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

+ **CS(COMM) 625/2018 and I.A. 350/2016**

CROCS INC USA

..... Plaintiff

Through: Mr. Shravan Bansal & Mr. Pankaj
Kumar & Mr. Mankaran Singh,
Advocates. (M:9718833632)

versus

M/S BATA INDIA LTD AND ORS

..... Defendants

Through: Mr. Neeraj Grover Mr. Kashish Sethi
Ms. Sunidhi Gupta & Ms. Ayushi
Chandra, Advocates. (M:
9138181263)

CORAM:

JUSTICE PRATHIBA M. SINGH

ORDER

% **12.07.2023**

1. This hearing has been done through hybrid mode.
2. The present suit has been filed by the Plaintiff - Crocs Inc USA seeking permanent injunction restraining the infringement of the Plaintiff's registered design under the Designs Act, 2000 and passing off, delivery up. etc. The Plaintiff has filed the present suit of infringement in respect of registered design no. 197685 against the Defendant No.1 - M/s Bata India Ltd.
3. Mr. Grover, Id. Counsel for the Defendants submits that as of 2019 the term of the design has come to an end. In addition, Id. Counsel has placed on record the order dated 9th May, 2019 passed by the Dy. Controller of Patents & Designs by which the Plaintiff's registered design



no. 197685 which is subject matter of this suit has been cancelled. The operative portion of the Controller's order reads as under:

"14. 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. The features stated to be added by the respondent in the impugned design are not sufficient to alter the character or the identity of the design previously published and known to art. 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 application of prior published designs is in reference to same article. Hence the respondent's design cannot be held as new or original.

15. In view of preceding analysis, the present petition filed by M/s Brainbees Solutions Pvt. Ltd. for cancellation of registered design no. 197685 dated 28th May, 2004 in respect of 'Footwear under Class 02-04 is allowed and it is ordered to cancel the said design in the Register of Designs."

4. The existence of this order is not disputed by the Mr. Bansal, Id. Counsel for the Plaintiff. It is submitted by Id. Counsel that the Plaintiff has filed an appeal challenging the said order of the Dy. Controller of Patents & Designs. He submits that there is another proceeding that has been initiated by the Plaintiff against the Defendants in respect of the shape mark relating to the registered design, in which the suit was dismissed but an appeal is pending before the Division Bench of this Court.

5. In view of the fact that the design has been cancelled, that too on the ground of lack of novelty and prior publication, the suit can no longer continue. If, however, any order is passed in the appeal in favour of the



Plaintiff restoring the registered design, then the remedies of the Plaintiff are left open, to be availed of, in accordance with law.

6. The Local Commissioner who was appointed for recording of evidence is discharged.

7. The present suit along with all pending applications is disposed of.

PRATHIBA M. SINGH, J.

JULY 12, 2023

dj/kt