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\* IN THE HIGH COURT OF DELHI AT NEW DELHI

*Reserved on: 17 September 2025*

*Pronounced on: 5 January 2026*

+ LPA 475/2025, CM APPLs. 45526/2025 & 45579/2025

MR. SUMIT VIJAY & ANR. ....Appellants

Through: Mr. C.M. Lall, Sr. Adv and Mr. J. Sai Deepak, Sr. Adv. with Mr. Rupin Bahl, Mr. Karan Bajaj, Ms. Aastha Arora, Mr. Avinash and Ms. Annanya Mehan, Advs.

versus

MAJOR LEAGUE BASEBALL

PROPERTIES INC. & ANR. ....Respondents

Through: Mr. Urfi Roomi, Ms. Janaki Arun, Mr. Jaskaran Singh, Ms. Angela Arora, Advs. for R-1

Mr. Nidhi Raman, CGSC with Mr. Akash Mishra, Mr. Arnav Mittal and Mr. Mayank Sansanwal, Advs. for R-2

**CORAM:**

**HON'BLE MR. JUSTICE C. HARI SHANKAR**

**HON'BLE MR. JUSTICE OM PRAKASH SHUKLA**

**JUDGMENT**

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**05.01.2026**

**C. HARI SHANKAR, J.**

1. The blue jay, a truly beautiful bird, is native to eastern North America. Though the appellants before us have sought to contend that the blue jay is also known as the Indian Roller and is the State bird of Karnataka, Andhra Pradesh and Odisha, this is incorrect. The blue jay and the Indian roller belong, in fact, to different avian families, with



the former belonging to the *Corvidae* and the latter to the *Coraciidae* family. The illusion seems to have originated in the description, by the famous naturalist Carl Linnaeus, in 1758, of the Indian Roller as the “Jay from Bengal”.

2. Enough, however, of ornithology. The blue jay occupies our attention, in this appeal, not in its natural avian *avatar*, but as the much more suburban subject matter of a trade mark. And thus we descend, from the skies above to the earth below.

### **The *lis***

3. By a judgment dated 1 July 2025, a learned Single Judge of this Court has, in CO (Comm IPD-TM) 279/2023<sup>1</sup> instituted by the respondent under Section 57(2)<sup>2</sup> of the Trade Marks Act, 1999, struck the registered BLUE-JAY trade mark of the appellants off, from the Register of Trade Marks.

4. Aggrieved thereby, the respondents before the learned Single Judge are in appeal before us.

### **5. The statutory scheme**

#### **5.1 Sections 47 and 57 are the only provisions, in the Trade Marks**

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<sup>1</sup> **Major League Baseball Properties Inc v Manish Vijay & Ors.**

<sup>2</sup> (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.



Act, under which a registered trade mark of one person can be removed from the Register of Trade Marks at the instance of another. Section 47 allows the mark to be removed on the ground of continuous disuse. Section 57(1) allows removal of a registered trade mark if any condition, in relation to the mark and entered in the Register, is contravened or not observed.

**5.2** These provisions do not concern us. We are concerned with Section 57(2).

**5.3** Section 57(2) can be invoked by any person who is aggrieved

- (i) by the absence from the Register of any entry, or
- (ii) by any entry made without sufficient cause, or
- (iii) by any entry which wrongly remains on the Register, or
- (iv) by any error or defect in any entry in the Register,

and empowers the Registrar, or the High Court, to make, expunge or vary the entry. Circumstances (ii) and (iii), if accepted, would naturally result in expunction of the entry, as has happened here.

**5.4** The circumstances in which a trade mark can be said to be “wrongly remaining” on the Register are not elucidated in Section 57. Nor are they to be found elsewhere in the Trade Marks Act. In the circumstances, one has to refer, for the purpose, to Sections 9 and 11, which set out the grounds on which registration of a trade mark can be refused. If a mark ought not to have been registered in the first place, as it breached the proscriptions contained in Section 9 or Section 11, the sequitur is, naturally, that it ought not to remain on the Register either.



**5.5** The circumstances in which the Registrar can refuse to register a trade mark, as envisaged in Sections 9 and 11, are many and varied. Of these, Section 9 contains “absolute” grounds of refusal, whereas Section 11 contains “relative” grounds of refusal. Section 9 does not concern us, as the respondent has not invoked any clause thereof.

**5.6** The impugned judgment has removed the appellants’ BLUE-JAY trade mark from the Register under Section 11(10)(ii)<sup>3</sup>. However, the grounds urged by the respondent in its Section 57 petition would also require us to address Section 11(3)(a)<sup>4</sup>.

**5.7** In order to avoid any confusion, we may observe, here, that though the main grievance of the respondent, against the appellants’ BLUE-JAY trade mark, was its similarity to the respondent’s BLUE JAYS trade mark, neither Section 11(1)<sup>5</sup> nor Section 11(2)<sup>6</sup> would apply in the present case, in view of the definition of “earlier trade

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<sup>3</sup> (10) While considering an application for registration of a trade mark and opposition filed in respect thereof, the Registrar shall—

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(ii) take into consideration the bad faith involved either of the applicant or the opponent affecting the right relating to the trade mark.

<sup>4</sup> (3) A trade mark shall not be registered if, or to the extent that, its use in India is liable to be prevented—

(a) by virtue of any law in particular the law of passing off protecting an unregistered trade mark used in the course of trade;

<sup>5</sup> 11. **Relative grounds for refusal of registration.**—

(1) Save as provided in Section 12, a trade mark shall not be registered if, because of—

(a) its identity with an earlier trade mark and similarity of goods or services covered by the trade mark; or

(b) its similarity to an earlier trade mark and the identity or similarity of the goods or services covered by the trade mark,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

<sup>6</sup> (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.



mark" provided in the Explanation following Section 11(4)<sup>7</sup>, which covers only marks which are registered, or in respect of which an application for registration is pending. Neither on 19 August 1998, when the appellants applied for registration of the BLUE-JAY mark, nor even at any later point of time till the date of institution of CO (Comm IPD-TM) 279/2023, was the respondent the proprietor of any registered trade mark, nor was any application for registration of any trade mark, filed by it, pending. We refer, of course, to India.

**5.8** Of the various circumstances outlined in para 5.3 *supra*, CO (Comm IPD-TM) 279/2023 was instituted by the respondent invoking circumstance (iii). The respondent's contention, which the learned Single Judge has accepted, is that the appellants' BLUE-JAY mark ought not to be permitted to remain on the Register. This contention has found favour with the learned Single Judge, to the chagrin of the appellants.

**5.9** Ergo, the present appeal.

## Facts

### **6. Proceedings before the learned Single Judge**

#### **6.1 Case of the respondent, as petitioner in CO (Comm IPD-TM)**

<sup>7</sup> *Explanation*.- For the purposes of this section, earlier trade mark means—

- (a) a registered trade mark or an application under Section 18 bearing an earlier date of filing or an international registration referred to in Section 36-E or convention application referred to in Section 154 which has a date of application earlier than that of the trade mark in question, taking account, where appropriate, of the priorities claimed in respect of the trade marks;
- (b) a trade mark which, on the date of the application for registration of the trade mark in question, or where appropriate, of the priority claimed in respect of the application, was entitled to protection as a well-known trade mark.



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279/2023

**6.1.1** The factual averments in CO (Comm IPD-TM) 279/2023, insofar as they are relevant for the purposes of the present appeal, may be set out thus:

(i) Major League Baseball<sup>8</sup> is a world renowned professional baseball league operating out of USA and Canada. The respondent holds all intellectual property rights of MLB, and controls licensing and merchandising for all MLB clubs. MLB is the highest form of professional baseball in the world, with a history which can be traced back to 1876. Baseball is played by more than one million players worldwide, in more than 108 countries, including India. On an estimate, in 2023, over 70 million people, including people from India, would have attended MLB games. These games were played at venues spread across the US and in different cities around the world. 30 teams comprise MLB, representing 29 cities in the US and one in Canada.

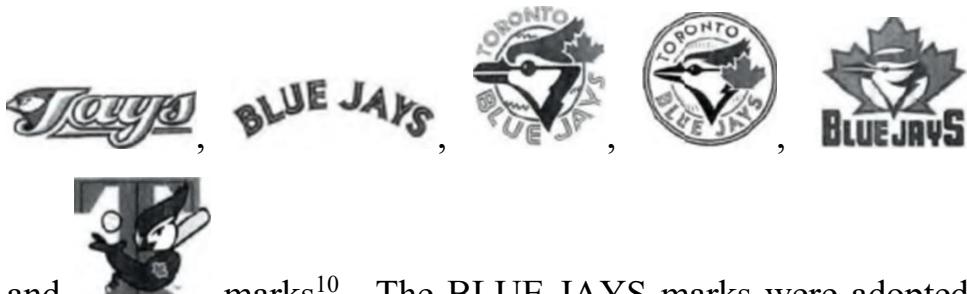
(ii) Of the 30 teams comprising the MLB, the only team situated outside the USA, which is in Canada, is the Toronto Blue Jays<sup>9</sup>. The respondent is the proprietor of the BLUE JAYS and TORONTO BLUE JAYS word and device marks,

employed by the BLUE JAYS club. These include the 

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<sup>8</sup> “MLB” hereinafter

<sup>9</sup> “TBJ”, hereinafter



and  marks<sup>10</sup>. The BLUE JAYS marks were adopted by the respondent in 1976, when the TBJ Club was established as an MLB team. BLUE JAYS was chosen and adopted as the name for the TBJ club.

(iii) As a result of extensive use and promotional activities, the BLUE JAYS marks have become distinctive and have achieved worldwide fame. They operate as source identifiers of the TBJ club and the vast array of goods and services used to promote the club. The TBJ club has, over a period of time, become one of the most famous and recognisable teams in professional baseball. The documents filed to substantiate this claim of widespread popularity and use of the BLUE JAYS marks are

- (i) an article dated 7 February 2006, titled “Toronto Blue Jays” from the Canadian Encyclopedia,
- (ii) a valuation list in the Forbes magazine of the TBJ MLB team,
- (iii) an article regarding the first official MLB game played by TBJ on 7 April 1977, on a website titled “FireShot Capture 077”,
- (iv) details regarding the attendance, stadiums and park

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<sup>10</sup> “the BLUE JAYS marks” hereinafter



factors of TBJ in the magazine “baseball reference”, a tabular statement setting out the franchise attendance, stadia and other details of TBJ,

(v) certain Instagram pages and photographs from the TBJ Instagram page,

(vi) an article in the magazine offside dated 17 September 2021 regarding celebrities who are fans of TBJ, and

(vii) an article dated 8 November 2023 in the Indian Express titled “Punjabi Singing Sensation AP Dhillon throws official ceremonial first pitch for baseball team Toronto Blue Jays”.

(iv) Ever since 7 April 1977, when the TBJ club played its first regular session MLB game, one or more of the BLUE JAYS marks have appeared on the TBJ clubs’ uniforms. Over the years, the BLUE JAYS marks have also been used on a wide variety of goods and in relation to a wide variety of services including baseball games, exhibition services and education services. The marks have become well known throughout the world, and have also received extensive worldwide acclaim. Various documents, in the form of articles in foreign magazines, were placed on record in this regard.

(v) Consumers around the world, including India, have been exposed to a wide range of goods and services designated by the BLUE JAYS mark through the official MLB website (<https://www.mlb.com>). Through this website, fans of baseball



in India and all over the world could subscribe to live game day broadcasts.

(vi) The official MLB website, and several other websites which covered MLB news and events, as well as sell MLB products, featuring the BLUE JAYS marks, have been seen by internet users throughout the world, including India. News and entertainment services provided on these websites, as well as goods available for sales thereon, have been offered to Indian consumers and worldwide through internet enabled computers, mobile phones etc. at least since 1998.

(vii) Games played as part of the MLB, including games in which the TBJ club was a participant, have been broadcasted and televised to persons across the world, including India, for several decades. MLB games, featuring the BLUE JAYS marks, have been broadcasted in India via Fox Sports India, Facebook, ESPN, Star Sports and other channels. These broadcasts have considerably enhanced consumer awareness of MLB professional baseball, as well as the BLUE JAYS marks. News coverage of MLB games, including games played by the TBJ club, was also widespread. Several international publications contained news items about MLB professional baseball, accompanied by photographs of the TBJ players wearing uniforms bearing the BLUE JAYS marks. Many of these publications were available online to internet users in India and throughout the world.



(viii) The social media accounts of the TBJ club and of MLB and its matches in general also contributed to their worldwide recognition. The TBJ club is recognised across the globe by the general public and fans alike. The BLUE JAYS marks are exclusively identified with the TBJ club. Consumers world over, who came across the BLUE-JAY mark would be compelled to infer an association with the TBJ club.

(ix) The following material indicated that the reputation of the BLUE JAYS marks has penetrated into India:

(i) In 2008, Z-Sports organized a contest called the 'Million Dollar Arm' to discover America's next baseball hero from India, in which more than 30,000 people in India participated. The two winners were signed to a professional contract by the Pittsburgh Pirates Major League Baseball Club. This created considerable buzz and excitement about the sport of baseball in general and MLB professional baseball in India. The two players made their debut in a baseball game on 4 July 2009, which was reported in well-known publication circulated in India.

(ii) MLB games featuring the BLUE JAYS marks have been televised and broadcasted internationally, including India, for several decades. Indian consumers and public thus stand exposed to the BLUE JAYS marks. Fox Sports Asia, VEQTA and Facebook are the international



broadcasters for MLB baseball games in India. During broadcasts of these games, the BLUE JAYS marks are visible on the uniforms of the players, coaches and on-field personnel.

(iii) MLB games, including those featuring the BLUE JAYS marks, are widely covered in news reports by publication in media outlets across the world, including India.

(iv) Details relating to the TBJ Club and the MLB games featuring the BLUE JAYS marks are also available by way of online articles, accessible in India and throughout the world. Highlights and scores of MLB games including those featuring the TBJ club are reported daily in virtually every newspaper in the US and worldwide, which are accessible even in India. The respondent's websites are accessible throughout the world, including India. They actively promote the TBJ Club and display the BLUE JAYS marks at least since far back as in 1996.

(v) In July 2019, the respondent announced the opening of an office in India to promote the game of baseball in India. This announcement was well covered in the media, both online and offline.

(vi) The official licensed products and merchandise of



the respondent including those bearing the BLUE JAYS mark continue to be sold on the respondent's websites since several years. They have been purchased by consumers across the world, including India. These products have also been available for sale through unauthorised sellers or various e-commerce websites.

(vii) The respondent's BLUE JAYS marks have enhanced goodwill and reputation amongst Indian consumers as compared to the rest of MLB clubs, owing to the significant presence of the Indian diaspora in Canada, as the TBJ Club is the only MLB club based out of Canada.

(x) The status of registrations held by the respondent under Section 23 of the Trade Marks Act, as on the date of filing the petition, were as under:

S. No.	Mark	Class	Goods/Services	Date of Application	Status
1	TORONTO BLUE JAYS (word)	25	Clothing, Footwear, Head-Gear (Head-Wear) and Knit-Wear included in Class 25	11 October 1983	Removed
2	TORONTO BLUE JAYS (word)	16	Stickers, Posters, Banners, Paper, Cardboard and Goods made of these materials, Printed Matter including Catalogues, Brochures, Rosters, Pamphlets, Leaflets, Book Binding Material, Photographs, Stationery, Adhesives for Stationery or Household Purposes, Artists' Material, Paint Brushes, Office	11 October 1988	Removed



			Requisites (except Furniture), Instructional and Teaching Material (except Apparatus), Playing Cards, Plastic Material Printing Blocks, All being goods included in Class 16		
3		16	Stickers, Posters, Banners, Paper, Cardboard and Goods made of these materials, Printed Matter including Catalogues, Brochures, Rosters, Pamphlets, Leaflets, Book Binding Material, Photographs, Stationery, Adhesives for Stationery or Household Purposes, Artists' Material, Paint Brushes, Office Requisites (except Furniture), Instructional and Teaching Material (except Apparatus), Playing Cards, Plastic Material Printing Blocks, all being goods included in Class 16	11 October 1988	Abandoned
4		25	Clothing, Footwear, Head-Gear (Head-Wear) and Knit-Wear included in Class 25	11 October 1988	Registered
5		41	Education in relation to baseball; providing of training; entertainment; sporting and cultural activities, education services in relation to baseball; educational information in relation to baseball; organization of educational competitions in relation to baseball, organization of exhibitions for cultural, educational services in relation to baseball; organization of sports competitions; entertainment services; providing sports facilities; entertainment information; Providing information relating to sports;	13 December 2021	Objected



			<p>presentation of live performances, sports camp services, instruction and coaching (training) services; Preparation of entertainment programmes for broadcasting; Organization of live shows; Conducting of live sports events; production and rental of video tapes and DVDs featuring recorded baseball programs; Recording, production and distribution of films, video and audio recordings, radio and television programs; providing on-line electronic publications; Online game services; Providing online newsletters in the fields of sports entertainment.</p>		
6		41	<p>Education; providing of training; entertainment; sporting and cultural activities, education services; educational information; organization of educational competitions, organization of exhibitions for cultural, educational; organization of sports competitions; entertainment services; providing sports facilities; entertainment information; Providing information relating to sports; presentation of live performances, sports camp services, instruction and coaching (training) services; Preparation of entertainment programmes for broadcasting;</p>	13 December 2021	Registered



			Organization of live shows; Conducting of live sports events; production and rental of video tapes and DVDs featuring recorded baseball programs; Recording, production and distribution of films, video and audio recordings, radio and television programs; providing on-line electronic publications; Online game services; Providing online newsletters in the fields of sports entertainment.		
7		25	Clothing, footwear, headgear	8 February 2022	Opposed

(xi) Though the respondent's first 1983 registration of the BLUE JAYS mark, in Class 25, was deemed to have been abandoned on account of non-renewal, the application, by the respondent, for registration of the mark, indicated that the respondent had adopted the BLUE JAYS marks in India prior to the appellants. The respondent continues to use its BLUE JAYS marks till date without interruption across the world, including India.

(xii) Owing to priority in adoption, long, continuous and uninterrupted user and worldwide publicity, the respondent's BLUE JAYS marks are familiar to a large number of consumers and members of the trade in India. There is considerable spillover of the global reputation of the said marks into India. The BLUE JAYS marks, therefore, enjoy trans-border



reputation in India.

(xiii) The respondent's BLUE JAYS mark also, therefore, qualifies as a "well known trade mark" within the meaning of Section 2(1)(zg)<sup>11</sup> read with Section 11(6)<sup>12</sup> of the Trade Marks Act.

(xiv) The word mark BLUE-JAY stood registered in favour of the appellants, in Class 25, for "shirts, pants, trousers, jeans, jackets and readymade garments", *vide* Registration No. 815236, with effect from 19 August 1998.

(xv) Notice of Opposition No. DEL-161698 was filed by the respondent opposing the grant of registration to the world mark BLUE-JAY in favour of the appellants in Class 25, on 3 February 2004. The counter statement to the said notice of opposition was filed by the appellants on 9 November 2004. In its counter statement, the appellants contended that, unlike the

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<sup>11</sup> (zg) "well-known trade mark", in relation to any goods or services, means a mark which has become so to the substantial segment of the public which uses such goods or receives such services that the use of such mark in relation to other goods or services would be likely to be taken as indicating a connection in the course of trade or rendering of services between those goods or services and a person during the mark in relation to the first-mentioned goods or services.

<sup>12</sup> (6) The Registrar shall, while determining whether a trade mark is a well-known trade mark, take into account any fact which he considers relevant for determining a trade mark as a well-known trade mark including—

- (i) the knowledge or recognition of that trade mark in the relevant section of the public including knowledge in India obtained as a result of promotion of the trade mark;
- (ii) the duration, extent and geographical area of any use of that trade mark;
- (iii) the duration, extent and geographical area of any promotion of the trade mark, including advertising or publicity and presentation, at fairs or exhibition of the goods or services to which the trade mark applies;
- (iv) the duration and geographical area of any registration of or any application for registration of that trade mark under this Act to the extent they reflect the use or recognition of the trade mark;
- (v) the record of successful enforcement of the rights in that trade mark, in particular, the extent to which the trade mark has been recognised as a well-known trade mark by any court or Registrar under that record.



respondent who used the BLUE JAYS marks for sport goods, the appellant was using the BLUE-JAY mark for readymade garments, which were distinct and different. Moreover, it was contended that the blue jay was a bird, native to North America and that, therefore, the mark BLUE JAYS lacked distinctiveness and was incapable of distinguishing any goods and was not, therefore, registrable in view of Section 9(1)(a)<sup>13</sup> of the Trade Marks Act.

(xvi) As evidence in support of the notice of opposition could not be filed by the respondent on or before 12 August 2005 when the time to do so expired, the appellants' application proceeded to registration on 8 June 2017.

**6.1.2** In this factual backdrop, the respondent sought removal of the appellants' BLUE-JAY mark from the Register on the following grounds:

(i) The continuance, on the Register of Trade Marks, of the appellants' BLUE-JAY mark, would irreparably damage, tarnish and injure the BLUE JAYS mark, of which the respondent was the prior adopter, user (dating back to 1976) and registrant.

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<sup>13</sup> 9. **Absolute grounds for refusal of registration. –**

(1) The trade marks—

(a) which are devoid of any distinctive character, that is to say, not capable of distinguishing the goods or services of one person from those of another person;

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shall not be registered:

Provided that a trade mark shall not be refused registration if before the date of application for registration it has acquired a distinctive character as a result of the use made of it or is a well-known trade mark.



(ii) The appellants had no proper cause for adopting the BLUE-JAY mark.

(iii) The BLUE JAYS mark of the respondent was coined, fanciful and arbitrary, and was not indicative of the associated goods or services.

(iv) The BLUE JAYS mark had a global reputation, which had also percolated into India much prior to the adoption of the BLUE-JAY mark by the appellants.

(v) The BLUE JAYS mark also had extensive and long use within India itself, *inter alia* because

- (a) the respondent's websites, which prominently displayed and promoted the BLUE JAYS mark, were accessible throughout the world, including India, at least since 1996,
- (b) the respondent was directly using the BLUE JAYS mark in India at least since 1997, since which time the respondent began directly broadcasting MLB games, including games involving the BLUE JAYS club, in India through its official broadcast partners,
- (c) the respondent was subjected to numerous pop-culture references in Hollywood movies and TV shows, prior to August 1998, and
- (d) the respondent's BLUE JAYS mark was regularly cited in various articles published in periodicals with global circulation, and sizeable Indian readership.



(vi) The appellants ought, therefore, to have been aware of the reputation and goodwill of the respondent's BLUE JAYS mark. This was also apparent from the near identity of the two marks.

(vii) The application of the appellants for registration of the BLUE-JAY mark was, therefore, tainted with bad faith. The mark ought not to have been registered in view of Section 11(10)(ii) of the Trade Marks Act.

(viii) As the respondent's BLUE JAYS mark was an earlier mark, the appellants' BLUE-JAY mark ought not to have been registered.

(ix) Concurrent existence of the two marks was likely to result in confusion in the minds of the public, as the marks were nearly identical, and were used for the same goods.

(x) The adoption of the BLUE-JAY mark by the appellants was, therefore, with an intention of passing off their goods as those of the respondent.

(xi) Priority of user trumped registration.

(xii) As the respondent's BLUE JAYS mark was well known, the appellants' mark ought not to have been registered in view of Section 11(10)(i) of the Trade Marks Act.



(xiii) The appellants were not the *bona fide* proprietor of the BLUE-JAY mark. They could not, therefore, have sought registration of the mark, under Section 18(1)<sup>14</sup>.

**6.1.3** To support its claim of trans-border reputation of the BLUE JAYS mark having percolated into India, the respondent filed, with the petition,

- (i) various news articles, as Documents 6, 7, 10 and 25,
- (ii) screen shots evidencing online sale of merchandise carrying the respondent's BLUE JAYS mark, as Document 13, as well as websites evidencing their availability for sale in India, as Document 16,
- (iii) printouts of the web pages of the MLB franchise, *inter alia* featuring the respondent's BLUE JAYS mark, as Documents 14 and 15,
- (iv) screenshots from broadcasts of MLB games featuring the respondent's BLUE JAYS mark, as Document 17,
- (v) documents relating to the "Million Dollar Arm" contest conducted by the MLB, in which two Indians made their debut, which was also covered in a Disney motion picture titled "Million Dollar Arm", as Document 22,
- (vi) documents evidencing that Fox Sports Asia, VEQTA and Facebook were the international broadcasters for MLB Baseball games in India, as Document 23, and

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<sup>14</sup> **18. Application for registration. –**

(1) Any person claiming to be the proprietor of a trade mark used or proposed to be used by him, who is desirous of registering it, shall apply in writing to the Registrar in the prescribed manner for the registration of his trade mark.



(vii) online articles in well-known Indian periodicals and newspapers covering the opening of the respondent's office in India in July 2019, as Document 28.

#### **6.2 Stand of the appellants, as the respondents in CO (Comm IPD-TM) 279/2023**

In response, the appellants, as the respondents before the learned Single Judge, contended thus:

- (i) The evidence placed on record by the respondent at best manifested use of the BLUE JAYS mark in the US and Canada. There was no evidence of use of the mark in India.
- (ii) There was no evidence of any trans-border reputation of the BLUE JAYS mark in India, or spillover, into India, of the reputation of the mark overseas. The respondent had placed only one invoice on record, in the form of Document 16, of someone ordering their product in Delhi.
- (iii) Presence of the respondents on social media platforms is no evidence of goodwill or reputation, in the absence of actual use of the respondent's mark.
- (iv) The respondent had not placed, on record, any evidence which was specific to India.
- (v) The respondent has no offices, stores or operations in India.



(vi) In the absence of any evidence of use, promotion or recognition of the respondent's BLUE JAYS mark in India, the mark could not qualify as a well-known trade mark within the meaning of Section 2(1)(zg) or 11(6) of the Trade Marks Act.

(vii) Baseball is not a popular sport in India.

(viii) The respondent had not renewed its applications for registration of the trademark BLUE JAYS. Moreover, the applications were filed on "proposed to be used" basis. The respondent did not have any valid registration under Class 25.

(ix) As against this, the appellants were the holders of a valid registration for the mark BLUE-JAY in Class 25 since 1998. Moreover, the registration was specific to ready-made garments, which were unrelated to the respondent's activities.

The appellants prayed, therefore, that the Section 57 petition be dismissed.

### **The Impugned Judgment**

7. In the impugned judgment, the learned Single Judge has proceeded to analyse the issues involved, and return his findings thereon, as under:

(i) Where cancellation of a registered trade mark was sought



on the basis of an identical or similar trade mark, and both marks related to similar goods or services falling within the same class, the adoption of the marks was of vital importance. Therefore, the fact that the Respondents had first applied for registration of the mark BLUE JAYS, albeit on proposed to be used basis in Class 25, only to give it up, and that the appellants had subsequently applied for registering the mark BLUE-JAY in Class 25, had to be considered.

(ii) The appellants had provided contradictory reasons for adopting the mark BLUE-JAY. In their counter-statement filed before the Trade Marks Registry, it was stated that the mark BLUE-JAY had been adopted from the name of a common bird of North America. As against this, in their reply to the Section 57 petition of the respondent, before the learned Single Judge, the appellants contended that their father, who was an employee of the Punjab National Bank, Sonipat, used to visit the Blue Jay Tourist Resort in Panipat for having meals and that he had suggested the use of the name BLUE-JAY, which was also the name of a famous bird of North America. Thus, the appellants had, before the learned Single Judge, concocted an entirely new explanation for adopting the mark BLUE-JAY. This contradiction raised a credible doubt in the mind of the Court as to the reliability of the adoption of the mark BLUE-JAY by the appellants. It reflected the appellants' *mala fides* and dishonest intention to appropriate and ride on the worldwide reputation and goodwill of the respondents BLUE JAYS mark. The adoption was, therefore, "shrouded under a dark cloud of



suspicion". No other valid reason or justification, for adopting the BLUE-JAY mark, had been provided by the appellants.

(iii) The rival marks were nearly identical.

(iv) The appellants did not seek to contend that, when they adopted the mark BLUE-JAY, they were unaware of the respondent's BLUE JAYS mark. In view of the fact that the respondent had applied for registration of the BLUE JAYS mark much before the appellants, it was highly unlikely that the appellants were unaware of the respondent's mark at the time when they applied for registration of their BLUE-JAY mark.

(v) On the aspect of trans-border reputation of the respondent's BLUE JAYS mark, the learned Single Judge has held, in para 26 of the impugned judgment, thus:

“26. In any event, the petitioner's trademark 'BLUE JAYS' has a worldwide presence since its adoption in the year 1976. The same is used/ consistently depicted on the uniform of the MLB franchise/ Club for the city of Toronto as well as on goods and services associated with the Club, thereby acquiring a substantial, irrefutable, and insurmountable reputation and goodwill globally. The petitioner was/ is also the holder of the trademark 'BLUE JAYS' in India under various Class(s), a few of which were applied well before the respondent nos.1 and 2 applied for registration of the impugned mark. Moreover, the petitioner has placed sufficient material like the presence of 'BLUE JAYS' marks on its websites, which are accessible in India since the year 1996, proof of its products under the 'BLUE JAYS' marks being available in India since the year 1996 and the broadcasting of the MLB matches in India at least since the year 1997. The same are sufficient for the petitioner to have established 'use', which need not be actual/ physical, in India.”



(vi) The rights of a prior user were superior to the right of a subsequent user, even if the subsequent user was the proprietor of a registered trade mark. Reliance has been placed, to sustain this finding, on the judgment of the Supreme Court in *Neon Laboratories Ltd v. Medical Technologies Ltd*<sup>15</sup>.

(vii) Further, the determinative test for establishing prior user was identifying who was the first to adopt and use the mark in the world market, as held by the decisions in *Innovolt Inc. v. Kevin Power Solutions Ltd*<sup>16</sup> and *Icrave LLC v. Icrave Design Pvt Ltd*<sup>17</sup>, both rendered by learned Single Judges of this Court. Admittedly, the appellants had adopted the mark BLUE-JAY only in 1998, 22 years after adoption of the mark BLUE JAYS by the respondent.

(viii) Following these observations, the learned Single Judge has, in para 31 of the impugned judgment, observed and held as under:

“31. In the light of the aforesaid, particularly, considering the dark clouds shrouded over the adoption of the impugned mark 'BLUE-JAY' by the respondent nos.1 and 2, its close resemblance with the petitioner's trademark 'BLUE JAYS', and its suspicious usage for the garments covered in Class 25 collectively establishes that the adoption thereof was not bona fide but was rather tainted with dishonest intention to ride upon the goodwill and reputation of the petitioner. When the element of 'bad faith' in adoption is so evident, the petitioner is entitled to the benefit of Section 11(10)(ii) of the TM Act as it mandates the Registrar of Trade Marks to take the same into account,

<sup>15</sup> (2016) 2 SCC 672

<sup>16</sup> 2015 SCC OnLine Del 13730

<sup>17</sup> 2013 (1) RAJ 618 (Del)



more so, if it is affecting the rights of a party relating to a trademark.”

Apropos the contours of the expression “bad faith”, as contained in Section 11(10)(ii), the learned Single Judge has relied on the judgement of one of us (C. Hari Shankar J), sitting singly, in ***BPI Sports LLC v. Saurabh Gulati***<sup>18</sup>.

**8.** Following the above findings, the impugned judgment concludes thus:

“34. Thus, based on the pleadings and documents on record, the petitioner has filed documents worthy of credence but on the other hand there is/ are ' no document(s) ' in support of the adoption of the impugned mark by the respondent nos.1 and 2, particularly since they themselves have claimed user after 22 years of the petitioner's trademark. The aforesaid, are thus sufficient for this Court to conclude that the petitioner is the undisputed ' prior user ' of the trademark 'BLUE JAYS'.

35. Accordingly, being the ' prior adopter ' and ' prior user ' of the trademark 'BLUE JAYS', the petitioner certainly has a better/superior right over the respondent nos.1 and 2, who, in any event, have come with half-baked truth with hardly any supporting document(s) qua its adoption. In light of the above, the respondent nos.1 and 2 cannot claim any benefit of its subsequent use. In view of the aforesaid, the petitioner has made out a *prima facie* case for cancellation of the impugned mark under Section 57 of the TM Act. Under the existing factual scenario, the facts that the petitioner has no valid and subsisting registration for the trademark 'BLUE JAYS' in Class 25 in India since it had abandoned the same and that the application for registration was filed on a ' proposed to be used ' basis, or that the respondent no.1 after applying for the impugned mark 'BLUE-JAY' by claiming usage after applying also in Class 25 has subsequently obtained registration are meaningless, in fact, of no relevance. In any event, though the application for registration of the trademark 'BLUE JAYS' in Class 25 was filed on a ' proposed to be used ' basis by the petitioner, however, as held in *Trustees of Princeton University (supra)* the actual usage, if any, prior in point of time can be established by sufficient/ ample evidence. As held hereinabove, the petitioner has been able to

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<sup>18</sup> 2023 SCC OnLine Del 2424



show sufficient proof thereof.

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37. Accordingly, the case set up/ defenses raised by the respondents herein and/ or reliance upon Toyota (supra) is of no assistance.

**Conclusion:**

38. In view of the foregoing analysis, this Court finds merit in the case/ submissions of the petitioner and is satisfied that the petitioner has been able to make out a case for cancellation of the trademark 'BLUE-JAY' registered in favour of the respondent nos.1 and 2 vide trademark application no.815236 in Class 25 . Accordingly, the Registrar of Trade Marks is directed to cancel and remove the registration of the impugned mark 'BLUE-JAY' registered vide application no.815236 in Class 25 from the Register of Trade Marks.”

**Rival Submissions before us**

**9. Submissions of Mr. Chander M. Lall, learned Senior Counsel for the appellants**

**9.1** Mr. Lall submits that the appellants' registration of the BLUE-JAY trade mark dates back to 19 August 1988 and that the appellants have placed on record sale agreements, invoices and advertisements evidencing use of the mark by them with effect from 2002, which is much prior to the alleged rights being claimed by the respondent in the BLUE JAYS marks in India. It is also pointed out that the appellants' BLUE-JAY mark proceeded to registration only after the respondent had abandoned its objection against the application filed by the appellants for registration of the mark. It is also pointed out that, till date, the respondent has not filed any suit alleging infringement or passing off against the appellants, or sought any injunction against the use by the appellants, restraining use, by them, of the BLUE-JAY



mark.

**9.2** Mr. Lall further submits that there is no evidence worth the name, placed by the respondent on record, to indicate that the BLUE JAYS mark of the respondent enjoyed any trans-border reputation in India. There is no document or evidence indicating any presence, in India, of the BLUE JAYS mark of the respondent, prior to adoption and use of the BLUE-JAY mark by the appellants. The trade mark applications for registration of the BLUE JAYS mark, filed by the respondent in 1983 and 1988 were on “proposed to be used” basis, and were abandoned by the respondent itself in 1990 and 1995.

**9.3** Mr. Lall further re-emphasises that there is no evidence of use by the respondent of the BLUE JAYS mark for Class 25 goods in India. Jerseys and merchandise of the respondent, or of the TBJ Club, may be sold in baseball playing countries. Baseball, however, is not a popular sport in India and there are no stores selling TBJ merchandise in India.

**9.4** In fact, submits, Mr. Lall, that there is no evidence of the respondent having dealt in readymade garments using any mark at any point, anywhere in the world.

**9.5** Mr. Lall once again submits that the respondent has not shown the existence of any goodwill or reputation of the BLUE JAYS mark in India. In the absence of any such goodwill or reputation, there was obviously no reason for the appellants to piggyback on the reputation of the respondent, or to adopt a mark which was similar to the BLUE



JAYS mark of the respondent which, at the end of the day, is merely a mark used by a Canadian Baseball Team.

**9.6** In this context, it is also pointed out that, of the 30 teams forming the MLB, the only team outside the US is TBJ, located in Canada.

**9.7** Mr. Lall submits that, in order to succeed in a claim of passing off, the respondent would have to succeed in demonstrating goodwill and reputation of the BLUE JAYS mark in India prior to August 1998. There is no evidence of any such goodwill or reputation prior to August 1998 or even till today. Mr. Lall points out that the only surviving class 25 application of the respondent is for the device mark



**9.8** Mr. Lall has also sought to debunk, document by document, the claim of the respondent that it enjoyed trans-border reputation of the BLUE JAYS mark in India. We would advert to these submissions in our findings which follow hereinafter.

**9.9** Mr. Lall submits finally that the learned Single Judge has proceeded entirely on the basis of bad faith adoption, by invoking Section 11(10)(ii) of the Trade Marks Act. He submits that the material cited by the learned Single Judge does not in any way make out a case of bad faith adoption, by the appellants, of the BLUE-JAY mark. In the absence of any trans-border goodwill or reputation of the



respondent's BLUE JAYS mark in India, he submits that there was no reason why the appellants would surreptitiously seek to adopt a similar mark. Moreover, he submits that the respondent itself having abandoned its applications for registration of the BLUE JAYS mark in India even prior to the adoption of the BLUE JAY mark by the appellants, the said adoption of the BLUE-JAY mark by the appellants could not be said to be tainted with bad faith.

#### **10. Submissions of Mr. Urfee Roomi for the respondent**

Mr. Urfee Roomi, responding to Mr. Lall's submissions, adopts the reasoning contained in the impugned judgment of the learned Single Judge. He seeks to point out that the learned Single Judge has, for cogent and convincing reasons, found the adoption of the BLUE-JAY mark by the appellants to be tainted with bad faith, and that no occasion arises for this Court to interfere with the said findings in appeal. He further submits that there was clear and convincing evidence to indicate the existence of trans-border goodwill and reputation of the respondent's BLUE JAYS mark in India. The finding of the learned Single Judge that the appellants were aware of the said mark while adopting the BLUE-JAY mark in 1998, he submits, is unexceptionable, and, even on this sole ground, the decision of the learned Single Judge to remove the BLUE-JAY mark of the appellants from the register of Trade Marks deserves to be upheld.



## Analysis

### **11. Provisions which are required to be considered**

**11.1** The respondent sought to contend, both before the learned Single Judge as well as before us, that its BLUE JAYS mark was an “earlier trade mark” for the purposes of Section 11(1) and 11(2) of the Trade Marks Act and that, as the appellants’ BLUE-JAY mark was deceptively similar thereto, and used for identical goods, the mark should not have proceeded to registration.

**11.2** We are unable to agree.

**11.3** The proscription against registration of a mark, which is identical with or similar to an earlier trade mark, as contained in Sections 11(1) and 11(2) of the Trade Marks Act, applies at the stage of registration. It has, therefore, to be seen, whether, on the date when the appellants’ mark was registered, the respondent’s BLUE JAYS mark was as an “earlier trade mark”.

**11.4** The expression “earlier trade mark”, for the purposes of Sections 11(1) and 11(2) stands defined in the Explanation below Section 11(4). A mark would qualify as an “earlier trade mark” plainly said, if (i) it was a prior registered trade mark, or (ii) an application for registration of the trade mark was pending before the Registrar, or (iii) it was a well known trade mark on the date of application for registration of the latter mark.



**11.5** Quite clearly, the respondent's BLUE JAYS mark does not fall in any of these categories.

**11.6** The applications for registration of the BLUE JAYS mark, filed in 1983 and 1988, already stood abandoned in 1990 and 1995, prior to the application by the appellants for registration of the BLUE-JAY mark in 1998. There was, therefore, no prior registration of the respondent's BLUE JAYS mark on that date. Nor was any application for registration of the respondent's BLUE JAYS mark pending before the Registrar in August 1998.

**11.7** It could not also be said that by 1998, the respondent's BLUE JAYS mark, had achieved the status of a well known mark in India. As we would hold hereinafter, there is no evidence to indicate that, even as on the date of the filing of the Section 57 petition before this Court, the respondent's BLUE JAYS mark qualified as a well known mark. There is no evidence of use of the said mark in India, or of percolation, into India, of the trans-border reputation of the said mark even as on the date of filing of the Section 57 petition, much less as far back as in 1998. It could not, therefore, be said that on 19 August 1998, the respondent's BLUE JAYS mark was a "well known trade mark".

**11.8** In as much as, therefore,

- (i) the respondent's BLUE-JAYS mark was not a registered trade mark,
- (ii) there was no application for registration of the respondent's BLUE JAYS mark pending either on the date of



application, by Appellant 1, for registration of the BLUE-JAY mark, or even till the filing of the Section 57 petition by the respondents before this Court, and

(iii) the respondent's BLUE JAYS mark cannot be treated as a well known trade mark on 19 August 1998, when Appellant 1 had applied for registration of the BLUE-JAY mark, or even on 8 June 2017, when the appellant's BLUE-JAY mark proceeded to registration,

the respondent's BLUE JAYS mark does not qualify as an "earlier trade mark" for the purposes of Sections 11(1) or 11(2) of the Trade Marks Act.

**11.9** We, therefore, have to examine the present controversy only apropos Section 11(3)(a) and 11(10)(ii) of the Trade Marks Act.

## **12. Re. Section 11(3)(a)**

**12.1** The learned Single Judge has cancelled the registration of the appellant's BLUE-JAY mark on the ground that it was adopted in bad faith. He has, thereby, invoked Section 11(10)(ii) of the Trade Marks Act. Nonetheless, as the impugned judgement also returns findings of goodwill and reputation in favour of the respondent's BLUE JAYS mark, and even holds that the respondent had led sufficient evidence to establish "use" of the BLUE JAYS mark in India, we are also examining whether the registration appellant's BLUE-JAY trade mark could be cancelled by invoking Section 11(3)(a).

**12.2** Section 11(3)(a) proscribes registration of a trade mark if its use



is liable to be prevented by any law, in particular the law of passing off.

**12.3** The law of passing off, as applicable to trade marks, prohibits goods of one person from being passed off as goods of another, by adopting a deceptively similar trade mark. It is classically a tort of deceit, in which the tortfeasor seeks to ride on the goodwill and reputation of another, by confusing consumers into believing his goods to be the other's though proof of *mala fides* on the part of the tortfeasor is not indispensable for a passing off action to succeed. The existence of goodwill, in the mark which has been imitated is, therefore, the *sine qua non* of any passing off action. Apart from goodwill, the two other requisites, for any passing off action to succeed, are misrepresentation, by the tortfeasor, and resulting damage to the other.

**12.4** In its comparatively recent decision in *Brihan Karan Sugar Syndicate (P) Ltd v. Yashwantrao Mohite Krushna Sahakari Sakhar Karkhana*<sup>19</sup>, the Supreme Court has approvingly cited the following passages from *Satyam Infoway Ltd v. Siffynet Solutions (P) Ltd*<sup>20</sup>, which identify the ingredients of passing off as a tort:

“13. The next question is, would the principles of trade mark law and in particular those relating to passing off apply? An action for passing off, as the phrase “passing off” itself suggests, is to restrain the defendant from passing off its goods or services to the public as that of the plaintiff's. It is an action not only to preserve the reputation of the plaintiff but also to safeguard the public. The defendant must have sold its goods or offered its services in a manner which has deceived or would be likely to deceive the

<sup>19</sup> (2024) 2 SCC 577

<sup>20</sup> (2004) 6 SCC 145



public into thinking that the defendant's goods or services are the plaintiff's. The action is normally available to the owner of a distinctive trade mark and the person who, if the word or name is an invented one, invents and uses it. If two trade rivals claim to have individually invented the same mark, then the trader who is able to establish prior user will succeed. The question is, as has been aptly put, who gets these first? *It is not essential for the plaintiff to prove long user to establish reputation in a passing off action. It would depend upon the volume of sales and extent of advertisement.*

14. The second element that must be established by a plaintiff in a passing off action is misrepresentation by the defendant to the public. The word "misrepresentation" does not mean that the plaintiff has to prove any mala fide intention on the part of the defendant. Of course, if the misrepresentation is intentional, it might lead to an inference that the reputation of the plaintiff is such that it is worth the defendant's while to cash in on it. An innocent misrepresentation would be relevant only on the question of the ultimate relief which would be granted to the plaintiff [*Cadbury-Schweppes (Pty) Ltd. v. PUB Squash Co. (Pty) Ltd.*<sup>21</sup>; *Erven Warnink Besloten Venootschap v. J. Townend & Sons (Hull) Ltd.*<sup>22</sup>]. What has to be established is the likelihood of confusion in the minds of the public (the word "public" being understood to mean actual or potential customers or users) that the goods or services offered by the defendant are the goods or the services of the plaintiff. In assessing the likelihood of such confusion the courts must allow for the "imperfect recollection of a person of ordinary memory" [*Aristoc Ltd. v. Rysta Ltd.*<sup>23</sup>].

15. The third element of a passing off action is loss or the likelihood of it."

**12.5** Before, however, advertiring to either of these provisions, we are required first to address the findings of the learned Single Judge that there was evidence of use by the respondent of the BLUE JAYS mark in India and that the mark enjoyed goodwill and reputation.

**12.6** Both these findings are essentially contained in para 26 of the

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<sup>21</sup> (1981) 1 WLR 193

<sup>22</sup> (1979) 3 WLR 68 (HL)

<sup>23</sup> 1945 AC 68 (HL)



impugned judgment.

### **12.7 Re. use of the mark BLUE JAYS by the respondent.**

**12.7.1** In the concluding sentence in paragraph 26 of the impugned judgment, the learned Single Judge has held that there was sufficient evidence of established use, by the respondent, of the BLUE JAYS mark in India. From a reading of paragraph 26, however, the basis of this finding is not immediately apparent. In fact, the observations in paragraph 26 of the impugned judgment, which precede the finding of established use, appear more to relate to the aspect of trans-border goodwill and reputation, rather than “use”. It appears to us, in fact, that the impugned judgment has conflated the aspects of “use” and trans-border goodwill and reputation.

**12.7.2** “Use” of a trademark has a definite connotation in the Trade Marks Act. Section 2(2)(b) and (c) of the Trade Marks Act cover, within the meaning of the expression “use” of a mark, (i) use of printed or other visual representations of the mark, (ii) use of the mark upon, or in any physical or in any other relation whatsoever, to goods, or (iii) use of the mark as part of any statement about the availability, provision or performance or services.

**12.7.3** There is no evidence of the respondent’s having used the BLUE JAYS mark, in India, in any of the modes envisaged in the Trade Marks Act. The mere fact that the BLUE JAYS mark figured on websites which are accessible in India, or figured on merchandise which could be purchased in India, cannot amount to use of the mark,



by the respondent, within India. At least, prior to 1998, there is little or no evidence of such use.

### **12.8 Re: trans-border goodwill and reputation**

**12.8.1** The learned Single Judge has, in paragraph 26 of the impugned judgment, observed, firstly, that the respondent's trademark BLUE JAYS has a worldwide presence since its adoption in 1976, and, secondly, that the consistent use of the BLUE JAYS mark on the uniforms of the TBJ club, as well as on goods and services associated with the club, had resulted in the BLUE JAYS mark acquiring "substantial, irrefutable and insurmountable" global goodwill and reputation.

**12.8.2** Acquisition of global goodwill and reputation is entirely irrelevant, while examining an allegation of passing off. It is goodwill and reputation *in India* that matters. The Court has to assess whether the "global" goodwill, assuming it exists, has percolated into India. Before arriving at any finding that the BLUE-JAY mark could be cancelled under Section 11(3)(a), therefore, the Court would have to satisfy itself that respondent's BLUE JAYS mark enjoyed goodwill, not merely globally, but also within India, *before August 1998 when the appellants adopted the BLUE-JAY mark*.

**12.8.3** The impugned judgment does not, in fact, return any specific finding to the effect that the respondent's BLUE JAYS mark enjoyed any goodwill or reputation in India. In paragraph 26, after first observing that the mark had global goodwill and reputation, the



learned Single Judge has proceeded to hold that (i) the applications, by the respondent, for registration of the BLUE JAYS trademark in India prior to adoption of the BLUE-JAY mark by the appellants, (ii) the presence of the respondent's BLUE JAYS mark on its websites which were accessible in India since 1996, (iii) the availability of products bearing the BLUE JAYS mark of the respondent in India since 1996 and (iv) the broadcasting of the MLB matches in India at least since 1997, were sufficient to prove "use", by the respondent, of the BLUE JAYS mark in India prior to 1998.

**12.8.4** We have already found the finding that the respondent was using the BLUE JAYS mark in India prior to 1998 to be unsustainable. We, however, proceed to examine whether the factors noted by the learned Single Judge in paragraph 26 of the impugned judgment, even read cumulatively with the other material on which the respondent sought to rely before the learned Single Judge, as enumerated in para 6.1.3 supra, would make out a case of trans-border reputation of the BLUE JAYS mark in India prior to 19 August 1998.

**12.8.5** The answer, to our mind, has necessarily to be in the negative.

**12.8.6** The law with respect to trans-border reputation and goodwill in a passing off action are the judgments of the Supreme Court in *N.R. Dongre v. Whirlpool Corporation*<sup>24</sup>, *Milmet Oftho Industries v. Allergan Inc.*<sup>25</sup> and *Toyota Jidosha Kabushiki Kaisha v. Prius Auto*

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<sup>24</sup> (1996) 5 SCC 714

<sup>25</sup> (2004) 12 SCC 624



**Industries Ltd.<sup>26</sup>**

### **12.8.7 N.R. Dongre**

In **N.R. Dongre**, the respondent Whirlpool Corporation<sup>27</sup> sued the appellant N R Dongre<sup>28</sup> for having manufactured and sold washing machines under the mark 'WHIRLPOOL', thereby confusing and deceiving buyers into believing that they had been manufactured by Whirlpool. Though Whirlpool was located abroad, and had no subsisting trade mark registration in India, the Supreme Court upheld the decision of this Court to injunct Dongre, as Whirlpool had the requisite trans border reputation which had spilled over into India. This finding was returned on the basis of the following facts:

- (i) Though there was no evidence of actual sales of Whirlpool appliances in India, Whirlpool had been frequently advertised and featured in international magazines having Indian circulation.
- (ii) Whirlpool was trading in its products in several parts of the world and was also sending the products to India in a limited circle.
- (iii) The worldwide reputation of Whirlpool was travelling trans border to India through commercial publicity made in magazines which were available or bought in India, in the strata of society which used washing machines.

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<sup>26</sup> (2018) 2 SCC 1

<sup>27</sup> "Whirlpool" hereinafter

<sup>28</sup> "Dongre" hereinafter



## 12.8.8 Milmet Oftho

**12.8.8.1** In *Milmet Oftho*, the respondent Allergan Inc<sup>29</sup> sued Milmet Oftho Industries<sup>30</sup> for having used the mark 'OCUFLOX' for eye drops, in respect of which Allergan claimed to be the prior owner and user. Allergan had no registration of the mark in India, though it claimed to have several registrations worldwide. Applications, for registration of the mark, filed by Allergan and Milmet were, however, pending with the Indian Trade Marks Registry.

**12.8.8.2** A learned Single Judge of the High Court declined injunction, holding that Allergan was not selling OCUFLOX drops in India, and that Milmet had first introduced the product in this country. An appeal, therefrom, was allowed by the Division Bench, on the premise that Allergan was first in the market.

**12.8.8.3** The Supreme Court, in appeal, upheld the decision of the Division Bench, reasoning thus:

“8. We are in full agreement with what has been laid down by this Court. Whilst considering the possibility of likelihood of deception or confusion, in present times and particularly in the field of medicine, the courts must also keep in mind the fact that nowadays the field of medicine is of an international character. The court has to keep in mind the possibility that with the passage of time, some conflict may occur between the use of the mark by the applicant in India and the user by the overseas company. The court must ensure that public interest is in no way imperilled. Doctors, particularly, eminent doctors, medical practitioners and persons or companies connected with the medical field keep abreast of latest developments in medicine and preparations worldwide. Medical literature is freely available in this country.

<sup>29</sup> “Allergan” hereinafter

<sup>30</sup> “Milmet” hereinafter



*Doctors, medical practitioners and persons connected with the medical field regularly attend medical conferences, symposiums, lectures, etc. It must also be remembered that nowadays goods are widely advertised in newspapers, periodicals, magazines and other media which is available in the country. This results in a product acquiring a worldwide reputation. Thus, if a mark in respect of a drug is associated with the respondents worldwide it would lead to an anomalous situation if an identical mark in respect of a similar drug is allowed to be sold in India. However, one note of caution must be expressed. Multinational corporations, which have no intention of coming to India or introducing their product in India should not be allowed to throttle an Indian company by not permitting it to sell a product in India, if the Indian company has genuinely adopted the mark and developed the product and is first in the market. Thus the ultimate test should be, who is first in the market.*

9. In the present case, the marks are the same. They are in respect of pharmaceutical products. *The mere fact that the respondents have not been using the mark in India would be irrelevant if they were first in the world market.* The Division Bench had relied upon material which *prima facie* shows that the respondents' product was advertised before the appellants entered the field. On the basis of that material the Division Bench has concluded that the respondents were first to adopt the mark. If that be so, then no fault can be found with the conclusion drawn by the Division Bench.”

(Emphasis supplied)

**12.8.8.4** The following three important features of this decision merit mention:

(i) Firstly, it is necessary to note that, even in this case, the Supreme Court upheld the necessity of the existence of trans border reputation which has spilled over into India as a prerequisite for grant of relief. Given the peculiar nature of pharmaceutical products, the Supreme Court held that, by dint of extensive literature and advertisements, with which doctors were necessarily conversant, existence of worldwide reputation could be presumed.



(ii) Secondly, the Supreme Court, even in such a case and with full consciousness of the overwhelming public interest involved, deemed it necessary to enter a cautionary caveat, by holding that “multinational corporations, which have no intention of coming to India or introducing their product in India should not be allowed to throttle an Indian company by not permitting it to sell a product in India, if the Indian company has genuinely adopted the mark and developed the product and is first in the market”.

(iii) Thirdly, the Supreme Court was also obviously influenced by the fact that the rival marks were identical, i.e. OCUFLOX. The case was, therefore, one of clear imitation.

### **12.8.9 *Toyota***

**12.8.9.1** *Toyota* is, perhaps, the most authoritative of the pronouncements on trans border reputation and spillover, in the context of passing off actions.

**12.8.9.2** Toyota Jidosha Kabushiki Kaisha<sup>31</sup> was a manufacturer of automobiles, incorporated in Japan. Toyota instituted a suit against Prius Auto Industries Ltd.,<sup>32</sup> in this Court, alleging infringement and passing off, by Prius, by use of the marks ‘TOYOTA’, ‘TOYOTA INNOVA’, ‘TOYOTA DEVICE’ and ‘PRIUS’. Toyota claimed

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<sup>31</sup> “Toyota” hereinafter

<sup>32</sup> “Prius” hereinafter



priority of user. Interlocutory injunction was granted, by a learned Single Judge of this Court, in favour of Toyota and against Prius, in respect of all these marks. Prius appealed to the Division Bench of this Court only against the injunction granted against use, by it, of the 'PRIUS' mark. The Division Bench allowed Prius' appeal, and set aside the injunction granted in favour of Toyota and against Prius, qua use of the 'PRIUS' mark by the latter. Toyota appealed to the Supreme Court.

**12.8.9.3** Before the learned Single Judge, Prius contended that the mark 'PRIUS' had not been registered in favour of Toyota for any product, and no PRIUS car had been shown to have been sold in India so as to result in creation of any goodwill therein. The product itself not being in existence in India, Prius contended that there was no possibility of Indian customers identifying the defendant's registered 'PRIUS' trade mark with Toyota's products. Prius claimed, in fact, to be the first in the Indian market to manufacture add on accessories.

**12.8.9.4** The learned Single Judge of this Court held that as (i) Toyota was the first in the world market to use the mark 'PRIUS', (ii) the goodwill and reputation of the brand 'PRIUS', given quantum of sales of 'PRIUS' cars and exponential rise thereof, and (iii) the permeation, into India, of the goodwill and reputation of Toyota in the mark 'PRIUS', Toyota was entitled to an injunction as sought. In arriving at the said decision, the learned Single Judge took into account (a) the fact that the plaintiff's websites had been visited by many Indians seeking information about Prius cars, (b) exhibitions of the car held in *India* and other countries, (c) advertisements in



different automobile magazines and cover stories in international magazines and journals, and (d) availability of information regarding the car in information-disseminating portals such as Wikipedia and Britannica. The learned Single Judge relied on *N.R. Dongre* and *Milmet Oftho* to hold that the Court was required to examine who was first in using the mark in the world market. Given the repute that the mark had earned internationally, which, according to the learned Single Judge, had permeated into India, Toyota was held to be entitled to an injunction.

**12.8.9.5** The Division Bench of this Court disagreed with the learned Single Judge. It held that the learned Single Judge had taken into accounts facts pertaining to a period after the date of first use of the impugned PRIUS mark by Prius. The reportage, and advertising, of the launching of the Prius car by Toyota in 1997 was held not to be groundbreaking, and figured as small news items in select papers. The Division Bench held that the Universality doctrine (which posits that a mark signifies the same source the world over) had been replaced with the Territoriality doctrine (which recognized the separate existence of the trade mark in each country). Prior to April 2001, when Prius commenced use of the impugned PRIUS mark in India, internet penetration in the country was held to be limited, and insufficient to justify an inference of establishment, by Toyota, of its goodwill and reputation in India.

**12.8.9.6** The Supreme Court, in its judgment, identified, at the outset, the three ingredients of passing off as goodwill of the plaintiff, misrepresentation by the defendant, and damage suffered by the



plaintiff as a consequence.

**12.8.9.7** Paras 29 to 39 of the report, thereafter, deal with the territoriality doctrine, which applied to trade mark passing off in preference to the universality doctrine. They merit reproduction, *in extenso*, thus:

“29. The view of the courts in UK can be found in the decision of the UK Supreme Court in *Starbucks*<sup>33</sup> wherein Lord Neuberger observed as follows:

“52. *As to what amounts to a sufficient business to amount to goodwill, it seems clear that mere reputation is not enough.... The claimant must show that it has a significant goodwill, in the form of customers, in the jurisdiction, but it is not necessary that the claimant actually has an establishment or office in this country. In order to establish goodwill, the claimant must have customers within the jurisdiction, as opposed to people in the jurisdiction who happen to be customers elsewhere. Thus, where the claimant's business is carried on abroad, it is not enough for a claimant to show that there are people in this jurisdiction who happen to be its customers when they are abroad. However, it could be enough if the claimant could show that there were people in this jurisdiction who, by booking with, or purchasing from, an entity in this country, obtained the right to receive the claimant's service abroad. And, in such a case, the entity need not be a part or branch of the claimant : it can be someone acting for or on behalf of the claimant.*”

30. It seems that in *Starbucks*, the Apex Court of UK had really refined and reiterated an earlier view in *Athletes' Foot Mktg. Associates Inc. v. Cobra Sports Ltd.*<sup>34</sup>, to the following effect:

“... no trader can complain of passing-off as against him in any territory ... in which he has no customers, nobody who is in trade relation with him. This will normally shortly be expressed by stating that he does not carry on any trade in that particular country ... but the inwardness of it will be that he has no customers in that country ...”

<sup>33</sup> *Starbucks (HK) Ltd v. British Sky Broadcasting Group*, (2015) 1 WLR 2628

<sup>34</sup> 1980 RPC 343



31. A passing reference to a similar view of the Federal Court of Australia in *Taco Bell v. Taco Co. of Australia*<sup>35</sup>, may also be made.

32. *Prof. Christopher Wadlow's view on the subject appears to be that the test of whether a foreign claimant may succeed in a passing-off action is whether his business has a goodwill in a particular jurisdiction, which criterion is broader than the "obsolete" test of whether a claimant has a business/place of business in that jurisdiction. If there are customers for the claimant's products in that jurisdiction, then the claimant stands in the same position as a domestic trader.*

33. *The overwhelming judicial and academic opinion all over the globe, therefore, seems to be in favour of the territoriality principle. We do not see why the same should not apply to this country.*

34. To give effect to the territoriality principle, the courts must necessarily have to determine *if there has been a spillover of the reputation and goodwill of the mark used by the claimant who has brought the passing-off action*. In the course of such determination it may be necessary to seek and ascertain the existence of not necessarily a real market but *the presence of the claimant through its mark within a particular territorial jurisdiction in a more subtle form* which can best be manifested by the following illustrations, though they arise from decisions of courts which may not be final in that particular jurisdiction.

35. In *LA Societe Anonyme Des Anciens Etablissements Panhard v. Panhard Levassor Motor Co. Ltd.*<sup>36</sup>, the plaintiffs were French car manufacturers who had consciously decided to not launch their cars in England (apprehending patent infringement). Nevertheless, some individuals had got them imported to England. It was seen that England was one of the plaintiff's markets and thus, in this case, permanent injunction was granted. Similarly in *Grant v. Levitt*<sup>37</sup>, a Liverpool business concern trading as the Globe Furnishing Company, obtained an injunction against the use of the same name in Dublin as it was observed that advertisements by the plaintiff had reached Ireland and there were Irish customers.

36. *C & A Modes v C & A (Waterford) Ltd.*<sup>38</sup>, was a case where the plaintiffs operated a chain of clothes stores throughout

<sup>35</sup> (1981) 60 FLR 60 (Aust)

<sup>36</sup> (1901) 2 Ch 513

<sup>37</sup> (1901) 18 RPC 361

<sup>38</sup> 1976 IR 198 (Irish)



the UK and even in Northern Ireland but not in the Republic of Ireland where the defendants were trading. The Court held that,

“a very substantial and regular custom from the Republic of Ireland was enjoyed by this store. Up to that time an excursion train travelled each Thursday from Dublin to Belfast, and so great was the influx of customers from the Republic as a result of that excursion that the store ordinarily employed extra part-time staff on Thursday on the same basis as it did on Saturday which were normally the busiest shopping days.”

The said view has since been upheld by the Irish Supreme Court.

37. Whether the second principle evolved under the trinity test i.e. triple identity test laid down in *Reckitt & Colman Products Ltd. v Borden Inc*<sup>39</sup>. would stand established on the test of likelihood of confusion or real/actual confusion is another question that seems to have arisen in the present case as the Division Bench of the High Court has taken the view that the first test i.e. likelihood of confusion is required to be satisfied only in *quia timet* actions and actual confusion will have to be proved when the suit or claim is being adjudicated finally as by then a considerable period of time following the initiation of the action of passing-off might have elapsed. Once the claimant who has brought the action of passing-off establishes his goodwill in the jurisdiction in which he claims that the defendants are trying to pass off their goods under the brand name of the claimant's goods, the burden of establishing actual confusion as distinguished from possibility thereof ought not to be fastened on the claimant. *The possibility or likelihood of confusion is capable of being demonstrated with reference to the particulars of the mark or marks, as may be, and the circumstances surrounding the manner of sale/marketing of the goods by the defendants and such other relevant facts.* Proof of actual confusion, on the other hand, would require the claimant to bring before the Court evidence which may not be easily forthcoming and directly available to the claimant. In a given situation, there may be no complaints made to the claimant that goods marketed by the defendants under the impugned mark had been inadvertently purchased as that of the plaintiff claimant. The onus of bringing such proof, as an invariable requirement, would be to cast on the claimant an onerous burden which may not be justified. Commercial and business morality which is the foundation of the law of passing-off should not be allowed to be defeated by imposing such a requirement. In such a situation, likelihood of confusion would be a surer and better test of proving

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<sup>39</sup> (1990) 1 WLR 491



an action of passing-off by the defendants. Such a test would also be consistent with commercial and business morality which the law of passing-off seeks to achieve. In the last resort, therefore, it is preponderance of probabilities that must be left to judge the claim.

38. The next exercise would now be the application of the above principles to the facts of the present case for determination of the correctness of either of the views arrived at in the two-tier adjudication performed by the High Court of Delhi. *Indeed, the trade mark "Prius" had undoubtedly acquired a great deal of goodwill in several other jurisdictions in the world and that too much earlier to the use and registration of the same by the defendants in India. But if the territoriality principle is to govern the matter, and we have already held it should, there must be adequate evidence to show that the plaintiff had acquired a substantial goodwill for its car under the brand name "Prius" in the Indian market also. The car itself was introduced in the Indian market in the year 2009-2010. The advertisements in automobile magazines, international business magazines; availability of data in information-disseminating portals like Wikipedia and online Britannica Dictionary and the information on the internet, even if accepted, will not be a safe basis to hold the existence of the necessary goodwill and reputation of the product in the Indian market at the relevant point of time, particularly having regard to the limited online exposure at that point of time i.e. in the year 2001. The news items relating to the launching of the product in Japan isolatedly and singularly in The Economic Times (issues dated 27-3-1997 and 15-12-1997) also do not firmly establish the acquisition and existence of goodwill and reputation of the brand name in the Indian market. Coupled with the above, the evidence of the plaintiff's witnesses themselves would be suggestive of a very limited sale of the product in the Indian market and virtually the absence of any advertisement of the product in India prior to April 2001. This, in turn, would show either lack of goodwill in the domestic market or lack of knowledge and information of the product amongst a significant section of the Indian population. While it may be correct that the population to whom such knowledge or information of the product should be available would be the section of the public dealing with the product as distinguished from the general population, even proof of such knowledge and information within the limited segment of the population is not prominent.*

39. *All these should lead to us to eventually agree with the conclusion of the Division Bench of the High Court that the brand name of the car Prius had not acquired the degree of goodwill, reputation and the market or popularity in the Indian market so as*



*to vest in the plaintiff the necessary attributes of the right of a prior user so as to successfully maintain an action of passing-off even against the registered owner. In any event the core of the controversy between the parties is really one of appreciation of the evidence of the parties; an exercise that this Court would not undoubtedly repeat unless the view taken by the previous forum is wholly and palpably unacceptable which does not appear to be so in the present premises.”*

(Italics and underscoring supplied)

**12.8.9.8** *Toyota* is a defining authority on the evidence which can, or cannot, make out a case of trans border reputation and goodwill.

**12.8.9.9** *Toyota*, thus, holds that facts such as (i) the accessibility of Toyota's websites in India, (ii) several visits to Toyota's websites by many Indians seeking information about Prius' products, (iii) exhibitions of the Prius product in India and other countries, (iv) advertisements and cover stories in magazines and availability of information regarding the “Prius” mark and products in various internet portals, even seen cumulatively, did not make out a case of trans border reputation and goodwill.

**12.8.10** In paragraph 26 of the impugned judgment, however, the learned Single Judge has practically relied on identical, or even lesser, material, to hold that use of the BLUE JAYS mark in India by the respondent, prior to August 1998, stood established.

**12.8.11** Before advertiring, now, to the individual elements cited by the respondent, to support its stand that the BLUE JAYS mark enjoyed trans border reputation and goodwill in India, we have to bear certain basic principles in mind.



**12.8.12** Firstly, there is no presumption that a mark, howsoever wide or global its reputation might otherwise be, has trans border reputation in India. Trans border reputation in India has to be positively proved. This is especially shown in the case of marks which may be associated with activities which are not popular or well known in India. Invoking this principle, the appellants have sought to contend that baseball, as a sport, is not followed in India by any substantial part of the populace. The respondent's BLUE JAYS mark is exclusively associated with the TBJ Club, which is a baseball Club located in Canada. Mr. Lall submits that the mark might, therefore, have considerable goodwill and reputation in Canada, perhaps in the US and, perhaps, also in other countries which play baseball or where baseball is a popular sport. In a country like India, where baseball is not played and is hardly followed, it is contended by the appellants that the mark of the TBJ Club cannot be said to have any goodwill or reputation. Baseball, in India, is not cricket.

**12.9** Secondly, the availability of a mark on websites can again be no indicator of trans-border goodwill or reputation percolating into a particular country such as India. Websites are globally accessible. If the principle that accessibility of a mark on a website is to be treated as an indicator of trans-border reputation, every mark of every entity would have trans border reputation in every country in the world. It is not enough, therefore, to aver that a particular mark is available on a website which is accessible within India, to substantiate a contention that the mark enjoys trans-border reputation in India. Positive assertions regarding the number of times the websites has been



accessed in India would have also to be pleaded.

**12.10** Similarly, the availability of goods bearing a particular mark, for sale on websites, whether they belong to the owner of the mark or are e-commerce websites, can also be no evidence of percolation of the reputation of the mark into India. As in the case of websites in general, e-commerce websites may be accessible within India, even if they are not hosted from within the country. Similarly, there is no necessity that every product which is available on an e-commerce website commands reputation or goodwill within India. Mere availability of products bearing a mark for sale on an e-commerce website, or on the website of the owner of the mark, would not, however, suffice as proof of trans-border goodwill or reputation. It would further have to be shown that orders were actually placed or purchases effected, to a considerable extent, of the goods bearing the mark, from within India.

**12.11** The same principle applies to publication of marks in periodicals, magazines, etc. With the proliferation of the internet, most magazines, periodicals and the like are now available globally. Every mark which figures in such magazines or periodicals cannot, therefore, be said to have trans-border reputation within India. There would have to be positive assertions regarding the readership or subscription of such magazines among Indians. Besides, such assertions cannot be merely in the nature of bald statements, but would also have to be supported by disclosure of the material on which the assertion is made, even if positive evidence in that regard may be deferred to the stage of trial. In the case of newspapers or



periodicals, empirical material should also be forthcoming that the newspapers or periodicals are widely circulated in the country. Offices of professionals often stock magazines, to occupy the time of those who are awaiting an appointment. The mere fact that some of them may be sports magazines does not *ipso facto* indicate that every sport, with reference to which an article may be contained in the magazines, has goodwill or reputation.

**12.12** Goodwill and reputation, it has to be remembered, is a two-way street. One cannot claim to have goodwill and reputation, unless others feel the same. Thumping one's own chest, and claiming to be famous, is mere false hope, and nothing more. Goodwill and reputation are positive attributes, relative to others. The purpose of requiring establishment of goodwill and reputation, in passing off actions, has to be remembered. They are not empty incantations. Passing off, in its very essence, involves misleading the consumer public into believing one's goods or services, to be those of another. If the other has no goodwill or reputation, the very *raison d' etre* of alleging passing off fails. Why would one pass off one's goods as those of another, if the other has no goodwill or reputation? Ergo, questions Mr. Lall, "Why on earth would my client adopt a mark which belongs to a baseball club based out of Canada?"

**12.13** The submission has weight, and merit.

**12.14** We have to examine the issue of whether the material, on which the respondent has placed reliance to make out a case of trans border reputation does, or does not, do so, keeping in mind the above



principles.

**12.15** Additionally, the Court is also to keep in mind the fact that the appellants had applied for registration of the BLUE-JAY mark on 19 August 1998. Existence of sufficient goodwill or reputation in the respondent's BLUE JAYS mark would, therefore, have to be established as on 19 August 1998, in order to sustain a case of passing off. This follows from the judgment in *Toyota*, in which the Supreme Court has clearly held that a plaintiff can succeed in a claim of passing off against the defendant only if the plaintiff can establish the existence of sufficient goodwill or reputation in its mark *prior to the adoption of the mark by the defendant*. Material which pertains to any period after 19 August 1998 is, therefore, of no relevance in assessing the existence of goodwill or reputation, in India, of the respondent's BLUE JAYS mark in the present case and cannot, therefore, constitute a basis to strike the appellants' BLUE-JAY mark off the register in exercise of the power conferred by Section 11(3)(a) of the Trade Marks Act.

**12.16** Thus viewed, there is no material, whatsoever, which can indicate the existence of *any – much less substantial – goodwill or reputation* of the BLUE JAYS mark in India, before August 1998.

**12.17** The observations and findings of the learned Single Judge in para 26 of the impugned judgment are clearly contrary to the extant legal position. The learned Single Judge has returned positive findings of goodwill, in favour of the BLUE JAYS mark of the respondent, on the ground that (i) the mark is “used/consistently depicted on the



uniform of the MLB franchise/Club for the city of Toronto as well as on goods and services associated with the Club”, (ii) the mark had, thereby, acquired a “substantial, irrefutable and insurmountable reputation and goodwill *globally*, (iii) the respondent was the “holder of the trademark ‘BLUE JAYS’ in India under various Class(s), a few of which were applied well before the respondent nos. 1 and 2 applied for registration of the impugned mark”, (iv) the respondent had placed “sufficient material like (a) the presence of ‘BLUE JAYS’ mark on its websites, which are accessible in India since the year 1996, (b) proof of its products under the ‘BLUE JAYS’ marks being available in India since the year 1996 and (c) broadcasting of the MLB matches in India since the year 1997”.

**12.18** We are unable to sustain these findings.

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

**12.20** In fact, in the rejoinder filed before the learned Single Judge, the respondent has admitted that “*at least till 1995*”, the respondent



owned one or more valid registration of the BLUE JAYS marks. It is undisputed that, on 19 August 1998, when Appellant 1 applied for registration of the BLUE-JAY mark – which the impugned judgment has removed from the Register – *there was no valid registration, held by the respondent, of any BLUE JAYS mark, in word or device form.*

**12.21** Secondly, acquisition of *global* reputation is irrelevant, unless said reputation has percolated into India.

**12.22** Thirdly, merely *accessibility* of websites, on which the respondent's mark figured, or *availability* of merchandise bearing the said mark for sale in India, would not make out even a *prima facie* case of goodwill or reputation. No reference is made to any transaction of sale and purchase – except one solitary invoice. Significantly, the respondent does not seek to contend that goods or merchandise, bearing the BLUE JAYS mark, was physically available for sale anywhere in India, or that there is any franchisee, or any brick and mortar store, which sells the said products.

**12.23** The documents on which the respondent places reliance, to make out a case of goodwill and reputation, too, do not advance its case. To wit,

- (i) Document 12, as filed by the respondent, relates to articles and photographs available in the Sports Illustrated magazine of 2 November 1999. It cannot, therefore, constitute a basis to plead existence of goodwill or reputation, of the respondent's BLUE JAYS mark prior to 19 August 1998.



(ii) Document 25 contains printouts of news and media reports, around the world, featuring the respondent's BLUE JAYS mark. The only periodicals cited in these documents are the New York Times and the Baltimore Sun. There is no material to indicate that these periodicals had any circulation in India, at any point of time, much less prior to August 1998.

(iii) Document 27 refers to an article which adverts to the BLUE JAYS Club. However, the article itself is from a magazine which was launched only in 2016.

(iv) Document 27 further adverts to references of the BLUE JAYS Club in the "Friends" sitcom. This, again, is irrelevant as the "Friends" sitcom was first aired, in India, in 1999.

(v) Document 23 contains printouts from the Wayback Machine site, and the respondent's website, evidencing international broadcasts of MLB games in India. Mere reference, in news articles, of broadcast of MLB games in India, cannot constitute a basis for asserting trans-border reputation. There is no reference, in the petition, to the viewership of such games within India. Moreover, as the appellants point out, the screen shots do not refer to the TBJ Club but only to baseball in general. *It has to be remembered that the respondent is required to establish the existence of goodwill and reputation, not in baseball as a sport, but in the BLUE JAYS trade mark.*



(vi) Document 26 contains screen shots from the respondent websites between 1996 and 1997 showing use of the respondent BLUE JAYS mark and availability of products bearing the respondent's BLUE JAYS mark online. As we have already noted, mere accessibility to websites is no proof of trans-border reputation. Equally, mere availability of goods online is also no evidence in that regard unless there is positive material relating to sale and purchase of the said goods, to a substantial extent. No such material is forthcoming.

(vii) Similarly, Document 29 refers to excerpts from the respondent's website, indicating that the respondent's goods bearing the BLUE JAYS mark are available for purchase in India. In the absence of any material indicating actual sale or purchase, or at least interest, in the Indian consuming public, to purchase such goods, the mere availability of goods online cannot constitute positive material to indicate trans-border reputation.

(viii) Document 13 refers to excerpts from the respondent's website showing sale of licensed goods bearing the respondent's BLUE JAYS mark. There is no evidence that any such sale took place in India or that any consumer from India purchased the products. The petition does not make any reference to any person or outlet in India which is licensed to sell goods bearing the respondent BLUE JAYS mark.



(ix) Document 16 again contains printouts of the respondent websites evidencing availability of MLB products in India, and invoices showing shipping of MLB licensed products by the respondent to India. None of this material pertains to the period prior to August 1998 and is, therefore, of no significance.

**12.24** Given the principles relating to trans-border reputation elucidated earlier in this judgment, and the law as it emerges from the decision in *Toyota*, it is clear that the material cited by the respondent in its petition does not make out any case of trans border reputation of the BLUE JAYS mark, in India. There is, in any case, certainly no material to indicate that the BLUE JAYS mark enjoyed trans-border goodwill and reputation in India prior to 19 August 1998.

**12.25** In the absence of any evidence of trans-border goodwill or reputation of the respondent's mark in India prior to 19 August 1998, it is clear that no case of passing off, by the appellants of its products or services as those of the respondent, by using the BLUE-JAY mark can be said to exist.

**12.26** Resultantly, no case for removal of the appellants' BLUE-JAY mark from the register of Trade Marks under Section 11(3)(a) of the Trade Marks Act is made out.

### **13. Re: Section 11(10)(ii) – bad faith adoption**

**13.1** We now proceed to address the issue of bad faith adoption. Indeed, the learned Single Judge has primarily directed removal from



the register of Trade Marks, of the appellants' BLUE-JAY mark on the ground that its adoption was tainted with bad faith.

**13.2** We are of the considered opinion that the material on which the learned Single Judge has arrived at a conclusion of bad faith adoption on the part of the appellants of the BLUE-JAY mark is entirely inadequate for the said purpose.

**13.3** The learned Single Judge has repeatedly adverted to the appellants' BLUE-JAY mark as "shrouded under a dark cloud of suspicion". To our mind, even if this finding were to be treated as justifiable, it would not make out a case of bad faith adoption. No amount of suspicion make out a case of bad faith, which has to be definitively established in order for a mark to be removable from the register in terms of Section 11(10)(ii) of the Trade Marks Act.

**13.4** One of us (C. Hari Shankar, J.), sitting singly, has, in ***BPI Sports***, considered the ambit of the expression "bad faith" as employed in Section 11(10)(ii) and held in that regard as under:

"47. "Bad faith" is not defined in the Trade Marks Act. Courts have, however, cogitated on the concept, in the context of trade mark law. The Court of Appeals of England and Wales, in ***Harrison v. Teton Valley Trading Co. Ltd.***<sup>40</sup>, observed thus:

"29. In ***Surene Pty. Ltd. v. Multiple Marketing Ltd.***<sup>41</sup> C000479899/1, the proprietor, multiple marketing, distributed the applicant for revocation's products under the trade mark BE NATURAL. The cancellation division held that the application had been made in bad faith. It said:

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<sup>40</sup> (2004) 1 WLR 2577

<sup>41</sup> C000479899/1



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

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

30. In the *Senso Di Donna Trade Mark case*<sup>42</sup>, the first cancellation division said:

"17. Bad faith is a narrow legal concept in the CTMR system. Bad faith is the opposite of good faith, generally implying or involving, but not limited to actual or constructive fraud, or a design to mislead or deceive another, or any other sinister motive. Conceptually, bad faith can be understood as a 'dishonest intention'. This means that bad faith may be interpreted as unfair practices involving lack of any honest intention on the part of the applicant of the CTM at the time of filing.

Example: if it can be shown that the parties concerned had been in contact, for instance at an exhibition in the respective trade, and where then one party filed an application for a CTM consisting of the other party's brand, there would be reason to conclude bad faith. In this case, however, according to the meaning of the term 'bad faith', there is no evidence that Senso di Donna Vertriebes-GmbH was acting dishonestly or that they intended any

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<sup>42</sup> C0006716979/1 2001 ETMR 5



similar act, or were involved in unfair practices or the like.”

31. To similar effect was the decision in *Lancôme Parfums et Beauté and Cie's Trade Mark case*<sup>43</sup>.”

**13.5** Lindsay J held thus, in *Gromas Plasticulture Ltd v. Don & Low Nonwovens Ltd*<sup>44</sup>, on “bad faith”:

“Plainly it include dishonesty, as I would add. It includes also some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined.”

**13.6** It has to be remembered that bad faith, in order to constitute a basis to remove of mark from the register of Trade Marks has to be found to exist at the time when the applicant applied for registration of the mark. This is because bad faith must reside in the applicant who applies for registration of the mark and not in any other person. Section 11(10)(ii) envisages the taking into consideration, by the Registrar, of bad faith involved “either of the applicant or the opponent” affecting the rights relating to the trade mark.

**13.7** The applicant must, therefore, be shown to have acted with bad faith. Either, therefore, the application made by the applicant must be tainted with bad faith or, after the application has been submitted, but before it is registered, the applicant must have acted with bad faith. No allegation of bad faith, howsoever serious, subsequent to the registration of the mark, can be relevant for the purposes of Section 11(10)(ii) of the Trade Marks Act.

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<sup>43</sup> 2001 ETMR 89

<sup>44</sup> (1999) RPC 367



**13.8** The impugned judgment, in our respectful opinion, does not advert to any material on the basis of which it can be said that, at any time prior to the registration of the BLUE-JAY mark in favour of the appellants, there was any bad faith in the manner in which they acted.

**13.9** To sustain the finding of bad faith, the learned Single Judge observes that the explanation provided by the appellants for adopting the BLUE-JAY mark, in the counter statement filed before the Registrar of Trade Marks, was at variance with the explanation tendered in the reply filed to the Section 57 petition of the respondent. We may, in this context, reproduce paras 19 and 20 of the impugned judgment, thus:

“19. At the outset, this Court while going through the plethora of documents on record finds that the respondent nos.1 and 2 in their Counter Statement filed before the Trade Marks Registry, have categorically stated that “... ...the trademark BLUE JAY is a trading style of the firm. The same was adopted by the proprietor Ajay Kumar by using nomenclature of Blue Jay, a common bird of North America.....”. Notably, barring this, there are no other pleading(s) of any sort qua the adoption of the impugned mark ‘BLUE-JAY’. Meaning thereby, the respondent nos.1 and 2 claimed to have adopted the said impugned mark ‘BLUE-JAY’, drawing inspiration from the North American bird of the same name. However, surprisingly, and to the contrary, in the present cancellation proceeding, the respondent nos.1 and 2 have sprung up with a story that “... ...the father of Mr. Sumit Vijay and brother of Mr. Ajay Kumar Gupta, Mr. Dinesh Kumar Vijay was an employee of Punjab National Bank from 31st October, 1973 to 28th February, 2012 and he was posted to Punjab National Bank, Rasoi, District, Sonipat from January 1997 to September, 1999 and during his posting he frequently used to go to the restaurant of Blue Jay Tourist Resort of Haryana Tourism in Panipat for having meals. The Resort is a very famous Resort and is very amongst the people in the region. When Mr. Ajay Gupta and Mr. Sumit Vijay decided to start the business and was looking for a trade mark to be adopted in respect of the goods, Mr. D. K. Vijay suggested the name of



BLUE-JAY which is also the name of a very famous bird of North America. Hence, it was decided by Mr. Ajay Kumar Gupta and Mr. Sumit Vijay to adopt the trade mark BLUE-JAY... ...”. This shows that the respondent nos.1 and 2 have now concocted an entirely new explanation/ story about the reason/ justification for adoption of the impugned mark ‘BLUE-JAY’.

20. The aforesaid, being a bald statement, is inconsistent with the earlier case of the respondent nos.1 and 2 themselves. It raises a credible doubt in the mind of this Court as to the reliability of the adoption of the impugned mark ‘BLUE-JAY’ by the respondent nos.1 and 2. It, *prima facie*, seems to be an afterthought since the respondent nos.1 and 2 were failing to provide any cogent and convincing reason/ justification for adopting the impugned mark ‘BLUE-JAY’. The same, primarily reflects the respondent nos.1 and 2’s *mala fide* and dishonest intentions to appropriate and ride upon the worldwide reputation and goodwill associated with the petitioner.”

**13.10** Having perused paras 19 and 20 of the impugned judgment, we are of the opinion that they do not make out any case of bad faith adoption by the appellants of the BLUE-JAY mark, either in law or on facts.

**13.11** The observation of the learned Single Judge that the explanation tendered by the appellants for adopting the BLUE-JAY mark in their counter statement before the Trade Mark Registry and in response to the Section 57 petition of the respondent, was contradictory, cannot be accepted. There is no real contradiction in the two explanations. In the counter statement filed before the Trade Marks Registry, the appellants submitted that the BLUE-JAY mark was adopted as the blue jay is a common bird of North America. In the reply filed to the respondents’ Section 57 petition, the appellants merely pointed out that the BLUE-JAY mark had been adopted at the instance of Mr. Dinesh Kumar Vijay, from the name of the Blue Jay



Tourist Resort which he used to frequent, *as it was also the name of a famous bird of North America*. It is not, therefore, as though the appellants advanced two different reasons, before the Trade Marks Registry and before the learned Single Judge, for adopting the BLUE-JAY mark.

**13.12** Even if, *arguendo*, it were to be assumed that the reasons cited by the appellants for adopting the BLUE-JAY mark on these two occasions were different, that cannot, in our mind, make out a case of bad faith adoption of the BLUE-JAY mark at the time when the appellants applied for registration thereof. It has to be remembered that, on that day, there was no subsisting registration of the BLUE JAYS mark in favour of the respondent. The two applications filed by the respondents for registering the BLUE JAYS mark in 1983 and 1988 had both been abandoned prior to Appellant 1's application for registration of the BLUE-JAY mark. We fail to understand how, even if it were to be assumed that the appellants were aware of the BLUE JAYS mark of the respondent, any bad faith can be alleged in the appellant applying for registration of the BLUE-JAY mark, when the respondent had abandoned its applications for registration of the BLUE JAYS marks much earlier.

**13.13** Moreover, we have already found that there is no substantial material on the basis of which it could be said that, on 19 August 1998, the respondent's BLUE JAYS mark commanded any goodwill or reputation in India. We agree with Mr. Lall, therefore, that there was no real reason for the appellants to seek to capitalize on the goodwill or reputation of the mark belonging to a baseball club which



was based in Canada and had never played a single match in India, where it has neither goodwill nor reputation.

**13.14** Further, if the findings of the learned Single Judge have to be accepted, it would amount to permitting the respondents to monopolize, and claim exclusivity in, an abandoned mark, which is clearly impermissible in law.

**13.15** The learned Single Judge has, on this aspect, further observed, in para 22 of the impugned judgment, thus:

“22. Considering the aforesaid, as also that the whole case of the petitioner vested on the impugned mark ‘BLUE-JAY’ being identically similar to its ‘BLUE JAYS’ marks, the respondent nos. 1 and 2 ought to have been more cautious, careful, if not specific.”

**13.16** With great respect, we fail to understand why the appellants ought to have been conscious, careful or specific in adopting a mark which was not similar to any mark which stood registered in the name of the respondent, or which had any goodwill or reputation in India. In fact, the very fact that the respondent had abandoned its applications for registration of the mark BLUE JAYS would convey a clear signal that there was no proscription on any other party applying for registration of an identical or similar mark in India. Any such application, if made, cannot, therefore, be said to have been tainted with bad faith.

**13.17** The finding, of the learned Single Judge, that the adoption of the mark BLUE-JAY by the appellants was tainted with bad faith, and that, therefore, the mark was liable to be cancelled under Section



11(10)(ii) of the Trade Marks Act, is not, therefore, sustainable in law.

**14. Re. Findings regarding prior user of the BLUE JAYS mark by the respondent**

**14.1** The learned Single Judge has, in paras 27 to 29 of the impugned judgment, observed that the respondent was the prior user of the mark BLUE JAYS and that the appellants had adopted the BLUE-JAY mark only in 1998, 22 years after the adoption of the BLUE JAYS mark by the respondent.

**14.2** This finding is predicated on the premise that the respondent's adoption of the BLUE JAYS mark dates back to 1976. The very basis of this premise is incorrect, as the respondent commenced user of the BLUE JAYS mark in 1976 only in Canada and the US. There is no proof of any user, by the respondent, of the BLUE JAYS mark, in India, prior to 1998. As such, the finding that the adoption by the appellants of the BLUE-JAY mark in 1998 was 22 years after the commencement of user by the respondent, of the BLUE JAYS mark, is unsustainable on facts.

**15. Re. Conclusions in the impugned judgment**

In view of the aforesaid discussion, the conclusions contained in paras 35 to 37 of the impugned judgment are obviously unsustainable.

**16.** We are, therefore, of the considered opinion that no case for rectification of the Register of Trade Marks by removal, therefrom, of



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the appellants' BLUE-JAY mark under Section 57(2) read with Section 11 of the Trade Marks Act, exists.

## **Conclusion**

**17.** In view of the aforesaid discussion, we are unable to sustain the impugned judgment dated 1 July 2025 of the learned Single Judge in C.O. (COMM.IPD-TM) 279/2023. It is, accordingly, quashed and set aside. The appellants' BLUE-JAY mark would stand restored to the Register of Trade Marks forthwith.

**18.** The appeal stands allowed in the aforesaid terms with no orders as to costs.

**C. HARI SHANKAR, J.**

**OM PRAKASH SHUKLA, J.**

**JANUARY 5, 2026/aky/yg**