IN THE HIGH COURT AT CALCUTTA
SPECIAL JURISDICTION
ORIGINAL SIDE

BEFORE:
The Hon'ble Justice Ravi Krishan Kapur

AID/5/2023
IA NO: GA/2/2023

IN THE MATTER OF

PARESH AJITKUMAR KAPOOR
VS
CONTROLLER OF PATENTS AND DESIGNS AND ORS.

For the appellant : Mr. Jishnu Saha, Senior Advocate
Mr. Harshit Tolia, Senior Advocate
Mr. Shuvasish Sengupta, Advocate
Mr. Balarko Sen, Advocate
Mr. Suvradal Choudhury, Advocate
Mr. Biren Panchal, Advocate

For the respondent no.3 : Mr. Ranjan Bachawat, Senior Advocate
Mr. D. Ghosh, Advocate
Mr. V. Dutta, Advocate
Mr. S. Dasgupta, Advocate
Mr. D. Chadha, Advocate

Judgment on : 24 May 2024

Ravi Krishan Kapur, J.:

1. *"In an ideal world, all good patents ought to be granted and all bad ones should be refused. How that is to be achieved given the ever rising flood of applications and the ever increasing importance of Chinese prior art, I have no real idea"["IP and Other Things"- Robin Jacob at page 239].*
2. This is an appeal filed under section 19(2) of the Designs Act, 2000 read with the relevant Rules framed thereunder, directed against an order of cancellation dated 12 April 2023 passed by the Deputy Controller of Patents and Designs cancelling the registered design of

the appellant bearing no.233559 for an Air Cooler with effect from 27 December 2010.

3. The appellant is engaged in the business of design, manufacture, sale, and export of industrial air coolers since 2009-2010. The appellant is also the creator of several designs of air coolers and has made huge investments in creating a state of art research and development for both industrial and institutional air coolers.

4. The private respondent no 3 is a trade rival of the appellant, engaged in the manufacture and sale of similar types of air coolers having its operations primarily at Rajkot, Gujrat and has registered designs for 'Air Coolers' bearing registration nos. 314930-001 and 314930-002 dated 22 March 2019 and 18 March 2019 respectively. The respondent nos. 1 and 2 are statutory authorities.

5. Briefly, a Chinese Company known as Ningbo Chenwu Humidifying Equipment Factory had in or about 2019 filed an application seeking cancellation of the registered design of the appellant on the ground that the Chinese company had registered a similar design bearing No. ZL200930131277.8 in China and that they were the prior publishers thereof. In such proceedings, the Chinese company had also produced its registration certificate showing photographs of all six sides of their design and details thereof.

6. The respondent no 2 considered the pleadings and evidence filed by the parties and framed the following issues:

    a) Whether the petitioner is a person interested?

    b) Whether the registered design no.233559 has been published in India or any country prior to its date of registration?

c) Whether the design no.233559 is new or original?

d) Whether the said design is registrable under the Act?

By an order dated 30 September 2019, the cancellation petition filed by the Chinese company was dismissed on the ground that the they had failed to establish any case of prior publication under section 4(b) of the Act and also that the website of the Chinese company did not establish the ground of prior publication. By such order, it was also held that the design of the appellant was original and novel.

7. Thereafter, the private respondent No. 3 had applied for registration of two designs similar to that of the appellant and the same were granted bearing registration nos. 314930-001 and 314930-002 respectively with effect from 5 February 2019. In view of the fact that the registered designs of the respondent no 3 were identical to that of the appellant, the appellant was compelled to file a suit for infringement before the High Court at Rajasthan wherein an order of restraint on the design of the respondent was passed on 28 November 2022 wherein the private respondent no.3 was restrained from infringing the registered design of the appellant and both the impugned desings stood cancelled. It is a matter of record that both the appellant and the private respondent no.3 have been contesting proceedings before different Courts. This litigation is obviously a sequel to the acrimonious history of litigation between the two parties.

8. On 4 May 2021, the respondent filed an application under section 19 of the Act, seeking cancellation of the appellant's registered design no. 233559 dated 23 December 2010 under class 23-04 of the design

'AIR-COOLER' on the ground that the same was incapable of being registered since the same had been published prior to the filing date in China.

9. Upon completion of the pleadings, the respondent no 2 framed the following issues:

a) *Whether the registered design no.233559 has been published in India or elsewhere prior to its date of registration?*

b) Whether the design no.233559 is new or original?

c) Whether the said design is not registrable under the Designs Act, 2000?

10. By an order dated 12 April, 2023 (the impugned order), the respondent no.2 allowed the application for cancellation primarily relying on the China National Intellectual Property (CNIPA) website and *inter-alia* held as follows:

> *"In view of the discussions in proceeding paragraphs in respect of evidences and exhibits submitted by the petitioner, the impugned design no.233559 when with the design features of the prior published design application no. 200930131277.8 and publication no.CN301106689D dated 06/01/2010 in China, it seen that the overall features of shape and configuration of the impugned design is the similar as that of the prior published design. Not only those features are same but also the said features are similarly arranged in the impugned design. The features of the impugned design are not significantly distinguishable from the features of known designs as analyzed above. A design, which is published prior to the date of registration or where applicable the priority date of the application for registration, cannot be considered as new. The features in the impugned design are not sufficient to alter the character or the identity of the design previously published and known to art. The application of prior design in the respondent's design is not original as the application of prior is made to same article i.e. Air Cooler. In view of such findings it is construed that the design is not a new or original design and not registrable.*
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> *In view of the proceeding analysis, the present application filed by Kalpesh Manubhai Ramolia, for cancellation of registered design 233559 dated 27/12/2010 under Class 23-04 registered in the name of Paresh Ajitkumar Kapoor, is allowed and it is ordered to cancel the said design in Register of Designs."*

11. It is contended by the appellant that, the respondent no 2 in passing the impugned order solely relied upon the Chinese design though a similar challenge had been categorically rejected by the same authority by a prior order dated 30 September 2019. It is also contended that there was no legally admissible evidence before the respondent no.3 to conclude that there had been prior publication under the Act or otherwise and that the same was a ground for cancellation of the appellant's design. The respondent no 2 had solely relied on the CNIPA website which was *per se* insufficient to conclude that there was prior publication. The fact of prior publication was simply not adjudicated upon in the impugned order. In any event, a prior foreign registration by the respondent no 2, ought not to have been reopened nor reviewed by the same Authority who had previously rejected the same. In such circumstances, the impugned order is unsustainable and is liable to be set aside. In this regard, reliance is placed on the decisions in *Gopal Glass Works Ltd vs Assistant Controller of Patents & Designs and Others, 2006 (3) CHN 188, Bharat Glass Tube Limited vs. Gopal Glass Limited (2008) 10 SCC 657, ITC Limited vs. The Controller of Patents and Designs and Ors. AIR 2017 Cal 156* and *Reckitt Benkiser India Ltd. vs. Wyeth Ltd. (2013) 54 PTC 90 (FB).*

12. On behalf of the respondent no 3, it is contended that in passing the impugned order the respondent no 2 considered all the materials submitted by both the parties and also carried out a proper analysis of the available details from the CNIPA website. The impugned order

takes into consideration, the overall features of the shape and configuration of the impugned design. It is also alleged that the respondent no 2 being an expert in the field, his findings ought not to be lightly interfered with. The respondent no 2 as empowered, himself retrieved data from the China National Intellectual Property Administration and made searches on the CNIPA website and found that the impugned design had been registered by the Chinese company and its publication date and registration application and the filing date were prior to the application of the appellant. It is also contended that the Certificate of Design issued by the State Intellectual Property Office suggests that "the conferred patent right shall take effect from the date of authorization publication". Rule 54 of the Implementing Regulation of the Patent Law of the People's Republic of China provides that while a Notification of grant is issued at an earlier date, registration and publication occur simultaneously. In any event, a design is considered to be published in a tangible form, if the same existed on paper in such a way that the shape or other features of the article are made clear to the naked eye. On the aspect of *res judicata*, it is submitted that the order dated 30 September 2019 was not passed on merits and also that the parties in both the proceedings were different. In conclusion, the impugned design was liable to be cancelled since there had been prior publication in a tangible form before the filing date of the appellant's application for registration. It is also submitted that affidavits under section 65B of the Evidence Act 1872, had also duly been filed by the respondents no 3 in support of each of the electronic records

produced as evidence before the respondent no 2. In support of such contentions, reliance is placed on the decisions in *ITC Limited vs. The Controller of Patents and Designs & Ors., AIR 2017 Cal 156* ,*Philco Industries & Ors. vs. The Deputy Controller of Patents & Designs & Anr., 2017 SCC OnLine Cal 9451* and *Excitel Private Limited vs. Registrar of Trade Marks, 2022 SCC OnLine Del 2097 at paras 13-14.*

13. For convenience, the relevant sections of the Designs Act, 2000 are as follows:

> ***2. Definitions***.
> * * *
> *(d) "design" means only the features of shape, configuration, pattern, ornament or composition of lines or colours applied to any article whether in two dimensional or three dimensional or in both forms, by any industrial process or means, whether manual, mechanical or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye; but does not include any mode or principle of construction or anything which is in substance a mere mechanical device, and does not include any trade mark as defined in clause (v) of sub-section (1) of section 2 of the Trade and Merchandise 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.*
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> ***4. Prohibition of registration of certain designs**. A design which—*
> *(a) is not new or original; or*
> *(b) has been disclosed to the public anywhere in India or in any other country by publication in tangible form or by use or in any other way prior to the filing date, or where applicable, the priority date of the application for registration; or*
> *(c) is not significantly distinguishable from known designs or combination of known designs; or*
> *(d) comprises or contains scandalous or obscene matter, shall not be registered.*
> ***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.

***44. Reciprocal arrangement with the United Kingdom and other convention countries or group of countries of inter-governmental organisations**.—(1) Any person who has applied for protection for any design in the United Kingdom or any of other convention countries or group of countries or countries which are members of inter-governmental organisations, or his legal representative or assignee shall, either alone or jointly with any other person, be entitled to claim that the registration of the said design under this Act shall be in priority to other applicants and shall have the same date as the date of the application in the United Kingdom or any of such other convention countries or group of countries or countries which are members of inter-governmental organisations, as the case may be:*

Provided that—

(a) the application is made within six months from the application for protection in the United Kingdom or any such other convention countries or group of countries or countries which are members of inter-governmental organisations, as the case may be; and

(b) nothing in this section shall entitle the proprietor of the design to recover damages for piracy of design happening prior to the actual date on which the design is registered in India.

(2) The registration of a design shall not be invalidated by reason only of the exhibition or use of or the publication of a description or representation of the design in India during the period specified in this section as that within which the application may be made.

(3) The application for registration of a design under this section has been made in the same manner as an ordinary application under this Act.

(4) Where it is made to appear to the Central Government that the legislature of the United Kingdom or any such other convention country or a country which is member of any group of countries or intergovernmental organisation as may be notified by the Central Government in this behalf has made satisfactory provision for the protection of designs registered in India, the Central Government may, by notification in the Official Gazette, direct that the provisions of this section, with such variations or additions, if any, as may be set out in such notification, shall apply for the protection of designs registered in the United Kingdom or that other convention country or such country which is member of any group of countries or inter-governmental organisation, as the case may be.

Explanation 1.—For the purposes of this section, the expression "convention countries", "group of countries" or "inter-governmental organisation" means, respectively, such countries, group of countries or inter-governmental organisation to which the Paris Convention for Protection of Industrial Property, 1883 as revised at Stockholm in 1967 and as amended in 1979 or the Final Act, embodying the results of the Uruguay Round of Multilateral Trade Negotiations, provided for the establishment of World Trade Organisation applies.

Explanation 2.—Where more than one application for protection referred to in sub-section (1) has been made for similar protections in the United Kingdom or one or more convention countries, group of countries or countries which are members of inter-governmental organisations, the period of six months referred to in clause (a) of that sub-section shall be

reckoned from the date of which the earlier or the earliest application, as the case may be, of such applications has been made.

14. The expressions 'published' or 'publication' have not been defined in the Act. The Act differentiates between prior registration in India and prior registration abroad. A registration of a design abroad *per se* is not included under section 19(1) (a) of the Act as a ground for cancellation of a design registered in India. There must be publication which is made available to the members of the public. Publication is a question of fact which is required to be considered in view of the evidence led in each and every case.

15. In *Reckitt Benkiser India Ltd. Vs. Wyeth Ltd. 2013 SCC OnLine Del 1096*, it has been held as follows:

> *40. It is true that publication has not been defined in the 2000 Act. Yet, for reasons discussed above, mere publication of design specifications, drawings and/or demonstrations by the Patent Office of the United Kingdom, or for that matter, any other foreign country, in connection with an application for registration, would not, in itself, amount to publication that would render a design registered in India liable to cancellation.*
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> *41. To constitute prior disclosure by publication to destroy the novelty of a registered design, the publication would have to be, in tangible form, of the design applied to the same article. Prior publication of a trade catalogue, brochure, book, journal, magazine or newspaper containing photographs or explicit picture illustrations that clearly depict the application of the design on the same article, with the same visual effect would be sufficient.*
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> *42. When the novelty of an article is tested against a prior published document, the main factor required to be adjudged is the visual effect and the appeal of the picture illustration.*
>
> *43. If the visual effect of the pattern, the shape or the combination of the pattern, shape, dimension, colour scheme, if any, are not clear from the picture illustrations, the novelty cannot be said to have been destroyed by prior publication, unless there are clear and unmistakable directions to make an article which is the same or similar enough to the impugned design.*

16. The Chinese Design being design no. ZL200930131277.8 alleged to have been filed on 5 February 2009 and registered on 6 January 2010

does not *per se* lead to an irrefutable conclusion that the same had been published on 6 January 2010. The date for grant of design or publication date (authorisation) does not amount to the design being published or circulated. To demonstrate publication, the respondent no 3 solely relied on the six side view 2 dimensional pictures of the Chinese design as shown on the CNIPA website. The impugned order also proceeds on the basis that since the patent certificate of Chinese design depicts the photo of an air cooler, the same amounted to the application to the article and was sufficient to constitute publication. The photograph may be considered as a graphic model and not an actual application of the design to the article which appeals to the eye. Rule 90 of the Chinese Regulations provide that the Patent Administration Department of China shall publish the Gazette releasing or announcing one drawing or photograph of patent for design. Rule 91 provides that the Department shall make available the Patent Gazette, separate volume for utility model and design to the public for free reference. Significantly, there is no discussion nor applicability, relevance or interpretation of the Chinese regulations in the impugned order. This naturally weakens the force of the arguments made for the first time before an Appellate Court.

17. In order, to constitute prior publication, an image or design must be published in such a way that a person possessing ordinary knowledge of the subject is able to apply the design, to the article or see the design to the article or to see the design to the eye of the mind. The publication must be in a tangible form of the design applied to the same article. Even publication in the form of photographs must be

explicitly illustrated so that there is sufficient clarity in such a way which could depict the application of the design on the article. If the illustrations or the dimensions, shapes and patterns are not clear from the pictures provided as evidence, the same does not destroy novelty. The six view pictures brought on record were unverified and legally inadmissible. No proof had been furnished to show that the translations provided by the respondent no.3 were true or correct. Moreover, no official translations under Rule 29(8) of The Designs Rule, 2001 had also been brought on record.

18. In arriving at the conclusion that there been publication, the respondent no 2 has proceeded with a preconceived mind as if registration of the Chinese design itself amounted to publication. The impugned order does not consider the aspect as to what constitutes publication in the facts of the present case. There has been no discussion on this aspect of the matter in the impugned order. Moreover, the respondent no 2 also failed to consider the authenticity or admissibility of such evidence and verify the same. Merely showing such designs on a foreign unverified website does not amount to prior publication.

19. In passing the impugned order, the Deputy Controller ought to have dealt with the question of prior publication. There were only two documents relied on by the respondent no 2 (i) Certificate of Registration and (ii) a snapshot of CNIPA website. Prior publication cannot be concluded on the basis of guesswork, surmises and conjectures. Registration in a foreign country *per se* is not a ground for cancellation of a design registered in India. An application under

section 19(1)(b) of the Act, for cancellation of registration of a design in India can only be justified on the ground of prior publication. Moreover, such publication should be as contemplated under section 4(b) of the Act. Since the prior art changes as new designs are published, it is crucial to ascertain the relevant date when the prior art is to be assessed. There must cogent evidence to show publication of the design which had been made available to the public. The impugned order has been passed without any consideration of this aspect of the matter. Before passing of the impugned order, the respondent no.2 was bound to examine the materials on record and conclusively come to a finding that there has been prior publication for the purposes of questioning the novelty of the impugned design. The power to cancel a registered designed is a draconian power and ought not to be exercised in a casual and cavalier manner.

20. In any event, the photographs submitted alongwith the cancellation application had 2 dimensional illustrations which failed to depict the application of the design with the same visual effect as a 3 dimensional model. Since the photographs do not provide a clear understanding of the design or illustrate on how the design could have been applied to an article, as would have been had three dimensional images been adduced as evidence, the respondent no 2 erred in comparing the images with that of the impugned design.

21. Significantly, the previous order dated 30 September 2019 and the impugned order have been passed relying on the same design and upon framing of similar issues, answers to which had been provided in the earlier judgment. In absence of any challenge to the previous

order, the order had become binding and conclusive. Ordinarily, a judgment in rem provides destiny of the "*res*" and binds all parties claiming an interest in the property. It is true that the parties in both the proceedings were different. There also may not have been any adjudication on the merits in the earlier round of litigation. However, the issue of both novelty and prior publication had been held in favour of the appellant, in the order dated 30 September 2019. The impugned order is also based on an identical set of facts passed by the same authority. In such circumstances, this aspect of the matter at least deserved to have been dealt with in the impugned order.

22. Moreover, though a specific challenge had been raised pertaining to the admissibility of evidence under section 65B of the Act, this issue has not even been considered in the impugned order. The compliance with the mandatory requirements under section 65B of the Act in view of the decision in *Arjun Panditrao Khotkar v. Kailash Kushanrao Gorantyal, (2020) 7 SCC 1* at para 73.2 has not even been adverted to in the impugned order.

23. It has also been contended that the pictures brought on record seeking cancellation had been first published in 2018. Having launched or hosted the relevant website on 4 June 2018, it is also questionable whether the contents thereof ought to have been considered as prior publication warranting cancellation of the impugned design. There has been no consideration on this aspect of the matter in the impugned order. The respondent no. 2 made no attempt to verify or question the authenticity of the website which had

been specifically challenged by the appellant. This aspect of the matter has also not been dealt with in the impugned order.

24. During the course of hearing of this appeal, both parties had filed separate applications seeking leave to rely on additional evidence. By an order dated 5 December 2023, GA 1 of 2023, filed by the appellant was withdrawn. In GA 2 of 2023, the respondent no 3 sought to rely on a notarized true and exact photocopy alongwith an English translation of the China National Intellectual Property Administration of the People's Republic of China Design Patent Bulletin (Volume 26), to contend that a design identical to the impugned design had been published in China on 6 January 2010 i.e. prior to the date of application for registration of the impugned design which had been filed on 27 December 2010. This application was heard and contested. Admittedly, the documents sought now to be relied on by the respondent no 3 were not disclosed before the respondent no.2 and had not been considered in the impugned order. A partial disclosure (albeit without translation) is of no consequence and is legally inadmissible. In a statutory appeal of this nature, reliance on a completely new document crucial to the aspect as to the date of publication of the Chinese Design ought not to be considered for the first time by the Appellate Court. This requires to be examined by the respondent authorities. It is true that in certain circumstances, an Appellate Court without remanding the matter can rely on additional evidence to dispose of an appeal. (*Sirajudheen vs. Zeenath & Ors. 2023 SCC OnLine SC 196).* However, in view of the perfunctory manner in which the impugned order has been passed without adverting to all

the questions raised by the appellant it would amount to an improper exercise of discretion by this Court to permit such evidence. This would also amount to denial of the right to a fair and proper adjudication before the statutory authorities.

25. For the above reasons, the impugned order dated 12 April 2023 is unsustainable and set aside. The matter is remanded to the statutory respondents to adjudicate the subject application for cancellation of the impugned design afresh including any application for additional evidence filed in accordance with law. The interim order stands vacated. It is made clear that the aforesaid findings insofar as the merits of the case are concerned, are *prima facie* in nature and not binding on the authority which finally hears the subject application for cancellation. The respondent authorities are directed to dispose of the application within eight weeks from the date of communication of this order. With the above directions, AID 5 of 2023 stands allowed. GA 2 of 2023 is dismissed.

(RAVI KRISHAN KAPUR, J.)

Later:

After pronouncement of the judgment, the Advocates appearing on behalf of respondents pray for stay of operation of the judgment. The prayer for stay is considered and rejected.

(RAVI KRISHAN KAPUR, J.)