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\* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

*Reserved on: 8<sup>th</sup> December 2022*

*Pronounced on: 19<sup>th</sup> December 2022*

+ CS(COMM) 30/2022 & I.A. 725/2022

DIAGEO BRANDS B.V. & ANR. .... Plaintiffs

Through: Mr. Amit Sibal, Sr. Adv. with Mr. Nitin Sharma, Ms. Savni D. Endlaw, Mr. Vivek Ayyagari, Mr. Angad S. Makkar, Mr. Sudarshan M.J. and Mr. Saksham Dhingra, Advs.

versus

ALCOBREW DISTILLERIES INDIA PVT LTD .... Defendant

Through: Mr. Chandar M. Lall, Sr. Adv. with Mr. Kapil Wadhwa, Ms. Tejasvini Puri, Ms. Surya Rajappan, Ms. Vasanthi Hariharan, Mr. Vishnu Langawat and Ms. Ananya Chugh, Advs.

**CORAM:**

**HON'BLE MR. JUSTICE C.HARI SHANKAR**

**J U D G M E N T**

**19.12.2022**

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**I.A. 725/2022 (under Order XXXIX Rules 1 and 2 of the CPC)**

## **Introduction**

1. Two seminal issues arise, albeit at an interlocutory stage, for consideration in the present case. They arise in the following factual scenario. The plaintiffs alleges piracy, by the defendant, within the

meaning of Section 22(1)<sup>1</sup> of the Designs Act, 2000 of their registered Design No. 306577. The defendant, invoking Section 22(3)<sup>2</sup> read with Section 19(1)(b) and (c)<sup>3</sup>, alleges, *per contra*, that the plaintiffs' design is bad on account of prior publication, and is lacking in novelty and originality *vis-à-vis* prior art in the form of two designs, one of which is Design No D562138 and the other to which allusion would be made in para 49 *infra*. The plaintiffs, in defence, impressed on certain distinguishing features of the suit design *vis-à-vis* said prior art, to assert the claim of the suit design to novelty and originality, and, consequently, validity. That argument already stands accepted by this Court in its judgement in *Diageo Brands B.V. & anr. v. Great Galleon Ventures Pvt. Ltd*<sup>4</sup> (referred to, hereinafter, as "*Diageo v. Great Galleon*") which, consequently, upholds the validity of the suit design. *The very same features, which, according to the plaintiffs, distinguish the suit design from prior art, also, prima facie, distinguish the impugned design of the*

<sup>1</sup> 22. Piracy of registered design. –

- (1) During the existence of copyright in any design it shall not be lawful for any person—
- (a) for the purpose of sale to apply or cause to be applied to any article in any class of articles in which the design is registered, the design or any fraudulent or obvious imitation thereof, except with the licence or written consent of the registered proprietor, or to do anything with a view to enable the design to be so applied; or
  - (b) to import for the purposes of sale, without the consent of the registered proprietor, any article belonging to the class in which the design has been registered, and having applied to it the design or any fraudulent or obvious imitation thereof; or
  - (c) knowing that the design or any fraudulent or obvious imitation thereof has been applied to any article in any class of articles in which the design is registered without the consent of the registered proprietor, to publish or expose or cause to be published or exposed for sale that article.

<sup>2</sup> 22. Piracy of registered design. –

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- (3) In any suit or any other proceeding for relief under sub-section (2), every ground on which the registration of a design may be cancelled under Section 19 shall be available as a ground of defence.

<sup>3</sup> 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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- (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;

<sup>4</sup> 2022 SCC OnLine Del 2350

*defendant's product from the suit design.* The defendant's contention is that, if these features confer novelty and originality to the suit design *vis-à-vis* prior art, they, equally, apply to the suit design *vis-à-vis* the defendant's design which cannot, therefore, be treated as infringing, or pirating, the suit design. Even otherwise, contends the defendant, piracy, within the meaning of Section 22 of the Designs Act would require near identity between the suit design and the infringing design, which is clearly absent in the present case. The plaintiffs contend, *per contra*, that, firstly, the scope of "novelty analysis" of the suit design *vis-à-vis* prior art is different from the scope of "infringement analysis" of the suit design *vis-à-vis* the defendant's design and, secondly, that the aspect of novelty has to be seen from the point of view of the "instructed eye" whereas the aspect of infringement would involve the "ordinary purchaser". Apart, therefore, from the general issue of whether the defendant's design pirates the suit design, the following three issues need to be addressed, in this backdrop:

(i) Is the scope of analysis, while examining the aspect of novelty and originality of the suit design *vis-à-vis* prior art, and the aspect of piracy of the suit design by the design of the defendant's product, different? In other words, if the features which distinguish the suit design and, therefore, confer novelty to it *vis-à-vis* prior art, also distinguish the defendant's design *vis-à-vis* the suit design, can the defendant's design be regarded as infringing (or pirating) the suit design?

(ii) Are the "eyes", through which the aspects of novelty of the

suit design *vis-à-vis* prior art, and of piracy of the suit design by the defendant's design, different, the former being the "instructed eye" aware of prior art and the latter the eye of the "ordinary purchaser" who, so to speak, sees the products on the shelf?

(iii) How are the plaintiffs' design and the defendant's product to be compared? Is the assessment to be made from the point of view of the average consumer who sees the products from a distance?

2. I, therefore, attempt to address, albeit *prima facie*, these issues.

## Facts

3. This judgment disposes of IA 725/2022, under Order XXXIX Rule 1 and 2 of the Code of Civil Procedure, 1908 (CPC), preferred by the plaintiffs Diageo Brands B.V. Netherlands and its licensee in India, United Spirits Ltd., against the defendant Alcobrew Distilleries India Pvt Ltd.

4. The plaintiffs allege infringement, by the defendant, of their registered Design No. 306577 ("the suit design" hereinafter), granted registration on 22<sup>nd</sup> March 2019.

5. The suit design was subject matter of earlier design infringement proceedings in *Diageo v. Great Galleon*<sup>4</sup>.

6. The suit design in *Diageo v. Great Galleon*<sup>4</sup> was the same as the

suit design in the present case. The design of the defendant's product in that case and in the present are, however, different. The design of the defendant's product in *Diageo v. Great Galleon*<sup>4</sup> was a near identical replica of the suit design. The impugned design in the present case is, however, different from the suit design in several respects. On this aspect, learned Counsel are *ad idem*.

7. What has to be seen is whether, *prima facie*, the differences in the impugned design *vis-à-vis* the suit design are sufficient to defeat the allegation of piracy.

8. Nonetheless, as the suit design in *Diageo v. Great Galleon*<sup>4</sup> and in the present case is the same, this Court, *vide* order dated 9<sup>th</sup> September 2022, required the defendant to address arguments first, as to how the present case could be distinguished from the decision in *Diageo v. Great Galleon*<sup>4</sup>.

9. Arguments were, therefore, first addressed by Mr. C.M. Lall, learned Senior Counsel for the defendant, whereafter Mr. Amit Sibal, learned Senior Counsel for the plaintiff, responded.

10. Both learned Senior Counsel were heard at length and opportunities for advancing submissions by way of rejoinder and sur-rejoinder have also been granted.

### **An Overview**

11. Plaintiff 1 is the proprietor of Design No. 306577, in respect of a

180 ml bottle, which is referred to, by the plaintiffs, as a “Hipster”, in which alcoholic beverages are packed and sold. The front view, the rear view, the top view, the bottom view, the side view and the perspective view of the design, as per the certificate granting registration, may be depicted thus:



**12.** The Plaintiffs also assert proprietary rights in respect of its trade

mark “Pocket Scotch”, under which it sells alcoholic beverages in the Hipster bottle.

**13.** The certificate of registration granted in respect of Design No. 306577 certifies that novelty resides, in each view of the registered design, “in the shape and configuration of the bottle as illustrated”. The registration certificate does not allude to any particular feature of the bottle as being specifically novel. Novelty, therefore, has been held to reside, by the certificate of registration of design, in its overall shape and configuration.

**14.** According to the plaintiffs, the defendant is manufacturing and selling whisky under the trade name “Golfer’s Shot” in a bottle/flask, the design of which infringes the suit design.

**15.** Learned Counsel for the parties have provided, to the court, the actual bottles in which the plaintiffs and defendant sell their respective products. For the sake of comparison, photographs of the front view, rear view, top view, bottom view, side view and perspective view of the defendant’s bottle, may also be provided thus, side by side with the corresponding views of the suit design :

<b>VIEW</b>	<b>HIPSTER</b>	<b>GOLFER'S SHOT</b>
<b>FRONT VIEW</b>		
<b>REAR VIEW</b>		
<b>PERSPECTIVE VIEW</b>		





**16.** Plaintiff 1 Diageo Brands B.V. Netherlands is the proprietor of the suit design. Plaintiff 2, which is a part of the Diageo group of companies, produces, imports, markets and distributes the products of Plaintiff 1. Plaintiff 2 is the proprietor of the brand “Black Dog” including its formative marks, logos, device mark, label and trade dress of the bottles and flasks in which the beverage “Black Dog” is packed and sold.

**17.** The particulars of the suit design, held by Plaintiff 2, may be provided in a tabular fashion thus:

Design	Design Number	Filing Date	Reciprocity Date	Class & Articles	Valid Till
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	306577	June 12, 2018	December 12, 2017	09-01 Bottle, flasks, pots, carboys, demijohns and containers with dynamic dispensing means	June 12, 2028 (extendable for a further period of 5 years)
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### The Plaintiff

**18.** The plaintiff avers that Love Creative Ltd, a design agency based in the UK was commissioned to create the suit design which, according to Mr. Amit Sibal, learned Senior Counsel for the plaintiff, is unique and was conceptualised consequent to the market interest in smartphones, with the advent of the new millennium. According to the plaintiff, the plaintiff's 'Hipster' design was modelled on the shape of a smartphone and, as it could be conveniently carried in a hip pocket, was marketed, by the plaintiffs, under the appellation "Pocket Scotch". In conceptualising and devising the said design, the plaintiff avers that it has expended approximately £ 1.5 million, with an additional £ 1.9 million spent in

setting up a supply distribution chain and global commercialisation of the “Pocket Scotch” products. According to the plaint, the imbibing of Scotch whisky in the plaintiff’s Hipster bottle was “more exciting, accessible, unique and convenient”.

**19.** Para 16 of the plaint asserts the unique features of the suit design:

“...The essential features of the Plaintiffs' 'Hipster' design reside in its rectangular shape inspired from shape and proportion of a smart phone; its smooth rounded shoulders and symmetrical edges; protruded 'v' shaped neck situated at the middle of both the shoulders; symmetrically raised and plateau like front and rear walls; rimmed rounded cap; dimpled bottom. The said essential features of the 'shape and configuration' of the design of Plaintiffs' 'Hipster' are distinctive and compositely create striking visual impression and 'appeal to the eye' which makes it novel.”

**20.** The suit design is claimed to have been first launched globally in 2018 to market the plaintiff’s well-known ‘Johnnie Walker (Black Label)’ and ‘Johnnie Walker (Red Label)’ Scotch Whisky brands. In India, it is averred that the plaintiffs’ Vat 69, Black Dog (Black Reserve), Black Dog (Triple Gold Reserve) and Black & White Scotch Whisky brands were also packed and sold in the 180 ml Hipster bottles. Additionally, it is stated that the plaintiff has now launched its ‘Smirnoff’ vodka brand in the same Hipster bottle. The plaint provides photographs of the Vat 69, Black Dog (Black Reserve), Black Dog (Triple Gold Reserve) and Black & White scotch whisky brands of the plaintiff, in the Hipster bottles, thus:



21. The monochromatic colour scheme of the Hipster bottle, with a label in the same background colour, the rim of the cap being of a different colour, the manner in which the text and label are depicted on the bottle, and other indentations and embellishments on the bottle are asserted as resulting in a distinctive trade dress, which acts as a source identifier for the plaintiff’s products. With the passage of time, asserts the plaintiff, the plaintiff’s ‘Pocket Scotch’ mark has acquired immense domestic as well as trans-border goodwill and reputation, and the mark “Pocket Scotch” and “Hipster” are invariably identified only with the

plaintiff's 180 ml Scotch Whisky brands, as sold in the Hipster bottle.

**22.** The suit design is stated to have become exclusively identified with the plaintiff and its products. The plaintiff's trade dress and the suit design are asserted to have acquired a secondary meaning, along with the marks "Hipster" and "Pocket Scotch". To emphasize the goodwill that the plaintiff's design has garnered over a period of time, the plaintiff avers that the sales, in India, of branded products of the plaintiff in the Hipster bottles, during May 2019 to March 2020, totaled ₹ 50.65 crores and, during the period April to September 2020, totaled ₹ 50.09 crores. The plaintiff also states that it has incurred promotional expenses, for its products in the Hipster bottles, to the tune of ₹ 9.2 crores in May 2019 to March 2020 and ₹ 3.3 crores in April to October 2020.

**23.** The defendant is also engaged in the manufacture and sale of alcoholic beverages. The plaintiff asserts that the defendant is packing and selling its 180 ml products in bottles, the design of which infringes the suit design. For this purpose, the plaintiff has provided comparative depictions of its "Vat-69" and "Black Dog Scotch Whisky" and the defendant "Golfer's Shot", thus:

NECK/TOP VIEW



FRONT VIEW



SIDE VIEW



BACK VIEW



ANGLE VIEW



NECK/TOP VIEW



FRONT VIEW



SIDE VIEW



BACK VIEW



ANGLE VIEW





NECK/TOP VIEW



24. The intent of the defendant to imitate the design of the plaintiff, it is submitted, is evidenced by the fact that the defendant was promoting its product under the “Pocket Shot” moniker, so as to confuse purveyors of the plaintiff’s product which was sold as “Pocket Scotch”. The *malafide* intention of the defendant, it is alleged, is also apparent from the fact that, till the suit design was registered and proved to be successful, the defendant was manufacturing and selling its 180ml “Golfer’s Shot” whisky in the following bottle:



In fact, contends the plaintiff, the defendant was selling its “Golfer’s Shot” whisky in 60 ml, 90 ml, 180 ml, 375 ml and 750 ml bottles, all of which were, till the impugned design came into being, of identical shape

and configuration, for which purpose the defendant's advertisement on its website, containing the following depiction, has been cited:



With the success of plaintiff's 180 ml "Hipster" design, the defendant started marketing and selling its 180 ml "Golfer's Shot" whisky in the bottle having the allegedly infringing design, even while retaining the original bottles for all other sizes. This, contends the plaintiff, makes it clear that the defendant was transparently seeking to capitalise on the goodwill earned by the plaintiff in the suit design.

**25.** The plaintiff also seeks to point out, in this connection, that, in its invoices placed by it on its customers, the defendant was referring to the whisky sold in all other sizes as "Golfer's Shot whisky", whereas the 180 ml product was referred as "Golfer's Shot 180 ml Hipster". A sample invoice has also been placed on record with the plaint. This, asserts the plaint, indicates that the defendant was, by using the appellation "Hipster" for its 180 ml product, clearly piggybacking on the reputation of the plaintiff in its "Hipster" suit design.

**26.** Para 38 of the plaint sets out the following features of the defendant's design which, according to the plaint, imitates the suit design:

- “(i) The overall shape and configuration of the 'Hipster' i.e. a tall and a lean bottle as compared to traditional flasks which are broad and short;
- (ii) The symmetrical edges and sides of both products are identical;
- (iii) Distance between the top sealing surface and the shoulder are identical;
- (iv) The dimensions of the bottom length and width of both products are identical;
- (v) Even positioning of the label at the front and back of the bottle are identical;
- (vi) Monochromatic colour scheme i.e. the entire product is Black;
- (vii) Rimmed cap of the bottle is identical”

**27.** All distinctive elements of the suit design, it is alleged, have been replicated by the defendant in the impugned design. The similarity between the two designs is so great that the customer, it is submitted, would invariably associate the defendant's products with the plaintiffs', especially as the products would be placed next to each other on the shelf. As the defendant's product is cheaper than that of the plaintiff, the plaintiff asserts that, by imitating the plaintiff's design, the defendant is eating – or rather drinking – into the plaintiff's market.

**28.** Premised on the aforesaid assertion and allegations, the plaintiff alleges that the defendant has involved itself in piracy of the plaintiffs' registered design within the meaning of Section 22 of the Designs Act.

**29.** Predicated on the aforesaid, the plaintiff seeks

- (i) a decree of permanent injunction, restraining the defendant

from dealing, in any manner, in the impugned “Golfer’s Shot” Barrel Reserve Whisky in 180 ml or in any other size in a bottle which infringes the suit design, or its overall trade dress and get-up, as would result in passing off, by the defendant, of its product as relatable to the plaintiffs, and

(ii) a decree of permanent injunction, restraining the defendant from promoting or selling its products using the mark/tag line “Pocket Shot” or any other mark/tagline deceptively similar to the plaintiffs’ mark “Pocket Scotch”,

apart from delivery up, rendition of accounts, damages and costs.

**30.** The defendant has filed a written statement, by way of response to the plaint. It is alleged, in the written statement, that the design of the defendant’s bottle is significantly different from that of the plaintiffs’ and that there is no chance of any confusion between the two. Differences, it is asserted, may be found in, *inter alia*, the height, dimensions and thickness of the product, roundness of shoulders and caps. The written statement further alleges that the shape and configuration of suit design is not novel but common to the trade and similar to several publicly known designs which precede the suit design. Rectangular bottles with round shoulders, basic rimmed caps and basic monochromatic designs, it is asserted, are broad features, common to the liquor trade. For this reason, it is alleged that the registration of the suit design is vulnerable to cancellation under clauses (b), (c) and (d)<sup>5</sup> of Section 19(1) of the

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<sup>5</sup> **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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Designs Act, 2000.

**31.** The written statement also disputes the plaintiffs' right to use the "Hipster" tag. A hipster, it is submitted, refers to a person, during the times of prohibition, who used to carry a hip flask. In any case, submits the written statement, the defendant is not using "Hipster" as a trade mark. The submission of the plaintiff with respect to the similarity between the plaintiff's "Pocket Scotch" and the defendant's "Pocket Shot" tag lines, it is submitted, is of no relevance, as the plaintiffs do not possess any domestic registration of the "Pocket Scotch" mark, and have also failed to demonstrate any goodwill exclusively associated with the said mark.

**32.** The shape and configuration of the plaintiffs' suit design are, submits the defendant, *publici juris*. There are several liquor brands which are sold in similar bottles, for which purpose the following pictorial depiction is to be found in the written statement:

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

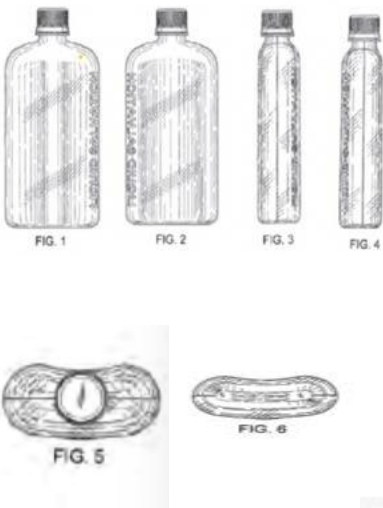


33. It is further submitted that the dimpled base of the plaintiffs' suit design is, again, a purely functional feature which is common to all bottles of that shape and configuration, and is intended to confer stability to the bottle when placed upright.

**34.** The written statement asserts that no monopoly could be claimed on such features which were common to the trade and to be found in several similar brands. Reliance has been placed, by the defendant, on Section 22(3) of the Designs Act, which allows every ground on which a registered design could be cancelled as a ground of defence to an infringement proceeding. It is also pointed out, in this context, that unlike the Trade Marks Act, the Designs Act does not presume any validity of a registered design. In its written statement, the defendant has in fact itself placed reliance on *Diageo v. Great Galleon*<sup>4</sup>. The defendant points out that, in order to plead that the suit design was novel, *vis-à-vis* an earlier existing international design no. D562138, the plaintiffs advanced contentions which would also serve to render the defendant's impugned design novel *vis-a-vis* the suit design. Expressed otherwise, the contention of the defendant is that the impugned design is identical to D562138.

**35.** The plaintiff, in its synopsis of written arguments in *Diageo v. Great Galleon*<sup>4</sup>, was required to show how the suit design was novel, *vis-à-vis* D-562138. The argument of the plaintiffs, in that regard, were presented in its synopsis of written arguments in *Diageo v. Great Galleon*<sup>4</sup>, thus:

<p>Document 10 (Page 27-28)</p>		<ul style="list-style-type: none"> <li>• Not clear enough to even visualize mentally the 'appeal to eye' if applied to tangible form. <u>Hence, not a valid publication.</u></li> <li>• Totally different from Plaintiff's design. Prima facie appears to be rounded,</li> </ul>
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<p>Date 26.08.2005</p>		<p>short, does not have the same features in the shoulders/corners/sides, plateau/raised sides, neck design, bottom dimple that of the Plaintiff's design.</p> <ol style="list-style-type: none"> <li>i. Two of its corners are more rounded than the other two bottom corners and not symmetrical.</li> <li>ii. Fig. 2 depicts that the bottle is concave in front.</li> <li>iii. There is embossing on the side.</li> <li>iv. It seems similar to the Defendant's existing 180 ml. bottle.</li> <li>v. Neck is entirely different and has no U-V design.</li> </ol>
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36. The impugned design of the defendant's bottle being identical to D562138, the defendant's contention is that the aforesaid features, cited by the plaintiff as distinguishing the suit design from D562138, would serve to equally distinguish the defendant's design from the suit design. If, therefore, on the basis of these features, the suit design can be regarded as novel *vis-à-vis* D562138, on the basis of the very same features, the defendant's design would be novel *vis-à-vis* the suit design.

37. Mr. Chander M Lall, learned Senior Counsel for the defendant, pointed out that the coordinate Bench, in *Diageo v. Great Galleon*<sup>4</sup>, accepted these contentions of the plaintiff as making out a case of novelty of the suit design *vis-à-vis* D562138. That acceptance, submits



Mr. Lall, would work in favour of the defendant in the present case, as the defendant's bottle would, for the very same reason, be novel *vis-à-vis* the suit design. *Diageo v. Great Galleon*<sup>4</sup>, therefore, submits Mr. Lall, supports, rather than defeats, to that extent, the case of the defendant *vis-à-vis* the plaintiffs.

38. As against this, points out Mr. Lall, the infringing product in *Diageo v. Great Galleon*<sup>4</sup> had a design which was identical to the suit design in all respects. The distinguishing features enumerated in the tabular statement in para 35 *supra*, on the basis of which the plaintiff, in *Diageo v. Great Galleon*<sup>4</sup>, sought to distinguish the suit design from D562138, would not apply to the impugned design in *Diageo v. Galleon*<sup>4</sup> *vis-à-vis* the suit design, as the two designs were identical. In the present case, the impugned design, submits Mr. Lall, is identical to D562138 and, therefore, the finding of the coordinate bench of this Court in *Diageo v. Great Galleon*<sup>4</sup> that the suit design was novel would also apply, equally, to the impugned design of the defendant in the present case.

39. In this context, the defendant, in the written statement, also pleads estoppel against the plaintiff. It is contended that the plaintiffs, having, in their synopsis of written arguments in *Diageo v. Galleon*<sup>4</sup>, taken a specific stand that the suit design was “totally different from D562138”, they could not seek to contend, in the present case, that the defendant's design was an imitation of the suit design. If the defendant's design is an imitation of the suit design, contends Mr. Lall, equally, the suit design would be an imitation of D562138.

**40.** The suit design, it is submitted, is merely the design of a plain hipflask, which is a thin flask for holding liquids, rectangular in shape (with or without curved edges) with a cap for fastening and cavities for pasting/affixing logos and labels of the manufactures. These common features, it is submitted, could not be allowed to be monopolised by the plaintiffs, as they seek to do in the present case. The suit design, *vis-à-vis* the design of an ordinary hipflask, it is submitted, contains mere ordinary trade variants. Such incorporation of ordinary trade variants into an existing design would not render the design new or original.

**41.** The defendant has also contested, in this case, the plaintiffs' contention that the suit design was inspired from a smart phone. In this context, Mr. Lall submits that, if the suit design was inspired by a smart phone, the impugned design of the defendant product was certainly not alike in shape or configuration to a smart phone and was, rather, more akin to the earlier hipster flasks, which were used during prohibition days. The very assertion of the plaintiffs that the suit design was inspired by the design of a smart phone, submits the defendant, is sufficient to distinguish the suit design from the design of the impugned product of the defendant.

**42.** Para 45 of the written statement presents the following comparative depiction to indicate the difference in the suit design and the design of the defendant's product:

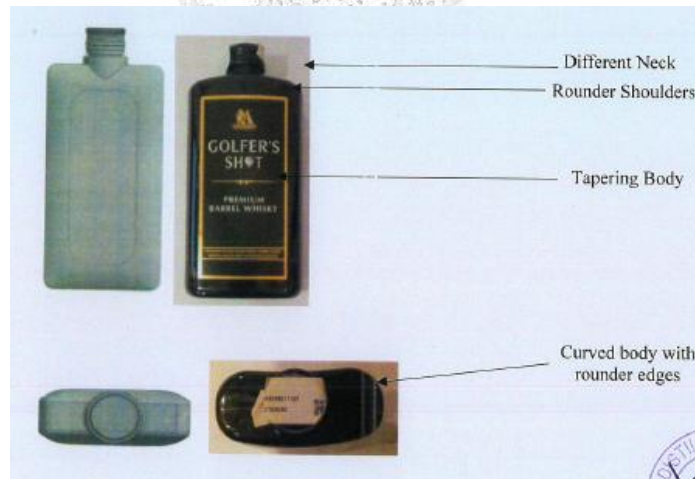
CATEGORY	PLAINTIFF'S DESIGN	DEFENDANT'S PRODUCT
Product Image		
		
Volume	180 ml	180 ml
Bottle Height up to Shoulder	128 mm	123.3 mm
Label Area Height	98.5 mm	103.5 mm
Label Area Width	36 mm	42 mm
Bottle Weight	32 gm	30 gm
Bottle Total Height	147 mm	140 mm
Neck Height	19 mm	14.5 mm
Bottle Width (Front)	67.5 mm	66 mm
Bottle Width (Side)	27 mm	30 mm

Para 46 of the written statement proceeds, thereafter, to once again

emphasise the differences in the design of the defendant's bottle *vis-à-vis* the suit design, as under:

“46. From a perusal of the above comparison, the following key differences in the Plaintiff's and the impugned designs are evident:

- a. **Overall Shape & Size-** It is stated that the Defendant's product is smaller in width and height as compared to the Plaintiffs' product and thus, resulting in overall smaller size. The height and width of the Defendant's product is 123.3 mm and 66 mm respectively as compared to the Plaintiffs' product which bears the height and width of 128 mm and 67.5 mm respectively. It is further stated that the side width (i.e. thickness of both the products is very different. While the Defendant's product is 30 mm thick, the Plaintiffs' product is only 27 mm thick. Thus, the Defendant's product is also fatter.
- b. **Rounder Edges-** It is stated that the Defendant's products bear rounder edges similar to the PETITIONER bottles and flasks illustrated in the foregoing paragraphs. That the curved shoulders of the Defendant's products significantly distinguishes it from the Plaintiff's design which is more rectangular in shape.
- c. **Smaller concave bottom-** It is stated that the defendant's products bear smaller concave/dimpled area at the bottom as compared to the Plaintiffs' product is elongated and sleek with rectangular edges, the Defendant's product bear a shorter dimpled area with curved edges.





43. In these circumstances, the written statement asserts that the design of the bottle in which the defendant sells its “Golfer’s Shot” Whisky cannot be regarded as either an obvious or a fraudulent imitation of the plaintiffs’ suit design, so as to constitute “piracy” within the meaning of Section 22(1) of the Designs Act.


44. The defendant has also contested the claim of passing off. It is submitted that the defendant’s product has a different name, label and appearance from that of the plaintiffs. There is, therefore, submits the defendant, no chance of any customer being confused between the product of the defendant and that of the plaintiffs, or believing that the product of the defendant is manufactured by the plaintiffs. Each, submits the defendant, has its own distinct reputation.

45. For all the aforesaid reasons, the written statement contends that the suit of the plaintiff is liable to be dismissed.

Rival submissions before me

46. Mr. Lall commenced his submissions by stating that he was not disputing the validity of the suit design, as it stood upheld in *Diageo v. Great Galleon*<sup>4</sup>, though later, in the course of his submissions, he somewhat relaxed the magnanimity of his stance.

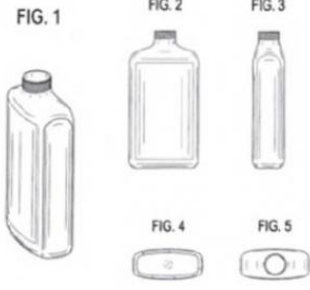
47. He then invited my attention to order dated 29<sup>th</sup> April 2022 passed by a coordinate Bench of this Court in *Diageo Brands B.V. v. Whiskin Spirits Pvt. Ltd.*<sup>6</sup>, in which the suit design was asserted, against the design of the bottle in which the defendant, Whiskin Spirits Pvt. Ltd (“Whiskin”, hereinafter) in that case, was packing and selling whisky. The suit was decreed on compromise, as Whiskin modified the design of its flask to the satisfaction of the plaintiff. As the said decision was passed on a settlement between the parties, and the product of the defendant in that case is different from the defendant’s product before me, this decision cannot, in my view, be of any serious significance. No estoppel can be pleaded against either party on the basis of a decree passed on compromise. Besides, I have been shown the actual modified bottle of Whiskin in that case, and it cannot be really said to be identical to the defendant’s bottle in the present case.

48. Drawing attention to the front view of the suit design, *vis-à-vis* the design of the defendant’s bottle, Mr. Lall submits that there are several features between the two which are dissimilar, and which defeat any plea of infringement. Among other things, he submits that, in the defendant’s bottle the distinctive V() shape at the neck of the suit design was absent, the shoulders of the defendant’s bottle were drooping/sloped as compared to the straight shoulders of the suit design, and the defendant’s bottle was curved, whereas the suit design was flat on both sides.

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<sup>6</sup> MANU/DEOR/91454/2022

49. Mr. Lall next refers to Annexure C of the written submissions filed by the plaintiffs in which the plaintiffs have sought to demonstrate how the suit design was novel *vis-à-vis* the prior registration, by underscoring the difference between them. He particularly refers to the defence of the plaintiffs *vis-à-vis* certain prior designs, of which one also stands noted in para 35 *supra*. Apart from the said prior art, Mr. Lall refers to the following tabular statements contained in the written submission of the plaintiffs, *vis-à-vis* other prior art form:

<p>Para 30 of the Reply to Injunction Application (Page Nos. 33-34)</p>	 <p>Date: 09.07.2014</p>	<ul style="list-style-type: none"> <li>• 3D image of the design being applied to tangible form missing.</li> <li>• Design illustrations are not so detailed to visualize the 'appeal to the eye' factor of the design when applied in tangible form. Hence, not a valid publication.</li> <li>• Dissimilar to Plaintiffs' design.             <ol style="list-style-type: none"> <li>i. Two of its shoulder more rounded and curved than the other two bottom corners and not symmetrical.</li> <li>ii. Prima facie appears to be</li> </ol> </li> </ul>
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		rounded, short, does not have the same features in the shoulders/corners/sides, plateau/ raised sides, neck design, bottom dimple that of the Plaintiffs' design.
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50. Apropos the prior art referred to in para 35 *supra*, and the plaintiffs' defence in that regard, Mr. Lall points out that while, in their written submissions in *Diageo v. Great Galleon*<sup>4</sup>, the plaintiffs contended that the design of the prior art was “*totally different* from plaintiffs' design”, the plaintiff had consciously modified the said submission in the present case, by averring that the prior art was “*different* from plaintiffs' design”.

51. Mr. Lall submits that the sweep of infringement analysis has necessarily to be equal to the sweep of analysis of novelty of the suit design *vis-à-vis* prior art. The perspective on the basis of which the aspect of imitation has to be decided, he submits, is not that of an average customer, as in the case of trademarks, but of an interested eye, i.e. an eye who is aware of the prior art. The interested eye, submits Mr. Lall, decides both the aspect of novelty and infringement. For this purpose, he relies on the following enunciation, to be found in para 10 of the report in *B. Chawla v. Bright Auto Industries*<sup>7</sup>:

“10. In *Phillips v. Harbro Rubber Company*<sup>8</sup>, Lord Moulton

<sup>7</sup> AIR 1981 Del 95 (DB)

<sup>8</sup> (1920) 37 RPC 233



observed that while question of the meaning of a design and of the fact of its infringement are matters to be Judged by the eye, (sic) it is necessary *with regard to the question of infringement*, and still more with regard to the question of novelty or originality, *that the eye should be that of an instructed person*, i.e., that he should know what was common trade knowledge and usage in the class of articles to which the design applies. The introduction of ordinary trade variants into an old design cannot make it new or original.”

(Emphasis supplied)

**52.** A second distinction between the approach to be adopted in design infringement cases *vis-à-vis* that to be adopted in trade mark infringement cases, submits Mr. Lall, is that, unlike trade mark infringement cases, which rely on the impression of a person of average intelligence and imperfect recollection, design infringement has to be decided on the basis of face-to-face comparison of the two designs. There is, therefore, no scope of applying the “imperfect recollection” test. Mr. Lall relies, for the said proposition, on the decision of the Chancery Bench of the High Court of UK in *Negretti & Zambra v. WF Stanley & Co.*<sup>9</sup>, particularly on the following passages therein:

“The alleged infringement is practically identical with the registered drawing, with the exception that, instead of the face of the instrument where the thermometer registers being flat, the Defendants have a V-shaped face, the mercury tube being seated at the bottom of the V. It appears from the correspondence which has been put in evidence that the Defendants were asked in 1922 by a firm known as the *Jackson Electric Stove Co.*, who had been customers of the Plaintiffs, to submit a section view of a thermometer which would overcome the registration difficulty, it having been pointed out that the Plaintiffs had a registered Design, and one of the Plaintiffs' thermometers having been handed to the Defendants for the purpose of providing the sketch *which was asked for in this letter. It is quite apparent that the Defendants were asked to supply, and did supply, thermometers which were to be as like the Plaintiffs' as possible, subject to such alterations as the Defendants might think sufficient to get them out of infringing the Design.* The Plaintiffs' article has been a very successful one. According to the evidence, after the war, 500 were sold in 1922;

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<sup>9</sup> 1925 (42) RPC 358

1,970 in 1923; 3,340 in 1924; and 3,400 in the first six months of the present year. It does not look as if the Defendants' conduct has had any very damaging effect upon the Plaintiffs' sales, although that, of course, is quite irrelevant to what I have to decide.

The Defendants allege that this Design is not new and original, and that they have not infringed it. *A number of prior documents and prior articles have been put in for the purpose of proving prior publication, and from those it is quite plain that stove thermometers were old ; inlet tubes at right angles to the thermometer were old ; the inclined faces of the scale of the thermometer to the stove were also old ; and there is really nothing new about the present Design, except possibly the combination of the two lugs for the purpose of screwing the instrument on to the stove face in an article in which the inlet tube of the thermometer was at right angles to the thermometer itself.* The Plaintiffs' instrument, like the Defendants', is intended to be used with the thermometer lying in a horizontal position, so that any person standing in front of the stove can read it, the reading being facilitated by reason of the inclined scale attached to the stove. There is nothing whatever in the drawing of the Plaintiffs' Design, when the heat figures are eliminated, to show whether the thermometer is intended to be used in a horizontal or in a vertical position.

The two nearest prior publications are, first, a thermometer made by the Defendants prior to 1913, which has been marked " No. 7, " in which the attachment containing the thermometer bulb is at right angles to the thermometer itself , the attachment being, in the size which has been put in, cumbrous, and it having a ball-shaped end to it where it adjoins the thermometer, and the thermometer being angled as in the Defendants' article. This particular one that has been proved is intended to be inserted in a stove, or some similar article, the thermometer in its vertical position being at right angles to the inlet tube, which is inserted into the stove, and the face of the thermometer being angled at much the same degree from the plane of the apparatus into which it is to be inserted, as is the case in the Plaintiffs' Design. The other one is in a catalogue of the Defendants, at page 43, being figure 148. That, again, shows a thermometer intended to be used in a vertical position, a right-angled inlet, and the face of the thermometer, again, is fiat, as is the case of the registered Design. *There are certain catalogues which have been put in showing a large number of thermometer Designs, where many of the features, if not all of the features, of the Plaintiffs', can also be found, though not, of course, all in the same combination.*

On the question of validity, the issue that I have to determine is whether this is an attempt to get a sort of patent advantage, having regard to the character and function of the article, as distinct from the

mere pictured Design. That the Plaintiffs' article is commercially of a size and character which is very successful has, of course, been amply demonstrated; but one must not be misled by the fact that the Defendants have made these articles of practically the same size and for the purpose of being used in an exactly similar manner to that shown in the registered Design, and to that used in practice by the Plaintiffs.

In *Phillips v. Harbro Rubber & Co.*<sup>8</sup>, there is a judgment of Lord Moulton which is constantly cited. At page 239 he says : Although a Design may be for an article of special form or configuration, "there is nothing in the definition which relates to construction, and therefore, "however constructed , an article of the same configuration is equally within or without the scope of a registered Design , and , on the other hand , a Design " cannot be rendered new or original merely by a change of the mode of construction of the article. This is a consideration of the gravest importance, and has been insisted upon again and again by the Courts. No better illustration can be given than the weighty judgment of the late Lord Parker (then Mr. Justice Parker ) in *Pugh v. Riley*<sup>10</sup> at page 202. A registered Design is not in any way a minor type of patent. It is something that is protected in respect of its appearance or form alone. It is for this reason that all attempts to make registered Designs cover modes of manufacture have rightly failed, and that the Courts have so invariably insisted on the principle that Designs must be judged by the eye alone. But, while questions of the meaning of a Design and of the fact of its infringement are matters to be judged of by the eye , it is necessary with regard to the question of infringement , and still more with regard to the question of novelty or " originality , that the eye should be that of an instructed person , that is, that " ho should know what was common trade knowledge and usage in the class of " articles to which the Design applies. The introduction of ordinary trade variants into an old Design cannot make it new or original . For example, if it is common practice to have or not to have spikes in the soles of running shoes , a man does not make a new and original Design out of an old type of running shoes by putting spikes into the soles. The working world, as well as the trade world, is entitled at its will to take, in all cases, its choice of "ordinary trade variants for use in any particular instance , and no patent and " no registration of a Design can prevent an ordinary workman from using or " not using trade knowledge of this kind. The importance of insisting upon this "principle is emphasised by the fact that under our legislation registered " Designs are kept secret. No member of the public has the right to inspect a "registered Design during the existence of the copyright . It is not my intention to dwell on the extraordinary

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<sup>10</sup> (1912) 29 B.P.C. 196

character of the legislation, which was “apparently inspired by the desire to prevent rivals learning of patterns of lace ' or textile articles which were intended to be brought into the market in the immediate future. But if an ordinary workman is thus to be kept in “ ignorance of what he may or may not do without infringing the unknown “ rights of registered proprietors of designs , it is obviously the duty of the “ Court to take special care that no design is to be counted a ‘ new or original 'design / unless it is distinguished from what previously existed by something “essentially new or original which is different from ordinary trade variants which have long been common matters of taste or choice in the trade. ” *In my judgment the Plaintiffs ' Design is not so distinguished . It seems to me that what the Plaintiffs have done is to make a neat and handy instrument similar in character as compared with many which went before , but which contains no novelty , within the meaning of the Act , which renders it a new and original Design as distinct from the many very similar Designs which had previously existed , and all that has been done has been to apply ordinary trade variants or trade adjustments well known and common for the purpose of making an instrument useful for the purpose for which it was intended and not rendering it qua configuration or design anything substantially new and original at all.*

A similar point came up for decision in *Allen West & Co., Ltd, v. British Westing house Electric and Manufacturing Co., Ltd.*<sup>11</sup> . The passage relied upon by the Defendants begins at page 162: “The encouragement given by the patent law to those who produce new and useful inventions, and by the law relating to designs to those who produce new and original designs, is primarily to advance our industries, and keep them at a high level of competitive progress ; but , in administering these provisions, it is, I think , most important to bear in mind the fact that they are not intended, and ought, not to. be. allowed, to paralyse or impede the natural and normal growth and development of the manufactures which they are intended to benefit. I think this case ought to be determined upon the question whether the difference in the registered Design of the right –angled finger support is or is not sufficient to make it an original Design within the meaning of the Act , or , whether , on the contrary, it is not an ordinary and natural alteration of the shape of a known article for the purpose of fitting it into a case or apparatus in which it is desired that it shall work . In the case of *Bayer' s Design*<sup>12</sup> , *Lord Macnaghten* , in giving judgment in the House of Lords , said : ‘Although a Design , properly ‘so-called, and duly registered, may incidentally protect a method of manufacture , it is clear that a mere method of manufacture cannot be registered as a Design under the Act.’” Later on in the judgment it is

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<sup>11</sup> (1916) 33 R.P.C.157

<sup>12</sup> ( 1908) 25 R . P . C . 56)

stated how far, if at all , the question of the utility of the article or product assists on the question of novelty , and I do not propose to read it through again. At page 164, at line 35, the judgment proceeds: “I now proceed to examine the matter a little more closely on this question of angle. This is a Design for shape or configuration. I agree it must be looked at by a person with knowledge of what has gone before, and with knowledge of what the article, the subject matter to which the Design applies, is to be used for. The Design as a whole is substantially identical with the anticipation. Every single part of it is the same, excepting the angle of the finger support. It is perfectly true that if you take the outline, the alteration of that angle makes a certain amount of difference, but, *qua* Design of the thing as a whole , the difference is small. *The question I have to decide is whether the alteration is a workshop alteration such as one would expect any competent workman to make as soon as he knew the shape of the support on to which this thing had to be screwed, or whether the Design as a whole is a new or original one within the meaning of the Act. ” Then it is pointed out that not every change of length, breadth or configuration in a simple article is sufficient to constitute novelty.*

Mr. *Trev or Watson* in his argument for the Plaintiffs referred to three tests, not for the first time in this Court, as to whether there is sufficient novelty to constitute a valid Design in this case. He said , first : Could the infringement be mistaken for the registered Design ? The answer to that is, that it certainly could if the exact details of the device are not considered. Secondly, he asked: Whether the Defendants ’ article would ever have existed if it had not been for the Plaintiffs’ Design ? I think he is entitled to say, having regard to the Plaintiffs’ correspondence , that the answer is that it probably would not. Thirdly, he asks: Is the infringement more like the registered Design than any article which previously existed ? Again, the answer is , that it is . But, in my opinion, none of those tests in the present case is really at all conclusive.

The Plaintiffs, in my judgment, have produced a useful article of commerce for a particular purpose, which, from its smallness and neatness, is readily distinguishable from the larger thermometers which had gone before; but that, of course, is wholly immaterial. *The fact that the Plaintiffs have hit upon a useful shaped and useful sized thermometer for the particular purpose in hand 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.* Again, the reason why the alleged infringement here is more like the Plaintiffs' article than the other Designs which have been shown is principally really concerned with

the question of size. As a matter of fact, the only real addition to the previous pictured knowledge of these thermometers in the Plaintiffs' Design is the fact that it is attached to the oven door by two lugs, instead of two holes in the face of the thermometer case itself . All that in thermometers of different size used for different purposes is old. The right-angled inlet tube, the inclined face, the flat face, are all matters of old common knowledge. For these reasons I am of opinion that the Plaintiffs ' Design is not a new and original Design, within the meaning of the statute. The second matter which has been discussed is the question of infringement. If I am wrong as to the validity of this Design, and as to its novelty and originality, then the question arises as to whether the Defendants' article is an infringement of the Plaintiffs' Design. In a Design of this very humble character, where the Design itself is very close to Designs which have gone before, as *Lord Halsbury* said in the *Gramophone Case*<sup>13</sup> \* the Plaintiffs, in order to succeed in infringement, must show' that the article complained of is an exact reproduction of the Plaintiffs' Design, and that any difference, however trifling or unsubstantial, will or may protect it from infringement. In the present case there is a distinct difference between the Plaintiffs' article manufactured and as shown in the Design and the article complained of infringement. The novelty claimed in the Certificate of Registration being the shape or configuration of the thermometer having the scale face projecting and being inclined as shown in the picture is a novelty which is not exactly or in fact, reproduced in the Defendants' instrument. The Defendants have a perfectly common V-shaped face to their scale plate, and that, having regard to the extreme slightness of the difference between this Design and the thermo- meters which have preceded it, if the Design be valid, is sufficient, in my judgment, to prevent the Defendants' being an infringement ; so that, if it were necessary to decide the question of infringement, on the assumption that the Design is valid, I think the Defendants are, again , entitled to succeed; but, in my view', the real question here is validity, and , in my judgment, the Plaintiffs have not answered the tests required of them for the purpose of sustaining this Design, and the action must, in consequence, be dismissed with costs"

(Emphasis supplied)

**53.** On the basis of the aforesaid decision, Mr. Lall contends that in the case of design infringement of a humble design, infringement can be said to exist only if the defendant's design is virtually identical to that of the plaintiffs.

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<sup>13</sup> 1911 RPC 221

54. Mr. Lall has also relied on the following passages from the judgment of a learned Single Judge of this Court in *Carlsberg Breweries A/S v. Som Distilleries and Breweries Ltd.*<sup>14</sup>:

“157. Before comparing the registered design of the plaintiff in its beer bottle, with the design adopted by the defendant in respect of its beer bottle, it would be useful to also take into consideration the tests laid down and applied by the courts in the decisions relied upon by the defendants. The leading case relied upon by the defendant is that of *Gramophone*<sup>13</sup> (supra). While rejecting the claim of the plaintiff for design infringement, the House of Lords (Lord Loreburn LC) held that the product of the defendant - a cabinet, “*is a different combination of familiar contrivances*”. He further observed that if the suggested novelty lies in the detailed arrangements of the parts, quite a small change in the arrangements make a real difference. The Earl of Halsbury in the same case observed that:

“.....it must be the exact thing; and or any difference, however trifling it may be or however unsubstantial, would nevertheless protect it from being made the monopoly of the particular designer who thought proper to take it.”

158. Lord Shaw, in his opinion, emphasized the aspect of novelty and originality which alone would render the design entitled to protection.

159. In *Negretti*<sup>9</sup> (supra), the claim of the plaintiff for design protection was rejected by holding that the plaintiff's design was not new or original. There was only a slight difference between the design of the plaintiff and the design of thermometer which had preceded it. The Court also held that there was sufficient distinction between the defendant thermometer and the design of the plaintiff.

160. In *Phillips*<sup>8</sup> (supra), the House of Lords rejected the claim of the plaintiff for a novel design in respect of rubber pads and plates for heels of boots and shoes on the ground that the same was not new or original, since it is not distinguishable from what previously existed. It was merely an ordinary trade variant. The House of Lords further held that to determine the question of infringement of a registered design, the eye should be of any instructed person i.e. he should know what was common trade knowledge and usage in the class of articles to which the design applies.

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<sup>14</sup> 2017 SCC OnLine Del 8125 : (2017) 70 PTC 413

161. In *Gaskell & Chambers Ltd v. Measure Master Ltd.*<sup>15</sup> (supra), the Court held that the issue of validity of registered design should be decided on a comparison and features which appeal to and are judged by the eye. It is often helpful to look at what was available before the priority date of the registered design as the eye of the interested addressee could be drawn to details, only if the registered design differs from the prior art by such details. It is only when the new design differs radically from the previous designs, that the interested person's eye would more likely concentrate on and more likely remember the general form of the new design rather than the details.

162. In *Repetition Woodwork Co. v. M Briggs*<sup>16</sup>, the comparison of the designs was in respect of combined press for neckties - or the like, and box to contain collars and other articles. The Court held that although each one of the differences in the two designs when taken separately may well be said to be not very substantial, yet when taken all together they cause the defendant's box, both when closed and when opened, to present an appearance substantially different from that of the plaintiff's design. Thus, apart from comparison of the different parts of the article in question, an overall view is also required to be taken.

163. In *Polar Industries Ltd. v. Usha International Ltd.*<sup>17</sup> since the design registration claim by the plaintiff pertained to the entire article as a whole, namely, a table fan/portable fan, the Court held that overall view of the registered designs of the plaintiff - comprising of configuration, shape and ornamentation will have to be considered for the purpose of comparison. The component parts of the registered design of the plaintiff could not be viewed in isolation to determine as to what are its striking features.

164. In *Dabur India Ltd. v. Rajesh Kumar*<sup>18</sup>, the claim for design infringement made by the plaintiff was rejected by the Court by observing that the hair oil bottles of the plaintiff are common bottles being used by several other companies for marketing their hair oil and other products. These bottles have similar shape with slight variation in form which have pre-existed the registration of design of the plaintiff. In that case, the design registration obtained by the plaintiff was not in respect of any peculiar feature of the bottle registered as a design. The whole bottle was got registered as a design. The Court held that the plastic bottle got registered as a design by the plaintiff was a very common shape, and that it did not have any peculiar eye catching designing or shape. To the same effect is the decision in *Amit*

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<sup>15</sup> 1993 RPC 76

<sup>16</sup> 41 RPC 449

<sup>17</sup> 2000 (20) PTC 469 (Cal)

<sup>18</sup> 2008 SCC OnLine Del 393 : 2008 (37) PTC 227



*Jain*<sup>19</sup>. In *Amit Jain*<sup>19</sup>, the Court held that unless the plaintiff had any claim qua specific ratios of the dimensions which were not pre-existing, there could be no novelty in the bottle.

165. In *Steelbird Hi-Tch India Ltd. v. S.P.S. Gambhir*<sup>20</sup>, the aspect of novelty and originality was explained to mean that there must be a mental conception expressed in a physical form which has not existed before, but has originated in the constructive brain of its proprietor and that it must not be trivial or infinitesimal in degree, but in some substantial degree.

166. In *Dover Ltd. v. Nurnberger Celluloidwaren Fabric Gebruder Wolff*<sup>21</sup>, the Court held that a slight trivial or infinitesimal variation from the pre-existing design will not qualify for its registration, and that the change introduced should be substantial. At the same time, the newness may be confined to only a part of the design of the article-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.”

**55.** The submission of Mr. Sibal that the suit design was based on the shape of a smartphone, submits Mr. Lall, is self-defeating, as it cannot be said, howsoever one looked at it, that the defendant’s bottle was shaped like a smartphone. In fact, reiterates Mr. Lall, the very features which were cited by the defendant as imbuing, to the suit design, novelty over prior art, such as the V shape, broad shoulders, etc, were not to be found in the impugned bottle of the defendant. Mr. Lall has, in this context, relied on para 38 of the plaint, which reads as under:

“38. A bare perusal of the above comparison reveals that Defendant's Infringing Product 'Golfer's Shot' Barrel Reserve Whisky in 180ml is identical / obvious and fraudulent imitation of the Plaintiff No. 1 's registered design of Hipster bottle and identical / obvious and fraudulent imitation of overall trade dress and get up of the Plaintiffs' Hipster Products. Defendant has deliberately and fraudulently copied the following features of the Plaintiffs' design:

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<sup>19</sup> 2008 SCC OnLine Del 1293 : (2009) 39 PTC 104 (Del) (DB)

<sup>20</sup>2014 SCC OnLine Del 821 : 2014 (58) PTC 428 (Del)

<sup>21</sup> 27 RPC 498

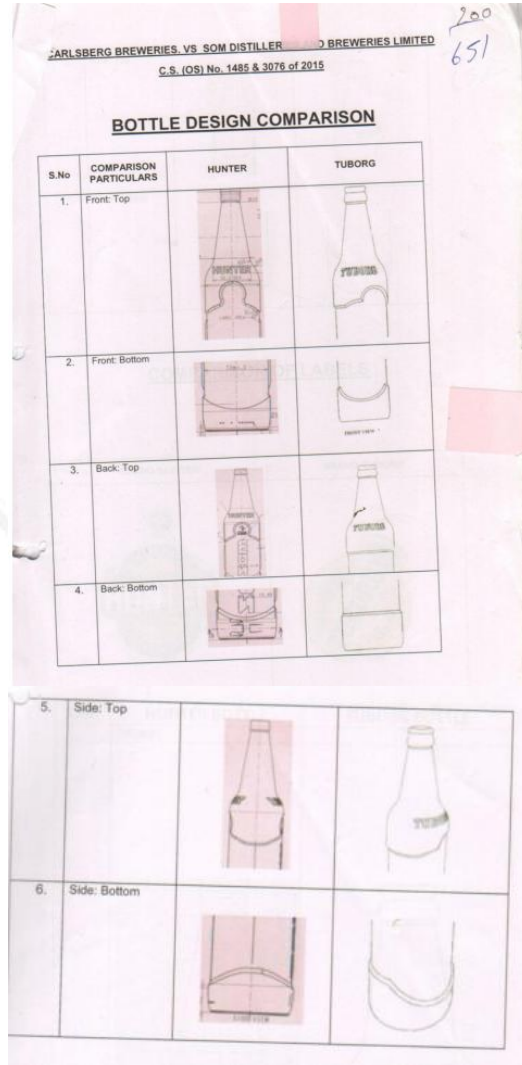
- i. The overall shape and configuration of the 'Hipster' i.e. a tall and a lean bottle as compared to traditional flasks which are broad and short;+
- ii. The symmetrical edges and sides of both products are identical;
- iii. Distance between the top sealing surface and the shoulder are identical;
- iv. The dimensions of the bottom length and width of both products are identical;
- v. Even positioning of the label at the front and back of the bottle are identical;
- vi. Monochromatic colour scheme i.e. the entire product is Black;
- vii. Rimmed cap of the bottle is identical.”

**56.** These features, submits Mr. Lall, cannot constitute a legitimate basis to allege that the defendant’s bottle infringed the plaintiffs’ suit design. Mr. Lall cites, in this context, paras 176 to 179, 182 and 183 of *Carlsberg Breweries*<sup>14</sup>, which read thus:

“176. The next question that arises for consideration is that even if the plaintiff's design registration is presumed to be valid, i.e. that the indentations/grooves found on the plaintiff's beer bottle are presumed to be not only novel, but also appealing to the eye and at the same time, as not being functional, whether the defendant's bottle design prima-facie infringes the plaintiff's registered design.

177. Once again, *I, prima-facie, find that the plaintiff has not been able to make out a case of design infringement. When one compares the beer bottle of the plaintiff as a whole with the beer bottle of the defendant - as a whole, they both appear to be like any other ordinary beer and other beverage bottles available in the market. The defendant has placed on record photographs of several other beer and other beverages brands having similar shapes of bottles, such as Bud Weiser, Staropramel, Podkovan, Ursus, Glenfiddseh, Goldur, Praha, etc. It needs consideration whether the indentations/grooves in the plaintiff's bottle design, and those found in the defendant's bottle, when compared, lead to the prima-facie conclusion that the*

*defendant's indentations/grooves are a fraudulent and obvious imitation of the plaintiff's bottle design.* The two bottles when viewed from different angles, by placing them side by side appear as follows:



178. The above comparison has been taken from the documents filed by the defendant at pages 651 and 652 of the record. I may observe that the plaintiff has not filed a similar comparison. The plaintiff has, however, filed the comparison of photographs taken from the same angles, and they have been taken note of in paragraph 3 above.

179. As held in *Castrol*<sup>22</sup>, *not every resemblance would be actionable at the instance of the registered proprietor of the design.* At the same time, imitation does not mean duplication. The copy complained of need not be an exact replica. *While comparing, it is necessary to break down the article into parts for descriptive*

<sup>22</sup> 1994 SCC OnLine Cal 303 : (1996) 16 PTC 202

*purposes, but in the ultimate result, it is the article in totality, i.e. as a whole, that must be compared and contrasted with the features of shape and configuration of the design allegedly infringed, taken as a whole. The Court is required to see as to whether the essential part or the basis of the plaintiff's claim for novelty forms part of the alleged infringing copy.*

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182. Once again, in my view, *the said indentations are extremely insignificant and non-essential part of the entire bottle design. It is not something that appeals to the eye, and when an overall view of the design of the two bottles is taken, the same pales into insignificance. When the two design shapes of the bottles in question are compared, in my view, it cannot be said that there is an obvious or a fraudulent imitation. The defendant's bottle design does not appear to be an obvious imitation, because the so-called similarity in the shapes of the two bottles - when they are compared part by part, and thereafter as a whole, do not lead to the immediate and striking impression that the defendant's bottle design is so close to the original design of the plaintiff's bottle, that the similarity is immediately apparent to the eye.*

183. It also cannot be said that the so-called imitation is based upon the plaintiff's registered design, or that the distinction between the two bottle designs is found to be subtle in nature, *upon close examination and comparison of the two bottle designs.*”

(Emphasis supplied)

57. Mr. Lall submits that the shape of the defendant's bottle was inspired by the shape of the hipflask, and not by the shape of the smartphone. He draws my attention, in this context, to para 36 of the written statement filed by the defendant, which provides a picture of a hipflask thus:



**58.** In the above context, Mr. Lall relies on the following passage from the judgment of a learned Single Judge of this Court in **Rajesh Kumar**<sup>18</sup>:

“11. In cases of design, the Court while granting interim injunction must keep in mind that the design must be validly registered and there must be some novelty and originality in the designs sought to be protected and it must not have been republished. No specific novelty has been mentioned by the plaintiff in the design of the bottle, neither any specific novelty has been mentioned in the registration certificate. The registration certificate only gives bottom view, top view and side view of the bottle. There is no specific dimensional ratio of the bottle given in the design as bottles are manufactured by most of the manufacturers for containing specific quantity of liquid by measurement. Normally these bottles are made 50 ml, 100 ml, 200 ml, etc. Since all the manufacturers manufacture bottles for such quantities, the bottles of same quantity are bound to have almost same height if they have same bottom circumference. Unless, plaintiff had any claim over specific ratios of the dimensions which were not pre-existing, there can be no novelty in the bottle. Similar designs are being used by many leading companies from the time much before the registration of this design by the plaintiff. I, therefore, consider that the plaintiff is not entitled for interim injunction. The application of the plaintiff is hereby dismissed.”

**59.** At this point, Mr. Lall resiles somewhat from his initial submission that he would not be questioning the validity of the plaintiff’s suit design. He draws my attention to para 40(c) of the plaint, which reads as under:

“40. The dishonest adoption and *mala-fide* intention on part of the Defendant is reflective from the following facts:

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c. The shape and configuration of the design of the Infringing Product is obvious imitation of Plaintiffs' registered design of Hipster. All the essential features of the Plaintiffs' registered design of Hipster have been found to be present in the design of the bottle of Defendant's Infringing Product.”

Thus, submits Mr. Lall, the plaintiff has accepted, in the plaint, that all the essential features of the suit design were present in the allegedly infringing design of the defendant’s bottle. The defendant’s bottle being identical in design to the prior art cited in para 35 *supra*, Mr. Lall submits

that all the essential features of the said prior art were, even as per the admission in para 40(c) of the plaint, present in the suit design. This, rendered the suit design lacking in novelty and, therefore, invalidated it. This argument was not available to the defendant in *Diageo v. Great Galleon*<sup>4</sup> as the design of the impugned flask in that case was identical to the suit design. For this reason, submits Mr. Lall, in view of the admission – though couched as an allegation – contained in para 40(c) of the plaint, the suit design was rendered invalid for want of novelty *vis-à-vis* the prior art cited in para 35 *supra*. The admission in para 40(c) of the plaint, submits Mr. Lall, stands reiterated in the following words in para 42 of the plaint, which reads as under:

“42. It is submitted that the Defendant has copied not only the Plaintiffs' registered design but also the distinctive elements of the Plaintiffs' overall trade dress and get up. The products of the Plaintiffs and the Defendant when compared as a whole, it becomes evident that the Defendant's Infringing Product is identical / deceptively similar in shape, configuration to Plaintiffs' registered design and dishonest adoption of overall trade dress and get up of the Plaintiffs' Hipster Products.”

**60.** Emphasising the fact that, in order to contest an application seeking interlocutory injunctive relief, the defendant is only required to set up a credible challenge to the validity of the suit design, Mr. Lall submits that, in the facts of the present case and in view of the submissions advanced by him, a credible challenge to the validity of the suit design in the present case had been made by the defendant. In that view of the matter, even if the design of the defendant's product were to be treated as infringing the suit design, the plaintiffs would nonetheless not be entitled to an injunction.

**61.** Mr. Lall next refers to para 43 of *Diageo v. Great Galleon*<sup>4</sup>, on the aspect of balance of convenience, which reads as under:

“43. The balance of convenience also lies in favour of the Plaintiffs. The Defendant was admittedly selling its products only in a limited geographical space viz. in Madhya Pradesh. It is an admitted position that Defendant’s Bottles were being marketed for only a few weeks, before the ad-interim injunction was granted to the Plaintiffs on 23rd February, 2021, and the impugned design has not been sold since. Mr. Lall, upon being queried by the Court, stated that since the injunction, the Defendant has been selling its product in another bottle which is dissimilar in design to the Hipster, and an application to this effect had also been filed before the Court seeking to modify the design of its bottle. It is also noted that there is no pleading by the Defendant that its entire business would shut down as a consequence of the injunction. Hence, as such, it cannot be said that the Defendant’s business has been severely impacted by the injunction.”

The considerations noted in para 43 of *Diageo v. Great Galleon*<sup>4</sup>, submits Mr. Lall, do not apply to the present case.

**62.** Finally, Mr. Lall submits that the concept of a “Hipster Flask” is as old as the hills. He has invited my attention to literature placed on record by the defendant, which cites the following quotation from an issue of the New York Tribune dated 22<sup>nd</sup> December 1920:

"How can twenty-five men keep Chicago dry, when it would take that any to watch the hipsters in one hotel dining room?" This is the question heard among those who already have obtained table reservations.”

**63.** Thus, submits Mr. Lall, “Hipster” was an expression used to denote persons who carried liquor flasks on their hips. Mr. Lall has also referred to the following literature, to be found at the website <https://www.jacksonstrophies.com/blog/flask-history-why-were-drinking-flasks-invented>:

### **“When were hip flasks invented?”**

The curved designs you see today were invented in the 18th century. They were popular with the gentry (the elite social class of the time). High-quality flasks were made from silver and glass, but cheaper ones made from pewter were also available.

Pewter contains dangerously high levels of lead. Unfortunately for some, the dangerous metal was leaking into their containers and causing brain damage. You can still buy pewter flasks, but thankfully, they no longer include lead ... Before their invention, women used to smuggle makeshift flasks (often made from pigs bladders) onto British warships. They would fill them with alcohol and hide them under their petticoats.

Why were hip flasks invented?

Hip flasks were invented to make smuggling alcohol easier. Their curved shape makes them easy to carry against your hip or thigh without anybody noticing. Most flasks also have a captive top with a hinge which prevents you from losing the small lid ....

### **Is carrying a hip flask illegal?**

In the UK, it is not illegal to carry or drink from a hip flask in public places. In America, it is illegal in some places due to open container laws.

Hip flasks and the Prohibition

During the U.S prohibition in the 1930s, the US government banned the sale of both hip flasks and cocktail shakers.

The ban was put in place because more people purchased a hip flask within the first six months of the prohibition than they had in the last 10 years.

Why did the prohibition start?

Alcohol was banned completely in America between 1920-1933. This was driven by various religious organisations who thought banning alcohol would reduce crime and violence rates, and raise religious quality in America.

It didn't work ...

Banning alcohol did not go the way the US government had hoped ....



it led to lost government revenue from alcohol tax and caused a lot of people to move on to heavier substances instead.

Throughout the prohibition, alcohol consumption gradually rose back to around the same level as it was before the ban anyway.

But it did give us some great stories and rich history ...

The high demand for alcohol birthed many dangerous and gangs and gangsters, including Al Capone, who is infamous for illegally brewing, distilling and distributing beer and liquor. It also led to the creation of speakeasies, illegal bars where people would drink alcohol in secret.

### **Hipsters & Bootleggers**

Due to the high tensions and serious penalties surrounding alcohol usage, many people used hip flasks to hide their drinks from officials. People who carried hip flasks were referred to as "hipsters".

A lot of men and women would conceal their flasks within their boots, which is where the phrase "bootlegger" comes from too."

**64.** For all the aforesaid reasons, Mr. Lall contends that the design of the flasks/bottles in which the defendant sells its product cannot be treated as infringing the suit design, so as to entitle the plaintiffs to an interlocutory injunction. The decision in *Diageo v. Great Galleon*<sup>4</sup>, he submits, was with respect to an entirely different product which was identical, in shape, size and configuration to the suit design. That decision, therefore, submits Mr. Lall cannot be of assistance in the present case.

### Contentions of Mr. Sibal

**65.** Mr. Amit Sibal, at the very outset, disputes Mr. Lall's contention that the tests for determining infringement, in the case of trademarks and

designs, is different. While Mr. Lall had sought to contend that novelty as well as infringement, in the case of a registered design, had both to be tested on the anvil of the instructed eye, Mr. Sibal would submit that, while the novelty of the design had to be tested on the basis of the instructed eye, the aspect of infringement had to be examined from the point of view of an average purchaser. Mr. Sibal has drawn my attention, in this context, to paras 67 and 68 of the decision in *Diageo v. Great Galleon*<sup>4</sup>, which cites the earlier decision of this Court in *Steelbird*<sup>20</sup> and the High Court of Calcutta in *ITC Limited v. Controller of Patents and Design*<sup>23</sup>:

“ 67. Coming back to the concept of ‘new and original’, which now stands clarified, the Court turns its eye to criteria for determining the same. The test for determining novelty under designs law is no longer *res integra*, and has been observed by this Court in *Steelbird*<sup>20</sup>, as follows:

“It is rightly held in the cases decided that in the matter of novelty the eye is to be the ultimate test and the determination has to be on the normal ocular impression. In order to know its newness or originality it is necessary 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 infinitesimal 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

(Emphasis Supplied).”

68. The Calcutta High Court’s discussion on the same in *ITC*<sup>23</sup> (supra), too, is of assistance in this regard, which is extracted as follows:

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<sup>23</sup> 2017 SCC OnLine Cal 415 : (2017) 71 PTC 178

“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 in fact new. It is a matter of first impression. In *The Wimco Ltd. v. Meena Match Industries*<sup>24</sup>, the Court held 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. The court has to consider and look at the two designs in question with an instructed eye and say whether there is or there is not such a substantial difference between them that which has been published previously and the registered design to say that at the date of registration that was not published in India previously.”

**66.** It is the purchaser’s perception which, therefore, according to Mr. Sibal, is determinative of the aspect of infringement. The purchaser has no knowledge of prior art. As such, prior art can form no part of consideration by the Court while assessing whether the defendant’s design infringed the design of the plaintiffs. Mr. Sibal has, in this context, also relied on para 11 of *B. Chawla*<sup>7</sup> and paras 54 to 56 of *Diageo v. Great Galleon*<sup>4</sup>, which read thus:

*B. Chawla*<sup>7</sup>

“11. The quintessence of the placitums above is that distinction has to be drawn between usual trade variants on one hand and novelty or originality on the other. For drawing such distinction reliance has to be placed on popular impression for which the eye would be the ultimate arbiter. However, the eye should be an instructed eye, capable of seeing through to discern whether it is common trade knowledge or a novelty so striking and substantial as to merit registration. A balance has to be struck so that novelty and originality may receive the statutory recognition and interest of trade and right of those engaged therein to share common knowledge be also protected.”

*Diageo v. Great Galleon*<sup>4</sup>

“54. The standards for comparison and substantive examination

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<sup>24</sup> AIR 1983 Del 537

have not been met for any single prior art shown to the court. Whether the cited drawings/prior art were applied to articles or not, is not known, as no material has been placed on record to prove the same. Although the Court is not looking for the physical article for comparison, as prior art need not necessarily be commercially or physically available, nonetheless, the drawings relied upon by Defendant must at least provide a perspective view for clarity. It is also to be remembered that 2D illustrations do not depict the application of the design with the same visual effect as a 3D model. For judging by the eye, the prior art or publication relied upon must exhibit clarity of application to a specific article which is capable of being judged. Understanding of a 3D design can be perceived only if the prior publication is lucid and is shown from several angles to gauge depth/perception. Reliance on a two-dimensional view can, in fact, be quite misleading, as can be seen from the following depictions:

Image of prior art as provided by the Defendant	Corresponding 3D image of the same prior art
	
	

55. For this reason, some of the prior publications shown by the Defendant cannot be relied upon. Nonetheless, to form a *prima facie* view, each prior art, published prior to 12th December, 2017, (i.e., the date of Plaintiffs' design registration) has been examined. To illustrate, a few of the comparisons made by the Defendant are extracted below:

Date	Alleged Prior Art	Plaintiff's Registered Design
31.12.1986 (at Pg. 22, Defendant Documents)		
01.04.2003 (at Pg. 24, Defendant Documents)		
14.10.2011 (at Pg. 46, Defendant Documents)		
09.07.2014 (at Pg. 44, Defendant Documents)		
09.04.2018 (at Pg. 54, Defendant Documents)		

56. Each one of above has visible dissimilarities when compared to Plaintiffs' Registered Design. The Defendant, in fact, painstakingly took the Court through 14 prior arts, to which the Plaintiffs further filed a detailed reply, negating each comparison on various grounds. The Court has examined each of these individually. It would not be apt to write a separate analysis for each; but it is fitting to say that the Court has observed that indeed, the pictures, as shown, differed from the Plaintiffs' Registered Design in terms of rounded/drooping shoulders; bulbous/curved walls, shorter/longer neck; length; and existence of a false bottom instead of a dimpled bottom. It must also be mentioned that, since the prior arts so filed were 3D articles, but depicted in 2D images, the pictorial illustrations were unclear so as to visualise the 'appeal to eye' factor."

67. Section 22 of the Designs Act, points out Mr. Sibal, identifies, as the test for design infringement, "obvious imitation" and "fraudulent imitation". While the impugned design in *Diageo v. Great Galleon*<sup>4</sup> was an obvious imitation of the suit design, the impugned design in the present case, submits Mr. Sibal may not be an obvious imitation of the suit design but was certainly a fraudulent imitation thereof. Mr. Sibal

seriously contests the submission of Mr. Lall that the impugned design was similar to the design of a hipster flask. In fact, he submits, the distinguishing features of the impugned design, *vis-à-vis* the design of a hipster flask themselves brought the impugned design closer to the suit design. There was, therefore, he submits, clear fraudulent intent on the part of the defendant. To drive home the submission that the test to be applied in the case of design infringement was that of the perception of an “average purchaser”, Mr. Sibal relies on para 24 of the report in *Videocon Industries Ltd. v. Whirlpool of India Ltd.*<sup>25</sup> and para 9 of the report in *Cello Household Products v. Modware India*<sup>26</sup>, rendered by a Division Bench and a learned Single Judge of the High Court of Bombay respectively, which read thus:

*Videocon Industries*<sup>25</sup>

"24. The next task of the Court is to judge the similarity or difference through the eye alone and where the article in respect of which the design is applied is itself the object of purchase, *through the eye of the purchaser*. Thus in the case of *Benchairs Ltd. v. Chair Center Ltd*<sup>27</sup>. where the article to which registered design was applied was a chair. Russel L.J. said:

“As we see it, our task is to look at these two chairs, to observe their similarities and differences, to see them together and separately, and to bear in mind that in the end the question whether or not the design of the defendant's chair is substantially different from that of the plaintiff is to be answered by consideration of the respective design as a whole: *and apparently, though we do not think it affects our present decision, viewed as though through the eyes of a consumer or customer.*”

25. *In judging the articles solely by the eye the Court must see whether the defendant's version is an obvious or a fraudulent*

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<sup>25</sup> 2012 SCC OnLine Bom 1171 : (2012) 6 Bom CR 178

<sup>26</sup> AIR 2017 Bom 162

<sup>27</sup> 1994 RPC 429

*imitation.*”

(Emphasis supplied)

***Cello Household Products***<sup>26</sup>

“9. I have reproduced these images not for a juxtaposed comparison myself, but because when the actual bottles and packaging were placed before me, my question to Counsel on both sides was “Which is whose?” I should imagine that in an action such as this, that is more than enough for the grant of interim relief. After all, this branch of law requires the test to be that of the Court's impression, presumably on the footing that if a judge cannot tell the difference then more should not be demanded of the average consumer, he of average intelligence and imperfect recollection.”

68. Mr. Sibal also relies on paras 37 to 39 of *Diageo v. Great Galleon*<sup>4</sup> which read thus:

“37. It is a trite principle of law that for determining infringement of designs, the yardstick is ‘visual effect’, ‘appeal to the eye’ of the customer’ and ‘ocular impression’ of design, as a whole. The test is not to look out for subtle dissimilarities, but rather, to see if there is substantial and overall similarity in the two designs. The test has been aptly elucidated by this Court in *Symphony Ltd. v. Life Plus Appliances*<sup>28</sup>, as follows:

“Under the law of designs, it is the settled principle that the overall look of the product is to be seen and the same is to be judged with the naked eye. An intricate examination of the design is not to be done.”

38. A Co-ordinate Bench of this Court held in *Carlsberg Breweries*<sup>14</sup>- 2017, that apart from the overall resemblance in design, the Court is required to see, as to whether the essential part or the basis of a plaintiff's claim for novelty forms part of the impugned mark, in the following words:

“153. Thus, to see whether the imitation is obvious, the same should strike at once on a visual comparison of the article containing the registered design and the article containing the design which is said to be infringing the registered design. The impugned design should be very close to the original design - the resemblance of the original design being immediately

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<sup>28</sup> 2019 SCC OnLine Del 7511

apparent to the eye while looking at the two designs. Fraudulent imitation is one which is deliberately based upon the registered design. The imitation may be less apparent than an obvious imitation. There may be subtle distinction between the registered design and the alleged fraudulent imitation, and yet the fraudulent imitation although different in some respects from the original, renders it as a perceptible imitation when the two designs are closely scanned.”

XX ... XX ... XX

“163. In Polar Industries Ltd. (supra) since the design registration claim by the plaintiff pertained to the entire article as a whole, namely, a table fan/portable fan, the Court held that overall view of the registered designs of the plaintiff - comprising of configuration, shape and ornamentation will have to be considered for the purpose of comparison. The component parts of the registered design of the plaintiff could not be viewed in isolation to determine as to what are its striking features.”

39. The Court now proceeds to apply the afore-noted test to determine if there is *prima facie* deceptive similarity in the impugned bottles when compared to the Hipster. While applying this test, the Court is also conscious that not every resemblance between the two designs would amount to infringement. The comparison by the eye has been done by physically holding in hand the Defendant’s impugned bottle alongside the Plaintiffs’. Unequivocally, at first blush, the Defendant’s impugned bottles bear a remarkable similarity to the Hipster. All the unique, essential and novel features of the Hipster: long, lean and sleek design, curved shoulders, ‘v’ element on the neck, etc. are found on the impugned bottle as well. In terms of shape, the bottles have identical necks, shoulders, joints and edges. Both are identically rectangular in shape, and have a dimpled bottom, which, indeed is nearly-identical and has sufficient similarity to make it difficult for the consumer to distinguish one from the other. In fact, even upon undertaking a microscopically detailed examination, or applying the instructed eye test, only three points of difference emerge: firstly, the Defendant’s bottle has a crest-shaped logo of the Defendant’s company embossed on the upper portion at the front, whereas the Hipster is plain. Secondly, the Defendant’s bottle is a few millimetres shorter and very slightly more bulbous than the Hipster. Thirdly, and lastly, the neck of the impugned product is about one millimetre shorter. However, when examined from a distance of three to five yards, which is a reasonable distance between a potential consumer and the shelf of a liquor store where the bottles may be displayed together, the differences vaporise.<sup>25</sup> Besides, the impugned



design need not be an exact replica to constitute infringement. Minor changes in size are insignificant as the overall and substantial similarity is glaring and undeniably apparent to the naked eye. The Court is, thus, satisfied that Defendant's product is deceptively similar to the Plaintiffs' Registered Design."

(Emphasis supplied)

**69.** Adverting to Section 22 of the Designs Act, Mr. Sibal submits that the principle of infringement, in the Designs Act, unlike that in the Trademarks Act, does not involve the aspect of recollection. While, therefore, the test of a person of average intelligence and imperfect recollection, which is the classic test for trademark infringement, may not apply in the case of design infringement (in which respect Mr. Sibal parts ways with the decision of the learned Single Judge of the High Court of Bombay in *Cello Household Products*<sup>26</sup>), the eye, even in the case of design infringement, he submits, has to be that of the average purchaser, and not the instructed eye.

**70.** Emphasizing the word "imitation" in Section 22 of the Designs Act, Mr. Sibal submits that there is a difference between an imitation and an identical product or a replica. Mr. Sibal submits that the difference between the expressions "obvious imitation" and "fraudulent imitation" is that, while both involved a deviation from the registered design, the distinction is one of degree. For this purpose, Mr. Sibal relies on the following passages from the decision of Ruma Pal, J (as she then was) as a learned Single Judge of the High Court of Calcutta in *Castrol*<sup>22</sup>:

"20. But all novel designs are not protected Novel designs which are purely functional cannot found an action for infringement (see: *In re : Lamson Industries Ltd.'s Application*<sup>29</sup>,. The object of the Designs Act is to protect shape but not a functional shape and if shape

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<sup>29</sup> (1978) RPC 1)

and configuration are dictated solely by function it is not registrable as a design. The decision in the case of *Amp. Inc. v. Utilux Pty. Ltd.*<sup>30</sup>, of the house of Lords related to the manufacture of electric terminals.

21. Lord Reid J. said:

“... and the words ‘judged solely by the eye’ must be intended to exclude cases where a customer might choose an article of that shape not because he thought that the shape made it more useful to him.”

22. The next question is whether there is sufficient resemblance between the allegedly infringing copy and the petitioner's registered design to found an action for infringement under section 53 of the Act. It is not every resemblance in respect of the same article which would be actionable at the instance of the registered proprietor of the design. The copy must be a fraudulent or obvious imitation. The word ‘imitation’ does not mean ‘duplication’ in the sense that the copy complained of need not be an exact replica. The word has been judicially considered but not defined with any degree of certainty. In *Best Product Ltd. v. F.W. Woolworth & Company Ltd*<sup>31</sup>. (supra) it was said in deciding the issue of infringement, it was necessary to break the article down into integers for descriptive purposes but in the ultimate result it is the article as a totality that must be compared and contrasted with the features of a shape and configuration shown in the totality observable from the representation of the design as registered. It was said that the Court must address its mind as to whether the design adopted by the defendants was substantially different from the design which was registered.

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24. The next task of the Court is to judge the similarity or difference through the eye alone and where the article in respect of which the design is applied is itself the object of purchase, through the eye of the purchaser. Thus in the case of *Benchairs*<sup>27</sup>, where the article to which registered design “As we see it, our task is to look at these two chairs, to observe their similarities and differences, to see them together and separately, and to bear in mind that in the end the question whether or not the design of the defendant's chair is substantially different from that of the plaintiff is to be answered by consideration of the respective design as a whole: and apparently, though we do not think it affects our present decision, viewed as though through the eyes of a consumer or customer.”

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<sup>30</sup> 1972 RPC 103

<sup>31</sup> (1964) IX RPC 215

25. In judging the articles solely by the eye the Court must see whether the defendant's version is an obvious or a fraudulent imitation.

26. In *Dunlop Rubber Co. Ltd. v. Golf Ball Developments Ltd*<sup>32</sup>, (1931) XLVIII RPC 268 at 279, the meaning of the word 'obvious' and 'fraudulent' have been stated

“... 'obvious' means something which, as soon as you look at it, strikes one at once as being so like the original design, the registered design, as to be almost unmistakable. I think an obvious imitation is something which is very close to the original design, the resemblance to the original design being immediately apparent to the eye looking at the two.”

27. In a later portion of the judgment it was said:

“...fraudulent imitation seems to me to be an imitation which is based upon, and deliberately based upon, the registered design and is an imitation which may be less apparent than an obvious imitation; that is to say, you may have a more subtle distinction between the registered design and a fraudulent imitation and yet the fraudulent imitation, although it is different in some respects from the original, and in respects which render it not obviously an imitation may yet be an imitation, imitation perceptible when the two designs are closely scanned and accordingly an infringement.”

(Emphasis supplied)

71. The only distinction between an obvious imitation and a fraudulent imitation, for the purposes of Section 22 of the Designs Act is, therefore, submits Mr. Sibal, a distinction of degree. In the present case, therefore, he reiterates, even if the design of the defendant's product were not to be treated as an obvious imitation of the plaintiffs' design, it was, nonetheless, a fraudulent imitation thereof. *Castrol*<sup>22</sup>, submits Mr. Sibal, was also followed by the Division Bench of the High Court of Bombay in *Videocon*<sup>25</sup>.

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<sup>32</sup> (1932) XLVIII RPC 268

72. Mr. Sibal next relies on the often quoted opening passage from the judgment of a learned Single Judge of this Court in *Marico Ltd. v. Mukesh Kumar*<sup>33</sup> which reads thus:

“1. The case at hand illustrates what is well known amongst the intellectual property rights fraternity, “*The most successful form of copying is to employ enough points of similarity to confuse the public with enough points of difference to confuse the courts. Few would be stupid enough to make exact copies of another's mark or symbol.*”

73. The present case, according to Mr. Sibal, is a classic example of the aphorism cited in para 1 of *Marico*<sup>33</sup>. The defendant, according to Mr. Sibal, has introduced, in the design of its flask/bottle, subtle points of difference, with a view to distinguish the defendant's bottle from the suit design, even while otherwise resorting to clear imitation. Mr. Sibal cites, in support of his contention, paras 21 and 22 of *Cello Household Products*<sup>26</sup>, which read thus:

“21. The first test to which Mr. Tulzapurkar invites my attention is that set out in SJ Kathawalla J's order in *Whirlpool of India Ltd. v. Videocon Industries Ltd.*<sup>34</sup>. The decision covered a range of issues in the context of rival designs for washing machines. Paragraph 25 of the decision sets out the tests to be applied in deciding what constitute an obvious imitation and is actionable as such:

"26. The question of what tests are to be applied in deciding what constitutes an obvious imitation and/or is actionable is no longer *res integra*. This question has been considered in several judicial pronouncements. The leading decisions on the point are the decisions in the case of *Castrol India Limited v. Tide Water Oil Co.(I) Ltd*<sup>22</sup> and *Kemp & Co. v. Prima Plastics Limited*<sup>35</sup>. In both the decisions, the Kolkata High Court and the Bombay High Court have laid down the following propositions as constituting the test to decide whether there is obvious imitation and/or piracy of a registered design.

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<sup>33</sup> 2018 SCC OnLine Del 10823 : (2018) 253 DLT 8

<sup>34</sup> (60) PTC 155 (Bom) : 2015 (1) Bom CR 137

<sup>35</sup> 1998 SCC OnLine Bom 437

*Castrol India Limited v. Tide Water Oil Co.(I) Limited*<sup>22</sup>:(*supra*)

(i) **The word 'imitation' does not mean 'duplication' in the sense that the copy complained of need not be an exact replica.**

(ii) **The Court is required to see in particular as to whether the essential part or the basis of the Plaintiff's claim for novelty forms part of the infringing copy.**

(iii) **The similarity or difference is to be judged through the eye alone and where the article in respect of which the design is applied is itself the object of purchase, through the eye of the purchaser.**

(iv) **The Court must address its mind as to whether the design adopted by the Defendant was substantially different from the design which was registered. The Court ought to consider the rival designs as a whole to see whether the impugned design is substantially different from the design sought to be enforced. (The test laid down on *Benchchairs Ltd. C. Chair Center Ltd.*. (1974 RPC 429) was cited with approval).**

(v) **'Obvious' means something which, as soon as one looks at it, strikes one as being so like the original design/the registered design, as to be almost unmistakable. Fraudulent imitation is an imitation which is based upon, and deliberately based upon, the registered design and is an imitation which may be less apparent than obvious imitation, that is to say, one may have a more subtle distinction between the registered design and a fraudulent imitation and yet the fraudulent imitation, although it is different in some respects from the original, and in respects which render it not obviously an imitation may yet be an imitation perceptible when the two designs are closely scanned and accordingly amounts to infringement. (The test laid down in *Dunlop Rubber Co. Ltd. v. Golf Ball Developments Ltd.*<sup>32</sup> was cited with approval.**

*Kemp & Co. v. Prima Plastics Limited*<sup>35</sup>: (*supra*)

(i) **If the visual features of shape, configuration pattern designs are similar or strikingly similar to the eye, it is not necessary that the two designs must be exactly identical and same. The matter must be looked at as one of substance and essential features of the designs ought to be considered.**

(ii) In a given case, **where the registered design is made up of a pattern which has no one striking feature in it, but it appeals to the eye as a whole, it may very well be that another design may be an imitation of it which makes the same appeal to the eye notwithstanding that there are many differences in the details.** (The opinion of Farwell J. in *Dunlop Rubber Co. Ltd. v. Golf Ball Developments Ltd.*<sup>32</sup> (was cited with approval).

(iii) In comparing rival designs the Court is required to see whether the impugned design/product is substantially different to the design which is sought to be enforced.

The aforesaid tests have been independently applied and/or followed in a series of judgments of various High Courts, including judgments in *JN Electricals (India) v. M/s. President Electricals*<sup>36</sup> (paras 24-25); *Alert India v. Naveen Plastics*<sup>37</sup> (, para 36); *Hindustan Sanitaryware v. Dip Craft Industries*<sup>38</sup> (para 8), and *Dabur India v. Amit Jain & Anr.*<sup>19</sup> "

22. *The approach is not, as the Court said, in identifying individual similarities or dissimilarities. These are not dispositive. The judicial assessment must be on an examination of the rival products, actually made available if possible. The products and designs must be seen as a whole, from the perspective of the common consumer. The test is of visual appeal, and the task is to see if the essentials of that which makes it visually appealing have been substantially, but not necessarily exactly, copied.*"

(Emphasis supplied)

74. Mr.Sibal would submit that the “three to five yard test” applied by

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<sup>36</sup> ILR 1980 (1) Del 215

<sup>37</sup> 1997 (Vol. 17) PTC 15 (Del)

<sup>38</sup> (2003) 26 PTC 163 (Del)

the Coordinate Bench in *Diageo v. Great Galleon*<sup>4</sup> is apt, as three to five yards is the usual distance between the average purchaser and products such as those involved in the present case, which are usually kept on shelves in the store.

**75.** The case being one of fraudulent imitation, Mr. Sibal would submit that the Court is required to emphasise similarities over dissimilarities between the suit design and the impugned design.

**76.** He has relied, in this context, on paras 77 and 78 of the decision of this Bench in *Pernod Ricard India Pvt. Ltd. v. Frost Falcon Distilleries Ltd.*<sup>39</sup>:

“77. When, with this legal position in mind, one views the defendants ‘CASINOS PRIDE’ label, the manner in which it is employed, and the manner in which the product is sold, it does appear, *prima facie*, that the defendant is seeking to create an association, in the mind of a customer of its product, with the plaintiff. The coincidences are just too many. The defendant has used the mark ‘CASINOS PRIDE’ while, incidentally, the mark of the plaintiff is ‘BLENDERS PRIDE’. Again incidentally, the mark is used in the form of white colours on a blue background, similar to the colour combination in which the plaintiff packages and markets its ‘IMPERIAL BLUE’ whisky. Again, incidentally, the defendant’s product also contains a golden dome shaped design, which is present on the plaintiff’s label. The shape of the defendant’s bottle is identical to that of the plaintiff. Though, viewed individually, these likenesses may not suffice to justify a conclusion even *prima facie* of infringement, by the defendant’s ‘CASINOS PRIDE’ marks, as used by it, infringes the plaintiff’s ‘BLENDERS PRIDE’ or ‘IMPERIAL BLUE’ marks, the defendant has, as Mr. Hemant Singh correctly puts it, ingeniously combined features of the ‘BLENDERS PRIDE’ and ‘IMPERIAL BLUE’ marks of the plaintiff to create an overall label and packaging which, in the mind of a customer of average intelligence and imperfect recollection, who has earlier in point of time purchased the plaintiff’s ‘BLENDERS PRIDE’ and ‘IMPERIAL BLUE’ beverages, and is aware thereof, is perilously likely to invite an

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<sup>39</sup> 2022 SCC OnLine Del 646 : (2022) 90 PTC 1

inference of association between the defendant's product and of the plaintiff. Applying *Munday*<sup>40</sup>, in view of the apparent dishonest intent of the defendant, the similarities between the defendant's and the plaintiff's labels would have to be accorded precedence over the dissimilarities. The intent of the defendant, therefore, to pass off its 'CASINOS PRIDE' whisky as that of the plaintiff appears, *prima facie*, to be apparent.

78. "CASINOS PRIDE" may not, therefore, infringe "BLENDERS PRIDE" within the meaning of Section 29 of the Trade Marks Act, *inter alia* because of the proscription contained in Section 17. The "CASINOS PRIDE" label, even as affixed on the bottle, may not, similarly, infringe the "IMPERIAL BLUE" marks of the plaintiff, again for want of imitation of a sufficient number of prominent essential features. The superimposition of the "CASINOS PRIDE" label on a trade dress which has the possibility of bringing to mind the plaintiff and its products, however, betokens an apparent intent to making the unwary customer believe that "CASINOS PRIDE" is perhaps a cheaper product from the plaintiff's brewery. Once such intent is thus apparent, following the principle enunciated in *Slazenger*<sup>41</sup>, the Court would presume that the intention of creating, in the mind of the customer of average intelligence and imperfect recollection, the impression of an association between the Defendant's product and the plaintiff, or that the "CASINOS PRIDE" whisky is also manufactured by the plaintiff, is successful."

77. The tests enunciated in the afore-extracted passages from *Pernod Ricard*<sup>39</sup>, according to Mr. Sibal, would apply with equal strength in the case of design infringement.

78. Mr. Sibal has next sought to highlight the fact that, till the plaintiffs had introduced the hipsters with the suit design globally in 2018 and in India in May 2019, the defendant was selling its 180 ml whisky in a bottle of an entirely different shape, as reproduced in para 24 *supra*. He submits that, once the plaintiffs' hipster design was successful in the market, the defendant piggybacked on the plaintiff's goodwill and

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<sup>40</sup> (1905) R.P.C. 273

<sup>41</sup> (1889) 6 RPC 531



changed the design of the flask/bottle in which it was selling its product only in respect of the 180 ml capacity. Mr. Sibal points out that the defendant's product, in all other capacities, continues to be sold using bottles of the earlier design and that it was only in respect of the bottle containing 180 ml of whisky that the defendant imitated the plaintiffs' design, seeing its success in the market. While the bottles in which the defendant was packing and selling its whisky were transparent, the new 180 ml impugned packing of the defendant was monochromatic black, again indicating the intent of the defendant to imitate the plaintiffs' suit design. Apropos the "curved" feature of the defendant's bottle, on which Mr. Lall placed emphasis, Mr. Sibal submits that the defendant had deliberately limited the curvature to the rear side of the bottle, so that, as presented to the customer on the shelf, the curvature would not be visible. This, he submits, is a clear example of the *Marico*<sup>33</sup> principle which involves duping, simultaneously, the customer and the Court.

**79.** The *malafide* intent of the defendant to capitalize on the reputation that the plaintiffs suit design garnered over a period of time, submits Mr. Sibal, is also apparent from the defendant electing to call its hipster flask "Pocket Shot" to confuse the customer with "Pocket Scotch" which was the appellation used by the plaintiffs in respect of its products. Mr. Sibal clarifies that the plaintiffs are not alleging infringement, by the defendant, of the mark or word "Hipster".

**80.** Mr. Sibal draws my attention to para 38 of the plaint, which sets out the similarities between the suit design and the design of the defendant's bottles/flasks.

**81.** In the above context, Mr. Sibal places reliance on para 81 of the report of the judgment of a learned Single Judge of this Court in *Havells India Ltd. v. Panasonic Life Solutions India Pvt. Ltd.*<sup>42</sup>, which reads as under:

“81. Learned Senior counsel for Defendant No. 1 had sought to bring out certain dissimilarities by comparing the intersecting golden lines on the marble pattern of the Plaintiff’s fans with the motifs and colours on the impugned products. In my view, the differences/dissimilarities that were attempted to be highlighted, are not sufficient to hold in favour of Defendant No. 1 that there has been no attempt to copy and misrepresent. It has been held in several judgments that if the Courts were to examine the dissimilarities with great minuteness, no Plaintiff would ever succeed in a claim for infringement or passing off as a clever Defendant, with some skill would always be in a position to make some cosmetic or minor changes and get away with deceit and/or infringement.”

He further relied on para 77 of *Diageo v. Great Galleon*<sup>4</sup> which reads thus:

“77. Applying the above test, the Court is unconvinced of the Defendant’s argument that the Plaintiffs have merely ‘cobbled together’ known integers. The element of originality in the aesthetics and style of the Hipster certainly bears out in the Court’s *prima facie* vision, as discussed above. Defendant has also failed to point out which particular known designs have been allegedly combined to get the Plaintiffs Registered Design. The images filed by the Defendant does not provide the perspective/3D view of the claimed/alleged known designs. The Court cannot take the neck of one bottle and the shoulder of another and attempt to stitch together such known features to see whether the Plaintiffs’ Registered Design is disclosed. The burden was on the Defendant to show any one prior art which would be an exact match to qualify for a prior publication. That said, the Plaintiffs are free to pick and choose elements and take inspiration from multiple pre-existing designs, as long as they are able to apply the same to create a new or original design. Certainly not all designs can be made *avant garde*, completely bereft of any inspiration from existing designs. True novelty lies in the originality of application of existing ideas in a hitherto unknown fashion. Any rule stricter than this would amount to stifling human creativity and enterprise, and would be counter-productive to the intent of novelty and innovation in

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<sup>42</sup> (2022) 291 DLT 174

design.”

82. Mr. Sibal submits that the idea of modelling the flask/bottle in which to pack and sell 180 ml Scotch whisky on the shape of a smartphone was entirely conceptualised by the plaintiffs, as was recognized in para 38 *supra* of the decision in *Diageo v. Great Galleon*<sup>4</sup>. In this context, Mr. Sibal also relies on paras 151 and 183 of *Carlsberg Breweries*<sup>14</sup> which read thus:

“151. The next task of the Court is to judge the similarity or difference through the eye alone, and where the article in respect of which the design is applied is itself the object of purchase - through the eye of the purchaser. She referred to the observation of Russel L.J. in *Benchairs*<sup>27</sup> wherein the learned Lords observed:

*“As we see it, our task is to look at these two chairs, to observe their similarities and differences, to see them together and separately, and to bear in mind that in the end the question whether or not the design of the defendant's chair is substantially different from that of the plaintiff is to be answered by consideration of the respective design as a whole : and apparently, though we do not think it affects our present decision, viewed as though through the eyes of a consumer or customer.”*

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183. It also cannot be said that the so-called imitation is based upon the plaintiff's registered design, or that the distinction between the two bottle designs is found to be subtle in nature, upon close examination and comparison of the two bottle designs. The adoption of its bottle design by the defendant also appears to be bona fide and not fraudulent in view of the detailed and protracted correspondence that the defendant has had with several designers, as already taken note of hereinabove while recording the defendant's submissions. From the correspondence place on record, prima-facie, it appears that the idea of revamping the Hunter Beer bottle design and packaging was present to the mind of the defendant as early as in August 2011, if not earlier, as would be apparent from the e-mail communication dated 18.08.2011 from Rohit Bindal of purpolefocus.com. The correspondence placed on record by the defendant with the various designers/consultants shows that the defendant approached several consultants for designing a new bottle and packaging for its Hunter Beer. Pertinently, the plaintiff got its design registered only on 30.03.2012, i.e. sometime after the defendant had already initiated the process of engaging

consultants to design and re-package its beer bottle and packaging for Hunter Beer. The communications that the defendant had with several designers/consultants have been extracted hereinabove, precisely for the reason that a perusal of these communications show that the defendant was actively engaged in the process of re-designing its bottle and packaging for its Hunter Beer. It appears that, eventually, the defendant engaged Lowe Lintas, who made their recommendations. The recommendations made on 30.08.2003 along with the e-mail have been taken note of hereinabove. It appears that the process of consultation continued even thereafter, and the pros and cons of the suggestions/recommendations made by the consultant were discussed between the defendant and the consultant. From the correspondence placed on record, it appears that the new design of the beer bottle and the packaging was firmed up by the defendant in consultation with its designer/consultant sometime in November 2014, whereafter the defendant applied for registration of its design on 28.11.2014. The defendant also proceeded to place the orders for manufacture and supply of 60 Lakhs new bottles on the basis of the bottle design, label and packaging created by the consultant. The consultant has also acknowledged receipt of substantial amount of professional fee from the defendant, as is evident from the certificate/communication of the consultant placed on record. Thus, prima facie, it appears that the defendant's beer bottle design is an independently evolved design and not a fraudulent imitation of the plaintiff's bottle design.”

**83.** Mr. Sibal clarifies that the plaintiffs are not seeking to contend that the impugned design of the defendant is identical to the suit design. In this context, apart from para 38 of the plaint, already reproduced in para 26 *supra*, Mr. Sibal relies on para 40(c)<sup>43</sup> and para 42 of the plaint, of which the latter reads thus:

“42. It is submitted that the Defendant has copied not only the Plaintiffs' registered design but also the distinctive elements of the Plaintiffs' overall trade dress and get up. The products of the Plaintiffs and the Defendant when compared as a whole, it becomes evident that the Defendant's Infringing Product is identical / deceptively similar in shape, configuration to Plaintiffs' registered design and dishonest adoption of overall trade dress and get up of the Plaintiffs' Hipster Products. The 'look' and 'feel' of the Defendant's Infringing Product are the same as those of the Plaintiffs' products. The unlawful acts of the

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<sup>43</sup> see para 59 *supra*

Defendant in blatantly copying the Plaintiffs' design and overall trade dress of Plaintiffs' Hipster Products, including the monochromatic trade dress of the same size, shape and configuration of the bottle / flask, dilutes the distinctiveness of the Plaintiffs' products and the design therein, thereby tarnishing the goodwill and reputation attached with them. Furthermore, it is evident that the Defendant is using a deceptively similar mark 'Pocket Shot' with respect to identical goods that would lead to confusion in the minds of consumers.”

**84.** Insofar as the reliance, by the defendant, on prior art in the form of Design No. D562138 is concerned, Mr. Sibal submits that, as the product had not been presented in a tangible form as required by Section 4 of the Designs Act, the defendant could not rely thereon. If the actual products were seen, Mr.Sibal submits that it would become clear that the impugned design of the defendant was not similar to D562138.

**85.** The shape of novelty of the suit design, he submits, already stands adjudicated in the plaintiffs’ favour by the Coordinate Bench in *Diageo v. Great Galleon*<sup>4</sup>, and no occasion arises for this Bench to revisit the said decision. He submits that, in its monochromatic design, the manner in which the label was affixed on the bottle and the design of the rim of the cap, the impugned design of the defendant was identical to the suit design. In support of these submissions, Mr. Sibal has cited paras 30 to 32 of *Videocon*<sup>25</sup>, paras 11 and 36 of *Cello Household Products*<sup>26</sup>, para 23 of *Gorbatschow Wodka v. John Distilleries Ltd.*<sup>44</sup> and paras 51 and 59 of *Havells India*<sup>42</sup>, which read thus:

*Videocon*<sup>25</sup>

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<sup>44</sup> 2011 SCC OnLine Bom 557 : (2011) 47 PTC 100

“30. Furthermore for maintaining action under passing off it is not necessary that the person must himself actively carry out the misrepresentation. It is enough that an instrument of deceit is created with full knowledge and intention and also no steps are taken to stop the deceit. The action of passing off can be maintained if the offender with full knowledge creates a situation where the consumer can be deceived. Creating opportunities where consumer can be deceived is enough to sustain action under passing off.

31. In the case at hand, the product is a washing machine. A washing machine is quite often sold in large shops or in shopping malls where several models of different brands of washing machines are kept together. If the consumer is attracted by a particular design of a washing machine, then he may choose the washing machine with that design, irrespective of the brand. The distinctive design of the Whirlpool is not meant to add functionality to the product, but to make it look more attractive. It is common knowledge that the washing machine in a store cannot be tested to see as to how it performs. With several brands manufacturing washing machines, the general basic level of functionality is expected from the leading brands. What the design of Whirlpool seeks to do, is to try to make the washing machine otherwise a piece of machinery, to make it look more artistic and appeal to aesthetic sense. The design seeks to appeal to the heart rather than to the head, to use common parlance. Once the consumer likes such a design, then the choice is made on aesthetic values rather than solely on functionality. Mr. Kadam therefore is right in contending that once a consumer is attracted to the design, the consumer can very well opt for a cheaper and smaller version of the design when it is placed in the same showroom. The average consumer of washing machine as depicted by Mr. Tulzapurkar, as being of rational thought, of certain education and affluence, need not necessarily make a logical choice based on functionality and brand when decision is to be made based on aesthetic appeal.

32. Thus Mr. Kadam is right in contending that even though Videocon may not have actively misrepresented to the consumer, it has nevertheless knowingly created a tool for deception and thus is guilty of passing off. According to us, action of passing off is clearly made out. The design registered by Whirlpool has been a success and according to them, about three lakh machines have been sold in a short span. The design registered by Whirlpool is very similar to the impugned product. The washing machine designed and sold by Whirlpool has been in market since September, 2010 and have sold about 3 lakh machines because of its innovative design. No reason is placed on record as to how the Videocon thought of designing the washing machine with same distinctive shape in June, 2012. To our mind it was to take advantage of popularity of the design of Whirlpool

washing machine.”

***Cello Household Products***<sup>26</sup>

“11. Slightly different considerations arise when assessing the claim in passing off. Here, as in any passing off action, a plaintiff must satisfy all three probanda of the so-called Classical Trinity: (i) reputation and goodwill in the goods; (ii) misrepresentation by the Defendants; and (iii) damage. This posits that similarity is demonstrated to begin with; that done, the question then is not so much whether it is confusing, but whether it is calculated to deceive. Passing off is an action in deceit; the deceit lies in the misrepresentation; and the misrepresentation must be as to source, i.e., to deceive the average consumer into believing the defendant's product is the plaintiff's. There need not be fraud, and intention is irrelevant. It is well-settled that actual damage does not have to be proved. The mere likelihood of damage, viz., that damage was reasonably foreseeable, suffices. Reputation and goodwill are also slightly different concepts. This has been the subject of some debate in international cases but this need not detain us today because Cello claims both reputation and goodwill and does not seek to treat the two as synonymous. There is some authority for the proposition that there must be a sale, because without a sale there is no misrepresentation; and, too, for the proposition, that there must be some prima facie evidence of misrepresentation, this not being a presumption. That material can come in different forms, and one of this might be to show the extent of copying and its exactitude, or to show that elements other than those in which protection is claimed have also been copied.

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36. Mr. Tolia is incorrect in saying that an expert view is the only test of novelty and originality. I believe Mr. Tulzapurkar is justified in his reliance on the decision of the Court of Appeals in *Wright, Layman & Umney LD v Wright LXVI RPC 149*. This was in the context of passing off and the question was whether there was anything to clearly distinguish the defendants' product from the plaintiffs. That should be the determinant. In the present case, I am not shown anything to support any such distinction.

***Gorbatschow***<sup>44</sup>

“23. The Supreme Court in its judgment in *Khoday Distilleries Limited vs. Scotch Whisky Association*<sup>45</sup>, emphasized that the class of purchasers who are likely to buy the goods by their education and intelligence and the degree

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<sup>45</sup> (2008) 10 SCC 723

of care which they are likely to exercise in purchasing or using the goods would be required to be considered. In that context, the Supreme Court relied on 'the earlier judgment in *Cadila Health Care Ltd. vs. Cadila Pharmaceuticals Ltd.*<sup>46</sup>'. The Supreme Court inter alia emphasized that when the class of buyers is educated and rich, the test is to be applied is different from one where the product would be purchased by villagers or by the illiterate and poor. The Supreme Court held in that case that had the test been applied, the matter might have been different and in a given case probably the Court would not have interfered. The Court was, however, inclined to interfere because a wrong test had been applied which had led to a wrong result. In the present case, the Court must undoubtedly place in the balance the fact that both the plaintiff and the defendant are selling Vodka which has a distinctive clientele. For the purposes of the application for interlocutory relief one can well proceed on the basis, as was suggested by the defendant, that the purchasers of Vodka are primarily educated and well placed in life. But that by itself is not dispositive of the issue as to whether the conduct of the defendant does or does not amount to passing off. In the present case, there are several circumstances, which must equally be placed in the balance by the Court. Firstly, the plaintiff has prima facie established both a trans border reputation as well as a reputation in the market in India and the fact that the unique shape of the bottle is an important element in tracing the source of origin of the product to the plaintiff; Secondly, under the Trade Marks Act, 1999, the shape of goods and their packaging is statutorily recognized as a constituent element of a trade mark as distinguishing the goods or services of a person with those of others; Thirdly, the submission of the plaintiff that no other manufacturer either globally or in India has adopted the shape of the bottle of the plaintiff (save and except for the defendant) has not been disputed in the course of submissions by counsel for the defendant; Fourthly the shape which has been adopted by the plaintiff is unique to the point of being capricious. The defendant has absolutely no plausible or bona fide explanation for adopting a shape which is strikingly similar; Even though the ad interim order of the Court permitted the defendant to sell Vodka, though in a 'distinct shaped bottle' the defendant has chosen not to do so. The defendant has no explanation of how this particular design was adopted; and Fifthly, the attempt of the defendant if it is allowed would result in diluting the distinctiveness and exclusivity of the mark of the plaintiff which has as an essential ingredient, the distinctive shape of the bottle in which Vodka is sold. This would only embolden other infringers to invade upon the proprietary right of the plaintiff and would ultimately result in a destruction of the goodwill associated with the mark of the plaintiff."

**86.** Thus, submits Mr. Sibal, apart from the fact that the present case is fully covered by the decision in *Diageo v. Great Galleon*<sup>4</sup>, the plaintiffs

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<sup>46</sup> (2001) 5 SCC 73



are entitled, on the basis the material on record and the law that applies, to *ad-interim* interlocutory injunction as was granted in that case.

Mr. Lall's submissions by way of rejoinder

**87.** Mr. Lall, in rejoinder, commences by seriously contesting Mr. Sibal's submission that different tests apply while examining the aspect of validity of the suit design on the ground of novelty and the aspect of infringement. He submits that the contention is, *ex facie*, illogical, apart from being incorrect in law. He drew my attention, initially, to the following passage from the decision of the Division Bench of this Court in *Kamdhenu Limited v. Aashiana Rolling Mills Ltd*<sup>47</sup>

“33. The question of 'eye appeal' has been considered in a multitude of judgments. In *Gaskell & Chambers Ltd. v. Measure Master*<sup>15</sup> learned Judge observed that "the decision whether the registered design and the designs of the alleged infringements are substantially different is for the court and cannot be delegated to the opinions of the witnesses. It must be decided on a comparison of the features which appeal to, and are judged by, the eye. To do this, the Court must adopt the mantle of a customer who is interested in the design of the articles in question as it is the eye of such an interested person, the interested addressee, which is relevant.”

**88.** Mr. Lall points out that the plaintiffs obtained registration, in respect of the suit design, only because of its novel features, which purportedly distinguishes the suit design from prior art. The basis of the registration of the plaintiffs being the said novelty, Mr. Lall submits that the monopoly conferred on the plaintiffs as a result of such registration has also, therefore, to be coextensive with the said novelty and originality. The sweep of inquiry while examining the aspect of

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<sup>47</sup> 2022 SCC OnLine Del 2364

infringement, cannot, submits Mr. Lall, be greater than the monopoly granted by the design registration. Having obtained registration in respect of the design by citing points of novelty, the plaintiffs wanted the infringement analysis, qua the design of the defendant's bottle, to be on the basis of the entire article, beyond the points of novelty and originality resident therein. Such an approach, submits Mr. Lall, defies logic.

**89.** The issue of the perspective from which the aspect of infringement is to be examined, he submits, stands covered in the opening sentence of para 10 of the report in *B. Chawla*<sup>7</sup>, which for the sake of ready reference may once again be reproduced thus:

“10. In *Phillips v. Harbro*<sup>8</sup>, Lord Moulton observed that while question of the meaning of a design and of the fact of its infringement are matters to be Judged by the eye, (sic) *it is necessary with regard to the question of infringement*, and still more with regard to the question of novelty or originality, *that the eye should be that of an instructed person, i.e., that he should know what was common trade knowledge and usage in the class of articles to which the design applies....*”

(Emphasis supplied)

**90.** The interested eye, submits Mr. Lall, possesses trade knowledge as well as awareness of prior art. It recognizes the inventive step, which confers on the design novelty and originality. Incorporation, in the design, of usual trade variants would not confer, on the design, novelty and originality *vis-à-vis* prior art. For this purpose, Mr. Lall draws attention once again to para 11 of the report in B. Chawla, which reads thus:

“11. The quintessence of the placitums above is that distinction has to be drawn between usual trade variants on one hand and novelty or originality on the other. For drawing such distinction reliance has to be placed on popular impression for which the eye would be the

ultimate arbiter. However, *the eye should be an instructed eye, capable of seeing through to discern whether it is common trade knowledge or a novelty so striking and substantial as to merit registration.* A balance has to be struck so that novelty and originality may receive the statutory recognition and interest of trade and right of those engaged therein to share common knowledge be also protected.”  
(Emphasis supplied)

**91.** Contradistinguishing Section 22 of the Designs Act with Section 29 of the Trade Marks Act, Mr. Lall points that, whereas Section 29 of the Trade Marks Act is predicated on considerations of confusion and deception, Section 22 operates on the principle of obvious imitation and fraudulent imitation. The very concept of obviousness, he submits, presupposes that the eye is instructed. Where the eye is less instructed, the possibility of confusion is greater. The difference between “obvious” and “fraudulent” imitation, he submits, is that fraudulent imitation would involve an element of *mens rea*. Once again drawing attention to para 10 of *B. Chawla*<sup>7</sup>, Mr. Lall also emphasizes para 9 of the same decision, which reads thus:

“9. Similar view was expressed by Buckley L.J. on the question of quantum of novelty in *Simmons v. Mathieson and Cold*<sup>48</sup>, at 494 in these words:

"In order to render valid, the registration of a Design under the Patents and Designs Act, 1907, there must be novelty and originality, it must be a new or original design. To my mind, that means that there must be a mental conception expressed in a physical form which has not existed before, but has originated in the constructive brain of its proprietor and that must not be in a trivial or infinitesimal degree, but in some substantial degree".”

**92.** Mr. Lall also places reliance, in the above context, on the following passage from *Simmons v. Mathieson & Co. Ltd.*<sup>48</sup>:

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<sup>48</sup> (1911) 28 RPC 486

“This case has been very clearly and very ably argued by Mr. Simmons and I have listened with all attention to everything he had to say. He said:—“I have registered a Design under the Act which is shown in the representation annexed to the registration and that, it is quite true, is the real test. He has not registered a Design merely for the curve of the panels or for the shape of the panels on the side view; he has registered, in the words of the registration, a Design for the shape and pattern of the body of a children's carriage as shown in the representation; that is, the thing as a whole, not merely, as I said just now, applied to the panels or the curves at the bottom of the panels. Looking, as I have in the course of the argument, at the numerous illustrations before us, more particularly I think at the one of a landau, I have come clearly in my own mind to the opinion that this Design is not new and original in the sense which the Act of Parliament intended when it authorised the registration of a new and original Design. *But assuming in favour of the Plaintiff that it was, it was clearly a registration for the shape and pattern of the body as shown in the representation. If the registration was valid at all, it must be taken in an extremely narrow and definite way, and it would not be an infringement unless the totality of the Design, as registered, has been infringed; it is no infringement of a registered Design to take a part out of that registered Design and with an addition to make the total not identical with the registered Design.* I have before me the registered Design, and I have also before me the Design of the Defendants. Looking merely at the picture, not taking any side or other view or anything of that kind, but looking simply at the Design as represented in the picture, I see that there is a side and also “C” springs which are not claimed by Mr. Simmons in any shape or way; I see a representation of panels with a curve below, and I also see that on the right hand, the narrow end of the perambulator, there is a flat end piece, quite plainly shown on the Drawing, which is just as much part of the shape and pattern of the body as are the side panels with the curve below. *I look at the Defendants' Design and I see that although there is, I agree, a general similarity but not identity of the panels and of the curve below, there is an absolute and entire difference in the Design of the end piece which is curved and not straight. That distinction alone, it seems to me in a case like this, where one must look so narrowly at the registration, is amply sufficient to prevent the Plaintiff from succeeding and saying—“My claim is good and the Defendants' is an infringement of my 'registered Design,' ”*”

(Emphasis supplied)

**93.** That the aspect of infringement has to be assessed by applying the test of the instructed eye, submits Mr. Lall, is also apparent from Section

22 of the Designs Act, which permits all grounds on which cancellation of a registered design may be sought under Section 19 to be pleaded as defences to an infringement action. The grounds on which cancellation of a registered design can be sought under Section 19, points out Mr. Lall, presuppose knowledge, by the challenger, of prior art.

**94.** As such, this, too, he submits, indicates that Section 22 has to be viewed from the perspective of an instructed eye, and not from that of an average consumer who is unaware of earlier designs or the state of prior art.

**95.** In this context, Mr. Lall also relies on Section 4(c)<sup>49</sup> of the Designs Act, which proscribes registration of any design which “is not significantly distinguishable from known designs or combinations of known designs”. What is registered by a design registration, therefore, is a new and original design. The fact that an identical design has been registered prior in point of time is, therefore, an absolute ground on which cancellation of a registered design can be sought. Mr. Lall refers to, in this context, para 3 of the judgment of the Division Bench of this Court in *Reckitt Benckiser (India) Ltd v. Wyeth Limited*<sup>50</sup> which identified the issues arising for determination, in that case, thus:

“3. The learned Single Judge framed the following questions for determination:

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<sup>49</sup> 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.

<sup>50</sup> 2010 SCC OnLine Del 3582 : (2010) 44 PTC 589

- “1. Whether the design registration in UK, USA or Australia could amount to prior publication or disclosure to public as contemplated in Section 4(b) of the said Act?
2. Whether there is material on record to indicate, *prima facie*, that the plaintiff's design had been published in India or in any other country prior to the date of registration, *i.e.*, 5.12.2003?
3. Can it be said, *prima facie*, as to whether the design of the defendant's spatula is a fraudulent or obvious imitation of the plaintiff's registered design as applied on its spatula?”

**96.** Having thus drawn my attention to para 3, Mr. Lall proceeds to rely on paras 28 and 29 of the report, which read as under:

“28. A reading of the decision of the Division Bench of this Court in the case of *Amit Jain*<sup>19</sup> (supra) shows that there is no discussion in the same with respect to inter play and inter-relation between Sections 4(b), Sub-sections (1)(a) and (1)(b) of Section 19 and Sub-sections (1) and (2) of Section 44 nor is this inter play of the said sections found in the judgment of learned Single Judge of the Calcutta High Court in the case of *Gopal Glass Works Ltd. v. Assistant Controller of Patents & Designs*<sup>51</sup> (supra), the ratio of which has been accepted by the Division Bench in the case of *Amit Jain*<sup>19</sup>. (supra).

29. The only discussion found in this aspect in *Amit Jain*<sup>19</sup> (supra) is in paras 24 to 26 which read as under:

24. Counsel for the Respondent-Defendant submitted that the very design in respect of which the registration has been granted in favour of the Plaintiff is already in the public domain and has been published earlier. The Respondents have relied upon the Design Registration Nos. 319582 and 263373 issued by the US Patent Office to contend that there is no novelty as far as the Plaintiff's designs are concerned. In the first place it must be noticed that the reliance upon a design registered in the US cannot satisfy the requirements of Section 19 of the present Act which specifies the ground on which cancellation can be granted. Section 19 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

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<sup>51</sup> 2005 SCC OnLine Cal 430 : (2006) 33 PTC 434 (Cal)

the following grounds, namely—

- (a) that it has been previously registered in India;
- (b) that it has been published in India or in any other country prior to the date of registration.’

25. We find that the Calcutta High Court has in *Gopal Glass Works Ltd.*<sup>51</sup>, explained the position, with which we concur, as under—

‘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.’

26. The mere fact that there may have been a registration in the U.S. in respect of similar bottles and caps cannot come in the way of the Plaintiffs seeking an order restraining the Respondent from infringing its registered design.”

Mr. Lall submits that, therefore, there is a distinction between the tangible form of the designs and their physical forms. What is to be compared is the registration of the plaintiffs *vis-à-vis* the product of the defendant, a tangible form of which must be available for comparison. In this context, Mr. Lall also relies on the following passage from *Rosedale*

***Associated Manufacturers Ld. v. Airfix Products Ld***<sup>52</sup>:

“I am, however, persuaded that this conclusion is unsound, bearing in mind that the design is to be judged by the eye and the language of Lord Moulton in *Phillips v. Harbro*<sup>8</sup> (1920) 37 R.P.C. 233, at p. 239. The test to be applied was there stated as follows: “But, while questions of the meaning of a design and of the fact of its infringement are matters to be judged of by the eye, it is necessary with regard to the question of infringement, and still more with regard to the question of novelty or originality, that the eye should be that of an instructed person, i.e., that he should know what was common trade knowledge and usage in the class of articles to which the design applies. The introduction of ordinary trade variants into an old design cannot make it new or original.” ”

97. Mr. Lall, thereafter, adverted to para 39<sup>53</sup> of the decision in *Diageo v. Great Galleon*<sup>4</sup>. Mr. Lall submits that, in para 39 of the decision in *Diageo v. Great Galleon*<sup>4</sup>, the coordinate Bench has held that though the defendants, in that case, could not be said to be passing off their products as those of the plaintiff, a case of infringement was, nonetheless, made out because of similarity in the shape between the plaintiff’s and the defendants’ bottles. This approach, submits Mr. Lall, is fundamentally erroneous, as what is to be compared is the plaintiffs’ design *vis-à-vis* the defendant’s bottle, and not the plaintiffs’ bottle *vis-à-vis* the defendant’s bottle. That apart, Mr. Lall submits that, as the case is one of design infringement, the labels of the bottles have no relevance. In this context, Mr. Lall also relies on para 38 of the report in *Castrol India*<sup>22</sup>, which reads thus:

“38. The test of deceptive similarity would be appropriate where the petitioner pleads passing off. But in cases of infringement of design the question is not whether the similarity has or is likely to cause confusion or deception of a purchaser but whether the similarity is an imitation of the registered design sufficient to destroy the exclusive right of user of the proprietor despite the fact that no confusion is or

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<sup>52</sup> 1957 RPC 239 (CA)

<sup>53</sup> Refer Para 68 *supra*



may be caused as to the source of the goods. Otherwise every registered design could be imitated with impunity merely by changing the colour of the two products thus obviating any confusion. In my view the respondents have so imitated the petitioner's design as to deprive the petitioner of the protection under the Statute.”

**98.** Copying, submits Mr. Lall, is not proscribed by the law. Legitimate copying does not lead to any breach of intellectual property rights. Mr. Lall has, in this context, referred to McCarthy on Trademarks and Unfair Competition, (Fourth Edition), specifically the following passages therein:

“Copying of non-IP Protected Concepts is Fair Competition. In the absence of legally defined exclusive rights, imitation and copying is permitted, and in fact, encouraged, as an essential element of free competition:

Imitation is the life blood of competition. It is the unimpeded availability of substantially equivalent units that permits the normal operation of supply and demand to yield the fair price society must pay for a given commodity.

The public interest in competition outweighs any interest in granting a reward for ingenuity in making a product attractive, unless a competitor who copies these attractive features transgresses the law—for example, by confusing customers as to the source of goods. In affirming the principle of free copying, the Fifth Circuit stated:

Outright copying is often a civilizing rather than a cannibalizing folkway. The world would be a duller place without the originators, but it would not work without the copyists.

*Legitimate Copying is an Essential Part of a Competitive Economy.* Much of the discussion in legal briefs, articles and judicial opinions is phrased in terms of whether or not an accused imitator has transgressed upon a valid exclusive right of intellectual property. "Copying" is sometimes denigrated as being somehow inherently immoral, unfair and illegal. The popular folklore is that a "copycat" is a pirate and that all commercial copying and imitation must be an illegal form of competition. That is not so. In fact, legitimate copying is a large part of what makes a free market economy work.

The Supreme Court has emphasized that free and legal copying

is an essential element of free competition: In many instances there is no prohibition against copying goods and products. In general, unless an intellectual property right such as a patent or copyright protects an item, it will be subject to copying .... Copying is not always discouraged or disfavoured by the laws which preserve our competitive economy ... Allowing competitors to copy will have salutary effects in many instances.

The successful competitor offers an identical or equivalent product at a lower price or with greater quality. It is important to emphasize that there is absolutely nothing legally or morally reprehensible about exact copying of things in the public domain.

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*Trade Dress Rights in Product Shape.* The principle of free copying is especially significant when a competitor claims exclusive rights in a product shape by invoking the rules of trade dress law. In such a case, the hovering presence of the patent laws counsels a strict adherence to the requirements of trade dress validity and infringement, lest a “back door” patent be granted under the guise of trade dress law:

Copying is not only good, it is a federal right—a necessary complement to the patent system’s grant of limited monopolies .... Effective competition and the penumbra of the patent laws require that competitors be able to slavishly copy the design of a successful product.

Business people will sometimes think that it is “unfair competition” for a competitor to copy a product design, even if it is not protected by some form of intellectual property. They erroneously equate competition by copying with “unfair” conduct. As Judge Easterbrook observed: Businesses often think competition unfair, but federal law encourages wholesale copying, the better to drive down prices. Consumers rather than producers are the objects of the law’s solicitude.”

**99.** On the aspect of passing off, Mr. Lall has invited my attention to paras 95, 96 and 98 of the decision in *Diageo v. Great Galleon*<sup>4</sup>, which read thus:

“95. In light of the foregoing discussion, the Court now proceeds to make a comparison of the trade-dress of the products in question. Immediately, it is noticed that the Hipster is marketed in three colour variants: white, golden and black. The Defendant’s bottles are in the

colour variants red and black. Whilst all the bottles are in a dual-chromatic scheme, there is indeed some grain of truth in the Defendant's submission that the black-and-gold combination is common to trade, and has been used by a plethora of alcohol manufacturers. Mr. Lall had produced various such trade dresses, which are extracted below:



96. Similarly, a two-toned rimmed and rounded cap, too, has been widely used in the said industry and is not unique to the Plaintiffs. Hence, upon a comparison of the trade dress as a whole, the Court cannot *prima facie* agree that the essential features are distinctive enough to become a source identifier. Apart from the black & gold colour scheme, there is hardly any similarity in the labels, trade dress, and get-up. Thus, the Court is not entirely convinced that the same is being imitated by the Defendant to deceive unwary customers. The Court is further *prima facie* unconvinced that the purported imitation of the Hipster's trade dress by the Defendant has resulted in some tangible confusion with regard to the origin or source of the goods, considering that the 'GOA' brand is boldly displayed on the bottle, the labels are largely dissimilar, and the price points of the goods are vastly different.

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98. Before moving on, clarification on one aspect is necessary, lest it might lead to confusion. While examining the issue of passing off, the Court has not borne in mind the design similarities, for which the Defendant is found to be at fault as discussed above. This claim of the Plaintiff is analysed squarely on the aspect of passing off of the trade dress, overall get-up, and presentation of the product through packaging. Even on the above noted aspect, there are undeniably some

similarities which are quite visible, but they are largely occurring because of identical designs (for which the plaintiff is entitled to injunction on account of design infringement) and the monochromatic colour of the bottles. However, at this interim stage, such similarities are not sufficient to grant injunction on a passing off action, particularly when the trinity test, recounted above is not met.”

**100.** The defendant cannot, therefore, submits Mr. Lall, be alleged of having committed of any fraud, as several distinguishing elements existed to differentiate the design of the defendant’s bottle vis-à-vis the suit design.

**101.** Adverting, next, to the judgment of a coordinate Bench of this Court in *Carlsberg Breweries*<sup>14</sup>, Mr. Lall, even while acknowledging the fact that in para 151 of the report in the said case, this Court had referred to the decision of the House of Lord in *Benchairs*<sup>27</sup>, which referred to the eyes of the consumer or customer, points out that the same judgement, in paras 161 and 162, follows the judgements in *Phillip v. Harbro*<sup>8</sup> and *Gaskell & Chambers*<sup>15</sup>, both of which affirm the “instructed eye” principle. Paras 176 and 177 of the same decision, points out Mr. Lall, again reiterate the “instructed eye” principle. The said paragraphs read as under:

“176. The next question that arises for consideration is that even if the plaintiff’s design registration is presumed to be valid, i.e. that the indentations/grooves found on the plaintiff’s beer bottle are presumed to be not only novel, but also appealing to the eye and at the same time, as not being functional, whether the defendant’s bottle design prima-facie infringes the plaintiff’s registered design.

177. Once again, I, prima-facie, find that the plaintiff has not been able to make out a case of design infringement. When one compares the beer bottle of the plaintiff as a whole with the beer bottle of the defendant - as a whole, they both appear to be like any other ordinary beer and other beverage bottles available in the market. The defendant

has placed on record photographs of several other beer and other beverages brands having similar shapes of bottles, such as Bud Weiser, Staropramel, Podkovan, Ursus, Glenfiddseh, Goldur, Praha, etc. It needs consideration whether the indentations/grooves in the plaintiff's bottle design, and those found in the defendant's bottle, when compared, lead to the prima-facie conclusion that the defendant's indentations/grooves are a fraudulent and obvious imitation of the plaintiff's bottle design. The two bottles when viewed from different angles, by placing them side by side appear as follows:”

**102.** On the aspect of balance of convenience, Mr. Lall again emphasizes the fact that, even in *Diageo v. Great Galleon*<sup>4</sup>, it was positively found that the defendant in that case could not be said to have passed off its products as that of the plaintiff, as there was no likelihood of confusion between them. In the present case, he submits, likelihood of confusion, if at all, would be even less, in view of the obvious differences between the defendant's bottle and the plaintiffs' registered design. In such a situation, he submits that, even on the principle of balance of convenience, no interlocutory injunction against the defendant would be justified.

**103.** Mr. Lall, in conclusion, submits, relying on the judgment of a coordinate Bench of this Court in *R.B. Health (US) LLC v. Dabur India Ltd*<sup>54</sup>, that the defendant was only required to show the existence of a credible challenge to the suit design. That, he submits, the defendant has certainly shown in the present case.

Mr. Sibal's submissions by way of sur-rejoinder

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<sup>54</sup> (2020) 84 PTC 492 (Del)

**104.** First addressing para 10 of the report in *B. Chawla*<sup>7</sup>, Mr. Sibal submits that the opening paragraph of *B. Chawla*<sup>7</sup> made it clear that the dispute in that case did not involve any issue of infringement. Para 10 of *B. Chawla*<sup>7</sup>, he submits, had to be understood in the light of the question involved in that case. Holistically read, the decision in *B. Chawla*<sup>7</sup>, as also the decision in *Kamdhenu*<sup>47</sup>, submits Mr. Sibal, dealt with the aspect of novelty and not with that of infringement. Mr. Sibal submits that Mr. Lall has, without justification, sought to liken the concepts of patent infringement and design infringement. Unlike patent infringement, he submits that, in the case of design infringement, there is no “person skilled in the art” or “person ordinarily skilled in the art”. The consumer or customer, from whose perspective the aspect of infringement has to be examined, points out Mr. Sibal, is not skilled in the art. He is a mere average customer, who sees the two products on a shelf, and the test is whether, on the aspect of design, the customer is able to differentiate between the two or whether the design of the defendant would, viewed thus, be liable to be regarded as an imitation of the design of the plaintiffs.

**105.** Like Mr. Lall, Mr. Sibal also relies on Section 22(3) of the Designs Act. Where Mr. Lall sought to rely on the said provision in conjunction with Section 20, to submit that the grounds of defense available to an action for piracy were grounds which presupposed the defendant to be a person who was instructed and aware of prior art, Mr. Sibal relies on Section 22(3) to contend that awareness of prior art was only envisaged in Section 22(3) as a defence to an action for piracy and was not a definitive test for piracy itself, under Section 22(1). Mr. Sibal

emphasizes the use of expression “for the purpose of sale”, as contained in sub-sections (1) and (2) of Section 22 as indicative of the fact that sale, or availability for sale, of the defendant’s goods, was a precondition for piracy to exist. As the aspect of piracy had to be examined in connection with sale of the allegedly offending goods, Mr. Sibal submits that, by necessity, the test had to be one of the average purchaser. The test of the instructed eye, Mr. Sibal submits, applies only to the defence to a charge of piracy under Section 22(3) read with Section 19(1)(c) of the Designs Act.

**106.** The aspect of *mens rea*, submits Mr. Sibal, is inbuilt into the concept of “imitation”. Design piracy, points out Mr. Sibal, would exist only where there was either obvious or fraudulent imitation. Innocent imitation, submits Mr. Sibal, is an oxymoron. Imitation, by its very nature, presupposes an intent to imitate. As such, the aspect of *mens rea* is already inbuilt in Section 22(1) of the Designs Act.

**107.** Apropos, the difference between an “obvious imitation” and a “fraudulent imitation”, Mr. Sibal once again relies upon paras 26 and 27 of *Castrol*<sup>22</sup>, which read thus:

“26. In *Dunlop Rubber Co. Ltd. v. Golf Ball Developments Ltd*<sup>32</sup>, (1931) XLVIII RPC 268 at 279, the meaning of the word ‘obvious’ and ‘fraudulent’ have been stated “... ‘obvious’ means something which, as soon as you look at it, strikes one at once as being so like the original design, the registered design, as to be almost unmistakable. I think an obvious imitation is something which is very close to the original design, the resemblance to the original design being immediately apparent to the eye looking at the two.”

27. In a later portion of the judgment it was said: “...fraudulent imitation seems to me to be an imitation which is based upon, and deliberately based upon, the registered design and is an imitation

which may be less apparent than an obvious imitation; that is to say, you may have a more subtle distinction between the registered design and a fraudulent imitation and yet the fraudulent imitation, although it is different in some respects from the original, and in respects which render it not obviously an imitation may yet be an imitation, imitation perceptible when the two designs are closely scanned and accordingly an infringement.”

**108.** The Court was, therefore, submits Mr. Sibal, required to concentrate on similarities, rather than dissimilarities, between the design of the plaintiffs and the product of the defendant.

**109.** Mr. Sibal also relies on the following passage from the decision of the Full Bench of this Court in *Carlsberg Breweries v. Som Distilleries and Breweries Limited*<sup>55</sup>:

“It bears note that the words “fraudulent or obvious imitation” which are found in Section 22 of the Designs Act, have their flavor similar to the words identity/identical or deceptively similar as are found in Section 29 of the Trade Marks Act.”

**110.** Apropos McCarthy, Mr. Sibal submits that he has no cavil with the proposition that legitimate copying is permissible. However, he submits that copying, in a manner which would infringe intellectual property, cannot be allowed.

**111.** The fact that the suit design was inspired by the design of a smartphone, submits Mr. Sibal, also stands recognized by the decision in *Diageo v. Great Galleon*<sup>4</sup>. He also relies, in the said context, on material available on the internet web page at <https://www.lovecreative.com/work/pocket-scotch>, wherein the plaintiff

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<sup>55</sup> 2018 SCC OnLine Del 12912



held out thus:

“When Diageo enlisted us to explore smaller formats for Scotch, we saw that smartphone culture could be the future of an embattled category.”

**112.** A similar declaration, points out Mr. Sibal, is to be found in the very next page of the same website, in which the plaintiff declares:

“We created Pocket Scotch. A portable whisky format inspired by the shape and proportions of a smartphone, ready for any occasion.”

**113.** Responding to Mr. Lall’s submission that, in para 160, the judgment of the coordinate Bench of this Court in *Carlsberg*<sup>14</sup> approved the “instructed eye” test, Mr. Sibal submits that para 160 cannot be read in isolation and has to be seen in conjunction with paras 177 to 182 of the same decision, which cites *Castrol*<sup>22</sup> with approval. Further, in the infringement analysis in the said decision, contained in paras 171 to 182 thereof, Mr. Sibal points out that the only decision cited was *Castrol*<sup>22</sup>.

**114.** Mr. Sibal next addresses Mr. Lall’s contention that infringement analysis has to be on design-to-design, and not design-to-product basis. He submits that this issue stands answered by a juxtaposed reading of the definition of “design” in Section 2(d) with the definition of “article” in Section 2(a) of the Designs Act.

**115.** In conclusion, Mr. Sibal cites paras 17 and 25 of *Castrol*<sup>22</sup>, and para 24 of *Videocon*<sup>25</sup> and paras 9, 18, 20 and 22 of *Cello Household Products*<sup>26</sup>, which read thus:

*Castrol*<sup>22</sup>

“17. The difference in the petitioner's containers and the containers of the

other concerns including the petitioner is primarily in the proportions of the rectangle and secondarily in the colours used. But broadly speaking there can be no doubt that the design of the respondent's container bears a 'family resemblance' to the petitioner's design (see: *Best Products*<sup>31</sup>). There can also be no doubt that the design used by the respondent in respect of the very class of goods in respect of which the petitioner's design is registered.

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25. In judging the articles solely by the eye the Court must see whether the defendant's version is an obvious or a fraudulent imitation.”

*Videocon*<sup>25</sup>

“24. The next task of the Court is to judge the similarity or difference through the eye alone and where the article in respect of which the design is applied is itself the object of purchase, through the eye of the purchaser. Thus in the case of *Best Products*<sup>31</sup> where the article to which registered design was applied was a chair. Russel L.J. said:

As we see it, our task is to look at these two chairs, to observe their similarities and differences, to see them together and separately, and to bear in mind that in the end the question whether or not the design of the defendant's chair is substantially different from that of the plaintiff is to be answered by consideration of the respective design as a whole: and apparently, though we do not think it affects our present decision, viewed as though through the eyes of a consumer or customer.”

*Cello Household Products*<sup>26</sup>

“9. I have reproduced these images not for a juxtaposed comparison myself, but because when the actual bottles and packaging were placed before me, my question to Counsel on both sides was "Which is whose?" I should imagine that in an action such as this, that is more than enough for the grant of interim relief. After all, this branch of law requires the test to be that of the Court's impression, presumably on the footing that if a judge cannot tell the difference then more should not be demanded of the average consumer, he of average intelligence and imperfect recollection.

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18. The difficulty in accepting any of this is graphically demonstrated at page 132 of the Notice of Motion paper book where Modware's KUDOZ bottle is set next to its own Kool Kruiser bottle. The two are entirely different products. The Kool Kruiser is nothing at all like Cello's PURO; but Modware's KUDOZ bottle is almost exactly Cello's PURO bottle. That is the totality of the case before me.

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20. I find no explanation for Modware taking not only this registered design but its identical - or, at any rate, an extremely and certainly deceptively similar – packaging and the same two-tone colour combinations. These are all issues that will have to be considered in the context of the settled law on the subject. There is no manner of doubt in my mind that on all three aspects, i.e., shape, configuration and ornamentation, the Modware KUDOZ product is wholly indistinguishable from Cello's PURO bottle.

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22. The approach is not, as the Court said, in identifying individual similarities or dissimilarities. These are not dispositive. The judicial assessment must be on an examination of the rival products, actually made available if possible. The products and designs must be seen as a whole, from the perspective of the common consumer. The test is of visual appeal, and the task is to see if the essentials of that which makes it visually appealing have been substantially, but not necessarily exactly, copied.”

## Analysis

116. One may commence the analysis of the issues that arise, and the merits of the rival contentions advanced, by examining, in the first instance, the effect of the decision of the coordinate bench in *Diageo v. Great Galleon*<sup>4</sup>.

117. *Diageo v. Great Galleon*<sup>4</sup> is an interlocutory order disposing of an application under Order XXXIX Rules 1 and 2 of the CPC – as is this. Para 99 of the decision, as reported in SCC OnLine, reads thus:

“Needless to say, the observations made hereinabove are on a *prima facie* basis, for the purpose of deciding the interim applications.”

118. The value of such an order as a precedent, even in later cases based

on similar facts, stands delineated in para 59 of the majority decision in *Empire Industries Ltd v. U.O.I.*<sup>56</sup> (though Varadarajan, J. entered a dissent):

“59. Good deal of arguments were canvassed before us for variation or vacation of the interim orders passed in these cases. Different courts sometimes pass different interim orders as the courts think fit. *It is a matter of common knowledge that the interim orders passed by particular courts on certain considerations are not precedents for other cases which may be on similar facts.* An argument is being built up nowadays that once an interim order has been passed by this Court on certain factors specially in fiscal matters, in subsequent matters on more or less similar facts, there should not be a different order passed nor should there be any variation with that kind of interim order passed. It is submitted at the Bar that such variance creates discrimination. This is an unfortunate approach. Every Bench hearing a matter on the facts and circumstances of each case should have the right to grant interim orders on such terms as it considers fit and proper and if it had granted interim order at one stage, it should have the right to vary or alter such interim orders. We venture to suggest, however, that a consensus should be developed in the matter of interim orders.”

(Emphasis supplied)

119. In a short order in *Vishnu Traders v. State of Haryana*<sup>57</sup>, however, the Supreme Court entered this note of caution:

“3. In the matters of interlocutory orders, principle of binding precedents cannot be said to apply. However, the need for consistency of approach and uniformity in the exercise of judicial discretion respecting similar causes and the desirability to eliminate occasions for grievances of discriminatory treatment requires that all similar matters should receive similar treatment except where factual differences require a different treatment so that there is assurance of consistency, uniformity, predictability and certainty of judicial approach.”

120. On the considerations to be borne in mind while passing interlocutory injunctive orders, the Supreme Court postulated the following broad principles in *Colgate Palmolive (India) Ltd v.*

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<sup>56</sup> (1985) 3 SCC 314

<sup>57</sup> 1995 Supp (1) SCC 461

***Hindustan Lever Ltd***<sup>58</sup>:

“24. We, however, think it fit to note herein below certain specific considerations in the matter of grant of interlocutory injunction, the basic being non-expression of opinion as to the merits of the matter by the court, since the issue of grant of injunction, usually, is at the earliest possible stage so far as the time-frame is concerned. The other considerations which ought to weigh with the court hearing the application or petition for the grant of injunctions are as below:

- (i) extent of damages being an adequate remedy;
- (ii) protect the plaintiff's interest for violation of his rights though, however, having regard to the injury that may be suffered by the defendants by reason thereof;
- (iii) the court while dealing with the matter ought not to ignore the factum of strength of one party's case being stronger than the other's;
- (iv) no fixed rules or notions ought to be had in the matter of grant of injunction but on the facts and circumstances of each case — the relief being kept flexible;
- (v) the issue is to be looked at from the point of view as to whether on refusal of the injunction the plaintiff would suffer irreparable loss and injury keeping in view the strength of the parties' case;
- (vi) balance of convenience or inconvenience ought to be considered as an important requirement even if there is a serious question or prima facie case in support of the grant;
- (vii) whether the grant or refusal of injunction will adversely affect the interest of the general public which can or cannot be compensated otherwise.”

These principles may not apply, directly, to intellectual property matters, as, in these cases, often little survives beyond the injunction order. The relief being urgent and imperative in nature (in most cases), it is often seen that, post the injunction order, the dispute is settled, as the purpose of the litigation does not really survive thereafter. It is for this reason that, in orders deciding interlocutory injunction applications in intellectual property matters, the Court is required to delve in some length into the facts. Nonetheless, the above guidelines are a useful

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<sup>58</sup> (1999) 7 SCC 1

indicator to the basic considerations which have to guide the Court while passing orders of interlocutory injunctions. Most prominently, they indicate that observations on the merits of the dispute, contained in an order of interlocutory injunction are merely tentative or *prima facie* in nature.

**121.** While, therefore, interlocutory injunctive orders, even in intellectual property matters, are not binding precedents, if the facts and issues are identical, Courts should strive to maintain uniformity of approach so that, even at the interlocutory stage, contrasting orders are not passed in identical facts. The need for uniformity is, in such cases, however, guided by the principle of fostering the faith of the litigant, rather than the principle of comity of Courts or judicial discipline. Erosion of the faith of the litigant denudes the Court of its *raison d'etre*. I have always found the following passage from *Joy v. Regional Transport Authority*<sup>59</sup>, from a short decision rendered by K.S. Radhakrishnan, J. (as he then was), sitting singly in the High Court of Kerala to be a useful pointer:

“4. Judicial discipline demands consistency in rendering judgments. A Judicial Officer may hold different views on various aspects. A Judicial Officer may err and pass contradictory orders inadvertently. But once it is brought to the knowledge of the Judicial Officer, he is duty bound to keep track of consistency. In-consistent orders passed by a judicial officer almost in the same fact situation, and that too on the same day, would give rise to complaint of discriminatory treatment, which will undermine the people's faith in judicial system and the rule of law. It will cause resentment and anguish and make an imprint in the mind of the litigant that he has been discriminated. A Judicial Officer may err and pass illegal orders, but he shall not err in consistency. He should be consistent even in illegality.”

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<sup>59</sup> 1998 SCC OnLine Ker 344

Needless to say, the concluding sentence in this passage is not to be read in absolute terms; what the learned Judge seeks to convey is that, while legality is a matter of subjective satisfaction, consistency is non-negotiable. Inconsistent orders, even at the interlocutory stage, therefore, are to be sedulously avoided, if the facts are identical.

**122.** The sequitur is also, however, true. If the facts before the Court are different from those which were before the Court which passed the earlier interlocutory order, the later Court should assess whether the factual distinctions would justify a different conclusion, and not blindly follow the earlier order. At the end of the day, as in most cases, the judicial conscience is the ultimate arbiter.

**123.** Applying these principles to the present case, there is substance in Mr Lall's contention that the design of the defendants' bottles in *Diageo v. Great Galleon*<sup>4</sup> being fundamentally different from those of his (present) client, it is not possible to adopt, straightaway, the order passed in that case while examining the aspect of infringement in the present. This is apparent from the following extracts from paras 39<sup>53</sup>, 57 and 71 of the report in *Diageo v. Great Galleon*<sup>4</sup>:

“57. The court thus finds that, upon a conspectus of the prior art shown by the Defendants, *the uniqueness of the Plaintiffs' Registered Design which resides in its striking features, i.e. (a) tall, lean and sleek look; (b) rectangular shape inspired from the shape and proportion of a smartphone; (c) smooth rounded shoulders and symmetrical edges; (d) protruding V-shaped neck situated at the middle of both the shoulders; (e) symmetrically raised and plateau like front and rear walls; two-toned rimmed and rounded cap; and (f) dimpled bottom,* are missing in all the cited the prior arts.

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71. ... Indeed, *the design has the ubiquity; it is travel-sized slim, glossy, angular, and has fit-in-the-pocket characteristics of the smartphone*. To that effect, it is also not the Defendant's case that there exists a prior-publication which is based upon the lean and thin design of a smartphone. *The Plaintiffs' product is the first in the market to take the visually-appealing features of a smartphone and apply it to pre-packaged alcohol*. None of the third-party products shown by the Defendant are pre-filled flasks which have the striking ocular attraction of the Hipster bottles. ... *The aesthetic appeal (or in other words, the pleasing, attractive appearance) which is the sum total of the configuration of the unique features discussed above (rounded shoulders, V neck, symmetrical design, raised front and back etc.) is the novelty that needs protection*. It is not just a trade variant of previous design, as sought to be trivialised by the Defendant. A bottle is undoubtedly a common article which has common features, such as neck, shoulders, etc. It is an article that offers limited artistic freedom to innovate. Yet, it has been significantly transformed in the Hipster, with distinguishable features, giving it an aesthetic appeal that had not been conceived hereinbefore.”

(Emphasis supplied)

**124.** From these passages, it is apparent that the coordinate Bench has, in *Diageo v. Great Galleon*<sup>4</sup>, identified certain features of the suit design as being distinctive and imparting novelty to it. These are its (i) long, lean and sleek design, (ii) curved shoulders, (iii) ‘v’ element on the neck, (iv) rectangular shape similar to a smartphone, (v) dimpled base, (vi) symmetrical edges, (vii) protruding v-shaped neck, (viii) symmetrically raised plateau like front and rear walls and (ix) two-toned rim and cap. These distinguishing features, it was noted, were common to the suit design as well as to the design of the infringing bottle in *Diageo v. Great Galleon*<sup>4</sup>. It is on this basis that the coordinate Bench held the defendant’s designs in *Diageo v. Great Galleon*<sup>4</sup> to be infringing of the suit design.

**125.** This Court has been aided by learned Counsel who have provided, to the Court, physical samples of the defendant’s bottles in *Diageo v.*



***Great Galleon***<sup>4</sup>, the defendant’s bottle in the present case, as well as the plaintiffs’ bottle. When one compares the design of the defendant’s bottles in ***Diageo v. Great Galleon***<sup>4</sup> with the design of the defendant’s bottle in the present case, *vis-à-vis* the distinguishing features of the suit design as identified by the coordinate Bench in ***Diageo v. Great Galleon***<sup>4</sup>, one finds several striking differences between the design of the defendant’s bottle in ***Diageo v. Great Galleon***<sup>4</sup>, as compared to the design of the defendant’s bottle in the present case. These may be identified thus:

- (i) The “long, lean and sleek design” of the rival bottles of the ***Diageo v. Great Galleon***<sup>4</sup>, is lacking in the defendant’s bottle in the present case, though it is of nearly equal length.
  
- (ii) The shoulders of the bottles under consideration in ***Diageo v. Great Galleon***<sup>4</sup>, which were identical in shape, are markedly different from the shoulder of the defendant’s bottle in the present case, which is curved downwards and not rectangular with sharp edges.
  
- (iii) The defendant’s bottle does not have a protruding v-shaped neck at the middle of both shoulders.
  
- (iv) The edges of the defendant’s bottle in the present case are rounded, whereas the edges of the bottle in the ***Diageo v. Great Galleon***<sup>4</sup> were sharp.

(v) The defendant's bottle in the present case is not rectangular in the shape, unlike the bottles in *Diageo v. Great Galleon*<sup>4</sup>, as its upper edge is sloping downwards.

(vi) The shape of the defendant's bottle in the present case is in no manner similar to the shape of a smartphone.

(vii) The defendant's bottle does not have plateau like front and rear walls. Rather, it is curved in design, and not flat. I may note, here, that Mr. Sibal's contention that the rear wall of the defendant's bottle alone is curved is not correct. Both the front and rear walls are curved, whereas the front and rear walls of the bottle in *Diageo v. Great Galleon*<sup>4</sup>, were flat with a plateau like surface.

(viii) No such plateau-like surface is to be found on either wall of the defendant's bottle.

(ix) The cap of the defendant's bottle is not two-toned, but is only of one tone.

**126.** In fact, of all the distinguishing features of the bottles under consideration in *Diageo v. Great Galleon*<sup>4</sup>, as identified by the decision of the coordinate Bench in that case, the only feature of the defendant's bottle in the present case, which is also to be found in the bottles forming subject matter of consideration in that case, is a dimpled base. On this aspect, I find, *prima facie*, substance in the contention of Mr. Chander Lall that a dimpled base is a standard feature in many bottles of similar

shape and size, as it affords stability to the bottle when placed in a standing position, as compared to a flat base.

**127.** While, therefore, this Court would undoubtedly keep in mind the decision of the coordinate Bench in *Diageo v. Great Galleon*<sup>4</sup>, yet, given the several features of dissimilarity between the defendant's bottle in the present case and the bottle of the defendant in *Diageo v. Great Galleon*<sup>4</sup>, especially when seen *vis-à-vis* the suit design, the Court would have to examine the present case, on the aspect of design infringement, as if it had, before it, a *tabula rasa*.

#### Novelty and Originality

**128.** One may next address the finding in the decision in *Diageo v. Great Galleon*<sup>4</sup> on the aspect of novelty of the suit design.

**129.** The suit design in *Diageo v. Great Galleon*<sup>4</sup> and the suit design in the present case are the same. In *Diageo v. Great Galleon*<sup>4</sup>, the coordinate Bench has found the said design to be novel *vis-à-vis* prior art. Mr. Lall, while initially stating that he would not be arguing on the point of novelty, as in view of the decision of the coordinate Bench, later sought to contend that the aspect of validity of the suit design was also open to re-examination in view of para 40(c) of the plaint, as already noted in para 59 *supra*.

**130.** The submission, in my view, merits serious consideration. However, as a coordinate Bench has, albeit at the interlocutory stage,

found, *prima facie*, merit in the plaintiffs' contention regarding novelty of the suit design *vis-à-vis* prior art, keeping in mind the principles enunciated in the decisions cited hereinbefore, I do not propose to revisit the said issue.

**131.** I would proceed, therefore, on the premise that the suit design possesses novelty *vis-à-vis* prior art.

Scope of Section 22 of the Designs Act and the aspect of piracy *vis-à-vis* para 46 of the plaint

**132.** Section 2(d) of the Designs Act defines “design” as meaning “only the features of shape, configuration, pattern, ornament or composition of lines or colours applied to any article whether in two dimensional or three dimensional or in both forms, by any industrial process or means, whether manual, mechanical or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye....”. Trademarks are statutorily excluded from the definition “design” in the same clause. “Article” is defined in Section 2(a) as meaning “any article of manufacture and any substance, artificial, or partly artificial and partly natural”. “Copyright” is defined in Section 2(c) as meaning “the exclusive right to apply a design to any article in any class in which the design is registered”. Section 2(g) defines “original”, in relation to a design, as meaning “originating from the author of such design and (including) cases which though old in themselves yet are new in their application”.

**133.** Section 4<sup>49</sup> prohibits registration of certain designs, including designs which are not new or original [*vide* clause (a)] and designs which are not significantly distinguishable from known designs [*vide* clause (c)]. Parallely, Section 19<sup>60</sup> permits the said disabilities to be urged as grounds to contest the validity of a registered design, and also as defenses to a plea of piracy, when read with Section 22(3)<sup>61</sup>.

**134.** Section 6(1) permits a design to be registered in respect of any or all of the articles comprised in a prescribed class of articles. Section 11(1) confers, on the registered proprietor of a design, consequent to its registration, copyright in the design for ten years from the date of registration, extendable by a period of five years under Section 11(2).

**135.** Section 19 deals with the circumstances in which a person could seek cancellation of registration of a design, and Section 22 deals with piracy of registered designs. Both provisions already stand reproduced.

#### Judicial Precedents

**136.** One may now advert to certain binding judicial precedents having relevance to the issues in controversy.

**137.** *Bharat Glass Tube Ltd. v. Gopal Glass Works Ltd*<sup>62</sup>

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<sup>60</sup> See FN 3,5 *ibid*

<sup>61</sup> See FN 2 *ibid*

<sup>62</sup> (2008) 10 SCC 657

**137.1** Gopal Glass Works Ltd. (“Gopal”) claimed to be the originator of new and original industrial designs, for application by a mechanical process to glass sheets, some of which were registered and some awaiting registration. The design with which the court was concerned was registered on 5<sup>th</sup> November 2002. Gopal claimed exclusive copyright on the said design, as applied to glass sheets. The glass sheets, bearing the design, were marketed under the name “Diamond Square”.

**137.2** Bharat Glass Tube Ltd. (“Bharat”) and its associate IAG Company Ltd. (“IAG”) started imitating Gopal’s registered design. Gopal sued Bharat for piracy, *vide* Civil Suit 1 of 2004 instituted in the district court of Mehsana. The learned District Judge restrained IAG from infringing Gopal’s registered Design No. 190336.

**137.3** Bharat filed an application under Section 19 of the Designs Act before the Controller of Patents and Designs for cancellation of Design No. 190336, on the ground that it had been previously published in India and abroad and was not, therefore, new and original. Reliance was placed, by Bharat, on a catalogue of M/s Dornbusch Gravuren GmbH (“Dornbusch”), which, Bharat claimed, had developed an identical design in 1992, as well as a document downloaded from the official website of the Patent Office of the United Kingdom on 22<sup>nd</sup> September 2004 indicating that the same design had been registered in the United Kingdom by M/s Vegla Vereinigte Glaswerke GmbH in 1992.

**137.4** Gopal contested the application. It was submitted that Dornbusch was merely engaged in manufacturing engraving rollers. The rollers were used to manufacture glass sheets to which Design No. 190336 was

engraved. Gopal submitted that Dornbusch never manufactured engraved glass sheets using the engraving rollers. Dornbusch, it was submitted, had sold the engraving rollers to Gopal, granting it exclusive user rights in India for at least five years. Gopal also disputed the entitlement of Bharat to rely on material downloaded from the UK Patent Office.

**137.5** Holding that Design No. 190336 was not new or original, as it had been published outside India, as well as in India prior to the date of application by Gopal, the Assistant Controller of Patents and Designs set aside the registration of Design No. 190336. Gopal appealed against the said decision under Section 36 of the Designs Act. A learned Single Judge of the High Court allowed the appeal and reversed the decision of the Assistant Controller. Bharat appealed, against the said decision of the learned Single Judge, to the Supreme Court.

**137.6** Dealing with the issue, the Supreme Court outlined the sole purpose of the Designs Act, in para 26 of the report, thus:

“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.”

**137.7** The prohibitions under the Designs Act, held the Supreme Court, “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”. Reliance was placed, by the Supreme Court, on para 27.01 of P.

Narayanan's Law of Copyrights and Industrial Designs, the relevant parts of which may be reproduced as under:

*“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.”*

(Emphasis supplied)

**137.7** The Supreme Court noted that the Assistant Controller, in order to hold that the design of Gopal was not new or original, had relied on (i) the registration of the design in 1992 by the German Company, for use on glass, rexine and leather and (ii) the United Kingdom Patent website which indicated that the same design had been granted in the UK. As such, the Supreme Court identified the issue arising before it for consideration as “whether the design is new and original”.

**137.8** The expression “new or original” was explained, by the Supreme Court in para 29 of the report thus:



“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.”

**137.9** The Supreme Court held that Design no. 190336 of Gopal was required to be reproduced on a glass sheet. As such, the expression “new or original”, in that context, was required to be construed by examining “whether this design has ever been reproduced by any company on the glass sheet or not”. The letter of the German company, it was observed, in para 31 of the report, merely indicated that the German Company produced the rollers for manufacture of the glass sheet and did not indicate that the design was reproduced on the glass sheet either by the German Company or by any other agency.

**137.10** Paras 32 and 33 of the report go on to observe thus:

*“32. 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 the United Kingdom. There is no evidence to show that these rollers which were manufactured or originally designed by the Company were marketed by this Company to be reproduced on glass sheets in India or even in the 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 the United Kingdom.*

*33. 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, rexine 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 anywhere in Germany.”*

(Emphasis supplied)

**137.11** Following the above, in para 34, the Supreme Court proceeds to hold as under:

“...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 the United Kingdom.”

**137.12** Thereafter, the Supreme Court expounded, in some detail, on the jurisprudential contours of the concept of “design”. It was noted that the definition of “design” in the Registered Designs Act, 1949 in force in UK, was almost *pari materia* to the definition of “design” in the Designs Act. Placing reliance on para 27.07 of P. Narayanan’s Law of Copyrights and Industrial Designs, the Supreme Court went on, in para 36 of the report, to hold thus:

“36. Similarly our attention was also invited to Para 27.07 of Law of Copyright and Industrial Designs by P. Narayanan (4th Edn.) 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.”

(Emphasis supplied)

**137.13** On the question of eye appeal, the Supreme Court quoted, with approval, the decision of the Privy Council in *Interlego AG v. Tyco*

**Industries Inc.**<sup>63</sup>, and went on to hold, in paras 40 and 41 of the report, thus:

“40. The question of eye appeal came up for consideration in **Interlego AG v. Tyco Industries Inc.**<sup>63</sup> In that case Their Lordships have laid down important test in the matter of visual appeal of the eye. It was observed as follows : (All ER pp. 959g-960a)

*“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 **Tecalemit Ltd. v. Ewarts Ltd.**<sup>64</sup> (No. 2) , **Stenor Ltd. v. Whitesides (Clitheroe) Ltd.**<sup>65</sup>, and **Amp**<sup>30</sup> [**Amp Inc. v. Utilux Pty. Ltd.**, 1972 RPC 103 (HL)] and in the more recent Irish case of **Allibert S.A. v. O—Connor**<sup>66</sup> in all of which the claim to registration failed. It was one which was present in *Kestos case*, 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 **Interlego AG v. Alex Folley (Vic) Pty. Ltd.**<sup>67</sup> (FSR at p. 298):*

‘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 gave 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.’”

41. *One has to be very cautious, unless two articles are simultaneously produced before the court then alone the court will be*

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<sup>63</sup> (1988) 3 All ER 949

<sup>64</sup> (1927) 44 RPC 503

<sup>65</sup> 1948 AC 107 : (1947) 2 All ER 241 : (1948) 65 RPC 1 (HL)

<sup>66</sup> (1981) FSR 613

<sup>67</sup> (1987) FSR 283

*able to appreciate. But in the present case no design reproduced on 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 the United Kingdom or Germany. That could have been decisive.”*

(Emphasis supplied)

**137.14** The principles which emerge from the decision of the Supreme Court in *Bharat Glass Tube*<sup>62</sup> may be enumerated thus:

(i) The purpose of the Designs Act is protection of intellectual property in the original design for a period of ten years, extendable by five more years. The protection is intended to benefit a person for the research and labour put in to evolve a new and original design.

(ii) The prohibitions in the design were engrafted so as to protect the original person who has designed a new design by virtue of his own efforts by researching for a long time.

(iii) The object of design registration was to see that the originator of a profitable design was not deprived of the reward due to him by others applying the designs to their goods.

(iv) The Designs Act was intended to protect novel designs.

(v) The expression “new or original” was defined as a design hitherto not published or made known to the public, invented for the first time and not reproduced by anyone else.

(vi) The expression “design” means a conception or idea which could be applied to an article. It was not the article, but the idea which was capable of registration. The registrant was, however, required to produce a pictorial illustration of the idea or suggestion, such as to enable the court or authority to visualize the design.

(vii) The important part of the purpose of registration of a design was the finished article and its appeal to the eye.

**138. *Carlsberg Breweries***<sup>55</sup>

**138.1** This decision, rendered by a Full Bench of five Hon’ble Judges of this Court, was concerned with Section 22 of the Designs Act. The two issues that arose for consideration in that case, as identified in para 20 of the report, were whether (i) the Court was compelled in law to reject a plaintiff for misjoinder if two actions could not be clubbed, and (ii) claims for design infringement and passing off so were so disparate or dissimilar that they could not be tried together in one suit. While, therefore, they do not directly address the controversy in the present case, in their resolution, the Full Bench returned certain pertinent findings of law which are binding. Para 66 of the report delineated the defences available to a claim of infringement of a registered design, thus:

“66. In a suit alleging infringement of registered design, *the defences which are available to a defendant essentially are three fold, firstly of there being prior publication of the registered design and which design is found in the public domain, secondly of whether the registered design even if is different/variation of a design existing in public domain yet the difference(s)/variation(s) do not cause the*

*design of the plaintiff to be a new or original design because plaintiff's design is only a trade variation of an existing design or that such variations do not give newness or originality to the plaintiff's goods/articles adopting the design, and thirdly as to whether the article being sold by the defendant is a fraudulent or obvious imitation of the article of the plaintiff containing the registered design. It bears note that the words "fraudulent or obvious imitation" which are found in Section 22 of the Designs Act, have their flavour similar to the words identity/identical or deceptively similar as are found in Section 29 of the Trade Marks Act."*

(Emphasis supplied)

Thus, there are three defences available to a claim of infringement. They are (i) that the suit design has been published prior in point of time, (ii) that the suit design, even if not a replica of an existing design, is wanting in novelty or originality *vis-à-vis* designs available in the public domain and (iii) that the defendant's design is neither an obvious nor a fraudulent imitation of the suit design. I have already observed that, in view of *Diageo v. Great Galleon*<sup>4</sup>, I am not inclined to revisit the issue of validity of the suit design; ergo, defences (i) and (ii) do not arise for consideration in the present case. Defence (iii) has, however, to be examined, in view of rival contentions of the parties.

**138.2** Thereafter, in para 67 of the report, the Full Bench, while holding that common facts and common defences would arise for consideration while examining the pleas of infringement and passing off, thereby justifying trial of both in one suit, observes that "in both the causes of action of infringement of a registered design and passing off, a substantial part of the bundles of facts of the two actions will be same *as to whether or not the article being sold by the defendant of a particular design is or is not a fraudulent or obvious imitation (identical or*

*deceptively similar*) to the article of the plaintiff, therefore, there will clearly exist common set of facts with respect to the actions of passing off and the defence of the defendant of the defendant's goods/articles not being a fraudulent or obvious imitation by the defendant of the articles/goods of the plaintiff.” Para 69 of the report goes on to hold thus:

“69. The reference is answered by holding that one composite suit can be filed by a plaintiff against one defendant by joining two causes of action, one of infringement of the registered design of the plaintiff and the second of the defendant passing off its goods as that of the plaintiff on account of the goods of the defendant being fraudulent or obvious imitation i.e identical or deceptively similar, to the goods of the plaintiff.”

The Full Bench, thus, was clearly of the view that the expression “obvious or fraudulent imitation” was analogous to the expression “identical or deceptively similar” as finds place in the Trade Marks Act. The interpretation binds me.

### **139. *Mohan Lal v. Sona Paint & Hardwares*<sup>68</sup>**

**139.1** The reference to the 5-judge Full Bench in *Calsberg Breweries*<sup>55</sup>, in fact, was a consequence of the correctness of this decision, also by a Full Bench albeit of three Hon’ble Judges, being doubted. *Carslberg Breweries*<sup>55</sup> reversed the decision in *Mohan Lal*<sup>68</sup> insofar as it held that a composite suit for infringement and passing off of a registered design would not lie. While doing so, however, it reproduced, in para 5 of the report, paras 24.3 and 25 to 31 of *Mohan Lal*<sup>68</sup> in which the following observation, which finds place in para 24.3, was left undisturbed:

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<sup>68</sup> 2013 SCC OnLine Del 1980



“The fundamental edifice of a suit for infringement under the Designs Act *would be the claim of monopoly* based on its registration, *which is premised on uniqueness, newness and originality of the design.*”

(Emphasis supplied)

**139.2** There is, therefore, an inextricable link between the claim, of a registered design, to novelty and originality, which is the basis on which it is granted registration and gains a monopoly, and the claim that it stands infringed by the design of another. This supports, in a sense, Mr Lall’s submission that the sweep of infringement analysis, as sought by the plaintiff, cannot exceed the sweep of the novelty, as claimed in the design and on the basis of which the design was granted registration.

**140. *Reckitt Benckiser India Ltd. v. Wyeth Ltd*<sup>50</sup>**

**140.1** The issue referred to the Full Bench of this Court, in this case, was identified in para 1 of the report as “whether a Division Bench of this Court in the case of *Dabur India Ltd. v. Amit Jain*<sup>19</sup> has correctly held that publication abroad by existence of the design in the records of the Registrar of designs which is open for public inspection cannot be said to be “prior publication” as per the meaning of the term as found in Sections 4(b) and 19(1) of the Designs Act. 2000”.

**140.2** The Full Bench proceeded, in para 12 of the report, to set out the following principles:

“(ii) When we read the definition of a ‘design’ under Section 2(d) we find that there are inter alia four important aspects in the same. The first aspect is that *the design is a design which is meant to produce an article as per the design by an industrial process or means. The second aspect is that design is not the article itself but the conceptual*

*design containing the features of a shape, configuration, pattern, composition of lines etc. Third aspect is the judging of the design which is to be put in the form of finished article solely by the eye. Fourthly, the design which is the subject matter of the Act is not an artistic work which falls under the Copyright Act or a trademark which falls under the Trademarks Act.*

(iii) More clarity is given to the meaning of the word design when we look at the definition of ‘original’ as found under Section 2(g). The definition of the expression ‘original’ shows that the design though is not new because such design exists in public domain and is otherwise well-known, however, the design is original because it is new in its application i.e. new in its application to a specific article. Therefore, for seeking registration under the Act it is not necessary that the design must be totally new, and it is enough that the existing design is applied in a new manner i.e. to an article to which that design has not been applied before.

(iv) So far as the expression ‘new’ is concerned, it is well known i.e. it is something which comes into existence for the first time and therefore a new design which comes into existence for the first time obviously will be entitled to copyright protection.”

(Emphasis supplied)

**140.3** The Full Bench, thereafter, proceeded to discuss the decision in *Gopal Glass Works*<sup>51</sup> and culled out, from the said decision, *inter alia*, the following principle:

“(i) The issue of originality of design has to be necessarily looked at in terms of the article to which it applies and there may be lack of clarity as to existence of prior publication unless the publication is totally clear i.e. it is only completely understood for its effect only when the same is actually put on the article.”

**140.4** Para 19 of the report thereafter went on to examine the concept of “tangible form”. It read thus:

“19(i) *In our opinion the expression ‘tangible form’ refers to a specific physical form or shape as applied to an article and not the mere ability to replicate, convert and give a physical shape to the design, though of course to fall under the expression ‘tangible form’ it is not necessary that the article should have been used, but the expression ‘in any other way’ takes some of its colour from the words ‘used’ or ‘tangible form’. The principle of Nositur a Sociis will be applicable. Section 4(b) therefore, not only, requires publication but it*

*should be publication by use, in tangible form or in any other way.* The expression ‘any other way’ here is wider in context and takes into its ambit a design which has been created though not still put to use or exists in tangible form but at the same time it is guided by the words “use” and “tangible form”. Thus, to disqualify a claim for registration or cancel registration of a design in India, the publication abroad should be by use, in tangible form, or in some other way, means that the design should not be a factum on paper/document alone, but further that the design on paper should be recognizable i.e. have the same impact in the public as a furnished article will appeal when judged solely by the eye (see Section 2(d)). Putting it differently *if the design is on paper then it must exist upon a piece of paper in such a way that the shape or other features of the article are made clear to the eye. The visual impact should be similar to when we see the design on a physical object i.e. an object in tangible form/in use.* As noted otherwise in the present judgment, registration of a design is article specific and thus depending on the facts of each case registration or publication of design of a particular article may or may not necessarily result in rejection or cancellation of registration of the same or similar design on another article. The Act protects the original artistic effort not in form of an idea or on its own as an artistic work, but is an embodiment in a commercially produced artefact. Thus the primary concern is what the finished article is to look like. [see observations of the Supreme Court in *Bharat Das Tools Ltd.*<sup>69</sup> (infra)].”

(Emphasis supplied)

**140.5** One may take home the following principles from the judgment of the Full Bench in *Reckitt Benckiser India Ltd.*<sup>50</sup>:

(i) The four aspects of the concept “design” as defined in Section 2(d) of the Designs Act were that (a) the design was meant to produce an article as per the design by an industrial process or means, (b) the design was not the article itself but the conceptual design containing the features of shape, configuration, pattern, composition of lines etc., (c) the design had to be judged in the form of the finished article solely by the eye and (d) an artistic

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<sup>69</sup> (2008) 10 SCC 657

work under the Copyright Act or a trade mark under the Trade Marks Act was not a “design” under the Designs Act.

(ii) A design which was not new, because it existed in the public domain or was otherwise well-known, could nonetheless be “original” because it was new in its application to a specific article. It was not necessary, therefore, for entitlement to registration, that the design had to be totally new. It was sufficient if an existing design was applied in a new manner, i.e. that the design was applied to an article in a manner in which it had not been applied before.

(iii) “New”, on the other hand, was a commonly understood expression, meaning something which came into existence for the first time. A design which came into existence for the first time was, therefore, *ex facie*, “new” and was entitled to copyright protection. For novelty of a design to be destroyed by prior publication, the prior publication had necessarily to be in a tangible form of the design applied to the same article. The main factor to be examined in such cases was the visual effect and appeal of the illustration. Illustrations and pictures which were sufficiently explicit would suffice for the purpose. The words “intangible form” as used in Section 4(b) of the Designs Act, indicated that the features of the design had to be clear to the eye.

(iv) The purpose of the Designs Act was to protect novel designs devised to be applied to articles for manufacture and marketing commercially. The Designs Act was not intended to protect

principles of operation/invention. The look of the finished article was of prime concern.

**141. *B. Chawla***<sup>7</sup>

**141.1** The issue arising before the Division Bench of this Court in *B. Chawla*<sup>7</sup> was whether the decision of B. Chawla in respect of a mirror was a “new and original” design. Para 4 of the report identified the basis of the claim of novelty by B. Chawla in the design, thus:

“4. The novelty in the design in question, admittedly, is on account of the further curve in the sloping upper length side as it is not disputed that rear view mirrors, rectangular in shape with rounded edges, width side curved or slopping and the lower length side also slopping are commonly available in the market.”

In conjunction with the above, para 7 of the report identified the scope of inquiry before the court, on the aspect of novelty, thus:

“7. Akil Ahmed, partner of the respondent, and his witnesses, Jagjit Singh, Rajendra Singh and Sultan Singh submitted affidavits before the learned single Judge swearing that appellants' mirror was a common type rectangular mirror with a slight curve on the upper side and such like mirrors were available in the market. They also swore that there was no newness nor originality about the design. Mr. Anoop Singh, learned counsel for the respondents, has frankly conceded that no documentary or material evidence showing the availability of rectangular mirrors having a curve on either side in the slopping upper length side has been brought on the record and he would not press that mirrors of such like designs were actually available in the market at the time the appellants brought out their product in the market. Thus, *we are left with the only consideration whether a further curve on either side in the slopping upper length side makes the design in respect of rear view mirror a new or original design which the appellant were entitled to get registered and which is not liable to cancellation under Section 51-A of the Act.*”

(Emphasis supplied)

**141.2** Thereafter, paras 8 to 10 of the report read as under:

“8. In *Le May v. Welch*<sup>70</sup>, Bowen L.J. expressed the opinion:

“It is not every mere difference of cut” — he was speaking of collars “Every change of outline, every change of length, or breadth, or configuration in a single and most familiar article of dress like this, which constitutes novelty of design. To hold that would be to paralyse industry and to make the Patents, Designs and Trade Marks Act a trap to catch honest traders. There must be, not a mere novelty of outline, but a substantial novelty in the design having regard to the nature of the article.”

And Fry L.J. observed:

*“It has been suggested by Mr. Swinfen Eady that unless a design precisely similar, and in fact identical, has been used or been in existence prior to the Act, the design will be novel or original. Such a conclusion would be a very serious and alarming one, when it is borne, in mind that the Act may be applied to every possible thing which is the subject of human industry, and not only to articles made by manufacturers, but to those made by families for their own use. It appears to me that such a mode of interpreting the Act would be highly unreasonable, and that the meaning of the words “novel or original” is this, that the designs must either be substantially novel or substantially original, having regard to the nature and character of the subject matter to which it is to be applied”.*

9. Similar view was expressed by Buckley L.J. on the question of quantum of novelty in *Simmons*<sup>48</sup> at 494 in these words:

*“In order to render valid, the registration of a Design under the Patents and Designs Act, 1907, there must be novelty and originality, it must be a new or original design. To my mind, that means that there must be a mental conception expressed in a physical form which has not existed before, but has originated in the constructive brain of its proprietor and that must not be in a trivial or infinitesimal degree, but in some substantial degree”.*

10. In *Phillips v. Harbro*<sup>8</sup>, Lord Moulton observed that *while question of the meaning of a design and of the fact of its infringement are matters to be Judged by the eye, (sic) it is necessary with regard to*

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<sup>70</sup> (1884) 28 Ch. D. 24

*the question of infringement, and still more with regard to the question of novelty or originality, that the eye should be that of an instructed person, i.e., that he should know what was common trade knowledge and usage in the class of articles to which the design applies. The introduction of ordinary trade variants into an old design cannot make it new or original. He went on to give the example saying, if it is common practice to have, or not to have, spikes in the soles of running shoes a man does not make a new and original design out of an old type of running shoes by putting spikes into the soles. The working world, as well as the trade world, is entitled at its will to take, in all cases, its choice of ordinary trade variants for use in any particular instance, and no patent and no registration of a design can prevent an ordinary workman from using or not using trade knowledge of this kind. It was emphasized that it is the duty of the Court to take special care that no design is to be counted a “new and original design” unless it is distinguished from what previously existed by something essentially new or original which is different from ordinary trade variants which have long been common matters of taste workman who made a coat (of ordinary cut) for a customer should be left in terror whether putting braid on the edges of the coat in the ordinary way so common a few years ago, or increasing the number of buttons or the like, would expose him for the prescribed years to an action for having infringed a registered design. On final analysis, it was emphasized that the use of the words ‘new or original’ in the statute is intended to prevent this and that the introduction or substitution of ordinary trade variants in a design is not only insufficient to make the design “new or original” but that it did not even contribute to give it a new or original character. If it is not new or original without them the presence of them cannot render it so.”*

11. *The quintessence of the placitums above is that distinction has to be drawn between usual trade variants on one hand and novelty or originality on the other. For drawing such distinction reliance has to be placed on popular impression for which the eye would be the ultimate arbiter. However, the eye should be an instructed eye, capable of seeing through to discern whether it is common trade knowledge or a novelty so striking and substantial as to merit registration. A balance has to be struck so that novelty and originality may receive the statutory recognition and interest of trade and right of those engaged therein to share common knowledge be also protected.”*

(Emphasis supplied)

**141.3** From *B. Chawla*<sup>7</sup>, therefore, the following principles emerge:

- (i) Trivial changes would not render the design new or original.
- (ii) Infringement and novelty are both to be tested by the instructed eye, which is aware of prior art.
- (iii) Introduction of ordinary trade variants did not render a design new or original.
- (iv) The court was required to strike a balance, by recognising the competing interests of novelty and originality being required to achieve statutory recognition and the interest of the trade and the rights of the person engaged in the trade, both of which were required to be protected.

**142. *Crocs Inc. v. Bata India Ltd*<sup>71</sup>**

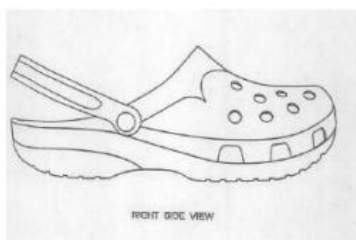
**142.1** Crocs Inc. (“Crocs”, hereinafter) alleged, in this case, that two of its registered Designs No. 197685 and 197686 were infringed by various respondents, resulting in separate suits being filed by Crocs and separate appeals being preferred thereagainst. Bata was one of the allegedly infringing respondents.

**142.2** The design with respect to which Crocs claimed exclusivity was the following:

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<sup>71</sup> 2019 SCC OnLine Del 6808 : (2019) 78 PTC 1





**142.3** The defendants contended that the registration of the design in favour of Crocs was itself invalid and that, therefore, there could be no question of piracy thereof. Exclusivity in the design, it was pointed out, had been claimed by Crocs in respect of the heel strap and holed outsole, which were merely functional and utilitarian features of the footwear. It was contended that the holes on the outsole were features of a traditional water canal design widely used in different types of footwear down the ages, as the holes facilitated flow of water, imparting functionality and suitability. They also allowed air ventilation for the feet inside the sole. The defendant further submitted that the attempt to register an identical design was rejected by the Third Board of Appeal in the European Union (EU) on 26<sup>th</sup> March 2010, which Crocs had suppressed. Further, it was urged that the clog-shaped design of the footwear was also not entitled to novelty as the shape was a traditional clog shape, used for an industrial shoe invented about 80 years prior thereto.

**142.4** The learned Single Judge of this Court accepted the defendant's objections. He held that Design Nos. 197685 and 197686 were already existing in the public domain prior to priority date of the said designs i.e. 28<sup>th</sup> May 2003. The designs were, therefore, it was held, liable to be cancelled under Section 19(1)(b) read with Section 4(b) of the Designs Act. They could not, therefore, confer, to Crocs, any legal entitlement on

the basis of which it could allege piracy under Section 22. In this context, para 17 of the judgment of the learned Single Judge in *Crocs*<sup>71</sup>, merits reproduction:

“17. On behalf of the plaintiff it could not be seriously disputed, and nor it could have been, that the printouts filed by the defendants from the website of the plaintiff itself show as on 16.10.2002, 24.11.2002, 25.11.2002, 28.11.2002 and 13.12.2002 that the registered designs were in public domain as on those dates which are prior to the date of priority of registration being 28.5.2003. In case if the aforesaid printouts were not so then nothing prevented the plaintiff from filing its own documents of its own website and only then it would be shown that the documents as filed by the defendants being the downloaded printouts of the website of the plaintiff of the different days prior to 28.5.2003 were not those as filed by the defendants. *In view of the aforesaid publications of plaintiff itself existing in the public domain in the website of the plaintiff much prior to 28.5.2003 showing the registered designs footwear of the plaintiff, and that too repeatedly, the registered designs of the plaintiff are to be held to be already existing in public domain prior to 28.5.2003 and consequently the registrations of the plaintiff are liable to be cancelled in terms of Section 19(1)(b) read with Section 4(b) of the Act. In my opinion therefore clearly the registered designs of the plaintiff were in the public domain prior to priority date of 28.5.2003 and therefore registration granted to the plaintiff with respect to registered designs which are subject matter of the present suits will not afford any legal entitlement to the plaintiff to allege piracy of the designs under Section 22 of the Act.*”

(Emphasis supplied)

**142.5** The Division Bench, thereafter, noted paras 24 and 26 to 28 of the judgment of the learned Single Judge, in appeal before it, which, in turn, relied on the decisions in *Bharat Glass Tube*<sup>62</sup> and *B. Chawla*<sup>7</sup>. Paras 24 and 26 to 28 of the judgment of the learned Single Judge in *Crocs*<sup>71</sup> merit reproduction, thus:

“24. *On behalf of the plaintiff it has been argued that the registered designs of the plaintiff have to be looked as a whole. It has been argued that there are various features in the registered designs of the plaintiff with respect to the placement, shape and size of the perforations/gaps/open spaces, and the hump like protrusion at the front of the footwear, and that there exists a mound above the joint*

*portion of the limb of the foot with the foot, and the designs of the soles are unique, and that when such features are taken as a whole, they have that much amount of visual appeal for the registered designs of the plaintiff's footwear to have that much newness or originality for having been rightly granted registrations under the Act. It is argued that once registrations have been granted, then this Court must presume existence of newness and originality and that onus in such circumstances must shift upon the defendants to show that there is no newness or originality.”*

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“26. One need not labour hard, or even labour much, to hold that footwear have existed and are known to mankind from in fact prehistoric age. Obviously footwear was originally created for the sole purpose to protect the feet. Footwear created over passage of time has differed because of choices made by human beings. Type of footwear is also dependent on whether the same are/were used by men or women. With respect to footwear of men there were created/existed various variations and so too with respect to footwear of women. Variations obviously are with respect to shape of the footwear, look of the footwear, fashion statement as per the footwear and so on. Footwear also when created had to take into account the convenience of the wearer of the same. Besides the issue of convenience of the wearer of the same footwear also was different depending on the place where it was worn or for the purpose for which it was worn. In those areas where climatic conditions were on the colder side obviously the footwear by its very nature had to be completely covered so that besides giving protection to the feet against injury, the footwear also provided warmth. In countries and areas where climatic conditions are hot or humid obviously the footwear created were such that they would be comfortable to wear in such climatic conditions being hot and humid. In these latter areas footwear had openness or breathing spaces. So far as the purpose of manufacture of footwear is concerned it can be noted that footwear for walking is of one type, other type is for sports, then again there is footwear for horse riding, or for mountaineering, or for office wear or formal wear, and so on. Even within sports shoes the type varies as per the type of the sport. I dare say that all the aforesaid aspects need not be established in a court of law and this Court can take judicial notice of the aforesaid aspects with respect to footwear.”

“27.....straps at the back portions of the sandals. Where the sandals are casuals, and for being worn for short periods only, the straps at the back can be missing. Straps at the back of the sandals also existed or were left out depending on the purposes for which the same were worn. The existence of what is known as “Jootis” is well known

in northern India especially in Punjab. — “Jootis” are fanciful sandals having multi-colours, with embellishments being fixed on the “Jootis” by means of fabrics of different colours. To give a further break up and elucidation it is noted that there are variations with respect to the sandals of men and women. Sandals of ladies, not unexpectedly were designed, moulded, re-moulded and again re-moulded with respect to the aspect of shapes and heights of the soles or the upper casing. To wit we have stilettos or flats or the platforms and so on. Obviously what is being stated by this Court is that save and except where a footwear design is an Intellectual Property Right, footwear is a footwear, shoe is a shoe is a shoe and sandal is a sandal. All the different footwear have changed over different periods of time and also as per requirements as to who were the persons wearing the same or of the particular climatic conditions where they were worn or the footwear becoming fashion statements but ultimately all the different types of footwear are variations of nothing else but a footwear i.e. foot plus wear i.e. something that is worn on the feet. Really therefore, *it would take in the opinion of this Court an effort larger than an ordinary effort to create a different footwear than the known types of footwear, to be an innovation/creation having such requisite newness and originality for that creation to become an Intellectual Property Right as a design in terms of the Designs Act.*

28.(i) With the aforesaid observations with respect to what is the law of design pertaining to newness and originality, and the concept of footwear itself being of different types, let us apply the aforesaid discussion to the facts of the present case as regards the registered designs of the plaintiff. In my opinion, *one does not have to travel too far to understand that footwear of the plaintiff is nothing but a sandal. Sandal with open spaces are only trade variations of a sandal. Placing of the open spaces or perforation or gaps, and sandals being with or without straps at the back, are in the opinion of this Court merely only variations or trade variations of footwear. Trade variations of footwear/sandals cannot be and should not be given exclusive monopoly. Of course every manufacturer who has done variations wants to earn maximum profit therefrom, and one of the ways to do so is by stifling competition by stopping the production of similar type of footwear as being manufactured by the plaintiff, however that eventuality does not mean that courts will allow such a plaintiff/manufacturer to create a monopoly when the law does not sanction the same. In my opinion the features which have been argued on behalf of the plaintiff as existing in its sandals/footwear of mounds or humps or straps (or lack of them) or soles designs or perforations/open spaces etc., even when taken as a whole, or even individually for that matter, cannot be said to result in innovation or creation of newness or originality as is the intention of the legislature*

*in terms of the Section 4(a) of the Act read with Section 19(1)(d) of the Act. It is therefore held that the registered design of the plaintiff with respect to its footwear, does not have the necessary newness or originality for the same to be called a creation or innovation or an Intellectual Property Right, and which must necessarily exist as stated by the Supreme Court in the judgment in the case of Gopal Glass Works Limited (supra). In my opinion the registered design of the plaintiff is such which is liable to be cancelled as per Section 19(1)(d) of the Act read with Section 4(a) of the Act, and therefore such factual defences entitles the defendants to succeed in view of Sub-Section (4) of Section 22 of the Act to argue against grant of reliefs in the injunction applications which are subject matter of the present order. On this ground itself also therefore the interim applications of the plaintiff are liable to be and are accordingly dismissed.”*

(Emphasis supplied)

**142.6.** The Division Bench, thereafter, categorically endorsed and approved the reasoning of the learned Single Judge in appeal before it, in para 28 of the report, thus:

*“28. The learned single judge's analysis - based on the decisions in **Bharat Glass**<sup>62</sup> (supra) and **B. Chawla**<sup>7</sup> (supra) that firstly a design should be new and original, secondly it should not have been disclosed to the public earlier (prior publication) thirdly that it should be significantly “distinguishable” from known designs or combination of known designs, is sound and acceptable inasmuch as it succinctly re-states the law on the subject; even the plaintiff/Crocs Inc does not appear to seriously object to it.”*

(Emphasis supplied)

**142.7** Significantly, the Division Bench also addressed an objection to the effect that the learned Single Judge could not have relied on the content downloaded from the Wayback Machine search engine on the internet, by observing that, at the Order XXXIX stage, the court was not expected to conduct a mini trial. In para 34 of the report, the Division Bench held that the screen shot on the basis of which the learned Single Judge had proceeded clearly showed that the “Holey Soles” design in respect of

which Crocs claimed exclusivity was made and published prior to Crocs' designs.

**142.8** Para 32 of the report held, in this context, thus:

“At the stage of considering the *prima facie* merits of any given case, the court cannot carry out a mini-trial; it has to consider the broad probabilities of the rival claims, having regard to the available pleadings and the documents. Whether the plaintiff's argument that the Wayback machine or search engine (or web archive) might be correct so far as web sites or web pages are concerned, but not true and therefore, unreliable because of the reasons mentioned by it, are to be considered during the trial.”

Thus, held the Division Bench (in para 37 of the report), the learned Single Judge had applied the appropriate test for prior publication. On the ability to decide the issue of prior publication on the basis of a document, the Division Bench relied on the following passage from *Rosedale Associated Manufacturers Ltd. v. Airfix Products Ltd.*<sup>52</sup>:

“Thus, approaching the matter, I have for my part come to the clear conclusion that the design was not published by Clarice Jones' specification. To conclude otherwise would, in my judgment, at least require that somewhere in the specification the design or something substantially the same as the design was described with reasonable clarity on a fair reading of the document. 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*<sup>72</sup> at p. 463:“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 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*

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<sup>72</sup> (1862) 31 L.J. (Ch.) 457

*eye and should not have to depend upon his own originality to construct the design from the ideas which the document may put into his head....”*

(Emphasis supplied)

**142.9** Para 44 of the report goes on to hold that a mere trade variation of an existing design would not entitle the originator of the design to protection through registration. The following extract from the said para is relevant:

“44. In the opinion of this court, the statement of the single judge with respect to certain common place designs and the limited scope for variation in design expressed in an unusual manner *per se* did not render the application of the law incorrect. Rather, what appears from the record is that the two designs, over which Crocs Inc claims novelty and originality are repetitions of age-old designs, with some variations - in strap, etc. A design for an article that simulates a well-known or naturally occurring object or person is unprotectible. *Thus, a mere trade variation of an existing design does not entitle the originator of the design to protection through registration.*”

(Emphasis supplied)

**142.10** *Crocs*<sup>71</sup>, therefore, holds, that (i) registration granted in respect of designs which were not new or original vis-à-vis prior published designs, would not afford any legal entitlement to the holder of the registration to allege piracy under Section 22 of the Designs Act, (ii) mere trade variations did not confer novelty and could not, therefore, be conferred exclusive monopoly and (iii) at the *prima facie* stage under Order XXXIX, the court was not required to conduct a mini trial and could, therefore, rely on images in search engines.

**143. *Pentel Kabushiki Kaisha v. M/s Arora Stationers*<sup>73</sup>**

It is not necessary to enter into the factual details of this decision. The only discernible principle, therein, which is of any significance to the case at hand, is that a defendant who has applied for a similar design was estopped from questioning its validity.

The view in other jurisdictions, and non-binding precedents

**144. *Litton Systems, Inc. v. Whirlpool Corp*<sup>74</sup>**

**144.1** Litton Systems Inc. (“Litton”) alleged infringement, by Whirlpool Corporation (“Whirlpool”) of, *inter alia*, US design Patent D 3843859 (“859” hereinafter), entitled “Microwave Oven”, covering Litton’s 400-Series microwave ovens.

**144.2** On the principles of infringement of design Patent, the Federal Court observed thus:

“More than one hundred years ago, the Supreme Court established a test for determining infringement of a design patent which, to this day, remains valid. *Gorham Co. v. White*<sup>75</sup>. This test requires that “if, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.” *Id.* at 528, 20 L. Ed. 731.

*For a design patent to be infringed, however, no matter how similar two items look, "the accused device must appropriate the novelty in the patented device which distinguishes it from the prior art." Sears,*

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<sup>73</sup> 261(2019) DLT 753(DB)

<sup>74</sup> 728 F.2d 1423 (Fed. Cir. 1984)

<sup>75</sup> 81 U.S. (14 Wall.) 511, 20 L. Ed. 731 (1871)



*Roebuck & Co. v. Talge*<sup>76</sup>, *Horwitt v. Longines Wittnauer Watch Co.*<sup>77</sup>. That is, even though the court compares two items through the eyes of the ordinary observer, it must nevertheless, to find infringement, attribute their similarity to the novelty which distinguishes the patented device from the prior art. ...

*The novelty of the '990 patent consists, in light of our analysis in the previous section on the '990 patent's validity, of the combination on a microwave oven's exterior of a three-stripe door frame, a door without a handle, and a latch release lever on the control panel. The district court expressly found, however, that the Whirlpool design had none of these features.*

*We recognize that minor differences between a patented design and an accused article's design cannot, and shall not, prevent a finding of infringement. In this case, however, "while there is some similarity between the patented and alleged infringing designs, which without consideration of the prior art might seem important, yet such similarity as is due to common external configuration is no greater, if as great, between the patented and challenged designs as between the former and the designs of the prior art." **Applied Arts Corp. v. Grand Rapids Metalcraft Corp.**<sup>78</sup>. Where, as here, a field is crowded with many references relating to the design of the same type of appliance, we must construe the range of equivalents very narrowly.*

*We hold, therefore, that the scope of protection which the '990 patent affords to a microwave oven is limited in application to a narrow range: the three-stripe effect around a door with no handle and the latch release mounted on the control panel. The Whirlpool ovens, therefore, do not infringe the '990 design patent. The contrary conclusion of the district court is clearly erroneous, being attributable to its failure to apply the correct legal standard of infringement in design patent cases."*

(Emphasis Supplied)

**145.** The hypothetical “informed user”, through whose “instructed eyes” the aspect of infringement is to be addressed, has been given colour and complexion by the judgement of the Supreme Court of the UK in *Procter*

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<sup>76</sup> 140 F.2d 395, 396 (8th Cir. 1944)

<sup>77</sup> 388 F. Supp. 1257, 1263, 185 USPQ 123, 128 (S.D.N.Y. 1975)

<sup>78</sup> 67 F.2d 428, 430 (6th Cir. 1933)

**& Gamble Co. v. Reckitt Benckiser (UK) Ltd<sup>79</sup>**, the *ratio decidendi* of which stands thus reproduced in Halsbury's Laws of England:

“A design infringes the right given by registration if it does not produce *on the informed user* a different overall impression. An informed user is not the same as a person ‘skilled in the art’ of patent law nor the average consumer of trade mark law. The informed user is a user *who has experience of other similar articles and who will be reasonably discriminatory*; he is *able to appreciate enough detail* to decide whether a design creates an overall impression which has individual character and whether an alleged infringement produces a different overall impression.”

The informed user, for the purposes of design infringement, or piracy, is, therefore, a specie *sui generis*. He is neither a “person skilled in the art” nor, as Mr. Sibal would seek to contend, an “average consumer”. He

- (i) has experience of other similar articles,
- (ii) is reasonably discriminatory and
- (iii) is able to appreciate enough detail.

With greatest respect to the coordinate bench in ***Diageo v. Great Galleon<sup>4</sup>***, therefore, I am unable to subscribe to the view that design infringement has to be seen by holding the products in hand, or as assessed by a person who sees them on a shelf eight to ten yards away. ***B. Chawla<sup>7</sup>*** clearly holds that the matter has to be viewed from the perspective of the “instructed eye”. The instructed eye has to be of an “informed person”, and not of the “average consumer”, much less the consumer of “average intelligence and imperfect recollection” who straddles trademark infringement law. ***Procter & Gamble<sup>79</sup>*** further clarifies that “the overall impression is *what strikes the mind of the*

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<sup>79</sup> (2007) EWCA Civ 936

*informed user when it is carefully viewed, not what he may recollect afterwards”.*

**146.** Though *Procter & Gamble*<sup>79</sup> was rendered in the context of the Registered Designs Act, 1949, in force in the UK, it has considerable precedential value, in view of the declaration by the Supreme Court, in *Bharat Glass Works*<sup>62</sup>, that the provisions of the Registered Designs Act are *pari materia* with the provisions of the Designs Act, 2000 in force in India.

**147.** The decision of the coordinate single bench of Vipin Sanghi, J. (as the learned Chief Justice then was) in *Carlsberg Breweries*<sup>14</sup> also underscores this position. From the passages from the said decision extracted in para 54 *supra*, the following elucidations of the law emerge:

(i) A pirated design “must be the exact thing; and any difference, however trifling it may be or however unsubstantial, would nevertheless protect it from being made the monopoly of the particular designer who thought proper to take it”.

(ii) The aspect of novelty and originality alone render the design entitled to protection.

(iii) “To determine the question if infringement of a registered design, the eye should be of an instructed person i.e. he should know what was common trade knowledge and usage in the class to which the design applies”.

(iv) The issue has to be decided by a “close examination and comparison of the two designs”.

(v) “It is often helpful to look at what was available before the priority date of the registered design as the eye of the interested addressee could be drawn to details, only if the registered design differs from the prior art by such details. It is only when the new design differs radically from the previous designs, that the interested person's eye would more likely concentrate on and more likely remember the general form of the new design rather than the details.”

(vi) “The Court is required to see whether the essential part or the basis of the plaintiff’s claim for novelty forms part of the alleged infringing copy”.

**148.** There is a distinction between the statutory provisions relating to infringement in the Trademarks Act and those relating to infringement in the Designs Act. Section 29 of the Trademarks Act envisages infringement with reference to the confusing and deceptive similarity between the rival trademarks. Intention to infringe is not necessary for infringement of a trademark to be said to have taken place, under Section 29 of the Trademarks Act.

**149.** As against this, Section 22 of the Designs Act does not use the word “infringement”. Significantly, it uses the word “piracy”. The distinction between these two words is important and, in my opinion, has

to be kept in mind and cannot be ignored. The provision, thereafter, proceeds to hold that piracy of a registered design takes place where the defendant's design is a fraudulent or obvious imitation of the design of the plaintiffs. Again, the use of the word "imitation" is significant, especially when juxtaposed with the word "piracy".

**150.** Piracy is a serious affair. It involves an element of conscious theft and, when used in ordinary language involves an element of loot. P Ramanatha Aiyar, in his advanced law lexicon, defines "piracy" thus:

"Piracy, Robbery, kidnapping, or other criminal violence committed at sea; a similar crime committed aboard a plane or other vehicle; hijacking, the unauthorized and illegal reproduction or distribution of materials protected by copyright, patent, or trade mark law."

**151.** Statutes relating to trademarks, designs, copyright and patents are cognate statutes. They all deal with intellectual property rights. Violation of one person's intellectual property rights by another, is actionable under each of these statutes. However, it is noticeable that the legislature has, while using the term "infringement" to denote such violation in the case of trademarks, copyright and patent, chosen, in the case of designs, to use the word "piracy". The four statutes being cognate and dealing with similar intellectual propriety rights, the decision of the legislature to use the expression "piracy" in the case of patents, instead of "infringement", has to be treated as deliberate.

**152.** Piracy, under Section 22 of the Designs Act, pre-supposes imitation. The imitation may be either obvious or fraudulent. Ruma Pal J, in *Castrol*<sup>22</sup>, quoted, with approval, the decision of Farwell J, in *Dunlop Rubber Co.*<sup>32</sup>, which distinguished between the expressions

“obvious” and “fraudulent”, apropos imitation. “Obvious imitation”, according to the said decision, would imply that, at first glance, the allegedly infringing design was unmistakably alike to the original design, with the resemblance between the two being immediately apparent, whereas “fraudulent imitation” would be said to exist where the imitation was more subtle, though it was, nonetheless, an imitation. Jessel M.R. in *Barran v. Lomas*<sup>80</sup> defined “fraudulent imitation” thus:

“A “fraudulent imitation” of a design must be something more than imitation. As I understand it, the meaning is, imitation with knowledge i.e. that the man who imitates has seen the first design. It is not unconscious imitation (which is said to be the greatest compliment, you can pay to an artist or author), but conscious imitation the man having the design before him and knowingly and wilfully imitating, and that imitation being not sufficiently original to be protected as a fair imitation.”

**153.** The word “fraudulent”, as employed in Section 22(1) does not, however, seem to be used in the manner in which, either etymologically or legally, it is ordinarily understood. The distinction between an “obvious” and a “fraudulent” imitation appears, on the basis of prior precedents including *Castrol*<sup>22</sup>, to be that the fraudulent imitation is more *consciously subtle* than the obvious imitation. As Mr Sibal, too, acknowledged, an element of *mens rea* is inbuilt in the expression “imitation”. Where the imitation stares one in the face, it would be obvious. Where it may be more subtle, but is consciously done, it would be fraudulent.

**154.** One may, in this backdrop, now approach the two main aspects on which Mr. Sibal and Mr. Lall joined issue and which, if decided, would

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<sup>80</sup> 28 WR 975

enable the Court to arrive at a *prima facie* finding for the purposes of the present application. The first aspect is whether the tests for determining whether the suit design is novel and original, *vis-à-vis* prior art, and as to whether the defendant's design infringes the suit design, are different. The second is whether the aspect of infringement has to be decided from the point of view of an average customer or purchaser of the goods or from the point of view of the instructed eye, i.e. the eye of a person who is aware of prior art.

**155.** I proceed, first, to deal with the second aspect, as it is concluded by the decision of the Division Bench of this Court in *B. Chawla*<sup>7</sup>, which binds me, no decision of any other Division Bench or of any hierarchically superior court having been brought to my notice.

**156.** Para 11 of *B. Chawla*<sup>7</sup> clearly and categorically holds that, even on the aspect of infringement, the eye through which the lens has to be trained is the instructed eye. Though Mr. Sibal tried, valiantly, to wish away the finding of the Division Bench in para 11 of the report in *B. Chawla*<sup>7</sup> by invoking the principle that the *ratio decidendi* of any case has to be understood in the light of the dispute before the Court, and sought to point that the Division Bench in *B. Chawla*<sup>7</sup> was not concerned with the aspect of infringement, the argument fails to impress. The aspect of infringement cannot be said to be foreign to the dispute in *B. Chawla*<sup>7</sup>. That apart, para 11 of *B. Chawla*<sup>7</sup> is categorical in holding that, even on the aspect of infringement, the eye has to be instructed.

**157.** One may usefully refer, in this context, to a decision of the Federal

Circuit in *Egyptian Goddess Inc. v. VSM Swisa Inc.*<sup>81</sup> which, even while holding that infringement would have to be analysed from the point of view of an ordinary observer, clarified that the ordinary observer would have to be a person who was conversant with prior art. To quote the Federal Circuit, the test to be applied was whether “a purchaser familiar with the prior art would be deceived by the similarity between the claimed and accused designs, inducing him to purchase one supposing it to be the other”.

**158.** *Diageo v. Great Galleon*<sup>4</sup> notices *B. Chawla*<sup>7</sup>. It fails, however, to take particular note of the opening sentences in para 11 of the said decision, which clearly hold that, even on the aspect of infringement, the matter has to be examined from the point of view of the instructed eye. That being so, on the aspect of infringement, it is, with respect, not possible to follow the procedure followed by the learned Coordinate Bench in holding up the bottle of the plaintiff and the bottle of the defendant in each hand and comparing the two, or even assessing whether it would be possible to differentiate between the two when viewed at a distance of six to eight yards. In either case, the Coordinate Bench has not approached the issue from the point of view of the instructed eye, but from the point of view of an uninstructed ordinary purchaser. That is contrary to the law enunciated in para 11 of *B. Chawla*<sup>7</sup> as well as the decision of the earlier coordinate bench in *Carlsberg Breweries*<sup>14</sup> and the judgement of the UK Supreme Court in *Procter & Gamble*<sup>79</sup>. *B. Chawla*<sup>7</sup> continues to remain the law on the point.

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<sup>81</sup> 543 F.3D 665 (Fed. Cir. 2008)



**159.** *On the second issue of difference between Mr. Sibal and Mr. Lall as set out in para 154 supra, therefore, my prima facie view is that the aspect of design piracy has to be examined from the point of view of the instructed eye of a person who is instructed with prior art, reasonably discriminatory and able to appreciate enough detail. The test of the average consumer, who sees the bottles on a shelf from a distance, would not be the appropriate test to apply.*

**160.** The first point of difference between Mr. Sibal and Mr. Lall, i.e. as to whether the test to be applied while examining the aspect of validity of the suit design on the point of novelty and originality *vis-à-vis* prior published designs, and the test to be applied while examining infringement, are different, is not really unconnected with the second point of difference. The familiarity, of the instructed eye, through whose iris the aspect of infringement has to be examined, with prior art, itself factors in the aspect of novelty and originality of the suit design, again *vis-à-vis* prior art. This, it appears to me, should be plain and obvious. Novelty and originality are prerequisites for registration of a design under the Designs Act. A design which is not novel or original, *vis-à-vis* prior art cannot, therefore, be entitled to registration. In order to establish its claim to registration, therefore, the suit design has to be shown as being novel and original, *vis-à-vis* prior art. Familiarity with prior art, of the instructed eye, therefore, necessarily presages familiarity of the points on which the suit design is novel and original *vis-à-vis* prior art. The aspect of novelty and originality of the suit design *vis-à-vis* prior art, therefore, becomes a relevant factor while examining the aspect of infringement of the suit design by the impugned design.

**161.** An ignorant observer, who is uninformed of the state of prior art and is merely comparing the design of the plaintiff with the product of the defendant, cannot, therefore, be the person from whose view point the aspect of infringement is examined.

**162.** This position would also seem to emerge from the judgments of the Supreme Court in *Bharat Glass Tubes*<sup>62</sup> which holds that the Designs Act protects novelty in the suit design and not the overall design as such. One may also usefully note, in this context, the observation, in the same decision, based on para 27.07 of P. Narayanan's Law of Copyrights and Industrial Designs, that a design is an idea, and it is that idea which is protected, even if the idea is one which has to be applied to an article. Where there exists prior art, the idea must necessarily be one by which attributes of novelty and originality are imparted to the suit design *vis-à-vis* such prior art. Protection of the idea, therefore, necessarily implies protection of the aspects of novelty and originality of the suit design *vis-à-vis* prior art. The opinion of Lord Shaw in *Gramophone*<sup>13</sup>, on which the decision of the coordinate bench in *Carslberg Breweries*<sup>14</sup> relies, clearly holds that “the aspect of novelty and originality ... alone render the design entitled to protection”. *Carslberg Breweries*<sup>14</sup> also relies on the decision in *Gaskell & Chambers*<sup>15</sup>, which, too, holds that the eye of the “interested assessee” would be drawn to the details in which the registered design differs from prior art. Para 183 of *Carslberg Breweries*<sup>14</sup> goes on to hold that “the Court is required to see *whether the essential part or the basis of the plaintiff's claim for novelty forms part of the alleged infringing copy*”. The same legal position is followed in *Litton*<sup>74</sup>.

**163.** *I find substance, therefore, in Mr. Lall's contention that the aspect of infringement cannot be examined de hors the aspect of novelty and originality of the suit design vis-à-vis prior art. If the aspects of novelty and originality, on the basis of which the plaintiff claims that the suit design is novel and original vis-à-vis prior art also serve to distinguish the impugned design from the suit design, the impugned design cannot, prima facie, be regarded as infringing in nature.*

**164.** One may examine the point in this aspect from another point of view. If the suit design is novel and original *vis-à-vis* prior art with respect to certain aspects, and the defendant's design is similar to prior art *in respect of those aspects*, it necessarily follows, as a logical corollary, that the impugned defendant's design is novel and original, *vis-à-vis* the suit design *qua* the said aspects. If these aspects of novelty and originality vest in the impugned design *vis-à-vis* the suit design, can it nonetheless be said that the impugned design infringes the suit design merely because, if the two products are placed on a shelf six to eight yards away, the average purchaser may not be able to distinguish the two? Accepting such a proposition would require doing away, altogether, with the "informed user" test, as also the ability of the informed user to reasonably discriminate and appreciate detail. The answer to the query would, therefore, in my respectful opinion, have to be in the negative.

**165.** It is not necessary to distinguish, in this regard, the present case from *Diageo v. Great Galleon*<sup>4</sup>, for the simple reason that the bottle of the defendant in that case was identical in design to the suit design. As

against this, in the present case, the defendant's bottle has striking features of dissimilarity *vis-à-vis* the suit design which already stand emphasized in para 125 *supra*. More importantly, these figures are, to a larger extent, the very features citing which the suit design claimed originality *vis-à-vis* prior art in the form of Design Nos D562138 and the prior art to which para 49 refers. Having, thus, claimed the said features to be points of difference *vis-à-vis* prior art, which, therefore, imparted novelty and originality to the suit design *vis-à-vis* prior art, it cannot lie in the mouth of the plaintiff to urge that these points of difference do not apply to the impugned design *vis-à-vis* the suit design.

**166.** Mr. Sibal sought to contend, in that regard, that this Court did not have with it a three dimensional reproduction of the product forming subject matter of prior art as required by Section 4(b) of the Designs Act, he submits, necessarily requires either the actual product or a three dimensional projection thereof to be available with the Court, before any comparison is made. The submission is without substance. Section 4(b) refers to prior disclosure of the design by publication in tangible form. A facial image, from which the features of the design can be usefully gleaned, is sufficient, as held in the judgement of the Full Bench in *Carlsberg Breweries*<sup>55</sup>.

**167.** Besides, even otherwise, the submission is, in the facts of the present case, not of relevance, in my opinion, for the simple reason that the points of difference cited by the plaintiff to urge that the suit design was novel and original, *vis-à-vis* prior art are on record. If those points of difference are also points on which the impugned design is different

from the suit design, therefore, the impugned design would be novel and original *vis-à-vis* the suit design. It is not necessary, therefore, for the Court to examine whether the bottle of the defendant is identical to the bottle forming subject matter of the prior art design no. D562138. Once the Court finds that the distinguishing features in the suit design *vis-à-vis* prior art, on the basis of which the suit design claims originality and novelty, are also applicable to the impugned design *vis-a-vis* the suit design, the impugned design has necessarily to be treated as novel and original *vis-à-vis* the suit design. That conclusion, if arrived at, would rule out, altogether, the allegation of piracy.

**168.** The Coordinate Bench in *Diageo v. Great Galleon*<sup>4</sup> has accepted the suit design to be novel and original *vis-à-vis* the prior art on the aforesaid aspects. The sequitur, would, therefore, be that the impugned design in the present case would also be novel and original *vis-à-vis* the suit design, for the same reasons, which already stand noted in para 125 *supra*.

**169.** Viewed from the point of view of the instructed eye, therefore, it is not possible for me to hold that, *prima facie*, the design of the bottle of the defendant was an obvious imitation or a fraudulent imitation of the suit design. If it was, then the plaintiff's bottle would also be an obvious imitation or a fraudulent imitation of prior art. The difference in tests to be applied, while examining the aspect of validity on the ground of novelty and originality, *vis-à-vis* infringement analysis, as so persuasively urged by Mr. Sibal is, therefore, actually a difference more of form than of substance.

**170.** One may look at the aspect from a more empirical and simplistic point of view as well. The suit design admittedly claims novelty and originality *vis-à-vis* Design No. D562138. If, hypothetically, another manufacturer were to manufacture a bottle with a design identical to Design No. D562138, would it be possible for the plaintiff to proceed against such manufacturer on the ground of design piracy? In my view, a paradoxical situation would result if the answer to this query were to be in the affirmative. The holder of the suit design, cannot be heard to urge, in one breath, that the suit design is novel and original *vis-à-vis* Design No. D562138 and that a bottle with a design identical to Design No. D562138 infringes the suit design, especially as the intellectual property that the Design Act protects, in either case, is the novelty and originality of the suit design.

**171.** Design piracy, under Section 22, arises only where the allegedly infringing design is an obvious or a fraudulent imitation of the suit design. This Court has seen the defendant's bottle as well as the view – albeit two dimensional – of Design no. D562138, forming prior art. The distinguishing features of the suit design *vis-à-vis* such prior art, on the basis of which the plaintiffs claimed novelty and originality of the suit design, *prima facie*, apply equally to differentiate the suit design from the impugned design. It is not possible for me, therefore, to hold, at least at a *prima facie* stage, that the defendant's design infringes the suit design.

**172.** Mr. Lall has also pointed out that, at an Order XXXIX stage, all that is required to be shown is a credible challenge by the defendant to the claim of infringement, set up by the plaintiff. On the facts of the

present case, I am convinced that such a credible challenge has been made out.

### **Conclusion**

**173.** For all the aforesaid reasons, I am of the view that the plaintiff has not been able to make out a *prima facie* case of obvious imitation or fraudulent imitation by the defendant, of the suit design by the design of the defendant's bottle, so as to justify injuncting, during the pendency of the suit, the defendant from marketing or manufacturing its product in the said bottles.

**174.** The application under Order XXXIX Rules 1 and 2 is accordingly dismissed.

**175.** Needless to say, observations in this order are only *prima facie* for the purposes of disposing of the application of the plaintiffs under Order XXXIX Rules 1 and 2 of the CPC.

**C. HARI SHANKAR, J.**

**DECEMBER 19, 2022**

*dsn/kr/rb*