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

% *Date of Judgment: 26th October, 2017*

+ **FAO(OS) (COMM) 110/2017 & C.M.18772/2017**

COLUMBIA SPORTSWEAR COMPANY Appellant

Through Mr. Sanjeev Sindhvani, Sr.
Adv. with Mr.Himanshu Deora,
Ms.Gunjan Paharia, Mr.Nazeeb
Nawab, Advs.

versus

GALAXY FOOTWEAR PVT LTD Respondent

Through Mr. S.K. Bansal, Mr. Ajay
Amitabh Suman and Mr.
Pankaj Kumar, Advs.

CORAM:

HON'BLE MR. JUSTICE G.S.SISTANI

HON'BLE MR. JUSTICE V.KAMESWAR RAO

G.S.SISTANI, J. (ORAL)

1. The present appeal is directed against the order dated 28.04.2017 by which the Interlocutory Application filed by the plaintiff (appellant herein) bearing I.A. No.16583/2014 has been dismissed and application bearing I.A. No.22361/2014 filed by defendant (respondent herein) under Order XXXIX Rule 4 of the Code of Civil Procedure, 1908, has been allowed and interim order granted on 01.09.2014 has been vacated.
2. Notice was issued in this appeal. Pleadings are complete. After some hearing in the matter, this appeal was passed over to enable the parties to consider a consent order being passed. We are happy to note that

both the counsels have arrived at an interim amicable arrangement till the disposal of the suit.

3. It is principally agreed that both the parties will not seek unnecessary adjournment to enable the learned Single Judge to dispose of the matter. Keeping this fact in mind, agreed issues have been handed over in Court, which read as under:-

- (i) Whether the appellant/plaintiff is guilty of suppression of material facts? If so, its effects? (OPD-2)
- (ii) Whether the suit of appellant/plaintiff suffers from delay, or latches? If so, its effect? (OPD-2)
- (iii) Whether the appellant/plaintiff is the owner of the trademark 'COLUMBIA' by virtue of its various trademark registration in classes, *inter alia*, 25, 18 and 28? If so, its effects? (OPP)
- (iv) Whether the appellant/plaintiff is the prior adopter and user of the trade mark 'COLUMBIA' in India and worldwide? (OPP)
- (v) Whether the respondent/defendant no.2 is entitled to use the trademark 'COLUMBIA' in relation to footwear on account of honest prior adoption and continuous use thereafter. OPD?
- (vi) Whether the appellant's/plaintiff's trademark 'COLUMBIA' enjoys trans-border reputation and goodwill in India and/or reputation and goodwill by use in India? (OPP)

- (vii) Whether the adoption/use of trade mark 'COLUMBIA' by the respondent/defendant no.2 amounts to infringement of the appellant's/plaintiff's registered trademark(s)? (OPP)
 - (viii) Whether the adoption / use of trademark 'COLUMBIA' and similar trade dress by the respondent/defendant no.2 amounts to passing off its goods as those of the appellant/plaintiff? If so, its effects? (OPP)
 - (ix) Whether the appellant/plaintiff is entitled to a decree of recovery of damages against the respondent/defendant no.2? If so, then for what amount? (OPP)
 - (x) Whether the appellant/plaintiff is entitled to an order of rendition of accounts against the respondent/defendant no.2? (OPP)
4. It is agreed that the appellant/plaintiff will file list of witnesses within four weeks from today. Plaintiff will file an affidavit by way of evidence within eight weeks, as prayed. The matter would be listed before the Joint Registrar for marking exhibits on documents and for fixing date for trial on 04.12.2017.
5. Similar timeframe will be fixed by the Joint Registrar for the respondent. The parties agree that evidence would be concluded within four months from the date of start of evidence. After the evidence is completed, both parties shall file written synopsis together with copies of judgments they wish to rely upon within 10 days. Both

the parties will jointly request the learned Single Judge for expeditious hearing of the matter.

6. Counsels for the parties on instructions further agree that the present appeal may be disposed of with the following agreed arrangement till the decision in the suit:-

- (i) During pendency of the suit, respondent/defendant no.2 shall maintain true and correct accounts (including quantity) for the footwear sold under the trademark 'COLUMBIA' and copies of the same would be filed in the Suit Court within every 3 months.
- (ii) It is agreed that the issues framed today and the schedule for conducting trial would be followed.
- (iii) The respondent/defendant no.2 agrees to restrict the use of the mark 'COLUMBIA' for footwear alone and further shall not use the combination of colours blue and brown in its footwear boxes and packaging material. However, the respondent/defendant no.2 would be free to use the font of the mark 'COLUMBIA' as reflected in the photos with LC report at pages 426, 427 and 432 of Vol-II) and as applied for in Form TM-1 (Application No.1123256 at page 363 of Vol-II).

7. The present appeal is disposed of in above terms.

8. The Court appreciates the efforts put in by both the counsels for early disposal of the appeal in an amicable manner. Parties agree to undertake that the terms and settlement would not be advertised in any manner directly or indirectly. We also clarify that the observations made in the order passed by learned Single Judge would be read only for the purposes of deciding the Interlocutory Application only.

G.S.SISTANI, J.

V.KAMESWAR RAO, J.

OCTOBER 26, 2017

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