

\$~40 (Original)

* **IN THE HIGH COURT OF DELHI AT NEW DELHI**
+ CS(COMM) 537/2022 and I.A. 12437/2022(Order XI Rule 1(4) of the CPC)

CASIO KEISANKI KABUSHIKI KAISHA D/B/A CASIO
COMPUTER CO. LTD. Plaintiff
Through: Mr. Rishi Bansal, Mr. Arpit and
Mr. Deepak, Advs.

Versus

RIDDHI SIDDHI RETAIL
VENTURE AND ANR. Defendants
Through: Mr. Arnav Goyal, Adv.

CORAM:
HON'BLE MR. JUSTICE C.HARI SHANKAR

JUDGMENT(ORAL)

% **07.02.2023**

I.A. 13291/2022 (Order VIII Rule 1(3) of the CPC for placing documents on record)

1. By this application preferred under Order VIII Rule 1(3) of the Code of Civil Procedure, 1908 (CPC), the defendants seek to place certain additional documents on record. Following the decision in *Sudhir Kumar @ S Baliyan v. Vinay Kumar G.B¹*, the application is treated as having been preferred under Order XI Rule 1(10) of the CPC, as amended by the Commercial Courts Act, 2015.

2. Mr. Rishi Bansal, learned Counsel for the plaintiff initially opposed the application but, later, agreed to the documents being taken on record.

3. Accordingly, the application is allowed. The documents filed with the application are taken on record.

I.A. 12436/2022 (Order XXXIX Rules 1 and 2 of the CPC) and I.A. 13344/2022(Order XXXIX Rule 4 of the CPC)

4. This case was originally pending before the learned Commercial Court and has subsequently been transferred to this Court. In I.A. 12436/2022 filed by the plaintiff under Order XXXIX Rules 1 and 2 of the CPC, *ad interim* relief was granted by the Additional District Judge (“the learned ADJ”) *vide* order dated 25th June 2021.

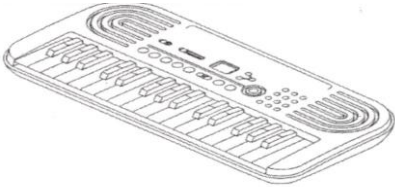
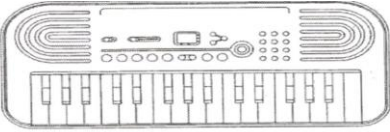


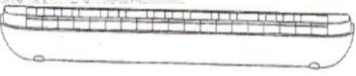
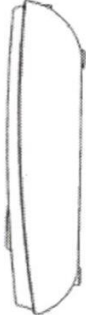
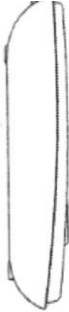
5. The defendants have filed IA 13344/2022 under Order XXXIX Rule 4 of the CPC for vacation of the said order dated 25th June 2021.

6. I have heard Mr. Rishi Bansal, learned Counsel for the plaintiff and Mr. Arnav Goyal, learned Counsel for the defendants on these applications and proceed, by this order, to decide the applications.

7. The plaintiff is a well known entity engaged in the manufacture of, among other things, musical keyboards. One of the keyboards of the plaintiff stands registered in the plaintiff’s favour as an “Electronic Keyboard” *vide* Design Registration No. 224547, with effect from 2nd September 2009. The registration is valid and subsisting, till 2nd September 2024. The Certificate of Registration issued to the plaintiff by the Controller of Designs certifies that novelty resides in the shape and configuration of the keyboard. The various views of the keyboard, in each of which the Certificate of Registration certifies

¹ 2021 SCC OnLine SC 734

existence of novelty in its shape and configuration may be thus presented, in a tabular form:

Details of Casio mini Keyboard Design registration	
Registration no.	224547
Perspective View	
Front View	
Rear View	
Top View	
Bottom View	
Right View	
Left View	

8. The plaintiff claims copyright in the registered design, under Section 11(1)² read with Clause (c) of Section 2³ of the Designs Act, 2000.

9. The plaintiff manufactures keyboards carrying the suit design under Model Nos. SA-46 and SA-47, the difference between the two being with respect to the colour of the base of the keyboards.

10. In order to fortify its case regarding its goodwill and repute in the market, the plaintiff has provided the figures of returns from sale of the products carrying the suit design from the year 2011 till 2020-21 in India. The defendant does not dispute the reputation or goodwill of the plaintiff.

11. The plaintiff asserts that the suit design has become indelibly associated with the plaintiff and has, over a period of time, acquired secondary significance. The purchasing public, it is submitted, invariably associates the suit design with the plaintiff's keyboard.

12. The plaintiff is aggrieved by the adoption, by the defendants, of a near identical design for its keyboard sold under the brand name "Nexus32", under its registered trademark "Blueberry". The plaintiff provides photographs of the plaintiff's and the defendants' keyboards, to emphasize the likeness of the design of the two, thus:

² 11. **Copyright on registration.** –

(1) 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.

³ (c) "copyright" means the exclusive right to apply a design to any article in any class in which the design is registered;

Design Comparison of Plaintiff SA-46 /Sa-47 with that of Defendants' Nexus32

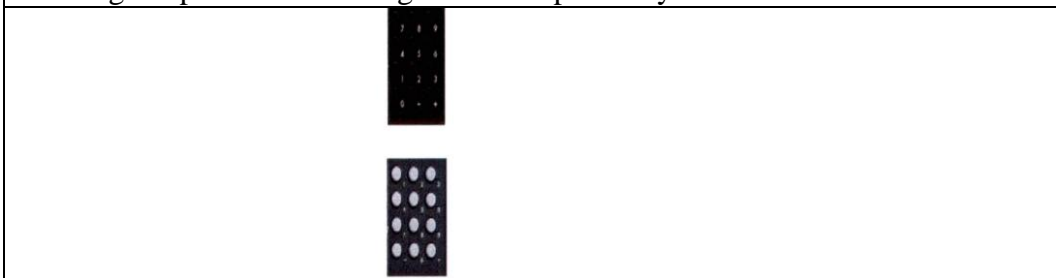


13. Physical samples of the plaintiff's and the defendants' keyboards have also been produced in the Court, and the photographs provided in the plaint and extracted hereinabove are faithful representation of the two keyboards.

14. The plaint also emphasizes the following similar features between the plaintiff's and the defendants' keyboards:

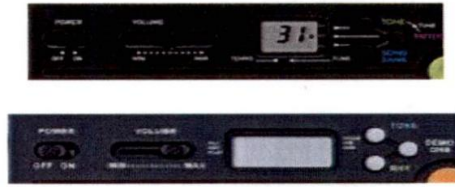


Identical Placement of Piano- Organ key along with the Horizontal line dividing the panel into two segments. Shape of key and line are identical



Identical Placement of the numeric keys having the identical shape and

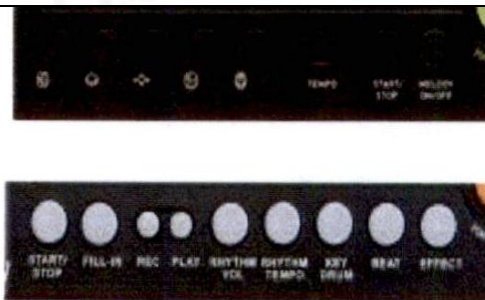
configuration



1. Identical Placement of power button with identical shape and configuration.
2. Identical Placement of Volume button with identical shape and configuration.
3. Identical Placement of display board with identical shape.
4. Identical Placement of tone keys in triangular shape as registered in design with identical shape and configuration.



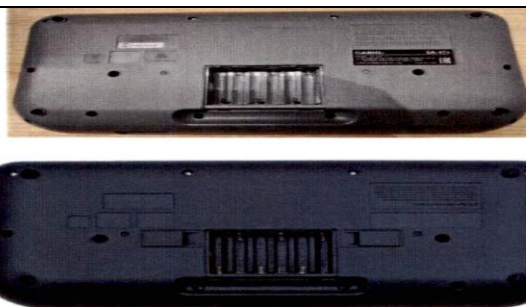
Identical engraved line at the top of the keyboard with identical outline of the board.



Keys placed below the horizontal line in the Nexus32 are simply the mirror image of the Plaintiffs said product with the said design.

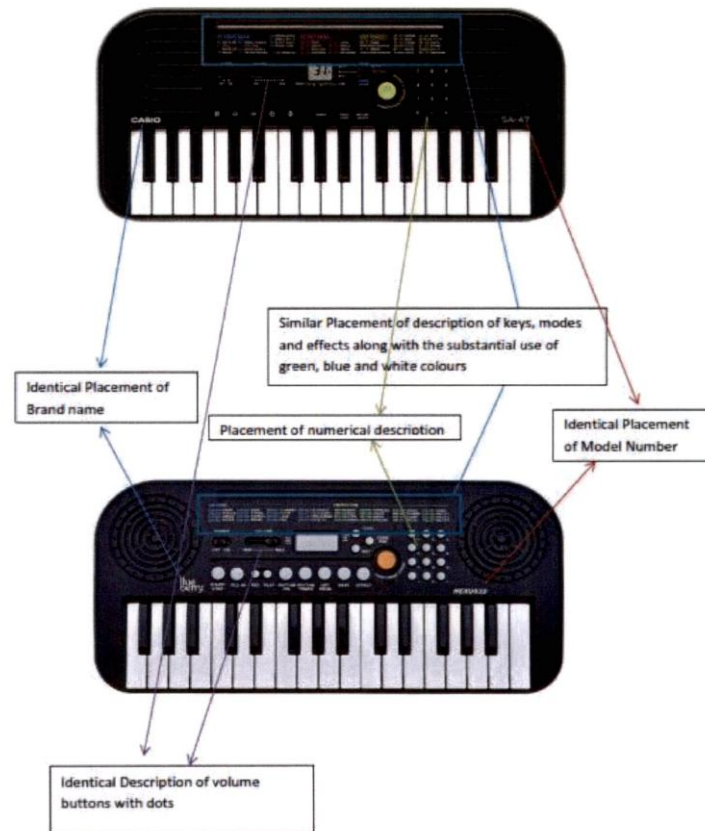


Piano Organ keys of the Nexus 32 is of same shape and configuration as that of Casio said product with said design, both are circular with shallow depth in centre.



The rear view of the Nexus 32 is exact replica of the Casio said product. The infringing goods has copied the shape and configuration of the said goods.

15. The plaintiff also seeks to identify the features in the designs of the plaintiff's and the defendants' keyboards, thus:



16. Defendant 2, avers the plaintiff, was a former distributor of the plaintiff who, Mr. Bansal would submit, was actually manufacturing covers for the plaintiff's keyboards, before setting forth with his own business. Mr. Arnav Goel contests this contention and submits that, in any case, there is no material placed on record to indicate that Defendant 2 was selling the plaintiff's SA-46 or SA-47 keyboards.

17. It is in these circumstances that the present plaintiff has been instituted before this Court, seeking an injunction against the defendants and all other acting on their behalf from manufacturing or selling any keyboards carrying the impugned design or any other design, which is deceptively similar to the suit design.

18. Concomitantly, the suit prays for rendition of accounts, delivery up, costs and damages.

19. As already noted, the learned ADJ, before whom the suit has originally been instituted, has already granted *ad interim* relief to the plaintiff *vide* order dated 25th June 2021. The issue before the Court, today, is, therefore, whether the interim relief should be confirmed or vacated.

Rival Stands

20. The defendants, in their written statement filed by way of response to the suit, do not dispute the allegations that the defendants' Nexus range of keyboards are identical, or near identical, in design to the plaintiff's keyboards carrying the suit design.

21. The defence in the written statement, as has been argued by Mr. Arnav Goyal, learned Counsel for the defendants in Court as well, is predicated on Section 22(3)⁴ read with Section 19(1)(b) and (c)⁵ and Section 4(a), (b) and (c)⁶ of the Designs Act. The plea, fundamentally, is that the plaintiff's design suffers from lack of novelty and is similar to the design of several other keyboards

⁴ **22. Piracy of registered design.**—

(3) 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 under Section 19 shall be available as a ground of defence.

⁵ **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;

⁶ **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

available in the market. The additional documents, which have been permitted to be placed on record by the order passed today, in fact, are listings on the internet pertaining to similar keyboards on various e-commerce websites, apparently with a view to buttressing the case that the defendants seek to set up, of lack of novelty.

22. Needless to say, the plaintiff disputes the allegation and submits that the plaintiff's design was, in fact, new, novel and original and that, therefore, the defendants' case has no legs to stand on.

Analysis

23. Even where the defendants' design is identical or similar to the suit design, Section 22(3) of the Designs Act permits a defendant to urge "every ground on which the registration of a design may be cancelled under Section 19" as a ground of defence to an allegation of design piracy. Section 19(1) envisages five circumstances in which the registration of a design can be cancelled, enumerated in clauses (a) to (e) of the sub-section. Of these, the clauses with which we are concerned in the present case are clauses (b) and (c). Clauses (b) and (c) envisage cancellation of a registered design if

- (i) the design has been published in India or in any other country prior to the date of registration or
- (ii) the design is not new or original.

24. "Publication" is not defined in the Designs Act. A Full Bench of this Court has, noting this fact in its design *Reckitt Benkiser India Ltd v. Wyeth Ltd*⁷, held the issue to be no longer *res integra* in view of

shall not be registered.

⁷ AIR 2013 Del 101 (FB), 198 2013 DLT 521(FB)

the judgment of the Supreme Court in *Bharat Glass Tube Ltd v. Gopal Glass Works Ltd*⁸. Para 20 of the report in *Reckitt Benkiser*⁷, which so holds, reads to the extent relevant, thus:

“In our opinion, most of the confusion or lack of clarity qua the meaning of the words "published" or "publication" will be removed when we refer to the judgment of the Supreme Court in the case of *Bharat Glass Tube Ltd. vs. Gopal Glass Work's Ltd*⁸. This judgment of the Supreme Court is the judgment which has been passed in an appeal against the judgment of the learned Single Judge of the Calcutta High Court in Gopal Glass Work's case. A reference to various paragraphs of the Supreme Court's judgment shows that the Supreme Court has taken note of the fact that though design is specifically qua an article, however, publication of a design in a paper form, may amount to prior publication, however, each case has to be necessarily seen and decided as per the facts of that case. The facts of each case must show sufficient amount of clarity qua the design which must necessarily exist in a public record of a Registrar of Designs Office and must have sufficient clarity attached to them before the same can be treated as prior publication. Therefore, really the issue is no longer res integra as to meaning of word "published" or "publication" as found in Sections 19(1)(b) and 4(b) of the Act because Supreme Court has held that existence of documents in public record such as the Office of the Registrar of Designs, will or will not, depending on facts of each particular case be evidence of prior publication.”

25. One may also advert, in this context, to the passages from the judgment of the Supreme Court in *Bharat Glass Tube*⁸, on which the Full Bench relied. In *Bharat Glass Tube*⁸, the Supreme Court had framed the following three issues as arising for its consideration, in para 9 of the report:

- “(i) Whether the design was not new or original in view of the fact that the roller bearing the design is published before the date of registration and the registered proprietor is not owner of design?
- (ii) Whether the design was published outside India as well as in India prior to the date of application?
- (iii) Whether the registered design was in public domain due to sale/use of the design prior to the date of application of the registered proprietor?”

⁸ (2008) 10 SCC 657

26. In para 29, adverting to Section 4 of the Designs Act, to the extent it prohibits registration of design, which is not new or original, the Supreme Court held as under:

“29. Section 4 which is couched in the negative terms, says that the design which is not a new or original then such design cannot be registered. Therefore, the question is the design which has been prepared by the German Company and which has been sold to the respondent which became the proprietor of it, is a new or original or not. *In this connection, the burden was on the complainant to show that the design was not original or new.* We have no hesitation in recording a finding that the burden was not discharged by the complainant. It only tried to prove on the basis of the letter of the German company that they produced the rollers and sold in market but it was nowhere mentioned that these rollers have been reproduced on the glass sheets by the German company or by any other company. *The expression, "new or original" appearing in Section 4 means that the design which has been registered has not been published anywhere or it has been made known to the public. The expression, "new or original" means that it had been invented for the first time or it has not been reproduced by anyone.*”

(Emphasis supplied)

27. Dealing with the jurisprudential contours of a concept of a “design”, the Supreme Court cited, with approval, the following passage from *Dover Ltd v. Nurnberger Celluloidwaren Fabrik Gebruder Wolff*⁹:

“ 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.”

(*Pugh v. Riely Cycle Co Ltd*¹⁰)

Accordingly, it is submitted that a design is an idea 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

⁹ (1910) 27 RPC 498 (CA)

¹⁰ (1912) 29 RPC 196

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 registrable."

28. Additionally, the Supreme Court also relied on the following definition of "design" as contained in Law of Copyright and Industrial Designs by P. Narayanan:

"27.07. *Design as a conception or idea.*— 'Design means 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 mentioned in the definition clause. It is a suggestion of form or ornament to be applied to a physical body". It is a conception, suggestion or idea, and not an article, which is the thing capable of being registered. It may according to the definition clause, be applicable to any article whether for the pattern or for the shape or configuration or for the ornament thereof (that is to say of the article) or for any two or more of such purposes. The design, therefore, is not the article, but is the conception, suggestion, or idea of a shape, picture, device or arrangement which is to be applied to the article, by some one of the means to be applied to a physical body.' "

29. The Supreme Court, thereafter, ruled thus:

"A design capable of registration cannot consist of a mere conception of the features mentioned in the definition, or in the case of an article in three dimensions, of a representation of such features in two dimensions. It must, in such a case, in order to comply with the definition, consist of the features as they appear in the article to which they have been applied by some industrial process or means. An applicant for registration of a design has to produce a pictorial illustration of the idea or suggestion which he has to establish as new or original.

Therefore, 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."

30. The afore-extracted passages from the decision in *Bharat Glass Tube*⁸ and *Reckitt Benkiser*⁷ sufficiently elucidate the concept of novelty, originality and publication, as employed in Section 19(1) of the Designs Act. “Original”, I may note, also stands defined in Section 2(g) of the Designs Act, thus:

“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;”

31. Section 19 has to be read in conjunction with Section 4, which delineates the categories of designs of which registration is prohibited. Among these, clause (a) prohibits registration of a design which is not new or original and clause (b) prohibits registration of a design which “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”.

32. This Court has already, in its decision in *Diageo Brands B.V. v. Alcobrew Distilleries India Pvt Ltd*¹¹ examined the concept of publication in a “tangible form” and held, after considering authorities on the point, that a design could be said to be published in a tangible form when, by viewing the publication, the article represented by the publication can immediately be visualized by the Court. Though physical samples of the design may not necessarily have to be produced before the Court, even a pictorial or a photographic representation of the design, which is sufficient to make it possible to envision the design in the mind’s eye would suffice as “publication”. That said, *Diageo*¹¹ also clarifies that a design, as defined in Section 2(d) of the Designs Act has necessarily to be applied to an article, and

¹¹ 2022 SCC OnLine Del 4499

an article is defined in Section 2(a) as “any article of manufacture and any substance, artificial or purely artificial and partly natural”. A design which is purely conceptual, not applied to any article, therefore, may not be a design within the meaning of Section 2(d) and if such a design is reduced to a two dimensional image, that reduction may not constitute publication in a given case within the meaning of Section 4(b) or Section 19(b) of the Designs Act.

33. We need not, however, travel down that somewhat thorny path in the present case, as the actual physical articles bearing the suit design and the impugned design have been presented before me and faithful photographic reproductions are also available on the record.

34. At a bare glance, it is clear that the plaintiff’s and the defendants’ keyboards are deceptively similar in design. The various similarities between the two, highlighted paras 12, 14 and 15 *supra*, as alleged in the plaint, actually stand borne out even from a viewing of the physical samples of the two keyboards. As such, it is clear that the design of the defendant’s keyboard is an “obvious imitation” of the suit design within the meaning of Section 22(1)¹² of the Designs Act.

35. Mr. Arnav Goel clarifies that the only point that he seeks to urge by way of defence is that the plaintiff’s design is not new or original.

¹² **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 licence 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.

36. By conjoint operation of Sections 22(3) and 19(1) of the Designs Act, lack of novelty or originality can constitute a ground of defence against an allegation of design piracy where the lack of novelty or originality can constitute a ground for cancellation of the registration granted to the design. As such, the lack of novelty or originality has to be seen as on the date when the design was registered. If a design, when registered, does not suffer from lack of novelty or originality, the mere fact that, after it is registered, several persons may choose to copy the said design can obviously not constitute a ground to cancel the registration of the design.

37. *The plea of novelty or originality has, therefore, to be urged and examined vis-à-vis the date of registration of the suit design. The existence, thereafter, of any number of similar designs in the market, or even the publication of any number of similar designs, cannot indicate any want of novelty or originality in the suit design, within the meaning of Section 19(1)(c) or Section 4(a) of the Designs Act.*

38. The onus to prove want of novelty or originality, when urged as a ground of defence under Section 22(3) read with Section 19(1)(c) of the Designs Act would obviously be on the defendants urging such defence.

39. It is for the defendants, therefore, to produce material before the Court to indicate that, *as on the date when the suit design was registered*, it was not new or original.

40. No such material is forthcoming on the record. To a query from the Court in this regard, Mr. Arnav Goel has merely drawn attention to the following screenshot, at page 97 of the documents filed by the


defendants:

8/10/22, 5:41 PM

Made-in-China.com

Aileen Music Co., Ltd. Jiangsu, China

Diamond Member Since 2008 Audited Supplier Manufacturer/Factory
Sample Available OEM/ODM Service U.S. Warehouse Factory Tour MEI Awards



32 Mini Size Keys Electric Student Musical Keyboard (EK3282)

Purchase Qty.: (Pieces)	1-29	30-299	300+
Reference FOB Unit Price:	US \$30	US \$23	US \$22

Type: Keyboard
 Style: Single Keyboard Electronic Organ
 Number of Keys: 32
 Material: Plastic
 Brand: Lexington
 Age: Children and Adults

Basic Info

Model NO.	EK3282	Plastic Type	ABS
Customized	Customized	Certification	CE
Condition	New	Tones	128
Rhythms	128	Demo Songs	30
Trademark	Aileen	Origin	China
HS Code	9207100000	Production Capacity	5000 PCS/Month

41. A bare glance at the aforesaid screenshot reveals that it puts up a keyboard for sale on the website made-in-china.com. The printout has been taken on 10th August 2022. Mr. Arnav Goel seeks to submit that the words “since 2008”, figuring in red towards the top of the screenshot would indicate that the keyboard was available in the market since 2008, i.e. prior to the date of grant of registration to the suit design.

42. It is obvious that no such inference can be drawn. The words “since 2008” follow the words “Diamond Member”. They only indicate, therefore, that Aileen Music Co., Ltd. Jiangsu China was a “Diamond Member” (whoever that may be) since 2008. They do not, in any manner, go to indicate that the keyboard shown in the said screenshot was available for sale prior to 2008.

43. There is, therefore, nothing to substantiate the defendants' contention that the suit design was liable to cancellation on account of want of novelty or originality.

44. Nor has any document been placed on record to indicate that it suffers from prior publication. All the documents which have been placed on record as additional documents today pertain to online listings of sales of keyboards on various e-commerce websites, none of which is prior to 2009.

45. The plea that the suit design is liable for cancellation on the ground of want of novelty and originality is, therefore, without substance.

46. That being the sole plea of the defendants and the defendants' design being otherwise an obvious imitation of the suit design, the plaintiff is entitled to interlocutory injunction, pending disposal of the suit.

47. As such, the *ad interim* injunction granted by the learned ADJ, *vide* order dated 25th June 2021 stands confirmed pending disposal of the suit.

48. IA 12436/2022 stands allowed accordingly.

49. IA 13344/2022 is dismissed.

CS(COMM) 537/2022

50. List before the Joint Registrar (Judicial) for marking of exhibits

on 15th March 2023, whereafter the matter would be placed before the Court for case management hearing and further proceedings on which date both sides are directed to place on record suggested issues.

51. Judgment to be uploaded on the website of this Court within 24 hours.

C.HARI SHANKAR, J

FEBRUARY 7, 2023

rb

