

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

+ **CS(COMM) No.361/2017**

% **8th January, 2018**

PENTEL KABUSHIKI KAISHA & ANR. Plaintiffs

Through: Mr. Sandeep Sethi, Senior Advocate with Mr. Afzal Khan, Advocate, Mr. Debjyoti Sarkar, Advocate and Ms. Parul Singh, Advocate.

versus

M/S ARORA STATIONERS & ORS. Defendants

Through: Mr. Shailen Bhatia, Advocate with Mr. H.P. Singh, Advocate, Mr. Amit Jain, Advocate, Ms. Ektanayar Saini, Advocate and Mr. Navroop Singh, Advocate.

CORAM:
HON'BLE MR. JUSTICE VALMIKI J.MEHTA

To be referred to the Reporter or not? **YES**

VALMIKI J. MEHTA, J (ORAL)

I.A. No.6056/2017 (under Order XXXIX Rules 1 & 2 CPC)

1. This application for injunction under Order XXXIX Rules 1 & 2 of Code of Civil Procedure, 1908 (CPC) is filed by the

plaintiffs in a suit pleading piracy by the defendants of the plaintiffs' registered design no.263172 for ball point pens.

2. The cause of action as pleaded in the plaint is one under Section 22 of the Designs Act, 2000 (hereinafter referred to as 'the Act') and which Section provides that during the existence of the copyright in any design, no other person shall use the registered design for commercial purposes, sale of the article etc being a design which is identical or an imitation of the registered design of the plaintiff. In the suit the following reliefs are claimed:-

“(a) A decree of permanent injunction restraining the Defendants, their partners, agents, proprietors, servants and all those actively in concert with them from manufacturing, selling, offering to sell, advertising, trading, dealing, either directly or indirectly in pens that is identical duplication or being obvious and/or fraudulent imitation to the Plaintiffs' copyright in the registered design no 263172;

(b) An order for delivery up to the Plaintiffs by the Defendants of all the infringing products including blocks, dyes, molds, any other material bearing the Plaintiffs' registered design No.263172 or used for applying the Plaintiffs' registered design No.263172 for purpose of erasure/destruction;

(c) An order of rendition of accounts of profits directly or indirectly earned by the Defendants from their infringing activities and wrongful conduct and a decree for the amounts so found due to be passed in favour of the Plaintiffs;

(d) A sum of Rs.1,00,00,000/- as decree of damages as valued for the purposes of this suit towards invasion of rights, loss of sales, revenue, and overall business identified with the Plaintiffs' registered design No.263172 caused by the activities of the Defendants;

(e) An order as to the costs of the present proceedings; and

(f) Any further order (s) as this Hon'ble Court may deem fit and proper in the facts and the circumstances of the present case.”

3. In the interim injunction application which is being disposed of in terms of the present order, the following reliefs are prayed:-

- “a. An order of *ex parte* interim injunction restraining the Defendants, their partners, agents, proprietors, servants and all those actively in concert with them from manufacturing, selling, offering to sell, advertising, trading, dealing, either directly or indirectly in pens that are identical or obvious and fraudulent imitation to the Plaintiffs’ copyright in the registered design no.263172 during the pendency of the suit.
- b. Any further order(s) as this Hon’ble Court may deem fit and proper in the facts and circumstances of the present case.”

4. In sum and substance this Court has to examine as to whether the plaintiffs, who are the holders of registered design no.263172 with respect to ball point pens, are entitled to interim reliefs on the ground that the defendants are infringing the registered design of the plaintiffs. For the purpose of disposal of the present application, three Sections of the Act would be relevant, and these are Sections 4, 19 and 22 of the Act. These Sections read as under:-

- “Section 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.
- shall not be registered.

Section 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 registerable under this Act; or
- (e) 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. Piracy of registered design.- (1) During the existence of copyright in any design it shall not be lawful for any person-

- (a) for the purpose of sale to apply or cause to be applied to any article in any class of articles in which the design is registered, the design or any fraudulent or obvious imitation thereof, except with the license or written consent of the registered proprietor, or to do anything with a view to enable the design to be so applied; or
- (b) to import for the purposes of sale, without the consent of the registered proprietor, any article belonging to the class in which the design has been registered, and having applied to it the design or any fraudulent or obvious imitation thereof, or
- (c) knowing that the design or any fraudulent or obvious imitation thereof has been applied to any article in any class of articles in which the design is registered without the consent of the registered proprietor, to publish or expose or cause to be published or exposed for sale that article.

(2) If any person acts in contravention of this section, he shall be liable for every contravention-

- (a) to pay to the registered proprietor of the design a sum not exceeding twenty-five thousand rupees recoverable as a contract debt, or
- (b) if the proprietor elects to bring a suit for the recovery of damages for any such contravention, and for an injunction against the repetition thereof, to pay such damages as may be awarded and to be restrained by injunction accordingly:

Provided that the total sum recoverable in respect of any one design under clause (a) shall not exceed fifty thousand rupees:

Provided further that no suit or any other proceeding for relief under this subsection shall be instituted in any court below the court of District Judge.

(3) In any suit or any other proceeding for relief under subsection (2), every ground on which the registration of a design may be cancelled under section 19 shall be available as a ground of defence.

(4) Notwithstanding anything contained in the second proviso to sub-Section (2), where any ground on which the registration of a design may be cancelled under section 19 has been availed of as a ground of defence and sub-section (3) in any suit or other proceeding for relief under sub-section (2), the suit or such other proceedings shall be transferred by the Court in which the suit or such other proceeding is pending, to the High Court for decision.

(5) When the court makes a decree in a suit under sub-section (2), it shall send a copy of the decree to the Controller, who shall cause an entry thereof to be made in the register of designs.”

5. Sub-Section (3) of Section 22 of the Act provides that in spite of the fact that a design is a registered design, whenever any suit is filed for the relief alleging piracy of the registered design by the defendant in the suit, then in such a suit every ground on which registration of a design may be cancelled under Section 19 of the Act shall be available to the defendant as a ground of defence.

6.(i) A reading of Sections 19 and 4 of the Act, shows that before a design is entitled to protection under the Act, the design has to be a new or original design. If the design is not a new or original design, then the registered design though registered is liable to be cancelled in the proceedings under Section 19 of the Act. The pendency or otherwise of the proceedings under Section 19 of the Act for cancellation of the registered design will however not prevent a

Court from deciding the issue of entitlement of the plaintiff to grant of an interim injunction in a suit which is filed under Section 22 of the Act by examining the defences that the registered design is such which is liable to be cancelled, i.e no interim or final relief can be granted to the plaintiff, and this is so specifically provided in Sub-Section (3) of Section 22 of the Act. Therefore, this Court has to examine that whether the design of the ball point pen of which the plaintiffs have obtained registration is or is not a new or original design and which are defences for cancellation of a registered design in proceedings under Section 19 of the Act. Defendants contend that design of the ball point pen of the plaintiffs is not a new and original design, and hence not only the design registered by the plaintiffs is liable to be cancelled in the proceedings already initiated under Section 19 of the Act, even the subject application for injunction is liable to be dismissed in view of Sub-Section (3) of Section 22 of the Act as defences under Section 19 of the Act are defences which are available to the defendants in the suit to contest the allegations and cause of action in the plaint of piracy of registered design.

(ii) While on the subject, as to what is new or original, this Court cannot lose sight of the what is stated in Sub-Section (c) of Section 4 of the Act. Whereas Sub-Section (a) of Section 4 of the Act provides that a design which is not new or original cannot be registered, Sub-Section (c) of Section 4 of the Act provides and clarifies that a design cannot be registered if it is not significantly distinguishable from known designs or combination of known designs. Sub-Section (c) of Section 4 of the Act is therefore in a way explanatory or clarificatory of Sub-Section (a) of Section 4 of the Act by stating that merely because there is some sort of newness or originality in an article, but in case that newness or originality is however not such so as to significantly distinguish the new article prepared from existing designs or combination of designs, then in such a case a design cannot be registered. It is implicit in the requirement of a design being new and original that there is creation by putting an effort. Since a totally new product applying the design comes into existence as a result of lot of labour and effort, consequently, this right is known as intellectual property right and the effect of registering of the intellectual property right called as design under the Act gives monopoly to the owner of

the registered design for a total period of ten plus five years. Therefore it is *sine qua non* that there is required sufficient novelty and originality for a completely new creation to come into existence of a design, and only thereafter would the design be said to be one which is capable of being protected as a design under the Act. This aspect of novelty and creation as regards a design which can only be protected has been dealt with by the Division Bench of this Court in the case of ***M/s. B. Chawla & Sons Vs. M/s. Bright Auto Industries AIR 1981 Delhi 95.*** The relevant paras of this judgment which deal with the aspect of newness or originality are paras 8 to 12 and these paras read as under:-

“8. In *Le May v. Welch* (1884) 28 Ch. D, 24-, Bowen L. J. expressed the opinion:

"It is not every mere difference of cut"-he was speaking of collars-
"Every change of outline, every change of length, or breadth, or
configuration in a single and most familiar article of dress like this,
which constitutes novelty of design. To hold that would be no paralyse
industry "and to make the Patents, Designs and Trade Marks Act a trap
to catch honest traders. There must be, not a mere novelty of outline,
but a substantial novelty in the design having regard to the nature of
the article."

And Fry L.J. observed :

"It has been suggested by Mr. Swinfen Eady that unless a design precisely similar, and in fact identical, has been used or been in existence prior to the Act, the design will be novel or original. Such a conclusion would be a very serious and alarming one, when it is borne in mind that the Act may be applied to every possible thing which is the subject of human industry, and not only to articles made by manufacturers, but to those made by families for their own use. It appears to me that such a mode of interpreting the Act would be highly

unreasonable, and that the meaning of the words "novel or original" is this, that the designs must either be substantially novel or substantially original, having regard to the nature and character of the subject matter to which it is to be applied."

9. Similar view was expressed by Buckley L.J. on the question of quantum of novelty in *Simmons v. Mathieson and Cold* (1911) 28 R.P.C. 486 at 494 in these words:

"In order to render valid, the registration of a Design under the Patents and Designs Act, 1907, there must be novelty and originality, it must be a new or original design. To my mind, that means that there must be a mental conception expressed in a physical form which has not existed before, but has originated in the constructive brain of its proprietor and that must not be in a trivial or infinitesimal degree, but in some substantial degree."

10. In *Phillips v. Harbro Rubber Company* (1920) 37 R.P.C. 233, Lord Moulton observed that while question of the meaning of design and of the fact of its infringement are matters to be judged by the eye (sic), it is necessary with regard to the question of infringement, and still more with regard to the question of novelty or originality, that the eye should be that of an instructed person, i.e. that he should know that was common trade knowledge and usage in the class of articles to which the design applies. The introduction of ordinary trade variants into an old design cannot make it new or original, He went on to give the example saying, if it is common practice to have, or not to have, spikes in the soles of running shoes a man does not make a new and original design out of an old type of running shoes by putting spikes into the soles. The working world, as well as the trade world, is entitled at its will to take, in all cases, its choice of ordinary trade variants for use in 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 was emphasized that it is the duty of the court to take special care that no design is to be counted a "new and original design" unless it distinguished from that previously existed by something essentially new or original which is different from ordinary trade variants which have long been common matters of taste workman who made a coat (of ordinary cut) for a customer should be left in terror whether putting braid on the edges of the coat in the ordinary way so common a few years ago, or increasing the number of buttons or the like, would expose him for the prescribed years to an action for having infringed a registered design. On final analysis, it was emphasized that the use of the words "new or original" in the statute is intended to prevent this and that the introduction or substitution of ordinary trade variants in a design is not only insufficient to make the design "new or original" but that it did not even contribute to give it a new or original character. If it is not new or original without them the presence of them cannot render it so.

11. The quintessence of the placitums above is that distinction has to be drawn between usual trade variants on one hand and novelty or originality on the other. For drawing such distinction reliance has to be placed on popular impression for which the eye would be the ultimate arbiter. However, the eye should be an instructed eye, capable of seeing through to discern whether it is common trade knowledge or a novelty so striking and substantial as to merit registration. A balance has to be struck so that novelty and originality may receive the statutory recognition and interest of trade and right of those engaged therein to share common knowledge be also protected.

12. Coming to the facts of the instant case the design in question as a whole consists in almost rectangular shape with rounded edges with sides curved or sloping with a further curve on either side in the sloping upper length side. The respondent produced in evidence Japan's Bicycle Guide, 1972, Vol. 22. At page Nos. 218 to 221, there are standard models of back mirrors besides branded models numbering 36. Models bearing Nos. 59-6, 62-1, 61-3, 66-1 and 70-1 would show back view mirrors rectangular in shape with sloping widths or lengths. In some of these models there is curve in the upper length side. We have mentioned this fact simply to emphasise that back view mirrors resembling the one in question have been in the market for a long time. The appellants' case is that further a curve in the sloping upper length side makes their design new or original. We have already noted that the extent and nature of novelty was not endorsed by the appellants in the application for seeking registration and, Therefore, it has to be taken only as regards the shape and configuration. In final analysis the matter would boil down to whether addition of further curve on either side makes the variation a striking one or a substantial so as to constitute a novelty meriting for registration. The learned Single Judge after enunciating the legal position correctly used his eye for discerning if there was in fact a novelty and answered the question in the negative. We have once again gone through the same exercise and come to the same opinion. We fail to see the hard labour which the appellants claimed to have bestowed in creating the design they got registered. It is devoid of newness and equally devoid of originality. An addition of curve here or there in a shape which is well-recognised shape of an article of common use in the market cannot make it an article new or original in design. If it is made eligible for registration, it would certainly hinder the progress of trade without there being any justification, whatsoever."

(emphasis added)

7. The emphasized portions of the aforesaid paras of the Division Bench judgment of this Court leave no manner of doubt that

there is required substantial novelty of design and that any and every change resulting in a new configuration will not necessarily constitute a novelty of design. Mere novelty of outline or few changes here and there which are trade variants would not result in creation of a new article on the design which would entitle to protection as a design under the Act. The Division Bench has time and again with reference to the different judgments of the courts of U.K. emphasized the requirement of novelty or originality which is substantial novelty and substantial originality with regard to the nature and character of the article. In para 10 of the judgment in the case of *M/s B. Chawla and Sons (supra)* while making reference to the observations of Lord Moulton it is observed that special care has to be taken that no design is counted as a new or original design unless it is distinguished from what previously existed by something essentially new or original which is different from ordinary trade variants. In para 11, the Division Bench has concluded that quintessence is that distinction has to be drawn between usual trade variants on the one hand and substantial novelty and originality on the other hand otherwise there

will be blockage of trade. Only newness/originality entitles monopoly on account of registration of the design.

8. The Supreme Court in the case of *Bharat Glass Tube Limited Vs. Gopal Glass Works Limited (2008) 10 SCC 657* has made similar observations in para 26 and this para 26 reads as under:-

“26. In fact, the sole purpose of this Act is protection of the intellectual property right of the original design for a period of ten 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. It has also laid down that if design is not new or original or published previously then such design should not be registered. It further lays down that if 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, or where applicable, the priority date of the application for registration then such design will not be registered or if it is found **that it is not significantly distinguishable from known designs or combination of known designs**, then such designs shall not be registered. It also provides that registration can be cancelled under Section 19 of the Act if proper application is filed before the competent authority i.e. the Controller that the design has been previously registered in India or published in India or in any other country prior to the date of registration, or that the design is not a new or original design or that the design is not registerable under this Act or that it is not a design as defined in Clause (d) of Section 2. The Controller after hearing both the parties if satisfied that the design is not new or original or that it has already been registered or if it is not registerable, cancel such registration and aggrieved against that order, appeal shall lie to the High Court. These prohibitions have been engrafted so as to protect the original person who has designed a new one by virtue of his own efforts by researching for a long time. The new and original design when registered is for a period of ten years. Such 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. therefore, it is in the nature of protection of the intellectual property right. This was the purpose as is evident from the Statement Of Objects And Reasons and from various

provisions of the Act. In this background, we have to examine whether the design which was registered on the application filed by the respondent herein can be cancelled or not on the basis of the application filed by the appellant. In this connection, the Law of Copyright and Industrial Designs by P. Narayanan (Fourth Edition), Para 27.01 needs to be quoted.

“27.01. *Object of registration of designs.*- 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.

"Those who wish to purchase an article for use are often influenced in their choice not only by practical efficiency but the appearance. Common experience shows that not all are influenced in the same way. Some look for artistic merit. Some are attracted by a design which is a stranger or bizarre. Many simply choose the article which catches their eye. Whatever the reason may be one article with a particular design may sell better than one without it: then it is profitable to use the design. And much thought, time and expense may have been incurred in finding a design which will increase sales". 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 (or in other words, to govern the shape and configuration of) particular articles to be manufactured and marketed commercially. It is not to protect principles of operation or invention which, if profitable (sic protectable) at all, ought to be made the subject-matter of a patent. Nor is it 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 effected 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 manufacture and sale of articles of a design not substantially different from the registered design. The emphasis therefore is upon the visual image conveyed by the manufactured article.”
(emphasis added)

9. A reference to the aforesaid para 26 of *Bharat Glass Tube Limited's* case (*supra*) shows that what is stated by the Division

Bench of this Court in the case of *M/s B. Chawla and Sons (supra)* has been accepted and in sum and substance it has been held by the Supreme Court that the object behind enactment of the Act is to give benefit to a person for the research and labour put by him to evolve the new and original design which is an intellectual property right. Supreme Court has also observed that unless the design is not significantly distinguishable from the known designs or combination of designs, then such a design is not entitled to registration and hence monopoly of user for 15 years under the Act.

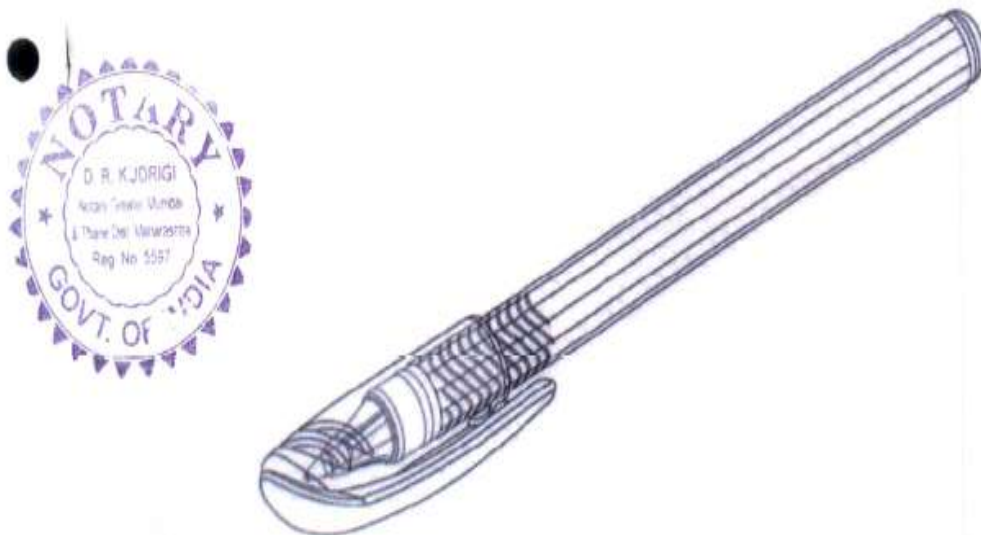
10. With the aforesaid being the position of law with respect to the requirement of newness and originality, with the fact that it also stands further clarified by virtue of Sub-Section (c) of Section 4 of the Act that design with respect to which registration is claimed has to be substantially different from existing designs, and hence monopoly for 15 years can only be given to such a design which is significantly distinguishable from the known designs or combination of known designs.

11. Let us therefore now turn to the facts of the present case on the basis of which plaintiffs claim entitlement to injunction on

account of alleged piracy by the defendants and thereby the plaintiffs would be entitled to reliefs under Section 22 of the Act. The relevant paras with respect to plaintiffs' claim of its validity of registered design are paras 11 and 12 and these paras are scanned below:-

11. The novelty of the '172 design lies in the shape and configuration.

More specifically, as can be seen from the picture extracted from the



registration certificate that the pen has:

- (i) a unique cap with two wedges on each side near the clip-end;



- (ii) a unique clip top which appears as a mounted attachment on the cap;
- (iii) a unique polygonal barrel with wave-like cuts on the grip-end and;
- (iv) the wave-like cuts on the grip-end that transform abruptly to a plain cylinder before meeting the tip;
- (v) the slightly curved conical tip having thin cuts from the nib till the bottom of the cone; and
- (vi) the barrel that transform abruptly into a plain cylinder on the plug side; and
- (vii) the plug side having a protruded knob.

Evidently, all these features are employed together. Therefore: all these features are the *shape and configuration* that constitutes the novelty of the '172 design.

12. The '172 design has been *faithfully and precisely* applied by the Plaintiffs on their Energel series of pen. More specifically, it is applied on Energel BL-417. The pictorial representation of the Plaintiffs' pens having *faithful and precise* application of the '172 design is provided below.





<u>Picture</u>	<u>Application of '172 design</u>
	<p>A unique cap with two wedges near the clip end indicated with red arrow and marked with the number (1).</p> <p>A unique clip top which appears as a mounted attachment on the cap indicated with green arrow and marked with the number (2).</p>

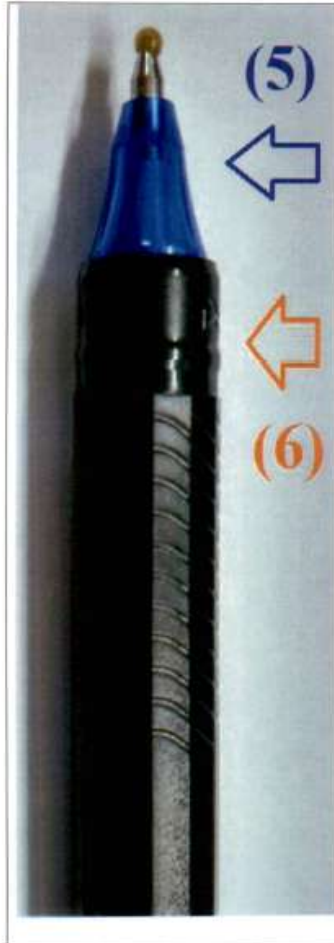


[Handwritten signature]



A unique polygonal barrel marked with green number (4) having wave-like cuts on the grip-end marked with yellow number (3).

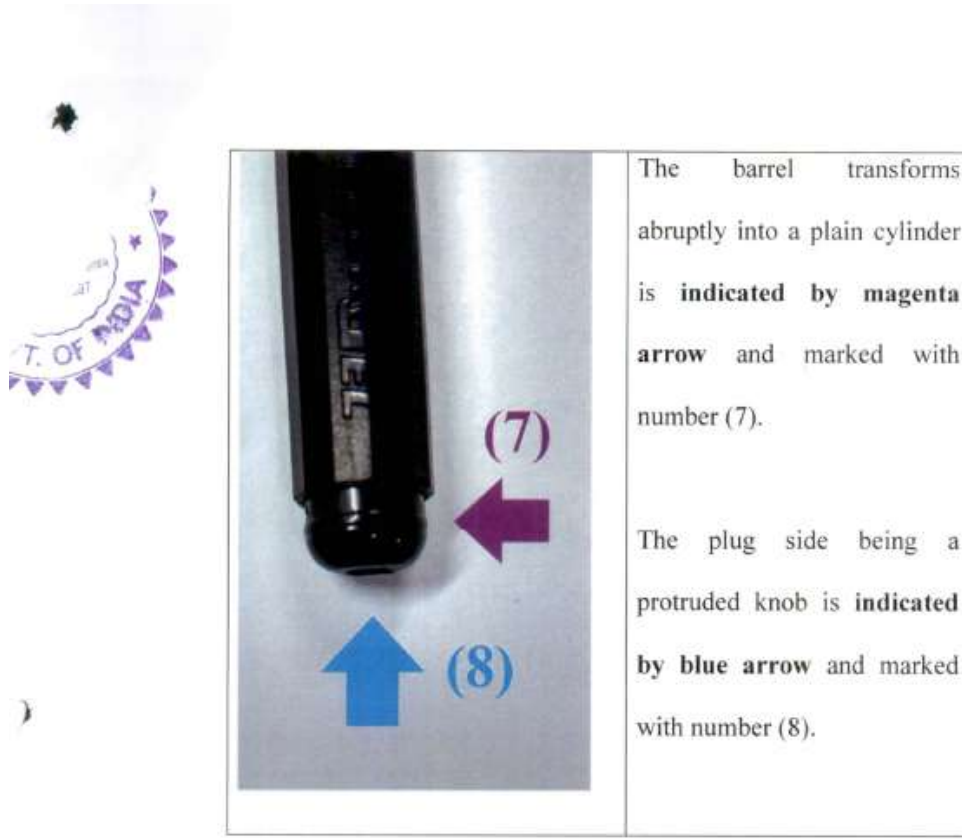




The slightly curved conical tip having thin cuts running from the nib till the bottom of the cone indicated with purple arrow and marked with number (5).

The end of the barrel abruptly transforming into plain cylinder before connecting with the cone indicated with orange arrow and marked with number (6).





12. Paras are being scanned instead of being typed so that by a visual impression it could be known as to what are the design features of which plaintiffs' claim exclusivity.

13. At this stage, it is required to be noted that whereas the plaintiffs are selling their ball point pens under the trademark PENTEL ENERGEL, defendants are selling their ball point pens under the trademark MONTEX and with sub-brands of MONTEX including the MONTEX MASTANI. It is MONTEX MASTANI

which is pleaded by the plaintiffs to be an infringement of the registered design of the plaintiffs. The defendants as per their written statement in order to dispute the claim of the plaintiffs have denied that there is any newness or originality and in fact the defendants plead that they are in the business of manufacture of ball point pens since around the year 1976 and defendants have various registered trademarks with the main brand name/trademark MONTEX as also registration of the trademark/trade name MONTEX with other special brands. This is stated in para 7 of the initial submissions of the written statement and this para 7 reads as under:-

“7. That aforesaid goods of the defendants are sold under the various distinct names along with the well-known trade mark/House Mark MONTEX which stand registered/protected in class 16 in the name of defendants, the details of same are furnished hereunder:

SR. NO.	TRADE MARK	NO.	STATUS
1	MONTEX	204732	REGISTERED
2.	MONTEX	383189	REGISTERED
3.	MONTEX	502782	REGISTERED
4.	MONTEX TURBO	673571	REGISTERED
5.	MONTEX HYTONE	678540	REGISTERED
6.	MONTEX GEL	835796	REGISTERED
7.	MONTEX PENS	847279	REGISTERED
8.	MONTEX PENS & REFILLS	1005718	REGISTERED
9.	MONTEX LAYA AUR KUCH NAYA	1113344	REGISTERED
10.	MONTEX MIRACLE	1185110	REGISTERED
11.	MONTEX MERCURY	1185111	REGISTERED
12.	MONTEX MEGA TOP	1262904	REGISTERED
13.	MONTEX NEW HONEY	1273423	REGISTERED
14.	MONTEX NEW HYBRID	1273424	REGISTERED

15.	MONTEX HANDSOME	1273425	REGISTERED
16.	MONTEX HYSQUARE	1273426	REGISTERED
17.	MONTEX MASTER GRIP	1328890	REGISTERED
18.	MONTEX FAST	1440830	REGISTERED
19.	MONTEX ACTION	1440836	REGISTERED
20.	MONTEX FARARI	1476482	REGISTERED
21.	MONTEX MABACK	1476483	REGISTERED
22.	MONTEX 9	1668638	REGISTERED
23.	MONTEX PLUS	1668639	REGISTERED
24.	MONTEX GLIDER	1668642	REGISTERED
25.	MONTEX RADIUM	1668643	REGISTERED
26.	MONTEX REGAL	1714628	REGISTERED
27.	MONTEX CAPTIVA	1714629	REGISTERED
28.	MONTEX ICON	1834331	REGISTERED
29.	MONTEX MURFY	1834332	REGISTERED
30.	MONTEX PAGODA	1834333	REGISTERED
31.	MONTEX POLITE	1834334	REGISTERED
32.	MONTEX SOLAR	1834335	REGISTERED
33.	MONTEX PRESIDENT	1855597	REGISTERED
34.	MONTEX TRICK RETRACTABLE BALL PEN	2927355	REGISTERED
35.	MONTEX CLASSIC	2927356	REGISTERED
36.	MONTEX TRICK RETRACTABLE BALL PEN	2927357	REGISTERED
37.	MONTEX HY-SLIM BALL PEN	2927358	REGISTERED
38.	MONTEX POWER POINT BALL PEN	2927359	REGISTERED
39.	MONTEX GALAXY GLIDER INK BALL PEN	2927360	REGISTERED
40.	MONTEX MONEY BALL PEN	2927361	REGISTERED
41.	MONTEX JEWEL	2927362	REGISTERED
42.	MONTEX STUDENT FOUNTAIN PEN	2927363	REGISTERED
43.	MONTEX STUDY FOUNTAIN PEN	2927364	REGISTERED
44.	MONTEX SMOTH FLOW GLIDER INK BALL PEN	2927365	REGISTERED
45.	MONTEX STYLISH GLIDER BALL PEN	2927366	REGISTERED
46.	MONTEX CROMA TWIST	2929291	REGISTERED

	METAL BALL PEN		
47.	MONTEX GRAPHIC	2488087	REGISTERED
48.	MONTEX TRI-MORE (LABEL)	3304583	REGISTERED
49.	MONTEX WORLD OF SCHOOL (LABEL)	3304586	REGISTERED

14. There are also details of registration with the trademark MONTEX of the defendants and this is stated in para 9 of the initial submissions of the written statement and this para 9 reads as under:-

“9. That the defendants in order to protect its *well-known* trade mark MONTEX have registered the same in respect of various goods and services of the Nice classification, the details of which are furnished hereunder:

SR. NO.	T.M. NO.	CLASS	STATUS
1.	846602	9	REGISTERED
2.	846603	21	REGISTERED
3.	846604	28	REGISTERED
4.	2930407	1	REGISTERED
5.	2930408	22	REGISTERED
6.	2930409	21	REGISTERED
7.	2930410	20	REGISTERED
8.	2930411	19	REGISTERED
9.	2930412	18	REGISTERED
10.	2930413	17	REGISTERED
11.	2030414	16	REGISTERED
12.	2930415	15	REGISTERED
13.	2930416	14	REGISTERED
14.	2930417	13	REGISTERED
15.	2930418	12	REGISTERED
16.	2930419	11	REGISTERED
17.	2930420	10	REGISTERED
18.	2930421	44	REGISTERED
19.	2930422	43	REGISTERED
20.	2930423	42	REGISTERED
21.	2930424	41	REGISTERED
22.	2930425	40	REGISTERED
23.	2930426	39	REGISTERED
24.	2930427	38	REGISTERED
25.	2930428	37	REGISTERED

26.	2930429	36	REGISTERED
27.	2930430	35	REGISTERED
28.	2930431	34	REGISTERED
29.	2930432	33	REGISTERED
30.	2930433	32	REGISTERED
31.	2930434	31	REGISTERED
32.	2930435	30	REGISTERED
33.	2930436	29	REGISTERED
34.	2930437	28	REGISTERED
35.	2930438	27	REGISTERED
36.	2930439	26	REGISTERED
37.	2930440	25	REGISTERED
38.	2930441	24	REGISTERED
39.	2930442	23	REGISTERED
40.	2930443	9	REGISTERED
41.	2930444	8	REGISTERED
42.	2930445	7	REGISTERED
43.	2930446	6	REGISTERED
44.	2930447	4	REGISTERED
45.	2930448	5	REGISTERED
46.	2930449	3	REGISTERED
47.	2930450	2	REGISTERED
48.	2930451	45	REGISTERED

15. Defendants also plead to be the owner of different designs which are registered under the Act and details of which are stated in para 10 of the initial submissions of the written statement and this para 10 reads as under:-

“10. That the said new developed designs of the writing instruments from time to time stand registered in the name of defendant under The Designs Act, 2000 and defendant is registered proprietors of various such Designs as mentioned hereunder:

SR. NO.	TITLE OF	DATE OF APPL.	REGD. DESIGN NO.
1.	HONEY	20.07.1996	171990
2.	HYGRIP	15.01.1999	178759
3.	HAIWA	18.04.2002	189124

4.	HYCON	16.03.2005	198979
5.	HITPOINT	16.03.2005	198981
6.	MELODY	16.03.2005	198982
7.	MEGA TOP	16.03.2005	198983
8.	HYSCALE	16.03.2005	198984
9.	HABBIT	25.03.2005	199139
10.	HY TANK 999	25.03.2005	199143
11.	HANDY	25.03.2005	199144
12.	HANDY # 18	25.03.2005	199145
13.	HYBOSS	25.03.2005	199148
14.	MASTER PIECE	13.09.2005	201286
15.	MERCURY WITH OUT RUBBER	13.09.2005	201287
16.	HYROLLER	21.04.1999	179345
17.	HOT POINT	21.04.1999	179347
18.	HYGEL	21.04.1999	179349
19.	HY Q	01.09.1999	180289
20.	HYPower	07.10.1999	180596
21.	HYSPEED	28.12.2000	184343
22.	HYPower	13.01.2001	184501
23.	HEADLINE	28.12.2001	185791
24.	HYSLIM	28.12.2001	187907
25.	BARREL	26.02.2003	188689
26.	HYSCALE	20.10.2002	190361
27.	MERCURY	25.01.2003	191179
28.	MIRACEL	25.01.2003	191180
29.	INNOVA	22.03.2006	203812
30.	ACCUPOINT	18.03.2006	203919
31.	FARARI	19.07.2006	205692
32.	PLATIMA	19.07.2006	206618
33.	DYNA	01.10.2007	213008
34.	REGAL	01.10.2007	213009
35.	MAGNUM	19.07.2006	205693

16. Defendants also claim that they have registered their trademarks for the ball point pens being the mark MONTEX in different countries of the world and the names of 18 countries in

which the trademark MONTEX is registered have been given in para 12 of the initial submissions and this para 12 reads as under:-

“12. That the defendants have been extensively selling their “writing instruments” designed and registered by them under the Design Act and under their Registered Trade Mark/House Mark MONTEX throughout length and breadth of India and in various countries of the world and accordingly have even obtained the registration and/or have applied for registration of the their well known trade mark in various countries of world, the details of which are furnished hereunder:

SR. No.	TRADE MARK NO.	COUNTRY	STATUS
1.	39136	BRUNEI	REGISTERED
2.	64147	BANGLADESH	REGISTERED
3.	BT/M/2004/4952	BHUTAN	REGISTERED
4.	2869733	EPO	REGISTERED
5.	209812	EGYPT	REGISTERED
6.	4234933572	GREAT BRITAIN	REGISTERED
7.	11856	GAZA STRIP	REGISTERED
8.	96417	JORDAN	REGISTERED
9.	74688	KUWAIT	REGISTERED
10.	28606	KAZAKHSTAN	REGISTERED
11.	3200800858	O.A.P.I	REGISTERED
12.	47961	OMAN	REGISTERED
13.	192825	PAKISTAN	REGISTERED
14.	97278	SRILANKA	REGISTERED
15.	2004/14928	SOUTH AFRICA	REGISTERED
16.	EE072261	TUNISIA	REGISTERED
17.	40504	U.A.E	REGISTERED
18.	51529	IRAQ	REGISTERED

Defendants therefore pleaded to be a huge company into manufacturing of writing instruments and turnover of the defendant no.2 since the year 2004-05 to 2015-16 runs into few hundred crores of rupees.

17. On the merits of the matter with respect to denial of the defendants not copying the features and the designs of the plaintiffs, defendants have referred to the fact that features which are alleged by the plaintiffs to be their exclusive creation and being different parts of their registered design have been used by the defendants from their own earlier designs commencing from the year 2005. These features are with respect to the pen caps with clips, the portion where ball point pen is gripped containing wedges and with respect to barrel/lower casing portion, and lower casing or housing being of octagonal sides and not semi-spherical. These details are contained in para 6 of the preliminary objections and this para 6 depicting the description of the features of the pens of the defendant no.2 is scanned below:-

6. The present suit is liable to be dismissed as the writing instrument "pen" of the plaintiff is not a new and novel but a combination of various distinct features of various pre-published designs of "pens" of defendant's sold under the trade marks MONTEX MELODY, MONTEX ADDICT, MONTEX LINER, MONTEX FERRARI, MONTEX HAIWA and MONTEX EASY FLOW and defendant's pen "MONTEX MASTANI" has been developed and designed by



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the defendants by taking the designs of various parts from its existing pre-published designs :

CLIP PORTION: is appearing in defendant's pre-published designs in pens under the title 'MONTEX MELODY', 'MONTEX EASY FLOW' & 'MONTEX ADDICT':

2005	2006	2008	2016
MELODY	ADDICT	EASY FLOW	MASTANI
			

GRIP PORTION: The curvy "Grip Portion" is a pre-published design and similar curvy grip portion as appearing in the defendant's pen MONTEX FERRARI

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who is a prior adopter & user of the said Design. The defendant submits that the Curvy grip portion is also in use by various other pen manufacturers including CELLO company in their pens under title 'CELLO LIQUI BALL' and 'CELLO BUTTER FLOW' and an international company OFFICE DEPOT in UNITED STATES under their trade mark FORAY, the same are depicted hereunder:



CELLO PENS WITH SIMILAR GRIP PORTION

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<u>CELLO BUTTER</u> <u>FLOW</u>	<u>CELLO LIQUI BALL</u>	<u>FORAY OF USA</u> <u>BRAND (advance</u> <u>ink ball point pen)</u>
		

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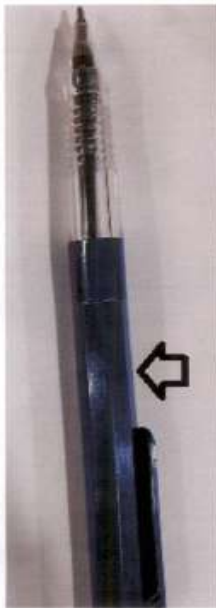





BARREL PORTION: The Hexagonal barrel portion of the MONTEX MASTANI has been taken by the defendants from their own pre-published pen MONTEX HAIWA, MONTEX TRICON, MONTEX

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LINER published by the defendants much prior to the plaintiff.

MONTEX HAIWA	MONTEX TRICON	MONTEX LINER	MONTEX MASTANI
			

"सत्यमेव जयते"

18. In sum and substance the defences of the defendants are therefore that neither there is any newness or originality in the registered design of the plaintiffs with respect to ball point pens claimed by the plaintiffs and also, that the defendants have copied the

features not from the registered design of the plaintiffs but from the features which are already adopted by the defendant no.2 in its ball point pens since the year 2005.

19. In the opinion of this Court the issue which arises squarely is whether paras 11 and 12 of the plaint which contain the cause of action of the plaintiffs of creation of features of designs and thus the ball point pen of the plaintiffs as a whole being entitled to exclusivity of the registered design yet the plaintiffs will have to satisfy this Court that the plaintiffs' registered design of the ball point pens satisfies the requirements of newness and originality with the fact that the so called newness or originality is not such so as not to be significantly distinguishable from the known designs features.

20. I must begin this reasoning portion by stating that a ball point pen is a ball point pen i.e every ball point pen normally has a refill with a nib, the refill is put in a lower casing called a barrel, over the barrel containing the refill and the nib there is a cap which is put, and such a cap obviously has a clip in order to fix/attach the ball point pen in the clothing of persons. In sum and substance therefore every ball point pen has common features of a lower casing/barrel in which

lower casing/barrel there is a refill, the refill exists with a ball point pen nib, the cap covers the ball point pen nib portion with additional portion of the lower casing/barrel, and finally that the cap ordinarily contains a clip. In order for a design to be totally a new and original design with respect to a ball point pen, there will have to be significantly distinguishable features so as to make the ball point pen of which exclusivity and continuation of the registration is claimed by the plaintiffs, that such is a completely new and original ball point pen and that there is enough/substantial novelty and originality by application of labour whereby the ball point pen of the plaintiffs is distinguished from the aforesaid known features/designs in a ball point pen. When the facts of this case on the features and design of the ball point pen of the plaintiffs is examined along with ratios of the judgments of the Division Bench of this Court in the case of *M/s B. Chawla and Sons (supra)* and that of the Supreme Court in the case of *Bharat Glass Tube Limited (supra)*, in my opinion the fact that the cap of the plaintiffs' ball point pen is alleged to be unique because of wedges at the point of holding of the ball point pen or the barrel is polygonal or there exists slightly curved tip or that barrel/lower casing

goes into a knob etc are only trade variants and such features really cannot be said to be in my opinion such newness or originality so as to distinguish these features from the known shape or the different features which already exist in a ball point pen. The features given in para 11 of the plaint which are claimed to be unique and new are not such that it can be held that the features in themselves or taken with other features will make the ball point pen of the plaintiffs as a completely unique new design having that much originality so as to be significantly distinguishable from the known features/design of a ball point pen. In fact the wedges in the grip portion in my opinion is in fact a functional feature because this wedges design created is for a better grip and in order to ensure that there is proper grip of the pen resultantly this being a mode or principal of construction applied with respect to a ball point pen and for ensuring a better grip of the ball point pen and which because of Section 2(d) of the Act defining design cannot be protected as a design.

21. Learned counsel for the plaintiffs sought to place reliance upon a portion of Full Bench judgment of this Court in the case of ***Reckitt Benkiser India Ltd. Vs. Wyeth Ltd. AIR 2013 Delhi 101 (FB)***

but the para relied upon of this judgment reproduces the observations in the book 'Industrial Designs by Russell Clarke and Howe' which only deals with the requirement of a design becoming a design not because of the design being otherwise existing in public domain but because of the design necessarily having been applied to an article. Putting it in other words, non-existence of a design in public domain is not enough to succeed on the aspect of registration of the design under the Act because even a known concept or known design or known idea becomes a design only when it is applied with respect to an article, whereby the new article would become a design as such, and one then which would have protection as a design under the Act. This is said in so many words in Section 2(d) of the Act which defines a design as under:-

“**Section 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 Mark Act, 1958 (43 of 1958) or property mark as defined in section 479 of the Indian Penal Code (45 of 1860) or any artistic work as defined in clause (c) of section 2 of the Copyright Act, 1957 (14 of 1957)” (emphasis added)

22. In the opinion of this Court, this Court does not even have to go to the facts as stated by the defendants in their written statement of their having used the features claimed by the plaintiffs as unique/new features in the ball point pens of the defendants which are already in existence in earlier manufactured ball point pens by the defendants in different years from the year 2005 inasmuch as firstly the plaintiffs have to satisfy this Court that the design of which exclusivity and ownership is claimed by the plaintiffs is a completely new and original design and is not as to be containing mere variations or trade variants or some or the other differences from the known designs already existing in a ball point pen. In this regard, in the opinion of this Court, the plaintiffs have miserably failed of showing substantial newness/originality as required by the definition and meaning of newness and originality as stated in the Division Bench judgment in the case of *M/s B. Chawla and Sons (supra)* and the judgment of the Supreme Court in the case of *Bharat Glass Tube Limited (supra)*, relevant paras of which are reproduced above.

23. In view of the aforesaid discussion, I do not find any merit in this application and the same is therefore dismissed. Interim order passed by this Court on 26.5.2017 is vacated.

JANUARY 08, 2017

VALMIKI J. MEHTA, J

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