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

Date of Decision: 12th December, 2023

+ **CS(COMM) 252/2023, I.As. 16768/2023, 21206/2023 & 24831/2023**

NEW BALANCE ATHLETICS INC.

..... Plaintiff

Through: Mr. Urfee Roomi, Ms. Janaki Arun,
Mr. Anubhav Chhabra, Ms. Anuja
Chaudhury, Mr. Alvin Antony, Mr.
Ritesh Kumar, Mr. Jaskaran Singh,
Mr. Ayush Dixit, Ms. Radhika
Arora, Advs. (M. 9818098835)

versus

**JITENDER KUMAR, TRADING AS
J. K. ENTERPRISES & ORS.**

..... Defendants

Through: Mr. Pardeep Dhingra, Mr. Archit
Relan and Mr. Pradeep Kumar,
Advs. (M. 9899617975)

CORAM:

JUSTICE PRATHIBA M. SINGH

JUDGMENT

PRATHIBA M. SINGH, J.

1. This hearing has been done through hybrid mode.
2. The present suit has been filed by the Plaintiff-New Balance Athletics, Inc. a US based Company seeking protection of its 'NB' shaded logo which is used in respect of footwear shoes and other related products. The various marks of the Plaintiff are set out below:-



3. The mark 'N' is stated to have been used on footwear since 1970's when the Plaintiff launched its athletic shoes. Over the years, the Plaintiff is stated to have used the letter 'N' along with the combination NB and has manufactured and sold a large number of products including footwear Apparel etc.
4. The Plaintiff is also offering retail services. It has businesses in several countries in the world including United Kingdom, Hong Kong, Singapore, Australia, New Zealand, Mexico, Canada, and South Africa as also in India. The marks 'N' and 'NB' are sold in all these countries. The shoes are manufactured by the Plaintiff in 25 countries across the world with a strict quality control mechanism. The sales of the Plaintiff are stated to be approximately three billion dollars.
5. The Plaintiff's mark 'NB' is promoted across the world in several advertisements, especially, for sporting footwear and it is stated that more



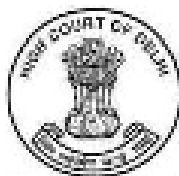
than 215 million dollars are invested in advertising. The Plaintiff also claims to be having a substantial social media presence including on platforms such as Facebook, Twitter, YouTube, Instagram etc.

6. The Plaintiff has also sponsored a large number of sporting events as stated in paragraph 23. It is stated that the Plaintiff has sponsored events such as the New York City Marathon organised by New York Road Runners, Major League Baseball teams, such as the New York Mets and the Boston Red Sox, the Olympic teams of Ireland and Chile at the 2016 Rio Olympics and various numerous national and club football teams as well as football teams.

7. The sports persons, who endorsed the Plaintiff's products includes Shikhar Dhawan, Taniya Bhatia, Brett Lee, Steve Smith and other well-known cricketers as also other tennis players, Olympians etc. The Plaintiff's footwear are also claimed to be used by large number of global political leaders and other celebrities such as Kate Middleton, the Princess of Wales, Bill Clinton, Barak Obama, Vladimir Putin, and entrepreneurs such as Steve Jobs, global celebrities such as Rihanna, Seth Rogen, Pharrell, Robert Downey Jr., Ed Helms, etc. The endorsers also include Leonardo DiCaprio, Tom Holland, Steve Carell, Jim Carrey, Kim Kardashian, and Indian celebrities such as Ranbir Kapoor, Vidyut Jammwal, Sonakshi Sinha *etc.*

8. The Plaintiff also claims to have won a number of awards. In India, the Plaintiff's product are stated to have been purchased by Indian consumers since 1986 and the products are also available on various E-commerce platforms such as Amazon, Myntra, Ajio and Flipkart etc.

9. The Plaintiff has incorporated its subsidiary Companies - New Balance IT Services India Private Limited in 2007 and New Balance India



Private Limited in 2022 and is actively doing business in India. The Plaintiff has added the large print media and electronic media business in India and has spent considerable amount of money on promotions and advertisements.

10. The Plaintiff has also taken various actions against misuse of the 'NB' marks, shaded logos and the 'New Balance' marks. Details of the said enforcement actions which have been taken are set out in below:-

<i>Order Dated</i>	<i>Adverse Party</i>	<i>Action Taken</i>	<i>Result Obtained</i>
<i>04.03.2022 in CS(COMM) 140/2022</i>	<i>Naveen Kumar Gupta, trading as Star Enterprises</i>	<i>Suit alleging trademark infringement, copyright infringement and passing off</i>	<i>Ex ad-interim injunction granted in favour of the Plaintiff. Defendant restrained from using the Plaintiffs marks, including, the Plaintiffs NB or any other mark deceptively similar to the Plaintiff's NB Marks.</i>
<i>17.08.2022 in CS(COMM) 553/2022</i>	<i>Salman Khan & Anr.</i>	<i>Suit alleging trademark infringement and passing off</i>	<i>Ex-parte ad-interim injunction granted in favour of the Plaintiff. The Defendant was restrained from using the Plaintiffs marks, including, the NB Marks, NEW BALANCE and NB logo mark or any other mark deceptively similar to the Plaintiffs Marks. The Court also appointed a Local Commissioner to visit the premises of the Defendants.</i>
<i>23.08.2022 in CS(COMM) 572/2022</i>	<i>Nineplus Shoes Private Limited</i>	<i>Suit alleging trademark infringement and passing off</i>	<i>The Court granted ad-interim injunction in favour of the Plaintiff. The Defendant was restrained from using the Plaintiffs marks,</i>



			including, the Plaintiff's N Marks or any other mark deceptively similar to the Plaintiffs N Marks. The Court also appointed a Local Commissioner to visit the premises of the Defendants.
20.02.2023 in CS (COMM) 92/2023	BUYPREMIUM PRODUCTS.COM and Ors. (John Doe Action)	Suit alleging trademark infringement and passing off	Ex-parte ad-interim injunction granted in favour of the Plaintiff. Defendant restrained from using the Plaintiffs marks, including, the Plaintiffs NB and N Marks or any other mark deceptively similar to the Plaintiffs NB and N Marks.
17.02.2023 in CS(COMM) 90/2023	LUXURYJUNCTIONLJ. COM, LUXURYJUNCTION.IN and Ors. (John Doe Action)	Suit alleging trademark infringement and passing off	Ex-parte ad-interim injunction granted in favour of the Plaintiff.
24.02.2023 in CS(COMM) 104/2023	LUXURYTAG.IN (John Doe Action)	Suit alleging trademark infringement and passing off	Defendant restrained from using the Plaintiffs marks, including, the Plaintiffs NB and N Marks or any other mark deceptively similar to the Plaintiffs NB and N Marks.
03.08.2022 in CS(COMM) 531 /2022	MYSHOESHOP.COM & Ors.	Suit alleging trademark infringement and passing off	Ex-parte ad-interim injunction granted in favour of the Plaintiff. Defendant restrained from using the Plaintiffs marks, including, the Plaintiffs N Marks or any other mark deceptively similar to the Plaintiff's N Marks.
20.05.2022 in CS(COMM) 339/2022	SASTAJOOTA.COM & Ors.	Suit alleging trademark infringement and passing off	Ex-parte ad-interim injunction granted in favour of the Plaintiff. Defendant restrained from



			<i>using the Plaintiffs marks, including, the Plaintiffs NB and N Marks or any other mark deceptively similar to the Plaintiff's NB and N Marks.</i>
<i>07.01.2022 in CS(COMM) 12/2022</i>	<i>NBSTORESINI NDIA.IN & ORS.</i>	<i>Suit alleging trademark infringement, copyright infringement and passing off</i>	<i>Dynamic injunction granted in favour of the Plaintiff, restraining the Defendants from using the Plaintiffs marks, including the Plaintiffs NB and N Marks, including by reflecting the marks on their website at any point or position, and operating through websites which are deceptively similar to that of the Plaintiff.</i>

11. The Registrations of the Plaintiff are as under:-

S. No.	Mark	Reg. No.	Class	Registration Date	Renewed Until
1.		472335	25	May 18, 1987	May 18, 2028
2.		768874	25	September 10, 1997	September 10, 2027
3.		1537347	25	March 6, 2007	March 6, 2027
4.		472334	25	May 18, 1987	May 18, 2027
5.		525286	18	February 27, 1990	February 27, 2024
6.		706035	18	May 20, 1996	May 20, 2026



7.		1637760	25	January 3, 2008	January 3, 2028
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12. In the present case, the Plaintiff found that Defendant No. 1 -Jitender Kumar, trading as J.K. Enterprises was manufacturing and selling various footwear with a similar logo and with the 'N' logo as well. The Defendant No. 1 is the main manufacturer. Defendant Nos. 2 to 4 are the sellers of Defendant No.1's footwear. The marks used by the Defendants are set out below:-



13. The Plaintiff first learnt of the Defendants through an application which was filed in the trademark Registry for 'ES EARTH SKY' Device mark bearing Number- 5407385 in Class 25 for "clothing, footwear, headwear". The logo is set out below:-



14. Another application being Registration No. 4650460 dated 10th September, 2020 was also found by the Plaintiff for which the Defendant No. 1 applied for in Class 25. The said logo is set out below:-



15. The Defendant No. 1's products were also found being sold on various e-commerce platforms such as Amazon and Flipkart. The Plaintiffs effected a sale of the said products. According to the Plaintiff, the Defendants are indulging in misusing various other well-known products such as Nike, Adidas, Off White and Campus etc.

16. The Plaintiff after a detailed investigation, then sent a legal notice dated 9th March, 2023 via email to the Defendant No. 1. In response to which the Defendant No. 1 agreed that he had used the 'NB' mark mistakenly and he had adopted a new device mark. However, the Defendant No. 1 continued to use the impugned marks thereafter.

17. The undertakings which were given have been filed as part of the



record. However, the Defendant No.1 did not revert with the signed undertakings. The Plaintiff also filed a request to the Trademark Registry for withdrawal of the trademark application. The email dated 12th March, 2023 sent by the Defendant No. 1 is set out below:-

*“Namaste Madam,
Hame apka notice kal subah (Date-11 March 2023)
mai mila tha, humne us notice ko dekha or jaisa ki hum
samaz paye ki apka kehna hai ki apke client - NB ke
logo ka design humne galti se use kiya hai bina jankari
ke jaisa ki humne ecommerce platforms pe se hamare
ES logo ko apke jaise brand logo ko hamare naye logo
se badalna hai,
Us prakriya ko krne mai thoda bahut time lagega toh
kripya krke hame thoda samay dijiye lakin hame apne
brand ES -Earth Step ko register krte samay is baat ka
pta nhi tha ki esi problem aayegi yaa aa sakti hai lakin
hamara brand registered ho gya tha or R bhi hame mil
gya tha toh hum nischint ho gye the isiliye humne is
brand logo ko har selling platforms per promote kiya
to ab hame sare E-platforms se se hatane mai samay
lagega to kripya krke aap isme hamara sahyog kre.
Hamare naye logo ki image hum is mail ke attachment
mai share kr rahe hai or yeh image or brand logo apko
thode bahut samay mai nazar aana shuru ho jayega
hum yeh apko hum aashvasan dete hai.
Thank you
Jitender Kumar (JK Enterprises, Earth Footwear)”*

18. Despite these undertakings, the marks were not withdrawn and the Defendant No. 1 continued to use the marks. The Plaintiff, then filed the present suit seeking an injunction.

19. The Court had, vide order dated 28th April, 2023 granted an interim injunction in the following terms:-

“29. Based on the averments in the plaint and



submissions made on behalf of the plaintiff, a prima facie case is made out on behalf of the plaintiff. Balance of convenience is in favour of the plaintiff and against the defendants. Irreparable harm would be caused not only to the plaintiff but also to the public if an ex parte ad interim injunction as sought is not granted in favour of the plaintiff.

30. Consequently, till the next date of hearing, the defendants, their individual proprietors, partners, directors, agents, representatives, distributors, assigns, heirs, successors, stockists and all others acting for and on their behalf are restrained from using, selling, soliciting, exporting, displaying, promoting, advertising and dealing with the impugned



marks/labels , the impugned 'N' device marks/labels and/or any other mark/label/packaging/artistic works either identical or deceptively similar to those of the plaintiffs marks/labels."

20. Local Commissioners were also appointed, to visit the premises of the defendants and make an inventory of the infringing materials. The inventory prepared by both the Local Commissioners in the premises of Defendant Nos.1, 2, 3 and 4 which are set out below:-

A. First Local Commissioner's inventory at the premises of Defendant Nos.1 and 2:



S.NO.	CLASSIFICATION OF GOODS	NUMBER OF SHOES/ QUANTITY
1	Shoes bearing “N” as their logo	220
2	Shoes bearing mark/ label “ES”	3707
3	Cardboard shoe- boxes bearing “ES” mark/label on them	1835
4	Shoe Uppers :- Old New	680 449

B. Second Local Commissioner’s inventory at the premises of Defendant Nos 3 & 4:

i. Seven gunny bags containing 201 pairs of shoes and sandals

ii. One single piece of shoe

21. A perusal of the reports would show that there was large scale use of the impugned ‘ES’ logo in the shaded manner as also the letter ‘N’ in the premises of the Defendant No.1. Despite the execution of the Local Commissioners and the injunction which was passed, the Defendants had continued to use the marks which led to the Plaintiff filing an application under Order XXXIX Rule 2A CPc being ***I.A. 16768/2023***.

22. The said application was listed on 1st September, 2023 on which date, the Court had issued notice and directed Defendant No. 1 to remain present in Court on the next date of hearing. However, despite the said order, the



Defendant No. 1 did not appear on 20th October, 2023. Accordingly, bailable warrants had to be issued.

23. In response to the bailable warrant, on 29th November, 2023, Defendant No. 1 was present in court and an application was filed for cancellation of bailable warrants. Further, on 29th November, 2023, the interim order was also made absolute during the pendency of the present suit.

24. The Court had also noticed that the Defendants had now applied for a new device mark “EARTH STEP” bearing No. 5847827 in Class 25 with the following logo:-



25. In view thereof, the Court had directed the suit shall proceed to trial and the Defendants would respond to the contempt application as to why contempt action ought not to be initiated against them.

26. Today, an application under Order VI Rule 17 has been filed by the Defendants claiming that they have now given up the ‘ES’ new logo as well and that they are using the ‘Earth Step’ mark in full word form.

27. Defendant No.1 - Mr. Jitender Kumar is present today in Court. The statement of Defendant No.1 - Mr. Jitender Kumar has been recorded. His statement is extracted below:

“Statement of Mr. Jitender Kumar, S/o Kanti Lal, R/o H No.-D-444, Madipur JJ Colony, Madipur, West Delhi, Delhi-110063

On SA



I am the proprietor of J.K. Trading Enterprises located at WZ-243, Ground Floor West Punjabi Bagh, Madipur New Delhi - 11 0026.

I am engaged in the manufacture and sale of athletic footwears under the mark 'EARTH STEP'.

I have given up the 'E' shaded logo and the new 'ES Logo' for which I had applied for registration.

I am currently using the full name "EARTH STEP" for the shoes which are being manufactured and sold by me.

I undertake that if I ever want to adopt an abbreviated 'ES' logo, the same would not be either identical or similar to the Plaintiff's shaded logo.

I also undertake that all the trademark applications which have been filed by me for the 'ES' logo and such similar logos shall be withdrawn. I shall, however, pursue the trademark application for the full mark "EARTH STEP".

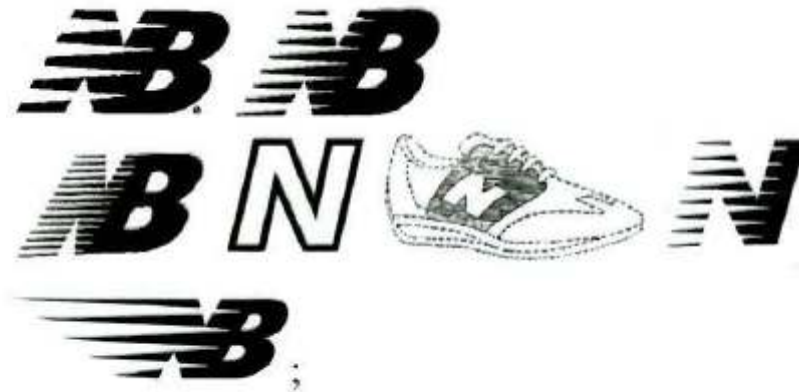
I also undertake to pay Rs.2,00,000/- as partial costs to the Plaintiff by 15th May, 2023.

I undertake to remove from the seized inventories the 'N' logo as also the 'ES' infringing logo from the shoes/footwear under the supervision of a representative of the Plaintiff. Thereafter, I would sell them in usual course."

28. In terms thereof, the Defendant no.1 has agreed to give up the impugned logos and the use of the letter 'N'. The Defendant no.1 has categorically stated that he only wishes to use the mark EARTH STEP and if at any point he designs a logo the same shall not be similar to the Plaintiff's marks or logos. Since the Defendant No. 1 is agreeable for a decree being passed that he would not use the identical or deceptively similar mark as that of the Plaintiff's mark or use 'ES' logo, a decree is passed in the following terms as set out below:-



“(a) An order for permanent injunction restraining the Defendants, any other individuals, officers, managers, employees, agents, dealers, licensees, related/affiliated companies/entities, retailers, wholesalers, distributors or any persons/entities that are under the control of the Defendants or are related or affiliated to the Defendants, as the case may be, and all others, acting for and on behalf of the Defendants, from manufacturing, offering for sale, selling, displaying, advertising, marketing, whether directly or indirectly, and whether on the Internet or otherwise, footwear and any other similar/related/allied/cognate goods bearing the Defendant No. 1 's Marks (as depicted in paragraph 7) and marks that incorporate the Defendant No. 1 's Marks, or any other mark that is identical/deceptively similar to the Plaintiff's following Marks:



29. In addition, it is directed that the Defendants shall also withdraw all the trademark applications filed by them. The Defendants have already withdrawn/modified the trademark applications:-

Trademark Applications/Registrations filed/owned by Defendant No. 1 to be withdrawn/cancelled

<i>S. No.</i>	<i>Trademark</i>	<i>Trademark Application</i>	<i>Class</i>	<i>Status as per the Trade Marks Registry</i>	<i>Action taken by Defendant</i>



1.	 Earth Step	4650460	25	Registered	Form TM-P for cancellation of entry filed on April 5, 2023
2.	 EARTH SKY	5407385	25	Withdrawn	Form TM-P for withdrawal of trademark application filed on April 5, 2023, and the same has been admitted by the TM Registry
3.	 Earth Step	5877825	25	Accepted and Advertised	N.A.

Trademark Application of Defendant No. 1 allowed by the court

<i>S. No.</i>	<i>Trademark</i>	<i>Trademark Application</i>	<i>Class</i>	<i>Status as per the Trade Marks Registry</i>
1.	Earth Step	5847827	25	Accepted and Advertised

30. Insofar as delivery up and recall is concerned, since the Defendants have agreed to remove any reference to the 'N' shaded mark and the 'N' logo in the supervision of the Plaintiff's representative, the said stitched labels shall be removed from the shoes and soles shall also be changed. After the same are changed, the same shall be released to the Defendants for



disposal in the usual course of business.

31. Defendant No.1 - Mr. Jitender Kumar shall also pay a sum of Rs.2,00,000/- by 15th May, 2023 to the Plaintiff through Id. Counsel for the Plaintiff. The name in which the payment is to be made shall be communicated to the Defendant No. 1 through Id. Counsel for the Defendant.

32. Remaining reliefs are not pressed.

Declaration as a well-known mark.

33. In view of the background recorded hereinabove, the Court is convinced that the factors that are required to be established for proving that the mark of the Plaintiff is well-known have been established.

34. Insofar as 'N' shaded logo is concerned. A large scale global and extensive use of the 'N' shaded logo of the Plaintiff as also the registration of the 'N' shaded logo in India since 1997 coupled with enforcement of the said mark and logo, leaves no manner of doubt that the said writing style and script in respect of footwear is exclusively associated with the Plaintiff.

35. Reliance is placed upon ***Hermes International v. Crimzon Fashion Accessories Pvt. Ltd. [2023 SCC OnLine 883]***, wherein the factors outlined by the Co-ordinate Bench under Section 11(6) of the Trade Marks Act, 1999, would be relevant for declaring the mark as well-known, are as follows:

“(i) The knowledge or recognition of that trademark in the relevant section of the public, including knowledge in India obtained as a result of promotion of the trademark.

(ii) The duration, extent, and geographical area of any use of that trademark.



(iii) *The duration, extent, and geographical area of any promotion of the trademark, including advertising or publicity and presentation, at fairs or exhibition of the goods or services to which the trademark applies.*

(iv) *The duration and geographical area of any registration of, or any application for registration of that trademark under the Trademarks Act to the extent that they reflect the use or recognition of the trademark.*

(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.”*

36. On the strength of averments in the Complaint, and the documents placed on record, and the reputation of the shaded ‘N’ mark and the New Balance logo, especially in respect of footwear and apparel, it is clear that it should acquire a **‘well-known’** status.

37. Accordingly, said ‘N’ shaded logo is declared as a well-known mark.

38. Insofar as simple ‘N’ logo is concerned, the well-known declaration which is sought may be canvassed in other appropriate proceedings as the present suit is not a contested matter and no evidence has been called.

39. Decree sheet be drawn.

40. Since the matter has been settled at an early stage, 50% Court fee is directed to be refunded to the Plaintiff through Id. Counsel upon submissions of authorisation.

41. All the pending applications are disposed of. Next date of hearing stands canceled.

**PRATHIBA M. SINGH
JUDGE**

DECEMBER 12, 2023

mr/bh

(corrected & released on 18th December, 2023)