Design Cancellation in India: Calcutta High Court Clarifies Prior Publication and Foreign Design Evidence

Thought Leadership • July 16, 2025

'First published on Asia IP'

By: Amita Arora

The case of *Paresh Ajitkumar Kapoor v. Controller of Patents And Designs (May 24, 2024, AID/5/2023)* highlighted some of the vital aspects in design invalidation proceedings.

This can be understood from the course of life of the registered design number 233559.

The said design for an air cooler was granted to Paresh Ajitkumar Kapoor, which came into effect from December 27, 2010.

First Cancellation Petition

In 2019, a Chinese Company, Ningbo Chenwu Humidifying Equipment Factory, filed an application seeking cancellation of the registered design 233559 on the ground that the Chinese company had registered a similar design bearing No. ZL200930131277.8 in China. The Chinese company also furnished its registration certificate showing photographs of six sides of their design.

By an order dated September 30, 2019, said cancellation petition was dismissed on the ground that they had failed to establish any case of prior publication under Section 4(b) of the Designs Act, and also that the website of the Chinese company did not establish the ground of prior publication. Accordingly, it was held that the design was original and novel, thereby resulting in the dismissal of the cancellation petition.

Second Cancellation Petition

In 2021, Kalpesh Manubhai Ramolia filed a cancelation petition against the same registered design on the ground of prior publication. The opponent contented that the impugned design had been published in China prior to the filing date in India. Again, the reliance was placed on the same prior

published Chinese design application No. ZL200930131277.8, having publication No. CN301106689D dated January 6, 2010.

By an order dated April 12, 2023, the application for cancellation was allowed and it was ordered to cancel said design in the Register of Designs. The order focussed on the China National Intellectual Property's (CNIPA) website and held that the overall features of shape and configuration of the impugned design were similar to prior published design. Accordingly, it was construed that the design is not a new or original design and not registrable.

The Appeal

The order dated April 12, 2023, cancelling the design was appealed by the registered proprietor in the High Court at Calcutta.

Interestingly, the appeal was allowed, setting aside the impugned order dated April 12, 2023, as being unsustainable. The matter was remanded to the patent office to adjudicate the cancellation petition of the impugned design afresh, including any application for additional evidence filed in accordance with law.

It was held that the prior art, Chinese Design No. ZL200930131277.8 filed on February 5, 2009, and registered on January 6, 2010, does not per se lead to an irrefutable conclusion that the same had been published on January 6, 2010.

Notably, as per Rule 90 of the Chinese Regulations, the Patent Administration Department of China publishes the Gazette only with one drawing or photograph of the concerned design.

The six pictures brought on record were unverified and, hence, legally inadmissible. No proof had been furnished to show that the translations were true or correct. Merely showing such designs on a foreign unverified website does not amount to prior publication.

The photographs of the cited Chinese design, submitted along with the cancellation application, had 2-dimensional illustrations which does not depict the application of the design with the same visual effect as a 3-dimensional model.

Thus, the CNIPA website was per se insufficient to conclude that there was prior publication. The impugned order makes no attempt to verify or question the authenticity of the website.

Additionally, the previous order dated September 30, 2019, passed in the earlier cancellation petition, and the impugned order had been passed relying on the same design and upon framing of similar issues. Moreover, since the previous order was not challenged, the order had become binding and

conclusive.

Key Takeaways

One of the noteworthy takeaways from the present case is that while under Section 19(1)(a) of the Designs Act, prior registration of a design in India is ground for cancellation of a registered design, a prior registration outside India is not.

Further, mere publication of design specifications, drawings and/or demonstrations by the patent office of any foreign country would not, in itself, amount to publication that would render a design registered in India liable to cancellation. As a matter of fact, publication is required to be considered in view of the evidence led in each and every case.

As also established in previous prior precedents, the publication would have to be, in tangible form, of the design applied to the same article. Most importantly, to constitute prior publication, an image or design must be published in such a way that a person possessing ordinary knowledge of the subject is able to apply the design.

Lastly, it yet again emphasizes the inevitability of submitting duly verified, corroborated and legally admissible evidence in legal proceedings.

KEY CONTACT



Amita Arora

Partner

View Bio of Amita Arora

RELATED PRACTICES

PATENTS