



Lakshmikumaran
& Sridharan
attorneys

IPR

amicus

An e-newsletter from
Lakshmikumaran & Sridharan, India

February 2018 / Issue-79

Contents

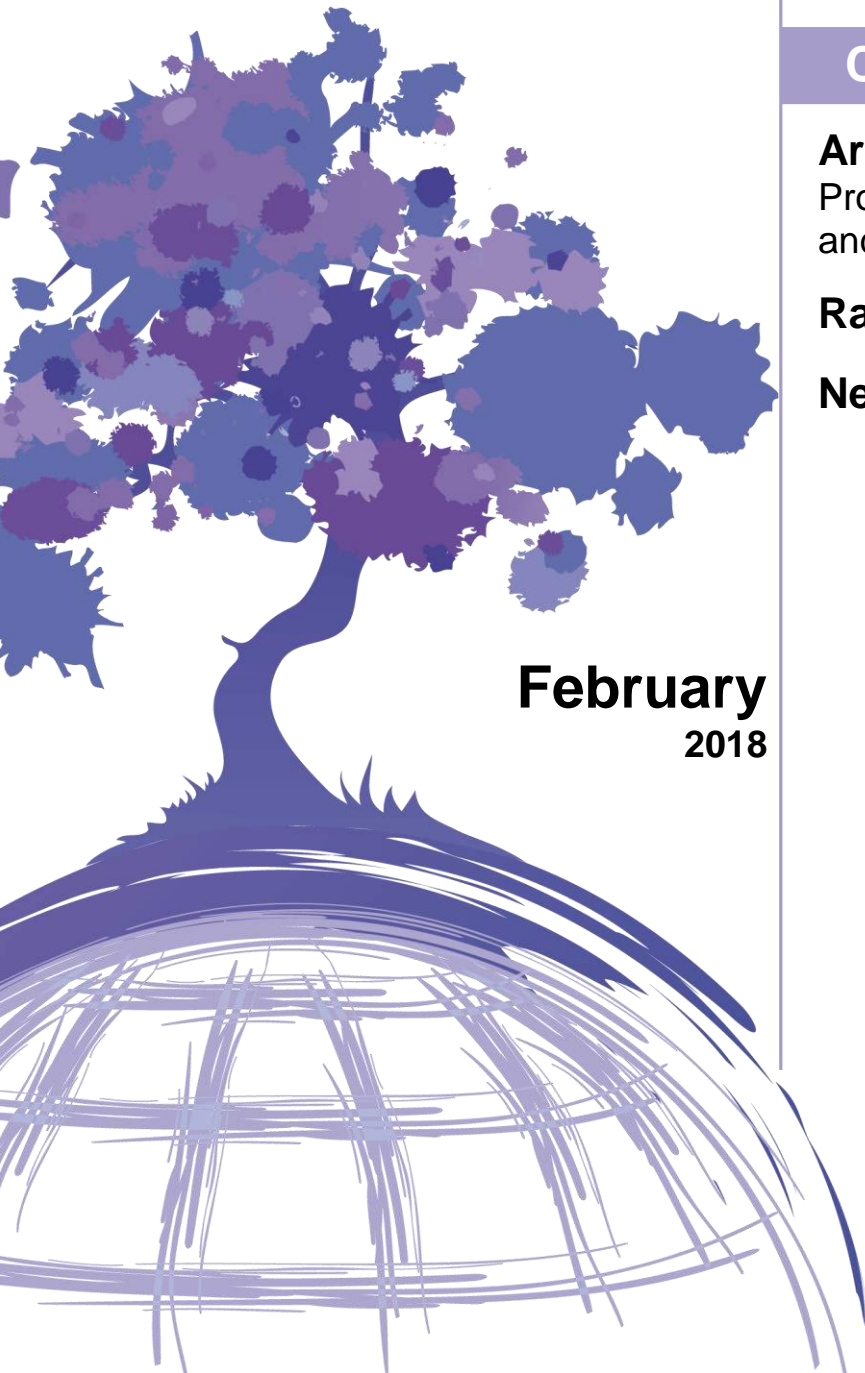
Article

Protection of designs vis-à-vis newness
and originality2

Ratio Decidendi.....4

News Nuggets6

February
2018





Article

Protection of designs vis-à-vis newness and originality

By **Godhuli Nanda**

There is required sufficient novelty and originality for a completely new creation to come into existence as a design, and only thereafter would the design be said to be one which is capable of being protected as a design under the Indian Designs Act. It is also pertinent to note that the meaning of the words “novel or original” is that the designs must either be substantially novel or substantially original, having regard to the nature and character of the subject matter to which it is to be applied.¹

A Single Judge of the Delhi High Court on January 8, 2018 held that unless a design is significantly distinguishable from the known designs or combination of designs, such a design is not entitled to registration, in the case of *Pentel Kabushiki Kaisha & Anr. v. Arora Stationers & Ors.* By way of a design infringement suit Pentel Kabushiki Kaisha and another (hereinafter referred to as the Plaintiffs) sued Arora Stationers, Montex Writing Instruments and Jineshwar Writing Instruments Limited (hereinafter referred to as the Defendants) from manufacturing and marketing any pen/writing instrument which infringed the registered design No. 263172 of the Plaintiffs. The Plaintiffs also filed an application seeking interim injunction under Order XXXIX Rules 1 & 2 CPC pleading piracy by the Defendants of the Plaintiffs' registered design.

On May 26, 2017, another Single Judge of the Delhi High Court agreed with the contentions of the Plaintiffs and granted an *ad-interim* injunction in favour of the Plaintiffs restraining the

Defendants from manufacturing and marketing any pen/writing instrument which infringed the registered design No. 263172 of the Plaintiffs'. However, while disposing of the interim application the Single Judge held that the Plaintiffs failed to show any substantial newness/originality of its design based on which they claimed infringement and while vacating the *ad-interim* Order dated May 26, 2017, dismissed the application seeking interim relief.

Brief facts:

The Plaintiffs filed a suit for permanent and interim injunction restraining the Defendants from manufacturing, selling, advertising, etc., an identical duplication or obvious and/or fraudulent imitation of the Plaintiffs' copyright in the registered design of their ball point pens. According to the Plaintiffs the novelty of its design was in its shape and configuration. The cause of action pleaded by the Plaintiffs in the plaint was under Section 22 of the Designs Act, 2000 (hereinafter referred to as the Act) which provides that during the existence of the copyright in any design, no other person shall use the registered design for commercial purposes, sale of the article, etc., being a design which is identical or an imitation of the registered design of the Plaintiffs.

As per Section 22 (3), whenever any suit is filed for the relief alleging piracy of the registered design by the Defendant in a suit, then in such a suit every ground on which registration of a design may be cancelled under Section 19 of the Act shall be available to the Defendant as a ground of defence. Further, if a design is not new

¹ CS(COMM) No.361/2017

or original design, then the registered design, though registered, is liable to be cancelled in the proceedings under Section 19 of the Act. Therefore, before deciding the issue of entitlement of the Plaintiffs to grant of an interim injunction in the suit, the court had to first examine whether the design of the ball point pen of which the plaintiffs have obtained registration can be considered as a new or original design or not.

The Single Judge after much deliberations arrived at a finding that the registered design of the Plaintiffs had no newness/ originality and therefore could not distinguish itself from known shapes or the different features which already exist in a ball point pen.

Contentions of the parties:

The Plaintiffs contended that the novelty of the '172 design rested in its shape and configuration. The pen had a unique cap with two wedges on each side near the clip-end, a unique clip top which appeared as a mounted attachment on the cap, a unique polygonal barrel wave-like cuts on the grip-end, the wave-like cuts on the grip-end that transforms abruptly to a plain cylinder before meeting the tip, the slightly curved conical tip having thin cuts from the nib till the bottom of the cone, the barrel that transforms abruptly into a plain cylinder on the plug side and the plug side having a protruded knob. All these features when employed together gives the ball-point pen of the Plaintiffs a unique design.

The Defendants on the other hand contended that the features which are alleged by the Plaintiffs to be their exclusive creation and being different parts of their registered design have been used by the Defendants from their own earlier designs commencing from the year 2005. The Defendants also submitted that the curvy grip portion of the ball-point pen is also in use by various other pen manufacturers including CELLO company in their pens.

The main defence taken by the Defendants was that there was no newness or originality in the registered design of the Plaintiffs with respect to ball point pens claimed by them. It was also contended they have copied the features not from the registered design of the Plaintiffs but from the features which are already adopted by the Defendant No. 2 in its ball point pens since the year 2005.

Decision of the court:

The Single Judge was of the view that in sum and substance every ball point pen has common features of a lower casing/barrel in which there is a refill, the refill exits with a ball point pen nib, the cap covers the ball point nib portion with additional portion of the lower casing/barrel, and finally that the cap ordinarily contains a clip. In order for a design to be totally new and original design with respect to a ball point pen, there will have to be significantly distinguishable features so as to make the ball point pen of which exclusivity and continuation of the registration was claimed by the Plaintiffs, that such is a completely new and original ball point pen having enough/substantial novelty and originality by application of labour whereby the ball point pen of the Plaintiffs is distinguished from the aforesaid known features/design in a ball point pen.

The fact that the cap of the Plaintiffs' ball point pen is alleged to be unique because of wedges at the point of holding of the ball point pen or the barrel was polygonal or there exists slightly curved tip or that barrel/lower casing goes into a knob, etc., are only trade variants and such features cannot be said to be such newness or originality so as to distinguish these features from known shape or the different features which already exist in a ball point pen. In fact, the wedges in the grip portion is a functional feature because this wedges design created is for a better grip and which because of Section 2

clause (d) of the Act, which defines design, cannot be protected as a design.

The Single Judge held that the non-existence of a design in public domain is not enough to succeed on the aspect of registration of the design under the Act because even a known concept or known design or known idea becomes a design only when it is applied with respect to an article, whereby the new article would become a design as such and then proceed to have protection as a design under the Act.

The Court did not even go into the facts as stated by the Defendants in their written statement of their already having used the features claimed by the Plaintiffs as unique/new features in their own ball point pens in different years from the year 2005, since the Plaintiffs

failed to show substantial newness/originality as required by the definition and meaning of newness and originality.

On the basis of the aforementioned, the Single Judge dismissed the present interim application and vacated the interim order dated May 26, 2017.

The quintessence when it comes to designs is that distinction has to be drawn between usual trade variants on the one hand and substantial novelty and originality on the other hand otherwise there will be blockage of trade. Only newness/originality entitles monopoly on account of registration of the design.

[The author is a Senior Associate in IPR practice, Lakshmikumaran & Sridharan, Delhi]



Ratio decidendi

Designs – Cancellation of registration when design a trade variation and available in public domain before

Rejecting plaintiff's claim of piracy of design, Delhi High Court has cancelled a registered design. The Court in this regard noted that the design in respect of the footwear was available in public domain before, and is only a trade variation of a sandal. It observed that plaintiff's registered design does not have necessary newness or originality for the same to be called a creation or innovation or an Intellectual Property Right, which is a necessary requirement according to the Supreme Court decision in the case of *Gopal Glass Works Ltd.*

The High Court held that the features which were argued on behalf of the plaintiff as existing in its sandals/footwear, of mounds or humps or straps (or lack of them) or soles designs or perforations/open spaces etc., even when taken as a whole, or individually, do not result in

innovation or creation of newness or originality. Relying on an earlier decision of the Court, it was held that mere trade variations to existing product will not entitle a person to contend that there is newness and originality and that such designs cannot be given designation of an IPR.

The Court in addition to the actual legal costs also granted each of the defendants a sum of Rs. 200,000 subject to final decision towards costs incurred for these proceedings except the head of legal costs. [*Crocs Inc. USA v. Liberty Shoes Ltd.* – Order dated 8-2-2018 in CS (COMM) No. 772/2016, 570, 571, 780/2017, 52, 53/2018, CS(OS) No. 2850/2014, 64/2016, Delhi High Court]

Trademarks - Interim injunction granted against use of mark 'Patanjali'

The Delhi High Court has passed an interim injunction order in favour of the plaintiff, restraining the defendant from using the mark

PATANJALI. The Court was of the view that the mark has acquired a secondary significance and has come to denote the goods of the plaintiff. The defendants in the dispute were using the words MAHARISHI PATANJALI PARIVAR and contended that PATANJALI is a proper Indian name and an ancient exponent of Raja Yog and the author of Yoga Sutras, a series of the verses about the eight steps needed to attain self-realisation. It was hence contended that the plaintiff had no exclusive right upon the trademark in the name. The Court however restrained them from manufacturing, selling, offering for sale, advertising, directly or indirectly the goods bearing the mark/word PATANJALI or any other artistic work/logo identical or deceptively/confusingly similar to the mark. [*Patanjali Ayurveda v. Kalpamrit Ayurved* – Order dated 23-1-2018 in CS (COMM) 47/2018, Delhi High Court]

Patent infringement - Technical expert allowed during cross-examination of another expert

Delhi High Court has allowed defendant's interim application regarding presence of his technical expert during cross-examination of plaintiff's witness, an expert himself. The plaintiff had relied upon Chapter XIII Rule 4 of the Delhi High Court (Original Side) Rules, 1967 according to which witnesses were not to be present in the Court during hearing of the suit. Considering that suit involved patent infringement, the Court, however, observed that lawyers are not expected to have technical knowledge to cross-examine a technical witness and that even a party and/or his authorized representatives may not have necessary technical knowledge for the purpose. It held that otherwise it will be a violation of principles of natural justice and rule of law because a person will be asked to

shoot in dark and be denied entitlement to effectively contest. The High Court was of the view that merely because this expert witness of the defendants has filed his affidavit by way of evidence with respect to a fact situation of the present case would not mean that he should not be allowed to be present. [*Dolby International AB v. Das Telecom Pvt. Ltd.* – Order dated 1-2-2018 in CS (COMM) No. 1426/2016, Delhi High Court]

Trademarks - Commercial Transaction must for Court's jurisdiction in passing off

For the purpose of invoking jurisdiction of a court in a passing off action, the plaintiff is required to plead and establish that there has been a Commercial Transaction within the jurisdiction of that Court which amounts to passing-off. The Delhi High has held that mere fact that plaintiff received queries for advertisement is not sufficient to attract jurisdiction of the court. Commercial transaction was held necessary to show that defendant specifically targeted persons within the court's jurisdiction.

The plaintiff had invoked the jurisdiction of the Court on the basis of two assertions. First, that the newspaper is published on a page on www.facebook.com, which is an interactive site inasmuch as users can place their comments on the facebook page, and second, that the plaintiff received queries from one company expressing its intention to advertise in the newspaper published by the defendants. The Court was of the view that maintenance of the facebook page on a social media site can at best be representative of the defendants issuing an advertisement of their product. Receipt of queries for advertisement was also found insufficient to attract the jurisdiction of the Court. [*News Nation Networks Pvt. Ltd. v. News Nation Gujarat* – Judgement dated 22-12-2017 in CS (COMM) 334/2016, Delhi High Court]

Trademark cannot be removed without notifying expiration due date

Relying upon an earlier decision in case of *Cipla Ltd.*, Bombay High Court has held that it is mandatory to issue notice in Form O-3 before removal of a non-renewed trademark from the register. Referring to Rule 67 of the Trademark Rules, the Division Bench of the Court held that if removal pursuant to non-renewal was to be without notice of removal, Rule 68 would have followed Rule 66 and not Rule 67 of the Rules. It also held that otherwise it would be contrary to Section 25(3) of the Trade Mark Act. The Court allowed the Writ Petition observing further that in the absence of documentary evidence, it cannot be concluded that such notices were sent and that the petitioner was in receipt of same. [*Kleenage Products v. Registrar* – Judgement dated 17-1-2018 in Writ Petition No. 850/2015, Bombay High Court]

Trademarks – Reasonable claim in passing off

A Division Bench of Bombay High Court has dismissed defendant's appeal in a case involving passing off of a trademark. The product was a pain relieving massage oil with majority of consumers being labourers from Bhiwandi area. The plaintiff was using the label 'Nageena Sukoon Oil' while defendant used 'Heena Sukoon Oil'. The Court in this regard observed that plaintiff has *prima facie* established use of deceptively similar mark, and that rise in sale of plaintiff's product gave a reasonable cause for him to raise claim of infringement of trade mark and passing off. It was noted that the test to be applied in the case is of a person of average intelligence and imperfect recollection, and that the mark has to be seen in its entirety and after taking into consideration the facts of the case, a decision has to be arrived. [*Ansari Bilal Ahmadlal Mohd. v. Shafeeque Ahmed Mohammed Sayeed* – Judgement dated 12-1-2018 in Commercial Appeal No. 94/2017 in Notice of Motion (L) No. 2311/2016 in Suit (L) No. 810/2016, Bombay High Court]



News Nuggets

Geographical indications and 'essential characteristics'

In a case involving allegation of infringement of Protected Designation of Origin (PDO) of 'Champagne', Court of Justice of the European Union has held that use of a PDO as part of the name of a foodstuff that contains an ingredient corresponding to those specifications, does not constitute misuse or imitation. Observing that reputation of the PDO was likely to be extended to the product, it was

held that only if the product in question does not have, as essential characteristic, a taste primarily attributable to champagne, the name 'Champagner Sorbet' will constitute a false or misleading indication.

Red colour whether can perform essential function of a trademark?

The European Union Trademark Directive sets out a number of grounds on which registration of a mark may be refused, particularly for signs that consist exclusively

of shape giving substantial value to goods. CJEU Advocate General has on 6-2-2018 opined that the prohibition is capable of applying to a sign combining colour and shape. The dispute involved trademark in high-heeled shoes for women, with a particular feature of outer sole being always red. The Advocate General expressed doubts as to whether colour red can perform essential function of a trademark.

Trademarks – Likelihood of confusion in a mark for clothing

In a case involving likelihood of confusion in marks used on clothing, High Court of United

Kingdom has upheld likelihood of confusion. The Court in this regard discussed visual, aural and conceptual similarities, overall impression conveyed and that the marks were used on identical/similar goods and services. The Court in *Lifestyle Equities v. Santa Monica Polo Club* also noted that degree of attention for average consumer of clothing is average. It was held that the consumer rarely does direct comparison and must instead rely upon the imperfect picture he has in mind, without analysing various details.

NEW DELHI

5 Link Road, Jangpura Extension,
Opp. Jangpura Metro Station,
New Delhi 110014

Phone : +91-11-4129 9811

B-6/10, Safdarjung Enclave
New Delhi -110 029

Phone : +91-11-4129 9900

E-mail : lsdel@lakshmisri.com

MUMBAI

2nd floor, B&C Wing,
Cnergy IT Park, Appa Saheb Marathe Marg,
(Near Century Bazar)Prabhadevi,
Mumbai - 400025

Phone : +91-22-24392500

E-mail : lsbom@lakshmisri.com

CHENNAI

2, Wallace Garden, 2nd Street
Chennai - 600 006

Phone : +91-44-2833 4700

E-mail : lsmds@lakshmisri.com

BENGALURU

4th floor, World Trade Center
Brigade Gateway Campus
26/1, Dr. Rajkumar Road,
Malleswaram West, Bangalore-560 055.

Ph: +91(80) 49331800

Fax:+91(80) 49331899

E-mail : lsblr@lakshmisri.com

HYDERABAD

'Hastigiri', 5-9-163, Chapel Road
Opp. Methodist Church,
Nampally

Hyderabad - 500 001

Phone : +91-40-2323 4924

E-mail : lshyd@lakshmisri.com

AHMEDABAD

B-334, SAKAR-VII,
Nehru Bridge Corner, Ashram Road,
Ahmedabad - 380 009

Phone : +91-79-4001 4500

E-mail : lsahd@lakshmisri.com

PUNE

607-609, Nucleus, 1 Church Road,
Camp, Pune-411 001.

Phone : +91-20-6680 1900

E-mail : ls pune@lakshmisri.com

KOLKATA

2nd Floor, Kanak Building
41, Chowringhee Road,
Kolkatta-700071

Phone : +91-33-4005 5570

E-mail : lskolkata@lakshmisri.com

CHANDIGARH

1st Floor, SCO No. 59,
Sector 26,

Chandigarh -160026

Phone : +91-172-4921700

E-mail : lschd@lakshmisri.com

GURGAON

OS2 & OS3, 5th floor,
Corporate Office Tower,
Ambience Island,

Sector 25-A,

Gurgaon-122001

phone: +91-0124 - 477 1300

Email: lsgurgaon@lakshmisri.com

ALLAHABAD

3/1A/3, (opposite Auto Sales),
Colvin Road, (Lohia Marg),

Allahabad -211001 (U.R)

phone . +91-0532 - 2421037, 2420359

Email: lsallahabad@lakshmisri.com

Disclaimer: IPR Amicus is meant for informational purpose only and does not purport to be advice or opinion, legal or otherwise, whatsoever. The information provided is not intended to create an attorney-client relationship and not for advertising or soliciting. Lakshmikumaran & Sridharan does not intend to advertise its services or solicit work through this newsletter. Lakshmikumaran & Sridharan or its associates are not responsible for any error or omission in this newsletter or for any action taken based on its contents. The views expressed in the article(s) in this newsletter are personal views of the author(s). Unsolicited mails or information sent to Lakshmikumaran & Sridharan will not be treated as confidential and do not create attorney-client relationship with Lakshmikumaran & Sridharan. This issue covers news and developments till 13th February, 2018. To unsubscribe, e-mail Knowledge Management Team at newsletter.ipr@lakshmisri.com

www.lakshmisri.com

www.gst.lakshmisri.com

www.addb.lakshmisri.com

www.lakshmisri.cn