

Western Engineering Co. Vs. Paul Engineering Co.

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Court : Kolkata

Decided On : Mar-10-1967

Reported in : AIR1968Cal109

Judge : S.A. Masud, J.

Acts : Patents and Designs Act, 1911 - Sections 2(5) and 51A

Appeal No. : Matter No. 574 of 1966

Appellant : Western Engineering Co.

Respondent : Paul Engineering Co.

Advocate for Def. : S. Tibriwalla, Adv.

Advocate for Pet/Ap. : Sankar Ghosh, Adv.

Disposition : Petition allowed

Judgement :

ORDER

S.A. Masud, J.

1. This is an application under Section 51-A of the Indian Patents and Designs Act (II), 1911, in which the petitioner has prayed for an order that the Design No. 127199 in respect of a Cycle lock registered in the name of the respondent on

October 10, 1965 be revoked and/or cancelled.

2. The petitioner is a registered partnership firm and carries on its business at No. 9206, Nawabgunge Library Road, Delhi 6. The said firm is the proprietor of a design duly registered under the said Act as Design No. 125728 of May 25, 1965. The said design was and is in respect of locks for cycle and the novelty or the originality was in respect of the shape and configuration of the design of the said locks for cycle as illustrated in the annexure to the certificate of the Controller of Patents and Designs dated May 25, 1965 which are annexed to the petition and collectively marked 'A'. After such registration, the petitioner has been manufacturing commercially the said cycle lock and selling them to the public which involve, according to the petitioner a new and original design as to the shape and configuration of the outer frame of cycle lock comprising, inter alia, the visibility of the outer portion of the devices of lock, i.e., protruding portion of the lock cylinder in which key is inserted for operation. It is the petitioner's case that prior to the introduction of the said design of the lock and its registration it was a common practice in the trade to have the cycle locks having keys on a side of the locks in the plain surface on the main frame of the cycle-locks and without any raised portion. The respondent is also claiming to have a monopoly in the right to manufacture and sale of cycle locks of a design closely similar to or identical with that the petitioner's registered design No. 125728. A photograph of the cycle lock relating to the said design registered in the name of the respondent is annexed to the petition and marked 'B'. The petitioner has challenged the validity of the said design No. 127199 dated October 10, 1965 registered in the name of the respondent on several grounds set out in paragraph 10 of the petition and, as stated earlier, has prayed for the cancellation of the same.

3. The respondent's case, as set out in the affidavit of Sri Awtar Singh, may be stated as follows: The petitioner's design No 125728 is not a new or original design; it is a common design previously published in India. It is merely an arrangement of well known design of Chinese origin and is an exact copy of the Cycle locks marketed by Chinese firm under the trade description 'Wing'. The respondent had no knowledge of the petitioner's design inasmuch as no publicity was given by the petitioner of their design. Further, the petitioner has obtained

registration of their design on misrepresentation of facts and, as such, the registration is illegal and invalid. Lastly, the respondent has submitted that the petitioner is not entitled to get the revocation or cancellation of the respondent's design inasmuch as the respondent's design is original and new and is in no way similar to or identical with the petitioner's design and, as such, the respondent has committed no piracy of the petitioner's registered design.

4. Mr. Sankar Ghosh, learned counsel for the petitioner has drawn my attention to Section 51-A (1) (a) of the Indian Patents and Designs Act, 1911 and has contended that his client prays for cancellation of the registration of the respondent's design on all the three grounds mentioned in the said sub-section. According to him, the petitioner's design has been registered in India on May 25, 1965 whereas the respondent has not his design, registered on October 10, 1965. Further, the publication of the petitioner's design has been done long prior to the date of the registration of the respondent's design. Lastly, Mr. Ghosh has urged that the respondent's design is not a new or original design. According to him, it is not necessary that the respondent's design has got to be the exact reproduction or copy of the petitioner's design in its minutest details for the purpose of invoking Section 51-A (1) (a) of the Act.

5. Mr. Tibriwalla, learned counsel for the respondent, on the contrary, has submitted that in the facts and circumstances of the instant case. Section 51-A has no application. His main contention is that before Section 51-A is invoked the petitioner must prove that the respondent's design is identical with that of the petitioner. According to him, the section does not contemplate a bare similarity of certain features of the two designs. In any event, the respondent's design has got many features which are clearly distinguishable from the features in the petitioner's design and, as such, it cannot be stated that the respondent's design is same as that of the petitioner. He has also contended that the petitioner's design itself is not a new or original design and, according to him, the design is a common design which was known in the market long prior to the registration of the petitioner's design. He has referred me to a similar cycle frame lock of Chinese origin and has, on that basis, asked me to hold that not only there is no novelty in the petitioner's design (but it?) Itself is an imitation or a copy of earlier designs.

6. I may now examine the contentions of learned counsel for both the parties. At the time of hearing of the application, several cycle frame locks were placed before me on which the learned counsel for both the parties relied. The photostat copies of the petitioner's and the respondent's designs are annexed to the petition. The photostat copies of two other designs were also annexed to the affidavit-in-reply of Surendra Kumar Aurora affirmed on July 8, 1966. Apart from those varieties of cycle frame-locks and a cycle frame-lock of Chinese origin, three or four other frame-locks were also shown to me. All the cycle frame-locks about 7 or 8 in number have been examined by me carefully and I have found that the shape, the circumference, the configuration of all of them are more or less similar to each other save and except in three cases where the outstanding feature which distinguishes the other varieties is that the lock has not only been fitted on the top portion of the surface but also the lock itself has been raised to about one inch height from the surface itself. The petitioner's and the respondent's designs and the design of the Chinese origin are the three specimen where the locks have been fitted conspicuously in such elevated position. There is no doubt that all these three designs including those of the petitioner and of the respondent looked alike and give an impression that they are species of the same design. Mr. Tibriwala has made a comparison of the petitioner's design and the respondent's design and has laid great emphasis on the following differences between the two.

(a) The top portion of the petitioner's design is semi-circular whereas the top portion of the respondent's design is more or less, rectangular.

(b) On the top portion of the petitioner's design there are three pins whereas on the same portion of the respondent's design there are four pins.

(c) The outer surface of the lock portion in the petitioner's design is smooth and round, but there is a clear dent on the upper portion of the lock in the respondent's design.

(d) Inside the circumference also there is one pin in the petitioner's design whereas there are two pins in the respondent's design.

(e) The two ends of the bottom portion of the petitioner's design is different in quality from those in the respondent's design.

(f) The top of the keys of the locks of the two designs are differently made.

(g) The petitioner's design has been clearly described on the frame itself as 'Western' whereas on the respondent's frame the word 'Nirman' is written and the said writings are also conspicuously made in the respective packing boxes. There is great force in Mr. Tibriwala's argument and it cannot be denied that there are certain differences and points of dissimilarity between the design of the petitioner and that of the respondent. But it also appears that there are outstanding points of similarity between the two designs which may be stated as follows:

(a) Both the designs are of equally circular or semicircular shape.

(b) In both cases the lock portion is raised from the flat surface of the design.

(c) Bodies in both the frames are painted black.

(d) The pin, the lock and the two laves (sic) at the end of two sides of the design are of silvery colour.

(e) A protruded round-shaped lock was fitted on the top of both the frames.

(f) The device and method of locking a cycle and opening by the key is the same in both cases. Thus, it is obvious that, although there are differences between two designs, there exist also very conspicuous points of identity between the two.

7. I may now discuss the relevant law on this point. The material portions of Section 51A of the Indian Patent and Designs Act, 1911 read as follows :

'Cancellation of Registration -- 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.....'

Under Section 2(5) 'Design' means:

'Only the feature of shape, configuration, pattern or ornament applied to any article by any industrial process or means whether manual, mechanical or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye, but does not include any mode or principle of construction or anything which is in substance a mere mechanical device, and does not include any trade mark as defined in Section 2(1) (v) of the Trade and Merchandise Marks Act 1953 (43 of 1953).'

By reading the two sections together, it appears that a subsequent design should be the self-same or identical design, registered earlier. The design the registration of which is sought to be cancelled under Section 51A must not have different features of shape, configuration, pattern, etc. from those of the earlier design. The definition itself lays emphasis on the fact that the sameness of the 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. Etymologically, identity and similarity are two different concepts but it should be remembered that two identical things do not necessarily mean that there cannot be any point of difference at all. There are Philosophers who are of opinion that leaves of the same tree are not the same and there are no two identical things in the world. Be that as it may, Section 51-A, in my opinion, cannot contemplate only cases where the two designs must be identical on every point. If at all, there is to be at best an identity in difference. But the difference must not be of a substantial nature. It is absurd to suggest that a slight variation between the earlier design and the subsequent design would make the two designs different. It should be remembered that the underlying principle behind the law of infringement of design is that, while the commercial exigencies require that a specific design which is novel and original should be protected, the monopoly of a trade in respect of a common design with no special skill or originality should not be encouraged. In the

premises, the subsequent registration of a design can only be cancelled if the earlier registration relates to the same design. The sameness in the present context cannot connote geometrical identity, in which case Section 51-A can easily be circumvented. Slight trade variants in the two designs cannot overshadow the totality of the fundamental features of the two. The ordinary meaning of identity or sameness on the one hand and that of difference or similarity on the other cannot be a safe guide to determine the validity or originality of earlier and subsequent registrations or designs. It is true that there cannot be one standard yardstick which would determine the issue and naturally each case has got to be decided on its own facts and circumstances. One practical test, however is to find out whether there are substantial differences between the design subsequently registered and the design which was earlier registered. These differences cannot be based on purely subjective or utilitarian or aesthetic considerations but the differences must be objective in its essential features. A general view of the features of both the designs should be looked into to find out if the one design is as good as the other, and the conclusion is to be arrived at by visual examination of the two things. Similarity of device in external appearance may be a relevant factor in considering the substantial difference between the two but is certainly not a determining factor in this connection reference may be placed on the following observations of Russell-Clarke's Copyright and Industrial Designs (1951) Edition at page 162:

'It is said that protection will be given to any design which is new or original. As to what distinction, if any, is to be drawn between the words new and original is doubtful. It may be that 'new' means different from what has gone before and that 'original' has the same meaning as in the Copyright Act, i.e., originating from the author. It is also possible that the view advanced by Buckley, L. J. in *Dover Ltd. v. Numberger Celluloid Waren Fabrik*, (1910) 27 RPC 498 is the correct one. There he said that 'new' referred to cases where the shape or pattern was completely new in itself, whilst 'original' referred to cases where, though old in itself, it was new in its application to the article in question. He said (at page 503):

'If the design be new it may be registered under that expression. But the act of Section 49 seems to contemplate that it may be registered, even if it not be new, provided that 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 something that by the exercise of intellectual activity he has started an idea which had not occurred to any one before, that a particular pattern or shape or ornament may be rendered applicable to the particular article to which he suggests that should be applied.....'.....

Whether a design is novel is a matter of fact to be decided by the eye. As already indicated, 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. The previous idea or design, will act as an anticipation of the later design, and will be a bar to its protection. That the eye, and the eye alone, is to be the judge of identity, and is to decide whether one design is or is not an anticipation of any, has been laid down time and time again in numberless cases. Whether a design is more useful than other designs which have gone before is not to be considered. It is simply the general impression gathered by the eye that counts, and it is, therefore, impossible to lay down any hard and fast rule which can be followed. It has in the past been decided that mere slight variations from articles already manufactured are not registrable that the variation from what has gone before must not be trivial or infinitesimal, and that small variations which any skilled workman might make between the articles which he makes for different customers are not enough. These principles still apply, and are accorded statutory recognition by Section 1(2) of the present Act which lays it down that no design shall be accounted new or original if it differs from a previous design 'only in immaterial details'. The novelty or originality should in other words be substantial, and it must be substantial having regard to the nature of the article. Especially with references to such matters as collars and other articles of dress, there must be some clearly marked and defined differences though the actual standard of ingenuity required on the part of the author is extremely small. The question which has to be decided is whether the two appearances are substantially the same or not. The design must be looked at as a whole, the question being whether an article made according to the design under consideration is substantially similar in appearance to an article made according to the alleged anticipation. The test is not only to look at the two

designs side by side, but also apart, and a little distance away.' Mr. Blanco White has also reiterated similar propositions of law in his work 'Patents for Inventions' (3rd Edition) at Page 265 where the learned author has said;

'The existence or not of substantial novelty or originality is a question of fact, to be decided by the eye.'

Accordingly, I hold that the words 'the design' in Section 51-A should be judicially construed as 'the substantially same Design'. Applying the above principles to the instant case in my view, the points of similarity and the points of difference which have been mentioned above and the examination of the two designs clearly indicate that the features in the shape and configuration of the respondent's articles are substantially same as those of the petitioner.

8. The three grounds mentioned in Section 51-A are alternative or disjunctive and not conjunctive. I am convinced that the registration of the respondent's design should be cancelled on the first ground. On the second ground also I find from the affidavits and the annexures and from a journal known as 'Cycle Times', referred to in the affidavit of Surendra Kumar Aurara affirmed on February 8, 1967, that the petitioner's design has been earlier published in India prior to the date of respondent's registration. In fact, on this point, Mr. Tibriwala did not raise any dispute. On the third ground, however, Mr. Tibriwalla's contention is that the respondent's design is a new or original one and not an imitation of the earlier one. But in making that submission, Mr. Tibriwala did not urge that the entire device or the design was purely his client's idea. According to him, it was a commonplace design in the market and the petitioner's design itself is only an imitation of design of similar cycle frame locks of Chinese origin. I have already held that the respondent's design is substantially the same as the petitioner's design, but with respect to Mr. Tibriwala's contention that the petitioner's design is not a new or original one, it seems to me that he is indirectly raising a question of validity of the petitioner's registration. In my view, the invalidity of an earlier registration could have been challenged by him in a substantive application. In an application under Section 51-A of the Act, the question cannot be gone into. In any event, I find that from all the samples of cycle frame-locks, the distinguishing feature, viz., the

protruded or the raised lock was not there. There is only one sample of Chinese origin where the similar contrivance was there but I have no materials whether that particular thing is at all a commodity which is common or easily available in India. It may not have entered the Indian market at all or it may have entered the Indian market by illegal means. Further, the said sample of Chinese origin has not been registered in India. The petitioner's design at the time of registration was new so far as the Indian market was concerned. Mr. Tibriwala's objection regarding the invalidity of the petitioner's design not being novel or original, therefore, cannot be sustained. In this connection, Mr. Sankar Ghosh has drawn my attention to the following passage in Blanco White's Patents for Inventions' (3rd Edition) page 263:

'The issues in an action for infringement of design normally reduced to the complementary questions of validity and infringement, it should be noted, however, that invalidity is not properly a defence to the action as invalidity of patents: the design is copyright if and so long as it is registered and an alleged infringer who wishes to dispute validity ought to do so by counter-claiming to rectify the register by cancelling the registration.'

9. Mr. Tibriwala has drawn my attention to the following observations of the Judicial Committee in Pope Appliance Corporation v. Spanish River Pulp and Paper Mills Ltd, AIR 1929 PC 38 at p. 43:

'It must be remarked that in almost every patent, for mechanical combination the elements are old. It must also be considered that there may be invention in what, after all, is only simplification.'

Relying on the said observations, the learned counsel has also argued that the respondent's design is really a combination of a rectangular shape at the top, not present in the petitioner's design, and a protruded lock a feature which is common in the design of Chinese origin. Accordingly, the respondent's design, he has contended, is not an imitation but it is a combination of two other designs and, as such, it is novel and original. The facts of that case are clearly distinguishable inasmuch as that was a case for infringement of patent where element of invention of a Paper-making machine and a complicated device for manufacturing paper from different pulps was involved. In the instant case, there is no question of any

difference of device in the two designs. Reliance was also placed by Mr. Tibriwala on Calico Printers Association Ltd v. Savani and Co. : AIR1939 Bom103 . In my opinion, that was a case which does not help his client at all. The facts and the propositions of law held in that case would rather help the petitioner and the observations of Justice Romer in Rose v. Pickavant and Co.. (1923) 40 RPC320 on which the Bombay Judgment relied may be stated as follows:

'The article is therefore an obvious imitation when it is apparent to the eye that it has been copied consciously or unconsciously from the design,'

The only other case to which my attention was drawn is Dwarkadas Dhanji Sha v. Chhotalal Ravicarandas and Co., AIR 1941 Bom 188 where it was held that there is a prima facie presumption that the person whose name is registered as the proprietor is a proprietor of new or original design, but the entry in the register is not conclusive thereof, and the presumption can be rebutted. There is no reason for me to differ with the said proposition of law.

10. A short point was raised by Mr. Tibriwala that the petitioner is a trader in Delhi and the petition has been verified by a constituted attorney. He has, of course, not contended that the petition is not maintainable on that ground. His only submission was that the said constituted attorney is a resident of Calcutta. The petitioner and the respondent both are residents of Delhi and much weight would not be placed on the petition inasmuch as the petitioner himself has not verified the affidavit. In my view, there is no substance in such contention. It is difficult to say under what circumstances the constituted attorney has verified the affidavit and there is no bar under the Indian Patents and Designs Act for a constituted attorney to verify a petition or an affidavit. Lastly, Mr. Tibriwala has argued that the subject-matter involves complicated questions of fact and, as such, should not be decided on affidavits. He suggested that the issue should be decided on a trial of oral evidence in my view, although several affidavits were filed in relation to the petitioner's design, I do not find it necessary to decide the matter on those affidavits alone. The original exhibits were placed before me. The points of similarity and the points of differences were obvious and I do not consider it indispensable to get the opinion of other traders in the market. Further, this is not a

case where the respondent in a substantive application has challenged the cancellation of the petitioner's design on the ground of lack of novelty and originality. As stated earlier, the petitioner has only filed this application for the cancellation of the registration of the respondent's design on the three grounds mentioned in Section 51-A which are disjunctive in nature, and, if I am convinced that one or the other ground has been established on the evidence before me, I find no reason why any additional evidence would be required.

11. In the premises, this application must be allowed. There will be orders in terms of prayers (a) (b) and (c) and the petitioner is entitled to the costs of this application.

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