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In the Delhi High Court

Case No : I.A. No. 6279 of 2016 in CS (COMM) 573 of 2016

Skechers USA Inc. APPELLANT

Vs

Pure Play Sports RESPONDENT

Date of Decision : 25-05-2016

Acts Referred:

Citation : (2016) 7 ADDelhi 713 : (2016) 231 DLT 299 : (2016) 158 DRJ 695 : (2016) 3 MIPR 124 : (2016) 67 PTC 324 : (2016) 6 RAJ 386

Hon'ble Judges : Mr. Vipin Sanghi, J.

Bench : Single Bench

Advocate : Mr. Jayant Bhushan, Senior Advocate along with Mr. Aman Singhal, Ms. Zoya Nafis, Ms. Raashi Jain and Mr. Ketan Paul, Advocates, for the Appellant; Mr. Akhil Sibal, Mr. Rupesh Gupta and Mr. Nikhil Chadha, Advocates, for the Respondent

Final Decision : Disposed Off

Judgement

Mr. Vipin Sanghi, J.—The operative part of the order was passed in Court today on this application. I am proceeding to record the summary of my reasons for granting ad interim injunction in favour of the plaintiffs.

2. The case of the plaintiffs is that the plaintiffs are engaged in the business of designing, developing and marketing uniquely and distinctively designed lifestyle footwear for men, women and children. Plaintiffs No. 1 & 2 are incorporated in United States of America, plaintiff No. 3 is incorporated in India and is a marketing arm of plaintiffs No. 1 & 2 in India. The plaintiffs offer their footwear in distinct categories, one of them being the Skechers GOwalk Footwear line. The plaintiffs claim that their product reflects a combination of style, comfort, quality and value that appeals to a broad range of consumers. Its products are sold through department and speciality stores, athletic and independent retailers, boutiques and internet retailers. They are also available on e-commerce websites and their own retail stores. The plaintiffs claim that the consumers are attracted to the plaintiffs shoe designs on account of their youthful brand image and

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fashion-forward designs.

3. In 2011, plaintiff No. 1 introduced and launched its GOwalk series designed for walking and casual wear. The products in the said series offer performance features in a comfortable casual slip-on style. The product line is known for its lightweight and flexible design and promotes natural foot movement while walking. Since the launch of the original GOwalk series, it has evolved through the second and third lines, i.e. GOwalk 2 and GOwalk 3 respectively. The plaintiffs state that the global net sales of GOwalk 3 shoes (part of the GOwalk series) from January 1, 2014 to April 27, 2016 were around USD 308 million (approximately INR 2000 crores) including around USD 200,000 (approximately INR 14 crores) in India. The plaintiffs state that they have sold over 85, 000 pairs of shoes in India during December 2014 to December 2015, and over 37,000 pairs of shoes between January 2016 to March 2016.

4. The plaintiffs use a variety of trademarks and other intellectual property rights, including the mark SKECHERS. The plaintiffs state that GOwalk 3 series has been advertised during 2015-16 through various publications and magazines, such as Best Health, Chatelaine, Optimyz and Women?s Fitness, Men?s Health, Myer Emporium Magazine, Shop Smart Magazine, Vogue, Take 5 Magazine. The Plaintiff No. 1 has also promoted GOwalk 3 series through advertisements in leading newspapers across the globe, including advertisements in Sunday Tasmanian, Herald Sun Newspaper, Women?s Weekly, Wairapa Times, Wanganui Times, NZ Women?s Weekly, Sunday Telegraph, Bay of Plenty Times, Northern Advocate.

5. The plaintiffs also state that the total expense made by them in India in 2015 for marketing and promotion of their products is to the tune of Rs. 9.4 crores. During January 2016 to March 2016, the plaintiffs have incurred promotional expenses to the tune of Rs. 2.55 crores. The advertisements in respect of GOwalk 3 shoes published in Magazines and leading newspapers in India, including Femina and Filmfare.

6. GOwalk 3 incorporates more advanced performance technologies including a high rebound "Goga Mat" insole, adaptive "GO Pillars" on the outsole and "Memory Form Fit" for a custom-fit experience. The identifying distinct features of the GOwalk 3 footwear of the plaintiffs are enlisted as follows:

The positioning of responsive points on the sole of the shoe in distinguishing colors;

Light weight of the shoe;

Side "S" logo of Skechers; and

"Goga Mat" used in the cushioning of the inside sole of the shoe.

7. Apart from claiming exclusive ownership in the trade mark, the plaintiffs also claim exclusive intellectual property in the unique elements and features of its

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GOwalk 3 series of footwear which constitute a distinct trade dress and acts as a unique source identifier of their footwear.

8. On account of the long, extensive and continuous use of the distinctive trade dress by the plaintiffs No. 1 and 2, the use by any other unrelated entity of the same, similar or deceptively similar trade dress would cause, and is likely to cause in the mind of the consumer, and the trade, a connection, affiliation or association with the plaintiffs No. 1 and 2.

9. The grievance of the plaintiffs against the defendants is that they have introduced, and are marketing footwear which are exact replica and look-alikes of the footwear designed, sold and marketed by the plaintiffs under GOwalk 3 series. The grievance of the plaintiffs is that unique and distinct elements and features comprising the trade dress of the plaintiffs? footwear sold under GOwalk 3 series have been copied by the defendants, aimed at misleading, confusing, and causing deception to the public and members of the trade as to the source of origin of their footwear, and to claim a false association with the plaintiffs, resulting in passing off their produces by the defendant, as those of the plaintiffs. Apart from producing photographs of the similar products, i.e. the plaintiffs products sold under the GOwalk 3 series and the similar products of the defendant, the original shoes were also produced before the Court by the plaintiffs to enable this Court to see for itself and assess whether the defendants have adopted a near identical trade dress to that of the plaintiff, which is likely to cause confusion amongst consuming public with regard to the source from where the defendants products originate. Though the plaintiffs have set out in their plaint the comparison of several models/products, I may for the present purpose only take note of some of them. Some of these photographs showing the comparison and the plaintiffs averments in relation thereto are as follows:

Plaintiff

Defendant?s

The Plaintiffs? shoe has a very distinctive and unique outsole with responsive rebound Go Pillars technology.

The visual characteristics of the outsole have been copied identically in the Defendant?s shoe including the positioning of Go Pillars (aesthetically if not technically).

Plaintiff

Defendant?s

The Plaintiffs? shoe has a very peculiar mid sole with multiple linings and stitching. The ?S? logo of the Plaintiffs has been placed on the right side of the shoe towards the end.

The position of the linings and stitching on the mid sole has been copied on the Defendant?s shoe. In fact the position of placing the logo has also been copied.

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Plaintiff

Defendant?s

The Plaintiffs? shoe has a very distinctive get up at the back end of the shoe. The triangular hole and u-shaped lining and a creative patch have been distinctively designed.

The back end of the Defendant?s shoe is a blatant copy of the Plaintiffs? shoe. The triangular hole has been identically cut and the linings and stitching at the back end along with the U-shaped patch are also identical to the Plaintiffs? shoe.

Plaintiff

Defendant?s

The insole of the Plaintiffs? shoe has been designed using Skechers Goga Mat Technology with responsive feedback and the heel is designed with Skechers Memory Form Fit.

The insole of the Defendant?s shoe is a blatant copy of the visual features of the Plaintiffs? shoe.

Plaintiff

Defendant?s

Plaintiff

Defendant?s

10. Mr. Bhushan, learned senior counsel for the plaintiffs submits that the present is a passing of action in relation to the trade dress on the plaintiffs goods which is unique and is clearly a source identifier. In support of his submissions, Mr. Bhushan has placed reliance on the judgment in Colgate Palmolive Company & Anr. v. Anchor Health and Beauty Care Pvt. Ltd., 2003 (27) PTC 478 (Del), and Gorbatschow Wodka KG v. John Distillers Limited, 2011 (47) PTC 100 Bom.

11. In Colgate (supra), the Court after referring the detailed submissions of the parties and taking note of the decisions relied upon on other side observed as follows:

"52. It is the overall impression that customer gets as to the source and origin of the goods from visual impression of colour combination, shape of the container, packaging etc. If illiterate, unwary and gullible customer gets confused as to the source and origin of the goods which he has been using for longer period by way of getting the goods in a container having particular shape, colour combination and getup, it amounts to passing off. In other words if the first glance of the article without going into the minute details of the colour combination, getup or lay out appearing on the container and packaging gives the impression as to deceptive or near similarities in respect of these ingredients, it is a case of

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confusion and amounts to passing off one''s own goods as those of the other with a view to encash upon the goodwill and reputation of the latter".

12. In Gorbatschow (supra), it was the shape of the vodka bottle which gave rise to the controversy in the proceedings. The plaintiff brought a quia timet action to restrain the defendant from launching its product in a bottle having the shape similar to that of the plaintiffs for vodka. The plaintiffs alleged that the defendant had adopted a deceptive variation of the shape of the bottles of the plaintiffs. The word mark of the defendant was, however, markedly different from that of the plaintiff. Salute in respect of its vodka. The Court found that the shape of the defendants bottle for vodka was similar to that of the plaintiffs. The Court reiterated the well-settled legal position of law as follows:

"18. Now, it is a well settled principle of law that in considering as to whether the mark of the Defendant bears a distinctive similarity to the mark of the Plaintiff, the Court must have due regard to the overall impact of the rival marks. In Hiralal Prabhudas v. Ganesh Trading Co., a Division Bench of this Court, after citing precedents formulated the test that must be applied thus:

"What emerges from these authorities is (a) what is the main idea or salient features, (b) marks are remembered by general impressions or by some significant detail rather than by a photographic recollection of the whole,(c) over similarity is the touchstone, (d) marks must be looked at from the view that first impression of a person of average intelligence and imperfect recollection, (e) overall structure, phonetic similarity and similarity of idea are important and both visual and phonetic tests must be applied, (f) the purchaser must not be put in a state of wonderment, (g) marks must be compared as a whole, microscopic examination being impermissible, (h) the broad and salient features must be considered for which the marks must not be placed side by side to find out difference in design and (i) overall similarity is sufficient. In addition, must also be taken into consideration the nature of the commodity, the class of purchasers, the mode of purchase and other surrounding circumstances."

Consequently, what the Court must consider, prima facie, at this stage, are the broad and salient features of the two rival shapes. A meticulous attempt to find differences in the two shapes on a comparison side by side is impermissible.

... ... The Defendant has no explanation whatsoever for adopting that design. The fact that the Defendant made enquiries prior to the registration of the mark can provide no answer in the facts of this case. The Defendant is engaged in the same trade and it is impossible to accept that the Defendant would not have been conscious of the shape which was used by the Plaintiff for its bottles of Vodka both internationally and in India.

The adoption of the shape by the Defendant is prima facie not honest ....".

13. The Court relied upon John Haig and Company Limited v. Forth Blending Company Limited, 70 RPC 259, wherein it had been, inter alia, observed:

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"If the goods of a trader have, from the peculiar mark or get-up which he has used, become known in the market by a particular name, the adoption by a rival or second trader of any mark or get-up which will cause his goods to bear the same name in the market is a violation of the rights of the first trader

The action of a trader who copies a rival''s established get-up need not be fraudulent, and he need have no intention of obtaining any benefit from his rival''s goodwill and reputation - indeed he may be ignorant of his existence - but if the result of his innocent action are that the public are likely to be misled, he will be interdicted, per Halsbury, L.C., in Cellular Clothing Coy. Ltd. v. Maxton & Murray (supra) at p. 31. If, however, the Court is satisfied that the trader who is sued intended to obtain some benefit from his rival''s established get-up and was thus fraudulent, the Court will be more ready to grant interdict, "Kerly", p. 576. The same principle was applied by the House of Lords in Reckitt & Colman Products Limited v. Borden Inc., 1990 (13) R.P.C. 341. In a judgment of the High Court of Ontario in Jay-Zee Food Products Inc. v. Home Juice Co. Ltd., 32 C.P.R. (2d) 265, a similar principle was applied while granting an interlocutory injunction:

"In my view, there is really no doubt that the use of the two bottles in the same area for the same business must cause confusion between the wares and business of the two companies. The combination of the ears, the shape of the bottle and the circle with the leaves would lead any but the most sophisticated observer to the conclusion that the products in either bottle emanated from the same source."

14. Reliance was also placed on Kemp and Company v. Prima Plastics Ltd., 2000 PTC 20 96 (Bom). In this decision, the learned Judge observed:

"If the Plaintiff has to succeed on the ground of passing off, he must show something more than mere similarity between the goods. Exceptions apart, where an article is shaped in an unusual way not primarily for giving same benefit in use or for any other practical purpose, but capricious in order purely to give an article a distinctive appearance, characteristic of that particular manufacturer''s goods, a case may be made out by the Plaintiff that he has reputation and goodwill in the distinctive appearance of the article itself which could provide him a cause of action in passing off if his goods were copied."

15. On the other hand, the submission of learned counsel for the respondents Mr. Akhil Sibal, firstly, is that there is a vast price difference in the products of the plaintiff and those of the defendant. He submits that the word mark is also completely different, as the plaintiff uses SKECHERS with its unique logo, whereas the defendants use PURE PLAY that their distinct logo. Thus, there is no likelihood of confusion. Mr. Sibal submits that the word mark of the parties are printed inside the sole of the shoes. Therefore, any consumer who goes to buy shoes cannot, but, see the word mark prominently. Mr. Sibal submits that the texture of the materials used in making the shoes in question is common to

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trade. The plaintiffs products have the texture of a wiremash on the shoe upper, which is used by several other manufacturers. Mr. Sibal submits by reference to the printouts from the defendants website that the manner of display of the defendants shoes does not betray the intention of the defendant to mislead or confuse the public at large. He submits that even the defendants shoes are not amongst the cheapest and, thus, the consumers who buys the said shows would do so with full consciousness and knowledge. He further submits that the shoes of the plaintiffs, and those of the defendant are sold in dedicated store. Therefore, the consumer interested in buying plaintiffs shoes would go to the plaintiffs exclusive stores, whereas those consumers who are interested in buying the defendants shoes would go to their exclusive stores-thereby eliminating any possibility of any confusion. Mr. Sibal submits that in Gorbatschow (supra), the rights in the unique bottle shape of the plaintiff had been got registered in several jurisdictions, and in India, the application for registration of the plaintiffs design was pending. However, in the present case, the plaintiffs have not got their design or trade dress (as a trademark) registered, and no application has been made. He further submits that in Gorbatschow (supra) the action before the Court was initiated before the defendants had launched their product in the market. However, in the present case, the defendants are also well-entrenched in the market, and are selling their products. Mr. Sibal submits that in the seize and desist notice issued by the plaintiffs on 09.03.2016, the figures with regard to its sales of GOwalk series shoes was disclosed by the plaintiffs as "Over a million GOwalk shoes have been sold worldwide of which around 35,000 have been sold in India alone". However, the figure mentioned in the present application is different, and appears to be inflated.

16. Mr. Sibal has also sought to place reliance on the judgment of the Division Bench of this Court in Kellogg Company v. Pravin Kumar Bhadabhai & Anr., ILR (1996) II Delhi 11. In this case, while taking note of Kerly?s Law on trademarks, the Court observed that cases of passing off, premised on get up or trade dress, are rather few, since traders do not rely on get up alone to distinguish their goods. The trade names or word marks are ordinarily present too. The Division Bench also referred to Fiasons Limited v. EJ Gottwin, 1976 RPC 653 (3). In this case, the items in question were grow-bags. The word mark affixed on their bags by the parties were distinct. The Court held that it was inconceivable that anyone seeing the defendants grow-bags would fail to observe that it was the product of the defendant, and that an ordinary consumer would not be misled. The Court further held that if the defendants grow-bag had not contained its word mark, or if word marks had not been so prominently displayed, it may have reached a different conclusion. Other similar instances were dealt with by the Division Bench in the said decision. The Court rejected the argument of confusion leading to passing off.

17. Mr. Bhushan, in his rejoinder, by reference to the record, has pointed out that the shoes of the plaintiffs and the defendants are being sold even in the same stores, and it is incorrect to suggest that the shoes of the plaintiffs and the

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defendants are sold only on exclusive stores.

18. Having myself seen the shoes of the plaintiff and compared the same with those of the defendants, I am, prima-facie, satisfied that the visual impression gathered from the trade dress of the competing products is that trade dress of the plaintiffs product is substantially copied by the defendants which is likely to result in confusion. There is every likelihood that an unwary and gullible customer may get confused as to the source of origin of the shoes of the defendants, and may assume that the same come from the source of the plaintiff as the shoes of the defendants have a remarkable resemblance with those of the plaintiffs. No doubt, the trademarks of the plaintiff, i.e. SKECHERS is inscribed on the inner sole of the plaintiffs shoes, and the defendants mark Pureplay is similarly inscribed on the inner sole of the defendants shoes, and there is no similarity in the said two word marks. However, that by itself, does not appear to be sufficient to dispel the possibility of confusion in the mind of an unwary customer. This is, because, the several aspects of trade dress are strikingly similar between the shoes of the plaintiffs and those of the defendants and the overall get up and trade dress is also markly similar. The word marks of the parties are printed on the inner sole, which is not what catches the attention of a consumer looking to buy a stylish shoe. As the plaintiffs themselves state ? and this is evident from a visual examination of the shoes in question, the "selling point" of these shoes in their catchy colour combinations, and texture combinations, coupled with their cuts and stitching styles. It is these features that would catch the attention of the consumer and it is likely that the consumers ? who would be youngsters more often than not, would overlook the labels printed inside the shoe sole which contain the word marks. So far as the logos of the parties are concerned, though they are printed on the sides of the shoe uppers, they are not all that prominent, as to immediately strike to the mind of a consumer. The logos, by themselves, may not even cause brand recall to the consumers.

19. The two logos of the plaintiffs and the defendant, as affixed on the sides of the shoe uppers of the respective parties are not the prominent and striking features in the overall trade dress of either of the parties. The submission of learned counsel for the defendant, premised on the different word marks of the plaintiffs and the defendant is answered in Colgate (supra) in the following words:

"56. ... ... It is the unwary, illiterate and gullible persons who determine by arriving at a conclusion whether the infringed goods are confusingly similar in colour combination, get up, lay-out printed over the container or packing. If it is not so then the offence of passing off will cease to have its existence once the guilty party chooses a different trade name.

57. Words "Colgate" and "Anchor" are distinct and have not an iota of similarities either in look or in sound. That is why the ingredients of trade dress, get up, colour combination, lay out of the container or packing acquire significance and relevance for determining the offence of passing off. This criteria flows from the

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concept of action of passing off developed over the years that it is the similarities and not the dissimilarities which go to determine whether the action for passing off is required or not. That is why in trademark cases even the deceptive similarities are considered sufficient for infringement of trademark. If similarities of trade dress are substantial from the look of the two goods, it comes within the mischief of passing off".

20. If one were to apply the aforesaid test ? as laid down in Colgate (supra) and Gorbatschow (supra) to the facts of this case, at this stage it would appear that the adoption of several unique features by the plaintiffs on its GOwalk series 3 footwear by the plaintiffs gives their shoes a unique trade dress which acts as a source identifier. The distinctive get up at the back of the shoe with an inverted triangular and stitching/lining in U shape below the said cut, appear to be completely capricious and prima-facie cannot be described as functional. The very distinctive and unique outsole, and suspension rebound go pillars on the sole have been completely copied by the defendant.

21. The onus would lie heavily on the defendant to explain as to why the defendants have adopted the strikingly similar get up and trade dress in respect of their shoes as that of the plaintiffs. Prima-facie, at this stage it can be said that the defendants shoes are a result of a conscious and substantial imitation of the colour combination, textures, style, cut and stitching of the plaintiffs shoes. The copying of - what the plaintiffs describe as the "responsive rebound go pillars technology", by the defendants on the soles of their shoes, in my view, is a give-away of the defendants attempt to copy the plaintiffs trade dress.

22. Prima facie, reliance placed on Kellogg (supra) appears to be misplaced, as, in that case the Court did not consider the trade dress to be confusingly and deceptively similar, and the word marks were prominently displayed. The price difference argument does not impress me because, even according to the defendant, its shoes are also expensive ? though not expensive as those of the plaintiff. The shoes of both parties, prima facie, appear to be sold, inter alia, at same stores.

23. I am, thus, inclined to injunct the defendants, as the continued impugned activity of the defendants would cause prejudice to the plaintiffs on a day to day basis. However, it is made clear that the above view is a tentative view, and would not come in the way of the Court forming its view upon hearing of the above application.

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