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

+ CS(COMM) 658/2021 & I.A. 16751/2021

BULGARI SPA .....Plaintiff

Through: Mr. Jayant Mehta, Sr. Adv. with  
Mr. Anirudh Bakhru, Mr. Shravan Kumar  
Bansal, Mr. Ajay Amitabh Suman, Mr. Gaurav  
Gogia and Mr. Aditya Rajesh, Advs.

versus

NOTANDAS GEMS PRIVATE LIMITED .....Defendant

Through: Ms. Rukmini Bobde, Mr.Nivesh  
Kumar and Ms. Suditi Singh, Advs.

**CORAM:  
HON'BLE MR. JUSTICE C. HARI SHANKAR**

**JUDGEMENT (O R A L)**

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**21.02.2022**

(By Video Conference on account of COVID-19)

**IA 16751/2021 (under Order XXXIX Rules 1 and 2 of the Code of Civil  
Procedure, 1908)**

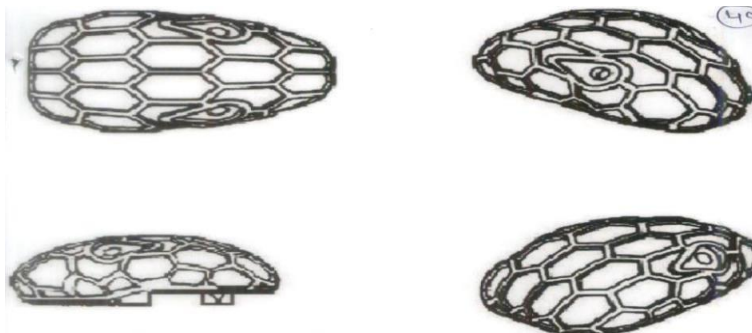
1. The plaintiff and the defendant manufacture and deal in, *inter alia*,  
high end luxury jewellery.

2. Thankfully, in the present case, they are duly deferential to the reputation and goodwill of each other.

3. The plaintiff alleges infringement, by the defendant, of (i) its trademark “SERPENTI”, forming part of four of its registered trademarks, to which detailed allusion would be made hereinafter, (ii) a device mark of a snakehead, in which too, it holds a registration and (iii) the design of its wristwatch and bracelet, in respect of which, too, the plaintiff holds a valid and subsisting registration under the Designs Act, 2000. All these registrations undisputedly are valid and subsisting as on date.

4. Plaintiff’s registered Trade Marks: The plaintiff holds the following trademarks registrations:

- (i) the device mark “BVLGARI SERPENTI”,
- (ii) the device mark “SERPENTI HYPNOTIC”,
- (iii) the device mark “SERPENTI INCANTATI”,
- (iv) the device mark “SERPENTI SEDUTTORI” and
- (v) the device mark of a “snakehead”, which appears thus:



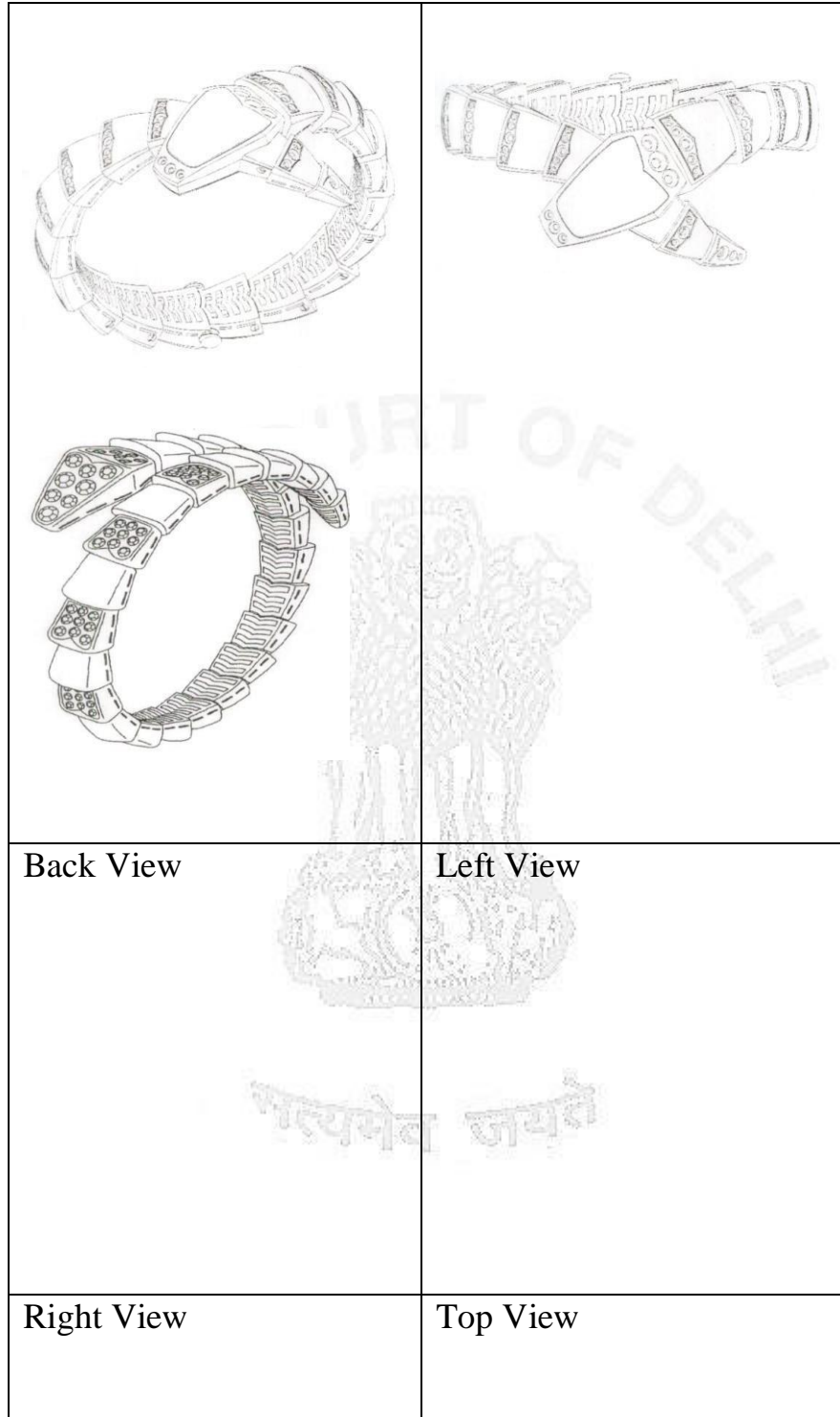
The “BVLGARI SERPENTI”, “SERPENTI HYPNOTIC”, “SERPENTI INCANTANTI” AND “SERPENTI SEDUTTORI” marks, I may note, are merely, in essence, word marks, as they are merely the words written in straight capitals, without any accompanying design or logo, for example:

BVLGARI

5. Plaintiff’s registered Designs: Apart from the aforesaid trademark registrations, the plaintiff also holds the following subsisting design registrations:

(i) Design Registration No. 275585 dated 17<sup>th</sup> March, 2015 in respect of a “wristwatch”: The various views of the wristwatch, in respect of which design registration has been granted, as contained in the Certificate of Registration, are the following:

Perspective View	Front View
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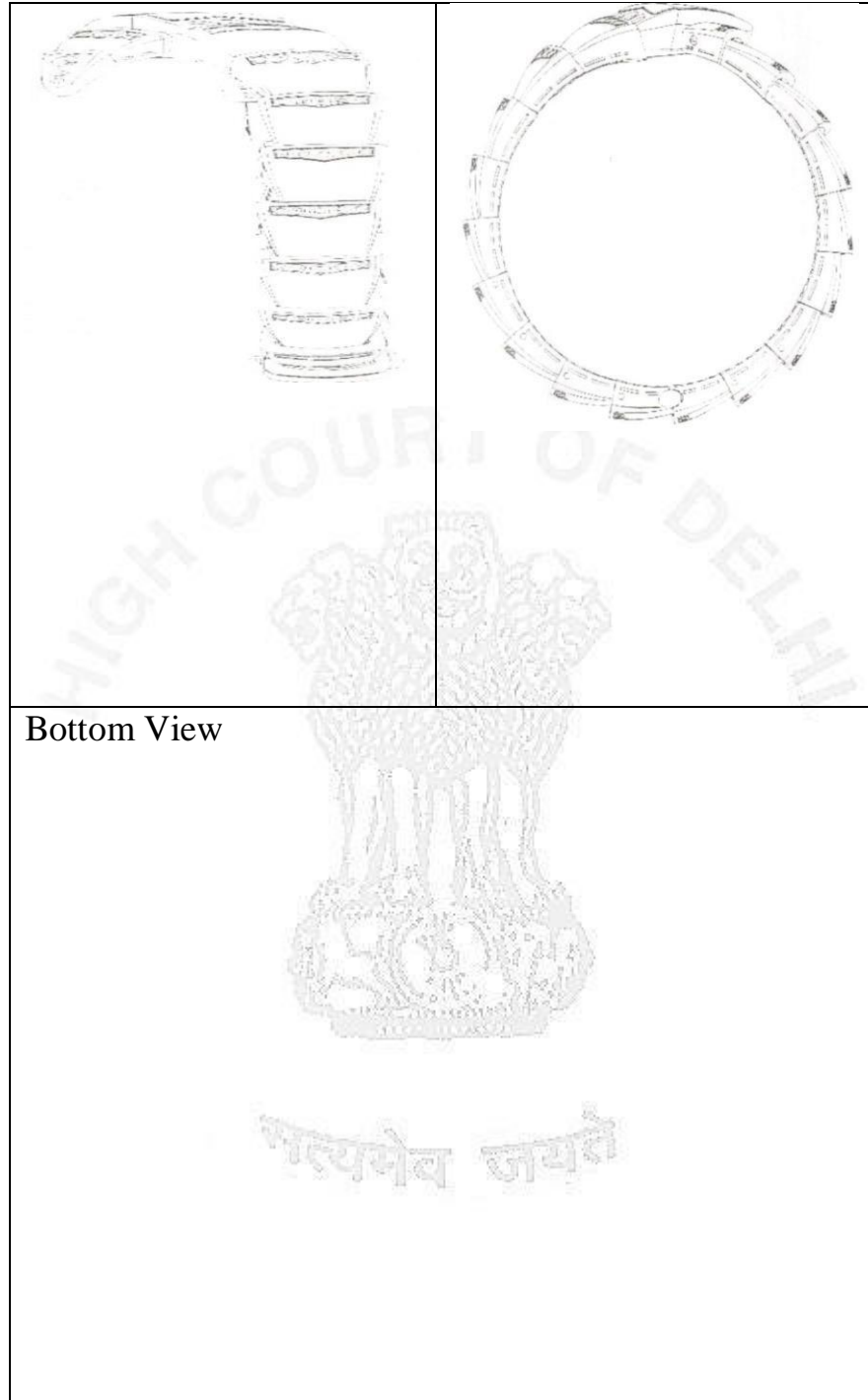


Back View

Left View

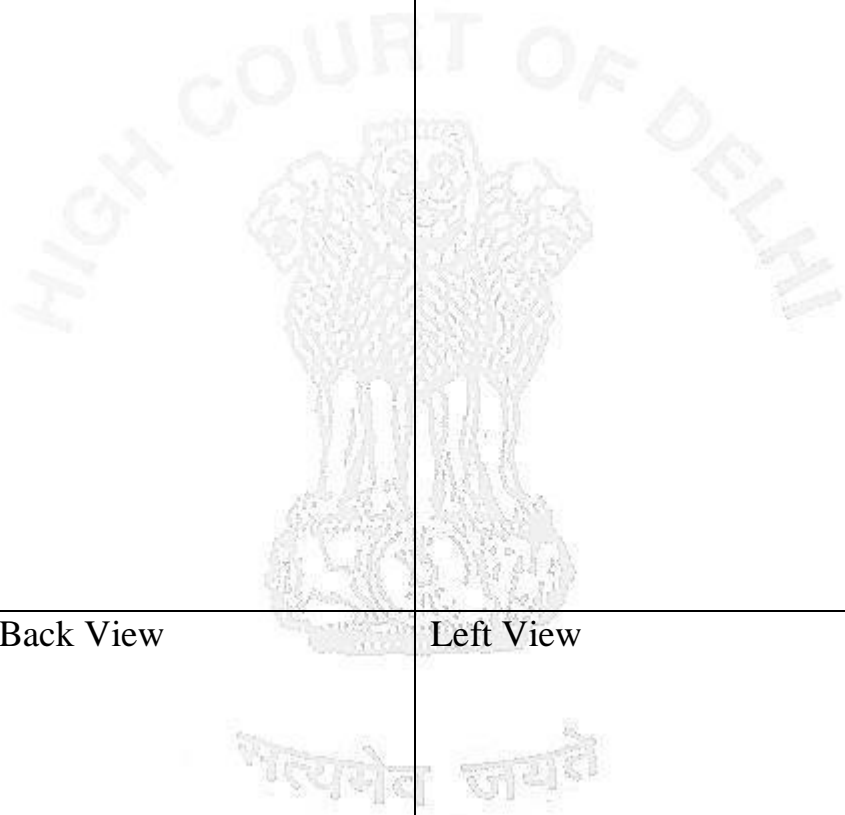
Right View

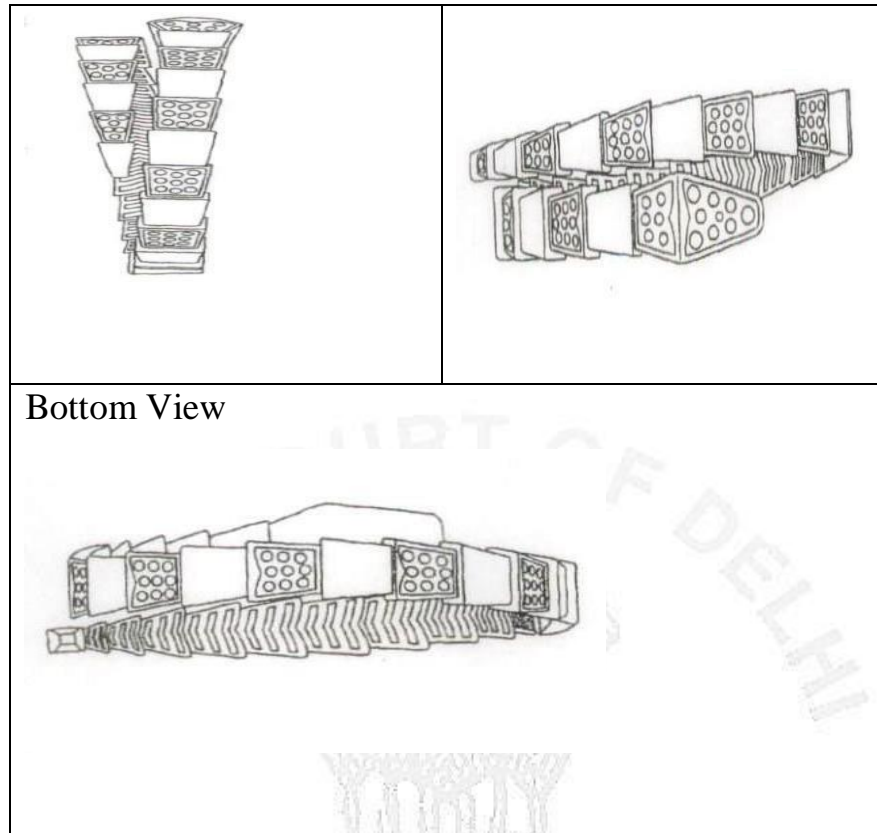
Top View



(ii) Design No. 222118 dated 30<sup>th</sup> September, 2008 in respect of a bracelet with the following views:

Perspective View	Front View
Back View	Left View
Right View	Top View





6. In respect of both the designs, the Certificate certifies that novelty resides in the “shape and configuration” of the item, i.e. the wristwatch in the case of Design No. 275585 dated 17<sup>th</sup> March, 2015 and the bracelet in respect of Design No. 222118 dated 30<sup>th</sup> September, 2008, as illustrated.

**Rival contentions:**

**Plaintiff’s submissions:**

7. Mr. Mehta, learned Senior Counsel for the plaintiff, submits that the mark “SERPENTI” has become indelibly identified with the

plaintiff's range of niche jewellery and has been in use by the plaintiff since the 1940s. He points out that the defendant is using the mark "SERPENTINE", in respect of identical jewellery, i.e. bracelets. The following screenshot, from the defendant's website, has been extracted, by way of illustration:



8. Mr Mehta has drawn my contention to the following comparative tabular representation, provided in the documents filed with the plaint, to submit that the defendant has adopted a trade dress which is identical or, at the very least, deceptively similar to that of the plaintiff, while manufacturing and marketing its jewellery:



PLAINTIFF'S SAID GOODS	DEFENDANT'S IMPUGNED PRODUCT
	
	

For ease of reference, this order shall allude to the aforesaid tabular representation as “Chart A”.

9. Mr. Mehta submits that the claim of the plaintiff is not hit by Section 17<sup>1</sup> of the Trade Marks Act, 1999 (“the Trade Marks Act”), which proscribes claiming of any exclusivity in respect of part of a

**<sup>1</sup>17. Effect of registration of parts of a mark.—**

(1) When a trade mark consists of several matters, its registration shall confer on the proprietor exclusive right to the use of the trade mark taken as a whole.

(2) Notwithstanding anything contained in sub-section (1), when a trade mark—

(a) contains any part—

(i) which is not the subject of a separate application by the proprietor for registration as a trade mark; or

(ii) which is not separately registered by the proprietor as a trade mark; or

(b) contains any matter which is common to the trade or is otherwise of a non-distinctive character, the registration thereof shall not confer any exclusive right in the matter forming only a part of the whole of the trade mark so registered.

composite mark as, in the registered marks of the plaintiff, “SERPENTI” constitutes the prominent part. To support the proposition that, even in respect of composite marks, infringement can be claimed of a part of the mark provided it is the prominent part of the mark, Mr. Mehta places reliance on the judgment of the Division Bench of this Court in *South India Beverages Pvt. Ltd. v. General Mills Marketing Inc.*<sup>2</sup>

10. Mr. Anirudh Bakhru, who supplemented the submissions of Mr. Mehta, on the aspect of trademark infringement, by contending that the case was also one of “idea infringement” as “SERPENTI” and “SERPENTINE” would denote the same idea in the mind of a consumer of average intelligence and imperfect recollection.

11. Mr. Mehta further submits that there is phonetic similarity between the words “SERPENTI” and “SERPENTINE”. Neither, he submits, can be treated as descriptive of the items in respect of which they are used, i.e. bracelets. Adverting to one of the lines of defence adopted by the defendant, Mr. Mehta submits that the trademark “SERPENTI” cannot be regarded as common to the trade as any such defence would require establishment of prior use, substantial trade and acquiescence by the plaintiff in such trade. These facts, he submits, have not been established by the defendant even *prima facie*. He relies, for the said purpose, on the judgment of a Division Bench of this Court in *Pankaj Goel v. Dabur*

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<sup>2</sup> 2014 SCC OnLine Del 1953

*India Ltd*<sup>3</sup>, specifically paras 4, 21 and 23 thereof.

12. On the aspect of design infringement, Mr. Mehta places reliance on the decision of Ruma Pal, J. (as she then was), sitting singly in the High Court of Calcutta in *Castrol India Ltd. v. Tide Water Oil Co. (India) Ltd*<sup>4</sup> to submit that, for design infringement, it is not necessary that the entire design, or every aspect thereof, is infringed; it is sufficient if, as a whole, the design of the defendant is deceptively similar to that of the plaintiff.

**Defendant's submissions:**

13. Responding to the submissions of Mr. Mehta, Ms. Rukmini Bobde, appearing for the defendant, invokes Section 17 of the Trade Marks Act to contend that, as the plaintiff's marks are composite in nature, it is not permissible for the plaintiff to claim exclusivity in respect of "SERPENTI" alone, which constitutes a part of the composite mark. She also submits that there is no justification for treating "SERPENTI" as the dominant part of the marks "BVLGARI SERPENTI", "SERPENTI HYPNOTIC", "SERPENTI INCANTATI" and "SERPENTI SEDUTTORI".

14. Ms. Bobde further invokes Section 30(2) of the Trade Marks Act

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<sup>3</sup> 2008 38 PTC 49

<sup>4</sup> 1996 60 PTC 202

to contend that “serpentine” is merely the adjectival form of “serpent” and that, therefore, the plaintiff cannot claim exclusivity in respect thereof. It merely describes, she submits, the shape of the item in question and the plaintiff can hardly seek to contend that jewellery manufacturers and persons engaged in similar trades are completely barred from making jewellery in the shape of serpents. She also submits that the words “SERPENTI” and “SERPENTINE” are not phonetically similar, their concluding syllables being completely different. She further submits that the “SERPENTI” mark is common to the trade and there are several manufacturers of jewellery and other items, who use the form of a serpent or a snake. Moreover, submits Ms Bobde, the customers who purchased the jewellery of the plaintiff, or the defendant, are customers of discernment and taste, who would be able to distinguish between one product and another, thereby minimizing any chance of confusion or deception.

15. Ms. Bobde further submits that the plaintiff can have no claim



whatsoever on  (in Chart A), as it does not constitute either a registered trade mark or a registered design of the plaintiff. She submits that the plaint does not disclose the intellectual property right that the plaintiff seeks to espouse in respect of the said item.

16. Ms. Bobde further submits that there is no infringement of the snakehead design of the plaintiff as the designs of the plaintiff and the defendant are completely different.

17. Ms. Bobde also submits that the present plaint is bad for want of territorial jurisdiction. Ms. Bobde has drawn my attention to para 50 of the plaint, which deals with territorial jurisdiction, and reads thus:

“50. That this Hon'ble Court has the territorial jurisdiction to try and adjudicate the present suit. The Defendant is carrying on its impugned business activity within the jurisdiction of this Hon'ble Court having its exclusive store located at G-26, South Extension, Block G, South Extension I, New Delhi, Delhi 110049. The Defendant is carrying on its business activities under the impugned trademark through its exclusive 'Notandas' stores located within the jurisdiction of this Hon'ble Court. Therefore, this Hon'ble Court has the necessary territorial jurisdiction to try and entertain the present suit within the meaning of Section 20(a) Code of Civil Procedure. The Defendant is soliciting, trading, displaying, promoting and advertising the impugned product bearing the impugned design, trademarks and trade dress in the markets of South Delhi and the Plaintiff apprehends that the Defendant might expand its business activities w.r.t. to the impugned product in the markets of South Delhi. Further, the Defendant is displaying, soliciting, advertising, promoting, marketing and offering for sale the impugned goods through its physical stores under the impugned trademark through its website [www.notandas.com](http://www.notandas.com), which is interactive in nature and accessible within the jurisdiction of this Hon'ble Court. The Defendant is also displaying, soliciting, promoting and advertising the impugned products under the impugned design, trademark and trade dress through social media websites such as Instagram and also through popular and renowned magazines (physical/digital) such as Femina Wedding

Times. The Plaintiff has a strong and credible apprehension that the Defendant will expand its impugned activities under the impugned design, trademark and trade dress in relation to the impugned goods and business in South Delhi and the threat that the Defendant will use the impugned design, trademark and trade dress within the jurisdiction of this Hon'ble Court is credible and imminent, thus, giving rise to a substantial and integral part of the cause of action within the jurisdiction of this Hon'ble Court. Further the above apprehended activities of the Defendant will be within the jurisdiction of this Hon'ble Court. In addition, the Defendant's infringing activities are likely to have a dynamic effect on Plaintiffs business, both current and forthcoming, within the territory of South Delhi. It is evident that the dynamic effect of the Defendant's activities is being felt in South Delhi besides other areas of the country and there exists an undeniable nexus between the cause of action in the present suit and the territory of South Delhi. Thus the Defendant is committing the acts of infringement and passing off within the jurisdiction of this Hon'ble Court. The cause of action in whole and/or in part has arisen within the jurisdiction of this Hon'ble Court. Therefore, this Hon'ble Court has the necessary jurisdiction to try and adjudicate the present suit within the meaning of Section 20 (c) of the Code of Civil Procedure, 1908. Further, the Plaintiff is also carrying on its said business through its dealers/distributors/special agents and also through its interactive website [www.bulgari.com](http://www.bulgari.com) on which purchase orders can be placed. The Plaintiffs proprietary rights are being tarnished and adversely affected due to the Defendants' impugned activities within the jurisdiction of this Hon'ble Court besides other areas. The Plaintiff has extensive goodwill and reputation under the said trademark on account of voluminous sales and advertisements within the jurisdiction of the Hon'ble Court. This Hon'ble Court thus further has the territorial jurisdiction within the meaning of Section 134 (2) of the Trade Marks Act, 1999. Therefore, in view of the above, this Hon'ble Court has the necessary territorial jurisdiction to try and entertain the present suit.”

**18.** Ms. Bobde submits that the sole outlet of the defendant at South

Extension, on the basis which the jurisdiction of this Court has been invoked in para 50 of the plaint, has been shut since long and the defendant presently has only one outlet at Mumbai. She also disputes the plaintiff's contention that the defendant's products are available online and submits, on instructions, that they are not so available. Apropos the contention that the defendant's website is interactive and can be accessed within the jurisdiction of this Court, Ms. Bobde has invited my attention to the judgment of a Division Bench of this Court in *Banyan Tree Holding (P) Limited v. A. Murali Krishna Reddy*<sup>5</sup>, and of a learned Single Judge in *Karans Gurukul Classes v. Gurukul Classes IIT Division*<sup>6</sup>. She submits, on the basis of these decisions, that mere interactivity cannot justify invocation of the jurisdiction of this Court against the defendant and that it would additionally have to be shown that the defendant was targeting customers within the jurisdiction of this Court through its website, as would amount to purposeful invocation of the jurisdiction of this Court by the defendant. Additionally, she submits, it would have to be shown that commercial transactions have actually taken place across the website. Absent these factors, Ms. Bobde submits that the present plaint is bad for want of territorial jurisdiction.

### **Plaintiff's submissions in rejoinder:**

19. Advancing submissions by way of rejoinder, Mr. Mehta, learned

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<sup>5</sup> 2010 42 PTC 361

<sup>6</sup> (2019) 261 DLT 102

Senior Counsel for the plaintiff, submits, on the aspect of territorial jurisdiction, that the principle of actual transactions taking place across an interactive website would not apply where the commercial transactions are possible from any geographical location through the website. In the case of an e-commerce website or a website across which goods are sold, he submits, any person located in the territories from which goods may be purchased from the website could, if she or he so chose, conclude a commercial transaction. Courts having territorial jurisdiction over the location of such persons would, therefore, he submits, necessarily be empowered to adjudicate on the aspect of infringement.

**20.** That apart, Mr. Mehta submits that there is no rebuttal, in the written statement filed by the defendant, to the specific averment in the plaint that the defendant's website is interactive and that commercial transactions can be concluded across it. He has also, in Court, accessed the website to seek to demonstrate that, should a customer in Delhi seek to purchase merchandise across the website, it would be possible for him to do so. In these circumstances, submits Mr. Mehta, the plaint cannot be dismissed for want of territorial jurisdiction, at least at an interlocutory stage.

**21.** Reiterating his submissions on the aspect of infringement, Mr. Mehta submits that, given the reputation of its "SERPENTI" line of products since the 1940s, "SERPENTI" has necessarily to be regarded to



be the prominent feature and the dominant part of the plaintiff's registered trademarks. Inasmuch as the mark "SERPENTINE" of the defendant is clearly deceptively similar to "SERPENTI", Mr. Mehta submits that a case of infringement is, *prima facie*, made out. Responding to the submission of Ms. Bobde, that the customers who purchase the bracelets and wristwatches of the plaintiff, and the bracelets of the defendant are discerning customers, who would be able to make out the difference the two, Mr. Mehta submits that this argument cannot apply where the products are available, both of the same nature, i.e. jewellery and cater to the same class of consumers, i.e. the persons who desire to purchase jewellery. In such cases, Mr. Mehta submits that the triple identity test of deceptive similarity/identity of the trademarks, identity of the trade channels through which the goods can be sourced and an identity of the class of consumers who would purchase the goods, stands satisfied. In such a case, submits Mr. Mehta, the argument of the customers being discerning is not available to an infringing defendant.

**Analysis:**

22. I have heard learned counsel for the parties at some length. Clearly, the following issues arise for consideration:

- i. whether the plaint is bad for want of territorial jurisdiction,
- ii. whether a *prima facie* case of infringement of trademark is made out,
- iii. whether a *prima facie* case of infringement of design is made out

and

- iv. whether a case of passing off, by the defendant, of the plaintiff's mark, is made out.

**Re: Territorial jurisdiction:**

23. On the aspect of territorial jurisdiction, I am of the considered opinion, having heard learned Counsel for both sides, that a clear case for dismissing the suit, or rejecting the request for interlocutory injunction on the ground of want of territorial jurisdiction cannot be said to have been made out. It is an admitted position that the defendant's website is interactive in nature. Once the defendant's website is interactive and permits commercial transactions to be concluded across the website, Courts having jurisdiction over all territories from which such commercial transactions can be concluded and consummated, would be possessed of the requisite territorial jurisdiction to adjudicate on a case of infringement. The legal position, in this regard, stands settled by the judgment of this Court in *V. Guard Industries Ltd. v. Sukan Raj Jain*<sup>7</sup>. Once the defendant has made its goods, or services, available for consideration, online, it has, *prima facie*, purposefully availed the jurisdiction of Courts in all territories where such transactions can be carried out and consummated.

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<sup>7</sup> (2021) 87 PTC 333

24. The distinction, drawn by Mr. Mehta between an interactive website which merely provides information and an interactive website across which goods or services may be purchased or availed for consideration is well taken. Where the website merely provides information, unless and until it is shown that such information has been accessed by a person located within the jurisdiction of the Court before which the plaint is preferred, the Court would not have jurisdiction to deal with it. As against this, where a website permits purchase of goods or services, for consideration, across the website, every Court having jurisdiction over places from which, by accessing the website, commercial transactions could be effected and concluded would, *prima facie*, have jurisdiction to deal with a case of trademark infringement.

25. I cannot, therefore, subscribe to the view, at least at the Order XXXIX stage, that a case for rejecting the plaint on the ground of want of territorial jurisdiction can be said to have been made out.

**Re. Trademark infringement:**

26. The plaintiff claims infringement of its registered trademarks “BVLGARI SERPENTI”, “SERPENTI HYPNOTIC”, “SERPENTI INCANTATI”, “SERPENTI SEDUTTORI”, as well as its “snakehead” device mark.

27. The defendant uses the mark “SERPENTINE”. The nature of

goods in respect of which the “SERPENTINE” mark is used by the defendant is the same as the nature of the goods in respect of which the plaintiff uses the marks “BVLGARI SERPENTI”, “SERPENTI HYPNOTIC”, “SERPENTI INCANTATI” and “SERPENTI SEDUTTORI”, namely bracelets/jewellery. There is clear phonetic similarity between the expressions “SERPENTI” and “SERPENTINE” and the mere slight phonetic distinction in the manner in which the concluding syllable of these two words is intoned cannot detract from the similarity between the two.

**28.** Ms. Bobde sought to invoke Section 17 of the Trade Marks Act. Section 17 engrafts a proscription against claiming exclusivity over a part of a composite mark, unless such part is separately registered by the plaintiff as a trademark. It is not the plaintiff’s case that “SERPENTI” is separately registered as a trademark.

**29.** Despite the above statutory interdiction, Courts have read, into this proscription, an exception where one part of the composite mark may be treated as dominant. In such cases, Courts have held that, where the dominant part of the mark is infringed, a case for injunction is made out. It would be for the Court, in every case, to examine whether the part of the mark which is infringed is or is not its dominant part. *South India Beverages*<sup>2</sup> is a widely cited authority on the point.

**30.** In the present case, Mr. Mehta has pointed out that since the 1940s,

Bulgari has been running its “SERPENTI” line of niche jewellery. This assertion in the plaint is not disputed in the written statement, nor has Ms. Bobde advanced any contention to the contrary. It is also averred, in the plaint, that the “SERPENTI” line of jewellery is associated indelibly with the plaintiff in the mind of the consuming public. In any case, the point of time from which the plaintiff has been manufacturing and marketing its “SERPENTI” line of products is anterior to that from which the defendant has been marketing its “SERPENTINE” line of jewellery.

**31.** I am not, *prima facie*, in agreement with Ms. Bobde that “SERPENTINE” being merely the adjectival form of “SERPENT”, it was a term of common use and was descriptive in nature and that, therefore, the plaintiff could not claim exclusivity in respect thereof. The word “SERPENTI” cannot, by any stretch of imagination, be treated as descriptive in the context of bracelets. Even if it were to be treated as descriptive of the shape of the bracelet, the shape is itself distinct and unique, even in the context of bracelets. As to whether the shape is common to the trade, or not, would require evidence to be led, by the defendant, regarding the volume of sales of others who are making such jewellery as well as the issue of whether the plaintiff has acquiesced thereto. In the facts of the present case, it cannot be held, *prima facie*, that bracelets are, commonly in the trade, made and sold in the serpentine shape and form. Besides, the word “SERPENTI” has no known etymological connotation in English or in any other language and, therefore, has to be regarded as fanciful and coined by the plaintiff.

32. In view thereof, I am of the opinion that, insofar as the aspect of trademark infringement is concerned, the plaintiff has a *prima facie* case in its favour. The defendant is using the mark “SERPENTINE” in respect of goods which are identical to those in respect of which the plaintiff uses the mark “SERPENTI”, namely high-end luxury ornaments/bracelets. The goods would cater to the same class of consumers. The goods are themselves similar in character. The marks “SERPENTI” and “SERPENTINE” are phonetically similar. Even on the basis of the reputation of the “SERPENTI” line of products of the plaintiff, a *prima facie* case for treating “SERPENTI” as the dominant part of the plaintiff’s marks is also made out. The plaintiff has also placed, on record, literature indicating that the mark “SERPENTI”, *prima facie*, is associated with the plaintiff, and may even be a source identifier. All these factors, seen in conjunction, in my view, do make out a *prima facie* case of infringement, by the defendant, by the use of its mark “SERPENTINE” of the registered trademarks “BVLGARI SERPENTI”, “SERPENTI HYPNOTIC”, “SERPENTI INCANTATI” and “SERPENTI SEDUTTORI” of the plaintiff.

33. Apropos the registration held by the plaintiff in respect of the “SNAKEHEAD” trademark, clearly, there is no infringement by the defendant as the “SNAKESHEAD” of the defendant is completely distinct in shape, configuration, contour and even visual appearance from the “SNAKESHEAD” in respect of which the plaintiff holds trademark

registration. Nonetheless, as this Court has found a *prima facie* case in favour of the plaintiff, *qua* registration of its “SERPENTI” range of trademarks, this aspect may not be of much significance.

**Re: Design infringement:**

34. Before advertng to the design registrations held by the plaintiff, a glance at some of the relevant provisions of the Designs Act would be apposite.

35. “Copyright” and “design” are defined in clauses (c) and (d) of Section 2 of the Designs Act, thus:

“(c) “copyright” means the exclusive right to apply a design to any article in any class in which the design is registered;

(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 any 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 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 (43 of 1958) or property mark as defined in section 479 of the Indian Penal Code (45 of 1860) or any artistic work as defined in clause (c) of section 2 of the Copyright Act, 1957 (14 of 1957);”

**36.** Section 4(a) of the Designs Act prohibits registration of a design which is not new or original. This aspect is further underscored by Section 5(1) which empowers the Controller of Designs to register “any new or original design not previously published in any country and which is not contrary to public order or morality”. Registration of a design confers, on its registered proprietor, copyright in the registered design for a period of ten years from the date of registration, *vide* Section 11(1). Section 19 envisages cancellation of registration of a registered design where, *inter alia*, it is not “new or original” (*vide* sub-section (1)(c) thereof). Section 22, which deals with piracy of registered designs, proscribes all persons from, *inter alia*, for the purpose of sale, applying or causing to be applied to any article in any class of articles in which the design is registered, the registered design or any fraudulent or obvious imitation thereof.

**37.** A common thread that runs through the Designs Act is the aspect of novelty and originality. Novelty and originality are, therefore, the *sine qua non* of any design registerable under the Designs Act. Absent novelty and originality, the design is not registerable.

**38.** The sequitur to this, though it does not clearly emerge from the provisions of the Designs Act, would be that exclusivity, by the proprietor of a registered design, can be claimed only in respect of those aspects of the design, in which, according to the certificate of registration, novelty and originality reside. What has to be seen by the



Court, adjudicating a claim of infringement of a registered design is, therefore, whether, in respect of the aspects *which, according to the certificate of registration, are novel*, there is infringement (or, as the Act calls it “piracy”) within the meaning of Section 22 of the Designs Act.

**39.** The claim of infringement of the plaintiff’s design, by the defendant, has also to be seen in this in this background.

**40.** As noted hereinabove, the plaintiff has two registered designs. One is for a wristwatch and the other is for a bracelet. The certificates of both designs certified novelty to reside in the “shape and configuration” of the design.

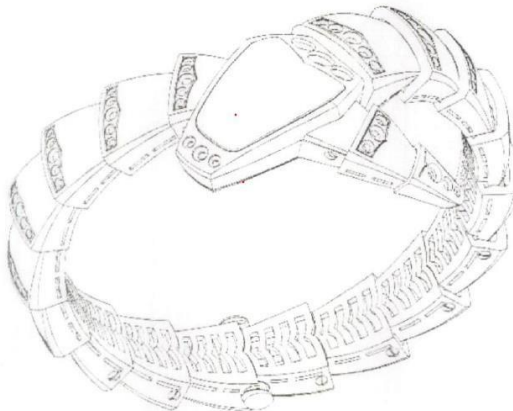
**41.** It is necessary, therefore, to understand the expressions “shape” and “configuration”, as used in the certificate of registration before arriving, even *prima facie*, at a conclusion as to whether there is infringement of the plaintiff’s registered designs by the defendant.

**42.** “Shape”, etymologically, is a expression of common use and of well understood meaning. There are well recognized shapes, such as circles, rectangles, triangles and the like. Where, therefore, novelty is said to reside in the shape of an article, for the purpose of granting it a certificate of registration under the Designs Act, the shape must be novel. In other words, where the certificate of registration certifies the novelty to be in the shape of the article, the Court would have to assess, for itself,

the aspect of the shape of the article which is novel, so as to examine whether *that* novel aspect has been copied by the defendant or not.

**43.** It cannot, quite obviously, be said that, that a mere circular shape is novel either for a wristwatch or for a bracelet. Wristwatches and bracelets are, commonly, circular in shape. What, then, persuaded the registering authority to certify that there was novelty in the shape of the registered design of the plaintiff's bracelet or the plaintiff's wristwatch?

**44.** If one were to glance at the representation of the various views of the plaintiff's bracelet and wristwatch, as contained in the certificate of registration, what becomes immediately apparent is that they are not merely circular in nature. In each case, the shape is in the form of a spiral with one loop of the spiral intersecting with the other. This is most apparent if one were to see the following representation of the wristwatch registration as contained in the certificate of registration:



**45.** This is re-inforced by the other views provided in the certificates

of registrations of the wristwatch and the bracelet. Clearly, what is novel insofar as the shape of the wristwatch or the bracelet is concerned is not that they are circular. Novelty resides, *prima facie*, in their spiral shape and form, in which the head of the spiral can intersect with the next ring of the spiral, or be worn below or above it.

46. It is also significant that the shape, of which registration has been granted to the plaintiff under the Registrations Act, both for the wristwatch and the bracelet consists of a single link in which the head of the snake can intersect with the tail in a single loop.

47. Coming, now, to the configuration of the registered designs, the expression “configuration” etymologically, refers to the arrangement of items in the design. Ms. Bobde is correct in pointing out that, in the registered designs of the plaintiff’s bracelet and wristwatch, there is a peculiar configuration in which there are links of a particular trapezoid



shape , with similarity between alternating links with the links intersecting into one another. Unquestionably, this kind of an intersection with trapezoid links, with alternate links being similar to each other, make for a novel configuration. It is in this configuration, therefore, that, in my view, novelty resides in the registered designs of the plaintiff.

48. When one compares this with the design of the defendant's bracelet, I am unable, *prima facie*, to come to a conclusion that there is an infringement of the plaintiff's registered design. The head of the snake in the defendant's design is totally different, both in shape and design, from that in the plaintiff's registered design. The shape of the defendant's bracelet has several loops, unlike the plaintiff's registered design which consists of a single loop with the tail of the snake intersecting with its head. The unique trapezoid shape and design of the links in the chain of the plaintiff's design are visually and conceptually different from the links in the chain of the defendant's design which are in the form of normal chain links seen in several such items. Holistically viewed, therefore, it is not possible for me to hold that, *prima facie*, the design of the defendant's bracelet infringes the registered design either of the plaintiff's bracelet or the plaintiff's wristwatch.

49. Insofar as the judgment of the High Court of Calcutta in *Castrol*<sup>3</sup> is concerned, my *prima facie* conclusion hereinabove, on the aspect of infringement of design, would not militate, in my manner, from the view expressed by the High Court of Calcutta in the said decision. What is said in the said decision is that, when examining infringement of a design, one is not to break the article down into integers but to view the competing articles in totality. Even viewed in totality, I am of the opinion that it cannot be said that the defendant's design is in any manner similar to the design in respect of which the plaintiff holds registration,

either with respect of its wristwatches or with respect to its bracelets.

50. I had specifically queried, of Mr. Mehta, regarding the item



, the plaintiff admittedly does not hold any registration in respect of the said item either under the Trade Marks Act or under the Designs Act. At the highest, therefore, the case that the plaintiff may make out in respect of the said item can only be one of passing off. To make out even a *prima facie* case of passing off at the very least, clear averments are required to be present in the plaint regarding the use of the trademark or the design, for long as well as goodwill and reputation that it has carved out over a period of time. No such averments are contained in the plaint. No case of passing off, therefore, can be made out, even, *prima facie*, in respect of the said design.

### **Conclusion:**

51. In view of the above discussion, I am of the opinion that a *prima facie* case has been made out by the plaintiff in respect of infringement of its “SERPENTI” range of marks, by the use, by the defendant, of the mark “SERPENTINE” for identical goods. However, in my view, there is no *prima facie* case of design infringement by the defendant of any of the designs in which the plaintiff holds registrations.

52. Resultantly, this application is disposed of by issuing an interim injunction restraining the defendant, its individual proprietors/partners, agents, representatives, distributors, assigns, heirs, successors, stockists and all other acting for and on their behalf from using the trademark “SERPENTINE” in respect of any of its products. It is clarified, however, that there is no injunction against the defendant using the allegedly infringing designs.

53. The application stands disposed of in the aforesaid terms.

**CS(COMM) 658/2021**

54. List before the Joint Registrar on 22<sup>nd</sup> March, 2022.

**C. HARI SHANKAR, J**

**FEBRUARY 21, 2022/r.bararia/kr**

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