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

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

% Reserved on: 27th September, 2010

Pronounced on: 8th October, 2010

RECKITT BENCKISER (INDIA) LTD. ..... Appellant/Plaintiff

Through: Mr. Aman Lekhi, Senior Advocate with Ms. Shikha Sachdeva, Advocate.

VERSUS

WYETH LIMITED ....Respondent/Defendant

Through: Mr. Pravin Anand, Advocate with Ms. Taapsi Johri, Advocate.

CORAM:
HON'BLE MR. JUSTICE SANJAY KISHAN KAUL
HON'BLE MR. JUSTICE VALMIKI J.MEHTA

1. Whether the Reporters of local papers may be allowed to see the judgment? Yes

2. To be referred to the Reporter or not? Yes

3. Whether the judgment should be reported in the Digest? Yes

JUDGMENT

VALMIKI J. MEHTA, J

1. The present appeal has been filed against the impugned order dated 7.8.2009 of the learned Single Judge disposing of two applications filed in the suit, one by the plaintiff/appellant for grant of

injunction and the second of the defendant/respondent for vacation the interim injunction. By the impugned order, the learned Single Judge had dismissed the injunction application of the plaintiff/appellant and allowed the application for vacation of injunction of the defendant/respondent and the interim order dated 8.1.2007 passed in favour of the appellant/plaintiff was vacated.

2. The issue in the present appal is with regard to the claim of entitlement of the appellant of alleged infringement by the respondent of the appellant's registered design No.193988 dated 5.12.2003 in Class 99-00 with respect to an S-shaped spatula. The S-shaped spatula is designed for the application of a cream for hair removal i.e. a cosmetic depilatory. The defence of the respondent is that the registered design of the appellant is not new/original and the same was also registered and published abroad prior to the registration in India. It is also further averred that the S-shaped spatula design was in fact in used abroad pursuant to its registration. The respondent, in fact, alleged suppression of facts on behalf of the appellant in not disclosing the prior registrations of the design in various countries and thereafter of the manufacturing and publication of the subject design abroad.

3. The learned Single Judge framed the following questions for determination:

> "1. Whether the design registration in UK, USA or Australia could amount to prior publication or disclosure to public as contemplated in Section 4(b) of the said Act?

> 2. Whether there is material on record to indicate, prima facie, that the plaintiff's design had been published in India or in any other country prior to the date of registration, i.e., 05.12.2003?
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> 3. Can it be said, prima facie, as to whether the design of the defendant's spatula is a fraudulent or obvious imitation of the plaintiff's registered design as applied on its spatula?"

On the question No.1 above, the learned Single Judge held that prior registrations in U.K., USA and Australia amounted to prior disclosure as contemplated in Section 4(b) of the Designs Act, 2000 (hereinafter referred to as the 'said Act').

So far as question No.2 is concerned, it has been held by the learned Single Judge that the subject design was available to the public i.e. was in public domain much prior to the registration in India on 5.12.2003. It was held that the design in question was published abroad prior to the date of registration in India and therefore the same was a valid defence in an action for action of infringement.

On question No.3, the learned Single Judge held that by putting the two designs side by side, one cannot conclusively say that one is an imitation of other. The learned Single Judge, however, hastened to clarify that this was only of prima facie view.

4. The learned senior counsel for the appellant urged the following grounds in support of the appeal:-

(i) In view of the categorical language of Section 19(1) (a) of the Act, a design which is previously registered abroad is not a ground of cancellation of a design registered in India and therefore the same

cannot be a defence in a proceeding for infringement of the registere design under Section 22 of the said Act.

(ii) As a corollary to the above, it is contended that a literal interpretation of Section 19(1) (a) should be resorted to and no intention should be ascribed to the legislature as to existence of any lacuna in drafting of the Act. It was therefore consequently urged that in view of the obvious difference in the language of Section 19(1)(a) as compared to Section 19(1)(b), in that whereas by virtue of Section 19(1)(b) publication in other countries prior to the date of registration is a ground for cancellation of registration and therefore available as a defence in an infringement proceedings, however since Section 19(1)(a) deals only with a registration of design in India as a ground for cancellation of a registration, therefore, a design registered in a foreign country cannot be a defence against an infringement action under Section 22.

(iii) The learned Single Judge erred in not relying upon the decision of the Calcutta High Court in the case of ***Gopal Glass Works Ltd. Vs. Assistant Controller of Patents and Designs : 2006 (33) PTC 434 (Cal).*** and the ratio of this decision has been accepted by the Division Bench of this court in the case of ***Dabur India Ltd. Vs. Amit Jain & Anr. 2009 (39) PTC 104*** and which ration is that registration abroad is not a ground for cancellation of a design in India and therefore cannot be use as a defence in a suit for infringement of a registered design. We may note that the decision of the Division Bench

in ***Dabur India Ltd's*** case was not cited before the learned Sing Judge.

(iv) The pleadings of the defendant/respondent i.e. its written statement filed in the suit, lacks in material particulars and in fact there is no defence which has been raised of the subject design being published abroad. It was contended that a pleading bereft of particulars is no pleading in the eye of law and no case can be argued on the basis of non-existent pleadings.

The counsel for the respondent in reply to the submissions made on behalf of the appellant has urged that registration abroad and the consequent publication of the registered design is very much available as a ground of defence in infringement action filed in India because in such a scenario, the case falls under Section 19(1) (b) and not under Section 19(1) (a). It was also urged in support of the submission that the registration of a design abroad may fall under two categories; first category being where in spite of registration, secrecy is maintained and the design is not brought in the public domain and secondly, where post registration the design brought into public domain, and that it is only in the formal class of cases where registration of design is kept secret, would such registration abroad be not available as a defence in a suit for infringement of an Indian registered design. It was further contended that there are sufficient pleadings before the learned Single Judge on the issue of prior publication and the registered design existing in public domain prior to its registration in India in view of the

additional affidavits filed by the respondent after conclusion of th arguments on the injunction applications and to which in spite of various opportunities being given by the learned Single Judge to the appellant, no replies were filed. The counsel also sought to distinguish the judgment of ***Dabur India Ltd***. (supra) on the ground that the same basically dealt with an issue of estoppel and not with regard to registration abroad and the consequent publication being available as a ground of defence to an infringement of registered design proceedings in India.

5. We have heard the submissions of the learned counsel for the parties and have perused the record.

6. Our present judgment proceeds in two parts.

The first part will deal with the issue with regard to whether there was prior publication abroad of the registered design prior to its registration in India and therefore consequently, since prior to the registration of design in India, the design was available in public domain, consequently, the case in fact falls under Section 19(1)(b) of the Act and one need not refer to Section 19 (1) (a) of the Act. The second part of the judgment proceeds on whether registration abroad is a defence even if we proceed only on the basis of 19(1) (a) of the Act.

We will take the first aspect first because in our opinion, that can be sufficient for disposal of the appeal. On the second aspect however, for the reasons given herein after, we feel that the matter ought to be

examined by a larger Bench of this court inasmuch as the Divisi Bench decision in the case of ***Dabur India Ltd. (supra)*** appears to have overlooked the vital provision of Section 44 of the Act, (importantly sub-section (2) thereof) and especially keeping its co-relation in mind with the provisions of various sub-sections of Section 4 read with the other sub-sections of Section 19 of the said Act. We also feel that on this aspect of the matter the reasoning of the learned Single Judge with respect to the fact that registration abroad being very much available as a defence (except in case of secret designs which are not open to public inspection) is indeed persuasive and if this reasoning was brought to the notice of the Division Bench in the case of ***Dabur India Ltd. (supra)*** along with the aspects with respect to Section 44 of the said Act and its co-relation to Sections 4 and 19 of the said Act, it is possible that the Division Bench in ***Dabur India Ltd. (supra)*** may not have held that registration of a design abroad with its availability in the public domain thereafter is not available as ground of defence in infringement action in India.

7. In order to understand the issue pertaining to prior publication, it is necessary to refer to the applicable provisions of the Act being Sections 2(g), 4, 5 (1), 10, 16, 17 and Section 19. These sections read as under:-

> **"Section 2(g)**"original", in relation to a design, means originating from the author of such design and includes the cases which though old in themselves yet are new in their application."

"**Section 4. Prohibition of registration of certain designs.-**A design which-
(a) is not new or original; or
(b) has been disclosed to the public anywhere in India or in any other country by publication in tangible form or by use or in any other way prior to the filing date, or where applicable, the priority date of the application for registration; or
(c) is not significantly distinguishable from known designs or combination or known designs; or
(d) comprises or contains scandalous or obscene matter, shall not be registered."

"Section 5. Application for registration of designs.-(1) The Controller may, on the application of any person claiming to be the proprietor of any new or original design not previously published in any country and which is not contrary to public order or morality, register the design under this Act:

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

"Section 10. Register of designs.-(1) There shall be kept at the patent office a book called the register of designs, wherein shall be entered the names and addresses of proprietors of registered designs, notifications of assignments and of transmissions of registered designs, and such other matter as may be prescribed and such register may be maintained wholly or partly on computer floppies or diskettes, subject to such safeguards as may be prescribed.
(2) Where the register is maintained wholly or partly on computer floppies or diskettes under sub-section (1), any reference in this Act to any entry in the register shall be construed as the reference to the entry so maintained on computer floppies or diskettes.
(3) The register of designs existing at the commencement of this Act shall be incorporated with and form part of the register of designs under this Act.
(4) The register of designs shall be *prima facie* evidence of any matter by this Act directed or authorized to be entered therein.

Section 16. Effect of disclosure on copyright.- The disclosure of a design by the proprietor to any other person, in such circumstances as would make it contrary to good faith for that other person to use or publish the design, and the disclosure of a design in breach of good faith by any person, other than the proprietor of the design, and the acceptance of a first and confidential order for articles bearing a new or original textile design intended for registration, shall not be deemed to be a publication of the design sufficient to invalidate the copyright thereof if registration thereof is obtained subsequently to the disclosure of acceptance.

Section 17. Inspection of registered designs.-(1) During the existence of copyright in a design, any person on furnishing such information as may enable the Controller to identify the design and on payment of the prescribed fee may inspect the design in the prescribed manner.

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

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

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

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

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

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

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

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

8. The gist and heart of Sections 4, 5(1) and Section 19 is basically that only such designs are capable of being given copyright

protection which are new or original. If a design is not new or origina then, the same cannot be registered. The expression "new" is not defined under the Act but the expression "original" is defined under the Act i.e., in Section 2 (g). While the expression "new" is easily understood in that which comes into existence in public knowledge for the first time the expression "original" had to be designed because "original" design may not be strictly new in that the shape of the design is available in public domain but yet 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 and hence it is given protection as an intellectual property right.

Elaborating further, what is new is quite obvious in that it comes into existence for the first time, however, a design may not be new in the sense it may already be available in the public domain, however, in its application for a particular purpose it may be totally original in the application which was not otherwise conceived of and therefore can amount to a new creation for commercial application thus entitling the same to copyright protection. Light on this aspect is also shed by Section 16 of the Act and which makes it clear that if there is disclosure in the public domain on account of breach of faith i.e. although the design was meant to keep the secret, yet it is brought into public domain, yet the same will not affect the newness of the design when registration of the same is sought. The provision of Section 16 is intended to narrow down the normal meaning of public domain.

Thus an original registered design once the same has broug into the public domain, without any breach of faith i.e it is ***intended*** that the registered design is brought into public domain, then, the said design no longer remains new. It is only new for the person who created the design, and thereafter gets its registration for its protection, and who is entitled to the benefit of it as an intellectual property right. A person who creates a design but releases it in public domain without seeking its registration under the Act, will not be able to seek protection against infringement of the design. A reading of the various sub-sections of Section 4, Section 19 along with Sections 5(1), 16 and 17 makes it thus more than abundantly clear that the most important ingredient and the heart of these provisions pertain to newness of the designs and that it is only a new design which is capable of protection. Prior publication or existence of a registered design in public domain is therefore very much an ingredient included within the manner of expression "new" designs itself and the aspect of public domain strictly need not have been separately provided for either under Section 4 or under Section 5(1) or under Section 19. However, these sections thus only clarify what is obvious that once a design is available in the public domain i.e. to the public at large it is not something "new" which can be registered as a new design under the said Act. *If one has to be put it in a consolidated form, the fulcrum of all the sections is that what is new is something which does not exist*

in public domain and what exists in public domain is not something which is new.

Of course even certain new designs are not given copyright protection because although the said designs are new, these designs are scandalous or obscene or are contrary to public idea of morality. We are of course, not concerned with this aspect of the matter and we are only otherwise concerned with regard to the issue of the design being new/original or the same being not new because the same is existing in public domain.

9. At the cost of repetition, we have repeatedly referred to the expression "public domain" because the same is a very wide expression and larger than the expression "publication" which may in certain circumstances be used in a restricted sense. Public domain is completely understood with reference to Section 4(b) of the Act in which disclosure to the public is a disclosure anywhere in India or abroad whether by publication or by use or "in any other way". Publication is therefore only one of the aspects of existence in public domain. Once therefore something exists in public domain, of course without breach of faith in violation of Section 16, its newness ceases.

10. It is quite apparent from the record of the proceedings before the learned Single Judge that the registered design was already available in public domain prior to its registration in India and therefore it has been rightly decided by the learned Single Judge that since the registered design was available in public domain prior to its registration

in India, the respondent/defendant had a complete defence by virtue Section 19 (1) (b) of the Act and also by virtue of the same/similar language employed in the other related Sections of the Act. Since the reasoning of the learned Single Judge (Badar Durrez Ahmed, J.) is persuasive and telling, we would seek to extensively refer to some of the paragraphs of the judgment of the learned Single Judge being paragraphs 21 to 30 which read as under:-

> 21. I now come to the reasons for taking a different view from that of the learned Single Judge of the Calcutta High Court in G***opal Glass Works*** *(supra)*. Section 4 of the said Act reads as under:-
>
> —**4. Prohibition of registration of certain designs.—** A design which — (a) is not new or original; or (b) has been disclosed to the public anywhere in India or in any other country by publication in tangible form or by use or in any other way prior to the filing date, or where applicable, the priority date of the application for registration; or (c) is not significantly distinguishable from known designs or combination of known designs; or (d) comprises or contains scandalous or obscene matter, shall not be registered.‖
>
> Section 4(b) clearly indicates that a design which has been disclosed to the public anywhere in India or in any other country or by publication in tangible form or by use or in any other way prior to the filing date, or where applicable, the priority date of the application for registration shall not be registered. This much is clear that prior disclosure to the public anywhere in the world is a complete bar on registration. This disclosure to the public can be by any of the three modes indicated in the provision itself, namely, (i) by publication in tangible form; or (ii) by use; or (iii) in any other way. Mr Sudhir Chandra, the learned senior counsel appearing on behalf of the defendant, was right in contending that in G***opal Glass Works*** *(supra)* the third mode referred to above, namely, —in any other way‖ was not considered at all. What was

considered was merely the aspect of publication. And, even in respect of that, my conclusions are different. It is pertinent to note the provisions of Section 19, which deal with cancellation of registration. The said Section reads as under:-

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

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

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

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

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

(e) that it is not a design as defined under clause (d) of section 2. (2) An appeal shall lie from any order of the Controller under this section to the High Court, and the Controller may at any time refer any such petition to the High Court, and the High Court shall decide any petition so referred.

It is apparent that if a design has been previously registered in India, the subsequent registration can be cancelled on that ground alone. Insofar as Section 19(1)(b) is concerned, prior publication of a design in India or in any other country is also a ground for cancellation of the registration of the design. Importantly, Section 19(1)(d) stipulates that a design can be cancelled also on the ground that the same was not registrable under the Act. This takes me back to Section 4 which I had already referred to above. Thus, if it can be shown that a design had been disclosed to the public anywhere in India or in any other country by any of the specified three modes, the registration of the design in India would be liable to be cancelled. For the sake of completeness, let me also mention Section 22(3) of the said Act which stipulates that in any suit or any other proceeding for relief under sub-Section (2) every ground on which the registration of a design may be cancelled under Section 19 shall be available as a ground of defence. It is, therefore, clear that the ground that the design could not be registered in view of the provisions of Section 4(b) would be a ground for cancellation of the registration in view of the provisions of Section

19(1)(d) and it would also be available as a ground of defence.

22. Reading the said provisions in this manner, it is apparent that, apart from the issue of prior publication, as indicated in Section 19(1)(b) of the said Act, prior disclosure to the public under Section 4(b) read with Section 19(1)(d) is also a ground for cancellation of registration. Section 4(b) is much wider than Section 19(1)(b), which only deals with publication. Section 4(b) of the said Act deals with disclosure to the public anywhere in India or in any other country. Such disclosure to the public may be by any of the three modes specified therein. One of the three modes is by publication in tangible form. The other two being —by use‖ and —in any other way‖. It is apparent that the concept of disclosure to the public is, therefore, wider than mere publication understood in the sense indicated in Section 19(1)(b). In G***opal Glass Works*** *(supra)* this wider aspect of disclosure to public was not considered and it was only the narrow aspect of publication, as indicated in Section 19(1)(b) which was the subject matter of concern.

23. In any event, I am not in agreement with the view that registration of a design would not amount to publication in any eventuality. Under the said Act, in view of the provisions of Section 7 thereof, the Controller is required to, soon after the registration of a design, cause publication of the prescribed particulars of the design to be published in the prescribed manner and thereafter the design is open to public inspection. At this juncture, it would be instructive to refer to a decision of a learned Single Judge of this Court in the case of ***National Trading v. Monica Chawla: 1994 PTC 233*** wherein the meaning of word —publication‖ in the context of a design was considered. The learned Judge observed as under:-

—(4) The question as to what would amount to pre-publication of the design has been very well stated in commentary by Russel and Clerk in Chapter-IV. This question has been dealt with as under:-
"meaning of publication.‖
Broadly speaking, there is publication if the design has been disclosed to the public as opposed to being kept secret. The question which has to be decided is,

therefore, has the public been put in possession of the design? Has it knowledge of the design? It is not, of course, necessary that every member of the public should possess the knowledge. It is sufficient, and there will be publication if the knowledge was either—
(1) Available to members of the public; or

(2) Actually in fact shown and disclosed to some individual member of the public who was under no obligation to keep it secret.

It is not necessary that the design should have been actually used. While considering the cases of knowledge available to public in Harris v. Rothwell, Lindley L.J., reported as (1887) 4 R.P.C. 225, it has been held in that case as under:- "It is sufficient to show that the invention was so described in some book or document, published in this country, that some English people may fairly be supposed to have known of it."

Again in Otto v. Steel, reported as (1886) 3 R.P.C. 109 (112), Pearson, J. has said as under:- "The question is whether or not this book has been published in such a way as to become part of the public stock of knowledge in this country. It is not, to my mind, necessary for that purpose to show that it has been read by a great many people, or that any person in particular has got from it the exact information which it is said would have enabled Dr. Otto in this case to have made his engine. But, to my mind, it must have been published in such a way that there may be a reasonable probability that any person, and amongst such persons, Dr.Otto, might have obtained that knowledge from it." In the case of Humpherson v. Syer, reported as (1887) 4 R.P.C. 407, Bowen L.J. held as under:-
"I put aside questions of public use, and treat this as a question of whether there has been a prior publication; that is, in other words, has information been communicated to any member of the public, who was free in law or equity to use it as he pleased. Was Widmer a person to whom this communication had been made in a manner which left him free both in law and equity to do what he liked with the information....You must take all the circumstances of the case, and ask yourself whether there was any

confidential relation established between the two parties-whether it was an implied term of the employment that the in format on should be kept by the shop man to himself, or whether he might afterwards, without any breach of good faith, use the matter, and use it as he chose."

(5) Thus it becomes clear that there is also pre-publication if the design is disclosed to any individual member of the public, who is not under an obligation to keep it secret. Disclosure to such person is sufficient to constitute publication of design.

24. Viewed in this light, the publication of the particulars of registered designs in terms of Section 7 of the said Act would amount to publication as understood in the context of Section 19(1)(b) as also publication in tangible form within the meaning of Section 4(b) of the said Act. To complete the discussion on public access to a registered design, it would be necessary to point out that Section 10 requires that a register of designs be kept at the Patent Office. Section 17 of the said Act provides for inspection of registered designs. It stipulates that during the existence of a copyright in a design, any person, on furnishing such information as may enable the Controller to identify the design and on payment of the prescribed fee, may inspect the design in the prescribed manner. Not only that, such person may also obtain a certified copy of any registered design. Section 26 also stipulates that every register kept under the Act shall at all convenient times be open to the inspection of the public, subject to the provisions of this Act, and that certified copies shall be given to any person requiring the same on payment of the prescribed fee. Rule 22 of the Designs Rules, 2001 (hereinafter referred to as the ‗said Rules') indicates the manner of publication of particulars of a registered design under Section 7. It provides that on acceptance of the design filed in respect of an application, the Controller shall direct the registration and publication of the particulars of the application and the representation of the article to which the design has been applied, in the Official Gazette. When publishing in the Gazette, the Controller may select one or more views of the representation of the design, which, in his opinion, would depict the best design. Rule 27 of the

said Rules also indicates that registered designs shall be open to public inspection after the notification of the said design in the Official Gazette and that the application together with the representation of the design may be inspected on a request made in Form-5.

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.

26. The position in the UK and perhaps in other countries is somewhat different. The Registered Designs Act, 1949, as applicable in the UK and as amended by the Copyright, Designs and Patents Act, 1988, speaks of registrable designs and proceedings for registration. However, Section 5 of the said Registered Designs Act, 1949 makes provision for secrecy of certain designs. Section 22 of the Act provides for inspection of registered designs. Section 22(1) clearly stipulates that where a design has been registered under the Act, they shall be open to inspection at the Patent Office, the representation or specimen of the design and any evidence filed in support of the applicant‘s contention that the appearance of an article, is material. However, it is specifically provided that the provision with regard to inspection would have effect subject to, *inter alia*, any rules made under Section 5(2) of the Registered Designs Act, 1949. Section 5(2) enables the Secretary of State to frame rules to make provision for securing that where secrecy of certain designs are to be maintained, the representation or specimen of the design and any evidence filed in support of the applicant‘s contention that the appearance of an

article is material, shall not be open to public inspection at the Patent Office.

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 a 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.

29. In the present case, I find that the designs registered in the UK and consequently in USA and Australia, are certainly not secret and are open to the public. Therefore, the defendant has been able to show, *prima facie*, that the design had been disclosed to the public in the UK, Australia and USA by publication in tangible form. The expression —in any other way‖ would also be wide enough to include registration as a mode of disclosure to the public. Therefore, *prima faice*, I am of the view that the prior registration in the UK, USA and Australia amounted to disclosure to the public as stipulated in Section 4(b) of

the said Act. This, in turn, means that it is a ground which is available to the defendant to seek cancellation of the plaintiff's registration and consequently, it is also a ground of defence in view of the provisions of Section 22(3) of the said Act.

QUESTION No.2

30. *De hors* the question of registration, I find that the defendant has been able to show that the design had been published prior to the date of registration. The two printouts filed along with the affidavit of Mr Gulraj Bhatia on 20.04.2007 are, of course, not very clear as to the features of the design such as the grooves and indentations but it gives an indication of the S-shaped spatula and overall appearance. The said printouts were of advertisements appearing abroad on or before November, 2003. That is, prior to the date of registration which was 05.12.2003. Apart from this, the defendant has also been able to show, *prima facie*, that the design of the very same spatula was advertised in Australia in the Magazine entitled ―Girlfriend‖. A copy of the Magazine of December, 2000 carries photographs of the plaintiff's product which also has photographs of the spatula which comes with the said Veet product. In these photographs the exact design and all the features of the spatula are clearly visible. It is obvious that the design was available to the public in the year 2000, much prior to the registration in India on 05.12.2003. Coupled with this, is the fact that the plaintiff did not file any reply to IA 3694/2008 despite opportunities having been given to it to do so. The *prima facie* conclusion, therefore, is that the design in question was published abroad prior to the date of registration in India."

We are in complete agreement with the reasoning of the learned Single Judge. In fact, the aforesaid reasoning would also be relevant when we would deal with the second aspect of this case with respect to the issue as to whether registration abroad is a ground of defence in infringement proceedings of a registered design in India.

11. We are unable to persuade ourselves to agree with th contention of the learned senior counsel for the appellant that there is no pleading with respect to the defence of prior publication in the written statement. The relevant paragraphs of the written statement which contain various defences, including the defence of prior publication, read as under:

> "1. The suit of the Plaintiff is liable to fail being based on a registration of a design which is liable to be cancelled under the provisions of Section 19 of the Designs Act 2000 on the following grounds which are without prejudice to one another:
>
> a) The design has been published in other countries prior to the date of its registration in India under No. 193988 dated 5th December, 2003. It is pertinent to note that the Plaintiff's Indian design is not based on a convention priority date.
>
> b) The design is not a new or original design;
>
> c) The design is not registerable under the Designs Act 2000 since its registration is prohibited under Section 4 of the Act as the design:
>
> (i) Lacks novelty since;
>
> * It is not new or original;
>
> * It is not significantly distinguishable from known designs or combination of known designs
>
> * It differs from existing designs only in immaterial details or in features which are variants commonly used in the trade
>
> (ii) Is prior published:
>
> * On account of being disclosed to the public in India and in other countries by publication in tangible form and

* By use, advertisement, etc. prior to the filing date in India

2. The impugned design registration No. 193988 has been obtained by the Plaintiff by playing a fraud on the Controller of Patents and Designs and is liable to be cancelled on the following grounds, among others:

i. There exists an earlier design registration No. 2055969 in the name of Reckitt Benckiser France, in the United Kingdom for an identical spatula design as that forming the subject matter of the present suit. This is dated 30th April 1996.

ii. There exists a prior US design patent registration No. 387629 dated 16th December 1997 for the line drawings of an identical spatula design in the name of Reckitt & Colman, France, which was filed in USA on 23rd October 1996 based on the UK design No. 2055969 dated 30th April 1996.

iii. There exists an Australian design registration No. 131347 dated 29th October 1996 in the name of Reckitt Benckiser France, also for line drawings of a spatula design identical to the US designs patent No. 387629.

True copies of the aforesaid three designs are filed herein."

Additional pleadings were also filed before the learned Single Judge in the form of affidavits with respect to prior publication and existence of the subject design in public domain prior to registration in India. Though various opportunities were given to the appellant to file replies to the same, however, the appellant failed to avail the opportunities to file the replies. It is also quite clear to us why no reply

was filed because the facts which are brought on the record before th learned Single Judge are undisputed facts of the publication of a magazine in Australia namely "Girlfriend" which clearly shows the publication of the subject registered design as used and published in Australia in December, 2000 i.e well prior to the registration of the design in India in December, 2003. The other material showing existence of the subject registered design in public domain prior to its registration in India appears to be a report as available in the internet prior to December, 1993 inasmuch it talks of the sale of the subject cosmetic depilatory of the appellant in various months prior to December, 2003 making reference to the subject design.

It was permissible for the learned Single Judge to call for and rely upon additional pleadings, especially since the pleadings pertain only to an interlocutory application, by virtue of the provisions of Order 8 Rule 9 of the Code of Civil Procedure, 1908 (CPC) along with Section 141 thereof which transcribes the procedure in the suit even with respect to the interlocutory proceedings. Therefore, existence of a defence of a prior publication in the written statement along with better pleadings as contained in the additional affidavits filed before the learned Single Judge show that there are sufficient pleadings with respect to prior publication. Any other view would be only a totally hyper-technical view which we consciously seek to avoid. In fact, if there is an averment of a material fact but material particulars are lacking, the Court can in fact call for the material particulars from the

concerned party under Order 6 Rule 4 of the CPC and therefo directions of the learned Single Judge to the respondent to permit the respondent to rely upon additional affidavits amounts to a direction and order of the learned Single Judge to call for better particulars from the respondent with respect to the pleadings of prior publication as existing in written statement. Such additional affidavits would in fact form part of pleadings and pleadings are not as such confined only and only to a plaint or a written statement or a replication. For example, even a statement under Order 10 CPC is not a plaint or a written statement but in fact is taken as part of pleadings. Light on this aspect is also thrown by Order 14 Rule 3 CPC and which states that the issues in the suit are framed not only from the pleadings but also from allegations on oath made by the parties or contents of documents produced by a party.

Finally, on the aspect of alleged lack of pleadings, we also note that the impugned order of the learned Single Judge does not show that any objection was raised with respect to non-existence of pleadings of prior publication pertaining to existence in public domain of the registered design, meaning thereby that this issue has not been argued before the learned Single Judge and it appears to be raised as an afterthought in the present appeal. If an argument of lack of pleading was in fact urged before the learned Single Judge, we are sure that the learned Single Judge would then have dealt with it. We also do not find in the grounds of appeal that where the appellant has

contended that it had raised an issue of lack of pleadings before th learned Single Judge but the learned Single Judge wrongly ignored this aspect.

Therefore, we reject the contention as raised on behalf of the appellant that there were no sufficient pleadings before the learned Single Judge on the aspect of prior publication or existence in public domain of the registered design prior to its registration in India.

12. We, therefore, hold that the defence of the respondent-defendant before the learned Single Judge that there was prior publication abroad and existence of the subject design in public domain was a valid defence on behalf of the respondent-defendant disentitling the appellant/plaintiff to an injunction. There is a related aspect with respect to existence in the public domain for a period of six months in view of the provision of Section 44 of the Act and though the design may be available in public domain for the said period yet the same would not be a defence in infringement proceedings. This aspect is adverted to by us later while dealing with the second aspect of whether registration abroad can be a defence in the proceedings for infringement of a registered design in India.

13. Now, coming to the second issue which is called for decision in the present case and which issue is whether registration abroad is a ground for cancellation of a registered design in India and consequently is also a ground of defence available in proceedings for

infringement of a registered design. The learned Single Judge has he that registration of a design abroad is available as a ground of defence in proceedings for infringement of a registered design in India if consequent to registration there is publication of the design registered abroad in the country where it is registered or any other country because post registration there is availability of the registered design for inspection and consequently it can be said that the registered design becomes available in public domain. As a corollary to the above, it has been held that if a design registered abroad is kept confidential on account of provisions which exist for keeping the said design as secret and confidential, like in the UK where there are such provisions, then, registration of a design abroad will not be available as a ground of defence for cancellation of a design registered in India and also as a ground of defence therefore to infringement proceedings because on account of the design remaining secret the same is not in public domain.

To appreciate this issue, besides the provisions of the Act already referred to, it is necessary to refer to Section 44 of the said Act because an answer to the issue is only possible on a conjoint reading of Sections 4, 9 and Section 44. Section 44 of the said Act, and more particularly sub section (2) is relevant and the same read as under:

> "**44. Reciprocal arrangement with the United Kingdom and other convention countries or group of countries or inter-governmental organizations.-** (1) Any person who has applied for protection for any

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

Provided that-

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

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

44(2) The registration of a design shall not be invalidated by reason only of the exhibition or use of or the publication of a description or representation of the design in India during the period specified in this section as that within which the application may be made."

A reading of Section 44 shows that a person who has registered his design abroad will be entitled to get his design registered in India within a period of six months of the application for protection/registration. Of course, the application filed abroad must necessarily be in the UK or such other convention countries or group of countries which are members of inter governmental organizations. In case, registration is applied in India within the specified time of six months, then, the priority date of registration will be the priority date of the registration made abroad in the countries specified. The effect

of this would be that once the design is registered also in India, after i registration in the specified countries, then, infringement will lie with respect to products which infringe the registered design prior to the date of application in India as long as the same is after the priority date with respect to the design registered abroad. Effectively, there is retrospectivity of registration by virtue of Section 44 on account of the priority date in India being not the date of application for registration in India but the date of application for registration in the specified country abroad. Sub section (2) throws further light on this issue by specifying that merely because the registered design comes into public domain in India within the period of six months required for registration of the design in India, the same will not prevent the validity of registration merely because there is publication/availability of the registered design in the public domain within this period of six months. Putting it differently, and this is the important aspect, that, in case there is no application made for registration in India within the specified period of six months of filing of the application abroad in the specified country for registration, then, in case the registered design abroad comes in public domain, the same would amount to prior publication although the design registered abroad is subsequently registered in India. Meaning thereby if the design registered abroad is registered in India after the period of six months of making of the application abroad and during this interregnum period after expiry of six months and before the date of making application for registration in India there is

publication of the design registered abroad or the same is brought in public domain, and, the same would mean that in terms of Section 4(b) there is disclosure to the public anywhere in India or in any other country by publication either intangible form or by use or any other way prior to the priority date for filing in India or the priority date of application for registration. The latter part of Section 4(b) which specifies "or where applicable, the priority date of the application for registration" is important because the same has reference to the provisions of sub sections (1) and (2) of Section 44 of the said Act. The priority date for registration in India on a conjoint reading of Section 4(b) and Section 44 would be either the date of filing of the application in India or the priority date of the application for registration in terms of Section 44 i.e. the date of application for registration abroad, **where so applicable** i.e. the aforesaid expression in Section 4(b) provides for priority date for designs registered abroad for infringement actions for designs registered in India provided that design registered abroad in the specified country is also registered in India within six months of the date of filing of the application abroad for registration of the design. Consequently, Section 4(b) has to be read alongwith sub section (1) and (2) of Section 44 and on reading of the said provisions alongwith Sections 19(1)(a) and 19(1)(b), it becomes clear that a design which is previously registered abroad will also be a ground for cancellation of a design and therefore a ground of defence to infringement proceedings on an Indian registered design in case

registration is applied for in India of the design which is registere abroad beyond the period of six months of the date of making the application abroad in the specified country. In a way, therefore, the provisions of sub sections (1) and (2) of Section 44 read with Section 4(b) containing the expression "where applicable, the priority date of application for registration" shows that the publication within the meaning of Section 19(1)(b) with respect to a foreign registered design would be a valid defence on the ground of prior publication if after making of an application abroad in a specified country for registration, there is no application for India for registration of the same design within the period of six months of making of the application abroad in the specified country for registration. The same conclusion is also the result when we read the expression "not be invalidated" as "be invalidated" taking the facts/circumstances as opposite than as provided in Section 44(2) i.e. Section 44(2) in effect states that registration of design in India after six months of making of the application abroad is invalidated on account of availability in public domain of the design registered abroad in India (includes accessible in India though in public domain abroad) as also through travel abroad within the period of six months in which the application for registration ought to have been made but is not made and is made only subsequent to the said six month period.

If registration abroad, even if it is available in public domain thereafter whether in India and/or abroad, is not a ground for

cancellation of the registration in India, the same would lead to pate and absurd consequences. For example, Mercedes or Toyota or Honda the famous car companies may get registration of its design for a car abroad and another person in India may although such design is available in public domain post registration abroad get the same design registered in India and then claim that since the design is only registered abroad the same is not a ground for cancellation of his design which is registered in India, although the design registered in India is completely identical or reproduction of the design registered abroad. The same would also be the case with respect to the other designs for any other article. Surely, the Legislature could never have intended that a design in India which is a complete copy of design registered abroad cannot be cancelled although the design was registered abroad and thereafter available in public domain post its registration abroad.

The net conclusion of the above is as under:

(i) A design would continue to remain new although it is published in India or abroad i.e. available in public domain in India or abroad within the period of six months after making of an application abroad for registration of such design in the specified country abroad if within this six month period an application is also made in India for registration of the design for which application is made abroad in the specified country.

(ii) In case, however, no application is made in India for registratic within a period of six months of making of an application abroad for registration of design in the specified country and if before the period of six months or after six months but before making the application for registration in India the design registered abroad comes into public domain, the availability of the design registered abroad in public domain will result in the design becoming not new on account of falling within the eventuality of Section 44 (2) read with Section 4(b) of availability in public domain.

14. A reading of the decision of the Division Bench of this Court in the case of ***Dabur India Ltd. (supra)*** shows that there is no discussion in the same with respect to inter play and inter relation between Sections 4(b), sub sections (1) (a) and (1) (b) of Section 19 and sub sections (1) and (2) of Section 44 nor is this inter play of the said Sections found in the judgment of learned Single Judge of the Calcutta High Court in the case of ***Gopal Glass Works Ltd.(supra) ,*** the ratio of which has been accepted by the Division Bench in the case of ***Dabur India Ltd. (Supra).***

The only discussion found in this aspect in ***Dabur India Ltd. (supra)*** is in paras 24 to 26 which read as under:

> "**24.** Counsel for the Respondent Defendant submitted that the very design in respect of which the registration has been granted in favour of the Plaintiff is already in the public domain and has been published earlier. The Respondents have relied upon the Design Registration

Nos.319582 and 263373 issued by the US Patent Office to contend that there is no novelty as far as the Plaintiff's designs are concerned. In the first place it must be noticed that the reliance upon a design registered in the US cannot satisfy the requirements of Section 19 of the present Act which specifies the ground on which cancellation can be granted. Section 19 reads as under:

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

(a) that it has been previously registered in India;

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

25. We find that the Calcutta High Court has in **Gopal Glass Works Ltd. v. Assistant Controller of Patents & Designs, 2006 (33) PTC 434 (Cal)** explained the position, with which we concur, as under:

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

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

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

The aforesaid inter play of Sections, especially the provisions of sub sections (1) and (2) of Section 44 with Section 4(b) and also the

reasoning given by the learned Single Judge on this aspect reproduced extensively above with respect to claim of defence of prior publication on the basis of foreign registration which we have already agreed with, having not been considered by the Division Bench in the case of ***Dabur India Ltd. (supra)***, it would be appropriate that the matter is referred to a decision by a larger Bench of this Court for determination.

15. We are thus unequivocally of the view that the conclusion of the learned Single Judge dis-entitling the appellant to injunction on the ground of prior publication/existence in public domain is unexceptionable.

16. We, however, simultaneously find that the consequences of registration abroad being not available as a defence is required to be examined by a larger bench in view of our respectful disagreement with the expression of view in ***Dabur India Case (supra)***. The larger bench would thus have to examine the consequences of registration abroad which is not kept secret post registration as in our view the same would amount to publication of such design and its availability in public domain in India or abroad. This is of course subject to the condition that no application for registration of the foreign design is filed in India within a period of six months of the date of making of the application for registration abroad in the specified country under Section 44 of the said Act. The consequence arises as there would be dis-entitlement to the registration in India post the period of six months

of making of the application abroad and there would be invalidation the design registered abroad in view of Section 44(2) of the said Act.

17. The matter be placed before the Hon'ble the Chief Justice for necessary directions.

VALMIKI J. MEHTA, J.

OCTOBER 08, 2010 **SANJAY KISHAN KAUL, J.**
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