CNR No : HCBM020405262025

MANALI PRASANNA TILAK
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IN THE HIGH COURT OF JUDICATURE AT BOMBAY

ORDINARY ORIGINAL CIVIL JURISDICTION

COMMERCIAL APPEAL (L) NO. 40525 OF 2025
IN
COMMERCIAL MISCELLANEOUS PETITION NO. 538 OF 2022
WITH
INTERIM APPLICATION (L) NO. 40663 OF 2025
IN
COMMERCIAL APPEAL (L) NO. 40525 OF 2025

1 Anil Shah Trading as Le Shark India (India) R/o of 306/2307, Premson Industrial Estate, Tahira Compound, Jogeshwari (East), Mumbai 400060. .. Appellants

2 Anil Laxmichand Shah, Mrs. Kiran Anil Shah and Bharat Damji Sadiwala Trading as Le Shark Global LLP,.. Address : 307, Premsons Industrial Estate, Caves Road, Jogeshwari (East), Mumbai 400060

Versus

1. Le Shark Apparel Limited, of Unit, 14, park Seventeen, Whitefield, Manchester M45 8FJ United Kingdom. .. Respondents

2. Registrar of Trade Marks, Trade Marks Registry, Boudhik Sampada Bhavan, Antop Hill, SM Road, Mumbai 400037.

...

Mr. Alankar Kirpekar a/w Mr. Lakshyaved R. Odhekar, Mr. Omkar N Mhasde, Mr. Ayush Tiwari, Ms. Janaki Bhide, Mr. Sujen Shaikh and Mr. Syed Nabeel Ali, for Appellant.
Mr. Rohan Kadam, Ms. Rucha Vaidya, Mr. Manosij Mukharjee, Ms. Dominic Alvares and Ms. Sneha Meghani i/b Suvarna Joshi, for the Respondent.

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CORAM : BHARATI DANGRE &
ASHISH S. CHAVAN, JJ
RESERVED ON : 27th AUGUST, 2026.
PRONOUNCED ON: 25th NOVEMBER, 2026.

JUDGMENT:- (Per Bharati Dangre, J)

1. Being aggrieved by the order passed by the learned Single Judge (Justice R.I. Chagla,) on 14/10/2025, while pronouncing upon Commercial Miscellaneous Petition No. 538/2022 filed by the petitioner "Le Shark Apparels Ltd." (hereinafter referred to as 'Le Shark') seeking Rectification of the respondents registered trademark no.466002 in Class 25 for "Articles of Clothing, including Boots, Shoes and Slippers, Scarves and Raincoats" under Section 47 and 57 of the Trade Marks Act, 1999, which granted the said application and directed deletion of entry of the said trademarks, the present Commercial Appeal is filed under Section 13(1A) of the Commercial Courts Act, 2015.

2. We have heard learned counsel Mr. Alankar Kirpekar for the appellants impleaded as 'respondents' in the Miscellaneous Petition, whereas the petitioners in the Miscellaneous Petition and the respondents in the present Commercial Appeal "Le Shark" is represented by Mr. Rohan Kadam.

For the sake of convenience, we would refer to the petitioner as 'Le Shark" and the respondents who suffered the rectification as 'Anil Shah and others' or 'the Appellant'.

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3. Before we appreciate the rival claims staked before the learned Single Judge and pronounce upon the legality and validity of the impugned order, we would briefly refer to the factual background in which the application was preferred under Section 47 and Section 57 of the Trade Marks Act, 1999 by 'Le Shark Apparel' and which came to be granted.

The petitioner Le Shark claimed to have secured the following registrations :-

(1) In the year 1984, the trade mark LESHARK and the device mark  being a unique, original and fanciful portmanteau of "Le" and 'Shark' with a unique graphic of a shark was conceived and adopted by the predecessors of respondent no.1 in the UK (Le Shark Limited).

(2) On 14/5/1984, respondent no.1's predecessor (Le Shark Limited) was granted registration of the device mark  in the United Kingdom in Class 25 (shirts, T-shirts, jumpers, trousers) under Registration No. UK00001218623.

(3) On 18/5/1984, Leshark Ltd. was granted registration for the device mark  in the United Kingdom in Class 25 (shirts, T-shirts, jumpers trousers) under Registration No. UK00001219092.

(4) On 5/6/1984, Le Shark Limited was granted registration of the mark  in the United Kingdom in

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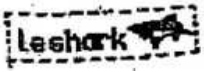
class 25 (shirts, T-shirts, jumpers, trousers) under registration no. UK00001220074.

(5) On 16/9/1985, Leshark Ltd was granted registration of the mark  in the United Kingdom in class 25 (shirts, T-shirts, jumpers, trousers) under Registration No. UK00001250917.

(6) In the year 1987, the mark leshark  was registered in France and Benelux.

4. According to Leshark, its predecessor had considerable goodwill and had associate/affiliates in India and through Aldgate Warehouse (Wholesale) Ltd, one of its affiliate, it used to source its clothing material from manufacturers in the Indian subcontinent.

It alleged that on 13/1/1987, Anil Shah applied for registration of his mark 'Leshark'  in India, under Application No. 466002 in Class 25 for Articles of Clothing, Including Boots, Shoes and Slippers, Scarves and Raincoats in India on a 'proposed to be used basis'.

It is the claim of Le Shark that this mark is identical to the trademark registered by its predecessor in UK under registration no. UK00001250917. It is on 15/10/1991, the registration was granted in favour of Anil Shah by Registrar of Trade Marks in India.

Le Shark claimed that between the years 1999 and 2001, it obtained registration of the mark 'Leshark' 

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in the UK in Class 3, 8, 9, 14, 16, 18, 20, 21, 24, 25, 26, 27, 28, 30, 35 and 36.

According to Leshark on 13/1/2008, Anil Shah's mark which  was registered under Application No. 466001 since 13/1/1987, was removed from the register in India for non-user and it claimed that this trade mark identical to shark device registered by Leshark's predecessor in the Benelux countries.

5. It is in October 2013, Le Shark Apparel Limited, a joint venture company was incorporated under the laws of United Kingdom and it became the registered proprietor of the following trademarks by virtue of assignment by Grabal Alok:- 



Pursuant to this, in December 2014, it officially relaunched the 'LE SHARK' and thereafter, it marked global presence with worldwide sales reaching over 5 million, with its product being sold through various websites by use 

of its mark as ASOS.com, www.tkmaxx.com, Leading Label, Tokyo Laundry, The Hut, Amazon, Studio.co.uk, Jeansfield etc. Le Shark continued to promote its products under the brand 'Leshark' by participating in various exhibition and trade shows across the globe. It is on 17/2/2015, Leshark filed application No. 2904714 for registration of its trade mark 'Le Shark' in India in Class 25 for Clothing, Footwear, Headgear.

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Pursuant thereto, the Registrar of Trade marks forwarded the copy of examination report along with its search report, intimating it about the presence of Anil Shah's trademark and it responded to the examination report by requesting a date of hearing.

6. On 1/10/2016, an LLP Agreement was executed between Anil Shah (appellant no.1), Kiran Shah and Damji Sadiwala, which resulted into formation of Leshark LLP and Anil Shah Trading as Le Shark India assigned the impugned trademark to Leshark LLP, who renewed it with effect from 13/1/2018 for another 10 years and on 11/1/2018, an application was preferred to the Registrar of Trade Mark to have its name recorded as proprietor of the impugned trademark.

7. It is on 20/3/2018, Le Shark Apparel filed an application before Intellectual Property Appellate Board (IPAB) for Removal/Cancellation of the Registered Trademark No. 466002 in the name of Anil Shah Trading as M/s. LE SHARK EXPORTS PRIVATE LIMITED in Class 25 under Section 9, 11, 18(1), 47, 57, of the Trade Marks Act, 1999.

The Rectification Petition came to be admitted by IPAB on 8/10/2018, however, pursuant to the Tribunal Reform Act, 2021, upon IPAB being abolished, the Rectification Petition was transferred to the High Court, and was adjudicated by the Single Judge who passed the

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impugned order on 14/10/2025, allowing the petition and directing removal of the marks of Anil Shah Trading as Leshark (India) and Anil Shah along with two others trading as 'Leshark Global LLP.'.

However, one more event deserve a mention, being on 7/4/2021, the application filed by Leshark for registration of its mark in India came to be refused, though the rectification proceedings were pending at the relevant time and being aggrieved, a Review Petition was filed against the said order, which is heard but the order is awaited.

8. It is in these background facts, we are called upon to appreciate the justiciability of the impugned order passed by the learned Single Judge, who allowed the application filed on both counts i.e. under Section 47 as well as Section 57 of the Trade Marks Act, 1999 with the following pertinent observations on this count, which reads to the following effect :-

> "75. The argument of the Respondents that the Petitioner had only proved use of its trademark from 2014 onwards and that too outside India and that the Petitioner has no trans-border reputation would have no relevance to the present enquiry. This, in view of the present proceedings being for rectification of the impugned trademark and not in respect of trademark infringement and/or passing off where such issues are relevant. The only enquiry before this Court would be whether the impugned registered trademark is liable to be rectified under Sections 47(l)(a) or 47(l)(b) of the Act and/or for 'sufficient cause' under Section 57 of the Act.
>
> 76. Having arrived at a prima facie finding that the impugned registered trademark is liable to be rectified

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> under Section 47 for having been borne out of the fraudulent adoption and not having been bonfidely used, the use by the Petitioner of its trademark from 2014 onwards and that too outside India is of no consequence. Thus, the judgments relied upon by the Respondents in support of their contention have no application to the facts of the present case.
>
> 82. Section 57 of the Act confers discretion upon the Court to maintain purity of the Register. Having prima facie held that there is fraudulent adoption of the impugned trademark by the Respondents, the impugned trademark merits removal from the Register for sufficient cause.
>
> 83. Accordingly, the Commercial Miscellaneous Petition is made absolute. The entry relating to Trademark No. 466002 in Class 25 shall be removed/expunged from the Register of Trade Marks."

9. Raising a serious challenge to the impugned order, Mr. Alankar Kirpekar would submit that the perusal of the application for rectification and the grounds pleaded therein, clearly fail to make out any case for exercise of power under section 47 and 57 of the Trade Marks Act, and in fact it supports the case of the appellants as registered proprietor of the mark.

Dealing with the finding as regards the applicability of Section 47 of the Trade Marks Act, he would submit that the petitioner before the learned Single Judge pleaded a non-use of the impugned mark 'LE SHARK' on behalf of the registered proprietor for a period of five years three months, or there is no bonafide use of the mark 'LE SHARK' and hence, as per the provisions of Section 47(1)(a) and (b), the registered trademark 'LE SHARK' is required to be

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removed from the register and this contention is accepted by the learned Single Judge while allowing the application for rectification.

According to Mr. Kirpekar, there is a clear cut admission of use of registered trademark by Leshark in its pleading and in fact, in the application filed for rectification, it has admitted the user of Anil Shah and others by referring to them as 'Anil Shah Trading' as LE SHARK (India) and 'Anil Laxmichand Shah, M/s. Kiran Anil Shah and Bharat Damji Sadiwala trading as LE SHARK GLOBAL LLP, Jogeshwari (East) Mumbai. According to him, the said reference itself amounts to an admission of the use of the mark 'LE SHARK' as a trade name.

According to Mr. Kirpekar, the definition of the term 'mark' in Section 2(m) of the Act, include a name and use of trading name is equivalent to the use of the mark and therefore, the admission of use of the trademark 'LE SHARK' by the registered proprietor, in the application for rectification on behalf of the petitioner, is ignored by the learned Single Judge. Apart from this, he would submit that the use of the mark "LE SHARK" as a part of domain name and also along with logo, as a mark on the web pages of domain name, are completely ignored. He would submit that the application for rectification admitted use of mark on the website 'www.leshark-india.com and even the print out of the web page was also annexed, which itself is

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admission of the use of the mark 'LE SHARK' as a part of domain name and also on the web page on visual representation and this admission bear great significance. In addition, it is submitted that reliance is placed upon domain name www.lesharkglobal.com which is extensively used by his client in the course of their business and for trading in goods bearing the said trademark, but unfortunately, according to Mr.Kirpekar, the Single Judge did not consider or deal with material evidence of the use and in fact, the petitioner 'Leshark' while relying upon and annexing the appellants website www.leshark-india.com conveniently did not refer to, or deal with www.lesharkglobal.com, despite the same having been specifically brought on record or being readily available online.

It is his submission that the learned Single Judge rendered a finding which is contrary to statutory provisions and is in ignorance of the pleading and admission by the petitioner in the Rectification Application itself, particularly when the use of mark 'Leshark' by registered proprietor is established by virtue of a clear admission on its behalf.

10. In the course of challenge being raised to the impugned order, the learned counsel would submit that 'Leshark' in its application for rectification filed in the year 2018, pleaded that the appellants were not using the mark at all without giving any proof of alleged non-use.

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Inviting our attention to Section 47 of the Trade Marks Act, it is urged that the period of inquiry must precede five years and three months from the date of the Application for Rectification, which was preferred on 20/3/2018 and therefore, what was required to be proved was the non-user for the period between 2012–13 and 2018.

It is submitted that the appellants Anil Shah and others annexed specimen invoices to their counter-statement, which included invoices of 1990 and 18/8/2015, but out of the whole series of invoices, the learned Single Judge picked up only two invoices in the name of "Isha Crafts Private Limited", for the year 2006–2007, and classified them as ‘fabricated’, on the ground that the entity was incorporated in 2009, and hence concluded that the invoices were forged.

However, it is urged by Mr. Kirpekar that the period of 2006–07 was not required to be considered, as the relevant period of inquiry was from 2012 onwards. Apart from this, it is urged that Isha Crafts Private Limited had placed a purchase order upon the appellants and in the ordinary course of business and goods were supplied under its trademark pursuant to the purchase order by raising an invoice, and the payment was received and there was no reason or occasion to question the legal existence or

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corporate status of the entity while conducting such transaction.

11. Another point which was focused upon by Mr. Kirpekar is the use of the website, as according to him, Leshark itself relied upon appellant's website (www.leshark.com), in its pleadings and annexed a screenshot but the learned Judge erroneously held that such website usage is insufficient to sustain the validity of the registration and arrived at a conclusion that the use of the trademark on the webpage by Anil Shah and others is "sporadic" and therefore not a bona fide use.

Reliance is placed by Mr. Kirpekar on the decision of the Apex Court *in* the case *of* ***Hardie Trading Limited vs. Addisons Paint & Chemicals Limited,***[1] where it is authoritatively held that the expression "use" under the Trade Marks Act must receive a broad and purposive interpretation, as it is held that with reference to the definition under section 2(2)(b), that the use may be other than physical. It may be in any other relation to the goods and there is no reason to limit the 'user', to the use of the goods or the sale of goods bearing the trademark and it was expressly held that there is no reason to restrict goods only to sale of goods bearing the mark, but advertisements, catalogues, price lists, promotional activities and commercial communications, bearing the mark would also

1 (2003) 11 SCC 92

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constitute the ‘use’, sufficient to defeat a plea of non-use.

Thus, it is urged by Mr. Kirpekar that the learned single judge ignored the appellants continuous operation of the website, displaying and representing goods under the mark "LE SHARK", constituting the trademark used in its commercial sense.

According to him, the website is not a passive or incidental presence, but it is a source-identifying commercial instrument and constitute bonafide use in relation to the goods and the continuous operation and commercial display of the mark by the appellant on their website must analogically and legally be construed as ‘use’ within the meaning of the Section 47 of the Trade Marks Act.

12. Mr. Kirpekar would also submit that the burden of proving non-use squarely fall on the applicant who files an application for rectification.

He would invoke the principle laid down by this Court *in* ***Eagle Potteries Private Limited v. Eagle Blast Industries Private Limited***,[2] where it is held that was non-use must be established through unimpeachable evidence, and mere averment or bald statement is not sufficient. According to him, the burden in rectification proceedings is heavy and lies entirely upon the applicant seeking removal but in the present case, a reading of the application would reveal that

2 1992 SCC Online Bom 490

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'Leshark', the applicant before the IPAB (then the High Court), failed to discharge the said burden and even the learned Single Judge chose to rely only upon two invoices raised in the name of "Isha Crafts Private Limited" and concluded that they appeared to be fabricated, ignoring the other documentary evidence spanning decades.

It is thus urged by Mr. Kirpekar that a final adjudication affecting a long-standing statutory right cannot rest upon a *prima facie* assumption, where the law to the effect categorically state that the burden of proving non-user falls strictly on the party alleging it and bald averments are insufficient. He would submit that no oral evidence was lead, nor was any additional affidavit filed by Leshark to conclusively establish non-use and had this evidence been brought on record the appellants would have availed the opportunity to rebut the same and lead further evidence in support of their use but in absence of the burden being discharged by the Petitioner, there was no question of them bringing any material to the contrary on record. Thus, it is his case that no case under section 47 was made out, and the application for removal of the mark ought to have been dismissed on the ground of clear admission of Leshark Apparel and also on the ground that it failed to lay down the foundational facts.

In relation to Section 57 of the Trade Marks Act, Mr. Kirpekar would urge that the claim was based on the

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registration secured by Leshark's predecessor in title in the UK, US European Union, Australia and Canada, and on a pleading that its predecessor-in-title, was well-known in men's clothing in brand at least in UK by 1980 and Leshark officially relaunched 'LE SHARK' brand in December 2014. Therefore, it was pleaded that since it was a well-known brand, the registration obtained by the appellant Anil Shah, was in bad faith.

According to Mr. Kirpekar, the appellant obtained registration by filing an application on 13/1/1987 and the registration was granted by the Registry of Trade Marks after examining the legality of the applied mark, and it has remained on the register since then.

Inviting our attention to the scheme of the Act, he would submit that the Trade and Merchandise Marks Act, 1958, and the Trade Marks Act, 1999, are territorial in nature and hence, registration secured outside India is of no consequence for grant of registrations in India. He would invite our attention to Section 11 of the Act, prescribing the relative grounds for refusal of registration and it is his specific contention that earlier registrations outside India are not of any material consideration or consequence while examining an application for registration of a mark in India. As regards to passing off, he would submit that a clear case of the classical trinity is required to be established by showing beyond doubt, through cogent material evidence,

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that the applicant who sought rectification has established goodwill and corporate and/or transborder reputation, which has spilled into/over India through circulation of advertisements and other material evidence imputing knowledge of the brand to the consumers of the goods in the country.

13. According to Mr. Kirpekar, bad faith cannot be simplified or inferred just because the two marks are similar, as there is nothing brought on record prior to the adoption of the mark "Le Shark" by the appellant, or that it was made aware of the mark registered in United Kingdom in the year 1985.

The unsupported statements regarding use abroad by Leshark prior to 1987 is also of no consequence according to Mr. Kirpekar, as the mark was registered by the appellants in India in 1987 and there was nothing demonstrated by Leshark that its predecessor-in-title had acquired local goodwill or transborder reputation which was spilled over India prior to 1987.

It is also not established that Leshark had any business presence in India, and as no invoices or advertisements are produced along with the application nor has the spillover reputation or existing transborder goodwill in India been proved. On the other hand, it is submitted that the only commercial activity indicated by Leshark is from 2014, and that too outside India but the application

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for rectification has been filed solely because Le Shark intended to launch its business in India, which, according to Mr. Kirpekar, has not done till date.

Heavy reliance is placed upon the decision of this Court *in* ***Kores (India) Limited v. Whale Stationery Products Limited,***[3] which has re-affirmed that Trade Marks Act is territorial in its operation and does not recognize extra-territorial use as conferring enforceable rights in India, unless such use translates into legally protectable goodwill within the Indian market. It is also held that trademark rights in India must be tested on the touchstone of Indian registration, Indian use and Indian market realities, and cannot be displaced merely on the basis of foreign registration or overseas reputation.

14. Reliance is also placed upon the decision of the Apex Court in case *of* ***Toyota Jidosha Kabushiki Kaisha Vs. Prius Auto Industries Limited,***[4] which contemplate a proof that substantial segment of Indian consumers had knowledge of the mark prior to the the adoption of the rival mark.

In the absence of any such pleading or proof, according to Mr. Kirpekar, the observations in paragraphs 75 and 76 of the impugned order, reaching a conclusion that the mark is *prima facie* liable to be removed, and that the issue of transborder reputation is of no consequence, do

3 2002 (24) PTC 269 Bom
4 (2018) 2 SCC 1

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not follow the settled principles of law, as the learned Single Judge has overlooked the territorial scheme of the Act and the settled requirement that foreign standing cannot unsettle a long-standing Indian registration in the absence of strict of Indian goodwill.

According to Mr. Kirpekar, the application for rectification failed to prove any case under Section 47 or Section 57 of the Trade Marks Act, 1999, much less an alleged case of bad faith. According to him, the Single Judge has failed to appreciate that the removal of a trademark from the Register, especially the one that had been subsisted for 38 years, would cause serious civil and commercial consequences. He is extremely critical about the finding rendered in the impugned judgment, resulting into a drastic outcome, being merely based on just a prima facie or ex-facie basis, without conclusive adjudication based on strict and cogent evidence.

According to him, by removing the mark physically from the Register of Trade Marks in the month of April 2026, grave injustice is caused to the appellants as it was otherwise valid and subsisting and remained on the Register of Trade Marks for over three decades. On the other hand no harm or prejudice would be caused to Leshark, the respondent No.1 in the Appeal, if the mark is reinstated in the register during the pendency of the present commercial appeal, as in any case, Le Shark, till date, has not

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commenced its business operations in India, and there are no sales depicting its commercial presence.

Reliance is also placed upon the decision in case of ***Milmet Oftho Industries v. Allergan Inc.***[5] to submit that the ultimate test in such matters is, who is first in the market and he would rely upon the pertinent observation of the Apex Court to the effect that in case of Multi National Corporations which have no intention of coming to India or introducing their product in India should not be allowed to throttle an Indian Company by not permitting it to sell a product in India, if the Indian Company has genuinely adopted the mark and developed the product and is first in the market. According to him, the said observation of the Apex Court clearly apply to the case of the appellant.

He would also place reliance upon the observation of the Division Bench of Delhi High Court in case of ***Sumit Vijay v. Major League Baseball Properties Inc.***[6] in a commercial proceedings instituted under section 57(2) of the Trade Marks Act, 1999 in regards to bad faith adoption and the finding being rendered as regards the similarity of the impugned mark 'BLUE-JAY' being identical and similar to 'BLUE JAYS' as the Division Bench reversed the finding of the Single Judge that the adoption of mark 'BLUE-JAY' by the appellant was tainted with bad faith and it was liable to be cancelled under section 10(ii) of the Trade Marks Act

5 (2004) 12 SCC 624
6 2026 SCC OnLine Del 2

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and the same was set aside.

15. Opposing the stand adopted by Mr. Kirpekar, Mr. Kadam representing the Petitioner, Leshark Apparel Limited would support the reasoning adopted by the learned Single Judge in the impugned order, thereby allowing its Miscellaneous Petition and granting the relief as prayed for.

Mr. Kadam would assertively submit that the trademark 'LESHARK' and the device mark being a unique, original and fanciful portmanteau of 'Le' and 'Shark', with a unique graphic of a shark was conceived and adopted by its predecessors in United Kingdom as early as in the year 1984. Pursuant to this, the device mark was registered in United Kingdom in Class 25 for shirts, T-shirts, jumpers, trousers and the registration was repeatedly sought on more than one occasion in UK under distinct registration numbers. He would submit that since in business from 1984, its predecessor acquired considerable goodwill and it is this goodwill which it has zealously guarded and it is the attempt of the Appellant to piggy ride the same.

He would categorically submit that it is unfathomable that Leshark's mark having acquired an international fame, but the Appellant claim that it was unaware of it and in particular since the predecessor of Leshark was associated with Aldgate Warehouse Limited, as the clothing material was sourced through this entity from manufacturers in the Indian continent and the Appellants manufactured

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garments for Aldgate Warehouse (Wholesale) Limited. Thus, with the global presence of the predecessor of Leshark as well as Le Shark, with its worldwide sales reaching over 5 million and the sales being effected through various websites, it is the submission of Mr. Kadam that despite being aware of the international presence of the trademark Leshark, the appellant has attempted to seek its registration in India and this prompted Leshark to file a petition by invoking Sections 18, 47 and 57 of the Trademark's Act for rectifying the entry, the Petition being instituted before the IPAB, which was subsequently transferred to the High Court.

It is his submission that the registration sought by the Appellant in India was on a 'proposed to be used basis' in Class 25 for articles of clothing, including boots, shoes and slippers, scarves and raincoats and the registration was granted on 15/10/1991 but it could not have remained on the register, as the Petitioner had already acquired goodwill globally and the artwork/ device used by it was conceived and designed as early as in 1984 and thereafter received registration in United Kingdom for clothing in Class 25. It is therefore the contention of Mr. Kadam, that the Petitioner is the global proprietor of the registered mark and the other Le Shark marks and has sold the goods globally. Somewhere around in February 2015, while it was in preparation for its launch in India, it applied for registration of trademark and

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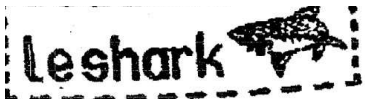
it application received objection from the registrar based on the very same artwork/device mark 

which was registered by the appellant on a 'proposed to be used' basis in Class 25 under Registration No. 466002. It is urged that the petitioner was shocked to learn that the Appellant No.1 has surreptitiously registered another artwork/device mark



which had also being designed by its predecessor and registered in UK, France and Benelux but this registration was removed from the register.

It is in these circumstances and fearing the consequences of an infringement action arising from the impugned registration, according to Mr. Kadam, the Petitioner was constrained to the delay launch of its goods in India and it preferred to file a Rectification Petition by invoking Sections 47 and 57 of the Trademark Act.

Supporting the judgment of the learned Single Judge, who has observed that the appellant had offered no explanation for adoption of the impugned artwork and that mere registration is no proof of user, and by merely presenting a case of alleged 30 years user, the learned Single Judge did not approve of the stand. On examining

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the evidence led by the parties, the Single Judge has rightly arrived at a conclusion that the impugned artwork/device mark was fraudulently adopted and the pleaded stand of long user of the impugned device mark was found to be not credible, as its veracity was impeached by submission of fabricated materials and therefore the mark under Registration No. 466002 was rightly expunged.

16. It is the contention of Mr. Kadam, that after failing before the learned Single Judge, the sheet anchor of the Appeal is, that the impugned mark of the appellant has stood on the register for over 30 years, but according to him, this foundation is of no consequence as by according registration to a mark under Section 31(1), what is achieved is only a *prima facie* evidence of its validity. However, in terms of Section 57(2), he would submit that an entry which is made without 'sufficient cause' and which continues to be on the register, is liable to be struck off, if it is entered unjustly and for this purpose, according to him, there is no period of limitation, when a rectification of this entry is sought and the length of the unchallenged occupation of the registrar is the trademark squatter's condition and not a defence available.

According to Mr. Kadam, the observation of the learned Single Judge about dishonest adoption is one which would fall within the ambit of Section 57(2) r/w Section 18 of the Trademarks Act and once it is concluded that the

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entry itself was made without sufficient cause and Section 18 puts the applicant's claim to the proprietorship at the time of making the application directly in issue, and therefore, the finding cannot be faulted with. Apart from this, the finding of dishonest adoption is also independently sustainable, according to Mr. Kadam, under Section 57(2), r/w Section 11 (10) (ii) of the Trademark Act, which provide for "bad faith… affecting the right relating to trademark" as a distinct ground for striking the registration.

According to him, the submission advanced by Mr. Kirpekar, as regards territoriality and non-applicability of Section 11(1) to 11(4) is a misdirected argument, since the case rests on absence of proprietorship and bad faith adoption under Section 18, 11(10) (ii) and 57 of the Act, each of it constituting a distinct ground. According to him, honesty in adoption is a fundamental underpinning principle of the Trade Marks Act, 1999 and this is borne out of its provision in particular Section 12, Section 11(10) (ii) and Section 18. According to him, the appellants cannot assail the finding of fabricated invoices on the ground of irrelevance, when no material evidence was produced, as regards use of the impugned mark which was registered, as the learned Single Judge has rightly noted that reliance was placed by the appellants on fabricated invoices and therefore a conclusion is rightly drawn that use of domain name by the appellant is not use of the impugned mark as

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registered and the contention of Mr. Kirpekar that mere description in the cause title of the rectification proceedings as 'Anil Shah trading as Le Shark' is an admission of user is also a misconceived argument. According to him, an inadvertent slip in the nomenclature, cannot reshape the substance or finality of an otherwise well reasoned and considered decision.

17. Heavy reliance is placed by Mr. Kadam on the decision in case of ***B.S. Ramappa vs. Mannappa***[7] when the Division Bench has held that, at the time of registration the Respondent was not the proprietor of the mark and therefore the application made by him was false to his knowledge and whenever the registration is obtained on a false claim of proprietorship and by suppression of material fact it would cover the contingency of 'without sufficient cause', which would justify rectification of an entry in the Register of Trade Marks. According to Mr. Kadam, the impugned mark is the very same artwork which originated from Leshark's predecessor, which was subsequently registered and neither in the pleading nor otherwise, any other evidence is placed before the learned Single Judge, as to how the appellant conceived or adopted the same art work. Notwithstanding that no explanation is offered, Anil Shah's own counter statement has created three mutually inconsistent accounts of adoption, as in the appeal it is

7 (1956) 69 LW 739

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pleaded that the business commenced 'on or about 1985' under the name and style of Le Shark (India). However, it is also pleaded in the appeal that 'in 1987 the respondent no.1 coined and started using unique trademark Le Shark and device mark of a shark. However, while responding to the rectification application, it is pleaded that the mark has been in the market since 1984 and on the register of trademark since 1987.

It is the contention of Mr. Kadam that none of the three alternative pleas can stand with the trademark application itself, as a proprietor who had been trading with the mark since 1984 or 1985 does not apply, in January 1987, on proposed to be used basis. Conversely, if the mark was coined only in 1987, the pleaded user from 1984 and the statement that the business commenced in 1985 are untrue, and thus, according to him, the contradiction is irreconcilable and that falsify the claim of the appellant. He would submit that the appellant had never pleaded that the artwork he claims have been coined in 1987. According to Mr. Kadam, the appellant has failed to establish his bonafides in adoption of the particular mark and according to him, inconsistency as to the origin of a mark, coupled with absence of any credible explanation is a recognized indicium of the want of bonafide adoption. According to him Section 18 requires the applicant claiming proprietorship of an unused mark to establish his

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proprietary right and the failure to do so was sufficient to justify the learned Single Judge to record a finding that the impugned mark was a proof of dishonest adoption and since this finding goes to the root of proprietorship under Section 18, it has made way to the rectification of the entry as it was made 'without sufficient cause'.

18. Further, appellant's reliance placed on **Kores (India) Ltd** (supra) according to him is misconceived, as:- it was a case of trademark infringement where the Learned Single Judge held at that it was bound to apply the registration as it stood and the remedy lay in rectification.

Further, according to him the findings in **Kores (India) Ltd.** (supra) on transborder reputation in order to defend an action for infringement and passing off cannot apply in the present case since Respondent has not relied on its transborder reputation or international registration to challenge the Appellant's registration but challenged the appellant's mark on the grounds of bad faith under Section 11(10)(ii), read with Section 18.

19. Further, Mr. Kadam submit that reliance placed upon the decisions on transborder reputation in the appellant's compilation do not take its case any further as the decisions in **Toyota** (supra) and ***Daiwa Pharmaceuticals Co. Ltd. v. Daiwa Pharmaceuticals Pvt. Ltd.***[8], are decisions upon the common law action of passing off, in which the claimant's

8 2024 SCC OnLine Bom 1078

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goodwill within the jurisdiction is a constituent element of the cause of action.

He would urge that the Appellant's mark is not challenged by Respondent based on its own goodwill and transborder reputation but the enquiry under Section 57(2) is directed towards the validity of the entry, and Section 18 asks, only whether the applicant was the proprietor and 11(10)(ii) asks whether the application was made in bad faith.

20. The Appellant's reliance on the Blue Jays case viz **Sumit Vijay** (supra) is also misconceived, as according to him; it was a case of a word mark as opposed to the specific artwork that is the same. It is inconceivable for two people to have made the same artwork not once but twice. The Registration of the very same artwork is itself a pointer of bad faith since no explanation was given by the Appellant, an inference further corroborated by the surrounding circumstances set out above. Further the Division Bench recognized that 'bad faith' under Section 11(10)(ii) was a separate ground for rectification under section 57 and not dependent upon any case under sections 11 (1) to (4). However, on facts it found that 'bad faith' to rectify the mark under section 11(10) (ii) had not been made out.

21. In the present case, Leshark's challenge to the Impugned mark is not based on its own prior user in India or internationally but on the fact that the Appellant has

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registered the very mark including the identical placement of the words "Le Shark" preceding the shark device, the depiction of the shark with its head turned towards the words "Le Shark", and the distinctive shading on the upper portion of the shark device. Bad faith due to such dishonest adoption is thus apparent on the face of the record in the present case.

22. According to Mr. Kadam, before the learned Single Judge, it was expressly pointed out by the Petitioner; that there was not a single invoice or material bearing the impugned registered 

artwork thereon, including in the five-year period to be computed under section 47 (1) (b), apart, that the invoices even in the first-year period were unsigned and did not reflect the mark. In addition the 'Isha craft' Invoices tendered by the Appellants were ex-facie fabricated since they were made out to a company that did not exist at the relevant time.

All these charges (including of fabrication of Isha craft invoices) were made out in the pleadings, but were never rebutted by the other side in the pleadings or by leading of evidence despite opportunity and this aspect is glaring and captured by the learned Single Judge.

An explanation of invoices being issued to 'Isha foundation' and not the company was only tendered in oral

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arguments before the Single Judge and even now before this Court. The charge of the fabrication of the 'Isha craft' invoices impact the credibility and truth of the materials presented by the Appellants as the civil standard being the preponderance of probabilities, where a charge that certain documents being fabricated is sustained, it will naturally impair the probability of the truth of the other materials.

Thus, once credibility was impeached, it is his submission that it was incumbent upon the Appellants at the very least to produce independent corroboration of the other materials, through Assessment Orders, Sales Tax Returns, Excise Registers etc. but it did not do so as a 30-year business claim will necessarily have these materials, but the Appellants failed to do so in the inquiry.

23. Mr. Kadam would urge that the Appellant invited the Court to give findings on its claim of uninterrupted user for over thirty years, goodwill, advertising and sales, and tendered invoices, a website and a trading sign in proof. Having invited this inquiry, the Appellant cannot now doubt the same, when the findings are in negative.

The Appellant's attempt now to hide behind onus is misconceived. Having invited adjudication of that positive case on its own evidence, it cannot, on the failure of that evidence, retreat behind initial onus since once both sides have led evidence, abstract considerations of onus are out of place, and the Court decides on the evidence before it.

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Once the applicant establishes prima facie, from the absence of any material bearing the mark as registered, that there has been no bona fide use within the relevant period, the evidential burden shifts to the registered proprietor to establish any use of the mark as registered.

24. The reliance placed in **Hardie Trading Ltd.** (supra) according to Mr. Kadam is also misplaced as he would submit that for contending that use of a mark is not restricted to physical affixation of the mark on goods but also encompasses 'use in relation to' goods. This judgment according to him does not apply for the following reasons:

a) No dispute that use of the mark may be 'in relation' to and not necessarily physical affixation on the goods.

b) But nevertheless the 'use' must of the mark as registered, in this case the registered



device mark.

c) The domain name by no means is use of the impugned artwork/device mark.

Further, according to Mr. Kadam, the judgment recognizes that Hardie was the admitted inventor, bonafide adopter and first proprietor of the word mark "SPARTAN" and the associated device mark and the controversy was whether its non-use disentitled it to registration. The Supreme Court held that the requisite abandonment had not been established and that is fundamentally different from the present case. Hardie's proprietorship and bona fides were not in issue.

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The Appellant applied on a “proposed to be used” basis and thereby asserted proprietorship of the Leshark device, the identical artwork already registered in the UK by the Respondents' predecessor. Once the Appellant's bad faith is sustained, its use can no longer be bona fide. According to him the learned Judge did not hold that the Appellant's acts were of a non-qualifying character, but he held that no invoice bearing the registered device exists within the statutory period, and the invoices produced are unsigned and uncorroborated, and that the "Isha Craft" invoices are fabricated.

25. As far as the locus is concerned, Mr. Kadam would submit that the Respondent No.1 (Le Shark) in the Appeal is an aggrieved person as the Applicant whose registration is refused by reason of an existing registration of the same or similar mark for the same goods is a ‘person aggrieved’ as according to him, the test to be applied is whether the impugned entry, if retained, would limit the applicant’s legal rights by preventing it from doing that which, but for the entry, it could lawfully do. In any case, according to him, the expression ‘person aggrieved’ has a wider amplitude under Section 57 than under Section 47, as Section 57 is concerned with pubic interest in maintaining the purity of the Register. According to him, Le Shark squarely satisfy the test, as it filed an application on

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17/02/2015 to register its 'Leshark' mark in Class 25 for clothing, footwear and headgear and on 16/04/2016, the Registrar's examination/search report cited the Appellant's mark and therefore its application was refused on 07/04/2021 because it's mark remaining on the Register. According to Mr. Kadam, the length of time for which the impugned mark has remained on the Register is not an answer to the claim for rectification, and the Act prescribe no period of limitation for an application to be filed under Section 57 and rather Section 57(4) confers a *suo motu* power exercisable.

According to him, the impugned order rests upon Section 47(1)(a), 47(1)(b), and 57 (2), each of which independently sustain the expunging of the mark and on either of the ground if the rectification application succeed, then the entry deserves to be moved from the Register.

26. In conclusion, it is the submission of Mr. Kadam that the learned Single Judge's finding of dishonest adoption is not assailed on facts by raising any ground in appeal but it is only met with an objection that such finding lie outside section 57(2) inquiry.

Further, this objection is answered by Section 18, which puts proprietorship directly in issue, and independently by Section 11(10)(ii) which makes bad faith of freestanding ground. According to him, the appellant applied in January 1987, on a proposed to be used basis,

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having non-user to rely upon, it was imperative to establish how the artwork was conceived particularly when the artwork originated from the predecessor of Le Shark and stood on the United Kingdom register since 1984.

It is also vehemently submitted by Mr. Kadam that Section 31(1) makes registration only *prima facie* evidence of validity and a presumption declared rebuttable does not become irrebuttable by efflux of time. According to him, Section 57 (2), hinges upon the circumstances in which the entry was made and if an entry was made without 'sufficient cause', then whatsoever may be the length of time, if the objector succeeds, the entry shall be deleted/removed.

In the wake of the aforesaid, it is the contention of Mr. Kadam that the Appeal deserve a dismissal, by upholding the finding rendered by the learned Single Judge in the impugned order.

27. The rival contentions deserve appreciation in light of the provisions of the Trademarks Act 1999, as a statute providing for better protection of trademarks for goods and services, and for the prevention of the use of fraudulent marks. The statute has defined various terms, including 'trademark' to mean a mark capable of being represented graphically, and which is capable of distinguishing the goods or services of one person from others.

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It is pertinent to note that for the purposes of the Act, Section 2 provide that any reference to 'trademark' shall include reference to 'collective mark' or 'certification trademark'. The reference to the use of 'mark' as per Section 2 shall be construed as reference to the use of printed or other visual representation of the mark, and the reference to the use of a mark, in relation to the goods shall be construed as a reference to the use of mark upon, or in any physical, or in any other relation whatsoever to such goods, and in relation to the services about the availability, provision, or performance of such services.

Under the statute, in terms of Section 6, a Register of Trade Marks is maintained, wherein all the registered trademarks with their names, address, and description of the proprietors, notifications of assignment and transmissions, address and descriptions of registered users, conditions, limitations in relation to the matter relating to registered trademarks shall be entered.

Section 9 provides the ground when the registration of trademark shall be refused by the Registrar and this will include marks, which are devoid of any distinctive character, that is to say, not capable of distinguishing the goods or services of one person from those of another person and which consist exclusively of marks or indications which have become customary in the current language or in

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the bona fide and established practices of the trade. However, a trade mark shall not be refused registration if before the date of application for registration it has acquired a distinctive character as a result of the use made of it or is a well-known trade mark.

Similarly, by virtue of Sub-section (2), a mark shall not be registered as a trade mark if; (a) It is of such nature as to deceive the public or cause confusion; (b) It contains or comprises of any matter likely to hurt the religious susceptibilities of any class or section of the citizens of India; (c) It comprises or contains scandalous or obscene matter; (d) Its use is prohibited under the Emblems and Names (Prevention of Improper Use) Act, 1950.

28. Section 11 of the Act has specifically set out the relative grounds for refusal of registration, and this includes a contingency where its identity is compared with an earlier trademark, and its similarity with the goods or services covered by the said trademark, and in such a contingency, a trademark shall not be registered.

'Earlier trademark', as per the explanation appended to Section 11 means; (a) a registered trade mark or an application under section 18 bearing an earlier date of filing or an international registration referred to in section 36-E or convention application referred to in section 154 which has a date of application earlier than that of the trade mark in question, taking account, where appropriate, of the

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priorities claimed in respect of the trade marks; (b) a trade mark which, on the date of the application for registration of the trade mark in question, or where appropriate, of the priority claimed in respect of the application, was entitled to protection as a well-known trade mark.

By virtue of Sub-section (5), a trademark shall not be refused registration unless an objection on any one or more of those grounds is raised in opposition proceedings by the proprietor of the earlier trademark, i.e., a Registrar on his own will not look into it.

The Registrar, while determining whether a mark is a well-known trademark, shall take into account any fact which he considers necessary, including the knowledge or recognition of that trademark in the relevant section of public, including the knowledge in India obtained as a result of promotion of the trademark, the duration, extent, and geographical area of any use of that trademark, or its duration, extent, and area of promotion of the trademark, including advertising or publicity and presentation, at fairs or exhibition of the goods or services to which the trademark applies.

What is also pertinent to take note of is sub-section (7) of Section 11, which has laid down the test for determining whether a trademark is known or recognized in relevant section of the public, and the Registrar shall take into account :

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(i) The number of actual or potential consumers of the goods or services;

(ii) The number of persons involved in the channels of distribution of the goods or services;

(iii) The business circles dealing with the goods or services, to which that trade mark applies.

When a trademark has been determined to be a well-known in at least one relevant section of the public in India by any Court or Registrar, then it shall be considered as a 'well-known trademark' for registration under the Act. As per Sub-section (9) of Section 11, the Registrar shall not require as a condition, for determining whether a trademark is a well-known trademark, any of the following conditions:

(i) that the trade mark has been used in India;

(ii) that the trade mark has been registered;

(iii) that the application for registration of the trade mark has been filed in India;

(iv) that the trade mark -

(a) is well known in; or

(b) has been registered in; or

(c) in respect of which an application for registration has been filed in, any jurisdiction other than India; or

(v) that the trade mark is well-known to the public at large in India.

As per sub-section (10), while considering an application for registration of a trademark, and opposition, the Registrar shall protect a well-known trademark against identical or similar trademark and shall take into consideration the bad faith involved either of the applicant or the opponent affecting the rights relating to the trademark.

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What is also relevant to note is Sub-section (11) of Section 11 which reads thus :-

> *"(11) Where a trade mark has been registered in good faith disclosing the material informations to the Registrar or where right to a trade mark has been acquired through use in goods faith before the commencement of this Act, then, nothing in this Act shall prejudice the validity of the registration of that trade mark or right to use that trade mark on the ground that such trade mark is identical with or similar to a well known trade mark."*

29

29. The Trade Marks Act provide for effects of the registration in Section 28, by providing that the registration of trademark shall, if valid, give to the registered proprietor of the trademark the exclusive right to the use of the trademark, in relation to the goods or services in respect of which the trademark is registered, and to obtain relief in respect of infringement of the trademark in the manner provided by the Act.

However, the exclusive right to use of a trademark given pursuant to the registration shall be subject to any conditions and limitations to which the registration is subjected. However, no such protection is available for an unregistered trademark alleging that there is an infringement of his trademark.

Section 29 of the Act prescribe as to what would amount to infringement of a registered trademark and how, and in what manner, a registered trademark is infringed, by providing that a person who is not a registered proprietor

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shall by use of a registered trademark in the course of trade use the mark which is identical with or deceptively similar to the trademark in relation to the goods or services in respect of which the trademark is registered, so as to render the use of the mark likely to be taken as being used as a trademark.

By virtue of Sub-section (6) of Section 29, a person is said to have used a registered trademark if in particular he,

> *(a) affixes it to goods or the packaging thereof;*
>
> *(b) offers or exposes goods for sale, puts them on the market, or stocks them for those purposes under the registered trade mark, or offers or supplies services under the registered trade mark;*
>
> *(c) imports or exports goods under the mark; or*
>
> *(d) uses the registered trade mark on business papers or in advertising.*

Similarly as per Sub-section (8) of Section 29 a registered trademark is infringed by advertising of that trademark if such advertising : -

> *(a) takes unfair advantage of and is contrary to honest practices in industrial or commercial matters; or*
>
> *(b) is detrimental to its distinctive character; or*
>
> *(c) is against the reputation of the trade mark.*

30. The Act, therefore, has attached protection to a registered trademark and before the trademark is registered with the Registrar, it is imperative to verify all the necessary ingredients which would deserve the mark a registration. However, even if a party misses the bus of raising an objection which would result in refusal of registration of a

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trademark, as the statute contemplates, that upon an application being presented for registration of a trademark, the Registrar shall cause the application to be advertised before its acceptance, and it is open for any person to give notice in writing to the Registrar in opposition to the registration, before it is registered. However, if this bus is missed, then the Trademark Act, 1999, contain a provision for rectification and correction of the Register as contemplated in Chapter VII of the Act.

31. Under Section 57, upon an application made in the prescribed manner to the High Court, or to the Registrar by any person aggrieved, the Court or the Registrar, as the case may be, may make such order as it think fit for cancelling or varying the registration of a trademark on the ground of any contravention, or failure to observe a condition entered on the register in relation thereto. Similarly, by virtue of sub-section (2), any person aggrieved by the absence or omission from the register of any entry, or by any entry made in the register 'without sufficient cause', or by an entry wrongly remaining on the register, or by any error or defect in entry in the Register, may apply to the High Court or to the Registrar, and the authority shall make such an order for making, expunging, or varying the entry as it think fit.

It is also open for the Registrar of the High Court, on its own motion, after giving notice in the prescribed manner

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to the parties concerned, and after affording an opportunity of hearing, to make any order for cancelling or varying the registration of a trademark, or making, expunging, or varying the entry in the Registrar.

Under Section 58, on an application made by the registered proprietor, the Registrar may cancel the entry of a trademark on the register, or strike out any goods or classes of goods or services from those in respect of which the trademark is registered, and he may make any consequential amendment or alteration in the certificate of registration.

32. In addition to the aforesaid provision, Chapter VI of the Trade Marks Act, in relation to the, "Use of Trade Marks and Registered Users," also permit a registered trademark to be taken off the register, in respect of the goods or services under Section 47, and it is appropriate for us to reproduce the provision:-

> *"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 [High Court] 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*

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the time being up to a date three months before the date of the application; or

(b) that up to a date three months before the date of the application, a continuous period of five years from the date on which the trade mark is actually entered in the register or longer had elapsed during which the trade mark was registered and during which there was no bona fide use thereof in relation to those goods or services by any proprietor thereof for the time being:

Provided that except where the applicant has been permitted under section 12 to register an identical or nearly resembling trade mark in respect of the goods or services in question, or where the [Registrar or the High Court, as the case may be] is of opinion that he might properly be permitted so to register such a trade mark, the [Registrar or the High Court, as the case may be] may refuse an application under clause (a) or clause (b) in relation to any goods or services, if it is shown that there has been, before the relevant date or during the relevant period, as the case may be, bona fide use of the trade mark by any proprietor thereof for the time being in relation to—

(i) goods or services of the same description; or

(ii) goods or services associated with those goods or services of that description being goods or services, as the case may be, in respect of which the trade mark is registered."

33. It is in this statutory background, we have to appreciate the facts placed before us.

According to Mr. Kadam, representing Leshark Apparel Limited, the trademark 'LESHARK', and the device mark being conceived and adopted by Le Shark Limited, its predecessor, in the year 1984, and it was granted registration of the device mark in UK in Class 25. Subsequent registrations were sought of the mark 'Leshark' and Le Shark Apparel is the assignee of the said mark, from the earlier registered proprietors of the said mark.

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Admittedly, the registration of the trademark and device 'Leshark' was in United Kingdom, and a claim is staked that it generated considerable goodwill, and this goodwill, was spilled over, even to India, as Le Shark Limited used to source its clothing material, from manufacturers in Indian subcontinent, through Aldgate Warehouse (wholesale limited), and the appellants manufactured garments for Aldgate Warehouse. Thus, it is a claim of the Petitioner that its goodwill, had a global presence, as it had sky-mounting sales worldwide, and it advertised through various websites operated worldwide, apart from the fact that it participated in various exhibition and trade shows in different countries. However, admittedly, it is only on 17/02/2015, Le Shark Apparel sought registration of its mark in India in Class 25 for clothing, footwear, headgear, and it was appraised about the existence of the appellant's trademark, which was duly registered in Class 25 under application number 466002 on 15/10/1991 for articles of clothing, clothing, including boots, shoes, and sleepers, scarves, and raincoats in India on a "proposed to be use basis".

However, application no. 2904714 was refused by the examiner of trademarks on 07/04/2021, by stating that the subject mark application for registration of trademark Leshark and Shark device, was coming up eighth time for hearing, and though it was urged that application has been

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filed for cancellation against the conflicting owner before IPAB, Delhi, since no proof was produced, the examiner of trademarks concluded that the mark sought to be registered is phonetically and visually identical to the conflicting marks mentioned in the search report, and also that in prior use in respect of identical goods which was sought by the applicant, who was a subsequent user. It was noted that the Petitioner Leshark had deliberately chosen the subject mark to ride upon the goodwill and reputation of the conflicting marks, and, mark had been dishonestly adopted, and the applicant cannot claim to be the proprietor of the subject mark under section 18(1) of the Act. This resulted in filing of a Review Petition before the Trademark Registry.

Pending the pronouncement thereupon, Leshark Apparel deemed it appropriate to move an application for rectification under the IPAB Board by invoking Section 9, 11, 18(1), 47 and 57 of the Trade Marks Act. 1999.

The said application impleaded the following as respondents:-

i. Anil Shah, Trading as LESHARK (India).
ii. Anil Laxmichand Shah.
iii. The Registrar of Trade Marks.

34. The application being annexed at Exhibit-B to the Appeal is carefully perused by us, and we find the pleaded case to the effect that the Petitioner (Le Shark) is the owner of widely known Leshark brand of clothing, and it is a, "well-known men's clothing brand".

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It is necessary for us to reproduce the relevant pleadings, as the finding rendered in the impugned Judgment shall be appreciated in its background therein :-

> *"ii. The Applicant is the owner of the widely known LE SHARK brand of clothing. This brand has a long history. By the 1980s, it was already a well-known men's clothing brand, at least in the UK.*
>
> *v. The Applicant officially re-launched the 'LE SHARK' brand in December 2014, producing and selling a range of fashionable casual clothing, such as polo shirts, retro style jackets, shirts and knitwear.*
>
> *vi. The trade mark LE SHARK and related LE SHARK device marks such as*  *were conceived and adopted by predecessors of the Applicant in or before the year 1984 in the UK.*
>
> *The application then gives the details of the UK registration for the mark Le Shark.*
>
> *ix. Besides the said registrations, the Applicant owns numerous registrations across the world for trademarks consisting of/or containing 'LE SHARK' and/or shark device marks, including in the UK, US, European Union, Australia and Canada. The Applicant also has additional pending applications for LE SHARK marks, for example in the European Union and South Africa.A list of such trade mark registrations/applications is annexed hereto and marked as Annexure A4. Copies of registration certificates/extracts of register along with copies of pending applications are being collectively filed as Annexure A5.*
>
> *x Since December 2014, the Applicant has produced and sold a range of different products under the LE SHARK trade marks, through its licensee S.R.G. Apparel Plc, including t-shirts, polo shirts, shirts, hooded sweatshirts or 'hoodies ', sweatshirts, jumpers, cardigans, coats, jackets, shorts, swim shorts, trousers and underwear. Examples of the LE SHARK products produced and sold by the Applicant can be seen on the websites http://ww.w.srg-plc.com/brands/le-shark and http://www.tokyolaundry.com. Extracts downloaded from the aforesaid websites are being filed with the present application as Annexure A6. Some of these extracts have been created using the internet archiving website Wayback Machine. The aforesaid Annexure A6 includes extracts showing the range of LE SHARK clothing items sold by the Applicant in April 2015, August 2015, April 2016 and October 2016. As the extracts*

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demonstrate, the Applicant prominently uses the trademarks 'LE SHARK', a Shark Device mark along with other variants incorporating the word 'LE SHARK' and/or a Shark Device in the course of its branding, distribution, sale and overall business of fashion apparel.

xi. The Applicant's products have been sold in many countries worldwide, including the Czech Republic, Denmark., Finland, France, Germany, Greece, the Republic of Ireland, Italy, Lithuania, the Netherlands, Poland, Portugal, Rumania, Spain, and the UK in the European Union, as well as Australia, Bosnia-Herzegovina, Canada, Iceland, Israel, Kazakhstan, Russian Federation, Saudi Arabia, South Africa, and the United Arab Emirates.

xii The Applicant has established a considerable market presence with worldwide wholesale sales from December 2014 to September 2017 reaching over £5 million (approximately Rs. 44 crores). A breakdown of the Applicant's approximate sales figures from December 2014 to September 201 7, which shows significant growth of the brand LE SHARK since 2014.

xiv The Applicant's LE SHARK products are sold by some of the most widely known clothing retailers. For example, LE SHARK products are sold by the Arcadia Group, a multi- national retailing company which has more than 2,500 outlets in the UK and a further 1,170 stores in 36 different countries outside of the UK. LE SHARK products are sold through Arcadia Group's Burton Menswear stores. There are over 400 Burton Menswear stores in the UK and Ireland in the UK alone. The Applicant's LE SHARK products are also sold by the widely-known retailer TK Maxx, including in its st~res and on its website www.tkmaxx.carn. TK Maxx is part of the TJX Companies family. There are over 500 TK Maxx stores in Europe, including stores in the UK, the Republic of Ireland, Germany, Poland, Austria and the Netherlands. LE SHARK products have been sold through www.tkmaxx.com since January 2015. The widely known online fashion and beauty store asos.com also stocks a variety of LE SHARK products. ASOS sells over 850 brands and ships products to over 140 countries."

35. After projecting its presence worldwide, and efforts taken to promote its products, the application pleaded that with a view to launch its product in India, the applicant proceeded to file an application for the composite

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trademark "LE SHARK" with shark device in Class 25 with the trademark registry on 17/02/2015. In or around the month of May 2016, the applicant was made aware of the examination report issued by the trademark registry as the search report revealed the presence of the impugned trademark registration issued to respondent No.1.

As far as the connection of the Applicant's predecessor with the Indian market is concerned, the application pleaded thus :-

> *"xx The Applicant's predecessor, who had considerable reputation and goodwill owing to the high quality of products sold under the brand LE SHARK in the 1980's/199O's, had business associates/affiliates in India. In fact, the Applicant's predecessor in interest through one of its affiliates Aldgate Warehouse (Wholesale) Limited used to source its clothing materials from manufacturers in the Indian sub-continent and the Far-East which included the Respondent No.1 herein. In this connection it is pertinent to point out herein that the Respondents have admitted to manufacturing garments for Aldgate (misspelled as Algate) of UK. An extract downloaded from www.leshark-india.com/buyer.htm evidencing such admission is annexed hereto and marked as Annexure A12."*

36. As regards the invocation of Section 47 the only pleading to be found is to the following effect :-

> *"vii. That the impugned registration stands to be removed/rectified for non-use under Section 47 of the Trade Marks Act since there has been no bona fide use of the impugned registration in relation to goods in Class 25 for a continuous period of five years or longer from the date on which the impugned registration was entered in the Register (i.e. 15.10.1991).*
>
> *viii. That the Respondents have no bona fide intention to use the impugned mark with respect to its goods and as such are merely blocking the Register of Trade Marks by renewing the registration from time to time without making use of the same.*

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> *xi. That the Respondent No.1 has deliberately with an ulterior motive adopted and obtained registration of the impugned trade mark which is deceptively and/or confusingly similar to the Applicant's trade mark solely with a view to sail as close as possible to the Applicant's trade mark. It is submitted that the Respondent No.1 being in the same business/ trade was wholly aware of the Applicant's brand/trade mark as stated hereinabove and as such there can be no justification for them to adopt an identical trade mark for identical/allied goods. It is stated that very adoption of the mark by the Respondent No. 1 was not honest as stated herein above. The Respondents are not the bona fide proprietors of the impugned trade mark and cannot continue to claim to be the proprietor thereof within the meaning, scope and ambit of the provisions contained in Section 18(1) of the Act."*

As regards invocation of Section 57 is concerned, the application pleaded thus :-

> *"xvii That the impugned registration has been allowed in contravention of The Trade Marks Act, including Sections 47 and 57, and its continued subsistence on the Register is in violation of these provisions.*
>
> *xviii. That the registration of the impugned trademark and its subsistence in the Register is an obstruction to the Applicant's business.*
>
> *xix. That the subsistence of the impugned registration on the Register in the absence of any use of the same by the Respondents on its products detrimentally affects and runs against the purpose of maintaining the purity of the Registry, which is recognized as a key stated purpose of The Trade marks Act.*
>
> *xx. That the registration of the impugned trademark remains on the Register without sufficient cause."*

The application therefore prayed for rectifying the register of trademark by removing the impugned trademark as if such relief is not granted it will suffer irreparable loss, injury and damage.

37. It is this application which is granted by the learned Single judge and from reading of the order, it is necessary

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for us to consider the issue raised by Mr. Kirpekar as to whether the Petitioner/Applicant who filed the rectification application and who had sought registration in UK and claimed to have its market world-wide can stake a claim against the registered mark of the appellant in India.

The learned Single Judge has directed rectification of the impugned mark by invoking Section 47 by concluding that it is borne out of fraudulent adoption and contemplating likelihood of injury to the Petitioner. The moot question that arises for consideration is whether the trademark has geographical limitations and whether an application under Section 47 necessarily require the petitioner to demonstrate whether it was prior adopter of the mark in India.

It is not in dispute that as far as the appellant no. 1 Anil Shah is concerned, he sought registration of the mark 

under Application No.46002 in Class 25 as early as on 13/01/1987 and the Petitioner claim that this mark is identical to the trademark registered by its predecessor in UK under registration no.UK00001250917. Upon an application being preferred, the impugned mark was granted registration on 15/10/1991 in favour of Anil Shah, who on 06/12/2017 assigned a trademark to the Appellant No.2 Le Shark LLP, who renewed the trademark on 22/12/2017 for ten years and on 22/09/2018, name of appellant no.2 was entered as a subsequent proprietor of

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the impugned registered trademark.

38. It is not in dispute that the petitioner has secured registration of its trademark in UK, France, Canada, US and several other countries, but not in India. It was desirous of launching its product and obtain statutory protection in India and, therefore, an application was filed for registration of trademark Le Shark in 2015, which was refused in the wake of the cited mark of the proprietor Anil Shah registered in Class 25. Admittedly, even as per the application of the petitioner, the registration of the trademark Leshark by Anil Shah in India was prior in point of time when the application was preferred by the petitioner, although the trademarks of the petitioner had received UK registration, but having failed to secure the registration in India, the petitioner Le Shark Apparel deemed it appropriate to file an application for rectification by invoking Section 47 as well as Section 57 of the Trade Marks Act.

In order to establish a case under Section 47(a), it is necessary to establish that the trademark was registered without any bona fide intention and there has been no bona fide use of the trademark in relation to those goods or services by the proprietor thereof for the time being upto a date three months before the date of the application or as per clause (b), that upto a date three months before the date of the application, a continuous period of five years

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from the date on which the trademark is actually entered in the register or longer had elapsed during which the trademark was registered and during this period there was no bona fide use thereof.

39. It is in relation to the aforesaid provision, permitting removal of a registered trademark from the register, on account of no bona fide use as contemplated in Clause (a) or Clause (b) of Sub Section (1) of Section 47, it is imperative that the burden of proving non use falls on the shoulders of the applicant, who files an application.

In **Eagle Potteries Pvt Ltd** (supra), it is observed thus :-

> *"In my view, looking to the wording of the Section (32), there can be no doubt that the burden of proving non-user will always be on the party making averments in the Petition. No other evidence either by way of affidavits from dealers and traders or oral evidence has been lead to show that there has been no use by the first respondent or that these are not goods of the same description. In my view, merely making an averment is not sufficient. If a party wants to prove a particular fact, the burden is on that party and in cases like the present, where the valuable rights of a registered owner are sought to be taken away, the burden must strictly be discharged."*

40. In establishing its claim under Section 47, except the bare pleadings in the application for rectification to the effect that there was no bona fide use of the impugned registration in relation to goods in Class 25 for continuous period of 5 years or longer from the date on which the impugned registration was entered in the registration (i.e.

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15/10/1991) and that the respondents had no bona fide intention to use the impugned mark, but they were merely blocking the register of trademarks by renewing the registration, no further evidence has been adduced by the petitioner, but the learned Single Judge completely glossed over this aspect.

In **Hardie Trading Ltd.** (supra), while focusing upon the provision of Section 46(1)(b), in the Trade and Merchandise Marks Act, 1958, which is comparable to Section 47 (1)(b) of the Trademarks Act, 1999, it is held that while considering an application for removal of registered trademark from the register, it is necessary to satisfy three conditions namely that; 1) the application is by a "person aggrieved" 2) the trademark has not been used by the proprietor for continuous period of at least five years and one month prior to the date of the application; and 3) there were no special circumstances which affected the use of the trademark during this period by the proprietor.

It is held that the onus to establish the first two conditions lie on the applicant whereas the burden of proving existence of special circumstances is on the proprietor of the trademark, but it is categorically held that these conditions are not to be cumulatively proved, but to be established *seriatim* and there is no question of third condition being established unless the second one has already been proved and there is no question of second one

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being even considered unless the High Court or Registrar is satisfied as to the locus of the applicant.

In the case before us, we do not doubt the locus of Le Shark in filing the application, but since the burden to establish the non use under Section 46 (1)(b) of the old Act which is in *para materia* to the provision of Section 47 (1) (b) is on the applicant, and in absence of this burden being discharged, according to us, it was not open for the learned Single Judge to arrive at a conclusion that the mark is liable to be rectified since it is borne out of fraudulent adoption and not bonafidely used. We note that the submissions strongly advanced, that the mark with which the comparison was made and which was described as fraudulent adoption of the Petitioner's mark and the contention that it was used outside India and that too from 2014 was held to be of no consequence.

41. This, therefore, brings us to the aspect of the principle of territoriality of the operation of the provisions of the Trade Marks Act.

In this regard, we are well guided by certain precedents and this has to be appreciated in the backdrop fact that the Appellant preferred an application for registration in the year 1987 and secured the registration in India in the year 1991, in contrast to the registration of the Petitioner being secured in United Kingdom may be as early as in 1984 and thereafter some other countries but not in

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India.

The learned Single Judge has attributed bad faith on the ground that the two marks are similar, but what is relevant to note is when Anil Shah secured registration of the mark Le Shark in India, whether he had a reason to be aware of the mark registered in United Kingdom in the year 1985 and the question that deserve consideration is whether the petitioner or its predecessor's mark had acquired local goodwill or transborder reputation and its transborder reputation spilled over in India prior to 1987.

The petitioner 'Le Shark Apparel' has not produced on record any evidence to demonstrate its business presence in India and admittedly whatever data is furnished in the rectification application in relation to its registration, including sales, etc. is exclusively outside India and no invoice/ advertisements are brought on record to establish the spilled over reputation and the application specifically lack any pleading of transborder goodwill in India. The rectification application itself has spelled out that the petitioner was desirous of launching its product in India and, therefore, it filed an application for composite trademark Le Shark with Shark device in Class 25 with the Trademark Registry in India, for the first time.

All the evidence produced alongwith the application for rectification, which was dealt by the Single Judge was in form of its trademark registration/application in various

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jurisdictions in United Kingdom as well as invoices evidencing sale of its product under the trademark 'LE SHARK', through its licensee S.R.G. Apparel PLC as well as the invoices evidencing the applicant company attending China import and export fair as well as Panorama fair in Berlin, Germany etc. The application is completely devoid of any pleading about the petitioner/applicant having any consumers/ customers of their product, being sold in India and rather the rectification petition itself plead that, it was intending to launch its business in India and we are informed that no such business is yet started in India.

42. Dealing with the issue of transborder reputation, though not a single pleading is found in the application to the effect that the petitioner had its presence in India as it is well accepted proposition that the Trade Marks Act is territorial in operation and does not recognize extra territorial use as conferring enforceable rights in India unless such use translate into legally protecting goodwill within the Indian Market.

In **Kores (India) Ltd** (supra), in relation to Section 46 of the Trade and Merchandise Marks Act, 1958, the issue as regards the territorial operation of the Trade Marks Act received consideration from the learned Single Judge of this Court Dr. D.Y. Chandrachud, (as his Lordship then was) and with reference to Section 28(1) of the Trademarks Act, 1999, along with the right conferred upon a registered

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trademark to prevent its infringement. Even Section 34 of the Act was invoked as it contemplated a provision for use by any person of a trademark identical with or nearly resembling it in relation to goods or services in relation to which that person or predecessor in title of his has continuously used that mark from a date prior and the Section contemplated that in such a situation the proprietor or a registered user of registered trademark shall not interfere with the use of first mentioned trademark in relation to the goods or services. Clarifying that Section 34 applied in a situation where a person has been continuously using a trademark from a date prior to the use of the registered trademark in relation to those goods and services by the proprietor of the mark prior to the date of registration, it was noted that in the facts of the case, the Plaintiff was the registered proprietor in India of the Trademark KORES, and initial registration of the mark dated back to 1943. The record would, however, indicate that after lapsing of the initial registration, the Plaintiff applied for, and obtained registration of the word mark KORES and of the associated device of a lady typist which continued to subsist on the register of trademarks. The Defendant was in the process of moving an application for rectification but it is admitted position that as of the date of these proceedings, the mark and the device continued to be registered in the name of the Plaintiff.

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This being so, it was held that the Defendant would within the territory of India be entitled to the benefit of saving contained in Section 34 of the Act, provided, that it establishes before the court a continuous user of trademark from a date prior to the use of registered trademark by the Plaintiff but it was noted that there was *prima facie* complete absence in the record of material to show prior, continuous or concurrent user of the trademark by the Defendants in the territory of India.

43. It is in this factual context, the learned Single Judge made reference to the territorial operation of the Trade Marks Act by referring to a decision of Justice P.V. Mukherjee of Calcutta High Court, (as his Lordship then was), where it was observed thus:-

> *"11. The Trade Marks Act, 1999, has territorial operation within the territory of India. While considering the provisions of the Trade and Merchandise Marks Act, 1958, Mr. Justice P.B. Mukharji observed in Aktiebologet Jonkoping Vulcan vs. V.S. V. Palancichamy Nadar, AIR 1969 Calcutta 43 that the provisions of the Act must be understood to refer to use within the territory of India and not use abroad. The Learned Judge held that the registration of a mark and its continuance on the register were exclusively within the scope and ambit of domestic law. That was a case involving rectification. The learned Single Judge held thus :-*
>
> *The Trade Mark law is not extraterritorial; that use abroad in foreign countries under foreign registration can be use within the meaning of the Indian Trade and Merchandise Marks act of 1958. This statute is an Act which provides for registration and better protection of trade marks and for the prevention of the use of fraudulent marks on merchandise. That is its preamble. That preamble I read as confined to the territorial limits of India. Section 1 (2) of the statute extends it to the whole of India. The statute establishes trade marks register for India. The definition of a trade mark in Section 2 (v) speaking of use in relation to goods must in my opinion*

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> *be understood as use within the territory of India and not use abroad. On the authorities quoted above and on the principles that I have just mentioned I am of the opinion that under Section 46 of the Trade and Merchandise Marks Act, 1958 the word "use" employed therein is use within India. Naturally if it is not used in India that would be a ground for removal from the Indian register. I cannot imagine that a foreign use or use abroad or outside India could be pleaded as a sufficient ground for retaining a registered Trade Mark on the Indian Trade Mark register. I cannot import any extraterritorial notion to construe the Indian Trade and Merchandise Marks Act, 1958 to cover foreign use. I am of the opinion that registration of a Trade Mark and its continuance on the register are exclusively within the scope and ambit of domestic and national law."*

44. With reference to the facts involved indicative that the Defendants were unable to establish a transborder reputation in India or for that matter continuous or concurrent user within the territory of India on one hand and on the other hand, noting that there is a Plaintiff, who is a registered proprietor of the trademark 'KORES' and the associated device has an established goodwill and reputation associated with its business in stationary products more particularly duplicating stencils, it was concluded that *prima facie*, there was no material to indicate continuous prior user of the mark by the Defendant within the territory of India, prior to the registration of the mark by the Plaintiff and that being the position, the action by the Plaintiff for infringement was held to be validly founded on the rights of the Plaintiff as a registered proprietor under Section 28 and 29 of the Trade Marks Act, 1999. Recording that the Plaintiff has *prima facie* made out

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a case for grant of interlocutory injunction, the Notice of Motion for injunction in an action for infringement and passing off came to be granted.

45. The Judgment in **Kores (India) Limited** (supra) make reference to the decision by Justice P. B. Mukherjee, of the Calcutta High Court, who was dealing with an Appeal under Section 109 (2) of the Trade and Merchandise Marks Act, 1958, from the decision of Deputy Registrar of Trademark allowing the application for rectification made by the Respondent, and expunging the Appellants mark, noted that the dispute involved the use of the trademark in respect of matches and match boxes, the impugned registration being that of the Swedish Match Company with a label containing the device of three stars in a row with the words "Three stars" on the top of the device. The registration, was dated 24/02/1944 and has since being renewed. The mark of the Madras Match Company was also 'Three stars' label which was in actual use since 1951 in respect of safety matches.

An application was filed by Madras Match Company for rectification of the register by expunging the entry relating to trade mark no. 93017 registered in Class 34, in the appellants name. The application claimed that the applicant was extensively using the trademark of Three stars on safety matches ever since 1951 and it had also made an application for registration of their mark on

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04/06/1963.

The Madras company sought cancellation of the registration of the trademark of Swedish Match Company on the ground based on Section 46(1)(b), that there was no bonafide use of the registered trademark by the Swedish Match Company for a statutory period of continuous stretch of five or more years upto one month before the date of the application for rectification.

46. The aforesaid discord called for resolution in terms of sub-section (3) of Section 46 of the Act of 1958, which read thus:-

> *'Any non-use of a trademark, which is shown to have been due to special circumstances in the trade, and not to any intention to abandon or not to use the trademark, in relation to the goods to which the application relates.'*

47. Interpreting the aforesaid provision to the effect that the actual non-use of the trademark must be shown to have been due to special circumstances of the trade and not with an intention to abandon, the learned Single Judge focussed upon the terminology 'special circumstances in the trade' and while considering the stand of the appellant Swedish Match Company, to the effect that they registered their trademark but there were severe import restriction imposed and this statement being made on affidavit, it was held that the only excuse, though not proved, as regards the use of the mark might have been that the restrictions imposed

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were temporary but it is noted that throughout the long number of years until 1968, a period of about 24 years, the mark has been a dead mark and it was an abortive registration, except that it appeared on the Indian Trade Mark Register and was renewed from time to time, but this mark was never been used in Indian Market in respect of the matches of the Swedish Match Company for which it was registered. It was also further noted that there is no association in mind of the Indian public that this mark of the appellant Swedish Match Company is associated with it.

It is in these circumstances, the learned Single Judge applied the test which was applied by Romer, J., in the case of John Batt and Co, reported in (1898) 2 Ch D 432 and the case laying down the principle that, “a trader cannot properly register a trademark for goods in which he does not deal or in which he has not, at the time of registration, some definite and present intention to deal”. It also laid down a principle that where there had been no real user of a trademark before or since its registration and it had been registered in a particular class without any bonafide intention to use in that class, on the application of another trader to register an identical mark, in respect of that class would rectify the register by expunging the existing mark as the entry was made without sufficient cause.

Applying the aforesaid test to the case of the appellant, the learned Single Judge concluded that it is

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difficult to imagine that the appellant had any bona fide intention to use the trademark in Indian Market, when it knew that it was registering at a time when there was virtual prohibition of all importation of foreign matches according to them. It was therefore observed thus :-

> "The statute establish a Trademark register for India. The definition of trademark in Section 2 (v) speaking of use in relation to goods must in my opinion be understood as used within the territory of India and not use abroad. I cannot import any extra-territorial notion to construe the Indian Trade and Merchandise Act, 1958 to cover foreign goods. I am of the opinion that registration of a trademark and its continuance on the register are exclusively within the scope and ambit of domestic and national law.
>
> I am therefore of the opinion that, both on the interpretation of India statute and on principle, that registration of the 'Three stars' trademark of the Swedish Match Company in foreign or convention countries, cannot help the appellant in this Appeal, on the question of Indian Registration and its statutory conditions, under the Indian Trade Marks and Merchandise Act, 1958."

48. In ***NR Dongre and Ors vs. Whirlpool Corporation and Anr***[9], the plaintiff filed a Suit for passing off against the defendant, seeking to restrain it from using the trademark 'Whirlpool'. The claim of the plaintiff was based on prior use of the mark and transborder reputation, which had spilled over into India. At the relevant time of filing of the suit, the plaintiff admittedly did not have registration in India for it's mark, 'Whirlpool', whereas the defendant did. The learned Single Judge granted injunction against the defendant, and the Division Bench dismissed the Appeal.

9 (1996) 5 SCC 714

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In the aforesaid background, the principle of transborder reputation were laid down by the Apex Court, which could be summarized as below:-

> "(i) There is no requirement of actual sale in the markets in India. Goodwill can be held to have permeated into India by virtue of magazines having international circulation, including India. Advertisements of trademarks without existence of goods in the market is also to be considered as use of the trademark.
> (ii) Prior user of the mark, even internationally, is a factor to be considered.
> (iii) Under Section 27(2) of the Trademark Act, the action in passing off is maintainable against the registered user".

49. In **Milmet Oftho Industries** (supra), the Apex Court was dealing with the medicinal/pharmaceutical product with deceptive similarity and a reading of the decision would reveal that the appellant was an Indian Pharmaceutical Company, whereas the respondent is a Pharmaceutical Company manufactured in pharmaceutical products in several countries and it filed a Suit for injunction based on an action for passing off in respect of mark "OCUFLOX" used on a medicinal preparation manufactured and marketed by the respondent and it claimed that they were the prior users of the mark in respect of an eye care product containing Ofloxacin and other compounds and they first used this Mark on 9/9/1992, after which they marketed the product in various countries and secured registration in Australia, Mexico,

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Peru, South Africa, Canada and the United States of America. They claimed that they also applied for registration of the mark in India and that their application was pending.

The appellants selling "OCUFLOX" claimed that they coined the word by taking the prefix "OCU" from "OCULAR" and "FLOX" from "CIPROFLOXACIN", the basic constituent of their product. They applied registration of the mark and the application was pending, but they were granted registration by the Food and Drug Control Administration in 1993.

The respondents secured an ad interim injunction which was vacated as the learned Single Judge held that the Respondents' product was not sold in India and the appellants had introduced the product first in India, the therefore, respondents were not entitled for injunction. The Appeal filed by the Respondents was allowed under the impugned Judgment and the matter went to the Apex Court, which referred to the decision in case of ***NR Dongre*** (supra) as well as decision in case of ***Cadila Health Care Ltd Vs. Cadila Pharmaceuticals Limited***[10]

Confirming the finding in the impugned judgment, the Apex Court noted that the Court has to keep in mind the possibility that with the passage of time, some conflict may occur between the use of mark by the applicant in

10 (2001) 5 SCC 73

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India and the user by the overseas company, but the Court must ensure that in no way the public interest is imperiled. If a mark in respect of a drug is associated with the respondents worldwide, it would lead to an anomalous situation if an identical mark in respect of a similar drug is allowed to be sold in India. However, by way of caution, it was indicated that when a Multinational corporations had no intention of coming to India or permitting it to sell its product in India and if the Indian Company has genuinely adopted the mark and developed the product, it should not be allowed to throttle an Indian Company and here ultimately, the test would be who is first in the market.

In the peculiar facts, noting that there was no proof produced that the respondents had adopted the mark and used it before the appellants, started using the mark in India and considering the fact that for all the years, because of the injunction order, the appellants had sold their product under some other name, the injunction was continued.

50. In a very instructive decision of Delhi High Court in case of **Sumit Vijay** (supra), in regards to a mark 'BLUE JAYS' adopted by the respondent, when it established a club and a team, and it was claimed that the mark had become distinctive and achieved world-wide fame, as it operated as a source identifier of the TBJ club and vast array of goods and services used to promote the club.

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On an application filed for rectification by claiming that 'BLUE JAYS' mark have appeared on the TBJ clubs' uniforms and they were also used on a variety of goods and in relation to a variety of services including baseball games, exhibition services and education services and claimed that the marks have become well known throughout the world, and have received extensive worldwide acclaim. Extensive reference was also made to the social media accounts of TBJ club which was recognised across the globe by the general public and fans alike. With a specific pleading that the reputation of BLUE JAYS mark had penetrated into India, particular material was produced for demonstrating the same also by setting out the status of the registration of the mark in detail.

With this background, the respondents sought removal of the appellants' BLUE-JAY mark from the Register, by urging various grounds, the prominent amongst it being that there was no proper cause for adopting BLUE-JAY mark as BLUE JAYS adopted by the respondent, was coined, fanciful, arbitrary, and not indicative of the associated goods or services. It was also urged that BLUE JAYS had extensive and long use within India and reliance was placed upon the respondent's website accessible throughout the world, including India.

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A specific claim was raised in respect of transborder reputation of BLUE JAYS which had percolated in India.

This plea was opposed on the ground that the evidence placed on record by the respondent at best manifested use of the BLUE JAYS mark in the US and Canada, but there was no evidence of use of mark in India and there was no evidence of any transborder reputation of BLUE JAYS mark in India or spillover, into India, of the reputation of the mark overseas, but only one invoice was placed on record of someone ordering their product in Delhi. Thus, it was specifically urged that in absence of any evidence of use, promotion or recognition of the respondent's BLUE JAYS mark in India, the mark could not qualify as a well-known trade mark within the meaning of Section 2(1)(zg) or 11(6) of the Trade Marks Act.

It is in light of this rival claim the impugned judgment was passed by the learned Single Judge, noting that the rival marks were merely identical and based on the pleading and documents on record, the Court concluded that the petitioner was the undisputed ‘prior user’ of the trademark 'BLUE JAYS' and has better/superior right over the respondent.

51. The Division Bench after considering the statutory scheme in great detail, concluded that it was unable to sustain the finding of the learned Single Judge and it reasoned its order as below :-

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*"**12.19** In the first place, the finding that the respondent was the holder of the trade mark BLUE JAYS in India under various Classes, for some of which the respondent had applied well before the appellant applied for registration of the BLUE-JAY mark, is, with respect, incorrect. The only two applications filed by the respondent for the BLUE JAYS mark were in 1983 and 1988, for registering the TORONTO BLUE JAYS word marks, both of which were abandoned much before the appellants applied for registering its BLUE-JAY mark. The respondent was never, therefore, the "holder" of the said marks.*
12.20 …

12.21 Secondly, acquisition of global reputation is irrelevant, unless said reputation has percolated into India.
12.22 Thirdly, merely accessibility of websites, on which the respondent's mark figured, or availability of merchandise bearing the said mark for sale in India, would not make out even a prima facie case of goodwill or reputation. No reference is made to any transaction of sale and purchase - except one solitary invoice. Significantly, the respondent does not seek to contend that goods or merchandise, bearing the BLUE JAYS mark, was physically available for sale anywhere in India, or that there is any franchisee, or any brick and mortar store, which sells the said products.
12.23 …
12.24 Given the principles relating to trans-border reputation elucidated earlier in this judgment, and the law as it emerges from the decision in Toyota, it is clear that the material cited by the respondent in its petition does not make out any case of trans border reputation of the BLUE JAYS mark, in India. There is, in any case, certainly no material to indicate that the BLUE JAYS mark enjoyed trans-border goodwill and reputation in India prior to 19 August 1998.
12.25 In the absence of any evidence of trans-border goodwill or reputation of the respondent's mark in India prior to 19 August 1998, it is clear that no case of passing off, by the appellants of its products or services as those of the respondent, by using the BLUE-JAY mark can be said to exist.
12.26 Resultantly, no case for removal of the appellants' BLUE-JAY mark from the register of Trade Marks under Section 11(3)(a) of the Trade Marks Act is made out."

The instructive judgment authored by Justice C. Harishankar of Delhi High Court, completely supports the case of Mr.Kirpekar, as no material has been brought on

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record to establish the trans-border reputation of Leshark or its percolation in India. Admittedly, even as per the application for rectification, Leshark thought of introducing itself into the Indian market and therefore, sought registration of its mark and remained unsuccessful and therefore, sought to adopt the mechanism of rectification which, is granted by the learned Single Judge, without considering that the mark adopted in U.K though prior in point of time, did not receive any recognition in India and there is no evidence brought on record to establish the spill-over of its reputation in India though it had presence all over the globe. The observations of the Delhi High Court in BLUE-JAY case therefore, strongly support the case of Kirpekar.

52. In case of **Toyota** (supra), once again the territoriality principle received attention by the Hon'ble Apex Court, in the background fact that the appellant/plaintiff (Toyoto) had launched the worlds first commercial hybrid car called 'Prius' in Japan in the year 1997 and other countries like UK, Australia, USA etc during the year 2000-2001 and secured registration of its mark 'prius' in different countries as early as in the 1990s (in Japan).

53. The mark 'Prius' was adopted by the plaintiff in India in the year 2009 and the car was launched in the year 2010. The defendant, however, adopted the same mark in the year 2001 and obtained registration in the year 2002-

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2003.

In the year 2009, the plaintiff discovered that the defendants had got the mark “Prius” registered way back in 2002-03 for all types of auto parts and accessories and not only that, it had been using the trademark in carrying out their trade in such auto parts and accessories. It therefore approached the Trademark Registry for cancellation of the registered trademark of the defendants and also filed a suit on the ground that the defendants have been using the well-known trademark of the plaintiff without any authorization, thereby taking an unfair advantage of the reputation and goodwill of the plaintiff, which it had earned over a period of time across the globe.

The defendant, however, set up its stand to the effect that they obtained registration of the mark in the year 2002 and have been continuously using the same in the year 2001, and based on it, it was regularly supplying auto accessories to various automobile giants like Hyundai Motors, General Motors. The defendants claim that over a period of time they have built up a considerable market reputation, and the mark ‘Prius’ had not been registered in favor of the plaintiff for any of its products; nor had any ‘Prius’ car been sold in India so as to enable the plaintiff to claim goodwill in respect of such cars in the Indian market, as the product itself was not in existence in Indian market, and therefore, it was impossible for people in India to

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identify and recognize or associate the defendants registered trademark 'Prius' with any of the products of the plaintiff.

The trial Judge, in a Suit, held that the defendants had adopted mark 'Prius' with sole intention of enjoying the benefits from the use of the said mark and noted that the explanation given as to why the defendants had adopted the name 'Prius' was found to be wholly untenable, and therefore they were guilty of passing off their goods under the mark, of which the plaintiff was the first user. Thus, permanent injunction came to be granted along with direction to pay the damages.

In appeal, the Division Bench reversed, the finding rendered by the Single Judge holding that the findings with regard to spread of the transborder reputation of the mark 'Prius' had not been correctly arrived at, as facts and material beyond the relevant period of time, i.e. the first date of use of the mark by defendants in India was taken into consideration.

54. It is in the aforesaid background the question which arose for determination in the Appeal before the Hon'ble Apex Court was whether the plaintiff was entitled to permanent injunction, restraining the defendants from using the trademark 'Prius', so as to prevent passing of the defendant's goods as that of the plaintiff's.

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Upon dealing with the counter submissions, their Lordships of the Apex Court recorded that in order to establish goodwill, the claimant must have customers within the jurisdiction, as opposed to people in the jurisdiction who happen to be customers elsewhere, and no trader can complain of passing off as against him in any territory in which it has no customers, this was normally expressed by stating that he does not carry on any trade in that particular country, but the inwardness of it will be that he has no customers in that country.

55. Applying the test laid down by the Federal Court of Australia in ***Taco Bell Vs. Taco Co. of Australia***[11]**,** the Court observed thus :-

> *"32. Prof. Cristopher Wadlow's view on the subject appears to be that the test of whether a foreign claimant may succeed in a passing-off action is whether his business has a goodwill in a particular jurisdiction, which criterion is broader than the "obsolete" test of whether a claimant has a business/place of business in that jurisdiction. If there are customers for the claimant's products in that jurisdiction, then the claimant stands in the same position as a domestic trader.*
>
> *33. The overwhelming judicial and academic opinion all over the globe, therefore, seems to be in favour of the territoriality principle. We do not see why the same should not apply to this Country.*
>
> *34. To give effect to the territoriality principle, the courts must necessarily have to determine if there has been a spill over of the reputation and goodwill of the mark used by the claimant who has brought the passing off action. In the course of such determination it may be necessary to seek and ascertain the existence of not necessarily a real market but the presence of the claimant through its mark within a particular territorial jurisdiction in a more subtle form which*

11 (1981) 60 FLR(AUST)

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can best be manifested by the following illustrations, though they arise from decisions of Courts which may not be final in that particular jurisdiction."

56. Noting that the trademark 'Prius' had undoubtedly acquired a great deal of goodwill in several other jurisdictions in the world, and that too much earlier to the use and registration of the same by the defendants in India, it was held that if the territoriality principle is to govern the matter, there must be adequate evidence to show that the plaintiff had acquired a substantial goodwill for its car under the brand name 'Prius' in the Indian market also.

Recording that the car itself was introduced in the Indian market in the year 2009-10, it was then advertised in automobile magazines, international business magazines. Availability of data in information-disseminating portals like Wikipedia and online Britannica dictionary, and the information on the internet, even if accepted, as held not to be safe basis to hold the existence of necessary goodwill and reputation of the product in the Indian market. Taking into consideration a very limited sale of the product in the Indian market and virtually the absence of any advertisement of the product in India, prior to April 2001, which will show either lack of goodwill in the domestic market or lack of knowledge, and information of the product amongst a significant section of Indian population, their Lordships agreed with the conclusion reached by the Division Bench of the High Court that brand name of car

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'Prius' had not acquired the degree of goodwill, reputation, and the market or popularity in the Indian market, so as to vest in the plaintiff the necessary attributes of the right of a prior user so as to successfully maintain an action of passing off, even against the registered owner.

57. Delhi High Court in ***MAC Personal Care Pvt. Ltd versus Laverena, GMBH & Co.KG & Anr.***[12] considered whether the plaintiff had established transborder reputation, and it rendered important findings on the meaning of transborder reputation as understood in India, and refined the principle laid down in **NR Dongre** (supra), where it is held that it is not necessary for the mark to have been in commercial use in the Indian market in order to maintain an action of passing off, but international reputation and re-known may suffice, if the sales spills over to India. It is also noted that the growth of internet and modern means of communication, including radio, television, and broadcasting, which is now available, can establish the percolation of the mark applied to a product in another country, and sometimes globally. Thus, the principles following the aforesaid decision, recognize the transborder reputation and which could be established by strong volume of sales internationally, registration in multiple jurisdictions and prior user. However, the reputation and goodwill must necessarily spill over into India and such international reputation do not *ipso facto*

12 2016 SCC Online Del 530

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prove the reputation and goodwill in India, by applying the universality principle. Spilling into India can be demonstrated by circulation of international magazines and journals, access to internet sources, seminars, etc. though requirement of actual sales to establish is not necessary.

58. On the basis of the aforesaid authoritative pronouncements, reflected through the judgments, the position of law is well established that mere foreign use, in absence of spill-over reputation in India, does not create enforceable rights within India. While rectification proceedings are distinct from passing off actions, the underlying principle that trademark rights are territorial, apply with equal force in both the proceedings. In proceedings under Section 47 and 57, the burden lies heavily on the applicant to lead cogent and unequivocal evidence. In fact, in rectification proceedings, the burden is much heavier to be discharged as it involves cancellation of a statutory right which is already granted, and therefore, the claim must be established by leading cogent and substantial evidence. In order to establish transborder reputation in India and to claim the protection under the Trademarks Act 1999, the applicant must demonstrate that a substantial segment of Indian consumers was aware of the mark through actual availability of goods in India or extensive advertising percolating in India. No presumption of spillover reputation arises merely because a mark enjoys

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reputation abroad.

It is in light of this position of law emanating from the aforesaid pronouncement, we must examine the claim of the petitioners when it filed a rectification application by invoking Section 47 and 57 of the Trade Marks Act. The premise on which the claim was staked, is the registration of the trademark 'Le Shark' by its predecessor in UK under various registration numbers, thereby claiming that it assumed itself to be 'well-known', in men's clothing brand at least in the UK by 1980s.

It is a pleaded case of the petitioner that it officially relaunched "Leshark' brand in December 2014, and the claim is based on an assertion that Le Shark Apparel is well-known and hence the registration obtained by the registered proprietor is in bad faith. It is to be noted that the applicant obtained registration by filing application on 13/01/1987 and the registration came to be granted after examining the legality of the applied mark and it continued to remain on the register since 1991. Nothing has been brought on record by the petitioner, except the registration of 1984/1985 in the United Kingdom that the registration granted to the appellant is bad, and it ought not to have been granted or that it was bad because it was pitched against a trade mark which was well-known. Bad faith cannot be simplicitor alleged on the basis of similarity in the two marks in absence of any specific evidence led to the

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effect that prior to adoption of the mark, 'Le Shark' the registered proprietor was aware of the mark which was registered in the United Kingdom, or in some part of the world in a far flung area.

At the time when the appellant's mark in India received registration 'Le Shark' on proposed to be used basis, the application being made in the year 1987 and the registration secured in 1991, there is no material to establish that Leshark Apparel or its predecessor had acquired a goodwill or its transborder reputation was spilled over in India prior to 1987. At the relevant time, no evidence is adduced to establish that Leshark had business presence in India and in fact, according to its own case, it was desirous of launching its product in India and therefore, it sought registration from the Registrar of trademark in India, but that was refused. This prompted the petitioner to file a Rectification Application, the basis being it had acquired a goodwill and reputation outside India. There is no invoice, no advertisement, no distribution of the product in India is established by tendering any evidence and the rectification application was also premised on the basis that it was intending to launch business in India, which significantly conveyed that it had not been done before this.

Surprisingly, the application did not even plead transborder reputation, but what is claimed is only vide

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circulation of the product in international magazines, exhibitions, etc, but definitely not in India.

59. Trade Mark Law for the principle of territoriality, meaning rights granted under the statute like India's Trade Marks Act, 1999, apply within national borders rather than automatically extending worldwide. However, extra territorial reach can arise through transborder reputation, cross-border online commerce and international treaties.

Trade mark rights are tied to the jurisdiction where a mark is registered or used in trade, allowing different owners to hold similar marks in different countries. Sovereign States exercise primary control over trade mark rights within their own territory. However, an exception exists in form of an extra territorial impact when the mark has permeated globally and the consumer is purchasing the product in a particular country and, therefore, the exception to the principle of territoriality doctrine exists in form of well-known marks and transborder reputation and it is only in such situation, the Indian Court shall protect foreign marks with strong transborder reputation or goodwill in India, even without prior local use or registration in India.

Territoriality doctrine is a principle of public international law that enables the sovereign state to exercise jurisdiction over individuals and other legal persons within its territory. Converse to this, the

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universality doctrine provides for the fact that if a trademark is registered or recognized in one country, it automatically gets a transborder reputation all over the world. The principle of territoriality runs in accordance with the principle of equity, justice and conscience and emphasizes the fact that no one should be permitted to take advantage of someone else's reputation and take precedence over the universality doctrine.

Mere reference in some magazines where advertisements are issued so as to encourage the sale of the product is not a proof of the product being percolated in the country or that a goodwill is created.

In **Toyota (**supra) the Apex Court after keeping in mind the jurisprudence of UK and Australia concerning the transborder reputation concluded that in India, the reputation of transborder will be governed by the territoriality principle and not by the universality principle, and that the escalation of reputation can be through advertisement, internet or any other means that can provide sufficient knowledge to the citizen, but a distinction was drawn to the effect that such knowledge or information of the product should be available to the section of the public dealing with the product as distinguished from the general population, and particularly, when proof of such knowledge and information is within the limited segment of the population.

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In the facts placed before us, no material is produced along with the rectification application to prove that the petitioner had adopted the mark and used the mark 'Le Shark' before the appellant started use of the mark in India and the proof in form of exhibits annexed along with the rectification application in over view falls short of making out a case under Section 47 of the Trade Marks Act.

60. Coming to the grant of relief under Section 57, which necessarily involve cancellation or variation of the registration and rectification in the register, if the entry made in the register has remained there without sufficient cause. If the registration is granted to the Appellants in Class 25 based on its application record in the year 1987 and it has stood on the register for nearly 38 years, merely on the basis of a *prima facie* finding being recorded by the learned Single Judge, in our view, the striking off of the registration from the register of trademarks is wholly unjustified. If the appellant continued registration of its mark in the register for last 38 years, by way of interim order and that to on a *prima facie* finding being recorded, the removal of the mark would cause tremendous harm to the appellants and on the contrary, if the entry of the trademark in favor of the appellant continue to stand, without any evidence being tendered to the effect as to how a goodwill has been created by the Petitioners in India and how it will be impacted, in our view, the balance of

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convenience clearly lies in favor of maintaining the impugned entry as upon final adjudication, the rights of the parties can be determined.

61. The learned Single Judge, while considering the issue as to whether the impugned trademark of the Appellant ought to remain in the Register, formulated two points for consideration; i.e. whether the Appellant had bonafide intention to use the impugned mark for the purpose of Section 47(1)(a) of the Act; and whether it has used the impugned registered trademark. Further, according to the learned Single Judge, what is relevant to determine is whether the impugned trademark is liable to be expunged for 'sufficient cause' under section 57 of the Act, it having been conceived in dishonest/ fraudulent circumstances.

While answering the aforesaid points which arose for consideration, a conclusion is recorded that there is complete absence of 'bonafide' intention to use the impugned trademark, as it is a virtual copy and/or deceptively similar to the trademark registration of Le Shark which is obtained prior in point of time in U.K in 1985 and the respondents (appellant) have not seriously contested the use of this trademark comprising of the word 'Le Shark' and a distinctive pictorial logo. Recording that the fraudulent adoption of the impugned trademark is evident, it is concluded that Leshark *prima facie* establish that the respondent's (appellant's) attempt to adopt an

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identical mark itself depicted dishonesty and therefore, it is held that when the mark is borne out of fraud, it is difficult to purify its use subsequently. However, as observed by us above, the learned Judge completely failed to take into consideration the territorial operation of the trademark, as in the Rectification Application itself, Le Shark had pleaded that its trademark 'LE SHARK' received registration in U.K and it is only in the year 2015, it approached the Registry of Registrar of Trademarks in India as it was proposing to launch its product.

62. In light of the settled position of law, which we have discussed based on the decision in case of **Toyota** (supra) it appears to us that the learned Judge has failed to consider the aspect that Le Shark had no sale of the product in India and there was no reason why the people in this country were aware of the trademark which was applied by it to its product in U.K and some other countries across the globe but definitely not in India. Therefore, in our view, the finding recorded that the Appellant deliberately adopted the mark of the Le Shark loses its significance.

Apart from this, we find that the learned Single Judge has referred to some fabrication in respect of invoices of Isha Craft Pvt. Ltd, but as Mr.Kirpekar has rightly observed that it is of no consequence because the period mentioned is of no relevance. The necessary test for determining whether there was no intention to use the mark after its

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registration is sought, as contemplated in Section 47(1)(a) and (b) is not at all made out as Mr.Kirpekar has pointed out to us that after securing the registration of the mark, it was put to use and no material has been brought on record by Leshark, except a bald statement that the registration was sought without an intention to put it to use.

It is pertinent to note that though the registration was sought by the respondent-Anil Shah by preferring an application on 'proposed to be used basis' when Leshark preferred an application for registration on 'proposed to be used basis', the respondent had already secured registration and was using the alleged trademark in India. No material is brought on record by Le Shark to demonstrate use of its trademark/logo in India prior to the date on which Anil Shah preferred an application and was conferred with registration. Leshark, however, decided to use the alleged mark in India in December 2014 and it thought it appropriate to prefer an application for registration and the fact that it was selling its products under the alleged trademark outside India, is of no consequence as the Hon'ble Apex Court in **Toyata** (supra) has clearly held that no trader can complain of passing off as against him in any territory in which he has no customers and the test of whether a foreign claimant may succeed in a passing off action is whether its business has a goodwill in a particular jurisdiction, which criteria is broader than the 'obsolete' test

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of whether the claimant has a business/place of business in that jurisdiction.

63. The Apex Court also categorically declared that to give effect to the territoriality principle, the Court must necessarily have to determine if there has been a spill-over of reputation and goodwill of the mark used by the claimant, but in the present case, there is none.

Though the law declared was qua the action of passing off, in our view, the principle laid down equally apply in case of an action under Section 47 and 57 of the Act where rectification of the register is sought for.

In our view, since this aspect has been completely overlooked by the learned Single Judge and the relief has been granted in favour of Le Shark, merely on a prima facie finding being established that the adoption of the Le Shark's mark by the Appellant is fraudulent and smacks of its dishonest intention, we are unable to concur with the view expressed by the learned Single Judge.

As a result of the aforesaid, according to us, the impugned order cannot sustain being based on a prima facie finding to the effect that the impugned registered trademark is liable to be rectified under Section 47 of the Trade Marks Act, having been borne out of fraudulent adoption and not bonafidely used and exercise of the power under Section 57 of the Act, so as to maintain purity of the registry.

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64. We, therefore, quash and set aside the impugned order and thereby dismiss the Commercial Miscellaneous Petition No.538 of 2022 filed by Le Shark Apparel Ltd against the respondents (appellant) and we also must express that the mark of the respondents continue to have its presence in the Register of trade marks for over three decades and thus, the balance of convenience is in favour of the appellant, apart from the fact that it would cause irreparable loss to its business activity in India, if the mark is directed to be erased. On the contrary, as far as Le Shark is concerned, since its product is not yet launched in India, in our view, it will suffer no loss as it can continue with its international/global reputation and it will have no impact by the appellant carrying on the business which is restricted to India.

Commercial Appeal No. (L) 40525 of 2025 is allowed in the aforesaid terms.

Interim Application, if any, stand disposed of accordingly.

(ASHISH S. CHAVAN, J) **(BHARATI DANGRE, J.)**

At this stage, Mr.Rohan Kadam requests for stay of the impugned Judgment on the ground that the impugned mark has been removed since April 2026. However, in our view, the request is unjusticiable, as the mark of the

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appellant continued to remain in the Register of Trademarks for more than three decades and for the reasons recorded in detail in our Judgment, we refuse to grant any stay.

(ASHISH S. CHAVAN, J) **(BHARATI DANGRE, J.)**

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