

MANU/DE/1155/2003

Equivalent Citation: 109(2004)DLT41, 2004(28)PTC1(Del)

IN THE HIGH COURT OF DELHI

IA 6474/03 in Suit No.1214/2003

Decided On: 11.12.2003

Appellants: **Glaxo Smithkline Consumer Healthcare Gmbh and Co. KG**
Vs.

Respondent: **Amigo Brushes Private Limited and Anr.**

Hon'ble Judges/Coram:

Mahmood Ali Khan, J.

Counsels:

For Appellant/Petitioner/plaintiff: C.M. Lall and Saurabh Banerjee, Advs

For Respondents/Defendant: G.L. Sanghi and Rajiv Nayyar, Sr. Advs., Praveen Anand, Pratibha M. Singh and Binny Kalra, Advs. for Defendant No. 2

Subject: Intellectual Property Rights

Acts/Rules/Orders:

Designs Act, 2000 - Section 2, Designs Act, 2000 - Section 4, Designs Act, 2000 - Section 19, Designs Act, 2000 - Section 22(1), Designs Act, 2000 - Section 48(5); Trade and Merchandise Marks Act, 1958 - Section 2(1); Indian Penal Code 1860, (IPC) - Section 479; Copyright Act, 1957 - Section 2

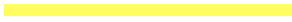
Cases Referred:

AMP Incorporated v. Utilux Proprietary Limited, 1972 RPC 103; Stenor Ltd. v. Whitesides (Clitheroe) Ltd., (1946) 63 RPC 81; Fisher Stoves, Inc. v. All Nighter Stove Works, Inc., 206 USPQ 961; Hello Mineral Water Pvt. Ltd. v. Thermoking California Pure, 2000 PTC 177; Dover Ltd. v. Nurnberger Celluloidwaren Fabrik Gebruder Wolff, 1910 (suppl) RPC 498; B. Chawla & Sons v. Bright Auto Industries, AIR 1981 Delhi 95; Terrell on Patents and A. Fulton Co. Ltd. v. Grant Barnett Co. Ltd., 2001 RPC (16)257; Walker & Co. v. A.G. Scott & Co., 1892 RPC 482; Sherwood & Cotton v. Decorative Art Tile Co., 1887 RPC (IV) 207; Smithkline Beecham v. Hindustan Lever Ltd., 1999 PTC 775; Hecla Foundry Co v. Wlaker, Hunter & Co., 1889 RPC 554; Castrol India Ltd. v. Tide Water Oil Co. Ltd., 1996 PTC 202; J. Harper & Co. Ltd. v. The Wright & Butler Lays Manufacturing Co., 1895 RPC 483; Lacey v. Foggins, 56 IPR 436; Philips Electronics by v. Remington Consumer Products, 1998 RPC(9) 283; Benchairs Ltd v. Chair Centre Ltd., 1974 RPC 429; Harrison v. Taylor, 4 H and N.815; Holdsworth v. McCrea, LR 2 House of Lords 388; The Pilot Pen Co. (India) Private Ltd., Madras v. The Gujarat Industries Private Ltd., Bombay, AIR 1967 Madras 215; The Wimco Ltd. v. Meena Match Industries, Sivakasi and Ors., AIR 1983 Delhi 537; Phillips v. Harbro Rubber Company, 1920 PTC 284; Western Engineering Company v. America Lock Company, Civil Original Appeal No. 7 of 1967; Simmons v. Mathieson & Co. Ltd., 1911 PTC 113; Smithkline Beecham Consumer Healthcare GMBH and Ors. v. G.D. Rathore and Ors., 2002(25) PTC 243 (Del)

Disposition:

Application dismissed

Citing Reference:

Discussed		15
Mentioned		9

Case Note:

(i) Intellectual Property Rights – joinder of parties – Section 22 of Designs Act, 2000 – proper party in case of different importer, manufacturer and distributor – manufacturer of goods Chinese, imported by Indian and distributed by defendant Indian – plaintiff made party to distribution only – suit maintainable.

manupatra (ii) Registration – Section 22 of Designs Act, 2000 – functional component – mere functional component with no appeal to eye cannot be registered as design – design should be capable of being applied to article so that it shows to eye particular shape, configuration, pattern or ornament.

JUDGMENT

Mahmood Ali Khan, J.

1. plaintiff has filed is 6474/03 under Order 39 Rule 1 & 2 CPC for grant of interlocutory order restraining the defendant from manufacturing, selling or offering sale of toothbrushes, a sample of which is attached as annexure 'C' and which is an obvious and fraudulent imitation of, and amounts to infringement of the registered design No. 183197 or any other toothbrush which are a fraudulent or obvious imitation thereof and further restraining the defendant to deliver to the plaintiff all toothbrushes, a sample of which is attached as annexure 'C' to the application including unfinished products etc as well as the moulds used for the manufacture of such toothbrushes, which infringe the plaintiff's registered design bearing No. 183197 and the defendant be called upon to allow inspection of their accounts to assist in ascertaining the amount of damages suffered by the plaintiff by the manufacture and sale of the offending toothbrushes.

2. Briefly, the facts are that the plaintiff filed a suit for permanent injunction for restraining the defendant from manufacturing and selling offending toothbrushes, which infringed the registered design of the plaintiff or which were fraudulent or obvious imitation thereof etc. It was alleged that plaintiff was a company organized under the laws of Germany. It is engaged in a variety of business in the healthcare field, more particularly, in the design and sale of toothbrushes. The suit is filed in respect of design of toothbrushes, which comprises a distinctive aesthetic toothbrush in respect of which the plaintiff had obtained a design registration No. 182197 dated 15.2.2000 in Class 3 in respect of the application of such design to toothbrushes. By virtue of said design registration and Section 48(5) of the Designs Act, 2000, the plaintiff has the copyright in the design for an initial period of 5 years from the date of the registration i.e. till 15.02.2005, which period is extendable by two successive period of 5 years each. The design registered in the name of the plaintiff is valid and subsisting. plaintiff has also obtained corresponding design registrations of this toothbrush model in several parts of the world whose names are mentioned in paras 5 and 6 of the application. Recently, the plaintiff came to know that defendant No. 2 has recently commenced sale of toothbrushes under the brand name "Pepsodent Cushion", which is a fraudulent and obvious imitation of the plaintiff's design registration No. 183197. On the packaging it is disclosed that the toothbrush is manufactured by the first defendant. It is not for the first time that defendant No. 2 has attempted to dishonestly adopt the features of designs of the plaintiff and/or its group companies. plaintiff had also filed Civil Suit No. 2515/96 against defendant No. 2 which is pending but this Court on 26.11.1999 had declined to grant interim relief sought against the first defendant against which an appeal has been filed which is pending before a Division Bench. However, the proceedings for relief for infringement of the registered design could not be perused in that suit owing to the fact of the registration became invalid on account of prior publication of the plaintiff's own design in India. The design in the present suit is new and novel and a substantial modification of the design which formed the subject matter of the earlier suit. It has not been pre-published. The plaintiff, is Therefore, entitled to the injunction in the present matter. Besides, the plaintiff also filed a civil suit for infringement of the copyright in the mould and mould drawings against defendant No. 2 in Suit No. 6556/99 in Mumbai High Court and it also filed a Civil Suit No. 17/99 against M/s United Brushes Private Ltd. The applications for ad interim injunction are pending in both these suits. plaintiff also filed a suit against other parties for passing off and infringement of the copyright in the mould. By a common order dated 16.1.2002 the court had declined to grant relief to the plaintiff in those five Suit Nos.2520/98, 2636/98, 2771/98, 2462/98 and 58/99. But in those suits rights were not claimed for design infringement. In relation to other design registration in the name of the plaintiff and its group companies Suit Nos.2460/99, 1802/00 and 1908/02 were filed by the plaintiff and its group companies against third parties. An ex parte ad interim injunction order has been passed in those suits which are still in operation. The defendants, as such, are well aware of the right of the plaintiff as registered trademark of the design in question. In suit No. 2515/96 defendant No. 2 raised plea of independent creation of the design of toothbrush in the year 1996 which is virtually identical to the toothbrush designed, developed and marketed by the plaintiff all over the world in 1998. It is stated that the plaintiff is prima facie entitled to the grant of ad interim injunction order and balance of convenience is also in favor of the grant of interlocutory injunction order and the plaintiff would suffer irreparable loss and injury if it is declined at this stage. Hence the application.

3. After the notice of the application was served on the two defendants, defendant No. 2 filed its reply resisting the application. Counsel for plaintiff upon instruction from his client stated on 15.7.2003 that "in view of the reply of defendant No. 2 to the application of the plaintiff, plaintiff does not wish to proceed against defendant No. 1 and request that the suit, so far as it is against defendant No. 1, be dismissed as withdrawn". In terms of that statement, the suit was dismissed as withdrawn against defendant No. 1 by the order of the same date. It is now proceeding against defendant No. 2 alone.

4. Defendant No. 2 in its reply raised a number of preliminary objections. It contended that the suit is bad for non-joinder and mis-joinder of the necessary parties. It was pleaded that there was no question of the defendant copying the design of the toothbrush of the plaintiff as it is not the manufacturer of the impugned

manupatna
toothbrush and was merely a marketer. The toothbrush handles without bristles were imported from a manufacturer in China by Seema Impex and these were in turn procured by defendant No. 1 after which the final product came to defendant No. 2 to be marketed. It is accordingly submitted that the Chinese manufacturer has not been impleaded as defendant. Moreover, the importer who had imported the toothbrush handles without bristles from China has also not been made as a party so the suit is bad for non-joinder of the said person as defendant. Defendant No. 2 has merely procured semi finished and/or finished product and bonafidely marketed it so no relief could be claimed against it in the suit for design infringement.

5. Furthermore, there was prior publication of the plaintiff design in the British Dental Journal which is available on the internet at www.bdj.Co.uk so it is in public domain and accessible to all. The prior published design is identical or substantially similar or having the same design feature to the registered design of the plaintiff except for small cosmetic changes and addition of trademarks, sub-brands from time to time as per marketing strategies adopted in various countries. The impugned design is otherwise not worthy of registration as it is hit by prior publication and huge evidence by the presence of other comparable products in the market incorporating one or more of the impugned features of the plaintiff design. The plaintiff's design registration is, Therefore, liable to be cancelled and cannot be enforced in a suit for infringement. It is also contended that the impugned design of the plaintiff incorporating S-bend or flexible neck is clearly functional by its own admission and Therefore, it is not worthy of protection under the Designs Act. No right vest in the plaintiff to claim proprietorship over a functional and commonly known feature of toothbrush which is in the public domain. Besides, the plaintiff's and the defendant's toothbrushes and their underlying designs are on one hand of different and distinguishable shapes, pattern and ornamentation, and on the other hand both are manufactured within the prescribed parameters laid down by the Bureau of Indian Standards. The defendant thereafter gave broad overall differences between the plaintiff's toothbrush in a tabular form. According to defendant No. 2 toothbrushes were always sold in the market in packaging and not loose as the plaintiff seems to have suggested and the packaging of both is entirely dis-similar so no case was made out against the defendant for an infringement of the plaintiff registered design and no action for it would lie. The plaintiff being not the manufacturer of the mould or the creator of the underline drawings and is merely procuring the impugned toothbrushes in their semi-finished and/or finished, bristled form and marketing them bonafidely motive could be attributable to the defendant. The allegation of the plaintiff to the contrary are false. Giving the nature and purpose of an object such a toothbrush the basic features of the same are common to the trade on account of their specific utility thereof having limited scope. The size of a handle is essentially determined by the size of a human hand and the nature of its grip as a result there is a little scope for striking changes to be made in the handle by any manufacturer of a toothbrush. Features such as curved handle as well as rubber-grip such as that found in the plaintiff's and the defendant's toothbrush is common to the trade and several third party brushes also have similar features. According to the plaintiff's own admission the plaintiff is neither manufacturing nor selling the impugned toothbrushes of the impugned design in India. On the contrary toothbrushes under the trademark Pepsodent are well known to the consumers in India and have acquired valuable goodwill. plaintiff is also guilty of delay and laches in filing the present suit as the defendant's product had been in market for over seven months. It was alleged that the defendant had almost exhausted its stock of toothbrushes that were procured from defendant No. 1 who in turn procured these from an importer who had imported them from a Chinese manufacturer via a dealer based in Hong Kong. The defendant was thus not even in possession of either the moulds or the finished toothbrushes which constitute the subject matter of the present suit. No fresh orders have been placed for the same for the time being. Hence, the suit is completely without merit and baseless in law and is not maintainable. Defendant has bonafidely purchased the toothbrushes for marketing purpose. plaintiff is guilty of misrepresentation as the toothbrush in respect of which design registration No. 183197 has been granted is different from the photograph of the actual toothbrush sample annexed by them annexure 'B', in respect of features such as the dual flexible bands on the head of the brush, which is present in the actual sample and absent in the diagram in annexure 'A'. plaintiff's design is neither new nor novel. It is also hit by prior publication and known to the consumers. Earlier suit filed by the plaintiff against defendant No. 2 was not perused. plaintiff is guilty of mis-statement and mis-representation since it was relying on matters which are sub judice before the Courts and in which it had failed to get favorable orders. There has been no fraudulent or obvious imitation of the plaintiff's toothbrush design by the defendant. The defendant has not infringed the design of the toothbrush of the plaintiff and also does not presently have any stock of the impugned toothbrushes.

6. In the rejoinder to the application, plaintiff reiterated its own case and denied the allegations made by defendant No. 2 in its reply. It was alleged that the name of Chinese manufacturer has not been disclosed and the plaintiff reserves right to initiate proceedings against that manufacturer also. By importing the toothbrush handles, which is fraudulent and obvious imitation of the plaintiff's design and marketing it, the defendant is independently guilty of piracy of the registered design of the plaintiff. The Chinese manufacturer is not a necessary party to the present proceedings. It also appears that importation of the Chinese handles were made at the instance of the defendant which purchased the finished offending product and have made them available to the public. plaintiff also reserves its right to initiate proceedings against the importer as well. According to defendant No. 2 the differences pointed out by the defendant in the table given in the reply were merely cosmetic and they did not change the essential characteristic of the defendant's design which is obvious and fraudulent imitation of the plaintiff design. plaintiff made its own comments on the differences in the two design stated by the defendant also in a tabular form. It was denied that the toothbrushes were always sold in the market in packages and not loose. plaintiff had no objection to the defendant's selling its toothbrush Pepsodent so long as the product did not violate the intellectual property right of the plaintiff. Other

7. I have heard counsel for the parties and have gone through the documents and the case law submitted in support of their respective cases of the parties.

8. The plaintiff is a German company having worldwide reputation in the healthcare field. It is engaged in variety of business including manufacture and sale of toothbrushes. It has not launched its product in India but has claimed to have the design of the toothbrush bearing registration No. 183197 registered here. It also had design registration of toothbrushes model in several other countries. The defendant, conversely, is engaged in the business of sale of toothbrushes under the brand name Pepsodent Cushion. It is not manufacturing it. Averment made in the written statement disclosed that toothbrush handle part used in the toothbrushes sold under its brand name are manufactured in China. These are imported into India by Seema Impex. The bristles are fixed in the head by M/s Amigo Brushes Pvt Ltd (which was defendant No. 1 and has since been deleted). Brushes then packaged and sold by the defendant under its house mark.

9. Mainly brushes have two main components. First is the plastic handle which itself has three sub-components and the second is the bristles. The three sub-components of the handles are (1) the head; (2) the neck; and (3) the handle grip. The bristles formed part of the head and has already been disclaimed in the design registration certificate of the plaintiff. The neck consisting of S-bend had gone into public domain by virtue of two prior registration of the plaintiff with the same feature having been rectified by an order of Kolkata High Court. The third component is the handle grip. In the instant case the plaintiff does not claim proprietary right and exclusivity in the design of the bristles and the neck including the S-bend and a band just below the head. The entire controversy centers around the design of the handle grip part used for gripping the toothbrush while in use by the hand and fingers. For the present controversy it may be called the handle. The plaintiff claims that the design of its handle is novel and original and has been registered under its design registration No. 183197 which the Hindustan Lever Limited (which was defendant No. 2 and after the deletion of defendant No. 1, may be described as the defendant) by adopting an obvious imitation of its design in its own toothbrush has infringed the plaintiff's property right for the design registered in its name.

10. The foremost objection raised on behalf of the defendant is that the suit is bad for non-joinder and mis-joinder of necessary parties. It is alleged that the Chinese manufacturer and the importer Seema Impex which imported it from China were necessary parties to the present suit and their non-joinder has rendered the suit bad in law. Second limb of the argument of the defendant in this regard is that the suit is also bad for the joinder of the defendant since the defendant is not the manufacturer or importer of the toothbrushes but it is only buying it after it is imported and bristled and it is only marketing it under its own house mark.

11. Sub-section(1) of Section 22 of the Act was enacted to eliminate the violation of the copyright in any design, in other words, the piracy of registered design. It is as under:-

"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 purpose 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."

12. Clause (a) reproduced above, discloses that it would not be lawful for any person to apply or cause to be applied to any article or any class of article in which the design is registered, the design or any fraudulent or obvious imitation thereof for the purpose of sale without the license or written consent of registered proprietor of the said design. It also prohibits doing anything with a view to enable the design to be so applied. In other words if a person places orders to the manufacturer or an importer of goods which is obvious imitation or similar in the design which is registered in the name of another person for the purpose of sale of the said goods under its own brand, it would clearly be covered by clause(a). Moreover, the action of such a person would also fall under clause (c) and would be not lawful if a person consciously infringed registered design or any fraudulent or obvious imitation thereof or apply to any article in that class of article in which the design is registered by adopting fraudulent or obvious imitation thereof without the consent of the registered proprietor of that design. It would also be unlawful for such a person to publish or expose for sale of the pirated version of that registered design. Defendant, indeed, has denied the knowledge and seeks refuge behind the provision of clause (c) aforesaid. But it is difficult to digest its contention. The defendant is a multinational company. It is difficult to believe that the products of its multinational competitor would escape its notice

manupatra although the same was being marketed in other countries where the defendant had also been selling similar products like toothbrushes. Moreover, the company like defendant could not be expected to launch the sale of a product of which it is not registered proprietor of design, without taking precaution of inspecting the registered designs in accordance with Section 17 of the Act. The defendant, Therefore, cannot be allowed to plead ignorance for want of knowledge to the registered design of the plaintiff in toothbrush. Sale of a toothbrush by the defendant, if it is obvious or fraudulent imitation of the registered design of the plaintiff, would violate clause (a) and (b) of Section 22 and would amount to piracy. The defendant is alleged to be a pirate of the registered design of the toothbrush of the plaintiff. A suit tried against it without impleading the manufacturer and the importer would not be bad in law. The suit could not be held to be bad for non-joinder of the Chinese manufacturer and Indian importer and for mis-joinder of the defendant. Suit is maintainable against the defendant. The preliminary objection of the defendant has no merit.

13. The crucial question is whether the defendant has infringed the plaintiff's registered design in toothbrushes. The plaintiff's toothbrush design bears design registration No. 183197. A copy of the registration certificate is annexure 'A' to the plaint. The date of the registration of design is 15.2.2000. The design is registered in class-3 in respect of the application of such design to toothbrushes. Illustration of the design registered under registration No. 183197 are given on 2 and 3 page of this document. The fourth page of the certificate states "novelty resides in the shape, configuration, pattern and ornamentation of the toothbrush, as illustrated". There is dis-claimer to the novelty in exclusive use of the bristles which are marked -A in the illustration given on 2nd page and the design is also restricted to any particular shape configuration and arrangement of the bristles as given in the illustration. There is further dis-claimer that the registration will not apply to any mechanical or other action of the mechanism whatsoever or in respect of any mode or principle of construction of the article. During the hearing, both the parties have produced several documents including the photographs of the plaintiff's, the defendant's products and the photographs of the toothbrushes marketed by other business houses of repute. Though the defendant has tried to find a few dissimilarities between the handle of the toothbrush sold by it and the handle of the toothbrushes which is manufactured by the plaintiff but on a glance at the two articles a not so discerning and not so vigilant consumer would not find much difference in the width of the handle. The toothbrush of the plaintiff and the defendant viewed as a whole by placing them side by side would not look alike by a wary and discerning customer or consumer. Same is with the package in which the toothbrushes are sold. They are different even on a cursory look on them. Similarly, the handle of the toothbrushes marketed by some other business houses, photographs of which have been filed or samples of which have been produced during the argument, could be identified as different from the get up of their packages and a slight variation in the width of the handle.

14. The arguments of counsel for defendant are five fold. Firstly, the plaintiff's design registration No. 183197 is not worthy of protection; (2) the defendant has not committed infringement of the plaintiff's registered design; (3) the plaintiff has suppressed material facts, Therefore, has disentitled itself a discretionary relief of an interlocutory injunction order; (4) the ad interim injunction should not be granted in case the validity of the design registration is disputed and (5) the balance of convenience for the purpose of interlocutory injunction has not been established by the plaintiff.

15. Argument of counsel for defendant is that the design of the toothbrush registered in the name of the plaintiff is liable to be cancelled on account of lack of novelty and its prior publication in terms of Section 19 of the Design Act, 2000. Furthermore, the defendant have already filed appropriate petitions for cancellation of the registration in this court and in the High Court of Kolkota which are pending. Moreover, it is contended, the product which is the subject matter of the plaintiff design registration in effect pertain to a part of article being the handle of a toothbrush, Therefore, does not qualify as an article under Section 2(a) of the Act on the ground (i) the features of bristles are disclaimed in the design registration certificate which is annexure-A to the plaint; (ii) the S-bend in the neck region of the brush being withdrawn in response to the cancellation petition filed by the defendant in AID No. 15 and 16/1996 in Kolkota High Court in accordance with order dated 29.7.2003 and (iii) what is left is the handle grip which is a non-detachable part of an article and not a finished article. It is argued that clause (a) of Section 2 of the Act defined an article to mean "any article of manufacturer and any substance, artificial or partly artificial and partly natural, and includes any part of an article capable of being made and sold separately". It is argued that hand cannot be made and sold separately, toothbrushes being made out of a single mould with only the bristling being a separate process. So, the plaintiff's toothbrush handle is not the subject matter of a valid design registration. Counsel further argued that even if it is assumed that handle fulfilled the definition of "article" the plaintiff's toothbrush would still be incapable of design registration as it is a mere mechanical device and is, Therefore, banned from registration under sub-section(d) of Section 2 of the Act. It is submitted that the plaintiff itself advertised the functionality of its toothbrush handle by stating on the packaging "ergonomically shaped handle for total control of your cleaning". The word "ergonomically" is defined in the Chamber Dictionary as "the physiological differentiation of functions". Counsel also stated that on the packaging of the toothbrush defendant nowhere mentioned that it holds a design registration for the product thereby leaving it to imagination that the design rights are claimed therein. Referring to the judgment in AMP Incorporated v. Utilux Proprietary Limited 1972 RPC 103 it was argued that the principles regarding unpredictability of the functional shape have been extensively enunciated in this landmark case. Further the functional design were also held to be unprotectable in Stenor Ltd. v. Whitesides (Clitheroe) Ltd. (1946) 63 RPC 81. According to him the conclusive proof as to the functionality of an object is the fact that it is advertised to be so by its manufacturer as in the present case

manupatra and submitted that this principle has been stressed in Fisher Stoves, Inc. v. All Nighter Stove Works, Inc. 206 USPQ 961. Applying this logic, the defendants were held to be not guilty of the design as the plaintiff's design was a functional one since "plaintiff's advertisement emphasised the functional nature of (the) features".

16. The defendant also argued that essential features of the plaintiff's toothbrush were prior published by the plaintiff itself in the British Dental Journal in its issues for the month of January, 1998 and November, 1999. Under Section 19(b) of the Act prior publication constituted a clear bar for design registration. It is also contended on behalf of the defendant that the features of the plaintiff toothbrush lack novelty as on the date of registration after 15.2.2000 and for this reason there was a statutory bar on its registration on account of Section 4(a) of the Act. He relied upon the judgment in Hello Mineral Water Pvt. Ltd. v. Thermoking California Pure 2000 PTC 177. He also referred to Dover Ltd. v. Nurnberger Celluloidwaren Fabrik Gebruder Wolff 1910 (suppl RPC 498 where it was held that the plaintiff's registered design for a pattern or ornament of hand-grip for cycle handgrips was not new or original within the meaning of the Design Act and, Therefore, the defendants were not guilty of the infringement. The plaintiff's handle, it is emphasised, is a trade variation incapable of being design protected and a few similarities of lines and angles between the competing products do not create design right or establish infringement. In this case reliance was placed on M/s B.Chawla & Sons v. M/s Bright Auto Industries MANU/DE/0336/1980 : AIR1981Delhi95 . Counsel for defendant also drew attention to the visible and broad overall differences dealienated by the defendant in its reply to the interlocutory injunction application para-5. In the comparative chart it was mentioned that the plaintiff's toothbrush had two bends in the head in order to provide flexibility which were not there in the defendant's toothbrush. The head in the plaintiff's brush was carved inward from the upper flexible band whereas in the defendant's toothbrush the head was flat and of a narrow triangular shape. plaintiff's handle was thick of a diameter of 20.9 mm. Handle of the defendant's toothbrush was of the diameter of 15.5 mm. There were cluster of pimples on the plastic part of the handles of toothbrush of the plaintiff which were missing in the handle of the toothbrush of the defendant and further there were two clusters of pimples on the top and bottom on the rubber part of the handle on the bottom side of the brush of the plaintiff which was missing in the toothbrush of the defendant. plaintiff's toothbrush had a curvaceous shape from the top and the bottom culminating in a tapering at the tail but there was curvaceous shape only from the top with a streamlined flat bottom tapering upward slightly in the tail in the defendant's toothbrush. There were 41 tuft holes for insertion of bristles in the plaintiff's toothbrush as compared to 38 such tuft holes in the defendant's toothbrush. There is also difference in the arrangement of the toughed holes and the arrangement of bristles in the two brushes. It is, Therefore, strenuously argued that the plaintiff's design registration is not only invalid of protection but there is in fact no infringement of the patent and design of the toothbrush of the plaintiff by the defendant.

17. In reply to the aforesaid submissions counsel for plaintiff has argued that the defendant in the pleadings has not categorically denied plaintiff's allegation in para-9 of the interlocutory injunction application that the design in question was new and novel. He submitted that the substantial modification of the design which form the subject matter of Suit No. 2515/96 has been carried out and there is no specific denial to that effect in the reply of the defendant. Defendant, on the other hand, has admitted this fact by reiterating that Suit No. 2515/96 did not have any bearing upon the subject matter of the present suit and further that the impugned design is neither manufactured, sold or otherwise known to consumers in India. Two designs which form the subject matter of Suit No. 2515/96 were the same or similar to the disputed design such an averment could not have been made by the defendant. It is accordingly submitted that the defendant has admitted the newness and novelty of the plaintiff's toothbrush. Counsel also referred to the chart showing progression of five of its toothbrush models and submitted that other than the first two brushes models which have been marked I and marked II the plaintiff continues to enjoy design registration for the remaining three models which are marked III, IV and V. The design mark V is the subject matter of the present suit. According to him each of these five brushes involved have sufficient innovative steps to be designed and reference has been made to the judgment in Terrell on Patents and A. Fulton Co. Ltd. v. Grant Barnett Co. Ltd. 2001 RPC (16)257. It is vehemently argued that substantial changes have been made in the handle of the toothbrush of the plaintiff which imbues a fresh design to the entire brush, even though some of the features in the brush are common to previously registered designs and reference is made to the judgment in Walker & Co. v. A.G.Scott & Co. 1892 RPC 482 in support. Counsel also submitted that for protecting the design registration, it is not necessary that all the features of the design should be new and novel and that a new arrangement of well known parts also constituted a new design. He referred to the judgment in Sherwood & Cotton v. Decorative Art Tile Co. 1887 (4) RPC 207 in this regard. As regards the argument of the defendant that the design in question is merely functional and the thickening of the handle was a mere functional for a better grip it was submitted that a design registration was possible even in respect of the functional articles. According to him, virtually all articles in respect of which design can be obtained have a function to perform and referred to Schedule 3 of the Designs Rules, 2001 in this regard where various classes of goods for which design can be registered have been set out. Section 2(b) of the Act, it is argued, is not bar to the registration of a design which is of functional articles. Some articles can have certain functional features and certain features which are design registrable that appeal to the eye. It is submitted that functional aspect forms subject matter of a patent and the aspect which appeals to the eye is registrable as a design. Attention was invited to the judgment in Amp Incorporated v. Utilux Proprietary Ltd. (supra). It is argued that the principle of law laid down in the cited judgments support the case of the plaintiff rather than the argument of the defendant who has cited them. Counsel also argued that both the design patent and a utility patent cover different aspects of the same article as per commentary of MaCarthy on Trademarks, which has been referred to by the defendant.

manupatra This court has observed that s-bend feature of the plaintiff toothbrush also had an aesthetically appeal in a case reported as SmithKline Beecham v. Hindustan Lever Ltd. 1999 PTC 775. It has been held by the court that there could be an aesthetic feature with the zig-zag bend which seeks to give an aesthetic view to the user. On the same proposition in Hecla Foundry Co v. Wlaker, Hunter & Co 1889 RPC 554 court has observed that for registration of a design, it was immaterial whether a design is useful or devoid of any utility. Drawing attention to the comparative table given by the defendant in its reply with the design at page 43 annexure-F to the reply, the counsel argued that the only difference between the two design is one is thicker than the other and both are registered as designs. The defendant themselves having obtained a separate design registration for a thicker handle cannot turn about and claim that adding thickness to the handle is not a registrable design. It is submitted that the defendant has filed illustration of six additional brushes with thick handles having an entirely different eye appeal. Counsel also submitted that a perusal of the differences in the two toothbrushes pointed out by the defendant showed that the defendant's toothbrush is a fraudulent or obvious imitation of the toothbrush of the plaintiff. He relied upon the judgment in Castrol India Ltd. v. Tide Water Oil Co. Ltd. 1996 PTC 202. It was argued that the test of imitation has been succinctly stated in J.Harper & Co. Ltd. v. The Wright & Butler Lays Manufacturing Co. 1895 RPC 483 and Lacey v. Foggins 56 IPR 436.

18. Counsel for plaintiff further argued that the defendant was claiming registration of the design registration No. 175426 dated 2.1.1998 which is annexure 'F' to the defendant's reply. A bare look would disclose that the said registration is in respect of an absolutely different design. It would be clear from it that thicker handle could be made with a shape and visual appeal which is entirely different from the plaintiff's design. In this regard reference was made to the design registration No. 175426 dated 2.1.1998. Counsel also pointed out to para-5 of the rejoinder filed by the plaintiff to the reply of the defendant that visual look was virtually identical. Same was in respect of the pimples on the plastic and rubber part of the handle as and has pointed that bristles tucked holes, upper band were subject of the impugned design. Though the infringement of the thickness of the handle of the two toothbrushes were denied but it was asserted noticed in the comparative chart of the defendant. It was argued that the defendant had infringed the statutory right of the plaintiff by obviously and fraudulently imitating the registered design of the toothbrush of the plaintiff, as such, a prima facie case existed in favor of the plaintiff. Counsel for plaintiff also argued that the defendant in its reply repeatedly submitted that it was not manufacturing the offending and they are bristled by the deleted defendant No. 1 company and they toothbrushes handles but they were being imported from China by Seema Impex ere only marketed by the defendant under its own brand name and further that it exhausted the stock of brushes and has no proposal to buy them for marketing the offending brushes. It is argued that the balance of convenience is also in granting the interlocutory injunction and the plaintiff may suffer irreparable loss and injury if it is declined at this stage. He accordingly prayed for grant of relief demanded.

19. Even at the risk of repetition it may be reiterated here that the plaintiff's case for infringement is not in respect of the design of whole of the toothbrush but only part of the handle which is used for grip by hand and fingers while brushing the tooth. Two main contentions are raised by the defendant. Firstly that it is not an article within the meaning of clause (a) of Section 2 of the Act and secondly, that the handle part is also purely functional so not a design as defined by clause (d) of Section 2 of the Act so unregistrable under the Act. Before proceeding further it will be apt to reproduce the definition of "article" and the "design" given under Section 2 of the Act:-

"(a) article" means any article of manufacture and any substance, artificial, or partly artificial and partly natural; and includes any part of an article capable of being made and sold separately.

"(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 of combined, which is in substance a mere mechanical device, and does not include any trade mark as defined in clause(v) of sub-section(1) of section 2 of the Trade and Merchandise Marks Act, 1958 (43 of 1958) or property mark as defined in section 479 of the Indian Penal Code (45 of 1860) or any artistic work as defined in clause(c) of section 2 of the Copyright Act, 1957 (14 of 1957).

Emphasis has been laid on behalf of the defendant to "and includes any part of an article capable of being made and sold separately" in clause (a) reproduced above. Whether handle i.e. the part which is meant for the grip by hand is capable of being made and sold separately? Answer has not been given by counsel for plaintiff to this query. There may be article part of which is capable of being made and sold separately. But can the handle of the toothbrush could be detached from other components of the toothbrush and sold out separately. The answer is in emphatic negative. So the handle (grip) is not an article as defined by Section 2(a) of the Act.

20. The second contention of the defendant is that the plaintiff itself advertised the functionality of its toothbrush handle by stating on the packaging "ergonomically shaped handle for total control of your cleaning". It is submitted that the word "ergonomics" has been defined in the Chambers Dictionary as "the physiological difference of functions." As per the definition of design in Section 2(d) of the Act a mere functional component with no appeal to the eye cannot be registered as a design. In the instant case the

thickness of the handle has been adopted only because of functional requirement. A thicker handle gives a better grip in hand when brush is in use. It is purely performing a function. Definition of the design would disclose that mere mechanical device would not be a design. The same, however, could not be said definitely about the functional part since a functional part of an article, depending upon the nature of the function it performs, may be a design which is registrable under the Act. The design in terms of clause (d) of Section 2 means only the feature 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 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". The design should be capable of being applied to an article in such a way that the article to which it had been applied will show to the eye a particular shape, configuration, pattern or ornament.

21. In *Stenor Ltd. v. Whitesides (Clitheroe) Ltd.* (supra) plaintiff was proprietor of a design registration in respect of fuses. He filed a suit for infringement of the said design. The defendant denied the infringement and pleaded that if it had infringed, the infringement was without knowledge of the plaintiff's registration and further the defendant also challenged the validity of the design and counter claim for rectification of the Registrar of design on the ground that the design was neither new or neither original and was a mechanical devise so not a design within the meaning of the relevant Act. It was held that neither the design was new nor original and the fuse in question was merely a small metal rod performing a mechanical function to which had been applied features long known and used by mechanics and engineers in relation to such articles as bicycle crank axles and rollers in rolling mills; the defendant had acted without knowledge of the plaintiff's rights. That the article was so small that the naked eye could not discern with certainty what were the features thereof. The appeal was dismissed and it was held that design was in substance a mere mechanical device, every feature of which was dictated by the functions which the fuse had to perform. It was, Therefore, not a proper subject for registration.

22. In *AMP Incorporated v. Utilux Proprietary Ltd.* (supra) in a plaintiff's action for infringement of its registered design relating to a single electric terminal and to a number of terminals joined together in line, it was held that the plaintiff had admitted that the function was the sole cause or reason which led the author of the design to choose the shape he did, but they contended that the terminals could have been of a different shape without affecting their function. The trial Judge held that both designs were invalid as lacking novelty or originality and on the ground that alleged novel or original features were dictated solely by the function which the article in question had to perform. The Court of Appeal allowed the appeal and reversed the finding holding that the statutory objection to validity that features of a design were dictated solely by the function which the article had to perform was only made out when the article's function for successful performance required that the article be made in that shape and in no other, and that that was not so in the present case. On appeal by the defendants to the House of Lords the appeal turned mainly on the questions whether the features of the design were dictated solely by function and of whether the designs appealed to and were judged solely by the eye and the House of Lords allowing the appeal further held that the features of the designs were dictated solely by function and that the designs were invalid. Lord Morris observed that the features of shape of terminals in the present case were neither the purpose nor the result of making an appeal to the eye, the features of shape were adopted only because of functional requirements. Lords Reid and Donovan observed that no doubt in the great majority of cases in which the Act would afford protection the designer would have had visual appeal in mind when composing his design but it could well be that a designer who only thought of practical efficiency had in fact produced a design which did appeal to the eye. He would not be denied protection because that was not his object when he composed the design. The majority of the judgment is that the design had no feature of shape or configuration which appealed to the eye.

23. In *Philips Electronics by v. Remington Consumer Products* 1998 (9) RPC 283 the plaintiff had been selling three headed rotary shavers in which the three heads were arranged in an equilateral triangle and projected slightly above a triangular face plate, itself an equilateral triangle with rounded corners under the trademarks "Philishave" for many years. The defendant started manufacturing and marketing a three headed rotary shaver under its "Remington" mark. The plaintiff had got its trademark registered for protection of a device of a depiction of its three headed shaver in respect of the electric shaver and design protection for a version of its three headed rotary shaver. It claimed that the defendant's product had infringed both its registered design and registered trademark. The defendant in reply alleged that the plaintiff's trademark was invalid on the ground that it was not a sign capable of distinguishing goods of one undertaking from those of another, it was devoid of distinctive character, it consisted exclusively of a sign or indication which served to designate in trade, the kind, or intended purpose of the goods and it consisted exclusively of the shape which resulted from the nature of the goods themselves or the shape which was necessary to achieve a technical result or the shape which gave substantial value to the goods and that the mark was registered contrary to public policy. It was held that the trademark was invalid and has not been infringed and that the registered design was valid but was not infringed. It was held that plaintiff's sign trademark denoted function and it could never denote shavers made only by the plaintiff because its primary message was "here is a three headed rotary shaver". It was not capable of distinguishing the plaintiff's goods and that capability of distinguishing was a fundamental requirement of the sort of sign which could be registered. It was further held that a sign which could never fully do that was not to be regarded as capable of distinguishing. It was further held that primarily the shape was recognized as having an engineering function and for that reason added substantial value to the product. Referring to the judgment in *Benchairs Ltd v. Chair Centre Ltd* 1974 RPC 429 where it

manupatra was observed that the task was to look at the two chairs to observe their similarities and differences to see them together and separately and to bear in mind that in the end the question whether or not the design of the defendant's chair is substantially different from that of the plaintiff is to be answered by consideration of the respective designs as a whole and apparently, it should be viewed as through the eyes of a consumer or customer and further that in addition to attempting a detailed analysis of similarities and differences, the designs of the two chairs have been repeatedly seen separately, together and each as a whole. In result, it was held that the two designs were distinct and was not a case of the infringement of the design of the plaintiff.

24. Applying the principles of law laid down in the above mentioned case to the facts in hand there is no escape from holding that the handle (grip) of the toothbrush detached from its other components is incapable of being registered as a design.

25. Next question arises whether there is newness and novelty in the infringed design. To be novel it need not be new also. A new arrangement of old components or combination of colour, a new pattern or ornament or shape which may result in novelty of design which may appeal to eye.

26. In *Dover Ld. v. Nurnberger Celluloidwaren Fabrik Gebruder Wolff* (supra) the plaintiff was the registered proprietors of a design in Class 3 for pattern or ornament of hand grip for cycle handles, brought an action for infringement against a German firm of manufacturers and against their London agents. The defendant making and selling cycle handles with a design resembling the plaintiff's registered design but pleaded that the plaintiff's registered design was not a new or original design nor previously published in the United Kingdom and alleged that it was commonly known for many years prior to the date of registration. The trial court granted an injunction but in appeal it was held that the design was not new or original within the meaning of the Patents and the Design Act 1907 and that the defendant has not infringed the design and that a design which is not new but is original may be registered. The word "original" contemplated that the person had originated something that by the exercise of intellectual activity he has started an idea which had not occurred to anyone before, that a particular pattern or shape or ornament maybe rendered applicable to the particular article to which he suggests that it shall be applied. It was further observed that the words "new or original" involve the idea of novelty either in the pattern, shape or ornament itself or in the way in which an old pattern, shape, or ornament is to be applied to some special subject matter. There must be the exercise of intellectual activity so as to originate, that is to say, suggest for the first time, something which had not occurred to anyone before as to applying, by some manual, mechanical, or Chemical means, some pattern, shape, or ornament to some special subject matter to which it had not been applied before. The Court interpreted the word "original" as referring to a design which no previous designer had created for any purpose and "new" as referring to a design which was not in this sense original, but was newly and for the first time applied to the particular kind of article with reference, not to the classification in the third schedule of the Designs Rules 1908 but to the kind of article having regard to its general character and use. Referring to the view expressed in *Clarke's Design* (LR 1896) where the meaning of the word new was illustrated as "a design may be new for a coal-scuttle but not for a bonnet". The Court further observed that the novelty or originality of the plaintiffs' design is alleged to lie in the pattern or ornament. Referring to *Harrison v. Taylor* (4 H and N.815) it was observed that in that case there was a novel combination by the designer, in a cloth fabric, of two old patterns—a large and a small honeycomb and it was held that it could not be asserted that there was any new combination in that which the present plaintiffs have registered. In the judgment *Holdsworth v. McCrea* (LR 2 House of Lords 388) was referred by Lord Westbury pointing on the appeal as to the eye and the eye alone is the judge of the identity "of the two things".

27. In *M/s B.Chawla & Sons v. M/s Bright Auto Industries* (supra) in an action for Patent and Design Act, 1911 in respect of a mirror claimed to be a new and or original design it was held that addition in the shape of a mirror which were available in the market did not constitute a mirror new or original in design. It was observed that addition of a curve here or there in a shape which is well recognized shape of an article of common use in the market cannot make it an article new or original in design. It was further observed that where the rear view mirrors available in market were rectangular in shape with rounded edges; width sides curved or sloping and the appellant who had registered his design of mirror under the Act by adding a further curve in such shape claimed his design as a new and original; without endorsing the extent and nature of novelty in design; on application for cancellation of registration by respondent it was held that the design made by the appellant was devoid of newness and equally devoid of originality.

28. In *Hello Mineral Water Pvt. Ltd. v. Thermoking California Pure* 2000 PTC 177 it was held that mere novelty of form or shape is insufficient. Novelty involves the presence of some element or new position of an old element in combination, different from anything found in any prior structure.

29. In *The Pilot Pen Co. (India) Private Ltd, Madras v. The Gujarat Industries Private Ltd, Bombay* MANU/TN/0254/1967 : AIR1967Mad215 a suit for injunction was filed restraining the defendants from using type of clips of fountain pens imitating plaintiff's design registered under the Act. The registration was in force when the suit was instituted but found to have expired before injunction was granted. The Court held that relief in terms prayed for was not available. It was further held that the registration cannot be deemed to be effective unless design sought to be protected is new and original and not of a pre-existing common type. It was further observed that unless there was something new or original in a design, a person claiming right in such a

manupatra design by reason of its registration may not claim or obtain any protection. Further it was observed that registration could not be deemed effective unless the design or configuration, sought to be protected, is new and original and not of a pre-existing common type. Court also noted that the tops with such clips are not sold separately and when fixed to the barrel, there are other distinguishing features in both the pens, Therefore, the court did not even find merit in the case of the plaintiff.

30. In *The Wimco Ltd. v. M/s Meena Match Industries, Sivakasi and others* MANU/DE/0255/1983 : AIR1983Delhi537 it was observed that the design may be applied to any kind of article but some novelty or originality must exist in a substantial degree otherwise it would paralyse the industry to make the design a trap for honest tradeRs.

31. In *Phillips v. Harbro Rubber Company* 1920 PTC 284, the plaintiff had obtained registration for a design in respect of a pad in the shape of the heel of a boot or shoe, having a plain central depression that might be filled in with leather or other substance and ornamented on the surrounding portion with cross lines and being thicker at the back than at the front. The defendant had sold rubber heels of the same form as the registered design except that the ornamentation of the portion surrounding the depression was different from that in the design and that the variation in thickness was absent. The defendant pleaded that if the parts of the design were important elements of novelty, the defendants' rubber heels had not those details, and there was no infringement, or, if the parts were not important, the design differed so little from the prior forms of heels that it was not new or original. It was held that a design cannot be rendered new or original merely by a change of the mode of construction of an article; that the fact that registered designs are kept secret makes it necessary for the court to take special care that no design shall be considered new or original unless it is distinguished from what has previously existed by something different from ordinary trade variants; that there was no evidence as to the novelty or originality of the greater thickness of the plaintiff's heel at the back than at the front (a feature that was not present in the alleged infringement) although it was evidently regarded by the plaintiffs as an essential feature of their design; that the central recess in that design was old and always intended to be filled with leather or a like substance; and that the object of the registration of the design had been to get control of the manufacture of heels with a central recess, however, it was filled up. The appeal was accordingly dismissed.

32. In *Western Engineering Company v. America Lock Company* in Civil Original Appeal No. 7 of 1967 decided on 6.4.1973 it was held that a new design can be treated as a new or original design, or it can be treated as being merely a trade variant of an already existing design. It was further held that the only change made by the plaintiff was to alter the shape of the cylinder and make a few other changes so it was not a new or original design.

33. In *Simmons v. Mathieson & Co. Ltd.* 1911 PTC 113 the product of the defendant had some resemblance with that of the plaintiff but it also differed as much as from the plaintiff's product and as the plaintiff's differed from any of its predecessors, Therefore, it could be impossible to hold that there was not sufficient novelty in the plaintiff's design to sustain his registration as new and original design.

34. As noticed, the contention raised on behalf of the defendant is that there is no novelty or originality in the design. The certificate of registration of design No. 183197 dated 15.2.2000 is annexure-A to the petition. It is in respect of toothbrush and it has been stipulated "the novelty resides in the shape, configuration, pattern and ornamentation of the "TOOTH BRUSH"" as given in the illustration annexed to the certificate san the bristles. There is further disclaimer that the design is not restricted to the shape, configuration and arrangement of bristles and further in respect of any mechanical or other action of the mechanism whatever or in respect of any mode of or construction of the article. In the instant case, the allegation of the plaintiff is not that the entire design of the toothbrush is being infringed by the defendant by adopting an obvious imitation of the toothbrush. plaintiff is not claiming any property or exclusive right in the design of the head and bristles, the band immediately below the head in the neck and S-bend portion of the handle. Only the portion of the handle which is used for the hand and finger grip while brushing the tooth is the subject matter of this suit. According to the plaintiff the novelty or originality in this portion of the handle is the pattern and configuration of the tail. There are cluster of pimples on the plastic part of the handle and there are also clusters of pimples on the top and bottom respectively on the rubber part of the handle. The handle has a curvaceous shape from the top and the bottom culminating in a tapering at the tail. This according to the plaintiff is the imaginative and intellectual work of its designer which distinguished it from the other toothbrushes available in the market. The sample of the toothbrush of the plaintiff and the defendant have been placed on record. The only perceptible and discerning difference between the shape of the tail part of the handle which is allegedly infringed is the difference in the width. The hand-grip of the toothbrush of the plaintiff is slightly thicker. There are pimples on the plastic part towards the tail end and a few pimples on the plastic part and the top of that grip on the tail and just below the s-bend. But viewed as a whole by placing them side by side they are not identical design of toothbrush. The head is smaller. There is no band at the neck which is below the head and the S-bend is also different. The defendant has also placed on record the photocopies of different toothbrushes sold by other business houses in the market. The grip portion of the toothbrush handle of at least three brushes including, Colgate, Oral-B, and another company which is at Seriall No. 4 from the top are thick with tapering at the end but their thickness is much less than the thickness of the handles of the plaintiff as well as of the defendant. A side by side examination examination of these photographs would also show that all these toothbrushes of which photographs have been filed are totally different in shape and configuration. But if only grip part of the

manupatra
handle is seen, in fact of these brushes may look different even to a not so discerning customer and trader. In fact, the packing of these toothbrushes is so different that no customer when supplied a toothbrush which he does not want to buy will be deceived in believing that he is supplied the toothbrush of a manufacturer which he wanted to buy. Nobody buys the toothbrush only because of the design of the tail and the handle which is gripped in the hand. It is the total design of the toothbrush which may make difference in the buyer's mind while choosing the toothbrush. The packing of the plaintiff's toothbrush and that of the defendant is absolutely different. Making handle (tail part) thick or thin or sharp tapering or slow tapering of end of grip part can by no stretch of reasoning be considered 'new' or 'novel' design. Such are a mere trade variant. Therefore, contention of the plaintiff that the novelty and originality of a toothbrush is only on the thick portion of the handle which comes in the hand's grip to my view has no substance. There cannot be any novelty or originality in the thickness. The originality and novelty in the component of the brush should be such that it brings perceptible change in the pattern, shape and configuration of the entire toothbrush which appeal to the eye because it is all the parts of the toothbrush which together make it different from other similar stuff available in the market. I, Therefore, do not find merit in the contention of the counsel for plaintiff that there is originality or novelty in the design of the grip portion. There cannot be any novelty in just thickening the grip portion or making it thinner.

35. A great deal of emphasis has been laid by counsel for defendant that the plaintiff has suppressed material facts and has concealed about the orders passed in the suits filed in the Calcutta High Court. It was argued that the ex parte interim injunction granted to the plaintiff was vacated in its suit Smithkline Beecham Consumer Healthcare GMBH and ORs. v. G.D.Rathore and Ors MANU/DE/2063/2002 by this Court where the court had held in relation to a earlier suit the facts of which were not disclosed by the plaintiff that it was the duty of the plaintiffs to disclose all such facts and documents for perusal and adjudication by this court and, Therefore, it was deliberate concealment of facts by the plaintiffs and such suppression of material facts was a sufficient ground for vacation of the order of injunction. It is argued that the same rule would be applicable to the present case also as the plaintiff failed to disclose in this suit that s-bend in the design registration had already been expired by order of Kolkota High Court in AID Nos.15 and 16 of 1996 and by incorporating the S-bend features in the present design registration, the plaintiff has attempted to extend the scope of design protection for a feature that already stood cancelled. It is no doubt true that the plaintiff ought to have clearly mentioned in the plaint that it was claiming protection to its design of the tail portion of the handle which is used for hand-grip and that the design registration certificate which was basis of the suit was only valid for the grip portion of the handle of the toothbrush. The ad interim injunction is discretionary relief and the court could not come to the aid of a person who has not come to the court with clean hands, concealed material facts or made mis-statement of material facts for obtaining ad interim injunction order.

36. In Smithkline Beecham Consumer Healthcare GMBH and others v. G.D.Rathore and Others MANU/DE/2063/2002 the infringed article was a toothbrush manufactured by the plaintiff. In a passing off action the court held that the plaintiff had not come to the court with clean hands and had suppressed material facts so was not entitled to the discretionary relief of ad interim injunction. It was further held that there was no pleading that the plaintiff's toothbrush "Aquafresh Flex" had acquired goodwill and reputation in India; shape feature (S bend) was functional in nature and the same would be incapable of any protection; many companies were manufacturing toothbrush having similar dimensions and shapes; previously the plaintiff's suit on the ground of infringement of copyright against two other companies was dismissed; no strong and cogent material was on record in support of the passing off so the ex parte ad interim injunction granted earlier in favor of the plaintiff was vacated.

37. In the instant case, the plaintiff in the plaint had mentioned about the two civil suits which it had filed in Kolkota High Court. It was also mentioned that suit No. 2515/96 which was pending in this court and in which the interlocutory injunction order was declined by this court though it was alleged that an appeal was pending against that order and it was further alleged that the relief for injunction of the registered design could not be perused owing to the fact that the registration had become invalid on account of prior publication of the plaintiff's own design in India. The plaintiff, however, sought to distinguish the designs which were involved in the present suit and the other suits which were being litigated in this court and in other courts. In fact, the plaintiff in the relief clause has prayed "the defendants be restrained by an ad interim ex-parte injunction from manufacturing, selling or offering for sale of toothbrushes, a sample of which are attached as annexure 'C' and which is an obvious and fraudulent imitation of, and amounts to infringement of the registered design No. 183197, or any other toothbrush which are fraudulent or obvious imitation thereof".Annexure-C is the photograph of the toothbrush marketed by the defendant and there is no clarification in the prayer clause or in annexure-C that the relief is only about the infringement of the design of the handle (grip) portion of the toothbrush since the claim over the design of S-bend, band in neck and the shape of head has already been given up in some other legal proceedings and there is no claim of infringement of the design of the bristle portion of the brush. There is considerable force in the contention of the counsel for defendant that the plaintiff has made itself disentitled to the grant of discretionary relief because of suppression of the material facts and further by not claiming the relief only in respect of the grip portion of the handle.

38. The principle of law applicable to the grant of ad interim injunction are now well settled. They are:-

"i) whether the plaintiff has made out a prima facie case meaning thereby that there is a bona fide contention between the parties or a serious question to be tried, (ii) whether the

balance of convenience is in favor of the plaintiff, that is to say whether it would cause greater inconvenience to the plaintiff if the ad interim injunction is not granted than the inconvenience to which the defendant will be subjected if it is granted, and, (iii) whether the plaintiff would suffer irreparable loss and injury if the prayer for grant of temporary injunction is refused. All these three considerations must be conjointly satisfied before the order of ad interim injunction is granted by the court."

39. Prima facie no case is made out for grant of interlocutory injunction in respect of shape, pattern and configuration of the handle. In other words its thickness divorced from rest of the handle of brush. As regards balance of convenience it is contended that the plaintiff does not manufacture or trade the toothbrush allegedly infringed by the defendant in India whereas the defendant is marketing the toothbrush in Indian market for the past over many months. Conversely, argument of counsel for plaintiff is that the defendant has itself admitted that it was not manufacturing the infringed toothbrush in India and that it was buying toothbrush from the importer and was getting bristles fixed in it by the deleted defendant No. 1. It was further contended that the defendant in the written statement further admitted that its stocks of the toothbrushes, allegedly infringed, had exhausted and it has not placed any order for further purchases of such toothbrushes. But as held above, there cannot be design/registration of the handle part only of the toothbrush and further it is also purely functional so cannot be subject matter of registration. The similarity of the toothbrushes of the plaintiff and the defendant cannot be judged simply on looking at the tail of the handle i.e. the grip portion. It is the overall shape, design and configuration which may make the toothbrushes similar or dissimilar. There is no infringement by the defendant, as per the contention of counsel for plaintiff if there is any similarity in the head neck and the S-bend portion of the toothbrush. Indeed the defendant has alleged that it does not have the stock of the toothbrushes and does not intend to sell it since it has not placed orders for supply of these toothbrushes imported from Chinese anymore but if the plaintiff had claimed the proprietary and exclusive right in the shape, pattern and configuration of the entire toothbrush, it could have made a prima facie case for grant of interim injunction as the plaintiff would suffer greater inconvenience had the defendant continued to infringe its design and market the toothbrush, even though, the plaintiff itself was not marketing the toothbrushes in India. But in the present case the defendant has already stopped using the toothbrushes with thick handles which were not exactly imitated but were having a close similarity to the design of the tail portion of the handle of the plaintiff. Therefore, neither there exist any prima facie case in favor of the plaintiff nor is the balance of convenience lie in the grant of ad interim injunction at this stage. The plaintiff even otherwise would not have suffered irreparable loss or injury since it itself was not marketing the toothbrushes with thick handle grip in India.

40. Another contention of the defendant is that the design of the toothbrush of the plaintiff had already been published in the medical journals. Attention is drawn to the news and notes of the British Dental Journal Volume 184/1 on dated 10.1.1998 where the design of a toothbrush of the plaintiff has been printed. However, counsel for plaintiff has drew attention to the photographs of the toothbrushes printed in the journal which according to him are not identical to the design which has been infringed by the defendant. The news report stated "the new brush retains the distinctive flexible neck but adds multi-colored interdental bristles for thorough cleaning and a thick rubber grip for greater control". The grip portion of the handle is thicker but it is certainly not as thicker and of the shape which is alleged to have been infringed by the defendant in this case. Therefore, it cannot be stated that the design which is the subject matter of the suit is the same which was published in the British Dental Journal earlier and a suit cannot be brought about the infringement of that design for this reason alone.

41. For the reasons stated above there is no prima facie case in favor of grant of interlocutory injunction order and balance of convenience is also not in favor of grant of interlocutory injunction order and the plaintiff would also not suffer any loss or injury if the interlocutory injunction order is refused at this stage.

42. Accordingly, the application is dismissed.

43. It is however clarified that none of the observations made in this order shall be construed to be an expression of opinion of this court on any of the question of law and fact involved which will be decided on its own merit after the suit goes onto full trial.