



2024 : DHC : 3789



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

% *Reserved on: 19th March, 2024*
Pronounced on: 02nd May, 2024

+ **C.O. (COMM.IPD-TM) 161/2021 & I.A. 15763/2022**

M/S VANS INC. USA Petitioner

Through: Mr. Anirudh Bakhru, Mr. Mankaran Singh, Ms. Vasundhra Bakhru and Ms. Vijay Laxmi, Advocates.

versus

FCB GARMENT TEX INDIA (P) LTD. AND ANR. Respondents

Through: Mr. Saubhagya Agarwal, Ms. Ridhima Purohit and Mr. Gyanendra Singh, Advocates for R-1.

Mr. Harish Vaidyanathan Shankar, CGSC with Mr. Srish Kumar Mishra, Mr. Alexander Mathai Paikaday, Mr. Lakshay Gunawat and Mr. Krishnan V., Advs. for R-2.

+ **C.O. (COMM.IPD-TM) 416/2022**

M/S VANS INC USA Petitioner

Through: Mr. Anirudh Bakhru, Mr. Mankaran Singh, Ms. Vasundhra Bakhru and Ms. Vijay Laxmi, Advocates.



versus

FATEH CHAND BHANSALI & ANR

..... Respondents

Through: Mr. Saubhagya Agarwal, Ms. Ridhima Purohit and Mr. Gyanendra Singh, Advocates for R-1.

Mr. Harish Vaidyanathan Shankar, CGSC with Mr. Srish Kumar Mishra, Mr. Alexander Mathai Paikaday, Mr. Lakshay Gunawat and Mr. Krishnan V., Advs. for R-2.

CORAM:
HON'BLE MR. JUSTICE ANISH DAYAL

JUDGMENT

ANISH DAYAL, J.

1. These two cancellation/rectification petitions have been filed under Sections 47, 57 and 125 of the Trade Marks Act, 1999 [*the Act*] seeking removal from the Register of Trade Marks [*the Register*] of the following marks [*following two marks collectively referred to as 'impugned marks' hereinafter*]:

<u>PARTICULARS</u>	<u>1ST IMPUGNED MARK</u>	<u>2ND IMPUGNED MARK</u>
WORD MARK	'IVANS'	'IV ANS NXT'
APPLICATION NO.	1109073	1849768







USE CLAIMED SINCE	01 st April, 1999	01 st April, 2000
APPLICATION DATE	04 th June, 2002	11 th August, 2009
GRANTED ON	22 nd February, 2007	14 th March, 2011
CERTIFICATE NO.	609832	972835
CLASS(ES)	25	25
RENEWAL DETAILS/VALIDITY	04 th June, 2032	11 th August, 2029

2. These petitions were originally filed before the Intellectual Property Appellate Board [*IPAB*] and pursuant to its abolition in 2021, these petitions were transferred to this Court.

3. Petitioner is a corporation organized under the laws of USA and engaged in the business of manufacturing and trading of footwear since the year 1966 including apparel, clothing, and allied/cognate goods since the 1970s, under its signature of brand ‘VANS’/ **VANS** [*petitioner’s trademarks*]. Petitioner has obtained registrations in the said marks which are tabulated as under:



Trademark	Application No.	Class	Label/Logo	Status
VANS	574910	25	Word Mark	Registered
DEVICE	2252452	18, 25, 35		Registered
VANS (LABLE)	574911	25		Registered

VANS OFF THE WALL WITH DEVICE	2031397	9,14,18,25, 28, 35,41		Pending
VANS	2031399	9,14,18,28,41	Word Mark	Pending
VANS (DEVICE)	2252449	9,14,18,35,41		Registered

Background of Petitioner-Company

4. It is stated that petitioner-company was founded by Mr. Paul Van Doren on 16th March, 1966 in California, USA and along with business associates he opened the first ever VANS store, a brand derived from the name of its founder. Petitioner claims that it became a preferred choice for skateboarders and by the



year 1979, they already had 70 stores in California, USA and started selling through dealers both nationally and internationally. In the year 1980, they started trading shoes for a number of sports. Since the reputation in their brand developed, petitioner-company introduced clothing as well including t-shirts, hats, caps as also sunglasses. Petitioner claims permanent presence in major Indian cities including launch of approximately 100 exclusive stores and retail outlets.

5. During the pendency of present proceedings, petitioner's trademark 'VANS' has been declared as a *well-known trademark* vide Journal No.2144 dated 19th February, 2024. Petitioner's products were launched in India in 2011. The artwork involved in the petitioner's trademarks are original artworks and they have claimed copyright in the same within the meaning of Section 40 of the Copyright Act, 1957. Petitioner operates a website, being www.vans.com and has been using the said domain name globally in relation to its goods and services.

Dispute Herein

6. These rectification petitions are restricted to the impugned marks 'IVANS' and 'IV ANS NEXT'. The similarity claimed is from the 'VANS' word mark for identical goods and services in Class 25. Petitioner has also filed a suit being *CS(COMM) 449/2022* as well as another rectification petition



being *CO(COMM.IPD-CR) 682/2022* for removal of respondent's copyright



in the mark

bearing no. A-117174/2017.

Prosecution History

7. *Vide* order dated 18th June, 2020, the IPAB had stayed the operation of the 1st impugned mark. This was challenged before this Court in *W.P.(C) 9010/2020*, which was disposed of with the liberty to respondent no.2 herein to approach the IPAB by way of an appropriate application. Respondent no.1 challenged it further by *LPA 383/2020* which was also disposed of with a request to the IPAB to decide respondent no.2's application.

Submissions on behalf of the Petitioner

8. Petitioner therefore sought cancellation of the impugned registered marks *inter alia* on the following grounds:

8.1 Contravention of Section 11(1)(b) of the Act: Counsel for petitioner asserts that *firstly*, the petitioner's trademark is an "*earlier trademark*"; *secondly*, goods bearing said marks are identical or similar; *thirdly*, there exists likelihood of confusion in the public; and *fourthly*, there is a likelihood of association with the earlier mark i.e. petitioner's trademark. The impugned marks, it is asserted, are phonetically, visually, and structurally similar. The only difference being the syllable '**I**' attached as a prefix to the impugned marks. The petitioner's marks and the impugned marks are in the same Class



25. Both parties deal in the same goods – *apparels/garments* and that the respondent’s application in respect of their marks was, in any event, earlier in time i.e. in 1992; prior to the respondent no.1’s application in 2002. The impugned marks are deceptively and confusingly similar to the petitioner’s marks and, therefore, as per the mandate of Section 11 of the Act, are ineligible for registration.

8.2 Faulty Examination Report by the Trade Marks Registry: The petitioner’s trademarks were not cited in the examination report with respect to registration application for the impugned marks. This is in violation of the Rule 33 of the Trade Marks Rules, 2017 [*‘the Rules’*] which mandates that the Registrar shall conduct a search amongst the earlier trademarks, registered or applied for registration, for ascertaining whether they are the same or similar goods and services any trademark identical or deceptively similar have been applied for. Moreover, other trademarks were duly opposed by the petitioner and were subsequently abandoned.

8.3 Section 12 of the Act has no application: In the present case, respondent no.1 could not take the benefit of Section 12 on grounds of *honest concurrent use* since both conditions of honesty and concurrent use have to be established. The onus of proving the same is upon the respondent who has not provided any justifiable explanation for adoption of the mark ‘IVANS’. It was stressed that respondent no.1 has not provided any reason for them to adopt a mark which would, therefore, prove their dishonesty, particularly since they had constructive notice of petitioner’s prior registration. The earlier 1992



application of the petitioner clearly preceded the application by respondent no.1 in 2002. The impugned marks are a serious copy of the petitioner's prior registered marks and deserve to be rectified/cancelled. There is no concurrent use since the application is prior to that of the respondent and subsequent concurrent user cannot purify a dishonest intention.

9. On the basis of the aforementioned submissions, counsel for petitioner submitted that adoption of the impugned marks by respondent no.1 was in bad faith and with dishonest motives, having deliberate intention to take advantage of petitioner's well-established reputation. The petitioner's trademark has been totally subsumed into the impugned marks and thus, ought to be rectified from the Register.

10. Petitioner is relied upon the following decisions:

SR. No.	DECISION	PARA	POINT OF ARGUMENT
10.1	<i>Hindustan Pencils Pvt. Ltd. v. Indian Stationery Products Company,</i> 1989 SCC OnLine Del 34	30	Dishonest adoption of a mark.
10.2	<i>MAC Personal Care Pvt. Ltd. v. Laverana GMBH and Co. KG & Anr.,</i>	30	Honesty of adoption at the initial stage to be established to take benefit of concurrent








	2016 SCC OnLine Del 530		registration under Section 12(3) of the Act.
10.3	<i>Radico Khaitan v. Devans Modern Ltd.,</i> 2019 SCC OnLine Del 7483	46, 47	Benefit of Section 34 of the Act to a prior user of the mark.
10.4	<i>Suzuki Motor v. Suzuki India Ltd.</i> 2019 SCC OnLine Del 9241	52	Defendant deemed to have constructive notice of the plaintiff's well recognized mark.

Submissions on behalf of Respondent No.1

11. In reply, counsel for respondent no.1 addressed the following arguments:

11.1 Not Deceptively Similar: It was submitted that the stay order by the IPAB was passed without hearing respondent no.1 and was a non-speaking order. Furthermore, post the abolition of the IPAB, the final hearing could not be done. Counsel for respondent no.1 contended that petitioner's trademarks and that of respondent no.1 were not deceptively similar. There were numerous differences in both these marks which are sufficient to show that they were not deceptively similar. For this, a tabulation was provided which is reproduced as under:



Trademark	IVANS	VANS
Logos	 	
Packaging		
Basis of origin and language	Mark name is based in <u>Hindi</u> ‘IVANS- इवांस’ <i>God's gracious and glorious gift; The Sun; Ruler; Royal</i>	Mark name is based in <u>English</u> ‘VANS’ <i>Claimed to be based on owner's name</i>
Pronunciation	<i>IVANS- इवांस</i>	<i>VANS- वेन्स</i>
Products	Deals with Men's Apparel	Famous for footwear
Pricing	Price Range of 400-800 Rs. (Affordable to middle and lower class)	Not affordable to middle and lower class and only for the upper-class people due to high pricing and place of availability.



Availability	Available in small stores in the markets of various states.	Available in malls or big shops. Majorly only shoes are available. Such shops and stores are decreasing.
User Detail	Have its presence and using the mark since 1999	Entered the Indian markets in 2011.
Phonetics	Use of TWO syllables.	Use of only ONE syllable.

What was stressed upon was the dissimilarity between the two marks and the pronunciation as has been noted above, as also the difference in the device marks, the packaging, and most importantly that of products that bear the said marks. While respondent no. 1 deals with men's apparels, the petitioner is famous for its footwear. Furthermore, the price points of the products sold under the respective marks would be quite different since the petitioner's brand is available in malls and big shops while that of respondent no.1 merely extends to small stores in various local/domestic markets. The user claimed by respondent no.1 is since 1999 whereas the petitioner had entered the market only in 2011. Reliance in this regard was placed on *F. Hoffmann-LA Roche & Co. Ltd. v. Geoffrey Manners & Co. Pvt. Ltd.*, (1969) 2 SCC 716.



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11.2 No Omission by the Registrar: The fact that a search was conducted and no deceptively similar mark was found by the Registrar bears out that there is no confusion regarding the petitioner's marks. Counsel for respondent no.1 stresses that even if a trademark search is carried out on the Register today, the petitioner's mark does not appear in opposition to the respondent's mark. Registration was, therefore, granted after following due procedure and the marks cannot be removed unless the registration itself is fraudulent. A list of trademarks containing the word 'VANS' was provided by respondent no.1 and has been extracted as under:



Trademark	Registration Number	Goods	Class	Status
VANSONS	571113	Footweats For Children, READYMADE GARMENTS, SOCKS, NECKTIES, HOSIERY, CAPS AND OTHER ARTICLES OF WEAR IN CLASS 25.	25	Registered
DEVANSH	1267594	SHOWROOM IN CLASS 25.	25	Registered
VANSH	1317427	SOLES FOR FOOTWEAR INCLUDED IN CLASS 25.	25	Registered
ADVANSA	1387884	CLOTHING, FOOTWEAR AND HEADGEAR, CYCLISTS CLOTHING, SOCKS, SWEAT ABSORBENT UNDERCLOTHING , (UNDERWEAR), TEE-SHIRTS, BABIES DIAPERS OF TEXTILE, BABIES NAPKINS OF TEXTILE.	25	Registered
EVANS	1500791	ARTICLES OF CLOTHING, FOOTWEAR, BOOTS, SHOES, SLIPPERS, SANDALS, SOCKS, HOSIERY, TRAINERS, HEADGEARS, HATS, CAPS, SCARVES, GLOVES, MITTENS, BELTS(BEING ARTICLES OF	25	Registered



		CLOTHING).		
VANSTON E	2414816	READYMADE GARMENTS	25	Registered
SHIVANS	2550061	SAREES, DRESS SUITS (READYMADE)	25	Registered
Vansh Zone (label)	2563507	HOSIER}" & READYMADE GARMENTS; FOOTWEARS, RUBBER CHAPPALS, SOLES & STRAPS.	25	Registered
VS vanshh STUDIO	2876168	SHIRT, T-SHIRT, TROUSER, JEANS, PANT, CHUDIDAR, KURTA, PYJAMA, READYMADE GARMENT INCLUDED IN CLASS 25	25	Registered
VANSH CREATION DEVICE OF WOMEN	3232260	SAREES, DRESS AND READYMADE GARMENTS.	25	Registered
HAR VANSH	4106076	HOSIERY GOODS & READYMADE GARMENTS INCLUDED IN CLASS-25	25	Registered

Reliance in this regard was placed on *Bindal Toys v. Gemini Toys*, AIR 1996 Delhi 161.

11.3 Prior Usage of the Respondent's Mark:

11.3.1 It is an admitted position that petitioner entered the Indian market only in 2011; on the other hand, respondent no.1 has been using its marks since 1999. Petitioner's application in 1992 was on a '*proposed to be used*' basis and the registration was finally granted in 2006. It was published only on 15th April, 2005. Therefore, the question of constructive notice when the respondent's mark was applied for in 2002 does not arise. Further, respondent's mark was published in 2006 and there was no opposition



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registered in 2007. Petitioner started selling in 2011 more than 19 years after the petitioner had applied.

11.3.2 Respondent has annexed invoices from 2002 onwards also showing that they had ordered for the packaging and inboxing from the vendors of the brand 'IVANS'. Various snapshots had been appended by respondent no. 1 to show that the mark 'IVANS' was very much promoted since many years as was evident through the invoices of 2008 and 2014, billboard photographs from 2019, etc. Illustrative invoices for booking of advertising space in magazines are extracted as under:



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ORDER FORM (Subject to all In Delhi Jurisdiction)

fashionERA
The Final Solution of Garments Trade

Y-12, D.S.I.D.C. Complex, Outer Ring Road,
Opp. Parijat Apartments, Delhi-110083 ☎ 27925703
E-mail : fashionera@rediffmail.com. ☎ 27913523

Order No. 1248 ⁹⁸⁸¹⁵¹¹¹ Dated 3/6/18
M/S PAWAN TRADING CO.
1X/6082 NEHRU STREET GANDHI, DELHI 110081

PARTICULARS	RATE	AMOUNT
Advertisement for <u>C. GARMENTS</u>		10000/-
Order No. _____ Dated _____		S
Published in <u>fold</u> Issue _____		
Position in <u>collar</u> Page No. <u>4 first men</u>		
Received by <u>fold page</u> <u>back</u> <u>Levincession</u>		
Page No./Draft No. <u>244605</u> <u>244605</u>		
<u>AK'S BANK</u> Dated <u>3/6/18</u>		
Company's Stamp & Signature	ESTABLISHMENT	TOTAL 10000/-
Advertiser's Name <u>JVANS (Pawan)</u>	Since _____	ADVANCE 5500/-
		BALANCE 4500/-

NOTE: Advertisement rates are net, and no discount permissible further.
One copy of the Magazine will be free of cost to every Advertiser.
The Publisher is not responsible for any specified position to the Advertisement.
All payments should be made through A/c Payees Cheque in favour of "FASHION ERA".
2% interest will be charge on late payments or dishonored cheques.

For FASHIONERA
[Signature]
Manager

TRUE COPY



BILL : CASH/CREDIT (Subject to all in Delhi Jurisdiction) 247

FashionERA
The Final Solution of Garments Trade

Y-12 D.S.I.D.C. Complex, Outer Ring Road,
Opp, Parijat Apartment, New Delhi-110083
Phone : 011-27925703, Fax: 27913523,
E-mail : fashionera@gmail.com, info@fashionera.org
Website: http://www.fashionera.org

Bill No. 7494 Dated. 18/10/2014

M/s. F.C.B. GARMENT TEX INDIA PVT. LTD.
IX/6773, SHYAM GAN, GANDHI NAGAR
DELHI - 31 Ph. - 22083110

PARTICULARS	RATE	AMOUNT
Advertisement for <u>IVANS BRAND</u>		
Order No. Dated	Final	6000
Publish in <u>October Special Issue</u>		
Position in <u>Cartoon</u> Page No.		
Size <u>Front Cover Title + 3 Page</u>		
Received by <u>ADV. Special Issue + 2 Page</u>		
Cash <u>10000 cash pay</u>		
Cheque No. / Draft No. <u>Balance 30000</u>		
Bank <u>Bay</u> Dated		
Company's Stamp & Signature		
Advertiser's Name <u>MR. PAWAN JI</u>		
	TOTAL	40000
	ADVANCE	10000
	BALANCE	30000

E.&O.E.
 * Advertisement rates are net, and no discount permissible further.
 * One copy of the Magazine will be free of cost to every advertiser.
 * The Publisher is not responsible for any specified position to the Advertisement.
 * All payments should be made through A/c Payees Cheque in favour of "FASHION ERA"
 * 10% interest will be charge on late payments or dishonored cheques

For Fashion Era
Auth. Signature

11.3.3 The booked advertisements in respect of which the invoices were issued are extracted below for ease of reference:



454
OCTOBER · 2014
₹ 100/- US \$ 10

Fashion **ERA**

The Ultimate Sourcing Apparel

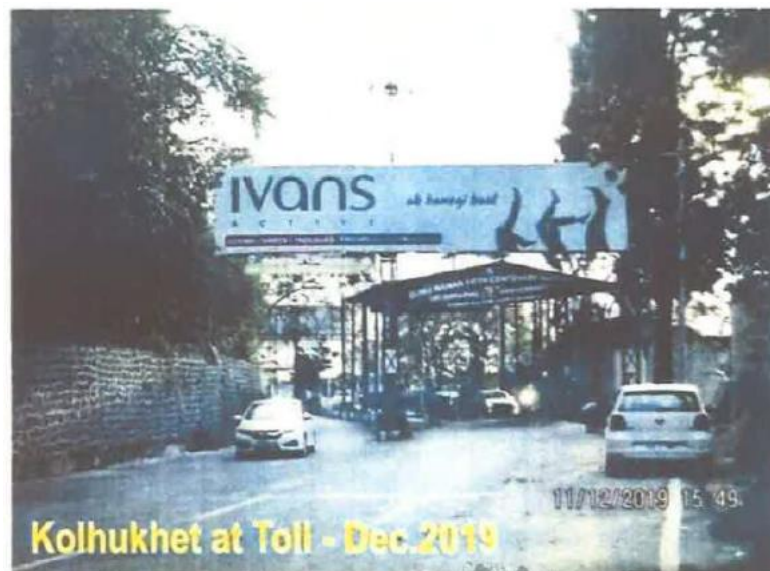
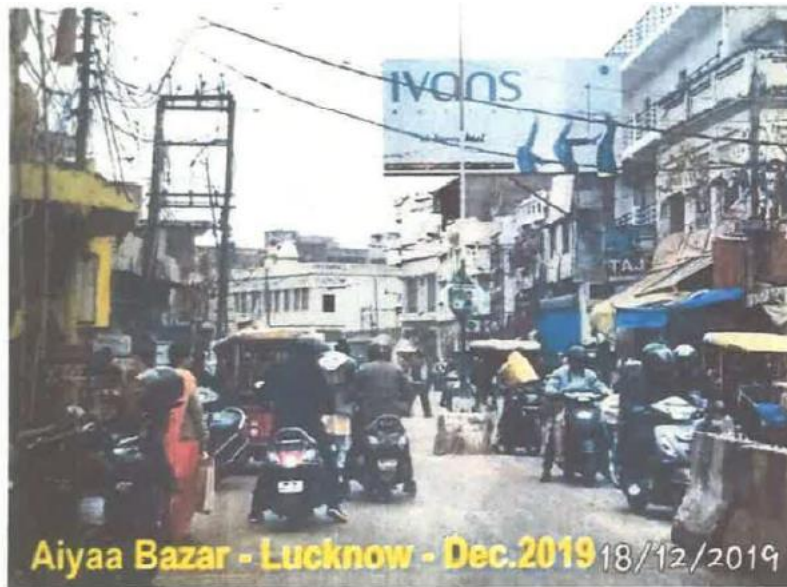
Sparky[®]
Dressing India

**ELEGANCE
REDEFINED**

JEANS
SHIRT
TROUSERS



11.3.4 Counsel for respondent no.1 also drew attention to photographs of 2019 showing billboards carrying the impugned mark of respondent no.1; same are extracted as follows:



11.3.5 Counsel for respondent no.1 further relied upon a brochure that gave a background of respondent no.1's founder; same is extracted as under:



Meet our founder

As the founder figure of Ivans brand, Mr. Fateh Chand Bhansali pioneered the vision of bringing high quality casual clothing within reach of everyone. Laying the foundation of Ivans 25 years back, he was dedicated to giving people an experience that no one else thought of in those times. After a humble beginning years back, he has been the pillar overseeing the company's growth. Today, Ivans has a manufacturing set up equipped with the most modern machinery installed at its unit. True to his commitment, he continues to create and innovate garments, package them in ways that the consumers love & bring them to shelf.

Reliance was placed on *Neon Laboratories Ltd. v. Medical Technologies Ltd. & Ors.*, 2015:INSC:728 and *S. Syed Mohideen v. P. Sulochanabai*, (2016) 2 SCC 683 on the issue of 'first in the market' test being applicable and a delayed user cannot be exploited merely by a prior application.

11.4 Product Differentiation: Petitioner was famous for its footwear and all its claims and invoices deal with the sale and goodwill for footwear. The petitioner started dealing in apparel only in the year 2006 and their stores predominantly deal in footwear. On the other hand, the respondent has been dealing only in men's apparel and has no intention of dealing in footwear even in the future. Reliance in this regard was placed on *M/s. Nandhini Deluxe v.*



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M/s. Karnataka Cooperative Milk Producers Federation Ltd.,
2018:INSC:642.

11.5 Acquiescence and Waiver: Respondent is using the mark ‘IVANS’ since 1999 openly and publicly without any opposition or objection. The petitioner was already aware of the usage of the mark. The mark has been advertised way back in the year 2008. Cumulative sales of the mark are more than Rs.130 Crores in the last five years. Petitioner has filed the cancellation petition after 16 years of its registration and unopposed enjoyment of the mark for 20 years. Therefore, reliance is placed on Section 33 of the Act which precludes a registered mark owner from seeking invalidity of the latter trademark.

11.6 Difference in price points: Furthermore, respondent no. 1 has attached, along with their reply, a comparative chart of the difference in price points that the parties’ products have; same is extracted hereinbelow for reference:



Annexure - I

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RATE LIST OF GOODS OF VANS AND IVANS (MRP range in INR)		
	VANS	IVANS
MEN		
Shirt	1597-5770	699-995
Pants/Trousers	2899-4319	899-1195
Shoes	2105-14514	NA
WOMEN		
All Clothing	1778-13066	NA
Shoes	2177-13066	NA
Information of VANS is from the official website of VANS Inc. (accessed at 14:06 pm on 13/02/2021)		
* 1 US Dollar = 72.59 INR (12:45 pm on 13/02/2021)		

12. Respondent's case effectively was that the marks were not similar; the prior application will not matter; Section 12 is not required since when marks are not similar. Even assuming that the mark was similar, concurrent use would be permitted under Section 12 for separate categories of goods; the respondent had prior use; the petitioner had acquiesced for a long period of time and the well-known trademark benefit had only been given now in 2024.

Analysis

13. Having perused the documents on record and appreciated the respective contentions of the parties, this Court is of the opinion that the rectification of



the impugned marks ought not to be permitted *inter alia* for the following reasons:

13.1 It is evident from the records that respondent no.1's trademark 'IVANS' was filed in the year 2002 and granted in the year 2007. The user was claimed since April 1999 for 'IVANS' and April 2000 for 'IVANS NXT' in Class 25. The mark was originally applied for by Mr. Fateh Chand Bhansali and was later assigned to the respondent no.1 company. Assignment deeds have been appended along with the response.

13.2 As per respondent no.1, it is only using this mark for the purposes of apparel, while the petitioner, as per their petition, are predominantly deploying it for shoes. The narrative provided by the petitioner *inter alia* in para 9.2 to 9.5 of the petition bears out that the origin of the brand is essentially for shoes although an averment is made that clothing has been introduced for sports such as motor-cross, surfing, skateboarding as well as certain other accessories like t-shirts, hats, caps, bags, hoodies, and sunglasses.

13.3 A perusal of the registrations appended by the petitioner include a large number of shoe sole patterns, shapes of shoes, patterns on the upper shoes, etc. It is quite evident from the averments made in the rectification petition as well as from the submissions by petitioner's counsel that the petitioner's vast principal and predominant presence is in footwear and only allied goods include apparel. The assessment, therefore, has to be seen in this context, considering that respondent no.1's stated case is that it has no intention to venture into the category of footwear and is only dealing with men's apparel.



13.4 It is also clear from the submissions made by petitioner's counsel that the launch of petitioner's products in India was in 2011 even if they may have secured a registration with effect from 1992. In any event, the application filed in 1992 for the word mark 'VANS' by petitioner was on a '*proposed to be used*' basis in Class 25. The registration itself was finally granted in 2006 and was published only in 2005. In contrast, the respondent no.1's mark was applied from 2002 with user claimed from 1999 and was published in 2006. No opposition was registered in 2007. The petitioner having launched their products in 2011 more than 19 years after they had applied cannot possibly claim prior user of the said mark. Respondent no.1, on the contrary, has shown their user since 2002 on the basis of invoices which have been annexed along with their reply. Furthermore, snapshots appended by respondent no.1 show that the mark 'IVANS' was promoted extensively through billboards, advertisements, etc. since at least 2008.

13.5 In this regard, reference by respondent no.1 to *Neon Laboratories (supra)* is instructive. The Supreme Court has relied on the '*first in the market*' test wherein what needs to be seen is the development in the period between the date of application for registration and the date of grant of registration. It is quite evident that while the petitioner had applied in 1992 and the respondent no.1 had applied in 2002, the petitioner had not launched the products in the market till 2011. Therefore, the actual user in the market would have to be considered whereas claimed user by petitioner is since 1992.



13.6 Respondent no.1 also relied upon the decision in *Syed Mohideen (supra)* wherein the Supreme Court held that registration is a mere recognition of the rights pre-existing in common law, and in case of conflict between two registered proprietors, the evaluation of the better rights in common law is essential as the common law rights would enable the court to determine whose rights between the two registered proprietors are better and superior in common law which have been recognized in the form of registration under the Act.

13.7 As regards product differentiation, reliance of respondent no.1 on the decision in *Nandhini Deluxe (supra)* is also instructive and applicable. In *Nandhini Deluxe (supra)*, the Supreme Court considered the point that goods of the disputing parties were different. While the respondent in that matter was producing and selling only milk and milk products, the goods of the appellant were fish, meat, poultry, etc.

13.8 Even otherwise, the marks of respondent no.1 are presented in a very different form than that of the petitioner; comparison and differences have been enumerated in the table extracted in para 11.1. The device marks are completely different, the trade dress used and the manner in which the trademark is used on the packaging is also totally different. Moreover, the customer base is vastly different since petitioner's products are highly priced whereas respondent no.1 is selling men's apparel in the price range of Rs.400/- to Rs.800/-. The stores in which such products are sold are also vastly different; while the petitioner's products are in high-end stores, or in malls and big shops, respondent no.1 is selling its products in small stores in various markets.



13.9 On this aspect, the decision in *Schering Corporation v. Getwell Life Sciences India Pvt. Ltd.*, 2008 SCC OnLine Del 760 is notable. Herein, this Court held that defendant's mark was not deceptively similar to the plaintiff's mark as the price ranges of the products are so distinct that no reasonable person would confuse the defendant's product with that of the plaintiffs and, therefore, there is no question of there being any likelihood of confusion. Although this decision was rendered for pharmaceutical products, the principle is of much relevance in the present case.

13.10 The customer base being quite different as also the association of the brand 'VANS' predominantly, mostly and substantially for footwear, it would be unlikely that a customer will purchase a product carrying respondent no.1's mark and associate it with that of the petitioner.

13.11 It is also noted that petitioner filed the cancellation petition 16 years after registration of respondent no.1's mark, and did not oppose the said mark even once in the past. Respondent no.1 has enjoyed rights in the mark since at least 2002 as is apparent from the invoices which have been filed by them. There would be no reason for a latter entrant into the market to suddenly claim that respondent no.1's mark should be taken off the Register merely because the petitioner chose to launch their products in 2011, that too, as an international brand in footwear. Apparels were only introduced as allied goods and also at a different price point, thereby ensuring that there would be no likelihood of confusion or association with the petitioner's mark.



13.12 In any event, it is obvious that the usage of the marks by respondent no.1 is in a totally different form as has been noted above in para 11.1. Respondent



no.1's device marks are and while the



petitioner uses its mark in the following fashion:

13.13 This Court does not give too much credence to the issue under Rule 33 raised by the petitioner, in that, it was incumbent upon the Registrar to have conducted a proper search for identical or deceptively similar trademarks for same or similar goods and services. In this regard, there is no response by the petitioner to the fact that, even today, if a search is carried out, the petitioner's mark does not appear in opposition to the respondent's mark. Besides, a list of trademarks containing the word 'VANS' was provided by respondent no.1 and is extracted in para 11.2 above.

13.14 Petitioner's reliance on *Hindustan Pencils (supra)* and other cases to claim dishonest adoption will not be applicable in the facts and circumstances of this case, particularly when the petitioner shows actual usage at the very least since 2002, claims since 1999, however, itself admits to having launched its products in 2011 in India. Further, respondent no.1 is not using the mark in any manner to show any association with the petitioner's mark; the presentation, stylization, and label being totally different.



13.15 Application of Section 12 of the Act was argued for honest concurrent user. While the petitioner argued that respondent no.1 could not claim that benefit, being neither an honest nor a concurrent user, respondent no.1's case is more acceptable. The facts as stated above in terms of the actual user of respondent no.1 since 2002 as opposed to petitioner's launch in 2011 and the different price points for products which are totally different, appeals to this Court. Moreover, dishonest adoption could not be made out for the simple reason that publication of petitioner's mark was only in 2005, and, therefore, there could be no constructive notice, as contended by the petitioner's counsel when respondent no.1's mark was applied for in 2002. Despite respondent no.1's mark being published in 2006, there was no opposition which was registered by the petitioner against the impugned marks assailed in the present petition.

13.16 Petitioner's contention that the marks are phonetically, visually, and structurally similar, and that the only difference being the syllable 'I' cannot accrue to the benefit of the petitioner for the reason that this petition is for rectification of the Register. Merely because another mark which has existed since the last 20 years is on the Register with no evidence of petitioner's prior use of its marks in India, this test in isolation cannot come to the petitioner's rescue. Issues of similarity cannot be seen in abstract and completely separate and severed from the more determinative issues such as *actual prior market use, difference of goods, difference in the devices and labels used, different price points*, etc.



13.17 In this context, this Court finds the ‘*global appreciation test*’ as referred to by a Single Bench of this Court in *AMPM Fashions Pvt. Ltd. v. Akash Anil Mehta, Partner of AMPM Designs and Anr.*, 2021 SCC OnLine Del 4945 of pertinence. Relevant portions are extracted as under:

61. When applying the test, one has to make a “global appreciation”. The “global appreciation” test requires one to examine, inter alia, the following facets, albeit, holistically as they are inter-dependent:

(i) The degree of visual, aural and/or conceptual similarity between the marks.

(ii) The overall impression created by the marks.

(iii) The impact that the impugned marks have on the relevant public i.e., the matter should be considered through the eyes of an average consumer, who would buy or receive the goods or services.

(iv) The distinctive character that the infringed mark has acquired i.e. either because of the mark per se or on account of reputation that it has enjoyed in the public space.

(v) That the average consumer has an imperfect recollection.

(vi) The degree of similarity between the goods or services, which are purveyed under the rival marks.

[See SABEL BV vs. Puma AG, Rudolf Dassler Sport [1998] R.P.C. 1992 & Kerly's Law of Trade Marks & Trade Names, 4th edition at page 247-248]

62. It needs to be emphasized that, while evaluating the aforesaid facets, one has to bear in mind the global/composite appreciation test, which enjoins



that each of them is inter-connected and explicable, as a whole. In other words, an integrated rather than a compartmentalized approach is required to be adopted. The proclivity of giving weight to one facet as against the other facet(s) is to be abjured. It is only an overall evaluation of all facets which helps in ascertaining, whether or not there is a likelihood of confusion. Likelihood of confusion would arise, if there is a risk of the relevant consumers/public believing that the goods or services offered by the defendants originate from the plaintiff or in some way, are economically or commercially linked to the plaintiff.

(emphasis added)

13.18 In any event, as has been noted above, petitioner's trademarks were not cited having not been found in conflict with what was sought to be registered by respondent no.1, and, therefore, even otherwise, respondent no.1's use of the mark cannot be said to be dishonest in any manner whatsoever.

13.19 In fact, Section 34 of the Act would also lean in favour of respondent no.1. Section 34 disentitles the proprietor for registered trademark to interfere with or restrain the use of an identical or similar trademark in relation to the same goods and services if the trademark has been used prior to the user of the registered trademark or prior to the date of registration, whichever is earlier. This is an important aspect which may be relevant considering that the user by respondent no.1 is from 2002, prior to 2011 user of the petitioner.



13.20 The declaration of the petitioner's trademark 'VANS' as a well-known trademark on 19th February, 2024 may also not be relevant for the purposes of rectification since respondent no.1 cannot suddenly lose rights over its own mark which, as noted above, is not liable to be removed for the reasons mentioned above. Declaration of a well-known trademark cannot give an automatic, unabridged, and unmitigated right to a proprietor to apply for rectification of all the marks which have subsisted on the Register for years prior and in different classes.

14. In view of the above discussion, present petitions are dismissed. Pending applications, if any, are rendered infructuous.

15. Present petitions stand disposed of in the above terms.

16. Judgment be uploaded on the website of this Court.

**ANISH DAYAL
JUDGE**

MAY 02, 2024/MK/sc