

BY EMAIL/DoT Website

Government of India
Ministry of Communications
Department of Telecommunications
Sanchar Bhawan, 20, Ashoka Road, New Delhi - 110 001
(Data Services Cell)

No. 813-07/LM-06/2023-DS-II

Dated:01.03.2023

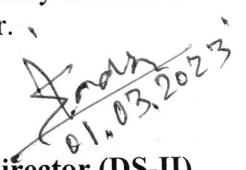
To,
All Internet Service Licensees'

Subject: CS (Comm) No. 104 of 2023; New Balance Athletics Inc. v. Ashok Kumar & Ors.
Before Hon'ble Delhi High Court

Kindly find the enclosed Hon'ble Delhi High Court order dated 24.02.23 on the subject. The said order is, in inter-alia, for compliance of para 19(j) in respect of blocking of following **ONE(01) website** mentioned in **para 11** of the said court order.

(i) www.luxurytag.in

3. Accordingly, in view of the above, all the Internet Service licensees are hereby notified to take immediate necessary blocking action for compliance of the above Court order.


Director (DS-II)

Tel: 011-2303 6860

Email: dirds2-dot@nic.in

Encl: A/A

Copy to:

- (i) Sh. V.Chinnasamy, Scientist E (chinnasamy.v@meity.gov.in), Electronics Niketan, Ministry of Electronics and Information Technology (MeitY) New Delhi for kind information and necessary action.
- (ii) Sh. Anubhav Chhabra, Sujata Chaudhri IP Attorneys, Counsel for the plaintiff (Anubhav@sc-ip.in,) for kind information along with technical limitation in blocking at ISPs.
- (iii) IT wing of DoT for uploading on DoT website.

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

+ CS(COMM) 104/2023 & I.A. 3739/2023, I.A. 3740/2023, I.A. 3741/2023, I.A. 3742/2023

NEW BALANCE ATHLETICS INC. Plaintiff
Through: Mr. Urfee Roomi, Ms. Janaki
Arun and Mr. Anubhav Chhbhra, Advs.

versus

ASHOK KUMAR & ORS. Defendants
Through: None

CORAM:
HON'BLE MR. JUSTICE C. HARI SHANKAR

ORDER

% **24.02.2023**

I.A. 3740/2023 2023 (under Order XI Rule 1(4) of CPC)

1. This application seeks permission to file additional documents.
2. The plaintiff is permitted to place additional documents on record in accordance with Order XI Rule 1(4) of the Code of Civil Procedure, 1908 (CPC) as amended by the Commercial Courts Act, 2015 within 30 days from today.
3. The application stands disposed of accordingly.

I.A. 3741/2023 (Exemption)

4. Subject to the plaintiff filing legible copies of any dim or illegible documents on which it may seek to place reliance within four weeks from today, exemption is granted for the present.
5. The application is allowed accordingly

I.A. 3742/2023 (under Section 12A of the Commercial Courts Act, 2015)




6. In view of the judgment of the Division Bench of this Court in *Chandra Kishore Chaurasia v. R.A. Perfumery Works Pvt Ltd*¹, exemption is granted from the requirement of pre-institution mediation under Section 12A of the Commercial Courts Act.

7. The application stands allowed accordingly.





CS(COMM) 104/2023

8. The plaintiff is aggrieved by the sale of counterfeit products, by unknown defendants, who have posted their products on websites, the WHOIS details of which are masked. The plaintiff has, therefore, not been able to identify the registrants of the websites over which the impugned products are being sold and has, therefore, impleaded them in an omnibus fashion as “Ashok Kumar”, the local cousin of John Doe.

9. The plaintiff claims to have commenced using the “NEW BALANCE” trade mark in the U.S. in 1951, and, in India, both as word mark and device mark since 1986. The plaintiff is the holder of the following registrations in India:

S. No.	Mark	Reg.No.	Class	Registration Date	Renewed Until
1		472335	25	May 18, 1987	May 18, 2028
2		768874	25	September 10, 1997	September 10, 2027
3		1537347	25	March 6, 2007	March 6, 2027

¹ 2022 SCC OnLine Del 3529
CS(COMM) 104/2023





4		472334	25	May 18, 1987	May 18, 2027
5		525286	18	February 27, 1990	February 27, 2024
6		706035	18	May 20, 1996	May 20, 2026
7		1637760	25	January 3, 2008	January 3, 2028
8	NEW BALANCE	472336	25	May 18, 1987	May 18, 2028
9	NEW BALANCE	525511	18	March 2, 1990	March 2, 2024

10. The plaintiff claims, in February 2023, to have become aware of the fact that, on the website of www.luxurytag.in, duplicate products, mimicking the products of the plaintiff's and using identical device marks, were being sold. To the credit of the owners of the said website, it must be said that they have been upfront with respect to their unwholesome intentions, and have declared, in so many words, on their websites, that they sell only replica and duplicates and that no original products are available on the website.

11. *Prima facie*, therefore, there is no dispute about the fact that the unknown defendants, operating over the websites www.luxurytag.in are indulging in counterfeiting of the products of the plaintiff.

12. The plaintiff has also placed on record various judicial orders, whereby its marks have been accorded protection by this Court.

13. In these circumstances, the plaintiff has moved this court by means of the present suit, seeking, essentially, an injunction against the defendants from using, in any manner, the plaintiff's registered

mark  ,  ,  ,  and “NEW BALANCE”, apart from ancillary reliefs of declaration, rendition of accounts, delivery-up and costs and damages.

14. In the circumstances, let the plaint be registered as a suit.

15. Issue summons in the suit.

16. Written statement, accompanied by affidavit of admission and denial of the documents filed by the plaintiff be filed within 30 days with advance copy to learned Counsel for the plaintiff who may file replication thereto, accompanied by affidavit of admission and denial of the documents filed by the defendants within 30 days thereof.

17. List before the learned Joint Registrar (Judicial) for completion of the pleadings, admission and denial of documents and marking of exhibits on 23rd March 2023, whereafter the matter would be placed before the Court for case management hearing and further proceedings.

I.A. 3739/2023 (under Order XXXIX Rules 1 and 2 of CPC)

18. By this application, under Order XXXIX Rules 1 and 2 of the Code of Civil Procedure, 1908 (CPC), the plaintiff seeks interim injunctive and directive reliefs.

19. The prayer clause in the application reads thus:

“32. The Plaintiff/Applicant, therefore, respectfully prays that the following reliefs be granted in its favour:

a) An order for interim injunction restraining the

Defendant/Non- Applicant No. 1, its proprietor(s) or partner(s) employees, agents, dealers, licensees, companies, retailers, wholesalers, distributors or any persons/entities that are under the control of the Defendant/Non-Applicant No. 1 or is related or affiliated to the Defendant/Non-Applicant No. 1, as the case may be, and all others, acting for and on behalf of the Defendant/Non-Applicant No. 1, from offering for sale, selling, displaying, advertising, marketing, whether directly or indirectly, and whether on the Internet or otherwise, footwear and any other similar/ related/ allied/ cognate goods bearing the Plaintiffs Marks (as depicted in paragraph 4) and marks that incorporate the Plaintiffs Marks or any other mark that is identical/deceptively similar to the Plaintiffs NEW BALANCE, N Device and NB Device marks (as defined in paragraph 2 above);

b) An order for interim injunction restraining the Defendant/Non Applicant No. 1, its proprietor(s) or partner(s) employees, agents, dealers, licensees, companies, retailers, wholesalers, distributors or any persons/entities that are under the control of the Defendant/Non-Applicant No. 1 or are related or affiliated to the Defendant/Non-Applicant No. 1, as the case may be, and all others, acting for and on behalf of the Defendant/Non-Applicant No. 1 from passing off the Plaintiffs NEW BALANCE, N Device and NB Device marks (as defined in paragraph 2 above);

c) An order directing the Defendant/Non-Applicant No.2 to provide contact details/addresses of the Defendant/Non-Applicant No. 1 and lock/deactivate/cancel/block/disable/suspend access to the domain name LUXURYTAG.IN, and any other domain name found during the proceedings to have been engaging in or carrying out fraudulent activities by infringement of the Plaintiffs Marks;

d) An order directing Defendant/Non-Applicant No. 3 to provide complete details complete details of the particulars of owners/operators of Defendant/Non-Applicant No. 1 's website located at www.luxurytag.in registered in its database to this Hon'ble Court and the Plaintiff/Applicant's Indian representatives;

e) An order directing the Defendant/Non-Applicant No. 4 to provide details of the mobile number, (+91) 7750098927, to the Hon'ble Court and the Plaintiff/Applicant's Indian representatives;

f) An order directing the Defendant/Non-Applicant No. 5 to suspend/freeze the bank account associated with

the UPI ID cca.136404(a)icici and Transaction ID 303495360758 and furnish the details of account holders of the bank account to this Hon'ble Court and the Plaintiff/Applicant's Indian representatives;

g) An order directing the Defendant/Non-Applicant No.6 to furnish details of the owners/operators of Defendant/Non-Applicant No. 1 's website located at www.luxurytag.in registered in its database to this Hon'ble Court and the Plaintiff/Applicant's Indian representatives;

h) An order directing the Defendant/Non-Applicant No. 7 to suspend/block the WhatsApp account, linked with the mobile number (+91)7750098927, and to provide complete details of the owner of the WhatsApp account linked with mobile number (+91)7750098927 to this Hon'ble Court and the Plaintiff/ Applicant's Indian representatives;

i) An order directing the Defendant/Non-Applicant No. 8 to suspend/block the access to Shiprocket Engage software provided to Defendant/Non-Applicant No.1 and provide complete details of the particulars of Defendant/Non-Applicant No.1 registered with Defendant/Non-Applicant No.8 to this Hon'ble Court and the Plaintiff/Applicant's Indian representatives;

j) An order directing the Defendant/Non-Applicant Nos. 9 and 10 to issue a notification calling upon the Internet Service Providers and Mobile Network Operators registered under it to block access to the Defendant/Non-Applicant No. 1 's website and any other domain names discovered during the proceedings to have been engaging in or carrying out fraudulent activities by infringement of the Plaintiffs Mark;

k) An order and decree directing the Defendant/Non-Applicant No. 11 to cancel the domain registrations of the Defendant/NonApplicant No. 1, and to provide contact details/addresses of the Defendant/Non-Applicant No.1 to this Hon'ble Court and the Plaintiff/ Applicant's Indian representatives;

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

20. In the above circumstances, issue notice, returnable on 25th April, 2023 before the Court.

21. Reply be filed within four weeks with advance copy to learned Counsel for the plaintiffs, who may file rejoinder thereto, if any, within four weeks thereof.

22. Till the next date of hearing, there shall be *ad interim* directions in terms of prayers (a), (c), (d), (e), (f), (g), (h), (i) and (j) of the application as reproduced hereinabove.

23. Let the plaintiff comply with the requirement of Order XXXIX Rule 3 of the CPC within one week from today.

C. HARI SHANKAR, J.

FEBRUARY 24, 2023

dsn

Email**Abhinesh Meena**

Fwd: New Balance Athletics Inc. v. Ashok Kumar & Ors. [CS(COMM) No. 104/2023]

From : Subodh Saxena Director DS II <dirids2-dot@nic.in>

Wed, Mar 01, 2023 11:10 AM

 2 attachments**Subject :** Fwd: New Balance Athletics Inc. v. Ashok Kumar & Ors. [CS(COMM) No. 104/2023]**To :** Abhinesh Meena <abhinesh.meena@gov.in>

With regards,
Subodh Saxena, ITS
Director(DS-II), DoT, New Delhi

Room no.- 303, third floor, Sanchar Bhawan, 20 Ashoka Road, New Delhi- 110001
Ph: [+91-11-23036860](tel:+91-11-23036860) (O), Fax: [+91-11-23359454](tel:+91-11-23359454) (O), Mo: [9869421900](tel:9869421900)

From: Anubhav@sc-ip.in**To:** "K Rajaraman" <secy-dot@nic.in>, "Subodh Saxena Director DS II" <dirids2-dot@nic.in>, "Cyberlaw and eSecurity.MeitY" <cyberlaw@meity.gov.in>, gccyberlaws@meity.gov.in, "Prafulla Kumar" <pkumar@meity.gov.in>, "Dr S Sathyanarayanan" <sathya.s@meity.gov.in>**Cc:** urfee@sc-ip.in, janaki@sc-ip.in, jaswant@sc-ip.in, jitender@sc-ip.in, records@sc-ip.in**Sent:** Tuesday, February 28, 2023 8:47:18 PM**Subject:** RE: New Balance Athletics Inc. v. Ashok Kumar & Ors. [CS(COMM) No. 104/2023]

WITHOUT PREJUDICE

-
New Balance Athletics Inc. v. Ashok Kumar & Ors. [CS(COMM) No. 104/2023]

To:

Department of Telecommunications and Ministry of Electronics and Information Technology
(Defendant No. 9 and 10)

Sir/Ma'am,

We write on behalf of New Balance Athletics Inc., a company incorporated under the laws of the State of Massachusetts, United States of America, with a place of business at 100 Guest Street, Boston, Massachusetts, 02135-2088, United States of America, the Plaintiff in the above-mentioned matter.

The Plaintiff had instituted the above-mentioned suit for permanent injunction restraining trademark infringement, passing off, acts of unfair competition, seeking damages/rendition of accounts and other appropriate relief against Defendant No.1 (noted in the Memo of Parties), before the Hon'ble High Court, Delhi.

As you may know, the case was listed before the Hon'ble Court on February 24, 2022 and the Hon'ble Judge has passed an *ex-parte ad interim* injunction restraining Defendant No.1 (as given in the Memo of Parties) as well as any other entity acting through them or on their behalf from using the registered NEW BALANCE, N Device and NB Device trademarks of the Plaintiff in any manner, whatsoever including by reflecting the said marks on their website at any point or position and from operating through the website located at www.luxurytag.in .

Furthermore, you have been directed by the Hon'ble Court to issue a notification calling upon the Internet Service Providers and Mobile Network Operators registered under it to block access to the Defendant No. 1 's website and any other domain names discovered during the proceedings to have been engaging in or carrying out fraudulent activities by infringement of the Plaintiff's Mark;.

As required under law, we are serving the copies of the plaint, applications and documents, which are available at <https://we.tl/t-O9FyIarVzx>.

Please note that the matter is fixed for hearing before the Hon'ble Delhi High Court on **April 25, 2023**. The matter is also listed before the Joint Registrar on **March 23, 2023**.

All of the Plaintiff's rights are reserved in the meanwhile.

Best Regards,

Anubhav Chhabra
He | Him | His
Associate




2106 Express Trade Towers 2, First Floor, B-36, Sector 132,
Expressway, NOIDA 201301, Uttar Pradesh, India.
Email: anubhav@sc-ip.in | Phone: +91-120-6233100 | Web: www.sc-ip.in



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 **Order 24-02-2023.pdf**
99 KB

1337 Services LLC

100 King St W,

Toronto, Ontario

Email : Requests@1337services.ca

... Defendant No.3

Bharti Airtel Limited

Airtel Center

Plot No. 16, Udyog Vihar

Phase IV Gurgaon, Haryana

Phone: +91-124-4222222

Email: compliance.officer@bharti.in

... Defendant No. 4

ICICI Bank Limited

ICICI Bank Tower

Near Chakli Circle, Old Padra Road Vadodara

Gujarat-390007 IN

Email: customer.care@icicibank

... Defendant No. 5

Infibeam Avenues Limited

28th Floor, Gift Two Tower,

Block No. 56, Road 5C, Zone 5,

Gift City, Gandhinagar - 382355. Gujarat, India.

Email: contact@ccavenue.com

nodalofficer@ccavenue.com

... Defendant No. 6

WhatsApp LLC

1601 Willow Road

Menlo Park

California 94025

Email: ip@whatsapp.com

... Defendant No. 7

BigFoot Retail Solution Pvt. Ltd.

Plot No- B, Khasra No- 360

Sultanpur, South Delhi

Delhi-110030

Email: grievance@shiprocket.com

... Defendant No.8

Department of Telecommunications

Through Secretary

Ministry of Communications and IT

20, Sanchar Bhawan, Ashoka Road

New Delhi – 110001

Email: secy-dot@nic.in; dir2-dot@nic.in

... Defendant No. 9

Ministry of Electronics and Information Technology

Through the Director General (DIT) Cyber Laws & E-security)

Electronics Niketan, 6, CGO Complex

Lodi Road, New Delhi – 110003

Email: cyberlaw@meity.gov.in; gccyberlaws@meity.gov.in;

pkumar@meity.gov.in; sathya.s@meity.gov.in

...Defendant No. 10


National Internet Exchange of India

6C,6D,6E

Hansalaya Building 15

Barakhamba Road
New Delhi – 110001
Email: info@nixi.in

... Defendant No. 11


URFEE ROOMI
Advocate [D/817/2017]
of SUJATA CHAUDHRI IP ATTORNEYS
Advocates for Plaintiff
2106 Express Trade Towers 2, First Floor
B-36, Sector 132 Expressway
Noida – 201301 (UP)
Mob. +919818098835
Mob. +919811600017
Email – trademarks@sc-ip.in

PLACE: New Delhi
DATE: February 23, 2023

The defendant No. 1 is the main contesting defendant.
The defendant No. 1 is a John Doe defendant, and the plaintiff don't have complete details of the defendant No. 1 kindly list as it is.