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IN THE HIGH COURT OF DELHI AT NEW DELHI

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CS(OS) 827/2015 & I.A. 6225/2015

**HUGO BOSS TRADE MARK MANAGEMENT
GMBH & CO. KG.**

.... Plaintiff

Through: Mr. Prashant Gupta and Mr. Arzu
Chimni, Advocates.

versus

SUBHASHBHAI

..... Defendant

CORAM: JUSTICE S. MURALIDHAR

ORDER

15.09.2016

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1. This suit by Hugo Boss Trade Mark Management GmbH & Co. KG. (Plaintiff) is directed against Subhashbhai (Defendant) seeking permanent injunction to restrain the Defendant from infringing the Plaintiff's trademarks, for damages, costs, and delivery up etc.

2. Summons in the suit and notice in the application were issued on 25th March, 2015. The relevant portion of the said order reads as under:

"IA No.6225/2015 (Stay)

Issue notice through Ordinary Process, Speed Post and Courier, returnable before the Court on 22.07.2015.

The plaintiff claims to be the owner of trade mark 'BOSS' in Class 3 of the Schedule to the Trade Marks Act for perfumes and cosmetics. Its trade mark 'BOSS' was registered in India in the year 1988 and is otherwise registered in over 100 countries. Its global annual turnover stated to be 2.5 billion Euros. It has 6880 sale points all over the world and 1200 outlets across the globe. Its annual expenditure on promotion of its brand is as under:

YEAR	AMOUNT (in thousand Euros)
2009	487,883
2010	574,430
2011	682,155
2012	808,688
2013	891,588
2014	994,861

It has also sponsored various international sporting events in which their logo and trade mark 'BOSS' is displayed on the clothes and other paraphernalia of the events. It has also advertised its brand and products in various magazines all over the world. The defendants are selling their perfumes under the trade mark 'BOSS' although with an addition, i.e., 'Ramdev'.

The learned counsel for the plaintiff submits that this clearly amounts infringement of the plaintiffs trade mark and seeks an ad interim protection against the same.

This Court is of the view that the plaintiff has made out a prima facie case for an *ad interim ex parte* injunction and in case such an *ex parte ad interim* order is not granted at this stage, irreparable prejudice would be caused to the plaintiff. The balance of convenience too is in favour of the plaintiff.

In the circumstances, till the next date of hearing, the plaintiff is granted an *ad interim ex parte* injunction in terms of prayer (i) made in the application.

Compliance under Order XXXIX, Rule 3 of the CPC shall be done by the plaintiff within two weeks.”

3. Thereafter, the affidavit of service was filed also by the Plaintiff. The Defendant filed an affidavit on 29th July 2015 stating that the Defendants “USING ONLY SHREE RAMDEV MARK IN OUR PRODUCTS AND THE WORD "BOSS" WE DELETE AND withdrawn by US from OURFACEBOOK the date of withdrawal we are not using the above mentioned WORD "BOSS" name”. However subsequently on 8th January

2016, the Court set the Defendant *ex parte* since he failed to appear despite service.

4. The Plaintiff then filed an affidavit of *ex parte* evidence of Mr. Shailyamanyu Singh (PW-1) on 18th April, 2016.

5. The uncontroverted facts emerging from the affidavit of PW-1 are as under:

(i) The Plaintiff Company is organised and existing under the laws of the Federal Republic of Germany having its registered office at the address at the address Dieselstraße 12, 72555 Metzingen, Germany. A true and correct copy of the English translation of the certificate evidencing registration of the Plaintiff as a company under the laws of Germany is marked as **Mark B**.

(ii) The origin of the Plaintiff Company goes back to the year 1924 when Mr. Hugo Ferdinand Boss started his clothing company in Metzingen, a small town south of Stuttgart, where it is still based. Since that time, the Plaintiff has extensively diversified its business from high fashion clothing to accessories, footwear and fragrances.

(iii) The mark HUGO BOSS was first adopted by the Plaintiffs predecessor in title as its business name in May 1948, when the company HUGO BOSS GmbH was incorporated in Germany. This company went public on June 27, 1984, where after its name was changed to HUGO BOSS AG.

(iv) In the same year, the earliest edition of the Plaintiff's BOSS perfumes was created. Since then, the Plaintiff 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, 'BOSS' Marks).

(v) The BOSS Marks have been continuously and uninterruptedly used by the Plaintiff since 1924 and products bearing the BOSS Marks are currently being sold in 129 countries around the world including but not limited to India, Australia, Austria, Benelux, Brazil, Canada, Chile, China, France, Germany, Great Britain, Hong Kong, Ireland, Italy, Japan, Mexico, Russia, Spain, Sweden, Switzerland, Taiwan and USA.

(vi) There are a total of around 1,200 stores and shop-in-shops operated by franchisees. The Plaintiff's perfumes under the BOSS Marks are available at leading stores around the world including Bloomingdales, Macy's, Kaufmanns and Lord & Taylor, to name only a few as well as, at leading duty free shops at most major airports around the world including international airports in Hong Kong, Indonesia, Korea, Malaysia, The Philippines, Singapore, UAE in Asia, Cyprus in East Europe and Austria, Croatia, Denmark, Finland, France, Great Britain, The Netherlands, Norway, Switzerland and Iceland in Europe and Mexico in South America. A significant number of Indians travelling out of India or foreigners travelling into India pass through these airports where they are exposed to the Plaintiff's products sold under the BOSS Marks.

(vii) In India, the Plaintiff's products under the BOSS Marks have been available since at-least 1991 in various distinctive packaging. A representation of one of such packaging of the Plaintiff's BOSS perfume is exhibited as **Exhibit PW-I/3**.

(viii) Today, the Plaintiff has several exclusive retail stores in India

wherein the Plaintiff's products including their perfumes are available. A list of these exclusive stores is set out in para 11 of the affidavit. A few print-outs from the internet consisting of information about the Plaintiff's exclusive stores in India are collectively exhibited as **EX PW-I/4 (Colly.)**. Further an original invoice pertaining to the purchase of the Plaintiff's product bearing the mark BOSS in Delhi is exhibited as **EX PW-I/5**. Additionally, copies of a few invoices evidencing sale of the Plaintiff's Hugo Boss perfumes in India are collectively exhibited as **EX PW-I/6 (Colly.)**.

(ix) The Plaintiffs products bearing the BOSS Marks are also sold extensively throughout India in leading departmental stores such as Lifestyle, Shoppers Stop, Ebony, Globus, Life Springs and Pall Mall etc. Additionally, the Plaintiffs products are sold in India through on-line shopping portals.

(x) The Plaintiff has aggressively marketed and promoted its products under the BOSS Marks through advertisement in magazines, newspapers, periodicals, organizing exhibitions, sponsorships of international events, retail marketing, etc. Also, the BOSS products have been extensively advertised in all major international magazines, including TIME, Newsweek, Fortune, The Economist, The Business World, Executive, Vogue, GQ, Forbes, Business, Vanity Fair and HARPER'S & Queen etc. All these magazines are widely circulated and read in India. The Plaintiffs worldwide expense towards marketing and promotion are set out in para 14 of the affidavit. Further, in India the Plaintiff has advertised its products under the BOSS Marks in leading Indian magazines and newspapers. The publication expenses incurred by the Plaintiff in India since November 2003 till March 2012 are in the region of Rs.8,16,733. In

addition to this, the BOSS Marks are also frequently advertised on various television and satellite channels in India.

(xi) Further the goodwill and reputation of the products sold under the BOSS Marks of the Plaintiff can be gauged by its worldwide sales which are set out in para 13 of the affidavit. The true and correct copies of the relevant extracts from the Annual Reports pertaining to the Plaintiff evidencing its worldwide sales and advertising figures are collectively exhibited as **EX PW-I/8 (Colly.)**.

(xii) The Plaintiffs substantial sales under the BOSS Marks in India demonstrate the extent of its goodwill and reputation, which are set out as below:

YEAR	AMOUNT
2007	674,324 BUR
2008	1,044,089 EUR
2009	2,477,744 EUR
2010	1,239,303 EUR
2011	1,490,153 EUR

(xiii) In addition to the above, the Plaintiff has been sponsoring various national and international events which have widespread reach and are extremely popular in India, such as the Davis Cup Tennis Tournament, Formula One and Champ Car, skiing, football and golf etc. which are widely covered and relayed in India. Further, motor sports have been sponsored by the Plaintiff since 1972 and McLaren since 1984. The Plaintiff is also the Official Formal Wear Supplier to the England Cricket Team with HUGO BOSS Fragrances and Skincare (the Official Fragrance and Skincare Partner of the England Cricket Team and ECB).

The Plaintiff also organized "DRESS ME FOR THE FINALE" design competition during the first ever Formula 1 Grand Prix held in Delhi, India. These events have been widely covered in leading national newspapers and periodicals. The photocopies of these articles along with a few print-outs from the internet and photographs evidencing events sponsored by the Plaintiff are collectively exhibited as **EX PW-I/9 (collectively)**.

(xiv) With a view to secure its trademark rights in the BOSS Marks, the Plaintiff has obtained registration and/or have pending applications in many countries around the world including, but not limited to, Australia, Austria, Benelux, Canada, China PR, Czech Republic, Denmark, Egypt, Finland, France, Germany, Great Britain, Hong King, India, Ireland, Italy, Japan, Korea, Mexico, New Zealand, Norway, Philippines, Portugal, Romania, Russia, Saudi Arabia, Singapore, Spain, Sweden, Switzerland, Taiwan, Thailand and USA, to name only a few. A list of the Plaintiffs worldwide registrations for the BOSS marks updated as of 2013 along with true and correct copies of a few certificates are collectively marked as **Mark C (Colly.)**.

(xv) In India, the Plaintiff is the registered proprietor of the BOSS Marks in various classes including class 3, 9, 14, 18, 25 & 35. The details of the Plaintiff's registrations for BOSS Marks in class 3, which is the relevant class for the present proceedings, are as follows:

S. No.	Trade Mark	Reg. no./ Date	Status
1.	BOSS	502837/ 23-12-1988	Registered and renewed up till 23-12-2019.
2.		610824/ 01-11-1993	Registered and renewed up till 01-11-2023.
3.	BOSS AQUA	766732/ 21-08-1997	Registered and renewed up till 21-08-2017.
4.	DARK BLUE HUGO HUGO BOSS	878574/ 27-09-1999	Registered and renewed up till 27-09-2019.
5.	BOSS IN MOTION	1135901/ 24-09-2002	Registered and renewed up till 24-09-2022.
6.	BOSS INTENSE	1201610/ 27-05-2003	Registered and renewed up till 27-05-2023.
7.	HUGO BOSS 	1282055/ 05-05-2004	Registered and renewed up till 05-05-2024.
8.	BOSS SKIN	1326542/ 17-12-2004	Registered and renewed up till 17-12-2024.

(xvi) All the aforesaid registrations are valid, subsisting, have been renewed from time to time, and are in force in favour of the Plaintiff. The legal proceeding certificates in respect of the marks under Nos. 502837 and 610824 are exhibited as **EX PW-I/11** to **EX PW-I/12**. The true and correct copies of the registration certificates along with their status as accessed and printed from the online records of the Trade Marks official website in respect of the registration Nos. 766723, 878574, 1135901, 1201610, 1282055 and 1326542 are filed herewith and are exhibited as **EX PW-I/12A** to **EX PW-I/17**, respectively.

(xvii) By virtue of Deed of Assignment dated 23rd December 2004, the aforesaid registrations were assigned from Eurocos Cosmetics GmbH to Hugo Boss AG in January 12, 1996 and thereafter from Hugo Boss AG, in favour of Hugo Boss Trade Mark Management GmbH & Co. KG., the Plaintiff herein, on December 23, 2004. The true and correct copies of the

Deed of Assignments assigning the trademarks under registration nos. 766723, 878574, 1135901, 1201610, 1282055 and 1326542 from Eurocos Cosmetics GmbH to Hugo Boss AG and thereafter from Hugo Boss AG, in favour of Hugo Boss Trade Mark Management GmbH & Co. KG along with the requests filed before the Registrar of Trade Marks are exhibited as **EX PW-I/18 to EX PW-I/19.**

(xviii) The Plaintiff also owns and operates the website www.hugoboss.com. Furthermore, the Plaintiff also owns and maintains a website dedicated exclusively towards the Indian customer base, i.e. www.hugoboss.in which provides details and location of its various stores in India. Moreover, the Plaintiff currently has online stores in Germany, the Netherlands, France, the UK, Austria, Switzerland and the United States. The Print-outs from the afore-mentioned websites are collectively exhibited as **EX PW-I/20 (Colly.).**

(xix) The trademark offices in several countries, such as Venezuela, France and China, have recognized the marks HUGO BOSS and BOSS as "well-known". Further, the Plaintiff has been protecting its BOSS Marks in other jurisdictions by taking necessary action such as issuing cease and desist notices, filing oppositions, suits etc. The true and correct copies of a few such orders obtained by the Plaintiff worldwide are collectively exhibited as **EX PW- I/21 (Colly.).** Additionally, true and correct copies of a few favourable orders obtained by the Plaintiff in India are collectively exhibited as **EX PW-I/22 (Colly.).**

(xx) Sometime in July, 2014, the Plaintiff became aware of the unauthorized use of its registered trademark 'BOSS' in relation to perfumes. Enquiries revealed that it was the Defendant, who was engaged in the business of manufacturing and supplying of perfumes inter-alia

those bearing the mark "BOSS". The Defendant was also found to have another office at M/s. Shreenathji Novelties Perfumes. A representation of sample packaging of the Defendant's product is exhibited as **EX PW-I/23**. The original visiting card of the Defendant is exhibited as **EX PW-I/24**.

(xxi) The Plaintiff soon learnt that the Defendant also maintains a social media profile page on the social networking website- www.facebook.com. Perusal of the Defendant's profile on Facebook revealed that the Defendant was displaying the Plaintiff's "BOSS IN MOTION" and "HUGO BOSS" perfumes on its profile. The print-outs from the Defendant's Facebook profile are exhibited as **EX PW-I/25**.

(xxii) In an effort to amicably resolve the matter, the Plaintiff served a legal notice on the Defendant through its attorneys on September 5, 2014 asking him to cease use of the mark BOSS and to provide an undertaking to that effect. An office copy of this notice is exhibited as **EX PW-I/26**.

(xxiii) The Plaintiff thereafter received a response dated September 21, 2014 from the counsel of the Defendant on September 30, 2014, wherein the Defendant, while explicitly admitting to the use of the mark BOSS for perfumes and fragrances, blatantly refused to comply with the Plaintiff's requisitions. The reply dated September 30, 2014 as received on behalf of the Defendant is exhibited as **EX PW-I/27**.

6. The Court is satisfied that the Plaintiff has been able to prove that from the representation of the Defendant's packaging it is evident that not only the Defendant is using an identical mark BOSS in relation to identical goods, but has also copied the overall look and feel of the Plaintiff's packaging. The Defendant has by doing so sought to benefit from the

reputation and goodwill of the Plaintiff's BOSS marks. The use by the Defendant of an identical mark BOSS in relation to identical products (Perfumes) is detrimental to and/or is dilutive of the distinctive character and repute of the BOSS Marks of the Plaintiff. The use by the Defendant of the impugned mark is bound to whittle down the source identifying function of the Plaintiff's distinctive BOSS Marks.

7. The report of the Local Commissioners ('LCs') appointed by the Court by its order dated 25th March 2015 also confirms this position. The LCs made an inventory of the infringing goods found in the premises of the Defendant bearing the BOSS trademark and released the same on Superdarinama. The inventory of the products at M/s Shree Ramdev Perfumes, Opposite Nareshwar Temple, Amba Chowk, Bhavnagar, Gujarat- 364001 included the following

- 1) Boss Ramdev Hanky Perfumes (30ML)-11 items
- (2) Boss Ramdev Roll On (8ML)-26 items
- (3) Packing material Boss Ramdev-Appx. 1500/- Boxes
- (4) Boss Ramdev Hanky Perfumes (60ML)-3 items
- (5) Boss Ramdev Hanky Perfumes (8ML)-22 items
- (6) Boss Ramdev Roll on (3ML)-60 items

8. The affidavit of PW-1 further states that by virtue of the continuous and longstanding efforts made by the Plaintiff, the BOSS Marks and the products sold there under today enjoy substantial reputation and goodwill amongst the members of trade and purchasing public. Also the BOSS Marks are exclusively associated with the Plaintiff and the same have become well-known marks in India.

9. It has been proved by the Plaintiff that its registered trademark has been used by the Defendant as a prominent part of the name of their

product and such use of the BOSS trademark or any other deceptively similar mark containing the Plaintiff's BOSS trademarks is a violation of the Plaintiff's trademark and amounts to infringement and further dilutes the distinctive character of the trademark of the Plaintiff.

10. However, as regards the claim for damages in the sum of Rs. 21,00,000 the Plaintiff has not given the calculation for arriving at the said figure. There also does not appear to be a formal prayer in that regard although the requisite court fees was paid. The court therefore declines to award damages in favour of the Plaintiff.

11. In the result the Court issues a decree of permanent injunction to restrain the Defendant by itself, its partners, directors, franchisees, managers, employees, family, agents and all others acting in concert with them or claiming under or through them or on their behalf

(a) from using upon or in relation to their business and products, the impugned mark "BOSS" and/or any other marks which may be identical and/or deceptively similar mark to the Plaintiff's BOSS trademarks in relation to perfumes and/or in any manner whatsoever so as to amount to infringement of the Plaintiff's statutory rights in the BOSS trademarks;

(ii) indulging in any activity which dilutes the distinctive character of the Plaintiff's BOSS trademarks;

12. Further a decree is issued in favour of the Plaintiff and against the Defendants for delivery up of material and equipment including labels, packing material, stationery, carry bags, price stickers, visiting cards, bill boards, brochures, promotional material, point of sale material, letter

heads, cash memos, sign boards, sign posts, leaflets, cartons, manufacturing equipment, invoices, or any other items of whatsoever description and nature bearing the impugned mark "BOSS" or any other deceptively similar mark containing the Plaintiff's BOSS trademarks.

13. A decree in the sum of Rs. 25,000 is issued in favour of the Plaintiff and against the Defendant towards the costs incurred by the Plaintiff.

14. The decree sheet be drawn up accordingly.

S.MURALIDHAR, J

SEPTEMBER 15, 2016

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