
M/s. Metal Impacts Pvt. Ltd. Vs M/s. Impact Metals Pvt. Ltd.

OS No"s. 1 and 2 of 2007

Court: Karnataka High Court

Date of Decision: Dec. 16, 2011

Acts Referred:

Designs Act, 2000 " Section 2 (d), 22, 22 (4)

Hon'ble Judges: N Kumar, J

Bench: Single Bench

Advocate: M.V.V. Ramana, for the Appellant; K N Subba Reddy and Vivek S. Reddy, for the Respondent

Final Decision: Dismissed

Judgement

N Kumar

1. These two suits are filed by the common plaintiff against the common defendant for an injunction restraining the defendant from infringing the

registered designs of the plaintiff. Except two different designs which are the subject matter of the suit in all other respects the facts of the case are

identical. Therefore, by consent of parties common trial is conducted and these two suits are disposed of by this common judgment. The plaintiff

filed O.S. No. 15349/2006 against the defendant on the file of the City Civil Judge, Bangalore City, for a decree of permanent Injunction

restraining the defendant, their men, from infringing the registered design of the plaintiff bearing design No. 187526 dated 10.12.2001 and for other

consequential reliefs. Similarly, the plaintiff also filed O.S. No. 15376/2006 for similar reliefs in respect of design No. 185097. After service of

summons defendant entered appearance and they filed written statement. They denied the allegations of the plaintiff. However, they also contended

that the registration of the designs in favour of the plaintiff is liable to be cancelled on the ground that the said designs have already been published

in journals. It is not a new or original design. The said design was invented by Mr. Ermat Frazee in the year 1960. Since then several manufacturers

all over the world have been using the device/design and have been manufacturing the products upon the same lines and, therefore, the design is to

be cancelled. The defendant also contended that the registered design of the plaintiff may be cancelled on the grounds as available u/s 19(1) of the

Act, i.e., it has been published in India or in any other country prior to the date of registration; and/or the design is not new or original design:

and/or that the design is not registrable under this Act; and/or it is not a design as defined under clause (d) of Section 2 of the Act. Therefore, the

defendant contended that the registration of the registered design is liable to be cancelled in view of the prohibitory provisions as laid down u/s 4 of

the Act to the effect that the said design is not new or original; and/or it 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; and/or the design is not significantly distinguishable from known

designs or combination of known designs.

2. After taking up the above said contention in the written statement in both the suits, they filed an application u/s 22(4) of the Designs Act, 2000

requesting the Court to transfer both the suits to the Hon'ble High Court of Karnataka for decision. The plaintiff did not file any objections to the

said application. The trial Court after hearing both the parties by an order dated 9.2.2007 allowed the application and directed that both the suits

be transferred to this Court for decision. After such transfer O.S. No. 15376/2006 is renumbered as O.S. 1/2007 and O.S. 15349/2006 is

numbered as O.S. 2/2007.

PLEADINGS

3. The plaintiff's case in both the suits is that, the plaintiff is a company incorporated under the Companies Act, 1956. It is engaged in manufacture

of all kinds of collapsible and rigid aluminum containers and easy open end lids with pour apertures. The company was established in the year

1978. It is committed to quality at every stage, right from concept creation, design, selection of raw materials, process engineering to final

appearances of their products. In respect of aluminum and metal containers manufactured by the plaintiff, they have secured registration under the

Designs Act, 2000 (hereinafter for short referred to as "the Act"). The product namely easy open end lids with round pour apertures in which

registration has been obtained under Designs Act, 1999 bears the design No. 185097 dated 21.3.2001 which is the subject matter of O.S.

1/2007. The registration certificate is produced. Similarly, the product container in respect of which registration has been obtained bears the

registration No. 187528 dated 10.12.2001, the certificate of registration is also produced. Plaintiff contends the use of any design which has been

duly registered under the Act by any person without obtaining express licence from plaintiff amounts to piracy and/or infringement of design and,

therefore, they are liable for action under the Act. The plaintiff has extensively worked to develop the design of the products and substantial

amount spent on toolings. The plaintiff brought out an attractive brochure as one of the marketing strategies and a copy of the same is produced.

The plaintiff have maintained a very high quality of their product. On account of high quality product, marketing, salesmanship and after sales

service, the products sold by plaintiff has become very popular in the market and have become very popular particularly in agrochemical industry

and multi national companies. The plaintiff submits that they have been selling their products since last several years. The plaintiff has spent

considerable amount of time on research, marketing, salesmanship and also advertising their products through print media. The sales turnover for

the past 5 years are as follows:

Year Sales Turn over

Bottles in Rs. Lids in Rs.

2001-02 1,85,94,160 52,03,400

2002-03 2,39,84,977 29,27,000

2003-04 2,62,68,423 49,44,280

2004-05 4,77,34,591 77,92,508

2005-06 3,43,63,624 61,23,350

Therefore, the plaintiff contends that they have spent considerable amount and time in popularising their products. The plaintiff in fact cautioned

general public about the registration of their design by issuing advertisement in various newspaper. The copies of the advertisements are produced.

Therefore, the plaintiff contends it alone has exclusive right on the design which has been duly registered. Adoption of similar design amounts to

infringement of design and also amounts to piracy and any person indulged in such piracy is liable for action u/s 22 of the Act. The photographs of

the plaintiffs designs are produced.

4. The plaintiff contend that they were shocked to notice that the defendants have also been selling their products to various multi national

companies and agro chemical companies by printing and infringing registered design of plaintiff. The adoption of design which are duly registered

amounts to infringement of registered design and therefore defendants are liable for action u/s 22 of the Act.

The defendants have no authority to copy designs of plaintiff. The designs adopted by defendant are produced. On comparison of both designs, it

is evident that the design adopted by defendant has been copied from plaintiffs registered design. The adoption of registered design by defendant

amounts to fraud and amounts to piracy. The cause of action arose for the suit on 24.2.2006 within the jurisdiction of this Court when the

defendant pirated and infringed the registered design of plaintiff and offered for sale to public through their website www.impact1976.com. The

copy of the same is also produced. Therefore, the plaintiff sought for a decree of permanent injunction restraining the defendant/their agents from

pirating and/or infringing the registered design in respect of easy open end lids with round pour apertures as well as its container, manufacturing the

same and marketing the same and for payment of damages.

5. The defendants have filed separate written statements in both the suits. Adverting to the allegations in the plaint, the defendant has contended

that, the defendant is also a company incorporated under the Companies Act, 1956 and certificate of registration is produced. The defendant

company was formed in the year 1976 as a registered partnership firm and since then it has been carrying on its business of manufacturing

aluminum bottle for agro chemical industry and other multinational companies. The defendant company has grown by leaps and bounds because of

which it was converted into a private limited company in the year 1979 and subsequently converted into a limited company in the year 1995. The

promoters of plaintiff and defendant companies are the President and the Vice President of All India aluminum Bottles Manufacturers Association.

Because of its name and fame it could set up factories at four different places viz., Hyderabad, Vadodara, Bhubaneswar and Visakhapatnam. It is

the name of the plaintiff which is deceptively similar to that of the defendant and not vice versa. The defendant is the prior adopter of the name and

style of M/s Impact Metals. In fact the plaintiff company was formed with the name and style of Klass Engineering. The defendant did not

prosecute the plaintiff upon the adoption of deceptively similar name of Metal Impact Private Limited because the Managing Director of the

defendant worked with the plaintiff for 11 months and out of respect for the Managing Director of the plaintiff company, it had not resorted to any

legal proceedings against them. It is a clear case of envy on the part of plaintiff to aver this point in the plaint. It is the case of the defendant that it

has been in the business of manufacture and production of aluminum pesticide containers, Aerosol containers, food and beverage cans, collapsible

tubes, besides other applications like gases. inks, paints perfumes, rubber, chemicals and pharmaceuticals. The defendant is in this business since

1976 that is even before the plaintiff company was formed. On account of the intrinsic, superior quality and excellent finishing, care and skill

exercised by them in marketing their products and the huge sums of money and labour expended by the defendant in promoting the sales, the

defendant has achieved large and extensive sales and has built up a valuable reputation for its products and in particular aluminum bottles, aluminum

easy open end lid, bottles and containers with apertures. The defendant because of the above said qualities attracted many big customers and

obtained various high value purchase orders. The defendant has always been committed to achieve market leadership through customer

satisfaction, by producing and supply quality products in time, at economical prices, through active involvement of all the employees. That is the

reason why the defendant company has been certified as ISO 9001 and the certificate is produced. The defendant is a manufacturer who

manufactures the products on confirmed orders and is neither a dealer nor a seller to indulge in piracy or infringement. Any company which is in the

business of manufacturing would be bringing out the brochures as means of sales promotion. The defendant company has also brought out several

brochures from time to time since 1976. i.e. the year of its inception. The work of the defendant over the years has been appreciated in the

aluminum bottles industry. That is why it could spread its factories over four places viz., Hyderabad, Vadodara, Bhubeneshwar and

Vishakhapatnam. The defendant has been instrumental in procuring purchase orders from many big companies. The strategies adopted by the

plaintiff are nothing new as they are universal in nature and every company be it small or big resort to the similar tactics to bring out the best result

in terms of manufacturing and producing the end products and their better pricing. The work of the defendant has been appreciated by the State of

Andhra Pradesh several times and the achievements were also published in the journal brought out by the A.P.State Finance Corporation. The

copies of the brochures are enclosed. The defendant is a manufacturer who manufactures the products against the confirmed orders and as per the

specifications of the customers. There is neither need nor necessity to copy the designs of the plaintiff because the defendant company is a research

oriented company giving full weightage to both quality and quantity of the products that are being manufactured upon the confirmed orders

received from its customers. The defendant has also invested huge monies to be abreast with the latest technology. It has also recruited personnel

whose main work is to do research and to infuse better quality. Because of its work ethics and proficiency it has been getting several coveted

orders. The defendant has spent huge amounts on advertisement and publicity for popularizing the products, sold with distinctive designs, as per

the specification of the customers. The fundamental forms for manufacture of various lids are adopted by the defendant, amongst others in the same

industry, since long time and mostly adopting I.S.I standards and of late I.S.O standards. The plaintiff is having only one unit in Bangalore where as

the defendant is having four units. The design No. 185097 was applied on 21.3.2001 and was registered on 26.9.2001. The plaintiff has chosen to

issue the public notice only on 20.2.2006 and not prior to that. It clearly shows that the plaintiff with a view to harass fellow manufacturer in

general and defendant in particular and to monopolize the market by resorting to restrictive as well as unfair trade practice has chosen to issue the

notice by way of publication in newspaper at the time when the defendant is able to procure purchase orders from the plaintiffs erstwhile

customers. The defendant was constrained to address a letter dated 28.2.2006 to Controller General of Patents, Designs and Trade Marks,

Mumbai. The copy of the letter is enclosed. The plaintiff has concealed the material fact that the design which it had got registered is universal in

nature and it does not have any novelty and or/originality, and that being the case the defendant has never even attempted to obtain exclusive

right/copyright for said fundamental form by registration thereof under the earlier or prevailing Indian Designs Act. The plaintiff has concealed the

material fact that the design which it has got registered is not new or original as the same is in use all over the world since 1960 when Mr. Ermat

(Earnie) Frazee, the founder of Dayton Reliable Tool and Manufacturing Company (now known as DRT Manufacturing Company) who

revolutionized the concept of opening the lids of any cans with the device, which has become popular and prevalent over the years and used

throughout the world, produced by many manufacturers and used for packaging a variety of products ranging from foods to poisons. The said

design neither has any novelty, nor is it significantly distinguishable from known designs existing since 1960 and the above design is nothing but an

ordinary trade variant. That even Mr. Ermat Frazee, the originator/innovator of the device of opening lids did not get it patented even though it was a

Novelty"" at that period of time. Moreover many designs similar to the registered design have been published in various magazines and journal both

in India and abroad. Mere novelty of form or shape is insufficient. Novelty involves the presence of some element of new position of an old

element in combination, different from anything found in any prior structures, which is not the case with the design of the plaintiff. The registered

design is significantly not distinguishable from known designs or combination of known designs. There is no statement of the matters in which

novelty is claimed. The sizes, shapes and configurations are the result of the specifications stipulated by a given customer. The above design had

been registered by the Registrar through oversight, as the plaintiff concealed the material facts from the Registrar that the said registered designs

have been in use since last 46 years unhindered all over the world. The plaintiff is engaged in the business of all kinds of collapsible and rigid

aluminum. To the best of the defendant's knowledge, the aforesaid products of the plaintiff are being manufactured and produced, constituting the

very same fundamental form thereof, without any distinctive/striking features for appealing to the eye. The plaintiff has fraudulently caused

registration in India of designs applied or to be applied to all kinds of aluminum packaging ranging from food products to poisons, which are

nothing but fundamental forms of designs, with a mala fide object of stifling the business activities of the defendant in the same field and also to have

a wrongful benefit in reduced or no competition in the common field of business activities. The plaintiff herein, caused a newspaper notice to be

published through Holla Associates, Attorneys. Bangalore. By the said notice the defendant was also asked to comply with certain wrongful, illegal

and non-tenable requirements. The defendant has also filed a petition u/s 19(1) of the Act for cancellation of registered design of plaintiff before the

learned Registrar of Designs, Kolkatta and the matter is sub judice there. The design of plaintiff is nothing but a mere trade variant. The devise used

in easy open ends pertains only to the drawing the same lid material in the form of a hollow rivet: putting a suitable tab on the same pip and riveting

the pip gently and firmly imposing a cutting on the lid (aperture) as per the choice of the customer, so that when the tab is lifted and pulled, the tab

gets separated leaving the opening (as per the aperture) on the lid for easy transfer of contents. Thus the basic feature of the easy open ends

remains till day, the lid material used to attach the tab is common to all the lids (several billions of them are made all over the world) in aluminum, in

tin sheet (ME) etc. Mr. Ermat Frazee is the only person who deserves the right for this invention and none else. M/s Metal Box Company has

contributed immensely to the Indian thought and enterprise putting packaging in forefront of Indians, till then, traditional systems of food

preservation and cooking were in place. Easy open ends too have come to India through Metal Box Company. The plaintiff has filed the suit just to

harass the defendant as it is instrumental in getting more orders, establishing more factories at different places, employing more people, spending

more money on infrastructure and machinery, adopting more research orientation. The suit is a pressure tactics in disguise. The plaintiff for long has

been aware about the business activities of the defendant. The promoters of both the plaintiff and the defendant are the President and Vice

President of the All India Aluminum Bottles Association. The defendant apart from website has been publishing the brochures to promote its

business. In various periodicals, the advertisements of both the plaintiff and defendants have been published on side by side in the same pages. The

very website suggests that the defendants are in the trade since 1976. The defendant has ever pirated, infringed or committed fraud on the plaintiff.

The defendant cannot be held liable for action u/s 22 of the Act as the registered design is neither new nor original. Therefore, they sought for

dismissal of the suit.

ISSUES

6. On the aforesaid pleadings, this Court framed the following issues:-

Whether the defendants prove that the registered design owned by the plaintiff:

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

(b) that the design is not a new or original design:

(c) that the design is not registerable under this Act and

(d) it is not a design as defined under clause (b) of Section 5 of the Act.

7. As the burden of proving the aforesaid issues was on the defendant, the defendant was called upon to lead evidence first. On behalf of the

defendants, on 5.10.2007 one G.Ramachandram s/o Late G.V. Subba Rao was examined as DW1. Exs. P1 to P42 were marked through him. It

is a mistake. It ought to have been marked as Exs. D1 to D42. On 11.10.2007 again he was recalled, cross-examined and reexamined. On

24.10.2007 an expert by name S. Sreenatha on behalf of the defendant was examined as DW2 and through him Exs. P43 to P46 were marked.

The side of the defendant was closed. Then on behalf of the plaintiff one Gopalakrishna was examined as PW1 on 30.10.2007. Exs. A to K and

MO.A is also marked. They also examined Works Manager, S. Basavaraj. Through him Exs. L and M were marked. Ex.P65 was marked in

cross-examination. On 28.11.2007 the plaintiff produced the original registration certificate of the Designs and they were ordered to be kept in

safe custody. On 29.11.2007 original registration certificate of the design 187526 was produced and it was taken on record and was ordered to

be kept in safe custody.

OBJECTS

8. Before answering the said issues, it is necessary to have a glimpse of the Designs Act and the relevant provisions governing the issues.

This case arises under the Designs Act, 2000, which came into force from 11.5.2000. The purpose of the Act is protection of the intellectual

property right of the original design for a period of 10 years or whatever further period extendable. The object behind this enactment is to benefit

the person for his research and labour put in by him to evolve the new and original design. This is the sole aim of enacting this Act. Certain

prohibitions have been engrafted in the Act so as to protect the original person who has created a new design by virtue of his own efforts by

researching for a long time. The protection given by the law relating to designs to those who produce new and original designs, is primarily to

advance industries, and keep them at a high level of competitive progress. The object of design registration is to see that the originator of a

profitable design is not deprived of his reward by others applying it to their goods. The purpose of the Designs Act is to protect novel designs

devised to be applied to particular articles to be manufactured and marketed commercially. It is not to protect principles of operation or invention

which, if profitable at all, ought to be made the subject matter of a patent. Nor is to prevent the copying of the direct product of original artistic

effort in producing a drawing. Indeed the whole purpose of a design is that it shall not stand on its own as an artistic work but shall be copied by

embodiment in a commercially produced artefact. Thus, the primary concern is, what the finished article is to look like and not with what it does

and the monopoly provided for the proprietor is affected by according not, as in the case of ordinary copyright, a right to prevent direct

reproduction of the image registered as the design but the right, over a much more limited period, to prevent the manufacturer and sale of article of

a design not substantially different from the registered design. The emphasis, therefore, is upon the visual image conveyed by the manufactured

article.

STATUTORY PROVISIONS

9. The word "design" has been defined under the Act at Section 2(d) as under : -

2(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 any 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 (43 of 1958) or property mark as defined in section 479 of the Indian Penal Code 145 of

1860) or any artistic work as defined in clause (c) of Section 2 of the Copyright Act, 1957 (14 of 1957).

The word "original" is also defined at Section 2(g) as under:-

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 of the Act prohibits registration of certain designs. It 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 5 of the Act provides for application for registration of designs as under : -

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.

(2) Every application under sub-section (1) shall be in the prescribed form and shall be filed in the patent office in the prescribed manner and shall

be accompanied by the prescribed fee.

(3) A design may be registered in not more than one class, and, in case of doubt as to the class in which a design ought to be registered, the

Controller may describe the question.

(4) The Controller may, if he thinks fit refuse to register any design presented to him for registration; but any person aggrieved by any such refusal

may appeal to the High Court.

(5) An application which, owing to any default or neglect on the part of the applicant, has not been completed so as to enable registration to be

effected within the prescribed time shall be deemed to be abandoned.

(6) A design when registered shall be registered as of the date of the application for registration.

Section 11 of the Act speaks about the consequences of registration of a design. It provides that, when a design is registered, the registered

proprietor of the design shall, subject to the provisions of this Act, have copyright in the design during ten years from the date of registration. Sub-

clause (2) of Section 11 provides for extension of the said period of 10 years.

Section 19 of the Act deals with cancellation of registration and the grounds on which the registration granted may be cancelled. It reads as under :

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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 registered 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.

Section 22 deals with piracy of registered design and legal proceedings that could be initiated under the Act for preventing the imitation of a

registered design without the permission of the proprietor of the design. Sub-section (3) of Section 22 provides 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 u/s 19 shall be available as a

ground of defence.

10. Russel-Clarke's Copyright and Industrial Designs (1951) Edition at page 162 reads as under:

It is said that protection will be given to any design which is new or original. As to what distinction, if any, is to be drawn between the words new

and original is doubtful. It may be that "new" means different from what has gone before and that "original" has the same meaning as in the

Copyright Act. i.e. originating from the author. It is also possible that the view advanced by Buckley. L. J. In *Dover Ltd. v. Nurnberger Celluloid*

Waren Fabrik, (1910) 27 RPC 498 is the correct one. There he said that "new" referred to cases where the shape or pattern was completely new

in itself, whilst "original" referred to cases where, though old in itself, it was new in its application to the article in question. He said (at page 503):

If the design be new it may be registered under that expression. But the act of Section 49 seems to contemplate that it may be registered, even if it

not be new, provided that it be original. The explanation of this lies possibly in the fact that the novelty may consist not in the idea itself, but in the

way in which the idea is to be rendered applicable to some special subject-matter. The word "original" contemplates that the person has

originated something that by the exercise of intellectual activity he has started an idea which had not occurred to any one before, that a particular

pattern or shape or ornament may be rendered applicable to the particular article to which he suggests that should be applied....

Whether a design is novel is a matter of fact to be decided by the eye. As already indicated, if the same shape or pattern, or one substantially

similar, has previously been thought of in connection with any article of manufacture and the idea published, or registered, then the design will be

deprived of its novelty. The previous idea or design, will act as an anticipation of the later design, and will be a bar to its protection. That the eye,

and the eye alone, is to be the judge of identity, and is to decide whether one design is or is not an anticipation of any has been laid down time and

time again in numberless cases. Whether a design is more useful than other designs which have gone before is not to be considered. It is simply the

general impression gathered by the eye that counts, and it is, therefore, impossible to lay down any hard and fast rule which can be followed....

According to BLACK'S LAW DICTIONARY:

in order that there may be novelty so as to sustain a patent, the thing must not have been known to any one before; mere novelty of form being

insufficient". Accordingly, mere novelty of form or shape is insufficient. Novelty involves the presence of some element or new position of an old

element in combination, different from anything found in any prior structure. Secondly, even in cylindrical shape, there may be different shapes. The

test is to consider and look at the design with an instructed eye and say whether or not such a difference between the which has been published

previously, and the registered design as to entitle the proprietor.

CASE LAW

11. In *Dover V. Nurnberger Celluloid Waren Fabrik Gebruder Wolff*, Buckley L.J. said as under:

Design means, therefore a conception or suggestion or idea of a shape or of a picture or of a device or of some arrangement which can be applied

to an article by some manual, mechanical or chemical means. It is a conception, suggestion, or idea, and not an article, which is the thing capable of

being registered. It is a suggestion of form or ornament to be applied to a physical body.

Design is an ideal or conception as to features of shape, configuration, pattern or ornament applied to an article. Although that idea, while still in the

author's head, may be potentially capable of registration, in fact it must be reduced to visible form to be identifiable, and until it is so reduced there

is nothing capable of registration. It may be so rendered either by its being embodied in the actual article, or by its being placed upon a piece of

paper in such a way that the shape or other features of the article to be made are clear to the eye. Whenever the means of identification (under

some of the old Acts, provision was made whereby a mere verbal description could in some cases be accepted as sufficient), as soon as the idea is

reduced to a form which is identifiable, there is something which is a "design", and which, if new or original, may be registered.

In the case of *Ampro Food Products Vs. Ashoka Biscuit Works and Others*, it is held as under:--

A design is necessarily part and parcel of the article manufactured while a trade mark is not necessarily so. In fact, the definition of "design" in

Section 2(5) of the Designs Act expressly states that it does not include any trade mark as defined in Section 2(1) (v) of the Trade and

Merchandise Marks Act, 1958. That is why the certificate of registration of the design contains a note which recites. "The novelty in the design

resides in the ornamental source pattern which appears only on the side of the biscuit as illustrated. No claim is made by virtue of this registration to

any right to the use as a trade mark of what is shown in the representation or to the exclusive use of the letters appearing in the design

The Supreme Court in the case of *Bharat Glass Tube Ltd Vs. Gopal Glass Works Ltd*, reported in ADS 2008 SC 2520 held that:

The concept of design is that a particular figure conceived by its designer in his mind and it is reproduced in some identifiable manner and it is

sought to be applied to an article. Therefore, whenever registration is required then those configuration has to be chosen for registration to be

reproduced in any article. The idea is that the design has to be registered which is sought to be reproduced on any article. Therefore, both the

things are required to go together, i.e., the design and the design which is to be applied to an article.

The Delhi High Court in the case of *Rotela Auto Components (P) Looed Vs. Jaspal Singh* reported in 2002 (24) PTC 449 (DEL) held that:

The design is a conception, suggestion or idea of a shape and not an article. If it has already been anticipated, it is not new or original. If it has been

pre-published, it cannot claim protection as publication before registration defeats the proprietor's rights to protection. Registration of design is not

a defence if the impugned design has been published by others prior to date of registration.

The Calcutta High Court in the case of *Western Engineering Co. Vs. Paul Engineering Co.*, it is held that the underlying principles behind the law of

infringement or design is that while the commercial exigencies require that a specific design which is novel and original should be protected, the

monopoly of a trade in respect of a common design with no special skill or originality should not be encouraged.

The Delhi High Court in the case of Glaxo Smithkline Consumer Health Care Vs. Amigo Brushes Private Limited reported in 2004 (28) PC 1

(DEL) was considering the question whether the handle of the toothbrush could be registered as a "new" or "original" design under the Act. The

Court held that making a handle thick or thin or with sharp tapering at the end of the grip part can by no stretch of reasoning be considered as

"new" or "novel" design. They are mere trade variants.

Again the Delhi High Court in the case of Hello Mineral Water Private Limited Vs. Thermaking California Pure reported in 2000 (20) PTC 177

(DEL) held that insofar as the cylindrical shape is concerned, there is no novelty for the novelty does not lie in just shape of this kind or the other, it

is something more.

Again the Delhi High Court in the case of National Trading Company Vs. Monika Chawla reported in AIR 1994 DEL 309, held that the design

will be deemed to be pre-published if the design is disclosed to any individual member of public who is not under an obligation to keep it secret.

Disclosure to such person is sufficient to constitute publication of design.

LEGAL CONCEPTS DESIGN

12. The concept of design is that a particular figure conceived by its designer in his mind and it is reproduced in some identifiable manner and it is

sought to be applied to an article. Design means, therefore a conception or suggestion or idea of a shape or of a picture or of a device or of some

arrangement which can be applied to an article by some manual, mechanical or chemical means. A design is necessarily part and parcel of the

article manufactured while a trade mark is not necessarily so. Therefore, both the things are required to go together, i.e., the design and the design

which is to be applied to an article. The idea is that the design has to be registered which is sought to be reproduced on any article. Registration of

design is not a defence if the impugned design has been published by others prior to date of registration.

NOVELTY

13. Novelty so as to sustain a patent, the thing must not have been known to any one before. Mere novelty of form is not sufficient. Novelty

involves the presence of some element or new position of an old element in combination, different from anything found in any prior structure. If the

same shape or pattern, or one substantially similar, has previously been thought of in connection with any article of manufacture and the idea

published, or registered, then the design will be deprived of its novelty. Protection will be given to any design which is new or original. "New"

means different from what has gone before and that "original" has the same meaning as in the Copyright Act, i.e. originating from the author.

"New" referred to cases where the shape or pattern was completely new in itself, whilst original referred to cases where, though old in itself, it was

new in its application to the article in question. The expression that "new" or "original" has to be construed in the context where this design has ever

been reproduced by any other Company earlier. It is only the new and original design which is new and which has not been available in the country

or has not been previously registered or has not been published in India or in any other country prior to the date of registration shall be protected

for a period of ten years. It is in the nature of protection of the intellectual property right.

ORIGINAL

14. The word "original" refers to design which no previous designer had created for any purpose and "new" as referring to a design which was not

in this sense original but was newly and for the first time applied to the particular kind of article with reference not to the classification in the third

schedule of the Designs Rules 1908 but to the kind of article having regard to its general character and use. The word "original" contemplated that

the person had originated something that by the exercise of intellectual activity he has started an idea which had not occurred to anyone before, that

a particular pattern or shape or ornament may be rendered applicable to the particular article to which he suggests that it shall be applied. ""New or

original"" involve the idea of novelty either in the pattern, shape or ornament itself or in the way in which an old pattern, shape, or ornament is to be

applied to some special subject matter. There must be the exercise of intellectual activity so as to originate, that is to say, suggest for the first time,

something which had not occurred to anyone before as to applying, by some manual, mechanical, or chemical means, some pattern, shape, or

ornament to some special subject matter to which it had not been applied before.

15. Generally, the test for integrity and originality is dependent on determining the type of mental activity involved in conceiving the design in

question. If the design is original, then the designer must have conceived something new. If the design is a mere trade variation of a previous design,

then the designer could be said to have merely keep an existing design in view and made some changes in its. The introduction of ordinary trade

variants into an old design cannot make it new or original. The working world, as well as the trade world, is entitled at its will to take, in all cases,

its choice or ordinary trade variants for use in any particular instance and no patent and no registration of a design can prevent an ordinary

workman from using or not using trade knowledge of this kind.

It is in the background of these statutory provisions, legal concepts and the judicial pronouncements, we have to answer the issues which are

framed in the suit.

ON FACTS

16. The plaintiff is a company incorporated under the Companies Act, 1956. It is engaged in manufacture of all kinds of collapsible and rigid

aluminum containers and easy open end lids with pour apertures. It was established in the year 1978. The plaintiff has obtained registration under

the Act for the product "easy open end lids with round pour apertures" on 21.3.2001 in Class 09-07 in its name and bearing registered design No.

185097. In the certificate of registration it is made clear as under : -

NO CLAIM IS MADE BY VIRTUE OF THIS REGISTRATION IN RESPECT OF ANY MECHANICAL OR OTHER ACTION OF THE MECHANISM WHATEVER OR IN RESPECT OF ANY MODE OR PRINCIPLE OF CONSTRUCTION OF THE ARTICLE.
THE NOVELTY RESIDES IN THE SHAPE AND CONFIGURATION OF THE EASY OPEN END LID WITH ROUND POUR APERTURE FOR CONTAINERS AS ILLUSTRATED

The front perspective view, top view and bottom view of the article is also stated.

17. The second design which is registered by them is in respect of the bottle dated 10.12.2001 in the name of the plaintiff and bears registration

No. 187526 in Class 09-03. In the certificate of registration it is made clear as under : -

NO CLAIM IS MADE BY VIRTUE OF THIS REGISTRATION IN RESPECT OF ANY MECHANICAL OR OTHER ACTION OF THE MECHANISM WHATEVER OR IN RESPECT OF ANY MODE OR PRINCIPLE OF CONSTRUCTION OF THE ARTICLE.
THE NOVELTY RESIDES IN THE SHAPE AND CONFIGURATION OF THE BOTTLE AS ILLUSTRATED

In the handwriting it is mentioned as under: -

Particularly in the portion marked "A" of the article

18. In support of their respective contentions, the parties have adduced evidence and examined experts. Sri G.Ramachandran, Managing Director

of the defendant company, has deposed substantiating the aforesaid stand. He has asserted in his evidence that Mr.Ermat Frazee is the original

inventor of easy opening lid and it is he who should be given the credit and distinction for the invention. Plaintiff was not the originator of the design

but had merely copied the same. In fact even at the time of registration of the easy and open design by the plaintiff the design was globally used and

manufactured for packaging foods including pesticides. It was used and updated for four decades before its attempted registration in India by the

plaintiff. During these four decades it had become universally exposed and globally acknowledged. The plaintiff has mischievously got the design

registered in order to use it at a future date against its competitors and to lay a false claim that it is his own. Mere cosmetic change does not create

any distinctive principle of design or construction. Though the plaintiff got registered in the year 2001 it has chosen to issue public notice only on

20.2.2006 and not at any point of time prior to that. It clearly shows that the plaintiff with a view to harass fellow manufacturers in general and

defendant in particular and to monopolize the market by resorting to restrictive as well as unfair trade practices has chosen to issue the notice by

way of publication in newspapers at the time when the defendant company was able to procure purchase orders from the plaintiffs erstwhile

customers. The said DW1 has produced 42 documents in all in support of his case. Exs. P11, 12 and 13 are the extracts of article on the subject

of open end lids taken from web. Exs. P14, 15 and 16 are letters issued by their customers. Ex. P17 is the statement of supplies and Ex.P18 is the

minutes of the meeting. Ex.P21 is the journal of Pesticides Association of India. Exs.P22 and 23 are extracts of journal of Minerals and Metals

Review. Exs. P24, 25 and 26 is a journal of Sea Food Export and Can Maker Magazine. Exs. P27 is a copy of the letter received from Willet

Flexi Cup. Ex.P28 is the additional extract issued by Willet and Company. Ex.P29 is a pamphlet printed by Daton Reliable Tool Manufacturing

Tool. Ex.P30 is an album containing designs issued by Automatic Corporation of USA in the year 1994. Ex.P31 is a packaging specification

issued by Automatic Corporation. Ex.P32 is a prospectus issued by the Indian Institute of Packaging, Bombay. Ex.P33 is the brochure of

defendant company. Exs. P34 and 35 are the advertisements published both by plaintiff and defendant in the magazine. Ex.P36 is another brochure

issued by the defendant company. Ex.P37 is an extract of Scan Holdings Company extracted from the web. Ex.P38 is a pamphlet of a company

KALL. Ex.P39 is an extract of web site of Dongguan Mansua Company Limited, China. Ex.P40 is a letter of Can Maker addressed to the

defendant company. Ex.P41 is pamphlet issued by a company by name CANTEC of Korea. Ex.P42 is an extract of a journal from the Can

Maker Summit, 2004.

19. This witness has been exhaustively cross-examined. In the cross-examination it is elicited that the design developed by Mr. Ermal Frazee is

available to everyone universally. It was patented in the year 1962 and after the expiry of 10 years period it has fallen to the public domain. There

is no difference between the design formulated by Mr. Ermal Frazee and the design which the plaintiffs have got it registered. However, he admits in

the case of design of Mr. Ermal Frazee the tab do not peel off whereas in the case of registered design the tab peels off. According to him it is a

subsequent development. He denies the suggestion that the design of Mr. Ermal Frazee is meant for use and throw whereas the plaintiff design is re-

usable.

20. Then we have the evidence of one S. Sreenatha, a Mechanical Engineering Graduate, who is an expert in the field. He has deposed that Can

making industry has originated more than 50 years ago. Can making technology and easy open end lids are universal and globally prevalent. The

technology is available throughout the world with no royalty charges. Easy open end lid is not new and dates itself to as old as the year 1962 with

its invention by Ermal Frazee, the founder of Dayton Reliable Tool and Manufacturing Company. The articles on the invention of Ermal Frazee is

published in newspapers in America are produced. These articles are available at a web site called Newslibrary.com which is an authentic

database of millions of newspaper articles published in American newspapers. The plaintiff company has concealed the material fact that the

designs which it has got registered are not new or original. Since 1960 when Mr. Ermal Frazee, the founder of Dayton Reliable Tool and

Manufacturing Company revolutionized the concept of opening the lids of any can with the device which has become popular and prevalent over

the years and used throughout the world, it is produced by many manufacturers and used for packaging in a variety of products ranging from foods

to poisons. The design which is the subject matter of the suit pertains to easy open end lid with round pour aperture. The allegation that the novelty

resides in the shape and configuration of the easy open end lid with round pour aperture is too abstract and vague. Neither the shape nor its

configuration nor the novelty is described. The plaintiff has got what is universally known and widely prevalent registered in general terms. In

respect of design No. 185097 in the "top view" of the design at sheet No. 2. below the opener, there are two semi circular projections (layers of

wedges or protrusions) in a round and semi circular shape running almost parallel to each other. This portion may be marked as "a" for inner circle

and "b" for outer circle. Defendant company's easy open end does not contain such a design. If this portion is contrasted with document No. 4 of

the plaint which is the photograph of defendant's and plaintiffs design there is no imitation at all. The apertures come in various forms and shapes.

The aperture itself in the form registered in 185097 cannot be a subject matter of registration. The said aperture is neither new nor original. It has

been already in use. It is not significantly distinguishable from known or combination of known designs. There is no novelty in the said easy open

end lid. These lids in the manner they are registered have been commonly used far and wide much before the registration. Apart from being used

the design has also been published. This design is not the invention of the plaintiff as he has falsely alleged. He has referred to various publications

and marked in the case which shows the publication of the aforesaid design much prior to the registration of the plaintiffs' design. The said

publications show that the design has been disclosed to the public in a tangible form much prior to the alleged filing and registration by the plaintiff.

It also shows that the design has been in use and manufactured since many years prior to the alleged date of registration. The entire operation of

the usage of the easy open end lid is based on the same principle of construction which is merely mechanical in nature. Easy open end lid and

round pour aperture are common in every day usage. The aluminum cans of various shapes and configurations are manufactured throughout the

world. Their principle of construction is the same. There can be various dimensions. These aluminum bottles have been in much use before the

registration. Through him also Exs. P43 to P66 were marked.

21. In the cross-examination he has deposed that in 1962 one Mr. Ernie Frazee invented the easy open lid. He applied in 1964 for grant of a patent

and it was patented in his name in the year 1966. There are two types of easy open ends. Type 1 : Tab stays on the lid and in the other it comes

out. In the can making industry, an easy open lid is also called as end making. It is based on the technology adopted the number of cars are

manufactured per hour. While manufacturing this easy open lid, it does not involve other sizes. The manufacturer of easy open lids require precision

tooling. Ex.M1 is a bottle which is of hexagonal shape. It is the hexagonal shape which may be a novelty in the bottle. An aperture comes in

various shapes. Therefore, it cannot be a novelty. The entire operation of the use of the easy open end lid is based on the same principle of

construction. The design which is registered by the plaintiff is vague because it does not contain any measurements.

22. On behalf of the plaintiff one Mr. Gopalakrishna, Sales Manager, of the plaintiff was examined. In examination in chief he has reiterated what

has been stated in the plaint. In the cross-examination he admits that plaintiff and defendant are in the business of manufacturing bottles from the

year 1976. However, the plaintiff was incorporated in the year 1978. Prior to the same, in the year 1969 a company by name Klas Engineering

Private Limited was incorporated to carry on the same business. He admits that both the plaintiff and defendant are competing with each other in

the same business. He also admits not only they are in the same business, they are also dealing with the same products. He pleads his ignorance

about the fact whether Alcan Exports Private Limited was the first to bring into India aluminum bottles with easy open end lids. He is not aware

whether the defendant company was using easy open end lids and aluminum bottles prior to the registration of the designs by the plaintiff company.

After seeing the registered design 185097 Ex.B he states that the top view of the said design has three parts, namely the lid, the upper portion tab

and the lower portion aperture. Ex. K is referable to the aforesaid three portions. Ex.E is the basis on which he contends that the defendant has

copied the designs. Ex.E contains the photographs of the plaintiff and defendant lids. He states that he is not aware whether the tap portion in Ex.K

is in use for many years prior to the registration of the said design. He cannot say whether the tap portion contained in Exs. P. 30(a), (b), (c), (d)

and Ex. 55(a) and the tap portion in Ex. K is one and the same. He admits that the lid MO.A is similar to the two lids shown in Ex.E where it is

marked as MI and IM. After seeing Exs. K and Mo.A he admits there is difference in the lower aperture region. The difference is in Ex. K. There

are two ribs whereas in Ex.Mo.A there are no ribs. He admits that the ribs are projecting outside. In Ex.K there is a semi inner circle with a

projecting like a bead in a semi circular manner. The same is not there in Ex.MO.A. The bottom view of Ex.K is similar to that of the bottom view

of Ex.B at page No. 3. There is a difference between Ex.K and Ex.MO.A in its bottom view. In Ex.MO.A there is depression which is not in

Ex.K. That apart, in Ex.K there are two circles which is not there in Ex.MO.A. He admits that there is a difference between the registered design

at 185097 Ex.D and Ex.MO.A. He also admits that the said difference extends to both to the shape and configuration. Ex.A is a design of the

bottle. He denies the suggestion that he is not producing the original as it does not contain the portion marked A"" in Ex.A. According to him there

is no difference between the view of the bottle in the first page of Ex.A and the bottle Ex.J. The dimension of the bottle is 89 diameters whereas the

height is 236 millimeters of the registered design at Ex.A. In Ex.J the diameter is 54 mm whereas the height is 80 mm. He admits that the bottle

shown in Ex.A and Ex.E are of different sizes. Similarly, the size of the bottle shown at Ex.J and Ex.A are different. He pleads his ignorance about

the fact that for the first time in India metal boxes were introduced by a company called Metal Box Private Limited. He has no document showing

the request from his customers acknowledging his invention and placing orders on the basis of such invention in respect of both the registered

designs. He pleads his ignorance whether Ermal Frazee is the inventor of this easy open end lid. He denies the suggestion that the design which he

got registered is universal in nature.

23. One Sri S. Basavaraj, the Works Manager of the plaintiff was examined. He is working for the last 24 years. He has also given evidence in

support of the plaintiff. He is a Diploma Holder in Mechanical Engineering. He admits in cross-examination that bottles are being manufactured

since innumerable years. Similarly, bottles of various metals and ingredients are being manufactured since innumerable years prior to registration.

Even aluminum bottles are being manufactured since innumerable years prior to registration. He admits that that bottles of aluminum metals are not

new to the market. He further admits that manufacturing of aluminum bottles by impact extrusion method is in vogue much prior to registration. He

admits that aluminum bottles which are in the market today are manufactured by this impact extrusion method. The technology adopted is

impacting an aluminum billet with a punch, which results in can forming. He do not know whether Germans created this technology during II World

War. Any bottle essentially has two portions, a mouth and a neck. The mouth and the neck of a bottle can be combined in various sizes. He has

been working in the plaintiff company since 24 years. He admits that, to get a design registered one has to make a claim of novelty. In the easy

open end there is an aperture. Once the said aperture is open, it cannot be closed. The opening of the said aperture could be controlled by the

amount of pressure used on the tap. He do not know whether the end user at his discretion can open the aperture depending on the pressure he

applies on the tab. It can be opened partially. It can also be opened fully. He do not know the extent of pressure applied besides the extent of

opening of the tab. Ex.L is not registered. The tap along with the aperture comes out when the lid is open. After the lid is completely open the tab

do not stay back. He do not know whether this pulling up of the tab is called peeling of the tap. He do not know whether this pulling up of the tap

is the invention of Ermal Frazee. He do not know whether this pull off tab caused environmental littering when it was changed over to stay on tab.

He do not know whether the pull off tab is in vogue much prior to stay off tab. He admits that the two semi circular beads found in Ex.K is not

found in MO-A. He further admits that that the design of these two lids vary. In the formation of a bottle, the metal flow is an important factor. In

Ex.A there is no cap at the top of the design. It is an open mouth bottle. In the said design there is nothing stated about the stopper or the lid. The

mark "A" is not visible at pages 1, 2 and 4 of Ex.A. He cannot say whether the said portion is there or not at all. He admits that apart from shape

and configuration in the design which is registered, there is no reference to any novelty. He admits that there is a difference in the shape of the neck

in Ex.M-2 and M-3. There is also difference in the shape of these two bottles. He admits that in the registered design there is no angulation. He has

not compared the plaintiffs and defendants design. He do not know whether the angulations have been used much prior to the plaintiffs design. This

is the oral evidence which is available on record.

24. From the aforesaid oral evidence it is clear that one Mr. Ermal Frazee, the founder of Dayton Reliable Tool and Manufacturing Company

invented this easy open end in 1960's and the said fact is widely published in various international and national journals of repute. The said

technology is used for more than 50 years before its registration by the plaintiff. It is in this context it is necessary to look into the documentary

evidence produced which is not disputed which came into existence at an undisputed point of time. Exs. P11 and P12 is one such publication titled

"Heartland Science Ohio's Legacy of Discovery and Innovation".

Froze born in Indiana in 1913 and better known as "Ernie," grew up on a farm and moved to Ohio where he found tool and die work in the 1940s.

With a small loan from his wife, Martha, he established his own company, the Reliable Tool and Manufacturing Co., in 1949 in Dayton. He was

the company's sole employee in its early days. Soon, however, he had customers in a variety of industries, making materials related to the war

effort during Word War II such as improved gun barrels for war planes that sped up bullets fired during flight. He patented this and other

innovations, and later earned an engineering degree at the General Motors Institute in Flint, Mich. The school is now known as Kettering

University.

By 1959, Froze had built a modestly successful enterprise with clients including General Electric, Ford, Chrysler and even NASA, but his most

lucrative invention was still to come. That year, while at a picnic with family and friends, he realized he had forgotten to bring an opener for the

canned beverages at the event so he was forced to use a car bumper to pry them open. This got him thinking of possible solutions to the problem

that would eliminate the need for a can opener in the future.

... Froze concentrated on an ideal that would use a lever attached to a rivet at the center of the top of a round can. He believed that strengthening

the rivet would be the secret to success, as this would help the lever stand up to the internal pressure of the can and if the aluminum were pre-

scored with an opening, the rivet and lever would be strong enough for pulling the can open without the lever snapping off.

Fraze's first version used a lever that pierced a hole in the can but resulted in sharp, sometimes dangerous edges. Later he created the familiar pull-

tab version, which had a ring attached at the rivet for pulling, and which would come off completely to be tossed aside. He received U.S. patent

No. 3, 349, 949 for his pull-top can design in 1963 and sold his invention to Alcoa.

The Pittsburgh Brewing Company was the first customer to use the design. Maker of Iron City Beer, the company found its sales soaring quickly

after introducing the pop-top cans. Other beer and beverage companies became interested and by 1965, nearly 75 percent of U.S. breweries

were using them. In the mid-1970's, outcry from environmentalists led to the development of the can-tops we know today the use non-

removable tabs, created first by the Continental Can Co.,

Meanwhile, Froze began manufacturing systems for brewers and soft-drink companies to be able to make their cans using his pull-tab design. By

1980. his company, renamed DRT Mfg. Co., (for "Dayton Reliable Tool"), was supplying can-end machinery all over the world with over \$500

million in annual revenues.

Froze died of a brain tumor at the age of 76 in 1989, and his company was sold and repurchased by its management. It remains in business today

operating out of Dayton, with subsidiary operations in South Carolina and Germany.

25. The aforesaid facts which are not disputed makes it abundantly clear that the registered design owned by the plaintiff has been published in

those international journals in various countries abroad prior to the date of registration. Therefore, defendant has proved that the registered design

owned by the plaintiff has been published in India as well as in other countries prior to the date of registration of the design owned by the plaintiff.

26. In the entire body of the plaint, the plaintiff has not pleaded the said design is new or an original design. In other words he is the inventor. Even

in the evidence neither he nor his witnesses have led any evidence to show what is the substantial improvement if any made by the plaintiff to what

was invented by Mr. Ermal Fraze. They are also unable to point, out what is the novelty involved in this design for which they are claiming any

credit. Section 4 as aforesaid prohibits registration of certain designs if a design is not new or original. It is only any new or original design not

previously published in any country which could be registered under the Act in terms of Section 5 of the Act. Therefore, a design cannot be

registered if the design is not new or original. There is no statutory definition of the term new. The word "original" when the term is sought to be

applied in relation to a "design" means originating from the author of such design and also includes designs which though old in themselves are new

in their applications.

27. It is clear that from the certificate of registration that in respect of registered design No. 187526 the novelty resides in the shape and

configuration of the bottle as illustrated. The evidence on record discloses that there is a considerable difference between the plaintiffs and

defendant's product. The defendant is not imitating the plaintiff in the matter of shape and configuration. In fact, it is not the case pleaded by the

plaintiff at all. Relying on the evidence of P.W-1, it was pointed out that it is admitted in case of design of Mr. Ermal Frazee the tab do not peel of

whereas in the case of registered design the tab peels of. A faint attempt was made to contend that this technology of tab is the invention of the

plaintiff. Though there is no plea, there is no evidence in this regard. It is on the basis of the admission in the cross-examination, such a case was

sought to be made out. However, the evidence on record clearly discloses that Mr. Ermal Frazee is the original inventor of easy opening lid. Plaintiff

is not the originator of the design. But it merely copied the same. On the date of registration of the design, this design was globally used and

manufactured for packaging foods including pesticides. It was used and updated for four decades before its attempted registration in India by the

plaintiff. During these four decades it had become universally exposed and globally acknowledged. Mere cosmetic change does not create any

distinctive principle of design or construction. At the best it can be construed as trade variant. The plaintiff has got registered the design for more

than 40 years prior to its registration by suppressing the true facts. In fact, after the invention of the said design by Mr. Ermat Frazee many designs

similar to the registered designs have been published in various magazines and journals both in India and Abroad. The plaintiff concealing this

material fact that the design which it had got registered is universal in nature and it does not have any novelty and or/originality. Therefore the

defendants have clearly established that the registered design owned by the plaintiff has been published in India and in other country prior to the

date of registration. It is not a design which is new or original. Therefore the said design could not have been registered under the Act. More over,

it is not a design defined in clause (b) of Section 5 of the Act. In that view of the matter, the plaintiff is not entitled to any of the relief sought for in

respect of these two designs.

28. The other material on record clearly establishes that both the plaintiff and defendants are in the very same business. Their products are being

published in various magazines. Some times, side by side. They have common customers. In fact. Mr. Late G.V.Subba Rao. the earlier Managing

Director of the plaintiff Company was the president of Aluminium Bottle Manufacturers Association. Mr. G. Ramachandran, the Managing

Director of the defendant Company was its Vice President. Ex.P-14 the letter issued by Rallis; India Limited shows that they are the largest

Agrochemical producers in India. They use aluminium containers in large quantities for packing the Agrochemicals they manufacture. In 1997-98,

they adopted a new design of aluminium container having a wide mouth fitted with a Easy Open End closure for certain premium products to

ensure pilfer-proofness and to also prevent duplication of their products. They began sourcing such type of containers from M/s Alcan Exports (P)

Ltd during 1997-99. As the demand for these type of containers increased, they also took up development of two other manufacturers namely the

plaintiff and the defendant. They have purchased such containers from all the sources developed by them.

29. Ex.P-15 discloses that Alcan Exports Private Limited was established in the year 1991. They are making different variety containers both for

Indian and overseas market. In the process, they claim to have developed number of designs which hereto not in use in India. They claim that they

are pioneers in the development of perfeckthion type of aluminium bottles (Easy Open End type) in India and introduced at M/s Rallis India and

supplied them 6000 Nos. in 1000 ml size in the year 1996 for export in to Yemen-imported by Wadi-Bani Qouus Associated -SANNA, Yemen.

Ex.P-22 is the Journal published in India in October 1998 which clearly shows the publication of design in question.

30. From the aforesaid discussion it is clear that, though the design has not been previously registered in India prior to the registration of the design

in favour of the plaintiff but it had been published in India or in other countries prior to the date of registration. The design is not new or an original

design. In fact the design could not have been registered under this Act as it is not a design as defined under clause (d) of Section 2 of the Act. For

the aforesaid reasons. I do not see any merit in this petition. Accordingly, I pass the following :-

ORDER

(a) Both the suits are dismissed.

(b) However, as the application for cancellation of the registered design is pending before the Controller, the Controller shall decide the case on its

merits.