

REGISTERED DESIGN IF INTENTIONALLY BROUGHT INTO THE PUBLIC DOMAIN WITHOUT ANY BREACH OF FAITH, NO LONGER REMAINS NEW AS PER PROVISIONS OF INDIAN DESIGN ACT.

Delhi High Court vide its judgment dated October 8, 2010 in re: Reckitt Benckiser (India) Ltd. v Wyeth Ltd. (FAO(OS) No. 458/2009), held that prior foreign registration would amount to publication of such design and its availability in public domain in India or abroad. The court laid down that

“(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 registration 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.”

The divisional bench of Justice Sanjay Kishen Kaul and Justice Valmiki J. Mehta disposed of an appeal filed by Appellant against Single-judge Bench order, wherein their petition to obtain an injunction against Wyeth had been dismissed. The Division Bench also held that the Learned Single Judge had been right in deciding that prior registration in case of designs that are not held in secret following registration should be considered as a valid ground for defence against any subsequent allegation of infringement of similar designs. The Division Bench cited Section 44 of the Act, which deals with reciprocity arrangement between nations regarding registered designs and priority dates there for. If the Single Judge’s reasoning didn’t hold true, said the Division Bench, then the entire procedure described in said section would be rendered chaotic, because registration could no longer be cancelled on the ground of prior registration of same design elsewhere.

The Division Bench further held that the Dabur case or the Gopal Glass Works case (both mentioned below and replied by Appellant) didn’t involve any discussion regarding the inter-

relation between Sections 4(b), 19(1)(a), 19(1)(b) and sub sections (1) and (2) of Section 44 of the Designs Act, 2000, nor had those cases considered any of the reasoning produced by the Single Judge in the present matter. The Divisional Bench upheld Single Judge's decision in not granting injunction to Appellant because of prior publication/existence in public domain through foreign registration. The Bench further opined that such registration would amount to publication of such design and its availability in public domain in India or abroad, although the same would be 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 Act.

The brief facts of the case are:

Appellant i.e. Reckitt had alleged infringement of its registered Design No. 193988 dated December 5, 2003, in Class 99-00 with respect to an S-shaped spatula by the respondent i.e. Weyth. The S-shaped spatula is designed for the application of a cream for hair removal i.e. a cosmetic depilatory.) The respondent countered 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.

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?*
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.

Against the order of Ld. Single Bench, the Appellant preferred an appeal before the Divisional Bench. The Division Bench also agreed to above reasoning and it also dismissed Appellant's contention about lack of detail in Respondent's written statement regarding the prior publication, citing provisions of the Code of Civil Procedure to establish validity of the additional pleadings submitted by respondent in that regard.

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 registered 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 ratio is that*

*registration abroad is not a ground for cancellation of a design in India and therefore cannot be used 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 Single 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 former 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 the 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.*

The Divisional Bench frames two issues in the matter,

- 1. 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.*

2. *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.*

The Court observed that first aspect first would be sufficient for disposal of the appeal and on second aspect *the matter ought to be examined by a larger Bench of this court inasmuch as the Division 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.*

The divisional bench referred to various provisions of the Design Act, i.e. Section 2(g), 4, 5(1), 10, 16, 17 & 19 and observed that *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 original, 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.

The Division Bench upheld order of the Single Judge (Justice Badar Durrez Ahmed) and even referred to paragraphs 21 to 30 of said judgment.

Finally, on the aspect of alleged lack of pleadings, the Divisional bench noted 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. The Bench was sure if an argument of lack of pleading was in fact urged before the learned Single Judge, then the learned Single Judge would have dealt with it. The court did not find in the grounds of appeal that the appellant has contended that it had raised an issue of lack of pleadings before the learned Single Judge but the learned Single Judge wrongly ignored this aspect. Therefore, the DB rejected 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. The DB held 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.”*

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 held 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.

The DB relied upon the provisions of Section 44 of the Act and observed that “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 its 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 retrospectively 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 into 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 in 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 registered 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 patent 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 Court upheld the conclusion of the learned Single Judge dis-entitling the appellant to injunction on the ground of prior publication/existence in public domain.

Further, the Court was of the finding 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 of the design registered abroad in view of Section 44(2) of the said Act.

The matter be placed before the Hon“ble the Chief Justice for necessary directions”.