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

\+ CS(COMM) 341/2024

BULGARI S.P.A ..... Plaintiff

Through: Ms. Bitika Sharma, Mr. Rishi Bansal, Ms. Anusha Banerjee and Ms. Janhvi Badoliya, Advocates.

versus

PRERNA RAJPAL TRADING AS THE AMARIS FLAGSHIP STORE ..... Defendant

Through: None.

CORAM:
HON'BLE MR. JUSTICE SANJEEV NARULA

O R D E R

% 29.04.2024

I.A. 9454/2024 *(seeking leave to file and place on record videographic evidence via CD/Pen Drive)*

1. The Plaintiff seeks the leave of the Court to place on record certain video recordings, which form the subject matter of the present suit in a pen drive. Rule 24 of Chapter XI of the Delhi High Court (Original Side) Rules, 2018 makes it clear that electronic records can be received in CD/DVD/Medium encrypted with a hash value. The said Rule is extracted below: -

> "***24. Reception of electronic evidence*** *-A party seeking to tender any electronic record shall do so in a CD/ DVD/ Medium, encrypted with a hash value, the details of which shall be disclosed in a separate memorandum, signed by the party in the form of an affidavit. This will be tendered along with the encrypted CD/ DVD/ Medium in the Registry. The electronic record in the encrypted CD/ DVD/ Medium will be*

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uploaded on the server of the Court by the Computer Section and kept in an electronic folder which shall be labeled with the cause title, case number and the date of document uploaded on the server. Thereafter, the encrypted CD/ DVD/ Medium will be returned to the party on the condition that it shall be produced at the time of admission/denial of the documents and as and when directed by the Court/ Registrar. The memorandum disclosing the hash value shall be separately kept by the Registry on the file. The compliance with this rule will not be construed as dispensing with the compliance with any other law for the time being in force including Section 65B of the Indian Evidence Act, 1872."

2. Registry may receive electronic record on CD-ROM so long as it is encrypted with a hash value or in any other non-editable format. The video recording contained in CD-ROM be placed in the electronic record of the present suit in a format which is non-editable, so that the same can be viewed by the Court during hearing.

3. Application is disposed of.

I.A. 9455/2024 (*u/Order XI Rule 1(4) (as amended by the Commercial Courts Act, 2015) read with Section 151 of the Code of Civil Procedure, 1908)*

4. Exemption is granted, subject to all just exceptions.

5. The application stands disposed of.

I.A. 9456/2024 *(seeking exemption from filing original, clear copies, prayer copies and documents with proper margins)*

6. Exemption is granted, subject to all just exceptions.

7. The Plaintiff shall file legible and clearer copies of exempted documents, compliant with practice rules, before the next date of hearing.

8. Accordingly, the application stands disposed of.

I.A. 9457/2024 *(seeking exemption from invoking pre-institution mediation*

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under Section 12A of the Commercial Courts Act, 2015)

9. As the present suit contemplates urgent interim relief, in light of the judgment of Supreme Court in ***Yamini Manohar v. T.K.D. Krithi,***[1] exemption from attempting pre-institution mediation is granted.

10. Disposed of.

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11. Let the plaint be registered as a suit.

12. Issue summons. Upon filing of process fee, issue summons to the Defendant by all permissible modes. Summons shall state that the written statement shall be filed by the Defendant within 30 days from the date of receipt of summons. Along with the written statement, the Defendant shall also file an affidavit of admission/denial of the documents of the Plaintiff, without which the written statement shall not be taken on record.

13. Liberty is given to the Plaintiff to file a replication within 15 days of the receipt of the written statement. Along with the replication, if any, filed by the Plaintiff, an affidavit of admission/denial of documents of the Defendant, be filed by the Plaintiff, without which the replication shall not be taken on record. If any of the parties wish to seek inspection of any documents, the same shall be sought and given within the timelines.

14. List before the Joint Registrar for marking of exhibits on 30th July, 2024. It is made clear that any party unjustifiably denying documents would be liable to be burdened with costs.

15. List before Court for framing of issues thereafter.

[1] 2023 SCC OnLine SC 1382.

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I.A. 9453/2024 *(u/Order XXXIX Rule 1 & 2 r/w Section 151 of the Code of Civil Procedure, 1908)*

16. Ms. Bitika Sharma and Mr. Rishi Bansal, counsel for the Plaintiff, have presented the following facts and contentions:

16.1. The Plaintiff, Bulgari S.P.A, is an Italian luxury brand specialising in the crafting and trading of innovative jewellery, watches, fragrances, accessories, etc. made from precious materials under different collections. The instant suit pertains to two of the Plaintiff's collections, namely "SERPENTI" and "B.ZERO1", encompassing jewellery such as bracelets, rings, necklaces, and pendants.

16.2. Plaintiff first adopted the trademark "SERPENTI" in the year 1940 in relation to wrist-watches, and later as a hallmark for its jewellery. The trademark "SERPENTI" is derived from ancient Greek and Roman mythology, which represents symbolism of seductive serpents. Further, it is used to depict a motif representing wisdom, vitality, and the circle of life inspired from the snake. The Plaintiff has registrations in respect of the trademark "SERPENTI" in several jurisdictions across the world, details whereof are delineated at Paragraph No. 18 of the plaint.

16.3. Furthermore, the Plaintiff is the owner and proprietor of the trademarks "BVLGARI SERPENTI", "BVLGARI", "BVLGARI BVLGARI" as well as B.ZERO l and SERPENTI variants and formatives. The said marks are utilised in relation to the Plaintiff's goods and business. Plaintiff has also applied for registering the wordmark "SERPENTI" in multiple classes such as 9, 14, 18 and 25. Their application was accepted and advertised by the Trademark Registry on 4th December, 2023 *via* journal

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No. 21330. The opposition period has expired on 4th April, 2024 and till date no opposition has been filed against the said trademark, rendering the application as good as registered. An illustrative list and the details of the Plaintiff's trademark registrations in India are furnished hereunder:

Sr. No.	Trademark	Class	Status	User Since	Application Number	Application Date	Disclaimer
1.	BVLGARI SERPENTI	3, 9, 14, 16, 18, 25 and 35	Protection Granted	Proposed to be used	IRDI-3533784	05/08/2016	NO
2.	SERPENTI (word mark)	9, 14, 18 and 25	Accepted and advertised	Proposed to be used	6018493	13/07/2023	NO
3.	SERPENTI SEDUTTORI	14	Protection Granted	Proposed to be used	IRDI-3448410	05/08/2016	NO
4.	SERPENTI INCANTATI	14	Protection Granted	Proposed to be used	IRDI-3470712	05/08/2016	NO
5.	SERPENTI HYPNOTIC	14	Protection Granted	Proposed to be used	IRDI-3530103	05/08/2016	NO
6.	B.ZERO1	18	Registered	Proposed to be used	4252065	31-Jul-2019	NO
7.	BVLGARI	14	Registered		1208135	20-Jun-2003	NO

16.4. Plaintiff's products are known for their diverse range of novel patterns, placement of stones, vibrant colour combination, ornamentation, and distinctive overall appearance, all of which contribute to the trade dress of the Plaintiff's goods. The trademarks and trade dress of the Plaintiff have acquired distinctiveness and are associated with the Plaintiff without any name or logo appended to it. The goods of the Plaintiff have also obtained immense goodwill and reputation in India.

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16.5. Plaintiff further asserts their rights over the product known as the "Serpenti Ocean Treasure Necklace". The same is a product of meticulous craftsmanship, beginning as a vision expressed as a sketch on paper which is then handcrafted into a three-dimensional finished product. The said product is renowned for its artistic quality – its elements being distinctively placed, having a unique form, shape, manner of depiction and arrangement resulting in a unique original expression. The artwork involved in the Plaintiff's Serpenti Ocean Treasure Necklace is an "original artistic work" within the meaning of the Copyright Act, 1957. The author of the same, i.e. Lucia Silvestri, is a prominent figure in the world of luxury jewellery, particularly renowned for her work with the Plaintiff. The Plaintiff has a copyright registration for the aforesaid in Rome, Italy, where it was first published. Consequently, their copyright in the said artistic work spills over to India by virtue of the Berne Convention for the Protection of Literary and Artistic Works.

16.6. The Defendant, Ms. Prerna Rajpal, the sole proprietor trading as 'The Amaris Flagship Store', is engaged in the business of manufacturing, trading, selling, marketing, advertising, promoting and displaying of gold, silver, diamond, polished and finished jewellery/ ornaments, including bracelets, earnings, necklaces etc. and all types of precious stones/ornaments, through its physical store outlet, website and social media platforms.

16.7. In August 2022, the Plaintiff came to know about the existence of the Defendant through their website, which is accessible at www.amarisjewels.com. On browsing the website, the Plaintiff found that the Defendant has substantially copied the idea, form, manner of depiction,

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arrangement and expression of all the essential elements of the Plaintiff's original artistic work in the aforenoted Serpenti Ocean Treasure Necklace. Further, the Defendant has also copied the pattern ornamentation, placement, colour combination and overall look, get-up and appearance of the trade dress of the Plaintiff's SERPENTI collection.

16.8. The Defendant's actions amount to infringement of the Plaintiff's copyright in the Serpenti Ocean Treasure Necklace as well as passing off of the Defendant's goods as those of the Plaintiff. Pursuant to coming across the Defendant's infringing activities, the Plaintiff issued a cease-and-desist notice dated 4th August, 2022 upon the Defendant, who replied to the same on 18th August, 2022. In their reply, the Defendant acknowledged that they had drawn inspiration from the Plaintiff's designs, however, denied similarity between the goods in question. Nonetheless, the Defendant stated that they have taken off all SERPENTI-related designs from their website and undertook not to promote the same in the future.

16.9. Subsequently, the Plaintiff wrote to the Defendant again, reiterating their rights in the SERPENTI, B.ZERO1 as well as their FIOREVER designs and requesting destruction of the infringing goods, however, received no response, despite following up. In such circumstances, the Plaintiff has approached this Court by way of the instant suit.

17. The Court has considered the aforenoted contentions. For the sake of steady reference, a side-by-side comparison of the competing goods is set out as follows:

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COMPARISON CHART DEPICTING COPYRIGHT INFRINGEMENT AND TRADE DRESS PASSING OFF BY DEFENDANT		
Plaintiff's said goods under the said original artistic work	**Defendant's impugned good under the impugned artistic work**	**Points of imitation of the original artistic works of the Plaintiff**
		➢ The unique shape of a twisted double row diamond set, intertwined like an obvious spiral, giving it a look of a snake's body; ➢ The placement of the snake-head at the centre of the necklace.

18. The Court is *prima facie* satisfied that the Defendant's impugned "Shield-It Necklace", as depicted above, is visually and structurally similar, with similar colour combinations and placement of elements/ ornamentation, to the Plaintiff's Serpenti Ocean Treasure Necklace. Plaintiff has set out a strong *prima facie* case of infringement of their copyright in the Serpenti Ocean Treasure Necklace on the basis of the copyright registration that they have secured in Italy. Since India is also a signatory to the Berne Convention for the Protection of Literary and Artistic Works, which is recognized under Section 40 of the Copyright Act, 1957, the Plaintiff's copyright registration in Italy can be relied on to demonstrate that they are the original author of the said artistic work. Further, there is also merit in the contention of the Plaintiff's counsel that the copyright in such artistic works would not fall within the ambit of the bar under Section 15(2) of the Copyright Act despite the same being capable of being registered as designs, as: (a) the Plaintiff has averred that they have not reproduced any article to which such design has been applied more than 50 times and (b) the said product has not been produced by any industrial process.

19. Additionally, the Plaintiff has also *prima facie* established their rights

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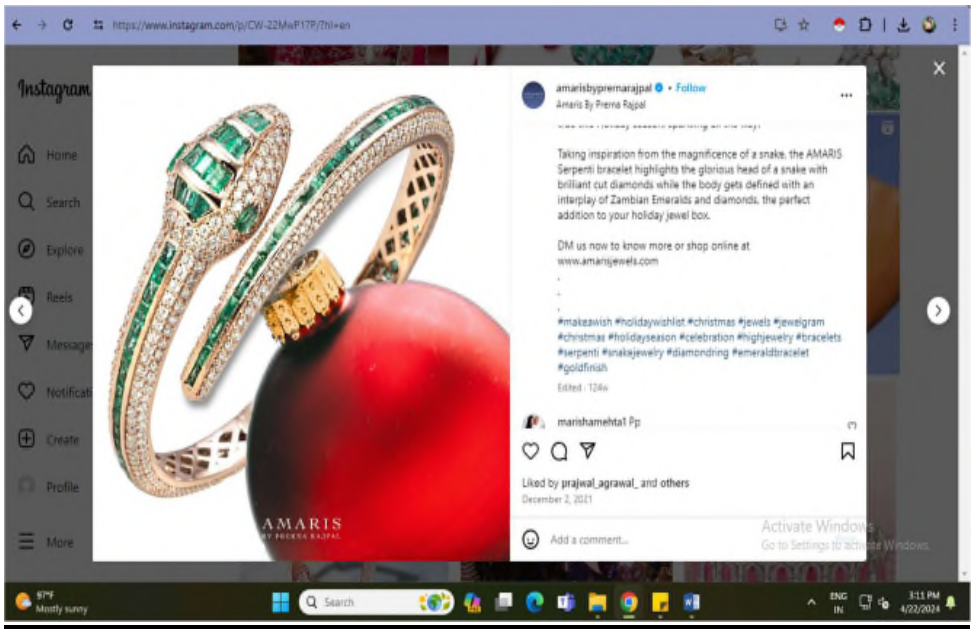
over the mark "SERPENTI", having secured various registrations which prominently feature the said mark, which has also been granted protection by this Court previously[2]. Accordingly, the Defendant's use of the identical mark "SERPENTI" in respect of identical products would constitute a clear case of infringement under Sections 29(2)(c) read with 29(3) of the Trade Marks Act, 1999. Illustrative screenshots of the Defendant's website depicting their infringing use of the "SERPENTI" mark are reproduced hereunder:



[2] Judgment dated 21st February, 2022 in CS(COMM) 658/2021

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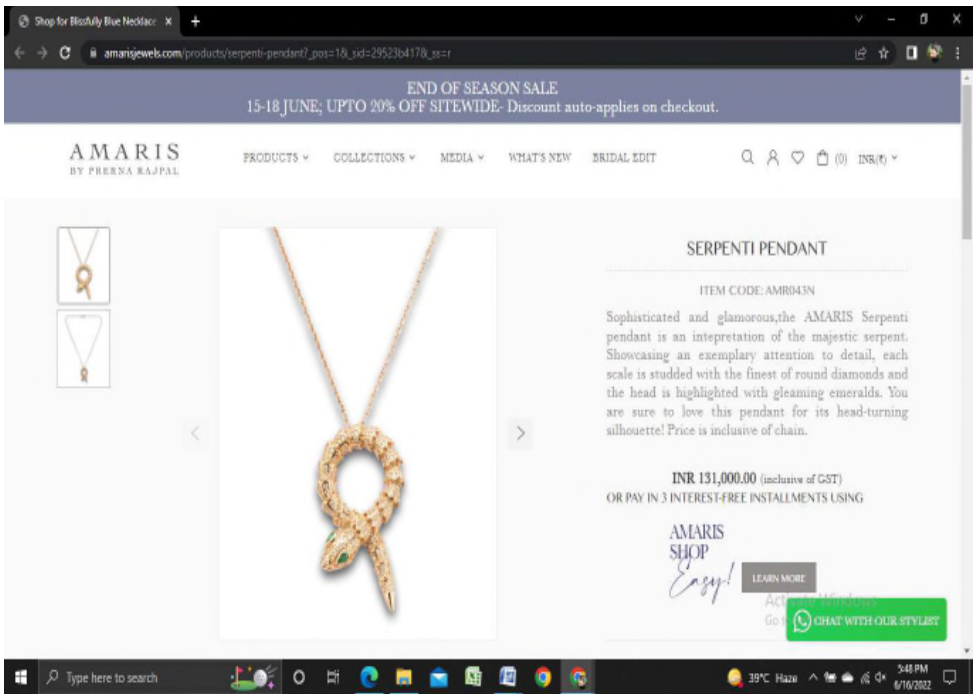

20. In view of the above, the Court finds that the Plaintiff has made out a *prima facie* case in their favour and in case no *ex-parte* ad-interim injunction is granted, the Plaintiff will suffer an irreparable loss; balance of convenience also lies in favour of the Plaintiff and against the Defendant

21. Accordingly, till the next date of hearing, the Defendant and/or anybody acting on their behalf are restrained from manufacturing, marketing, importing, exporting, using, selling, soliciting, displaying, advertising on the internet through its physical stores, websites, social media pages like Instagram and Facebook and/or by any other mode or manner:

21.1. The impugned good 'Shield-It Necklace  and/or any other related/ allied goods which may be identical or deceptively similar to

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the Plaiuntiff's copyright in the original artistic work in the Serpenti Ocean Treasure Necklace- "".

21.2. The impugned goods bearing the mark **'SERPENTI**' or any other marks which may be identical with and/or deceptively similar to the Plaintiff's trademarks/ labels "**SERPENTI"**/ "BVLGARI SERPENTI".

22. Issue notice to the Defendant, by all permissible modes, upon filing of process fee, returnable on the next date of hearing. Reply, if any, be filed within four weeks from the date of service. Rejoinder thereto, if any, be filed within two weeks thereafter.

23. Compliance of Order XXXIX Rule 3 of CPC be done with one week from today.

24. List before the Court on 30th September, 2024.

SANJEEV NARULA, J

APRIL 29, 2024
as

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