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

+ **CS(COMM) 396/2023**

RETAIL ROYALTY COMPANY & ANR. Plaintiffs

Through: Mr. Urfee Roomi, Mr. Ayush
Dixit, Ms. Anuja Chaudhury and Mr. Alvin
Antony, Adv.

versus

**SANTOSH KUMAR SHARMA TRADING AS SHIV
SHAKTI CREATIONS**

..... Defendant

Through: Mr. Deepak Sharma, Adv.

CORAM:

HON'BLE MR. JUSTICE C. HARI SHANKAR

JUDGMENT (ORAL)

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06.09.2023

CS(COMM) 396/2023

1. The plaintiffs are public limited companies incorporated in the USA in 1977 and claim to have been using the mark AMERICAN



EAGLE, with the logo of a flying eagle as a trademark since then. The mark "AMERICAN EAGLE OUTFITTERS" stands registered in favour of the plaintiffs in Class 25 in India since 22 February 2000. The plaintiff further asserts that, since 1977, the plaintiffs are using the mark AMERICAN EAGLE OUTFITTERS on readymade clothing, fashion accessories and related goods and services.



2. The plaint further asserts that the plaintiffs are the owners of the domain names americaneagleoutfitters.com (registered in 2002), americaneagleoutfitters.in (registered in 2011), americaneagle.in (registered in 2013) and americaneagle.co.in (registered in 2014).

3. The plaint further enlists the registered trademarks of the plaintiffs thus:

S. No.	Mark	Registration/ Application No.	Class (es)	Registration/ Application Date
1.		3261825	25, 35	May 17, 2016
2.		3264163	18	May 19, 2016
3.	AMERICAN EAGLE OUTFITTERS	905098	25	February 22, 2000
4.	AMERICAN EAGLE OUTFITTERS	2061432	18	November 30, 2010
5.	AMERICAN EAGLE	1474694	3, 14, 25 and 35	July 31, 2006
6.	AMERICAN EAGLE	1486587	18	September 12, 2006
7.	AMERICAN EAGLE	1639992	25	September 1, 2008
8.		1463555	3, 18 and 25	June 22, 2006
9.		2195681	14 and 35	August 8, 2011



10.		2552604	19, 16, 24, 36 and 38	June 21, 2013
11.		3729369	3	January 17, 2018

4. The plaintiffs further hold the copyright Registration No. A-122033/2017 for the aforesaid Flying Eagle Device Mark.

5. It is further pointed out, in the plaint, that this Court has, in its judgment in *Retail Royalty Company v. Nirbhay Marg News Broadcast Pvt. Ltd.* vide orders dated 25 April 2023 and 3 May 2023 in CS (COMM) 601/2022 declared the Flying Eagle device mark of the plaintiffs, a well-known trademark within the meaning of Section 2(1)(zg) of the Trade Marks Act.

6. The plaintiffs are aggrieved by the fact that the defendant is selling counterfeit products using the aforesaid registered trademark of the plaintiffs. In fact, the plaint points out that the defendant's website candidly acknowledges that the defendant is "the name to trust to avail premium quality branded *first copy* jeans".

7. The counterfeit products of the plaintiffs, as made and sold by the defendant, it is submitted, are freely available online.

8. It is in these circumstances that the present plaint has been



instituted by the plaintiffs, seeking an injunction against the defendant as well as all others who act on his behalf from manufacturing, offering for sale, displaying, advertising or using directly or indirectly, physically or virtually, on readymade clothing or any other allied or

cognate goods, the marks



AMERICAN EAGLE OUTFITTERS and AMERICAN EAGLE.

9. Additionally, the plaint prays for delivery up, rendition of accounts, costs and damages.

10. A perusal of the facts in the case reveals a clear case of counterfeiting, by the defendant, of the afore-noted marks of the plaintiffs.

11. By order dated 1 June 2023, this Court had restrained the defendant by way of an *ad interim* injunction from manufacturing, selling, offering for sale or otherwise directly or indirectly, physically

or virtually dealing with the marks



, AMERICAN EAGLE OUTFITTERS and AMERICAN EAGLE or any other confusingly or deceptively similar mark, in respect of any goods or services which are identical or allied or cognate to the goods or services in respect of which the afore-noted marks stand registered and are being used by the plaintiffs.



12. Mr. Deepak Sharma, learned Counsel for the defendant submits, on instructions, that his client is willing to give up use of the afore-

noted marks  ,  ,  , AMERICAN EAGLE OUTFITTERS and AMERICAN EAGLE and is agreeable to the suit being decreed, against the defendant, on the basis of the said statement, subject to plaintiffs not pressing for damages and being awarded costs only as per actuals.

13. Mr. Urfee Roomi, learned Counsel for the plaintiffs is also agreeable to the said suggestion.

14. The prayer clause in the suit reads thus:

“It is, therefore, prayed that this Hon'ble Court may be pleased to grant:

a. An order for permanent injunction restraining the Defendant, his business affiliates, managers, employees, agents, dealers, licensees, companies, retailers, wholesalers, distributors or any persons/entities that are under the control of the Defendant or are related or affiliated to the Defendant. as the case may be, and all others, acting for and on behalf of the Defendant, from manufacturing, offering for sale, selling, displaying, advertising, marketing, whether directly or indirectly, and whether on the Internet or otherwise, readymade clothing and any other similar/ related/ allied/ cognate goods bearing the Plaintiff's Marks depicted herein, i.e., marks

 ,  ,  , AMERICAN EAGLE OUTFITTERS and AMERICAN EAGLE. or any other mark that is identical/deceptively similar to the Plaintiff's Marks;

b. An order for permanent injunction restraining the Defendant, his business affiliates, managers, employees, agents, dealers, licensees, companies, retailers,



wholesalers, distributors or any persons/entities that are under the control of the Defendant or are related or affiliated to the Defendant, as the case may be, and all others, acting for and on behalf of the Defendant, from doing any act that amounts to trademark infringement of

the Plaintiff's Marks



, AMERICAN EAGLE OUTFITTERS and AMERICAN EAGLE (as noted in paragraph 4 above);

c. An order for permanent injunction restraining the Defendant, his business affiliates, managers, employees, agents, dealers, licensees, companies, retailers, wholesalers, distributors or any persons/entities that are under the control of the Defendant or are related or affiliated to the Defendant, as the case may be, and all others, acting for and on behalf of the Defendant, from doing any act that amounts to infringement of the Plaintiff's copyright in the Flying Eagle Device Mark



depicted herein, i.e.

and

d. An order for permanent injunction restraining the Defendant, his business affiliates, managers, employees, agents, dealers, licensees, companies, retailers, wholesalers, distributors or any persons/entities that are under the control of the Defendant or are related or affiliated to the Defendant, as the case may be, and all others, acting for and on behalf of the Defendant, from passing-off their readymade clothing and/or any other similar/ related/ allied/ cognate goods under the Plaintiff's



Marks depicted herein, i.e.,



, AMERICAN EAGLE OUTFITTERS and AMERICAN EAGLE as those of the Plaintiff;

e. An order of mandatory injunction for recall and delivery up by the Defendant to the Plaintiff of all readymade clothing, similar/ related/ allied/ cognate goods, packaging, labels, promotional and advertising material, business incidentals, price tickets, stationery,



brochures and any other materials that bear the Plaintiff's Marks, and/or marks that are identical/deceptively similar to the Plaintiff's Marks in possession of the Defendant or a person or entity or under the control of the Defendant or related to the Defendant or under control of the Defendant, or with a dealer, distributor, retailer, wholesaler, or any persons/entities that are related or affiliated to the Defendant;

f. A decree for rendition of accounts of the profits earned by the Defendant, from the activities complained of and a decree for the amount so found due to be passed in favour of the Plaintiff. The Plaintiff undertakes to file such court fee, as may be required by this Hon'ble Court at any point of time in future;

g. An order declaring the AMERICAN EAGLE OUTFITTERS and AMERICAN EAGLE marks to be well-known in view of the averments and contentions put forward by the Plaintiff;

h. A final money decree in favour of the Plaintiff for payment of damages in the sum of Rs. 2,00,00,500/- (Rs. Two Crores Five Hundred) or in such higher sum as may be determined/ascertained pursuant to the rendition of accounts;

i. An order for costs of the proceeding;

j. Any other orders as this Hon'ble Court may deem fit and proper in the facts and circumstances of the present case.

It is prayed accordingly.”

15. In view of the aforesaid, the suit stands decreed in terms of prayers a. to d. of the afore-extracted prayer clause. The plaintiffs are additionally entitled to costs as per actuals, for which purpose the parties are referred to the concerned Joint Registrar to access the Taxation Officer, who would workout the actual costs incurred by the plaintiffs, to which the plaintiffs would be entitled against the defendants.



16. In view of the aforesaid, Mr. Roomi does not press prayers f. and h. in the suit.

17. Let a decree-sheet be drawn up in the aforesaid terms.

18. The parties are referred to the learned Joint Registrar/Taxation Officer to compute the costs.

19. Let the parties appear before the Joint Registrar on 4 October 2023.

20. Apropos prayer g., which is for a declaration that the plaintiffs' mark is well-known within the meaning of Section 2(1)(zg) of the Trade Marks Act, 1999, list before the Court on 22 November 2023.

21. The plaintiffs may file submissions on the aforesaid aspect before the Court, based on the documents which are already on record, within a period of four weeks from today.

IA 11062/2023 (Order XXXIX Rules 1 and 2 of the CPC)

22. This application does not survive for consideration and is disposed of.

C.HARI SHANKAR, J

SEPTEMBER 6, 2023

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