

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

+ **FAO(OS) 458/2009**

% **Reserved on: 11<sup>th</sup> January, 2013**  
**Pronounced on: 15<sup>th</sup> March, 2013**

RECKITT BENKISER INDIA LTD ..... Appellant  
Through: Mr. Aman Lekhi, Senior Advocate  
with Ms. Shikha Sachdev, Advocate.

Versus

WYETH LTD. .... Respondent  
Through: Mr. Pravin Anand, Advocate with  
Mr. Vaishali Mittal, Advocate and  
Ms. Abhilasha Nautiyal, Advocate.

**CORAM:**  
**HON'BLE MR. JUSTICE SANJIV KHANNA**  
**HON'BLE MR. JUSTICE VALMIKI J.MEHTA**  
**HON'BLE MR. JUSTICE S.P. GARG**

To be referred to the Reporter or not?

**VALMIKI J. MEHTA, J**

1. Reference has been made to this Full Bench, by a Division Bench of this court, vide the reference order dated 8.10.2010 in this FAO(OS), for this larger Bench to consider as to whether a Division Bench

of this court in the case of *Dabur India Ltd. Vs. Amit Jain & Anr. 2009*

(39) *PTC 104 (Del) (DB)* has correctly held that publication abroad by existence of the design in the records of the Registrar of designs which is open for public inspection cannot be said to be “prior publication” as per the meaning of the term as found in Sections 4(b) and 19(1)(b) of the Designs Act, 2000 (hereinafter referred to as ‘the Act’). The Division Bench of this court observes that it concurs with the view of learned Single Judge of Calcutta High Court in the case of *Gopal Glass Works Ltd. Vs. Assistant Controller of Patents & Designs 2006 (33) PTC 434 (Cal.)* as stated in paras 39 and 40 of the judgment, as per which the learned Single Judge of the Calcutta High Court holds that mere publication of designs, specifications, drawings and /or demonstrations by the patent office in a foreign country would not in itself amount to publication for rendering a design registered in India liable to cancellation. The reference order doubts the correctness of the ratio in the judgments in the cases of *Dabur India Ltd.* and *Gopal Gas Wors Ltd.* for the reason that the said judgments are stated to have overlooked the provision of Section 44 of the Act which provides that a design which is registered abroad in a Paris Convention country, and to which convention India is a signatory, gets priority over an Indian registered design, provided that the person who gets the designs registered

FAO (OS) No.458/2009 Page 2 of 67

abroad in a Paris convention country, within six months of the date of the application made in the said convention country abroad, applies and gets registration in India.

2. In order to answer the reference with clarity it would be necessary first to crystallize the various issues/aspects, so that not only each of them can be approached independently, but also the inter-play and inter-relation of those issues as regards points which are common to those issues/aspects can be noticed. The issues/aspects as crystallized would be as under:-

(i) When Section 19(1) (a) of the Act provides for cancellation of a design registered in India on account of a design previously registered in India, whether the said provision has to be read literally only i.e only a design registered in India can be basis for cancellation of a subsequent design registered in India and not a design registered abroad in a convention country or whether the provision of Section 19(1) (a) takes within its sweep and includes a previous design registered abroad in a convention country for cancellation of a design registered in India. Putting it differently, is a design previously registered abroad in a convention country a ground under Section

19(1) (a) of the Act for cancellation of a design subsequently registered in India.

(ii) If under Section 19(1)(a) a design registered in a convention country abroad is a ground for cancellation of a design registered in India, is this rule absolute or the rule falls in those circumstances where the design registered abroad is not applied to be got registered India within a period of six months of making of the application in a convention country abroad. Be it noted that the issue of design registered abroad alongwith its prior publication can be under certain circumstances a basis of cancellation of a design which is registered in India, however, that is the subject matter of Section 19(1)(b) and not 19(1)(a), because the aspect of prior publication is within the subject matter of Section 19(1)(b) as stated in the immediately following issue.

(iii) If a design registered in a convention country abroad is not a ground for cancellation of a design registered in India under Section 19(1)(a), then, whether the registration abroad entitles cancellation of a design registered in India because the registration abroad conclusively amounts to prior publication as per that expression found in Section 19(1)(b) read with Section 4(b) of the Act.

(iv) What is the meaning of the expression “publication abroad”/“published abroad”, for it then to be argued that on account of such publication abroad, the design registered in India becomes liable to cancellation in terms of Section 19(1)(b) of the Act.

3. An offshoot of the aforesaid issues (iii) and (iv) above is that whether in all circumstances and all cases, the record of the Registrar of Designs open to public inspection abroad should be held to be prior publication so that on the basis cancellation can be applied under Section 19(1)(b) of the Act for the design registered in India, and if, the record of the Registrar of Designs in a convention country abroad is to be taken as a basis for cancellation of a design registered in India, whether it is an unqualified rule or whether it has to be examined as per the facts of each case that record of the Registrar of Designs in a convention country abroad does or does not amount to prior publication in terms of the expression in Section 19(1)(b) and Section 4(b) of the Act.

4. In order to deal exhaustively with the aforesaid issues which call for our answers, it would be necessary to refer to various relevant Sections of the Act. One way would be to quote and deal with the different

Sections of the Act when we take up for discussion a specific issue as stated  
*FAO (OS) No.458/2009* *Page 5 of 67*

above and another way can be to set out all the relevant Sections of the Act at the outset and thereafter refer to the language of such whichever Section is necessary when we take up the discussion qua a particular issue. We would prefer to take the second course of action of reproducing all the Sections which will come into play for discussion in the present judgment at the outset because for the issues which have to be considered, the language not only of one particular Section or but also of various other Sections jointly will come into play, and also because of the fact that inter-play of Sections will have to be noticed when we deal with a specific issue. The relevant Sections with necessary underlining/emphasis are therefore reproduced below:

**“Section 2(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 an 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 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);.

(g) “original”, in relation to a design, means originating from the author of such design and includes the cases which though old in themselves yet are new in their application;

**Section 4. Prohibition of registration of certain designs.-** A design which-

(a) is not new or original; or

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

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

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

**Section 5. Application for registration of designs.-**

(1) The Controller may, on the application of any person claiming to be the proprietor of any new or original design not previously published in any country and which is not contrary to public order or morality, register the design under this Act.

Provided that the Controller shall before such registration refer the application for examination, by an examiner appointed under sub-section (2) of section 3, as to whether such design is capable of being registered under this Act and the rules made thereunder and consider the report of the examiner on such reference.

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(6) A design when registered shall be registered as of the date of the application for registration.

### **Section 6. Registration on 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.

### **Section 7. Publication of particulars of registered Design**

The Controller shall, as soon as may be after the registration of a design, cause publication of the prescribed particulars of the design to be published in such manner as may be prescribed and thereafter the design shall be open to public inspection.

### **Section 11. Copyright on registration**

(1) When a design is registered, the registered proprietor of the design shall, subject to the provisions of this Act, have copyright in the design during ten years from the date of registration.

(2) If, before the expiration of the said ten years, application for the extension of the period of copyright is made to the Controller in the prescribed manner, the Controller shall, on payment of the prescribed fee, extend the period of copy-right for a second period of five years from the expiration of the original period of ten years.

### **Section 17. Inspection of registered designs**

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

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

### **Section 18. Information as to existence of copyright**

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On the request of any person furnishing such information as may enable the Controller to identify the design, and on payment of the prescribed fee, the Controller shall inform such person whether the registration still exists in respect of the design, and, if so, in respect of what classes of articles, and shall state the date of registration, and the name and address of the registered proprietor.

### **Section 19. Cancellation of registration**

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

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

## **Section 22. Piracy of registered design**

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(I) 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. (1) 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 subsection shall be instituted in any court below the court of District Judge.

(3) In any suit or any other proceeding for relief under subsection (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 or which the registration of a design may be cancelled under section 19 has been availed of as a ground of defence and 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.

#### **Section 44. Reciprocal arrangement with the United Kingdom and other convention countries or group of countries of intergovernmental organisations**

(1) Any person who has applied for protection for any design in the United Kingdom or any of other convention countries or group of countries or countries which are members of inter-governmental organisations, or his legal representative or assignee shall, either alone or jointly with any other person, be entitled to claim that the registration of the **said design under this Act** shall be in priority to other applicants and shall have the same date as the date of the application in the United Kingdom or any of such other convention countries or group of countries or countries which are members of inter-governmental organisations, as the case may be:

Provided that-

(a) the application is made within six months from the application for protection in the United Kingdom or any of such other convention Countries or group of countries or countries which are members of inter-governmental organisations, as the case may be; and

(b) nothing in this section shall entitle the proprietor of the design to recover damages for piracy of design, design happening prior to the actual date on which the design is registered in India.

(2) The registration of a design shall not be invalidated by reason only of the exhibition or use of or the publication of a description or representation of the design in India during the period specified in this section as that within which the application may be made;

(4) Where it is made to appear to the Central Government that the legislature of the United Kingdom or any such other convention country or a country which is member of any group of countries or inter-governmental organisation as may be notified by the Central Government in this behalf has made satisfactory provision for the protection of designs registered in India, the Central Government may, by notification in the Official Gazette, direct that the provisions of this section, with such variations or additions, if any, as may be set out in

such notification, shall apply for the protection of designs registered in the United Kingdom or that other convention country or such country which is member of any group of countries or intergovernmental organisation, as the case may be.

Explanation- (1) For the purposes of this section, the expression “convention countries”, “group of countries” or “inter-governmental organisation” means, respectively, such countries, group of countries or inter-governmental organisation to which the Paris Convention for Protection of Industrial Property, 1883 as revised at Stockholm in 1967 and as amended in 1979 or the Final Act, embodying the results of the Uruguay Round of Multilateral Trade Negotiations, provided for the establishment of World Trade Organisation applies.

Explanation- (2) Where more than one application for protection referred to in sub-section (1) have been made for similar protections in the United Kingdom or one or more convention countries, group of countries or countries which are members of inter-governmental organisations, the period of six months referred to in clause (a) of that sub-section, shall be reckoned from the date of which the earlier or the earliest application, as the case may be, of such applications has been made.”

**Section 19(1)(a): Whether a design registered abroad can be a ground for cancellation of a design registered in India**

5(i). On a literal interpretation of Section 19(1)(a), it is clear that it is only a design which is registered in India which can cause cancellation of a design which is again registered in India i.e a design registered abroad on a literal construction of Section 19(1)(a) is not a ground for cancellation of a design registered in India. The issue is that should a literal construction

prevail or should it be held that a design registered abroad should be included in the sweep of Section 19(1)(a) for cancellation of the design registered in India. In order to appreciate this issue, we would at this stage reproduce Section 51A of the erstwhile Designs Act, 1911 which dealt with cancellation of registration, and which provision is similar to the present Section 19 of the 2000 Act. The earlier Section 51A reads as under:-

**“Section 51A. Cancellation of registration-**

(1) Any person interested may present a petition for the cancellation of the registration of a design-

(a) at any time after the registration of the design, to the High Court on any of the following grounds, namely:

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

(ii) that it has been published in India prior to the date of registration;

or

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

(b) within one year from the date of the registration, to the Controller on either of the grounds specified in sub-clauses (i) and (ii) of Clause

(a).

(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.”

(ii) When we compare Section 51A of the 1911 Act with Section 19 of the 2000 Act, it becomes clear that the parliament has brought in prior publication abroad by including this aspect in Section 19(1)(b) of the 2000 Act for cancellation of a design registered in India, whereas previously

under Section 51A (1)(a)(ii) of the 1911 Act the factum of prior publication abroad was not a ground for cancellation of a design registered in India. There is hence a conscious departure by the legislature while enacting Section 19(1)(b) of the 2000 Act than as compared to Section 51A(1)(a) (ii) of the 1911 Act, however, there is no change in the language of Section 51A(1)(a)(i) of the 1911 Act when we compare the same with the equivalent provision of Section 19(1)(a) in the 2000 Act i.e both under the 1911 Act and the present 2000 Act it is only a prior registration in India (and not abroad) which is a ground for cancellation of a design which is subsequently registered in India. There is therefore a marked change in approach of the legislature while dealing with the separate aspects viz. one of cancellation of a design registered in India on the ground of registration in India which has remained the unchanged, and second as regards cancellation because of prior publication and which expression has been extended to mean prior publication not only in India but also abroad. In *Gopal Glass Works Ltd.'s case* the learned Single Judge of the Calcutta High Court has rightly noticed this conscious act of the legislature, and this is stated in paras 28 and 29 of the said judgment, which paras read as under:-

“28. It is significant that prior to the enactment and enforcement of the 2000 Act prior registration or publication of the design in India was a ground for cancellation of a registered design, but no prior registration or publication abroad. Parliament in its wisdom deemed it expedient to add prior publication in a country other than India as a ground for cancellation of a registered design, but not prior registration in a country other than India.

29. Parliament has thereby consciously differentiated between prior registration in India and prior registration abroad. No such difference has, however, been made in the case of prior publication. Prior publication either in India or abroad is a ground for cancellation of a registered design.”

6. Therefore, we cannot ignore this specific mandate of the legislature whereby no change has been brought about to the language of the earlier provision of Section 51A (1)(a)(i) of the 1911 Act, and there being an identical provision in Section 19(1)(a) of the 2000 Act. Therefore, a registration of a design abroad cannot be a ground included under Section 19(1)(a) of the Act for cancellation of a design registered in India.

7. The question which then immediately arises is whether the provision of Section 44, with its sub-Sections (1) and (2), requires any change to be brought about in the aforesaid interpretation which we have given to Section 19(1) (a) that a foreign registration cannot be a ground for seeking cancellation of an Indian registration.

8(i). On a close reading of Section 44 (1) and (2), and taking note of the provision of Section 5(6) of the Act which provides that registration is effective from the date of the application for registration, it is clear that the design registered abroad which is talked off under Section 44, and which has priority by giving the date of the application for registration in India the earlier date of the application made in a convention country, the same does not mean that it is the foreign registered design which brings about cancellation of the Indian registered design on the ground of priority. What we mean to say is that it is not as if the foreign registered design continues to be a foreign registered design by virtue of Section 44(1) of the Act, because on registration in India the foreign registered design becomes a design registered in India, albeit having a priority date of the date of the application made in a convention country abroad. This becomes clear when we note an all important expression found under Section 44(1), and which is “the registration of the said design under this Act”, and which shows that a design registered abroad after making of an application within six months of the date of application made in the convention country abroad, after its registration in India actually does not remain a foreign registered design but it becomes a design registered in India, of course with the earlier priority

date. Putting it in other words, the date of registration in India is taken as the date of application made in the convention country abroad, inasmuch as, by virtue of provision of Section 5(6) of the Act a design which is registered in India will be registered as the date of the application for registration in India; and by virtue of Section 44(1) the date of application for registration of the foreign design registered in India (for which an application was earlier made in a convention country abroad) is to be taken as a date when the application was made in the convention country abroad. Neatly put what we are stating is actually the design which is registered abroad in fact becomes a design registered in India on complying of the requirement of making the application within six months in India from the date of the application being made in the convention country abroad, and therefore, the design registered abroad becomes a design registered in India with an earlier priority date being the earlier date of the application made abroad, and thereby foreign registered design on becoming an Indian registered design is therefore an Indian registered design for seeking cancellation of a design registered in India having a subsequent priority date. Section 19(1)(a) accordingly sufficiently provides for this when it talks of cancellation of one design subsequently registered in India when there exists a previously design

registered in India. Therefore, the language of Section 44(1) does not bring about, nor is required to bring about, any widening of the sweep of Section 19(1)(a) for including within Section 19(1)(a) cancellation of an Indian registered design on account of a registered design in a convention country abroad.

8(ii). Issue No.1 is answered accordingly by holding that Section 19(1)(a) of the Act has to be interpreted literally, and only a previously registered Indian design can be a ground for cancellation of subsequently registered design in India, and a foreign registered design cannot under Section 19(1)(a) be a ground for seeking cancellation of a design registered in India. Of course, the issue of a design registered abroad, subject to its prior publication, can be under certain circumstances a basis of cancellation of a design which is registered in India, however, that is a subject matter of Section 19(1)(b) and not 19(1)(a), which aspect we will deal with while taking up issue Nos.3 and 4 of para 2 above.

**Effect of failing to apply in India for registration within six months of making of an application abroad.**

9. The language of sub-Sections (1) and (2) of Section 44 leaves no manner of doubt that if any person who has applied for registration in a

convention country abroad fails to make an application for registration of the design registered abroad in India within six months of having made the application abroad in a convention country, then in such a case the said person who has registered his design abroad will lose his entitlement to priority which is claimed on the basis of date of application made in a convention country abroad, and the date of registration in such a case of having made an application after six months in India would be the date of the application made in India (and which is after the six months period of the date of the application made abroad) with the consequent effect that in the meanwhile if there is registration of a similar/same design in India in the six months period (or till the foreign owner makes an application in India) then such Indian applicant will then get priority to the application of the owner of the foreign registered design made after the six months period of the date of application made in a convention country abroad. Thus, such registration of a foreign registered design after the six months period will become a design which is to be taken as a subsequently registered in India to a design which is registered in India on an application being made in the interregnum six months period, and therefore, the foreign registered design cannot be a ground for cancellation of an Indian registered design under Section 19(1)(a)

because the foreign registered design will have the date of application for registration not as the priority date of an application made abroad in a convention country but will only be of that date which is the date of application made in India for registration being a date after the six months period of the application made abroad for registration of the design.

10. Thus issue No.2 is answered by holding that a person who fails to apply in India within six months of making of an application in a convention country abroad, then, such an owner of a foreign registered design, though would have appropriate entitlement in the convention country in which registration is applied and granted, however, in India the registration in a convention country abroad will have no effect of destroying the priority date of an application made for registration in India within the interregnum six months period. Putting it differently, whereas the foreign registered design owner in the convention country in which his design is registered may take necessary action in such foreign country on the basis of registration if the Indian registered owner of the design seeks to sell articles in that country in which the design is registered by the foreigner, however, in India, it will be the Indian registered owner who will be entitled to bring an

course, we must hasten to add that if there is prior publication abroad before the registration In India by a third party, then in such a case the foreign registered holder will be able to challenge the registration in India i.e in effect, both the Indian registered design owner and the foreign registered design owner can simultaneously market their products in India with the design, and none of them can successfully maintain an action for infringement under the Act.

**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  
*FAO (OS) No.458/2009*

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.

14. In *Gopal Glass Works’s case*, the design in question was registered in India with respect to glass. The owner of the design registered in India had purchased it from a German company. However, the design which was sold to the Indian owner was also found to be registered in the name of one other company M/s. Vegla Vereinigte Glassworke GMBH in UK. Though from the illustration in the form of drawings downloaded from the website of United Kingdom Patent Office depicted the design that may be applied to glass sheets, however, two important conclusions are made clear from the reading of the judgment and which are that firstly that the patterns found in the design registered in the UK Patent Office may be the same but the illustrations did not give the same visual effect for being understood and applied to the article. The judgment in the case of *Gopal Glass Works* has laid emphasis on applying of the design to an article in terms of the definition of design under Section 2(d) of the Act, and on

FAO (OS) No.458/2009 Page 26 of 67

account of lack of factual clarification and evidence led by the person who opposed the Indian owner of the registered design it was held that it cannot be said in the facts of that case that mere existence of papers downloaded from the UK Patent Office will not amount to prior publication. It was accordingly held that not only the papers downloaded from the UK Patent Office did not have necessary clarity for being applied to any article, but also there was no evidence of manufacture of glass sheets by anyone with the design in question. Secondly, admittedly at no point of time even though the design was registered in the UK Patent Office, there was ever any manufacture of glass sheets by anyone other than the Indian registered design owner. Some of the relevant paragraphs of the judgment in *Gopal Glass Works* relating to the factual matrix read:-

“4. For production of glass sheets of the design registered as Design No. 190336, two rollers are required. The rollers are manufactured by M/s. DORN BAUSCH GRAVUREN GMBH of Germany, hereinafter referred to as the German Company. According to the petitioner the rollers are not only used for manufacture of glass sheets, but for various other articles including plastic, rexin and leather.

5. The appellant claims to have placed orders on the German Company, for supply of the rollers for launching a design of figured glass with new and novel features, not produced before by any one else.

6. On or about 29th October, 2002 the appellant applied to the Controller of Patent and Designs under Section 51 of the Designs Act, 2000, hereinafter referred to as the said Act, for registration of the said design in Class 25-01. The said design was duly registered on 5th November, 2002 and was to remain valid for a period of 10 years from date of its registration.

10. It is alleged that the respondent No. 2 and/or its associate IAG Co. Ltd. started imitating the said registered design, as a result whereof the appellant was constrained to file a suit being Civil Suit No. 1 of 2004 against the respondent No. 3 and its associate IAG Co. Ltd. in the District Court at Mehsana. The appellant obtained an interim order of injunction restraining IAG Co. Ltd. from infringing the copyright of the appellant in the said registered design.

11. In the meanwhile, the respondent No. 3 as counterblast to the aforesaid notice, filed an application under Section 19 of the said Act, before the respondent No. 1 for cancellation of registration of Design No. 190336 in the name of the appellant, mainly on the ground of prior publication of the design in India and abroad and on the ground of the design not being new or original.

12. The respondent No. 3 relied on inter alia a catalogue of the German Company, a letter dated 10th September, 2003 of the German Company addressed to M/s. IAG Co. Ltd. stating that the said German Company had developed Design No. 2960-9010 in the year 1992, and a document downloaded from the internet from the official website of the Patent Office of the United Kingdom on 22nd September, 2004 which shows that the same design had been registered in the United Kingdom in the name of M/s. Vegla Vereinigte Glaswerke Gmbh some time in 1992.

15. A Liaison Executive of the appellant also filed an affidavit stating that he visited Germany, and upon enquiry ascertained that M/s. Vegla Vereinigte Glaswerke Gmbh had never manufactured

glass sheets of the design registered as Design No. 2022468 in the United Kingdom.

16. In the proceedings before the respondent No. 1, the appellant questioned the admissibility of the materials alleged to have been downloaded from the United Kingdom Patent Office website, in evidence, in the absence of any corroborative evidence regarding the authenticity of the same.

17. It was emphatically argued that the German Company did not apply the design in question on glass sheets. The catalogue of the German Company did not depict the application of the design on glass sheets. As such the catalogue as also the letter of the German Company dated 10th September, 2003 to M/s. IAG Company Ltd. were of no relevance.

The ratio decidendi of the judgment in *Gopal Glass Works* is as under:-

18. The respondent No. 1 framed three issues. The first issue was whether the design was not new or original in view of the fact that the design had been published before the date of registration and the registered proprietor was not the owner of the design. The second issue was whether the design had been published outside India as well as in India, prior to the date of application and the third issue was whether the registered design was in public domain due to sale/use of the design prior to the date of application of the registered proprietor.

30. Under the law presently in force in India, specifications, drawings and/ or demonstrations in connection with registration of a design do not per se constitute publications which prohibit future registration of that design. Had publication of design specifications by a registering authority, particularly a registering authority in a foreign country, in connection with registration of a design, in itself, amounted to prior publication, that would hit all future applications in India for registration of designs, prior registration in India would not separately have been made a

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

33. The respondent No. 1 failed to appreciate that a design is solely judged by the eye. The visual appeal of a pattern, ornament or configuration on leather or rexin would not be the same as the visual appeal of that pattern, ornament or configuration on glass.

34. In order to destroy the novelty of a design registration, prior disclosure whether by publication or use or any other way, must be of the pattern, shape and/or configuration **applied to the same article**. The use of the embossing roller, to emboss a pattern ornament or configuration on a glass sheet, a material totally different in composition, nature, fragility, durability and look from leather, rexin or even plastic, in itself, involves inventive ingenuity.

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

38. The respondent No. 1 has apparently not considered the definition of "original" in Section 2(g) of the 2000 Act. The reasoning on the basis of which the respondent No. 1 arrived at his impugned finding that the design was not new or original is misconceived.

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

40. It is true that publication has not been defined in the 2000 Act. Yet, **for reasons discussed above**, mere publication of design specifications, drawings and/or demonstrations by the Patent Office of the United Kingdom, or for that matter, any other foreign country, in connection with an application for registration, would not, in itself, amount to publication that would render a design registered in India liable to cancellation.

41. To constitute prior disclosure by publication to destroy the novelty of a registered design, the publication would have to be, in tangible form, of the design applied to the same article. Prior publication of a trade catalogue, brochure, book, journal, magazine or newspaper containing photographs or explicit picture illustrations that clearly depict the application of the design on the same article, with the same visual effect would be sufficient.

42. When the novelty of an article is tested against a prior published document, the main factor required to be adjudged is the visual effect and the appeal of the picture illustration.

43. If the visual effect of the pattern, the shape or the combination of the pattern, shape, dimension, colour scheme, if any, are not clear from the picture illustrations, the novelty cannot be said to have been destroyed by prior publication, unless there are clear and unmistakable directions to make an article which is the same or similar enough to the impugned design.

45. **The illustrations in the form of drawings downloaded from the website of the United Kingdom Patent Office depict the patterns that may be applied to glass sheets. The patterns may be same but the illustrations do not give the same visual**

**effect as the samples of the glass sheets produced by the appellant in Court. There are also no clear unmistakable instructions or directions for production of glass sheets of the pattern illustrated.**

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

47. The order impugned considered with the materials on record, including in particular the computer print-outs clearly reveals that the respondent No. 1 has only compared the pattern and/or configuration and considered the visual appeal thereof, but not the visual appeal of the pattern and/or configuration on the article. In other words, the respondent No. 1 has not considered the visual appeal of the finished product.

48. There are no material on record to show that the design had previously been applied to glass sheets. On the other hand, an affidavit was sworn on behalf of the appellant by a Liason Executive affirming that he had ascertained that the proprietor of the design registered in the United Kingdom had never manufactured glass sheets of the design registered.”

(emphasis is added by us)

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  
FAO (OS) No.458/2009 Page 33 of 67

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.

17(i) The Division Bench of our High Court in the case of *Dabur India Ltd.* has not referred to the facts of *Gopal Glass Works* case while concurring with paras 39 and 40 of the judgment in *Gopal Glass Works* case by reproducing those paragraphs in para 25 in the judgment of the Division Bench. The relevant paras of the judgment of Division Bench are paras 24 to 26 which read as under:-

FAO (OS) No.458/2009

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

“19. Cancellation of registration.- (1) Any person interested may present a petition for the cancellation of the registration of a design at any time after the registration of the design, to the Controller on any of the following grounds, namely:

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

25. We find that the Calcutta High Court has in *Gopal Glass Works Ltd. v. Assistant Controller of Patents and Designs* (2007)1CALLT290(HC) explained the position, with which we concur, as under:

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

40. It is true that publication has not been defined in the 2000 Act. Yet, for reasons discussed above, mere publication of design specifications, drawings and/or demonstrations by the Patent Office of the United Kingdom, or for that matter, any other foreign country, in connection with an application for registration, would not, in itself, amount to publication that

would render a design registered in India liable to cancellation.

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

(ii) The observations of the Division Bench if taken literally may seem to hold that registration abroad of a design taken in itself without anything further cannot be a ground for claiming prior publication in an infringement action. The question is, is this the law and did the Division Bench at all intend to say that existence of papers open to public inspection in a Registrar of Designs office abroad by that fact itself without anything further cannot be a ground under any circumstances for cancellation of an Indian registered design.

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  
*FAO (OS) No.458/2009* *Page 38 of 67*

foreign country. Moreover, such publication should be of the nature delineated in sub-section 4(b). Registration abroad perse 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. vs. Gopal Glass Work’s Ltd., 2008 (10) SCC 657.* This  
FAO (OS) No.458/2009 Page 40 of 67

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. At this stage, it would be relevant to refer to the relevant paras of the judgment of the Supreme Court in the case of ***Bharat Das Tools Ltd.*** and which paras 26, 27, 28, 29, 30, 31, 32, 33, 35,

36, 37, 41, 45, 46 and 47 read as under:

*FAO (OS) No.458/2009*

*Page 41 of 67*

“26. In fact, the sole purpose of this Act is protection of the intellectual property right of the original design for a period of ten years or whatever further period extendable. The object behind this enactment is to benefit the person for his research and labour put in by him to evolve the new and original design. This is the sole aim of enacting this Act. It has also laid down that if design is not new or original or published previously then such design should not be registered. It further lays down that if it has been disclosed to the public anywhere in India or in any other country by publication in tangible form or by use or in any other way prior to the filing date, or where applicable, the priority date of the application for registration then such design will not be registered or if it is found that it is not significantly distinguishable from known designs or combination of known designs, then such designs shall not be registered. It also provides that registration can be cancelled under Section 19 of the Act if proper application is filed before the competent authority i.e. the Controller that the design has been previously registered in India or published in India or in any other country prior to the date of registration, or that the design is not a new or original design or that the design is not registerable under this Act or that it is not a design as defined in Clause (d) of Section 2. The Controller after hearing both the parties if satisfied that the design is not new or original or that it has already been registered or if it is not registerable, cancel such registration and aggrieved against that order, appeal shall lie to the High Court. These prohibitions have been engrafted so as to protect the original person who has designed a new one by virtue of his own efforts by researching for a long time. The new and original design when registered is for a period of ten years. Such original design which is new and which has not been available in the country or has not been previously registered or has not been published in India or in any other country prior to the date of registration shall be protected for a period of ten years. therefore, it is in the nature of protection of the intellectual property right. This was the purpose as is evident from the statement of objects and reasons and from various provisions of the Act. In this background, we have to examine whether the design which was registered on the application filed by

the respondent herein can be cancelled or not on the basis of the application filed by the appellant. In this connection, the law of Copyright and Industrial Designs by P.Narayanan (Fourth Edition), Para 27.01 needs to be quoted.

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

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

The purpose of the Designs Act is to protect novel designs devised to be applied to (or in other words, to govern the shape and configuration of) particular articles to be manufactured and marketed commercially. It is not to protect principles of operation or invention which, if profitable at all, ought to be made the subject- matter of a patent. Nor is it to prevent the copying of the direct product of original artistic effort in producing a drawing. Indeed the whole purpose of a design is that it shall not stand on its own as an artistic work but shall be copied by embodiment in a commercially produced artefact. Thus the primary concern, is what the finished article is to look like and not with what it does and the monopoly provided for the proprietor is effected by according not, as in the case of

ordinary copyright, a right to prevent direct reproduction of the image registered as the design but the right, over a much more limited period, to prevent the manufacture and sale of article of a design not substantially different from the registered design. The emphasis therefore is upon the visual image conveyed by the manufactured article.”

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

28. Now, we shall examine to what extent the view taken by the Assistant Controller can be sustained and whether the view taken by learned Single Judge was correct or not. Now, coming to the first issue which has been framed by the Assistant Controller, the Assistant Controller found that M/s.Dornbusch Gravuren GmbH, a German Company published a brochure bearing distinctive number 2960-910 for the first time on 10.9.1993 and the registered proprietor took the user's right and got it registered. The Assistant Controller found that it is not the inventive ingenuity of the respondent and found that in order to register the design it should be new or original and the Assistant Controller found that there is insufficient evidence of originality and therefore, he came to the conclusion that the design is not a new and original one registered prior to the date of registration. therefore, the question is whether the design is new and original.

29. Section 4 which is couched in the negative terms, says that the design which is not a new or original then such design cannot be registered. therefore, the question is the design which has been prepared by the German Company and which has been sold to the respondent which became the proprietor of it, is a new or original or not. **In this connection, the burden was on the complainant to show that the design was not original or new. We have no hesitation in recording a finding that the burden was not discharged by the complainant.** It only tried to prove on the basis of the letter of the German company that they produced the rollers and sold in market but it was nowhere mentioned that these rollers have been reproduced on the glass sheets by the German company or by any other company. The expression, "new or original" appearing in Section 4 means that the design which has been registered has not been published anywhere or it has been made known to the public. The expression, "new or original" means that it had been invented for the first time or it has not been reproduced by anyone.

30. The respondent company purchased the rollers from the German company and got it registered with the registering authority that by these rollers they are going to produce the design on the glass sheets. Design has been defined in Section 2(d) which means that a feature of shape, configuration, pattern, ornament or composition of lines or colours applied to any article whether in two dimensional or three dimensional or in both forms, by any industrial process. That means that a feature or a pattern which is registered with the registering authority for being produced on a particular article by any industrial process whether manual, mechanical or chemical or by any other means which appears in a finished article and which can be judged solely by eye appeal. The definition of design as defined in Section 2(d) read with application for registration and rule 11 with form 1 makes it clear that the design which is registered is to be applied to any finished article which may be judged solely by eye appeal. A conjoined reading of these three provisions makes it clear that a particular shape or a particular configuration is to be registered which is

sought to be produced on any article which will have visual appeal. Such design once it is registered then it cannot be pirated by any other person. But the question is whether it is new or original.

31. In the present case, the complainant relied on the correspondence of the German company which produced the rollers and sold it to the respondent herein and it gave the proprietary right to the present respondent company. 'Proprietor' as defined in Section 2(j) of the Act means that any person who acquires the design or right to apply the design to any article, either exclusively of any other person or otherwise, means, in the respect and to the extent in and to which the design or right has been so acquired. therefore, this right to reproduce this design on an article has been given by the German company to the respondent. But again the question is whether the complainant had discharged their burden to show that this design is not new or original. For this purpose, they only banked upon the letter of the German company which prepared these rollers and **there is no evidence to show that the design which was reproduced on glass sheets was either produced by any other agency. therefore, the expression that ' new or original' in this context has to be construed that whether this design has ever been reproduced by any other company on the glass sheet or not.**

32. There is no evidence whatsoever produced by the complainant either before the Assistant Controller or before any other forum to show that this very design which has been reproduced on the glass sheet was manufactured anywhere in the market in India or in United Kingdom. There is no evidence to show that these rollers which were manufactured or originally designed by the company was marketed by this company to be reproduced on glass sheets in India or even in United Kingdom. This proprietorship of this design was acquired by this respondent from the German company and there is no evidence on record to show that these rollers were used for designing them on the glass sheets in Germany or in India or in United Kingdom.

33. What is required to be registered is a design which is sought to be reproduced on an article. This was the roller which was designed and if it is reproduced on an article it will give such visual feature to the design. No evidence was produced by the complainant before the Assistant Controller that anywhere in any part of the world or in India this design was reproduced on glass or it was registered anywhere in India or in any part of the world. The German company only manufactured the roller and this roller could have been used for bringing a particular design on the glass, rexine or leather but we are concerned here with the reproduction of the design from the roller on glass which has been registered before the registering authority. therefore, this design which is to be reproduced on the article i.e. glass has been registered for the first time in India and the proprietary right was acquired from the German company. We have gone through the letter of the German company and it nowhere says that this was reproduced on a glass sheet. No evidence was produced by the complainant that this design was reproduced on a glass sheet in Germany or in India. The contents of the letter are very clear. It shows that it was designed in 1992 and was marketed in 1993. But there is no evidence to show that this design was reproduced on glass sheet anywhere in Germany.

35. The expression, 'design' has come up for interpretation in English courts. The expression, design is almost pari materia with the definition of design in the Indian context. The expression, 'design' in the English Act which is known as the Registered Designs Act, 1949 reads as under:

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

(a) a method or principle of construction or

(b) features of shape or configuration which

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

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

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

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

Xx xx xx

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

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

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

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

[*Pugh v. Riely Cycle Co Ltd.* (1912) 29 R.P.C. 196]

Accordingly, it is submitted that a design is an idea or conception as to features of shape, configuration, pattern or ornament applied to an article. Although that idea, while still in the author's head, may be potentially capable of registration, in fact it must be reduced to visible form to be identifiable, and until it is so reduced there is nothing capable of registration, It may be so rendered either by its being embodied in the actual article, or by its being placed upon a piece of paper in such a way that the shape or

**other features of the article to be made are clear to the eye.** Whenever the means of identification (under some of the old Acts, provision was made whereby a mere verbal description could in some cases be accepted as sufficient), as soon as the idea is reduced to a form which is identifiable, there is something which is a "design", and which, if new or original, may be registrable.”

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

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

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

of the idea or suggestion which he has to establish as new or original;"

Therefore, the concept of design is that a particular figure conceived by its designer in his mind and it is reproduced in some identifiable manner and it is sought to be applied to an article. therefore, whenever registration is required then those configuration has to be chosen for registration to be reproduced in any article. **The idea is that the design has to be registered which is sought to be reproduced on any article. therefore, both the things are required to go together, i.e. the design and the design which is to be applied to an article.**

37. In the present case, the design has been reproduced in the article like glass which is registered. This could have been registered with rexin or leather. therefore, for registration of a particular configuration or particular shape of thing which is sought to be reproduced on a particular article has to be applied. As in the present case the design sought to be reproduced on a glass-sheet has been registered and there is no evidence to show that this design was registered earlier to be reproduced on glass in India or any other part of the country or in Germany or even for that matter in United Kingdom, therefore, it is for the first time registered in India which is new and original design which is to be reproduced on glass sheet. therefore, the submission of learned senior counsel for the appellant, Mr. Gupta cannot be accepted that this design was not new and original.

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

produced the design reproduced on glass-sheet it manufactured in United Kingdom or Germany. That could have been decisive.

45. The next evidence which was lead by the appellant was a website had been downloaded from the United Kingdom Patent Office effecting patent that may be applied to glass sheets. No evidence has been produced to show that M/s.Vegla Vereinigte Glaswerke Gmbh had manufactured this design in glass sheet or not. It is only a design downloaded from the website of the Patent office in U.K. and it is not known whether it was reproduced on glass-sheet in U.K. or not. In this connection, the Assistant Controller has only observed that he has made a visual comparison of the U.K. registered design No. 2022468 with the impugned design No. 190336 and he was satisfied that both the designs make same appeal to the eye and there was sufficient resemblance between the two designs. therefore, the Assistant Controller held that the impugned design was prior published and it could not be said to be new or original. The Assistant Controller further observed that the proprietor of this design had not been able to make a difference between the U.K. design and the present design. This was not accepted by learned Single Judge of the Calcutta High Court and for the good reason. It was observed by learned Single Judge as under:

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

The visual effect and/or appeal of a pattern embossed into glass sheets by use of embossing rollers could be different from the visual effect of the same pattern etched into glass

sheets manually. The respondent No. 1 has not considered these factors.

The order impugned considered with the materials on record, including in particular the computer print outs clearly reveals that the respondent No. 1 has only compared the pattern and/or configuration considered the visual appeal thereof, but not the visual appeal of the pattern and/or configuration on the article. In other words, the Respondent No. 1 has not considered the visual appeal of the finished product.

There are no materials on record to show that the design had previously been applied to glass sheets. On the other hand, an affidavit was sworn on behalf of the appellant by a Liaison Executive affirming that he had ascertained that the proprietor of the design registered in the United Kingdom had never manufactured glass sheets of the design registered.”

From this it appears that in fact the pattern of the design which is reproduced on the glass-sheet and the design and the pattern which was reproduced on the glass-sheet of the United Kingdom was not common.

46. The affidavit sworn on behalf of the respondent herein, the liaison Executive that he had ascertained from the proprietor of the design registered in United Kingdom and they have never manufactured glass-sheet of the design registered. This affidavit evidence of the Liaison Executive of the respondent company has remained un-rebutted. Secondly, the learned Assistant Controller has not properly compared the two designs that on what comparison he found that the same configuration or pattern are identical with that of the impugned design. Simply by saying visually one can liable to commit the mistake but if the comparison is to be judged whether the pattern of the United Kingdom and that

of the present pattern is three dimension or not. Both the designs were placed before us as was done before the High Court also. Learned Single Judge recorded its finding after seeing both the designs that there is distinguishable difference between the two. Similar attempt was made before us to show that both the designs i.e. one that is published in United Kingdom and the impugned design are identical.

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

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

clarity for the same to be said to be prior publication for seeking cancellation on the basis of such alleged prior publication of a design registered in India.

22. What has been observed by the Supreme Court in the case of *Bharat Das Tools Ltd.* is reinforced by the following paragraphs of

*Russell-Clarke and Howe on Industrial Designs VIIIth Edition:*

What counts as “published” for the purpose of calling into question the novelty of a later design registration? This is broader than the word at first suggests. It is by no means limited to the publishing of a design in a printed publication, although it includes that. In practical terms, there are two main ways in which a design can be published: by prior use of the design, by selling or displaying to the public articles to which the design has been applied; and by paper publications of one sort or another. It is not, in fact, necessary that publication should be on paper; an oral disclosure, provided it is non-confidential, will amount to publication.

3-097

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

A special exception existed to the general rule that the novelty of a design will be destroyed by the prior registration or publication of that design as applied to any kind of article. By S.4(1) of the RDA(A), the proprietor of a registered design was entitled to apply for registration of the same design, or a design with modifications or variations not sufficient to affect its identity, in respect of another article. His own previous

3-105

registration, or the publication of his design as registered, does not then destroy the novelty of his new design registration in respect of the new article, but his term of protection is limited to the term of the original design. This, in effect, gave the proprietor of a design registration the ability to extend the scope of the registration during its lifetime to cover further articles, although in formal terms each application to protect his design on a new article will be a separate application leading to a separate design registration. It appears that his application for registration of the design on the new article must precede his actual use of the design on the new article. This is because, if he uses the design on an article which falls outside the scope of his earlier registration, then that will not count as a publication “of the registered design”, which is all that s.4(1) of the RDA(A) shields him against as regards the novelty of his new application. 3-106

A person who makes an application to register a design and finds that it has previously been registered in respect of a different article was allowed to buy up the earlier design registration while his own application was still pending, and if he did so he could take advantage of this rule in the same way as if he had himself been the owner of the earlier registration all along. 3-107

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

In *Sebel Ltd's Application (No.1)*, it was held that substitution in the old design of a different stand did substantially alter the identity of the article (a rocking horse), and that the subsection did not apply. Since the stand had already been published in an advertisement showing it applied to another horse, it was held that design failed to qualify for novelty under s.1, the said stand being a mere trade variant. In *Sebel Ltd's Application (No.2)*, a design was held not to fall within s.4 because the character of the design was different from the character of the applicant's earlier design. Thus it seems that the applicant's own earlier design may be sufficiently similar to destroy the novelty of his later application for protection of his modified design, and yet too different to allow him to take advantage of the protection of RDA(A) s.4(1). This is an odd and unfortunate result if it is indeed correct. 3-108

### **Publication in documents**

In cases of publication of a design by prior use as applied to an article, normally the only questions which arise are whether it has been published at all (i.e whether the articles to which it has been applied have been disclosed to the public), and whether the design is similar enough to the design in suit to destroy the latter's novelty. But where the novelty of a design is tested against a prior published document, a number of additional questions can arise which do not arise in the case of a prior use. 3-109

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

But the publication in a document of a pattern or picture does not as such destroy the novelty of a design which consists of applying that pattern or picture **to an article**. For it to destroy the novelty of such a design, the paper publication must suggest explicitly or implicitly by context that the pattern or picture should be applied **to an article**. 3-110

Secondly, the pattern (if it is two-dimensional) or shape (if it is three-dimensional) of the design may not be clear from the document. Particularly in a case where it involves a written description rather than an explicit picture or illustration, there may be room for argument as to the precise nature of the design which the document discloses, before one can go on to ask whether or not it is similar enough to the later design to destroy novelty. 3-111

Thirdly, a paper publication may be shielded from destroying the novelty of a later design registration by the special provisions of subss.6(4)-(5) of the RDA(A). These provisions allowed the owner of copyright in an artistic work to exploit his work so long as he did not apply it industrially to an article, without his own exploitation of it counting against the novelty of his own later application for a design registration covering the artistic work as applied to an article. 3-118

### **Does the document disclose a design applied to an article?**

In order to destroy the novelty of a design registration, an earlier design must be published “in respect of the same or any other article”. Mere publication of the pattern which constitutes the design was therefore not sufficient to destroy the novelty of a design registration, which consisted of the application of that pattern to an article. In principle, the same

holds true of the publication of a shape, although it is less easy to envisage cases where the publication of a shape does not implicitly convey the article to which that shape is to be applied. Thus, novelty may reside in the application of an old shape or pattern to new subject-matter. This was first laid down in the leading case of *Saunders v Wiel*. There, the design consisted of the handle of a spoon made to represent Westminster Abbey seen from a particular point of view. The design had actually been copied from a photograph of the Abbey. 3-119

The validity of the design was upheld, Bowen L.J. saying

“It seems to me that the novelty and originality in the design, within this section, is not destroyed by its being taken from a source common to mankind...The novelty may consist in the applicability to the article of manufacture of a drawing or design which is taken from a source to which all the world may resort. Otherwise, it would be impossible to take any natural or artistic object and to reduce it into a design applicable to an article of manufacture, without also having this consequence following, that you could not do it at all in the first place unless you were to alter the design so as not to represent exactly the original; otherwise there would be no novelty in it, because it would be said that the thing which was taken was not new. You could not take a tree and put it on a spoon, unless you drew the tree in some shape in which a tree never grew, nor an elephant unless you drew it and carved it of a kind which had never been seen. An illustration, it seems to me, that may be taken about this is what we all know as the Apostles spoons. The figures of the Apostles are figures which have been embodied in sacred art for centuries, and there is nothing new in taking the figures of the Apostles, but the novelty of applying the figures of the Apostles to spoons was in contriving to design the Apostles’ figures so that they 3-120

should be applicable to that particular subject-matter. How does a building differ from that? In no sense it seems to me.

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

3-121

### **What design is disclosed by a prior published document?**

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

3-122

or similar enough to the registered design in suit to deprive it of novelty.

This was laid down in *Rosedale Associated Manufacturers Ltd v Airfix Ltd*. Lord Evershed M.R. said

“In this respect the test of prior publication of an alleged invention should, in my judgment, be no less applicable in the case of a registered design, and as regards the former, I venture to cite once more the oft-quoted language of Lord Westbury in *Hills v Evans*: ‘The antecedent statement must, in order to invalidate the sub-sequent patent, be such that a person of ordinary knowledge of the subject would at once perceive and understand and be able practically to apply the discovery without the necessity of making further experiments.’ By a like reasoning, to my mind, if a document is to constitute prior publication, then a reader of it, possessed of ordinary knowledge of the subject, must from his reading of the document be able at least to see the design in his mind’s eye and should not have to depend on his own originality to construct the design from the ideas which the document may put into his head.”

3-123

On the same point Romer L.J. said:

“In *Flour Oxidising Co v Carr & Co* Parker J. (as he then was) said: ‘Where the question is solely a question of prior publication it is not, in my opinion, enough to prove that an apparatus described in an earlier specification could have been used to produce this or that result. It must also be shown that the specification contains clear and unmistakable directions so to use it.’ These observations by Parker J. were cited with approval by Lord Dunedin in *British Thomson Houston Co v Metropolitan-Vickers Electrical Co*, and again (when

delivering the judgment of the Judicial Committee) in *Pope Alliance Corporation v Spanish River Pulp & Paper Mills, Ltd.* In the latter case and at the same page Lord Dunedin posed the test as follows: ‘would a man who was grappling with the problem solved by the Patent attacked, and having no knowledge of that Patent, if he had had the alleged anticipation in his hand, have said “that gives me what I wish”? It is true that these citations were related to anticipation of inventions, but it seems to me that they apply by analogy to alleged anticipation by “paper publications” of registered designs.’ 3-124

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

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  
*FAO (OS) No.458/2009* *Page 65 of 67*

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.

25. So far as the merits of the present case of existence of prior publication in the facts of the present case are concerned, we find that Division Bench has approved the decision of the learned Single Judge of existence of prior publication in the facts of the present case because the spatula in question was found in actual use prior to registration in India, and with respect to which the relevant observations are made by the Division Bench in paras 12 and 15 of the judgment/reference order of the Division

Bench dated 8.10.2010. We may, of course, hasten to add that any  
*FAO (OS) No.458/2009* *Page 66 of 67*

observations made in an interim order are always prima facie in nature and are made only for the purpose of disposing of an interim injunction, and the issue of prior publication in the facts of the present case will be finally decided uninfluenced by any observations qua the factual aspects made at the interim stage as to existence of the spatula abroad after evidence is led by both the parties in this case.

26. Let the parties appear before the learned Single Judge on 17<sup>th</sup> April, 2013 for further proceedings in the suit.

**VALMIKI J. MEHTA, J**

**SANJIV KHANNA, J**

**S.P. GARG, J**

**MARCH 15, 2013**  
ib/Ne/ak