2026:MHC:542

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IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on	Delivered on:
22.1.2026	**11.2.2026**

CORAM:

THE HON'BLE MR. JUSTICE N. ANAND VENKATESH

(T) CMA (TM) Nos.110 & 157 of 2023

7 – Eleven International LLC
(a Delware Limited Liability
Company), USA, having address
for service in India
Archer & Angel, #5B, 5th Floor,
Commercial Towers,
Hotel JW Marriott, Aerocity,
New Delhi-110037.

(Substituted as per order dated
22.1.2024 in CMP(TM) No.18 of
2023 in (T)CMA(TM) No.110 of 2023
& CMP(TM) No.16 of 2023 in
(T)CMA(TM) No.157 of 2023
Respectively by NSSJ) ...Appellant in both appeals

Vs

1.The Deputy Registrar of Trade Marks,
Trade Marks Registry, Intellectual
Property Building, GST Road,
Guindy, Chennai-32.

2.The Registrar of Trade Marks,
Trade Marks Registry, Intellectual
Property Building, GST Road,
Guindy, Chennai-32.

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3.Ravi Foods Private Limited,
7-4-112/1, Madhuban Colony Road,
Kattedan, Hyderabad-500077.

(R3 substituted vide order of court dated 31.7.2025 made in CMP(TM).Nos. 1 & 2 of 2025 respectively in both (T)CMA(TM) Nos.110 & 157 of 2023 by SKRJ)

...Respondents in both appeals

APPEALS under Section 91 of the Trade Marks Act, 1999 praying that

(T)CMA(TM) No.110 of 2023:

(i) the impugned order dated 18.7.2014 passed by the Deputy Registrar of Trade Marks in respect of Opposition No.MAS – 211161 to Application No.1297871 in Class 30 be set aside;

(ii) the Trade Mark Application under No.1297871 in Class 30 in the name of respondent No.3 be rejected;

(iii) the Opposition filed by the appellant under No.MAS – 211161 to Application No.1297871 in Class 30 be allowed; and

(iv) respondent No.3 to pay costs of and incidental to these appeals; and

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(T)CMA(TM) No.157 of 2023:

(i) The judgment and order passed by the Deputy Registrar of Trade Marks dated 18.7.2014 in respondent No.3's Opposition No.MAS - 720132 against the appellant's Application No.636986 in Class 03 be set aside;

(ii) the said Application No.636986 in Class 30 be allowed and Opposition No.MAS - 720132 be refused and/or dismissed;

(iii) respondent Nos.1 and 2 to transmit and certify to the Tribunal the entire records of the proceedings including all exhibits thereto before them in the matter of Application No.636986 in Class 30 and the opposition there to being Opposition No.MAS – 720132; and

(iv) respondent No.3 to pay the costs of and incidentals to this appeal to the appellant.

For Appellant in both appeals	:	Mr.K.Harishankar for M/s.Archer & Angel
For R1 & R2 in (T)CMA(TM) No.110 of 2023	:	Mr.S.Diwakar, SPC
For R1 & R2 in (T)CMA(TM) No.157 of 2023	:	Mr.K.Subbu Ranga Bharathi, CGSC

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For R3 in both the appeals : Ms.Aanchal M.Nichani

COMMON JUDGMENT

These appeals, filed under Section 91 of the Trademarks Act, 1999 (for short, the Act), are directed against a common order dated 18.7.2014 passed by the Deputy Registrar of Trademarks in (i) Trademark Opposition No.MAS - 211161 to Application No.1297871 in Class 30 and (ii) Trademark Opposition No.MAS - 720132 to Application No.636986 in Class 30, respectively.

2. Vide the impugned order, Application No.636986 filed by the appellant seeking registration of their mark ***"Big Bite"*** in Class 30 has been rejected on the basis of the opposition lodged by the 3rd respondent and Application No.1297871 filed by the 3rd respondent in seeking registration of their mark ***"Big Bite"*** in Class 30 has been accepted thereby rejecting the opposition lodged by the appellant herein.

3. The case of the appellant is as follows:

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(i) The appellant operates convenience store chain, owning/ operating/franchising nearly 80,000 stores in 22 countries around the world under the 7 – Eleven mark and brand. The appellant also has a store chain in India. The appellant intended to make use of their "***Big Bite***" trademark with respect to savoury food items and more specifically hot dogs, pizzas and potato chips.

(ii) The appellant claims that the "***Big Bite***" formative mark has been continuously used by them since August 1988 in respect of their goods and services and hence, the appellant is the original, genuine and bona fide adopter of "***Big Bite***" formative marks for more than three decades. In order to statutorily protect their rights, the appellant along with their affiliated/related companies, secured registration of "***Big Bite***" marks in numerous jurisdiction across the world in numerous classes namely Classes 29, 30 and 43.

(iii) By virtue of continuous and extensive use and promotion, which includes various global registrations, the appellant earned a reputation for the "***Big Bite***" mark, which transcends geographical boundaries including India. The appellant also submitted their earliest trademark application for the mark "***Big Bite***" on 16.8.1994 under No. 636986 in Class 30. The mark was advertised for registration under

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the Proviso to Section 20(1) of the Act in the trade marks journal dated 16.9.2007.

(iv) On 18.2.2008, the original third respondent - one M/s.Dukes Consumer Care Limited gave opposition and notice objecting to the registration of the mark. The appellant filed their counter statement for the opposition.

(v) The said M/s.Dukes Consumer Care Limited had, on 19.7.2004, submitted Application No.1297871 in Class 30 for the trade mark "***Big Bite***" in respect of chocolates, biscuits, bread, pastry, confectionery, ice creams, spices and all goods included in Class 30. The mark was advertised on 15.5.2005 and the appellant submitted their objections to the registration of the trade mark. A counter statement was filed for the opposition made by the appellant.

(vi) The said M/s.Dukes Consumer Care Limited was rechristened on 09.8.2023 as one M/s.SWG Consumer Care Limited, which, later assigned the mark to one M/s.Ravi Foods Private Limited with effect from 21.1.2025. Accordingly, the said M/s.Ravi Foods Private Limited was substituted as the third respondent in these appeals and subsequentlh, the cause title was amended in the appeals.

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(vii) The first respondent, by the impugned order dated 18.7.2014, refused the application filed by the appellant on the basis of the opposition made by the third respondent and instead, allowed the application submitted by the third respondent by rejecting the opposition made by the appellant. These appeals are directed against the aforesaid common order.

4. The learned counsel appearing on behalf of the appellant submitted as follows:

(a) The first respondent passed the impugned order solely on the basis of the judgment of the Hon'ble Supreme Court in ***Milmet Oftho Industries Vs. Allergan Inc. [reported in 2004 (12) SCC 624].*** The said judgment does not, in any way, support the reasoning given by the first respondent to the effect that only the prior user in India would be considered favourably for the grant of the trademark. But, the first respondent failed to consider the fact that the appellant had adopted the mark "***Big Bite***" even in 1988 itself and had the prior international adoption and use of the "***Big Bite***" marks as well as prior Indian application for the said mark.

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(b) The third respondent adopted the very same mark only from the year 2004 and such adoption of an identical mark was done with a mala fide intention to siphon off the international reputation and goodwill of the appellant's "***Big Bite***" marks. The registration of the mark was sought for by the third respondent with respect to allied goods in the food industry, which is also the industry of operation of the appellant with the well-known international "***Big Bite***" marks. Hence, if the third respondent is permitted to use the identical mark, it is bound to cause confusion in the minds of the consumers including a likelihood of association with the appellant's "***Big Bite***" brand.

(c) The first respondent committed a fundamental mistake while passing the impugned order by assuming that the prior user test had to be applied only with respect to the usage in India and that the international usage could not be taken into consideration.

(d) In order to substantiate his submissions, he relied upon the following judgments:

(1) of the Hon'ble Supreme Court in

S.Syed Mohideen Vs. P.Sulochana Bai

[reported in 2016 (2) SCC 683];

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(2) of the Hon'ble Supreme Court in ***N.R.Dongre Vs. Whirlpool Corporation [reported in 1996 (5) SCC 714];***

(3) of the Hon'ble Supreme Court in ***Milmet Oftho Industries;***

(4) of a learned Single Judge of the Delhi High Court in ***Jolen Inc. Vs. Doctor & Company [reported in ILR (2002) I Delhi 550];***

(5) of another learned Single Judge of the Delhi High Court in ***Cadbury UK Limited Vs. Lotte India Corporation Ltd. [reported in 2014 SCC OnLine Delhi 367];***

(6) of a Division Bench of the Delhi High Court in ***Dalip Chand Aggarwal Vs. M/s. Escorts Ltd. [reported in 1980 SCC OnLine Delhi 342];***

(7) of a learned Single Judge of the Bombay High Court in ***Drums Food International Pvt. Ltd. Vs. Euro Ice Cream***

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[reported in 2011 (5) Mh.L.J. 166 : 2011 SCC OnLine Bombay 817];

(8) of one more learned Single Judge of the Delhi High Court in ***Tata Sons Ltd. Vs. Manoj Dodia [reported in 2011 SCC OnLine Delhi 1520];***

(9) of another learned Single Judge of the Delhi High Court in ***Kia Wang Vs. Registrar of Trademarks [reported in 2023 SCC OnLine Delhi 5844];***

(10) of a learned Single Judge of the Delhi High Court in ***Suzuki Motor Vs. Suzuki (India) Ltd. [reported in 2019 SCC OnLine Delhi 9241];***

(11) of another learned Single Judge of the Delhi High Court in ***Somany Ceramics Ltd. Vs. Shri Ganesh Electric Co. [reported in 2022 SCC OnLine Delhi 3270];*** and

(12) of another Division Bench of the Delhi High Court in ***Raman Kwatra Vs. KEI***

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Industries Ltd. [reported in 2023 SCC OnLine Delhi 38].

5. On the other hand, the learned counsel appearing for the third respondent submitted as follows:

(a) The original third respondent - the said M/s.Dukes Consumer Care Limited has been using the trade mark "***Big Bite***" since 05.10.2004 continuously, openly and extensively for their products. The appellant, at no point of time, used this mark in India and was proposing to get into the Indian market. While considering the applications submitted by both sides, the territoriality principle would apply and the Authority has rightly taken into consideration the fact that the third respondent was the prior user of the trade mark, that at no point of time, the appellant had used this trade mark in India and that the appellant was only proposing to use the trade mark.

(b) Therefore, the mere fact that this trade mark is available in the website of the appellant, by itself, would not result in the appellant establishing the actual usage of the impugned mark in India in trade and commerce and the appellant has not gained any substantial goodwill and reputation within the Indian market. The first respondent

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took into consideration this vital fact in line with the provisions of the Act, considered the effect of the judgment of the Hon'ble Supreme Court in ***Milmet Oftho Industries*** and rightly accepted the application filed by the third respondent and rejected the application filed by the appellant. There is absolutely no ground to interfere with the impugned common order.

(c) In order to substantiate her submissions, the learned counsel appearing for the third respondent relied upon the following decisions:

(1) of the Hon'ble Supreme Court in ***Milmet Oftho Industries;***

(2) of the Hon'ble Supreme Court in ***S.Syed Mohideen;***

(3) of the Hon'ble Supreme Court in ***Neo Laboratories Ltd. Vs. Medical Technologies Ltd. [reported in 2016 (2) SCC 672];***

(4) of a Division Bench of the Delhi High Court in ***Intex Technologies (India) Ltd. Vs. AZ Tech (India) [reported in 2017 DHC 1450 – DB : MANU/DE/0625/2017];***

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(5) of the Hon'ble Supreme Court in ***Toyota Jidosha Kabushiki Kaisha Vs. Prius Auto Industries Ltd. [reported in 2018 (2) SCC 1];***

(6) of a learned Single Judge of the Delhi High Court in ***Keller Williams Realty Inc. Vs. Dingle Buildcons Pvt. Ltd. [reported in MANU/DE/0951/2020];***

(7) of another Division Bench of the Delhi High Court in ***Bolt Technology OU Vs. Ujoy Technology Pvt. Ltd. [reported in 2023 DHC 8509-DB : MANU/DE/7956/2023];***

(8) of a Division Bench of the Delhi High Court in ***Arvi Lights Vs. Big Deeper Industries LLP [reported in MANU/DEOR/ 132322/2024];***

(9) of a Division Bench of the Delhi High Court in ***VIP Industries Ltd. Vs. Carlton Shoes Ltd. [FAO(OS) (COMM) Nos.151 & 152 of 2023 dated 01.7.2025];*** and

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(10) of a Division Bench of the Delhi High Court in ***Sumit Vijay Vs. Major League Baseball Properties Inc. [reported in MANU/DE/0021/2026].”***

6. This Court has carefully considered the submissions of the learned counsel on either side and perused the materials available on record and more particularly the impugned order.

7. The main thrust of arguments on the side of the appellant is as follows :

The appellant has been using the mark “***Big Bite***” internationally since 1988 and has filed an application for registration way back in 1994. While considering the application, which was opposed by the third respondent, the first respondent completely lost sight of the scope of Section 11 of the Act and was swayed by the judgment of the Hon’ble Supreme Court in ***Milmet Oftho Industries.*** The appellant has built a reputation at an international level with respect to the “***Big Bite***” marks and they are clearly international prior users. This mark is known across India since it is exhibited in the website of the appellant

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and therefore, the first respondent ought to have given preference to the claim made by the appellant over the mark "***Big Bite***".

8. On the contrary, the stand taken by the third respondent is as follows:

The international reputation of the appellant is immaterial and the appellant ought to have proved that they are the prior users of the mark "***Big Bite***" in India. In the absence of the same, they cannot prevent the third respondent from getting the registration of the trade mark since, admittedly, the third respondent (previously M/s.Dukes Consumer Care Limited) was using the mark from 2004. The mere launch of a website and promotion of the impugned mark by the appellant, by itself, will not tantamount to the appellant being considered as a prior user of the trade mark in India. The appellant, which had no intention of coming to India or introducing their product in India, should not be allowed to throttle an Indian company to sell their products in the market chosen by it on the ground that they are used for a substantial period since 2004 and that the appellant has earned reputation.

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9. Before entering into the merits of the controversy, it is necessary to first notice the scope of the appellate powers of this Court in an appeal against an order of the Registrar.

10. Section 91(1) of the Act, as it originally stood, was as follows:

> *"(1) Any person aggrieved by an order or decision of the Registrar under this Act, or the rules made thereunder may prefer an appeal to the Appellate Board within three months from the date on which the order or decision sought to be appealed against is communicated to such person preferring the appeal."*

11. The Act was extensively amended by the Tribunals Reforms Act, 2021, which abolished the Intellectual Property Appellate Board and substituted the High Court as the Appellate Body under the Act. Thus, the appeals from an order of the Registrar of Trade Marks now lie to the High Court. It is also important to note that the Tribunals Reforms Act, 2021 omitted Section 92 of the Act, which dealt with the procedure and powers of the Appellate Board.

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12. Pursuant to the aforesaid amendment and in exercise of powers under Clauses 37 & 38 of the Letters Patent and Section 129 of the Code of Civil Procedure, 1908, the Madras High Court has framed the Madras High Court Intellectual Property Division Rules, 2022.

13. Rule 7 sets out the procedure for appeals and Sub-Rule (9) reads as follows:

> *"The Provisions of Order XLI Code of Civil Procedure Code, 1908, Limitation Act, 1963, the Madras High Court Appellate Side Rules, Civil Rules of Practice and Circular Order and the practice notes/directions issued by the High Court from time to time, as far they are not inconsistent to these rules, shall apply to appeals filed under these Rules."*

14. It is, therefore, clear that the Commercial Division, while hearing an appeal from an order of the Registrar, is required to follow the procedure set out in Order XLI of the Code for appeals against original decree, which, in this Court, is numbered as an Appeal Suit (A.S). However, Schedule I of the Madras High Court Intellectual Property Division Rules prescribe the nomenclature of CMA (TM) IPD. Civil Miscellaneous Appeals under the Code are governed by Section

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104 and Order XLIII whereas an appeal against an original decree is governed by Section 96 & Order XLI. The order of the Registrar does not amount to a ***"decree"*** in any sense of the term. Be that as it may.

15. Turning to the scope of such appeals, it is necessary to bear in mind that in this case, an appeal under Section 91, unlike an appeal under Order XLIII, emanates from a final order of the Registrar. Consequently, considerations, which may properly be applied while testing discretionary orders passed by the trial courts, must not be mechanically imported into Section 91 under the garb of Order XLI. Order XLI merely prescribes the procedure, by which, an appeal is to be heard and has nothing to do with the scope of appellate jurisdiction, which is an entirely different matter altogether.

16. The proper approach to appeals of this kind has been explained in an instructive decision of the Court of Appeal, United Kingdom in ***Procter & Gamble Limited's Trade Mark Application [reported in 1999 RPC 673]*** wherein it was held thus:

> *"The judge recognized that he was not bound by the findings of the hearing officer, but said that he would be slow to differ from the*

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hearing officer on a question which was largely one of impression and on which the hearing officer would be likely to have far wider experience. Mr Morcom [counsel for the appellants] has directed some mild criticism at that approach but I see no force in the criticism. The judge was right to pay respect to the view of the hearing officer, nevertheless he had to form his own view and he did so, though he reached the same conclusion as the hearing officer".

17. In the decision of the House of Lords in ***Yorkshire Copper Works Limited, TM Application [reported in (1954) 71 RPC 150]***, Lord Simmonds said as follows:

> *"And if it were a border-line case, which it is not, I think that a Court, to which an appeal is brought from the Registrar, though, no doubt, it would exercise its own discretion in the matter, should be slow to differ from the experienced official whose constant duty it is to protect the interests of the public not only of today but of tomorrow and the day after."*

18. In the considered view of this Court, the proper approach is that the Appellate Court, while reassessing the material before the Registrar, would be entitled to form its own view of the matter.

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However, in doing so, the Court would be slow to interfere with the findings and conclusions of the Registrar, who is an expert body under the Act, unless it is demonstrated that the view taken is perverse or is one, which could not be arrived at on the evidence before it.

19. Turning to the issues raised in these appeals, it is first necessary to set out the relevant provisions of the Trade Marks Act, 1999. The expression ***"mark"*** has been defined in Section 2(1)(m) as under:

> *"mark includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof;"*

20. Section 2(1)(zb) defines a trademark to mean as under:

> *"trade mark means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours; and—*
>
> *(i) in relation to Chapter XII (other than section 107), a registered trade mark or a mark used in relation to goods or services for the*

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purpose of indicating or so as to indicate a connection in the course of trade between the goods or services, as the case may be, and some person having the right as proprietor to use the mark; and

(ii) in relation to other provisions of this Act, a mark used or proposed to be used in relation to goods or services for the purpose of indicating or so as to indicate a connection in the course of trade between the goods or services, as the case may be, and some person having the right, either as proprietor or by way of permitted user, to use the mark whether with or without any indication of the identity of that person, and includes a certification trade mark or collective mark;"

21. Registration of a trademark can be refused if it falls within any of the grounds contained in Section 9 (absolute grounds) or Section 11 (relative grounds). Section 9 permits refusal on the ground of lack of distinctiveness etc. Further discussion on this aspect may not be necessary as this Court is not concerned with the application of this provision in this case. Section 11, on the other hand, provides for relative grounds ie., on the ground of conflict with other trademarks/ marks.

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22. Section 11 of the Act reads as follows:

> *"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.*
>
> *(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.*

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(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; or

(b) by virtue of law of copyright.

(4) Nothing in this Section shall prevent the registration of a trade mark where the proprietor of the earlier trade mark or other earlier right consents to the registration, and in such case the Registrar may register the mark under special circumstances under Section 12.

Explanation: For the purposes of this Section, earlier trade mark means -

(a) a registered trade mark or an application under Section 18 bearing the earlier date of filing or an international registration referred to in Section 36E 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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(5) A trade mark shall not be refused registration on the grounds specified in Sub-Sections (2) and (3), unless objection on any one or more of those grounds is raised in opposition proceedings by the proprietor of the earlier trade mark.

(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 publication 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

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extent to which the trade mark has been recognised as a well-known trade mark by any court or Registrar under that record.

(7) The Registrar shall, while determining as to whether a trade mark is known or recognised in a relevant section of the public for the purposes of Sub-Section (6), take into account -

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

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

(iii) the business circles dealing with the goods or services,

to which that trade mark applies.

(8) Where a trade mark has been determined to be well-known in at least one relevant section of the public in India by any court or Registrar, the Registrar shall consider that trade mark as a well-known trade mark for registration under this Act.

(9) The Registrar shall not require as a condition, for determining whether a trade mark is a well-known trade mark, any of the following, namely: -

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

(ii) that the trade mark has been registered;

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

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(iv) that the trade mark -

(a) is well known in; or

(b) has been registered in; or

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

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

(10) While considering an application for registration of a trade mark and opposition filed in respect thereof, the Registrar shall -

(i) protect a well-known trade mark against the identical or similar trade marks;

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

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

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23. Section 11(1) begins with the phrase "*Save as otherwise provided in Section 12, a trademark shall not be registered….*", which is because Section 12 recognizes honest concurrent use or other special circumstances, by which, registration is permissible though the mark is identical or similar. Section 12 is, thus, an exception to Section 11. Coming to Section 11(1), it provides for refusal on the ground of likelihood of confusion on the part of the public because of the identity with an earlier trade mark or similarity of goods and services. Section 11(2) deals with a case where the goods and services are not similar and the use of the trademark, which is identical with or similar to an earlier trademark without due cause would amount to unfair advantage or be detrimental to the distinctive character or reputation of an earlier trademark.

24. It should be mentioned that the expression ***"earlier trade mark"*** occurring in Section 11(1) is defined in Explanation (a) that follows Section 11(3). This explanation at the relevant point of time defined an earlier trade mark to mean a registered trade mark or a convention application under Section 154, which has a date of application earlier than the date of trade mark in question. Vide the

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Trade Marks (Amendment) Act, 2010 (Act 40 of 2010), Explanation (a) was substituted as under:

> *"a registered trade mark or an application under section 18 bearing an earlier date of filing or an international registration referred to in section 36E 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."*

25. The amendment to Explanation (a) came into force only on 08.7.2013, which is much after the opposition proceedings had commenced in this case. The explanation expands the scope of the expression ***"earlier trade mark"***. The amendment is clearly substantive in character and cannot be applied retrospectively. In any event, Section 11(1) was not seriously pursued by the appellant as their main focus was on Section 11(3).

26. There is no material to show that the appellant is a well-known trademark within the meaning of Section 2(1)(zg) and Section 11(8) of the Act. No Court or Registrar has recognized the mark as a

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well-known trademark nor is the appellant recognized as such by the Registrar in the list maintained by him on the official website.

27. Section 11(8) reads as follows:

> *"Where a trade mark has been determined to be well known in at least one relevant section of the public in India by any court or Registrar, the Registrar shall consider that trade mark as a well-known trade mark for registration under this Act."*

28. Hence, as the trademark of the appellant does not fall within the aforesaid criteria, it does not qualify as a well-known trademark and the question of applying Section 11(2) or Section 11(6) does not arise.

29. Section 11(3), which directly applies to this case, deals with a scenario where the trademark is refused registration on the ground that its use will be prevented by the law of passing off or copyright unless the proprietor of the said mark consents to its registration under Section 11(4). This is a case where both parties are at loggerheads and hence, the question of consent does not arise. The question really boils down as to whether the use of the trademark will

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be prevented by the law of passing off in this country. This test must be applied with reference to both marks as it must not be overlooked that these are cases of cross oppositions.

30. The tort of passing off is a sub-species of the tort of deceit. The classic formulation of what constitutes passing off is set out in the decision of the Privy Council of UK in ***Star Industrial Co. Ltd. Vs. Yap Kwee Kor [reported in 1976 F.S.R. 256]*** wherein ***Lord Diplock*** observed thus:

> *"A passing off action is a remedy for the invasion of a right of property not in the mark, name or get-up improperly used, but in the business or goodwill likely to be injured by the misrepresentation made by passing off one person's goods as the goods of another. Goodwill, as the subject of proprietary rights, is incapable of subsisting by itself. It has no independent existence apart from the business to which it is attached."*

31. In the decision in ***Ruston & Hornsby Ltd. Vs. Zamindara Engineering Co. [reported in 1969 (2) SCC 727],*** the Hon'ble

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Supreme Court of India pointed out the distinction between an infringement action and an action for passing off by holding as under:

> **"***Apart from the question as to the nature of trade mark the issue in an infringement action is quite different from the issue in a passing off action.*
>
> *In a passing off action the issue is as follows:*
>
> *"Is the defendant selling goods so marked as to be designed or calculated to lead purchasers to believe that they are the plaintiff's goods?"*
>
> *But in an infringement action the issue is as follows:*
>
> *"Is the defendant using a mark which is the same as or which is a colourable imitation of the plaintiff's registered trade mark."*

32. In the decision in ***S.Syed Mohideen,*** the Hon'ble Supreme Court approved the following test laid down by Lord Oliver in ***Reckitt & Colman Products Ltd. Vs. Borden Inc. [reported in (1990) 1 WLR 491]***, popularly called the ***'Jif Lemon case'*** wherein the following three ingredients were spelt out:

> *"In a case such as the present where what is in issue is whether the goods of A are likely to be*

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passed off as those of B, a plaintiff, to succeed, must establish

(1) that his goods have acquired a particular reputation among the public,

(2) that persons wishing to buy his goods are likely to be misled into buying the goods of the defendant and

(3) that he is likely to suffer damage thereby."

33. From the above, it is discernible that the tort of passing off is actually a wrong against the goodwill acquired by a business. Goodwill was famously explained by Lord MacNaughten in the decision in ***Inland Revenue Commissioners Vs. Muller & Co's Margarine [reported in 1901 AC 217]*** as constituting:

"*… the benefit and advantage of the good name, reputation, and connection of a business. It is the attractive force which brings in custom…. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has power of attraction sufficient to bring customers home to the source from which it emanates… I think that if there is one attribute common to all cases of good will it is the attribute of locality. For goodwill has no*

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independent existence. It cannot subsist by itself. It must be attached to a business. Destroy the business, and the goodwill perishes with it, though elements remain which may perhaps be gathered up and be revived again."

34. Thus, the essence of passing off is that it is an injury against goodwill, which, in turn, is inextricably linked to a business for goodwill, cannot exist independently of a business. This has given rise to two competing schools of thought, one taking the view that it is essential for business to exist within the jurisdiction and the other view in cases where the business has an international reputation and is able to demonstrate that it attracts customers from the concerned country. In other words, there is a spillover of goodwill gained internationally into the local market.

35. As is common with this branch of law, there is no dearth of precedents, both Indian and foreign, on the issue of transborder rights. However, on a closer look, it will be seen that a majority of these decisions emanate from appeals against interlocutory orders in suits for infringement/passing off. Thus, the precedents cited on either side will have to be examined keeping in mind the aforesaid aspect.

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36. As noticed supra, the case of the appellant is that they have built a reputation at an international level with respect to the "***Big Bite***" marks and that they are clearly international prior users.

37. Admittedly, there is no material to show that the appellant has done business on Indian soil, with the aforesaid mark, on the date of the application or at any subsequent point of time prior to the commencement of opposition proceedings.

38. On the other hand, it is the case of the contesting third respondent that they are doing business in India with the mark ***"Big Bite"*** since 2004 and that the application of the appellant must fail since they were not doing business in India and consequently, can have no goodwill in India.

39. The issue before the Hon'ble Supreme Court in ***N.R.Dongre*** arose out of an application for injunction in a passing off action. On facts, it was found that material had been placed before the learned Single Judge of the Delhi High Court (R.C.Lahoti,J as he then was) to demonstrate that Whirlpool washing machines had been sold in India,

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though in a limited way, to the U.S. Embassy and U.S. AID in India. It was also demonstrated that their products were advertised in magazines having international circulation including in India. More importantly, the name was registered in favour of the plaintiff from 1955-1977, which would have generated goodwill. On this basis, the order of injunction granted by the learned Single Judge and affirmed on appeal by the Division Bench was upheld by the Hon'ble Supreme Court with the following observations:

> *"It has also to be borne in mind that a mark in the form of a word which is not a derivative of the product, points to the source of the product. The mark/name 'Whirlpool' is associated for long, much prior to the defendants' application in 1986 with the Whirlpool Corporation, Plaintiff 1. In view of the prior user of the mark by Plaintiff 1 and its trans-border reputation extending to India, the trade mark 'Whirlpool' gives an indication of the origin of the goods as emanating from or relating to the Whirlpool Corporation, Plaintiff 1."*

40. In the decision of the Hon'ble Supreme Court in ***Milmet Oftho Industries***, a suit was filed for passing off in respect of the mark "ocuflex" used on a medicinal preparation manufactured and marketed by the respondents therein. This decision also arose out of

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an appeal against an order granting ad-interim injunction. The Hon'ble Supreme Court held thus:

> *"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."*

The Court added the following caveat:

> *"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."*

41. The Court also emphasized that in respect of pharmaceutical products, a more exacting judicial scrutiny was necessary in view of the larger public interest that was at stake. In fact, a similar view had been expressed earlier in the decision of the Hon'ble Supreme Court in

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Cadila Health Care Ltd. Vs. Cadila Pharmaceuticals Ltd. ***[reported in 2001 (5) SCC 73]*** wherein it was held thus:

> *"The drugs have a marked difference in the compositions with completely different side effects, the test should be applied strictly as the possibility of harm resulting from any kind of confusion by the consumer can have unpleasant if not disastrous results. The courts need to be particularly vigilant where the defendant's drug, of which passing-off is alleged, is meant for curing the same ailment as the plaintiff's medicine but the compositions are different. The confusion is more likely in such cases and the incorrect intake of medicine may even result in loss of life or other serious health problems."*

42. In the decision in ***Milmet Otfho Industries,*** the Hon'ble Supreme Court ultimately upheld the order of interim injunction leaving it open to the respondents therein to agitate the issue of prior use after conclusion of trial.

43. The learned counsel appearing on behalf of the appellant is perhaps correct in his criticism of the impugned order of the Registrar, which purported to apply the principles laid down in the decision of the

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Hon'ble Supreme Court in ***Milmet Oftho Industries*** without appreciating the fact that it concerned a pharmaceutical product where slightly different standards would apply.

44. However, what must also be taken into account is the fact that the impugned order was passed on 18.7.2014 when the law as regards transboundary reputation was still hazy. The decision of the Hon'ble Supreme Court in ***Toyota Jidosha Kabushiki Kaisha*** has now settled the issue once and for all. However, it is necessary to take a brief detour to see as to how this change had really come about.

45. In the decision in ***Starbucks (HK) Ltd. Vs. British Sky Broadcasting Group PLC [reported in 2012 EWHC 3074 (Ch)]***, ***Arnold,J*** held that although advance advertising could create protectable goodwill, the activities relied on by the foreign plaintiff to establish goodwill in the UK ***"did not take the form of advertising or promotion for a forthcoming product or service"***. Instead, the advertisements were primarily aimed at promoting its home business in Hong Kong.

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46. The matter was carried on appeal and finally reached the UK Supreme Court in the decision in ***Starbucks (HK) Limited Vs. British Sky Broadcasting Group PLC [reported in (2015) UKSC 31]***. The Supreme Court reaffirmed the requirement in a passing off action of showing goodwill within the local market. The position at common law was stated by ***Lord Neuberger*** as follows:

> *"I consider that we should reaffirm that the law is that a claimant in a passing off claim must establish that it has actual goodwill in this jurisdiction, and that such goodwill involves the presence of clients or customers in the jurisdiction for the products or services in question. And, where the claimant's business is abroad, people who are in the jurisdiction, but who are not customers of the claimant in the jurisdiction, will not do, even if they are customers of the claimant when they go abroad.*
>
> *It seems to have been the consistent view of the House of Lords and Privy Council from 1915 to 1990 that a plaintiff who seeks passing off relief in an English court must show that he has goodwill, in the form of customers, in the jurisdiction of the court. While it can be said that, in none of the cases discussed in paras 21-25 above was that point the main focus of attention, it nonetheless seems clear that that is what a succession of*

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respected judges, many of whom had substantial experience in this area, considered to be the law."

47. Finally, as to what constituted sufficient goodwill for the purposes of protection, in ***Starbucks (HK) Limited,*** it was held thus by the UK Supreme Court:

> *"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."*

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48. Shortly prior to the aforesaid decision of the UK Supreme Court in ***Starbucks (HK) Limited,*** the Singapore Court of Appeal delivered an important decision in ***Staywell Hospitality Group Pty Ltd Vs. Starwood Hotels & Resorts Worldwide, Inc., [reported in (2014) 1 SLR 911],*** in which, the law was summarized by ***Sundaresh Menon,CJ*** as under:

> *"Our courts have since largely followed Star Industrial, holding that a foreign trader which does not conduct any business activity in Singapore cannot maintain an action in passing off here (see Tan Gek Neo Jessie v Minister for Finance [1991] 2 MLJ 301, Jumbo Seafood Pte Ltd v Hong Kong Jumbo Seafood Restaurant Pte Ltd [1997] 3 SLR(R) 878 and CDL Hotels ([102] supra)). The "hard-line" approach, as currently applied in Singapore, draws a clear distinction between goodwill and reputation: "[a] desire to become a customer of the plaintiff without the ability to actually be one, cannot ordinarily form the basis of goodwill."*

49. A close reading of the decision of the UK Supreme Court in ***Starbucks (HK) Limited*** and the decision of the Singapore Court of Appeal in ***Staywell Hospitality Group Pty Ltd.,*** reveals a common concern. Both the Courts have expressed their concerns about

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balancing the rights of a foreign business and those of a local competitor and have taken a position that tips the law slightly in favour of the local player.

50. In the decision of the UK Supreme Court in ***Starbucks (HK) Limited,*** it was further held thus:

> *"If it was enough for a claimant merely to establish reputation within the jurisdiction to maintain a passing off action, it appears to me that it would tip the balance too much in favour of protection. It would mean that, without having any business or any consumers for its product or service in this jurisdiction, a claimant could prevent another person using a mark, such as an ordinary English word, "now", for a potentially indefinite period in relation to a similar product or service. In my view, a claimant who has simply obtained a reputation for its mark in this jurisdiction in respect of his products or services outside this jurisdiction has not done enough to justify granting him an effective monopoly in respect of that mark within the jurisdiction."*

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51. In a similar vein, in the decision of the Singapore Court of Appeal in ***Staywell Hospitality Group Pty Ltd., Sundaresh Menon,CJ*** further said as under:

> *"In softening the "hard-line" approach so as to consider pre-trading activity as capable of generating goodwill, our courts must strike a considered balance between the interests of foreign or aspiring entrants to the Singapore market, and existing local enterprises. Where the foreign trader has no interest in the local market, the concern of stifling local enterprises prevails. Where the foreign trader has unequivocally evinced his intention to enter the local market, the concern of preventing local traders from "freeriding" on the efforts and expenditure of the foreign trader prevails. It will be a rare case, if ever, that spill-over advertising meant primarily for a foreign audience or to increase brand reputation in general, or early stages of negotiation and sourcing without any serious commitment to investment, will displace the interests of local enterprise in favour of proprietary protection for the foreign trader.*
>
> *Finally, the unequivocal intention to enter the local market is a necessary factor qualifying pre-trade activity for consideration in the goodwill inquiry, but it is not sufficient. It must be remembered that the ultimate question is whether*

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the activity has generated an attractive force that will bring in custom when the business eventually materialises. If a trader has taken steps evincing his intention to trade in Singapore, such as securing premises or employees here, but has done nothing to put the business in the awareness of the public so as to create demand, then there clearly is no Singapore goodwill to be protected."

52. Reverting to the Indian position, in the decision in ***Trans Tyres India Pvt. Ltd. Vs. Double Coin Holdings Limited [reported in (2012) 49 PTC 209]***, a Division Bench of the Delhi High Court opined that in trademark law, the doctrine of territoriality must be preferred to the doctrine of universality. The Division Bench had held thus:

"Trademark, as we all know is territorial in nature. Thus, under the Territoriality Doctrine, a trademark is recognized as having a separate existence in each sovereign territory in which it is registered or legally recognized as a mark. The Universality Doctrine, which posits that a mark signifies the same source wherever the mark is used in the world has been rejected by Courts all over the world. Thus, the registered proprietor of a trademark would be entitled to the protections

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conferred by law and exclusivity vested within the territorial limits as conferred by a Municipal Law. Prior use of a trademark in a dominion would ipso facto not entitle its owner to claim exclusive trademark rights in another dominion.

The conventional theory that a trademark connects, in the mind of the consumer, the goods to the source of manufacturer is inapplicable in today's environment because modern global trading has assumed multi-channel modes of sale of goods in the market. Thus, in today's global environment, the theory pertaining to a trademark would be that a trademark connects, in the mind of the consumer, the source wherefrom the goods enter the market, whatever may be the nomenclature of that source. It could be the agent, the distributor or even a person who purchases goods from a manufacturer and sells them in the market."

53. The aforesaid view was reiterated by another Division Bench of the Delhi High Court in ***Prius Auto Industries Ltd Vs. Toyota Jidosha Kabushiki Kaisha [reported in (2017) 236 DLT 343]***. The defendants had obtained registration of the mark *'Prius'* in 2002 and had been using the same since 2001. ***Toyota Jidosha Kabushiki Kaisha*** contended that the mark *'Prius'* was a well known trade mark

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and that its first hybrid car *"Prius"* was launched in Japan in 1990 and was also sold in various parts of the globe. The car was released in India in 2010. The defendants, on the other hand, took the defence that they had been selling car accessories under the name *"Prius"* since 2001 and that ***Toyota Jidosha Kabushiki Kaisha*** had not sold any cars in the Indian market so as to claim goodwill locally. The Division Bench upheld the defence and held that the mark *'Prius'* was not entitled to protection.

54. In the latter decision, the Division Bench of the Delhi High Court took note of the earlier decisions of the Hon'ble Supreme Court and observed that they were rendered at the ad-interim stage where the only test was whether the products were likely to result in confusion. It was observed thus:

> *"Issues of trans-border reputation or likelihood of confusion decided in various cases cited before us and even in cases not cited arose before the Court either in quia timet actions or when the defendants had just entered the market. At that point of time, the issue could obviously be decided on the test of likelihood of confusion and we find that most of the judgments are dealing with the issue at the stage of injunction where*

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documents filed by the parties had yet to translate into evidence and witnesses were yet to be examined. In such situation, the only way in which the issue of an injunction pending adjudication in the suit can be decided is on the touchstone of likelihood of confusion. But in a case of the kind at hand where the appellants had been selling the goods under the offending trade mark for nearly ten years when the suit for injunction was filed, there must be evidence of actual confusion. Toyota is a big company. It has had a presence in India for over two decades when the suit was filed. It was well entrenched in the Indian market in the year 2001. Obviously no consumer of Toyota car or buyer of an auto part sold by Toyota was ever confused by the appellants selling their products under the trade mark Prius, for if this was so, in ten years somebody would have complained to Toyota or at least would have made known said fact to Toyota."

55. In this case, admittedly, the third respondent has been selling their products under the mark ***"Big Bite"*** since 2004 and there is no evidence of any kind to show that the consumers were confused or deceived in the past two decades.

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56. The decision of the Division Bench of the Delhi High Court was taken on appeal to the Hon'ble Supreme Court in ***Toyota Jidosha Kabushiki Kaisha Vs. Prius Auto Industries Ltd. [reported in (2018) 2 SCC 1]***. Dismissing the appeals, the Hon'ble Supreme Court affirmed the applicability of the territoriality doctrine in trademarks. The Hon'ble Supreme Court referred to and approved the following observations in ***Athletes' Foot Marketing Associates Inc. Vs. Cobra Sports Ltd. [reported in 1980 RPC 343]*** 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 …"*

57. In said decision in ***Toyota Jidosha Kabushiki Kaisha,*** certain exceptions were also noticed by the Hon'ble Supreme Court as, for instance, protection was granted where the cars were imported and sold in England thereby creating a market within the United Kingdom ***{LA Societe Anonyme Des Anciens Etablissements Panhard Vs.***

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Panhard Levassor Motor Co. Ltd. [reported in (1901) 2 Ch 513]} and where the customers travelled to another jurisdiction to purchase the products as in the case of ***C&A Modes Vs. C&A (Waterford) Ltd. [reported in 1976 IR 198 (Irish)].*** The Hon'ble Supreme Court finally rejected the contention raised by ***Toyota Jidosha Kabushiki Kaisha*** premised on transborder reputation and goodwill by observing as under:

> *"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*

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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."

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58. The aforesaid view has since been consistently followed by the Courts in India. Among the cases cited on either side, the decisions in ***Keller Williams Realty Inc.***, ***Bolt Technology OU***, ***KEI Industries***, ***Somany Ceramics Limited*** and ***Kia Wang*** arose out of interlocutory applications. In the last-mentioned decision, it was factually found that the claimant had been selling its products in India through Amazon for quite some time. In the decision of the Delhi High Court in ***Suzuki Motor,*** it was found on facts that the defendant claimed to have adopted the name Suzuki because they had friend named Suzuki. Quite obviously, the defence was rightly found to be a sham and the use of the mark was found to be in bad faith. This decision, therefore, turned on its own facts.

59. The decision of the Division Bench of the Delhi High Court in ***VIP Industries Ltd.*** also emanates from interlocutory proceedings. But, it contains two important passages on transborder reputation, which deserve to be set out and noticed and which run thus:

> *"118. The concept is actually elementary, when one keeps in mind the basic principle of passing off. Passing off takes place when a defendant, by using the mark or name of the*

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plaintiff, seeks to pass of his goods, or services as the goods, or services, of the plaintiff. The issue of trans-border reputation arises where the plaintiff is situated outside the territorial jurisdiction in which the defendant is located. Even in such a case, if the reputation and goodwill which is commanded by the plaintiff's mark is of such a degree that it has percolated into the territory of the defendant, and is "well-known" in that territory, the defendant is still seeking to capitalise on the reputation of the mark or name. This is because, if consumers within the defendant's territory are consciously aware of the reputation of the mark or name in question, even though it is exclusively, or even essentially, used outside the territory, they may presume, when such mark or name is used by the defendant, that the plaintiff has now established a presence in that territory. When dealing with India, for example, many reputed brands, and names, which earlier had no presence in India, though they commanded a global reputation, have now established a presence within India.

119. One may, for example, consider a mark such as Burger King. Till a decade or so ago, Burger King had no presence in India. Even so, it had a global reputation, and many consumers in India, who were fond of burgers, were aware of the existence of the Burger King franchise. If, therefore, some adventurous entrepreneur, in

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India, decided to set up a Burger King outlet, before Burger King officially established a presence in this country, it might have amounted to passing off, given the fact that Burger King had a global reputation, and that reputation had percolated into India, through promotional material, literature, advertisements, and the like, even if there was no physical Burger King outlet within this country. Of course, if Burger King were to bring a passing off action against such entrepreneur, the onus would be on Burger King to prove that its global reputation had percolated into India so that it could be said to enjoy trans-border reputation within this country."

60. From the aforesaid, it would be clear that it must be demonstrable that the mark used extensively outside India is so well known that they may presume, when such mark or name is used by the respondent and that the claimant has now established a presence in that territory.

61. That, however, is not the case here. Admittedly, before the Registrar, no evidence worth its name was ever produced by the appellant to show that they have been selling their products in India. There was, therefore, no question of confusion or deception.

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62. On the contrary, the third respondent was able to show through Ex.D.1 to Ex.D.58 that they had sales across the country since 2004 and invested money in advertisements, etc., which was evidenced through Ex.A.1 to Ex.A14.

63. The learned counsel for the third respondent cited the recent decision of the Division Bench of the Delhi High Court in ***Sumit Vijay***.

64. The decision in ***Sumit Vijay*** was on an appeal from the order of the Registrar where the application of Section 11(3) of the Act was directly in issue and answers the contention raised by Mr.Harishankar, learned counsel on behalf of the appellant that the mark of the appellant was available on their website, which was accessible in India thereby leading to the conclusion that it was known throughout this country.

65. This contention cannot be accepted and it is not necessary to repeat what was said in the decision in ***Toyota Jidosha Kabushiki Kaisha,*** except to refer to the following passages from the decision of the Division Bench of the Delhi High Court in ***Sumit Vijay***:

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"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.

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.

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

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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.

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 existent, of the goods bearing the mark, from within India."

66. The older cases, prior to the decision in ***Toyota Jidosha Kabushiki Kaisha,*** cited on the side of the appellant, will now have to

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be read in the light of the law laid down by the Hon'ble Supreme Court in the decision in ***Toyota Jidosha Kabushiki Kaisha.*** Mr.Harishankar, learned counsel appearing on behalf of the appellant also referred to the decision of the Hon'ble Supreme Court in ***S.Syed Mohideen*** wherein the question was as to whether the holder of registered trade mark could sue for infringement of his registered trade mark if the opponent also has the trade mark, which is registered. The other issue was as to whether such a respondent could bring an action against the appellant for passing off invoking the provisions of Section 27(2) of the Act. The decision is, therefore, inapplicable to the facts of this case although there is a wealth of precedent cited for the general principles concerning passing off.

67. If the aforesaid principles are applied to the facts of this case, the admitted position is that the appellant did not sell their products in this country at any time from 1994, when they purportedly made an application for registration or in 2007 when the opposition proceedings commenced before the Registrar. The impugned order also states that the appellant was not selling any products in India and was not able to produce any material to show the use of their mark in

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Classes 29 & 30. Consequently, in view of the decision of the Hon'ble Supreme Court in ***Toyota Jidosha Kabushiki Kaisha***, it cannot be said that the appellant has acquired sufficient goodwill in this country so as to entitle them to protection. On the other hand, the third respondent has been able to demonstrate actual sale and percolation of their products throughout the country with the mark ***"Big Bite"*** for a sufficiently long period so as to generate goodwill and reputation entitling them to protection under the law of passing off.

68. Before concluding, it must also be pointed out that though Section 18 does permit registration of a mark, which is ***"used or proposed to be used",*** it must be remembered that the applicant must show that it has a definite and present intention to use the mark as on the date of the application. In the decision in ***Ducker's Trade Mark [reported in (1928) 45 RPC 397],*** it was held thus:

> *"I think the words 'proposed to be used' mean a real intention to use, not a mere problematic intention, not an uncertain or indeterminate possibility, but it means a resolve or settled purpose which has been reached at the time when the mark is to be registered."*

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69. In yet another case in ***Batt's Trade Mark [reported in (1898) 15 RPC 534],*** which was quoted in the aforesaid decision, it was held thus:

> *"Can a man properly register a trade mark for goods in which he does not deal or intend to deal; meaning by ' intending to " deal' having at the time of registration some definite and present intention to deal in certain goods or descriptions of goods, and not a mere general "intention of extending his business at some future time to anything which he "might think desirable. This question we answer in the negative. To answer it otherwise would be unduly to strain the language of the Acts relating to trade marks and to render those Acts extremely mischievous instead of beneficial to trade or commerce."*

70. The fact that the appellant had applied for registration in 1994, but had not commenced business or sale in this country either on the said date or on the date of commencement of opposition proceedings almost over a decade later in 2007, is also an additional (though not decisive) factor that weighs in the balance while testing the order of the Registrar declining registration of the appellant's mark. In the final analysis, this Court is of the considered view that

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the conclusion arrived at by the Registrar must be upheld, though for different reasons. This Court is not convinced that the appellant has made out a case for interference in these appeals.

71. In the result, these civil miscellaneous appeals fail and are dismissed. In the facts and circumstances of the case, there shall be no order as to costs.

11.2.2026

Index : Yes
Neutral Citation : Yes

To
1.The Deputy Registrar of Trademarks,
Trade Marks Registry, Intellectual
Property Building, GST Road,
Guindy, Chennai-32.

2.The Registrar of Trademarks,
Trade Marks Registry, Intellectual
Property Building, GST Road,
Guindy, Chennai-32.

RS

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N.ANAND VENKATESH,J

RS

(T)CMA(TM) Nos.110 & 157 of 2023

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