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* IN THE HIGH COURT OF DELHI AT NEW DELHI

*Reserved on: 19th July, 2023**Date of Pronouncement: 8th August, 2023*

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C.O. (COMM.IPD-TM) 164/2022

RUSSELL CORP AUSTRALIA PTY LTD. 5 LAKEVIEW DRIVE,
SCORESBY VICTORIA 3179, AUSTRALIA Petitioner

Through: Mr. Prashant Gupta and Mr. Jithin M
George, Advocates. (M-9810113505)

versus

SHRI. ASHOK MAHAJAN B-10 SPORTS AND SURGICAL
COMPLEX JALANDHAR- 144021 (PUNJAB) AND
ANR. Respondents

Through: Ms. Yachi Vashney, Advocate for
(M-9868401295)

CORAM:
JUSTICE PRATHIBA M. SINGH
JUDGMENT

Prathiba M. Singh, J.


1. This hearing has been done through hybrid mode.

Background and Facts

2. This present petition has been received on transfer from the Intellectual Property Appellate Board (IPAB), upon the enactment of the Tribunals Reforms Act, 2021. The Petitioner- M/s Russell Corp Australia Pty Ltd. seeks cancellation of the registered trademark of the Respondent - Ashok Mahajan trading as M/s Deal International, Jalandhar and also removal of the said mark from the Register of Trade Marks. The said prayers have been filed in accordance with Section 47 and Section 57 of the Trade Marks Act, 1999 (*hereinafter 'the Act'*). The details of the trademark which is impugned in the



present petition is as under:

S. No.	Trademark	Application. No. & Filing date	Class/Goods & Services	Sealing Date	Status
1.		1534670 27/02/2007	Class 28: Sporting articles (except clothing)	18, 2010	Registered

3. The Petitioner which is a part of the Russell Brands, LLC Group (formerly known as Russell Corporation) is a leader in the sporting goods industry, apparel and uniforms being manufactured and sold for various sporting activities at national and international levels as also household sporting goods. The Petitioner and other members of the Russell Brands Group sell athletic uniforms, apparel, athletic footwear, sporting goods and athletic equipment in several countries of the world since the year 1902. The brands used by the Petitioners and other members of the Russell Brands Group are SPALDING, RUSSELL ATHLETIC, JERZEES, AAI, HUFFY SPORTS, DUDLEY and SHERRIN.

4. As per the petition, the brand name SHERRIN was adopted in 1879 by Mr. Thomas William Sherrin who opened a factory in Australia and established the company, namely, T.W. Sherrin Pty Ltd. The Company designed and manufactured specially shaped footballs for use in Australian Football. The said special shape was thereafter accepted by the Australian Football League and went on to become the standard shape and size for football in Australia. The SHERRIN business has changed hands over the years and has now been acquired by Russell Brands, LLC in 2003.



5. The Petitioner continues to make footballs for the Australian league and in fact sources footballs from Jalandhar, India and various other locations. The Plaintiff has filed various applications as also obtained registration for the mark 'SHERRIN' internationally.

6. As per the Petitioner, sometime in 2016, the Plaintiff is stated to have become aware of the Respondent No. 1- M/s Deal International Pvt. Ltd. which had filed an application for the mark 'SHERRIN' bearing application no. 2654471 in Class 35. The said mark was opposed by the Petitioner by filing a notice of opposition dated 23rd March, 2016. In those proceedings, the Petitioner realised that the Respondent also had a registered trademark bearing no. 1534670 in Class 28. Subsequently, the Respondent No.1 has also opposed the trademarks of the Petitioner. The present petition has thus been filed seeking variation of the register and cancellation\rectification of the Respondent No. 1's registered trademark 'SHERRIN'.

Submissions

7. Ld. counsel for the Petitioner - Mr. Prashant Gupta submits that the Petitioner seeks cancellation on two grounds. Firstly, on non-use under Section 47(1)(a) of the Act and bad faith registration under Section 57 of the Act and secondly on the ground that the Respondent No. 1 is a habitual squatter of well-known marks. It is his submission that the mark has itself been fully copied especially, when it is derived from surname of the founder of the Petitioner. It is also averred that the style of writing of the impugned mark being identical to that of the Petitioner shows that the mark has been registered in bad faith. It is also not distinctive of the Respondent's product. In support of his assertion that the Respondent No.1 is a habitual squatter of



well-known marks, *Id.* Counsel for the Petitioner cites the examples of the same are KOOKABURRA, Buffalo, Steeden, Kawasaki, Struddys Sports, World of Sport, Webbellis, Surridge, etc.

8. Insofar as the ground of non-use of the impugned mark is concerned, the case of the Petitioner is that an Investigator was engaged to look into the activities of the Respondent. The said Investigator has clearly deposed by way of an affidavit that the said mark is no longer being used by the Respondent. The Investigator affidavit would also go to show that the Respondent's primary brand name is 'DEAL' which it has been using since 1990 and that the registered proprietor's family member informed the Investigator that it is not using the mark 'SHERRIN'. The Investigator hired by the Petitioner is also stated to have conducted a market survey but could not find any product of the Respondent with the name 'SHERRIN'. He thus submits that on the grounds of non-use, lack of distinctiveness and being a bad faith registration, the mark is liable to be cancelled/rectified in accordance with the provisions of the Act.

9. *Id.* Counsel for the Petitioner also relies upon the following judgments in support of his submissions:

1. *BPI Sports LLC v. Saurabh Gulati & Anr.*, 2023:DHC:2920
2. *Blue Heaven Cosmetics Private Limited v. Deepak Arora and Ors.*, 2022:DHC:1953
3. *Dorco Co. Ltd. v. Durga Enterprises and Ors.*, 2023/DHC/001821

Analysis and Findings

10. A perusal of the record would show that the Plaintiff filed for trademark registration on 14th April, 2016 in India with application number 3236200 in class 35 for export of leather goods, sporting and athletic goods, sporting



articles, balls for sports, balls for games. The said application was opposed by the Respondent No. 1- M/s Deal International. Similarly, another application of the Petitioner bearing no.2795700 in class 28 has also been opposed by the Respondent No. 1. In both these applications the Petitioner claims user since 1998 in India, which has also been claimed under the present Petition.

11. The Supreme Court in *Hardie Trading Ltd. and another v. Addisons Paint & Chemicals Ltd., (2003) 11 SCC 92*, has considered the question as to who would be classified as a person aggrieved. The said determination was undertaken while referring to the Trade And Merchandise Marks Act, 1958 (*hereinafter '1958 Act'*). However, the grounds of Section 46 and 56 of the 1958 are *pari materia* with Sections 47 and 57 of the Act. The relevant extract of the said decision is extracted as under:

“30. The phrase "person aggrieved" is a common enough statutory precondition for a valid complaint or appeal. The phrase has been variously construed depending on the context in which it occurs. Three sections viz. Sections 46, 56 and 69 of the Act contain the phrase. Section 46 deals with the removal of a registered trademark from the register on the ground of non-use. This section presupposes that the registration which was validly made is liable to be taken off by subsequent non-user. Section 56 on the other hand deals with situations where the initial registration should not have been or was incorrectly made. The situations covered by this section include: - (a) the contravention or failure to observe a condition for registration; (b) the absence of an entry; (c) **an entry made without sufficient cause; (d) a wrong entry; and (e) any error or defect in the entry.** Such type of actions are commenced for the "purity of the register" which it is in public interest to maintain. Applications under Sections 46 and 56 may be made to the Registrar who is



competent to grant the relief. "Person's aggrieved" may also apply for cancellation or varying an entry in the register relating to a certification trademark to the Central Government in certain circumstances. Since we are not concerned with a certification trademark, the process for registration of which is entirely different, we may exclude the interpretation of the phrase "person aggrieved" occurring in Section 69 from consideration for the purposes of this judgment.

31. In our opinion the phrase "person aggrieved" for the purposes of removal on the ground of nonuse under section 46 has a different connotation from the phrase used in section 56 for cancelling or expunging or varying an entry wrongly made or remaining in the Register.

32. In the latter case the locus standi would be ascertained liberally, since it would not only be against the interest of other persons carrying on the same trade but also in the interest of the public to have such wrongful entry removed."

12. The decision in ***Hardie Trading (supra)*** was considered by the Supreme Court in ***Kabushiki Kaisha Toshiba v. Toshiba Appliances Co. & Ors., (2008) 10 SCC 766***. The said decision is of particular relevance in the present case as in ***Kabushiki Kaisha Toshiba (supra)***, the Supreme Court specifically considered a composite application which took multiple grounds for cancellation/rectification of a mark and removal of the said mark from the Register of Trade Marks. The relevant extracts of the said judgement are set out below:

48. Mr. Gupta submits that therein the application was filed under Section 46 and not under Section 56 whereas grounds have been raised both under Sections 46 and 56 of the Act.

49. A situation of this nature has not been considered in



any of the precedents. The original application filed by the respondent was maintainable on three counts:

- 1. Application of Section 46, both under clauses (a) and (b);*
- 2. Application of Section 56; and*
- 3. The common law principle that he had been served with a legal notice by the appellant desisting from using the word TOSIBA.*

50. It is difficult to hold that only because respondent had not been able to prove one of the grounds, namely, applicability of Section 56 of the Act, it loses its locus also. It would continue to be a person aggrieved even within the purview of Section 46 of the Act as it was slapped with a notice of action and it had a cause of action. It had a remedy. It invoked the jurisdiction of the Registrar on a large number of grounds. One of it was accepted, others were not.

51. The petition, therefore, which was maintainable, did not cease to be so particularly when the respondent not only faced with a legal action but, in fact, later on a suit has also been filed by the appellant against it. We would leave the question at that.”

13. The present case is premised on the ground of non-use of a trademark and also being a habitual offender of misusing well-known marks, including the mark of the Petitioner. In view of the fact that the Respondent has opposed the Petitioner’s mark, and also due to the fact that the Petitioner is the user of the mark in various countries and even the holder of trademark registrations, the Petitioner is, clearly, a ‘person aggrieved’ under Section 47 and Section 57 of the Act.

14. The background of the Petitioner company has been made out quite clearly both in pleadings as also in the documents. The documents which have been placed on record are press clippings which date back to 1996 in Australia, which show the use of the mark ‘SHERRIN’ including in the logo



form. As per the Petitioner, the mark ‘*SHERRIN*’ is registered in favour of the Petitioner in a number of foreign countries. The name ‘*SHERRIN*’ is derived from surname of the founder of the Petitioner company. Though, the said company changed hands over the years, the use of the said mark continues. The manner in which the Respondent has applied for the mark ‘*SHERRIN*’ shows clearly the bad faith, inasmuch as even the writing style has been copied. The history of the mark has been traced since 1880 wherein ‘*SHERRIN*’ football has been described as under:



1880 - 2020

HAND-CRAFTED IN AUSTRALIA FOR 140 YEARS.

From humble beginnings in a Collingwood factory, to becoming a widely recognised Australian icon, every premium leather Sherrin continues to be made the very way T.W Sherrin intended back in 1880. We carefully hand-make every leather ball using our rigorous 23-step process. Each football is masterfully cut and perfectly stitched by our passionate craftsmen - whose genuine focus is to simply deliver the best ball possible.

We are extremely proud to be the football of choice for this great game of ours. In continuing our dedication to innovation and craftsmanship, Sherrin strives to provide the football community with the best possible balls and equipment, as well as offer exciting, new football products each year.”



15. The manner in which the business of the Petitioner has expanded over the last 140 years, is clearly recognisable. The mark '*SHERRIN*' is not merely used for Australian football related activities but the same is used for the iconic ball that is used in the sport, which has a unique design and appearance. The '*SHERRIN*' football by itself is stated to have become symbolic of Australian football due to size and shape of the football, which has been adopted and integrated into the rules of Australian football. The Petitioner's products also include football accessories, apparel, leather game balls, etc. The Australian Football League has signed an agreement with the Petitioner by which it has ensured that the '*SHERRIN*' footballs are the official match balls of the league itself. The mark of the Petitioner '*SHERRIN*' is registered in countries such as Australia, China and even in India. The copies of the trademark registrations in these countries have also been placed on record. The '*SHERRIN*' mark is also registered by the Petitioner in class 25, bearing No. 3236199.

16. The details of the registration of the mark of the Petitioner have also been verified from the extract of the E-Register of the Registrar of Trade Marks. The same is extracted as under:

भारतमेव जयते



(NOT FOR LEGAL USE)

As on Date : 05/08/2023

[View Registration Certificate](#)

Status : Registered

[View TM Application](#) | [View Examination Report](#)

TM Application No.	3236199
Class	25
Date of Application	14/04/2016
Appropriate Office	DELHI
State	DELHI
Country	Australia
Filing Mode	e-Filing
TM Applied For	SHERRIN
TM Category	TRADE MARK
Trade Mark Type	WORD
User Detail	Proposed to be used
Certificate Detail	Certificate No. 1774599 Dated : 07/02/2018 Notified in Journal No : 1837
Valid upto/ Renewed upto	14/04/2026
Proprietor name	(1) RUSSELL CORP AUSTRALIA PTY LTD Body Incorporate
Proprietor Address	5 Lakeview Drive, Scoresby Victoria 3179, AUSTRALIA
Email Id	****j@knspartners.com
Attorney name	K & S PARTNERS[666]
Attorney Address	109, SECTOR-44, GURGAON - 122 003, NATIONAL CAPITAL REGION, INDIA
Goods & Service Details	[CLASS : 25] Clothing, footwear and headgear; sportswear; casual wear; formal wear; pants; shorts; shirts; sweatshirts; sweatpants; T-shirts; athletic jerseys; athletic team uniforms; jackets; socks; hosiery; underwear; underpants, boxer shorts, singlets, shirts, dress shirts, sport shirts, knit shirts, woven shirts, blouses, T-shirts, tank tops, skivvies, rugby tops, board shorts, tracksuits, warm-up suits, warm-up shirts, warm-up pants, sweat pants, spandex bodywear, trousers, slacks, jeans, dresses, skirts, clothing belts, knitwear, jumpers, sweaters, jerseys, cardigans, vests, neckwear, neckties, scarves, jackets, leather jackets, suits, coats, swimsuits, gloves, wristbands; hats, caps, visors, headbands; boots, shoes, casual shoes, leather shoes, sports shoes, baseball shoes, basketball shoes, football shoes, golf shoes and track shoes.
Publication Details	Published in Journal No. : 1815-0 Dated : 18/09/2017

WARNING/DISCLAIMER : THE DATA OF TRADE MARKS REGISTRY IS UNDER THE PROCESS OF DIGITISATION, IF ANY DISCREPANCY IS OBSERVED IN THE DATA PLEASE CONTACT OR SUBMIT AT APPROPRIATE TRADE MARKS REGISTRY ALONGWITH SUPPORTING DOCUMENTS. THIS WILL HELP IN UPDATION OF ELECTRONIC RECORDS.

17. The domain name <https://www.sherrin.com.au> was registered since the year 2007. Documents have been placed on record dating back to 1999 to show that the 'SHERRIN' footballs have been sourced from Jalandhar, India. The said documents include communications, purchase orders etc. One of the



trademark applications of the Respondent bearing no.2654471 was applied for in class 35, which was opposed by the Petitioner and the same was abandoned by the Respondent.

18. Insofar as the Respondent is concerned, the affidavit of the investigator has been placed on record, which states as under:

“8. I met Mr. Manu Mahajan who introduced himself as one of the Directors of the company. Upon making discreet enquiries with him, I was given to understand as below:

i) Deal International Pvt. Ltd. was incorporated on December 3, 1990;

ii) Mr. Manu Mahajan, Muni Lai Mahajan, Jyoti Mahajan, Ashok Kumar Mahajan and Anu Mahajan are the directors in the company, Deal International Pvt. Ltd;

iii) Respondent No.1 is engaged in the business of manufacturing and supplying of sports equipment and accessories such as rugby ball, football, cricket kit, badminton, hockey etc. under the brand name "Deal" since 1990;

*iv) On specifically enquiring about the products under the trademark Mr. Manu Mahajan informed that earlier they were operating under the name **Rebel Sports** and were a third-party manufacturer for Rugby ball under the said trademark but*

discontinued using the mark 'in the year 2010. Mr. Manu Mahajan further stated that they are not manufacturing or selling any products under the

trademark

v) Mr. Manu Mahajan also stated that they do not deal in the domestic market and the products manufactured by Respondent No. 1 are available for sale only in the



International market;

vi) No product or packaging material under the

trademark **SHERRIN** *were found to being stocked at the manufacturing unit;*

vii) During the local market survey in the city of Jalandhar, I did not locate any product under the

trademark **SHERRIN** *at any of the shops.*

9. I say and submit that the first investigation was concluded in February 2019 and was reported accordingly. From the aforementioned investigation, I concluded that the Respondent No.1 and/or any of its related entities is/are not manufacturing or selling any

products under the trademark **SHERRIN** *with regard to any products.*

10. I say and submit that thereafter in June 2020, I was once again approached by the attorneys of the Petitioner, K&S Partners, to re-investigate the use of the

mark **SHERRIN** *by the Respondent no.1 and thereafter re-confirm my findings of the investigation on oath.*

11. A quick re-investigation concluded & reported in

July 2020 on the use of the mark **SHERRIN** *by the Respondent No. 1 revealed that the Respondent No.1*

had stopped use of the mark **SHERRIN** *and had not used the mark ever since. I once again concluded that the Respondent No. 1 and/or any of its related entities is/are not manufacturing or selling any products under*

the trademark **SHERRIN** *with regard to any products.*”

In the opinion of this Court, there is no reason to disbelieve the investigator.



19. In this background, the question before the Court is whether the mark of the Respondent is liable to be rectified on either of the grounds raised i.e., non-use, lack of distinctiveness and trade mark squatting.

20. Section 47 of the Act specifically provides for removal of a mark from the register on the grounds of non-use. The said provision is set out below:

“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 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 tribunal 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.*

(2) Where in relation to any goods or services in respect of which a trade mark is registered—

- (a) the circumstances referred to in clause (b) of sub-section (1) are shown to exist so far as regards non-use of the trade mark in relation to goods to be sold, or otherwise traded in a particular place in India (otherwise than for export from India), or in relation to goods to be exported to a particular market outside India; or in relation to services for use or available for acceptance in a particular place in India or for use in a particular market outside India; and*
- (b) a person has been permitted under section 12 to register an identical or nearly resembling trade mark in respect of those goods, under a registration extending to use in relation to goods to be so sold, or otherwise traded in, or in relation to goods to be so exported, or in relation to services for use or available for acceptance in that place or for use in that country, or the tribunal is of opinion that he might properly be permitted so to register such a trade mark,*

on application by that person in the prescribed manner to the High Court or to the Registrar, the tribunal may



impose on the registration of the first-mentioned trade mark such limitations as it thinks proper for securing that registration shall cease to extend to such use.

(3) An applicant shall not be entitled to rely for the purpose of clause (b) of sub-section (1) or for the purposes of sub-section (2) on any non-use of a trade mark which is shown to have been due to special circumstances in the trade, which includes restrictions on the use of the trade mark in India imposed by 28 any law or regulation and not to any intention to abandon or not to use the trade mark in relation to the goods or services to which the application relates”

21. A perusal of Section 47 of the Act, would reveal that a registered trademark is liable to be taken off the Register if the mark is not used for a period of five years and three months prior to the date of filing of the petition. This has been specifically mentioned in Section 47(1)(b) of the Act.

22. A perusal of the impugned mark in the present case would show that the application for the said impugned mark was filed on 27th February, 2007 and the same was granted on 18th March, 2010. The mark relates to sporting articles. The affidavit of the investigator would show that the clear information received from the Respondent was that the mark ‘*SHERIN*’ was discontinued since the year 2010. The present petition was filed in the year 2020 before the IPAB. This affidavit filed by the investigator as also the petition has gone unrebutted by the Respondent. Thus, the requirement of the period of five years & three months stands satisfied.

23. In *Shell Transource Limited v. Shell International Petroleum Company Ltd. MANU/IC/0017/2012*, it was observed by the IPAB that the onus of proving non-user is on the person who pleads the same. In the present petition, where the Petitioner has pleaded that Respondent No. 1 is no using



the impugned mark, the said Respondent must specifically deny the allegation of non-use by stating the facts on which the denial is made. In the absence of specific denial, and also furnishing of an investigator's affidavit by the Petitioner, also confirming the non-use by the Respondent No. 1, the only conclusion that can emerge is that the acceptance of the allegation of non-use. The relevant extracts of the decision of the IPAB in *Shell Transource Limited (supra)*, are extracted as under:

14. We have considered the rival submissions and the materials before us. There is no disagreement with the position that he who pleads non-user must prove it. But when the applicant has pleaded non-user, the respondent must specifically deny it stating the facts on which he denies non-user. In the absence of specific denial we can only hold that the allegations stands admitted. This is the spirit of Order 8 Rule 3 and Rule 5 (CPC). There must be pleading of a fact and then there must be acceptable evidence to prove the same. The respondent should have pleaded that they have in fact used the mark after registration and set out the details regarding that. If the respondent does not plead that they had in fact used the mark it would be difficult for the applicant to prove non user. In fact it is unnecessary. Not having pleaded that they had used the mark the respondent cannot let in evidence to show how they have used the mark. Let us take the example of a suit on a promissory note. The plaintiff sues because of non-payment. The defendant can plead non-execution of course. But if he accepts execution then he should plead the facts to show when he returned the loan. Then the plaintiff can prove that the repayment is false. But if the defendant merely denies non-payment, the plaintiff would find it very difficult to prove non-payment. The task is many times more difficult in a case of non-user.

15. The applicant has shown that they have been trading in the name of SHELL TRANSOURCE with regard to



financial services. They are aggrieved because of the Suit filed by the respondent. The main defence of the respondent regarding the pleading of non-user is that the applicant has not proved that the respondent has not used the mark.

16. The Revlon case (cited supra) is used to defeat rectification applications on the ground that there is no evidence let in by the applicant seeking rectification that the registered proprietor has not used the mark. In the present case, apart from stating that 'The applicant has miserably failed to show how the respondent has registered the mark SHELL AUTOSERV without a bonafide intention to use the mark in relation to the services in respect of which it is registered' the respondent has not pleaded that they have used it. We have gone through the counter statement and we found that in the primary objections, para 3 (iii) the above averment is found and in the para-wise reply, in para 7, it is stated that viz-a-viz the applicant's submission in para 22 the respondent submitted that they had registered the mark with a bonafide intention to use the said mark in India in relation to the services for which it is registered. There is absolutely no pleading that they are using the mark after registration. Unless the respondent had pleaded that they are in fact using the mark, there is no duty cast on the applicant to prove that they are not using. Without pleading to that effect, the applicant's case is as good as admitted and the respondent cannot in fact let any evidence of user and has not in fact let in any evidence. The mark remains as a "proposed to be used mark". As regards bonafide intention too, the respondent must state the facts to show such intention, otherwise it would be difficult for the applicant to let in any evidence or file affidavits to show bonafide intention i.e. what transpires in the minds of the persons that who run the respondent company. For that, there must be intrinsic evidence on the side of the respondent like internal correspondence or



*advertisements etc., to show that there was some intention to use. There is no pleading regarding the user. If so, the applicant need not prove non-user. It is for the respondent to first plead bonafide intention; which they have not done. Therefore, in the absence of pleading regarding use or bonafide intention to use, we have to accept the applicant's case. In this case, we may look at the order of the Trademark Trial and Appeal Board in *Research In Motion Limited Vs. NBOR Corporation* of 12.2.2009, where it is held that*

“In sum, applicant has no documentation to demonstrate that it had the requisite bona fide intent to use the mark BLACK MAIL in commerce when it filed the present application. As evidenced by its responses to discovery requests, applicant has no plans relating to use of the mark, no plans relating to trade channels or target customers, and no plans for expansion and growth of its product line to be sold under the mark. So as to be clear, the record is completely devoid of any evidence such as product design efforts, test marketing, correspondence with prospective licensees, preparation or marketing plans or business plans, creation of labels, marketing or promotional materials, and the like.

Applicant has not rebutted opposer's showing that applicant lacked the requisite bona fide intent. The fact that applicant filed multiple applications for the mark, or that there is correspondence between applicant and counsel regarding applicant's applications, hardly establishes a bona fide intent to use the mark. If the filing and prosecution of a trademark application constituted a bona fide intent to use a mark, then in effect, lack of a bona fide intent to use would never be a ground for opposition or



cancellation, since an inter partes proceeding can only be brought if the defendant has filed an application. The absence of documentation coupled with applicant's failure to take testimony or offer any evidence supporting its bona fide intent to use convince us that applicant did not have a bona fide intent to use the mark.

Further, that Denny Jaeger, applicant's chief executive officer, believed BLACK MAIL to be a good mark for future use does not establish a bona fide intent to use. Likewise, applicant's mere statement that it intends to use the mark, and its denial that it lacked a bona fide intent, do not establish, in fact, that it had a bona fide intent to use the mark in commerce when it filed the involved application. Evidence bearing on bona fide intent is "objective" in the sense that it is evidence in the form of real life facts and by the actions of the applicant, not by the applicant's testimony as to its subjective state of mind. That is, Congress did not intend the issue to be resolved simply by an officer or applicant later testifying, "Yes, indeed, at the time we filed that application, I did truly intend to use the mark at some time in the future."

*17. This is correct. In this case, there is no pleading rebutting the allegation of non-user. The above passage indicates how bonafide intention is pleaded and if necessary proved. **The mere fact that a mark is registered cannot be evidence of use or bonafide intention to use, for then all s. 47 applications must fail.***

*18. In J.T. McCarthy, McCarthy on Trademarks and Unfair Competition, 19:14 (4th ed. 2009) it is observed **"here the complete lack of documentation or testimony clearly outweighs any subjective or sworn intent to use the mark."***



24. In terms of the judgment in *Disney Enterprises Inc. & Anr. v. Balraj Muttneja & Ors.* [CS (OS) 3466/2012 decided on 20th February, 2014], this Court is of the opinion that no further evidence would be required in this matter. This position has been reiterated by the Court in *S. Oliver Bernd Freier GMBH & CO. KG v. Jaikara Apparels and Ors.* [210 (2014) DLT 381], as also, in *United Coffee House v. Raghav Kalra and Ors.* [2013 (55) PTC 414 (Del)]. Under such circumstances, in the absence of denial by the Respondent, the Court has no reason to disbelieve the pleadings as also the investigator's affidavit on record. The Respondent has chosen not to appear in the matter despite being served. Specific court notice was issued even to the lawyer/trademark agent of the Respondent.

25. In the context of non-use, it is the settled legal position that use has to be genuine use in the relevant class of goods and services. Unless the non-use is explained by way of special circumstances, the mark would be liable to be removed for non-use. In the present case, no special circumstances have been cited and, in these facts, the mark would be liable to be removed on the ground of non-use itself.

26. Under Section 57 of the Act, if any entry is wrongly remaining on the register, the same would be liable to be removed/cancelled. It is again the settled position that if any of the grounds for refusal of the registration under Section 9 or Section 11 of the Act are made out, the such mark would be a mark, which is wrongly entered on the Register of Trade Marks. Section 57 of the Act is set out below:

“57. Power to cancel or vary registration and to rectify the register.—

(1) On application made in the prescribed manner to the



High Court or to the Registrar by any person aggrieved, the Registrar or the High Court, as the case may be, may make such order as it may think fit for cancelling or varying the registration of a trade mark on the ground of any contravention, or failure to observe a condition entered on the register in relation thereto.

(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 any entry wrongly remaining on the register, or by any error or defect in any entry in the register, may apply in the prescribed manner to the High Court or to the Registrar, and the Registrar or the High Court, as the case may be, may make such order for making, expunging or varying the entry as it may think fit.

(3) The Registrar or the High Court, as the case may be, may in any proceeding under this section decide any question that may be necessary or expedient to decide in connection with the rectification of the register.

(4) The Registrar or the High Court, as the case may be, of its own motion, may, after giving notice in the prescribed manner to the parties concerned and after giving them an opportunity of being heard, make any order referred to in sub-section (1) or sub-section (2).

(5) Any order of the High Court rectifying the register shall direct that notice of the rectification shall be served upon the Registrar in the prescribed manner who shall upon receipt of such notice rectify the register accordingly."

27.

27. Section 57 of the Act has been analysed by this Court in ***Blue Heaven Cosmetics Private Limited (supra)***. As per the said decision as also a perusal of the above provision, upon an application being filed by any person aggrieved, the High Court may pass orders cancelling or varying the registration if:



- i. There is any contravention or failure to observe a condition entered on the register in relation thereto.
- ii. Any entry is made in the register without sufficient cause.
- iii. Any entry is wrongly remaining in the register.
- iv. There is any error or defect in any entry in the register.

28. In the present case, the mark '*SHERRIN*', which is registered by the Respondent, is clearly a mark, which is identical in all respects to the Petitioner's mark. The Petitioner not only has adopted the mark more than 140 years ago but has even used the said mark in India by sourcing its products from India. The uniqueness of the products sold under the mark '*SHERRIN*' along with the use of the mark on the balls itself have also made '*SHERRIN*' synonymous with Australian football. All these factors clearly point out that the adoption of this mark is not genuine. It is an attempt to usurp the reputation of globally established mark. The adoption is also dishonest as is evident from the adoption of an identical mark in identical style for identical goods.

29. The registration of the mark '*SHERRIN*' would be barred under Section 29(3) and Section 11 of the Act as even though the Petitioner's mark is not yet registered in class 28, for sporting articles, as it is opposed by the Respondent, the same would be entitled to protection, under the laws of passing off. The logo and style of writing of the mark '*SHERRIN*' having been designed in Australia in by the Petitioner, several years prior to the application filed by the Respondent, the said logo would also be liable to be protected under the law of copyright. In addition, the relevant section of the public dealing with sporting articles in India would be clearly aware of the Petitioner's mark '*SHERRIN*' owing to the iconic character and nature. In



view of all these facts and circumstances, the adoption and use of the ‘*SHERIN*’ mark would be violative of the statutory provisions apart from being in bad faith and malafide.

30. The further allegation that the Respondent is a habitual squatter of well-known marks also leaves no room of doubt to this Court in holding that the Respondent’s mark ‘*SHERIN*’ is liable to be removed from the Register.

31. In the facts and circumstances of the case, the mark ‘*SHERIN*’ bearing no. 1534670 in class 28 of the Respondent is directed to be removed from the Register of Trademarks. The said removal of the impugned mark shall be carried out by the Registrar of Trademarks within eight weeks.

31. The petition is allowed in the above terms. Petition is disposed of, all pending applications, if any are also disposed of.

32. The Registry is directed to supply a copy of the present order to the office of the Controller General of Patents, Designs & Trademarks of India on the e- mail- llc-ipo@gov.in for compliance of this order.

PRATHIBA M. SINGH
JUDGE

AUGUST 08, 2023

Mr/am