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IN THE HIGH COURT OF DELHI

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CO. 15/1996

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Date of decision : 27.09.2005

M/s A.C. Footwear Co. & Anr. ... Petitioners

through : Mr. Alok Shukla, Advocate.

- VERSUS -

M/s Deiem (India) Pvt. Ltd. & Anr. ... Respondents

through : None

CORAM:

HON'BLE MR. JUSTICE SANJAY KISHAN KAUL

1. Whether the Reporters of local papers may be allowed to see the judgment? *Yes*

2. To be referred to Reporter or not? *Yes*

3. Whether the judgment should be reported in the Digest? *Yes*

JUSTICE SANJAY KISHAN KAUL (Oral)

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1. The petitioner has filed this petition under Section 51A of the Designs Act, 1911 (hereinafter referred to as the '1911 Act') for cancellation of design No.166627 of respondent No.1.

2. The respondents have entered appearance and have

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Signature Not Verified

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filed their written statement.

3. However, the respondents were subsequently proceeded ex parte on 22.11.2004.

4. The subject matter of dispute is the design in respect of the sole of the shoe which has been registered with the Controller of Patents and Designs, Calcutta. It is the submission of the petitioner that design ought not to have been registered in view of the dual plea : firstly that the design has been previously registered in India and secondly the design is not a new or an original design.

5. The plea raised by the respondents is that the petitioner was pirating the design of respondent No.1 which was original.

6. Before proceeding on the merits of the controversy, it would be relevant to take note of the fact that the 1911 Act stands repealed by the Design Act, 2000 (hereinafter referred to as the '2000 Act'). Section 48 of the 2000 Act deals with repeals and savings and sub-section (4) provides that nothing contained in the Act of 2000 would affect the proceedings pending in any Court at the commencement of the Act under the 1911 Act and those proceedings be continued as if the 2000 Act had not been passed. The corresponding provision to Section 51A of 1911 Act dealing

with cancellation of registration is Section 19 of 2000 Act where the ambit and scope has been expanded and additional grounds have been added.

7. Learned counsel for the petitioner submits that a learned Single Judge of the Bombay High Court had the occasion to consider the effect of this repeal provision of 2000 Act in Faber Castell Aktiengesellschaft Vs. Pikpen (P) Ltd. 2003 (27) PTC 538.

The relevant Section 48 is as under :

"48.Repeal and Savings.-

- (1)The Design Act, 1911 (2 of 1911) is hereby repealed.
- (2)Without prejudice to the provisions contained in the General Clauses Act, 1897 (10 of 1897) with respect to repeals, any notification, rule, order, requirement, registration, certificate, notice, decision, determination, direction, approval, authorisation, consent, application, request or thing made, issued, given or done under the Designs act, 1911 (2 of 1911), shall, in force at the commencement of this Act, continue to be in force and have effect as if made, issued, given or done under the corresponding provisions of this Act.
- (3)The provisions of this act shall apply to all applications for registration of designs pending at the commencement of this Act and to any proceedings consequent thereon and to any registration granted in pursuance thereof.
- (4)Notwithstanding any contained in this Act, any proceeding pending in any court at the commencement of this Act may be continued in that court as if this Act has not been passed.

(5) Notwithstanding anything contained in sub-section (2), the date of expiration of the copyright in the designs registered before the commencement of this Act shall, subject to the provisions of this Act, be the date immediately after the period of five years for which it was registered or the date immediately after the period of five years for which the extension of the period of copyright for a second period from the expiration of the original period has been made.

8. It was held in the aforesaid judgment that as regards the registration done under the Old Act, sub-section (2) of Section 48 of the 2000 Act lays down that the registration shall continue to be in force and have the effect as if done under the corresponding provisions of the new Act. Thus the intention of the Parliament was that all other things done under the Old Act of 1911 can be continued to be in force and have effect as made under the provisions of the new Act of 2000. The only exception made is sub-section (4) of Section 48 which provides that any proceedings pending in any Court at the commencement of the new Act may be continued in that Court as if the new Act has not been passed. It was thus held that the intent of the Parliament was that the scrutiny of the matter will take place under the new Act but the proceedings would continue under the Old Act with the object to ensure that those proceedings are not terminated or have to start

anew.

9. I am in agreement with the view taken by the learned Judge.

10. The aforesaid being the position, it is Section 19 of 2000 Act which will govern the matter in question which is as under :

"19.Cancellation of registration

(1) Any person interested may present a petition for the cancellation of the registration of a design at any time after the registration of the design, to the Controller on any of the following grounds, namely :-

(a) that the design has been previously registered in India; or

(b) that it has been published in India or in any other country prior to the date of registration; or

(c) that the design is not a new or original design; or

(d) that the design is not registerable 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."

11. It may also be relevant to note that in so far as present

matter is concerned, really speaking it makes no difference whether the same is considered under the provisions of the old Act or the new Act and this would be apparent from the provisions of Section 51A of 1911 Act which is as under :

"51A. Cancellation of registration -

(1) Any person interested may present a petition for the cancellation of the registration of a design -

(a) at any time after the registration of the design, to the High Court on any of the following grounds, namely :-

(i) that the design has been previously registered in India; or

(ii) that it has been published in India prior to the date of registration; or

(iii) that the design is not a new or original design; or

(b) within one year from the date of the registration to the Controller on either of the grounds specified in sub-clause (i) and (ii) of Clause (a).

(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."

12. It is thus clear that in so far as provisions relating to the previous registration in India or the design not being new or original remains the same.

13. In my considered view, what has to be seen is whether there was any earlier registration of design as alleged by the petitioner. It may be noted that issues were framed on 22.11.2004 which are as under :-

“1. Whether Registered Design No.166627 is liable to be cancelled on the grounds stated in the petition?

2. Relief.

14. Issue No.1

The petitioner is claiming cancellation of the registration of design No.166627 on the dual grounds as mentioned above and has filed the affidavit of evidence in support of the allegations made in the petition. Thus the question to be considered would be whether there is another design already registered which is identical to the design registered of petitioner. In this behalf, allegation has been made by the petitioner that the identical design in question is of M/s Phoenix Overseas Limited under registration No.164739 which is prior to the registration of the design of respondent No.1. The design of M/s Phoenix Overseas is valid from 2nd September, 1992 while that of defendant No.1 from 29th December, 1993. The petitioner has produced the design of M/s Phoenix Overseas Limited along with a copy of the certificate

of registration. A comparison of the soles of the two designs shows that they are practically identical. The grooves in the sole are placed in the identical position and the pattern is also identical. There is V groove and the circular groove on the front portion of the shoe and dotted groove near the heel. Placement of the groove is also identical.

15. In view of the aforesaid, it is apparent that the provisions of Clause 2 of sub-section (1) of Section 19 of the 2000 Act, would come into play since the design of defendant No.1 ought not to have been registered in view of the prior registration of the design of M/s Phoenix Overseas Limited. Needless to say that if there is already a registered design, there can hardly be originality in the design of respondent No.1 and to that extent clause (c) of sub-section (1) of Section 19 will follow as a consequence of clause (a) of sub-section (1) of Section 19 of 2000 Act.


16. In view of the aforesaid, the registration and design of respondent No.1 being 166627 is directed to be cancelled and respondent No.2 is directed to strike off the said design from the Register of Designs.

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17. The petition stands disposed of leaving the parties to their own costs.

18. A copy of this order be forwarded to respondent No.2. The new address of respondent No.2 is filed in Court and is taken on record.

September 27, 2005
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SANJAY KISHAN KAUL, J.