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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**
+ C.O. (COMM.IPD-TM) 271/2023 & I.A. 22284/2023, I.A. 22285/2023

FALCON LICENSING LIMITEDPetitioner

Through: Mr. Kunal Tandon, Sr. Advocate with
Mr. Ronnie Singh, Advocate and Ms.
Natasha, Advocate
Mob: 8882228686

versus

PRI ENTERPRISES PRIVATE LIMITED & ANR.Respondents

Through: Mr. Utsav Jain, Advocate for R-1.
Ms. Nidhi Raman, CGSC with Mr.
Arnav Mittal, Mr. Zubin Singh, Mr.
Akash Mishra and Ms. Ridhi Kapoor,
Advocates for R-2.
Mob: 8588916612
Email: nidhiraman.office@gmail.com

CORAM:
HON'BLE MS. JUSTICE MINI PUSHKARNA

JUDGMENT
15.04.2025

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MINI PUSHKARNA, J:

1. The present petition has been filed seeking the prayer to remove/cancel/expunge the entry pertaining to the trademark, **BOLDIFY.**, registered under application no. 3867168 in Class 3, from the Register of Trade Marks.
2. The facts, as canvassed in the petition, are as follows:
 - 2.1 Petitioner is a limited company having its registered office in New Zealand.



2.2. The mark 'BOLDIFY' was adopted by the predecessor-in-interest of the petitioner in the year 2016 for hair care products. The said mark has since been used honestly, *bonafidely*, continuously, openly, uninterruptedly and exclusively.



2.3 Subsequently, the label mark  was coined and developed to convey a unique visual identity to represent and communicate the 'BOLDIFY' brand to the general public.

2.4 The predecessor-in-interest of the petitioner adopted the trademark



/'BOLDIFY', as an essential and material part of its domain name, viz., www.getboldify.com. Since then the said domain name has been used in the course of trade thereof globally, in relation to its goods and business, under the 'BOLDIFY' brand.

2.5 The predecessor-in-interest of the petitioner also secured trademark registrations for the mark 'BOLDIFY', in United States ("US") with the earliest trademark application being, dated 27th March, 2016, for goods and services, such as hair shampoos and conditioners, hair sprays and other hair products.

2.6 Starting from August, 2016, the predecessor-in-interest of the petitioner also started selling their goods under the trademark/label



/'BOLDIFY', on the e-commerce platform, www.amazon.com.



2.7 The predecessor-in-interest of the petitioner, constituted the petitioner company on 14th February, 2017, for protection of the ‘BOLDIFY’ brand and for managing all intellectual property assets under the said mark.

2.8 On 11th September, 2018, the predecessor-in-interest of the petitioner founded Boldify Incorporation (“Boldify Inc.”), as a wholly owned subsidiary of the predecessor-in-interest of the petitioner. Boldify Inc. was incorporated in US and the brand ‘BOLDIFY’, was operated through it, thereafter.

2.9 On 27th July, 2020, Boldify Inc., filed a trademark application bearing no. 4581605 under Class 35, before the Trade Marks Registry, India. The



mark, ‘BOLDIFY’, secured registration in India on 13th June, 2022. Further, Boldify, Inc., listed its business on www.amazon.in under the



trademark/label ‘BOLDIFY’, from 20th July, 2022 onwards.

2.10 Vide Assignment Agreement dated 25th January, 2021, the petitioner herein has acquired all right, title and interest vested in the trademarks of Boldify Inc., registered in various countries.

2.11 Respondent no. 1 was incorporated on 15th December, 2017, and filed to register itself as a micro enterprise for trading in the business for manufacturing of tableware, kitchenware and other household articles, along with toilet articles of plastic, including, manufacture of vacuum flasks and other vacuum vessels. Respondent no. 1 is engaged in the business of manufacture of rubber and plastic products, and is a verified supplier as a



wholesale trader of vacuum storage bag.

2.12 The respondent no. 1 filled the distributor application form with the predecessor-in-interest of the petitioner on the website www.getboldify.com on 17th May, 2018, and expressed its interest in being an offshore partner for

goods sold under the trademark/label  /'BOLDIFY', in India. The contract form bore the name 'PRI Enterprises Pvt. Ltd.', which is the respondent no. 1. Further, communication by respondent no. 1 was done through the Email Id, i.e., pri.enterprises64@gmail.com. *Vide* Email dated 18th May, 2018, the predecessor-in-interest of the petitioner responded to respondent no. 1 that they were exploring options with other companies to market their products in India.

2.13 Subsequently, on 19th May, 2018, the respondent no. 1 requested the predecessor-in-interest of the petitioner for the price list of goods under the

trademark/label  /'BOLDIFY'. The predecessor-in-interest of the petitioner shared the distributor price list containing all information about

the goods sold under trademark/label  /'BOLDIFY' with respondent no. 1, *vide* Email dated 21st May, 2018. Thereafter, no further communication was received from respondent no. 1.

2.14 Boldify Inc., filed a trademark application bearing no. 4581605 on



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27th July, 2020, for its mark **BOLDIFY.** under Class 35 in India. In the examination report, reference was made to a conflicting mark, **BOLDIFY.**, of respondent no. 1, already registered as a trademark. In response, the predecessor-in-interest stated about its registrations in other

BOLDIFY.

countries and business under the mark **BOLDIFY.** / 'BOLDIFY'. Thus, registration was granted for the mark 'BOLDIFY' on 13th June, 2022, under Class 35.

2.15 Subsequently, on 20th March, 2023, petitioner applied for registration

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of the word mark 'BOLDIFY' and label mark **BOLDIFY.** in Class 3. The Trade Marks Registry objected to the said application citing the impugned mark of the respondent no. 1, **BOLDIFY.**, registered under Class 3.

2.16 The petitioner issued a cease-and-desist notice on 8th August, 2023, against the unauthorised usage of the registered trademark/label/marks/word marks of the petitioner/Boldify, Inc. Since, the respondent no. 1 did not heed to the cease-and-desist notice, the present petition has been filed.

3. On behalf of the petitioner, it has been submitted as follows:

3.1 The adoption of the impugned mark by respondent no. 1 is dishonest and tainted. The respondent no. 1 has blatantly copied the trademark/label of the petitioner.



3.2 Respondent no. 1 has purposely applied for registration of the impugned mark, which is deceptively identical to the petitioner's trademark/label. The impugned trademark of the respondent no. 1 is for Class 3, for products/goods, which are allied and cognate, to the petitioner's business.

3.3 The petitioner's brand is well-known in the international market and has gained a good recognition and enjoys a strong trans-border reputation.

3.4 The respondent no. 1 is engaged in completely different trade and goods, other than what is claimed under the impugned trademark. The respondent no. 1 is aware of the petitioner's status and goodwill, and is squatting on the trademark of the petitioner.

4. On behalf of respondent no. 1, it has been submitted as follows:

4.1 Respondent no. 1 started running a wholesale trading business of cosmetics, general household articles, rubber and plastic products, along with bleaching, cleaning, beauty products in the year 2017. During the course of his business in June, 2018, respondent no. 1 adopted the trademark, **BOLDIFY.**, for the purpose of enabling itself to develop a brand in connection with the nature of its business.

4.2 In the year 2020, respondent no. 1 also started dealing in sanitizer, PPE kits, masks, vacuum storage bags and abandoned trading in beauty products. Respondent no. 1 continues to trade in the said products, along with rubber and plastic products, charcoal and activated carbon, which is used for industrial, water treatment, air and sewage cleaning, bleaching and laundry purposes.

4.3 Section 47 of the Trade Marks Act, 1999 ("Trade Marks Act"), is applicable only when a continuous period of five years and three months,



from the date of actual registration of the trademark, upto the date of application under Section 47, has elapsed. In the present case, the subject trademark of respondent no. 1 got registered on 23rd December, 2018, while the present petition was filed on 26th October, 2023, before this Court. The five years and three months period elapsed only on 22nd March, 2024, only after which, the present petition could have been filed under Section 47 of the Trade Marks Act.

4.4 There is nothing on record to show that the petitioner had a bad faith at the time of registration. The email allegedly exchanged between the petitioner and respondent no. 1 is denied by respondent no. 1.

4.5 The cause of action, as pleaded in the petition, arose on 19th August, 2020. The petitioner did not take any action against respondent no. 1 for three years. The petitioner accepted the existence of the trademark of respondent no. 1. It is only when the petitioner applied for a trademark in Class 3 on 20th March, 2023, that the petitioner initiated the present action.

4.6 The respondent no. 1 does not manufacture and market any products, which are similar to the petitioner's products. Thus, no prejudice is being caused to the petitioner.

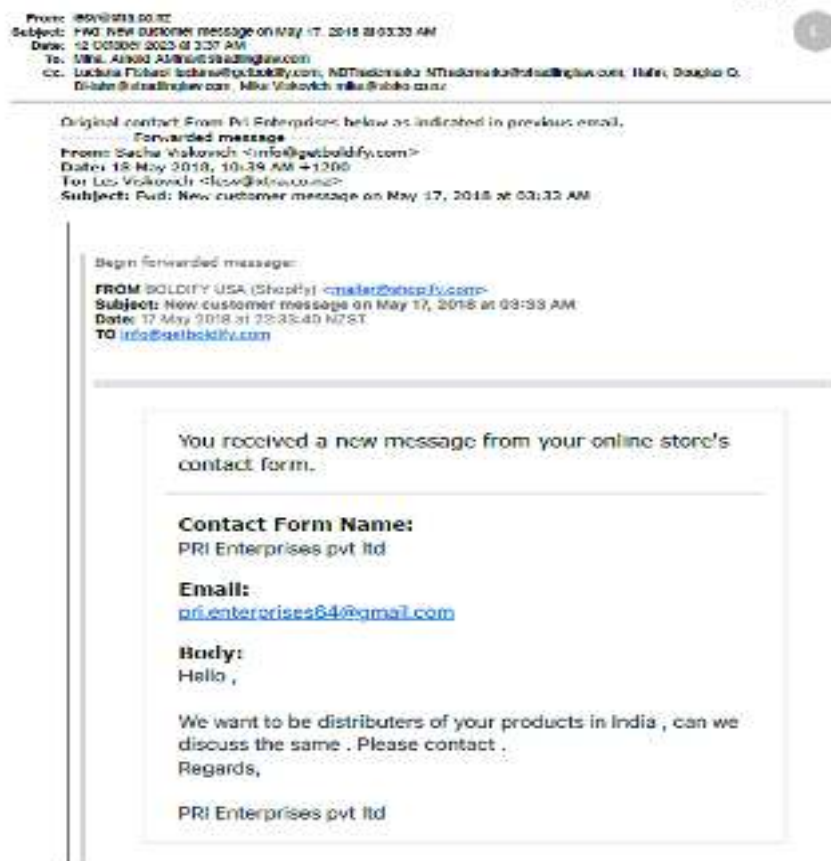
5. I have heard learned counsels for the parties and have perused the record.

6. The contention raised by the petitioner is twofold. Firstly, the registration of similar mark 'BOLDIFY'/'**BOLDIFY.**', by the respondent no. 1 is dishonest. Secondly, the respondent no. 1 has not used the mark 'BOLDIFY'/'**BOLDIFY.**' for any products, in respect of which, the said mark is registered in favour of respondent no. 1.

7. As regards the contention that the registration of the mark



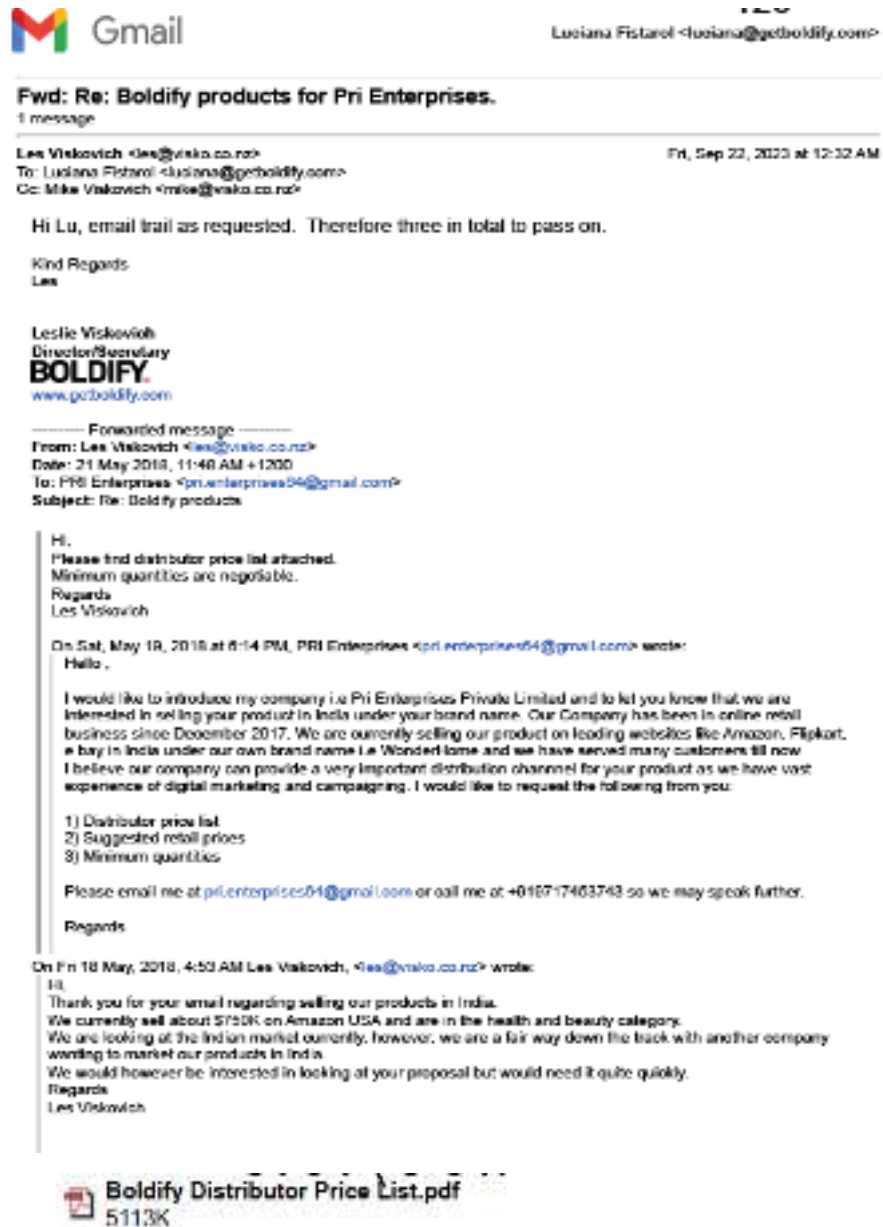
‘BOLDIFY’/ **BOLDIFY.** by respondent no. 1 is dishonest, petitioner has stated that respondent no. 1 expressed its interest *vide* Email dated 17th May, 2018, written to its predecessor-in-interest for distributing the products of the petitioner, in India. The said Email, as received by the petitioner from the Email: pri.enterprises64@gmail.com, is reproduced as under:



8. In reply, the predecessor-in-interest of the petitioner wrote an Email dated 18th May, 2018, indicating that they were looking at the Indian market and would be interested in looking at the proposal of the respondent no. 1 herein. Subsequently, the predecessor-in-interest of the petitioner received another Email dated 19th May, 2018 from respondent no. 1, wherein, they introduced their company, i.e., PRI Enterprise Pvt. Ltd., and showed interest in selling the products under the brand name ‘BOLDIFY’, in India. Pursuant



thereto, the distributor price list for the products under the mark 'BOLDIFY', was shared with the respondent no. 1. The said Email dated 19th May, 2018, written by respondent no. 1 and Email dated 21st May, 2018, written by predecessor-in-interest of the petitioner to respondent no. 1, are reproduced as under:



9. Though, the respondent no. 1 has denied sending any such Emails, as aforesaid, however, in its reply filed before this Court, the respondent no. 1



has categorically admitted that the Email Id in question, i.e., pri.enterprises64@gmail.com, as relied upon by the petitioner, belongs to the respondent no. 1. Relevant portion of the reply filed on behalf of respondent no. 1, is extracted herein below:

“xxx xxx xxx

4. *Contents of Para 30-33 are denied. **It is denied that there was any such email communication between Petitioner and Respondent no.1.***

5.....

6. ***Contents of Para 45 are admitted to the extent that email pri.enterprises64@gmail.com belongs to Respondent no.1, however no such enquiry as alleged was sent by the Respondent no. 1 or any person authorized by the Respondent no.1.***

xxx xxx xxx”

(Emphasis Supplied)

10. Perusal of the aforesaid reply filed by respondent no. 1 shows that though the respondent no. 1 has extended a blanket denial to having sent any such Email expressing interest in distributing the products of the petitioner under the mark ‘BOLDIFY’, however, no explanation has been given as to how such communication has emanated from the respondent no. 1’s Email. It is relevant to note that the petitioner has admitted to the Email address, from which the aforesaid Emails were received by the petitioner’s predecessor-in-interest. Therefore, the feeble denial by the respondent no. 1, that it did not send any Email to the predecessor-in-interest of the petitioner expressing interest in distributing its products under the mark ‘BOLDIFY’, is clearly an afterthought. In the absence of any explanation as regards the source of the said communication from the admitted Email of the respondent no. 1, the submissions of the respondent no. 1 in this regard, cannot be accepted.

11. The present petition is premised on the claim of the petitioner that its



predecessor-in-interest coined and adopted the mark ‘BOLDIFY’ in the year 2016, and by virtue of subsequent assignment, the petitioner is the prior user of the said mark. The predecessor-in-interest of the petitioner obtained registrations for various hair products from the US Patent and Trademark Office (“USPTO”) in International Classes, as follows:

“xxx xxx xxx

9.....

i. 003 (US Class Codes 001, 004, 006, 050, 051, 052) where the first use of the mark is 01.02.2016 with first use in commerce is 01.08.2016

ii. 005 (US Class Codes 006, 018, 044, 046, 051, 052) where the first use of the mark is 01.02.2016 with first use in commerce is 01.02.2017

xxx xxx xxx”

12. Besides the aforesaid, the predecessor-in-interest of the petitioner/the



petitioner, have various registrations for the mark ‘BOLDIFY’/ in a number of countries, details of which, are as follows:

Date of Registration/ Application	Country	Nice Class	Mark	Application/ Registration Number
07.01.2016	Singapore	3	BOLDIFY.	40202015676P (registered)
02.02.2021	New Zealand	3	BOLDIFY.	1154808 (registered)
28.10.2022	United Arab Emirates	3	BOLDIFY.	376328 (registered)
26.12.2020	United Kingdom	3	BOLDIFY.	UK00918276722 (registered)
20.11.2020	United Kingdom	3, 26	BOLDIFY.	UK00003516719 (registered)
26.12.2020	European Union	3	BOLDIFY.	018276722 (registered)



13.06.2022	India	35	BOLDIFY.	4581605 (registered)
18.03.2021	Canada	3	BOLDIFY.	2053829 (registered)
30.07.2020	Australia	3	BOLDIFY.	2107482 (registered)
20.03.2023	India	3	BOLDIFY.	5855590 (pending)
20.03.2023	India	3	BOLDIFY.	5855581 (pending)

13. As per the facts on record, the trademarks registered in various

countries for the mark/label '**BOLDIFY.**', were assigned in favour of the petitioner *vide* Assignment Agreement dated 25th January, 2021. Thus, currently petitioner is the owner of the various registered trademarks/labels

under the mark '**BOLDIFY.**', in various countries, including, in India.

14. This Court takes note of the submission made on behalf of the petitioner that the business of the petitioner has been conducted under the

said trademarks/label '**BOLDIFY.**', throughout the world since the year 2016, through its authorised dealers, e-commerce platform, i.e., Amazon, through direct sales, by way of physical stores, as well as online website, www.getboldify.com. The annual sales figures for products under



the mark 'BOLDIFY', from the year 2017 to 2023, as given in the petition, is reproduced as under:

Period	Annual Sales Figure (in USD)
2016-17	48,662
2017-18	479,240
2018-19	851,136
2019-20	3,022,743
2020-21	5,254,584
2021-22	9,647,749
2022-23	13,909,463
2023-24	17,000,000 (projected)

15. The petitioner/its predecessor-in-interest, has spent enormous amounts of money for the promotion of its products under the mark 'BOLDIFY', since the year 2016. The table showing the expenditure incurred for advertising the goods and business under the mark 'BOLDIFY', is reproduced as under:

Period	Expenditure (in USD)
2016-17	11,000
2017-18	90,000
2018-19	180,000
2019-20	900,000
2020-21	1,600,000
2021-22	2,269,645
2022-23	3,755,068
2023-24	4,400,000 (projected)

16. This Court further takes note of the submission of the petitioner that the respondent no. 1 has never used its registered mark 'BOLDIFY'/. **BOLDIFY.** for the products for which it is registered. It is to be noted that the registration in favour of respondent no. 1 for the mark



BOLDIFY.

was on '*proposed to be used*' basis. The details of registration in favour of respondent no. 1 is reproduced as under:

(NOT FOR LEGAL USE)

10

As on Date : 18/10/2023

Status : (Registered)

[New Registration Certificate](#)

[View Examination Report](#)

TM Application No.	3867188
Class	3
Date of Application	23/06/2018
Appropriate Office	DELHI
State	DELHI
Country	India
Filing Mode	e-Filing
TM Applied For	BOLDIFY
TM Category	TRADE MARK
Trade Mark Type	DEVICE
User Detail	Proposed to be used
Certificate Detail	Certificate No. 2058396 Dated : 23/12/2018 Notified in Journal No : 1882
Valid upto/ Renewed upto	21/06/2028
Proprietor name	(1) PRI ENTERPRISES PRIVATE LIMITED Single Firm
Proprietor Address	D-5/14, SHOP NO. 3 SECTOR- 36, ROHINI
Email Id	***andara***@gmail.com
Agent name	PRIVANKA(32839)
Agent Address	RZ 18E/2, STREET NO 3, MAIN SAGAR PUE, NEW DELHI-110046
Goods & Service Details	[CLASS : 3] Cosmetics, Bleaching preparations, soaps, perfumery, essential oils and hair lotions
Publication Details	Published in Journal No : 1881-0 Dated : 06/08/2018
Trade Mark Image : (1)	



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17. Despite the categorical submission in the petition that the respondent no. 1 has never used the mark 'BOLDIFY'/'**BOLDIFY.**' for any products under Class 3, under which the said mark is registered, no documents have been filed on record by the respondent no. 1, to show the user of the said mark. The submission of the petitioner, as given in the petition, in this regard, is reproduced as under:

"xxx xxx xxx

36. That Respondent No. 1 had obtained registration of the mark

BOLDIFY.

under class 3 for goods listed as under:

"Cosmetics, Bleaching preparations, soaps, perfumery, essential oils and hair lotions".



It is fitting to mention that Boldify, Inc, by itself and through its predecessor and/or sister company, has been securing registrations all over the world under class 3 of NICE Classification, which is an international classification of goods and services applied for the registration of marks, of which India is a signatory. Further, it is important to note that till date Respondent No. 1 has not used the mark with respect to anything.

xxx xxx xxx

44. That there is absolutely not a shred of documentary evidence or any online presence of Respondent No. 1 or that the mark

***BOLDIFY.** has been ever used anywhere and especially has zero presence in the business of cosmetic and beauty products. That Respondent No. 1 attached its MSME Udyog Aadhar certificate along with its Form TM-A in its trademark application number 3867168, which showcases that Respondent No. 1 is engaged in the business of manufacture of rubber and plastic products and not any kind of beauty products. Further, the date of filing of TM-A by Respondent No. 1 i.e., 21.06.2018, is of paramount importance herein, as it is exactly one month after the conclusion of the conversation between Boldify, Inc. and Respondent No. 1 i.e., 21.05.2018.*

xxx xxx xxx”

(Emphasis Supplied)

18. Thus, it is evident that the petitioner/petitioner’s predecessor-in-interest, are the prior user of the mark in question. The right of a prior user has been recognised as superior to the registrant of a trademark. It is settled principle that rights of a prior user will override the rights of a subsequent user, even though, the latter’s mark may be a registered trademark. In this regard, Supreme Court in the case of *Milmet Oftho Industries and Others Versus Allergan Inc., (2004) 12 SCC 624*, has held in categorical terms that the mere fact that a party has not been using the mark in India, would be irrelevant, if they were first in the world market. Thus, it has been held, as follows:

“xxx xxx xxx

9. In the present case, the marks are the same. They are in respect of pharmaceutical products. The mere fact that the respondents have not been using the mark in India would be irrelevant if they were



first in the world market. The Division Bench had relied upon material which prima facie shows that the respondents' product was advertised before the appellants entered the field. On the basis of that material the Division Bench has concluded that the respondents were first to adopt the mark. If that be so, then no fault can be found with the conclusion drawn by the Division Bench.

xxx xxx xxx”

(Emphasis Supplied)

19. The petitioner has placed on record documents showing the continuous use of the mark in question since the year 2016. Taking in account, the petitioner’s international and online presence, and communications thereof, the respondent no. 1 was clearly aware of the

petitioner’s status and goodwill in the trademark/label, ‘BOLDIFY’/ . Thus, it is manifest that the respondent no. 1’s adoption of the impugned mark is dishonest, *malafide*, tainted, and is in bad faith.

20. Elucidating on the concept of ‘bad faith’ as to mean unfair practices involving lack of honest intention, this Court in the case of ***BPI Sports LLC Versus Saurabh Gulati and Another, 2023 SCC OnLine Del 2424***, has held as follows:

“xxx xxx xxx

47. “Bad faith” is not defined in the Trade Marks Act. Courts have, however, cogitated on the concept, in the context of trade mark law. The court of Appeals of England and Wales, in *Harrison v. Teton Valley Trading Co. Ltd.* [*Harrison v. Teton Valley Trading Co. Ltd., (2004) 1 WLR 2577*], observed thus:

“29. In *Surene Pty. Ltd. v. Multiple Marketing Ltd.* C000479899/1, the proprietor, multiple marketing, distributed the applicant for revocation’s products under the trade mark BE NATURAL. The cancellation division held that the application had been made in bad faith. It said:

10. Bad faith is a narrow legal concept in the CTMR system. Bad faith is the opposite of good faith, generally



implying or involving, but not limited to, actual or constructive fraud, or a design to mislead or deceive another, or any other sinister motive. Conceptually, bad faith can be understood as a 'dishonest intention'. This means that bad faith may be interpreted as unfair practices involving lack of any honest intention on the part of the applicant of the CTM at the time of filing.

11. Bad faith can be understood either as unfair practices involving lack of good faith on the part of the applicant towards the office at the time of filing, or unfair practices based on acts infringing a third person's rights. There is bad faith not only in cases where the applicant intentionally submits wrong or misleading by insufficient information to the office, but also in circumstances where he intends, through registration, to lay his hands on the trade mark of a third party with whom he had contractual or pre-contractual relations.

xxx xxx xxx

49. In *Gromax Plasticulture Ltd. v. Don & Low Nonwovens Ltd.* [Gromax Plasticulture Ltd. v. Don & Low Nonwovens Ltd., 1999 RPC 367], Lindsay, J., defined "bad faith" in the following terms:

"Plainly it requires dishonesty, as I would hold. It includes also some dealings which fall short of the standards of acceptable commercial behaviour deserved by reasonable and experienced men in the particular area being examined."

50. The High Court of Punjab and Haryana, in *Bhupinder Singh Vohra v. State of Haryana* [Bhupinder Singh Vohra v. State of Haryana, 1968 SCC OnLine P&H 74 : AIR 1968 P&H 406], defined "bad faith" thus:

"The term 'bad faith' is a shade milder than malice, and implies breach of faith or wilful failure to respond to one's known obligation or duty. Bad judgment or negligence is not 'bad faith', which imports a dishonest purpose, or some moral obliquity and implies conscious doing of wrong. It is much more than a mistake of judgment and is synonymous with dishonesty."

xxx xxx xxx"

(Emphasis Supplied)

21. This Court finds no merit in the contention of the respondent no. 1, that the present petition is not maintainable under Section 47 of the Trade Marks Act. The respondent no. 1 has raised the contention that the present



petition has been filed before the lapse of five years and three months period pertaining to non-use of the mark in question. The said contention of respondent no. 1 is totally misplaced and is liable to be rejected, as the present case clearly falls within Section 47 (1)(a) of the Trade Marks Act, on account of no *bonafide* use of the mark in question by respondent no. 1, since its registration. Section 47(1)(a) of the Trade Marks Act, reads as under:

“47. Removal from register and imposition of limitations on ground of non-use.—(1) A registered trade mark may be taken off the register in respect of the goods or services in respect of which it is registered on application made in the prescribed manner to the Registrar or the Appellate Board by any person aggrieved on the ground either—

(a) that the trade mark was registered without any bona fide intention on the part of the applicant for registration that it should be used in relation to those goods or services by him or, in a case to which the provisions of section 46 apply, by the company concerned or the registered user, as the case may be, and that there has, in fact, been no bona fide use of the trade mark in relation to those goods or services by any proprietor thereof for the time being up to a date three months before the date of the application; or

xxx xxx xxx”

(Emphasis Supplied)

22. As noted above, in the present case, the respondent no. 1 obtained registration of the mark in question, on ‘*proposed to be used*’ basis. However, there has been no *bonafide* use of the trademark in question ever, in relation to the goods and services, for which, the said mark has been registered, by the respondent no. 1. Thus, in this regard, this Court in the case of ***Russell Corpn. Australia Pty. Ltd. v. Ashok Mahajan and Another, 2023 SCC OnLine Del 4796***, has held as follows:

“xxx xxx xxx

25. In the context of non-use, it is the settled legal position that use has to be genuine use in the relevant class of goods and services. Unless the non-use is explained by way of special circumstances, the



mark would be liable to be removed for non-use. In the present case, no special circumstances have been cited and, in these facts, the mark would be liable to be removed on the ground of non-use itself.
xxx xxx xxx”

(Emphasis Supplied)

23. The respondent no. 1 has been unable to show any user of the mark in question and no documents in regard to sale of any of its products under the mark in question, has been produced or filed before this Court. A *bona fide* intent to use a trademark can be evidenced by way of documentary evidence. However, if there is failure to provide such evidence, the same would amount to a lack of *bona fide* intention to use. On this aspect, it would be apposite to refer to *McCarthy on Trademarks and Unfair Competition (Volume 3, 5th Edition)*, wherein, the following has been observed:

“xxx xxx xxx

19:14 Intention to use-What is a bona fide intention to use?- Objective test of bonafide/good faith

xxx xxx xxx

Lack of Documentary Evidence of Intent to Use. One way an opposer can establish a prima facie case of a lack of bona fide intent to use is to establish that applicant has no documentary evidence to support its allegation of an intent to use as of the filing date.

xxx xxx xxx

A challenger (such as an opposer) has the initial burden of demonstrating by a preponderance of the evidence that applicant lacked a bona fide intent to use the mark on the identified goods. If the challenger satisfies this initial burden then the party who made the application must present documentary evidence showing an intent to use or some other evidence explaining the absence of documentary evidence. The challenger can satisfy its initial burden by showing that there is an absence of documentary evidence of an applicant's intent to use the designation as a mark. This absence of any documentary evidence to support applicant's claim of a bona fide intent to use establishes a prima facie case that applicant lacks a bona fide intent to use. Then the burden shifts to the applicant to come forward with evidence which would adequately explain or outweigh the failure to have documentary evidence.

This means that if an ITU applicant, when challenged, has no



documents supportive of its claimed intent to use, then this absence of evidence is usually sufficient to prove that applicant lacked a bona fide intention to use. If the challenge is made as to all of the goods and services and the applicant fails to produce any evidence of a bona fide intent to use on any of the goods or services, then the opposition can be sustained as to all of the goods or services.
xxx xxx xxx”

(Emphasis Supplied)

24. Thus, holding that trafficking in trademarks is to be prevented when a party does not have any *bonafide* intention to use the trademark, Supreme Court in the case of ***Kabushiki Kaisha Toshiba Versus Tosiba Appliances Company and Others, 2008 SCC OnLine SC 960***, has held as follows:

“xxx xxx xxx

46. The intention to use a trade mark sought to be registered must be genuine and real. When a trade mark is registered, it confers a valuable right. It seeks to prevent trafficking in trade marks. It seeks to distinguish the goods made by one person from those made by another. The person, therefore, who does not have any bona fide intention to use the trade mark, is not expected to get his product registered so as to prevent any other person from using the same. In that way trafficking in trade mark is sought to be restricted.

xxx xxx xxx”

(Emphasis Supplied)

25. Facts in the present case, clearly point to the case of trademark squatting by the respondent no. 1, as no use of the mark has been shown by respondent no. 1 since its registration, for the goods for which the mark has been registered. Trademark squatting has been defined as an internationally known intellectual property misdemeanour, wherein, parties seek to register third party marks domestically, before their legitimate right holders have an opportunity to secure their rights. The clear intent of respondent no. 1 is to steal the mark of the petitioner, so as to block the petitioner’s attempt to have it registered in its name, which is, the textbook definition of trademark squatting. Thus, in the case of ***BPI Sports LLC (Supra)***, this Court, while dwelling on the issue of trademark squatting, has held as follows:



“xxx xxx xxx

52. “Trade mark squatting” is an internationally known intellectual property misdemeanour, though it does not find specific place in the Trade Marks Act. Prof. Doris Estelle Long has, in her article “Is Fame All there is? Beating Global Monopolists at their Own Marketing Game” defined a “trade mark squatter” as “a person who seeks to register third party marks domestically before their legitimate rights holders have an opportunity to secure their rights”. Elsewhere, in the same article, the learned author observes that “a trade mark squatter steals another's mark and registers it as a trade mark in his countries knowing that it belongs to someone else”. In their article trade marks squatters: Evidence from Chile, Carsten Fink (Economics & Statistics Division, WIPO, Geneva, Switzerland), Christian Helmers (Assistant Professor, Santa Clara University, USA) and Carlos Ponce (Associate Professor of Economics, Ilades-Universidad Alberto Hurtado, Santiago, Chile) explained trade mark squatting, terming it a recent phenomenon, thus:

“In recent years, popular media and specialised blogs have reported widely about a phenomenon called ‘trade mark squatting.’ This phenomenon describes a situation in which a company or individual registers a trade mark that protects a good, service, or trading name of another company. This latter company has usually invested in brand recognition and built substantial goodwill in the product, service, or trading name, but has not registered a trade mark. Squatters attempt to register such trade marks, in most cases not with the intention to use these trade marks in commerce, but with the intention to extract rents from the brand owners or other companies that rely on the brand, such as importers in case of foreign brands. A typical scenario is for a squatter to register the trade mark of a foreign brand and wait until the foreign brand owner enters the local market. Once the brand owner has entered, the squatter may threaten to sue for trade mark infringement. It may be possible for the brand owner to get the intellectual property office or a civil court to cancel the trade mark, but this is costly and may involve considerable delay and legal as well as commercial uncertainty.”

53. There can be no manner of doubt that the act of Respondent 1 in registering the BPI SPORTS word mark, which, to his knowledge and awareness, was registered in the name of the petitioner in the USA and in which the petitioner had global repute, in his name, constitutes “trade mark squatting”. Though trade mark squatting as an individual phenomenon does not find especial mention in the Trade Marks Act, it would certainly amount, in my opinion, to “bad faith” within the meaning of Section 11(10)(ii) of the Trade Marks Act.



The clear intent of Respondent 1, which is also the textbook definition of trade mark squatting, is to steal the mark of the petitioner, so as to block the petitioner's attempt to have it registered in its name — as has happened in the present case.

xxx xxx xxx”

(Emphasis Supplied)

26. From the pleadings and documents on record, it is clear that the respondent no. 1 has never used the mark in question and is merely squatting on the said mark. Nothing has been produced before this Court by the respondent no. 1 to show even a single user of the mark in question.

27. This Court also rejects the contention of respondent no. 1 that petitioner is not a ‘person aggrieved’. The rights of the petitioner are clearly being limited due to the existence of the impugned mark on the Register and the restraint faced by the petitioner in registration of their mark. Thus, this Court in the case of ***Kia Wang Versus Registrar of Trademarks and Another, 2023 SCC Online Del 5844***, has held as follows:

“xxx xxx xxx

22. In Khoday Distilleries Limited (now known as Khoday India Limited) v. Scotch Whisky Association, (2008) 10 SCC 723 the Supreme Court highlighted the importance of maintaining purity of the Register of Trade Marks and held that public interest has to be kept in view. It was observed that what is necessary for the Registrar of Trade Marks, when registering a trademark is to first arrive at a conclusion as to whether having regard to the nature of the mark sought to be registered and the use thereof as also the class of buyers, there is a likelihood of deception or confusion and if the answer is in the affirmative, rectification and correction of the Register may be entertained. A Co-ordinate Bench of this Court in Mr. Sanjay Chadha trading as Eveready Tools Emporium v. Union of India, W.P.(C) (IPD) 12/2021 decided on 17.02.2022 has also emphasized that maintaining purity of the Register is in public interest. Section 57 of the Act empowers the High Court and the Registrar to make an order for cancelling or varying the registration of trademark on an application made in the prescribed manner by any person aggrieved. The Supreme Court in Hardie Trading Ltd. (supra) considered the phrase ‘person aggrieved’ albeit referring to Trade and Merchandise Marks Act, 1958 and the interpretation is relevant



since grounds of Sections 46 and 56 of the said Act are *pari materia* with Sections 47 and 57 of the 1999 Act. Relevant passages from the judgment are as follows:—

“30. The phrase “person aggrieved” is a common enough statutory precondition for a valid complaint or appeal. The phrase has been variously construed depending on the context in which it occurs. Three sections viz. Sections 46, 56 and 69 of the Act contain the phrase. Section 46 deals with the removal of a registered trade mark from the Register on the ground of non-use. This section presupposes that the registration which was validly made is liable to be taken off by subsequent non-user. Section 56 on the other hand deals with situations where the initial registration should not have been or was incorrectly made. The situations covered by this section include: (a) the contravention or failure to observe a condition for registration; (b) the absence of an entry; (c) an entry made without sufficient cause; (d) a wrong entry; and (e) any error or defect in the entry. Such type of actions are commenced for the “purity of the Register” which it is in public interest to maintain. Applications under Sections 46 and 56 may be made to the Registrar who is competent to grant the relief. “Persons aggrieved” may also apply for cancellation or varying an entry in the Register relating to a certification trade mark to the Central Government in certain circumstances. Since we are not concerned with a certification trade mark, the process for registration of which is entirely different, we may exclude the interpretation of the phrase “person aggrieved” occurring in Section 69 from consideration for the purposes of this judgment.

31. In our opinion the phrase “person aggrieved” for the purposes of removal on the ground of non-use under Section 46 has a different connotation from the phrase used in Section 56 for cancelling or expunging or varying an entry wrongly made or remaining in the Register.

32. In the latter case the locus standi would be ascertained liberally, since it would not only be against the interest of other persons carrying on the same trade but also in the interest of the public to have such wrongful entry removed. It was in this sense that the House of Lords defined “person aggrieved” in the matter of Powell’s Trade Mark, Re, (1894) 11 RPC 4 : [1894] A.C. 8 : 70 LT 1 (HL):

“... although they were no doubt inserted to prevent officious interference by those who had no interest at all in the register being correct, and to exclude a mere common informer, it is undoubtedly of public interest that they should not be unduly limited, inasmuch as it is a public mischief that there should



remain upon the register a mark which ought not to be there, and by which many persons may be affected, who, nevertheless, would not be willing to enter upon the risk and expense of litigation.

Whenever it can be shown, as here, that the applicant is in the same trade as the person who has registered the trade mark, and wherever the trade mark, if remaining on the register, would, or might, limit the legal rights of the applicant, so that by reason of the existence of the entry on the register he could not lawfully do that which, but for the existence of the mark upon the register, he could lawfully do, it appears to me he has a locus standi to be heard as a person aggrieved."

23. In the present case, in my opinion, case of the Petitioner fits into the description of 'person aggrieved' since the registration of the impugned trademark operates in restraint of the legal right of the Petitioner emanating from prior, long, continuous and uninterrupted user since 2014. Surely, the benefit accruing to Respondent No. 2 by virtue of the registration of the impugned trademark casts a corresponding disadvantage on the Petitioner and he has the right and locus to assert that registration of the impugned trademark deserves to be cancelled and the Register of Trade Marks rectified to that extent.

xxx xxx xxx"

(Emphasis Supplied)

28. In view of the discussion hereinabove, it is evident that the impugned trademark registration is in derogation of the petitioner's rights. Thus, the petitioner is '*person aggrieved*' and has locus to file and maintain the present petition.

29. This Court also rejects the contention of respondent no. 1 that the petitioner has accepted the existence of the trademark of respondent no. 1. There has been no use of the registered mark by the respondent no. 1 in respect of the goods for which it is registered. Thus, it cannot be said to be a case of either concurrent use or continuous use by the respondent no. 1. Just because the petitioner has approached this Court after three years of the knowledge of the registration of the respondent no. 1, cannot in any manner



be construed that the petitioner has accepted the registration in favour of respondent no. 1, when no products of the respondent no. 1, *qua* which the trademark of the respondent no. 1 stands registered, are available in the market.

30. This Court also rejects the contention of respondent no. 1 that no prejudice is being caused to the petitioner, since the respondent no. 1 does not manufacture and market any product, which is similar to the petitioner's products. The said contention is not tenable and cannot be accepted. Thus, holding that the test of '*field of activity*' is no more valid and although the goods may be totally different with no trade connection between them, still, there would be a likelihood of deception or confusion, Division Bench of this Court in the case of *Larsen & Toubro Limited Versus M/S Lachmi Narain Trades and Ors.*, 2008 SCC OnLine Del 183, has held as follows:

“xxx xxx xxx

12. Mr. Kaul, learned counsel for the respondents, however, argued that since some of the products marketed by the defendants under the trademark/logo LNT/ELENTE are not even manufactured or marketed by the plaintiff-appellant herein there was no justification for restraining the use of the said trademark or logo vis a vis such products. We do not think so. As rightly held by the learned Single Judge the test of “field of activity” is no more valid. The question really is one of real likelihood of confusion or deception among the consumers and the resultant damage to the plaintiff. The legal position on the subject is fairly well settled by a long line of decisions rendered by this Court as also the Apex Court.

13. In Sunder Parmanand Lalwani v. Caltex (India) Ltd., AIR 1969 Bombay 24, a division bench of Bombay High court while dealing with the question whether there was any tangible danger of confusion between Caltex watches and Caltex petrol and various other oil products of the opponents, observed that although the goods were totally different and there was no trade connection between them still there was a likelihood of deception or confusion. The court observed:

“On the facts of this case, we have no hesitation in holding that a large number of persons, if they see or hear about the mark



“Caltex” in connection with watches, would be led to think that the watches were in some way connected with the opponents, or they would at least wonder whether they were in any way connected with the opponents. Persons seeing the mark attached to watches, which is a new class of goods, would assume, or are most likely to assume, that they originated from the proprietor of the mark, namely, the opponents.”

14. In Bata India Ltd. v. Pyare Lal & Co. Meerut City, AIR 1985 Allahabad 242, the Allahabad High Court was dealing with a situation where the plaintiff was manufacturing shoes, while the defendant was producing goods like foam and analogous products. Rejecting the argument that there was no possibility of any deception on the purchaser of foam materials in the market, the Court observed:

“This argument loses sight of an important feature viz., how would a lay customer know in the first place that the plaintiff was not producing foam or foam material ‘How would the customers know that Bata were not producing foam’ It is well known that the name represented makers of shoes and analogous products, but a question would also arise in the mind of the lay customers whether Bata were also producing foam. Who is going to answer this question? Does an ordinary customer ask the seller as to whose product it is? The answer generally is in the negative. He buys a thing on the basis of his own impression.

Merely because the plaintiff in case is not producing foam is not enough to hold that there can be no passing off action in respect of the user of the name ‘Bata’ to the products marketed by the defendants. The user of the name or mark ‘Bata’ by the defendants is indicative of their intent. It appears that they desire to market their foam with a view to gain some advantage in a competitive market. As seen earlier, there is no plausible explanation as to why the name ‘Bata’ was being used by them. A passing off action would lie even if the defendants were not manufacturing or producing any goods similar to that of the plaintiff. A passing off action would lie where a misrepresentation is likely to be caused or a wrong impression created, as if the product was of some one else.”

15. In Daimler Benz Aktiegesellschaft v. Hybo Hindustan, AIR 1994 Delhi 239, a single judge of this court while issuing an injunction against the defendant from using the word ‘Benz’ with reference to any underwear manufactured by them in the face of the same being used by the plaintiffs therein for their cars, observed as follows:

“5. I think it will be a great perversion of the law relating to



Trade Marks and Designs, if a mark of the order of the “Mercedes Benz” its symbol, a three pointed star, is bumbled by indiscriminate colourable imitation by all or anyone; whether they are persons, who make undergarments like the defendant, or any one else. Such a mark is not up for grabs — not available to any person to apply upon anything or goods. That name which is well known in India and world wide, with respect to cars, as is its symbol a three pointed star.”

xxx xxx xxx”

(Emphasis Supplied)

31. While holding that action against a party can still be maintained despite the goods existing in different Classes, this Court in the case of ***Aktiebolaget Volvo & Ors. Versus Mr. Vinod Kumar & Ors., 2011 SCC OnLine Del 1180***, has held as follows:

“xxx xxx xxx

21. *The defendant has contended that the word VOLVO is a generic word which means ‘I roll’. There are not many people in India who know the Latin language, therefore, it can hardly be said to be a generic word. On the contrary, there is a judicial finding as reproduced hereinabove, wherein it has been specifically said that it is a Latin word, not known to many people and it has been adopted by the plaintiff way back in 1915 for its automobiles etc. and was adopted by the plaintiffs in India from 1975 and thus have attained certain amount of distinctiveness and standard and quality of product so far as the plaintiff is concerned. **Therefore, it cannot be said that merely because the defendant is using the word VOLVO in respect of ice cream which falls in a class of goods which are not manufactured by the plaintiff itself, there cannot be an action for infringement or passing off as has been done in the instant case.***

22. **As a matter of fact, there are number of judicial pronouncements of our own High Court and other Courts, where the user of the known trademark for a different class of goods or services has been restrained on account of the fact that it is likely to cause confusion and thereby dilute the distinctiveness and the reputation of the registered trade mark and thus would be detrimental to the reputation of the party concerned. Reliance in this regard can be placed on Daimler Beriz v. Hybo Hindustan 1994 PTC 287 Del, Alfred Dunhel v. Kartar Singh 1999 PTC (19) 294, Mahindra v. Mahindra AIR 2002 SC 117 and Bata India Ltd v. Payrelal PTC Supp (1) 116 All. In all these cases, the**



offending trade mark/name was restrained from being used for a product unconnected with the product of the proprietor in respect of which the trade mark/name was registered. Therefore, by no stretch of imagination, it can be said that the user of the word VOLVO though adopted by the defendant in respect of ice cream cannot be said to be violative and infringing the trade mark of the plaintiff or that it is not likely to cause confusion or will not be detrimental to the interest of the plaintiff.

xxx xxx xxx”

(Emphasis Supplied)

32. In view of the detailed discussion hereinabove, the present petition is allowed and the Trade Marks Registry is directed to remove the impugned registration of trademark **BOLDIFY.**, registered under application no. 3867168 in Class 3, from the Register of Trade Marks.

33. The Registry of this Court is directed to send a copy of the present order to the Trade Marks Registry, at Email: llc-ipo@gov.in, for compliance.

34. The present petition is accordingly, disposed of.

(MINI PUSHKARNA)
JUDGE

APRIL 15, 2025

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