

TM No. 04-2022

Hugo Boss Trademark Management GmbH & Co. K.G.

Vs.

Global Perfumes Company & Anr

03.02.2022

Matter is taken up through Video Conferencing pursuance to order of Hon'ble High Court vide order no. 1/RG/DHC/2022 dated 12.01.2022.

Present : Sh. Amit Chanchal Jha, ld. counsel for plaintiff.

Alongwith the suit, the plaintiff has also filed an application under Order XXXIX Rules 1 & 2 CPC readwith section 151 of CPC. Arguments on the application heard.

1. It is submitted by ld counsel for plaintiff that the plaintiff no.1 is a company incorporated under the laws of the Federal Republic of Germany and Mrs. Meena Bansal, constituted attorney of the plaintiff no.1 is authorized to sign and verify the pleadings, on behalf of the plaintiff. Plaintiff no.2 is a company organized and incorporated under the laws of Switzerland and Ms. Meena Bansal is also the Constituted Attorney of plaintiff no. 2 is duly authorized to sign and verify the pleadings on behalf of the plaintiff no. 2.

2. It is averred that plaintiff no. 1 company goes back to year 1924 when Mr. Hugo Ferdiannnd Boss started his clothing

company and since that time, plaintiff has extensively diversified its business from high fashion clothing, to accessories, footwear and fragrances.

3. It is further submitted that the mark HUGO BOSS was first adopted by plaintiff's predecessor in title as its business name in May, 1948 when the company HUGO Boss GmbH was incorporated in Germany. The company went public on 27.07.1984, whereafter its name was changed to HUGO BOSS AG.

4. In the same year, the earliest edition of the plaintiff no. 1's HUGO BOSS perfumes were created. Since then, the plaintiff no. 1 has come up with a wide and extensive range of fragrances under the mark HUGO BOSS, BOSS, HUGO and other BOSS/HUGO formative marks such as HUGO HUGO BOSS, BOSS HUGO BOSS, etc. (hereinafter collectively referred to as the "*said trademarks/label*"). Plaintiff company, since its inception and over a period of more than 90 years, has been engaged in the business of manufacturing, distribution and the sale of a wide range of apparel & clothing accessories, perfumes, fragrances, life style goods, watches shoes, belts, glasses, bags and various other goods and other allied/related products (hereinafter referred to as the "*said goods and business*") under its said trademarks/labels.

5. It is further submitted that plaintiff is registered proprietor of said trademark in various classes including class 3, 9, 14, 18, 25 and 35. The details of the plaintiff no.1's registration for trademark in Class 3 is given in para no. 7 of the plaint. The said

registrations are valid, subsisting and have been renewed from time to time and are in force in favour of the plaintiff. The trademark registration numbers 502837, 497775, 766732, 1135901, 1201610, 878574, 971856, 1101842, 1327729, 610824, 1282055 and 1162702 were assigned from Eurocos Cosmetics GmbH to Hugo Boss Trade Mark Management GmbH & Co. KG., the Plaintiff herein, *vide* Deed of Assignment dated 1st day of 2005. Plaintiff no.1 also owns and operates the website www.hugoboss.com and also owns and maintains a website dedicated exclusively towards the Indian customer base i.e. www.hugoboss.in.

6. Plaintiff no. 1 has several exclusive retail stores in India including within the territorial jurisdiction of this Hon'ble Court wherein the plaintiff no.1's said goods are available. Additionally, the plaintiff no.1's products are sold in India on-line shopping portals / e-commerce platforms such as Amazon, Tata CliQ Luxury, Ajio, Myntra etc.

7. It is further averred that plaintiff no.2 - Zino Davidoff S.A., is a Swiss tobacco goods house founded by Henri Davidoff and family in the early 20th century. Plaintiff no. 2 expanded into perfumes, leather goods and accessories in year 1980s. The first fragrance introduced by the company was Davidoff for men in the year 1984. The Davidoff brand achieved remarkable success with the introduction of COOL WATER in the year 1988, one of the first in the Aromatic Aquatic fragrance category and often imitated by men's fragrances in the decade that followed. The Davidoff brand continues

to offer fragrances for men and women in conjunction with Coty Beauty Germany GmbH (Licensee of the plaintiff no. 2). Since the launch of first fragrance in 1984, the brand has become one of the most iconic perfume brands, including a worldwide bestseller for more than 20 years: *the legendary Davidoff Cool Water*.

8. Fragrances of plaintiff no. 2 include Cool Water Game, Cool Water Deep, Cool Water Sea Rose, Cool Water Night Dive, Cool Water Coral Reef, David Cool Water Woman, Davidoff Silver Shadow, Davidoff Hot Water and Davidoff Champion (hereinafter the term “*said products*” shall be inclusive of the goods of the plaintiff no. 2). Ever since the adoption of mark/label ‘COOL WATER’, Cool Water and other such formative mark/label having ‘COOL WATER’ as essential part (hereinafter the term “*said trademarks/labels*” shall be inclusive of the aforesaid COOL WATER marks of the plaintiff no. 2 as well), plaintiff no. 2 has been extensively using the same in relation to its said products/business.

9. Since the introduction of the said mark/label, plaintiff no. 2 has been honestly, with *bona fide* intentions, continuously, commercially, openly, exclusively, and to the exclusion of others, uninterruptedly and in course of trade and as proprietor thereof using its said trademark in relation to its said goods and business thereunder and has built up a worldwide and globally valuable trade, goodwill and reputation thereunder and has acquired proprietary rights therein. Plaintiff no. 2, in order to secure its statutory rights in the said trademarks/labels has filed various trademark applications in India. The details of the plaintiff no. 2’s registrations for the said

trademarks in Class 03 is given in para no. 23 of the plaint. The said registrations are valid, subsisting and have been renewed from time to time and are in force in favour of the plaintiff.

10. The trademarks/labels of the plaintiff include the art work involved in the plaintiff no. 2's stylized, formative labels and plaintiff holds copyright therein. plaintiff no. 2 has got the said trademarks/labels registered in all the major countries of the world and across all continents and regions. Plaintiff no. 2's said products under the said trademarks/labels are extensively advertised on television, internet, print media, and bill board worldwide. Plaintiff no. 2 is also the owner of the domain names www.coolwater.com and www.zinodavidoff.com (hereinafter the term "*said domain names*" shall be inclusive of the aforesaid websites also).

11. The plaintiffs (the plaintiff no. 1 and the plaintiff no. 2 have collectively been referred to as the "*plaintiffs*") have already built up a globally valuable trade under its said trademarks/labels and have conducted handsome business thereunder running into millions of dollars worldwide and Crores of rupees in India and by virtue thereof, the plaintiffs have acquired immense goodwill and reputation under their respective said trademarks/labels. Coty Beauty Germany GmbH is the licensee of both the plaintiffs herein for the manufacture and marketing of Class 03 products of the plaintiffs.

12. It is further submitted that the plaintiffs said goods and business are known, recognized, demanded, sold and traded world over with reference to its said trade mark. The members of the trade,

industry, consumers and general public at large world over and in India are well aware of the plaintiff's said good and business thereunder. The plaintiffs said trademark / label has become distinctive, associated and has acquired secondary significance with the plaintiff and plaintiffs said goods and business.

13. The grievance of the plaintiffs is that defendant no.1 M/s Global Perfumes Company and defendant no.2 Mr. Hammad Syed are engaged in the business of manufacturing, marketing and selling of perfumes, attar, perfumery and fragrances, cosmetics, cosmetic creams and lotions, essential oils, and other related goods and offering services in connection therewith (collectively referred to as the "*impugned goods and/or business*").

14. The defendants, in the course of their impugned business, have adopted the marks "HUGO BOSS" and "COOL WATER", (hereinafter referred to as "*the impugned marks/labels*") in relation to their impugned goods or business which are same/similar as that of the plaintiffs. It is pertinent to mention herein that the impugned marks/labels adopted by the defendants are identical and deceptively similar to that of the plaintiffs said trademarks/labels. The true representations of defendants' impugned mark/label as sold, solicited, used and displayed on the e-commerce website IndiaMART.

15. The defendants have, dishonestly and with *mala fide* intentions, adopted the impugned marks/labels in relation to identical/same goods as that of the plaintiffs. The impugned

marks/labels are entirely identical with the plaintiff's said trademarks/labels in each and every aspect including structurally, phonetically, conceptually, visually, in its basic idea, and in its essential features etc.

16. The defendants are not the proprietor of the impugned marks/labels. The defendants are using the impugned marks/labels without the leave and license of the plaintiffs. The *mala fide* intent of the defendants is evident from the fact that the defendants have copied every aspect of the said trademarks/labels of the plaintiff in relation to identical/allied goods and business.

17. By the defendants' impugned adoption and use, deception and confusion in the market is ensuing or is likely to ensue. Any person not knowing clearly the relationship between the parties or to this action is bound to be confused and deceived by the defendants' use of the impugned marks/labels. Such a person may be led into deception by the belief that the defendants are dealing with the plaintiffs or some vital links exist between the plaintiffs and the defendants or that the goods under the impugned marks/labels are emanating from the Plaintiffs' source.

18. The defendants are trying to cash in on the hard built reputation and goodwill of the plaintiff no. 1 under the said trademarks/labels 'HUGO BOSS', 'BOSS', 'BOSS HUGO BOSS', HUGO HUGO BOSS etc. and plaintiff no. 2 under the said trademarks/labels 'COOL WATER' and attempting to make illicit profits therein. The defendants are using all kind of false description on its impugned goods to wrongly link the impugned goods with the

said goods of the plaintiff and to wrongly convey to the public and customers that the impugned goods are coming from the source and origin of the plaintiffs.

19. In the last week of December, 2021, the plaintiff came across the impugned goods under the impugned marks/labels 'HUGO BOSS' and 'COOL WATER' being displayed on the e-commerce website www.indiamart.com. Thereafter, the plaintiffs caused an inquiry in the market which revealed that the defendants are selling, advertising, promoting, trading and using in course of their impugned business, the impugned goods under the impugned marks/labels as also through its physical stores as well as through the aforesaid e-commerce website www.indiamart.com across the country. The cause of action further arose when the plaintiffs, through its material investigation, came across presence/listings of defendants impugned goods on various e-commerce and interactive websites such as www.indiamart.com, www.tradeindia.com etc.

20. The defendants are selling, advertising, exposing for sale, soliciting and otherwise selling and using in the course of trade the impugned goods bearing impugned marks/labels in the markets of New Delhi viz. Connaught Place, Gole Market, Bengali Market, Chankyapuri, Mandir Marg and adjoining areas in surreptitious and clandestine manner without issuing any formal bills/cash memo. By the defendant's impugned adoption and use, deception and confusion in the market is ensuing or is likely to ensue. Thus, prayed for ex-

parte ad-interim injunction. Reliance is placed on following judgments :

- (i) Century Traders V. Roshan Lal Duggar Co. AIR 1978 Delhi 250
- (ii) Marico Limited Vs. Mr. Mukesh Kumar & Ors CS Comm 1569/2016 – judgment dted 27.08.2018
- (iii) Zino Davidoff SA Vs. AIR Couture Inc and Ors - TM no. 344/2016 – order dated 01.08.2016
- (iv) Zino Davidoff SA Vs. Ashok Kumar - TM no. 155 and 158 of 2019 – order dated 15.06.2019
- (v) Hugo Boss Trade Mark Management GmbH & Co KG Vs. Rafique Haroon Kudia & Ors – CS Comm 826/2016 – order dated 15.07.2016.

21. The Court has heard arguments advanced on behalf of the plaintiff and has perused the record with the assistance of its counsel.

22. The documents filed by the plaintiff prima facie establishes that the trademark ‘HUGO BOSS’ and ‘COOL WATER’ was registered with the Trademarks Registry pursuant to various applications. By virtue of the said registration, the trademark ‘HUGO BOSS’ and ‘COOL WATER’ is valid and subsisting trademark of the plaintiff. The photographs of the products of the defendant, which have been enclosed alongwith the plaint shows that phonetically, visually, structurally, conceptually and in its essential features, get up, make up etc., the impugned products of the defendant are deceptively similar to the products of the plaintiff.

23. From a visual comparison of the products of plaintiff and defendant, an unwary customer is likely to be deceived by formulating

an opinion that the products of defendant pertain to the plaintiff. Therefore, a strong prima facie case is made out in favour of the plaintiff. Balance of convenience also lies in its favour and it is likely to suffer irreparable loss, if ex-parte injunction is not granted in its favour as the goodwill of the plaintiff would be frittered.

24. Accordingly, the defendant(s) by themselves as also through their individual proprietors/partners, agents, representatives, distributors, assigns, heirs, successors, stockists and all others acting for and on their behalf are hereby restrained from using, selling, soliciting, manufacturing, marketing, importing, exporting, displaying, advertising, or by any other mode or manner dealing in the course of trade in the physical or online market place including by way of export and import, refilling, packaging and distributing under the impugned marks/labels 'HUGO BOSS' and 'COOL WATER' or any other word/mark which may be identical with and/or deceptively similar word/mark to the plaintiffs' said trademarks/labels in relation to their impugned goods and related goods under the plaintiffs' respective said trademarks/labels and related/allied goods and from doing any other acts or deeds amounting to or likely to infringement of plaintiffs registered trademarks/labels; passing off their goods as that of the plaintiffs; infringement of copyright in the artwork of the said trademarks/labels; indulging in falsification and unfair and unethical trade practices, till the next date of hearing.

Compliance under Order XXXIX Rule 3 of CPC be made with one week from today.

Issue summons for settlement of issues and notice of application U/o 39 rules 1 and 2 of CPC to the defendant on filing of PF, RC and through all modes of services returnable **on 18.07.2022.**

Copy of this order be given dasti to ld. Counsel for plaintiff forthwith.

(Ajay Garg)
Additional District Judge-01
PHC/New Delhi/03.02.2022