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

+ CS(COMM) 919/2022 & I.A. 22377/2022

HERMES INTERNATIONAL & ANR. Plaintiffs

Through: Mr. Pravin Anand, Ms. Tusha Malhotra and Ms. Richa Bhargava, Advs.

versus

CRIMZON FASHION ACCESSORIES PRIVATE LIMITED

..... Defendant

Through: Mr. Sidhant Goel, Mr. Ahhishek Kotnala and Mr. Deepankar Mishra, Advs.

CORAM:

HON'BLE MR. JUSTICE C.HARI SHANKAR

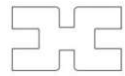
JUDGMENT (O R A L)

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08.02.2023

1. CS(COMM) 919/2022, instituted by the plaintiffs against the defendant stands partly decreed in terms of prayers (a) to (d) in the suit by judgment dated 23rd December 2022.

2. Prayer (e) in the suit seeks a declaration that the plaintiffs'



mark is a well-known trade mark within the meaning of Section 2(1)(zg) of the Trade Marks Act, 1999.

3. Section 11(6) of the Trade Marks Act sets out the factors which are to be taken into consideration by the Registrar while determining whether a mark is a well-known. It reads as under:

“(6) The Registrar shall, while determining whether a trade mark is a well-known trade mark, take into account any fact which he considers relevant for determining a trade mark as a well-known trade mark including—

(i) the knowledge or recognition of that trade mark in

the relevant section of the public including knowledge in India obtained as a result of promotion of the trade mark;

(ii) the duration, extent and geographical area of any use of that trade mark;

(iii) the duration, extent and geographical area of any promotion of the trade mark, including advertising or publicity and presentation, at fairs or exhibition of the goods or services to which the trade mark applies;

(iv) the duration and geographical area of any registration of or any application for registration of that trade mark under this Act to the extent they reflect the use or recognition of the trade mark;


(v) the record of successful enforcement of the rights in that trade mark; in particular, the extent to which the trade mark has been recognised as a well-known trade mark by any court or Registrar under that record.”

4. Mr. Sidhant Goel, learned Counsel for the defendant, has no objection to the plaintiffs’ mark being declared as a well-known trade mark.


5. Mr. Pravin Anand, learned Counsel for the plaintiffs, has set out the data available with respect to each of the five factors enumerated in Clauses (i) to (v) of Section 11(6) of the Trade Mark as being relevant for deciding whether a mark is eligible for being declared a well-known trade mark, thus:

(i) Re: Factor -I


The knowledge or recognition of that trade mark in the relevant section of the public including knowledge in India obtained as a result of promotion of the trade mark.

a. The Plaintiffs have stores in Mumbai and Delhi and its products bearing Plaintiffs’ H  trade mark, are displayed at the stores. The Plaintiffs have curated several catalogues for their stores in Delhi and Mumbai.

b. The Plaintiffs have mentioned retail distributions and revenue generated in its activity report for the year 2021.



c. Several articles and magazines such as Vogue, Harper Bazaar etc. have reviewed and recognised the Plaintiffs' sandals with H  trade mark.

(ii) Re: Factor 2: The duration, extent and geographical area of any use of that trade mark.



a. The Plaintiffs' H  trade mark was coined and Plaintiffs' Oran sandals having the said trade mark was conceptualised in the year 1997, by Mr. Pierre Hardy, Creative Director of Plaintiffs' company and a famous French designer.


b. The Oran Sandals with the Plaintiffs' trademark were inspired by the house decorations of Africa's Ndebele tribe and is made with soft leather and characterized by a leather band, with the iconic H cut-out representing the Plaintiffs' fashion house.

c. The Plaintiffs since coining of the trade mark have used the said trade mark in several products, significantly in its sandals such as Oran sandals, Oasis sandals and Legend sandals.

d. The Plaintiffs' H  trade mark has been since 1997 in circulation in the market. The Plaintiffs have range of footwear bearing the Plaintiffs' H  trade mark.

e. Recently, in the year 2022, the Plaintiffs celebrated a silver jubilee i.e. 25th anniversary of its signature Oran sandals.


f. In India, the Plaintiffs advertise their products through their stores and have showcased the Plaintiffs' products bearing the Plaintiffs' H  trade mark, in several events conducted in India. The extracts and photographs from the said events are available at Pgs 202-206 of LOD dated 22.12.2022 and Pgs 7-9, 826- 853 of LOD dated 16.01.2023. The sample sales receipt for the Plaintiffs' Oran sandals having H  trade mark, are available at Pg 227 of LOD dated 22.12.2022.

g. Several celebrities and people have been found to have been using the Plaintiffs' Oran sandals having H  trade mark.

(iii) Re: Factor 3: The duration, extent and geographical area of any promotion of the trade mark, including advertising or publicity and presentation, at fairs or exhibition of the goods or services to which the trade mark applies.

a. The Plaintiffs have since 1997 undertaken extensive promotional activities. The Plaintiffs Oran sandals have been taken note of and publicised in several international magazines globally, which is evident from the advertisement and listing of the Plaintiffs' footwear on Plaintiffs' website, publications in international magazines, news etc.

b. Publications of its product catalogues since the year 1997 and listings on its own website are available at Pgs 98-199 of LOD dated 22.12.2022; Pgs 11-516 and 719-728 of LOD dated 16.01.2023 and Pgs 8-48 of LOD dated 23.01.2023. The international publications are available at Pgs 277-432 of LOD dated 22.12.2022 and Pgs 519-674 of LOD dated 16.01.2023.

c. As mentioned above, in India, the Plaintiffs advertise their products through their stores and have showcased the Plaintiffs' products bearing the Plaintiffs' H  trade mark, in several events conducted in India. The extracts and photographs from the said events are available at Pgs 202-206 of LOD dated 22.12.2022 and Pgs 7-9, 826- 853 of LOD dated 16.01.2023.

(iv) Re: Factor 4- The duration and geographical area of any registration of or any application for registration of that trade mark under this Act to the extent that they reflect the use or recognition of the trade mark.

a. The Plaintiffs filed for registration of the H trade mark in France on April 15, 2015 under the application no. 4167976. Thereafter, vide the Madrid Protocol, the Plaintiff No. 1 filed an international application in Class 25. The Plaintiffs' trademark was granted international registration on September 8, 2016, under international registration no. 1325552 and International Registration Designating India No. 3485491.

b. The Plaintiffs also enjoy international registrations

and/or National Registrations, in over 93 countries such as UAE, France, Canada, Switzerland, Singapore, Australia, the UAE etc.

(v) Re: Factor 5- The record of successful enforcement of the rights in that trade mark, in particular the extent to which the trade mark has been recognised as a well-known trade mark by any court or Registrar under that record.

a. The Plaintiffs have been vigilant in protecting and safeguarding its trade mark rights from misuse by third parties.

b. Pursuant to the same the Plaintiffs had instituted proceedings for the Plaintiffs' trademark before the courts in Germany, wherein the Plaintiffs had obtained a preliminary injunction against the several third parties therein and thereafter the said third parties had also given an undertaking.


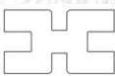
i) Injunction orders granted by the German Courts @ Pgs 85-118, 187-221, and their translations are available at Pgs 328-361, 430-464; and

ii) The undertakings given by third parties @ Pgs 1-84, 119-186 and their translations are available at Pgs 264-327, 404-429, 465- 511)”

6. Mr. Pravin Anand has also drawn attention to the reference, “relevant section of the public”, to which Sections 11(6)(i) and 11(7) of the Trade Marks Act 1999 specifically refer. He points out that knowledge or recognition of the trade mark is, therefore, required to be assessed *vis-à-vis* the relevant section of the public. In a case where goods in question are intended to cater to a specific section of the public, he submits, therefore, that the knowledge or recognition of the trade mark for the purpose of Section 11(6)(i) and 11(7) has to be *vis-à-vis* that section of the public.

7. In the present case, for example, he submits that, as the product is specific to the fashion industry, and the material that he has placed

on record indicates that the criteria numerated in Clauses (i) to (v) of Section 11(6) stand satisfied with respect to the renown of the mark in the fashion industry, the mark is entitled to be certified as a well-known trade mark.

8. I have gone through the material cited by Mr Anand to support his plea for declaration of the plaintiff's  mark as a well known trade mark. Given the volume and nature of material placed on record, to which I have already adverted hereinabove, I am satisfied that the criteria enumerated in section 11(6) of the Trade Marks Act, read with Section 11(7), stand satisfied in the present case, so as to justify declaration of the  mark as a well-known trade mark within the meaning of Section 2(1)(zg) of the Trade Marks Act 1999.

9. It is declared accordingly. Accordingly, prayer (e) in the plaint also stands decreed.

10. Let a decree be drawn up by the Registry in accordance with the present order.

11. Judgment to be uploaded on the website of this Court within 24 hours.

C. HARI SHANKAR, J.

FEBRUARY 8, 2023

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