



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

**Reserved on: 16<sup>th</sup> April, 2024.**  
**Date of Decision: 28<sup>th</sup> May, 2024.**

+ C.O. (COMM.IPD-TM) 92/2023, I.A. 3941/2023

JITENDRA KUMAR

..... Petitioner

Through: Mr. Abhinav Bhatia and Mr. Rishabh,  
Advocates.

versus

THE REGISTRAR OF TRADEMARKS, NEW DELHI & ANR.

..... Respondents

Through: Mr. Saroj Kumar Singh, Advocate for  
R-2.

Mr. Harish Vaidyanathan Shankar,  
CGSC with Mr. Srish Kumar Mishra  
and Mr. Alexander Mathai Paikaday,  
Advocates for R-1.

**CORAM:**

**HON'BLE MR. JUSTICE SANJEEV NARULA**

**JUDGMENT**

**SANJEEV NARULA, J.:**

1. This petition has been brought under Sections 47 and 57 of the Trademarks Act, 1999 to cancel the registration of the trademark “WHITE BOY,” registered under No. 4886714 in class 25, in favour of Respondent No. 2. The Petitioner, who attempted to register the same trademark “WHITE BOY” in the identical class just one day after Respondent No. 2’s application, challenges the validity of Respondent No. 2’s mark on the basis of prior user rights.



## **THE PETITIONER'S CASE**

2. Mr. Abhinav Bhatia, counsel for Petitioner, put forth the following facts and contentions for cancellation of the impugned registration:

2.1. The Petitioner established a sole proprietorship by the name of M/s White Boy Apparels in the year 2010 for manufacturing and trading in shirts under an arbitrary and fanciful trademark "WHITE BOY." The mark has been in continuous and uninterrupted use since 2010, and has become an integral element of the firm's commercial identity.

2.2. Petitioner applied for registration of the wordmark "WHITE BOY" in class 25 on 03<sup>rd</sup> March, 2021, with a user claim since 10<sup>th</sup> January, 2013 under application No. 4887214. The Examination Report issued by Respondent No. 1 [Registrar of Trademarks] on 17<sup>th</sup> March, 2021 cited Respondent No. 2's then pending application No. 4886714, filed on 02<sup>nd</sup> March, 2021, for her mark "WHITE BOY" in class 25 in relation to "*readymade garments, hosiery, under garments, sports wear clothing and footwears including uniforms, dresses, jeans, jackets, trackpants, leggings, shirts, t-shirts, trousers, suits, vests, coats, sherwanis, kurta, pyjamas, shawl, childrens clothing, mens & womens clothing, caps, hats, headwear, neckwear, socks, tops, lehenga, chunni, skirts, night-suits, innerwear, swimwear, bra, panties; tights; brassieres; blazers, gloves, socks, ties, woolen garments, boots, shoes and slippers included in class 25.*"

2.3. Respondent No. 2 filed her trademark application on a proposed-to-be-used basis. Notwithstanding, the Examination Report issued on 13<sup>th</sup> March, 2021 failed to acknowledge the Petitioner's earlier application, even though his claimed date of use predates that of Respondent No. 2. Overlooking the Petitioner's established priority claim to the trademark



“WHITE BOY,” Respondent No. 1 proceeded to advertise Respondent No. 2’s application in the Trademarks Journal on 28<sup>th</sup> June, 2021. This oversight subsequently led to the erroneous grant of registration to Respondent No. 2, despite the clear precedence of the Petitioner’s claim.

2.4. The Petitioner has, by virtue of long and continuous use as well as robust advertising and promotional activities, acquired immense goodwill and reputation under the trademark “WHITE BOY.” This mark being exclusively associated with the Petitioner, now carries a secondary meaning.

2.5. According to her trademark application, Respondent No. 2 had not yet begun using the “WHITE BOY” mark for the goods specified. Contrarily, the Petitioner has actively used this mark since founding of White Boy Apparels in 2010, unequivocally establishing him as the prior user. Pertinently, the Petitioner and the husband of Respondent No. 2 are competitors in the market. Given this relationship, it is reasonable to assume that Respondent No. 2 was well aware of the Petitioner’s extensive business operations. The deliberate choice by Respondent No. 2 to adopt an identical trademark for identical goods suggests a strategy tainted with bad faith, aimed at capitalizing on the Petitioner’s established goodwill and market reputation. This act of appropriation is designed to confuse consumers, leading them to believe there is an association or collaborative venture between the two parties. While evaluating and processing Respondent No.2’s application, Respondent No. 1 ought to have considered Section 11(10) of the Trademarks Act. Specifically, the potential for market confusion and the undermining of an established trademark should have been significant factors in the evaluation process.

2.6. Further, Respondent No. 2 has not presented any documents evincing



use of the mark “WHITE BOY” since the grant of registration. Thus, the impugned trademark must also be removed under Section 47 of the Trademarks Act for absence of *bona fide* intention to use the mark.

2.7. The impugned mark has been registered in favour of Respondent No. 2 without sufficient cause, and is liable to be cancelled for violating Sections 9, 11(1), 11(2), 11(3)(a), and 18 of the Trademarks Act.

### **CONTENTIONS OF RESPONDENT NO. 2**

3. Mr. Saroj Kumar Singh, counsel representing Respondent No. 2, opposed the Petitioner’s request by arguing as follows:

3.1. The husband of Respondent No. 2, Mr. Gaurav Dua, was the proprietor of the firm M/s White Boy Shirts, established on 01<sup>st</sup> April, 2007. The firm M/s White Boy Shirts was earlier trading in readymade garments under the mark “ENGLISH PREMIUM,” for which they secured a registration under No. 2054200 in class 25 *w.e.f.* 16<sup>th</sup> November, 2010. However, due to his ill-health, Mr. Gaurav Dua authorized his wife (Respondent No. 2) to use the brand name “WHITE BOY.” Resultantly, she applied for and secured the registration of trademark “WHITE BOY” on a proposed-to-be-used basis. In support, reliance was placed upon statement of the bank account opened on 05<sup>th</sup> June, 2007 in the name of White Boy Shirts, financial audit report of White Boy Shirts since 2007, and membership certificate of the Readymade Garments Cloth Dealers Welfare Association dated 04<sup>th</sup> May, 2011.

3.2. Admittedly, the date of filing of Respondent No. 2’s trademark application is prior to the Petitioner’s. Therefore, there is no illegality in the grant of registration to Respondent No. 2 as the same was granted following



the due procedure.

3.3. As Mr. Gaurav Dua, husband of Respondent No. 2, commenced using “WHITE BOY” mark prior to the Petitioner in the same field, Petitioner ought to have known about his existence.

3.4. Respondent No. 2 has, through investments in brand promotion and campaigns, created a formidable reputation and goodwill in the market. If the present petition is allowed, Respondent No. 2 will suffer grave losses.

### **ANALYSIS AND FINDINGS**

4. The Court has considered the afore-noted contentions and carefully examined the record. The grounds for seeking rectification of the Register raised by the Petitioner are four-fold: (a) they are the prior user of the trademark “WHITE BOY,” (b) the subsequent adoption and registration of identical trademark by Respondent No. 2 is prohibited by Sections 11(1), 11(2) and 11(3)(a) of the Trademarks Act, (c) the mark has been registered in Respondent No. 2’s favour without any *bona fide* intention of use, and (d) non-use since the grant of registration as per Section 47(1)(b) of the Trademarks Act. The strength of each of these arguments is elaborated upon in the succeeding paragraphs of the judgment.

### **Whether the impugned registration is barred by Section 11 of the Trademarks Act**

5. The Petitioner’s challenge to the impugned registration is predicated on violation of Section 11 sub-sections (1), (2) and (3). Section 11(1) and (2) prohibit registration of a trademark on account of its identity or similarity with an ‘earlier trademark.’ An ‘earlier trade mark’ is defined in the



explanation to Section 11 as follows:

*“(a) a registered trade mark or an application under section 18 bearing an earlier date of filing or an international registration referred to in section 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.”*

6. Thus, for the Petitioner to seek invalidation of registration of Respondent No. 2 under the afore-mentioned provisions, his trademark must satisfy the criterion delineated in the explanation. The Petitioner’s case falls short in this aspect as his trademark “WHITE BOY” is not registered and is not an application referable to Sections 18 (as his application was filed subsequent to Respondent No. 2) or 36E or 154 of the Trademarks Act. The Petitioner’s trademark also does not qualify for protection as a well-known trademark, nor is it his pleaded case. Therefore, the Petitioner’s mark cannot be considered as an ‘earlier trademark’ under Section 11(1) and (2).

7. Mr. Bhatia strongly contested the legitimacy of impugned registration, arguing that the use of the mark “WHITE BOY” by Respondent No. 2 amounts to passing off of Petitioner’s trademark in the course of trade. Referring to Section 11(3)(a) of the Trademarks Act, he contended that the Court must cancel Respondent No. 2’s registration. Section 11(3)(a) aims to prevent the registration of a mark if its use in India could be prohibited by the law of passing off protecting unregistered trademarks. Under Indian trademark law, the doctrine of ‘passing off’ is a common law action designed to prevent entities from using a trademark with the intent to



mislead customers and divert business by capitalizing on the goodwill established by another entity. Section 11(3)(a) of the Trademarks Act explicitly recognizes the action of passing off. This legal safeguard prevents the registration of a trademark if its use in India could potentially violate the rights associated with an unregistered trademark actively used in commerce. Essentially, this clause ensures that the rights of those who have not registered their mark, but have established their reputation through actual use, are protected from infringement by newcomers seeking registration. However, the burden of proving passing off lies with the opponent. They must convincingly establish the legal criteria of passing off –demonstrating that they had goodwill in India on the date of the relevant application, that there would be misrepresentation from the use of the proposed trademark, and that such misrepresentation would result in damage to their business or goodwill.<sup>1</sup>

8. The Petitioner has not satisfied the fundamental requirement of demonstrating established goodwill in the market. They have failed to provide any supporting documentation, such as sales figures, promotional materials, or customer testimonials, to substantiate their claim of having acquired a significant reputation and goodwill among consumers and in the marketplace. The stringent standard for proving reputation in passing off cases necessitates that the claimant must convincingly demonstrate that the relevant consumer segment uniquely identifies the goods with them.<sup>2</sup> This critical association has not been established in the present case. The Petitioner's bare assertions in the petition, sans any underpinning material,

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<sup>1</sup> Refer: K.C. Kalisan, *Law of Trademarks*, fourth ed.

<sup>2</sup> Refer: *Laxmikant V. Patel v. Chetanbhat Shah and Anr.*, 2002 (3) SCC 65.



are insufficient to discharge their onus to establish a potential case of passing off, envisaged under Section 11(3)(a) of the Trademarks Act.

**The challenge under Section 47 of the Trademarks Act**

9. Turning now to Section 47 of the Trademarks Act, which envisions two scenarios for the removal of a trademark from the Register – (a) when the trademark has been registered without a *bona fide* intention on the part of the applicant to use the mark in relation to specified goods or services, and that there has been no *bona fide* use of the mark until a period of three months before the date of the application, and (b) where the mark has not been used by the registrant for a continuous period of five years from the date of grant of registration up till three months before the date of the application seeking rectification. Concededly, the statutory timeframe prescribed in Section 47(1)(b) has not yet expired. Thus, at this juncture, the Petitioner cannot invoke the said provision to seek cancellation of Respondent No. 2’s registration.

10. Section 47(1)(a) of the Trademarks Act imposes a rigorous standard on the opponent in a trademark cancellation case, requiring substantial and convincing evidence to demonstrate that the trademark registrant lacked a *bona fide* intention to use the trademark. In evaluating this ground, the Courts finds that the Petitioner has not successfully proven that Respondent No. 2 had no genuine intention to utilize the trademark “WHITE BOY.” Contrarily, the fact that the husband of Respondent No. 2 operated a business under the name ‘M/s White Boy Shirts’ provides a plausible explanation for Respondent No. 2’s choice of the impugned trademark. Consequently, the petition fails to meet the rigorous criteria set forth in





Section 47 of the Trademarks Act, as it does not persuasively demonstrate a lack of *bona fide* intent on the part of Respondent No. 2.

**Validity of impugned registration vis-à-vis Section 9(2)(a) of the Trademarks Act**

11. Section 9(2)(a) entails an absolute proscription on the registration of a mark if it is potentially deceptive or capable of causing confusion. In the case at hand, the contesting marks are indistinguishable and are used on identical products namely, garments categorized under class 25. These resemblances accentuate the likelihood of consumers being confused about the origin of the goods. In these circumstances, if the Petitioner succeeds in proving their status as the earlier user of the “WHITE BOY” trademark, as canvassed, then the subsequent registration of an identical mark by Respondent No. 2 will inevitably need to be removed from the Register of Trademarks.

**Petitioner’s use of the trademark “WHITE BOY”**

12. The Petitioner has filed on record the following documents to establish their prior adoption and use and purported goodwill and reputation in the clothing market:

- (a) Order for registration of White Boy Apparels under the DVAT and CST Act dated 23<sup>rd</sup> July, 2010.
- (b) Certificate of Central Sales Tax Registration in the name of White Boy Apparels dated 23<sup>rd</sup> July, 2010, authorizing the firm to trade in readymade garments/ clothes.
- (c) Membership certificates issued to the Petitioner, proprietor of White Boy Shirts, by the Readymade Garments and Cloth Dealers Welfare



Association (Regd.), attesting that Petitioner conducts the business of readymade garments/ clothes.

(d) Statement of bank accounts held in the name of White Boy Apparels with HDFC Bank that were opened on 21<sup>st</sup> September, 2013 and 19<sup>th</sup> July, 2014.

(e) CST Form of declaration (Form C) for the third-quarter of the financial year 2014-2015.

(f) Form DP-1 filed on 24<sup>th</sup> March, 2015 with the Department of Trade and Taxes, Government of NCT of Delhi.

(g) Form DVAT-16 of 31<sup>st</sup> March, 2016 filed by White Boy Apparels with the Department of Trade and Taxes, Government of NCT of Delhi.

(h) Form DVAT-56 dated 24<sup>th</sup> January, 2017 filed by White Boy Apparels with the Department of Trade and Taxes, Government of NCT of Delhi.

(i) GST registration certificate of White Boy Apparels issued on 16<sup>th</sup> July, 2018.

(j) Notice for Appearance under the Minimum Wages Act, 1948 and Delhi Shops and Establishments Act, 1954 issued by the Office of Joint Labour Commissioner, Karampura, New Delhi to White Boy Apparels on 26<sup>th</sup> February, 2019.

(k) Invoices evincing sale of garments under the trademark “WHITE BOY” between the years 2020 to 2022.

13. The documentary evidence presented confirms that the Petitioner established a proprietary firm named ‘White Boy Apparels’ in 2010 for the production of readymade apparel. Since its inception, the firm has been actively engaged in commercial activities within this industry. While the



documentation from 2010 to 2019 does not explicitly demonstrate the use of the “WHITE BOY” trademark on the products, it unequivocally shows that the firm operated under the business name ‘White Boy Apparels.’ This leads to a critical legal question: does using “WHITE BOY” as a trade name qualify as trademark use, and would this use afford the Petitioner the benefits of prior use dating back to 2010?

14. Under Section 2(1)(m) of the Trademarks Act, the definition of a ‘mark’ includes a name, which arguably encompasses a trading name of an entity. Additionally, Section 2(1)(zb) defines a ‘trademark’ as a mark that can be graphically represented and serves to distinguish one person’s goods or services from those of others. It is common practice for businesses to use their corporate names not just as identifiers of the business entity, but also as source identifiers for their goods or services, thereby functioning as trademarks.<sup>3</sup> Thus, a trade name can effectively be interpreted as a trademark under the relevant legal definitions and precedents. Supporting this interpretation, Kerly’s Law of Trademarks and Trade Names also posits that the name chosen by a businessperson for conducting their trade or business activities is almost always considered a trademark.<sup>4</sup> Thus, in the Court’s opinion, the lack of evidence depicting direct use of “WHITE BOY” by the Petitioner on products for the initial period does not debilitate their claim of continuous trademark use since 2010, as a trade name also qualifies for trademark protection.<sup>5</sup>

15. The Petitioner has further bolstered their assertion of continuous

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<sup>3</sup> Refer: Vol. 1, *McCarthy on Trademarks*, §9:3.

<sup>4</sup> See: *Kerly’s Law of Trademarks and Trade Names*, 16<sup>th</sup> Edn., para 16.49.

<sup>5</sup> Refer: *Laxmikant (Supra)* and *Kala Niketan v. Kala Niketan*, 1981 SCC OnLine Del 261.



commercial use by submitting tax invoices that demonstrate the sale of “WHITE BOY” shirts to third parties since 2020. These invoices lend strong support to the Petitioner’s claim of active trademark usage. In stark contrast, Respondent No. 2 filed the application for registration of the impugned trademark on a proposed-to-be-used basis, indicating her intention to use the mark only in the future. Moreover, Respondent No. 2 has failed to provide any documentary proof to demonstrate the use of the trademark “WHITE BOY” before or after the grant of registration. Respondent No. 2 has predicated the adoption of an identical mark on the use of ‘White Boy’ by her husband in the trading name ‘White Boy Shirts.’ It has been averred that husband of Respondent No. 2 authorized her to use the said mark, however, no documentation has been produced before Court to maintain this contention. The fact that the registration was applied on a proposed-to-be-used basis raises significant doubts about the validity of this alleged authorization to Respondent No. 2 to use the trademark “WHITE BOY” for her to take benefit of the alleged use of the mark by her husband. The narrative is further complicated by Respondent No. 2’s own case that her husband had earlier been using the trademark “ENGLISH PREMIUM” to conduct their business activities. Given the lack of corroborative evidence from Respondent No. 2, the Court finds that the Petitioner’s documented and sustained use of the trademark “WHITE BOY” since 2010 clearly establishes them as the prior user. This prior use, substantiated by sales data, outweighs the unverified and future-oriented intentions of Respondent No. 2, leading to the conclusion that the Petitioner holds the rightful claim to the trademark “WHITE BOY.”



## **CONCLUSION AND DIRECTIONS**

16. In view of the foregoing discussion, the Petitioner has established that he is the prior and continuous user of the trademark “WHITE BOY” since 2010. Consequently, the registration of an identical mark in the name of Respondent No. 2 is untenable, as it is likely to deceive the public or cause confusion, thus contravening the principles intended to protect consumers, set forth in the Trademarks Act. This finding is in accordance with the provisions of Section 9(2)(a) of the Trademarks Act.

17. Accordingly, the present petition is allowed and the following directions are issued:

17.1. Registration of the mark “WHITE BOY” under No. 4886714 in class 25 is cancelled.

17.2. Trademarks Registry shall issue an appropriate notification to the above effect.

18. Registry is directed to supply a copy of the present order to Trademarks Registry at llc-ipo@gov.in for compliance.

19. With the above directions, the petition is disposed of.

**SANJEEV NARULA, J**

**MAY 28, 2024**

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