IN THE HIGH COURT OF JUDICATURE AT BOMBAY

ORDINARY ORIGINAL CIVIL JURISDICTION

IN ITS COMMERCIAL DIVISION

COMMERCIAL MISCELLANEOUS PETITION NO. 857 OF 2022

WITH

COMMERCIAL MISCELLANEOUS PETITION NO. 36 OF 2022

WITH

COMMERCIAL MISCELLANEOUS PETITION NO. 824 OF 2022

WITH

COMMERCIAL MISCELLANEOUS PETITION NO. 834 OF 2022

WITH

INTERIM APPLICATION NO. 2136 OF 2022

IN

COMMERCIAL MISCELLANEOUS PETITION NO. 36 OF 2022

WITH

INTERIM APPLICATION NO. 2132 OF 2022

IN

COMMERCIAL MISCELLANEOUS PETITION NO. 857 OF 2022

Century 21 Real Estates LLC …Petitioner

Versus

Century 21 Town Planners Pvt. Ltd. & Anr. …Respondent

Ms. Shwetasree Majumder, Ms. Janhvi Chadha, Ms. Priya Adlakha, Mr. Dhirendra Singh, Ms. Aishwarya Ambardekar i/b. Mr. Bimal Rajasekhar for the Petitioner.

Ms. Pooja Jain, Ms. Bhavi Gada for the Respondent.

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CORAM : ARIF S. DOCTOR, J.

RESERVED ON : 17th FEBRUARY 2026

PRONOUNCED ON : 6th MARCH 2026

JUDGMENT

1. The captioned Commercial Miscellaneous Petitions impugn the validity of the following four registrations obtained by Respondent No. 1 viz.

Petition No.	Trade mark	Registration No.	Dated	Class	User Claim
824 of 2022		1941724	26.03.2010	16	09.04.2007
834 of 2022		1959526	03.05.2010	41	Proposed to be used
857 of 2022		1957532	29.04.2010	36	09.04.2007
36 of 2022		1941725	26.03.2010	35	09.04.2007

The Petitioner has impugned the aforesaid registrations of the trade mark 'C21' ("**the impugned registrations**") and has sought rectification of the register of trade marks on the basis that the Petitioner has prior rights, both statutory and common law in 'CENTURY 21' and 'C21' word as well as device mark worldwide and also in India.

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The Facts and Challenge in Brief:

2. The Petitioner is a multinational company engaged in the business of franchising its brand for use in connection with real estate.

3. The Petition sets out that the Petitioner operates more than 6,900 independently owned and operated franchised broker offices across 78 countries and territories worldwide, with independent sales associates in numerous jurisdictions, including India. The Petition also sets out that, by virtue of the Petitioner's extensive global presence and longstanding operations, the Petitioner has acquired significant goodwill and reputation in the real estate industry, such that the trade mark “CENTURY 21” has become closely associated with and is synonymous with the Petitioner.

4. The Petition also sets out that the Petitioner owns rights in the mark "C21" which is a well-known abbreviation of “CENTURY 21", and that the Petitioner has used the mark “C21” on a standalone basis as well as in conjunction with other terms such as C21 EDGE, C21 TAP IN, and C21 SOCIAL XCHANGE. The Petitioner is also currently using C21 COMMERCIAL, C21 FINE HOMES AND ESTATES, C21 UNIVERSITY, and .

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5. It is the Petitioner's case that Respondent No. 1, who operates in the same field of business as the Petitioner, has dishonestly adopted the impugned marks only to trade upon the Petitioner's immense reputation and goodwill. It is thus that the Petitioner has sought rectification of the register by filing the present Commercial Miscellaneous Petitions.

Submissions on behalf of the Petitioner:

6. Ms. Majumder, the Learned Counsel appearing on behalf of the Petitioner at the outset, in order to demonstrate the Petitioner's common law and statutory rights in "CENTURY 21" & "C21" trade marks, globally, adverted to the following:

i. The Petitioner was incorporated in 1971 in California, USA, as *'Century 21 Real Estate Corporation',* and after mergers and restructuring, the Petitioner was incorporated in Delaware in 1979 and thereafter was renamed *'Century 21 Real Estate LLC'* on 28th December 2004.

ii. As per the online Acronym Finder Site, "C21" was a known abbreviation of the "CENTURY 21" mark.

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iii. The Petitioner has executed "CENTURY 21" sub-franchise agreements all over the world, including the first Asian sub-franchise agreement in Japan on 16th June 1983, Hong Kong on 12th August 1993, Indonesia on 24th September 1996, Taiwan on 17th February 1997, Singapore on 21st August 1997 and China on 22nd March 2000.

iv. The Petitioner has obtained registration of the "CENTURY 21" mark in at least 140 countries and territories around the world, including India, with the earliest registration in the United States of America (USA) dating back to 1977.

v. The Petitioner also owns the registration of the "C21" mark in the USA, Canada and EUIPO, with the earliest registration in the USA at least since 2005, with a first user claim since 1982.

vi. The Petitioner has obtained registration of the domains "century21.com" and "c21.com" since March 1995 and active websites, which have over 4 million visits per month. Several

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websites operating in different jurisdictions, bearing the "CENTURY 21" and "C21" trade marks.

vii. The Petitioner also made huge investments to popularise its "CENTURY 21" brand throughout the world, through television, radio and print and digital media, reaching millions of consumers worldwide.

viii. The Petitioner has a major presence on Google and all prominent social media platforms, where the distinctive logo '', is used as the brand icon.

ix. Over the last 5 decades, Petitioner has earned huge goodwill and reputation in respect of the trade marks "CENTURY 21" and "C21", which is evident from the following:

- As per the 2015 Alexa Ranking, the Petitioner's website www.century21.com has ranked no. 3,129 with 87.8% visitors in the USA; ranked 59,296 with 2.4% visitors in India.

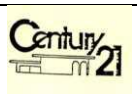
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- ➢ As per Milward Brown's (a leading global market search organisation) 2009 study, Petitioner's "CENTURY 21" brand achieved 97% name recognition.
- ➢ As per the 2013 study of Milward and Brown, the Petitioner has achieved a 95% brand awareness ranking. In the 2016 study, Petitioner achieved a 92% brand awareness ranking**.** As per the 2017 study, the ranking remained the highest among the real estate industry.
- ➢ The Petitioner has received several awards, including the reputed JD Power & Associates Awards for customer satisfaction for a number of years, including 2014 to 2017.
- ➢ The Petitioner was announced as the number one most visited real estate website in 2013 by ComScore Inc.

7. Ms. Majumder then pointed out that the Petitioner even had statutory and common law rights in India as established from the following:

   i. The fact that the Petitioner had, as early as the year 1989, obtained the following registrations, viz.:

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Trade mark	Registration No.	Dated	Class	Status
CENTURY 21	506834	13.3.1989	16	**Registered** (Rectification filed by R-1 dismissed by the Kolkata High Court on 13th Nov. 2024 for non-prosecution) (Rectification filed by R-1 pending before the Trade Marks Registry – Pleadings are complete)
	506833	13.3.1989	16	Same as above
CENTURY 21	2855768	4.12.2014	35	**Registered** (Rectification filed by R-1 pending before the Trade Marks Registry)
C21 EDGE	2864553	17.12.2014	35, 38	Same as above

ii. Registered the Indian top-level domain "century21.co.in" on 29th January 2006, which was redirected to Petitioner's Indian website www.century21.in (registered on 26th July 2011). Also operated another website, www.c21.in (registered on 25th June 2010), dedicated to the Indian market.

iii. Entered into a sub-franchise agreement through its authorised licensee, 'Realogy', with an Indian entity, 'DGS Realtors Pvt. Ltd.', in 2007 for expansion in India, granting DGS Realtors an exclusive

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licence to use the marks "CENTURY 21" and "CENTURY 21 System"

iv. Entered into a Master Franchise Agreement with Alchemist Ltd. (now known as Century 21 Properties India Pvt. Ltd.) in December 2012, granting an exclusive license to use the marks "CENTURY 21" and "CENTURY 21 System".

v. The Petitioner's marks had, since the year 2007, also been extensively advertised and had also received wide press and media coverage and featured in listings such as Reality Plus Magazine (2007), MagicBricks (2007), Franchise Connect (2008), and internship-related coverage in 2009. Advertisements issued by DGS Realtors in 2009 and 2010. Articles and press releases in prominent publications and platforms such as Business Line (10th August 2013), World Property Journal (11th November 2014), Business Wire, The Times of India (19th October 2013), and Ace Update (26th November 2013). Also, multiple press releases dated 22nd May 2014 carried by Business Wire, India Notes, Investment Guru,

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NewsSuperFast, The Telegraph, AndhraNews and Ad Hoc News, and a property listing under the "*Century 21*" brand on 99acres.com (11th May 2015).

8. Ms. Majumder then pointed out that the Petitioner's trade marks "CENTURY 21" and "C21" had also consistently received judicial recognition and protection across various jurisdictions, including in India by adverting to the following viz.

   i. Judgement dated 19th May 1988 by the US Courts of Appeal, upholding the summary judgment in favour of the Petitioner in an infringement Suit against an ex-franchisee.

   ii. *Ex-parte* injunction Order passed by the Delhi High Court in the case of ***Century 21 real estate LLC v. Sambit Basu and ors.***[1] against an infringing website "century21realty.com".

   iii. Judgement dated 23rd July 2018 passed by the Delhi High Court in the above suit (named changed to Kangana Das), wherein the Delhi High Court had recognised the worldwide goodwill and reputation of the Petitioner and protected its marks in India.

[1] [Delhi High Court] Order dated 28th May 2015 in CS(OS) 1671/2015.

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iv. INDRP Award in favour of the Petitioner concerning the domain CENTURY21.

v. WIPO Award in favour of the Petitioner concerning the domain century21bd.com.

vi. Judgement passed by the Delhi High Court in ***Century 21 Real Estate LLC v. Alchemist Ltd. & Anr.***[2] in favour of the Petitioner.

vii. Judgement in the case ***Century 21 Real Estate v. Century 21 Builders and Promoters Private Limited***.[3]

9. Ms. Majumder then pointed out that Respondent No. 1 was incorporated on 27th December 2006 by completely subsuming the Petitioner's registered mark "CENTURY 21" into the corporate name of Respondent No. 1 and obtaining registration of the impugned marks "C21" (device mark), which was identical to the Petitioner's prior adopted, used and registered "C21" trade marks worldwide, in respect of identical real estate business and allied and cognate services. She submitted that this registration as also the conduct of Respondent No. 1 was therefore clearly dishonest and in bad faith since the Petitioner was

[2] [Delhi High Court] Order dated 24th January 2022 in CS(COMM) 416/2020.
[3] [Delhi High Court] Order dated 25th September 2023 in CS(COMM) 637/2023 and I.A. 17762/2023.

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the prior adopter and user of “CENTURY 21” and "C21", and in respect of which the Petitioner had immense goodwill and reputation.

10. Ms. Majumder submitted that each of the defences (I to V below) taken by Respondent No. 1 to justify the adoption and use of “C21” were not only misconceived and legally untenable but, in fact, plainly dishonest. She then dealt with each of the defences as follows:

I. Honest and bona fide adoption

11. Ms. Majumder submitted that the dishonesty of such a plea was writ large on the face of the record, as Respondent No. 1 had not only adopted a mark identical to the Petitioner’s prior adopted, used and registered “C21” word and device marks but had also incorporated the Petitioner’s well-known trade mark “CENTURY 21” into its corporate name.

12. Ms. Majumdar submitted that such adoption and incorporation of a company whose corporate name entirely subsumes the Petitioner's in its entirety could not be coincidental but clearly was deliberate, calculated and dishonest from inception since Respondent No. 1 was engaged in the same line of business as the Petitioner, namely real estate. Ms. Majumder then took pains to point out

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that Respondent No. 1 had provided no explanation whatsoever for adopting the impugned marks which fact she submitted by itself spoke volumes of the lack of bona fides and dishonesty on the part of Respondent No. 1. Ms. Majumdar submitted that it was well settled that in any event the defence of honest and bona fide use was unavailable where the marks in question were identical.

13. Ms. Majumder also submitted that it was well settled that there can be only one source and one proprietor of a trade mark and that a trade mark cannot have a dual origin. She submitted that even long-standing use cannot legitimise a dishonest adoption. In support of her contention, she placed reliance upon the following decisions, ***MAC Personal Care Pvt. Ltd. v. Laverana GMBH***[4], ***Kanshiram Surinder Kumar v. Thakurdas Deomal Rohira***[5], ***M/s. Turning Point Institute Pvt. Ltd. v. Turing Point***[6], and ***Power Control Appliances v. Summet Machines Pvt. Ltd***.[7]

[4] 2016 SCC OnLine Del 530.
[5] MANU/MH/2069/1976.
[6] 2017 SCC OnLine Del 9765.
[7] MANU/SC/0646/1994.

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II. Respondent's prior use of "C21" in India and Petitioner's non-use

14. Ms. Majumder submitted that the claim of prior user by Respondent No. 1 was entirely false and was belied by the very documents relied upon by Respondent No. 1. She then pointed out that while Respondent No. 1 had asserted a user claim of the year 2007, the earliest invoice relied upon by Respondent No. 1 was dated 30th October 2010, and the earliest advertisement was of 25th February 2010. In contrast, she pointed out that the Petitioner had been using "CENTURY 21" internationally since 1971 and has been the registered proprietor thereof in the USA and Canada since 1977. She submitted that the mark "C21", being a well-known abbreviation of "CENTURY 21", had also been extensively and continuously used, including on the Petitioner's website "www.c21.com", since at least 1995. She submitted that the "C21" logo had also been prominently displayed on the Petitioner's websites and social media platforms and was exclusively associated with the Petitioner.

15. Ms. Majumder then submitted that the test of the "use of a mark" must be construed in accordance with Section 2(2)(c) of the Act and that the Petitioners Marks ***'Century 21'*** and ***'C21'*** and the logo having acquired immense goodwill

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and reputation in India, were liable to be protected against the dishonest adoption by Respondent No. 1. She submitted that, given the immense global presence of the Petitioner, Respondent No. 1 was fully aware of the Petitioner's rights or then was deemed to have constructive notice of the Petitioner's rights, given the prior statutory rights. In support of her contention, she placed reliance upon the decision in ***Suzuki Motor v. Suzuki India Ltd.***[8], ***N.R. Dongre v. Whirlpool Corporation***[9], ***Milmet Oftho Industries v. Allergan Inc.***[10], ***Hardie Trading Ltd. v. Addisons Paint & Chemicals Ltd.***[11], ***MAC Personal Care Pvt. Ltd. v. Laverana GMBH***[12], ***S. Syed Mohideen v. P. Sulochana Bai***[13], and ***Cadbury UK Ltd. v. Lotte India Corporation Ltd***.[14]

III. Conflicting Marks are different

16. Ms. Majumder submitted that the Respondent's contention that the conflicting marks were different was plainly untenable on the face of it. She submitted that the marks are in fact virtually identical or then deceptively similar, and the

[8] 2019 SCC OnLine Del 9241.
[9] (1996) 5 SCC 714.
[10] (2004) 12 SCC 624.
[11] (2003) 11 SCC 92.
[12] 2016 SCC OnLine Del 530.
[13] (2016) 2 SCC 683.
[14] 2014 SCC OnLine Del 367.

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services offered by both parties, namely real estate services, were identical and/or overlapping. She submitted that, therefore, a clear likelihood of confusion and deception as to source or association was bound to arise in the minds of consumers and on this ground alone the Petitioner was entitled to relief. In support of her contention, she placed reliance upon the decisions in the case of ***B.K. Engineering Co. v. Ubhi Enterprises***[15] and ***Laxmikant V. Patel v. Chetanbhai Shah***[16].

IV. Petitioner has no right over "C21"

17. Ms. Majumder submitted that the contention that the Petitioner has no right over the mark "C21" was also entirely without merit and plainly untenable. She reiterated that the Petitioner enjoys both common law and statutory rights in the mark "C21", worldwide and in India, by virtue of long-standing use and registration, as already pointed out. Ms. Majumder then submitted that it was well settled that registration of a mark does not create a new or greater right than what already existed in common law. In support of her contention, she

[15] 1984 SCC OnLine Del 288.
[16] (2002) 3 SCC 65.

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placed reliance upon ***Consolidated Foods Corporation v. Brandon Co. Pvt. Ltd.***[17] and ***Century Traders v. Roshan Lal Duggar & Co.***[18]

18. Ms. Majumder submitted that the Petitioner's adoption of the mark **'Century'** with the numeral "21" as well as **'C21'** dates back to 1971. She thus submitted that the contention of Respondent No. 1 that the impugned marks is taken from the 21st Century is of no assistance to the Respondent and was plainly a bogus attempt to attack the Petitioner's mark. She submitted that even otherwise, when Respondent No. 1 had itself obtained the mark **C21** (device) and claimed it to be coined, arbitrary and inventive, the defence of genericness is not even available to it. She submitted that Respondent No. 1 could not approbate and reprobate its stand on the basis of convenience. In support of this contention, Ms. Majumder placed reliance upon the decision in the case of ***Anil Verma v. R.K. Jewellers***[19], ***Peps Industries Pvt. Ltd. v. Kurlon Ltd.***[20], and ***Jagdish Gopal Kamath v. Lime & Chilli Hospitality Services***.[21]

[17] 1961 SCC OnLine Bom 55.
[18] MANU/DE/0153/1977.
[19] 2019 SCC OnLine Del 8252.
[20] 2022 SCC OnLine Del 3275.
[21] 2015:BHC-OS:3538.

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V. Use of "CENTURY" and "CENTURY 21" by various Third Parties

19. Ms. Majumder submitted that the Respondent's reliance on third-party registrations and alleged third-party use would also not legitimise the Respondent's adoption and use of the impugned mark. She submitted that the mere presence of marks on the Register does not establish actual use, nor is a registered proprietor required to initiate proceedings against every trivial or insignificant infringer, as held in the case of ***Pankaj Goel v. Dabur India Ltd***.[22] and ***H&M Hennes & Mauritz AB v. HM Megabrands Pvt. Ltd***.[23]

20. Basis the above, she submitted that the Petitions deserved to be allowed and the impugned registrations be struck off the register of trade marks.

Submissions on behalf of the Respondent:

21. Ms. Jain, learned counsel appearing on behalf of Respondent No. 1, at the outset submitted that the Petitioner had failed to establish any use of the impugned marks in India prior to, or even around, the year 2007. In contrast,

[22] 2008 SCC OnLine Del 1744.
[23] 2018 SCC OnLine Del 9369.

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she submitted that Respondent No. 1 had established its prior and continuous use of the impugned marks since 9th April 2007.

22. She submitted that Respondent No. 1 had adopted and commenced use of the impugned marks through incorporation and secured registration under No. 1242781 in Class 35, with a user claim dating back to April 2000. She pointed out that the registration covered services relating to advertising, business management, business administration and office functions connected with real estate affairs and building construction. Ms. Jain further submitted that the adoption of the impugned marks was bona fide by Respondent No. 1 and was duly supported by corporate records and statutory filings, which demonstrated the continuous use of the impugned trade marks by Respondent No. 1 since the year 2007. Basis this, she submitted that Respondent No. 1 was the prior adopter and user of the impugned marks in India and therefore Respondent No. 1 enjoys superior rights over the Petitioner under the provisions of Sections 34 and 33 of the Trade Marks Act.

23. Ms. Jain submitted that the Petitioner had not produced any credible document evidencing use of the marks “CENTURY 21” or “C21” in India in or prior to

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2007. She then submitted that in support of its claim of prior use, the Petitioner had only annexed the first and last page of the franchise agreement of 2007, and the same was neither stamped nor notarised. Similarly, she pointed out that the sub-franchise agreement of 2012 upon which the Petitioner had placed reliance was not notarised and was also unstamped. She therefore submitted that these agreements could not be relied upon by the Petitioner since the same were inadmissible in evidence. Ms. Jain additionally submitted that the Petitioner had not produced any invoices, sales records, advertisements, customer data, statutory filings, or other documentary evidence of commercial use of the trade marks "CENTURY 21" or "C21" in India and that the few articles which were relied upon by the Petitioner were third-party publications which did not emanate from the Petitioner and therefore cannot establish the Petitioner's proprietary use or goodwill.

24. She further submitted that the Petitioner's trade mark applications and registrations relied upon in India were on a "proposed to be used" basis and thus infact evidence non-use by the Petitioner of the Petitioners trade marks. She then submitted that even on the Petitioner's own showing, any material

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suggesting the Petitioner's presence and use of the Petitioner's trade marks in India appeared to be only from 2014 onwards. She also submitted that the website, i.e., "http://www.century21.in.co", relied upon by the Petitioner, was non-existent and that the Petitioner did not have an office of its own in India. She thus submitted that Respondent No. 1 was clearly the prior user and that it was well settled that the rights of a prior user are superior to and will prevail over the rights of a registered proprietor of a trade mark. In support of her contention, she placed reliance upon the decisions in ***S. Syed Mohideen v. P. Sulochana Bai***[24], ***R.J. Components and Shafts v. Deepak Industries Ltd.***[25], ***Exide Industries Ltd. v. Exide Corporation***[26], ***Rati Traders v. K.P. Pouches Pvt. Ltd.***[27], ***Suttind Seeds Pvt. Ltd. v. Sutton & Sons India Pvt. Ltd.***[28] and ***Neon Laboratories Ltd. v. Medical Technologies Ltd.***[29]

25. Ms. Jain further submitted that the Petitioner had also failed to establish any trans-border reputation or spill-over goodwill in India prior to the adoption of

[24] (2016) 2 SCC 683.
[25] 2017 SCC OnLine Del 11071.
[26] 2012 SCC OnLine Del 4645.
[27] 2004 SCC OnLine MP 480.
[28] 2010 SCC OnLine Del 2323.
[29] (2016) 2 SCC 672.

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the impugned marks by Respondent No. 1. She submitted that the material upon which reliance was placed by the Petitioner pertained largely to the Petitioner's operations in the United States and other foreign jurisdictions. She submitted that there was no evidence of the Petitioners business operations, consumer targeting, promotional campaigns, sales, or market recognition within India at the relevant time. She reiterated that trade mark law is territorial in nature and that global reputation or foreign use does not confer rights in India in the absence of cogent evidence of goodwill having spilt over into the Indian market.

26. Ms. Jain then placed reliance upon the decision of the Delhi High Court in ***Century 21 Real Estate L.L.C. v. Century 21 Main Realty Pvt. Ltd. & Ors.*** to point out that the Petitioner had in that case been refused relief on the ground that the Petitioner did not have any business or operations in India. She pointed out that the Delhi High Court had held that mere registration or blocking of a mark without use in India confers no advantage upon the Petitioner. Ms. Jain then also placed reliance upon an extract from the book by ***Venkateswaran*** on ***Trademarks & Passing off*** to point out that use of domain names would not amount to use of a trade mark.

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27. Ms. Jain then also placed reliance upon the decision of the Hon'ble Supreme Court in ***Toyota Jidosha Kabushiki Kaisha v. Prius Auto Industries Ltd.***[30]**,** to submit that even global goodwill must be shown to have existed in India at the time of adoption by the Defendant and that foreign advertisements, internet material, and international recognition were held insufficient absent proof of Indian market penetration. Additionally, she also placed reliance upon the decision in the case of ***Broad Peak Investment Holdings Ltd. v. Broad Peak Capital Advisors LLP***[31] to point out that sporadic transactions and scattered media articles were held to be insufficient to establish goodwill in India and that continuous and substantial use must be demonstrated.

28. She further pointed out, from the decisions in ***Toyota Jidosha Kabushiki Kaisha v. Tech Square Engineering Pvt. Ltd.***[32] and ***Du Pont De Nemours & Co. of USA v. Zip Industries Pvt. Ltd.***[33], that trans-border reputation cannot be presumed in the absence of concrete, India-specific evidence of goodwill. In both cases, she submitted that despite assertions of global publicity and

[30] (2018) 2 SCC 1.
[31] 2025 SCC OnLine Del 196.
[32] 2023 SCC OnLine Del 583.
[33] 2004 (28) ptc 174.

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international recognition, the Courts held that the absence of commercial presence, advertising, sales, or consumer recognition within India was fatal. Ms. Jain submitted that these authorities consistently affirm that worldwide fame or foreign publicity cannot satisfy the requirement of goodwill in India unless accompanied by clear proof of use in India.

29. Basis the above, Ms. Jain submitted that the Petitioner had failed to demonstrate any use of the Petitioner's marks in India in 2006 and that the Petitioner's own material, at best, reflected alleged use of the Petitioner marks in India only from 2014 onwards.

Submissions on behalf of the Petitioner in Rejoinder:

30. Ms. Majumder submitted that, on the one hand, Respondent No. 1 had contended that the Petitioner's proprietorship and use of the mark CENTURY 21 since 1989 cannot be treated as proprietorship or use of the mark "C21" while on the other hand, Respondent No. 1 had relied upon its alleged use of the mark CENTURY 21 TOWN PLANNERS to assert proprietorship over the abbreviated form "C21" and, by extension, to claim use of the device marks in

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question. Ms. Majumder submitted that this amounts to a clear conflation of the two marks by Respondent No. 1 and is an implicit admission that CENTURY 21 and C21 are not distinguishable.

31. She she submitted that, from Respondent No. 1's own evidence, the earliest document evidencing use of the C21 device dates back only to 1st December 2010, and that there was no material demonstrating use of C21, much less the impugned device marks, in 2007, as claimed by Respondent No. 1.

32. Without prejudice to the above, Ms. Majumdar submitted that Respondent No. 1's registration for the mark CENTURY 21 TOWN PLANNERS was also liable to be rectified under Rule 98 of the Trade Marks Rules, 2017, as Respondent No. 1 had failed to file a counter-statement within the statutory period of three months. She further submitted that the Petitioner has addressed a letter dated 16th December 2024 to the Registry seeking a formal abandonment of the said registration.

33. On the question of priority, Ms. Majumder submitted that Respondent No. 1 was not the prior user of either CENTURY 21 or C21 in India, as was evident from the agreements entered into by the Petitioner with DGS Realtors (October

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2007) and Alchemist Ltd. (December 2012), extracts from Realty Plus Magazine (September 2007), listings on MagicBricks (2007), Franchise Connect (2008), internship listings (April 2009), advertisements by DGS Realtors, and various press releases and property listings. In respect of C21, she relied upon extracts from the Petitioner's Indian website, *WHOIS* records of the domain c21.in, and the Petitioner's use of CENTURY 21 and C21 on its social media platforms, which she submitted was plain and clear evidence of the Petitioner's prior use in India.

34. She reiterated that the Petitioner is the registered proprietor of the CENTURY 21 and C21 marks in India and internationally, with Indian registrations dating back to 1989 and subsequent registrations in Class 35 and other classes, in addition to longstanding international registrations in the United States, EUIPO, and Canada.

35. Ms. Majumder then submitted that the reliance placed by Respondent No. 1 upon the extract from the book by ***Venkateswaran*** on ***Trademarks & Passing off*** to contend that use of a domain name does not amount to use of a trade mark was archaic and contrary to the now settled legal position. In support of her

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contention, Learned Counsel placed reliance upon the decision of the Hon'ble Supreme Court in ***Satyam Infoway Ltd. v. Siffynet Solutions Pvt. Ltd.***[34], which *inter alia* held that a domain name functions as a business identifier and may amount to use in relation to services. She thus submitted that the Petitioner's domain names and social media usage of CENTURY 21 and C21 demonstrate use in India. She also referred to the registration of the Indian top-level domains century21.co.in (on 29th January 2006), c21.in (on 25th June 2010), and century21.in (on 26th July 2011).

36. She further submitted that the Petitioners Indian sub-franchisee operated websites from some of these domains, and that subsequent litigation had resulted in their transfer to the Petitioner pursuant to a decree of the Delhi High Court in ***Century 21 Real Estate LLC v. Alchemist Ltd. & Anr.***, wherein the Court expressly noted the immense reputation and goodwill of the Petitioner's mark in India. She also relied upon ***Century 21 Real Estate LLC v. Century 21 Builders and Promoters Pvt. Ltd.*** to point out that the Delhi High Court had

[34] (2004) 6 SCC 145.

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taken judicial notice of the Petitioner's registrations and domain names and described CENTURY 21 as a "well-known brand."

37. Ms. Majumder submitted that the Respondent's contention that the Petitioner did not have a physical office in India was of no consequence since there was no such requirement under Indian trade mark law. She reiterated that the Petitioner operates a franchise-based model and had thus entered into franchise and sub-franchise agreements with Indian entities such as DGS Realtors (2007) and Alchemist Ltd. (2012), which agreements had already been recognised in judicial proceedings.

38. She further submitted that the objection of Respondent No. 1 to the franchise agreements on the ground of alleged lack of stamping and notarisation were hyper-technical objections taken only because Respondent No. 1 did not have any answer on merits. She pointed out that the present proceedings concern rectification and involve adjudication of rights in rem, not private contractual disputes. Objections, even if valid, could only be raised by the parties to the agreements in any private dispute arising from those agreements, and certainly not by Respondent No. 1. She reiterated that the Petitioner's rights flowing from

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such agreements had already been recognised and upheld in multiple judicial decisions, as already pointed out.

39. Ms. Majumder submitted that the argument of Respondent No. 1 that third-party publications cannot constitute proof of use was also untenable. She pointed out that under Section 2(1)(c)(ii) of the Trade Marks Act, use of a mark in relation to services includes reference to the availability or provision of services in India. In support of her contention, she placed reliance upon the decisions in ***Hardie Trading v. Addisons Paint & Chemicals Ltd.,*** and ***Trustees of Princeton University v. Vagdevi Educational Society and Ors.,***[35] which recognised that use of a trade mark need not be confined to actual sales. She further pointed out that Respondent No. 1 had itself relied upon third-party publications to claim use of the impugned C21 device marks from 2010. Learned Counsel thus submitted that Respondent No. 1 cannot insist upon a higher evidentiary threshold for the Petitioner while applying a different standard to itself. She submitted that Respondent No. 1 cannot be permitted to approbate and reprobate its stand according to its convenience.

[35] 2025 SCC OnLine Del 6296.

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40. Ms. Majumder then also submitted that Respondent No. 1 had relied on extracts of the Petitioner's website as it stood on the date of hearing. She submitted that the relevant date for assessing priority was not the date of hearing but the date when Respondent No. 1 claims to have commenced use of C21, and it was thus that the current website extracts were irrelevant to the determination of priority.

41. In dealing with the judgements relied upon by Learned Counsel for Respondent No. 1 Ms. Majumder submitted that the judgements in the case of ***S. Syed Mohideen v. P. Sulochana Bai***, ***R.J. Components and Shafts v. Deepak Industries Ltd.,*** and ***Neon Laboratories Ltd. v. Medical Technologies Ltd.,*** all pertain to infringement and passing-off proceedings and not to rectification proceedings. She thus submitted that the same were wholly inapplicable to the facts of the present case. She submitted that the issue at hand was one of priority of use and as to which party would have better rights in law. It was this she submitted that would have to be considered. In support of her contention she placed reliance upon the decision in the case of ***Le Shark Apparel Limited v. Anil Shah & Ors.***[36]

[36] 2025 SCC OnLine Bom 4006.

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42. In dealing with the decision of the Delhi High Court in ***Century 21 Real Estate LLC v. Century 21 Main Realty Pvt. Ltd.***, Ms. Majumder pointed out that the said decision was of the year 2010 and was passed at the interlocutory stage and thus does not constitute binding precedent. She submitted that the observations therein were only prima facie and that subsequent decisions of the Delhi High Court in the year 2015, 2017, 2022, and 2023 had recognised the Petitioner's goodwill and reputation in CENTURY 21 and C21 in India, on the basis of which the Court had granted the Petitioner protection. Ms. Majumder therefore submitted that the Petitioner had established priority of use, statutory registrations, judicial recognition, and goodwill in India, and that the Respondent's claims of prior use are unsupported by credible evidence. She thus submitted that the Petitions be allowed as prayed for.

Reasons and Conclusions:

43. After having heard learned counsel for the Parties and having considered the rival contentions and the material upon which reliance has been placed, as also

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the case law cited, I find that the Petitions deserve to succeed for the following reasons:

A. At the outset, and crucially, though the burden to prove the bona fide use and adoption lies squarely upon Respondent No. 1, I find that Respondent No. 1 has made no attempt to justify or explain the basis on which it adopted the impugned marks, i.e., "C21". In my view, this silence on the part of Respondent No. 1 speaks volumes about the lack of bona fides and honesty in adoption.

B. Additionally, the dishonesty and lack of bona fide on the part of Respondent No. 1 is manifest from the fact that Respondent No. 1 has, in addition to adopting the impugned mark, also incorporated the Petitioner's well-known trademark "CENTURY 21" in its entirety into its corporate name, i.e., Century 21 Town Planners Pvt. Ltd. The adoption of an identical mark and appropriation of "CENTURY 21" into the corporate name of Respondent No. 1, more so when both the Petitioner and Respondent No. 1 are in the same field/business. Therefore, clearly such adoption and use of the impugned trade marks is by design and not coincidence. In my view,

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it is as plain as daylight that the entire attempt of Respondent No. 1 is to clone the Petitioner and nothing more.

C. The claim of prior use by Respondent No. 1 is also plainly untenable and is belied by the very documents upon which Respondent No. 1 has placed reliance. I say so because, although Respondent No. 1 has claimed user of the impugned marks from the year 2007, the earliest invoice produced by Respondent No. 1 is dated 30th October 2010, and the earliest advertisement relied upon is dated 25th February 2010. Thus, on Respondent No. 1's own showing, the earliest use of the impugned marks is of the year 2010 and not 2007 as claimed. Clearly, therefore, Respondent No. 1 has made a false claim of prior user.

D. Conversely, the Petitioner has, in support of its prior use, reputation and goodwill in “CENTURY 21” and “C21”, *inter alia* placed reliance upon the fact that (i) the Petitioner was originally incorporated in 1971 in California as "Century 21 Real Estate Corporation", later restructured and incorporated in Delaware in 1979, and renamed "Century 21 Real Estate

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LLC" in 2004; (ii) over the past five decades, the Petitioner has expanded globally through an extensive network of franchise and sub-franchise agreements, including early expansion into Asia beginning with Japan in 1983, followed by Hong Kong, Indonesia, Taiwan, Singapore and China; (iii) the mark "CENTURY 21" is registered in at least 140 countries and territories worldwide, with registrations in the United States and Canada dating back to 1977, and the mark "C21" registered in jurisdictions such as the United States, Canada and the European Union, with first use claims tracing back to 1982; (iv) the Petitioner also owns and operates the domain names "century21.com" and "c21.com" since 1995, with substantial global web traffic and multiple jurisdiction-specific websites; (v) significant investments have been made in global brand promotion through television, radio, print and digital media, resulting in high brand recognition, as reflected in independent studies indicating awareness levels exceeding 90% across several years; (vi) the Petitioner's online presence is reinforced by substantial global rankings and visibility, including measurable traffic from India. All these factors collectively establish that over five decades

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the Petitioner has built substantial international goodwill and reputation in the marks “CENTURY 21” and "C21", which is not even really disputed by Respondent No. 1.

E. The Petitioner has also placed on record material which clearly demonstrates that “CENTURY 21”, “C21” and the logo have also acquired immense goodwill and reputation in India. The Petitioner pointed out that (i) the Petitioner has, as early as 13th March 1989, secured registrations in India for “CENTURY 21” in Class 16, which continue to remain on the Register; (ii) obtained subsequent registrations in Class 35 for “CENTURY 21” and “C21 EDGE"; (iii) obtained registration of the domain name “century21.co.in” in January 2006, followed by “c21.in” in June 2010 and “century21.in” in July 2011, all directed toward the Indian market; and (iv) entered into franchise arrangements in India, including a 2007 sub-franchise agreement with one DGS Realtors Pvt. Ltd. and a 2012 Master Franchise Agreement with one Alchemist Ltd. (subsequently renamed as Century 21 Properties India Pvt. Ltd), granting exclusive rights to use the “CENTURY 21” marks in India; (v) from 2007 onwards, the Petitioner’s

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marks received consistent advertising, listings, and media coverage on Indian platforms and in various Indian publications (both online and in print), including Realty Plus Magazine, MagicBricks, Franchise Connect, The Times of India, Business Line, World Property Journal, and other widely circulated media outlets, as well as property listings under the "CENTURY 21" brand on Indian real estate portals.

F. Hence, from what is set out in paragraphs (D) & (E) above, it is clear that the Petitioner's marks "CENTURY 21" and "C21" and the logo have acquired immense goodwill and reputation, including in India, which the Petitioner is entitled to seek the benefit of and protect. Also, given what has been set out in (D) and (E) above, Respondent No. 1 is deemed to have notice of the Petitioner's statutory and common law rights in the said marks which makes the adoption of the impugned marks plainly dishonest and lacking in bona fides. In this regard, the Petitioner's reliance upon the decision in ***N. R. Dongre v. Whirlpool Corporation*** and ***Milmet Oftho Industries v. Allergan Inc.*** is entirely apposite.

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G. Furthermore, and in my view crucially, the Petitioner's rights in "CENTURY 21" have been expressly recognised and protected by the Courts in India. The Petitioner has in support of this, placed reliance upon the decisions in ***Century 21 Real Estate LLC v. Sambit Basu & Ors***., ***Century 21 Real Estate LLC v. Kangkana Das, Century 21 Real Estate LLC v. Century 21 Builders and Promoters Pvt. Ltd.***, and ***Century 21 Real Estate LLC v. Alchemist Ltd. & Anr.*** to point out that the Delhi High Court has recognised the Petitioner's mark "CENTURY 21" as a well-known mark. Therefore, the reliance placed by Respondent No. 1 upon the decision of Delhi High Court in ***Century 21 Real Estate LLC v. Century 21 Main Realty Pvt Ltd.,*** is of no relevance since the said decision firstly predates the several decisions upon which the Petitioner has placed reliance and secondly, and also the observations contained therein were merely *prima facie* factual observation made on the basis of the material then before the Court at the interlocutory stage.

H. The Petitioner's reliance upon the decisions in ***Power Control Appliances v. Summet Machines Pvt. Ltd.***, ***MAC Personal Care Pvt. Ltd. v. Laverana***

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GMBH, Kanshiram Surinder Kumar v. Thakurdas Deomal Rohira, and ***M/s. Turning Point Institute Pvt. Ltd. v. Turning Point***, which holds that no amount of subsequent use can legitimise dishonest adoption, especially when the marks are identical, is entirely apposite to the facts of the present case.

I. The contention that the marks are dissimilar needs only to be stated to be rejected. This contention once again brings to the fore the dishonesty and inconsistency in the conduct of Respondent No. 1, since Respondent No. 1 has itself relied upon "CENTURY 21 TOWN PLANNERS" to assert rights in "C21", thereby acknowledging the association between the two. In any event, the Petitioner has, as noted in (D) and (E) above, demonstrated global and Indian registrations and use of "C21" as both a formative and standalone mark, Respondent No. 1 cannot therefore approbate and reprobate by drawing artificial distinctions for its defence while relying on the association for its benefit. In my view, given that it is clear that Respondent No. 1 is using "C21" as an abbreviation of "CENTURY 21" and the services offered by both parties, i.e., real estate,

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are identical and overlapping, and thus the likelihood of confusion and deception, the decisions in the case of ***B.K. Engineering Co. v. Ubhi Enterprises*** and ***Laxmikant V. Patel v. Chetanbhai Shah*** upon which reliance was placed by the Petitioner, would squarely apply**.** Also, as held in the case of ***Consolidated Foods Corporation v. Brandon Co. Pvt. Ltd.*** and ***Century Traders v. Roshan Lal Duggar & Co.*** registration does not create new rights but recognises and protects pre-existing common law rights, which clearly the Petitioner has established both in "CENTURY 21" and also in "C21", in addition to the statutory rights the Petitioner has in both.

J. It is also now well settled that domain name registration and use constitutes recognised use of a trade mark as confirmed by the Hon'ble Supreme Court in ***Satyam Infoway Ltd. v. Siffynet Solutions Pvt. Ltd.***, which held that a domain name functions as a business identifier and may amount to use in relation to services. In the present case, the Petitioner has set out use of the domain names internationally, "century21.com" and "c21.com" since the year 1995, and in India, "century21.co.in", "c21.in", and "century21.in"

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since 2006, 2010, and 2011, respectively, which clearly amounts to use as a trade mark, given this and also for the reason stated in (E) above, I find that the Respondent's reliance upon the extract from the book by ***Venkateswaran*** on ***Trademarks & Passing off*** is entirely misplaced.

K. The objections with regard to the alleged lack of stamping or want of notarisation of the franchise agreements, in my view, are clearly untenable and devoid of substance given the issue which falls for determination, namely whether the Petitioner has statutory and common law rights in "CENTURY 21" and "C21" in India. The agreements, when read in conjunction with the wealth of other material referred to in (E) and (G) above, sufficiently establish the Petitioner's presence and commercial engagement in India. Thus, the question of inadequacy of stamping or want of notarisation, even if valid, would be of no relevance. Such contention, if valid, might assume relevance in a civil lis between the parties to the said agreements but not for the purpose for which they have presently been relied upon by the Petitioner. Equally untenable is the contention that the franchise and sub-franchise agreements cannot be relied upon on the

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ground that only the first and last pages thereof have been produced. The Petitioner has produced the Franchise Agreements for the perusal of the Court alongwith the Petitioner's note. The Petitioner cannot reasonably be expected to disclose detailed commercial terms of such agreements to a competitor, particularly one whose adoption of the impugned marks has been found to be dishonest.

L. I find that the decisions in ***Toyota Jidosha Kabushiki Kaisha v. Prius Auto Industries Ltd.***, ***Broad Peak Investment Holdings Ltd. v. Broad Peak Capital Advisors LLP***, ***Toyota Jidosha Kabushiki Kaisha v. Tech Square Engineering Pvt. Ltd.***, and ***Du Pont De Nemours & Co. v. Zip Industries Pvt. Ltd.*** upon which reliance was placed by Respondent No. 1, would not apply to the facts of the present case. Firstly, as I have already noted in (A) and (B) above, the adoption of the impugned marks is dishonest. Additionally, as already noted in (D), (E) and (J) above, the Petitioner has placed substantial material on record demonstrating (i) international use since 1971; (ii) statutory registrations in India dating back to 1989; (iii) India-specific domain registrations from 2006 onwards; (iv) franchise and

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sub-franchise arrangements operating in India since 2007; and (v) media presence and listings on Indian platforms from 2007 onwards. Those decisions, which concerned cases where only stray or sporadic references to foreign reputation were produced, have therefore no application to the facts of the present case.

M. Also, the expression "use of a mark" as contemplated under Section 2(2)(c) of the Trade Marks Act is of wide import. In the context of services, it includes reference to the availability, provision, or performance of services in India. "Use" is therefore not confined to instances of direct sales but extends to demonstrable market presence and the offering of services within India, both of which the Petitioner has sufficiently established. The decisions in ***R.J. Components and Shafts v. Deepak Industries Ltd***. and ***Exide Industries Ltd. v. Exide Corporation***, relied upon by Respondent No. 1, would be of no assistance to Respondent No. 1 since those cases arise in the context of infringement and passing-off actions and not actions for rectification.

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44. Therefore, for the reasons set out in (A) to (M) above, the captioned Petitions deserve to succeed. Hence, the following Order is passed.

ORDER

i. The captioned Commercial Miscellaneous Petitions are allowed.

ii. The trade marks registered under No. 1941724 and 1941725 dated 26th March 2010, No. 1959526 dated 3rd May 2010 and No. 1957532 dated 29th April 2010 be removed from the trade marks register.

iii. There shall be no order as to costs.

iv. Interim Applications if any are accordingly disposed of.

[ARIF S. DOCTOR, J.]