



2024:DHC:9103



\$~23 & 24

\* **IN THE HIGH COURT OF DELHI AT NEW DELHI**  
% **Date of Decision: 14<sup>th</sup> November, 2024**

+ C.O. (COMM.IPD-TM) 697/2022  
PUMA SE

.....Petitioner

Through: Mr. Ranjan Narula, Mr. Shakti Priyan  
Nair and Mr. Parth Bajaj, Advs.  
M: 9711721913  
Email: legal@rnaip.com

versus

SH JUGAL KISHORE JAIN T/A M/S ASHISH JAIN TEXTILE  
MILLS (REGD) AND ANR.

.....Respondents

Through: Mr. Harish Vaidyanathan Shankar,  
CGSC with Mr. Srish Kumar Mishra  
and Mr. Alexander Mathai Paikaday,  
Advs.  
M: 9810788606  
Email: hvscgscdhc@gmail.com

+ C.O. (COMM.IPD-TM) 81/2023  
PUMA SE

.....Petitioner

Through: Mr. Ranjan Narula, Mr. Shakti Priyan  
Nair and Mr. Parth Bajaj, Advs.  
M: 9711721913  
Email: legal@rnaip.com

versus

JUGAL KISHORE JAIN AND ANR.

.....Respondents

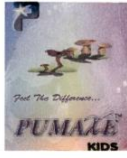
Through: Mr. Harish Vaidyanathan Shankar,  
CGSC with Mr. Srish Kumar Mishra  
and Mr. Alexander Mathai Paikaday,  
Advs.  
M: 9810788606  
Email: hvscgscdhc@gmail.com

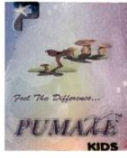

**CORAM:**

**HON'BLE MS. JUSTICE MINI PUSHKARNA**

**MINI PUSHKARNA, J (ORAL)**

1. The present petitions have been filed under Section 57 of the Trade Marks Act, 1999 ("Trade Marks Act") seeking removal of the trademarks,



i.e.  and  /PUMAXE (Label) registered under nos. 1572831 under Class 35 and 1229883 under Class 24, in favour of respondent no. 1 from the Register of Trade Marks.

2. This Court vide order dated 14<sup>th</sup> October, 2024 has proceeded *ex-parte* against respondent no. 1. The relevant portion of the said order is reproduced as under:

“xxx xxx xxx

1. Perusal of the order dated 01<sup>st</sup> August, 2024 shows that respondent no.1 has already expired and the legal representative of the deceased respondent no.1 was served on 19<sup>th</sup> July, 2024 via publication.

2. None has appeared for respondent no.1 despite service on the previous date.

3. None appears for the respondent no.1 even today.

4. Accordingly, respondent no.1 is proceeded *ex-parte*.

.....

xxx xx xxx”

3. Accordingly, this Court has proceeded to hear the present matters.

4. The facts as encapsulated in the pleadings, as necessary for adjudication of the present matters, are as under:



4.1 The petition *C.O. (COMM.IPD-TM) 697/2022* was initially filed before the Intellectual Property Appellate Board (“IPAB”), and consequent to the promulgation of Tribunals Reforms (Regulation and Conditions of Service) Ordinance, 2021 and after abolition of IPAB, the matter came before this Court. The petition *C.O. (COMM.IPD-TM) 81/2023* was originally instituted before this Court itself.

4.2 The petitioner is a company incorporated under the laws of Germany which through its subsidiaries in more than 120 countries including India, is





engaged in the business of manufacturing and marketing a wide range of products, *inter alia*, sports shoes, apparel and accessories.

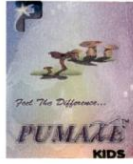
4.3 The petitioner is the owner of the brand PUMA, which is its company name as well, and is associated with the public and trade doing business

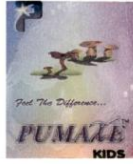

under the marks,  and . The said marks are registered in various countries across the world, earliest of which dates back to the year 1948. Further, the petitioner has several domain names, i.e. [www.puma.com](http://www.puma.com) and a dedicated Indian domain <http://in.puma.com>.

4.4 The petitioner presently is carrying out its business in India under the corporate name, 'Puma Sports India Private Limited' which was incorporated in 2005. However, the petitioner has been doing business in India since 1982 with its earliest India registration dating back to 15<sup>th</sup> February, 1977 along with various other registrations in other classes.

4.5 In the course of these petitions, the petitioner's marks  and  have also been declared as well-known trademarks on 19<sup>th</sup> February, 2024 under Rule 124 of the Trade Mark Rules, 2017. The Trade Mark Journal no. 2144 dated 19<sup>th</sup> February, 2024 indicates the well-known declaration of the petitioner's marks on Sr. No. 68 & 69.


4.6 The respondent no. 1 is stated to be engaged in the business of manufacturing and supplying clothing, footwear and headgear goods under



impugned marks, i.e.  and  //PUMAXE (Label) registered under nos. 1572831 under Class 35 and 1229883 under Class 24.

4.7 The petitioner in February, 2016 filed an opposition with the Trade



Marks Registry against the application for the mark  bearing application no. 1751339 in Class 25, sought to be registered by respondent no. 1 herein. However, as on date the said application stands refused on account of a successful opposition on part of the petitioner.

4.8 Thus, being aggrieved by the impugned registrations bearing no. 1572831 under Class 35 and 1229883 under Class 24 in favour of respondent no. 1, the present petitions came to be filed, seeking rectification and removal of the said marks from the Register of Trademarks.

5. On behalf of the petitioner, the following submissions are made:

5.1 The petitioner due to inadvertence/oversight missed the publication of the impugned marks. Therefore, could not file an opposition towards the same. The said marks came to knowledge of the petitioner, only on account of filing an opposition to another attempt of registration of a mark by respondent no. 1.

5.2 The impugned marks are deceptively similar to the prior mark of the petitioner, and it relates to identical business for sales and marketing of clothing, footwear and headgear business. Further, due to the extensive usage of marks by the petitioner, the public associates the mark, 'PUMA', with the petitioner only. Hence, the marks of respondent no. 1 are incapable



2024:DHC:9103

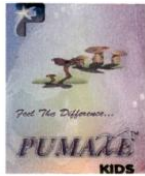


of distinguishing with those of the petitioner and being deceptively similar.

5.3 The petitioner is the prior adopter of the mark, 'PUMA' internationally as well as in India. Further, the marks of respondent no. 1 being deceptive similar are bound to cause confusion. Therefore, registration of the impugned marks is contrary to Sections 11 (1)(a) & (b) of the Trade Marks Act.

5.4 The petitioner's trademark, 'PUMA' is associated to the petitioner itself and holds a well-known reputation in India and internationally. Therefore, registration of the impugned marks is liable to be cancelled as per the provisions of Section 11 (2) of the Trade Marks Act.

5.5 The respondent no. 1 has no intention for usage of the impugned



mark, i.e. under registration no. 1572831 in Class 35, as the impugned mark was registered on 31<sup>st</sup> March, 2009 without any *bona fide* use, till date. The impugned mark has not been used for a continuous period of five years up to a date of three months before filing of this petition. Thus, the impugned mark is liable to be removed from the register under provision of Section 47 (1)(b) of the Trade Marks Act.

5.6 The mark of the petitioner has been declared as a well-known trademark on 19<sup>th</sup> February, 2024 under Rule 124 of the Trade Mark Rules, 2017. Therefore, by virtue of Section 11 (2) of the Trade Marks Act, the same will be protected and the impugned mark is liable to be cancelled.

6. I have heard learned counsel for the petitioner and have perused the record.



7. At the outset this Court notes that the petitioner has various Indian registrations under several Classes relating to the word 'PUMA', which are valid, subsisting and renewed as on date. Further, the earliest of petitioner's registration dates back to 15<sup>th</sup> February, 1977. A table indicating the Indian registrations of the petitioner, is reproduced as under

Trademark	Regn. No.	Regn. Date	Class	Validity
PUMA	323054	15/02/1977	25	15/02/2025
PUMA	323053	15/02/1977	18	15/02/2025
PUMA	323055	15/02/1977	28	15/02/2025
PUMA	449270	05/02/1986	24	05/02/2027
PUMA	532578	03/07/1990	28	03/07/2024
PUMA	2967782	20/05/2015	32	20/05/2025
PUMA 	450142	25/02/1986	18	25/02/2026
PUMA 	412852	08/11/1983	28	08/11/2024
PUMA 	424934	27/07/1984	14	27/07/2025
PUMA 	450143	25/02/1986	25	25/02/2027
PUMA 	699154	22/02/1996	3	22/02/2026
PUMA 	699153	22/02/1996	9	22/02/2026
PUMA 	700541	04/03/1996	16	04/03/2026
PUMA 	1264294	03/02/2004	41	03/02/2024
PUMA 	3419759	25/11/2016	21	25/11/2026
PUMA 	559635	03/10/1991	24	03/10/2028

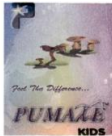
8. The petitioner also has several international trademark registrations in its favour. Documents confirming the same are placed on record. Table



indicating some of the early international trademarks of the petitioner, is reproduced as under:

Trademark	Country	Regn. No.	Regn. Date	Class
PUMA	GERMANY	608870	01.10.1948	25
PUMA	USA	797843	19.10.1965	25
PUMA	GERMANY	2001632	21.02.1991	35

9. The aforesaid brings forth that the petitioner has its first international trademark registration for the mark 'PUMA' on 01<sup>st</sup> October, 1948 in Germany and first Indian registration dating back to 15<sup>th</sup> February, 1977. In

contrast both of respondent no. 1's registrations, i.e.  and





/PUMAXE (Label) registered under nos. 1572831 under Class 35 and 1229883 under Class 24 have a prior use claim of 13<sup>th</sup> April, 1992 and 01<sup>st</sup> April, 1996. Therefore, *prima facie* the petitioner's marks have prior claim and seniority over the marks of respondent no. 1.

10. Further, the petitioner has earned substantial revenue and spent considerable amounts on advertisements internationally. Figures indicating the revenue from the year 2012-2018 and expense on advertisement from the year 2012-2017 as given in the petition, is reproduced as under:

Year	Net Sales (€ in millions)
2012	3270.7
2013	2985.3
2014	2,972
2015	3387.4
2016	3626
2017	4,135.9
2018	4,648.3



Year	Advertisement/Promotional Figures (€ in millions)
2012	609.3
2013	544.1
2014	599.7
2015	697.6
2016	732.3
2017	822.9

11. This Court also records the submissions of learned counsel for the petitioner, that during the course of the petition, the petitioner's marks,  and  have been declared as well-known marks on 19<sup>th</sup> February, 2024 under Rule 124 of the Trade Mark Rules, 2017. The Trade Mark Journal no. 2144 dated 19<sup>th</sup> February, 2024 indicates the well-known declaration of the petitioner's mark on Sr. No. 68 & 69 on page 18410 of the Journal. A screenshot of the same is reproduced, as under:

Trade Marks Journal No: 2144 , 19/02/2024




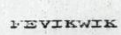
**Inclusion of the trade Mark in the list of Well-known Trade Marks**

Whereas request has been received by Registrar of Trade Marks u/r 124 of Trade Marks Rules, 2017 for determination of Well-Known trademarks and after consideration of request and perusal of the documents, the same were notified/ published in TMR Journal.

The trade marks at Sr. No. 01 to 115 were published earlier in the Trade Mark Journal u/r 124 (4) of Trade Marks, Rules 2017, and whereas no objections were filed by any person.




Further trade marks at Sr. No. 116 to 143 were already notified earlier in the Trade Mark Journal u/r 124 (5) of Trade Marks, Rules 2017.

Hence it has been decided to include following marks in the list of well-known trademarks:

Sr. NO.	Trade Mark	Well-Known Application No.	Applicant and Address
1.		816591	JK LAKSHMI CEMENT LIMITED 4TH FLOOR, NEHRU HOUSE, 4 BAHADUR SHAH ZAFAR MARG, NEW DELHI - 110002
2.		816624	UNIT NO. 134, RECTANGLE-1, SAKET DISTRICT CENTRE, SAKET, NEW DELHI -110 017
3.		816638	LIVING MEDIA INDIA LIMITED F-26, 1ST FLOOR, CONNAUGHT PLACE, NEW DELHI - 110 001
4.		816528	PIDILITE INDUSTRIES LIMITED REGENT CHAMBERS, 7TH FLOOR, JAMNALAL BAJAJ MARG, 208 NARIMAN POINT, MUMBAI-400021, MAHARASHTRA, INDIA.

18402



62	MONTEK	816451	SUN PHARMA LABORATORIES LIMITED SUN HOUSE, PLOT NO 201 B/1, WESTERN EXPRESS HIGHWAY, GOREGAON (EAST), MUMBAI - 400063
63	ELECTRAL	816523	FDC LIMITED 142-48, S.V. ROAD, JOGESHWARI (WEST) MUMBAI-400102.
64	ILS	816663	INDIAN LAW SOCIETY ILS LAW COLLEGE CAMPUS, LAW COLLEGE ROAD, PUNE-411 004.
65		816572	HONDA MOTOR CO., LTD. 1-1, MINAMI-AOYAMA, -CHOME MINATO-KU, TOKYO 107-8556, JAPAN.
66	SCHINDLER	816600	INVENTIO AG SEESTRASSE 55 6052, HERGISWIL, SWITZERLAND
67	EPSON	816493	SEIKO EPSON KABUSHIKI KAISHA TRADING AS SEIKO EPSON CORPORATION 1-6, SHINJUKU 4-CHOME, SHINJUKU-KU, TOKYO, JAPAN.
68		816513	PUMA SE PUMA WAY 1, 91074 HERZOGENAURACH, GERMANY.
69		816516	PUMA SE PUMA WAY 1, 91074 HERZOGENAURACH, GERMANY.
70	CRAX	816625	DFM FOODS LTD 149, 1ST FLOOR, KILOKARI, RING ROAD, ASHRAM, NEW DELHI-110014.

18410

12. At this stage, it would be relevant to examine the grounds for refusal and protection, as provided for ‘well-known’ trademarks under Section 11 (2) of the Trade Marks Act. The same is reproduced as under:

“xxx xxx xxx

**11. Relative grounds for refusal of registration.**—(1) Save as provided in Section 12, a trade mark shall not be registered if, because of—

.....

(2) A trade mark which—

(a) is identical with or similar to an earlier trade mark; and





(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered in the name of a different proprietor,

**shall not be registered if or to the extent the earlier trade mark is a well-known trade mark in India and the use of the later mark without due cause would take unfair advantage of or be detrimental to the distinctive character or repute of the earlier trade mark.**

xxx xxx xxx”

(Emphasis Supplied)

13. Therefore, in view of the aforesaid, the petitioner’s marks,  and  which have been declared as ‘well-known’, are entitled to receive the highest degree of protection. Thus, the Division Bench of this Court in the case of *Hamdard National Foundation (India) and Another Versus Sadar Laboratories Pvt. Ltd., 2022 SCC OnLine Del 4523*, has held as follows:

“xxx xxx xxx

63. As noted above, the trademark ‘ROOH AFZA’ has been used in respect of the appellant’s product for over a century. Prima facie, it is a strong mark. **It is also well settled that the requirement of protection varies inversely with the strength of the mark; the stronger the mark, the higher the requirement to protect the same. Trademarks serve as source identifiers. It is also well-settled that in case of a well-known mark, which has acquired a high degree of goodwill, the mark requires higher protection as it is more likely to be subjected to piracy from those who seek to draw an undue advantage of its goodwill.** In the present case, the appellants claim that the trademark ‘ROOH AFZA’ is a well-known mark.

64. In *Planters Nut & Chocolate Co. v. Crown Nut Co.*<sup>24</sup>, the United States Court of Appeals for the Federal Circuit had observed that a mark’s fame is an incentive for competitors “to tread closely on the heels of a very successful trademarks”. In cases of a weak trademark, where the trademark has not acquired significant goodwill, a higher degree of similarity is permissible. **However, strong marks which have acquired immense goodwill are vulnerable from competitors seeking to ride on their goodwill. Such marks require a higher degree of protection and it**



**is necessary to ensure that the marks of a competitor do not come close to the said senior marks.**

65. In *Kenner Parker Toys v. Rose Art Industries*<sup>20</sup>, the United States Federal Court has observed as under:—

“A strong mark, on the other hand [as opposed to weak marks] casts a long shadow which competitors must avoid.”

66. *Prima facie*, the word ‘ROOH AFZA’ has served as the source identifier for the appellant's product for over a century and it has acquired immense goodwill. We are of the view that the said mark requires a high degree of protection and it is essential to ensure that the competitors keep a safe distance from the said mark.

67. Given the overall commercial impression, *prima facie*, we are of the view that the impugned trademark lacks sufficient degree of dissimilarity, which is required to protect the appellant's trademark.

xxx xxx xxx”

(Emphasis Supplied)

14. Further, a Coordinate Bench of this Court in the case of *Allied Blenders & Distillers Pvt. Ltd. Versus SNJ Distillers Limited and Another*, 2023 SCC OnLine Del 2251, while observing the scope of protection to a well-known mark, has held as follows:

“xxx xxx xxx

**46. The next station on this journey is an important landmark where the trademark ‘Officer's Choice’ was declared as a ‘well-known trademark’ under Section 2(1)(zg) of 1999 Act in Surya Rao (supra). Needless to state that having been declared as a well-known mark, ‘Officer's Choice’ is entitled to protection not just qua identical/similar goods in same class but across all classes, including classes in respect of which it holds no registration and/or for goods or services it has yet to enter in. [Ref. Disney Enterprises, Inc. v. Rajesh Bharti, 2013 SCC OnLine Del 605]. The strength of the mark ‘Officer's Choice’ is thus evident from its status as a ‘well-known’ and ‘arbitrary mark’ and it needs no emphasis that if law protects such a mark across classes and dissimilar goods, it cannot permit use of a deceptively similar mark for identical goods.**

xxx xxx xxx”

(Emphasis Supplied)

15. At this stage, on account of establishing petitioner's prior use,



goodwill and scope of protection provided to a well-known mark, it would be relevant to compare the competing marks. A comparative table is set out, as below:

PETITIONER'S MARKS	RESPONDENT NO. 1'S MARKS

16. Perusal of the marks shows that the impugned marks are deceptively similar to the petitioner's prior used and registered 'PUMA' trademarks. The services covered under the impugned marks relate to sales and marketing of clothing, footwear and headwear business, which is identical to the petitioner's products/ services and business. Further, on account of the mark of the petitioner being accorded the position of a well known mark, the same are entitled to highest degree of protection. Thus, the impugned marks cannot qualify for protection as trademarks, as the members of the trade and public would invariably associate the same with the petitioner. The adoption of deceptively similar marks by the respondent no. 1, is bound to cause confusion and deception in the minds of the members of the trade and public, as to the source or origin of the goods.

17. This Court also notes the submission of learned counsel for the petitioner that the respondent no. 1 has not been using one of the impugned



marks, i.e. bearing registration no. 1572831 under Class 35 for a continuous period of five years and more. Moreover, no document has been

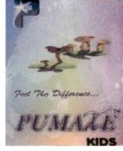



2024:DHC:9103

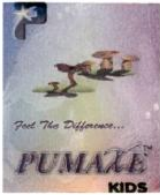



placed on record to indicate any *bona fide* and continuous usage of the mark. The submissions made by the petitioner in this regard, have remained uncontroverted.

18. In view of the aforesaid detailed discussion, it is evident that the

impugned marks of respondent no. 1, i.e.  and  /PUMAXE (Label), are liable to be removed from the Register.

19. Accordingly, the impugned registrations of respondent no. 1's

trademarks, i.e.  and  /PUMAXE (Label) registered under nos. 1572831 under Class 35 and 1229883 under Class 24, are hereby cancelled, and directed to be removed from the Register of Trade Marks. Rectification of its Register be carried out by the Registrar of Trade Marks, and its website be updated, in terms, thereof.

20. The Registry of this court is directed to supply a copy of the present order to the Office of the Controller General of Patents, Designs and Trade Marks of India, on E-mail Id: llc-ipo@gov.in, for compliance.

21. Accordingly, with the aforesaid directions, the present petitions are disposed of.

**MINI PUSHKARNA, J**

**NOVEMBER 14, 2024/kr**