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

+ CS(COMM) 98/2023 & I.A. 3530/2023, I.A. 3531/2023

V GUARD INDUSTRIES LTD Plaintiff

Through: Mr. Sachin Gupta, Mr. Rohit Pradhan, Mr. Manan Mondal and Mr. Lokesh Dhaka, Advs.

versus

MS MAHAVIR HOME APPLIANCES AND ANR.

..... Defendants

Through: Mr. Sivaraman Vaidyanathan, Adv.

CORAM:

HON'BLE MR. JUSTICE C.HARI SHANKAR

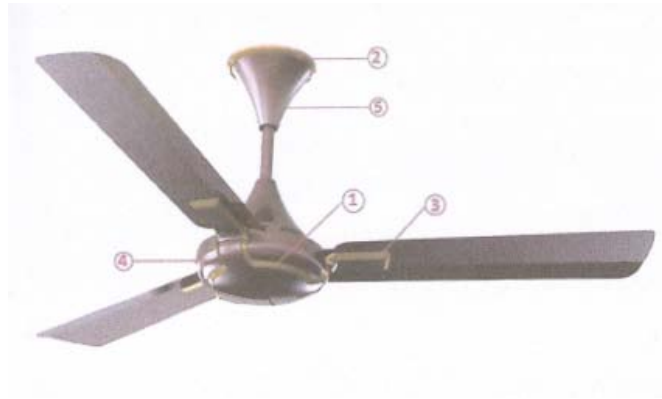
ORDER

% **28.02.2023**

CS(COMM) 98/2023 & I.A. 3530/2023 (under Order XXXIX Rules 1 & 2 of the CPC)

1. We are concerned, in the present case, with ceiling fans.
2. The plaintiff is the holder of design registration No. 330602-001 dated 1st July 2020, for a ceiling fan. As is usual in such cases, the certificate of registration, as granted, registered the design individually in respect of its perspective view, seen from the top and from the bottom, the bottom view, the top view and the side view. For the purposes of the order being passed today, it is necessary only to reproduce the registrations and the recitals in that context, as certified by the Controller of Designs, in respect of the top perspective view, the bottom perspective view and the bottom view of the ceiling fan, thus:

“Perspective view – Bottom



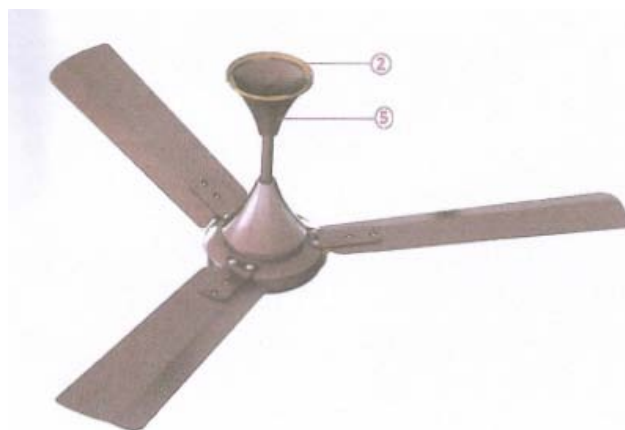
Endorsement of novelty:

The novelty resides in the shape, configuration and surface ornamentation of ‘Ceiling fan’, in particular the portions marked ‘1’, ‘2’, ‘3’, ‘4’, ‘5’ and ‘6’ as illustrated.

Endorsement of disclaimer:

No claim is made by virtue of this registration in respect of any mechanical or other action of mechanism whatsoever or in respect of any mode or principle of construction of the article or colour combination.”

“Perspective view – Top



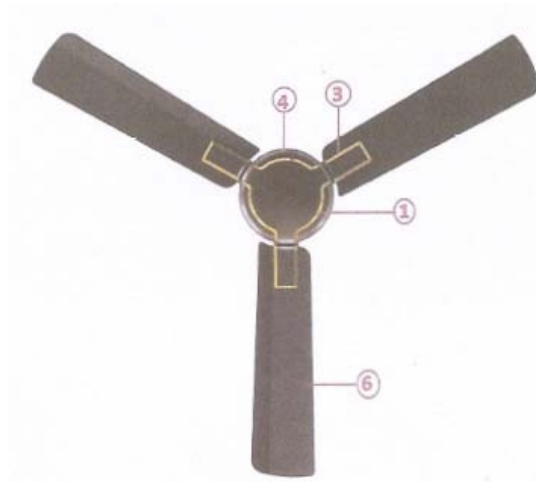
Endorsement of novelty:

The novelty resides in the shape, configuration and surface ornamentation of ‘Ceiling fan’, in particular the portions marked ‘1’, ‘2’, ‘3’, ‘4’, ‘5’ and ‘6’ as illustrated.

Endorsement of disclaimer:

No claim is made by virtue of this registration in respect of any mechanical or other action of mechanism whatsoever or in respect of any mode or principle of construction of the article or colour combination.”

“Bottom view



Endorsement of novelty:

The novelty resides in the shape, configuration and surface ornamentation of ‘Ceiling fan’, in particular the portions marked ‘1’, ‘2’, ‘3’, ‘4’, ‘5’ and ‘6’ as illustrated.

Endorsement of disclaimer:

No claim is made by virtue of this registration in respect of any mechanical or other action of mechanism whatsoever or in respect of any mode or principle of construction of the article or colour combination.”

3. Unusually for the Controller of Designs, the registration granted to the petitioner in the present case individually identifies the features of the suit design which are novel and original. A reading of the extracts from the registration granted to the suit design reproduced hereinabove disclose that

- (i) novelty has been certified to reside in the shape, configuration and surface ornamentation of the ceiling fan and
- (ii) in particular, novelty has been certified to reside in the features identified as ‘1’ to ‘6’.

4. Of these features ‘1’ to ‘6’ which have been, in particular, certified as novel by the Controller of Designs,

- (i) Feature 1 relates to the curved golden design on the motorhead assembly of the ceiling fan,
- (ii) Feature 2 relates to the metallic hub, constituting the

circumference of the head of the canopy of the ceiling fan,

(iii) Feature 3 relates to the extension of the golden design on the motorhead of the ceiling fan on to its arms, in a golden rectangular shape,



(iv) Feature 4, though somewhat unclear, appears to be referring to the edge of the central motorhead of the ceiling fan,

(v) Feature 5 refers to the shape of the canopy which is concave in nature and

(vi) Feature 6 relates to the shape of the blades of the fan.

5. I have heard Mr. Sachin Gupta, learned Counsel for the plaintiff and Mr. Sivaraman Vaidyanathan, learned Counsel for the defendant at some length and perused the material on record.

6. Mr. Gupta submits that the design of the defendants' fan is identical or, at the very least, an obvious imitation of the suit design within the meaning of Section 22(1)¹ of the Designs Act, 2000. For this purpose, the plaint provides a tabular comparison of the individual features of the plaintiff's and the defendants' fans, thus:

| Plaintiff's fan | Defendant's fan |
|---|--|
|  MOTOR-BLADE ASSEMBLY |  MOTOR-BLADE ASSEMBLY |

¹ 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.



7. I may immediately observe, here, that, *prima facie*, the submission of Mr. Gupta that the design of the defendants' fan is an obvious imitation of the design of the plaintiff's fan within the meaning of Section 22(1) of the Designs Act merits acceptance. On the concepts of obvious and fraudulent imitation, as envisaged in Section 22(1), the following passages, from the decision of Ruma Pal J, as she then was, sitting singly in the High Court of Calcutta in

*Castrol India Ltd. v. Tide Water Oil Co. Ltd*² have become part of legal lore:

“25. In judging the articles solely by the eye the Court must see whether the defendant's version is an obvious or a fraudulent imitation.

26. In *Dunlop Rubber Co. Ltd. v. Golf Ball Developments Ltd.*, (1931) XLVIII RPC 268 at 279, the meaning of the word ‘obvious’ and ‘fraudulent’ have been stated

“... ‘obvious’ means something which, as soon as you look at it, strikes one at once as being so like the original design, the registered design, as to be almost unmistakable. I think an obvious imitation is something which is very close to the original design, the resemblance to the original design being immediately apparent to the eye looking at the two.”

27. In a later portion of the judgment it was said:



‘...fraudulent imitation seems to me to be an imitation which is based upon, and deliberately based upon, the registered design and is an imitation which may be less apparent than an obvious imitation; that is to say, you may have a more subtle distinction between the registered design and a fraudulent imitation and yet the fraudulent imitation, although it is different in some respects from the original, and in respects which render it not obviously an imitation may yet be an imitation, imitation perceptible when the two designs are closely scanned and accordingly an infringement.’ ”

8. Physical samples of the plaintiff’s and the defendants’ fans have also been provided in the Court. On an examination thereof, it is clear that the photographs in the tabular statement afore-extracted, as contained in para 1 of the plaint faithfully reproduce the essential features of both the fans.

9. Apropos, the submission of Mr. Gupta that the design of the defendants’ fan is an imitation of the suit design, the only aspect in

² 1996 (16) PTC 202 (Cal)
CS(COMM) 98/2023

respect of which the two designs differ, even as per the submission of Mr. Vaidyanathan, is with respect to feature 3 in the list of novel features as certified by the Controller of Designs i.e. the golden extension of the circular design on the motorhead, on to the blades of the fan. There is such an extension even in the blades of the defendants' fan; however, the difference between the two extensions is that the extension as it exists towards the blade of the defendants' fan has a rounded edge unlike the extension towards the blades of the plaintiff's fan, which is rectangular. This may be demonstrated thus:

| Feature 3 in suit design | Corresponding feature in defendants' fan |
|---|--|
|  |  |

10. This minor difference, in my considered opinion, is at the best a merely trade variant between the suit design and the design of the defendants' fan and cannot detract from the overall similarity – in fact, identity – of the two designs. *Prima facie*, therefore, I am of the opinion that the design of the defendant's fan does constitute an obvious imitation of the suit design, within the understanding of the expression as defined in *Castrol*².

11. Mr. Vaidyanathan has, as the second leg of his submission, urged that the suit design is non-registrable for want of novelty *vis-à-vis* prior art. He submits that the features of the suit design which have been characterised as novel, in the design registration granted to the plaintiff, are not novel in fact, but are to be found in several fans which were already existing in the market. He has, in this context, drawn my attention to page 114 of the documents filed with the plaint, which refers to Design No. 272126 granted to Havells India Limited



in respect of the Havells Ambrose range of ceiling fans. The said page provides the following photograph of the Havells Ambrose ceiling fan registered under Design No. 272126:



12. Mr. Vaidyanathan has also provided a physical sample of the motorhead, the canopy as well as the blades of the aforesaid Havells Ambrose ceiling fan, registered under Design No. 272126.

13. On a comparison of the fans registered under Design No. 272126, the following distinguishing features, *vis-à-vis* the suit design, become immediately apparent:

(i) The circular design on the motorhead is in the form of a broken circle in Design No. 272126, without any extensions towards the blades. This may be demonstrated by the following comparison.

| Suit Design | Design of Havells Ambrose fan |
|---|--|
|  <p data-bbox="598 1803 707 1821">MOTOR ASSEMBLY</p> |  |

(ii) The shape, design and configuration of the canopy of the Havells Fan is clearly different from the shape, design and

configuration of the canopy in the suit design. On the comparison of two canopies, it becomes apparent that

- (a) the metallic rim/hub, which constitutes novel Feature 2 in the suit design is absent in the design of the Havells Ambrose fan, and
- (b) the shape of the canopy, which constitutes novel feature 5 in the suit design, is glossy and concave, whereas the shape of the canopy of the Havells Ambrose fan is plain and convex, with no embellishments or ornamentations.

14. Once, therefore, novel Features 1, 2 and 5 of the suit design are different in the design of the Havells Ambrose fan, it cannot be said that the suit design is bad on account of prior publication in Design No. 272126 of the Havells Ambrose Fan. In fact, at page 60 of the documents filed by Mr. Vaidyanathan with his reply to the present stay application, the following clearer photograph of the Havells Ambrose fan is available:



15. Mr. Vaidyanathan has also referred me to the design of a Milor Fan, at page 74 of the documents filed by the defendant with its reply

to the present application.

16. Mr. Sachin Gupta points out that this fan was never in the market prior to the registration of the suit design and Mr. Vaidyanathan, with commendable fairness, acknowledges this position. It is not necessary, therefore, for me to advert to the said design.

17. At a *prima facie* stage, therefore, I am of the opinion that the material on record is not sufficient for me to hold that the suit design is wanting in novelty, within the meaning of Section 19(1)(c) or 19(1)(d)³ read with Section 4(a)⁴ of the Designs Act.

18. That apart, Mr. Sachin Gupta has, relying on para 30 of the judgment of a Division Bench of this Court in *Pentel Kabushiki Kaisha v. Arora Stationers*⁵, sought to contend that, as the defendant had itself applied for registration of the suit design, the registration of the suit design is bad for want of novelty. Needless to say, the availability of this argument to the plaintiff would be conditional upon the design of the defendant's fan, for which it has applied for registration, being different from the suit design.

³ 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.

⁴ 4. **Prohibition of registration of certain designs.** – A design which –

- (a) is not new or original; or
- (b) has been disclosed to the public any where 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.

⁵ 261 (2019) DLT 763
CS(COMM) 98/2023

19. The design of the defendant's fan is identical to the suit design, save and except for minor difference in the shape of the extension of the central motorhead design towards the blades, which, in the suit design is rectangular in shape and in the design of the defendant's fan is rounded. As I have already held, that minor differences cannot suffice to distinguish the suit design from the impugned design of the defendant's fan.

20. In view of the aforesaid, as

(i) the impugned design of the defendant's fan is an obvious imitation of the suit design within the meaning of Section 22(1) of the Designs Act read with the judgment of the High Court of Calcutta in *Castrol*², and

(ii) there is no sufficient material on the basis of which the court can hold, *prima facie*, that the suit design is vulnerable to cancellation on the ground of want of novelty or could not have been registered for that reason,

the plaintiff has made out a *prima facie* case justifying grant of injunction.

21. Where infringement is found to have taken place, the Supreme Court, in *Midas Hygiene Industries*⁶ clearly held that an injunction must ordinarily follow.

22. In view of the aforesaid, pending further proceedings in the suit, the defendant, its partners, their assignees in business, licensees, franchisee, distributors and dealers shall stand restrained, from manufacturing, selling, offering for sale, advertising, directly or

⁶ (2004) 3 SCC 90

indirectly dealing in ceiling fans under the impugned design.

23. I.A. 3530/2023 is allowed accordingly.

I.A. 3531/2023 (under Order XXVI Rule 9 of the CPC)

24. This is an application for appointment of a Local Commissioner to effect seizure and inventorisation of the allegedly infringing product.

25. Mr. Vaidyanathan submits that, so long as the present order is in force, his client would not be manufacturing any fans bearing the impugned design.

26. As such, in view of the said undertaking, for the present, the court is not passing any order on this application.

27. The defendant is directed, however, to place on record the details of the number of fans as well as the moulds etc. which may be used for manufacturing of the fans bearing the impugned design by way of an affidavit before the court within two weeks from today.

C. HARI SHANKAR, J.

FEBRUARY 28, 2023

ar/dsn