

THE PATENT OFFICE, KOLKATA

The Designs Act, 2000

Section - 19

In the matter of Registered Design No. 273000
registered in the name of Parvesh Kamboj

And

In the matter of petition for cancellation of the
registered Design No. 273000 under Section 19
of the Designs Act 2000, filed by Groz
Engineering Tools Private Ltd.

Groz Engineering Tools Private Ltd. Petitioner/ Applicant for cancellation

--Versus--

Parvesh Kamboj Registered Proprietor/Respondent

DECISION

1. A petition for cancellation of registration of Design no. 273000 in Class 08-05 was presented under section 19 of the Designs Act, 2000 by Groz Engineering Tools Private Ltd. , an Indian company incorporated under the Indian Companies Act 1956, of having principal place of business at C-717, New Friends Colony, New Delhi-110065 .The said design was registered as of 24/06/2015 in respect of application of such design to 'Lubricating Equipment ' under class 08-05 in the name of Parvesh Kamboj, an Indian national having address at Plot No. 66/6, Industrial Area , N.I.T. Faridabad, Haryana. .

2. The grounds as presented by the petitioner under the section 19 of the Designs Act 2000 in support of the application for cancellation were:

- (a) That the design has been published in India or any other country prior to the date of registration;

(b) That the design is not a new or original design;

(c) That the design is not registrable under the Designs Act 2000.

3. It is the case of the petitioner that it is manufacturer and merchants of industrial equipment in India and engaged in manufacturing of products including engineering tools and equipment, fluid handling equipment, precision engineering equipment, professional hand tools, lubrication equipment, fuel equipment, air control units etc. and has been in operation since 1976. Petitioner is also certified companies under ISO 9001:2015 and ISO 14001:2015 & OHSAS 18001:2007. Petitioner's products are also show cased in the website www.groz-tools.com. It was submitted that the petitioner, in the year 2003, developed a drawing of grease bucket pump and introduced it in the market around October 18, 2003. Petitioner has applied for trademark registration in respect of the above shape under trademark application No. 3547316 in Class 07. Petitioner made improvements in their grease bucket pump in 2008 and commenced the use of the same around from August 01, 2008. Petitioner also applied for registration under trade mark application no. 3502874 in Class 06, 07& 08. It was stated that petitioner extensively advertises and promotes their grease bucket pump in exhibitions and by other sources of media. Petitioner submitted that respondent purchased products of petitioner including grease bucket pump and there had been an agreement signed between the petitioner and respondent on October 11, 2005. It was further submitted that thereafter since 2005, the respondent and its affiliate concern have been procuring grease bucket pumps from the petitioner. In and around March, 2017, petitioner learnt that respondent and its affiliate concern are unlawfully manufacturing and supplying grease bucket pump having shape that is identical or obvious imitation of shape applied by the petitioner, to third parties including clients of petitioner. Petitioner served cease and desist notice to respondent on March 07, 2017 in reply to which respondent, on March 11, 2017, replied to the notice. It was stated that respondent had also filed a trade mark application for the shape of goods under

application no. 3508594 dated 15/03/2017 under class 08. User affidavit in relation thereto states use of the trade mark since July 12, 2006. It was also submitted that along with the user affidavit, respondent submitted an invoice of grease bucket pump which reads as " Make GROZ, showing that the grease bucket pumps supplied by the respondent are those provide to them by the petitioner.

4. Petitioner submits that petitioner had come across the design registration of lubricating equipment under design no. 273000 in class 08-05 and the impugned design of the respondent is identical with or obvious imitation of the design of grease bucket pump of the petitioner being used since 2003. It was submitted that the petitioner is a person interested to file the petition for cancellation and impugned design is neither new nor original and further is an imitation of prior published and prior used design of grease bucket pump of the petitioner. It was stated that the impugned design ought not have been granted registration in view of provisions of Section 4 of the Designs Act, 2000. It is also submitted that respondent has also filed a trade mark application seeking right in the shape of the grease bucket pump for which the impugned design registration has been obtained. It was also submitted that respondent, in the said trade mark application, claimed date of first use of the shape of article as July 12, 2006 which is much prior to the date of registration of the impugned design registration. Petitioner further submits that the impugned design is not significantly distinguishable from known designs or combination of known designs.

5. Registered proprietor, in their counter statement and evidence filed under Rule 29(3) of the Design Rules, stated that respondent started in the year 1984 with the dealing in hand tools, power tools, lubrication equipment etc. and is supplier to various OEMs like JCB, Escorts, Action Construction, etc. for tool kits and grease bucket pump. It had begged order from JCB in 2001/2002 for supply of grease bucket pump and due to not having infrastructure for making the same, it used to make the same at home. Around 2004, in order

to cope up with the demand, it had decided to get it prepared from the petitioner . It was stated that all the drawings and technical know-how for manufacturing the same was provided to the petitioner who in turn manufactured the same for the petitioner. Accordingly respondent entered an agreement with the petitioner in 2005 for supply of grease bucket pump. It was stated that though the parties had signed the agreement there was no consensus ad idem on the sale of the product by the petitioner. Reference was made to the condition stating that "GROZ" shall not approach M/s JCB(I) Ltd, Ballabgarh directly for sale of its products model BGP/10A. however "GROZ" can sell BGP/10A anywhere else in India. It was submitted that the petitioner was only manufacturing the product at the behest of the respondents and had no market of their own. In the year of 2015, respondent developed a new product under the design of which was specifically supplied to one of the major client of the respondent JCB and the said product was designed and developed solely for JCB. Upon approval of the design and testing, the respondent started producing the same for JCB in the year 2016 . In order to protect the novel design , the same was registered.

6. Generally denying the averments and statements of the applicant for cancellation, it was stated that petitioner is neither an interested party nor the design of the respondent is similar to that of the petitioner as claimed. It was stated that the alleged product grease bucket pump was being manufactured by the petitioner at the behest of the respondent. It was stated that grease bucket pump has been in existence since ages in India as well as abroad and the shape claimed by the petitioner is that of the respondent who after various modifications and improvement made the unique shape, however the same was further advanced in 2006 which is currently used by the defendant. It was denied that there was any shape earlier used by the plaintiff wherein improvements were made in 2008 and introduced another shape of grease bucket pump. The shape which the plaintiff is alleging was developed by defendant in the year 2006, wherein petitioner used to supply to the defendant as a manufacturer. It was

further stated that the said design was further added with addition of aesthetic values and a new design was introduced solely for JCB and for which design application was filed. It was stated that respondent reiterates the reply to legal notice of the petitioner regarding content of the said legal notice. It was submitted by the respondent that the cancellation petition is not maintainable as the respondent design is novel and distinctive in nature from that of respondents.

7. Petitioner, in their affidavit in reply to counter statement of respondent, denied the contentions and averments of respondent and stated that petitioner, in the year 2003 developed a drawing of grease bucket pump and introduced the same in the market in October 2003 and thereafter a modified version of grease bucket pump was introduced in the year 2008. Respondent approached the petitioner in 2005 for purchase of various goods including grease bucket pump as can be seen from the agreement between the parties. It was further submitted that till recently the respondent and its affiliate have been procuring crease bucket pumps and there had been several communications between them. Therefore the contention of the respondent, that there had been no ad idem between the parties, is denied.

8. It was further denied by the petitioner that the shape developed by the petitioner in the year 2008 was introduced by the respondent in the year 2006 and various companies in the market that use the same design as that of petitioner. It was stated that petitioner's design of grease bucket pump had already been introduced in the market prior to the alleged introduction of the bucket pump. It was further stated that the respondent, in their use affidavit of the trademark application, had claimed the impugned shape since 2006 and whereas the respondent applied for the design registration of the shape in question claiming it to be novel and original as on June 24, 2015. It was submitted that the impugned registration is not new and original design and is an obvious imitation of the prior published and used design of the grease bucket pump conceived by the petitioner as early as 2003.

9. Hearing on the said matter was scheduled to be held through video conferencing on 19/05/2022 which was attended only by learned counsel of petitioner, Mr. Davesh Vasistha. Next hearing through video conferencing was scheduled on 01/06/2022 where learned counsel of registered proprietor, Mr. Amarjeet Kumar, informed that he is not having the full set of documents and requested petitioner for the same. Next hearing was scheduled on 10/06/2022. After pleading, it was desired by the respondent to place samples of the concerned designs and petitioner consented for the same. Next hearing was held on 30/06/2022 where learned counsels from both sides, Mr. Davesh Vasistha and Mr. Amarjeet Kumar, appeared and petitioner also demonstrated the physical samples of the articles.

10. Upon consideration of the documents filed by the petitioner & respondent as well as the pleadings in the present proceeding, the following issues are considered to be decided –

- (a) Whether the petitioner is a person interested?
- (b) Whether the said design has been published in India or in any other country prior to the date of registration?
- (c) Whether the said design is not new or original design?
- (d) Whether the said design is not registrable under the Act?

11. Regarding the first issue whether the petitioner for cancellation is an interested person or not, it is observed that both the petitioner and registered proprietor are engaged in similar business. Considering the facts of the case as presented, it is opined that the petitioner instituted this proceeding in view of their observations as stated in the petition.

12. The registered design no. 273000, against which the present petition for cancellation has been filed, was registered as of 24/06/2015 for the article "Lubricating Equipment" under class 08-05. The representation accompanying the design consists of seven sheets depicting front view, back view, left side view, right side view, top view, bottom view and perspective view of the article in the consecutive sheets of representation. Novelty statement

is endorsed in each representation sheet as "Novelty resides in the shape, configuration and surface pattern of Lubricating Equipment as illustrated". Disclaimers were provided in respect of mechanical or other action of mechanism, or any mode or principle of construction of the article, words, letters, trademark, numerals and extraneous matter.

13. Design of an article consists features of shape, configuration, pattern, ornament or composition of lines or colours applied to the article whether in two dimensional or three dimensional or in both forms, by any industrial process or means, which in the finished article appeal to and are judged solely by the eye. A design is not registrable if it is previously registered in India and is not new or original and if it has been published in tangible form prior to its date of publication. In order to be registrable, a design should also be significantly distinguishable from known design or combination of known designs. It was pleaded by the petitioner that the impugned design has been copied from the petitioner's design already published in India. As per provisions of Section 4 (b) – a design shall not be registered 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. 'Publication' per se is not defined in the Design Act, 2000. In the matter of Gopal Glass Works Limited Vs. Asst. Controller of Patents & Designs. [2006 (33) PTC –434 (Calcutta)], it was stated that:

Para 41: To constitute prior disclosure by publication to destroy novelty of a registered design, the publication would have to be, in tangible form, of the design applied to the same article. Prior publication of a Trade catalogue, brochure, book, journal, magazine or newspaper containing photographs or explicit picture illustrations that clearly depict the application of the design on the same article with the same visual effect would be sufficient.

Para 42: When the novelty of an article is tested against a prior published document, the main factor required to be adjudged is the visual effect and the appeal of the picture illustration.

Para 43: If the visual effect of the pattern, the shape or the combination of the pattern, shape, dimension, color scheme, if any, are not clear from the picture illustration, the novelty cannot be said to have been destroyed by prior publication, unless there are clear and unmistakable directions to make an article which is the same or similar enough to the impugned design.

14. Traversing the documents submitted by the petitioner in support of petition for cancellation, it is observed that :

(a) Page 5 of documents submitted with petition for cancellation by petitioner: It is an extract of Patent Office Journal dated 27/11/2015 with publication in respect of registered design no. 273000 in class 08-05. The relevant date of registration is 24/06/2015.

(b) Pages 6-47 of documents submitted with petition for cancellation by petitioner: These pages are copies of certificate of incorporation of the petitioner's company along with memorandum of association and article of association, certificate regarding quality system certification and certificate from chartered accountant in respect of total turnover of the petitioner.

(c) Pages 48-51 of documents submitted with petition for cancellation by petitioner: These pages are copies of trademark application filed by the petitioner for trade mark of grease bucket pump (shape of goods) .

(d) Pages 52-62 of documents submitted with petition for cancellation by petitioner: Petitioner submitted comparisons of grease bucket pumps of petitioner and respondent including comparison of accessories , however, the said comparison does not denote

any date of production or date of publication to ascertain the issue of prior publication.

(e) Pages 63-233 of documents submitted with petition for cancellation by petitioner:

These are copies of invoices of sale of grease bucket pumps by petitioner during 2004-2010. Certain invoices for example invoice dated 08/12/2007 (Page 66 and annexure thereof) show sale of grease bucket pump BGP/10A. However, generally all those invoices do not depict any design to correlate with the impugned design.

(f) Pages 234-247 of documents submitted with petition for cancellation by petitioner:

These are stated to be copies of export invoices in respect of sale of grease bucket pumps by petitioner during 2004-2016. All those invoices do not depict any design to correlate with the impugned design.

(g) Pages 248-282 of documents submitted with petition for cancellation by petitioner:

These pages are extracts from lubricant equipment catalogues of the petitioner since 2004. The first of these documents are dated June 2004. Pages 249 & 250 shows bucket grease pump of generally cylindrical shape with a top cover fitted with clips. Similarly page 252 onwards show 'Lubrication Equipment' of March 2010 wherein in pages 254 & 255, bucket greasers are shown.

(h) Pages 283-289 of documents submitted with petition for cancellation by petitioner:

These pages are copy of the agreement dated 11/10/2005 between the parties for purchase of goods. The agreement drawn between petitioner and the buyer, M/s Kamboj Enterprises specifies that the buyer has approached the company for the purchase of various goods manufactured by the company and it has been agreed that

'Groz' shall not approach M/s JCB(I) Ltd. , Ballabgarh directly for sale of its product model BGP/10A [there is a phrase in parenthesis as 'rewrite it as per discussions', however the agreement appears to be signed on witness by both the sides]. It was also stated therein that the buyer assures to purchase minimum quantity of BGP/10A pumps. It was further stated that the buyer shall not transfer or assign the rights or benefits of this agreement to any one without prior approval of 'Groz' in writing. It was also stated there that it is known to the buyer that 'Groz' is the proprietor and exclusive owner of its trademark and brand name as well as copyright and the buyer assures that it will not infringe the trademark and copyright of 'Groz' and shall not adopt said trade mark, get up or device. It was also stated that the buyer shall have no right and interest of any kind or any part of the trade mark 'Groz', it's get up and design as well as its brand name.

It was stated by the respondent the product was that of the respondent and the petitioner by way of agreement wanted to encash upon goodwill of the respondent. However the said contention is not clear from the agreement.

(i) Pages 290-408 of documents submitted with petition for cancellation by petitioner:

These pages are sale invoices to evidence sale of bucket grease pump from petitioner to respondent. The invoices show sale of bucket grease pump BGP/ 10A since 2005 , however none of the invoices depict any design of the same.

(j) Pages 409-448 of documents submitted with petition for cancellation by petitioner:

These are copies of exchange of emails between the petitioner and respondent. The communication deals with various matters like minutes of meeting between Kamboj Enterprise and Groz Engineering Tools Pvt. Ltd. regarding pricing of items including

that of BGP-10A bucket grease pump. Invoice dated 23/10/2008 from Kamboj Enterprise to Groz Engg. Tools Pvt. Ltd. for release of sales promotion commission charges for Rs. 448320. It was also stated by Kamboj Enterprises that no branding on the pump, only the vendor code and particularly no GROZ branding on the pump & no Groz name on pump, packaging or insert. The communications from Groz Engineering Tools Pvt. Ltd. regarding model VGP/10A also state that there will be no brand sticker on the product or packaging. However, none of the pages specifically give any clear depiction regarding the impugned design.

(k) Pages 449-459 of documents submitted with petition for cancellation by petitioner:

These are few photographs of participation of the petitioner in exhibitions of India. It is not established from the photographs that the particular impugned design has been published prior to the date of registration.

(l) Pages 460-467 of documents submitted with petition for cancellation by petitioner:

These pages are copies of cease & desist notice sent by the petitioner to the respondent and it was stated therein that the petitioner has been selling grease bucket pumps having distinctive shape comprising of black & orange colour combination since 01/08/2008. It was stated that petitioner learnt that respondent is engaged in manufacturing and distributing / supplying grease bucket pumps having identical/ deceptive similar shape and trade dress as that of petitioner and respondent was requested for cease & desist from manufacturing/ supplying / distributing grease bucket pump having shape and trade dress identical or deceptively similar to that of petitioner.

(m) Pages 468-473 of documents submitted with petition for cancellation by petitioner:

It is copy of reply of respondent to the cease & desist notice of petitioner. It was submitted by the registered proprietor that it has conceived & adopted the products/goods in or about the year 2006 and responded is the proprietor of the said products/goods being trade mark application number 3508594. It was also stated that respondent has filed user affidavit and stating on oath that he is using said products / goods since 2006.

(n) Pages 474-475 of documents submitted with petition for cancellation by petitioner:

It is copy of trademark application filed by the respondent for registration of grease bucket pump.

(o) Pages 476-491 of documents submitted with petition for cancellation by petitioner:

It is copy of the user affidavit & documents filed in reference to the trade mark application for device of grease bucket pump. The user affidavit was given by Shri Parvesh Kamboj , proprietor of M/s Kamboj Enterprises and it was stated therein that he had adopted the said shape of goods/ trade mark device of grease bucket pump which is carrying the said business since 12/07/2006. It was also stated that the said trade mark has been adopted since 12/07/2006 and used it in the said mark device of grease bucket pump throughout the market and had used it widely and successively in the market. It is stated that he had spent substantial amount by various types of advertisements and promotional expenses to promote the sales under the trademark.

(p) Pages 492- 529 of documents submitted with petition for cancellation by petitioner:

It is copy of plaint in the matter of TM No. 20/17 in the matter of Groz Engineering Tools Pvt. Ltd versus Kamboj Enterprises & Ors.

15. The documents submitted by the petitioner along with their reply evidence are :
- (i) Annexure A of reply evidence : These are copies of invoices stated to be documentary evidence to show use of the novel design of grease bucket pump since 2003 by the petitioner. However, it is not established from the said invoices that the impugned design in particular had been the subject matter of those invoices.
 - (ii) Annexure B of reply evidence: Few initial pages are print outs from website and printed on 21/05/2018 which is later than the date of registration of the impugned design. However, the catalogue of GROZ dated as August 2016 shows bucket grease pump VGP/ 10A in item no. 39. Visual impression of the said depicted design is substantially similar to that of the impugned design.
 - (iii) Annexure C of reply evidence: It is copy of application of petitioner for registration of trademark. It was stated that in the year 2008, certain improvements were made in the shape of grease bucket pump and petitioner applied for registration under application. It was submitted by the petitioner that the design of grease bucket pump had already been introduced in the market prior to the alleged introduction of the impugned design. The trademark application as submitted in respect of Grease bucket pump (Shape of goods) in the name of Groz Engineering Tools Pvt. Ltd. shows an article similar to the impugned design. The user detail of the said mark is applied as 10/10/2003.
 - (iv) Annexure D of reply evidence: It is the copy of the user affidavit of Mr. Parvesh Kamboj, proprietor of M/s Kamboj Enterprise as already discussed in preceding paragraphs.

16. Revisiting the documents submitted by the respondent as Annexure along with their counter statement and evidence, the email communication of respondent to Simranjit Singh on 16/09/2016, trailing mails of which shows conservation since 07/09/2016, states about sending of JCB approved ballooned drawing, testing report and inspection report. The attachments to said mail are : Grease Bucket Pump Ballooned. Pdf, Testing Report.pdf and Final Inspection Report_JCB.pdf. The drawing No. KEPL-GBP-06 shows a schematic drawing of model no. GBP-6 and written as approved for pilot trail 200 nos. with a date 15/01/2016. Testing report and inspection report are showing the testing & inspection of certain parameters. It was submitted by the learned counsel of respondent that, in the year 2015, respondent developed a new product under the design of which specifically supplied to one of the major client of the respondent JCB and no other. The said product was designed and developed solely for JCB and upon approval of the design and testing; the respondent started producing the same for JCB in the year 2016. The impugned design was registered as of 24/06/2015. Therefore, the issue relates to whether the impugned design has been published prior to the date of registration and whether the said design is new or original and thereby registrable.

17. In the matter of Glaxo Smithkline Consumer Healthcare GmbH and Co. and Anr. Vs. Anchor Health and Beautycare Private Limited [2004 (29) PTC 72(Del)] it was stated that:

Para14: “..... It is true that in certain cases even a small novelty may introduce a new design but the bottom line is that a really new design should come into existence which is not a copy or trade variation of the earlier design introduced mala fide to continue to have a hold on the old design. Novelty should be capable of making a design different and distinctive at first sight of the consumer, should be new and should not require lot of effort to find out the novelty. If this yardstick is not applied then by introducing minor

and insignificant changes here and there, one may try to monopolise an old and already known design which cannot be protected even by Designs Act.”

Also, In the matter of Ravinder Kumar Gupta Vs Ravi Raj Gupta And Ors. [1986 DLT Page 190] it was stated that :

Para 28 : “.....Some thinking or mental process has to be gone into while effecting even a small change/ variation in the existing design. When it is said that the design should be original or new it does not mean that it should be a copy or imitation or a variation of the existing design. It should be something like inventive. By making the corners from sharp to round, it cannot be said that some new design has been created from one’s own mind and thought. ‘New’ should be something you develop and which was not earlier in existence. It should be striking new design. ...”

In the matter of Alert India vs. Naveen Plastics [1997 (17) PTC 15] it was stated that:

Para 36: “Thus for determining whether two designs are identical or not, it is not necessary that the two designs should be exactly the same. The main consideration is to be applied is whether the broad features of shape, configuration, pattern etc. are same or nearly the same and if they are substantially the same then it will be a case of imitation of the design of one by the other”.

Para 37: “... The broad features of pattern, configuration and design being similar it cannot be said that these are substantial variations in the two designs. Also the sample of the plaintiff’s sole is of brown colour whereas the defendant’s sole is black but the colour will not make any difference as the colour is interchangeable or could be the same. If the two designs are not before a potential purchaser at the same time, he may not be in a position to distinguish one from the other....”

18. The main contention of the petitioner is that the impugned design was published much prior to the date of registration of the impugned design. It was also pleaded that the impugned design was published in India by way of use. The impugned design, in respect of application of such design to Lubricating Equipment, was registered as of 24/06/2015. Scrutiny of the documents shows that Groz Lubricating Equipment of June 2004 reveals a bucket greaser (page 249 of annexures) comprising general overall design features as that of the impugned design. Similarly item number 39 of Groz Tools & Equipment, August 2016 (Annexure B of reply evidence of petitioner) discloses a bucket grease pump having similar design features as that of the impugned design. Not only the overall shape is similar, but also the parts like lift handle, foot rest are also same. The features of air release valve or swivel connector do not matter as they are parts for mechanical function and not for design attributes. The overall broad features of the impugned design are not significantly distinguishable from the design existed prior to the date of registration of the impugned design.

19. Learned counsel of petitioner submitted that respondent had filed a trade mark application no. 3508594 in class 08 dated 15/03/ 2017 with an alleged user claim of 12/07/2006. It was submitted that it is evident that the said shape trade mark was applied for registration with an alleged user claim of 12/07/2006 and is of same shape & design for which the impugned design registration dated 24/06/2015 was obtained by the respondent. It was stated that, therefore, by own admission of the respondent, the products bearing the impugned design was allegedly commercially used by the respondent since 2006. The status of trademark applications are publicly available and any public can retrieve the same from the official website (www.ipindia.gov.in). It is seen that Trade application number 3508594 in Class 8 was filed on 15/03/2017 by Parvesh Kamboj Proprietor of Kamboj Enterprise. The application was made for Trade Mark Category Shape of Goods and was applied for Shape of grease bucket pump goods. The images therein shows Front view, back view, left side

view, right side view , top view and bottom view. The designs depicted therein are similar to the impugned design. It is stated in the notarized user affidavit submitted by Parvesh Kamboj proprietor of M/s Kamboj Enterprise in respect of the said trade mark application that he had adopted the said shape of goods/ trade mark Device of Grease bucket pump which is carrying the said business since 12/07/2006 and it was submitted that he had adopted the said trade mark since 12/07/2006 and used it the said mark device of grease bucket pump throughout in the market and have used it widely & successively in the market. Reference of this user affidavit was also made by the respondent in the reply to cease & desist notice of the petitioner. The foregoing statements show that respondent himself claims prior use of his impugned design before the date of its registration. This amounts to prior publication of the impugned design before the date of registration apart from the publications in the Exhibits referred and discussed above . In the matter of SRMB Srijan Limited versus Tribeni Industries Private Limited & Anr (AID 4 of 2010), it was held by the Hon`ble High Court of Calcutta that:

“ It has also been admitted by the appellant that for the first time, on 4 April, 2003, the idea of X-Rib design was conceived. Reinforcing steel TMT Bar with surface patterns of various design are manufactured by the appellant has also been admitted. The X-Rib surface pattern has become popular by virtue of advertisement in the media is also an admitted position. Reliance has been placed on invoices and two of the invoices relied on are dated 15th March 2003 and 2nd April, 2003, i.e, prior to 4th April, 2003. Therefore, the said design was prior published and the appellant’s registration cannot be sustained. The Affidavit of Evidence wherein the said invoices have been furnished has been verified by Mr. M.M. Abraham the Vice-

President of the said paragraph the deponent in paragraph 3 and has been affirmed as true to knowledge.

In reply Counsel for the petitioner submits that the respondent has claimed development of the registered design in 2005 i.e. after the design was registered by the appellant in 2003. Novelty has been claimed in the surface pattern. In the affidavit of evidence filed in reply the respondent has disputed the advertisements and called for production of the original copies of invoice and bills.


Having considered the submissions of the parties the order of the Controller calls for no interference as the appellant relied on invoice issued by it in 15th March 2003 and 2nd April, 2003 for X-Rib TMT Rods. This in itself is sufficient to negate the case of novelty and originality. The documents were enclosed by the appellant in its affidavit of evidence and such affidavit has been affirmed by the Vice-President of the appellant who was aware of the facts. In fact advertisement of 2002 has been relied on and the said advertisement is of the appellants X-Rib Rods. From the invoice dated 15th March, 2003 and 2nd April, 2003, it is also apparent that the said rods were sold by the appellant.....

Another reason is that Para 3(i) of the affidavit of evidence affirmed on behalf of the appellant wherein the said invoice and advertisement have been mentioned are affirmed as true to knowledge by the deponent viz. the Vice-President of the appellant and in the light of such admission not to allow the appellant to deal with or explain the same cannot be termed as contrary to law. For all the said reasons this appeal fails and is dismissed.”

20. It is thus seen that the respondent himself admitted that the shape trademark of the trade mark application number 3508594, design of which is same as the design depicted in the impugned registration 273000 dated 24/06/2015, has been used since 12/07/2006. Thus, as per his own statement, respondent had adopted and used the impugned design prior to the date of registration. A design, which is published prior to the date of registration or where applicable the priority date of the application for registration, cannot be considered as new. As per Section 2(g) of the Designs Act 2000, ' "Original", in relation to a design, means originating from the author of such design and includes the cases which though old in themselves yet are new in their application'. Here the impugned design was already in public domain & knowledge at the time of its registration and applied to same article. Therefore the impugned design is not new or original and not registrable.

21. In view of preceding analysis, the present application filed by Groz Engineering Tools Private Ltd. for cancellation of registered design 273000 dated 24/06/2015 under Class 08-05 registered in the name of Parvesh Kamboj, is allowed and it is ordered to cancel the said design in Register of Designs.

There is no order as to costs.


(Madhurjya Thakur)

Dated 24th January, 2023

Deputy Controller of Patents & Designs

Copy To: All concerned