

\$~25

*

IN THE HIGH COURT OF DELHI AT NEW DELHI

Date of decision :25th July, 2018

+

CS (COMM) 221/2018 & I.A. 13387/2014

M/S KENZO SA

..... Plaintiff

Through: Mr. S. K. Bansal, Mr. Pankaj Kumar
& Mr. Kapil Kumar Giri, Advocates
(M-9810438450).

versus

M/S SMART COLLECTION & ORS

..... Defendants

Through: Mr. H. P. Singh, Advocate for D-1 to
6&8 (M-9810008116).

CORAM:

JUSTICE PRATHIBA M. SINGH

Prathiba M. Singh, J. (ORAL)

1. The Plaintiff – M/s Kenzo S.A. (*hereinafter*, ‘*Plaintiff*’), is a French luxury house founded in 1970 by Japanese designer Kenzo Takada. In 1988, the Plaintiff ventured into fragrances, perfumery and other cosmetics worldwide. Ever since its establishment, the Plaintiff has been using the mark ‘KENZO’. The Plaintiff’s products are said to have achieved global repute and renown and are claimed to have been sold in more than 100 countries. In India, the Plaintiff’s mark ‘KENZO’ is registered in several classes including classes 3, and 25, as stated in paragraph 6 of the plaint. It is the case of the Plaintiff that the mark ‘KENZO’ is also an essential part of the domain name and website www.kenzo.com.

2. The Plaintiff avers that in the last week of April, it came across various counterfeit products with the trademark ‘KENZO’ and came to know that the said products are being promoted through various social media platforms. The original Plaintiff impleaded Defendant No.1 as M/s. Smart

Collection. Mr. Yasin Sayani original Defendant no.2 claimed that he was the owner of the trade mark '*SMART COLLECTION*'. Hence M/s. Smart Collection was deleted vide order dated 6th October 2015. An amended memo of parties was thereafter filed. Mr. Yasin Sayani, Mr. Danish Sayani, Ms. Yasina Sayani, M/s Floressence Perfumes Pvt. Ltd, M/s Cris Moda Perfumes Pvt. Ltd., are defendants 1-5. Defendant No.6, is M/s Singh Collection who is claimed to be the seller of the infringing products in Delhi. Defendant no.7 is M/s Cosmic International against whom there are no specific allegations.

3. The claim of the Plaintiff is that the sale of these products is violative of the Plaintiff's rights in the trade mark '*KENZO*', and since the products are counterfeit, an injunction is liable to be granted.

4. In a common written statement filed on behalf of Defendant Nos.1 to 5 and 7 (*as per amended memo of parties*), it was claimed that the Defendant No.1 – M/s. Smart Collection does not exist as an entity, but is a trademark owned by Mr. Yasin Sayani. Thus, the Defendants did not dispute that the mark '*SMART COLLECTION*' emanated from their stable of products. The Defendants, however, challenged the territorial jurisdiction of this Court. It was claimed that the Defendant No.5 – Cris Moda Perfumes Pvt. Ltd., is not a company. It is actually a sole proprietary concern of Mr. Danish Sayani by the M/s. Cris Moda Parfums. It is claimed to a small scale industry which manufactured and marketed its own perfumes under their registered trademark '*Cris Moda Parfums*'. It is also claimed that the mark '*Cris Moda Parfums*' was assigned by Defendant no.4 to Defendant no.5. According to the Defendants, M/s. Singh Collections has been impleaded only for the purposes of vesting territorial jurisdiction in this Court. There is no

connection between the other Defendants and M/s. Singh Collections. The Defendants also categorically stated in the written statement as under:

“23 to 29. The Contents of paras 23 to 29 of the plaint are incorrect, wrong and denied. Plaintiff is put to strict proof thereof. It is submitted by the Defendants that the suit is bad on account that the present Defendants have never sold any products with the Trademark KENZO. Therefore, the Defendants have no reason to sell goods with a false description or have ever indulged in counterfeiting of the Plaintiff products. The question of selling products with phonetically, visually and structurally similar marks of the Plaintiff products does not arise, nor have the Defendants copied the artistic work or copyright of the Plaintiff or have tried to give false description or have ever tried to link themselves with the customers of the Plaintiff. The Defendants have their own trademark to bank upon and do not require any leave or licence from the Plaintiff nor have the Defendants have ever violated the trademarks of the Plaintiff to lead to infringement or passing off. The present suit is an ill founded suit and has been filed with ulterior motives. The averments made in these paragraphs are absolutely ill founded and are liable to be rejected. Any chance of confusion or deception cannot arise. The Defendants have never tried to cash upon the goodwill and reputation of the Plaintiff, if any.”

5. In the written statement filed by Defendant No. 6 (earlier Defendant No. 7), i.e., M/s Singh Collection, they have categorically denied having any association with the other Defendants in the suit, and contended that they have been wrongfully impleaded in the suit. Defendant No.6 denied all allegations of dealing in any counterfeit products, as also any goods manufactured by the other Defendants. They further averred that the

Plaintiff had failed to produce any documentary evidence to show that the impugned goods are being manufactured/sold by Defendant No.6.

6. Initially, on 23rd July, 2014, an ex-parte ad-interim injunction was granted. Mediation was also explored between the parties, however the same failed. The matter was listed for case management hearing on 25th July, 2018.

7. The documents filed Plaintiffs on record in order to show misuse of the trademark '*KENZO*' are printouts of the packagings bearing the mark '*KENZO*' and '*SMART COLLECTION*'. The screenshots are clearly visible on the record. The fact, that the word '*KENZO*' is being used along with the trademark '*SMART COLLECTION*', clearly shows that the Defendants were misusing the word and mark '*KENZO*'. This shows that the complaint of the Plaintiff is not completely baseless. Images of the packagings and the screen shots of the posts, which show the use of the mark '*KENZO*' along with the Defendants' mark '*SMART COLLECTION*', goes to show that there is more than what meets the eye.

8. The Defendants are in the identical trade i.e., manufacturing/selling perfumes, fragrances, etc. There is no reason as to why the images ought to have appeared online with the mark '*KENZO*' along with the mark '*SMART COLLECTION*'. Thus, it appears that the Defendants did make an attempt to sell the products co-branding the same as '*KENZO*' along with their own mark '*SMART COLLECTION*'. Such a use even with co-branding is completely illegal and unlawful and cannot be permitted.

9. When the suit was taken up for case management hearing, learned counsel for the Defendants, apart from challenging the jurisdiction of this Court, did submit that the Defendants have not sold the products under the

mark '*KENZO*'. Insofar as jurisdiction is concerned, the Defendants' website has been accessible from within Delhi. Since the Defendants admit that they don't intend to use the mark '*KENZO*' and also because there is no proof of actual sales but the documents show use of the mark and there is no serious dispute as to the same, no useful purpose would be served in sending the matter to trial. Both Ld. Counsels for the Plaintiff and the Defendants do not have an objection in this Court disposing of the matter finally.

10. The Defendants appear to be adopting various marks of third parties, as is evident from the records wherein the injunctions have been granted against them from using the trademarks Tommy Hilfiger, Lacoste, Calvin Klein, Christian Dior and other well known brands. The Defendants also appear to be clandestinely making the sales. The images of the Defendants' co-branded product, using the mark '*KENZO*' and '*SMART COLLECTION*' is set out below:



Defendants' use of the Plaintiff's mark

11. The above image leaves no manner of doubt that the Defendants were using the Plaintiff's mark '*KENZO*'. Thus, a permanent injunction is liable

to be granted against the Defendants from using the mark 'KENZO'. However, since there is no evidence of sales and the entire evidence appears to be a clandestine business, and further, keeping in view the fact that the Defendants completely denied that they sold products bearing the mark 'KENZO', permanent injunction as prayed for is granted.

12. The suit is decreed in terms of para 35 (a), (d) & (e). The present order be communicated by the Plaintiff to the Customs Authorities to ensure that counterfeit products bearing the mark 'KENZO' are not permitted to be either imported or exported.

13. Suit is decreed in the above terms. Decree sheet be drawn up accordingly. All pending applications are also disposed of.

PRATHIBA M. SINGH, J.
JUDGE

JULY 25, 2018/dk