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* IN THE HIGH COURT OF DELHI AT NEW DELHI

+ CS(COMM) 531/2025 & IA 13596/2025

XX

.....Plaintiff

Through: Mr. Chander M. Lall, Sr. Adv. with
Mr. Raghav Malik, Ms. Aastha
Kakkar, Mr. Lalit Alley, Mr.
Prashant, Ms. Nida Khanam, Ms.
Ananya Chug and Ms. Annanya
Mohan, Advs.

Versus

YY & ORS.

.....Defendants

Through: None.

CORAM:

HON'BLE MR. JUSTICE SAURABH BANERJEE

ORDER

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26.05.2025**I.A. 13595/2025** (*Exemption from pre-litigation mediation*)

1. *Vide* the present application under *Section 12A* of the Commercial Courts Act, 2015, read with *Section 151* of the Code of Civil Procedure, 1908 (**CPC**), the plaintiff seeks exemption from pre-litigation mediation.
2. Considering the averments made in the present application, as also since the plaintiff is seeking *ex parte ad interim* injunction in an accompanying application, and also in view of the judgment passed by the Hon'ble Supreme Court in ***Yamini Manohar v. T.K.D. Krithi*** 2024 (5) SCC 815, which has been followed by a Division Bench this Court in ***Chandra Kishore Chaurasia v. R. A. Perfumery Works Private Limited*** 2022:DHC:4454-DB, the plaintiff is exempted from instituting pre-litigation mediation.
3. Accordingly, the present application stands disposed of.



I.A. 13599/2025 (*Exemption*)

4. Exemption allowed, subject to all just exceptions.

5. The application stands disposed of.

I.A. 13597/2025 (*Exemption from advance service to defendants*)

6. *Vide* the present application under *Section 151* of the CPC, the plaintiff seeks exemption from advance service upon the defendants.

7. Learned counsel for the plaintiff submits that considering the factual position involved, particularly since appointment of a Local Commissioner for execution of search and seizure of evidence/ counterfeit products at the premises of defendants are being sought, there is a likelihood that the apprehensions of the plaintiff will become a reality in case advance service is effected and therefore, an exemption from effecting advance service is necessary.

8. For the reasons stated in the application as also taking into account the aforesaid factors and in the interest of justice, the plaintiff is granted exemption from effecting advance service upon the defendants.

9. Accordingly, the present application is allowed and disposed of.

I.A. 13594/2025 (*Additional document*)

10. *Vide* the present application under *Order XI Rule 1(4)* read with *Section 151* of the CPC, the plaintiff seeks leave of this Court to file additional documents.

11. The plaintiff will be at liberty to file additional documents at a later stage, *albeit*, after initiating appropriate steps, strictly as per the provisions of the Commercial Courts Act, 2015 read with *Section 151* of the CPC and the Delhi High Court (Original Side) Rules, 2018.

12. Accordingly, the present application stands disposed of.



I.A. 13598/2025 (*Seeking leave to file certain documents on a compact disk (CD)/ pen drive*)

13. By virtue of the present application under Section 151 of the CPC, the plaintiff seeks leave to file certain documents on a Pen Drive/ Hard Drive.

14. In terms of Rule 24 of Chapter XI of the Delhi High Court (Original Side) Rules 2018, let the electronic record by way of an encrypted CD/ DVD/ Pen Drive/ Hard Drive/ Medium with a hash value in a non-edited form be filed before the Registry within a period of four weeks.

15. Let the same accordingly form a part of the record of the present suit by way of an electronic folder in such a manner that it can be opened to view by this Court as and when required. Also let the hash value be kept separately by the Registry on the file.

16. Accordingly, the present application stands disposed of

I.A. 13600/2025 (*Seeking masking the name of the plaintiff*)

17. By virtue of the present application, the plaintiff under *Section 151* of the CPC, 1908, seeks masking the name of the plaintiff as also that of the defendants till the time the Local Commissioner submits his/ her report.

18. Accordingly, for the reasons stated therein, the present application is allowed and the name of the plaintiff and the defendants are masked till the submission of the Local Commissioners' Reports, whereafter the said names shall be unmasked by the Registry.

19. The application stands disposed of.

CS(COMM) 531/2025

20. *Vide* the present plaint, the plaintiff seeks grant of permanent



injunction restraining the defendants from infringement of trademark, under the Trademark Act, 1999 (*the Act*) its copyright under the Copyright Act, 1957 and its design under the Designs Act, 2000.

21. Let the plaint be registered as a suit.

22. Upon filing of the process fee, issue summons of the suit to the defendants through all permissible modes returnable before the learned Joint Registrar on 26.08.2025.

23. The summons shall state that the written statement(s) be filed by the defendants within a period of *thirty days* from the date of the receipt of the summons. Written statement(s) be filed by the defendants along with affidavit of admission/ denial of documents of the plaintiff, without which the written statement(s) shall not be taken on record.

24. Replication(s) thereto, if any, be filed by the plaintiff within a period of *fifteen days* from the date of receipt of written statement(s). The said replication, if any, shall be accompanied by with affidavit of admission/ denial of documents filed by the defendants, without which the replication(s) shall not be taken on record within the aforesaid period of fifteen days.

25. If any of the parties wish to seek inspection of any document(s), the same shall be sought and given within the requisite timelines.

26. List before the learned Joint Registrar for marking exhibits of documents on 26.08.2025. It is made clear that if any party unjustifiably denies any document(s), then it would be liable to be burdened with costs.

I.A. 13592/2025 (*Stay*)

27. *Vide* the present application, the plaintiff seeks grant of an *ex-parte ad-interim* injunction restraining the defendants from infringement of its



trademark, copyright and design.

28. As per the plaint and arguments advanced by the learned senior counsel for the plaintiff, the plaintiff, Birkenstock IP GmbH, is a limited liability company incorporated under the laws of Germany, with its principal place of business at Burg Ockenfels, 53545 Linz am Rhein, Germany, which carries on business in India through its wholly owned subsidiary, Birkenstock India Private Limited, which is a company registered in India.

29. The plaintiff is a part of the Birkenstock Group of companies that produces and markets footwear under the trade mark '**BIRKENSTOCK**' since and from 1774, the said mark also forms part of plaintiffs trading names as also the plaintiff owns, manages and enforces a portfolio of trade mark BIRKENSTOCK and its formative marks as well as its device



marks, *inter alia*,

and



as well as shape marks

/



and under *Class(es)* 2, 3, 5, 8, 9, 10, 11, 14, 16, 18, 19, 20, 21, 24, 25, 26, 27, 28, 29, 30, 31, 32, 35, 36, 39, 41, 42, 43, 44 and 45 of the Act.

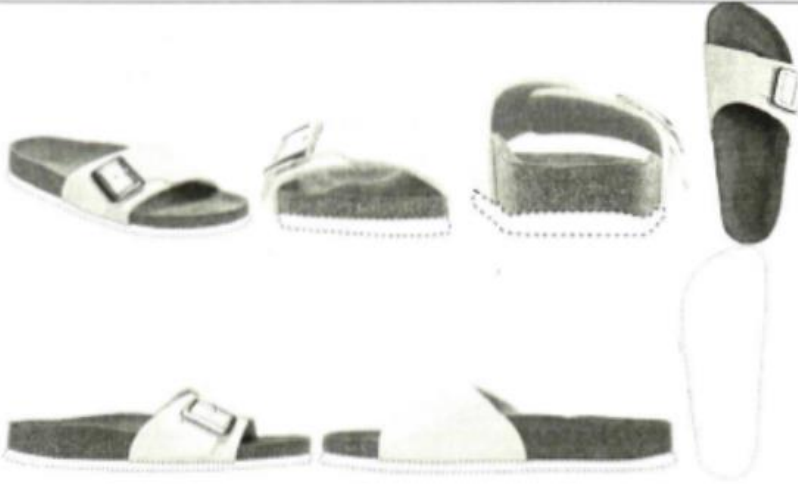
30. The plaintiff's distinctive labels and packaging under which it sells its products bearing the trade mark '**BIRKENSTOCK**' and its formatives, constitute original artistic work under *Section 2(c)* of the Copyright Act, 1957. Furthermore, the plaintiff sells its products bearing the '**BIRKENSTOCK**' marks with the following packaging:-



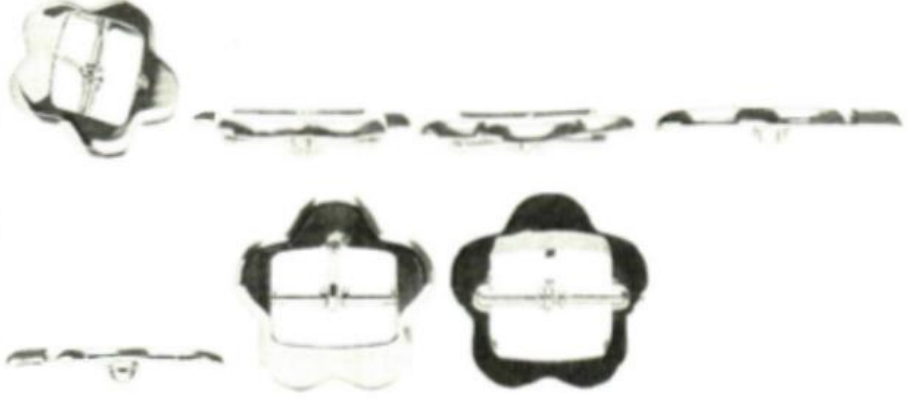
31. The plaintiff also has several design registrations of the BIRKENSTOCK footwears in India, details of few of them is entailed below:-




Design Registration no.	Date of registration	Reciprocity Date	Class
433455-001	10/10/2024	11/04/2024	02-04
In respect of the application of such design to FOOTWEAR			
Statement of Novelty: The novelty resides in the shape and configuration of the FOOTWEAR as illustrated.			
			


433459-001	433459-001	11/04/2024	02-04
In respect of the application of such design to FOOTWEAR			
Statement of Novelty: The novelty resides in the shape and configuration of the FOOTWEAR as illustrated.			
			




433461-001	10/10/2024	11/04/2024	02-07
in respect of the application of such design to BUCKLE			
Statement of Novelty: The novelty resides in the shape and configuration of the BUCKLE as illustrated.			
			


433466-001	10/10/2024	11/04/2024	02-04
in respect of the application of such design to FOOTWEAR			
Statement of Novelty: The novelty resides in the shape and configuration of the FOOTWEAR as illustrated			
			




433467-001	10/10/2024	11/04/2024	02-04
in respect of the application of such design to FOOTWEAR			
Statement of Novelty: The novelty resides in the shape and configuration of the FOOTWEAR as illustrated			
			

433468-001	433468-001	11/04/2024	02-04
in respect of the application of such design to FOOTWEAR			
Statement of Novelty: The novelty resides in the shape and configuration of the FOOTWEAR as illustrated			
			



433452-001	10/10/2024	11/04/2024	02-04
in respect of the application of such design to SOLE			
Statement of Novelty: The novelty resides in the shape and configuration of the SOLE as illustrated.			
			

439483-001	04/12/2024	11/06/2024	02-04
in respect of the application of such design to FOOTWEAR			
Statement of Novelty: The novelty resides in the shape, configuration and surface pattern of the FOOTWEAR as illustrated.			
			

32. The plaintiff is the owner of the brand's specific website i.e.,



www.birkenstock.com which provides detailed information about the plaintiff and its various products under the brand BIRKENSTOCK and its formatives as well as unique shape and design of footwears. Furthermore, the plaintiff has spent huge sums of monies in advertisement of its mark and earned huge profits therefrom.

33. In and around March 2025, the plaintiff was alerted regarding manufacture and sale of counterfeit product of the plaintiff and investigations were conducted globally by independent third-party investigators at the behest of the plaintiff to identify key players engaged in manufacturing and distribution of counterfeit products bearing the plaintiff's trade mark BIRKENSTOCK and its other formative marks.

34. As a result of the investigations, it was discovered that there are various production units operating out of the rural areas in/ or around Agra, Uttar Pradesh, who are producing the counterfeit/ misbranded products of the plaintiff in bulk, who are further exporting the said goods and/ or are distributing/ supplying the same in various states, including the markets of New Delhi.

35. The defendant no.1 is John Doe/ Ashok Kumar.

36. The defendant nos.2 to 4 are engaged in manufacturing, selling, wholesaling, retailing, marketing, supplying, distributing, importing, exporting, using and/ or dealing sandals (counterfeit products) bearing the

plaintiff's registered mark(s) BIRKENSTOCK/





and .

37. The plaintiff has found that the defendant Nos.2 to 4 own and run retail shops/ go-downs/ warehouses/ storage units from the addresses mentioned in the cause title of the plaint, wherefrom the said defendants are wholesaling, retailing, marketing, supplying, distributing, importing/ exporting, using and/ or dealing in counterfeit and/ or misbranded products of several companies including those of the plaintiff. Furthermore, the plaintiff's investigators have also procured such counterfeit samples of plaintiff's products from the defendant Nos.2 to 4 in the presence of a Notary Public and upon inspection of the said products, the same have been confirmed to be counterfeit.

38. The plaintiff's investigators were able to procure photographs from the premises of defendants which are reproduced below:-











39. Defendants are neither the plaintiff's authorized manufacturers/ distributors/ stockists nor are they part of the plaintiff's supply chain of their products and/ or goods and/ or packaging material. The plaintiff's investigator was also able to procure counterfeit and misbranded samples from the said entities at the unmarked locations in Agra in and around April, 2025. It was revealed by the proprietors of the production units that the counterfeit/ misbranded products bearing the plaintiff's trademarks/ trade dress/ footwear shape/ packaging/ copyrights/ design are supplied by them across the country including the Ghaffar Market, Karol Bagh and Tilak Nagar markets in New Delhi and also exported to other countries.

40. In view of the above, the learned senior counsel for the plaintiff



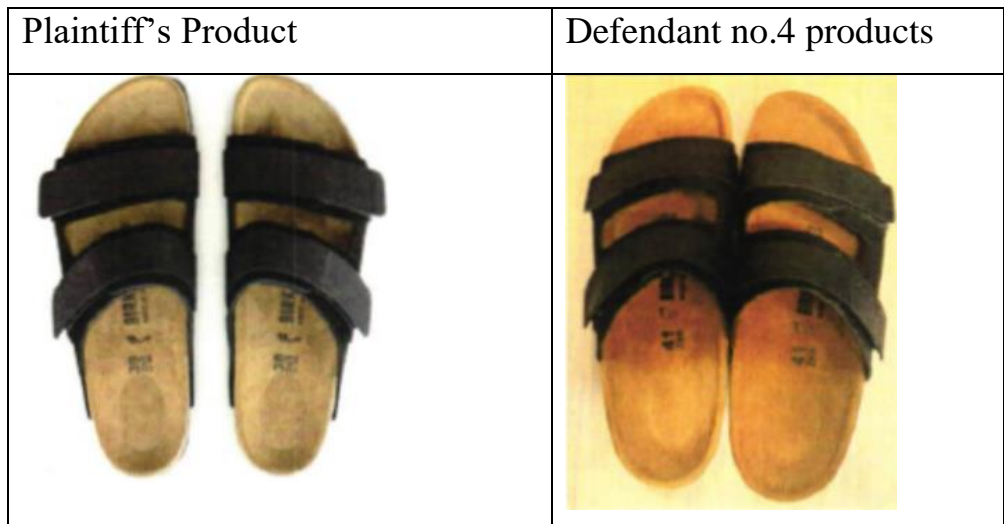
prays that an *ex-parte ad interim* injunction may be passed.

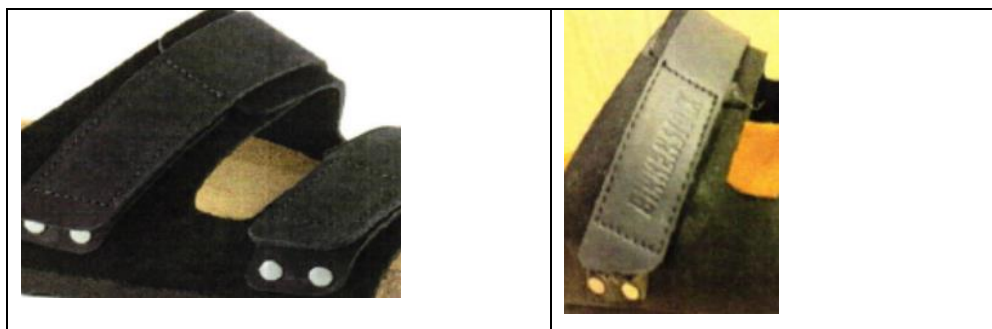
41. This Court has heard the learned senior counsel for the plaintiff and perused the pleadings and documents alongwith the products handed over in the Court during the course of the hearing as well.

42. For adjudication, a comparative table of the products of the plaintiff to that of the defendant nos. 2 to 4 is reproduced below:-

Plaintiff's Product.	Defendant no.2 Products.
	
	

Plaintiff's Product	Defendant no.3 product
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43. A bare perusal of the above products of the parties as also those handed over in Court during the course of arguments, it is revealed that the products of the defendants seem like a cheap knock off of the plaintiff's products. Furthermore, there is hardly any difference *inter-se* the products of defendants from that of the plaintiff. Moreover, *prima facie* the impugned marks on the products of the defendant nos.2 to 4 are also similar in more than one way to that of the plaintiff. The differences, hardly/ if any, are not something which can be discernable to the naked eyes.

44. Based on the pleadings, it is noteworthy that the plaintiff is not only the prior adopter and prior user of the said marks but also the registered proprietor thereof as compared to those marks being used by the defendant nos.2 to 4. Thus, the plaintiff is *prima facie* entitled to the relief of injunction and it has a far-reaching effect, if the plaintiff is not protected.

45. Thus, it would not be wrong in saying that *prima facie* the impugned marks of the defendant nos.2 to 4 are *identically/ deceptively similar* in all respects to that of the plaintiff's mark as there is/ are hardly any, in fact no such, visible difference(s) *inter-se* them, especially when the defendant nos.2 to 4 are also dealing in, offering and selling goods similar/ identical to that of the plaintiff and is operating using the same



trade channels and is targeting the same class of purchasers, reflects and leads to the conclusion that the defendant nos.2 to 4 have deliberately and with *mala fides* chosen to do so.

46. Therefore, there is all likelihood of the public getting deceived and confused into thinking that the products of the defendant nos.2 to 4 are in some way associated/ connected with and/ or coming from the house of the plaintiff or that there is some kind of understanding *inter se* the plaintiff and the defendant nos.2 to 4.

47. In view of the aforesaid, the *balance of convenience* and probabilities tilt in favour of the plaintiff for grant of an *ex parte ad interim* injunction in its favour and against the defendant nos.2 to 4. So much so, as per the existing circumstances, the plaintiff has been able to make out a *prima facie* case in its favour and against the defendant nos.2 to 4 as well. Therefore, allowing the defendant nos.2 to 4 and/ or those associated with them to continue passing off their products as that of the plaintiff and infringing upon the goodwill of the plaintiff by using the impugned marks which is/ are deceptively/ identically similar to that of the plaintiff is prone to cause *irreparable harm, loss and injury* to the plaintiff.

48. Accordingly, till the next date of hearing, anyone/ any entity its/ their directors, proprietors, partners, employees, servants, agents, distributors, sellers, importers, exporters, franchises, representatives, suppliers, affiliates, subsidiaries, franchisees, licensees, representatives, group companies, assigns and all acting on and for their behalf are restrained from manufacturing, authorizing the manufacture, packaging, storing selling, offering for sale, importing, exporting, retailing,



distributing, marketing and/ or using or dealing in the impugned products and/ or any products bearing the plaintiff's trademarks BIRKENSTOCK,



/ and and/ or its associated trade dress/ shape mark/ trade dress/ device/ logo/ or any derivative/ formative marks which is identical and/ or deceptively and confusingly similar to plaintiff's trade mark either as a trade mark, trading name, domain name or a part thereof or as a part of the packaging/ artwork/ get-up/ layout/ design (as mentioned in paragraph 13 of the plaint) as also any act that may impinge any of the intellectual property rights vested with the plaintiff qua the subject matter of the *lis* i.e., BIRKENSTOCK in form of copyright/ shape mark/ packaging/ logo/ device, in any manner whatsoever, so as to infringe the intellectual property rights of the plaintiff.

49. Upon filing of process fee, issue notice to the defendants through all permissible modes, including through *email*, returnable before the learned Joint Registrar on 26.08.2025.

50. Reply be filed within four weeks. Rejoinder thereto, if any, be filed within two weeks thereafter.

51. The provisions of *Order XXXIX Rule 3 CPC* be complied with within one week after execution of commission mentioned hereinbelow.

52. List before Court on 06.10.2025.

I.A. 13593/2025 (*Order XXVI Rule 9 CPC, 1908: Appointment of Local Commissioner*)

53. *Vide* the present application, the plaintiff seeks appointment of



Local Commissioner(s) to visit the premises of the defendants along with other premises that are discovered during the pendency of the suit which sell similar impugned products.

54. Learned counsel for the plaintiff submits that the defendants are aware of the plaintiff and its products and the infringing materials placed on record are clear evidence of the intention of the defendants to ride upon the goodwill and reputation of the plaintiff. The plaintiff believes that the infringing products are being marketed from the location set out in the memo of parties annexed with the plaint and the defendants are likely to remove all physical evidence or deny their involvement in the infringing activities.

55. In view of the aforesaid as also considering the factual matrix involved, and most relevantly, in order to preserve the counterfeit and infringing materials involved, in the considered opinion of this Court, it is deemed appropriate to appoint a Local Commissioners to visit the premises of the defendants.

56. Accordingly, the following are appointed as Local Commissioners with a direction to visit the premises of the defendants as entailed herein below:-

S.no.	Local Commissioner	Defendant(s) and their Premises	Fee Schedule
1.	Mr. Manish Shanker Verma, Advocate +91-9811304202	Mr. Bhavay Khurana Trading as Kirpal Footwears Shop No.6, 14, Beodan Pura, Rani Jhansi Market, Ajmal	Rs.1,50,000/-



		Khan Road, Karol Bagh, New Delhi- 110005	
2.	Mr. Sumer Nath Khanna, Advocate +91-9811107749	Mr. Pavandeep Singh Trading as Shoes Point Shop No.29 Ground Floor, Ghaffar Market, Karol Bagh, New Delhi- 110005	Rs.1,50,000/-
3.	Mr. Rajat Joseph, Advocate +91-9818451155	Mr. Mohit Trading as Shoe Factory 14/ 1B, Mangal Bazar Rd, Part-1, Block 14, Tilak Nagar, Delhi- 110018	Rs.1,50,000/-
4.	Mr. Abhay Sahai, Advocate +91-9971067110	Mr. Mohit Trading as Shoe Factory 11/3B, Central Market, Tilak Nagar, New Delhi- 110018	Rs.1,50,000/-
5.	Mr. Madhukar Verma, Advocate +91-9810141952	Unnamed Factory Unit No.1 Agra, Uttar Pradesh	Rs.2,00,000/-
6.	Mr. Amit Acharya, Advocate	Unnamed Factory Unit No.2	Rs.2,00,000/-



	+91-9873024619	Agra, Uttar Pradesh	
7.	Mr. Shivanshu Gusain, Advocate +91-9643670913	Unnamed Factory Unit No.3 Agra, Uttar Pradesh	Rs.2,00,000/-
8.	Mr. Rahul Ranjan, Advocate +91-7033666699	Unnamed Factory Unit No.4 Agra, Uttar Pradesh	Rs.2,00,000/-
9.	Mr. Deepanshu Dhama, Advocate +91-9810300723	Ashok Kumar/ John Doe	Rs.2,00,000/-
10.	Mr. Madhav Anand, Advocate +91-7042028636	Ashok Kumar/ John Doe	Rs.2,00,000/-

57. The Local Commissioner(s) is/ are to execute the commission in the respective premises of the defendant(s) with the following directions:-

- a) The Local Commissioner(s) be accompanied by a representative and/ or counsel of the plaintiff, who shall be permitted to enter into the premises of the defendant(s) as per the address(es) hereinabove.
- b) The Local Commissioner(s) is/ are permitted to seize, pack and seal the infringing products/ materials and handover the same on *Superdari* to the plaintiff or its counsel or authorised representative upon them giving an 'Undertaking' that they shall not tamper with or remove the sealed products as also shall in compliance of the orders of this Court, as and when passed, produce the sealed products under *Superdari*.



c) The Local Commissioner(s) is/ are permitted to take photocopies and/ or screenshots of all the books of accounts including ledgers, cashbooks, bill books, purchases and sales records or any document(s) deemed necessary and found in the premises of the defendant(s) etc. for placing the hard copies or e-copies thereof on record.

d) The Local Commissioner(s) is/ are permitted to make video recording of the execution of the commission at the premises of the defendant(s) in compliance of the present order.

e) The Local Commissioner(s) is/ are permitted to take the assistance of the Superintendent of Police within whose jurisdiction the premises of the defendant(s) is situated. The said Superintendent of Police shall provide all and every necessary assistance and protection to the Local Commissioner(s), if as and when sought for ensuring protection of the Local Commissioner(s) as also for unhindered and effective execution of the commission at the premises of the defendant(s) in compliance of the present order.

f) If the premises of the defendant(s) is/ are found under lock(s), the Local Commissioner is/ are permitted to break open the said lock(s) in the presence of the Superintendent of Police/ any designated Police Officer from the local Police Station for acting in compliance of the aforesaid.

58. The fee of the each of the Local Commissioner(s) finding mention in the fee schedule hereinabove, is in addition to all the related expenses for travel as also any other miscellaneous out of pocket expenses for the execution of the commission. All the aforesaid expenses shall be borne by the plaintiff and paid in advance to the each of the Local Commissioner(s).



59. Each of the Local Commissioner(s) is permitted to visit, secure, seize, pack and seal the infringing products on receiving any information or coming to know from the plaintiff of any other premises (John Doe) with the infringing products of the similar nature during the time of execution of the commission, on each such visit, the fee of the Local Commissioner(s) for each additional premises visit is fixed at Rs.50,000/- [*Rupees Fifty Thousand Only*] in addition to all the related expenses for travel as also any other miscellaneous out of pocket expenses for execution of the commission. The additional visit expenses shall also be borne by the plaintiff and paid in advance to the Local Commissioner(s). In such a situation, the Local Commissioner(s) is/ are permitted to act in the same manner as enumerated in para 57 hereinabove.

60. In addition to the aforesaid, each of the Local Commissioner(s) is also permitted to visit, secure, seize, pack and seal the infringing products on receiving any information or coming to know from the plaintiff of any other premises (John Doe) with the infringing products of the similar nature on any subsequent date(s)/ at subsequent stages as well. On each such occasion/ visit, the fee of the Local Commissioner(s) for each additional premises visit is fixed at Rs.50,000/- [*Rupees Fifty Thousand Only*] in addition to all the related expenses for travel as also any other miscellaneous out of pocket expenses for execution of the commission. The additional visit expenses shall also be borne by the plaintiff and paid in advance to the Local Commissioner(s). In such a situation, the Local Commissioner(s) is/ are permitted to act in the same manner as enumerated in para 57 hereinabove.

61. The report of the Local Commissioner(s) be filed within a period of



two weeks from the date of execution of the commission.

62. A copy of this order be provided to each of the Local Commissioner(s).

63. Accordingly, the application is allowed and disposed of.

Dasti.

SAURABH BANERJEE, J.

MAY 26, 2025/ssc