

**CS (COMM.) 228/25 M/s WELLA OPERATIONS US LLC Vs.
YASIN SHAIKH**

16.04.2025

Present: Sh. Arpit Pundir, Ld. Counsel for the plaintiff.

Arguments heard.

1 The present suit has been filed by plaintiff under Section 134 and 135 of the Trade Marks Act, 1999; Section 51 and 55 of Copyright Act, 1957 seeking permanent injunction restraining the defendant from infringement, passing off, damages, delivery up, rendition of accounts, etc. against defendants.

2 Let summons of the suit along with notice of the application u/o XXXIX Rules 1 and 2 CPC be issued to the defendants through all permissible modes on filing of PF/RC and all other modes, returnable for 13.05.2025.

3 Written statement be filed within stipulated period. Alongwith the written statement, the defendants shall also file any affidavit of admission/denial of documents of the plaintiff, without which, the written statement shall not be taken on record.

4 Along with the instant suit, the plaintiff has moved

application under Order XXXIX Rules 1 and 2, r/w Section 151 CPC as well as an application under Section 151 CPC seeking exemption from pre-institution mediation under Section 12 A of the Commercial Courts Act, 2015.

5 As the present suit contemplates, urgent interim relief, in the light of judgment of Hon'ble Apex Court in *Yamini Manohar v/s T.K.D. Keerthi*, 2023 SCC ONLINE SC 1382, exemption from requirement of pre-institution mediation is granted. Application moved by plaintiff under Section 12 A of Commercial Courts Act, 2015 stands disposed off.

6 The plaintiff has also filed an application under Order XI Rule 1 (4) of the Commercial Courts Act seeking leave to file additional documents. The plaintiff is permitted to file additional documents in accordance with the provisions of Commercial Courts Act. Accordingly, the application is disposed off.

7 The plaintiff has also moved two another applications, one under Section 151 CPC for seeking exemption from carrying out advance service upon defendants and second, under Section 80 (2) of CPC read with Section 151 CPC seeking exemption from service notice to National Internet Exchange of India i.e. defendant no.4 herein.

8 Ld. Counsel submits that due to urgency involved in the

matter, the plaintiff has moved the afore-stated applications and prays that the same may be allowed.

9 Submissions heard. In view of the submissions and reasons mentioned in the application, same is allowed and plaintiff is exempted from serving prior notice of two months to defendant no.4 as required u/s. 80(1) of CPC.

10 An application u/s. 151 of CPC seeking exemption from filing original, clear and legible documents with proper margin.

11 Considering the submissions and facts mentioned in the application u/s. 151 of CPC, the application is allowed with directions to the plaintiff to file original documents at the earliest but in any case, prior to the settlement of the issues.

12 Ld. Counsel for the plaintiff pressed for grant of *ad-interim ex-parte* injunction restraining the defendant from using trademark OPI, O.P.I, The OPI NailBar, the OPI Nail Saloon and Nailbaropi or any other trademark/trade name which is similar to that of plaintiff's OPI. Ld. Counsel for the plaintiff submits that the plaintiff has also moved an application for appointment of Local Commissioner under Order XXVI Rule 9 CPC but he is not pressing for the same.

13 Ld. Counsel for plaintiff submits that plaintiff, a Limited

Liability Company, is engaged in business of manufacturing, marketing and selling of wide range of cosmetic products, fragrances, soaps, perfumery, essential oils, hair lotions, conditioning and embellishing, salon exclusive colour treatments, styling and other allied and cognate products as also providing professional services for beauty, make up, hair care, services air dresses, services of beauty parlour, professional consultancy in field of beauty care via internet as also in providing services of education, training, in the fields of hair dressing and cosmetics and several other allied/cognate as well as related services.

14 Ld. Counsel for plaintiff inviting attention to the history of plaintiff submits that in 1981, OPI, which was originally called “Odontorium Products Inc” was founded by George Schaeffar in Los Angeles, USA who was later on joined by his co-founder Suzi Weiss-Fischmann, also known as “the First Lady of Nails”. In Year 1989, OPI extended its portfolio from Nail Lacquers to other nail products. Subsequently, in year 2010, the OPI brand was acquired by French multinational Coty Inc. However, in the year 2020, during the split of plaintiff, from Coty Inc, OPI was acquired by plaintiff.

15 Ld. Counsel further submits that plaintiff established and adopted the trademark OPI /O.P.I in relation to acrylic nails, nail lacquers and other nail products and allied/cognate goods as well as related services. In year 2017, the plaintiff launched its products in India. Since then, the plaintiff has been honestly, with *bonafide*

intention, extensively, exclusively, continuously, commercially and in course of trade, using the said trademark in connection with its said goods and services. Its trademark has garnered the reputation of a well known trademark within the meaning of Section 2 (1) (zg) of the Trade Marks Act, 1999. The plaintiff has duly registered its trademark in India as per details contained in para 10 of the plaint and the said registrations are valid, legal and subsisting in law. The plaintiff has also devised and adopted unique packaging and trade dress and original artwork for such packaging material in relation to its said trademark and also holds copyright therein. With the advent of internet and e-commerce and trade thereunder, the plaintiff's said goods and business under the said trademark/label are also advertised, solicited and promoted through its own website <https://www.opi.com>. The plaintiff's said trademark/label in respect of its OPI products is distinguishable from its overall look, get up and aesthetic. It is also carrying its business activities under its said trademark/label at various third party platforms/market places like <https://sephora.in/>, www.purple.com, www.nykaa.com, www.amazon.in and www.myntra.com. The purchasing public, trade and industry at large worldwide and in India identify and distinguish the said goods under the said trademark/label with the plaintiff and associate the source and origin alone with plaintiff. It is stated that by virtue of common law rights within the said trademark/label, its goodwill and reputation and its copyrights, there is an exclusive right to use thereof and nobody can be permitted to use the same or any other deceptively similar trademark/trade dress/copyrights thereto in any manner whatsoever in

relation to any specification of goods without the leave and license of the plaintiff.

16 Ld. Counsel further submits that defendant no.1 is engaged in business of offering nail care services and services in connection therewith via its physical store outlet bearing storefront



name as The O.P.I Nails Bar/ (referred to as ‘impugned trade name’) and also promoting, advertising, marketing and soliciting its impugned services via its domain names <https://nailbaropi.in/> and <https://theopinailssalon.godaddysites.com/>. It is further alleged that defendant no.1 is engaged in same/similar business to that of plaintiff and is using OPI mark/label as well as OPI formatives (hereinafter referred to as ‘impugned mark/label’) on its storefront/signboard, tags, bill books and promotional material such as bill boards and visiting cards.

17 Ld. Counsel further submits that defendant no.2 i.e. GoDaddy.com, LLC is the Registrar of the impugned domain names <https://nailbaropi.in/> and <https://theopinailssalon.godaddysites.com/>. Further, defendant no.2 is unlawfully allowing the registration of various domain names incorporating the mark ‘OPI’ as a prominent and/or distinctive element.

18 Ld. Counsel further submits that defendant no.3 is the owner and proprietor of Gmail and it is in possession of the

information contained within the e-mails exchanged/transferred during the course of impugned activities by the defendant no.1 using the email theopinailsbarpune@gmail.com on a daily basis.

19 Defendant no.4 is the National internet Exchange of India. The Government of India delegated the operations of INRegistry to NIXI in 2004. The INRegistry operates and manages India's '.IN' ccTLD.

20 Ld. Counsel for plaintiff further submits that defendant no.1 has dishonestly and in a *mala fide* manner adopted the impugned trademark/label/trade name/domain name as well as the artwork thereof, being inspired by the said trademark/label/artwork of the plaintiff and started using same in relation to their impugned services without the due consent of plaintiff. The plaintiff, in the first week of January, 2025, during its routine internet searches, came across the impugned domain name <https://nailbaropi.in/> of defendant no.1. Thereafter, from further investigations, it was revealed that defendant no.1 is also operating under another domain name i.e. <https://theopinailssalon.godaddysites.com/> and maintaining a physical storefront. Further, plaintiff's online search revealed that the defendant no.1 is having an account on website Justdial whereof the



impugned OPI and the OPI Nail Bar/ marks/labels are being reflected wherefrom the defendant no.1 is marketing,

advertising, promoting, soliciting and offering the impugned services to prospective consumers under the impugned trade name. It is also found that defendant no.1 is operating and having an account on social media platform i.e. Instagram (<https://www.instagram.com/theopinailsbar/>). Further, plaintiff came across the email id i.e. theopinailsbarpune@gmail.com and the mobile number of defendant no.1 which show that defendant no.1 is using OPI wordmark in the impugned email address as well.

21 Ld. Counsel for plaintiff further stressed that defendant no.1 is using the impugned mark/label inside the premises of the physical store front on the bill boards, sign boards, hoardings, promotional materials, bills, posters, visiting cards etc to deceive the consumers and prospective consumers into believing that defendant no.1 is having association with plaintiff or that the impugned services are authorized by plaintiff, which in fact is not the case. The defendant no.1 had adopted and has been using the impugned marks/labels/trade name in the course of its trade and business, wherein the word 'OPI' is forming a dominant and essential part /feature of the impugned marks/label in relation to impugned services. The defendant no.1 has no right or legitimate interest with respect to the use of plaintiff's said trademark/label O.P.I as a part of impugned domain names, which are identical and/or deceptively and confusingly similar to the said trademark/label and said domain name of the plaintiff. Ld. Counsel for plaintiff has also invited attention to the documents annexed screen shots of the impugned domain name

<https://nailbaropi.in/> of the defendant no.1 showing features to allow the consumers to create an account, book an appointment, manage bookings and inquiry form, same are shown at para 35 of the plaint. Aggrieved by the dishonest and unauthorized adoption of its well-known trademark by defendant no.1, the plaintiff served a cease and desist letter dated 03.01.2025, upon the defendant no.1 calling them to immediately cease and desist from using the impugned mark/label 'OPI' from all platforms, including but not limited to its impugned trade name, domain name, storefront catalogues, brochures, invoices and social networking platforms. The plaintiff received a response from defendant no.1 which was evasive. The defendant no.1, however, after reminder continued use of impugned trademark.

22 I have considered submissions made by Id. Counsel for plaintiff and gone through the record. After going through the photographs of storefront/signboard and other material, it *prima facie* appears that defendant no.1 has adopted impugned mark/label 'OPI' to its impugned trade name, domain name, storefront, social networking platforms etc. Given the similarities in the marks, the overlap in market demographics, and the potential for confusion, *prima facie* case is made out and balance of convenience lies in favour of plaintiff and in case the protection is not granted against the defendant no.1's action, irreparable loss would be caused to the plaintiff.

23 Consequently, till the next date of hearing, the defendant

no.1 by itself as also through its individual proprietor, agents, representatives, distributors, assigns, heirs, successors, stockists and all other acting for and on its behalf are restrained from using, selling, soliciting, manufacturing, marketing, displaying, advertising, promoting or by any other mode or manner dealing with the impugned services under the impugned marks/labels/trade name OPI, O.P.I, The OPI Nail Bar, The OPI Nails Salon & nailbaropi or any other word/mark/label/trade name which may be identical with and/or deceptively similar to the plaintiff's said trademarks/labels which may result in infringement of plaintiff's registered trademarks/labels.

24 Further, defendant no.2 is restrained from allowing the registration of any domain names incorporating the mark 'OPI' as a prominent and/or distinctive part, in any manner that infringes upon the plaintiff's proprietary rights, misleads consumers or dilutes the plaintiff's goodwill and reputation till further orders.

25 Further, defendant no.3 is directed to block/disable the impugned email id i.e. theopinailsbarpune@gmail.com and/or any other email id any word / mark / trademark/label which may be identical with and/or deceptively similar to plaintiff's trademarks/labels.

26 Plaintiff has to comply with provisions of Order XXXIX Rule 3 CPC within one week. The defendant will be at liberty to apply for modification and vacation of the order, if required.

-11-

27 Put up on 13.05.2025.

VINEETA GOYAL
District Judge (Commercial Court-03)
PHC / New Delhi / 16.04.2025