2025:DHC:10128-DB

$~

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

Reserved on: 11 November 2025
Pronounced on: 18 November 2025

\+ FAO(OS)(IPD) 1/2022

AQUALITE INDUSTRIES PRIVATE LTD ....Appellant
Through: Ms. Swathi Sukumar, Sr. Adv. Mr. C. A. Brijesh, Ms. Simranjot Kaur, Mr. Ritwik Sharma, Advs.

versus

RELAXO FOOTWEARS LIMITED .....Respondent
Through: Mr. Saif Khan and Mr. Shobhit Agarwal, Advs.

CORAM:
HON'BLE MR. JUSTICE C. HARI SHANKAR
HON'BLE MR. JUSTICE OM PRAKASH SHUKLA

% **JUDGMENT**
18.11.2025

C. HARI SHANKAR, J.

The *lis*

1. Relaxo Footwears Ltd[1] makes, among other kinds of footwear, *hawai* slippers – the Indian *avatar* of flip flops. Among these are its models BHG 136 and BHG 137. The designs of BHG 136 and BHG 137 are registered under the Designs Act, 2000, *vide* Registration Certificates Nos 325071 and 325074 respectively[2].

[1] "Relaxo" hereinafter
[2] Collectively referred to, hereinafter, as "the suit designs"

2. Relaxo has instituted CS (Comm) 190/2021[3] against Aqualite Industries Pvt Ltd[4], alleging that Aqualite is manufacturing and selling *hawai* slippers which infringe the suit designs. The suit is presently pending before a learned Single Judge in the Intellectual Property Division of this Court.

3. With the suit, Relaxo filed IA 5717/2021 under Order XXXIX Rules 1 and 2 of the Code of Civil Procedure, 1908[5], seeking an interim injunction restraining Aqualite from manufacturing or dealing in footwear which infringes the suit designs, pending disposal of the suit. By order dated 8 October 2021, the learned Single Judge has allowed the IA, and has granted an interim injunction in favour of Relaxo and against Aqualite, as sought.

4. Aqualite is in appeal.

Facts

5. The Plaint

5.1 The suit alleges infringement, by Aqualite, of the designs registered, under the Designs Act, relating to Relaxo's footwear BHG 136, BHG 137 and BHG 147. The plea of infringement of the design relating to BHG 147 was given up during the course of hearing. The judgment of the learned Single Judge, which is under challenge in the present appeal, therefore, merely concerns itself with Design

[3] "the suit" hereinafter
[4] "Aqualite" hereinafter
[5] "CPC" hereinafter

Registrations 325071 relating to BHG 136 and 325074 relating to BHG 137, both of which are dated 27 December 2019.

5.2 BHG 136 and BHG 137 were both Hawai slippers. The perspective view of the respective products, as depicted in the concerned design registrations, were as follows:

Design Registration 325071	
Design Registration 325074	

5.3 In each case, the certificate of registration certified novelty as residing in the shape, configuration and surface pattern of the footwear.

5.4 Relaxo contended, before the learned Single Judge, and continues to contend, that the primary novel feature in the designs of its footwear, registered under the aforenoted design registrations, was the existence of vertical ridges along the sides of the footwear. These ridges are clearly apparent in the photographs extracted *supra.* In the footwear registered *vide* Design Registration 325071, the ridges cover

the entire side surface of the footwear, whereas in the case of Design Registration 325074, the ridges are towards the front – or, as Relaxo describes it, the upper – side surface of the footwear. For ease of reference, we will allude to this feature, hereinafter, as the "side ridges".

5.5 Relaxo contended, before the learned Single Judge, that it had come to learn, in February 2021, that footwear which were replicas of the footwear in respect of which it possessed the aforenoted Design Registrations 325071 and 325074, were being manufactured and sold by Aqualite in the market. The plaint provided pictures of the footwear covered by Relaxo's Design Registrations, and the footwear being manufactured and sold by Aqualite, thus, to emphasise the likeness between the two:

Relaxo's Product	**Aqualite's Product**
<u>Product BHG 136 corresponding to Design Registration 325071</u>	
	

Product BHG 137 corresponding to Design Registration 325074	
	

5.6 The manufacture and sale, by Aqualite, of footwear which were replicas of the products covered by Design Registrations 325071 and 325074, it was alleged, constituted piracy of Relaxo's registered designs within the meaning of Section 22(1)[6] of the Designs Act. Advancing further contentions regarding the reputation that its products commanded in the market and the manner in which the Relaxo's goodwill was being depleted on account of Aqualite's act of manufacturing and selling footwear which replicated Relaxo's designs, the suit sought a decree of permanent injunction, restraining Aqualite from manufacturing and selling footwear which infringed Relaxo's registered designs, apart from additional reliefs of delivery

[6] **22. Piracy of registered design**. –
(1) During the existence of copyright in any design it shall not be lawful for any person—
(a) for the purpose of sale to apply or cause to be applied to any article in any class of articles in which the design is registered, the design or any fraudulent or obvious imitation thereof, except with the licence or written consent of the registered proprietor, or to do anything with a view to enable the design to be so applied; or
(b) to import for the purposes of sale, without the consent of the registered proprietor, any article belonging to the class in which the design has been registered, and having applied to it the design or any fraudulent or obvious imitation thereof; or
(c) knowing that the design or any fraudulent or obvious imitation thereof has been applied to any article in any class of articles in which the design is registered without the consent of the registered proprietor, to publish or expose or cause to be published or exposed for sale that article.

up, rendition of accounts, damages and costs.

6. Summons came to be issued in the suit only on the date when orders were reserved in IA 5717/2021 by the learned Single Judge, i.e. on 4 June 2021. As such, Aqualite never had an opportunity to file a written statement in response to the plaint, before the impugned order was passed.

7. The learned Single Judge chose, instead, to issue notice, in the first instance, in IA 5717/2021 – in which the impugned order has been passed – calling upon Aqualite to file its reply thereto. Aqualite, therefore, proceeded to file its reply to IA 5717/2021.

8. Aqualite's reply to IA 5717/2021

8.1 Aqualite did not, in its reply, seriously contest the allegation that the footwear manufactured and sold by it replicated the registered designs of Relaxo.

8.2 Instead, Aqualite chose to raise a defence under Section 22(3)[7] of the Designs Act, by pleading that the registered designs of Relaxo were liable to be cancelled under Section 19(1)(b) and (c)[8] of the

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

[8] **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:—
*****
(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

Designs Act. Aqualite alleged that the designs which were being asserted by Relaxo were lacking in novelty *vis-à-vis* prior art and were also bad on account of their having been published prior to the asserted design registrations.

8.3 Aqualite predicated the aforesaid defence on the following four prior art designs/footwear:

Prior Art 1



Design Application Details

Design Number:	294472
Filing Date:	06-06-2017 15:38:38
Article Name:	FOOTWEAR
Class:	02-04-FOOTWEAR, SOCKS AND STOCKINGS
Journal Number:	11/2018
Journal Date:	16-03-2018 00:00:00

Applicant Detail

Sl. No.	APPLICANT NAME	APPLICANT ADDRESS
1	RELAXO FOOTWEARS LIMITED	Aggarwal City Square, Plot No. 10, Manglam Place, District Centre, Sector – 3, Rohini, Delhi 110085

Prior Art 2



Prior Art 3



Prior Art 4



8.4 Of the aforesaid four examples of footwear cited by Aqualite as prior art, the learned Single Judge held, correctly, that there was no evidence with respect to the date of publication, or introduction in the market, of the footwear, reflected in Prior Art 3 and Prior Art 4. As such, these footwears were not regarded as acceptable prior art for assessing the validity of suit designs. Ms. Swathi Sukumar, learned Senior Counsel who appears for the appellant has, with customary

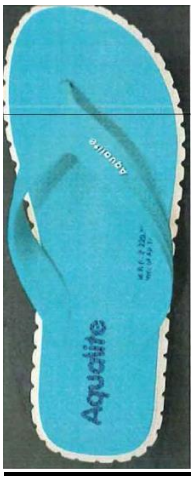
fairness, not contested this finding of the learned Single Judge, which is, even otherwise, unexceptionable.

8.5 Aqualite contended that the footwear depicted in the prior arts cited by it also possessed ridges along the side surfaces similar to those in the suit designs. As such, it was submitted that the main novel feature of the suit designs, i.e. the side ridges, was not, in fact, novel, but was already found in footwear not only of Relaxo itself but also of other footwear manufacturers.

8.6 Thus, it was submitted that the suit designs were vulnerable to cancellation both on account of prior publication as well as for want of novelty. They could not, therefore, be enforced against Aqualite or constitute a basis to obtain an injunction against it.

8.7 Aqualite further submitted that Relaxo could not seek any monopoly over the colours used by it in the footwear corresponding to the asserted suit designs, as it had not obtained any design registration for colours, or for any combination thereof. Mr. Khan, learned Counsel for Relaxo, fairly acknowledges this point.

8.8 Finally, Aqualite submitted that the products of Relaxo and Aqualite, when compared to each other, were completely dissimilar in appearance. For this purpose, the following comparison of the actual products of Relaxo and Aqualite were provided, in para 23 of the reply:

Relaxo's Product	Aqualite's Product
Re. Design Registration 325071	
	
Re. Design Registration 325074	
	

8.9 In order to support its submissions, Aqualite relied, before the learned Single Judge, on the judgments of the Division Benches of this Court in ***Crocs Inc v Bata India Ltd***[9] and ***Kellogg Company Ltd v***

[9] **(2019) 78 PTC 1**

Pravin Kumar Bhadabhai[10]. We may note, here**,** that before us, the decision in ***Kellogg*** has not been relied upon. In any event, the said decision is completely distinguishable as it does not even deal with a dispute under the Designs Act.

9. Documents filed by Aqualite before the learned Single Judge

9.1 Ms. Sukumar submits that, as summons in the suit were issued only on 4 June 2021, on which date the learned Single Judge reserved orders in IA 5717/2021, Aqualite was handicapped from filing a written statement, documents in support thereof, or any formal application to place additional documents on record.

9.2 Aqualite did, however, with its reply to IA 5717/2021, place certain documents on record. A set of additional documents were filed by Aqualite under cover of an Index dated 1 June 2021, before the judgment was reserved by the learned Single Judge on 4 June 2021.

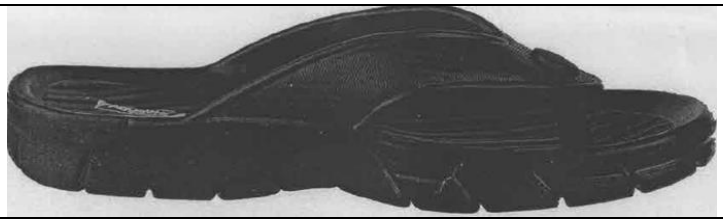
9.3 There is substance in the submission of Ms. Sukumar that, as summons had, till then, not been issued in the suit, Aqualite was handicapped in placing the documents on record in the manner envisaged in the CPC read with the Commercial Courts Act, 2015. The fact remains, however, that the documents were on record. The order reserving judgment in IA 5717/2021 does not reflect any objection, by Relaxo, to the placing of the said documents on record. As such, it has to be presumed that the learned Single Judge agreed to

[10] **62 (1996) DLT 79 (DB)**

take on record, not only the documents which were filed by Aqualite with its reply to IA 5717/2021, but also the additional documents filed under cover of an index dated 1 June 2021.

9.4 Among the documents filed with the Index dated 1 June 2021 were, at S. No. 3 thereof, images of third party products available in the market which, according to Aqualite, bore similar side ridges. Ms. Sukumar has placed reliance, in this context, on three other prior arts which we, for the sake of convenience, would refer to as Prior Arts 5, 6 and 7. Prior Art 5 was the following design for which M/s Aerobok Shoe Pvt Ltd had applied for registration on 21 April 2015:

Top View	
Bottom View	
Left View	

Right View	

Prior Arts 6 and 7 were of the following designs, registered in favour of M/s Euphoric Innovations Pvt Ltd:

Prior Art 6



Prior Art 7



9.5 However, even while filing photographs of the aforesaid prior arts under cover of the Index dated 1 June 2021, Aqualite did not choose to file any additional reply, or supplement the reply filed by it by way of response to IA 5717/2021. As such, there were no pleadings to support these designs.

The impugned judgment

10. Having taken stock of the rival contentions before him, the learned Single Judge, in the impugned judgment, proceeded to grant interlocutory injunction, pending disposal of the suit, restraining Aqualite, its directors, etc. from using the registered designs of Relaxo corresponding to its products BHG 136 and BHG 137 or any other design which was deceptively similar thereto.

11. In arriving at this conclusion, the learned Single Judge has held that

(i) on an ocular comparison of Aqualite's footwear with the design registrations of Relaxo, a clear similarity was apparent, especially with respect to the side ridges,

(ii) the plea of Aqualite that the asserted design registrations were liable to cancellation in terms of Section 19(1)(b) and (c) of the Designs Act was not acceptable as

(a) the date of launch of the products cited by Aqualite as Prior Arts 3 and 4 was unknown, and

(b) Prior Arts 1 and 2 cited by Aqualite were different in appearance from the asserted suit design, and

(iii) having itself applied for registration of the designs, corresponding to the infringing footwear, Aqualite could not be heard to say that the designs were not registerable under the Designs Act.

12. Aggrieved by the aforesaid decision, Aqualite has instituted the present appeal before us.

Rival submissions

13. Submissions of Aqualite

13.1 Ms. Sukumar, learned Senior Counsel for Aqualite, has not advanced, orally, all the contentions contained in the written submissions filed by Aqualite in the present proceedings. We, however, comprehensively note the contentions advanced in the written submissions as well as the contentions advanced orally before us, as under:

(i) The asserted suit designs were not appealing to the eye. In order for a design to be entitled to registration, it was required to be catchy or capricious.

(ii) The aspect of design piracy, as also the aspect of validity of a registered design, were to be examined from the perspective of an "instructed eye", as held by the Division Bench of this Court in ***B. Chawla & Sons v Bright Auto Industries***[11], which was followed by one of us (C. Hari Shankar J), sitting singly, in ***T.T.K. Prestige Ltd v K.C.M. Appliances Pvt Ltd***[12].

(iii) The asserted design registrations of Relaxo were dated 27 December 2019. Aqualite had relied upon as many as seven prior arts, which demonstrated that the asserted designs were not novel and had, in fact, been published prior to the registration. The learned Single Judge, however, took note only of two of the said prior arts, namely Prior Arts 1 and 2.

(iv) The findings of the learned Single Judge with respect to Prior Arts 1 and 2 were not sustainable, as the footwear relating to the said Prior Arts bore side ridges identical to those which were borne by the suit designs.

(v) The suit designs were also wanting in novelty, and bad for prior publication, on the basis of Prior Arts 5, 6 and 7 which,

[11] **AIR 1981 Del 95**
[12] **2023 SCC OnLine Del 2129**

too, bore identical side ridges.

(vi) The observation, of the learned Single Judge that Aqualite was estopped from contending that the suit designs were lacking in novelty, as Aqualite had itself applied for registration of its own designs, which were identical to the suit designs, was incorrect, as Aqualite had never applied for any such registration prior to the passing of the impugned judgment.

13.2 To support her submissions, Ms. Sukumar placed reliance on paras 11, 15, 18, 19 and 21 of the judgment of the Full Bench of this Court in ***Reckitt Benkiser India Ltd v Wyeth Ltd***[13].

14. Submissions of Relaxo

14.1 Appearing for Relaxo, Mr. Saif Khan commences his submissions by refuting Ms. Sukumar's contention that Aqualite had not applied for registration of its designs, under the Design Act. He submits that Aqualite had in fact applied for registration, albeit after the judgment was reserved by the learned Single Judge.

14.2 On merits, Mr. Khan submits that Aqualite had copied not only the side ridges on the suit designs, in its footwear, but had made and sold footwear which was identical in all features with Relaxo's footwear, even to the extent of placement of the brand name of the footwear. He submits that the placement of the brand name

[13] **AIR 2013 Del 101 (FB)**

"Aqualite", in Aqualite's footwear, is identical to the placement of the brand name "Bahamas", in Relaxo's footwear.

14.3 Mr. Khan refutes Ms. Sukumar's contention that the prior arts cited by Aqualite diluted the validity of the suit designs in any manner. In so far as the prior art designs noted by the learned Single Judge were concerned, Mr. Khan submits that the findings of the learned Single Judge are unexceptionable, and that there is no similarity between the prior arts and the suit designs. The footwear forming subject matter of Prior Arts 5 to 7, submits Mr. Khan, were not cited in the pleadings of Aqualite, and mere filing of photographs of the said footwear could not suffice, in the absence of supportive pleadings. Besides, these Prior Arts were introduced by way of additional documents, *sans* any accompanying application to take them on record, three days prior to reserving of judgment by the learned Single Judge.

14.4 To support his submissions, Mr. Khan places reliance on the judgment of a coordinate Division Bench of this Court in ***Relaxo Footwears Ltd v Aqualite India Ltd***[14].

Analysis

15. Scope of registration – Section 2(d)[15] of Designs Act

[14] **2022 SCC OnLine Del 3530**

[15] **2. Definitions.** - In this Act, unless there is anything repugnant in the subject or context, -

*****

(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 an 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

15.1 The definition of "design" in Section 2(d) of the Designs Act means "only the features of shape, configuration, pattern, ornamentation or composition of lines or colours applying to any article…"

15.2 It is important to understand the scope of the "design", as may constitute subject matter of an action for piracy. Section 2(d) makes it clear that the *entire article does not constitute the design.* The "design" is constituted "only (of) the features of shape, configuration, pattern, ornament or composition of lines or colours *applied* to" the article. The *features of the article, therefore, constitute the "design" as defined in Section 2(d); not the article itself.*

15.3 Section 4[16] sets out, albeit in negative terms, the pre-requisites for a design to be entitled to registration. The design must

(i) be new or original,

(ii) not have been disclosed by prior publication or prior use,

(iii) be significantly distinguishable from known designs or combinations thereof, and

(iv) not contain any scandalous or obscene matter.

---

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 or property mark as defined in Section 479 of the Indian Penal Code or any artistic work as defined in clause (c) of Section 2 of the Copyright Act, 1957;

[16] **4. Prohibition of registration of certain designs**. – A design which –

(a) is not new or original; or

(b) has been disclosed to the public any where 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.

These are pre-requisites of the *features of the article to which the registration relates*, incorporating, into Section 4, the definition of "design" in Section 2(d) by reference.

15.4 The corollary would, therefore, be that the design, as registered, would be, *not the article forming subject matter of registration*, but *the features in which novelty resides, as per the Certificate of Registration*.

16. <u>"Piracy" – Section 22(1) of the Designs Act</u>

16.1 For some strange reason, while trade marks and patents are *infringed*, designs are *pirated*. Section 22(1)[17] defines design piracy, again in negative terms. The following acts would amount to piracy of a registered design, under the said sub-section:

(i) application, to any article in the class of articles in which the design is registered,

(a) the registered design itself, or

(b) any fraudulent or obvious imitation thereof,

without licence from, or the written consent of, the registered proprietor of the design, or

[17] **22. Piracy of registered design**. –
(1) During the existence of copyright in any design it shall not be lawful for any person—
(a) for the purpose of sale to apply or cause to be applied to any article in any class of articles in which the design is registered, the design or any fraudulent or obvious imitation thereof, except with the licence or written consent of the registered proprietor, or to do anything with a view to enable the design to be so applied; or
(b) to import for the purposes of sale, without the consent of the registered proprietor, any article belonging to the class in which the design has been registered, and having applied to it the design or any fraudulent or obvious imitation thereof; or
(c) knowing that the design or any fraudulent or obvious imitation thereof has been applied to any article in any class of articles in which the design is registered without the consent of the registered proprietor, to publish or expose or cause to be published or exposed for sale that article.

(ii) importing, for the purposes of sale, any article in the class of articles in which the design is registered, to which the design, or any fraudulent or obvious imitation thereof, has been applied, for the purposes of sale, without consent of the registered proprietor of the design, or

(iii) publish, or expose, any article in the class of articles in which the design is registered, knowing that the registered design, or any fraudulent or obvious imitation thereof, has been applied to such article, without the consent of the registered proprietor of the design.

The impugned order finds Aqualite, *prima facie*, to have pirated the suit designs in terms of Section 22(1)(a).

16.2 Section 22(2)[18] exposes the design pirate to injunction, damages, and a contract debt payable to the registered proprietor of the pirated design.

16.3 The "design", as we have already seen, consists, not of the article, but of its novel feature or features. Design piracy, within the meaning of Section 22(1)(a) would, therefore, take place where the novel features – meaning, the features in which novelty is certified as

[18] **22. Piracy of registered design. –**
(2) If any person acts in contravention of this section, he shall be liable for every contravention—
(a) to pay to the registered proprietor of the design a sum not exceeding twenty-five thousand rupees recoverable as a contract debt, or
(b) if the proprietor elects to bring a suit for the recovery of damages for any such contravention, and for an injunction against the repetition thereof, to pay such damages as may be awarded and to be restrained by injunction accordingly:
Provided that the total sum recoverable in respect of any one design under clause (a) shall not exceed fifty thousand rupees:
Provided further that no suit or any other proceeding for relief under this sub-section shall be instituted in any court below the court of District Judge.

residing, in the Design Registration Certificate – of the article, or any fraudulent or obvious imitation of the said novel features, are applied to any other article in the class of articles in which the design is registered, without licence or consent from the registered design proprietor.

16.4 In the present case, therefore, as the Registration Certificates pertaining to the suit designs certify novelty as residing in their "shape, configuration and surface pattern", it is these features which constitute the suit designs, and any replication of the shape, configuration or surface pattern by another would be piracy.

16.5 As defined in Section 2(d) of the Designs Act, the "shape", "configuration", the "surface pattern", the "ornamentation" and "composition of lines or colours" are all individual features in respect of which a design registration could be obtained. Inasmuch as the Certificates of the Registrations forming subject matter of the suit designs certify novelty in the suit designs as residing only in the shape, configuration and surface pattern of the corresponding footwear, no certificate of novelty in colour combination has been granted to Relaxo. The colours used in the footwear BHG 136 and BHG 137, in respect of which the suit designs stand registered, therefore, are not part of the suit designs. Replication of the colours shown in the footwear, as contained in the Design Registration Certificates would not, therefore, constitute "piracy" under Section 22. As such, Relaxo could not, on the basis of the asserted suit designs, seek any injunction against any other party on the ground that the

footwear manufactured and sold by the said party was of the same colour as Relaxo's footwear.

16.6 Mr. Khan's reliance on the similarity in the colours of some of the models of Aqualite's footwear and Relaxo's footwear, to emphasise the aspect of piracy is, therefore, misplaced. Piracy has to be examined by assessing whether the suit designs, i.e., the shape, configuration and surface pattern of the footwear BHG 136 and BHG 137, as certified in the Design Registration Certificates, have been replicated in Aqualite's footwear.

16.7 The side ridges in the BHG 136 and BHG 137 footwear, on the other hand, clearly fall withing the ambit of the expression "shape, configuration and surface pattern", and are, therefore, subject matter of the suit designs. Replication of the side ridges by anyone else would, therefore, constitute design piracy, within the meaning of Section 22 of the Designs Act.

17. Admitted case as setup before the learned Single Judge

17.1 Before the learned Single Judge, it was, in fact, an admitted case by learned Counsel for both sides that the dispute related only to the side ridges in the BHG 136 and BHG 137 footwear. No other aspect of the shape, configuration or surface pattern of the said footwear, therefore, was subject matter of controversy. This is thus noted in para 18 of the impugned order:

> "18. The first issue is as to whether the defendant is guilty of

> having copied the designs of the plaintiff. In the course of submissions, it was submitted by the learned counsel for the parties that *essentially the dispute pertains to the teeth like design on the two products in question as noted above*."
>
> (Emphasis supplied)

17.2 The parties cannot, in appeal, set up a case different from that set up before the learned Single Judge. On the aspect of infringement, we would, therefore, in our discussion, be restricting our examination to the side ridges in Relaxo's BHG 136 and BHG 137 Hawai slippers, and whether they stand replicated by Aqualite.

18. Infringement not in dispute

18.1 Ms. Sukumar has not disputed the fact that the footwear manufactured by Aqualite, identically, bears the side ridges running along the sides of the BHG 136 and BHG 137 footwear. This is also apparent by a comparison of the products of the Aqualite and the footwear forming subject matter of the suit designs, as reflected in the Table in para 5.5 *supra*.

18.2 The submission that there was no similarity between Aqualite's and Relaxo's footwear, cannot be accepted, for two reasons.

18.3 In the first place, the comparison has to be between Aqualite's footwear and Relaxo's suit designs.

18.4 Secondly, the side ridges stand replicated in Aqualite's footwear. Aqualite has also released Hawai slippers which bear, on their side surfaces, ridges which, in the case of some models, cover the

entire side surface and, in the case of others, cover only the front portion of the slipper, identical to the suit designs 325071, corresponding to Relaxo's product BHG 136 and 325074 corresponding to Relaxo's product BHG 137. As such, design piracy, within the meaning of Section 22(1) of the Designs Act has indisputably taken place in the present case.

19. The Section 22(3) defence – Novelty of suit designs *vis-à-vis* prior art

19.1 Aqualite predicates its defence on Section 22(3) of the Designs Act, which permits every ground, on which the registration of a design can be cancelled under Section 19, to be raised as a ground of defence by the defendant. Aqualite's contention is that the suit designs are liable to be cancelled under Section 19(1)(b) and 19(1)(c) of the Designs Act. Ergo, submits Aqualite, no order of injunction can be passed against it, in view of Section 22(3) of the Designs Act.

19.2 Though the Designs Act does not further enlighten on the scope of "publication" or the aspect of "newness and originality", we have the benefit of authoritative pronouncements on the issue, among others, of the Supreme Court in ***Bharat Glass Tube Ltd v Gopal Glass Works Ltd***[19] and of the Full Bench of this Court in ***Reckitt Benckiser.***

19.3 ***Reckitt Benkiser***

19.3.1 This decision is significant, as it addresses the issue of "prior

[19] **(2008) 37 PTC 1 (SC)**

publication" and, though prior publication is one of the reasons why a design may not be registered [under Section 4(b)] and is also one of the grounds on which cancellation of a registered design may be sought [under Section 19(1)(b)], the Designs Act does not enlighten on the aspect of prior publication, or what it entails.

19.3.2 A Division Bench of this Court held, in ***Dabur India Ltd. v Amit Jain***[20], publication abroad by existence of the design asserted in a suit in the records of the Registrar of Designs which was open to public inspection to constitute "prior publication" for the purposes of Section 4(b) and 19(1)(b) of the Designs Act. The correctness of this view was referred to a Full Bench of three learned Judges for examination, resulting in the judgment in ***Reckitt Benkiser***.

19.3.3 The Full Bench held, at the outset, that Section 19(1)(a) of the Designs Act provided, as a ground for cancellation of a design registered in India, only the registration of the said design earlier in India itself. As against this, Section 19(1)(b), it was observed, provided prior publication of the suit design not only in India but also abroad as a ground for seeking its cancellation. A difference in approach was, therefore, apparent, while envisaging prior registration, and prior publication, as grounds for seeking cancellation of a registered design. Prior registration had necessarily to be in India, whereas prior publication could be either in India or abroad.

19.3.4 In the course of its further discussion, the Full Bench went on

[20] **(2009) 39 PTC 104**

to dilate on the aspect of "publication", for the purposes of the Designs Act. In the course of the discussion on the point, the Full Bench, predictably, adverted to the judgment of the Supreme Court in ***Bharat Glass Tubes***, but, prior thereto, observed thus, on the aspect of publication:

> "11. The expressions 'published' or 'publication' are not defined in the Act. Various judgments have however defined these expressions found in the Designs Act. Some judgments define publication as being opposed to one which is kept secret, whereas other judgments define publication as something which is available in public domain i.e. available as of right to any member of the public. *We are of course looking into the issue of publication by means of existence in public domain by publication in a paper (which expression "paper' is taken to mean any other medium where the design can be judged by the eye) inasmuch as, it was not (and could not be) disputed by both the parties before us that once there is actual use of the design by making an article out of the same, which is commercially exploited and put in public use ('by use' as stated in Section 4(b) of the Act), there would surely be publication.* The issue of publication is accordingly being specifically looked into from the point of view of whether publication by means of publishing in a paper form available in public generally including of their availability in the office of the Registrar of Designs.
>
> 12(i) *Let us therefore see what should be the meaning which should be ascribed to the expression 'published' or 'publication' when we use such expressions qua 'published' or 'publication' in paper form or by depiction in any form which is visible to naked eye without the same having been put in the form of an article.*
>
> We have already in this regard reproduced the definition of design as per Section 2(d) of the Act and the definition of expression 'original' as per Section 2(g) of the Act above, and which sections will be of relevance for discussion of 'publication'.
>
> (ii) *When we read the definition of a 'design' under Section 2(d) we find that there are inter alia four important aspects in the same. The first aspect is that the design is a design which is meant to produce an article as per the design by an industrial process or means. The second aspect is that design is not the article itself but the conceptual design containing the features of a shape, configuration, pattern, composition of lines etc. Third aspect is the*

judging of the design which is to be put in the form of finished article solely by the eye. Fourthly, the design which is the subject matter of the Act is not an artistic work which falls under the Copyright Act or a trademark which falls under the Trademarks Act.

(iii) More clarity is given to the meaning of the word design when we look at the definition of 'original' as found under Section 2(g). *The definition of the expression 'original' shows that the design though is not new because such design exists in public domain and is otherwise well-known, however, the design is original because it is new in its application i.e. new in its application to a specific article. Therefore, for seeking registration under the Act it is not necessary that the design must be totally new, and it is enough that the existing design is applied in a new manner i.e. to an article to which that design has not been applied before.*

(iv) *So far as the expression 'new' is concerned, it is well known i.e. it is something which comes into existence for the first time and therefore a new design which comes into existence for the first time obviously will be entitled to copyright protection.*

13(i) When we see the provision of Section 4(b) we find that a design which is already disclosed by publication in India or abroad will not be registered, however, the bar for registration of a design which is disclosed to the public in India or abroad is accompanied by the language which requires publication 'in a tangible form or by use or in any other way'. *It is this language and the fascicle of expressions 'tangible form' or 'use' or 'in any other way' which requires to be understood and interpreted so as to understand the meaning of the word 'publication'.*

(ii) *So far as the expression 'by use' is concerned, there would be no difficulty because obviously use of the design would be by translating the same into a finished article by an industrial process or means*. The real difficulty which arises actually is qua the expressions 'tangible form' or 'in any other way'. *These two expressions on a normal literal interpretation are much wider than the expression 'use' (the design having been translated to an article). Publication in a paper form or publication as being visible to the naked eye without the same having been put on an article is very much otherwise included in these wide expressions. The question thus is to what extent should there be publication for the same to be in 'tangible form' or 'in any other way' for being included within the language of 'publication' as found in Sections 4(b) and 19(1)(b).*"

(Emphasis supplied)

19.3.5 The Full Bench, thereafter, went on to refer to the judgment of the Supreme Court in ***Bharat Glass Tube*** and culled out the following principles as emanating therefrom:

> "(i) The issue of originality of design has to be necessarily looked at in terms of the article to which it applies and *there may be lack of clarity as to existence of prior publication unless the publication is totally clear i.e. it is only completely understood for its effect only when the same is actually put on the article.*
>
> (ii) Primacy was given to the Indian registered design because the design which was registered in the U.K. Patent Office was never used qua the article in question viz the glass sheet and the documents downloaded from the internet of the U.K. Patent Office could not be said to have much clarity for being treated as a prior publication qua the specific article in question viz the glass sheet.
>
> (iii) A foreign registered design cannot be the basis for cancellation under Section 19(1)(a) of a design registered in India unless there is application of a design to an article which is put into public domain/use or unless there would have been complete and sufficient clarity in the documents downloaded through internet from the U.K. Patent Office that it can be held that there is a clear cut clarity qua prior 'publication'.
>
> (iv) In the facts of that case since there was no clarity from the design downloaded from U.K. Patent office it was held that there was no prior publication."

19.3.6 The Full Bench proceeded, thereafter, to explain the concept of publication "in a tangible form", as envisaged in Section 4(b) of the Designs Act, thus:

> "19(i) *In our opinion the expression 'tangible form' refers to a specific physical form or shape as applied to an article and not the mere ability to replicate, convert and give a physical shape to the design, though of course to fall under the expression 'tangible form' it is not necessary that the article should have been used*, but the expression 'in any other way' takes some of its colour from the words 'used' or 'tangible form'. The principle of Nositur a Sociis will be applicable. Section 4(b) therefore, not only, requires

publication but it should be publication by use, in tangible form or in any other way. *The expression 'any other way' here is wider in context and takes into its ambit a design which has been created though not still put to use or exists in tangible form but at the same time it is guided by the words "use" and "tangible form". Thus, to disqualify a claim for registration or cancel registration of a design in India, the publication abroad should be by use, in tangible form, or in some other way, means that the design should not be a factum on paper/document alone, but further that the design on paper should be recognizable i.e. have the same impact in the public as a furnished article will appeal when judged solely by the eye (see Section 2(d)). Putting it differently if the design is on paper then it must exist upon a piece of paper in such a way that the shape or other features of the article are made clear to the eye. The visual impact should be similar to when we see the design on a physical object i.e. an object in tangible form/in use.* As noted otherwise in the present judgment, *registration of a design is article specific* and thus-depending on the facts of each case registration or publication of design of a particular article may or may not necessarily result in rejection or cancellation of registration of the same or similar design on another article. *The Act protects the original artistic effort not in form of an idea or on its own as an artistic work, but is an embodiment in a commercially produced artefact. Thus the primary concern is what the finished article is to look like.* [see observations of the Supreme Court in ***Bharat Glass Tools Ltd. v Gopal Glass Work's Ltd.*** (*infra*)]."

(Emphasis supplied)

The Supreme Court, in ***Bharat Glass Tube***, held that "the documents downloaded through Internet from the website of the UK Patent Office did not add that amount of clarity for the same to be said to be prior publication for seeking cancellation on the basis of such alleged prior publication of a design registered in India".

19.3.7 The Full Bench proceeded to place reliance on the following passages from Russell-Clarke and Howe on Industrial Design as reinforcing the principles enunciated in ***Bharat Glass Tube***:

"*What counts as "published" for the purpose of calling into*

question the novelty of a later design registration? This is broader than the word at first suggests. It is by no means limited to the publishing of a design in a printed publication, although it includes that. In practical terms, there are two main ways in which a design can be published : by prior use of the design, by selling or displaying to the public articles to which the design has been applied; and by paper publications of one sort or another. It is not, in fact, necessary that publication should be on paper; an oral disclosure, provided it is non-confidential, will amount to publication."

19.4 Ms. Sukumar has, for this purpose, cited seven prior arts. Of these, Prior Arts 3 and 4 were held to be of no value, by the learned Single Judge, as the date when the footwear reflected in the said prior arts were released in the market, or any data in respect thereof was published, was not known. The learned Single Judge has, in respect of the said prior arts, held thus, in para 27 of the impugned order:

> "27. As pointed out by the learned counsel for the plaintiff it is not known as to when the above footwear were launched. The documents do not mention the date when they were specifically launched or published. In fact, one of the documents states on the top 'new arrival'. Hence, at this stage, the plea of the defendant of prior art cannot be accepted."

19.5 Ms. Sukumar too did not place any reliance on Prior Arts 3 and 4. She, however, emphasised Prior Arts 1, 2 and 5 to 7 stating that they reflected lack of novelty of the suit design *vis-à-vis* existing prior arts, and also, *vis-à-vis* Prior Arts 1 and 5, that the suit design was bad for prior publication. Her contention is that the side ridges were also to be found in the aforenoted Prior Arts 1, 2 and 5 to 7, which were all published and available in the market prior to 27 December 2019, when the suit designs were registered.

19.6 Some amount of debate took place as to whether the Aqualite

was entitled to rely, before us, on the aforesaid suit designs. Mr. Khan particularly objects to Aqualite citing Designs 5 to 7, as, in his submission, there were no pleadings supporting the said designs, or stating that they reflected lack of novelty in the suit designs. In fact, he submits that there are no pleadings whatsoever making reference to Prior Arts 5 to 7. These prior art footwears, he points out, were merely introduced for the first time in the documents filed with the Index dated 1 June 2021, which was not even accompanied by an appropriate application. Aqualite, therefore, he submits cannot be permitted, at the very least, to rely on Prior Arts 5 to 7.

19.7 We find ourselves unable to agree.

19.8 In so far as Prior Arts 1 and 2 are concerned, documents in respect thereof were filed with the reply to IA 5717/2021 and reliance was specifically placed on the said prior arts in the said reply. As such, there can be no debate about the entitlement of Aqualite to rely on the said prior arts to support its case.

19.9 In so far as Prior Arts 5, 6 and 7 are concerned, it is true that there were no written arguments by Aqualite with respect to the said prior arts. It is also true, however, that the prior arts were placed on record under the cover of an index dated 1 June 2021. For reasons already cited *supra*, we are inclined to consider the said documents, especially the cited prior arts, too, while adjudicating on the present appeal.

19.10 There is substance in Ms. Sukumar's submission that as

summons were never issued in the suit till 4 June 2021, when orders were reserved in IA 5717/2021, Aqualite had no opportunity to file a written statement or any application to take the additional documents filed under Index dated 1 June 2021 on record. In fact, the procedure followed by the learned Single Judge is somewhat peculiar. Even without issuing summons in the suit, the learned Single Judge issued notice in IA 5717/2021 and allowed pleadings in the IA to be completed. Thereafter, arguments were heard in IA 5717/2021. Three days before judgment was reserved in the said IA, the documents filed by Aqualite on 1 June 2021 were filed in the Registry. Summons were issued, in the suit, for the first time on 4 June 2021, *vide* the order reserving judgment in IA 5717/2021. In view of the fact that no summons were ever issued to Aqualite so that it had no opportunity to file a written statement, till the impugned order was passed by the learned Single Judge, we are in agreement with Ms. Sukumar that Aqualite could not be blamed for not having filed a formal application to take the documents filed on 1 June 2021 on record.

19.11 Having been thus not afforded an opportunity to file any written statement before the impugned order was passed, as no summons were issued in the suit, we cannot deny Aqualite the right to refer to the documents filed on 1 June 2021 merely because they had not been filed under cover of an appropriate application before the learned Single Judge. The fact of the matter is that the said documents were on record even before arguments were completed in the IA 5717/2021 and the judgment was reserved on 4 June 2021. We, therefore, have permitted Ms. Sukumar to refer to the said documents as well in her attempt to convince us that the suit designs lacked novelty *vis-à-vis*

prior arts and already stood published anterior in point of time.

19.12 Novelty in Footwear designs – the ***Crocs*** judgment

19.12.1 The human foot is, howsoever one may view it, a peculiarly shaped body part. It is narrow at one end and wide at the other, with five toes, each of which, in itself, is individually and peculiarly contoured. Footwear, therefore, by its very nature, is an item in respect of which there is very limited scope of novelty. In order to be utilitarian, footwear has to correspond to the shape of the foot, and yet not be ungainly in appearance. The difficulty of ensuring novelty in footwear designs is tellingly underscored, in his own inimitable style by S. Ravindra Bhat, J., writing for the Division Bench of this Court in ***Crocs***, thus:

> "42. As far as the other aspect of novelty, is concerned (i.e. the distinctiveness of the Crocs design - its uniqueness being its ugliness, which in turn imparts comfort to the user) this court notices that footwear generally and sandals, in particular have a design constraint: unlike other objects of use, footwear have to necessarily cater to the somewhat irregular foot-shape, which is narrow at the heel and much broader at the toes. Therefore, worldwide, footwear manufacturers have little "play" in creating new designs: their single most constraining factor is the utility which is largely dictated by comfort. If one understands this basic constraint, the single judge's description that a "footwear is a footwear is a footwear, shoe is a shoe is a shoe and sandal is a sandal is a sandal" and further that the basic design has remained unchanged, cannot be faulted."

19.12.2 At the same time, footwear remains an item, which is amenable to registration under the Designs Act. This point was urged before the learned Single Judge, as noted in para 14 of the impugned judgment, in which reference is made to the assertion, in the rejoinder

of Relaxo, to the effect that footwear figured in Entries 02 to 04 of the Third Schedule to the Designs Rules, 2001. Schedule three, however, stands omitted by GSR 45 (E) dated 25 January 2021, with effect from that date. Prior to 25 January 2021, Rule 10(1) of the Designs Rules read:

> "(1) For the purpose of registration of designs and of these rules, article shall be classified as specified in the Third Schedule hereto."

Rule 10(1) stands substituted by GSR 45 (E) dated 25 January 2021, with effect from that date, to read:

> "(1) For the purposes of the registration of designs and of these rules, articles shall be classified as per current edition of "International Classification for Industrial Designs (Locarno Classification)" published by World Intellectual Property Organization (WIPO):
>
> Provided that registration of any design would be subject to the fulfillment of provisions of the Act specifically 2(a) and 2(d)."

Thus, the classifiability of designs, under the Designs Rules, now abides by the Locarno Classification published by the WIPO. In the Locarno Classification, footwear figures in Class 2. Footwear, therefore, still remains an article, in respect of which, a design is registrable under the Designs Rules. It cannot, therefore, be said that footwear designs can never be novel. Where the Registering Authority has certified novelty as residing in the Registration Certificates, the Court has to assess for itself as to whether the design has any novel feature. Of course, unlike Section 31(1) of the Trade Marks Act, 1999, there is no presumption in the Designs Act, of the validity of a registered design.

19.13 Viewed thus, the side ridges in Relaxo's footwear, are, to our mind capable of imparting novelty to the suit designs. The ridges are undoubtedly a feature which is outside the normal shape of the *hawai* slipper and a majority of *hawai* slippers do not have such ridges. Subject, of course, to their satisfying the test of novelty *vis-à-vis* prior art, the side ridges on the suit designs could definitely be regarded as novel, so as to make the designs themselves registrable. They have a distinct aesthetic appeal apart from the general shape and contours of the slipper itself.

19.14 Re. Allegation of lack of Aesthetic Appeal

19.14.1 One of the arguments advanced in the written submissions filed by Aqualite is that the suit designs are invalid as they lack aesthetic appeal. There is, as Aqualite would contend, 'nothing special' in the suit designs.

19.14.2 We cannot agree. Whether a design is, or is not, aesthetically appealing, is a matter of entirely subjective personal opinion. No test, set in crystal, exists, to assess aesthetic appeal. That which is appealing to one may appear grotesque to the other. Beauty, after all, lies in the eyes of the beholder.

19.14.3 Besides, it is not necessary for a design to be registrable, that it must be beautiful or even aesthetically appealing. All that is required is that, it must possess a distinct visual appeal. That appeal itself may be positive or negative.

19.14.4 In fact, it is very difficult, to our mind, to regard a design as not registrable because of want of aesthetic appeal. We have seen, in our experience, design registrations of items as simple as common bottles, which have no aesthetic appeal, as classically understood, whatsoever. So long, therefore, as the shape, configuration or other elements included in the definition of "design" in Section 2(d) of the Designs Act are not merely utilitarian or functional in nature, they would ordinarily be registrable as designs.

19.14.5 In any event, we cannot agree with the contention of Aqualite, as urged in its written submissions and in its appeal, that, owing to want of aesthetic appeal, the suit designs were not registrable. Ms. Sukumar, quite fairly, did not plead this issue during arguments.

19.15 Novelty *vis-à-vis* prior art, and prior publication

19.15.1 Which brings us to the main issue in controversy, which is whether the suit designs are vulnerable to cancellation under Section 19 of the Designs Act, either because they are not novel *vis-à-vis* prior art or because they have been published prior in point of time.

19.15.2 For this purpose, we are required to examine the suit designs *vis-à-vis* Prior Arts 1, 2 and 5 to 7.

19.15.3 The definition of "design", in the Designs Act,

specifically requires a design to be capable of being applied to an article. In its judgment in ***Bharat Glass Tube***, the Supreme Court has held that before pronouncing on a design infringement action, or even examining the validity of the asserted design *vis-à-vis* prior art, the Court should, if possible, examine the articles themselves, to which the designs have to be applied. The relevant paragraph from ***Bharat Glass Tube*** may be reproduced thus:

> "41. One has to be very cautious, unless two articles are simultaneously produced before the court then alone the court will be able to appreciate. But in the present case no design reproduced on glass sheets was either produced before the Assistant Controller or before the High Court or before us by the appellant to appreciate the eye appeal. The appellant could have produced the design reproduced on glass sheet it manufactured in the United Kingdom or Germany. That could have been decisive."

19.15.4 It is also a settled proposition that whether comparing the defendants' article with the plaintiff's design for the purpose of infringement or comparing the plaintiff design with prior art in the face of a Section 22(3) defence, the perception would be from the point of view of an "instructed eye". This is a stark departure from the principles which apply in trade mark law, where infringement is to be assessed from the point of view of a person "of average intelligence and imperfect recollection", or in patent law, where the lady in question is a person "skilled in the art". The person from whose point of view - both literally as well as figurately – the comparisons are to be made in the case of a design infringement action, is not a person who is either of average intelligence or of imperfect recollection. Her eye is instructed. In other words, she is a person who is aware of prior art and of the features of prior art. She, therefore, is in a position to

assess whether the asserted suit design is or is not novel *vis-à-vis* prior art, of the features of which she is wholly aware. This position, as it emerges from the judgment of the Division Bench of this Court in ***B. Chawla***, has also been reiterated by one of us (C. Hari Shankar, J.) sitting singly in ***TTK Prestige***, thus:

> "116. ***B. Chawla & Sons*** **v** ***Bright Auto Industries***
>
> 117. The issue arising before the Division Bench of this Court in ***B. Chawla*** was whether the decision of B. Chawla in respect of a mirror was a "new and original" design. Para 4 of the report identified the basis of the claim of novelty by B. Chawla in the design, thus:
>
> > "4. The novelty in the design in question, admittedly, is on account of the further curve in the sloping upper length side as it is not disputed that rear view mirrors, rectangular in shape with rounded edges, width side curved or slopping and the lower length side also slopping are commonly available in the market."
>
> 118. In conjunction with the above, para 7 of the report identified the scope of inquiry before the court, on the aspect of novelty, thus:
>
> > "7. Akil Ahmed, partner of the respondent, and his witnesses, Jagjit Singh, Rajendra Singh and Sultan Singh submitted affidavits before the learned single Judge swearing that appellants' mirror was a common type rectangular mirror with a slight curve on the upper side and such like mirrors were available in the market. They also swore that there was no newness nor originality about the design. Mr. Anoop Singh, learned counsel for the respondents, has frankly conceded that no documentary or material evidence showing the availability of rectangular mirrors having a curve on either side in the slopping upper length side has been brought on the record and he would not press that mirrors of such like designs were actually available in the market at the time the appellants brought out their product in the market. Thus, *we are left with the only consideration whether a further curve on either side in the slopping upper length side makes the design in respect of rear view mirror a new or original design which the appellant were entitled to get registered and which is not*

liable to cancellation under Section 51-A of the Act"
(Emphasis supplied)

119. Thereafter, paras 8 to 10 of the report read as under:

"8. In ***Le May v Welch***[21], Bowen L.J. expressed the opinion:

> "It is not every mere difference of cut" - he was speaking of collars "Every change of outline, every change of length, or breadth, or configuration in a single and most familiar article of dress like this, which constitutes novelty of design. To hold that would be to paralyse industry and to make the Patents, Designs and Trade Marks Act a trap to catch honest traders. There must be, not a mere novelty of outline, but a substantial novelty in the design having regard to the nature of the article."

And Fry L.J. observed:

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

9. *Similar view was expressed by Buckley L.J. on the question of quantum of novelty* in ***Simmons***[22] at 494 in these words:

> *"In order to render valid, the registration of a Design under the Patents and Designs Act, 1907, there must be novelty and originality, it must be a*

[21] **LR 28 Ch 24**
[22] **(1911) 28 RPC 486**

new or original design. To my mind, that means that there must be a mental conception expressed in a physical form which has not existed before, but has originated in the constructive brain of its proprietor and that must not be in a trivial or infinitesimal degree, but in some substantial degree".

10. In ***Phillips v Harbro***[23], Lord Moulton observed that *while question of the meaning of a design and of the fact of its infringement are matters to be Judged by the eye, (sic) it is necessary with regard to the question of infringement, and still more with regard to the question of novelty or originality, that the eye should be that of an instructed person, i.e., that he should know what was common trade knowledge and usage in the class of articles to which the design applies. The introduction of ordinary trade variants into an old design cannot make it new or original. He went on to give the example saying, if it is common practice to have, or not to have, spikes in the soles of running shoes a man does not make a new and original design out of an old type of running shoes by putting spikes into the soles. The working world, as well as the trade world, is entitled at its will to take, in all cases, its choice of ordinary trade variants* for use in any particular instance, and no patent and no registration of a design can prevent an ordinary workman from using or not using trade knowledge of this kind. It was emphasized that it is the duty of the Court to take special care that *no design is to be counted a "new and original design" unless it is distinguished from what previously existed by something essentially new or original which is different from ordinary trade variants which have long been common matters of taste workman who made a coat (of ordinary cut) for a customer should be left in terror whether putting braid on the edges* of the coat in the ordinary way so common a few years ago, or increasing the number of buttons or the like, would expose him for the prescribed years to an action for having infringed a registered design. On final analysis, it was emphasized that the use of the words 'new or original' in the statute is intended to prevent this and that the introduction or substitution of ordinary trade variants in a design is not only insufficient to make the design "new or original" but that it did not even contribute to give it a new or original character. If it is not new or original without them the presence of them cannot render it so."

[23] **(1920) 37 RPC 233**

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

120. From ***B. Chawla***, therefore, the following principles emerge:

> (i) Trivial changes would not render the design new or original.
>
> (ii) Infringement and novelty are both to be tested by the instructed eye, which is aware of prior art.
>
> (iii) Introduction of ordinary trade variants did not render a design new or original.
>
> (iv) The court was required to strike a balance, by recognising the competing interests of novelty and originality being required to achieve statutory recognition and the interest of the trade and the rights of the person engaged in the trade, both of which were required to be protected."

19.15.5 This distinction is of fundamental significance, especially when considering the novelty of the suit design *vis-à-vis* prior art. A person of average intelligence and imperfect recollection may not recollect all the specific features of the prior art. At the same time, the instructed eye, which is aware of the novel features of prior art would be much better equipped to assess as to whether the suit design is novel *vis-à-vis* prior art.

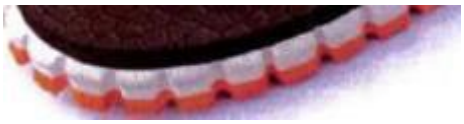
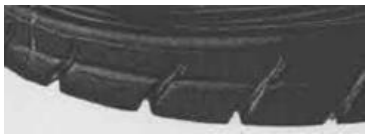
19.15.6 We, therefore, have to examine the aspect of novelty of the suit designs, in the present case, *vis-à-vis* the prior art on which Ms. Sukumar relies, from the point of view of an instructed eye, i.e., an eye which is aware of the specific features of the said prior arts.

19.15.7 Though the photographs which are available on record, of the prior arts are themselves sufficiently clear and make out their essential features we, nonetheless, were also shown physical samples of the footwear forming subject matter of Prior Arts 1 and 2. We have also closely perused the features of Prior Arts 5 to 7, as filed by Aqualite under the Index dated 1 June 2021, which we have also reproduced in para 9.4 *supra*.

19.15.8 Having done so, we are unable to convince ourselves that there is lack of novelty in the suit designs, *vis-à-vis* the said prior arts. The shape of the ridges in the footwear forming subject matter of the suit designs is distinct, and is different from the ridges in the footwear forming subject matter of Prior Arts 1, 2 and 5 to 7. In the case of the footwear forming subject matter of Prior Arts 1 and 2, the vertical outer surface of the Hawai slippers have a more saw like structure, unlike the rectangular "crenellation-shaped" ridges which are present in the footwear forming subject matter of the suit designs. In visual appeal, there is a clear and stark difference between the two designs.

19.15.9 Equally, the ridges on the vertical outer surfaces of the footwear forming subject matter of the prior art designs 5 to 7 are different in appearance from the ridges on the vertical outer surfaces of the footwear forming subject matter of suit designs. This is clear

when one compares the footwear forming subject matter of the suit designs with the footwear forming subject matter of Prior Arts 5 to 7, for which purpose, we may provide a comparative table thus, of the side ridges on the suit designs *vis-à-vis* the side ridges in Prior Art 5:

Side ridges on the footwear relating to the suit designs	**Side ridges on the footwear relating to Prior Art 5**
	

19.15.10 Besides, the Registration Certificates relating to Designs 325071 and 325074 certify that novelty resides in the shape, configuration *and* surface pattern. When these design elements, in the suit designs, are cumulatively compared with Prior Arts 5 to 7, there is clearly no similarity between them whatsoever. In fact, Prior Arts 5 to 7 are not even *hawai* slippers.

19.15.11 Comparison of the suit designs, for the purposes of novelty, *vis-à-vis* prior art, is an entirely subjective exercise, which essentially depends on the discretion of the Court. We, in appeal against the decision of the learned Single Judge, are circumscribed in our power to interfere with the exercise of such discretion, given the principles contained in the following passages from ***Wander Ltd v Antox India (P) Ltd***[24]:

> "14. The appeals before the Division Bench were against the exercise of discretion by the Single Judge. *In such appeals, the*

[24] **1990 Supp SCC 727**

> *appellate court will not interfere with the exercise of discretion of the court of first instance and substitute its own discretion except where the discretion has been shown to have been exercised arbitrarily, or capriciously or perversely or where the court had ignored the settled principles of law regulating grant or refusal of interlocutory injunctions. An appeal against exercise of discretion is said to be an appeal on principle. Appellate court will not reassess the material and seek to reach a conclusion different from the one reached by the court below if the one reached by that court was reasonably possible on the material. The appellate court would normally not be justified in interfering with the exercise of discretion under appeal solely on the ground that if it had considered the matter at the trial stage it would have come to a contrary conclusion. If the discretion has been exercised by the trial court reasonably and in a judicial manner the fact that the appellate court would have taken a different view may not justify interference with the trial court's exercise of discretion.* After referring to these principles Gajendragadkar, J. in ***Printers (Mysore) Private Ltd. v Pothan Joseph***[25]:
>
> > "... These principles are well established, but as has been observed by Viscount Simon in ***Charles Osenton & Co. v Jhanaton***[26] '...the law as to the reversal by a court of appeal of an order made by a judge below in the exercise of his discretion is well established, and any difficulty that arises is due only to the application of well settled principles in an individual case'."

The ***Wander*** dictum has been recently reiterated, by the Supreme Court, in ***Pernod Ricard India (P) Ltd v Karanveer Singh Chhabra***[27].

19.15.12 Nonetheless, as the learned Single Judge has not really provided any cogent reason as to why he finds the suit designs novel *vis-à-vis* prior art, we have ourselves perused the suit designs, perused the prior art documents as well as, in the case of the Prior Arts 1 and 2, the footwear themselves, and satisfied ourselves that there is novelty in the crenellation-like side ridges on the vertical outer surface

[25] **AIR 1960 SC 1156**
[26] **1942 AC 130**
[27] **2025 SCC OnLine SC 1701**

of the suit designs, vis-a-vis the ridges on the vertical outer surface of the prior art footwear.

19.15.13 We, therefore, do not find any cause to differ with the decision of the learned Single Judge that the suit designs are not lacking in novelty *vis-à-vis* the prior art documents.

19.15.14 As the same prior art forms subject matter of the claim of prior publication, the suit designs can also not be treated as vulnerable to cancellation by reason of their having been prior published in point of time.

19.16 We, therefore, are in agreement with the learned Single Judge that the suit designs were not invalid *vis-à-vis* prior art, under clauses (b) and (c) of Section 19(1) of the Designs Act.

Conclusion

20. As

(i) Aqualite's footwear is identical, in shape and configuration, to the footwear forming subject matter of the suit designs, and

(ii) the registration of the suit designs is not, *prima facie,* liable to cancellation under Section 19 of the Designs Act,

the learned Single Judge has, to our view, correctly injuncted Aqualite from manufacturing or dealing in footwear which replicates the suit designs or is deceptively similar, in design, thereto.

21. The appeal is, therefore, devoid of merit and is accordingly dismissed, with no orders as to costs.

C. HARI SHANKAR, J.

OM PRAKASH SHUKLA, J.

NOVEMBER 18, 2025
AR/DSN/AKY/YG