



\$~47

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

+ CS(COMM) 1098/2024 & I.A. Nos. 47628/2024, 47629/2024,
47630/2024, 47631/2024, 47632/2024 & 47633/2024

YKK CORPORATIONPlaintiff

Through: Mr. Gaurav Gogia with Mr. Rishi
Bansal and Mr. Mayank Saraf,
Advocates.

versus

KC SAPRA & ORS.Defendants

Through: None.

CORAM:
HON'BLE MS. JUSTICE MINI PUSHKARNA

ORDER
09.12.2024

%

I.A. 47630/2024 (Exemption from filing clear copies of documents)

1. The present is an application under Section 151 of the Code of Civil Procedure, 1908 ("CPC"), on behalf of the plaintiff, seeking exemption from filing clear/legible copies, English translation of vernacular documents and documents with proper margins.
2. Exemption is granted, subject to all just exceptions.
3. Plaintiff shall file legible, clear, and translated copies of the documents, on which the plaintiff may seek to place reliance, before the next date of hearing.
4. Accordingly, the present application is disposed of.

I.A. 47631/2024 (Exemption from instituting Pre-Institution Mediation)



5. The present is an application under Section 12A of the Commercial Courts Act, 2015, read with Section 151 of CPC, seeking exemption from undergoing Pre-Institution Mediation.

6. 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.

7. Accordingly, the application stands disposed of.

I.A. 47629/2024 (Exemption from advance service to the defendants)

8. The present is an application under Section 151 CPC, seeking exemption from advance service to the defendant.

9. The plaintiff seeks urgent interim relief, and has also sought appointment of Local Commissioners. Therefore, in the peculiar facts and circumstances of this 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.

I.A. 47632/2024 (Application seeking leave to file additional documents)

11. This is an application under Order XI Rule 1(4) read with Section 151 CPC as amended by the Commercial Courts Act, 2015, seeking leave to file additional documents.

12. The plaintiff, if it wishes to file additional documents at a later stage, shall do so strictly as per the provisions of Commercial Courts Act, 2015 and the Delhi High Court (Original Side) Rules, 2018.



13. The application is disposed of, with the aforesaid directions.

CS(COMM) 1098/2024

14. Let the plaint be registered as suit.

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

16. 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 defendants, 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.

17. List before the Joint Registrar (Judicial) for marking of exhibits, on 30th January, 2025.

18. List before the Court on 30th April, 2025.

I.A. 47628/2024 (Application under Order XXXIX Rules 1 and 2 CPC)

19. The present suit has been filed under Sections 134, 135, 27 and 29 of the Trade Marks Act, 1999 read with Sections 51 and 55 of the Copyright Act, 1957 for permanent injunction restraining the defendants from infringing and passing off of the plaintiff's trademark, damages, rendition of accounts etc.

20. Learned counsel appearing for the plaintiff submits that ever since its



bonafide adoption of the Trade Mark YKK in the year 1946, the plaintiff has been using the said YKK trademarks word *per se* and in a stylized manner in relation to its said goods and business in the course of trade. An illustrative representation of the goods of the plaintiff bearing the said trademark, is reproduced as under:



21. It is submitted that in order to obtain statutory protection and safeguard their inherent proprietary rights, the plaintiff has registered the word/mark/label/device YKK trademarks in relation to the said goods and



business, under the relevant classes globally, including, in India.

22. It is further submitted that the plaintiff's said trademark "YKK" has been registered in 177 countries and regions across the world, while YKK fastening products are currently sold in 71 countries and regions worldwide, including, in India. In addition to maintaining a robust trademark portfolio, the plaintiff's YKK Group actively obtains other intellectual property rights such as patents, utility models, and design patents in various jurisdictions. The said registrations are legal, valid, and subsisting on the registers of the respective countries.

23. It is further submitted that the plaintiff has coined and adopted the trademark 'YKK' honestly and in a *bona fide* manner and has been using the same openly, extensively and continuously since then, in relation to the said goods uninterruptedly and to the exclusion of others. The plaintiff has devised and adopted unique packaging and original art works for such packaging material in relation to its said goods and business, one of which is being reproduced under:

REPRESENTATION OF THE PACKAGING
DEvised BY THE PLAINTIFF.





24. It is submitted that the above packaging has a unique art work whereunder the background is yellow in color and the trademark YKK in a stylized font and size is depicted in black color, followed by a prominent tag line “put a zip in your style” in orange and black color, under which the blue color zip appears in a prominent manner, and under which the description “New Design” is followed by “Autolock Zipper For Trousers CINC – 36”. It is submitted that all the features when placed together are a unique artwork of the plaintiff and constitute the plaintiff’s said trade-dress. The relevant industry and trade recognize the plaintiff’s said trade-dress with the overall appearance, get-up, and unique layout of the packaging, which is associated with none other than the plaintiff.

25. It is further submitted that the artworks involved in the plaintiff’s said trademark/label as well as packaging, including, the packaging, are original artistic works of the plaintiff, and the plaintiff is the owner and proprietor of the Copyright therein. The plaintiff has the exclusive rights to deal with the said trademark/label/packaging and has been so dealing with them in the course of trade in relation to its said goods and business, *inter-alia*, within the meaning of Section 14 of the Copyright Act 1957.

26. It is submitted that the plaintiff’s goods and business under the said trademark/label have acquired tremendous goodwill and enviable reputation in the markets and the plaintiff has already built up a handsome and valuable trade there under. Further, the plaintiff thereunder has already commanded handsome sales running into Millions of Yen globally and running into crores of rupees in India

27. It is further submitted that the plaintiff maintains the highest standard of quality in relation to its goods and business under the said



trademark/label. The plaintiff invests heavily in the research and development of its products, which are known for their highest standards of quality, safety, innovation, and reliability.

28. It is submitted that the plaintiff's said trademark/label/trade dress has therefore acquired distinctiveness and it's said goods and business under the said trademark, are associated with none other than the plaintiff. The purchasing public, the trade and industry worldwide and in India identify and distinguish the plaintiff's said goods bearing the said trademark/label/trade dress with the plaintiff and from the plaintiff's source and origin alone and regard them as a high-quality product exclusively as that of the plaintiff.

29. It is further submitted that the defendants are engaged in the business of manufacturing, distributing, selling, soliciting and dealing in *inter alia*, fasteners and zippers bearing the mark/labels YKK/GKK/BKK/



including its formatives and variants. It is submitted that the impugned trademarks/labels are a slavish copy and an imitation of the plaintiff's said trademarks/labels. It is submitted that the defendants are operating without the leave and license of the plaintiff. It is further submitted that the defendants are indulged in rank counterfeiting of the said goods of the plaintiff bearing the said trademarks/labels, which are identical to the genuine zippers of the plaintiff, as well as infringing YKK zippers under the brands BKK, GKK, etc. which bear a high degree of deceptive similarity to that of the plaintiff's said trademarks and plaintiff's said goods and business thereunder.



30. It is submitted that the plaintiff came across the impugned goods of defendant no. 2 in November 2023, and on conducting investigation against the aforesaid defendant for a few months, as well as through various enquiries in the market and the illicit trade of the impugned goods, the plaintiff, in the months of February and August 2024, learnt about the involvement of the defendant nos. 1 and 3 in relation to the impugned goods and business under the impugned trademarks/labels. He submits that the defendants are carrying their impugned business under the impugned trademark/labels in a clandestine and surreptitious manner without issuing formal sales bills/invoices in various markets of Delhi.

31. It is further submitted that the plaintiff has carried out an online public search on 11th November, 2024 on the website maintained by the Indian IP Office in Classes 8 and 26 for the marks BKK and GKK, and the plaintiff did not come across any search results for any Trademark application(s) filed in the name of any of the defendants for the said marks BKK and/or GKK, both in Classes 8 and 26.

32. It is submitted that the dishonesty in the adoption of the impugned marks/labels by the defendants are writ large and cannot exist except by way of a deliberate imitation of the plaintiff's said trademarks/labels. In addition, the defendants have also copied the font style, the font size, arrangement of text on the packaging, color combination, placement, get up, layout and other essential features of the plaintiff's said trademark/label/trade dress, which are identical to that of the plaintiff. A side-by-side comparison of the defendant's impugned marks and impugned goods/packaging with that of the plaintiff, is reproduced as under:



Comparison of the marks as used by the Plaintiff and the Defendants	
PLAINTIFF	DEFENDANTS
	
	
	



Comparison of the packaging of the Plaintiff and the Defendants	
PLAINTIFF'S PACKAGING	DEFENDANTS PACKAGING



33. It is further submitted that the defendants are using deceptively similar variations of the said trademarks and trade-dress of the plaintiff only with the intent of deceiving the consumers into believing that there exists some vital link of the defendants with the plaintiff or that the goods of the



defendants originate from the plaintiff's source. Therefore, he submits that on a visual appearance of the defendant's impugned packaging, an ordinary unwary consumer with average intelligence and imperfect recollection, is bound to be deceived into believing that he is purchasing the goods of the plaintiff or is somehow related to the plaintiff, which in fact is not the case. He submits that the defendants are operating in similar trade channels catering to the exact same category of consumers and end-user customers. Therefore, the possibility of consumer deception and confusion is higher and more prevalent.

34. It is submitted that the defendants have dishonestly adopted identical/deceptively similar mark/label/trade dress, as that of the plaintiff's said trademarks/label/trade dress in relation to their counterfeit and pirated impugned goods and business activities. The impugned marks/label/trade dress are identical with the said trademarks/label/trade dress of the plaintiff in each and every aspect, including, structurally, phonetically, conceptually, visually, artistic features, in its basic idea, its essential features, etc.

35. It is further submitted that the impugned adoption of the impugned marks, as well as the impugned packaging by defendants, is dishonest, tainted, ill-motivated, and disseminating confusion and deception. The defendants are trying to cash in on the hard-built reputation and goodwill of the plaintiff under the said trademarks/logo and making illicit profits and easy money.

36. It is submitted that the defendants' impugned goods are a stark imitation of plaintiff's goods/products and the same are sold to the general public at a quality, which is lower than that of the plaintiff. The impugned distribution of the impugned goods of low quality products under the name



and style of the plaintiff's trademark/label or its deceptively similar variants is detrimental to the distinctive character and repute of the plaintiff.

37. In the above circumstances, the plaintiff has demonstrated a *prima facie* case for grant of injunction and, in case, no *ex parte ad interim* injunction is granted, the plaintiff will suffer an irreparable loss. Further, balance of convenience also lies in favour of the plaintiff, and against the defendants.

38. Accordingly, till the next date of hearing, the defendants by themselves, as also through its individual proprietors/partners, agents, representatives, distributors, assignees, heirs, successors, stockists and all others acting for and on their behalf, are 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 mark/label/trade

dress YKK/GKK/  or any other variants, which may be identical with and/or deceptively similar word/mark to trademark/label/trade dress of the plaintiff, i.e., YKK, which may amount to infringement of the plaintiff's registered trademarks/labels; infringement of the plaintiff's copyrights/labels; Passing off and violation of the plaintiff's common law rights in the plaintiff's trademarks/labels/ trade name and violation of the plaintiff's rights in the plaintiff's trade name; including falsification, unfair and unethical trade practices.

39. Issue notice to the defendants by all permissible modes upon filing of



the Process Fee, returnable on the next date of hearing.

40. Let reply be filed within a period of four weeks.

41. Rejoinder thereto, if any, be filed within two weeks, thereafter.

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

43. List before the Court on 30th April, 2025.

I.A. 47633/2024 (Application for appointment of Local Commissioners)

44. The present application has been filed on behalf of the plaintiff under Order XXVI Rule 9 and Order XXXIX Rule 7 CPC, read with Section 151 CPC, seeking appointment of Local Commissioners.

45. It is submitted that in order to preserve evidence of infringement, it is necessary that Local Commissioners be appointed to visit the premises of the defendants.

46. Accordingly, the following directions are issued:

I. Ms. Santosh Kohli, Advocate (M: 9958323029), is appointed as Local Commissioner, with a direction to visit the following premises of the defendant no. 1:

***5/53, Block No. 5,
Pyare Lal Road,
Dev Nagar,
Karol Bagh, New Delhi-110005***

II. Ms. Dimple Aggarwal, Advocate (M: 8882649853), is appointed as Local Commissioner, with a direction to visit the following premises of the defendant no. 2:

***CN-255, Gali no. 1,
Gali Peepli Wali,
Kumhar Wali Gali, Rampura, Delhi-110035
also at L-107/C, Shastri Nagar, Ashok Vihar, Delhi-110052***



III. Mr. Himanshu Goel, Advocate (M: 9810215487), is appointed as Local Commissioner, with a direction to visit the following premises of the defendant no. 3:

**422/6 and 422/8,
Upper Anand Parbat, Near Post Office,
New Delhi-110005**

IV. The learned Local Commissioners, along with a representative of the plaintiff and its counsel, shall be permitted to enter upon the premises of the defendants mentioned hereinabove, or any other location/premises, that may be identified, during the course of commission, in order to conduct the search, and seize the infringing products, or any other mark that may be identical to or deceptively similar to the plaintiff's registered trade mark.

V. After seizing the infringing material, the same shall be inventoried, sealed, and signed by the learned Local Commissioners, 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.

VI. The learned Local Commissioners 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.

V. Further, the learned Local Commissioners shall be permitted to undertake/arrange for photography/videography of the execution of the commission.

VII. Both the parties shall provide assistance to the learned Local Commissioners, for carrying out the aforesaid directions.



VIII. In case, any of the premises are found locked, the learned Local Commissioners shall be permitted to break open the lock(s). To ensure an unhindered and effective execution of this order, the Station House Officers (“SHOs”) of the respective local Police Stations, are directed to render all assistance and protection to the Local Commissioners, as and when, sought.

IX. The fee of the learned Local Commissioners, to be borne out by the plaintiff, is fixed at ₹ 1,00,000/- (Rupees One Lakh) each. The plaintiff shall also bear all the expenses for travel of the Local Commissioners and other miscellaneous out-of-pocket expenses, for the execution of the commission. The fee of the Local Commissioners shall be paid in advance by the plaintiff.

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

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

48. In terms of the foregoing, the present application stands disposed of.

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

MINI PUSHKARNA, J

DECEMBER 9, 2024

C