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

+ **CS(COMM) 865/2022**

TTK PRESTIGE LTD...... Plaintiff
Through: Mr. Manish Kr. Mishra, Ms.
Akansha Singh and Ms. Saloni Kasliwal,
Advs.

versus

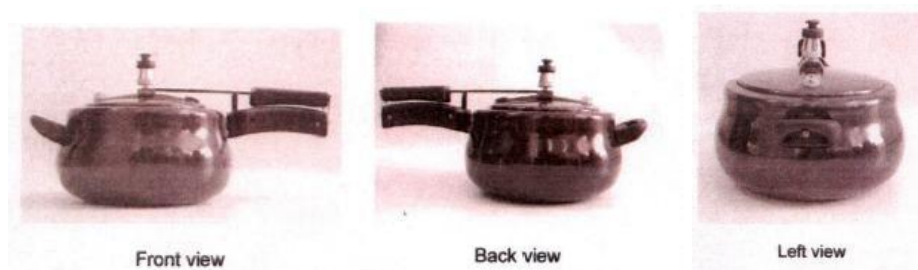
GUPTA LIGHT HOUSEDefendant
Through: Mr. Kunal Khanna and Mr. Manish
Singhal, Advs.

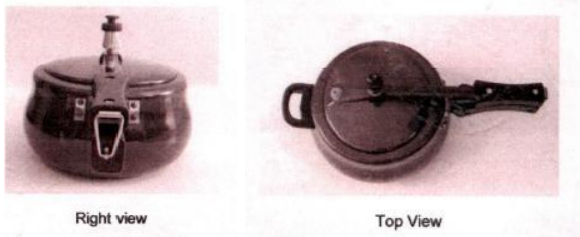
**CORAM:
HON'BLE MR. JUSTICE C.HARI SHANKAR**

ORDER (O R A L)
24.07.2023

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1. The plaintiff pleads infringement, by the defendant, of the design of a cooker, registered in favour of the plaintiff *vide* Registration No. 197906 by the Design Office in the Patent Office, Government of India. The various views in respect of the suit design, in terms of which registration has been granted are as under:





The certificate of registration certifies, as in most cases, that –novelty resides in respect of the shape and configuration of the cooker as illustrated.

2. The suit was originally filed before the learned District Judge (Commercial Court) as CS (Comm) 1892/2019. Consequent on completion of pleadings and admission and denial of documents, the following issues were framed by the learned Commercial Court on 4 September 2019:

- (1) Whether the suit filed by the DH is not maintainable and is liable to be dismissed as alleged Registration of the plaintiff is invalid and is liable to be cancelled under the provisions of Section 19¹ of the Designs Act, 2000? OPD
- (2) Whether the plaintiff is entitled to a decree of permanent injunction as per sub clause (a) of the prayer clause? OPP
- (3) Whether the plaintiff is entitled to a decree for delivery up of the infringing goods of the defendant, as per sub clause

¹ 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.

(b) of the prayer clause? OPP

(4) Whether the plaintiff is entitled to a decree for a sum of ₹ 5,00,000/- as per sub clause (c) of the prayer clause? OPP

(5) Relief.

3. The suit has been heard finally, after completion of pleadings, framing of issues, and recording of evidence.

4. The plaintiff alleges that the design of the pressure cookers manufactured and sold by the defendant are obviously or fraudulently imitative of the registered suit designs, within the meaning of Section 22(1)² of the Designs Act, 2000 and that, therefore, the defendant is guilty of design piracy under the said provision. The plaint provides the following photographs of the defendant's products and the plaintiff's products, which stand exhibited as Ex. PW-1/9 and Ex. PW-1/4, respectively.

Plaintiff's Pressure Handi Cookers

² 22. Piracy of registered design. –

- (1) During the existence of copyright in any design it shall not be lawful for any person –
- (a) for the purpose of sale to apply or cause to be applied to any article in any class of articles in which the design is registered, the design or any fraudulent or obvious imitation thereof, except with the licence or written consent of the registered proprietor, or to do anything with a view to enable the design to be so applied; or
 - (b) to import for the purposes of sale, without the consent of the registered proprietor, any article belonging to the class in which the design has been registered, and having applied to it the design or any fraudulent or obvious imitation thereof; or
 - (c) knowing that the design or any fraudulent or obvious imitation thereof has been applied to any article in any class of articles in which the design is registered without the consent of the registered proprietor, to publish or expose or cause to be published or exposed for sale that article.



Defendant's Pressure Handi Cookers



5. Physical samples of the rival products have also been produced in Court before me, and the photographs as reproduced hereinabove faithfully replicate the actual products.

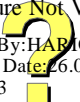
6. Mr. Mishra, learned Counsel for the plaintiff submits that the design of the defendant's products is identical to the suit design and that, therefore, it is a clear case of design piracy. He submits that the only substantial defence raised by the defendant in his written

statement is that the suit design is bad for prior publication. However, he submits that no prior publication of the suit design is forthcoming on the record and that all other representations of pressure cookers bearing similar designs, filed by the defendant, relate to a period after 13 December 2004, when the suit design was registered in favour of the plaintiff.

7. Mr. Mishra, submits further that the defendant has also pleaded that the suit design is bad as it is purely functional in nature. However, there is no material whatsoever to substantiate the said plea, forthcoming on the record.

8. Responding to the submissions of Mr. Mishra, Mr. Kunal Khanna, learned Counsel for the Defendant has drawn attention to the issues that were framed in this case by this Court on 4 September 2019.

9. Insofar as Issues 2 and 3 are concerned, Mr. Khanna submits that the plaintiff cannot be given relief in terms of either of the said issues as the suit design has expired by efflux of time on 13 September 2019 and is now in the public domain, available for exploitation while anyone who seeks to do so. As such, he submits that there can be no permanent injunction against use of the suit design at this point of time. For the same reason, he submits that no order directing delivery up of any infringing goods of the defendant can be granted.



10. Apropos Issue 1, Mr. Khanna submits that the suit design is bad for want of novelty and originality. However, the only submission that he is in a position to advance, to support this plea, is a reference to the opening sentences in para 9 of the plaint, which read thus:

-Considering the Indian women used to cook food in Handi, an earthen pot, prior to pressure cooker, the Plaintiff conceptualised the idea of handi pressure cooker in the year 2004 with aim to make the kitchen smarter but yet to retain the tradition values and the PRESTIGE Nakshathra handi pressure cooker was launched in the market in the year 2005The effort, skill and knowledge of the experts at the instruction of the Plaintiff led to realisation of the novel and unique design of the Plaintiff's pressure cooker. The said unique and novel design and product drawings are subject matter of intellectual property rights owned by the Plaintiff.¶

11. Mr. Khanna's submission is that a *handi* is a well-known cooking vessel which has been used in India since ancient times and that this Court can, therefore, take judicial notice of the similarity between the design of a *handi* and a suit design. He submits that the plaintiff has, by averring as above, in para 9 of the plaint, admitted the fact that the suit design is merely a replication of the design of a *handi* and cannot, therefore, lay any claim to novelty or originality. Relying on the judgment of this Bench in *Jayson Industries v. Crown Craft (India) Pvt. Ltd.*³, Mr. Khanna submits that originality can be ascribed to a design only if the design originates in the mind of its creator. A design which borrows from an earlier existing design cannot, *ex facie*, be treated as original. In view of the admission, in para 9 of the plaint, that the suit is based on the design of the pre-existing and well-known design of a *handi*, Mr. Khanna's submission is that the suit design

³ 2023 SCC OnLine Del 3750

suffers from want of novelty and originality.

12. Mr. Khanna has further placed reliance on para 16 of the plaint, *vis-à-vis* the definition of design as contained in Section 2(d)⁴ of the Designs Act. He points out that the statute expressly excludes, from the definition of –design, a mark which is capable of being registered as a trademark under the Trade Marks Act, 1999. Para 16 of the plaint, submits, Mr. Khanna, admits that the suit design is capable of being registered as a mark under the Trade Marks Act and also seeks protection of Section 9(3) thereof. Even on this ground, submits Mr. Khanna, the suit design is vulnerable to invalidity under clause (e) of Section 19(1)⁵ of the Designs Act.

13. Mr. Khanna further submits that, even if one were to examine the suit design as such, *de hors* the pleadings in the plaint, it would become immediately apparent that the individual features of the suit design, such as the handle, the vessel, the cap etc. are well-known in the trade even much prior to the registration of the suit design. He,

⁴ (d) –design means only the features of shape, configuration, pattern, ornament or composition of lines or colours applied to any article whether in two dimensional or three dimensional or in both forms, by an 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 clause (v) of sub-section (1) of Section 2 of the Trade and Merchandise Marks Act, 1958 or property mark as defined in Section 479 of the Indian Penal Code or any artistic work as defined in clause (c) of Section 2 of the Copyright Act, 1957;

⁵ **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.



therefore, submits that, even on this score, the suit design suffers from want of novelty and originality.

14. Apropos the aspect of damages, Mr. Khanna submits that, as the suit design is itself invalid, there can be no question of any damages being payable to the plaintiff. He further submits that the plaintiff has not placed on record any invoices relating to sale of goods under the suit design as all invoices which are placed on record were de-exhibited. He also submits that even the sales figures provided with the plaint are cumulatively for all products and that, therefore, the plaintiff has not been able to demonstrate the loss, if any, which it has suffered on account of use of the impugned design by the defendants. No claim to damages can, therefore, be raised by the plaintiff.

15. Responding to the aforesaid submissions, Mr. Mishra submits that the averment, in para 9 of the plaint, was with respect to the entire get up of the plaintiff's pressure *handi* cooker, and not merely with respect to the suit design. Even otherwise, he submits that it can hardly lie in the mouth of the defendant to raise this contention, as the defendant has, in the corresponding paragraph of the written statement, specifically denied that the suit design is a mark or is capable of being registered as a trademark.

16. I have heard learned Counsel for both sides at length and perused the material on record.

Analysis

17. The plaintiff is a holder of the valid registration for its cooker, granted on 13 December 2004. The certificate of registration clearly states that novelty resides in the shape and configuration of the cooker. A glance at the cooker makes it apparent that it does not bear the conventional shape of a cooker but has a bulging mid/lower section, which is not ordinarily found in cookers. As such, the design of the plaintiff's cooker has clear distinctive eye appeal, which is one of the definitive criteria for entitlement to registration as a design.

18. A comparison of the suit design with the defendant's product, as also a comparison of the plaintiff's and the defendant's product themselves, make it clear that the design of the defendant's product is imitative of the suit design. Though the defendant has sought to place on record various photographs of pressure cookers having similar designs, there is not a single photograph which is prior to the date of registration of the suit design i.e. on 13 December 2004. In the absence of any photograph or other representation of a pressure cooker bearing a design similar to the suit design, dating prior to 13 December 2004, it cannot be said that the suit design is bad for prior publication. It is quite possible that, in view of the novelty of the suit design, other manufacturers had copied it.

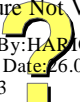
19. Insofar as plea of want of novelty is concerned, there is not a scintilla of material placed on record by the defendant to support the stand. Mr. Khanna, too, is unable to draw my attention to any material on record which can indicate that the suit design is bad for want of



novelty. He merely relies on para 9 of the plaint which states that, at one point of time, Indian women used to cook food in *handi*, an earthen pot, prior to the pressure cooker from which the plaintiff has conceptualised the idea of a *handi* pressure cooker. By no stretch of imagination can this averment be treated as denuding the suit design of novelty or originality. No picture or representation of any *handi* has been placed on record by the defendant – on whom the onus to prove want of novelty and originality had been placed by this Court while framing issues – to indicate that the suit design was similar in any form to any prior existing design of a *handi*. Mr. Khanna sought to exhort the Court to take judicial notice of the well-known shape of *handis* in Indian culture. However, in a commercial suit, it is quite obvious that this Court cannot pass orders on the basis of its imagination.

20. There is no material, therefore, to substantiate the defendant's argument that the suit design is bad for want of novelty and originality. The said plea, therefore, is rejected.

21. Apropos the so-called admission in para 16 of the plaint that the suit design is registrable as a trademark, Mr. Mishra has pointed out that the said averment was made with respect to the overall get up of the pressure cooker. Even otherwise, the onus to prove that the suit design was bad for want of novelty and originality, was as already noticed hereinabove, placed on the defendant by this Court while framing issues. The defendant has, in its written statement, categorically averred as under:



-It is further denied that the alleged design on the alleged goods makes the alleged goods distinctive *or that the get-up of the plaintiff's 'PRESTIGE Pressure Handi Cooker' constitutes mark and trade mark within the meaning of the Trade Marks Act* or that the same is valuable intellectual property rights of the plaintiff or that the same is entitled to protection under the Trademarks Act including under section 9(3) as well as under the common Law.¶

(Emphasis supplied)

Mr Kunal Khanna seeks to point out, in this context, that the written statement also avers, in para 1(e) thus:

-(e) The alleged design of the plaintiff was not registrable *as plaintiff has alleged that its alleged design comprising the unique get-up constitutes trademark within the definition of 'trademark' defined under section 2(1)(zb) of the Trademarks Act and as such, the alleged design could not have qualified as 'design' as per the Designs Act.*"

(Emphasis supplied)

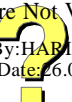
A reading of Section 2(d) of the Designs Act discloses that it excludes every trade mark as defined in Section 2(1)(v)⁶ of the Trade and Merchandise Marks Act, 1958. It may fall for consideration as to whether the Court can, by judicial fiat, substitute, in place of –Section 2(1)(v) of the Trade and Merchandise Marks Act, 1958¶, –Section 2(1)(zb) of the Trade Marks Act, 1999¶, though, in the judgment of the Full Bench of this Court in *Micolube India v. Rakesh Kumar*⁷, there is an observation in the affirmative. It is not, however, necessary to enter into that arena as, in the face of the aforesaid averment by the defendant, to the effect that the suit design was not

⁶ (v) –trade marks¶ means –

(i) in relation to Chapter X (other than Section 81), a registered trade mark or a mark used in relation to goods for the purpose of indicating or so as to indicate a connection in the course of trade between the goods and some person having the right as proprietor to use the mark; and

(ii) in relation to the other provisions of this Act, a mark used or proposed to be used in relation to goods for the purpose of indicating or so as to indicate a connection in the course of trade between the goods and some person having the right, either as proprietor or as registered user, to use the mark whether with or without any indication of the identity of that person, and includes a certification trade mark registered as such under the provisions of Chapter VIII;

⁷ 198 (2013) DLT 120



registrable as a trademark, it can obviously not lie in the mouth of Mr. Khanna to seek to press, into service, the exclusionary latter part of the definition of –design|| as contained in Section 2(d) of the Designs Act. A party cannot raise one plea in writing and argue an exact opposite plea during arguments in Court.

22. The final plea of Mr. Khanna is on the aspect of functionality. Again, there is nothing to indicate that the suit design was vulnerable to invalidity as it was purely functional in nature. This Court has, in its recent decision in *TTK Prestige Ltd. v. KCM Appliances Private Limited*⁸ as well as *Jayson Industries*³ had occasion to deliberate, in some detail, on the aspect of functionality as a delimiting factor in registrability of designs. Functional designs, *per se*, are not ineligible to registration. It is only if a design is *purely* functional and not possessed of any aesthetic appeal, that the design becomes non- registrable, as held by Ruma Pal, J. (as she then was), sitting singly in the Calcutta High Court in *Castrol India Ltd v. Tide Water Oil Co. (I) Ltd*⁹, following the decision in *In re. Lamson Industries Ltd's Application*¹⁰.

23. In the present case, it cannot be said, that the suit design has no aesthetic appeal. Clearly, the suit design has aesthetic appeal even *vis-à-vis* prior art and *vis-à-vis* other known and commonly seen designs of pressure cookers. The mere fact that it has a functional attribute cannot, therefore, divest it from its right to registration as a design. A

⁸ 2023 SCC OnLine Del 2129

⁹ 1996 (16) PTC 202 (Cal)

¹⁰ (1978) RPC 1

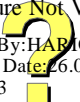


design which is functional and also possesses aesthetic qualities is entitled to be registered as a design. The plea that the suit design is vulnerable to invalidity as it is purely functional can also, therefore, not be exhibited and is accordingly rejected.

24. Having said that, it is also a matter of fact that the suit design has expired, by efflux of time, on 13 December 2019. Mr. Khanna is right in his submission that, therefore, the suit design is now in the public domain and there can be no judgment or decree restraining use of the suit design by anyone at this point of time. The only aspect that would survive for consideration is, therefore, the aspect of damages, presuming this Court were to hold that, in fact, that the design of the defendant's pressure cookers does amount to piracy of the suit design within the meaning of Section 22(1) of the Designs Act.

25. On the facts stated hereinabove, as none of the defences raised by Mr. Khanna relatable to Section 19 of the Designs Act have been to be sustainable, and as, on facts, this Court has found the design of the defendant's pressure cookers to be obviously imitative of the suit designs, a clear case of piracy within the meaning of Section 22(1) of the Designs Act exists.

26. On the aspect of damages, Mr. Mishra, for the present, restricts his claim to a direction to the defendant to render accounts of the earnings earned by the defendant by sale of the pressure cookers bearing the impugned designs, reserving his right to claim damages in future on the basis of the accounts as rendered.



27. Mr Khanna sought to contend that, where a suit claims damages and rendition of accounts, the plaintiff has to elect, at the time of framing of issues, the remedy which he ultimately seeks. Inasmuch as, at the time of framing of issues, the plaintiff in the present case elected to claim damages, no relief of rendition of accounts can, in his submission, be granted.

28. Mr Khanna did not cite any authority in support of his submission. A.K. Sikri, J. (as he the was), sitting singly in this Court has, on the other hand, held to the contrary in *Titan Industries v. Nitin P. Jain*¹¹.

Conclusion

29. In view thereof, the issues framed in the present case are decided thus:

Issue 1 – In favour of the plaintiff and against the defendant. The suit filed by the plaintiff is maintainable. The suit design is not vulnerable to invalidity on any of the grounds envisaged in Section 19 of the Designs Act.

Issue 2 – In favour of the defendant and against the plaintiff. The plaintiff cannot be granted a decree of permanent injunction as the suit design has expired on 13 September 2019.

Issue 3 – In favour of the defendant and against the plaintiff.

¹¹ (2006) 126 DLT 132

As the suit design has expired, and there are no seized goods, no direction for delivery up can be passed.

Issue 4 – Not pressed by the plaintiff.

Issue 5 – The plaintiff is entitled to a decree of rendition of accounts against the defendant, as also to costs.

30. The present suit is decreed by directing the defendant to render accounts by filing on affidavit the details of the earnings made by the defendant by sale of the pressure cookers bearing the impugned designs, from the beginning, duly certified by a Chartered Accountant. Said details shall be filed before this Court within a period of four weeks from today. Liberty shall separately stand reserved with the plaintiff, thereafter, to proceed against the defendant for recovery of damages, if it so chooses.

31. The plaintiff shall also be entitled to actual costs of the present litigation, for which purpose, the plaintiff is directed to place on record a certificate of costs incurred by it. For the purpose of computation of costs, let this matter be listed before the Taxation Officer of this Court on 29 August 2023.

32. The suit stands decreed in the aforesaid terms.

C.HARI SHANKAR, J

JULY 24, 2023

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