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## **UNVEILING DESIGN INFRINGEMENT: A DUEL BETWEEN CONSUMER WITH INSTRUCTED EYE AND AVERAGE CONSUMER**

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### **Abstract**

*The Designs Act, 2000 governs design rights in the IP framework of India, providing for registration and protection of industrial designs from infringement. For a design to be eligible for registration, it must be new and original. If, however, a registered design is used without permission of registered proprietor, the design is said to be infringed. In India, design infringement cases bank on three major tests to determine similarity between designs: the instructed eye, consumer with instructed eye and average consumer eye tests. Inconsistent application of these tests has resulted in absence of clear guidelines on particular usage of each test. This paper, thus, aims to evaluate the effectiveness of these tests in identifying design infringements. A mixed-methods approach is used, including analysis of relevant cases, in determining reliability and accuracy of these tests. We find that, instructed eye test is the most reliable for such cases, but consumer with instructed eye test can be useful in cases involving complex designs where the average consumer is not able to discern similarities or differences which can be attributed to the lack of knowledge and expertise of average consumers, leading to biases and inaccurate judgments. The study concludes that the Indian judiciary should adopt a standardized approach to determine when to use each test and provide clear guidelines on their application. This will lead to consistency in design infringement cases. Moreover, it suggests greater consumer education in improving knowledge and understanding of design infringement, thereby enhancing the reliability of two tests.*

**Keywords:** Instructed eye, average consumer, consumer with instructed eye, design infringement,

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similarity.

## Introduction

Design as a word may have different interpretations and usages. In IPR particularly, the term design rights are usually the rights over the shapes and decoration of articles.<sup>3</sup> Unique designs, or so to say ‘novel’ are registered and thus protected since these designs represent in some sort the original creative work of the designers, thus are valuable assets and need to be safeguarded. This aids the designer in preventing the exploitation of his design without permission. There are ‘n’ number of advantages for why a design is needed to be registered, however, since that is not the scope of this paper, the author has excluded it. In India, design and design rights are governed by the Design Act, 2000. An Act of 1911<sup>4</sup> previously governed the design rights in India, however, after the growth of design-allied litigations in the field, the old Act provided for a very limited scope.

Section 2(d) of the Designs Act, 2000, states that;

*“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.”*<sup>5</sup>

Further in the case of *Bharat Glass Tube Limited v. Gopal Glass Works Limited*,<sup>6</sup> the Supreme Court held that design as under the Act *“means that a feature or a pattern which is registered with the registering authority for being produced on a particular article by any industrial process whether manual, mechanical or chemical or by any other means which appears in a finished article and which can be judged solely by eye appeal.”*

Thus, from the statutory meaning alone, it can construe that design firstly, applied to an article, secondly, that article can be two-dimensional or three-dimensional, thirdly, it is applied by any industrial process and lastly, it in the finished article appeal to and is judged solely by eye. The last phrase i.e., the words *appeal to and are judged solely by the eye*, when seen from a microscopic lens may develop a cataract of confusion in the minds of the readers. To comprehend the phrase fully and grasp its true meaning, it is necessary to delve deeper and conduct a comprehensive examination of numerous design rights cases in Indian jurisprudence.

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<sup>3</sup> Jacob, Sir Robin. *Guidebook to Intellectual Property*. 3rd ed. Oxford: Hart Publishing, 2013.

<sup>4</sup> Patents and Designs Act 1911, Act No. II of 1911.

<sup>5</sup> Designs Act, 2000 § 2(d).

<sup>6</sup> 2008 AIR SC 2520.

## Novelty

A design is registered only when it is novel in character. This is the trend followed in all IPR jurisprudence around the globe. In the United States, a design can be registered and given patent protection only if the design is a *new, original, and ornamental invention*.<sup>7</sup> Novelty is seen at par with a new inventive step in designing. In *Gorham Co. White*,<sup>8</sup> which is one of the most landmark cases in the United States on design patents and novelty, the court held that a design is not “*merely the mechanical result of proportion, form, or configuration of parts*” and it is “*the product of the exercise of the inventive faculty*”.

The Copyright, Designs, and Patents Act 1988<sup>9</sup> (CDPA) is the primary law that governs design and infringement in the UK. According to the CDPA, a design must meet the criteria of being both new and original to qualify for protection. When it comes to defining what constitutes a design, the CDPA includes a variety of elements, such as the physical shape, configuration (i.e. how different parts of a design are arranged together), decoration, and color and pattern of a design. In other words, a design can encompass any combination of these elements, and it is the overall combination that determines the uniqueness and originality of the design.

Further, as mentioned earlier, in India, the law governing the design rights is the Designs Act, of 2000. Section 4 of the said Act states that for a design to be registered it has to be *new and original*<sup>10</sup> or that *it has not been published prior in India or any other country*<sup>11</sup> before the filing of the design application or in short, it should be *novel*. Even though ‘publication’ is not defined anywhere in the Act, it is widely held that it takes place in two ways- publication by prior use and publication in print.<sup>12</sup> It can also be construed that the design must not be available in the public domain. *Disclosure to an individual who was under no obligation to keep the design secret would constitute publication*.<sup>13</sup> Furthermore, *it shouldn't be disclosed to the public anywhere in India or any other country by publication in tangible form or by use, or in any other way prior to the filing date*.<sup>14</sup>

Novelty is a character that is by far the most fundamental in registering a new design that claims protection.

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<sup>7</sup> 35 U.S.C. § 171.

<sup>8</sup> 81 U.S. (14 Wall.) 511 (1872).

<sup>9</sup> Copyright, Designs and Patents Act, 1988, c. 48.

<sup>10</sup> Designs Act, 2000, § 4(a).

<sup>11</sup> Designs Act, 2000, § 4(b).

<sup>12</sup> *The Wimco Limited vs Meena Match Industries*, AIR 1983 Delhi 537.

<sup>13</sup> *Ibid*.

<sup>14</sup> *Bharat Glass Tube Limited v. Gopal Glass Works Limited*, 2008 SCC 10 657.

Therefore, the rule in India is that for a particular design to inhibit novelty, it mustn't be made available to the public by either sale, exhibition, use, or otherwise. It should be new and not disclosed to the public in any form and *secondly*, it should be original. The Act in itself does not mention the word "novel", however, Section 2(g) of the Act defines the term 'original' as "*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*"<sup>15</sup>.

For registration, the article must be original or novel in terms of elements such as shape, configuration, pattern, decoration, or color line composition applied to any article; also, the article must have a visual appeal (i.e., aesthetic appeal).<sup>16</sup> If such novelty is not present or it cannot be ascertained, in such cases the design shall not be registered. Therefore, the crucial aspect of a design is that it must be new with respect to the class of articles to which it is applied.

The Black's Law Dictionary defines novelty as "*So that there may be 'novelty' so as to sustain a patent, the thing must not have been known to any one before; the mere novelty of form being insufficient.*" Therefore, novelty should be involved not only in the form or figure of an article but also there must be some novelty in its application. In the case of,<sup>17</sup> it was held that "*mere novelty of form or shape is insufficient. Novelty involves the presence of some element or a new position of an old element in combination, different from anything found in any prior structure.*"

### **Appeal to an eye**

As discussed in the previous sections, the Designs Act, of 2000 provides for the basis on which a design is registered. It specifies that in order to be eligible for protection under the Act, a design in question must be new and original and it must have an appeal to the eye.<sup>18</sup> The novelty and originality of a design were discussed in the previous section. *When the novelty of an article is tested against a prior published document, the main factor required to be adjudged is the visual effect.*<sup>19</sup> Under the Act, appeal to an eye refers to the visual appearance of a design.<sup>20</sup>

In *Interlego AG v. Tyco Industries Inc.*<sup>21</sup> the Privy Council said: "*The starting point remains the same as it*

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<sup>15</sup> Designs Act, 2000, § 2(g).

<sup>16</sup> *Crocs Inc. v. Liberty Shoes Ltd.*, 2018 SCC ONLINE DEL 7107.

<sup>17</sup> 1999 SCC ONLINE DEL 485.

<sup>18</sup> Designs Act 2000, § 2(d).

<sup>19</sup> *Gopal Glass Works Ltd. v. Assistant Controller of Patents and Designs & Ors.*, 2006 SCC ONLINE CAL 442.

<sup>20</sup> *Videocon Industries Ltd vs. Whirlpool of India Ltd.*, 2014 SCC ONLINE BOM 565.

<sup>21</sup> 1988 RPC 343.

*always was — visual appearance. Nothing is to qualify as a design at all unless it has “features...which appeal to and are judged solely by the eye.”* This was further reiterated by the Bombay High Court in *Photoquip India Limited v. Delhi Photo Store*.<sup>22</sup>

It is a visual and subjective test that considers whether a design has an overall visual impression that is substantially different from prior designs or combinations of prior designs. The features of a design should appeal to the eye and should be judged solely by the eye and not by any functional considerations.<sup>23</sup> The visual appeal of a design must be adjudged by the eye of the consumers.<sup>24</sup>

However, the criteria to judge is based on the physical appearance of the design. It could also be understood vis-à-vis novelty and originality in the sense that “features of shape, configuration, pattern, ornament or composition of lines or colours applied” to a previously registered design must not be present in the design which is to be registered i.e. the aesthetic appeal of a design must be distinct. The Act only applies to this criterion on a design, which would have a visual appeal.<sup>25</sup> Hence, only those designs which are original and visually distinctive are granted protection but not the designs which are very similar in visual appeal to the prior published designs.

### **The conflict of appeal to eye in case of design infringement: Whether average consumer eye or consumer with an instructed eye?**

As we discussed above, the definition of design under the Act, it is mentioned that *a design appeals to and is judged solely by eye*. This phrase is indeed a little dim. If a design is to be judged by an eye, whose eye it will be? Especially in the cases of design infringement when the courts look at a design in question, whether the particular design is in infringement to an existing design or not, the court firstly judges the design on its appeal to the eye. The issue at hand pertains to the appropriate standard by which to evaluate a design, namely whether it should be assessed from the perspective of a person possessing specialized knowledge or that of an ordinary consumer seeking to acquire the relevant product. This quandary bears a degree of ambiguity and incongruity, thus necessitating a nuanced and discerning approach to its resolution.

### **Test of average consumer eye**

Firstly, we will discuss the test of the average consumer’s eye. The principle behind this test is that the similarity or difference is to be judged through the eye alone and where the article in respect of which the

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<sup>22</sup> 2016 SCC ONLINE BOM 7728.

<sup>23</sup> P. Narayanan, *Intellectual Property Law*, 2nd ed. (New Delhi: Eastern Law House, 2018), p. 108.

<sup>24</sup> B.L. Wadehra, *Law Relating to Intellectual Property*, 5th ed. (New Delhi: Bharati Law House, 2016), p. 416.

<sup>25</sup> *Microfibres Inc. v. Girdhar & Co. & Anr. S*, 2009 PTC 40 519.

design is applied is itself the object of purchase, through the eye of the purchaser. The average consumer, like you and me, is a local buyer who visits the marketplace to buy goods for various purposes. Let's say the buyer wants to purchase a specific air-conditioner model. However, there might be an imitation product with a similar design. The question is whether the buyer can distinguish between the original product and the pirated version. The test aims to determine if the average buyer can identify and differentiate between the two designs. The approach is not identifying individual similarities or dissimilarities. The design as well as the product has to be seen as a whole from the viewpoint of the average consumer. The visual appeal of the product has to be examined and it is to be seen whether the essential that makes the product visually appealing has been substantially copied, rather than the design copied verbatim.<sup>26</sup>

In the landmark case of *Videocon v. Whirlpool*,<sup>27</sup> applying the eye of the average consumer, the court said that it is to be seen whether product manufactured and marketed by Videocon is the design or an obvious imitation of the design registered by Whirlpool, which involves the comparison of both the designs. The court looked at the design of both the washing machine and judged it from the eye of an average buyer and concluded that it was certainly a similar design as Whirlpool.

Further, in *Diageo v. Great Galleon*,<sup>28</sup> the Delhi High Court held three yardsticks for determining infringement of design – “visual effect, appeal to the eye of the customer and the ocular impression of design as a whole.” Similarly, in the case of *Castrol India Limited v. Tide Water Oil Co. (I) Ltd.*,<sup>29</sup> Calcutta High Court held that “The task of the judiciary is to judge the difference or similarity through eye alone and that too through the eye of the purchaser.” In this case, the court referred to the case of an English landmark case on *Benchairs Ltd. v. Chair Center Ltd.*,<sup>30</sup> where the article to which the registered design was applied was a chair. The English court in this case opined that their task is to observe whether there exist any similarities and differences, to view them both separately and together, and to keep in mind that, in the end, the question of whether or not the design of the defendant's chair is substantially different from that of the plaintiff is to be answered by consideration of the respective design as a whole: and viewed as though through the eyes of the plaintiff, When analyzing the articles simply on their appearance, the Court must determine whether the defendant's version is an obvious or fraudulent copy.

It is indeed essential to keep in mind and take into consideration the buyers who make the purchase of goods by application of their rationally intelligent minds. The Supreme Court in its judgment in *Khoday Distilleries*

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<sup>26</sup> *Cello Household Products v. Modware India*, 2017 AIR BOM R 3 499.

<sup>27</sup> Supra note 18.

<sup>28</sup> 2022 SCC ONLINE DEL 2350.

<sup>29</sup> 1994 SCC ONLINE CAL 303.

<sup>30</sup> 1994 RPC 429.

*Limited vs. Scotch Whisky Association*,<sup>31</sup> emphasized that the class of purchasers who are likely to buy the goods by their education and intelligence and the degree of care which they are likely to exercise in purchasing or using the goods would be required to be considered. In the case mentioned, the Supreme Court referred to a previous ruling in the case of *Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd.*,<sup>32</sup> wherein the Supreme Court highlighted that the standard applied for determining whether a product is misleading or deceptive may vary based on the class of buyers who are likely to purchase the product. The Court noted that the level of education and affluence of the buyers may impact their level of awareness and understanding of the product, potentially reducing the likelihood of being misled or deceived by advertising claims. In this context, the Court concluded that if the appropriate test had been applied, the outcome may have been different and the court may not have intervened in the matter.

Thus, the test of an eye of an average consumer plays a fundamental role in determining whether a particular design is an infringement or not. It is pertinent to note that the approach taken by the Indian judiciary in such cases of infringement is to judge the similarity or difference between the designs by examining the particular product from an eye of a consumer. It is particular to take into consideration the perspective of the purchaser, who is likely to buy the goods based on their education, intelligence, and degree of care exercised in purchasing or using the goods. The standard applied for determining whether a product is misleading or deceptive may vary based on the class of buyers who are likely to purchase the product. Therefore, in such cases, it is paramount for the courts to keep in mind the buyers' demographics and purchasing behavior while applying the test of an average consumer's eye.

### **Test of a consumer with an instructed eye**

The average consumer, as we know, could be you and me. However, an average person does not have a particular skill and eye as that of an informed or an instructed person. In the words of the European Union Intellectual Property Office (EUIPO), an informed user is defined as “a user of the product concerned who is reasonably well-informed, observant, and circumspect.”<sup>33</sup> An informed user is a person who has a particular experience of other like goods and would be discriminatory, further, that person can appreciate enough detail to decide whether an overall impression is made by the particular design or whether the alleged infringement molded a different impression.<sup>34</sup>

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<sup>31</sup> (2008) 10 SCC 723.

<sup>32</sup> (2001) 5 SCC 73.

<sup>33</sup> European Union Intellectual Property Office (EUIPO), Guidelines for Examination of Registered Community Designs, Part B, Section 3, Chapter 2, 2.2.2.

<sup>34</sup> *Procter Gamble v. Reckitt Benckiser*, (2007) EWCA Civ 936.

The consumer with an instructed eye in legal terminology especially used by the Indian judiciary in cases of design infringement refers to a theoretical person who has specific knowledge in the field of design and is capable of comparing design to determine whether two articles are substantially identical or not. A consumer with an instructed eye possesses trade knowledge as well as an awareness of the prior art. He can identify whether a particular design has taken an inventive step, which makes it new and original. However, incorporating common design elements that are already in use, it would not make the design novel or original when compared to the existing prior art.

In *B. Chawla v. Bright Auto Industries*,<sup>35</sup> a widely quoted judgment in the field of design law in the Indian intellectual property rights jurisprudence, the court referred to *Philips v. Harbro Rubber Company*;<sup>36</sup> in which lord Moulton observed that the question of the understanding of design and its infringement are substances to be judged by eye and eye alone. Further, with regards to the issue of infringement and that of the novelty and originality, should be of an instructed person. The court went on to define instructed person as some with “common trade knowledge” and usage in the class of article to which that particle design applies. The incorporation of common trade variants into an existing design does not make it new or unique. The eye should be trained to see through to determine if it is common to trade information or an innovation significant enough to merit registration. A balance must be achieved so that uniqueness and originality receive statutory acknowledgment while simultaneously protecting the interests of trade and the right of people involved in it to share common knowledge. The addition of common trade versions did not make a design unique or innovative. The consumer with an instructed eye, which is cognizant of the prior art, is to be used to determine infringement and novelty.

In *Som Distilleries and Breweries Ltd. v. Carlsberg Breweries*,<sup>37</sup> to assess if a registered design has been infringed, Delhi High Court held that the eye of any instructed person should be used, i.e., he should know what was common trade knowledge and usage in the class of items to which the design relates. Thus, the bench held that the phrase “obvious or fraudulent imitation” was akin to the phrase “identical or deceptively similar” as used in the Trade Marks Act.

Further, on the lines of *the B Chawla case*, recently the Delhi High Court applied this test in a dispute of alcohol packaging regarding a novel design of hipster flask in the *Diageo Brands B.v. v. Alcobrew Distilleries India Pvt. Ltd.*<sup>38</sup> The *prima facie* view of the court in the case was that with regards to piracy of design, the test to be applied is that the particular design has to be examined from the point of view of the

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<sup>35</sup> AIR 1981 Del 95 (DB).

<sup>36</sup> (1920) 37 RPC 233.

<sup>37</sup> 2017 SCC ONLINE DEL 8125.

<sup>38</sup> 2022 SCC ONLINE DEL 4499.



instructed eye of a person who is reasonably knowledgeable in terms of the prior art and the person can appreciate enough details. The test from the point of view of an average consumer that “*sees the bottle on a shelf from a distance, would not be the appropriate test to apply*”.

Furthermore, in the latest judgment in *TTK Prestige Ltd. v. KCM Appliances Private Limited*<sup>39</sup> case, the Delhi High Court has continued its stance on the test of design infringement by upholding that the eye with which it is to be analyzed is that of an instructed person. The Court categorically stated that the test in which a consumer who views the suit design with an instructed eye “*undoubtedly forms the definitive test to assess infringement.*” Moreover, it was stated that the Courts should not apply their subjective standards in judging a suit design while examining the ocular appeal, which is the definitive test for a valid design.

Therefore, when analyzing the element of infringement of the suit design by the disputed design, the aspect of uniqueness and originality of the suit design in relation to prior art becomes a relevant factor. An uneducated spectator who is unaware of the state of the previous art and is only comparing the plaintiff's design with the defendant's product cannot, therefore, be the person from whom the aspect of infringement is examined.

## **Analysis**

In the realm of Indian design right jurisprudence, there have been three kinds of test relied upon by the courts for determining instances of design infringement. These include the instructed eye, consumer with instructed eye, and average consumer eye test. Each of these tests is used to evaluate the degree of similarity between the imitated design vis-a-vis the original design. A closer analysis reveals that the application of these tests has been indiscriminate, albeit, the reliability and accuracy of these tests vary significantly.

Instructed eye test involves presenting the impugned design to a person with a trained and discerning eye, who is well-versed and has specialized knowledge of the original design. This person is expected to examine both designs and identify similarities or differences between them. This test is generally employed in cases involving intricate designs where the similarities may not be evident to an untrained eye.

The consumer with instructed eye test necessitates judging a particular design from the eye of a consumer who has specific knowledge of the product. He might be a frequent buyer and has developed a particular degree of expertise, and thus, considered more reliable than the average consumer eye test as the consumer has some knowledge about the original design.

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<sup>39</sup> 2023 SCC ONLINE DEL 2129.

The average consumer eye test, in contrast, involves judging a product solely from the eye of an average consumer who has no prior knowledge of the original design. He is a person, who goes on to buy an article in the market. Will he be able to distinguish between the original and copied article? The court, in this instance, adopts the role of an average layman and evaluates the design based on his perspective.

If we look at design infringement cases, the most reliable test is the instructed eye test. However, it doesn't fall within the scope of this research paper, albeit, the focus is on the other two tests- consumer with an instructed eye and average consumer eye, which can be applied based on the complexity of designs. As discussed above, the Indian judiciary has applied these tests haphazardly. There is no right or wrong way of applying these tests, as of now. But they can be judged based on reliability and accuracy.

A consumer with an instructed eye knows the general trade practices, contrary to the average consumer. This test is not based on his memories and perceptions of a design but rather on an objective outlook, meaning his outlook is not affected by his personal biases. On the other hand, an average consumer, since he doesn't have much knowledge or in some cases, no knowledge about a design or general trade practices, might perceive a design based on his biased opinions and outlook, this majorly affects the reliability of that test.

For instance, if the designs are very dissimilar or there are only a few similar features, which are also easily visible and discernible, then an average consumer might be able to identify the design infringement. Or, if the designs are basic and conspicuous, then also an average consumer might identify similarities and differences. However, if the design is complex or has subtle elements, then an average consumer test will fail. In this aspect, a consumer with instructed eye test will come handy. Further, it is essential to note that in design infringement cases, the designs are usually complex and don't vary much, so applying an average consumer eye test wouldn't prove to be fruitful in many instances.

Moreover, a consumer eye test might help gather consumer perception and preference but it is not much reliable and accurate in ascertaining design infringement when compared to the other two tests. The most reliable test can be considered to be the test of instructed eye owing to the rigorous and standardized approach to comparing designs. But, a consumer with instructed eye test is also reliable, though not as much as the instructed eye test, but more than the average consumer eye test.

## Conclusion

The test of design infringement in India is mauled with a lot of diverse opinions by the Indian judiciary as to the appeal to eye aspect. We have discussed three tests that have been applied by the Indian judiciary. To put it simply, these include - test of an instructed eye, consumers with instructed eye, and average consumer eye. It is pertinent to note that application of the average consumer eye is not reliable as a standard nor its use can help the judiciary to estimate the existence of imitation in all cases. The consumer with an instructed eye is a better alternative in all cases instead of the average consumer because of its more reliable character. The consumer with an instructed eye knows the market, contrary to the average consumer.

In design infringement cases, the magnitude of complexity and intricate features play a key role in ascertaining which test is to be applied based on the reliability of those tests. Our findings indicate that the most reliable test for design infringement is the consumer with instructed eye test when compared with the average consumer eye test. This test is based on the opinion of a person who has knowledge about general trade practices and is not affected by personal biases. The consumer with an instructed eye test is also reliable, but not as much as the instructed eye test. Instructed eye or the eye of an expert is used in cases where design is highly complex or technical. An expert, therefore, necessarily has more chances of identifying the existence of any imitation. The average consumer eye test is the least reliable, as it is based on the opinion of a person who may be biased or not have enough knowledge about the design or general trade practices. The average consumer eye test might help gather consumer perception and preference but it is not much reliable and accurate in ascertaining design infringement when compared to the other two tests.

Due to no delineated criterion to apply these tests in design infringement cases, the approach of the judiciary had been irregular. As discussed above, different High Courts have applied different tests while ascertaining design infringement. It is imperative to note that facts and circumstances of the cases are important to adjudge which test is to be applied, however, if a standardized approach to determine when to use each test and clear guidelines on their application are provided, then the problem of irregular application can be resolved to a certain extent. Furthermore, at the grassroots level, greater consumer education to improve their knowledge and understanding of design infringement would enhance the reliability of the consumer with instructed eye test and average consumer eye test.

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