



## *IP Laws Declared by the Supreme Court*

### Design Law Declared by the Supreme Court of India

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By virtue of Article 141 of the Constitution of India (*hereinafter*, the Constitution), the law declared by the Supreme Court of India (*hereinafter*, the Supreme Court) is the law of the land. The Supreme Court furtherance to its law-declaring power under Article 141 of the Constitution has declared design law only in three decisions. This Paper seeks to cull out the principles of design law declared by the Supreme Court in the last 72 years. There are only three reported decisions of the Supreme Court on the design law of which two are Division Bench decisions and one is Full Bench decision. Number of decisions per year is not even one. On an average, the Supreme Court has decided 4 cases in a year, or one design case in 8,836.66 days or in 24.21 years. Since the number of reported decisions is very less so only few questions of design law have been answered by the Supreme Court. A review of decisions of the Supreme Court on the design law reveals that: (i) unlike the patent and copyright decisions, the Supreme Court has declared the design law in all the three reported decisions; (ii) no case is reported in which the constitutionality of The Designs Act, 2000 was challenged; (iii) no Constitution Bench or Single Bench decision is reported; (iv) no Chief Justice of India was on the bench in any decision; (v) the Court has unanimously declared the design law; and (vi) no dissenting or concurring judgment is reported.

**Keywords:** Design Law, Supreme Court of India, Law Declared, Article 141, The Constitution of India, The Designs Act, 1911, The Designs Act, 1957, Interpretation-Construction, Constructed Meaning, Principles, Bench, Decisions, Dissenting, Concurring, New, Original, Registration, Cancellation, Transfer of Suit, The Commercial Courts Act, 2015

This Paper is in continuation to the papers '*Patent Law Declared by the Supreme Court of India*'<sup>1</sup> and '*Copyright Law Declared by the Supreme Court of India*'<sup>2</sup> published in the *Journal of Intellectual Property Rights (JIPR)*. This is the third paper on the theme but covers the design law declared by the Supreme Court of India. In this Paper, an attempt has been made to analyze the reported decisions<sup>3</sup> of the Supreme Court of India (*hereinafter*, the Supreme Court) from the date of its establishment *i.e.*, 28 January 1950 till 28 August 2022 to find what questions of design law have been answered and what principles of design law have been declared by the Court in the last 72 years. The Designs Act, 2000<sup>4</sup> (*hereinafter*, The Designs Act) is the fourth intellectual property rights (*hereinafter*, IPRs) legislation enacted in the Independent India. Before coming into force of The Designs Act, the design cases were governed under the provisions of The Patents and Designs Act, 1911.<sup>5</sup>

The Supreme Court has delivered a total of three direct decisions on The Designs Act, 2000 in the last 72 years (till 28 August 2022). The Court has used the

title of The Designs Act in four<sup>6</sup> other decisions but they are only just a reference to the title of the Act or the title as used in the provisions of the other statutes. Number of decisions per year is not even one. On an average .04 (point zero four) case has been decided in a year, or in 8,836.66 days [24.21 (point two one) years] one design case has been decided. Hence, only few questions of design law have been answered by the Supreme Court.

Out of three reported decisions on design law, one is Full Bench decision and two are Division Bench decisions. Out of these three decisions, 1 Division Bench decision is from the first decade of this century, 1 Division Bench decision is from the second decade, and the remaining a Full Bench decision, is from the third decade. No matter dealing with the interpretation of determination of question on The Designs Act was placed before the Constitution Bench or the Single Bench. Hence, no decision of these two benches of the Court. All the three decisions of the Court are unanimous decisions. Hence, no dissenting or concurring opinion of the judges.

In total, six judges were on the bench in these three decisions. No sitting Chief Justice of India was on the

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bench in any decision dealing with The Copyright Act. Justice Altamas Kabir was the only judge who was on the bench in two cases (both Division Bench) and authored one judgment. Justice A. K. Mathur was on the bench (Division) in only one case and authored one judgment. Justice Cyriac Joseph was on the bench (Division) in only one case and did not author the judgment. Justices L. Nageswara Rao and Ajay Rastogi were on the bench (Full Bench) in only one case and did not author any judgment.

### Design Law Declared by the Supreme Court

The first reported judgment of the Supreme Court on The Designs Act is *Bharat Glass Tube Limited v Gopal Glass Works Limited*<sup>7</sup> and the latest decision is *S D Containers Indore v Mold Tek Packaging Ltd.*<sup>8</sup> In all the three decisions, the Supreme Court has declared design law.

*Bharat Glass Tube Limited v Gopal Glass Works Limited*,<sup>7</sup> is a Division Bench decision of the Supreme Court. The unanimous judgment of the Court was penned down by Justice A. K. Mathur. The Court while deciding the question whether the design (in issue) is new and original, observed referring to the purpose of The Designs Act as:

*[T]he sole purpose of this (Designs) Act is protection of the intellectual property right of the original design for a period of ten years or whatever further period extendable. The object behind this enactment is to benefit the person for his research and labour put in by him to evolve the new and original design. This is the sole aim of enacting this Act. It has also laid down that if design is not new or original or published previously then such design should not be registered.*<sup>9</sup>...It further lays down that if it 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 then such design will not be registered or if it is found that it is not significantly distinguishable from known designs or combination of known designs, then such designs shall not be registered.<sup>10</sup>

The Court also observed on the question when the registration can be cancelled:

*[U]nder Section 19 of the Act if proper application is filed before the competent authority i.e., the Controller that the design has been previously registered in India or published in India or in any*

*other country prior to the date of registration, or that the design is not a new or original design or that the design is not registerable under this Act or that it is not a design as defined in Clause (d) of Section 2. The Controller after hearing both the parties if satisfied that the design is not new or original or that it has already been registered or if it is not registerable, cancel such registration and aggrieved against that order, appeal shall lie to the High Court. These prohibitions have been engrafted so as to protect the original person who has designed a new one by virtue of his own efforts by researching for a long time.*<sup>11</sup>

As to the nature of protection of design as IPRs, the Court also declared:

*'The new and original design when registered is for a period of ten years. Such original design which is new and which has not been available in the country or has not been previously registered or has not been published in India or in any other country prior to the date of registration shall be protected for a period of ten years. Therefore, it is in the nature of protection of the intellectual property right. This was the purpose as is evident from the statement of objects and reasons and from various provisions of the Act.*<sup>11</sup>

As to the question whether the design which was registered on the application filed by the respondent can be cancelled or not on the basis of the application filed by the appellant, the Court answered:

*'The expression, "new or original" appearing in Section 4 means that the design which has been registered has not been published anywhere or it has been made known to the public. The expression, "new or original" means that it had been invented for the first time or it has not been reproduced by anyone.*<sup>12</sup>

The Court also clarified the definition of "design" as defined under the Designs Act in the light of other provisions of the Act:

*'Design...Section 2(d)...means that a feature of shape, configuration, pattern, ornament or composition of lines or colours applied to any article whether in two dimensional or three dimensional or in both forms, by any industrial process. That means that a feature or a pattern which is registered with the registering authority for being produced on a particular article by any industrial process whether manual, mechanical or chemical or by any other means which appears in a finished article and which can be judged solely by eye appeal.*<sup>12</sup>

*'The definition of design as defined in Section 2(d) read with application for registration and Rule 11 with*

Form 1 makes it clear that the design which is registered is to be applied to any finished article which may be judged solely by eye appeal.<sup>12</sup>

‘A conjoined reading of...provisions makes it clear that a particular shape or a particular configuration is to be registered which is sought to be produced on any article which will have visual appeal. Such design once it is registered then it cannot be pirated by any other person.’<sup>12</sup>

The Court also declared as to the definition of “proprietor” as defined under the Designs Act:

‘Proprietor as defined in Section 2(j) of the Act means that any person who acquires the design or right to apply the design to any article, either exclusively of any other person or otherwise, means, in the respect and to the extent in and to which the design or right has been so acquired.’<sup>12</sup>

As to the registrability of design and its protection, the Court observed:

‘Section 4 clearly says that the Controller will only register a design on application made under Section 5 by the proprietor of any new or original design not previously published in any country and which is not contrary to public order or morality and it further says that this application shall be in a prescribed form and the prescribed form has been given in Form 1. Form 1 clearly says that the design is to be applied.’<sup>13</sup>

‘[F]or registration of a particular configuration or particular shape of thing which is sought to be reproduced on a particular article has to be applied.’<sup>14</sup>

‘[W]hat is sought to be protected is that the design which will be reproduced on the roller by way of mechanical process and that design cannot be reproduced on glass by anybody else.’<sup>15</sup>

The Court also explained the concept of design in the following words:

‘[T]he concept of design is that a particular figure conceived by its designer in his mind and it is reproduced in some identifiable manner and it is sought to be applied to an article. Therefore, whenever registration is required then those configuration has to be chosen for registration to be reproduced in any article. (*Sick*) The idea is that the design has to be registered which is sought to be reproduced on any article. Therefore, both the things are required to go together, *i.e.*, the design and the design which is to be applied to an article.’<sup>16</sup>

*Godrej Sara Lee v Reckitt Benckiser Australia Pty Ltd*,<sup>17</sup> is a Division Bench decision of the Supreme Court. The unanimous judgment of the Court was

delivered by Justice Altamas Kabir. In this case, the interpretation of the expression ‘High Court’ as used in Sections 19 (2) and 22 (4) of The Designs Act, 2000, and Section 51A of The Designs Act, 1911 was placed for consideration before the Court. The Court declared:

‘In contrast to the provisions of Section 51A(1)(a) of the 1911 Act, Section 19 (1) of the 2000 Act, which also deals with cancellation of registration, provides for a petition for cancellation of registration of a design to be filed before the Controller and not to the High Court. On a comparison of the two provisions of the two enactments, it will be obvious that under the 2000 Act the intention of the Legislature was that an application for cancellation of a design would lie to the Controller exclusively without the High Court having a parallel jurisdiction to entertain such matters. It is also very clear that all the appeals from any order of the Controller under Section 19 of the 2000 Act shall lie to the High Court. The basic difference,...is that while under Section 19 of the 2000 Act an application for cancellation would have to be made to the Controller of Designs, under Section 51A of the 1911 Act an application could be preferred either to the High Court or within one year from the date of registration to the Controller on the grounds specified under sub-clauses (i) and (ii) of Clause (a) of Section 51A(1).’<sup>18</sup>

‘Under Section 19 of the 2000 Act the power of cancellation of the registration lies wholly with the Controller. On the other hand, an application for cancellation of a design could be made directly to the High Court under Section 51A of the 1911 Act. Under the 2000 Act, the High Court would be entitled to assume jurisdiction only at the appellate stage, whereas under Section 51A of the 1911 Act the High Court could itself directly cancel the registration’.<sup>18</sup>

‘[T]he question as to which High Court would have jurisdiction to entertain an appeal under Section 19, had to be determined on the basis of the statutory provisions and not on the basis of *dominus litus* or the *situs* of the Appellate Tribunal or the cause of action.’<sup>19</sup>

*S D Containers Indore v Mold Tek Packaging Ltd*,<sup>20</sup> a Full Bench decision, is the latest decision on design law. The unanimous judgment of the Court was delivered by Justice Hemant Gupta. The issue involved in this case was related to the transfer of suit. The Court settled the conundrum relating to transfer of design suit with respect to the provisions of The Commercial Courts Act, 2015,<sup>21</sup> by declaring the following:

“Commercial Dispute” within the meaning of Section 2(c)(xvii) of The Commercial Courts Act, 2015, includes the dispute pertaining to “intellectual property rights relating to registered and unregistered trademarks, copyright, patent, design, domain names, geographical indications and semiconductor integrated circuits.” *Therefore, disputes related to design are required to be instituted before a Commercial Court constituted under Section 3 of the said Act.*<sup>22</sup>

‘On the other hand, Section 4 of the 2015 Act provides that where the High Courts have ordinary original civil jurisdiction, a Commercial Division is required to be constituted. Further, in terms of Section 5 of the Act, a Commercial Appellate Division is required to be constituted. Section 7 of the Act deals with the suits and applications relating to the commercial disputes of a specified value filed in the High Court having ordinary original jurisdiction, whereas, the second proviso contemplates that all suits and the applications transferred to the High Court by virtue of sub-section (4) of Section 22 of 2000 Act shall be heard and disposed of by the Commercial Division of the High Court in all the areas over which the High Court exercises ordinary original civil jurisdiction’.<sup>23</sup>

‘It is pertinent to mention that Section 7 of the 2015 Act only deals with the situation where the High Courts have ordinary original civil jurisdiction. There is no provision in the 2015 Act either prohibiting or permitting the transfer of the proceedings under the 2000 Act to the High Courts which do not have ordinary original civil jurisdiction. Further, Section 21 of the 2015 Act gives an overriding effect, only if the provisions of the Act have anything inconsistent with any other law for the time being in force or any instrument having effect by virtue of law other than this Act. Since the 2015 Act has no provision either prohibiting or permitting the transfer of proceedings under the 2000 Act, Section 21 of the 2015 Act cannot be said to be inconsistent with the provisions of the 2000 Act. It is only the inconsistent provisions of any other law which will give way to the provisions of the 2015 Act. In terms of Section 22(4) of the 2000 Act, the defendant has a right to seek cancellation of the design which necessarily mandates the Courts to transfer the suit.’<sup>24</sup>

‘The transfer of suit is a ministerial act if there is a prayer for cancellation of the registration. In fact, transfer of proceedings from one Bench to the

Commercial Division...if a suit is to be transferred to Commercial Division of the High Court having ordinary original civil jurisdiction, then the Civil Suit in which there is plea to revoke the registered design has to be transferred to the High Court where there is no ordinary original civil jurisdiction.’<sup>24</sup>

‘[I]n the 2000 Act, there are two options available to seek revocation of registration. One of them is before the Controller, appeal against which would lie before the High Court. Second, in a suit for infringement in a proceeding before the civil court on the basis of registration certificate, the defendant has been given the right to seek revocation of registration. In that eventuality, the suit is to be transferred to the High Court in terms of sub-section (4) of Section 22 of the 2000 Act. Both are independent provisions giving rise to different and distinct causes of action.’<sup>25</sup>

## Conclusion

An analysis of the decisions on design law reveals that the Supreme Court has answered few substantial questions of design law by declaring law on those questions. The Court also interpreted-constructed some expressions of The Designs Act to give them a specific meaning within the scheme of the statute.

Had there been more number of reported decisions of the Supreme Court on the Design Law, more clarity on the same was expected from the Court. Nonetheless, the Court in these three decisions has cleared the some of the conundrums relating to the design law.

The Court interpreted-constructed the following expressions of The Designs Act as:

The expression, “new or original” appearing in Section 4 means that the design which has been registered has not been published anywhere or it has been made known to the public. (*Bharat Glass Tube Limited*)

The expression, “new or original” means that it had been invented for the first time or it has not been reproduced by anyone. (*Bharat Glass Tube Limited*)

The expression “Design” under Section 2(d) means that a feature of shape, configuration, pattern, ornament or composition of lines or colours applied to any article whether in two dimensional or three dimensional or in both forms, by any industrial process. (*Bharat Glass Tube Limited*)

The expression “design” means that a feature or a pattern which is registered with the registering authority for being produced on a particular article by

any industrial process whether manual, mechanical or chemical or by any other means which appears in a finished article and which can be judged solely by eye appeal. (*Bharat Glass Tube Limited*)

The definition of “design” as defined in Section 2 (d) read with application for registration and Rule 11 with Form 1 makes it clear that the design which is registered is to be applied to any finished article which may be judged solely by eye appeal. (*Bharat Glass Tube Limited v Gopal Glass Works Limited*)

The expression “Proprietor” as defined in Section 2(j) of the Act means that any person who acquires the design or right to apply the design to any article, either exclusively of any other person or otherwise, means, in the respect and to the extent in and to which the design or right has been so acquired. (*Bharat Glass Tube Limited*)

Following principles of design law may be culled out from the decisions of the Supreme Court:

The sole purpose of The Designs Act is protection of the intellectual property right of the original design for a period of ten years or whatever further period extendable in order to benefit the person for his research and labour put in by him to evolve the new and original design. (*Bharat Glass Tube Limited*)

The Controller only after hearing both the parties if satisfied may cancel such registration. Against such order of the Controller, the appeal shall lie to the High Court. (*Bharat Glass Tube Limited*)

A particular shape or a particular configuration is to be registered which is sought to be produced on any article which will have visual appeal. Such design once it is registered then it cannot be pirated by any other person. (*Bharat Glass Tube Limited*)

For registration of a particular configuration or particular shape of thing which is sought to be reproduced on a particular article has to be applied. (*Bharat Glass Tube Limited*)

What is sought to be protected is that the design which will be reproduced on the roller by way of mechanical process and that design cannot be reproduced on glass by anybody else. (*Bharat Glass Tube Limited*)

The concept of design is that a particular figure conceived by its designer in his mind and it is reproduced in some identifiable manner and it is sought to be applied to an article. Therefore, both the things are required to go together, *i.e.*, the design and the design which is to be applied to an article. (*Bharat*

*Glass Tube Limited*)

In contrast to the provisions of Section 51A(1)(a) of the 1911 Act, Section 19 (1) of The Designs Act, which also deals with cancellation of registration, provides for a petition for cancellation of registration of a design to be filed before the Controller and not to the High Court. On a comparison of the two provisions of the two enactments, it will be obvious that under The Designs Act the intention of the Legislature was that an application for cancellation of a design would lie to the Controller exclusively without the High Court having a parallel jurisdiction to entertain such matters. It is also very clear that all the appeals from any order of the Controller under Section 19 of the 2000 Act shall lie to the High Court. The basic difference is that while under Section 19 of The Designs Act an application for cancellation would have to be made to the Controller of Designs, under Section 51A of the 1911 Act an application could be preferred either to the High Court or within one year from the date of registration to the Controller on the grounds specified under sub-clauses (i) and (ii) of Clause (a) of Section 51A(1). (*Godrej Sara Lee*)

Under Section 19 of The Designs Act the power of cancellation of the registration lies wholly with the Controller. On the other hand, an application for cancellation of a design could be made directly to the High Court under Section 51A of the 1911 Act. Under the 2000 Act, the High Court would be entitled to assume jurisdiction only at the appellate stage, whereas under Section 51A of the 1911 Act the High Court could itself directly cancel the registration. (*Godrej Sara Lee*)

The question as to which High Court would have jurisdiction to entertain an appeal under Section 19, had to be determined on the basis of the statutory provisions and not on the basis of *dominus litus* or the *situs* of the Appellate Tribunal or the cause of action. (*Godrej Sara Lee*)

Commercial Dispute within the meaning of Section 2 (c) (xvii) of The Commercial Courts Act, 2015, includes the dispute pertaining to “intellectual property rights relating to registered and unregistered trademarks, copyright, patent, design, domain names, geographical indications and semiconductor integrated circuits.” Therefore, disputes related to design are required to be instituted before a Commercial Court constituted under Section 3 of the said Act. (*S D Containers Indore*)

Section 7 of The Commercial Courts Act, 2015 only deals with the situation where the High Courts have ordinary original civil jurisdiction. There is no provision in the 2015 Act either prohibiting or permitting the transfer of the proceedings under the 2000 Act to the High Courts which do not have ordinary original civil jurisdiction.

Section 21 of the 2015 Act gives an overriding effect, only if the provisions of the Act have anything inconsistent with any other law for the time being in force or any instrument having effect by virtue of law other than this Act.

Since The Commercial Courts Act, 2015 has no provision either prohibiting or permitting the transfer of proceedings under The Designs Act, Section 21 of The Commercial Courts Act cannot be said to be inconsistent with the provisions of The Designs Act. It is only the inconsistent provisions of any other law which will give way to the provisions of The Commercial Courts Act, 2015. In terms of Section 22(4) of the 2000 Act, the defendant has a right to seek cancellation of the design which necessarily mandates the Courts to transfer the suit. (*SD Containers Indore*)

The transfer of suit is a ministerial act if there is a prayer for cancellation of the registration. In fact, transfer of proceedings from one Bench to the Commercial Division if a suit is to be transferred to Commercial Division of the High Court having ordinary original civil jurisdiction, then the Civil Suit in which there is plea to revoke the registered design has to be transferred to the High Court where there is no ordinary original civil jurisdiction. (*SD Containers Indore*)

In The Designs Act, there are two options available to seek revocation of registration. One of them is before the Controller, appeal against which would lie before the High Court. Second, in a suit for infringement in a proceeding before the civil court on the basis of registration certificate, the defendant has been given the right to seek revocation of registration. In that eventuality, the suit is to be transferred to the High Court in terms of sub-section (4) of Section 22 of The Designs Act. Both are independent provisions giving rise to different and distinct causes of action. (*SD Containers Indore*)

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