

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

Reserved on: 27.05.2022

Date of decision: 05.07.2022

+ **CS(COMM) 46/2019**

PHILIPS LIGHTING HOLDING B.V.

..... Plaintiff

Through: Ms.Shwetaree Majumder,
Ms.Devyani Nath & Mr.Nitin
Mittal, Advs.

versus

JAI PRAKASH AGARWAL AND ANR. Defendants

Through: Mr.C.M. Lall, Sr. Adv. with
Mr.Partha J. Deka, Ms.Radhika
Arora, Ms.Ananya Chug &
Mr.Rishabh Srivastava, Advs.

+ **CS(COMM) 76/2019**

SIGNIFY HOLDING B.V.

..... Plaintiff

Through: Ms.Shwetaree Majumder,
Ms.Devyani Nath & Mr.Nitin
Mittal, Advs.

versus

SYSKA LED LIGHTS PVT. LTD. Defendant

Through: Mr.Shailen Bhatia, Ms.Zeba
Tarannum Khan & Mr.Raghav
Bhalla, Advs.

CORAM:

HON'BLE MR. JUSTICE NAVIN CHAWLA

I.A. 7716/2019 in CS(COMM) 46/2019

1. The present application has been filed by the plaintiff under Order VI Rule 17 of the Code of Civil Procedure, 1908 (in short, 'CPC') seeking an amendment to the cause title of the suit by substituting its name from '*Philips Lighting Holding BV*' to '*Signify Holding BV*'. The plaintiff asserts that subsequent to the filing of the present suit, on

01.02.2019, the plaintiff underwent a corporate name change from '*Philips Lighting Holding BV*' to '*Signify Holding BV*'. A declaration of the Notary Public showing an amendment to the Articles of Association of the plaintiff-company and the change of the plaintiff-company's name to '*Signify Holding BV*' has been filed along with the application.

2. The defendants oppose the present application contending therein that the plaintiff has filed the above two suits, that is, CS(COMM) 46 of 2019 and CS(COMM) 76 of 2019, in different names. Though the plaintiff-company claims to have changed its name to '*Signify Holding BV*' on 01.02.2019, but the documents filed by the plaintiff show that the resolution for the change of name of the plaintiff-company was passed in November, 2018, that is, prior to the filing of the present suit. The defendants contend that, therefore, on the date of filing of the suit, the legal entity in the name of the plaintiff did not exist and the suit has been wrongly instituted.

3. I have considered the submissions made. Along with the application, the plaintiff has filed a declaration of the Notary Public showing an amendment to the Articles of Association of the plaintiff-company and the change of name. The learned counsel for the plaintiff submits that in Netherlands, where the plaintiff-company is registered, it is only with such declaration that the change of name, in fact, becomes operational. Be that as it may, as it is only the change of name and not a case of transfer of rights and the plaintiff has derived no undue benefit by instituting this suit in its previous name, I do not see any reason not to allow the present application, the same being only formal in nature.

4. Accordingly, the application is allowed. The amended memo of parties be filed within a period of ten days from the date of this order.

I.A. 6718/2019 in CS(COMM) 76/2019

1. The present application has been filed by the defendant under Order VI Rule 17 of the CPC seeking an amendment of its written statement. By way of an amendment, the defendant primarily wants to place on record the Certificate of Registration of Design bearing no. 305185 granted in favour of M/s Shree Sant Kripa Intellectual, who is allegedly the licensor of the defendant-company, in Class 26-05 for the design of the '*LED Tube Lamp*'. The learned counsel for the defendant submits that as this design registration was granted subsequent to the filing of the written statement, the same needs to be brought on record by way of an amendment in the written statement.

2. The application is not opposed by the learned counsel for the plaintiff and in fact, submissions had been made by the learned counsel for the plaintiff relying upon the amendment sought.

3. Accordingly, the application is allowed and the amended written statement is taken on record.

I.A. 1241/2019 in CS(COMM) 46/2019 and I.A. 2159/2019 in CS(COMM) 76/2019

1. The above applications have been filed by the plaintiff under Order XXXIX Rules 1 and 2 of the CPC praying for an *ad-interim* injunction against the defendants (in both the suits), restraining them from manufacturing and selling or in any manner dealing in products

embodying the plaintiff's registered design under the registration no. 299147 or a deceptively similar variant thereto. Though in CS (COMM) 76 of 2019, a claim is also made to another registered design of the plaintiff bearing no. 247723, the present common order is being passed as, in my opinion, at least for the purpose of the present applications, the claim of the plaintiff on the design under the registration no. 299147, which is claimed to have been infringed by the defendants in both the suits, would require to be considered in a holistic manner rather than separately. This is primarily as one of the common defences raised by the defendants (in both the suits) is that the design has been wrongly registered in favour of the plaintiff and is liable to be cancelled for the same having been previously registered in India as also published in India.

2. The plaintiff claims itself to be the leading manufacturer and seller of high quality and energy-efficient lighting products, systems and services, such as home lighting, stage lighting, studio lighting, location lighting, landscape lighting, display lighting, smart lighting as also their controls, distribution and power sources. It claims to have developed several innovative lighting products keeping technologies of Light Emitting Diodes (in short, 'LED') at the forefront. It claims to be continuously investing in the research and development as well as the advertisement and promotions of its products, details whereof it gives as under:-

Year	Annual Sales	Research and Development	Advertisement and Promotional
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		Expenses	Expenses
	(In millions of EUR)		
2016	7,115	353	170
2017	6,965	354	172

3. For India, it gives the total sales figures of its Indian subsidiary as under:-

Financial Year	Total Income (INR in million)
2016-17	33,386
2017-18	35,310

DESIGN REGISTRATION NO. 299147

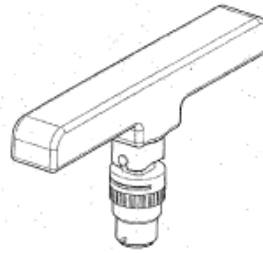
4. As noted hereinabove, the present two suits are filed by the plaintiff (in both the suits) (hereinafter referred to as the ‘plaintiff’) *inter-alia* claiming rights in the design of what it refers to as a ‘*T-Shaped LED Bulb*’ (hereinafter referred to as a ‘T-Bulb’) registered under the design registration no. 299147 on 06.11.2017 with a reciprocity date of 08.05.2017 in Class 26-04. The Certificate of Registration of Design is reproduced hereinunder:-

		ORIGINAL
		No 61789
भारत सरकार GOVERNMENT OF INDIA पेटेंट कार्यालय THE PATENT OFFICE		
CERTIFICATE OF REGISTRATION OF DESIGN		
Design No.	299147	
Date	06/11/2017	
Reciprocity Date*	08/05/2017	
Country	EUIPO	
Certified that the design of which a copy is annexed hereto has been registered as of the number and date given above in class 26-84 in respect of the application of such design to LAMP in the name of PHILIPS LIGHTING HOLDING B.V., HIGH TECH CAMPUS 45, 5656 AE EINDHOVEN, THE NETHERLANDS		
In pursuance of and subject to the provisions of the Design Act, 2000 and the Design Rules, 2001.		
 Controller General of Patents, Designs and Trade Marks		
*The reciprocity date (if any) which has been allowed and the name of the country. Copyright in the design will subsist for ten years from the date of Registration, and may under the terms of the Act and Rules, be extended for a further period of five years. This Certificate is not for use in legal proceedings or for obtaining registration abroad		
M. BASE, CANTWELL & CO., 28 EZRA MANSIONS, KOLKATA 700069		
Date of Issue 28/01/2018 16:25:03		

नस्यमेव जयते

NAME OF THE APPLICANT:
Philips Lighting Holding B.V.

NO. OF SHEETS: 2
SHEET NO.: 1



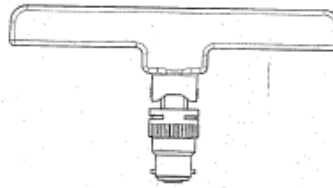
PERSPECTIVE VIEW



RIGHT SIDE VIEW



LEFT SIDE VIEW



FRONT VIEW

The novelty resides in the shape and configuration of the LAMP, as illustrated.

No claim is made by virtue of this registration in respect of any mechanical or other action of mechanism whatever or in respect of any mode or principle of construction of the article.

Dated this 05th day of NOVEMBER 2017

Philips Lighting Holding B.V.
By their agent & attorney

M. JORDAN
(M. BASU)
OF CANTRELL & CO.

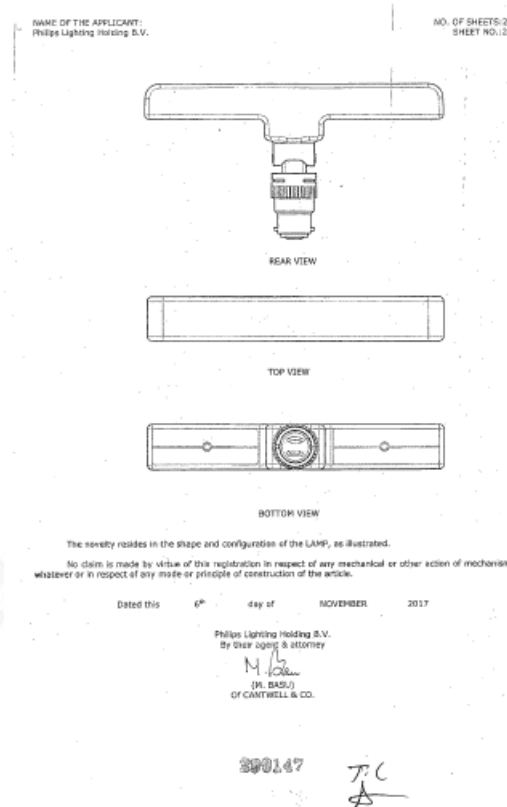
299147

05 NOV 2017

F.A.



सत्यमेव जयते



4.1. At this stage itself, I may note that in paragraph 15 of the plaint, the plaintiff claimed priority of its registration from the EUIPO registration dated 08.05.2015. The same is admittedly incorrect as is evident from the Certificate of Registration of Design reproduced hereinabove, and the correct date of priority should have been 08.05.2017. The defendants contend that the wrong date was given in the plaint with a *mala fide* intent. I shall be dealing with this submission in detail in the later part of this judgment.

ARGUMENTS ON BEHALF OF THE PLAINTIFF (IN BOTH THE SUITS)

5. The learned counsel for the plaintiff submits that the novelty in the above design resides in its unique ‘T-Shape’ and ‘Plug-and-Play’ format. She submits that in the lighting industry, bulbs are always understood to

have been round in shape. However, the same was often not enough to brighten a room. Similarly, a tube light was understood to be having a base attached to the wall with a holder on the side, which was not often convenient to install. The plaintiff, therefore, came out with this novel design, which is not only easy to install but also gives greater light as there are no holders on the side. The rotational mechanism of the T-Bulb also makes it convenient to focus the light.

5.1. The learned counsel for the plaintiff further submits that the right of the plaintiff in the aforementioned design is also recognized by the industry as the plaintiff is the Original Equipment Manufacturer (in short, 'OEM') for several lighting companies in India such as Eveready Industries India Ltd. and Havells India Limited, to name a few, which procure the plaintiff's T-Bulb and sell the product under their own brand name subject to the payment of a license fee and/or other valuable consideration under the terms of their respective contracts.

5.2. Referring to the products of the defendants (in both the suits), she submits that the same are infringing copies of the plaintiff's registered design and ought to be enjoined. She refers to a '*Comparative Report*' dated November 2018 (in CS(COMM) 46 of 2019) and a '*Benchmark Report*' dated 08.01.2019 (in CS(COMM) 76 of 2019) to highlight that the products of the defendants (in both the suits) are identical to that of the plaintiff's. The photographs of the plaintiff's and both the defendants' products as also the original products were produced for the scrutiny of the Court. The photographs of the plaintiff's and the defendants' products, in CS(COMM) 46 of 2019 are as under:-

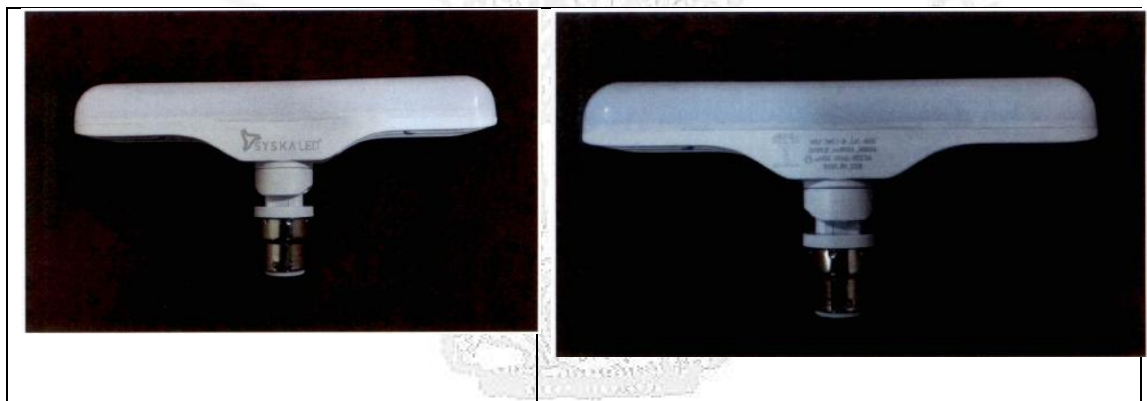
<u>Photographs of the Plaintiff's Product</u>	<u>Photographs of the Defendants' Product</u>
	
	

5.3. She highlights the similarity of the design of the two products, in CS(COMM) 46 of 2019, as under:-

- a. The impugned product has the same overall shape, that is, a T-Shaped bulb formed horizontally by an elongated rectangular light diffuser and vertically by a smaller plastic rectangular and round element;

- b. The dimensions of the elongated diffuser of the bulb as well as the smaller rectangular bottom which connects the diffuser to the pivot and the socket are identical to the plaintiff's product;
- c. The diffusers in both have grooves on the base; and
- d. The defendants' product also has the same swivel and twist mechanism supported by a pivot right above the socket to allow adjusting the light coverage.

5.4. In CS(COMM) 76/2019, the defendant's product is pictorially represented as under:-



5.5. The learned counsel for the plaintiff submits that the products of the plaintiff and the defendant, in CS(COMM) 76 of 2019, are identical in the following aspects:-

- a. The '*SYSKA Lumispread LED Bulb*' has the same overall shape, that is, a T-Shaped bulb formed horizontally by an elongated rectangular light diffuser and vertically by a smaller plastic rectangular and round element;

- b. The diffusers in both have grooves on the base; and
- c. The defendant's product also has the same swivel and twist mechanism supported by a pivot right above the socket to allow adjusting the light coverage.

6. The learned counsel for the plaintiff further submits that the defendants (in both the suits) are also guilty of passing off their impugned products as that of the plaintiff's on account of a deceptively similar look, feel and trade dress of both the products. In support of the reputation of the plaintiff's product, she places reliance on the affidavits of the plaintiff's distributors filed along with the plaint, as also certain articles written about the plaintiff's T-Bulb.

7. The learned counsel for the plaintiff places reliance on the judgments of this Court in ***J.N. Electricals (India) v. President Electricals***, MANU/DE/0172/1979 and ***Dabur India Ltd. v. Amit Jain and Ors.***, 2009 (39) PTC 104 (Del) (DB), to submit that the test to be applied in cases of design infringement is of judging solely by the 'eye'. All that is required to be seen in action of design infringement is the 'sameness' of the features of shape, configuration or pattern and it is not necessary that the two designs must be identical on all points and should differ on none. A fraudulent imitation is one which is deliberately based upon the registered design, though it may be different in some aspects from the original.

7.1. She places reliance on the judgments of this Court in ***Dart Industries Inc and Ors. v. Polyset Plastics Pvt. Ltd. and Ors.***, 2018 (75)

PTC 495 (Del) and ***Apollo Tyres Ltd. v. Pioneer Trading Corporation and Ors.***, 2017 (72) PTC 253 (Del), to submit that because the product of the plaintiff is also functional, inasmuch as it provides better lighting and easier installation, it cannot be said that its design is not worthy of protection. In such cases, the test to be applied is whether a particular function can be achieved through a number of different forms. In the present case, the function sought to be achieved by the plaintiff's products can be achieved in a different manner and, therefore, its unique design is entitled to protection.

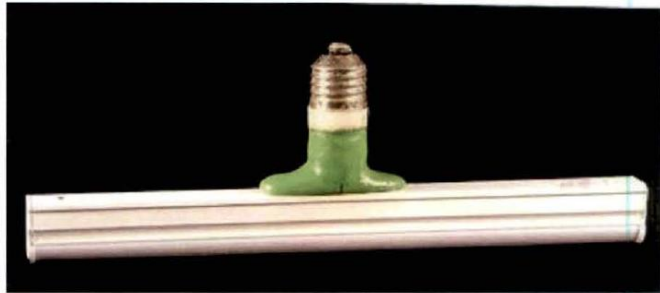
8. On the claim of passing off, the learned counsel for the plaintiff places reliance on the judgment of the Full Bench of this Court in ***Carlsberg Breweries A/S. v. Som Distilleries and Breweries Ltd.***, 2019 (77) PTC 1 (Del) and of the Division Bench of this Court in ***Crocs Inc. USA v. Bata India and Ors.***, 2019 (79) PTC 75 (Del), to submit that claim of passing off in a design is also maintainable.

ARGUMENTS ON BEHALF OF THE DEFENDANTS IN CS(COMM) 46 OF 2019

9. The learned senior counsel for the defendants submits that as the plaintiff is claiming passing off in the design itself, the design registration is liable to be cancelled. He submits that by its very definition, a 'design' does not include any trade mark. The moment the plaintiff claims a right in a design as a trade mark, the same is liable to be cancelled. Referring to the judgment of the Full Bench of this Court in ***Carlsberg Breweries A/S.*** (*supra*), he submits that the Full Bench of this Court merely recognized that there can be an action of passing off maintained where

the plaintiff bases its claim not only on the elements of its design, but on a larger trade dress or get up, the presentation to its product through its packaging and so on. In the present case, as the passing off action is based only on the elements of design, the design itself is liable to be cancelled and no relief can be granted to the plaintiff.

9.1. He further submits that the design registration of the plaintiff is also liable to be cancelled in terms of Section 19(1)(a) and 19(1)(b) of the Designs Act, 2000 (in short, 'the Act') for the same having been previously registered in India and having been published in India or in any other country prior to the date of registration. In this regard, he draws the attention of this Court to the design registration no. 280993 dated 29.02.2016 in Class 26-04 and the design registration no. 280699 dated 22.02.2016 in Class 26-05, both in favour of Thaikattil Jose. The same are reproduced hereinunder for sake of easier reference:-

DESIGN NUMBER	280993	
CLASS	26-05	
1)THAIKATTIL JO SE, THAIKATTIL HOUSE, HIGH LAND STREET, OLLUKARA P.O., THRISSUR, KERALA STATE, 680655, INDIA, AN INDIAN NATIONAL		
DATE OF REGISTRATION	29/02/2016	
TITLE	LINEAR ELECTRIC LAMP	
PRIORITY NA		

DESIGN NUMBER	280699
CLASS	26-05
1)THAIKATTIL JOSE, THAIKATTIL HOUSE, HIGH LAND STREET, OLLUKARA P.O., THRISSUR, KERALA STATE, 680655, INDIA, AN INDIAN NATIONAL	
DATE OF REGISTRATION	22/02/2016
TITLE	ELECTRIC LAMP
PRIORITY NA	


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9.2. The learned senior counsel for the defendants submits that not only are the products of the plaintiff and the above-referred registered designs, in favour of Thaikattil Jose, common but also are for the same product. He submits that as these registrations predate that of the plaintiff, therefore, the design registration of the plaintiff is liable to be cancelled.

9.3. The learned senior counsel for the defendants further submits that to get over this legal hurdle, the plaintiff, in paragraph 15 of the plaint, has falsely claimed the reciprocity date of its registration as 08.05.2015. This misstatement was not *bona fide* but was intentionally made in order to mislead this Court and to create a false defence against the cancellation of the plaintiff's design registration. He submits that this itself is sufficient to disentitle the plaintiff to any interim relief.

9.4. Though the defendant has also referred to a design registration in the name of Jadhav Powertech under registration no. 280438 under Class 26-05, the learned senior counsel for the defendant does not lay emphasis on the same for the purposes of the present application as the document produced is not a clear copy and the complete design cannot be made out therefrom.

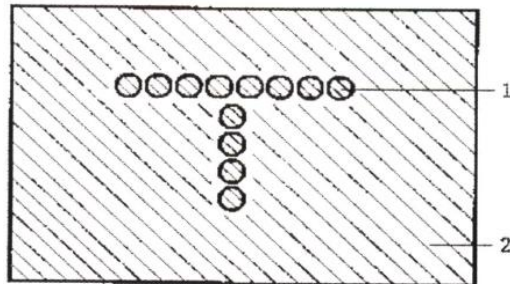
10. The learned senior counsel for the defendants further submits that the plaintiff has also concealed from this Court correspondence that was exchanged between the parties prior to filing of the present suit. He submits that the said correspondence clearly shows that the claim of the plaintiff was only monetary, which is a relevant consideration at least as far as the present interim application is concerned. He submits that the said correspondence was intentionally not disclosed to this Court in order to obtain a favourable order of injunction behind the back of the defendants. He submits that for such concealment alone, the plaintiff is not entitled to any interim injunction.

11. Referring to the judgment of this Court dated 24.02.2014 in I.A. Nos.19671 of 2013 & 596 of 2014 in CS(OS) 2407 of 2013 titled ***Steelbird Hi-Tech India Ltd. v. S.P.S. Gambhir & Ors***, he submits that the design of the plaintiff is even otherwise only a trade variant with an LED tube light and the holder being common to trade. For the plaintiff to claim its right in the design as being ‘new’ or ‘original’, the plaintiff must show that it introduced some substantial change to the already-known design. He submits that the plaintiff has miserably failed to meet the above test and, therefore, is not entitled to any relief.

ARGUMENTS ON BEHALF OF THE DEFENDANT IN CS(COMM) 76 OF 2019

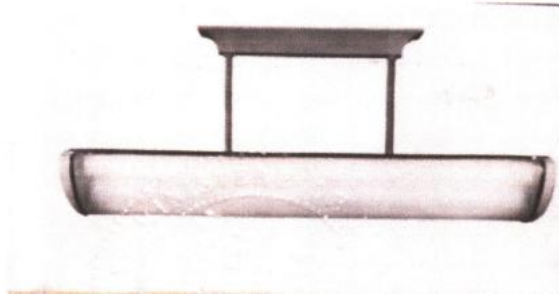
12. The learned counsel for the defendant in CS(COMM) 76 of 2019, apart from adopting the arguments of the learned senior counsel for the defendants in CS(COMM) 46 of 2019, places reliance on a patent bearing no. CN20102107858U20100119 filed on 24.11.2010 in China for a bulb

(though to be fitted in an automobile) with the following shape and abstracts thereof as under:-

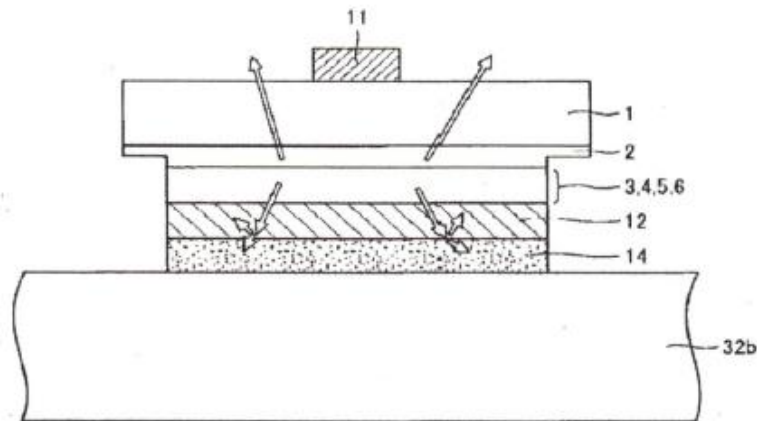


“The existing vehicle brake lamps are round lamps which are easy to be omitted when drivers of other vehicles do not focus on the frontal vehicle, and cannot be distinguished by colour blind passerby particularly. The utility model provides a T-shaped vehicle brake lamp which comprises a plurality of LED bulbs and a lamp holder. The T-shaped vehicle brake lamp is characterized in that a plurality of LED bulb are arranged in a T-shape and are fixed on the lamp holder. The T-shaped vehicle brake lamp has the following advantages: the T-shape has a well-known significance of stopping; when the T-shaped vehicle brake lamp is turned on, the drivers and the passerby can visually know the stopping significances, thus carrying out the reflection quickly.”

12.1. He further refers to a design registration filed by CIEDESLAMPES S.A. for a T-Shape tube in 1957, which he claims constitutes a prior publication. The same is reproduced hereinbelow:-



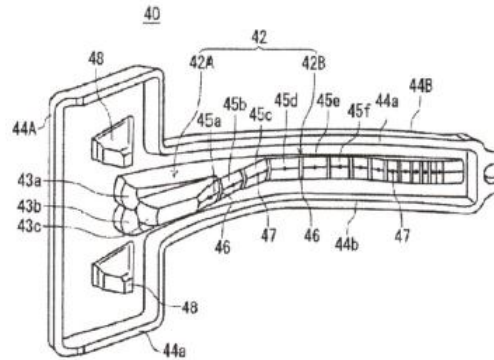
12.2. He also places reliance on the U.S. Patent No.US2005/0121688A1 filed by M/s Sumitomo Electric Industries Limited in 2005 for the following shape, drawing attention to the portion marked as figure 11. The relevant depiction and description of figure 11 are reproduced hereinbelow-



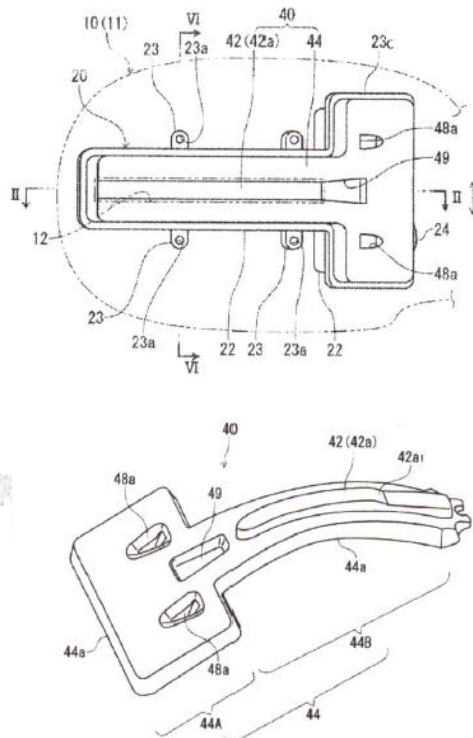
“FIG. 11 is view illustrating the relation between the applied current and the light output, according to the first embodiment;”

12.3. He further draws the attention of the Court to patent application no.US 8,303,146 B2/ a T-Shaped bulb for a vehicle light with the following description:-

"As shown in FIG.1, the side turn signal lamp 20 is configured like a T-shape as a whole in a front view, and is longer in the lateral direction than in a height direction."



Another sight turn signal lamps and US Patent No. US 8,303,146B2 is as under (T-shape).



12.4. The learned counsel for the defendant submits that there are various other brands of T-Shaped bulbs/tube lights in the market and, therefore, the plaintiff cannot claim any exclusivity in their design.

12.5. He further submits that, even otherwise, the design of the plaintiff's and the defendant's products is different inasmuch as the defendant's product is cylindrical in appearance; the moving mechanism is also different, thereby giving a different feel and get up to the defendant's product when compared to the plaintiff's product. He submits that, therefore, the two products are not identical and there is no infringement of the design of the plaintiff by the defendant.

13. The learned counsel for the defendant submits that as far as the claim of passing off is concerned, apart from design itself, the plaintiff has not asserted any other ingredient required to maintain a claim of passing off. He submits that, therefore, the said claim is liable to be rejected.

REJOINDER ARGUMENTS

14. In rejoinder, the learned counsel for the plaintiff submits that the defendants (in both the suits), apart from placing the documents of prior design registration and patents granted, have not produced the products bearing such design or patent registrations. She submits that for challenging the registration of the plaintiff, it was incumbent upon the defendants to show prior '*publication*', which necessarily would mean a prior product in the market or the industry bearing a similar design. She submits that even otherwise, the articles for which the design registrations have been earlier obtained and/or the patent granted are different from that of the plaintiff and, therefore, are not relevant to the present suit. She submits that as far as design registrations are concerned, they are in Class 26-05, which is for '*lamps, standard lamps, chandeliers,*

wall and ceiling fixtures, lampshades, reflectors, photographic and cinematographic projector lamps’, whereas the plaintiff’s registration is in Class 26-04, which is for ‘*including bulbs for electric lamps, luminous plaques and tubes, and candles.*’ With respect to the patents, the same are for tubes and vehicles and not LED Tubes and in any case, are not sufficiently depicting the actual design. She places reliance on the judgment of the Supreme Court in ***Bharat Glass Tube Ltd. v. Gopal Glass Works Ltd.***, (2008) 10 SCC 657 and of the Full Bench of this Court in ***Reckitt Benkiser India Ltd. v. Wyeth Ltd.***, 2013 SCC OnLine Del 1096 to submit that these do not constitute ‘*publication*’.

14.1. She submits that in any case, the defendant in CS (COMM) 76 of 2019, having itself obtained a registration for similar design, though at a later stage and date, is estopped from challenging the novelty in the design. In support, she places reliance on the judgment of this Court in ***Pentel Kabushiki Kaisha & Anr. v. M/s Arora Stationers & Ors.***, 2018 SCC OnLine Del 6512 and ***Vega Auto Accessories (P) Ltd v. S.K. Jain Bros Helmet (I) Pvt. Ltd.***, (2018) 75 PTC 59 (Del). She submits that the defendant-company and M/s Shree Sant Kripa Intellectual are under the same management and, therefore, are estopped from challenging the validity of registration of design granted in favour of the plaintiff.

15. As far as allegations of suppression and misstatement are concerned, she submits that the correspondence exchanged between the plaintiff and the defendants in CS (COMM) 46 of 2019 was not relevant and, in fact, would only come to the support of the claim of the plaintiff, inasmuch as, the defendants till then were recognizing the rights of the

plaintiff in the design and were negotiating for the license fee payable for use of the same. On the claim of misstatement, she submits that the reciprocity date was a typographical error; the documents of registration were itself filed with the plaint, which evidences the correct date of priority of plaintiff's registration. She submits that therefore, no *malafide* can be attributed to the plaintiff for such *bona fide* typographical mistake.

FINDINGS OF THIS COURT

16. I have considered the submissions made by the learned counsels for the parties.

16.1. At the outset, reference is to be made to certain provisions of the Act. Section 2(d) of the Act, defines the term '*design*', and is reproduced hereinunder:-

“(d) “design” means 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; but does not include any mode or principle of construction or anything which is in substance a mere mechanical device, and does not include any trade mark as defined in clause (v) of sub-section (1) of section 2 of the Trade and Merchandise Marks Act, 1958 (43 of 1958) or property mark as defined in section 479 of the Indian Penal Code (45 of 1860) or any artistic work as defined in clause (c) of section 2 of the Copyright Act, 1957 (14 of 1957).”

16.2. ‘Article’ is defined in Section 2(a) of the Act, as under:-

“(a) “article” means any article of manufacture and any substance, artificial, or partly artificial and partly natural; and includes any part of an article capable of being made and sold separately;”

16.3. Section 4 of the Act provides for what cannot be registered as a ‘design’, and reads as under:-

“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.”

16.4. Section 2(g) of the Act states that the term ‘original’, in relation to design, means originating from the author of such design and includes the cases which though old in themselves yet are new in their application.

16.5. Section 6 of the Act states that a ‘design’ may be registered in respect of any or all of the articles comprised in a prescribed class of articles. It further provides that where a design is registered in respect of any article comprised in a class of article, the application of the proprietor of the design to register it in respect of some one or more other articles

comprised in that class of articles cannot be refused or invalidated on the ground of the design not being new or original for reason of it being so previously registered, or on the ground of it having been previously published in India only for the reason that it has been applied to articles in respect of which it has been previously registered. Sub-Section (1) and (3) of Section 6 of the Act are relevant to the decision on the present applications, and are reproduced hereinbelow:-

“6. Registration to be in respect of particular article. - (1) A design may be registered in respect of any or all of the articles comprised in a prescribed class of articles.

xxxxx

(3) Where a design has been registered in respect of any article comprised in a class of article, the application of the proprietor of the design to register it in respect of some one or more other articles comprised in that class of articles shall not be refused, nor shall the registration thereof invalidated-

(a) on the ground of the design not being a new or original design, by reason only that it was so previously registered; or

(b) on the ground of the design having been previously published in India or in any other country, by reason only that it has been applied to article in respect of which it was previously registered:

Provided that such subsequent registration shall not extend the period of copyright in the design beyond that arising from previous registration.”

16.6. Section 19 of the Act gives the grounds for the cancellation of the registration of a design, including on the ground that the design has been

previously registered in India or has been previously published in India or in any country prior to the date of registration. Section 19 of the Act is reproduced hereinunder:-

“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:—

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

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

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

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

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

(2) An appeal shall lie from any order of the Controller under this section to the High Court, and the Controller may at any time refer any such petition to the High Court, and the High Court shall decide any petition so referred.”

16.7. Section 22 of the Act grants protection to the registered design against piracy thereof. Sub-Section (3) of Section 22 of the Act states that in any suit or any other proceeding for relief against piracy of the registered design, every ground on which the registration of a design may be cancelled under Section 19 of the Act shall be available as a ground of defence. Section 22 of the Act is reproduced hereinunder:-

“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 license 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.

(2) If any person acts in contravention of this section, he shall be liable for every contravention—

(a) to pay to the registered proprietor of the design a sum not exceeding twenty-five thousand rupees recoverable as a contract debt, or

(b) if the proprietor elects to bring a suit for the recovery of damages for any such contravention, and for an injunction against the repetition thereof, to pay such damages as may be awarded and to be restrained by injunction accordingly:

Provided that the total sum recoverable in respect of any one design under clause (a) shall not exceed fifty thousand rupees:

Provided further that no suit or any other proceeding for relief under this sub-section shall be instituted in any court below the court of District Judge.

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

(4) Notwithstanding anything contained in the second proviso to sub-section (2), where any ground on which the registration of a design may be cancelled under section 19 has been availed of as a ground of defence under sub-section (3) in any suit or other proceeding for relief under sub-section (2), the suit or such other proceedings shall be transferred by the Court, in which the suit or such other proceeding is pending, to the High Court for decision.

(5) When the court makes a decree in a suit under sub-section (2), it shall send a copy of the decree to the Controller, who shall cause an entry thereof to be made in the register of designs.”

16.8. A reading of the above provisions shows that a ‘design’, refers only to the features of shape, configuration, pattern, ornament or composition of line and colours applied to any article whether in two dimensional or three dimensional or in both forms, which in the finished article ‘*appeal to and are judged solely by the eye*’. It has to be ‘new’ or ‘original’. If the design has been previously registered in India or has been published in India or in any other country prior to the date of its registration, such registration itself is liable to be cancelled and can be assailed even as a defence to the suit alleging piracy of such registered design.

17. In ***J.N. Electricals (India)*** (*supra*), a Division Bench of this Court held that in judging the claim of piracy of a registered design, the test to be applied is of ‘*sameness*’ of the features of shape, configuration or pattern. The ‘*sameness*’ of features does not necessarily mean that the two designs must be identical on all points and should differ on none. They have to be substantially the same. The said judgment made a reference to an earlier judgment of the High Court of Calcutta in ***Western Engineering Co. v. Paul Engineering Co.***, AIR 1968 Cal 109, wherein it was held that one of the practical tests to find out the identity or the sameness of the design is to find out whether there are substantial differences between the design subsequently registered and the design which was earlier registered. These differences cannot be based on purely subjective or utilitarian or aesthetic considerations, but the differences must be objective in its essential features. A general view of the features of both the designs should be looked into to find out if the one design is as good as the other and the conclusion is to be arrived at by visual examination of the two products. Similarity of device in external appearance must be a relative feature in considering the substantial difference between the two but is certainly not a determining factor.

18. In ***Dabur India Ltd. v. Amit Jain*** (*supra*), a Division Bench of this Court held that ‘*imitation*’ does mean ‘*duplication*’ in the sense that the copy complained of need not be an exact replica. The Court must address its mind as to whether the design adopted by the defendants was substantially different from the design which was registered. If the Court is able to find that there is substantial and sufficient resemblance between

the alleged infringed design, an injunction should follow. It further explained that '*fraudulent imitation*' is an imitation which is based upon and deliberately based upon the registered design, though which may be less apparent than an obvious imitation. There would be 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, would be an imitation when two designs are closely scanned.

19. In ***Dart Industries Inc. and Ors.*** (*supra*), a Co-ordinate Bench of this Court held that use of a design not substantially different from the registered designs would also amount to infringement. Designs must be protected against imitations since the statutory right of exclusive use is granted only for a limited period of time and that damages can never be an adequate compensation to the plaintiffs if they are deprived of their statutory right of commercial exploitation. To test as to whether a design is merely functional or not is by asking a question whether there is no other shape or configuration available in which the product can discharge the desired function. If the answer is in the negative, the registered design is entitled to protection. The onus of proving that the registered design is not new or original and not entitled to protection is always on the defendants.

19.1. Keeping in the view the above test, the designs of the T-Bulb of the plaintiff and those of the defendants can easily be said to be similar, if not identical. In fact, the learned senior counsel for the defendants in CS(COMM) 46 of 2019 did not make any serious efforts to distinguish the two. In the order passed by this Court dated 11.02.2019 in CS

(COMM) 46 of 2019, the following submission of the learned senior counsel for the defendants was recorded:-

“3.Learned senior counsel for the defendant submits that Mr. Kapil Tyagi, designer of the defendant company is present in Court and he saw these designs in a fair in China in 2016 and he designed this product in 2018 after examining the similar products including that of the plaintiff.....”

(Emphasis Supplied)

19.2. Therefore, at least at this stage, it cannot be said that the article of the defendant in CS(COMM) 46 of 2019 is not similar to that of the plaintiff.

20. The submission of the learned counsel for the defendant in CS(COMM) 76 of 2019 highlighting the alleged differences in the two designs, also *prima facie* has no merit. The alleged differences are merely superficial in nature. Once judged solely by the eye, the two products, that is, one of the plaintiff's and the other of the defendant, are similar if not identical. The difference of cylindrical shape of tube and/or of the joint to the holder, are hardly sufficient to distinguish the design of the two products.

21. The submission of the learned counsels for the defendants that the plaintiff is not entitled to protection of its design as it has itself claimed such design to be functional, is *prima facie* incorrect. Though the plaintiff has highlighted certain functional aspects and benefits of its products, at least *prima facie*, it has not been shown by the defendants that the shape and design adopted by the plaintiff is the only shape or design by which

the desired functionality could be achieved. In view of the judgments of this court in **Dart Industries Inc** (*supra*) and **Apollo Tyres Ltd.**(*supra*), I therefore, *prima facie* find no merit in the submission of the defendants in this regard.

22. Having said the above, the question arises as to whether the defendants have been able to make out at least a *prima facie* defence of the registration of the design in favour of the plaintiff to be cancelled under Section 19 of the Act. In this regard, it is first to be seen that the date of priority of registration assigned to the plaintiff's design is admittedly 08.05.2017. Though, much has been said about plaintiff's averments in paragraph 15 of the plaint of claiming such priority with effect from 08.05.2015, it *prima facie* appears to be a mere typographical error in the plaint and is not found sufficient to disentitle the plaintiff to *ad-interim* protection, if the plaintiff is otherwise entitled.

22.1. With the priority date of 08.05.2017, the question that then is to be considered is as to whether the defendants have been *prima facie* able to show a similar previously-registered design in India or a similar design having been published in India or in any other country prior to this date. In my opinion, the defendants have, at least *prima facie*, been able to show the same. The designs registered in favour of Thaikattil Jose dated 22.02.2016 and 29.02.2016, reference whereof has been made herein before, are prior to the registration of the plaintiff's design of the T-Bulb.

22.2. The learned counsel for the plaintiff contended that the two aforementioned designs are dissimilar to that of the plaintiff's design. In this regard, she also drew my attention to a table forming part of the

replication filed by the plaintiff in CS(COMM) 46 of 2019, highlighting such distinction. The same is reproduced hereinbelow:-

Features	Thaikattil Jose's design under no. 280993	Thaikattil Jose's design under no. 280699	Jadhav Powertech's design under no. 280438	Plaintiff's design under no. 299147
Class and description of article	26-05 Linear electric lamp	26-05 Electric lamp	26-05 Tube light holder	26-04 Lamp
Product	A tube light	A tube light	Tube light holder	LED bulb
Rotational mechanism	No	No	No	Yes
Colour of the base	Green	Red	Not visible	Silver or White or Gold
Visual aspect of base	Looks like a plastic bulky pedestal	Looks like a plastic bulky pedestal	Not visible	Sleekly integrated on the head
Color of the head (lighting part)	White	White	White and translucent white	Translucent white
Contains a holder	Yes, it encases the tubelight	Yes, it encases the tubelight	Yes, it encases the tubelight	No. The light itself is fixed on the base giving maximum coverage
Visual aspect of light	The light is emitted through the top and the length of the tube, with the	The light is emitted through the top and the length of the tube, with the	The light is emitted through the top and the length of the tube, with the	The light is emitted evenly on all sides - the absence of a holder and the square

	holder blocking the long sides partially and the short sides entirely	holder blocking the long sides partially and the short sides entirely	holder blocking the long sides partially and the short sides entirely	edges ensure maximum light dispersal
Shape of the edges	Rounded as in a normal tubelight	Rounded as in a normal tubelight	Rounded as in a normal tubelight	Square, unlike in tubelights
Dimension	Unknown	Unknown	30 cm x 7.62 cm x 5.08 cm	20 cm x 11 cm x 3 cm
Wattage	Unknown	Unknown	18 W	10 W

22.3. In my view, however, the above distinctions are not substantial enough to hold that the plaintiff's design is 'new' or 'original'. A Co-ordinate Bench of this Court in its judgment in **Steelbird Hi-Tech India Ltd.** (*supra*), considered the test to be adopted by the Court while judging whether the design claimed by the plaintiff is new or original or a trade variant to an old design. This Court held as under:-

*"16. It was expressed by Buckley L.J. on the question of quantum of novelty in **Simmons v. Mathieson & Cold**, (1911) 28 R.P.C. 486 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."

*17. In **Phillips v. Barbro Rubber Company** (1920) 37 R.P.C. 233, Lord Moulton observed that while*

question of the meaning of design and of the fact of its infringement are matters to be judged 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. 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, any man does not make a new and original designs 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 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 as "new and original design" unless it is distinguished from that 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 tender 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.

18. The question before me for consideration is whether the plaintiffs' design when registered on 1st December, 2011 was new or original or different from what has been done before. As per certificate of registration produced along with plaint, the same does not show any light except the novelty is claimed in all views for the whole shape, configuration and surface pattern of the Helmet. 'Original' means that the design originating from the author.

19. Drawing a distinction between 'new' and 'original' Buckley L.J. said in **Dover Ltd. vs. Nurnberger Celluloidwaren Fabric Gehruder Wolff**, (27 R.P.C. 498) that 'new' is referred to a case where the shape or pattern was wholly new in itself and on the other hand 'original' to the case where it was old but new in its application to the particular subject matter. The word 'original', according to the learned Judge "contemplates that the person has originated something, that by the exercise of intellectual activity he has started an idea which had not occurred to anyone before, that a particular pattern or shape or ornament may be rendered applicable to the particular article to which he suggests that it shall be applied".

20. 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.

21. It was laid down by Lord Moulton in **Phillips v. Harbro Rubber Company** (37 R.P.C. 233) that it is the duty of the Court to take special cast that no design shall be counted new or original unless it is distinct from what previously existed by something essentially new or original which is different from ordinary trade variants which may have long been common matters of taste or choice in the trade. It is well established that a registration cannot be deemed effective unless the design or configuration sought to be protected is new or original and not of a pre-existing common type. (**Ram Sahai v. Angnoo**, Air 1922 All. 496, **Bahkhshiv. Ghulam Mohammad**, Air 1934 Lahore 709 and **The Pilot Pen Co. (India) Private Ltd., Madras v. The Gujarat Industries Private Ltd.**, AIR1967 Madras 215). Vide In the matter of Wingate's Registered Design No. 768.611 (52 R.P.C. 126) it was observed that what a substantial difference is, is a question upon which no general principle can be laid down at all; it must depend on the particular facts in each case. In one case a quite small variation in the details of a design may be enough to make the design something quite different from an existing design. On the other hand, there are cases even where quite large alterations in detail leave two designs for all practical purposes the same. The Court has to consider and look at the design in question with an instructed eye and say whether there is or is not such a substantial difference between that which had been published previously and the registered design as to entitle the proprietor of the registered design to say that at the date of registration that was a new or original design and therefore properly registered.

22. Thus, the design must be held to be valid if the statement of novelty is correctly construed in the narrow sense. However, in other type of cases like the case reported in **Neggretti and Zambra v. W. F. Stanley & Co., Ltd.** (42 R.P.C. 358), the case

was concerned with the design of a thermometer. The Court deciding the action noticed the plaintiffs had produced a useful article of commerce for a particular purpose, which, from its smallness and neatness, was readily distinguishable from the larger thermometers which had gone before; but that was found to be wholly immaterial. "The fact that the plaintiffs have hit upon a useful shaped and useful sized thermometer for the particular purpose in hand", it was found that there is no reason in law why the defendants should not even copy such features of that Design which 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."

22.4. Therefore, the test to determine if the design is ‘new’ or ‘original’ *inter-alia* is to determine and exclude ordinary trade variants into an old design. A design identical with or even materially similar to the relevant design should not been published or registered previously. A slight trivial or infinitesimal variation from the pre-existing design shall disqualify the relevant design for registration. The change introduced should be substantial. 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 is also protected. Mere trade variants of what is already in existence or what is common to the trade is not capable of being registered.

22.5. Applying the above test to the facts of the present case, it *prima facie* appears that the design of the plaintiff is merely a trade variant of an already-existing registered design(s) cited by the defendant in CS(COMM) 46 of 2019 and as referred hereinabove. The earlier

registered designs are of a tube light on a holder. Though the plaintiff calls its lighting source as a bulb, it is shaped like a small tube light. The learned counsel for the defendant in CS(COMM) 76 of 2019 had asserted that such tube lights are common in trade. The so-called bulb of the plaintiff is attached to a holder by a '*swill mechanism*', which even according to the plaintiff's own case is more functional in nature. Therefore, *prima facie* it appears that the plaintiff's registered design is a trade variant of an already existing registered design and was not capable of being registered.

23. The submission of the learned counsel for the plaintiff that the registered designs cited by the defendants are for Class 26-05 whereas the plaintiff's design is registered in Class 26-04 and therefore, not relevant, and cannot be accepted. Class 26 is for '*Lighting apparatus*'. Class 26-04 is a sub-class and is for '*Luminous sources, electrical or not*'. The Note(s) appended to Class 26-04 clarifies that the sub-class is '*including bulbs for electrical lamps, luminous plaques and tubes, and candles*.' Class 26-05 is for '*Lamps, Standard Lamps, Chandeliers, wall and Ceiling fixtures, lampshades, reflectors, photographic and cinematographic projector lamps*.' Section 6 of the Act provides that a design may be registered in respect of any or all of the articles comprised in a prescribed '*class of articles*.' Any question arising as to the class within which any article falls shall be determined by the Controller, whose decision shall be final. Sub-section (3) of Section 6 of the Act further provides that where a design has been registered in respect of any article comprised in a class of article, the application of the proprietor of

the design to register it in respect of some one or more other articles comprised in that class of articles shall not be refused, nor shall the registration thereof invalidated on the ground of it being so previously registered for the other article or being previously published in India or in any other country by reason of its application to that other article. The proviso further states that the subsequent registration shall not extend the period of copyright in the design beyond that arising from previous registration. Therefore, once a design is registered for one of the articles in a class of articles, the proprietor can claim a right even for other articles in the same class of articles. Equally, someone else cannot claim to become proprietor of the design by seeking registration thereof in another sub-class of the same class of articles. It has not been shown that the classification of the earlier registered articles or that of the plaintiff was determined by the Controller upon contest and therefore, finality is attached to it.

24. At this stage, it would be also relevant to note the submission of the learned counsel for the plaintiff that as the defendants have failed to produce the product to which the designs referred by them have been applied, registration of such design by itself shall not be sufficient to invalidate the registration of the plaintiff's design. In my *prima facie* opinion, the above argument of the learned counsel for the plaintiff is liable to fail for two reasons:-

24.1. What is being claimed is a previously registered design in India: Section 19(1)(a) of the Act provides that registration of a design is liable to be cancelled where the design has been

previously registered in India. The said provision does not require ‘publication’ as is the requirement in Section 19(1)(b) of the Act.

24.2. At least the two Indian registered designs relied upon the by the defendants, in my *prima facie* opinion, would disqualify the plaintiff’s design from registration: For Section 19(1)(b) of the Act, what constitutes ‘publication’ and effect to registration of a design in another country, has been explained in detail by the Full Bench of this Court in ***Reckitt Benkiser India Ltd.*** (*supra*), where it was held as under:-

“Meaning of prior publication under Sections 19(1)(b) read with Section 4(b) and whether documents existing in the record of Registrar of Designs in a convention country abroad which are open to public inspection results in prior publication:

11. The expressions ‘published’ or ‘publication’ are not defined in the Act. Various judgments have however defined these expressions found in the Designs Act. Some judgments define publication as being opposed to one which is kept secret, whereas other judgments define publication as something which is available in public domain i.e. available as of right to any member of the public. We are of course looking into the issue of publication by means of existence in public domain by publication in a paper (which expression “paper” is taken to mean any other medium where the design can be judged by the eye) inasmuch as, it was not (and could not be) disputed by both the parties before us that once there is actual use of the design by making an article out of the same, which is commercially exploited and put in public use (‘by use’ as stated in Section 4(b) of the Act), there would surely be publication. The issue of publication is accordingly being specifically looked into from

the point of view of whether publication by means of publishing in a paper form available in public generally including of their availability in the office of the Registrar of Designs.

12(i). Let us therefore see what should be the meaning which should be ascribed to the expression 'published' or 'publication' when we use such expressions qua 'published' or 'publication' in paper form or by depiction in any form which is visible to naked eye without the same having been put in the form of an article. We have already in this regard reproduced the definition of design as per Section 2 (d) of the Act and the definition of expression 'original' as per Section 2(g) of the Act above, and which sections will be of relevance for discussion of 'publication'.

(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.

13(i). When we see the provision of Section 4(b) we find that a design which is already disclosed by publication in India or abroad will not be registered, however, the bar for registration of a design which is disclosed to the public in India or abroad is accompanied by the language which requires publication 'in a tangible form or by use or in any other way'. It is this language and the fascicle of expressions 'tangible form' or 'use' or 'in any other way' which requires to be understood and interpreted so as to understand the meaning of the word 'publication'.

(ii) So far as the expression 'by use' is concerned, there would be no difficulty because obviously use of the design would be by translating the same into a finished article by an industrial process or means. The real difficulty which arises actually is qua the expressions 'tangible form' or 'in any other way'. These two expressions on a normal literal interpretation are much wider than the expression 'use' (the design having been translated to an article). Publication in a paper form or publication as being visible to the naked eye without the same having been put on an article is very much otherwise included in these wide expressions. The question thus is to what extent should there be publication for the same to be in 'tangible form' or 'in any other way' for being included within the language of 'publication' as found in Sections 4(b) and 19(1)(b). Before we answer this question, we would however like to refer to the ratios of the

judgments in the cases of Gopal Glass Works and Dabur India Ltd. cases.

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15. A reading of the aforesaid paras shows that the following ratio can be culled out from the judgment in Gopal Glass Works' case : -

(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.

(ii) Primacy was given to the Indian registered design because the design which was registered in the U.K. Patent Office was never used qua the article in question viz the glass sheet and the documents downloaded from the internet of the U.K. Patent Office could not be said to have much clarity for being treated as a prior publication qua the specific article in question viz the glass sheet.

(iii) A foreign registered design cannot be the basis for cancellation under Section 19(1)(a) of a design registered in India unless there is application of a design to an article which is put into public domain/use or unless there would have been complete and sufficient clarity in the documents downloaded through internet from the U.K. Patent Office that it can be held that there is a clear cut clarity qua prior 'publication'.

(iv) In the facts of that case since there was no clarity from the design downloaded from U.K. Patent office it was held that there was no prior publication.

16. Besides the aforesaid ratio, it needs to be noted on the reading of the judgment in Gopal Glass Works that though there are observations when such observations are read only in a particular para of the judgment or only in a

particular line of a judgment, then, there may be an indication that existence of registration in a foreign country would not be a ground to hold prior publication, however, when such observations are read in context of entire judgment it was found that those observations are made in the facts of the case because there was lack of sufficient clarity and evidence of what actually was the depiction and the effect of the design registered in U.K. Patent Office qua the specific article in question being the glass sheets. Also, the observations of lack of prior publication in facts of that case were made with respect to a design having to be put on an article as differentiated from lack of clarity in a design merely by the same existing in public records, because in the facts of that case the design registered abroad had not been put in use in glass sheets.

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18. We have extensively quoted the reasoning and ratio in the case of Gopal Glass Works and various facets and factual matrix which led to the conclusion. It will not be correct to read only few paragraphs of the judgment in isolation. In the case of Gopal Glass Works, the Court took into consideration several aspects before reaching its conclusions and para 40 contains one of the aspects. The Division Bench of this Court in its decision in case of Dabur India Ltd. has referred to only paras 39 and 40 of Gopal Glass Works's case. It is therefore necessary to clarify and elucidate upon the expression 'publication' as dilated upon in the case of Gopal Glass Works and to what extent and when the registration abroad will result in publication abroad which is specifically covered in Sections 4(b) and 19(1)(b) of the 2000 Act.

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. (infra)].

(ii) Registration in a foreign country is one aspect but what can entail rejection of an

application for registration in India or cancellation of registration in India, is prior publication and not registration ipso facto in a foreign country. Moreover, such publication should be of the nature delineated in sub-section 4(b). Registration abroad *per se* cannot be a ground for cancellation or rejection of a design in India but the registration in India can be *impugned* if the design is not “new and original” or is already published abroad as stipulated in Section 4(b). In some cases of registration abroad, the same not by itself a ground for rejection/cancellation in India, yet can lead to cancellation if it can be shown and proved that the claim in India is not “new and original” as there was publication abroad and which publication abroad is a publication within the meaning of Section 4(b). In such cases registration can be refused or cancelled. New, original or novelty of the pattern or design when replicated or applied or fully understood by the eye for being applied to an article is a *sine qua non* to avail and get benefit of the rights under the Act. This underlying principle is accentuated as well as protected when Section 4(b) and 19 stipulate and provide for rejection/cancellation of registration of a design which has been published in any country prior in point of time. Though publication in India or abroad are enlisted as separate grounds under Section 4 and 19 of the Act, they are in a way interlinked and intertwined with the question of whether design is new or original for determining the meaning of “design” as understood and as defined in Section 2(d) of the Act.

(iii) Registration abroad is one aspect and publication abroad in terms of Section 4 (b) is another aspect. There can be and will be cases when registration abroad, may have resulted in publication of a design as stipulated in Section 4(b). In such cases there would be publication abroad, not because the design is registered abroad but because the conditions mentioned in Section 4(b) are satisfied. The observations of the Division Bench in *Dabur India Ltd.'s* case cannot

be read to mean that though conditions of Section 4(b) are satisfied, the registration of design cannot or should not be cancelled although the design has been registered abroad. Registration abroad and publication abroad are two distinct parameters, each having their own consequences. When registration abroad results in publication under Section 4(b), the said provision gets attracted and necessary consequences as envisaged in Section 4 and 19 will follow.

20. In our opinion, most of the confusion or lack of clarity qua the meaning of the words “published” or “publication” will be removed when we refer to the judgment of the Supreme Court in the case of *Bharat Das Tools Ltd. v. Gopal Glass Work's Ltd.*, (2008) 10 SCC 657. This judgment of the Supreme Court is the judgment which has been passed in an appeal against the judgment of the learned Single Judge of the Calcutta High Court in *Gopal Glass Work's* case. A reference to various paragraphs of the Supreme Court's judgment shows that the Supreme Court has taken note of the fact that though design is specifically qua an article, however, publication of a design in a paper form, may amount to prior publication, however, each case has to be necessarily seen and decided as per the facts of that case. The facts of each case must show sufficient amount of clarity qua the design which must necessarily exist in a public record of a Registrar of Designs Office and must have sufficient clarity attached to them before the same can be treated as prior publication. Therefore, really the issue is no longer res integra as to meaning of word “published” or “publication” as found in Sections 19(1)(b) and 4(b) of the Act because Supreme Court has held that existence of documents in public record such as the Office of the Registrar of Designs, will or will not, depending on facts of each particular case be evidence of prior publication.

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23. *In view of the above discussion, the following conclusions in our opinion emerge: -*

(i) Existence of a design registered abroad in a convention country is not a ground under Section 19(1)(a) for cancellation of a design registered in India.

(ii) The provision of Section 44 does not have the effect of changing the literal interpretation of Section 19(1)(a) inasmuch as under Section 44, the foreign registered design becomes an Indian registered design, although, the date of registration of the foreign registered design which is registered in India will relate back and have retrospective effect from the date of application first made in the convention country abroad. Once, the foreign registered design becomes registered in India, the very fact that it is an Indian registered design it will be a previously registered design in India, and by virtue of the priority rule the same will be a ground for cancellation of a design subsequently registered in India on an application made after the date of the priority date given of the application made abroad for registration of the design in a convention country.

(iii) The benefit of foreign registered design after its registration in India for seeking cancellation of an Indian registered design under Section 19(1)(a) will only be available if the application for registration in India is made within six months of the date of the application made in the convention country abroad, notwithstanding there may be prior publication in this interregnum six month period.

(iv) In case, the application for registration in India is not made within the statutory permissible period of six months of having made the application abroad, then, the design registered in India in the meanwhile in six months period cannot be cancelled under Section 19(1)(a), though, the foreign registered design owner on proving of prior publication can have an effective

defence to the infringement action filed by the Indian registered design owner and which defence against an infringement action is available vide Section 22 relying on the ground of prior publication under Section 19(1)(b) read with Section 4(b) of the Act.

(v) What is publication is essentially a question of fact to be decided as per the evidence led in each case. Existence of a design in the publication record/office of a Registrar of design abroad may or may not depending on the facts of each case amount to prior publication and there would be prior publication only if the prior registered design is made public and has that much necessary clarity as applied to a specific article capable of judged by the visual appearance or the eye of the mind, that by use of the said knowledge and information in the public record of the Registrar of design office, an article can be made using that design which will be a piracy or violation of that design i.e. putting it differently unless and until there is complete clarity and understanding to the naked eye or the eye of the mind of the foreign registered design as found in the public record of the Registrar of design qua a specific article, it cannot be said that such public record will amount to prior publication.

24. We therefore answer the reference that the ratio in the case of Dabur India Ltd. by the Division Bench of this Court that existence of public record in the office of Registrar of design in a convention country abroad may or may not amount to prior publication inasmuch existence of a design in a public record of Registrar of design in a convention country abroad may or may not, depending on the facts of a particular case, amount or not amount to publication abroad, and which depends on the complete clarity available to the eye of the design found in the public record so that it can be said to be understood for being applied to a specific article. Each case has to be necessarily judged by putting the subject design with the articles side by side with the prior

publication material and only after thoroughly scrutinizing the same any finding can be given of existence or non-existence of prior publication.”

(Emphasis supplied)

24.2.1. I have quoted the above judgment in detail as it extensively and exhaustively discusses the judgment of the Supreme Court in ***Bharat Glass Tube Limited*** (*supra*) as also of the Division Bench of this Court in ***Dabur India Limited*** (*supra*) and has held that what is ‘*publication*’ is essentially a question of fact to be decided on evidence led in each case. The existence of a design in the public record/office of a Registrar of Design may or may not, depending on the facts of each case, amount to prior publication. It would be a prior publication only if the registered design is made public and has necessary clarity as applied to a specific article capable of being judged by visual appearance or the eye of the mind, and by use of that knowledge, an article can be made using that design, which will be piracy or violation of that design. In the present case, though not required, the prior registered designs are clear enough and depict the end product with the said design. *Prima facie*, therefore, the defendants have been able to show that the design of the plaintiff is not ‘*new*’ or ‘*original*’ but is a variant of an already-existing design.

24.2.2. The same, however, cannot be said for the patent pleaded by the defendant in CS (COMM) 76 of 2019. The patent registered in China is for vehicle brake-lamps and though in a T-Shape, in the absence of the end product, at least *prima facie*, it is

difficult to visualize the end product. The design registration of CIEBES LAMPES S.A., again without the actual product produced, at least at this stage, cannot be said to be sufficient to hold that the claim of the plaintiff in its design is neither novel nor original. The same also applies to the registered design of M/s Sumitomo Electric Industries Limited in the USA and to the patent application no.US 8,303,146 B2.

25. The learned counsel for the plaintiff submits that the defendant in CS (COMM) 76 of 2019 (Syska LED Lights Pvt. Ltd.), having, through its licensor (which the plaintiff alleges to be only an *alter ego* of the defendant itself), obtained the registration of its design, is estopped from challenging the registered design of the plaintiff. On the hand, the learned counsel for the defendant submits that the design in which the registration has been obtained by its licensor is different from that of the plaintiff.

26. I have already hereinabove expressed by *prima facie* opinion that the submission of the defendant of its design being different from that of the plaintiff is liable to be rejected; the difference being trivial and not sufficient to brand the defendant's design as 'new' or 'original'. However, at the same time, in case the design of the plaintiff is liable to be cancelled, it has to be cancelled in *rem* and not specific to a party. Therefore, at this stage, the registration of the design by the defendant itself is not sufficient to entitle the plaintiff to interim injunction. The effect of registration of its design by the defendant in CS (COMM) 76 of 2019, however, is left to be considered in detail on parties leading evidence and in the final adjudication of the suit.

27. On the issue of claim of passing off, I deem it appropriate to first consider the findings of the Full Bench in **Carlsberg Breweries A/S.** (*supra*) on this aspect. Paragraph 43 of the said judgment is reproduced hereinbelow:-

*“43. This court is also of the opinion that the Full Bench ruling in Mohan Lal (*supra*) made an observation, which is inaccurate: it firstly correctly noted that registration as a design is not possible, of a trade mark; it, however later noted that "post registration under Section 11 of the Designs Act, there can be no limitation on its use as a trademark by the registrant of the design. The reason being: the use of a registered design as a trade mark, is not provided as a ground for its cancellation under Section 19 of the Designs Act." This observation ignores that the Designs Act, Section 19 (e) specifically exposes a registered design to cancellation when "(e) it is not a design as defined under clause (d) of section 2." The reason for this is that Section 2 of the Designs Act, defines "design" as "...the features of shape, configuration, pattern, ornament or composition of lines or colours applied to any article.....; but does not include any trade mark as defined in clause (v) of sub-section (1) of section 2 of the Trade and Merchandise Marks Act, 1958....." Therefore, if the registered design per se is used as a trade mark, it apparently can be cancelled. The larger legal formulation in Mohan Lal (*supra*), that a passing off action i.e. one which is not limited or restricted to trademark use alone, but the overall get up or "trade dress" however, is correct; as long as the elements of the design are not used as a trademark, but a larger trade dress get up, presentation of the product through its packaging and so on, given that a "passing off" claim can include but is also broader than infringement of a trademark, the cause of action against such use lies.”*

28. Though by way of an *ad-interim* order, a Division Bench of this Court in **Crocs Inc. USA** (*supra*), after considering the judgments of this Court in **Mohan Lal** (*supra*) and **Carlsberg Breweries A/S.** (*supra*) observed as under:-

“23. Secondly, the sentence in para 43 of the judgment of Bhat, J. that “the larger legal formulation in Mohan Lal that a passing off action i.e. one which is not limited or restricted to trademark use alone, but the overall get up or trade dress however, is correct” appears prima facie to place the issue beyond doubt that the FJB in Carlsberg upheld the view of the majority of the FB in Mohan Lal that a passing off action was indeed maintainable in respect of a registered design used as a trademark. To this Court it appears prima facie on a reading of the above para 43, together with the preceding and succeeding para, as a whole that the only qualification in Carlsberg was that if such registered design was used as a trademark then it can lead to the cancellation of the registration of such design. The words “as long as the elements of the design are not used as a trademark but a larger trade dress get up, presentation of the products through its packaging and so on” has to be seen in the context of the discussion preceding it which turns on what can be registered as a design and what cannot. Importantly, the FJB does not explicitly or impliedly overrule the FB in Mohan Lal as regards the answer to Issue II and rightly so since the FJB in Carlsberg was concerned only with Issue III (whether a composite suit for design infringement and passing off was maintainable).

24. However, the learned Single Judge has in the impugned order understood the above observations in para 43 of the judgment of Bhat J. as leading to the position that the majority in Mohan Lal did not recognise the protectability of a registered design when used as a trademark.

Prima facie this understanding by the learned Single Judge in the impugned judgment of what the majority in Mohan Lal held and what Bhat J. as part of the FJB in Carlsberg observed does not appear to this Court to be correct. There is prima facie merit in the contention on behalf of the Plaintiff that the impugned order of the learned Single Judge unwittingly reiterates the minority view in Mohan Lal which by no means was, even impliedly, affirmed by the FJB in Carlsberg.

(Emphasis supplied)

28.1. I must herein also note that the learned counsels for the parties have brought to my attention that the above appeal in **Crocs Inc. USA** (*supra*) is still pending adjudication before the Division Bench of this Court. Reliance on the above order is, therefore, being placed only to a limited extent of holding that the claim of passing off can be maintained on a registered design at least where, in addition to the registered design, claim is also based on packaging, trade dress or other features as are generally understood and acknowledged and as forming a part of a trademark protectable on a claim of passing off.

28.2. In the facts of the present case, the plaintiff has pleaded as under in support of its claim of passing off:-

“29. Apart from infringement of the Plaintiff’s registered design, the Defendants are also guilty of passing off the impugned product as that of the Plaintiff on account of the deceptively similar look and feel and trade dress of both the products. The same is attributable to the aggregate of the following factors:

(a) The shape, dimensions, configuration and colour of the products and their parts are identical.

(b)Both the products have the same mechanical feature of a rotating diffuser which helps in adjusting the aim of the light.

(c)Both the products use similar LED technology and have the identical configuration of 40 in series LED (2 parallel series of 20) inside the diffuser.”

28.3. In my view, the above averments do not, atleast *prima facie*, make out a case of passing off even under trade mark law. Apart from placing reliance on affidavits of its distributors and certain articles in trade magazines reporting the launch of the plaintiff's product, there is nothing further placed on record to substantiate, at least *prima facie*, a claim of passing off. It is also to be noted that the plaintiff itself pleads that it is also the OEM for several other lighting companies in India and produces such T-Bulbs for such companies, who in turn sell them under their own brand name. Therefore, the design itself cannot be enough to attribute a connection of the product with the plaintiff for it to maintain a claim of passing off.

29. Even otherwise, the plaintiff has also failed to fulfil the other two elements of the trinity test for grant of temporary injunction-balance of convenience and irreparable injury. In this regard, I take note of the correspondence that was exchanged between the plaintiff and defendants in CS (COMM) 46 of 2019 (Surya Roshni Limited). The same evidences that the claim of the plaintiff at that stage was monetary, that is, in terms of royalty or license fee. It is also an admitted case of the plaintiff that the plaintiff has granted licenses for consideration in form of payment of a license fee and/or other valuable consideration to other lighting

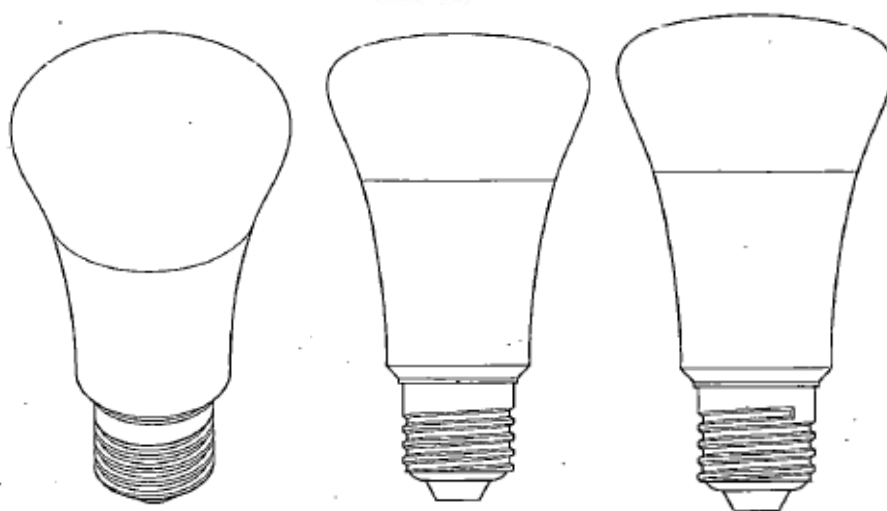
companies. The plaintiff can, therefore, always be compensated in terms of damages in case it succeeds in the suit(s).

RELIEF AS FAR AS DESIGN REGISTRATION NO. 299147:

30. In view of the above, I am of the opinion that the balance of convenience demands that, while rejecting the claim of *ad-interim* injunction of the plaintiff, the defendants (in both the suits) are directed to file, on a regular basis, accounts of their sales made under the impugned design(s). Such accounts be filed on affidavit(s) on a half-yearly basis during the pendency of the suits.

DESIGN REGISTRATION NO. 247723:

31. As noted hereinabove, in CS (COMM) 76 of 2019, a claim is also made by the plaintiff on its registered design no. 247723 of a bulb under brand '*Philips Hue*'. The said design registration is in Class 26-04 with a reciprocity date of 07.03.2012. A pictorial depiction of the same and claim made therein for purposes of design registration is as under:-



PERSPECTIVE VIEW FRONT VIEW REAR VIEW

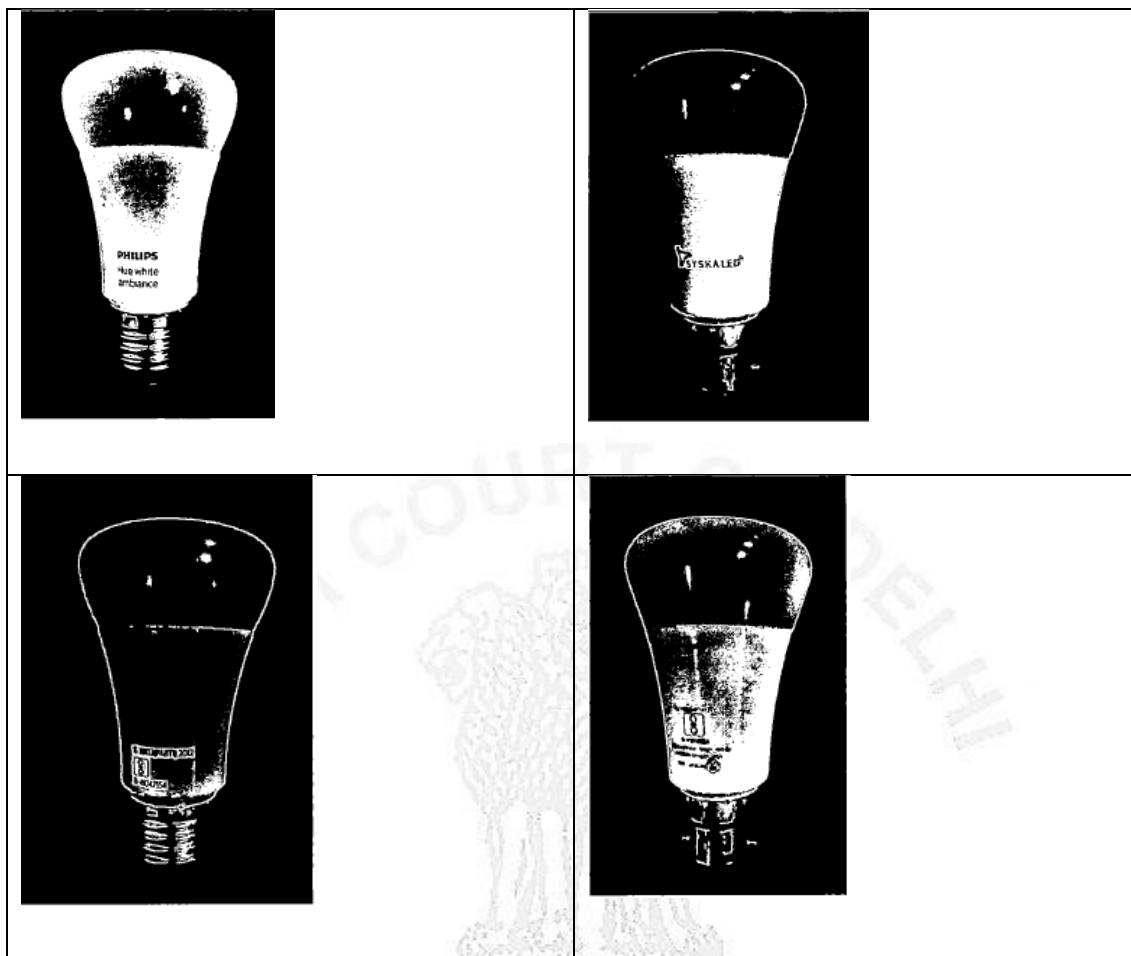
The novelty resides in the shape and configuration of the LED BULB, as illustrated.

No claim is made by virtue of this registration in respect of any mechanical or other action of mechanism whatever or in respect of any mode or principle of construction of the article.”

SUBMISSIONS OF THE PARTIES

32.1. The plaintiff claims that the Hue Bulb design is a part of the ‘*Philips Hue lighting system*’, which comprises also other types of bulbs (spots and candles) and luminaries. The lighting system allows the user to control the lights from their devices (telephone, computer) and create the right ambience by changing the light colours, intensity, creating light scenes. The plaintiff further claims that Hue Bulb design has a unique shape which departs significantly from the common shapes of LED bulbs. The plaintiff claims that the product being sold by the defendant under the name ‘*SYSKA Smart Light*’ is identical in appearance to the Hue Bulb of the plaintiff. Comparative photographs of the two bulbs in the plaint are reproduced hereinunder:-

<u>Photographs of the Plaintiff's</u> <u>Product</u>	<u>Photographs of the Defendant's</u> <u>Product</u>



32.2. The plaintiff also make comparison of the two products and states as under in its plaint:-

- “a. The light bulbs are identical and have the same champagne glass shape.*
- b. More precisely: the size, shape, colour, dimensions and material used for both the diffuser as well as the housing and the base are identical.*
- c. The placement and orientation of the trademarks are similar*
- d. Feature of wireless control of brightness and color of light and is part of the defendant's smart light product range.”*

33. On the other hand, the defendant, as far as the Hue Bulb is concerned, contends that its bulb is different from that of the plaintiff. In any case, it is an ordinary glass bulb shape which has always been available in the market; its uniqueness, even as per the plaintiff, lies in its features of wireless control of brightness and colour of light, which cannot be claimed as a design. The defendant claims that the wireless technology used by the defendant is different from that of the plaintiff and that there are other companies which are manufacturing and selling similarly-shaped bulbs.

34. The learned counsels for the parties have reiterated the submissions as noted hereinabove from the pleadings.

FINDINGS OF THE COURT

35. I have considered the submissions made by the learned counsels for the parties. I have also discussed herein above the law applicable to such claim based on a registered design.

35.1. The defendant in its written statement has reproduced photographs of various bulbs, which also include thereby some reputed brands, bearing similar design as that of the parties. The plaintiff in its replication states that the mere inclusion of photographs of products with names of third parties cannot serve to discharge the onus on the defendant to prove that the said products indeed emanate from the named third parties or that they were in existence in the market prior to the publication of the plaintiff's design.

35.2. In my opinion, however, for judging the balance of convenience and irreparable injury, the fact that bulbs with reputed brands bearing similar design are available in the market, would be relevant and

disentitle the plaintiff to an interim injunction. Though it is correct that the plaintiff is not required to sue each and every infringer of its design, at the same time, where no such action is taken by the plaintiff against even big market competitors, it would be relevant to deny the plaintiff interim relief of injunction.

35.3. I am also of the opinion that the claim of the plaintiff appears to be in its 'lighting system' whereof its Hue bulb is an integral part. Whether the bulb alone is new or original would, therefore, need to be judged on further evidence being led by the parties.

RELIEF AS FAR AS DESIGN REGISTRATION NO. 247723:

36. Accordingly, to balance the equities and to protect the rights of the plaintiff, it is directed that the defendant in CS(COMM) 76 of 2019 shall, on a regular basis, file accounts of its sales made under the impugned design. Such account be filed on a half-yearly basis on an affidavit.

DISPOSAL OF APPLICATIONS:

37. The applications are disposed of with the above directions. It is made clear that any observation made in this order is only *prima facie* in nature and shall not, in any manner, be considered as a conclusive finding of this Court and/or prejudice either party at the final adjudication of the two suits.

CS(COMM) 46/2019 & CS(COMM) 76/2019

List before Joint Registrar (Judicial) for further proceedings on 12th September, 2022.

NAVIN CHAWLA, J.

JULY 5, 2022/rv/AB/Ai