IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
IN ITS COMMERCIAL DIVISION

INTERIM APPLICATION (L) NO. 28407 OF 2024
IN
COMMERCIAL IPR SUIT (L) NO. 28275 OF 2024

1. **Travel Blue Products India Private Limited**]
a company incorporated under the]
Companies Act, 1956 and having its]
registered office at 102, Rama Gulab]
Apartments, Subhash Road, Tejpal Scheme]
Main Road, Vile Parle (East), Mumbai – 400]
057, Maharashtra, India]

2. **Travel Blue Limited**]
a company incorporated]
under the laws of United Kingdom having]
its registered office at Travel Blue Ltd Suite]
13, Building 6 Croxley Park, Watford WD18]
8YH, United Kingdom] **...Applicants**

In the matter of :

1. **Travel Blue Products India Private Limited**
a company incorporated under the Companies Act 1956 having its registered office at 102, Rama Gulab Apartments, Subhash Road, Tejpal Scheme Main Road, Vile Parle (East), Mumbai – 400 057, Maharashtra, India

2. **Travel Blue Limited**
a company incorporated
under the laws of United Kingdom having
its registered office at Travel Blue Ltd Suite 13, Building 6 Croxley Park, Watford WD18 8YH, United Kingdom **...Plaintiffs**

Versus

1. **Miniso Life Style Private Limited**]

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A company incorporated under the provisions of Companies Act 2013, having its registered address at 6th Floor, Unit No. 603-604, Welldone Tech Park, Sohna Road Sector 48, Gurgaon, Gurugram, Haryana, India 122 018
Email : durga.verma@minisoindia.com]

2. **Miniso Hong Kong Limited**]
a company incorporated under the laws of Hong Kong having its address at Unit D, 16/F, One Capital Place, 18 Luard Road, Wan Chai, Hong Kong]
And also at 6th Floor, Unit No. 603-604, Welldone Tech Park, Sohna Road Sector 48, Gurgaon, Gurugram, Haryana, India 122 018.] **...Defendants**

Mr. Hiren Kamod (On VC) a/w Mr. Bhushan Shah, Mr. Abhishek Nair i/by Mansukhlal Hiralal and Co. for Plaintiff

Dr. Abhinav Chandrachud a/w Mr. Darshan Patankar, Mr. Pranit Kulkarni, Mr. Aditya Mehta, Mr. Agneya Gopinath and Mr. Dhruv Chhajed i/by Cyril Amarchand Mangaldas for Defendant/Respondent.

Ms. Charushila Vaidya 2nd Assistant to Court Receiver present.

Coram : Sharmila U. Deshmukh, J.

Reserved on : 24th June, 2025.

Pronounced on : 31st July, 2025.

Judgment :

1. This is an action for piracy of registered design and passing-off. By order dated 24th September, 2024, this Court had granted ad-interim reliefs in terms of prayer clauses (a) to (d). Subsequently, the Defendants entered appearance and filed its Affidavit-in-reply dated

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23rd November, 2024. Though initially it was the Defendant's contention that the ad-interim order ought to be vacated and it was not necessary for filing of a separate application under Order XXXIX, Rule 4 of Code of Civil Procedure, 1908, it was agreed that the Interim Application itself could be taken for final disposal. Accordingly the Interim application was taken up for final hearing and is being disposed of by this order.

2. The Plaintiffs are engaged in the business of marketing and sale of travel accessory products through online and offline modes, which are manufactured by Plaintiff No. 2. The case of the Plaintiffs is that in the year 2015, Plaintiff No. 2 designed an innovative and distinctive "Travel Blue Tranquility Neck Pillow" and obtained registration of the tranquility pillow in India on 9th March, 2016 claiming reciprocity from 19th October, 2015. The certificate of registration was issued on 24th July, 2017 with a reciprocity date of 19th October, 2015 bearing number 281315. The Plaintiff No. 2 applied for extension of copyright in the Plaintiffs' registered design under Section 11 of the Designs Act, 2000 before Controller of Designs which has been extended for five years i.e., till 19th October, 2030. The Plaintiff No. 2 had obtained registrations in Europe, Republic of China, United States of America and Australia apart from India. According to the Plaintiffs, since October, 2015, Plaintiff No. 1 has done substantial business in respect

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of its tranquility pillow and the annual sales figure as of 2024-2025 is Rs. 70,20,507.80 with the sales and promotional expenses at Rs. 25,20,934.77. It is stated that the tranquility pillow was widely accepted on various social media platforms and exhibitions and conferences. The Plaintiff No. 2 claims to be a proprietor/owner of tranquility pillow design bearing design registration no. 281315. It is submitted that appropriate steps were taken by the Plaintiffs in protecting its registered design against the piracy by third parties.

3. In or around August, 2024, the Plaintiffs became aware of the Defendant's impugned travel neck pillow bearing the same distinctive features as the Plaintiff's design in retail stores in Mumbai and that the Defendants had been marketing their neck pillow on various e-commerce websites. It is submitted that the Defendants have not only copied the Plaintiff's identical design but have also copied the exact colours in which the Plaintiff's product was being sold, i.e. gray, blue, purple and pink colors. The tabular comparison is placed as part of the Plaint. In such circumstances, the suit came to be filed for piracy of the registered design and passing-off.

4. By ad-interim order dated 24th September, 2024, this Court came to a *prima facie* view that aesthetic and visual appeal of the rival products is identical and that the impugned product is obvious imitation and a replica and/or near replica of the said Tranquility

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Pillow/Plaintiff's registered design. It further came to a *prima facie* view that dishonesty of the Defendants is also evident as they are selling their goods in the same colors as those of the Plaintiff's goods and by applying the test of piracy of design as laid down in ***Whirlpool of India Ltd. vs. Videocon Industries Limited***[1] granted ad-interim relief.

5. The defence is that the Plaintiffs have knowingly made false statement by concealing that the Plaintiff's design relates specifically to "Neck Pillow with Pocket" and it is inclusion of protruding and extending pocket which added distinctive visual appeal. There existed pillow designs with identical visual appeal prior to the Plaintiff's design and by reason of inclusion of protruding and extending pocket adding distinctive visual appeal to the neck pillow which was not found in the other neck pillows available at that time and based on which the Plaintiffs have registered a design despite the existence of prior design. It is stated that the Defendants are international product retailers and are operating under MINISO brand and trade mark and have established a global reputation for themselves through online market as well as offline sources. It is submitted that the impugned product bears no similarity to registered design and this design has been developed by the Defendants considering the consumer's preferences, needs and satisfaction. There are material differences of

1 2014 SCC OnLine Bom 565.

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contours, length, placement and style of clasps etc between the registered product and impugned product. The features of the Plaintiff's product such as foldable pillow, easy storage and transportation, pouch, high density memory foam are functional features. It is stated that the shape and configuration particularly, contours to the overall design and visual appeal of the Defendant's impugned neck pillow when judged solely by eye is demonstrable different from both the registered design as well as the Plaintiff's tranquility pillow.

6. It is submitted that in the absence of tenable case of the piracy of registered design No. 281315 by the Defendant, there is no case of passing-off made out by the Plaintiffs. It is stated that the Plaintiff's registered design is liable to be cancelled as it is not a new or original design and as the Plaintiffs have admitted that the "extending/protruding pocket" in the registered design is functional feature, the Plaintiff cannot fall back of the visual appeal of the design which is result of the pocket.

SUBMISSIONS :

7. Mr. Kamod, learned counsel appearing for Plaintiffs submits that once the design is registered, there is presumption of validity under Section 10(4) of Designs Act, 2000 which cannot be displaced by bare allegations or generalised assertions of functionality. He submits that

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the Defendant has not pleaded the case or produced a single document to establish that the Plaintiff's design is functional. He submits that if a design is a result of artistic or aesthetic consideration even if it incidentally confers some functional advantage, it is neither excluded from registration nor vulnerable to cancellation on that ground alone. He points out paragraph 13, 14, 19 and 22 of the Plaint to demonstrate that the tranquillity pillow has been designed by Plaintiff No 2 with distinct aesthetic sensibility in mind. He submits that the features such as easy storage, foldable, clasp etc are product features and not visual elements and what is protected is the shape, configuration and aesthetic composition. He submits that the judgment in the case of ***Whirlpool of India Ltd. vs. Videocon Industries Limited*** (supra) lays down the governing test that if the particular function can be achieved through number of different forms then the defence of functionality must fail.

8. He submits that the design has been registered not only in India but also in foreign countries which brings a distinctiveness to the Plaintiff's brand. He submits that the Plaintiff has accurately and prominently disclosed the correct design, location details, neck pillow with pocket and has annexed the certificate of the registration which is part of the record and that the averment of "neck pillow with pillow" is only a typographical error. He would further submit that the

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contention in the Affidavit-in-reply that visual appeal is solely on account of pocket is speculative and unsupported. He submits that the pocket is merely a mechanical appendage with no prominent role in overall configuration of tranquility pillow and the dominant feature of the design lies in overall shape and configuration of the neck pillow.

9. He would submit that as regards the third party registered designs cited as prior art is concerned, the same are visually and configurationally distinct from the Plaintiff's registered design in terms of shape, contours, preparation and overall aesthetic appeal. He submits that passing-off action is based on misrepresentation and likelihood of confusion and is maintainable in the case of statutory infringement. He submits that there is no justification for the Defendant to adopt the identical shape and configuration and color of Plaintiff's tranquility pillow. He would point out the table of comparison to contend that the Defendant's design is obvious imitation of Plaintiff's design. In support, he relies upon the following decisions:

> ***Whirlpool of India Ltd. v. Videocon Industries Ltd.*** (supra)
>
> ***Videocon Industries Ltd. v. Whirpool of India Limited***[2]
>
> ***Sirona Hygiene Private Limited v. Amazon Seller***

2 2012 SCC OnLine Bom 1171.

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Services Private Limited[3]

Faber-Castell Aktiengesellschaft v. M/s. Pikpen Private Limited[4]

Parle Products Pvt. Ltd. v. DS Innovative Products LLP[5]

Frito-Lay North America Inc v. Balaji Wafers Pvt. Ltd.[6]

Asian Rubber Industries v. Jasco Rubbers[7]

Faber-Castell Aktiengesellschaft v. Cello Pens Pvt. Ltd.[8]

Selvel Industries v. Om Plast (India)[9]

10. *Per contra*, Dr. Chandrachud, learned counsel appearing for the Defendants submits that shape/contours of the Plaintiff's product are pre-dominant functional rather than aesthetic in nature. He draws attention of this Court to the pleadings in the Plaint in order to demonstrate that the Plaintiff's have themselves described their product as ergonomical and has described the features which are functional. He submits that the pleadings in the Plaint refers to the functionality aspect of the registered design and what is necessary is an aesthetic appeal for a design to be registered which is missing in the

3 2023 SCC OnLine Del 1559.
4 2003(4) Mh. L.J. 264.
5 2024 SCC OnLine Bom 3452.
6 2020 SCC OnLine Bom 2375.
7 Appeal No. 62 of 2012 in Suit No. 371 of 2012/2013(53) PTC495 (Bom).
8 2015 SCCOnLine Bom 8762.
9 2016 SCC OnLine Bom 6945.

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present case. He would further draw the attention of this Court to the social media promotional material where the Plaintiffs have emphasized the functional aspects of the Plaintiff's product and not its alleged aesthetic element. He points out the customer reviews to contend that the reviews only speak of the functional aspects and not aesthetic elements. He submits that the Plaintiff's obtained registration for a neck pillow with an inextricably intertwined pocket which is absent in Defendant's product.

11. He would submit that in the recent decision of ***Cryogas Equipment Pvt. Limited vs. Inox India Limited***[10], the Hon'ble Supreme Court has applied the dominant purpose test to decide whether a design can be protected under this Act and when an article has both functional and aesthetic elements, the predominant feature has to be considered. He submits that the material on record shows that the primary characteristic of the Plaintiff's neck pillow is functional utility and by applying the test laid down by Hon'ble Apex Court, the design is not registrable. He submits that in the test laid down in decision of ***Whirlpool of India Ltd. vs Videocon Industries Ltd.*** (supra), i.e. only mode/option test is no longer good law.

12. He submits that from 2011 onwards several parties have obtained design registration of neck pillow whose shape is similar to

10 2025 SCC OnLine SC 780.

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the Plaintiff's neck pillow and draws attention of this Court to the annexures in the Affidavit-in-reply to substantiate the said submission. He submits that in case of design infringement, the Defendant's product must be compared with the Plaintiff's product and in the present case, as the pocket is absent in the Defendant's product, no case of design infringement is made out.

13. He would submit that there can be no claim of passing-off because mere similarity between the goods is insufficient to constitute passing-off and it has to be shown that the Defendant not only copied the design but also have made a false representation to the public that its goods are that of Plaintiff. He submits that the Defendant's packaging is different from the Plaintiff's packaging and has been marketed under the own trade mark and not the Plaintiff's trade mark. He submits that there can be no monopoly of colors and there is no question of any confusion amongst the consumers. In support, he relies upon the following decisions:

> ***Cryogas Equipment Private Limited v. Inox India Limited*** (supra)
>
> ***Whirpool of India Ltd. v. Videocon Industries Ltd.*** (supra)
>
> ***M/s. Smithkline Beecham Plc. v. Hindustan Lever Limited***[11]

11 2000 (52) DRJ 55.

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A. N. Sehgal v. Raje Ram Sheoran[12]

ITC Limited v. The Controller of Patents and Designs[13]

Super Smelters Limited v. SRMB Srijan Private Limited[14]

Indiana Gratings Private Limited v. Anand Udyog Fabricators Private Limited[15]

Atomberg Technologies Private Limited v. Luker Electric Technologies Private Limited[16]

Videocon Industries Limited v. Whirlpool of India Ltd.[17]

Empire Industries Limited v. Union of India[18]

State of Assam v. Barak Upatyaka D. U. Karmachari Sanstha[19]

Kewal Ashokbhai Vasoya v. Suarabhakti Goods Pvt. Ltd.[20]

14. In rejoinder, Mr. Kamod would submit that reliance on case of ***Cryogas Equipment Pvt. Ltd.*** (supra) is highly misplaced both in facts and in law as in that case Apex Court was concerned with the case of copyright infringement and associated literary works. He submits that

12 1992 Supp (1) SCC 304,
13 2017 SCC OnLine Cal 415.
14 2019 SCC OnLine Cal 4888.
15 2008 SCC OnLine Bom 1688.
16 (2023) 2 HCC (Bom) 426.
17 2012 SCC OnLine Bom 1171.
18 (1985) 3 SCC 314.
19 (2009) 5 SCC 694.
20 2022 SCC OnLine Bom 3335.

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the central question was interpretation of Section 15(2) of Copyright Act, 1957 and the Hon'ble Apex Court has reiterated the principle that once the artistic work is industrially applied beyond threshold, it ceases to have the protection unless it is registered as design under the Designs Act, 2000. He submits that the observations of the Hon'ble Apex Court was confined to the non-registrable works under the Copyright and Designs Act. He submits that the jurisprudence in India has consistently held that functionality *per se* can cancel the registration provided the design is utilitarian with no scope for visual variation. He submits that where alternative design is feasible to achieve the same utility and chosen design serve as aesthetic function or offers consumers visual differentiation, it qualifies for protection under the Act, which is the test which is laid down in ***Whirlpool of India Ltd.*** (supra) and has been noted with approval in ***Cryogas Equipment Pvt. Ltd*** (supra). He submits that the conclusion of the Hon'ble Apex Court in Paragraph 66(d) of the ***Cryogas Equipment Pvt. Ltd.*** (supra) makes it evident that so long as design of article is not functional, it can possess aesthetic appeal and be protected under the Designs Act, 2000. He submits that even otherwise the dominant purpose of the Plaintiff's design is not functional but its unique and visual appeal which sets it apart in the market. He draws the attention of this Court to the pleadings in the Plaint to demonstrate that the product has

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been described as capricious, catchy and distinctive.

15. He submits that there is sufficient material on record to establish reputation and goodwill. He points out to the sales figure which for year 2023-24 was INR 3.95 crores and promotional expenses were INR 25 lakhs. He submits that upon comparison of the rival products, the consumers are liable to be deceived and the test is not in identifying individual similarities or dissimilarities.

REASONS AND ANALYSIS:

16. The issue arising for consideration is whether the Plaintiff is entitled to commercial monopoly in respect of the design of the tranquility neck pillow. As a prelude, the broad issue to be determined is whether the Plaintiff's design is non registrable under the Designs Act, 2000, for the reason that (a) the Plaintiff's design is dictated by function and incapable of protection and, (b) there exists prior art substantially similar to the Plaintiff's design.

17. The Plaintiff's product branded as "Travel Blue Tranquility Neck Pillow" was granted registration on 24th July, 2017 with reciprocity date of 19th October, 2015 bearing Design No 281315. The certificate mentions that the design has been registered in Class 06-09 in respect of the application of the design to "NECK PILLOW WITH POCKET." The novelty is stated to reside in the shape and configuration of the "NECK PILLOW WITH POCKET".

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18. The Plaintiff's product is a neck pillow having a specific shape and configuration with elevated sides and dipping curves in a unique pattern. The Plaintiff has obtained registration of its design in India and several foreign countries. The rival products were produced physically before this Court and it was nigh impossible to differentiate between the two products with both products being identical/substantially similar in shape, configuration, features, fabric, colour etc.

19. The pleaded case of the Defendant for cancellation of registration is that the Plaintiff's design is not new or original and that the registration has been obtained only by reason of the protruding pocket which added a distinctive visual appeal. It is not the pleaded case of the Defendant that the shape and configuration of the Plaintiff's tranquility pillow is not registrable being functional. The functionality averment is restricted to the features of the Plaintiff's product as set out in paragraph 17 of the Plaint such as being foldable, easy storage etc. and cannot be protected. Whereas the substantive arguments canvassed by Dr. Chandrachud were on the aspect of the Plaintiff's design being pre-dominantly functional and incapable of registration as design. The arguments canvassed during the hearing is not the Defendant's pleaded case and on the contrary the pleadings in the Affidavit in reply accepts the visual appeal of the Plaintiff's design.

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20. In paragraph 6(d) of the Affidavit in reply, it is pleaded that the Plaintiff has suppressed that the visual appeal associated with the Defendant's pillow is categorically different from the visual appeal of the Plaintiff's registered design and its tranquility pillow and that the visual appeal of the Defendant's pillow is a result of its overall shape and configuration which being devoid of extending/protruding pocket appears completely different from the Plaintiff's design. In paragraph 39(b), it is pleaded that the shape and configuration, particularly the contours and overall design and visual appeal of the Defendant's neck pillow when judged solely by the eye is demonstrably different from both the registered design as well as the Plaintiff's tranquility pillow. In paragraph 50, it is pleaded that the design of the tranquility pillow of Plaintiff is indeed strikingly different from the registered design no 281315 in so far as both designs hold a very distinctive visual appeal.

21. The gist of the pleadings reproduced above *prima facie* indicates the acceptance by the Defendant of the fact that the Plaintiff's design possess visual appeal which can be judged solely by the eye and the pleaded case is that the Defendant's neck pillow bears a distinct visual appeal from that of the Plaintiff's design. In teeth of these pleadings, *prima facie* it is not open for the Defendant to canvass the submission that the Plaintiff's design is non registrable on ground of functionality. The pleading of functionality is restricted to the features as set out in

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paragraph 17 of the plaint and answered in paragraph 53 and 54. In paragraph 54, it is pleaded that the features identified by the Plaintiff in paragraph 17 are functional features.

22. Now what has been registered is appended at Page 75 of the plaint as "Neck Pillow with Pocket" and the representation is that the novelty resides in the shape and configuration of the "Neck Pillow with Pocket" as illustrated. The novelty is not claimed in the protruding pocket as is sought to be contended by Dr. Chandrachud but specifically claimed in the shape and configuration of the neck pillow which includes the pocket. The design registration specifically states that no claim is made by virtue of this registration in respect of any mechanical or other action of any mechanisam whatever or in respect of any mode or principles of construction of the Article. The pocket is a mechanical appendage and does not play any role in the overall visual appeal of the Plaintiff's product which is attributed to the shape and configuration of the tranquility pillow. The description of the tranquility pillow as "Neck pillow with pocket" does not undermine the fact that the registration was granted to the shape and configuration and not to the mechanical appendage.

23. The submission that the design was registered by reason of the protruding pillow as otherwise the same would not have been registered by reason of existence of prior art pillow has its foundation

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in the international registrations annexed at Exhibit "C" and "D" to the Affidavit in reply. From the illustrations at Exhibit "C" *prima facie* it cannot be deduced that the shape and configuration of the Plaintiff's neck pillow is visually and configurationally similar to the illustrations. The Defendant has merely reproduced the illustrations without any table of comparison to show that the Plaintiff's neck pillow which has distinct elevations and curves already existed in the prior art. The illustrations would primarily indicate that there are various shapes and configurations of neck pillows. As far as the products listed on e-commerce websites at Exhibit "D", the availability of similar products for online sale is *prima* facie not indicative of the products being in existence prior to the Plaintiff's registration.

24. There is another aspect of the matter as far as prior art registrations at Exhibit "C" is concerned, perusal of the said registrations would indicate that the registrations are international registrations. Under Section 19 of the Designs Act, 2000, there would be cancellation of registration where:

> *(a) Design has been previously registered in India; or*
>
> *(b)That it has been published in India or in any Country prior to the date of registration.*

25. It was necessary for the Defendants to specifically plead as to whether the design has been registered in India or has been published

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in India for the purpose of application of Section 19(1) (a) or 19(1)(b). The distinction between Section 19(1) (a) or 19(1) (b) is that if the design is registered in India the same is sufficient to constitute ground for cancellation of registration of the subsequent registered design. In event the design is registered outside India a mere fact of international registration is not sufficient to warrant cancellation. Under Section 19(1) (b) the prior art has to be published in India or in any other country prior to the date of registration. The pleadings in the affidavit-in-reply as well as the submissions which merely points out to the international registrations without any material details is not sufficient to make out *prima facie* case of cancellation either under Section 19(1) (a) or 19(1)(b). The prior publication has to be necessarily be in some brochure, book or Journal with the illustration clearly depicting the design for the purpose of constituting a ground for cancellation. *Prima facie* from perusal of the registrations it appears that there is only one registration at page 212 which is national registration of 11th February, 2011, however the design is not visually or structurally similar to that of the Plaintiff's design.

26. Though the pleaded case of the Defendant accepts the presence of visual appeal and there is no pleading of the shape and configuration being functional, I have proceeded to consider the submissions canvassed by the Defendant on the functionality test. As

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the argument is that the Plaintiff's product is pre-dominantly functional rather than aesthetic, it would be appropriate to have a look at the relevant statutory provisions. Design is defined under Section 2(d) of Designs Act, 2000 as under:

> **"2(d)** "design" means only the features of shape, configuration, pattern, ornament or composition of lines or colours applied to any article, whether in two dimensional or three dimensional or in both forms, by any industrial process or means, whether manual, mechanical or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye; but does not include any mode or principle of construction or anything which is in substance a mere mechanical device, and does not include any trade mark as defined in clause (v) of sub-section (1) of Section 2 of Trade Mark and Merchandise Marks Act, 1958 (43 of 1958) or property mark as defined in section 479 of 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)"

The essence of design as discerned from the definition is that design is (a) features of shape, configuration, pattern, ornament or composition of lines or colours applied to any article, (b) in two dimensional or three dimensional or both forms (c) that enhances overall appearance of article, while excluding mere mechanical device, trade mark as defined in Section 2(1)(v) of Trade Mark and Merchandise Marks Act, 1958, property mark as defined in Section 479 of IPC or artistic work as defined in clause (c) of Section 2 of the Copyright Act, 1957.

27. Section 22 of Designs Act dealing with piracy in registered design prohibits during existence of copyright in any design for any

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person for purpose of sale to apply to any article in any class of articles in which the design is registered, the design or any fraudulent or obvious imitation thereof without permitted use. Sub-Section (3) of Section 22 affords the grounds for cancellation of design as defence to a piracy allegation. Section 19 of Designs Act, 2000 governing the cancellation of registration reads as under:

> **"19. Cancellation of registration -**(1) Any person interested may present a petition for the cancellation of the registration of a design at any time after the registration of the design, to the Controller on any of the following grounds, namely-
> (a) that the design has been previously registered - in India; or
> (b) that it has been published in India or in any other country prior to the date of registration;or
> (c) that the design is not a new or original design; or
> (d) that the design is not registrable under this Act;or
> (e) that it is not a design as defined under clause (d) of Section 2
>
> (2) An appeal shall lie from any order of the Controller under this section to the High Court, and the Controller may at any time refer any such petition to the High Court, and the High Court shall decide any petition so referred."

28. The pivotal defence raised by the Defendant is that the decision of the Hon'ble Apex Court in ***Cryogas Equipment Pvt Ltd vs Inox India Ltd*** (supra) has resulted in a paradigm shift from the well settled "only option test" i.e. whether the function can be achieved through number of different forms to the "dominant purpose of functional utility test".

29. Extensive jurisprudence has shaped the functionality test which is required to be applied to determine whether the design is qualified

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for protection under the Designs Act. Learned Counsel for the parties have relied upon several authorities of this Court as well as other High Courts in support of their respective contentions and it would be apposite to refer to the same at this juncture with the purpose to discern the view adopted by the various High Courts.

30. The Delhi High Court in ***M/s Smithkline Beecham Plc vs. M/s. Hindustan Lever Limited*** (supra), while considering the case of infringement of design in respect of S-shaped toothbrush applied the test of functionality to determine whether the S-shaped feature is functional or aesthetic. The Delhi High Court held that although to some extent the said feature could be said to be aesthetic but the Court is to look into the dominant purpose for deciding as to whether the features are functional or utilitarian or not. By applying the dominant purpose test, it held that the dominant purpose of the feature is functional and no passing off action could be available.

31. The Delhi High Court in ***Apollo Tyres vs Pioneer Trading Corporation***[21] was considering a case of infringement of tread pattern of tyres and held as under:

> **"87.**…..Mr. Chandra has clarified-and I agree with his submission, that no party can claim proprietary over the shape of a tyre, since all tyres are round in the shape of a wheel, which is a functional requirement. No party can claim proprietary over the technique/ practice of providing treads in a tyre, since treads are functional, i.e. they afford the necessary grip between the tyre and the ground during

21 2017 SCC OnLine Del 9825.

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> movement of the vehicle to keep it substantially stable. No party can claim proprietary over the technique/practice of having a plurality of ribs, separated by grooves, which create the tread on the tyre. However, that does not mean that the unique pattern of the tread adopted by a particular manufacturer, which constitutes its unique design and shape, would not be entitled to protection as a design - if it is registered, and also as a trademark- if the tread pattern has been exploited as a trademark i.e. a source identifier. What is functional in a tyre are the "treads" and not the "tread pattern".
>
> 88. It is clear from the documents placed on record that each of the manufacturers have adopted their unique tread patterns. **It is not the defendants case that the tread pattern adopted by the plaintiff is the only tread pattern which can serve the function of providing the necessary grip between the tyre and the ground during movement of the vehicle, so as to keep it substantially stable. This is not, and cannot be, the defence of the defendant since numerous unique trade patterns have been adopted by different manufacturers of tyres the world over.**
>
> (emphasis supplied)

32. The Delhi High Court in the said decision noted with approval the decision of Bombay High Court in ***Whirlpool of India Ltd.*** and held as under:

> **"93.** No doubt, the tread pattern adopted by the plaintiff in respect of its tyre also serves the purpose which the treads on any tyre serve. **However, if the same function can be achieved through numerous different forms of tread patterns, then the defence of functionality must fail. It was essential for the defendant to, at least, prima facie, establish that the tread pattern of the plaintiff was the only mode/ option, or one of the only few options, which was possible to achieve the functional requirements of the tyre.** The position which emerges on a perusal of the documents placed on record by the plaintiff is that there are innumerable different and unique tread patterns in existence, adopted by different manufacturers of tyres, which achieve the same objective.
>
> (emphasis supplied)

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33. The Calcutta High Court in ***ITC Limited vs. The Controller of Patents and Designs*** held :

> **"55.** Good design involves two fundamental elements; the product must perform its function and it should be pleasant to look at and appealing to the eyes. Predominance and pre-eminence of the aesthetic elements over the functional elements would satisfy the definition of "design" under the Act."
>
> **79.** It is also well settled that where a design could particularly perform a particular function but the designer has also added some features of shape that appealed to the eye and are additional to or supplementary to the function, the design could be registered..."

34. In ***Super Smelters Limited vs. SRMB Srijan Private*** Limited (supra), one of the issues before the Calcutta High Court was whether the Respondent's "X" ribbed mark could be recognised as trade mark in common law action of passing off. In that context the Calcutta High Court noted the provisions of Section 9(3)(b) of Trade Marks Act, 1999 to hold that shape of goods may be considered for registration of Designs Act provided that the finished article appeals to the eye and is not merely a mechanical device or functional device. The Calcutta High Court differed from the decision of Delhi High Court in ***Apollo Tyres vs. Pioneer Trading Corporation*** (supra) by referring to the provisions of Section 9(3)(b) of Trade Marks Act which states that the marks shall not be registered if it consists exclusively of shape of goods which is necessary to obtain a technical result. It held that in applying Section 9(3)(b) of Trade Marks Act, it is not necessary to investigate whether

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shapes could achieve the given technical result to establish that the shape in question necessarily achieves the given technical result.

35. The decision of Calcutta High Court turned on the interpretation of Section 9(3)(b) of Trade Marks Act which provided for non-registrability of trade mark if it consists exclusively of the shape of goods which is necessary to obtain a technical result. It held that for the shape of a good to be purely functional and therefore incapable of protection as a trade mark, it is not sufficient that the shape have certain aspects, which achieve a technical result, rather what is required is that the shape, as a whole, performs a function only.

36. Now coming to the decision of Bombay High Court, in ***Whirlpool of India Ltd vs Videocon Industries Ltd*** (supra), which was upheld by Hon'ble Division Bench of this Court, the Learned Single Judge was considering the issue of piracy of registered design in case of washing machine and held thus on submission of defence of functionality:

> **"46.** For a defense of functionality to succeed, it is not enough to say that the form has some relevance to the function. If a particular function can be achieved through a number of different forms, then the defense of functionality must fail. For the defence of functionality to succeed, it is essential for Defendant to establish that the design applied for is the only mode/option which was possible considering the functional requirements of the products. Even otherwise, as submitted by the Plaintiff assuming that the shape also performs a certain function, that by itself is not determinative of the fact that the design is functional if that is not the only shape in which the function could be performed. In case of Cow (P.B) and Co Ltd vs Cannon Rubber Manufacturers Ltd 1959 RPC 347 (cited at Page 75 of the majority judgment of Delhi High Court) the court held that there may be cases where the

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> design while fulfilling the text of being appealing to the eye is also functional. **In such case the conundrum of functionality is resolved by taking note of the fact that it would make no impact on the articles functionality, if the function could be performed by use of another shape as well."**
> (emphasis supplied).

37. In ***Indiana Gratings Private Limited vs Anand Udyog Fabricators Pvt Ltd*** (supra), the Co-ordinate Bench of this Court held that purely functional feature is excluded from registration under the Designs Act, 2000 and that a design which has eye-appeal will be excluded from registration only if every feature of it is one which is dictated solely by function.

38. In ***Faber-Castell Aktiengesellschaft vs Cello Pens Pvt Ltd*** (supra), the Co-ordinate Bench followed the decision of ***Whirlpool of India Ltd vs Videcon Industries Ltd*** (supra) and considered a situation where a particular feature or element had both form and function and held that existence of function if combined with form does not disentitle it from all protection together.

39. The proposition propounded by our Court in ***Whirpool of India Ltd. vs Videocon Industries Ltd.*** (supra) that the fact that the shape also performs a certain function does not make the shape unregistrable if that is not the only shape in which the function could be performed has been consistently followed. The Delhi High Court in ***Apollo Tyres vs Pioneer Trading Corporation*** (supra)**,** concurred with the proposition laid down in ***Whirlpool of India Ltd. vs Videocon***

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Industries Ltd. (supra)**.** The Calcutta High Court in ***Super Smelters vs SRMB Srijan Private Limited*** (supra) which turned on the expression used in Section 9(3)(b) held that the provision only requires the establishment that without the shape in question the given technical result would not be achieved and not to ascertain whether other shapes could achieve the given technical result.

40. The registration of design depends on the satisfaction that the application of features of shape, configuration, pattern, ornament etc to the finished article appeals to and can be judged solely by the eye. The protection afforded by the Designs Act, 2000 is for the ornamental/visual aspect of the product and not its functional feature. There is tendency of a unique design to have an overlap between functionality and aesthetics. The articles designed to perform intended function may also have an aesthetic appeal and upon reading of the definition of design, in my view, the definition does not require the design to be purely aesthetic and devoid of functionality. If the design is purely functional, there can be no protection. It is the mid-path i.e. where the design is functional and aesthetic that needs to be resolved. Apart from the functions of the features if it creates a visual effect for the overall appearance of the finished article, the design cannot be purely functional.

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41. The decision of ***Whirlpool of India Ltd. vs Videocon Industries Ltd.*** (supra) has resolved the conundrum of functionality, which is binding. It is not disputed by Dr. Chandrachud that the Plaintiff's product has an aesthetic value and what he submits that the "only option test" has been replaced by dominant purpose test by the decision of the Hon'ble Apex Court in ***Cryogas Equipment Private Limited*** (supra)***.***

42. In ***Cryogas Equipment Private Limited*** (supra)**,** one of the issues which arose for determination of the Hon'ble Apex Court was "What are the parameters for determining whether a work or an article falls within the limitation set out in Section 15(2) of the Copyright Act, thereby classifying it as a "design" under Section 2(d) of the Designs Act". The Hon'ble Apex Court resolved the interplay between copyright and design protection and essentially provided a framework for determining whether an item is primarily an artistic work eligible for copyright protection or a design eligible for protection under Design Act in the context of Section 15(2) of Copyright Act, 1957.

43. The Hon'ble Apex Court formulated a two pronged approach (a) whether the work in question is purely an artistic work or design derived from the original artistic work which would entitle the work for protection under Copyright Act in former case and under Design Act in latter case and (b) if such work does not qualify for Copyright as being

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a purely artistic work then the test of functional utility will have to be applied so as to determine the dominant purpose and then ascertain whether it would qualify for design protection under the Design Act. The Hon'ble Apex Court noted the decisions of various High Courts on aspect of functional utility including the test laid down in ***Whirlpool of India Ltd. vs Videocon Industries Ltd.*** (supra) and notably observed that no decision of any other High Court or the Hon'ble Apex Court expressing a discordant view has been cited and held that the test of functional utility is integral to determining whether an article qualifies for protection under the Designs Act. The Hon'ble Apex Court approved the conclusions of the Gujarat High Court in paragraph 66 of the decision. Clause (d) of paragraph 66 holds that for assessing whether the protection under the Designs Act is available it must be assessed whether the dominant aspect of the design is functional meaning that the finished product must possess aesthetic appeal rather than being purely functional.

44. The Hon'ble Apex Court has re-inforced and re-emphasised the test of functionality which is to be applied in cases where the design has both functional aspect and aesthetic appeal. The Hon'ble Apex Court did not explicitly formulate the dominant purpose theory as legal principle and has propounded the well settled functional utility as the test within the broader legal framework to distinguish between

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copyright protection and design protection. There is no real conflict between the only mode/option test and the dominant functionality test. The test of functionality will necessarily involve an inquiry into the question whether the finished product appeals to the eye rather than being purely functional. When the Courts consider whether the claimed design is dictated by function i.e. the design is pre-dominantly functional, the question they ask is whether there are other design that would produce the same overall functions and if the answer is in the affirmative, then the design is not dictated by function. The appearance of the design is dictated by function when there are limited ways to achieve that function. Where the functional features itself creates a different visual effect of the overall look of the product, it is qualified for protection. For example if a kitchen knife has a textured pattern on its handle for better grip and at the same time has a visual appeal, the Court will have to consider if the textured pattern is essential for function or if there are other equally functional but visually different patterns available. If the same result of better grip can be achieved by different patterns, then the textured pattern is not functional and will receive protection.

45. Applying the well settled test of functionality, *prima facie,* the Plaintiff's design was registrable as design under Section 2(d) of Designs Act, 2000. The shape and configuration of the tranquility

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pillow *prima facie* is not devoid of aesthetic appeal, which is also borne out of the Defendant's pleading. The illustrations produce by the Defendant at Exhibit "C" would *prima facie* indicate that the same functionality of lending support to the neck during travel may be realized in variety of forms and the adoption of the Plaintiff's design is not the only way of performing the function and *prima facie* the Plaintiff's design passes the muster of aesthetic appeal. The mere fact that the customer reviews speak of the functional aspects of the tranquility pillow by itself is *prima facie* not sufficient to arrive at a finding of the product being functional. As far as the pleadings in the plaint describing the tranquility pillow, the pleadings blur the description between functionality and aesthetic value, however, upon holistic reading of the plaint, *prima facie*, there are sufficient pleadings in the plaint to accept that the Plaintiff has described its product as aesthetic in nature. The features of easy storage, foldable, memory foam etc described in the plaint are product's functional features and not capable of design protection. The contention that the registered design has a non detachable pocket whereas the actual tranquility pillow has removable pocket and the Defendant's product does not have a pocket is *prima facie* not sufficient to hold that there is no design infringement.

46. As far as the suppression of material facts is concerned, the

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submission is that at the time of seeking *ex-parte* ad-interim relief, the Plaintiffs suppressed the fact that (a) they had obtained registration not for the pillow *per se* but for the pillow with an inextricably intertwined non removable pocket; (b) there exists prior art and the pocket is an integral element of design and (c) the Plaintiffs had highlighted the functional features of their pillow, the customer review. It is not necessary for this Court to go into the issue of suppression of fact as the application itself for taken up for final disposal and all material facts are placed before this Court.

47. The infringement of registered design occurs when a person applies or causes to be applied to any article in which the design is registered the design or obvious imitation thereof. The table of comparison at paragraph 41 of the plaint *prima facie* indicates that the Defendant's product is an obvious imitation of the Plaintiff's registered design. *Prima facie* case for infringement of registered design is made out as there are no identifiable differences between the rival products. The expression "imitation" used in Section 22 of Designs Act, 2000 does not mean to be an exact replica. The similarity or difference is to be judged through the eye of purchaser [See **Selvel Industries vs. Om Plast (India)** (supra)]. As the Plaintiff's product is being marketed since the year 2015, *prima facie* the product has achieved distinctiveness and the balance of convenience is therefore in favour of

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the Plaintiff.

48. The defence to the action for passing off is absence of proof of existence of goodwill and reputation, misrepresentation and damage to the Plaintiff. As far as the goodwill and reputation is concerned, the sales figure and promotional expenses of the Plaintiff for the year 2023-2024 was INR 3.95 Crores and INR 25 lakhs respectively. The Plaintiff has obtained registration of the design in the year 2017 with reciprocity from October, 2015 and the sales figures and promotional expenses since the year 2016 are set out in the plaint to demonstrate the goodwill and reputation. The Plaintiff has obtained international registrations in the year 2015 which *prima facie* demonstrates the Plaintiff's global presence. The fact that action was required to be taken against the infringers in the past *prima facie* demonstrates the market penetration. The early entry of the Plaintiff's registered design in the market which is now sought to be diluted by the Defendant's infringed product is *prima facie* likely to cause injury to the Plaintiff's business, reputation and goodwill. For establishing passing off, the Courts are required to ask whether the infringed product is likely to cause confusion in the relevant consumer base. Upon *prima facie* comparison of the rival products, the overall similarity between the two products is likely to deceive the consumer in believing that the goods of the Defendant are that of the Plaintiff. The minor variations

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as set out in the Affidavit in reply are not sufficient to distinguish the goods of the Defendant from that of the Plaintiff. As the product itself are kept for display and not marketed through packaging, the only identifier would be the product itself, which shows a overall similarity enough to cause confusion in the public. The imitation of the Plaintiff's registered design amounts to *prima facie* misrepresentation of association with the Plaintiff. The Plaintiff's product being in the market since the year 2016 whereas the Defendant is late entrant in the year 2022 shows the dishonest adoption of the similar design by the Defendant. Given the Defendant's own case that there is prior art existing, the pleading that the Defendant has independently developed the design of the product cannot be countenanced.

49. In ***Faber-Castell Aktiengessellschaft*** (supra), the Co-ordinate Bench noted the decision of ***Gorbatschow Wodkd KG vs John Distillerires Ltd***[22] which held that a conscious imitation by the defendant of the various constituent elements that go in the uniqueness of the plaintiff's product must lead to a conclusion that confusion and deception are both , respectively, inevitable and intended.

50. In light of the above *prima facie* case for infringement of design and passing off is made out entitling the Plaintiff to interim reliefs in

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terms of prayer clauses (a), (b) and (c) which reads as under:

> **"a.** that pending the hearing and final disposal of the suit, the Defendants by themselves, their partners, proprietors, stockiest, distributors, franchisees, servants, agents and all person claiming under or through them be restrained by an order of temporary injunction of this Hon'ble Court from infringing the Applicants' design registered under No. 281315 by the use of the impugned design of the Impugned Product shown at Exhibit - "L" above and/or any other design which is an obvious or fraudulent imitation of the Applicants' design registered under No. 281315 or in any other manner whatsoever;
>
> **b.** that pending the hearing and final disposal of the suit, that the Defendants by themselves, their proprietors, partners, franchisees, servants and agents and all persons claiming under or through them be restrained by an order of temporary injunction of this Hon'ble Court from from manufacturing, displaying, marketing, selling, exporting, advertising, promoting, dealing in and/or form using the impugned design and/or shape and/or دو get up shown at EXHIBIT – "L" to the Plaint and/or any other design and/or shape and/or get up which is identical with and/or deceptively similar to the Applicants' design and/or shape and/or get up shown at Exhibit "B" to the Plaint, in respect of pillows, travel accessories or like goods so as to pass off or enable others to pass off the Defendant's Impugned Product and / or cognate, allied complimentary goods as and for the Applicant's well-known pillows or in any other manner whatsoever;
>
> **c**. that pending the hearing and final disposal of the suit, the Defendants, by themselves, their directors, proprietors, partners, servants, franchisees, agents, dealers, distributors and/or otherwise howsoever, be directed to remove and/or delete all online listings of the Impugned on any e- commerce platform including the websites hosted on https://minisopaschimvihar.catalog.to; and / or any other e-commerce / social media platform where the Impugned Product is made available."

[Sharmila U. Deshmukh, J.]