



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

% *Judgment reserved on: 23rd March, 2023*
Judgment delivered on: 16th August, 2023

+ CS(COMM) 1078/2018 & I.A. 11007/2018 (O-XXVI R-9 of CPC)
HERO MOTOCORP LIMITED Plaintiff
Through: Mr. Gaurav Miglani and Ms. Shivika
Chaudhary, Advocates.

versus

SHREE AMBA INDUSTRIES Defendant
Through: Mr. Amit Sibal, Senior Advocate with
Mr. Sushant Singh, Mr. Rishab
Sharma, Mr. Sourav Pattanaik,
Mr. Vinay Tripathi, Mr. Saksham,
Ms. Mary Jonet and Mr. Kunal
Khanna, Advocates.

CORAM:
HON'BLE MR. JUSTICE AMIT BANSAL

JUDGMENT

I.A. 11006/2018 (O-XXXIX R-1 & 2 of the CPC)

1. By way of the present judgment, I shall decide the captioned application filed on behalf of the plaintiff company under Order XXXIX Rules 1 and 2 of the Code of Civil Procedure, 1908 (CPC).
2. The present suit has been filed seeking relief of permanent injunction restraining the defendant from infringing the registered design of the plaintiff company along with other ancillary reliefs.



3. Reply to the interim application was filed on behalf of the defendant on 28th August, 2018 and the rejoinder thereto has also been filed by the plaintiff company.

4. On 30th January, 2023, I.A.2211/2023 under Order VI Rule 17 of the CPC was also moved on behalf of the defendant for amendment of the written statement. The said amendment was sought in order to incorporate an objection based in law relating to the suit design not being registrable under the Designs Act, 2000 (hereinafter 'Designs Act'). While keeping open the right of the plaintiff company to raise objections to the amendment sought by the defendant, *vide* order dated 1st March, 2023, I.A.2211/2023 was allowed.

5. Arguments were heard on 17th January, 2023, 6th February, 2023, 27th February, 2023, 1st March, 2023, 15th March, 2023 and 23rd March, 2023, when the judgment was reserved in the captioned application. Subsequently, written submissions have also been filed on behalf of the parties.

CASE SET UP IN THE PLAINT

6. The case set up by the plaintiff company in the plaint is as follows:

6.1. The plaintiff company is part of the "Hero Group" and is engaged in the business of manufacturing and selling of automobiles, spare parts, fittings and accessories thereof.

6.2. One of the motorcycle models being sold by the plaintiff company is the "HERO HF DELUXE" motorcycle. The plaintiff company also sells front fenders for the said motorcycle model. The design of the front fender



of the plaintiff company is a registered design bearing Registration No.271199 registered on 7th April, 2015.

6.3. In the registered design of the plaintiff company's front fender, the surface of the front section is elevated, forming a "V" shape design and has slightly elongated sides, which give a distinct and aesthetic look to the fender.

6.4. Sales figures of the plaintiff company pertaining to the "HF DELUXE" motorcycles with the suit fender as well as the sales figures from the independent sale of the suit fender from the year 2015–2016 to 2018–2019 are provided in paragraph 12 of the plaint. The plaintiff company has also provided their advertisement and publicity expenses in paragraph 13 of the plaint.

6.5. In June 2018, the plaintiff company became aware of a front fender similar to their own, being manufactured by the defendant and sold in the market. Upon examination, the plaintiff company discovered the front fender of the defendant sold as "HF DLX TYPE" to be a copy of the registered design of the plaintiff company.

6.6. The "HF DLX TYPE" front fender of the defendant clearly refers to the plaintiff company's motorcycle sold under the name "HERO HF DELUXE", on which motorcycle such front fender can be set.

6.7. The defendant's replication of the registered design of the front fender of the plaintiff company is an act of piracy of the registered Design No.271199 of the plaintiff company.



6.8. The replication and infringement of the registered design of the plaintiff company by the defendant is dishonest and *mala fide*. The similarities between the two products are so close and exact that the adoption by the defendant of its front fender design is, without a doubt, fraudulent and tainted with dishonesty.

6.9. Due to continuous and extensive use and publicity of the suit design, the plaintiff company has acquired immense goodwill and reputation and the design of the front fender has come to be exclusively associated with the plaintiff company by the members of the public and the trade. Thus, the design has become a source identifier of the plaintiff company.

6.10. The front fender of the defendant is being sold for a price lesser than that of the plaintiff company's, leading to damage to the business, goodwill and reputation of the plaintiff company.

6.11. Accordingly, the present suit along with an application for interim injunction has been filed against the defendant.

CASE SET UP IN THE WRITTEN STATEMENT

7. In the written statement, the defendant has pleaded as under:

7.1. The defendant is a partnership firm engaged in manufacturing and selling spare parts of two-wheeler motorcycles, including that of the plaintiff company, since 2008. The defendant has been in the business of spare parts in Karol Bagh and has sold its products at other places in India.

7.2. The defendant has been selling the front fender which fits the plaintiff company's motorcycles "HERO HF DELUXE" and "HERO HF DELUXE ECO" since 2017.



7.3. The defendant has been selling front fenders of several motorcycles apart from that of the plaintiff company. There exist various other manufacturers in the market apart from the defendant who have been selling front fenders similar to that of the plaintiff company for several years.

7.4. The defendant has been selling fenders of other motorcycles of the plaintiff company prior to the date of registration of the design and there is nothing unusual about the activities of the defendant.

7.5. The plaintiff company has suppressed the fact that it carried out wide publicity of the “HF DELUXE” and “HF DELUXE ECO” models prior to the date of registration of the design. The plaintiff company also advertised the suit fender in 2013 and 2014, which was prior to the registration of the design of the plaintiff company in 2015. In this regard, the defendant has provided websites and advertisements in motion picture of the motorcycles with the suit fender from 2013 and 2014 in paragraph 3 of the written statement.

7.6. Additionally, the registered design is not different from previous designs of the front fenders of earlier models of the plaintiff company’s motorcycles. Therefore, the design of the front fender of the plaintiff company is neither new nor original.

7.7. The registered design of the plaintiff company is not different from the front fenders of third-party manufacturers. Many such designs have been operative prior to the date of registration of the said design including “TVS APACHE RTR 160”, “YAMAHA”, SUZUKI INAZUMA 250 JSR” and “BMW”.



7.8. The submission made by the plaintiff company in respect of dishonest adoption of the suit design by the defendant is solely aimed at preventing the sale of spare parts and replacement parts based on the original manufacturer's design.

7.9. The design of the plaintiff company is not registerable under the Designs Act. The front fender is sold as a replacement part and is not an article or part of an article within the meaning of Section 2(a) of the said Act.

SUBMISSIONS OF THE PLAINTIFF COMPANY

8. On behalf of the plaintiff company, the following submissions have been made:

8.1. The plaintiff company had registered the design of the front fender on 7th April, 2015. The design of the plaintiff company qualifies as a "design" under Section 2(d) of the Designs Act and is "new" and "original" in terms of Section 4(a) read with Section 2(g) of the Designs Act respectively.

8.2. A comparison of the fender of the plaintiff company and that of the defendant shows that the fender sold by the defendant is identical to that of the plaintiff company.

8.3. After registration of the design in 2015, the plaintiff company has been openly and continuously using and advertising the said design by selling the front fenders independently and along with the "HERO HF DELUXE" motorcycle.



8.4. Registration of the design is itself *prima facie* evidence of the validity of the design. Since the defendant is unable to show any credible challenge to the registered design of the plaintiff company, an injunction must follow.

8.5. The defendant had full knowledge of the design of the plaintiff company and intentionally imitated the said design. After the adoption is found to be dishonest, an injunction must follow as per the settled law. Reliance in this regard is placed on *Midas Hygiene Industries Pvt. Ltd. v. Sudhir Bhatia & Ors.*, (2004) 3 SCC 90.

8.6. If the designer is restricted in developing the design, minor differences between comparable designs would be sufficient to produce an overall impression to an informed user regarding the distinctiveness of the art. Reliance in this regard is placed on *Thomas Murphy v. European Union Intellectual Property Office*, Case T-90/16 dated 4th July, 2017.

8.7. There must be clear and unmistakable disclosure of the features of the design where the evidence of prior art is a paper publication. Further, the design of the plaintiff company must be disclosed in a single prior art document to be considered as not new or original. Reliance has been placed on *Reckitt Benkiser India Ltd. v. Wyeth Ltd.*, 2013 SCC OnLine Del 1096.

8.8. The defendant has tried to equate the threshold of novelty under patent law with the threshold of “new” or “original” under the Designs Act, which cannot be done. Reliance in this regard has been placed on *Diageo Brands B.V. v. Great Galleon Ventures Limited*, 2022 SCC OnLine Del 2350.



8.9. If the design of the suit fender were commonplace, there is no justification for the defendant to not manufacture the present fender in all these years. The design was copied only in 2017, once the fender of the plaintiff company had gained reputation.

8.10. With no assurance on quality, fenders sold under identical designs have the potential to cause irreparable harm and injury to the reputation of the plaintiff company.

8.11. The front fenders of the plaintiff company are articles in terms of Section 2(a) of the Designs Act. The Statement of Objects and Reasons of the Designs Bill, 1999 provides that the Bill intended to enlarge the scope of definition of “article” and “design” and the phrase “parts of articles” was included in the Designs Act, 2000 in contrast to the old Designs Act, 1911. Thus, the definition of the word “article” should not be read narrowly as proposed by the defendant.

8.12. If the narrow interpretation of the word “article” as given by the defendant is accepted, it would render thousands of design registrations granted for spare parts susceptible to cancellation.

8.13. Interpretation of the defendant is contrary to Rule 10 of the Design Rules, 2001, which protects component parts of various articles like vehicles, engines, textile machines and the like. The Act is a code within itself and does not give a right or special privilege to spare part manufacturers to replicate or reproduce a design.

SUBMISSIONS OF THE DEFENDANT



9. On behalf of the defendant, the following submissions have been made:

9.1. The registered design of the plaintiff company is neither new nor original since the design of the suit fender has been advertised by the plaintiff company in 2013 and 2014, prior to the date of registration in 2015. The advertisement is available on various internet websites including that of the plaintiff company. Such advertisements on the internet are available not only in India, but globally, making it a prior publication in tangible form. Any trade/part catalogue and depiction contained therein shall constitute prior publication. Reliance in this regard has been placed on *Reckitt Benkiser India Ltd. v. Wyeth Ltd.*, 2013 SCC OnLine Del 1096.

9.2. The design of the front fender of the plaintiff company is substantially similar to other front fenders of its earlier models of motorcycles, namely “HERO CD Deluxe” and “HERO CBZ Xtreme”, which were launched in the year 2006. The suit design of the plaintiff company’s front fender has miniscule changes, thereby not satisfying the test of novelty of special degree as required by the law.

9.3. The front fender of the plaintiff company is not significantly different from third-party fenders, including “TVS APACHE RTR 160”, “YAMAHA”, “SUZUKI INAZUMA 250 JSR” and “BMW”. The said design is merely a trade variant and not significantly distinguishable to be considered as novel. The registration of the design is thus violative of Sections 4(a), 4(b) and 4(c) read with Section 19(1)(d) and Section 22(3) of the Designs Act.



9.4. The suit design is also vitiated by prior use and publication of the said design and patents in foreign countries, which existed in the public domain much prior to the registration of the design of the plaintiff company, making it violative of Sections 19(1)(b) and 19(1)(c) of the Designs Act.

9.5. The plaintiff company has failed to disclose that the “V” shape technology of the front fender gives functional result rather than aesthetic appeal. The design aims to control the airflow towards the engine for the purposes of efficiency results. The registration thus becomes violative of Section 19(1)(a) of the Designs Act as it does not fall under the definition of “designs”.

9.6. There is a pre-existing wide-scale market for spare parts of motorcycles and other two wheelers where the spare parts of various products are sold in addition to those sold by the Original Equipment Manufacturer (OEM). The product is being produced in the public domain and is neither new nor original. The plaintiff company, by claiming design infringement, is trying to prevent the sale of spare parts of their products when there is a large market for the said products.

9.7. Granting registration to designs which do not deserve protection prevents competition. Reliance in this regard has been placed on the judgments of (i) *Niki Tasha India (P) Ltd. v. Faridabad Gas Gadget Pvt. Ltd.*, 26 (1984) DLT 355; and, (ii) *Rotela Auto Components (P) Ltd. v. Jaspal Singh & Ors.*, 95 2002 (24) PTC 449.

9.8. There is no confusion and deception by the defendant in the market as all products of the defendant are sold under the brand name of “SAI”, whereas those of the plaintiff company are sold under the brand name of



“HERO”. It is the choice of the consumers as to which spare part they intend to buy.

9.9. The suit fender is sold not as an independent but as a replacement part of a motorcycle and is therefore, not an article in itself under Section 2(a) of the Designs Act. Such kind of spare parts and replacement parts are not covered under the definition of “article” in the Designs Act and is against the purport and meaning of “*part of an article capable of being made and sold separately.*”

9.10. The definition of an “article” under Section 2(a) of the Designs Act is *pari materia* with Section 44(1) of the unamended Registered Designs Act, 1949 of the United Kingdom prior to its amendment in 2001. The words “*made and sold separately*” would mean an independent life as an article of commerce. The main test is to see if the said part will continue to be manufactured and sold even if the larger article has come to an end. Replacement/spare parts of a larger article essential to the shape of the larger article have no independent life of their own apart from the larger article. Reliance in this regard is placed on the judgment of the House of Lords in *Ford Motor Co. Ltd.’s Design Applications*, [1995] R.P.C. 167.

SUBMISSIONS IN REJOINDER

10. The counsel appearing on behalf of the plaintiff company made the following submissions in rejoinder:

10.1. The Chancery Division in *Sifam Electrical Instrument Company v. Sangamo Weston Limited*, [1973] R.P.C. 899 held that registration has to be



granted to such parts of articles that are intended by the proprietor to be made and sold separately.

10.2. The judgment of the House of Lords in *Ford Motor Company* (supra) is distinguishable in light of the judgment of the Division Bench of the Bombay High Court in *Marico Limited v. Raj Oil Mills*, AIR 2008 Bom 111, wherein, while noting that there is a difference between the English and the Indian definition of the word “article,” the Court held that the intention of the legislature was to enlarge the definition of “article” in the Indian Act in order to include within its ambit a part of an article as well. Therefore, any restriction placed on the definition of “article” under Indian law, to exclude an article which does not have its own independent commercial identity, is not tenable in law.

10.3. The submission of the defendant, that the phrase “*part of an article capable of being made and sold separately*” in Section 2(a) of the Designs Act has to be read to mean those parts that have an independent commercial life of their own apart from the larger article of which they form a part, is fallacious. The test is whether the part can be detached and sold separately. The said part should not be so inextricably fixed that it is impossible to make and sell it separately. Reliance in this regard is placed on *Glaxo Smithkline Consumer Healthcare v. Amigo Brushes Pvt. Ltd. & Anr.*, 2005 Del SCC OnLine 1342.

11. I have heard the counsels for the parties and examined the material on record.

ANALYSIS AND FINDINGS



12. In the present case, there is no dispute that the front fender of the defendant is an exact replica of the front fender of the plaintiff company. The defendant itself states that the defendant's fender is to be an exact replacement of the fender for the plaintiff company's motorcycle.

13. Before dealing with the submissions of the parties, it would be prudent to refer to the overall scheme of the Designs Act with regard to registration of a design. In this regard, reference may be made to the following provisions:

“2. Definitions.—In this Act, unless there is anything repugnant in the subject or context,—

...

(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; ...

4. Prohibition of registration of certain designs.—A design which—

(a) is not new or original; or

(b) 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; or

(c) is not significantly distinguishable from known designs or combination of known designs; or

(d) comprises or contains scandalous or obscene matter, shall not be registered.

5. Application for registration of designs.—(1) The Controller may, on the application of any person claiming to be the



proprietor of any new or original design not previously published in any country and which is not contrary to public order or morality, register the design under this Act:

Provided that the Controller shall before such registration refer the application for examination, by an examiner appointed under sub-section (2) of section 3, as to whether such design is capable of being registered under this Act and the rules made thereunder and consider the report of the examiner on such reference.

...

(6) A design when registered shall be registered as of the date of the application for registration.

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7. Publication of particulars of registered designs.—The Controller shall, as soon as may be after the registration of a design, cause publication of the prescribed particulars of the design to be published in such manner as may be prescribed and thereafter the design shall be open to public inspection.”

14. A perusal of the provisions above would show that the purpose of enacting the Designs Act was to protect new and original designs by giving exclusive rights over such designs to their inventors. At the same time, there are limitations to the protection afforded under the Designs Act. Section 4 of the Designs Act provides that certain designs are not amenable to registration and includes within its ambit designs that are not “*new or original*”. Section 4(c) of the Designs Act uses the words “*significantly distinguishable*” from known designs or combinations of designs. In terms of Section 4(b), for a design to be eligible for registration under the Designs Act, it must not already be published in India or abroad.

15. A reading of Section 5 above would show that the Designs Act does not contemplate publication and advertisement of a design before grant of



registration, which is in stark contrast to the procedure for registration of trademarks provided under the Trade Marks Act, 1999¹. Section 7 of the Designs Act provides that the publication will occur only after the registration of the design.

16. Now, a reference may also be made to Sections 19 and 22 of the Designs Act, which are set out below:

“19. Cancellation of registration.—*(1) Any person interested may present a petition for the cancellation of the registration of a design at any time after the registration of the design, to the Controller on any of the following grounds, namely:—*

- (a) that the design has been previously registered in India; or*
- (b) that it has been published in India or in any other country prior to the date of registration; or*
- (c) that the design is not a new or original design; or*
- (d) that the design is not registrable under this Act; or*
- (e) that it is not a design as defined under clause(d) of section 2.*

(2) An appeal shall lie from any order of the Controller under this section to the High Court, and the Controller may at any time refer any such petition to the High Court, and the High Court shall decide any petition so referred.

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22. Piracy of registered design.—

...

(2) If any person acts in contravention of this section, he shall be liable for every contravention—

...

(b) if the proprietor elects to bring a suit for the recovery of damages for any such contravention, and for an injunction against the repetition thereof, to pay such damages as may be awarded and to be restrained by injunction accordingly:

...

¹ See §§ 18 to 23, Trade Marks Act, 1999.



(3) In any suit or any other proceeding for relief under subsection (2), ever ground on which the registration of a design may be cancelled under section 19 shall be available as a ground of defence.”

17. A perusal of the above shows that Section 19 of the Designs Act provides for grounds of cancellation of a registration of a design, which include, *inter alia*, (i) publication of the design prior to its registration date; (ii) the design not being “new or original”; and, (iii) the design not being registrable under the statute. Section 22(3) of the statute further provides that all the grounds available under Section 19 for cancellation of a design would be available as a defence in a suit. Unlike Section 31 of the Trade Marks Act, 1999, there is no *prima facie* presumption with regard to validity of a design on account of its registration.

18. On behalf of the plaintiff company, reliance has been placed on the judgment in *Bharat Glass Tube Limited v. Gopal Glass Works Limited*, (2008) 10 SCC 657 to submit that the burden is on the defendant to show that the plaintiff company’s design is not new or original.

19. The term new is not defined under the Designs Act, however, the word “original” is defined in Section 2(g) of the Act as under:

“(g) “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;”

20. The expression, “new or original” has been interpreted in *Bharat Glass Tube* (supra) in the following manner:

“29. ...The expression, “new or original” appearing in Section 4 means that the design which has been registered has not been published anywhere or it has been made known to the



public. The expression, “new or original” means that it had been invented for the first time or it has not been reproduced by anyone.”

21. In *Steelbird Hi-Tech India Ltd. v. S.P.S. Gambhir And Ors.*, 2014 SCC OnLine Del 821, a Single Bench of this Court was concerned with the infringement of the helmet design of the plaintiff by the defendant and the issue to be decided by the Court was whether the shape and configuration claimed by the plaintiff was new or original or had not been subject to prior publication on the date of the registration. Holding that designs similar to that of the plaintiff were available in the market much before the date of registration of the plaintiff’s design, the Court held that the plaintiff’s design was neither new nor original and hence, interim injunction was refused. The relevant observations of the Court are set out below:

*“20. It is rightly held in the cases decided that in the matter of novelty the eye is to be the ultimate test and the determination has to be on the normal ocular impression. **In order to know its newness or originality it is necessary that a design identical with or even materially similar to the relevant design should not have been published or registered previously. A slight trivial or infinitesimal variation, from a pre-existing design will not qualify it for registration. Taking into account the nature of the article involved, the change introduced should be substantial.** It is not necessary to justify registration that the whole of the design should be new, the newness may be confined to only a part of it but that part must be a significant one and it should be potent enough to impart to the whole design a distinct identity, unless registration is sought for the said part alone.”*

22. In *Dart Industries Inc. And Ors. v. Techno Plast And Ors.*, 2007 SCC OnLine Del 892, the Court laid down the test for what constitutes pre-publication of a design. The judgment quotes from Russell-Clarke on



Industrial Designs (Sixth Edition) to illustrate the manner in which prior publication can be found. The relevant extract from the judgment is as under:

“25. Russell-Clarke on Industrial Designs (Sixth Edition) also throws some light on the manner in which prior publication is to be found. Relevant portion from the said book containing discussion on this aspect can be reproduced below:

‘3.89. ...In practical terms, there are two main ways in which a design can be published by prior use of the design, by selling or displaying to the public articles to which the design has been applied, and by paper publications of one sort or another.

3.92. Prior publication of a design by prior use can be said to take place when the design has been applied to articles and those articles have been used in such a way that the design becomes disclosed to the public before the date of application for registration of the design in suit. It should be noted that it is sufficient if the design is used on any kind of article, and it need not be the same article, or even in the same category, as the article in respect of which the design is registered or sought to be registered.

3.93. In general there will be publication if articles to which the design is applied are manufactured, displayed or used in such a way that members of the public will or might see them. It is not necessary that the articles should have been sold.

3.95. Thus, if the use was in such a position and in such circumstances that some members of the public would be likely to have seen the design, there will be publication, even though it is not proved that anyone did examine it.

3.96. The disclosure of the prior use need not be to a large number of the public. If there has been a disclosure of the design to any individual member of the public....

3.121. ...However, there is no restriction on the manner in which the design comes to be published and the disclosure could even be purely oral. In general, there



will be publication if the design is disclosed to any individual member of the public who is not under any obligation to secrecy. Disclosure to merely one such person will be sufficient to constitute publication....

*3.147. What is a trade variant was explained by Lord Moulton in Philips v. Harbro Rubber Co.... It is necessary with regard to the question of infringement and still more with regard to the question of novelty and originality that the eye should be that of an instructed person i.e. that he should know what was common trade knowledge and usage in the class of articles to which the design applies. **The introduction of ordinary trade variants into an old design cannot make it new or original. For example, if it is common practice to have or not to have spikes in the soles of running shoes, a man does not make a new or original design out of an old type of running shoe by putting spikes into the soles.***







3.181. In order to ascertain what the registered design is, so that it may be compared with the alleged infringement, it is necessary to examine the representation of the design on the register. A copy of this is in practice attached to the certificate of registration...although if this course is adopted care should be taken to avoid introducing further features which are not present on the representation on the register...

3.182. A registration, if valid gives to the registered proprietor an exclusive right in relation to article to which the registered design, or a design not substantially different from it....' ”

23. In ***B. Chawla & Sons v. M/s. Bright Auto Industries***, 1980 SCC OnLine Del 320, a Division Bench of this Court observed that an addition to a curve here or there in shape, which is a well-recognized shape of an article of common use in the market cannot make it an article new or original in design and therefore, such a claim was devoid of newness and equally devoid of originality.



24. Keeping in view the aforesaid principles, I proceed with the comparison between the prior art put forth by the defendant/designs of front fenders of different brands already available in the market with the registered design of the suit fender of the plaintiff company, which is set out below:

PRIOR ART	PLAINTIFF'S FRONT FENDER
<p data-bbox="454 728 702 766" style="text-align: center;">TVS APACHE</p> 	<div style="display: flex; justify-content: space-around;"> <div style="text-align: center;"> <p data-bbox="917 750 1061 784">Top View</p>  </div> <div style="text-align: center;"> <p data-bbox="1228 862 1388 896">Perspective View</p>  </div> </div>
<p data-bbox="375 1220 782 1258" style="text-align: center;">HERO CBZ EXTREME</p> 	<div style="display: flex; justify-content: space-around;"> <div style="text-align: center;"> <p data-bbox="917 1276 1061 1310">Top View</p>  </div> <div style="text-align: center;"> <p data-bbox="1228 1388 1388 1422">Perspective View</p>  </div> </div>

25. A perusal of the above pre-existing designs cited by the defendant shows that both of the aforesaid designs contain a feature of 'V' shape on the face of the fender and have elongated sides. This Court has also had the



opportunity to compare the actual front fenders of the “TVS Apache” motorcycle and the defendant company with the front fender of the plaintiff company, samples of which were shown during the course of the hearing.

26. A comparison above shows that there are substantial similarities between the design of “TVS Apache” and the design of the plaintiff company, both of which have a ‘V’ shape design with elongated sides. The slight change in the ‘V’ shape of the various fenders would therefore amount to nothing more than a trade variation/adjustment. The difference, if any, between the said designs is of cut and curve alone. It is also an admitted position that the “TVS Apache” design was published as far back as in 2008, much prior to the launch of the plaintiff company’s motorcycle. Reference in this regard may be made to the TVS Apache Parts Catalogues from 2008, 2012 and 2014 (pages 4 to 24 and 27 to 35 of the convenience volume of documents filed on behalf of the defendant). The defendant has also placed on record invoices to demonstrate that the “Apache RTR” front mudguard carrying the suit design has been selling in the Indian market since 2012. In *Reckitt Benkiser* (supra), it has been held that trade catalogues/part catalogues and depictions contained therein constitute prior publication.

27. It may also be noted that the plaintiff company itself has had other existing models that have a fender with a ‘V’ shape. As illustrated in the table above, the “HERO CBZ EXTREME” model of the plaintiff company has a fender with a ‘V’ shape and elongated sides and it has been selling from a date prior to the model “HERO HF DELUXE”, which has the suit fender.



28. Even the design of the suit fender for the “HERO HF DELUXE” motorcycle has been advertised by the plaintiff company in 2013 and 2014, prior to the date of registration of the design in 2015. Reference in this regard may be made to pages 5 to 31 of the documents filed on behalf of the defendant, which are screenshots from the plaintiff company’s own website, YouTube, and an internet article detailing the product portfolio and the unveiling of the “HERO HF DELUXE” motorcycle.

29. Counsel for the plaintiff company also submitted that the ‘V’ shape and elongated sides are not the only unique parts of its design. There are other unique features and therefore, what has to be considered is the overall design of the fender. However, the unique design of the suit fender of the plaintiff company has been described by the plaintiff company itself in paragraph 10 of the plaint as being that of a ‘V’ shape as well as elongated sides. In my *prima facie* view, the aforesaid prior published design samples duly contain the aforesaid features.

30. On behalf of the plaintiff company, it has also been submitted that in the present case, there is limited design freedom for the plaintiff company and therefore, even if there are limited variations in the design, they cannot be overlooked. Reliance in this regard is placed on the judgment in ***Thomas Murphy v. European Union Intellectual Property Office*** (Case T-90/16 dated 4th July, 2017). The aforesaid judgment was in the context of wristbands and passed after a full trial and it was noted that the design of an electronic band was limited by technological constraints that specifically applied to wristbands. However, there is no basis to say that such design limitations would be applicable in the case of fenders of motorcycles. The



fact of the matter is that for a fender to be functional, the plaintiff company need not have the fender with a ‘V’ shape. There are so many other models after the plaintiff company which have fenders without a ‘V’ shape. The plea of design freedom cannot be used to get over the existing prior publication of the design.

31. On behalf of the plaintiff company, reliance has been placed on the judgment of a Coordinate Bench of this Court in *Diageo Brands B.V. And Anr. v. Great Galleon Ventures Limited.*, 2022 SCC OnLine Del 2350 in support of the contention that the design of the plaintiff company’s fender is new and original. In *Diageo* (supra) the Court was concerned with the design infringement of a bottle/hip flask. In the said case, the plaintiff had designed a shape of the bottle/hip flask inspired by smartphones. Noting that the said design was new and original, an injunction was granted in favour of the plaintiff. However, in the said judgment, the Court specifically noted that it was not the defendant’s case that there existed a prior publication which was based on the lean and thin design of a smartphone. Further, it was observed that the plaintiff’s product was the first in the market to take the visually appealing features of smartphones and apply them to an alcohol bottle/hip flask. This judgment does not advance the case of the plaintiff company as the defendant in the present case has placed on record designs of fenders that were published prior to the date of registration of the design of the plaintiff company and which designs are almost identical to that of the plaintiff company.

32. On behalf of the plaintiff company, reliance is placed on the Full Bench judgment in *Reckitt Benkiser* (supra) to submit that it is not



permissible to make a mosaic of a number of prior documents for the purpose of attacking novelty, but the present case does not involve mosaic of prior documents. By itself, the design of the plaintiff company is similar to a number of prior documents by themselves without any mosaic.

33. From a perusal of the discussion above, it is clear that the defendant has placed sufficient material on record to demonstrate that the design of the plaintiff company's front fender is neither new nor original. Neither can it be said that the plaintiff company's design is significantly distinguishable from known designs or combination of known designs in terms of Section 4(c) of the Designs Act. Further, as already noted above, the plaintiff company itself has been selling fenders for other models of its motorcycles, which carry the design comprising of a 'V' shape and elongated sides.

34. In light of the above, at this interlocutory stage, I am of the considered view that the defendant has laid a credible challenge to the design registration held by the plaintiff company.

35. Consequently, the plaintiff company has failed to make out a *prima facie* case for grant of interim injunction.

36. Even though the discussion above is sufficient to reject the present application for grant of interim injunction, since both sides have strenuously made submissions on the question of registrability of the suit fenders under the provisions of the Designs Act, I would be failing in my duty if I were not to examine the aforesaid aspect.

37. On behalf of the defendant, it has been argued that the fender involved in the present case would not fall under the definition of "article" under



Section 2(a) of the Designs Act. In this regard, senior counsel appearing on behalf of the defendant has placed reliance on the judgment of the Chancery Division of the High Court in *Ford Motor Company*, [1993] R.P.C. 399, which was also upheld by the House of Lords.

38. In the said case, the court was seized with the question of registrability of two sets of components of motor vehicles. The first set of components comprised of main body panels, doors, bonnet lid, boot lid, windscreen and the like, which articles form part and contribute to the overall shape and appearance of the vehicle. The second group of components included items such as wing mirrors, wheels, seats and the steering wheel, which, while contributing features to the appearance of the vehicle, were subsidiary to its essential shape. These articles in the second group could be substituted without affecting the overall shape and appearance of the vehicle.

39. Relying upon an earlier judgment of the Chancery Division in *Sifam* (supra), the Deputy High Court Judge of the Chancery Division in *Ford Motor Company* (supra) held that the first set of components was not registrable, as the said components have no independent existence as articles of commerce apart from their forming part of the complete vehicle. On the other hand, it was held that the second group of components are registrable, as they have an independent existence and can be sold separately.

40. Insofar as the non-registrability of the first set of components was concerned, Ford Motor Company took up the matter in appeal before the Queen's Bench Division (Divisional Court). The Divisional Court in *Ford*



Motor Co. Ltd.'s Design Applications, [1994] R.P.C. 545 dismissed the appeal by holding as under:

*“In my judgment, the interpretation given to the word “article” in the 1949 Act as amended is of crucial importance, an interpretation which is not provided for the new unregistered design right in Part III of the 1988 Act. **Within the interpretation the key words are “made and sold separately”.** To be that, an article has to have an independent life as an article of commerce and not merely be an adjunct of some larger article of which it forms a part. The selling of a mere replacement part is not separate from the sale of the article as a whole. Consequently, I agree with the Tribunal’s decision on the first point.”*

(emphasis supplied)

41. The aforesaid judgment was challenged by Ford Motor Company before the House of Lords. The House of Lords dismissed the appeal and upheld the aforesaid test laid down by the Divisional Court that for a spare part to qualify as an article under Section 44(1), a spare part has to have an independent life as an article of commerce and not be merely an adjunct of some larger article of which it forms part. The observations of the House of Lords in this regard are set out below:

“My Lords, for these reasons I have been compelled to give up the attempt to read the words of definition literally, and will instead look behind them for the intension of the legislature. In my opinion the purpose was to distinguish between, on the one hand, an item designed for incorporation, whether as a spare part or as an original component, in a particular article or range of articles made by the manufacturer of the component, in a particular article or range of articles made by the manufacturer of the component, and on the other an item designed for general use, albeit perhaps aimed principally at use with manufacturer’s own artifacts. Whilst it is often unwise



*to restate the effect of a statute in different words, since this may lead to the new formula being subjected to the kind of textual analysis which ought to be reserved to the statute itself, an answer will I believe be supplied in many cases by applying the criterion given by McCowan L.J., namely: **that to qualify under section 44(1) a spare part has to have an independent life as an article of commerce and not be merely an adjunct of some larger article of which it forms part.**”*

42. Senior counsel appearing on behalf of defendant contended that since the definition of the term “article” in English law, (as it existed then) was *pari materia* with the definition of the term “article” under Section 2(a) of the Designs Act, the *ratio decidendi* of the aforesaid judgment would be fully applicable in the present case.

43. *Per contra*, counsel for the plaintiff company relied upon an earlier judgment of the Chancery Division in *Sifam* (supra), where the Court had held that the only requirement for registrability of an “article” is that such parts of articles are intended by the proprietor of the design to be put in the market and sold separately. Therefore, what is of significance is the intention of the proprietor of the design. It was further contended that the House of Lords interpreted the relevant portion of the definition of “article” under Section 44(1) to read as “*if that part is to be made and sold separately*”, and not as “*articles that are susceptible of being made and sold separately*”. It has been further submitted that the definition of “article” under the Indian law is materially different from the definition that existed under the UK Act. Further, the Designs Act of India does not contain any “must match” exclusion that is provided under the UK Act.



44. At this stage, a reference may be made to the definition of “article”, as contained in the English law as it existed at the time of the aforesaid decision² and the Indian law, which are set out below:

SECTION 44(1), UK REGISTERED DESIGNS ACT, 1949	SECTION 2(a), DESIGNS ACT, 2000
<p>“ ...</p> <p><i>‘Article’ means any article of manufacture <u>and includes any part of an article if that part is made and sold separately.</u></i>”</p>	<p>“ ...</p> <p><i>“article” means any article of manufacture and any substance, artificial, or partly artificial and partly natural; <u>and includes any part of an article capable of being made and sold separately;</u>”</i></p>

45. Undoubtedly, Justice Graham in *Sifam* (supra) laid down the intention test in determining the registrability of a component i.e., whether the proprietor of the design intended the same to be put in the market and sold separately. However, the House of Lords approved only that part of the finding in *Sifam* (supra) that Section 44 (1) of the UK Act must be read as meaning “...if that part is to be made and sold separately”. The House of Lords in *Ford Motor Company* (supra) did not approve the intention test laid down in *Sifam* (supra) and approved the test of “*independent life as an article of commerce,*” as laid down by the Divisional Court. Even though the House of Lords did not interpret Section 44(1) of the English statute to read as “*susceptible of being made and sold separately,*” it noted the findings of the Deputy High Court Judge of the Chancery Division in *Ford*

² In 2001, the UK Act was amended and the definition of the word “article” has been deleted.



Motor Company (supra) referring to the second set of components being registrable as they were, by their nature, “*susceptible of being made and sold separately.*”

46. Even though the UK Act defines “article” as “*any part of an article if that part is made and sold separately*”, the aforesaid words have been interpreted by the House of Lords in *Ford Motor Company* (supra) to read as “*if that part is to be made and sold separately*”.

47. In my considered view, the aforesaid definition of “article” under the UK Act as interpreted by the House of Lords in *Ford Motor Company* (supra) is *pari materia* to the definition under the Indian Designs Act, which uses the words “*part of an article capable of being made and sold separately*”. Resultantly, the interpretation given by the House of Lords would have some bearing on the definition of the word “article” in the Indian Designs Act.

48. The UK Act has been subsequently amended in 2001 and the definition of the word “article” has been deleted. However, no such amendment has been made in the Indian Act and therefore, the amended UK Act is of no relevance for interpreting the definition of “article” under the Indian Designs Act.

49. As regards the “must match exclusion,” which is specifically provided under Section 1(1)(b)(ii) of the English statute, it is not a part of the Indian statute and therefore, no reference can be made to the same while interpreting the provisions of the Designs Act. In any event, the judgment of the House of Lords independently proceeds on the basis of the definition of



“article” and therefore, reference made to the “must match exclusion” by the plaintiff is of no relevance.

50. The two questions that were framed by the House of Lords for consideration were as under:

- (i) Are objects which are spare parts for other objects “articles” within the meaning of the Act?
- (ii) What is the true construction of Section 1(1)(b)(ii) of the Act?

51. It is pertinent to note that the House of Lords proceeded to answer only question no.(i) above and not question no.(ii), which dealt with the interpretation of the “must match exclusion,” as is evident from page 179 of the Law Report.

52. Similar view has been taken by the Supreme Court of South Africa the judgment dated 18th September, 2013 in Case No.722/2012 titled ***Bayerische Motoren Werke Aktiengesellschaft v. Grandmark International (PTY) LTD.*** (hereinafter “BMW”). In the said case, BMW sought registration of designs of certain components of their cars, bonnet, grille, headlight assembly and the front fender. Relying upon the judgments of the Deputy High Court Judge of the Chancery Division and the Division Bench in ***Ford Motor Company*** (supra), the Supreme Court of South Africa dismissed the appeal filed by BMW against non-grant of registration of its aforesaid components and held as under:

*“[13] The designs now in issue are designs of individual components, and must be judged for the qualities of the individual components, independently of the design of the build-up vehicle. **The articles embodying the designs are not selected by customers for their appeal to the eye. They are***



selected solely for the function they perform – which is to replace components so as to restore the vehicle to its original form.

[14] Counsel for BMW submitted that an owner of a BMW vehicle may choose to replace a component with a component of a different design, suitable modified if needs be, so as to alter the appearance of the vehicle. We are not concerned, of course, with components of a different design that might be fitted to BMW vehicles, but with BMW's components, and the submission needs to apply the other way round. Perhaps there are eccentric motorists to whom it might appeal to fit a BMW fender, for example, to a vehicle of a different kind– though it is difficult to imagine one – but the designs are not to be judged by their appeal to eccentricity. **The eye through which the design must be judged is that of the likely customer, who will choose it so as to maintain the form of the vehicle. Indeed, it can be accepted, from their nature, that most customers will not even see the component before it is fitted to the vehicle, nor make any selection at all, other than by giving instructions for the restoration of the vehicle.**

[15] **There are some motor vehicle components – examples given in a case before the Registered Designs Appeals Tribunal in England are wing mirrors, wheels, seats and steering wheel – that are intended to be inter-changeable between vehicles, and perhaps their designs are capable of being registered as aesthetic design, but we are not concerned with designs of that kind. There is no suggestion that the purpose of the BMW components is to be fitted, upon selection by customers, to vehicles of a different kind. The purpose they are intended to serve is solely to replace the components of the respective BMW vehicles.**

(emphasis supplied)

53. Counsel for the plaintiff company sought to distinguish the aforesaid judgment on the ground that in the case before the Supreme Court of South Africa, registration was denied on the ground that the parts in question were functional in nature. I do not agree. The functionality of the component that



was considered by the Supreme Court of South Africa was only in the context of replacing the component so as to restore the vehicle to its original form.

54. It has further been submitted on behalf of the plaintiff company that the judgment in *BMW* (supra) proceeds in conformity with Section 14(6) of the Designs Act, 1933 of South Africa, which provides for an exclusion of registration of a spare part of a vehicle. However, in my view, this would not detract from the aforesaid observation made by the Supreme Court of South Africa.

55. Next, I will consider the judgment of the Single Judge of the Bombay High Court in *Marico Limited v. Raj Oil Mills Ltd.*, (2007) 35 PTC 330 and the judgment of the Division Bench in the said case, reported as *Marico Limited v. Raj Oil Mills Ltd.*, (2008) 37 PTC 109 (DB).

56. On behalf of the defendant, the reliance has been placed on the judgment of the Single Judge in *Marico* (supra), authored by Justice S.A. Bobde (as he then was).

57. In *Marico* (supra), plaintiff and the defendant were both oil manufacturers and both had applied for registration of the design of a bottle cap. Plaintiff had a registered design in respect of its bottle cap. Defendant was using a similar design for its bottle cap and therefore, the plaintiff sought an interim injunction. Relying upon the judgment of the House of Lords in *Ford Motor Company* (supra), the Bench comprising of Justice S.A. Bobde held that the words “*part of an article capable of being made and sold separately*” used under Section 2(a) of the Designs Act cannot be read literally. The Single Judge approved the test of “*independent life as an*



article of commerce” and not “*be merely an adjunct of some larger article of which it forms part*” as laid down by the House of Lords in ***Ford Motor Company*** (supra). Holding that the cap involved in the said case could not have been said to have an independent life as an article of commerce, the interim injunction was denied.

58. The aforesaid judgment was set aside in appeal by the Division Bench of the Bombay High Court. Naturally, the plaintiff company places reliance on the judgment of the Division Bench. The Division Bench placed reliance on the Statement of Objects and Reasons of the Designs Act, 2000 to hold that (i) intent of the new Act was to enlarge the scope of definition of “article” and “design”; (ii) definition of “article” under the Indian Act and the UK Act were different. Therefore, the observations of the House of Lords would not be relevant for interpreting the Indian statute; (iii) the defendants themselves had applied for registration of their bottle caps separately, which was rejected; and, (iv) the words “*capable of being made and sold separately*” used in Section 2(a) of the Designs Act have to be given their literal meaning, which is to say that an article that is separate from other parts of the good and intended or desired by the proprietor as capable of being made and sold separately.

59. No doubt, the intent and the object of the Designs Act, 2000 was to enlarge the definition of the term “article”³ so as to include part of an article, but there is an inbuilt limitation put in the definition itself by the use of the words “*capable of being made and sold separately*” after the words “*any part of an article*”. The aforesaid expression would have to be given its full

³ Earlier, in the Designs Act, 1911, the definition of “article” did not include “parts of an article”.



meaning so as to interpret the definition of “article” under Section 2(a). The Statement of Objects and Reasons itself provided that the “law does not unnecessarily extend the protection beyond what is necessary to create required incentive for design activity”. Therefore, while the intent of the new Act was to enlarge the scope of protection, it was only to the extent necessary to provide incentive for design activity.

60. In my considered view, the judgment of the Division Bench in *Marico* (supra) proceeds to give a literal meaning to the words used in the statute, whereas the judgment of the Single Judge gave a purposeful meaning to the words. While the Single Judge held that the cap involved in the case cannot be said to have an independent life as an article of commerce, the Division Bench held that a cap is capable of being made and sold separately. Though, literally speaking, a bottle cap is capable of being made and sold separately, however, in practice, it is hard to imagine a bottle cap being sold separately to a consumer.

61. I am in respectful disagreement with the view taken by the Division Bench in *Marico* (supra) that there is a dissimilarity between the Indian statute and the English statute (as it existed earlier). As observed by me above, the definition of “article” under the English Act, as interpreted by the House of Lords in *Ford Motor Company* (supra) is *pari materia* with the definition under the Indian Designs Act, which uses the words “*part of an article capable of being made and sold separately*”. I am in respectful agreement with the view of the Single Judge of the Bombay High Court as well as the judgment of the House of Lords in *Ford Motor Company* (supra) to the extent that they laid down the test of the component having an



independent life as an article of commerce and not merely being an adjunct of some larger article of which it forms part. In my considered view, the words “*any part of an article capable of being made and sold separately*” used in Section 2(a) of the Indian statute have to be read to include parts of articles that can be sold as articles that have an independent life as articles of commerce and not merely as substitutes/accessories.

62. The plaintiff company has placed reliance on the judgment of the United States Court of Appeals for the Federal Circuit in ***Automobiles Body Part Associations v. Ford Global Technologies***, wherein the court was considering the question of whether “vehicle hood” or “vehicle headlamps” were protectable designs. The US District Court decided in favour of the registration of the designs for the said products and hence, the matter was taken up in appeal before the United States Court of Appeals. Dismissing the appeal, the Court of Appeals held that (i) customers prefer the peculiar and distinctive appearance of Ford’s designs over other designs performing the same function and therefore, Ford is entitled to protection of its designs; (ii) just because the consumers prefer a particular design to match other parts of the vehicle, it cannot be said that the design is functional; and, (iii) since there are various functional alternatives available in the market, the consumers make a choice based on the aesthetics of a design to purchase a replacement part.

63. On the face of it, the observations made in the aforesaid judgment advance the submission of the plaintiff company. However, on a careful reading of the judgment, it emerges that the aforesaid observations were made on the basis of the admission of the plaintiff’s own witness that



customers select replacement parts among different designs based on their preferred aesthetics. This aspect of consumer preference in India can only be determined after trial.

64. The aforesaid findings are in stark contradiction with the findings of the Supreme Court of South Africa in *BMW* (supra), which held that the customer does not even see a product while purchasing at the time of replacement as the objective is to maintain the original appearance. Another point of distinction with the judgment of the US Court of Appeals is that in the said case, Ford did not claim monopoly over the whole article but had separately registered the components/parts of the article. In the present case, the plaintiff company had not only applied for the registration of the entire motorcycle but also of its front fender. Further, the term “article of manufacture” used in the US statute is not defined and the Supreme Court of the United States in *Samsung Elecs. Co. v. Apple Inc.*, 196 L. Ed. 2d 363 has given a broad interpretation to the term so as to include articles as well as their components. As noted above, under the Indian Designs Act, part of an article that can be registered has been given a restricted meaning.

65. There can be no doubt that the front fender, the component involved in the present case, would fall in the first category of components as categorized by the Deputy High Court Judge of the Chancery Division and approved by the House of Lords in *Ford Motor Company* (supra), which comprised of components such as body panels, doors, bonnet lid, boot lid and windscreen, which form a part of and contribute to the overall shape and appearance of the vehicle. A front fender of a motorcycle is an external part which is visible to the viewer. The fender has no independent life as an



article of commerce in itself. It is specifically made for the particular model of motorcycle manufactured by the plaintiff company, namely, “HERO HF DELUXE” and cannot fit into any other motorcycle. The plaintiff company in the plaint has clearly pleaded that the subject front fender is sold as a replacement part domestically as well as exported for its particular “HERO HF DELUXE” model motorcycles.

66. In light of the discussion above, in my *prima facie* view, the plaintiff company’s front fender design is incapable of registration under Section 2(a) of the Designs Act.

67. On behalf of the plaintiff company, it was also submitted that if the interpretation of Section 2(a) of the Designs Act as suggested by the defendant is accepted, none of the spare parts of any product would be registrable. In my view, the aforesaid submission is too farfetched to be accepted. At this stage, the Court is only deciding an application for grant of interim injunction while examining *prima facie* validity of the registration granted in favour of the plaintiff company’s fender. The Court is not determining the question of registrability of spare parts in general.

68. In my *prima facie* view, accepting the submission of the plaintiff company would also result in the creation of a monopoly in favour of the OEMs. In the event a consumer needs a replacement of a spare part, he would have no choice but to go to the OEMs. In my view, the interpretation as suggested by the plaintiff company would not be in consumer interest as it would create a monopoly in favour of the OEM and allow the OEM to dictate the prices. Even though the motorcycle of the plaintiff company in the present case is an entry-level motorcycle, the impact of this



interpretation would be felt greater in the event of an expensive motorcycle or any other vehicle, whose spare parts would also be more expensive.

69. It is an undisputed position that the front fenders of the defendant are being sold in the market under the brand name “SAI”, whereas the products of the plaintiff company are sold under the brand name “HERO”. Therefore, consumers can make an informed decision and choose between the replacement part sold by the OEM and other manufacturers such as the defendant.

70. In view of the discussion above, the plaintiff company has failed to make out a case for grant of interim injunction. Balance of convenience is in favour of the defendant and against the plaintiff company. Irreparable harm will be caused to the defendant if an interim injunction as sought is granted in favour of the plaintiff company.

71. Accordingly, the present application for grant of interim injunction is dismissed. However, the defendant shall file complete statement of accounts of manufacture and sale of their front fender from the date of institution of the suit till date, within eight weeks from today. Thereafter, the defendant shall file statement of accounts of manufacture and sale of their front fender on a half-yearly basis until further orders of the Court.

72. Needless to state, any observations made herein are for the purposes of adjudication of the present application and shall not have a bearing on the final outcome of the suit.



CS(COMM) 1078/2018

73. List before the Joint Registrar on 20th September, 2023 for further proceedings.

AUGUST 16, 2023

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AMIT BANSAL, J.