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

+ CS(COMM) 725/2022, I.A. 17018/2022, I.A. 17019/2022 & I.A. 48178/2024

PUMA SE

.....Plaintiff

Through: Mr. Ranjan Narula, Mr. Shakti Priyan Nair and Mr. Parth Bajaj, Advocates

versus

MAHESH KUMAR

.....Defendant

Through: None.

CORAM:

HON'BLE MS. JUSTICE MINI PUSHKARNA

ORDER

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12.02.2025

MINI PUSHKARNA, J (ORAL)

IA/48178/2024 (Application on behalf of the plaintiff under Order XIII-A read with Order VIII Rule 10 and Section 151 of the Code of Civil Procedure, 1908 ("CPC"))

1. The present application is filed on behalf of the plaintiff under Order XIII A, read with Order VIII Rule 10, and Section 151 of the Code of Civil Procedure, 1908 ("CPC").

2. Present suit has been filed by the plaintiff seeking permanent injunction *inter alia*, restraining infringement of their trademarks, 'PUMA',



logo and Form strip logo



by the defendant and for




unfair trade competition, rendition of accounts, damages, delivery up, etc.


3. The plaintiff seeks a summary judgement against the defendant, on the ground that the defendant has no prospect of the defending the claims of the plaintiff.

4. The case, as canvassed by the plaintiff, is as follows:

4.1 The plaintiff company is one of the world's largest sports brands engaged in designing, developing and marketing footwear, apparel and

accessories under their coined marks PUMA and  logo since the year 1948.

4.2 The plaintiff's well-known trademark, 'PUMA' is registered in several countries all around the world, including, India. Further, the earliest registration of the plaintiff's mark, 'PUMA' dates back to the year 1948, and

the earliest registrations for the plaintiff's marks 'PUMA',  logo and in India is since the year 1977.

4.3 The plaintiff's products are available in more than 120 countries worldwide and the plaintiff has been selling its products in India under their marks since the 1980's, having extensively advertised its 'PUMA' products bearing the logos, by way of various printed media, i.e. newspapers, magazines, trade journals, leaflets etc. all over the country. Further, the plaintiff sponsors and advertises with various celebrities which are known throughout the world.

4.4 The plaintiff's trademark 'PUMA' has been declared as a well-known trademark in India on 30th December, 2019, by the Trade Marks Registry which was published in the Trade Marks Journal bearing no. 1934.



4.5 The defendant is engaged in the business of stocking, selling, and supplying counterfeit shoes bearing the plaintiff's marks, 'PUMA',



logo and Form strip logo



without

authorization/approval of the plaintiff.

4.6 In the 1st week of October, 2022, the plaintiff discovered large quantities of counterfeit 'PUMA' branded shoes being locally manufactured, supplied and sold in bulk quantities at several shops in East Delhi. Upon enquiry, the plaintiff's representative identified the defendant's manufacturing unit at *B1-424, Gali no. 15, B-Block, Harsh Vihar, Mandoli, North-East Delhi- 110093*.

4.7 The plaintiff is the prior adopted, user and the registered proprietor of the marks in question and the said marks are distinctive of the plaintiff's goods, therefore the adoption and copying of the plaintiff's marks by the defendant and applying them on inferior quality counterfeit products which amounts to infringement under Sections 29 (1) and (2) of the Trade Marks Act, 1999 ("the Act").

4.8 The defendant has copied each and every essential feature of the plaintiff's marks in order to ride upon the goodwill of the plaintiff, thereby, creating misrepresentation on the minds of the trade and common man which amounts to passing off.

5. I have heard learned counsel for the plaintiff and perused the record.

6. At the outset, it is noted that this Court *vide* order dated 18th October, 2022 passed an *ex-parte ad-interim* injunction against the defendant restraining them from advertising, manufacturing, selling, offering for sale, etc., any products, including shoes, sportswear, accessories etc., under the



plaintiff's mark, 'PUMA',  logo and the Form strip logo



or any other mark, which is identical, or deceptively / confusingly similar to the plaintiff's trademarks.

7. It is noted that the defendant was initially 'John Doe' at the time of filing the present suit, and *vide* order dated 11th March, 2024, the present defendant was impleaded and directed to file their written statement.

8. It is further noted that the defendant failed to file their written statement within the statutory period, therefore, *vide* order dated 18th September, 2024 the right of defendant to file a written statement was closed. Consequently, the defendant was proceeded *ex-parte vide* order dated 09th December, 2024, which is reproduced as under:

“xxx xxx xxx

1. *Perusal of the order sheets show that defendant has not filed any written statement, despite expiry of the statutory period.*

2. *Accordingly, the defendant is proceeded ex-parte.*

3. *Learned counsel appearing for the plaintiff submits that an application for summary judgment has already been filed on behalf of the plaintiff. However, the same is not before this Court.*

4. *At request, re-notify on 12th March, 2025.*

xxx xxx xxx”

9. The plaintiff is the proprietor of its registered marks in various countries, the earliest registrations of which, date back to the year 1948. Details of the said registrations are reproduced as under:











Trade Mark	Country	Regn. No.	Regn. Date	Cl. '
PUMA	GERMANY	608870	01.10.1948	25
PUMA	USA	797843	19.10.1965	25
PUMA	AUSTRALIA	228918	15.05.1969	28

10. Further, the plaintiff is the registered proprietor of the various marks in India, which are valid and subsisting, details of which, are reproduced as under:

Trade Mark	Registration No.	Filing date	Class	Renewed Status
PUMA (WORD MARK)	323053	15/02/1977	18	15/02/2025
PUMA (WORD MARK)	323054	15/02/1977	25	15/02/2025
 PUMA	450142	25/02/1986	18	25/02/2026
 PUMA	559635	03/10/1991	24	03/10/2028
 PUMA				



	699153	22/02/1996	09	22/02/2026
	699154	22/02/1996	03	22/02/2026
	700541	04/03/1996	16	04/03/2026
	1264294	03/02/2004	41	03/02/2024
	412852	08/11/1983	28	08/11/2024
	424934	27/07/1984	14	27/07/2025
	450143	25/02/1986	25	27/02/2027
PUMA	532578	03/07/1990	28	03/07/2024
PUMA	449270	05/02/1986	24	05/02/2027
PUMA	323053	15/02/1977	18	15/02/2025
PUMA	323054	15/02/1977	25	15/02/2025
PUMA	3093793	04/11/2015	35	12/11/2025
	3097774	12/11/2015	35	12/11/2025
	407833	11/07/1983	25	11/07/2024



11. At this stage, it is pertinent to note that the trademarks of the plaintiff, i.e. 'PUMA' have been declared as a well-known mark by the Trade Marks Registry on 30th December, 2019, under the application no. 816409, and the same was published at Sr. No. 05, in the Trade Marks Journal bearing no. 1934. The relevant portion of the Trade Marks Journal dated 30th December, 2019, is reproduced as under:

Trade Marks Journal No: 1934 , 30/12/2019


Publication of the Trademarks under Rule 124 of Trade Marks Rules, 2017

A. Publication of the trademark u/r 124 (4) of Trade Marks, Rules 2017, proposed to be included in the list of Well-Known Trademarks.

Whereas request has been received by Registrar of Trade Marks u/r 124 of Trade Marks Rules, 2017 for determination of Well-Known trademarks (details as per Schedule I) and after consideration of request and perusal of the documents, Registrar is of the view that objection, if any, from general public are to be called for in accordance to the provision of rule 124 (4) of the Trade Marks Rules, 2017.

Therefore, Objection from general public, if any, is invited before the determination of the mark mentioned in scheduled I as well-Known trademark. If, anyone has any objection in this regard, may file his / her objection with reasons along with supporting documents, if any, within the period of 30 days from the date of publication to the Registrar of Trade Marks at Trade Marks Registry, Mumbai, Boudhik Sampada Bhavan, S M Road, Antop Hill, and Mumbai 400037.

Schedule I: list of trademark proposed to be included in the list of Well-Known trademarks

Sl. No	Well-Known TM App. No.	Trademark(s)	Applicants Details
01	784854	FORBES MARSHALL Relating to process efficiency and energy conservation for process industry.	Forbes Marshall Private Limited, A-34/35, MIDC, H Block, Pimpri, Pune-411018. Maharashtra.
02	777329	LIFEBUOY Relating to soap and allied products.	Hindustan Unilever Limited (HUL), Unilever House, B D Sawant Marg, Chakala, Andheri East, Mumbai 400099
03	816418	GMR Relating to the field of infrastructure comprising of airports, energy, railways and urban infrastructure in India.	GMR Enterprises Private Limited Third Floor, Old No.248/New No.114, Royapettah High Road, Royapettah, Chennai - 600 014.
04	816392	BIG BAZAAR Relating to retail stores.	FUTURE RETAIL LIMITED Knowledge House, Shyam Nagar, Off Jogeshwari Vikhroli Link Road, Jogeshwari (East), Mumbai-400 060.
05	816409	PUMA Relating to sports shows, apparel and accessories including track suits, T-shirts, shorts, polo shirts, accessories and equipments.	PUMA SE Way 1, 91074 Herzogenaurach, Germany
06	809474	 Relating to washing soap, detergent powder, detergent cake, shampoo, hair oil, toothpaste, moisturizer, shaving cream, liquid hand wash, floor cleaner, liquid detergent, toilet cleaner and other allied and cognate goods.	RSPL Limited 119/121 (Part), Block P & T, Fazalganj, Kalpi Road, Kanpur-208012 (U.P)

12. During the course of the present proceedings, the plaintiff's marks



, have also been declared as well-known marks and published in Trade Marks Journal bearing no. 2144 dated 19th February, 2024 at Sr. Nos. 68 and 69 respectively. The relevant portion of the Trade



Marks Journal dated 19th February, 2024 is reproduced as under:

Trade Marks Journal No: 2144 , 19/02/2024

Inclusion of the trade Mark in the list of Well-known Trade Marks

Whereas request has been received by Registrar of Trade Marks u/r 124 of Trade Marks Rules, 2017 for determination of Well-Known trademarks and after consideration of request and perusal of the documents, the same were notified/ published in TMR Journal.

The trade marks at Sr. No. 01 to 115 were published earlier in the Trade Mark Journal u/r 124 (4) of Trade Marks, Rules 2017, and whereas no objections were filed by any person.

Further trade marks at Sr. No. 116 to 143 were already notified earlier in the Trade Mark Journal u/r 124 (5) of Trade Marks, Rules 2017.

Hence it has been decided to include following marks in the list of well-known trademarks:

62		816451	SUN PHARMA LABORATORIES LIMITED SUN HOUSE, PLOT NO 201 B/1, WESTERN EXPRESS HIGHWAY, GOREGAON (EAST), MUMBAI - 400063
63		816523	FDC LIMITED 142-48, S.V. ROAD, JOGESHWARI (WEST) MUMBAI-400102.
64		816663	INDIAN LAW SOCIETY ILS LAW COLLEGE CAMPUS, LAW COLLEGE ROAD, PUNE-411 004.
65		816572	HONDA MOTOR CO., LTD. 1-1, MINAMI-AOYAMA, 2-CHOME MINATO-KU, TOKYO 107-8556, JAPAN.
66		816600	INVENTIO AG SEESTRASSE 55 6052, HERGISWIL, SWITZERLAND
67		816493	SEIKO EPSON KABUSHIKI KAISHA TRADING AS SEIKO EPSON CORPORATION 1-6, SHINJUKU 4-CHOME, SHINJUKU- KU, TOKYO, JAPAN.
68		816513	PUMA SE PUMA WAY 1, 91074 HERZOGENAURACH, GERMANY.
69		816516	PUMA SE PUMA WAY 1, 91074 HERZOGENAURACH, GERMANY.
70		816625	DFM FOODS LTD 149, 1ST FLOOR, KILOKARI, RING ROAD, ASHRAM, NEW DELHI-110014.

13. This Court also notes that *vide* order dated 18th October, 2022 this Court had appointed a Local Commissioner to visit the premises of the defendant. In furtherance to the same, the Local Commissioner filed a report dated 14th November, 2022, recording the infringing materials found on the site. The inventory list in the Local Commissioner's report, is reproduced as under:



INVENTORY LIST

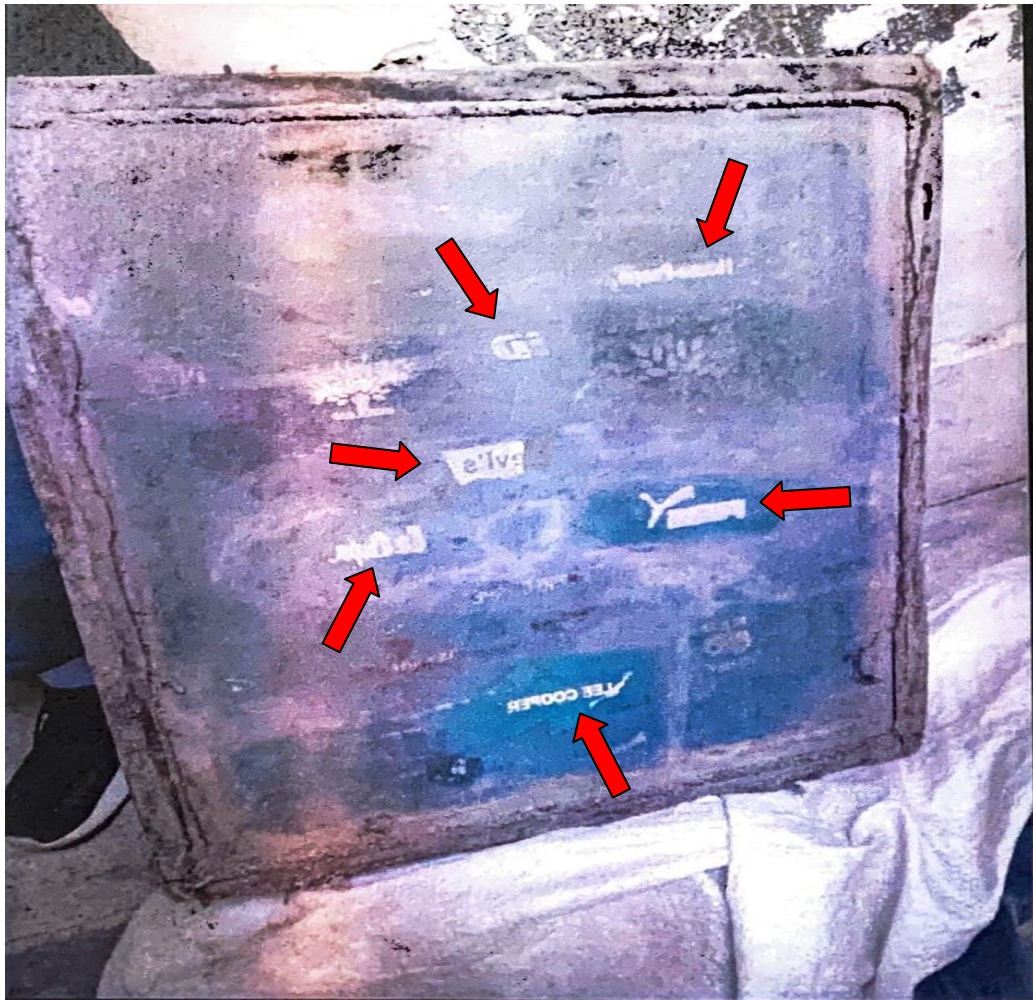
S. NO.	PARTICULARS OF THE INFRINGING GOODS	QUANTITY
1.	SPATS OF THE INFRINGED MARK "PUMA"	110
2.	SHOES OF THE INFRINGED MARK "PUMA"	4
3.	SCREEN FILM OF THE INFRINGED MARK "PUMA"	1

14. This Court also records that the infringing materials found on the site of the defendant are counterfeit goods of the plaintiff's products, affixed with the plaintiff's registered marks. A clear indicative of the counterfeiting activity towards the plaintiff's products, are the observations and photographs as attached by the Local Commissioner in its report. Furthermore, the photographs further show that the defendant is undertaking counterfeiting of goods from several other well-known brands as well. The said photographs are reproduced as under:










15. Perusal of the above brings forth the following:

i. The defendant is manufacturing counterfeit products under the

plaintiff' registered and well-known marks, 'PUMA',  and



. Further, counterfeit products of other known brands as well are found, i.e. Adidas, Nike etc.

ii. The counterfeit products found are spats, shoe soles, shoes and screen film bearing the infringing marks. Moreover, a metal mould for the logos is found, wherein the marks of various other known brands,



i.e. Adidas, Nike, Lee Cooper etc. are imprinted, showing that the operation of the defendant was not just limited to creating counterfeit products of the plaintiff, rather for known marks of other brands as well.

16. This Court in the case of *Louis Vuitton Malletier Versus Capital General Store and Others, 2023 SCC OnLine Del 613* elucidated upon the seriousness of counterfeiting and the actions of the counterfeiters, making the following observations:

“xxx xxx xxx

33. Counterfeiting is an extremely serious matter, the ramifications of which extend far beyond the confines of the small shop of the petty counterfeiter. It is a commercial evil, which erodes brand value, amounts to duplicity with the trusting consumer, and, in the long run, has serious repercussions on the fabric of the national economy. A counterfeiter abandons, completely, any right to equitable consideration by a Court functioning within the confines of the rule of law. He is entitled to no sympathy, as he practices, knowingly and with complete impunity, falsehood and deception. Even while remaining within the confines of the provision with which it is seized - in this case, Order 39 Rule 2A - the Court is, therefore, required to be economically and socially sensitized, and to send a deterrent message to others who indulge, or propose to indulge, in the practice of counterfeiting.

xxx xxx xxx”

(Emphasis Supplied)

17. Moreover, the Division Bench of this Court in the case of *Jawed Ansari Versus Louis Vuitton Malletier & Ors., MANU/DEOR/136880/2023*, upheld the view of a Single Judge of this Court, while observing that counterfeiting is indeed a serious menace and should be dealt firmly.

18. Any goods or products, that are identical to such a degree, in the manner of appearance, for an identical business, with an identical customer



base, wherein it falls under the category of counterfeit, will unquestionably cause confusion and deception in the eyes of the public. Further, it has been succinctly observed, that “*Counterfeiting is ‘hard core’ or ‘first degree’ trademark infringement and the most blatant and egregious form of ‘passing off’.*” (See: *4 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 25.10 (4th ed. 2008)*). Thus, it stands established that the defendant is infringing upon the rights of the plaintiff under their well-known and registered marks, by engaging in the blatant act of counterfeiting.

19. Further, the plaintiff’s marks are well-known, which in such designation, have a strength associated to their marks, which brings association of consumers only to the plaintiff in relation to the strata of plaintiff’s operation. It was observed by J. McCarthy, that, “*The stronger the mark, the broader the scope of protection given to it*” (See: *McCarthy on Trademarks and Unfair Competition, 4th ed., Vol. 2, para 15.25*).

20. It is settled law that a mark which is well-known requires a higher degree of protection, as it is highly susceptible to piracy. Thus, the Division Bench of this Court in the case of *Hamdard National Foundation (India) and Another Versus Sadar Laboratories Pvt. Ltd., 2022 SCC OnLine Del 4523*, held as follows:

“xxx xxx xxx

63. As noted above, the trademark ‘ROOH AFZA’ has been used in respect of the appellant’s product for over a century. Prima facie, it is a strong mark. It is also well settled that the requirement of protection varies inversely with the strength of the mark; the stronger the mark, the higher the requirement to protect the same. Trademarks serve as source identifiers. It is also well-settled that in case of a well-known mark, which has acquired a high degree of goodwill, the mark requires higher protection as it is more likely to be subjected to piracy from those who seek to draw an undue advantage of its goodwill. In the present case, the appellants claim



that the trademark 'ROOH AFZA' is a well-known mark.

64. In *Planters Nut & Chocolate Co. v. Crown Nut Co.*, the United States Court of Appeals for the Federal Circuit had observed that a mark's fame is an incentive for competitors "to tread closely on the heels of a very successful trademarks". In cases of a weak trademark, where the trademark has not acquired significant goodwill, a higher degree of similarity is permissible. However, strong marks which have acquired immense goodwill are vulnerable from competitors seeking to ride on their goodwill. Such marks require a higher degree of protection and it is necessary to ensure that the marks of a competitor do not come close to the said senior marks.

xxx xxx xxx"

(Emphasis Supplied)

21. Taking note of the above, this Court can proceed to pass a summary judgement, on account of no defence being put forth by the defendant and the right to filing a written statement being closed, no purpose will be served in adducing *ex-parte* evidence from the plaintiff, as the defendant has no real prospect of succeeding or defending the unrebutted claims as put forth by the plaintiff's (*See: Su-Kam Power Systems Ltd. Versus Kunwer Sachdev and Another, 2019 SCC OnLine Del 10764*).

22. Even so, in consideration of the evidence placed before this Court by way of the Local Commissioner report and the narration as recorded above, it is apparent that the activity of the defendant constitutes infringement of the plaintiff's registered marks and passing off of the plaintiff's products.

23. This Court notes the submission of learned counsel for the plaintiff, who prays for actual cost of litigation, wherein Rs. 1,00,000/- is sought towards the Local Commissioner's Fee along with actual expenses, and Rs. 8,00,000/- towards litigation costs.

24. In view of the above, the present is befitting case for grant of actual costs on account of a clear case being made out for counterfeiting against the



defendant.

25. Further, the plaintiff is also held entitled to damages. In the facts and circumstances of the present case, damages of Rs. 2,00,000/- is imposed upon the defendant.

26. Accordingly, the following directions are issued:

I. The suit is decreed in favour of the plaintiff and against the defendant, in terms of para 38 (a) and (b) of the plaint.

II. The plaintiff is held entitled to actual costs of Rs. 9,00,000/-.

III. The plaintiff is held entitled for payment of damages of Rs.2,00,000/-.

IV. The aforesaid amounts shall be payable by the defendant, within a period of three months, from today.

27. Suit is decreed in the aforesaid terms. The Registry is directed to draw up a decree sheet, in terms thereof.

28. With the aforesaid directions, the present suit along with the pending applications, stands disposed of.

MINI PUSHKARNA, J

FEBRUARY 12, 2025

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Corrected & Released on: 9th March, 2025