

BY EMAIL

**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-14/2022-DS-II

Dated: 18-04-2022

To,

All Internet Service Licensee's

Subject: CS (Comm.) No. 230 of 2022 titled as Asics Corporation vs. Ashok Kumar and Ors. Before DJ(Comm.)-02, South District, Saket Courts, New Delhi

Kindly find the enclosed DJ(Comm.)-02, South District, Saket Courts, New Delhi order dated 07th April, 2022 in the subject matter court case CS (Comm.) No. 230 of 2022 along with website/URL (**<https://www.sastajoota.com>**) of defendant no.1 as per memo of parties for compliance. DoT is defendant No. 2 in this case.

2. Hon'ble Patiala House Court, New Delhi vide order dated 07th April, 2022 has, inter alia, directed that:

*15. D-2 and D-3 shall take necessary steps at their end to ensure blocking of the website **www.sastajoota.com** and/or mirror/re-direct/alphanumeric websites, which are put in play by D-1 to conduct any trademark infringement and/or counterfeiting activities under the plaintiff's aforementioned trademarks.*

3. Accordingly, in view of the above, all the Internet Service licensees are hereby instructed to take immediate necessary action for compliance of the court order dated 07.04.2022 with respect to website/URL of defendant no. 1.

Encl: A/A

**Director (DS-II)
Tel: 011-2303 6860
Email: dirds2-dot@nic.in**

विनय कुमार खन्ना
VINAY KUMAR KHANNA
जिला न्यायाधीश
District Judge
(वाणिज्यिक न्यायालय)-02
(Commercial Court)-02
दक्षिण कक्ष सं. 503, पाँचवा तल
South, Room No 503, Fifth Floor
साकेत कोर्ट परिसर, नई दिल्ली
Saket Court Complex, New Delhi

**IN THE COURT OF DISTRICT JUDGE (COMM-02),
SOUTH DISTRICT, SAKET COURTS, NEW DELHI**

CS(Comm) 230/2022

Asics Corporation

..... Plaintiff

Vs




Ashok Kumar & Ors.


..... Defendants


07.04.2022

Present : Mr. Shivang Bansal and Mr. Dharendra Singh, counsels for
the plaintiff


1. The present suit has been filed by the plaintiff under section 134 & 135 of The Trade Marks Act, 1999 and Section 51 & 55 of The Copyright Act, 1957 for permanent injunction restraining infringement of trade mark/copyright, passing off, delivery up, damages and rendition of accounts, etc. against the defendants.


2. Heard submissions on the application U/o XXXIX Rule 1 & 2 CPC. Plaintiff's case, in brief, is that it is involved in the business of manufacturing and selling of sports shoes, apparels, socks, hats, gloves, bags, towels, sports equipment and other related/cognate/allied goods and that it adopted the trade mark /logos ASICS,   in the year 1977 and has been using the same since then with regard to said goods. It is pleaded that the plaintiff is also involved in the manufacturing/sale of said goods under the trade marks ,



**ASICS TIGER ONITSUKA TIGER, GEL-KAYANO, GEL-NIMBUS,
METARUN, MEXICO 66 etc. and in this regard, reliance is placed on**


TM  dated 23.10.1978 in class 25 bearing Registration No.



341997; TM  dated 08.01.1982 in class 25 bearing Registration No.

385150; TM  dated 31.05.1991 in class 25 bearing Registration No.

551897; TM  dated 29.01.2007 in class 25 bearing Registration No.

1525866 and TM  dated 29.01.2007 in class 25, 28, 18 bearing Registration No. 1525868.

3. It is submitted that plaintiff has applied for LPC which will take time and has placed on record the official receipt issued by the Trade Mark Registry in that regard and a copy of the trademark registration certificate has been filed alongwith the latest status report from the website of Trademark Registry and copy of trademark journal has been filed. It is submitted that there are no disclaimers imposed on the mark and the mark stands renewed till date.

4. It is pleaded that the artwork involved in the above logos is original artistic work and protected under the Copyrights Act, 1957. It is submitted that plaintiff also has many global registrations and that the said goods of the plaintiff are sold through retail, e-commerce platforms like www.amazon.com, www.ajio.com, www.flipkart.com and www.myntra.com and plaintiff's own interactive Website <https://www.asics.com/in/en-in> accessible and available in jurisdiction of this court. It is further submitted that the plaintiff has widely advertised its said goods under the said trade marks/labels through print, electronic and digital media including social media platforms, through product placements and eminent bollywood celebrities.

5. Plaintiff's case further is that on account of long continuous use, the said trade marks/labels have acquired enviable and enduring goodwill, reputation and users, in the international markets including in



India and in this regard reliance is placed on list of global trade mark registrations, i.e. Promotional material; Sale/promotion of Plaintiff's said goods on e-commerce platform and Financial Statements.

6. Plaintiff's case further is that defendant no. 1 is carrying on violative/infringing/counterfeiting activities by manufacturing and selling counterfeit footwear including sports shoes, casual shoes, slippers, etc. through its website www.sastajoota.com. It is submitted that the particulars of defendant no. 1 is unknown and has been addressed as "Ashok Kumar" and defendant no. 1 is blatantly mentioning on its website that they are dealing in "first copy", "7A Quality", etc. of the plaintiff's goods. It is further submitted that defendant no. 1's act thus constitutes infringement of plaintiff's said trade marks, infringement of artwork involved in plaintiff's said logos, passing off, unfair competition and counterfeiting and in this regard, reliance is placed on screen shot of defendant no. 1's website; defendant no. 1's admission that he/they sell first copy/replica and Comparison of plaintiff's goods vis-à-vis defendant's goods shows the similarity in the products. It is submitted that name of D-1 shall be substituted by the person(s) after the disclosure of its true identity by D-4 and D-5 registrar of domain name and web-hosting service provider respectively. It is further submitted that the plaintiff be granted the liberty to approach this court to add any other rogue websites which are infringing the plaintiff's aforementioned trademarks or selling its counterfeit goods.

7. It is pleaded that Department of Telecommunications (DOT) has been arrayed as defendant no. 2 and Ministry of Electronics and Information Technology (MeitY), Government of India, is impleaded as defendant no. 3, who have the requisite powers and jurisdiction to block



the websites by directing all Internet Service Providers (ISPs) operating in India. It is submitted that an ISP provides the consumer access to the Internet in order to view different and various websites and URL(s) by virtue of license agreement with DOT and/or MeitY. It is stated that DoT and MeitY have been arrayed as a necessary party in the interest of justice and for effective implementation of orders passed by this court. It is submitted that one of the main functions of these government bodies is to deal in matters relating to Cyber Laws, administration of the Information Technology Act, 2000 (21 of 2000) and other IT related laws.

8. Plaintiff's case further is that the defendant no. 4 is the Domain Name Registrar of the website of defendant No. 1. It is stated that defendant no. 5 is the Web Hosting Service Provider of the website of defendant no. 1 that provides technologies and services needed for the website or webpage to be viewed on the Internet and the World Wide Web.

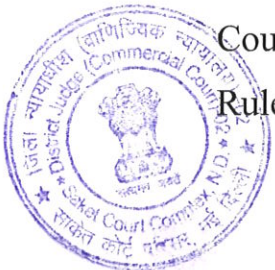
9. It is pleaded that the cause of action against defendant no. 1 arose on 2nd week of February, 2022 when the plaintiff came across the impugned goods of the defendant no. 1 on its website www.sastajoota.com. It is submitted that plaintiff has also made test purchase on 24.02.2022. It is further submitted that this court has territorial jurisdiction to try and adjudicate the present suit under Section 20 of CPC, 1908 since cause of action in whole and/or in part has arisen within the jurisdiction of this court. It is pleaded that the impugned website is interactive, accessible and has been accessed within the jurisdiction of this court. It is further submitted that defendant no. 1 is carrying out its business of infringing/violative/counterfeiting activities



and promotion of its impugned goods through its website within the jurisdiction of this court and its impugned goods are also deliverable within the jurisdiction of this court.

10. It is further submitted that this court also has the jurisdiction within the meaning of Section 134(2) of Trademarks Act, 1999 as well as Section 62(2) of Copyright Act, 1957 since plaintiff is carrying on its business through its own interactive website <https://www.asics.com/> within the jurisdiction of this court and plaintiff also has exclusive store within the jurisdiction of this court at F-58, First Floor, Select City Walk Mall, Saket, Delhi-110017.

11. Ld. Counsel for the plaintiff prays for granting *ex-parte* ad-interim injunction against defendant No. 1 operating through www.sastajoota.com from selling/displaying/manufacturing/marketing of infringing/ violative/ counterfeit goods under the Plaintiff's said trade marks and restraining defendant No. 1 from disposing of its assets; Issue direction to defendant No. 4 & 5 to block/restrict defendant No. 1's website and any other mirror/ redirect/ alphanumeric websites of defendant no. 1; Issue direction to defendant No. 4 & 5 to disclose ownership details of defendant no. 1; Issue Direction to Defendant No. 2 to block the access of the webiste through all Internet Service Providers (ISPs) operating in India; Issue direction to defendant no. 3 to block the access of the webiste through all Internet Service Providers (ISPs) operating in India and ensure that Defendant No. 2 directs all the ISPs; Issue direction to defendant no. 1 to disclose the payments received by sale of impugned goods; To grant liberty to the Plaintiff to approach this Court in accordance with law by filing of applications under Order 1 Rule 10 of the CPC, 1908 to array other rogue websites.



12. In support of his submissions, Ld. Counsel for the plaintiff has relied upon IT Rules, 2021 –(a) Due diligence by an intermediary and (b) Section 3(1)(d) and the following cases, Shreya Singhal v. Union of India, [MANU/SC/0329/2015]; Star India Pvt. Ltd. Vs. Haneeth Ujwal, [MANU/DE/1737/2014] ; Disney Enterprises, INC and Ors. Vs. Kimcartoon.to and Ors. [MANU/DE/1457/2020]; UTV Software Communication and Ors. Vs. 1337X. to and Ors., CS (Comm) 724/2017 dated 10th April 2019].

13. This court has carefully considered the submissions raised and has gone through the accompanying application as well as the documents filed alongwith the plaint, affidavit and statement of truth of Mrs. Meena Bansal, AR of the plaintiff and other material on record. On perusal of the record and hearing the counsel for the plaintiff and in view of the aforesaid reasons, this court is satisfied that the plaintiff has made out a prima-facie case for ex-parte injunction with respect to the allegations of the plaintiff that defendant no. 1 is using the trademarks/logos/label/copyright of the plaintiff. This court is satisfied that balance of convenience are also in favour of the plaintiff which would suffer irreparable loss which cannot be compensated in terms of cost other than injunction.

14. Consequently, defendant nos. 4 and 5 registrar of domain name and web-hosting service provider respectively shall disclose the identity/ownership of the owner(s) of the website www.sastajoota.com of D-1. Further D-4 and 5 are directed to withdraw any support and block/restrain the aforementioned website of D-1 and/or mirror/re-direct/alphanumeric websites, which are put in play by D-1 to conduct




any trademark infringement and/or counterfeiting activities under the plaintiff's aforementioned trademarks till further orders.

15. D-2 and D-3 shall take necessary steps at their end to ensure blocking of the website www.sastajoota.com and/or mirror/re-direct/alphanumeric websites, which are put in play by D-1 to conduct any trademark infringement and/or counterfeiting activities under the plaintiff's aforementioned trademarks.

16. Plaintiff shall comply with the provisions of Order XXXIX Rule 3 CPC.

17. Summons of the suit and notice of the application U/o XXXIX Rules 1 & 2 be issued to the defendants on filing of PF/RC/Speed Post/Courier/E-mail and whatsapp numbers of the defendants, returnable on **09.06.2022**. Copy of this order be also given **dasti** to learned counsel for plaintiff.




(VINAY KUMAR KHANNA)
District Judge
(Commercial Court-02)

South Distt., Saket, New Delhi/07.04.2022

जिला न्यायाधीश
District Judge
(वाणिज्यिक न्यायालय)-02
(Commercial Court)-02
साकेत कोर्ट परिसर, नई दिल्ली
Saket Court Complex, New Delhi