

Toothbrush design row reaches Supreme Court



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In a legal battle being fought over toothbrush designs, the Supreme Court has issued a notice to the Controller General of Patents, Designs and Trademarks on a petition filed by Anchor Health & Beauty Care Pvt Ltd. Anchor has petitioned the Supreme Court against the decision of Calcutta High Court dismissing its appeal against the controller's order rejecting its application seeking cancellation of two Colgate toothbrush designs.

The Supreme Court will also consider a cross-appeal filed by Colgate-Palmolive Company, challenging the high court's decision that Colgate's design No. 180362 could not have been registered because of already published designs.

Background

The dispute started with Colgate-Palmolive registering three toothbrush designs with the Design Office and rivals Anchor Health & Beauty Care filing petitions seeking cancellation of these designs. Anchor claimed that Colgate's designs could not be registered as its designs for a similar product were already registered under the Designs Act, 2000.

After a series of hearings, the Controller General of Patents, Designs and Trademarks held that the three models registered as toothbrushes by Colgate-Palmolive satisfied the definition of "designs" under the Designs Act. During the hearings, every portion of the toothbrush – head, bristles and handle – was scrutinized.

The Design Office concluded that the designs were different from those registered earlier. This was challenged by Anchor in an appeal before the Calcutta High Court.

The high court upheld the controller's order on two of the toothbrush designs

registered by Colgate-Palmolive but ordered that the controller's order on Colgate's design No. 180362 be set aside and so allowed Anchor's appeal.

High court appeal

Anchor's appeal was filed for setting aside of the controller's orders on its applications seeking cancellation of Colgate's registered toothbrush designs Nos. 176343, 176345 and 180362. The appeal rested on the contention, first, that the designs are not designs as defined under the act and also were not new or original. The variation, if any, was only a trade variation and functional.

Anchor also contended that the designs ought not to be on the register on the grounds of prior publication, as Anchor had registered similar designs in 1996 and 1997, i.e. before the registration of Colgate's designs in 1998.

Anchor argued that the earlier registered designs have the same or similar neck, handle and bristles, which constitute a toothbrush, as those registered by Colgate and therefore neither the handle, neck or bristles has a distinctive eye appeal from a prior published design nor is there any distinct addition to such design. The addition, if any, is functional and therefore there is no novelty.

The bristles in a prior registered design are long and short, which can as well be described as zigzag bristles, being proof enough of the functionality of the design taking precedence and being manifested as a trade variant rather than a novel design.

The court undertook a comparison between the essential features of Colgate's designs and Anchor's prior published designs, and also a determination of their date of registration. The findings culminated in the court's observation that the controller had

considered all materials, which is evident from his order, and that the order was not perverse, which would call for interference.

Dwelling on the concept of a design being "original" as defined in the Designs Act, the court concluded that Colgate's design Nos. 176343 and 176345 are the results of an exercise of intellectual activity on the earlier designs and are therefore an "original" design according to the law. The law says that "original", in relation to a design, means originating from the author of such design and includes designs which though old in themselves yet are new in their application.

Thus, these designs were held to be original, new and not published earlier.

However, in the case of design No. 180362, the court held that in view of the prior publication of registered design Nos. 176343 and 176345, No. 180362 could not have been registered and therefore set aside the findings of the controller in respect of this design as they cannot be sustained. The court remarked that the toothbrush bristles, though different from those in design Nos. 176343 and 176345, are a trade variant and functional.

The Supreme Court in its treatment of the case in hand may elucidate on the essential requirements to qualify for a design registration and also on whether the high court erred in failing to consider that a registered design can be cancelled on the ground of prior registration under section 19(1)(a) of the Designs Act only if the design registered prior in time is held to be identical to the subsequent design for which cancellation is sought.

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