

Itc Limited Vs. The Controller of Patents and Designs and Ors.

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Court : Kolkata

Decided On : Mar-06-2017

Judge : Soumen Sen

Appellant : Itc Limited

Respondent : The Controller of Patents and Designs and Ors.

Judgement :

IN THE HIGH COURT AT CALCUTTA SPECIAL JURISDICTION ORIGINAL SIDE
BEFORE: THE HONBLE JUSTICE SOUMEN SEN AID No.10 of 2016 ITC
LIMITED VS. THE CONTROLLER OF PATENTS AND DESIGNS & ORS. For the
Petitioner : Mr. S.N. Mookherjee, Sr. Adv., Mr. Ranjan Bachawat, Sr. Adv., Mr.
Sayan Roy Chowdhury, Adv., Mr. Shaunak Mitra, Adv., Mr. Paritosh Sinha, Adv.,
Ms. Mitul Das Gupta, Adv., Ms. Sreemoyee Roy Chowdhury, Adv., Mr. K.K.
Pandey, Adv., Ms. Aparna Banerjee, Adv., Mr. Debayan Ghosh, Adv., For the
Respondent No.3 : Mr. Abhrajit Mitra, Sr. Adv., Ms. Rajshree Kajaria, Adv., Mr.
Satadeep Bhattacharya, Adv., Ms. V. Mohini, Adv., Ms. Jasmine Malik, Adv, For
the Respondent Nos.1 & 2 : Mr. Rabi Prasad Mookerjee, Adv. Heard On :

09. 12.2016, 16.12.2016, 20.12.2016, 21.12.2016, 23.12.2016. Judgment On :

6. h March, 2017 Soumen Sen, J.:- This is an appeal under Section 36 of the
Designs Act, 2000 from a decision of the Deputy Controller of Patents and
Designs on 14th June, 2016 in respect of an application filed by the appellant

under Section 19 of the Designs Act, 2000 for cancellation of the Registered Design No.196859. The design in question was registered on 8th March, 2004 for the article Cigarette Pack. in Class 27-06 in the name of Phillips Morris Products S.A., a corporation organized under laws of Switzerland. The said application for cancellation was filed on 30th November, 2012. The Controller has dismissed the said application. The grounds stated in the petition for cancellation under Section 19 of the Designs Act, 2000 were:- 1. That the design was published in India or in any other country prior to the date of registration.

2. That the design is not a new or original design.

3. That the design is not registrable under the Designs Act, 2000. (hereinafter referred to as the said Act.) The point here is this: the design is for a cigarette pack. There is apparently, prior published designs known to the world through prior publication based on German Patent Application No.1008196 dated 13th February, 1952 and published on 9th May, 1957, UK Registered Design No.2038787 dated 30th April 1994 published on Official Journal No.5517 dated 4th January 1995, UK Registered Design No.2026527 dated 17th October 1993 published on Official Journal No.5453 dated 29th September 1993 and Appellants 20s cigarette pack under its brand CLASSIC published by way of advertisement on 1st August 1995 which on examination by the controller were found to be different from the impugned design. The Controller although harboured doubts about publication of UK registered design Nos.2038787 and 2026527 registered on April 30, 1994 and 17th October, 1992 respectively depicting a pack for smoking articles considered both the German patent specifications as well as UK registered designs and did not arrive at a definite finding but opined that the impugned registration cannot be considered to be devoid of newness. Mr. S.N. Mookherjee, learned Senior Counsel appearing with Mr. Ranjan Bachawat, learned Senior Counsel, on behalf of the appellant/petitioner submits that the Deputy Controller has gone along comparing the minute details of the said designs with the impugned designs and has only highlighted the small differences and not the substantial similarities of the said designs with the impugned design. The Controller has not compared the said designs and the impugned design as a whole even though the alleged novelty in the impugned design resides in the

shape, surface pattern, configuration and/or colour combination of CIGARETTE PACK. as illustrated. I was referred to the decision of the Bombay High Court in *Harish Chhabra vs. Bajaj Electricals Ltd.* reported at (2005) 5 Bom CR153(Paragraphs 5-6) where the learned Single Judge following the decision in *William J.*

Holdsworth v. Henry C. M'crea, 1887 Vol. II English and Irish Appeal 380 at page 388 observed that the designs are to be compared as a whole in order to ascertain if the said design is new or original. *Castrol India Ltd. vs. Tide Water Oil Co. (I) Ltd.* reported at 1996 (16) PTC202 was referred to in which the same principle was reiterated following *Benchairs Ltd. v. Chair Center Ltd.* reported at 1974 RPC429 In *Benchairs Ltd. (supra)* it was heldthe question whether or not the design of the defendant's chair is substantially different from that of the plaintiff is to be answered by consideration of the respective design as a whole.. The view expressed in *Castrol India (supra)* has been approved in *Rotomac Pens Ltd. vs. Milap Chand* reported at (1999) 19 PTC757 My attention has been drawn to the following observation of the Honble Division Bench :- It is not necessary to break the articles down into integers for descriptive purposes but in the ultimate result it is the article as a totality that must be compared and contrasted with the features of a shape and configuration shown in the totality observable from the representation of the design as registered.

. It is argued that the Controller has not looked at the design as a whole and not examined the functionality of the features. The learned Senior Counsel has referred to a Single Bench decision of this Court in *Western Engineering vs. Paul Engineering* reported at AIR1968 Cal 109 and submitted that in the said decision it has been held that the sameness of features is to be decided by the eye that is to say by seeing the two and getting a total synoptic view of the same. The sameness of features does not necessarily mean that the two designs must be identical on all points and differ on no point. The learned Senior Counsel on the aspect of prior publication submitted that a design is deemed to have been published if the knowledge was, in fact, shown and disclosed to some individual member of the public who was under no obligation to keep it a secret and that it is not necessary that the design should have been actually used. The observation in

Pressler & Company Ltd. -Vs- Gartside & Company (of Manchester) Ltd. And Widd and Owen Ltd. reported at 50 RPC240 to the effect that publication in a private library where design is open for inspection was also held to be prior publication has been relied upon to justify that having regard to the German and UK registered design publications and the petitioners cigarette pack under its brand Classic, the design could not have been registered as it has already been published abroad as also in India prior to the date of registration. The next contention is that the impugned design is not new or original. The learned Senior Counsel has referred to the German and UK registrations and submits that at best it can be said to be a combination of known designs, which design registration is prohibited under section 4(c) of the Designs Act 2000. In any event, the impugned design is not significantly distinguishable from known designs or combination of known designs. The learned Senior Counsel relying upon Sebel & Coy. Ld. reported at 1959 RPC12 submitted that a design showing merely a combination of known features and without any real mental activity being required for its production is not registrable. The observation in Western Engineering (supra) that if the same shape or pattern or one substantially similar, has previously been thought of in connection with any article of manufacture and the idea published, or registered, then the design will be deprived of its novelty has been relied upon. The learned Senior Counsel submits that in order to render a registration valid there must be novelty and originality. It must be a new or original design which means that there must be a mental conception expressed in a physical form which has not existed before, but has originated in the constructive brain of the proprietor. The decision of the Delhi High Court in B.Chawla v. Bright Auto Industries, reported at AIR1981 Del 95 reiterating this principle following Simmons v. Mathieson and Cold reported at (1911) 28 RPC486 and Phillips v. Harbro Rubber Company reported at (1920) 37 RPC233 has been relied upon wherein it was stated that the introduction of trade variants into an old design cannot make it new or original. It is submitted that a slight trivial, infinitesimal variation from a pre-existing design will not qualify it for registration and in this regard reliance is placed on Steelbird Hi-tech India Ltd. vs. SPS Gambhir, reported at 2014 (58) PTC428(Del). It is submitted that Courts have consistently held that in a matter of novelty, the eye is to be the ultimate test and the determination has to be on the

normal ocular impression. In order to know its newness or originality it is necessary that a design identical with or even materially similar to the relevant design should not have been published or registered previously. The ocular comparison of the prior published design with the registered design has to be done by an instructed person./ skilled person.. It is always desirable that the controller refers the matter for an expert view before taking any decision. The aforesaid argument has been elaborated by referring to Section 4(c) of the Designs Act,2000, which prohibits registration of a design if it is not significantly distinguishable from known design or combination of known design. The learned Senior Counsel referring to Section 2(d) of the said Act submitted that the definition of design makes it clear that in order to claim novelty or originality, the finished article should be appealing to the eye and are judged solely by the eye. If the design is functional in nature and is, in substance, a mere mechanical device it shall not be considered to be a design under Section 2(d) of the Designs Act, 2000 and hence is not registrable. In order to show that the design lacks novelty reference was made to the application filed by the respondent for registration. It is submitted that the impugned design consists of components which, inter alia, include the side hinge, a semi circular extended tab, a cut out of the outer pack and a cut out on the collar. The side hinge and the semi circular extended tab are functional in nature and are nothing but mere mechanical device. The lid is operated by the hinge and the semi circular tab can be push fitted around the collar portion to close the pack and the action of closing is guided by the side walls of the box neck merely by lightly pressing the lid downwards such that the lid sits on the body around the collar portion. Lord Reid, J.

in *Amp. Inc. v. Utilux Pty. Ltd.* (1972 RPC103 quoted with approval in *Castrol India* (supra) has been relied upon the manufacture of electric terminals. The following observation of Lord Reid J.

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

. The evidence of prior publication provided by the petitioners before the Controller clearly depicts the design applied to packets with smoking articles in it. The pictures and drawings explicitly depict the use of the design to the articles. Further, the literature of the German Patent Specification clearly instructs how the design is to be applied to cigarette packets. The learned Senior Counsel submits that the cigarette pack of the respondent with the impugned design that was produced for the first time during the hearing of the appeal on a closer look at the said pack would demonstrate that the said semi circular tab was functional in nature and the tab along with the cut out on the outer pack was the only way the lock function mechanism could be performed. Once the packets were seen in the closed form, as customers would see it when sold, it is beyond a shadow of doubt that the two designs are substantially similar in every way if not identical. It is further submitted that with the presence of the respondents cigarette pack with the impugned design before the Appellate court, the eye of the Appellate court becomes an eye of a higher instructed person. Per contra, Mr. Abhrajit Mitra, the learned Senior Counsel appearing on behalf of the respondent No.3 submits that although references have been made to German Patent and UK registration designs but in the cancellation application there is a single sentence averment at Paragraph 4(B)(I)(a)(iv) on CLASSIC Packets. The rest of the averment is a detailed comparison of the German registered design and the 2 (two) UK registered designs with the help of drawings of the said registered designs and photographs of Respondent No.3's Marlboro registered design. No endeavour has also been made to identify the similarities between Respondent No.3's registered designs on the one hand and the Appellant's own CLASSIC packets on the other hand. The reason is obvious i.e. no apparent similarity. It is settled law that distinction between Sections 19(1)(a) and 19(1)(b) is that mere registration of a prior design in India would be sufficient to warrant cancellation of the subsequent registered design. For designs registered outside India, mere registration is not sufficient. Under section 19(1)(b) the foreign design also has to be published in India or in any other country. The judgment of the Calcutta High Court in Gopal Glass Works Limited versus Assistant Controller of Patents and Designs & Ors. reported at 2006 (33) PTC434 Paragraphs 33, 39-44 highlights the above distinction between Section 19(1)(a) and Section 19(1)(b). As per this judgment, the prior publication

has to be either in tangible form or by way of photographs or explicit pictures in the form of illustrations in a trade catalogue, brochure, book, journal, magazine or newspaper subject to the illustration clearly depicting the Design. The learned Senior Counsel has referred to the decision of the Honble Supreme Court in Bharat Glass Tube Ltd. Vs. Gopal Glass Works Ltd. reported at 2008 (10) SCC657 Paragraphs 7, 29, 30, 31, 32, 33, 46 and 47 and submits that the view of the learned Single Judge has been affirmed by the Honble Supreme Court. Dabur India Limited vs. Amit Jain and Anr. reported at 2009(39) PTC104 Paragraph 24-26 is also relied upon to show that the principle laid down in Gopal Glass (supra) has been followed in subsequent decisions by other Courts. In the same vein, a Full Bench decision of the Delhi High Court in Reckitt Benkiser India Ltd. Vs. Wyeth Ltd. reported at AIR2013 Delhi 101 (FB) Paragraph 19(i), (ii) has been placed. Mr. Mitra has referred to Section 4(b) of the Act and submits that the expression ...or in any other way...

., to be found in Section 4(b), is qualified by the expression a design which ...

.. Drawings alone do not meet the definition of "design" under Section 2(b). To be a design, it has to be "two dimensional or three dimensional or in both forms" [Section 2(b)]. Thus, a drawing alone does not qualify as a design. Drawing alone can be registered as a copyright in the category of "artistic work". Section 15 of the Copyright Act, 1957 makes it clear that a drawing which is an original artistic work would cease to be so under the Copyright Act, 1957 when it is applied to an article. If the finished article appeals to the eye then the features, shape, configuration, pattern, ornament, composition of lines and colour applied to the article would constitute a design under The Designs Act. In other words, a set of drawing which may constitute artistic works registrable under the Copyright Act, once applied to an article, the drawings cease to be artistic works but the features of the finished article may become registrable as a design under The Designs Act. The drawings of the German and the drawings of the two UK Registered Designs unless applied to a cigarette packet could never assume the character of design. within the meaning of Section 2(d) read with 2(a) of The Designs Act, 2000 which can be disclosed to the public in any way . [Section 4(b)]. What has to be disclosed is the Design of the finished article, the article to which the drawings

have been applied, which disclosure/publication going by the case of Gopal Glass Works (supra) would include publication of the design in trade catalogue, brochure, magazine etc. There is no evidence of publication, whether in India or abroad, of the German design and the two UK registered designs. What the Appellant has shown vis-a-vis publication is restricted exclusively to the drawings forming part of the applications that were made for registration of the said three designs. The appellant has annexed a certified copy of the registered design of the German Patent application with one drawing. In the cancellation application, there is no mention of any form of publication even in any official journal or a library or official website, leave aside publication of the design i.e. the article to which the drawing of the design has been applied. In this regard, reference is made to Paragraph 41 of Gopal Glass (supra) which reads:- 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.

. There is no other publication disclosed in the evidence filed before the Controller. However, in the Appellant's Notes of Argument, there is a whisper (without any supporting document) of the German design being available on the "European Patent office website", to be found at the top of Pg 195. Even now, there is no documentary evidence to support this bare contention. In support of UK registered design No.1 it is submitted that it would appear that the Appellant has obtained a certified copy of the said registered design from the office of the Comptroller General of Patents, Designs and Trademarks, UK. This design appears to have been published after registration on 4th January 1995 in the "Official Journal (Patents)". In this journal the drawings of the design have not been published. In support of UK registered design No.2 it is submitted that the submission made in respect of UK registered design No.1 also equally applies with regard to the said UK design application. There is no evidence of publication of even the drawings, leave aside the design after being applied to the finished articles in question. It appears that even the drawings are not available to the public at large in the

concerned foreign countries where the designs have been registered. Without prejudice to the contention that the German registered design and the 2 (two) UK registered designs are not relevant, these having not been published at all in any country, it is submitted that these registered designs, even if they had been applied to cigarette packets. / pack for smoking articles., would not have shown similarity with the Respondent No.3's registered design. The Controller is deemed to be a "skilled person" having knowledge and experience in the matter. There is no allegation to the contrary in the appeal. Consequently, the Controller's judgment, unless it is found to be "wrong in principle", should not be interfered with as observed in In The Matter Of An Application by Games Balls Co. Ltd. reported at 45 RPC26at page 30 and Reckitt Benckiser Australia Pty. Ltd. Vs. Controller of Patents and Designs [2016 SCC Online CAL5455. Had the German and UK registered designs been in fact published, then in that case the test that would have to be applied in a case of cancellation of Respondent No.3's designs by relying upon the prior publication of the German and UK Designs would be as is commonly known as "Very Designs" test. The design in question "as a whole with all its component features, important and unimportant" would have to be compared with the earlier published designs. That is also what the Controller has done. Thereafter, if it is found that the design in question is the "very design" that was earlier published, then that would be a ground for cancellation under Section 19(1)(b). The learned Senior Counsel in this regard has relied on the following decisions:- i) Vikas Jain vs. Aftab Ahmad & Ors. [2008 (37) PTC288 Paragraph 11].; ii) Troikaa Pharmaceuticals Ltd. Vs. Pro Laboratories (P) Ltd. & Anr. [2008(3) GLR2635= MANU/GJ/0364/2008 Paragraph 29].; iii) Rosedale Associated Manufacturers Ld. V. Airfix Products Ld. [1957 (10) RPC239at 244].. The decision of the Bombay High Court in Videocon Industries Ltd. Vs. Whirlpool of India Ltd. reported at 2012 SCC OnLine Bom 1171, Paragraphs 14 to17 has been relied upon for interpretation of section 4(c) of the Designs Act, 2000 which deals with combination of known designs. In dealing with the submission made that design is bad for it being in respect of the whole cigarette pack and not only part of it where the novelty resides and that open views of the design could not have been registered. It is submitted that this contention has never been made before the Controller. In any event, it is a mixed question of law and fact and the same cannot

be urged for the first time in appeal and this regard the learned Senior Counsel has relied upon the decision in Mahamaya Paul vs. Dipak Kumar Mukherjee & Ors reported at MANU/WB/0881/2012 Paragraphs 19 and 20. Mr. Mitra has submitted that Design can be claimed only in that part of the design where the novelty resides. This, of course, being restricted to cases where the design is constituted of independent integral parts put together. A registered design can also be had of the entire article without any further limitation or description. The consequences of the two cases would be different. While in the former case, the design, when applied to some other article, would also constitute infringement, in the latter case, to constitute infringement, the infringing article would have to be the exact copy of the registered design of the entire thing. For example, if Respondent No.3 had obtained registration of the design that resides in the lid and the collar of the cigarette packets instead of the entire cigarette packet, then in that case Respondent No.3 would have been in a position to file an infringement action against a third party who copies the Respondent No.3's registered design of the lid and the collar and applies this infringing design to say a long pencil box. However, with the Respondent No.3's design as registered, infringement action would have to be restricted to cases where infringing article is a cigarette pack coupled with the same having substantial similarity with the Respondent No.3's cigarette pack, both being compared in their entire form. This is explained very lucidly in the aforesaid judgment of William J.

Holdsworth & Ors. Vs. Henry C. M'crea [1867 (2) English and Irish Appeal 380 at pages 387 and 388 of the report].. Even in the German registered design and the UK registered designs, so heavily relied upon by the appellant, novelty is said to reside in the shape and/or configuration of the whole article i.e. "pack for smoking articles". There is a Manual of Designs, Practice and Procedure published by the Office of the Controller General of Patents, Designs and Trade Marks, relevant extracts wherefrom have been handed over to the Court and the Appellant at the time of hearing to show the extent of detailed examinations made of a design before registration. The application has to pass through rigorous tort in the hands of experts. Mr. Mitra submits that the entire cigarette packet with the Respondent No.3s registered design, i.e. Marlboro packet (closed) should have been compared with the German and UK registered designs instead of comparison of

various features in the open packet and since cigarette packets are sold as closed packets, the novelty and visual appeal has to be adjudged by comparing the closed packets only is wholly misplaced since the Appellant itself in its cancellation application consciously did not compare the closed Marlboro packet with the drawings of closed UK packets but went for feature wise comparison only of the open packets. The Appellant is estopped from arguing a new point in the appeal contrary to its case in the cancellation proceedings before the Controller. On the aspect of functionality of the design it is submitted that the appellant before the controller contended that it is the hinge part of the cigarette packet and not the flick open mechanism which can be treated as the functional part of the design. Only on that premise in the cancellation application it has been claimed that it is a functional design. This has been done completely overlooking the fact that the German design and two UK registered designs have the same hinge mechanism used for opening and closing of the cigarette packet. In the Appellants evidence there is no mention as to what part of the design is claimed as functional. The learned Senior Counsel submits that the features of the flick open mechanism are not guided by functionality but by the aesthetics. In other words, this flick open mechanism could have been achieved by features other than that forming part of the design. It is not the Appellants case that the feature of the Flick Open Mechanism. is the only option available to achieve the opening function even though the person challenging the design as functional has to prove this. The onus is on the appellant which it has failed to discharge. The following observation of the Bombay High Court in Whirlpool of India Ltd. Vs. Videocon Industries Ltd. reported at (2015) 1 Bom CR137 is relied upon in support of the aforesaid proposition:- For the defence of functionality to succeed, it is essential for the Defendant to establish that the design applied for. is the only mode/option which was possible considering the functional requirements of the products. Even otherwise, as submitted by the plaintiff assuming that the shape also performs a certain function, that by itself is not determinative of the fact that the design is functional if that is not the only shape in which the function could be performed. In the case of Cow (P.B.)and Coy Ltd. Vs. Cannon Rubber Manufacturers Ltd. 1959 RPC347(cited at page 75 of the majority judgment of the Delhi High Court), the court held that there may be cases where the design while fulfilling the test of

being appealing to the eye is also functional.. In this regard, the learned Senior Counsel has also referred to Cow (P.B.) and Coy Ltd. Vs. Cannon Rubber Manufacturers Ltd. reported at 1959 RPC347 at pages 351 and 354. It is submitted that the Appellant nowhere contended that the features of the Flick Open Mechanism. are the pre-dominant features of the design of the whole cigarette packet. In fact, features of the Flick Open Mechanism are only one of the many features which comprise the Respondent No.3s design. It is submitted that, in fact, ITC Limited has itself got registered about 43 designs of cigarette packets [closed packets as well as open view packets]. which would be evident from the website of the Patent Office, Intellectual Property Building,. Kolkata ([ipindiaservices.gov.in/design search](http://ipindiaservices.gov.in/design%20search)). It shows that apart from ITC Limited, there are other cigarette manufacturers in India who in the usual course would have registered designs of cigarette packets. It would, thus, clearly go to show that the cancellation of registered design has been applied for in this case on grounds novel to Design laws as applied so far in India. Moreover, the application for cancellation is liable to be rejected due to inordinate delay in applying for cancellation. Application for registration of the design was filed on March 8, 2004 (Priority date in European Community Design) by Respondent No.3 and the same was registered on October 24, 2005 (with the registration dating back to March 8, 2004). The registered design of Respondent No.3 was published in the official Gazette No.27 dated July 8, 2006 by the Design Office. The cancellation petition was filed by the Appellant only in December, 2012 i.e. after delay of more than six years. In so far as the application for additional evidence at the appellate stage is concerned, it is submitted that the appellants failed to demonstrate that in spite of due diligence that the said documents could not be placed before the controller. It is submitted that the averment made in the petition that despite exercise of due diligence, the appellant could not procure the said documents and, therefore, the same could not be produced before the controller is contrary to record. The hearing before the Controller in the cancellation proceeding took place on April 11, 2016 and Written Notes of Arguments was filed by the Appellant on May 9, 2016. Thus the Appellant had the opportunity to file the said documents before the Controller which for the reasons best to known to them was not availed of. At any rate, the additional documents sought to be placed on record are those pertaining

to Gold Flake packages which is their own product and was readily available with them. The application has been filed as an afterthought by the Appellant to fill in the lacunae in the case set up before the Controller. The said attempt to place new documents on record by alleging false ground should not be allowed. At any rate, the proposed documents fail to advance the case of the Appellant as they pertain to a front opening cigarette pack whereas the registered design has a side opening. The Appellant had anyways referred to their own Classic Cigarette packets (though not at all followed up by any comparison or evidence) having similar front opening system. The case of Neutrogena Trademark [1984 RPC563at 579]. has been referred where on an application for disclosure of additional evidence in a trademark appeal it was held by the court that application for admission of evidence filed belatedly in the appeal should be allowed only if the applicant furnishes full explanation for the delay as also for non-disclosure of the evidence at the appropriate stage. Section 2(d) defines design. to mean only the features of shape, configuration, pattern, ornament or composition of lines or colours applied to any article whether in two dimensional or three dimensional or in both forms, by any industrial process or means, whether manual, mechanical or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye. Thus, a registrable design as defined by the Designs Act must have reference to some specific article to which it is applied. The article itself does not, however, constitute the design. In *Dover Ltd. v. Nurnberger Celluloidwaren Fabric Gebruder Wolff*, (1910) 27 RPC498 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.

. Accordingly, it can be said 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 authors 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. (King Features Syndicate Inc and Betts v. O. & M. Kleemann Ltd., (1941) 58 R.P.C. 207 at

228) The definition makes it clear that design means the features of shape, configuration, pattern, ornament or composition of lines or colours applied to an article and not the article itself. The definition of design. is applicable to an article in two dimensional or three dimensional forms or in both the forms. Thus, as a general rule, a design consists of: (i) three-dimensional features, such as the shape of a product; (ii) two-dimensional features, such as ornamentation, patterns, lines or color of a product; or (iii) a combination of one or more such features. The design must be such that in the finished article the features of it appeal to and are judged solely by the eye. It does not relate features which are dictated by function. The rationale behind this exclusion is that the point of design protection is to reward and encourage good product design by protecting the skill, creativity and labour of product designers. Design is concerned with both form and function. Design law is not seeking to reward advances in function. A good subject of design must be visually appealing, though it need not be an artistic work or possess artistic merit. In Parle Products Private Limited v. Surya Food & Agro Limited reported at 2009 (40) PTC638(Mad.) (DB) at p.648, the court stated that the purpose of the Designs Act was to protect novel designs devised to be applied to particular articles to be manufactured and marketed commercially. The main concern was what the finished article was to look like and not with what it did. A mere mechanical device or a functional design is not registrable. While pattern or an ornament would ordinarily be applied to an article; shape and configuration becomes the article itself. Design in that sense relate to the non-functional features of the article. Therefore, by necessary corollary, a design which has functional attributes cannot be registered under the Designs Act. This is the essence of section 2(d) of the Designs Act. The protection under the Designs Act is granted only to those designs which have an aesthetic value or otherwise appeal to the eye. There may be, however, cases where the design while fulfilling the test of being appealing to the eye, is also functional. (Mohan Lal v. Sona Paint & Hardwares, AIR2013 Del 143:

2013. (55) PTC61(Del) and Micolube India Limited v. Rakesh Kumar, 2013 (55) PTC61(Del) (FB) at p.75. In *Kestos Ltd. v. Kempat Ltd.*, (1936) 53 RPC139 the court observed that a mere mechanical device is a shape in which all the features are dictated solely by the function or functions which the article has to perform.. In *AMP Incorporated v. Utilux Proprietary P. Ltd.*, (1972 RPC103, the House of Lords approved the above statement of law in *Kestos Ltd.* (supra). The House of Lords held that dictated solely by function. meant attributable to or caused or prompted by function.. The House of Lords further held that where a design would perform a particular function, but the designer had also added some features of shape that appealed to the eye and was additional to or supplementary to the function the design could be registered. In other words, where a designer sets out to produce an article that would perform a particular function, but where in producing it he has added or applied some features of shape that are additional to or supplementary to what is functionally needed, with the result that in the finished article there are features that appeal to the eye, there may be a design which is registrable within the statutory definition. (*Amp v. Utilux*, (1972) R.P.C. 103 at

113) In *Brighto Auto Industries Vs. B.Chawla & Sons* reported at PTC (Suppl) (1) 851 (Del) in Paragraph 12 it was held:-

12.what a substantial difference is, is a question upon which no general principle can be laid down at all; it must depend on the particular facts in each case. In one case a quite small variation in the details of a design may be enough to make the design something quite different from an existing design. On the other hand, there are cases even where quite large alterations in details leave two designs for all practical purposes the same. The Court has to consider and look at the designs in question with an instructed eye and say whether there is or is not such a substantial difference between that which had been published previously and the registered design as to entitle to proprietor of the registered design to say that at the date of registration that was a new or original design and therefore properly registered.

. Good design involves two fundamental elements: the product must perform its function and it should be pleasant to look at and appealing to the eyes.

Predominance and pre-eminence of the aesthetic elements over the functional element would satisfy the definition of design under the Act. The eye alone is to be the judge of identity for the purpose of deciding whether a particular design has been anticipated or not by another has long been settled law. (*Kestos Ltd. v. Kempat Ltd.*, (1936) 53 RPC139. In *Gammeter v. The Controller of Patents and Designs*, AIR1919 Cal.887 it was held by the court: The design should be protected provided it was not merely an analogous and that the test of novelty is the eye of the Judge who must place the two designs side by side and see whether the one for which novelty is claimed is new.

. The word new in relation to a design means a design which is completely new in the sense that it is invented or created for the first time and was hitherto unknown. The word original in relation to a design may mean a new application of an existing or known design to a subject-matter. Thus, a design may not be new in the sense that it is completely new. It may be an existing or known design but has been applied to a particular article for the first time. Such a design, therefore, may be original in the sense that its application to the article is new. A new design is one which comes into existence in public knowledge for the first time, whereas an original design may not be strictly new in the sense that the shape of the design is available in public domain but there is newness or originality in applying the existing design to a particular article which no one thought of before which amounts to newness in creation. (*Reckitt Benckiser (India) Ltd. v. Wyeth Limited*, 2010 (44) PTC589(Del.) (DB) at p.595; *Reckitt Benckiser India Ltd. V. Wyeth Ltd.* 2013 (54) PTC90(Del) (FB) at p.102.). Original means that the design is originated from the author. (*Steelbird Hi-tech India Ltd. v. S.P.S. Gambhir & Ors.*, 2014 (58) PTC428(Del) at p.445). Drawing a distinction between new and original., Buckley L.J.

stated in *Dover Ltd.* (supra), that new referred to cases where the shape or pattern was completely new in itself and on the other hand original referred to cases where though old in itself, it was new in its application to the article in question. The word original contemplates that the person has originated something, that by the exercise of intellectual activity he has started an idea which had not occurred to anyone before, that a particular pattern or shape or ornament may be rendered

applicable to the particular article to which he suggest that it shall be applied. He said:- If the design be new it may be registered under that expression. But the Act by section 49 seems to contemplate that it may be registered, even if it be not new, provided it be original. The explanation of this lies possibly in the fact that the novelty may consist not in the idea itself, but in the way in which, the idea is to be rendered applicable to some special subject-matter. The word original contemplates that the person has originated some thing that by the exercise of intellectual activity he has started an idea which had not occurred to anyone before, that a particular pattern or shape or ornament may be rendered applicable to the particular article to which he suggests that it should be applied... It is easier by illustration in the concrete than by words in the abstract to explain what I mean. First, a few illustrations as to shape. The traditional figure of Falstaff is as old as Shakespeare, but if a person conceived for the first time, the idea of making a wine beaker in the form of the figure of Falstaff, that would be an original design for a wine beaker. The same would be true of an Uncle Toby jug for beer. The words new, or original, involve the idea of novelty, either in the pattern, shape, or ornament itself, or in the way in which an old pattern, shape, or ornament is to be applied to some special subject-matter.

. Their Lordships discussed the concept of new and original in *Gammeter v. The Controller of Patents and Designs*, AIR1919 Cal.

887. In this context, it was observed: A design in order to be new or original within the meaning of the Act, need not be new or original in the sense of never having been seen before as applied to any article whatever, there might be a novelty in applying an old thing to a new use, provided it is not merely analogous.

. In *Saunders v. Wiel* reported in *Reports of Patent, Design and Trade Mark*, Vol. X, No.4, Page 29, it was held that new or original design not previously published did not require novelty in the idea of the design but novelty in the application of the design to some article of manufacturer. If it is found that the design is novel in its application, its novelty and originality is not destroyed by its being taken from source common to mankind. The Supreme Court in *Bharat Glass Tube Limited v. Gopal Glass Works Limited*, AIR 2008 SC2520 (2008) 10 SCC657 2008 (37)

PTC1(SC), held that the expression new or original. appearing in Section 4 means that the design which has been registered has not been published anywhere or it has been made known to the public. The expression, new or original. means that it had been invented for the first time or it has not been reproduced by anyone. The expression 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. The Court further held:- 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. The test of novelty is the eye of the judge who must place the two designs side by side and see whether the one for which novelty is claimed is in fact new. It is a matter of first impression. In *The Wimco Ltd. v. Meena Match Industries*, AIR1983 Del 537, the Court held that in the matter of novelty the eye has to be the ultimate arbiter and the determination has to rest on the general ocular impression. The court has to consider and look at the two designs in question with an instructed eye and say whether there is or there is not such a substantial difference between them that which has been published previously and the registered design to say that at the date of registration that was not published in India previously.

. In *Steelbird Hi-tech India Ltd. v. S.P.S. Gambhir & Ors.*, 2014 (58) PTC428(Del), it was stated that in the matter of novelty the eye was to be the ultimate test and the determination had to be on the normal ocular impression. In order to know its newness or originality it was necessary that a design identical with or even materially similar to the relevant design should not had been published or registered previously. The novelty or originality of the particular part may be sufficient to impart the character of novelty and originality to the whole. (*Walker v. Scott*, (1892) 9 RPC482. In *Hawkins Cookers Ltd. v. Zaverchand Liladhar Shah &*

Ors., 2005 (31) PTC129(Bom), the Court held that it is now well settled that even a slight innovation or improvement in the design is a design by itself and can be registered as independently innovated design.

. Design is a conception, suggestion or idea of a shape and not an article. If it has been already anticipated it is not new or original.. If it has been pre-published it cannot claim protection. A design which is prior published cannot be considered as new. Publication before registration defeats the proprietors right to protection under the Act. (Niki Tasha P. Ltd. v. Faridabad Gas Gadgets P. Ltd., AIR1985 Del 136:1984 (4) PTC87(Del)) Under the designs Act, mere registration of a design abroad would not be a ground for cancellation of design in India unless it is show that the prior design has been published abroad prior to the date of registration. It, thus, follows that prior registration of a design abroad is not a bar. Publication is essentially a question of fact to be decided as per the evidence laid 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. As there is no specific definition of publication in the Designs Act, 2000, any document that is accessed by the public can be considered as publication as held in Gopal Glass (supra). What constitute prior publication has been discussed at length in Paragraphs 41, 42 and 43 in Gopal Glass (supra) which read:-

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.

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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, color scheme, if any, are not clear from the picture illustration, 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. To constitute prior disclosure by publication to destroy the novelty of a registered design, the publication of the design applied to the same article, would have to be in tangible form. 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. 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. In *Rosedale Associated Manufacturers Ltd. v. Airfix Ltd.*, (1957) RPC239 Lord Evershed M.R. observed:- [I]f a document is to constitute prior publication, then a reader of it, possessed ordinary knowledge of the subject, must from his reading of the document be able, at least, to see the design in his minds 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...

. Referring to the *Rosedale* judgment, the court in *Dart Industries Inc. And Another v. Techno Plast and others*, 2007 (35) PTC129(Del) at p.140 observed that a person with ordinary prudence while seeing the designs/documents in question is able to relate, in his minds eye, the same antecedents designs/statements without the necessity of making further experiments i.e., the moment he sees the designs, he is able to at once say Oh! I have seen before.

. The petitioner refers to the one German patent application and two UK registered designs without evidence of publication whether in India or abroad of the said designs. The petitioner relied upon certain drawings forming the part of the applications that were made for registration of the said three designs. The documents disclosed by the appellant/petitioner do not show that the said designs registered abroad were published in tangible form prior to the date of registration of the impugned design and hence they cannot be considered as prior publication. Under the Designs Act, specifications, drawings and/or demonstrations in

connection the registration of a design do not per se constitute publication which prohibit future registration of the design. There would be prior publication only if the prior registered design is made public and has that much necessary clarity as applied to a specified article capable of being 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 a design office, an article can be made using that design which will be a piracy or violation of that design. In other words, 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. In the cancellation application there is no mention of any form of publication even in any official journal or library or official website. The appellant has disclosed certain drawings filed along with the application for registration. Mere drawing cannot be treated as publication. What is essential is the finished article to which the drawings of the design have been applied. As Lindley LJ.

said in *Re Clarkes Registered Design* (1896) 13 R.P.C. 351 at 358, a design applicable to a thing for its shape can only be applied to a thing by making it in that shape. The application may according to the statutory definition be by any industrial process and it must be such that in the finished article it will appeal to the eye, and is to be judged solely by the eye. The design must be new or original. There is no evidence that the drawings of the design have been published in any tangible form, in any catalogue, brochure, book, newspaper, etc. On the basis of the said evidence, in my view, the contention of the appellant that the impugned design is liable to be cancelled on the ground of prior publication must fail. The registration of the same and/or the similar design in India, however, would have been considered as a deemed publication in view of Section 7 of the Designs Act, 2000 which presumption, however, would not apply in respect of the foreign publication when the fact remains that the respondent is unable to produce that apart from the drawings, there is no publication in tangible form of the cigarette pack in any journal, brochure or catalogue abroad or in India. In *Reckitt Benckiser (India) Ltd. v. Wyeth Limited* reported at 2009 (41) PTC24Del it was held:-

25. All these provisions make it clear that once a design is registered in India, it is made open to the public. It is not a secret document. Not only is it kept passively in the records of the Controller but the Controller is required to, as indicated by Rule 22 read with Section 7 of the said Act, publish the same in the Official Gazette. The publication in the Official Gazette would include one or more views of the representation of the design, which, in the opinion of the Controller, would best depict the design. In other words, the statutory provisions in India require the disclosure of a registered design by publication in a tangible form. Thus, if a design is registered in India, it automatically means that it is also published in tangible form.

27. I have referred to the aforesaid provisions as applicable in the UK to indicate that registration can be of two kinds of designs - those which are open to the public and those which are secret. It is obvious that, therefore, registration by itself, in such circumstances, would not amount to disclosure to the public as construed in the Indian context under Section 4(b) of the said Act. Thus, there is possibility that though a design may be registered, it may not be open to the public and in that sense it cannot be considered to having been published. Perhaps, that is the reason why in Section 19(1)(a) prior registration of a design in India is made a ground for cancellation and not prior registration of a design in any other country. Because, in any other country, there may be a law such as in the UK which classifies a design as a secret design which is not open to the public. Previous registration of such a design would obviously, ipso facto, not amount to publication or disclosure to the public.

28. From the above discussion, it can be safely concluded that while a previous registration in India would be a ground for cancellation without looking into the aspect of disclosure to the public or publication in general, a design registered in any other country prior to the date of registration in India, would also be required to have been disclosed to the public by publication in tangible form or by use or in any other way for it to qualify as a ground for cancellation of the subsequent registration in India.

. The distinctiveness of the said design cannot be underscored by referring to the foreign published designs. The appellant before the Controller does not appear to have taken a plea that the design is bad for it being in respect of the whole cigarette pack and not only part of it where the novelty resides and that open views of the design could not have been registered. Ocular impression is the main yardstick in deciding distinctiveness of a design. The Deputy Controller has applied the eye test and on comparison of the competing designs with the impugned design has arrived at the following finding:- The cigarette pack as suggested by the impugned design differs from the box suggested by the cited German document in some noticeable embellishments. Those are: (i) The lid of the impugned design consists of a semi-circular flap on one end opposite to the hinged end. There is a semi-circular cut out at the body for accommodating the flap. (ii) The collar part of the impugned design is curved whereas the box of German specification has rectangular pattern. (iii) There is a cut out at the front end of the collar which is not present in the box of German specification. (iv) The box of German specification consists a slanted top opposite to the hinged part where the lid can be press fit. However, the slanting is not present in the impugned design and entire curvature pattern is different. (v) Due to the additional features, the overall visual impression of the article of impugned design as a whole is different from the box taught by the German specification.

. The argument that apart from the design being taught by German design, the features are essentially functional although appears to be attractive, but as I have indicated, on the whole, I am not satisfied that the appellant here has discharged the onus, which requires, after all, that they should establish this distinctive features, which does seem to the Deputy Controller as well as to me to appeal strikingly to the eye is actually and in reality a feature dictated solely by - that is to say, one adopted upon the sole requirement of - functional ends. The German and UK designs are registered designs. It cannot be said that such designs lack distinctive features. The said designs are not considered to be taught by any other design. The petitioner has failed to establish prior publication of such designs. The result is that the impugned design has to be considered independent of any other prior design. If one ignores the said three foreign designs then one is left with the Appellants 20s cigarette pack under its brand CLASSIC published by way of

advertisement on 1st August, 1995. The design of the said cigarette pack is significantly different from both the German and UK designs. The impugned design may have some similarity with the foreign published designs but as noticed by the Deputy Controller it has some distinctive features which distinguished the impugned design from the foreign published design. There cannot be any doubt that the impugned design has aesthetic appeal which overrides functional consideration. The article is not a mechanical device. The features are not dictated solely by the function that the article had to perform. It is also well-settled that where a design could particularly perform a particular function but the designer has also added some features of shape that appealed to the eye and are additional to or supplementary to the function, the design could be registered. In comparing designs, the visual impact of the two competing designs is what matters. How the two designs are to be looked at, for similarity, is suggested in a case reported in 50 LTR420(Grafton v. Watson) Mr. Justice Chitty said there as follows:- The test is not merely to look at the two designs side by side, though no doubt that is one element of comparison in coming to a conclusion, but it is not the whole test. I think, the designs should be looked together, but then consideration should be given to what would be the effect supposing that they were seen, at different times, or supposing they were looked at a little distance off.. The impugned order of the Deputy Controller has noticed these additional features and it cannot be said that the impugned design is devoid of newness and originality. The overall visual impact of the impugned design with the other designs is not the same. It is also not significantly indistinguishable from the visual impression. It has to be remembered that the respondent No.1 is an expert body and has the required expertise to decide the matter. The said authority on consideration of all aspects of the matter has clearly opined that the design suggested by the foreign designs differs from the impugned design for its features of flaps, cut outs as well as overall visual impression and it cannot be considered to be devoid of newness. The impugned design is significantly distinguishable from features of known designs or combination of known designs. Moreover, it was not substantiated that the design is not originating from the Author of such design. In short, the impugned design is not devoid of newness and originality. The Appellate Court ordinarily will not interfere with the finding of the controller unless it is found that the controller

has proceeded on some wrong principle. The controller must, prima facie, be the judge of novelty having regard to its knowledge and experience in the matter and certainly in this case, I see nothing wrong in principle what the said controller has done. Moreover, it appears that the appellant never contended before the controller that the design is bad for it being in respect of the whole cigarette pack and not only part of it where the novelty resides and that open views of the design could not have been registered. The design as a whole has an eye appeal and innovative and significantly different from the competing designs. I feel that it would be improper to permit the appellant to raise the said new plea at this stage. In fact, the appellant filed the application for cancellation on 30th November, 2012 in respect of the design registered as on 8th March, 2004. There has been a considerable delay and laches on the part of the appellant to approach the controller. The application for additional evidence must also fail as the petitioner has failed to give full explanation for the delay as also for non-disclosure of the evidence at the appropriate stage although allowing such additional evidence would not have made any difference. It is trite to observe that under Order 41, Rule 27, additional evidence could be adduced in one of the three situations, namely, (a) whether the trial Court has illegally refused the evidence although it ought to have been permitted; (b) whether the evidence sought to be adduced by the party was not available to it despite the exercise of due diligence; (c) whether additional evidence was necessary in order to enable the Appellate Court to pronounce the judgment or any other substantial cause of similar nature. It is equally well-settled that additional evidence cannot be permitted to be adduced to as to fill in the lacunae or to patch up the weak points in the case. (Malayalam Plantations Ltd. v. State of Kerala, AIR 2011 SC559 The ratio of the Neutrogena Trademark (supra) also applies in the instant case. Under such circumstances, the appeal stands dismissed. However, there shall be no order as to costs. Urgent Photostat certified copy of this judgment, if applied for, be given to the parties on usual undertaking. (Soumen Sen, J.)