

Levi Strauss And Co vs Imperial Online Services Private ... on 22 December, 2021

Author: C. Hari Shankar

Bench: C. Hari Shankar

\$~22 (original)

* IN THE HIGH COURT OF DELHI AT NEW DELHI
+ CS(COMM) 657/2021 & I.A.16736/2021, I.A.16737/2021,
I.A.16738/2021, I.A.16739/2021, I.A.16740/2021,
I.A.16741/2021

LEVI STRAUSS AND CO Plaintiff
Through: Mr. Dushyant K. Mahant, Mr.
Urfee Roomi, Mr. Vishesh Kumar and Mr.
Alvin Antony, Advs.

versus

IMPERIAL ONLINE SERVICES PRIVATE LIMITED &
ANR. Defendants
Through: Ms. Shilpa Gamnani and Mr.
Abhishek Malhotra, Advs.

CORAM:
HON'BLE MR. JUSTICE C. HARI SHANKAR
ORDER

% 22.12.2021

1. Consequent to the directions issued by this Court on the last date of hearing, advance notice was served on the defendants which are represented in these proceedings by Ms. Shilpa Gamnani.

I.A.16741/2021 (exemption)

2. Subject to the plaintiff filing an apostilled power of attorney within four weeks from today, exemption is granted for the present.

3. The application is disposed of.

I.A.16740/2021 (exemption)

4. For the reasons stated in the application, exemption from the By:SUNIL SINGH NEGI Signing Date:24.12.2021 17:22:14 requirement of pre-institution mediation is granted.

5. The application is allowed accordingly.

16739/2021 (exemption)

6. In view of the fact that advance notice stands issued to the defendants which are represented in these proceedings, this application does not survive for consideration and is disposed of as such.

16738/2021 (exemption)

7. Subject to the plaintiff filing legible copies of any dim or illegible documents on which it may seek to place reliance within four weeks from today, exemption is granted for the present.

8. The application is disposed of.

I.A.16737/2021 [under Order XI Rule 1(4)]

9. This application seeks permission to file additional documents.

10. Subject to the right of the defendants to admit/deny the same, additional documents may be filed by the plaintiff within four weeks from today.

11. The application stands allowed accordingly.

CS(COMM) 657/2021 & I.A.16736/2021 (under Order XXXIX Rules 1 and 2 of the CPC)

12. The plaintiff alleges infringement, by Defendant 1, of a distinctive stitching design, named, by the plaintiff, for reasons completely unknown to the Court, as the "Arcuate Stitching Design Mark". This mark, which is a common feature on the rear pockets of jeans manufactured by the plaintiff, looks like this:

13. The plaintiff has emphasised, in the plaint, the fact that the aforesaid "Arcuate Stitching Design Mark" is indelibly identified, in the consumer consciousness, with the jeans manufactured and sold by the plaintiff. Figures of earnings from sales of jeans, with the aforesaid mark added on the rear pockets have also been provided in the plaint.

14. The aforesaid "Arcuate Stitching Design Mark" is registered in favour of the plaintiff under Classes 9, 14, 18 and 25 of the Schedule to the Trademark Rules -- since 1979. A tabular statement of the registrations held by the plaintiff, in respect of the aforesaid "Arcuate Stitching Design Mark" is provided in para 39 of the plaint thus:

S.No.	Mark	Reg. No.	Class/es	Registration	Renewed Date	Until
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1.	352692	25	August 23,	August 1979	23,	2027
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2. 382357 25 October 23, October 1981 23, 2029

3. 851939 25 April 19, April 19, 1999 2029

4. 1625122 9,14,18 November November 27, 2007 27, 2027

15. By dint of long and uninterrupted usage, the plaintiff asserts that "Arcuate Stitching Design Mark" has acquired the status of a well-known trademark within the meaning of Section 2(1)(zg) of the Trade Marks Act, 1999.

16. The defendant is stated to be using, on the rear pockets of the jeans being manufactured and sold by it, a stitching design which is deceptively similar to the "Arcuate Stitching Design Mark", in which the plaintiff holds the aforementioned subsisting registration. A comparative depiction has been provided in the plaint thus:

Plaintiff's Arcuate Stitching Design Impugned Stitching Design Mark Mark

17. It is clear, at a bare glance, that the curved stitching design on the rear pockets of the design of the jeans being manufactured by the defendant is confusingly similar to the "Arcuate Stitching Design Mark" registered in favour of the plaintiff, within the meaning of Section 29(1) of the Trade Marks Act.

18. A cease and desist notice was sent, by the plaintiff to the Defendant 1 on 1st April, 2020, to which Defendant 1 replied on 17th April, 2020. In its reply, the defendant sought for a reasonable period to sell the jeans which bore the "Arcuate Stitching Design Mark". Defendant 1 has, therefore, prima facie pleaded honest and concurrent use. The factum of infringement, thereby, stands, prima facie, admitted.

19. Though Defendant 1, in its communications to the plaintiff, assured the plaintiff that it had ceased selling jeans with the impugned mark, the plaintiff alleges that such jeans continue to be available on the website of the defendant www.urbanofashion.com, as well as through various e-commerce websites. It is in these circumstances that the plaintiff has filed the present suit, seeking an injunction against the defendants from continuing to infringe the plaintiff's registered "Arcuate Stitching Design Mark".

20. In the circumstances, let the plaint be registered as a suit.

21. Issue summons in the suit. Summons are accepted on behalf of the defendants by Ms. Shilpa Gamnani. Written statement, accompanied by affidavit of admission/denial of the documents filed by the plaintiff be filed within four weeks with advance copy to the learned Counsel of the plaintiff who may file replication thereto, accompanied by affidavit of admission/denial of the documents filed by the defendants within two weeks thereof.

22. List before the Joint Registrar for completion of pleadings, admission/denial of documents and marking of exhibits on 10th March, 2022.

23. I.A.16736/2021 seeks interim relief. The prayer clause in this application reads thus:

"33. The Plaintiff, therefore, respectfully prays that the following reliefs be granted in its favour:

a) An order for interim injunction restraining the Defendant No. 1, and all others acting for and on behalf of the Defendant, including the Defendant Nos. 2 - 5, from manufacturing, marketing, offering for sale and selling, whether directly or indirectly, and whether on the internet or otherwise, any goods, including, most prominently, denim jeans, bearing the Impugned Stitching Design mark which are deceptively similar to the Plaintiffs Arcuate Stitching Design mark or any other stitching patterns/ designs that are identical/ deceptively similar to the Plaintiffs Arcuate Stitching Design mark as depicted in paragraph 2 of the instant application, thereby resulting in violation of the Plaintiffs statutory and common law rights in the Plaintiffs Arcuate Stitching Design mark as depicted herein more specifically

b) An order for interim injunction restraining the Defendant No. 1, and all others acting for, and on behalf of, the Defendants, including the Defendant Nos. 2 - 5, from doing any act that amounts to trademark infringement of the Plaintiffs Accurate Stitching Design Marks bearing Registration Nos. 352692, 382357, 851939 and 1625122;

c) An order for interim injunction restraining the Defendant No.1, and all others acting for, and on behalf of, the Defendants, including the Defendant Nos. 2- 5, from doing any act that amounts to infringement of the Plaintiffs copyright in the Plaintiffs Accurate Stitching Design Mark;

d) An order for interim injunction restraining the Defendant No. 1, and all others acting for, and on behalf of, the Defendants, including the Defendant Nos. 2- 5, from doing any act that amounts to passing off of the Plaintiff's Accurate Stitching Design Mark; and

e) Any other orders as this Hon'ble Court may deem fit and proper in the facts and circumstances of the present case."

24. Issue notice.

25. Notice is accepted on behalf of the defendants by Ms. Shilpa Gamnani. Reply, if any, be filed within four weeks with advance copy to learned Counsel for the plaintiff who may file rejoinder thereto before the next date of hearing.

26. List before the Court on 24th March, 2022.

27. Till the next date of hearing, there shall be an ad-interim order in terms of prayers (a) and (b) in this application.

C. HARI SHANKAR, J DECEMBER 22, 2021/kr