

The Kohinoor Mills Co. Ltd. Vs Vijay Bharat Thread Mills (India)

Court: Bombay High Court

Date of Decision: July 8, 1957

Acts Referred: Designs Act, 1911 â€” Section 2, 43, 51A, 64
 Penal Code, 1860 (IPC) â€” Section 478, 479

Citation: (1958) 60 BOMLR 397

Hon'ble Judges: K.T. Desai, J

Bench: Single Bench

Judgement

K.T. Desai, J.

The petitioner carries on business of manufacturing and selling, amongst other things, yarn and thread. That petitioner is the

proprietor of a registered trade mark known as the ""Sadhu"" mark. The petitioner has been using wrappers and labels bearing a representation of

that trade mark. The said trade mark has been registered in respect of yarn and thread, and has been used inter, alia in respect of two cord

machine thread No. 40. The certificate of registration has been tendered and is marked as exh. B. The respondents, in the year 1955, started

manufacturing and selling their two cord thread bearing No. 40 under a mark known as the ""Sanyasi"" mark and are using labels bearing a

representation of that mark. On May 5, 1955, the respondents got that mark registered as a design under the Indian Patents and Designs Act,

1911, in class 5. The certificate of registration of that design is exhibited in the case as exh. G. On May 10, 1955, the respondents applied for the

registration of their ""Sanyasi"" mark as a trade mark affixing a representation of that mark. That application is exh. D. In that application it has been

stated that the respondents have been using that mark since January 1955.

2. The petitioner contends that the design used by the respondents is a colourable imitation of its trade mark. The petitioner has filed this petition

under the provisions of Section 51A of the Patents and Designs Act, 1911, for an order that the registration of the respondents ""Sanyasi"" design

bearing No. D 82466 as a design under the Patents and Designs Act be cancelled on the ground that it is not a design or a new or original design,

and also on the ground, which was subsequently taken, that it is a design which was previously published in India before its registration.

3. Various points have been raised in the petition which have been controverted by the respondents in reply. The two points on which the matter

was canvassed before me were (1) that the Court had no jurisdiction to entertain the petition and (2) that the design in question was not a design

within the meaning of the Patents and Designs Act, 1911, or in any event, was not a new or original design.

4. In the evidence that was led before me it came out that the respondents' design had been published in India prior to the application for

registration of that design under the Patents and Designs Act, 1911, with the result that there is no dispute now between the parties that the design

was published in India prior to the application for its registration. I have allowed the petition to be amended so as to enable the petitioner to claim

the cancellation of the respondents' design on the ground of the previous publication in India of that design before its registration. The case clearly

falls within the ambit of Section 51A(1)(a)(ii) of the Patents and Designs Act, and the petitioner would be entitled to the cancellation of the

registration of the respondents' design on the ground that it had been published in India prior to the date of its registration if it is established that the

Court had jurisdiction to entertain this petition.

5. As the question whether the design is a design within the meaning of the Patents and Designs Act has been argued before me at some length, I

will briefly deal with the same.

6. Turning to the provisions of the Patents and Designs Act, the first section that may be noticed is Section 43 of the Act. Section 43 lays down

that the Controller may, on the application of any person claiming to be the proprietor of any new or original design not previously published in

India, register the design under Part II of the Act. Section 2(5) of the Act defines the word "design". The definition is as under:

"Design" means only the features of shape, configuration, pattern or ornament applied to any article 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 Section 478, or property mark as defined in Section 479 of the Indian Penal Code.

There are two things apparent from the definition of the expression "design" as given in the Act, viz., (1) that it must be applied to any article by any

industrial process or means and (2) that it would not include any trade mark as defined in Section 478 of the Indian Penal Code. The term "article"

is defined by Section 2(2) to mean as respects designs any article of manufacture and any substance, artificial or natural, or partly artificial and

partly natural. Rule 34 of the Rules framed under the Patents and Designs Act refers to the classification of goods for the purposes of the

registration of designs. That Rule runs as under:

34(1) For the purposes of the registration of designs and of these rules, goods shall be classified in the manner specified in the Fourth Schedule

hereto.

(2) If any doubt arises as to the class to which any particular description of goods belongs, it shall be determined by the Controller.

When one turns to the Fourth Schedule, one finds various articles referred to under various classes. In this ease, the design is registered under class

5. Class 5 provides as. under:

Class 5 : Articles composed wholly of paper, card-board, mill-board or straw-board (except articles included in Class 2, and paper hangings), or

in which such materials predominate.

It will thus be seen that a design which is liable to be registered must be a design which is intended to be applied to any article composed wholly of

paper or in which paper predominates. The design, in question is shown on paper and is intended to be affixed to other goods. It cannot be said

that this is a design which is intended to be applied to an article composed wholly of paper or in which paper predominates. The paper on which

the design is printed cannot be said to be the article to which the design is intended to be applied. What constitutes an article for the purpose of the

application of a design has been considered by A.D. Russell-Clarke in his book on Copyright and Industrial Designs. At pages 144-145 it has

been stated as under:

“Even under the old Act, however, not every drawing or painting placed upon a piece of paper or canvas was a design. The reason for this was

that paper and canvas as such were not “articles of manufacture” or “substances” within the meaning of the definition. The same must be even more

true under the 1949 Act, where it is only the application of the design to an “article of manufacture” which has to be considered. An article of

manufacture, or a substance under the old Act to be within the definition had to have some purpose other than that of merely carrying the

ornament. Where the article has no purpose beyond merely carrying the ornament, as, for instance, in the case of a drawing, painting, or

photograph upon an ordinary piece of paper, the article is so subordinate to the ornament that it may be said practically to disappear. Thus in the

case of a drawing of, say, a landscape or hunting scene on a piece of paper, although there is a pattern, that pattern is not applied, nor is it shown

as applied to any article of the manufacture within the meaning of the Act, and there is no "design" which can be registered.

The learned author was dealing with the provisions of the laws in England on the subject. I would give a similar meaning to similar words used in

the Patents and Designs Act, which is copied from the English statute. In my view, that which is registered as a design is not in reality a design

within the meaning of the definition as given in Section 2(5) of the Indian Patents and Designs Act, 1911.

7. The respondents are using what they call their design as a trade mark. In fact, they applied under the Trade Marks Act for the registration of

what they call their design as a trade mark. Their design itself indicates that trade mark rights are claimed in respect of the design. When one turns

to exh. G, one finds that the words "Trade Mark" appear in bold letters on the so called design, and the word "Sanyasi" in similar letters appears

at the foot thereof. On one side the name of the manufacturer is given as Vijay Bharat Thread Mills (India) and on another side we have the words

"superior quality machine thread". It seems to be the clear intention to use, what is called a design, as a trade mark within the meaning of Section

478 of the Indian Penal Code, 1860, in connection with the machine thread manufactured by Vijay Bharat Thread Mills. In my view, what is

termed as a "design" by the respondents is not really a design within the meaning of the Patents and Designs Act, 1911. In view of what I have

held, it is not necessary to consider whether what the respondents call a design is either a new or original one, and I should not be deemed to have

decided whether the same is either new or original. In view of what I have stated above, the petitioner is entitled to the reliefs claimed, provided the

Court has jurisdiction to entertain the petition.

8. It is this question of jurisdiction which has been the principal matter of controversy between the parties. The petition is made u/s 51A of the

Indian Patents and Designs Act, 1911. Section 51A provides that 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 High Court", on any of the following grounds, namely

(i) that the design has been previously registered in India, or

(ii) that it has been published in India prior to the date of registration; or

(iii) that the design is not a new or original design.

Though the definite article "the" has been used before the words "High Court", one does not find any reference to the particular High Court to

which an application has to be made in that section or in what precedes it. The expression "High Court" has been defined by Section 2(7) of the

Act. The definition is as under:

2(7) High Court means

- (a) in relation to a Part A State or a Part B State, the High Court for that State;
- (b) in relation to Ajmer and Vindhya Pradesh, the High Court at Allahabad;
- (c) in relation to Bhopal, the High Court at Nagpur;
- (d) in relation to Bilaspur, Delhi and Himachal Pradesh, the High Court of Punjab;
- (e) in relation to Coorg, the High Court of Mysore;
- (f) in relation to Kutch, the High Court at Bombay;
- (g) in relation to Manipur and Tripura, the High Court of Assam;
- (h) in relation to the Andaman and Nicobar Islands, the High Court at Calcutta.

It may here be noted that so far as the registration of Patents and Designs is concerned, there is only one Registry at Calcutta. That office is situate

at 214, Lower Circular Road, Calcutta. There are no branches of that office anywhere in India.

9. Mr. Shah, who appears for the respondents, contends that the expression "the High Court" which appears in Section 51A of the Act means the

High Court which would otherwise have jurisdiction over the person against whom a petition is filed under the Act, or over the subject matter of

such petition. Mr. Shavaksha, on the other hand, contends that the application would lie to any High Court and that the definite article "the" before

the words "High Court" has not been used in the section with any design so as to confine the application to any particular High Court having regard

either to the person against whom the petition is to be filed or the subject-matter of the petition. Mr. Shavaksha contends that the jurisdiction

conferred by Section 51A of the Act is a special jurisdiction, and that for the exercise of that jurisdiction one cannot turn to the Letters Patent or

the CPC for ascertaining the jurisdiction of the High Court in the matter. He points out that where the Legislature intended that an application had

to be made to a particular High Court, the Legislature has expressly so provided. He drew my attention to Section 23F of the Act where it has

been expressly provided that an appeal shall lie to the High Court at Calcutta from any order of the Controller made u/s 23 or Section 23A or

under Clause (a) or Clause (b) of Sub-section (1) of Section 23B or u/s 23CC of the Act. He says that the expression "the High Court" in Section

51A should be considered in the light of the use of the same words and the words "a High Court" appearing in various sections of the Act, and that

it would clearly appear that the Legislature did not in any way intend to specify any particular High Court before which an application had to be

filed under the provisions of Section 51A, but that it was left to the petitioner to choose any High Court specified in Section 2(7) of the Act, There

is considerable force in what Mr. Shavaksha says.

10. He drew my attention first to the provisions relating to patents and secondly to the history of the legislation in relation to designs. Section 26(1)

of the Indian Patents and Designs Act, 1911, refers to the question of the revocation of a patent. That section provides as under:

Revocation of a patent in whole or in part may be obtained on petition to or on a counter claim in a suit for infringement before a High Court on all

or any of the following grounds, namely—

There the words used are "a High Court" and not "the High Court". Section 28(1) of the Act provides that "a High Court" may, if it thinks fit, direct

an issue for the trial, before itself or any other High Court, or any District Court, of any question arising upon a petition to itself u/s 26, and the

issue shall be tried accordingly. Section 34 of the Act provides that "a High Court" to which a petition has been presented u/s 26 may stay

proceedings on or dismiss the petition if in its opinion the petition would be disposed of more justly or conveniently by another High Court. When

one turns to the provisions of the Patents and Designs Act, 1911, as originally enacted, one finds that Section 64 of the Act contains the words "a

High Court" and not "the High Court". Section 64(1) ran as follows:

64(1) A High Court may, on the application in the prescribed manner of any person aggrieved by the non-insertion in or omission from the register

of patents or designs of any entry, or by any entry made in either such register without sufficient cause, or by any entry wrongly remaining on either

such register, or by an error or defect in any entry in either such register, make such order for making, expunging or varying such entry as it may

think fit.

Section 64(5) provided as under:

64(5) A High Court to which an application has been made under this section may stay proceedings on or dismiss the application if in its opinion

the application would be disposed of more justly or conveniently by another High Court.

Section 64 was amended by Act VII of 1930. By Section 24 of the amending Act Section 51A was added where the expression "the High Court

appears. By Section 27 of the amending Act the original Section 64 was amended and in Sub-section(1), for the words "A High Court" the words

"The Controller" were substituted, and the present Sub-section(3) was substituted for the old Sub-section (3) of the Act. It does not appear that

the Legislature intended to make any change by the use of the expression "the High Court" instead of "a High Court" in Section 51A. The

Legislature could not have intended to provide differently by the use of the words "a High Court" in connection with the revocation of patents and

the expression ""the High Court"" in connection with the cancellation of registration of designs. In my view, no distinction could be made merely on

account of the use of the expression ""a High Court"" and the expression ""the High Court"" when used in connection with patents and designs, and the

Legislature could not be said to have laid down different provisions in connection with the revocation of patents and in connection with the

cancellation of the registration of designs in reference to Courts

11. What I have to consider is whether the Legislature intended to restrict the jurisdiction of the High Courts in respect of an application for the

revocation of a patent or the cancellation of the registration of a design having regard to the subject-matter of the application or having regard to

the place of residence of the respondents to the application or the place where he carried on business. The provisions relating to patents indicate

that the Legislature contemplated the sending down for the trial of any issue in such an application to another High Court. It also contemplated the

stay of proceedings when the application could be more justly or conveniently determined by another High Court in India. These provisions

indicate that the Legislature did not intend to confine the jurisdiction of the High Court u/s 26 in respect of an application for revocation of a patent,

to cases where the subject-matter had arisen within its jurisdiction and to cases where the respondent resided or carried on business within its

jurisdiction. In my view, what the Legislature intended was an application to any High Court provided it was a High Court set out in Section 2(7)

of the Act, and it was left to the Court either to try the matter or to stay the matter if the Court thought that the application could be more justly or

conveniently disposed of by another High Court. In my view, the same construction should be placed on the expression ""the High Court"" when

used in connection with designs, and an application for the revocation of a design can be made to any High Court provided it was one of the High

Courts specified in Section 2(7) of the Act. When one has to consider the question of jurisdiction, which has been conferred by a special

enactment upon a High Court, one has to look to the provisions of that Act for the purpose of determining when the Court is to exercise that

jurisdiction. One cannot turn to the provisions of the Letters Patent or the CPC for the purpose of determining when that jurisdiction has to be

exercised. If the Legislature intended to circumscribe the ambit of the special jurisdiction of the Court, it was for the Legislature to have expressly

stated so.

12. It has been urged that Clause 12 of the Letters Patent applies for the purpose of determining the jurisdiction of the Court u/s 51A of the Indian

Patents and Designs Act. There would be considerable difficulty in applying the provisions of Clause 12 of the Letters Patent to a proceeding u/s

51A of the Indian Patents and Designs Act, 1911. The jurisdiction which the Court exercises u/s 51A is the jurisdiction to set aside the act of the

Controller. An application made u/s 51A cannot aptly be termed a suit within the meaning of el. 12 of the Letters Patent. An application u/s 51A

has to be made by any person interested; it has to be made against a person who has got a design registered; the person who has got the design

registered may be a foreigner or may be a person who neither resides nor carries on business within the local limits of the jurisdiction of any High

Court, So far as the subject-matter is concerned, a design can only be registered provided there was no previous publication of that design.

Immediately on registration a person who is interested acquires a right to have the same set aside provided the conditions laid down in Section

51A of the Act are satisfied. In those circumstances, difficulty may arise as regards the location of the subject-matter of the application. Clause 12

of the Letters Patent refers to the original jurisdiction of the High Court. There is no reason to confine the jurisdiction of the High Court u/s 51A of

the Act, to the jurisdiction it exercises on the Original Side. In my view, one cannot turn to the provisions of the Letters Patent for the purpose of

considering the limits of the jurisdiction of the High Court when the same is conferred under a special enactment.

13. Mr. Shah has strongly relied upon a case reported in National Telephone Co. Limited v. Postmaster General [1913] A.C. 546. He drew my

attention to a passage from the speech of Lord Chancellor Viscount Haldane. At page 552 it has been observed as under:

“When a question is stated to be referred to an established Court without more, it, in my opinion, imports that the ordinary incidents of the

procedure of that Court are to attach, and also that any general right of appeal from its decisions likewise attaches.

This passage clearly indicates that the ordinary incidents of the procedure of that Court are to apply. Now, the question of jurisdiction of a High

Court is not a question relating to procedure and you cannot say that merely because the ordinary incidents of procedure of that Court are to

apply, the jurisdiction of that Court is circumscribed. He also drew my attention to the speech of Lord Parker in the same report, appearing at

page 562. The learned Lord observed as under:

Where by statute matters are referred to the determination of a Court of record with no further provision, the necessary implication is, I think, that

the Court will determine the matters, as a Court. Its jurisdiction is enlarged, but all the incidents of such jurisdiction, including the right of appeal

from its decision, remain the same.

This passage also does not help Mr. Shah in the construction he seeks to put upon the provisions of Section 51A of the Indian Patents and Designs

Act. Lord Parker observes that the jurisdiction of the Court is enlarged, but to what extent it is enlarged cannot be found in the rules which lay

down the procedure of the Court. It can only be found in the enactment which enlarges that jurisdiction. In my view, there is nothing in any of the

provisions of the Letters Patent or the CPC to limit the jurisdiction of the Court u/s 51A of the Act. In my view, it is open to the petitioner to file a

petition in any High Court provided it is one of the Courts specified in Section 2(7) of the Act. The Bombay High Court is one of such Courts, and

in my view the petition is maintainable in the Bombay High Court.

14. Mr. Shavaksha at one stage attempted to rely upon the fact that the goods of the respondents were being sold in Bombay and that the Court

had, therefore, jurisdiction to entertain the petition. An amendment was applied for in the month of February 1957 and was granted to raise that

plea. At the hearing a witness was called by Mr. Shavaksha who deposed to the fact that he had effected the sales of the goods of the respondents

bearing the design in question in the month of January 1957, which was long after the date of the petition. That fact cannot in any way help Mr.

Shavaksha. I have already stated that the Court has jurisdiction in the matter and the petitioner is entitled to the relief by way of cancellation of the

registration of the respondents' design.

15. I accordingly order that the registration of the respondents' design No. D 82466 as a design under the Indian Patents and Designs Act, 1911,

be cancelled. The petitioner is entitled to the costs of the petition and I order that the respondents do pay to the petitioner the costs of the petition.

I do further direct that the Prothonotary do send a certified copy of the decree to the Controller of Patents and Designs at Calcutta at the costs of

the petitioner. By consent of the parties I direct that the papers from the Controller's office be returned on true copies being put in.