
Competing designs need not be identical

M/s Videocon Industries Ltd v M/s Whirlpool of India Ltd

This is an order passed by the Mumbai High Court in an appeal filed by the Defendant, M/s Videocon Industries Ltd against the Plaintiff, M/s Whirlpool of India Ltd. The Plaintiff herein had filed a suit for infringement of Design, passing off, etc, against the Defendant and obtained an interim injunction restraining the Defendant from dealing with washing machines which are similar to the Plaintiff's registered design.

Facts of the case

The Plaintiff had registered a design for shape and configuration of its washing machines. The designs registered by the Plaintiff is having square shape on one side and rounded shape on the other side which gives a distinctive aesthetic appeal. According to the Plaintiff their design has proved to be a great success so much so that in a short span of time they have made extensive sales of the washing machine with the impugned design. Thereafter, the Plaintiff noticed that the Defendants had started manufacturing and marketing washing machines having same/similar design, shape and configuration as the one registered by the Plaintiff. The Defendant's washing machines were so similar to the Plaintiff's design that it was obvious that the Defendant had infringed the registered design and had done so deliberately to encash the popularity enjoyed by distinctive design of Plaintiff's washing machine. It was in these circumstances the Plaintiff filed the suit for infringement of design and passing off.

The Plaintiff's design is not an original design and has been in the market since last more than 50 years. The Defendant's product is not similar to the one registered by the Plaintiff and further the Plaintiff has registered its design for only size and shape and for no other aspect. No passing off action will lie against the Defendant as their brand is known much more than the Plaintiff's and there is no possibility that the Defendant will try to sell its products as that of the Plaintiff.

As the Defendant has also applied for registration of its own design which is pending, no case is made out for injunction.

The Trial court after hearing the parties and comparing the rival products held that the Defendants washing machine is similar to the Plaintiff's registered design when judged solely by the eye and granted an injunction.

When the appeal was taken up for hearing the counsel for the Appellant/Defendant submitted that the Plaintiff's designs are not new and original, have been in the public domain and are also not significantly distinguishable from known designs or combination of known designs. The Defendant further stated that the Plaintiff's design is achieved by merely putting together shapes borrowed from two or more designs. Thus, the designs of Plaintiff are merely a combination of known designs and registration is only for shape and configuration and not for pattern, ornamentation or colours. As the Defendant's washing machine has different ornamentation, colour, and placement of operational knobs, it is clearly distinct even when solely judged by eye and further no case of passing off also is made out.

The Respondent/Plaintiff in turn made the following submissions.

The designs registered by the Plaintiff having square shape on one side and rounded shape gives a distinct visual appeal and there have not been similar designs in the past. The unique boat shape design of the Plaintiff has appealed to the buyers even though the shape by itself does not relate to functionality. The shape is distinctive and thus the action of the Defendant in marketing the product with same/similar design, is clearly to pass off the goods.

After detailed hearing and comparison of the rival products, the Division Bench held as follows:

The design registered by the Plaintiff which has distinctive boat shape appearance is also found in the washing machine marketed by the Defendant. The novelty of the design is in its shape which has certain appeal to the eye and it has created a value in the products which may not be relatable to improved functionality, but it makes it desirable. Merely by placing certain ornamentations, changing position of knobs or adding color scheme, the Defendant has not made any difference to its product so as to make it different from the Plaintiff's. The test of judging solely by the eye will clearly evidence that both the machines are similar and a case of infringement is made out.

The Court further held that to maintain an action for passing off it is not necessary that the person must himself actively carry out the misrepresentation and as the rival machines are similar, a case of passing off is made out.

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