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

+ CS(COMM) 539/2024 & I.A. Nos. 32165/2024, 32166/2024,
32167/2024, 32168/2024, 32169/2024 & 32170/2024

M/S JAY PLASTIC COMPANY & ORS.Plaintiffs

Through: Mr. Sachin Gupta with Mr. Manan
Mondal, Ms. Prashansa Singh and
Mr. Rohit Pradhan, Advocates.

versus

M/S. GURUNANAK ENTERPRISES & ORS.Defendants

Through: None.

CORAM:

HON'BLE MS. JUSTICE MINI PUSHKARNA

ORDER

% **04.07.2024**

**I.A. No. 32165/2024 (Application for exemption from Pre-Litigation
Mediation)**

1. The present is an application under Section 12A of the Commercial Courts Act, 2015 read with Section 151 of the Code of Civil Procedure, 1908 ("CPC") for exemption from instituting Pre-Litigation Mediation.
2. Having regard to the facts of the present case and in the light of the judgment of Supreme Court in the case of *Yamini Manohar versus T.K.D. Keerthi, 2023 SCC OnLine SC 1382*, and Division Bench of this Court in *Chandra Kishore Chaurasia Versus RA Perfumery Works Private Ltd., 2022 SCC OnLine Del 3529*, exemption from attempting Pre-institution Mediation, is granted.
3. Accordingly, the application stands disposed of.

I.A. No. 32166/2024 (Exemption from filing clearer copies)

4. The present is an application under Section 151 CPC seeking an exemption from filing clearer copies or documents with exact margins and/or which are handwritten or English translations, certified copies and from filing originals of the relevant documents at this stage, along with supporting affidavit.

5. Exemption is granted, subject to all just exceptions.

6. Plaintiff shall file legible, clear, and original copies of the documents, on which the applicant may seek to place reliance, within four weeks from today or before the next date of hearing, whichever is earlier.

7. Accordingly, the present application is disposed of.

I.A. No. 32170/2024 (Exemption from Advance service to the defendants)

8. The present is an application under Section 151 of the CPC seeking exemption from Advance Service to the defendants.

9. Plaintiff seeks urgent interim relief and an ex-parte appointment of Local Commissioner is also sought for this purpose. Thus, in peculiar facts and circumstances of the present case, exemption from effecting advance service upon the defendants is granted.

10. For the reasons stated in the application, the same is allowed and disposed of.

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11. Let the plaint be registered as suit.

12. Upon filing of the process fee, issue summons to the defendants by all permissible modes. Summons shall state that the written statement be filed by the defendants within thirty days from the date of receipt of summons.

Along with the written statement, the defendant shall also file affidavit of admission/denial of the plaintiff's documents, without which, the written statement shall not be taken on record.

13. Liberty is given to the plaintiff to file replication within thirty days from the date of receipt of the written statement. Further, along with the replication, if any, filed by the plaintiff, an affidavit of admission/denial of documents of the defendant, be filed by the plaintiff, without which, the replication shall not be taken on record. If any of the parties wish to seek inspection of the documents, the same shall be sought and given within the timelines.

14. List before the Joint Registrar (Judicial) for marking of exhibits on 16th August 2024.

15. List before the Court on 04th November, 2024.

I.A. No. 32167/2024 (Application under Order XXXIX Rules 1 and 2 read with Section 151 CPC)

16. The present suit has been filed for permanent injunction restraining infringement of the copyright and trademark against passing off, for rendition of accounts of profits/damages, delivery up, acts of unfair competition, etc.

17. Learned counsel appearing for the plaintiffs submits that by way of the present suit, the plaintiff complains against the defendants for dishonestly adopting a blue and white box packaging/trade dress containing a circular device for selling goods, namely Tag Fasteners such as *Tag Pins* and *Loop Pins*; and the mark "SPARROW", being deceptively similar to the Plaintiffs' registered trade mark "ARROW" and its blue and light blue coloured Tag Fasteners box packaging/ trade dress.

18. The plaintiffs and defendants impugned packaging, are reproduced as below:-


Plaintiff's Packaging	Defendant's impugned packaging
	
	

19. It is submitted that the plaintiffs' *ARROW* branded Tag Pins and Loop Pins are sold in a distinctive blue and white colour cubical box comprising of distinctive trade mark **→ARROW®** written in black lettering in the centre of a light coloured circle since the year 1994-1995. It is submitted that on account of long, continuous and exclusive use, promotion and advertisement, the plaintiffs' trade mark 'ARROW' and blue and light blue box packaging/trade dress, has acquired formidable goodwill, reputation and a great amount of distinctiveness within the minds of consumers.

20. It is further submitted that the plaintiffs, sometime in November 2021, came across defendant no. 1's *CREATIVE* branded blue and white box packaging/trade dress for selling identical products, i.e., Tag Pins and Loop

Pins. The plaintiffs, immediately, contacted the defendant no. 1 via WhatsApp, requesting him to cease and desist the use of the impugned trade dress/box packaging, for being deceptively similar to that of the Plaintiffs' ARROW branded blue and light blue colour box packaging/trade dress


21. In response, the defendant No.1 suggested changes to its packaging, and requested the plaintiffs to permit him to sell off his old stocks. The defendant No.1 assured that he shall obtain new stocks under the changed packaging. Attention of this Court has been drawn to document no. 15, which are the whatsapp messages between the plaintiffs and the defendants.



22. It is submitted that thereafter the plaintiffs did not come across the defendants products under the impugned packaging. However, in the fourth week of June 2024, the plaintiffs were shocked to come across the defendants' products under the impugned Blue and White packaging, with the mark CREATIVE and SPARROW written in a circular device. It is submitted that defendant no. 2 had applied for registration of the trademark/label  in Class 26 under no. 5258280 dated 23rd December, 2021 claiming its use since 01st July, 2021. The plaintiff no. 2 opposed the said application on 13th March, 2023 before the Trade Marks Registry under opposition no. 1209912. The said opposition was served by the Trade Marks Registry on 11th August, 2023. Further, it is submitted that no counter-statement had been filed by the defendant no. 2, within the statutory period of two months (from the date of service of Opposition). Thus, it is submitted that the impugned application shall be abandoned in due course.

23. Learned counsel for the plaintiffs submits that the defendants impugned Blue and White box packaging containing a circle; and the mark

SPARROW, is a clear attempt to ride piggy back on the goodwill and reputation of the plaintiffs. The impugned activities of the defendants are unlawful and amounts to infringement of plaintiff's trade dress, and unfair competition, which is in turn causing confusion and deception amongst the public and loss to the plaintiffs.

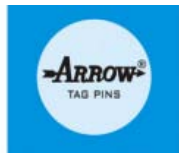
24. He submits that plaintiffs have bonafidely and honestly adopted the trade mark ARROW in the year 1994 for manufacture and sale of plastic tag pins, tag guns, implements and tools and extended the use of said trade mark for its other products, namely, textile cleaning spray guns, trimmers, etc. In order to gain statutory rights, the plaintiff no. 1 filed various applications, and, have been granted registration of such trade marks by the Registrar of Trade Marks. The details of the trade mark registrations, as occurring in the plaint, are as follows:-

Trade Mark	Class	Number	Goods	Status
	26	643102 dated 17.10.1994	Plastic Tag Gun and implements	Registered until 17.10.2024

			(Hand Operated) Gun (Hand Tools) Gun Hand operated for the Extrusion of Mastics	
	26	871619 dated 17.08.1999	Plastic tag pins	Registered until 17.08.2029.
	26	781283 dated 08.12.1997	Plastic tag pins	Registered until 8.12.2027.

25. He further submitted that the said trademarks are still in force, valid and subsisting and have been registered in favour of plaintiffs.

26. It is submitted that the artistic work "*Arrow Tag Pins*" packaging also constitutes an "original artistic work" within the meaning of section 2(c) of the Copyright Act, 1957, and copyright subsist in such artistic work under the provision of Section 13 (1) of the Copyright Act, which has been created by at the behest of Plaintiff No.1. Furthermore, he submits that plaintiff no.1 has obtained a copyright registration for Arrow Tag Pin artistic work under No. A-57158/1999, as follows:-



27. Thus, it is submitted that plaintiff no. 1 is the owner of copyright in the above Arrow Tag Pin artistic work, having exclusive right to use thereof, in any material form, under the provisions of Section 14 of the Copyright Act, 1957.

28. It is further submitted that plaintiffs are vigilant and diligent about protecting its intellectual property rights in the trade dress / box packaging against infringement/ passing off. The Plaintiff has been taking legal actions against infringers and successfully obtained favourable orders from various Courts against blatant and slavish imitation of its trade dress, as follows:-

Subject Matter of dispute	Title	Order Dt.
	<p>Umaid Mohonot & Others vs. Praveen Rai & Others</p> <p>CS (OS) No. 523/2009</p> <p>Before Hon'ble High Court of Delhi</p>	<p>20.03.2009</p> <p>Ex-parte injunction in favour of the Plaintiff</p> <p>15.03.2010</p> <p>W.r.t final settlement of the dispute</p>
	<p>M/s Jay Garments Accessories vs. Sh. Vipul Sethi</p> <p>TM No. 107/2017</p> <p>Before Hon'ble Patiala House Court</p>	<p>18.05.2017</p> <p>Ex-parte injunction in favour of the Plaintiff</p> <p>Decree passed on 17.04.2018 in terms of settlement order dated 24.03.2018</p>
	<p>Umaid Mohonot vs Abhishek Ambalal & Ors.</p> <p>CS (COMM) No. 57 of 2022</p> <p>Before Hon'ble high Court of Delhi</p>	<p>24.01.2022</p> <p>Ex-parte injunction in favour of the Plaintiff</p>

29. Thus, it is submitted that the impugned activities of the defendants are unlawful and amount to infringement of plaintiffs' trade dress and unfair competition.

30. In the above circumstances, the plaintiff has demonstrated a *prima*

facie case for grant of ex-parte ad-interim injunction, and in case, no *ex-parte ad-interim injunction* is granted, the plaintiff will suffer irreparable loss. Further, balance of convenience also lies in favour of the plaintiffs, and against the defendants.

31. Accordingly, till the next date of hearing, the defendants, its, proprietors, partners, their assignees in business, distributors, dealers, stockists, retailers, servants and agents are restrained from manufacturing, selling, offering for sale, advertising directly or indirectly dealing in tag fasteners, including tag pins and loop pins or any allied or cognate goods used in Sewing and Garment industry in blue and white box packaging/trade dress along with a circular device, or with the mark SPARROW



, which is amounting to infringement of the plaintiffs trade mark



ARROW

32. Issue notice to the defendants by all permissible modes, upon filing of process fees, returnable on the next date of hearing.

33. Reply, if any, be filed within a period of four weeks from the date of the service.

34. Rejoinder thereto, if any, be filed within a period of two weeks thereafter.

35. Compliance of Order XXXIX Rule 3 of CPC, be done within a period of two weeks from today.

36. Re-notify on 04th November, 2024.

I.A. No. 32168/2024 (Appointment of Local Commissioner)

37. The present application has been filed for appointment of a Local Commissioner. It is submitted that in order to preserve evidence of infringement, it is necessary that a Local Commissioner be appointed to visit the premises of the defendants.

38. Accordingly, the following directions are issued:

37.1 Ms. Priti Verma, Advocate (Mob. No. 7838581994), Email: vermapriti74@gmail.com is appointed as Local Commissioner, with a direction to visit the following premises of the defendants:

M/s. Gurunanak Enterprises, Proprietor: Shri Rajpreet Singh, 318/4, Daya Basti, Shahzada Bagh, Old Rohtak Road, The Rajdhani Udyog, Near Daya Basti Railway Station, Delhi-110035.

37.2 The Local Commissioner, along with a representative of the plaintiff and its counsel, shall be permitted to enter upon the premises of the defendants mentioned above, or any other location/premises, that may be identified during the course of commission, in order to conduct the search and seizure.

37.3 The Local Commissioner shall conduct a search in the defendants' premises and seize impugned goods bearing any Mark, which are similar to the plaintiff's goods, bearing the defendants' impugned Marks, or any other Mark, which is identical or deceptively similar to the plaintiff's trademarks.

37.4 After seizing the infringing material, the same shall be inventoried, sealed and signed by the Local Commissioner, in the presence of the parties, and released on *superdari* to the defendants, on their undertaking to produce the same, as and when further directions are issued in this regard.

37.5 The Local Commissioner shall also be permitted to make copies of the books of accounts including ledgers, cash books, stock registers, invoices, books etc., in so far as they pertain to the infringing products.

37.6 Further, the Local Commissioner shall be permitted to undertake/arrange for photography/videography of the execution of the commission.

37.7 Both the parties shall provide assistance to the Local Commissioner for carrying out the aforesaid directions.

37.8 In case, any of the premises are found locked, the Local Commissioner shall be permitted to break open the lock(s).

37.9 To ensure an unhindered and effective execution of this order, the Station House Officer (“SHO”) of the local Police Station, is directed to render all assistance and protection to the Local Commissioner, if and when, sought.

37.10 The fee of the Local Commissioner, to be borne out by the plaintiff, is fixed at ₹ 1,00,000/-. The plaintiff shall also bear all the expenses for travel of the Local Commissioner and other miscellaneous out-of-pocket expenses for the execution of the commission. The fee of the Local Commissioner shall be paid in advance by the plaintiff.

37.11 The Local Commission shall be executed within a period of two weeks from today. The Local Commissioner shall file the report within a period of two weeks from the date, on which the commission is executed.

39. The order passed today, shall not be uploaded for a period of two weeks.

40. In terms of the forgoing, the present application stands disposed of, in the aforesaid terms.

41. *Dasti* under the signatures of the Court Master.

MINI PUSHKARNA, J

JULY 4, 2024

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