

**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 (used for applying a cream for hair for hair removal) the defendant i.e. Weyth contended that Appellant's design lacked originality insofar as the same had also been registered, published as well as used in countries other than India before the Indian registration had taken place. One other ground taken against infringement suit by defendant was suppression of material facts i.e. prior registration in foreign countries of said design.

The Single-judge Bench, of Delhi High Court decided that prior registration in foreign registrations should be considered as 'prior disclosure' as per Section 4(b) of the Designs Act, 2000. The Court held that as said design was in public domain prior to December 5, 2003, therefore could be perceived as having been published abroad prior to its Indian registration by Appellant (Petitioner before Single Judge). The court was also of opinion that prima facie the defendant's spatula cannot be viewed as to be an obvious or fraudulent imitation of Petitioner's spatula.

The Single Judge considered the statutory provisions such as Rule 22 of the Design Rules, 2001 and Section 7 of the Act, which 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. Provisions of UK Registered Designs Act, viz. Section 5(2) and 22 thereof were considered, which provides for secrecy of certain designs even after registration, owing to which, the Single Judge believed that provisions such as S. 19(1)(a) of the Act were necessary, since in such cases, registration will not amount to public disclosure/publication. However, in the present matter, the design under consideration had not been kept secret following its registration abroad and hence it was S. 19(1)(b) and not (a) that the present matter should be subjected to.

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 Defendant's written statement regarding the prior publication, citing provisions of the Code of Civil Procedure to establish validity of the additional pleadings submitted by defendant in that regard.

It was contended by Appellant that as per the literal interpretation of Section 19(1)(a) of the Act, prior registration abroad cannot be a ground for cancellation of registration of a design in India and hence the same cannot be used as a defence in a suit for infringement of a registered design under Section 22 of the Act. In support the decision in re: Gopal Glass Works Ltd. Vs. Assistant Controller of Patents and Designs [2006 (33) PTC 434 (Cal)], was relied upon. The said decision was followed by the Division Bench of the Delhi High Court in re: Dabur India Ltd. Vs. Amit Jain & Anr. [2009 (39) PTC 104]. It was also contended that literal interpretation of S. 19(1)(a) and not any insubstantial legislative intention nor the different perspective provided by S. 19(1)(b) regarding grounds for cancellation of registration that should be relied upon in the present matter. Also, since defendant had not mentioned the particular details of prior publication of the design in its written statement, it had been urged that the defensive plea couldn't be entertained by the court at all.

The defendant countered that present case fell under S. 19(1)(b) and hence prior publication abroad could be successfully be taken up as a defensive plea in case of infringement. Moreover, it's only in those cases where the design, even after registration, is kept secret

and not released in public domain that prior publication couldn't be agitated as a valid ground and the present matter clearly did not belong to that category. The Dabur case was also sought to be distinguished on the ground that it had been concerned 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 Division Bench first proceeded to decide whether the current matter falls within Section 19(1)(a) or (b) of the Act. It was held that in the Dabur case, the provisions of Section 44(2) of the Act and its correlation with the provisions of Sections 4 and 19 of the Act had been overlooked. According to Section 4, 5(1) and 19 of the Act, copyright protection through registration can be given only to those designs that are new or original.

While the Act does not define "new", the Section 2 (g) does define "original" as "*originating from the author of such design and includes the cases which though old in themselves yet are new in their application.*" Therefore, while a 'new' design comes into existence in public knowledge for the first time, an 'original' one 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. Section 16 further makes it clear that if a design was meant to be kept secret, yet it is brought into public domain owing to breach of faith, it will not affect the newness of the design during registration. Based on this, the Court concluded that if a registered design is intentionally brought into the public domain without any breach of faith, then the design no longer remains new. Only the creator of the design who gets it registered prior to publication can get the protection, not a person who creates a design, but releases it in public domain without seeking its registration under the Act. Reading together Section 4, 5(1), 16, 17 and 19, the Court came to decide that prior publication or existence of a registered design in public domain is an essential ingredient for a design to be 'new' so as to get registered.

The Division Bench upheld order of the Single Judge and even referred to paragraphs 21 to 30 of said order. Among the designs prohibited to be registered by Section 4(b) of the Act, those that are not significantly distinguishable from known designs or combination thereof are also included and this particular aspect of prior existence in public domain had not been considered in the Gopal Glass Works case, as had been pointed out by the Single Judge. It had also been said that if it could be shown that a design had been disclosed to the public anywhere in India or in any other country by any of the modes specified in Section 4(b), then the registration of the design in India would be liable to be cancelled and hence the same could be cited as a ground for defence against alleged infringement of the design under Sub-Section (3) of Section 22. Nor was the Single Judge concurring with the view expressed in Gopal Glass Works regarding the matter of registration not amounting to publication under any eventuality, and in his support, he had cited several cases, including National Trading v. Monica Chawla (1994 PTC 233), Otto v. Steel [(1886) 3 R.P.C. 109 (112)], and Humpherson v. Syer (1887) 4 R.P.C. 407].