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

% ***Date of decision: 20th February, 2025***

+ **C.O. (COMM.IPD-TM) 160/2024**

PUNJAB FC PRIVATE LIMITED

.....Petitioner

Through: Mr. Nageshwar Kumhar, Mr. Ayush
Dey and Mr. Abhinav Singh,
Advocates
M: 9818823289

versus

POSSHUSA APPARELS INDIA PRIVATE LIMITED & ANR.

.....Respondents

Through: Mr. Rohan Jaitley, CGSC with Mr.
Dev Pratap Shahi and Mr. Varun
Pratap Singh, Advocates for UOI
Mob: 9355665877
Email: office@rohanjaitley.com

CORAM:

HON'BLE MS. JUSTICE MINI PUSHKARNA

MINI PUSHKARNA, J (ORAL)

1. None appears for the respondent no. 1 when the matter is called out.
2. This Court notes that in order dated 8th November, 2024, it is clearly recorded that respondent no. 1 stands served through email.
3. Time was granted to respondent no. 1 to file reply. However, neither any reply has been filed on behalf of respondent no. 1, nor any appearance has been made on behalf of respondent no. 1, despite service.
4. Respondent no. 2 is Registrar of Trademarks, who is represented in Court.
5. Accordingly, this Court proceeds to hear the matter.
6. The present petition has been filed under Section 57 of the Trade

Marks Act, 1999 for rectification/removal of the trademark  'PFC'



under registration no. 4611787 in Class 18, in favour of respondent no. 1.

7. As per the case canvassed on behalf of the petitioner, the petitioner company was incorporated on 2nd February, 2017. It is the true owner, prior adopter, honest user and proprietor of the trademarks PUNJAB FC,



PUNJAB FOOTBALL CLUB, PFC & and the same have been honestly conceived and adopted by it.

8. The petitioner submits that the trademarks of the petitioner, i.e.,



PUNJAB FC, ROUNDGLASS PUNJAB FC and are registered.

The details of the various registrations in different classes in favour of the petitioner and the applications, which are pending registration, as given in the petition, are reproduced as under:

S. No.	Date of Application	App. No.	Class	Trade Marks	Status
1.	24/09/2020	4671181	41	PUNJAB FC	Registered and Valid Upto 24/09/2030
2.	24/09/2020	4671182	41	ROUNDGLASS PUNJAB FC	Registered and Valid Upto 24/09/2030
3.	24/09/2020	4671183	41		Registered and Valid Upto 24/09/2030
4.	24/04/2023	5907214	41		Pending
5.	24/04/2023	5907649	9		Pending
6.	24/04/2023	5907690	16		Pending



7.	24/04/2023	5907691	14.		Pending
8.	24/04/2023	5907692	18.		Pending
9.	24/04/2023	5907693	21.		Pending
10.	24/04/2023	5907694	25.		Pending
11.	24/04/2023	5907695	28.		Pending
12.	24/04/2023	5907696	33.		Pending
13.	24/04/2023	5907697	38.		Pending
14.	25/07/2024	6544656	35.	PFC	Pending
15.	25/07/2024	6544657	41.	PFC	Pending

9. It is the petitioner's case that it is a duly registered football club and operates within the highest standards of professional integrity and ethical conduct. Over the years, the club has actively participated in the I-League, one of India's top-tier football leagues and has achieved commendable success. The various achievements of the petitioner, i.e., Punjab Football Club (PFC), as given in the petition, are reproduced as under:

Seasons	Achievements
2022-23	Champions of I-League
2022-23	Winners of Punjab Super League
2022	Winners of JSW U-18 Youth Cup
2022	Runners-Up of JSW U-13 Youth Cup
2022	Winners of KBN Youth Cup
2023	Champions of Administrator's Challenge Cup
2023	Winners of JSW U-13 Youth Cup
2024	Third Place in Premier League Next Gen Cup

10. It is the case of the petitioner that it has spent enormous funds to promote its football club under its PUNJAB FC, ROUNDGLASS PUNJAB



FC and marks through various forms of media, including, online social media platforms and in newspapers, magazines, etc. Therefore, by virtue of prior adoption and such long, continuous and uninterrupted use and extensive promotion of the trademarks PUNJAB FC, PUNJAB FOOTBALL CLUB and PFC, the same have come to be associated with the petitioner exclusively.

11. It is submitted that an online search for PUNJAB FC results in several hits attributable to the trademark PUNJAB FC, PUNJAB FOOTBALL CLUB and PFC of the petitioner exclusively. Such a high number of organic results are demonstrative of the popularity of the business of the Petitioner under the trademarks PUNJAB FC, PUNJAB FOOTBALL CLUB and PFC.

12. This Court records the statement made on behalf of the petitioner that PUNJAB FC is a national team for the state of Punjab for football, and the same is registered with the All India Football Federation. The document pertaining to the same, as filed with the plaint, is reproduced as under:

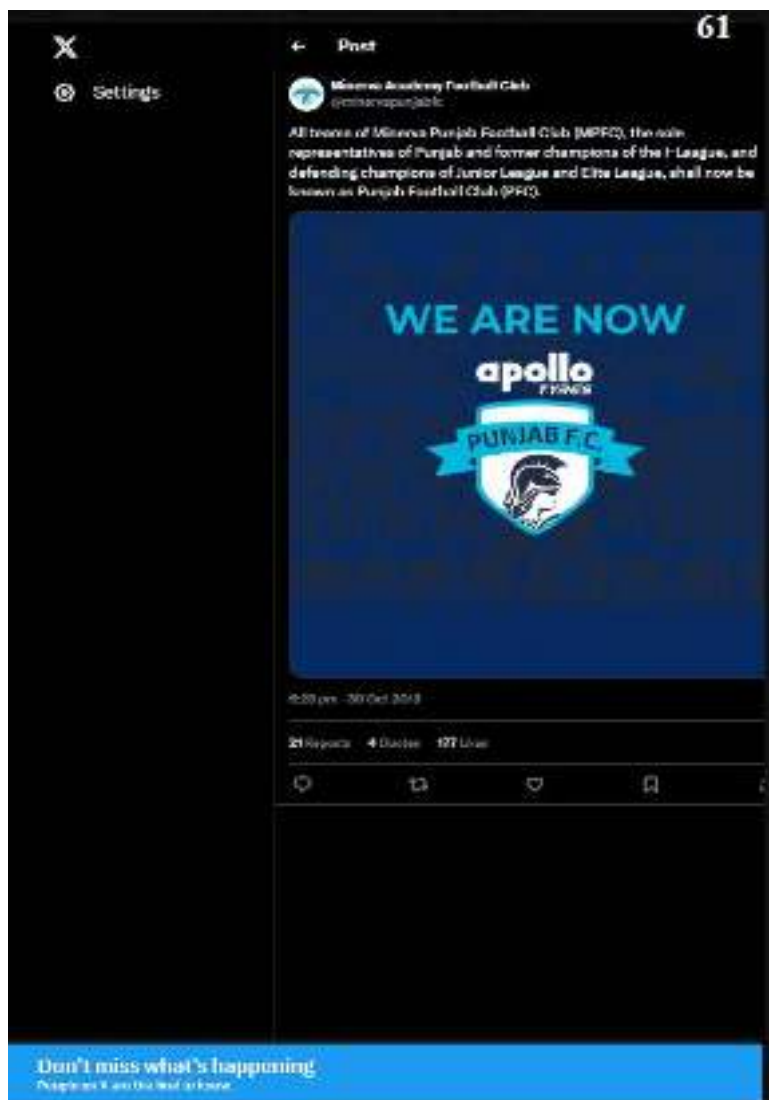


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13. This Court further notes that the petitioner was earlier using the name Minerva Punjab Football Club (“MPFC”), from the year 2017 till the year 2019. However, in the year 2019, the name of the promoter, i.e., Minerva, was dropped from the name of the petitioner, and from 2019 onwards, the petitioner is only known as Punjab Football Club (“PFC”). The document pertaining to the same is reproduced as under:



14. The respondent no. 1, *per contra*, has registration in its favour for the mark ‘PFC’, and the application for the same, under Class 18, bearing no. 4611787, was filed on 17th August, 2020, on a ‘*proposed to be used*’ basis.



15. The document of registration in favour of respondent no. 1, is reproduced as under:

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(NOT FOR LEGAL USE)

As on Date : 08/08/2024
Status : Registered

[View Registration Certificate](#)
[View Examination Report](#)

TM Application No.	4611787
Class	18
Date of Application	17/08/2020
Appropriate Office	DELHI
State	DELHI
Country	India
Filing Mode	e-Filing
TM Applied For	PFC
TM Category	TRADE MARK
Trade Mark Type	DEVICE
User Detail	Proposed to be used
Certificate Detail	Certificate No : 2695599 Dated : 05/04/2021 Notified in Journal No : 1995
Valid upto/ Renewed upto	17/08/2030
Proprietor name	(1) POSSHUSA APPARELS INDIA PRIVATE LIMITED Body Incorporate
Proprietor Address	F- 501, 3RD FLOOR, GREEN VALLEY CGHS LTD, PLOT NO. 18, SECTOR 22, DWARKA, NEW DELHI- 110075
Email Id	***@blueinkk.com
Attorney name	BLUE INKK (PVT) LTD
Attorney Address	GOEL NIVAS, I-62, STREET NO. 4, LAXMI NAGAR, DELHI - 110092
Goods & Service Details	[CLASS : 18] Leather and imitations of leather; Animal skins and hides; Luggage and carrying bags; Umbrellas and parasols; Walking sticks; Whips; harness and saddlery; Collars, leashes and clothing for animals.
Publication Details	Published in Journal No : 1973-6 Dated : 26/10/2020

Trade Mark Image : (1)

REPORT DATE

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THE TRADE MARK IMAGE IS THE PROPERTY OF THE REGISTRAR OF TRADE MARKS. IT IS NOT TO BE USED FOR ANY OTHER PURPOSE WITHOUT THE PERMISSION OF THE REGISTRAR. THE REGISTRAR IS NOT RESPONSIBLE FOR THE CONTENTS OF THE DOCUMENTS. THE REGISTRAR IS NOT RESPONSIBLE FOR THE CONTENTS OF THE DOCUMENTS. THE REGISTRAR IS NOT RESPONSIBLE FOR THE CONTENTS OF THE DOCUMENTS.



16. Perusal of the aforesaid shows that while the mark of the petitioner, i.e., Punjab Football Club, has been registered with user detail of 29th July, 2019, the registration sought on behalf of respondent no. 1 was *vide* application filed on 17th August, 2020 and that too, only on a '*proposed to be used*' basis.

17. This Court further notes the submission made by learned counsel appearing for the petitioner that the mark 'PFC' and its logo are not being used by respondent no. 1 and no listings of the products of the respondent no. 1 were found by the petitioner on conducting an internet search.

18. A comparative representation of the trademark of the petitioner with the mark of respondent no. 1, is given as below:

Petitioner's Trademarks	Respondent No. 1's Trademarks
PUNJAB FC PFC ROUNDGLASS PUNJAB FC 	PFC 

19. Upon careful examination of the aforementioned comparison, it is apparent that the petitioner's registered mark PFC forms the dominant portion of respondent no.1's infringing mark, which bears evident resemblance to the registered trademarks of the petitioner.

20. This Court further finds that inclusion of a football icon and a crest-shape in its logo by respondent no.1, clearly shows its intent to depict an



association with football, and consequently, with the petitioner. Moreover, there exists phonetic and visual similarity between petitioner's prior used and adopted marks and the impugned mark.

21. From the above, it is manifest that the respondent no. 1, to ride upon the goodwill vesting in petitioner's marks, has dishonestly adopted the impugned PFC mark. Thus, this Court, in the case of *Ishi Khosla Versus Anil Aggarwal & Anr.*, 2007 SCC OnLine Del 126, has held as follows:

“xxx xxx xxx

23. What is relevant is the admission on the part of the defendants in using the word “DIET WHOLE FOODS” in respect of the same products which are marketed by the defendants with same techniques and same benefits. As on the date of filing of the application by the defendants for registration of this mark in 2004, they had not started marketing their products under this label. Even if it is taken that the defendants' products hit the market in the year 2004, the plaintiff had been marketing her products with trademark 'Whole Foods' since the year 2001. Obviously, the defendants could see through the benefits of products as conceptualised by the plaintiff and they wanted their own share in the pie. It is not to suggest that the plaintiff has monopoly over these products. Any other person may enter the trade and be a competitor. Competition is healthy for not only consumers but for manufacturer as well and is, therefore, in public interest. However, what is to be discouraged in the dishonest adoption of somebody else's trademark and trying to ride on the goodwill created by the competitor who entered the market prior in time. This is what is sought to be done by the defendants by clever manipulation, namely, adding the word 'DIET' in their mark after adopting identically the entire trademark of the plaintiff i.e. 'Whole Foods'. This intention of the defendants becomes manifest as they have also adopted same style of the trademark and same labels/packing etc. I may mention that during arguments learned counsel for the defendant conceded this and offered to change the writing style as he accepted that artistic feature could not be used. However, what is emphasized is the manner in which the defendants adopted the trademark 'DIET WHOLE FOODS'. Addition of one word with same style in which these letters are written explains the obvious, namely, dishonest adoption. With such adoption, confusion is inevitable. In Ruston Hornsby v. Zamindara Engineering, PTC (Suppl) (1) 175 SC, the Supreme Court deprecated the defendant's adoption of plaintiff's trademark 'RUSTON' by adding word 'INDIA' to its mark and held that mere addition of the word 'INDIA' could not be held to be a



distinguishing factor as the said word had no trademark value or signification.

24. In the case of *Munday v. Carey*, 1905 RPC 273 the Court held:
“.....I believe that it is a rank case of dishonesty, and where you see dishonesty, then even though the similarity were less than it is here, you ought, I think, to pay great attention to the items of similarity, and less to the items of dissimilarity”.

25. Further, in the case of *Midland Counties Dairy Ltd. v. Midland Dairies Ltd.*, 1948 PRC 429 it was held that:

“.....For if the Court comes to the conclusion that the defendant was actuated in adopting the style complained of by the dishonest motive of filching some part of the plaintiff's reputation, then the Court will not be astute to find that this nefarious design has failed.

xxx xxx xxx”

(Emphasis Supplied)

22. This Court is of the view that this dishonest adoption of the impugned mark by the respondent no. 1 in relation to goods and merchandise under Class 18 is bound to create the impression of association of the said goods with petitioner's football club in the minds of consumers as well as members of the trade and consequently, result in dilution of the brand identity associated with petitioner's trademarks. Moreover, as noted above, the petitioner has a pending registration in Class 18 for its device mark.

23. Further, this Court, in cases of deceptive similarity of marks, in its decision in *Amit Sood Versus Union of India and Others*, 2024 SCC OnLine Del 3226, has held as under:

“xxx xxx xxx

34. In *Montari Overseas Ltd. v. Montari Industries Ltd.*, 1995 SCC OnLine Del 865, the Court observed **the true measure of deception lies in the likelihood of misleading an ordinary person on the street. This issue should be examined from their perspective as imitating a trade name is equivalent to providing false information to the public, and they need to be shielded from such misleading practices.** The relevant portion of the said judgment is extracted below:

11. It is well settled that an individual can trade under his own name as he is doing no more than making a truthful statement of the fact



which he has a legitimate interest in making. But while adopting his name as the trade name for his business he is required to act honestly & bonafidely and not with a view to cash upon the goodwill & reputation of another. An individual has the latitude of trading under his own name is in recognition of the fact that he does not have choice of name which is given to him. However, in the case of a Corporation the position is different. Unlike an individual who has no say in the matter of his name, a company can give itself a name. Normally a company cannot adopt a name which is being used by another previously established company, as such a name would be undesirable in view of the confusion which it may cause or is likely to cause in the minds of the public. Use of a name by a company can be prohibited if it has adopted the name of another company.

It is well settled that no company is entitled to carry on business in a manner so as to generate a belief that it is connected with the business of another company, firm or an individual. The same principle of law which applies to an action for passing off of a trade mark will apply more strongly to the passing off of a trade or corporate name of one for the other. Likelihood of deception of an unwary and ordinary person in the street is the real test and the matter must be considered from the point of view of that person. Copying of a trade name amounts to making a false representation to the public from which they have to be protected. Besides the name of the company acquires reputation and; goodwill, and the company has a right too to protect the same. A competitor cannot usurp the goodwill and reputation of another. One of the pernicious effects of adopting the corporate name of another is that it can injure the reputation & business of that person.

12.

It is also not a case where the appellant had no knowledge of the corporate name of the respondent. Rather the stand of the appellant is that in the prospectus and press reports of the company, it was pointed out that the appellant had nothing to do with the respondent. In the circumstances it appears to us that the adoption of the corporate name by the appellant with the word "MONTARI" figuring in it, was not innocent. When a defendant does business under a name which is sufficiently close to the name under which the plaintiff is trading and that name has acquired reputation and the public at large is likely to be misled that the defendant's business is the business of the plaintiff, or is a branch or department of the plaintiff, the defendant is liable for an action in passing off. Even if the word "MONTARI" as part of the corporate name of the appellant was derived from the names of the father and father-in-law of the M.D. of the appellant company it would still be liable for an action in passing off as the use of the word "MONTARI" in its corporate name



*is likely to cause confusion and injure the goodwill and reputation of the respondent, in the sense that this is a reasonable and foreseeable consequence of the appellant's action. We find from the record of the trial court, which contains the Memorandum of Association of six Montari group of companies and annual reports of Montari Industries Ltd., that Montari group of industries have large operations and some of them have been in business for a long time. **The members of the public are likely to mistakenly infer from the appellant's use of the name which is sufficiently close to the respondent's name that the business of the appellant's company is from the same source, or the two companies are connected together.***

xxx xxx xxx''

(Emphasis Supplied)

24. Therefore, in light of the foregoing discussion, this Court finds that the impugned registered mark of respondent no. 1 is deceptively similar to petitioner's prior adopted and used trademarks.

25. Considering the submissions made before this Court and in light of the reputation and goodwill of the petitioner as a premier national-level football club, its prior adoption and extensive use of the PFC trademarks, and the findings of this Court with respect to the deceptive similarity of the marks in question, the present petition for rectification/removal of the impugned mark is allowed.

26. Accordingly, the trademark registration in favour of respondent no. 1,



bearing no. 4611787 for the mark PFC in Class 18, is hereby cancelled.

27. The respondent no. 2, i.e., Registrar of Trade Marks, is directed to carry out the necessary rectification in its Register and issue an appropriate notification, with regard thereto.

28. The Registry is directed to supply a copy of the present order to the



Office of the Controller General of Patents, Designs and Trade Marks of India, on the Email Id: llc-ipo@gov.in, for compliance.

29. The present petition is accordingly disposed of, with the aforesaid directions.

MINI PUSHKARNA, J

FEBRUARY 20, 2025
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