



2025:DHC:5103



* IN THE HIGH COURT OF DELHI AT NEW DELHI

%

+

*Reserved on: May 26, 2025
Pronounced on: July 01, 2025*

C.O. (COMM.IPD-TM) 279/2023

MAJOR LEAGUE BASEBALL PROPERTIES INC

.....Petitioner

Through: Mr. Urfee Roomi, Ms. Janki
Arun and Mr. Jaskaran Singh, Advs.

Versus

MANISH VIJAY & ORS.

....Respondents

Through: Mr. Mohan Vidhani, Ms. Nidhi
Pandey, Mr. Saurabh Kumar, Ms.
Shreya Jain and Ms. Mokshita
Gautam, Advs. for R-2.
Ms. Nidhi Raman, CGSC with Mr.
Arnav Mittal and Mr. Akash
Mishra, Advs. for R-3/UOI.

CORAM:

HON'BLE MR. JUSTICE SAURABH BANERJEE

J U D G M E N T

Preface:

1. The petitioner, by way of the present rectification petition filed under *Section 57* of the Trade Marks Act, 1999¹, seeks cancellation of the trademark 'BLUE-JAY' registered in favour of the respondent nos.1 and 2 *vide* trademark application no.815236 in *Class 25*, and its consequent removal from the Register of Trade Marks.

Brief Facts:

2. The petitioner is a company duly organised and existing under the laws of the State of New York, USA, having its address at 1271, Avenue

¹Hereinafter referred as "*TM Act*"



2025:DHC:5103



of the Americas, New York, NY 10020, United States of America. The petitioner is the intellectual property holding company of Major League Baseball² and controls the licensing and merchandising of all MLB Clubs as well as the affiliated entities of MLB.

3. The petitioner adopted the trademark 'BLUE JAYS'/ 'TORONTO BLUE JAYS' in 1976 in connection with the MLB franchise based in the city of Toronto and has since continuously using the trademark and its variations. Moreover, the petitioner's trademark has been registered in numerous jurisdictions and countries around the world, including the USA, UK, EU, Australia, Brazil, China, and South Korea, among others.

4. Relevantly, the petitioner being the owner of various iterations of BLUE JAYS mark(s)³ in India, has filed the following applications:

S. No.	Mark	App/ Reg. No.	Class	Date of Filing
1.	TORONTO BLUE JAYS	499182	25	11.10.1983
2.	TORONTO BLUE JAYS	499209	16	11.10.1988
3.		499156	16	11.10.1988
4.		499259	25	11.10.1988
5.		5245514	41	13.12.2021
6.		5245513	41	13.12.2021


²Hereinafter referred as "*MLB*"

³Hereinafter collectively referred as "*BLUE JAYS marks*"



2025:DHC:5103



7.		5319401	25	08.02.2022
----	---	---------	----	------------

5. Additionally, the petitioner maintains its official websites viz. <https://www.mlb.com> and www.mlb.com/bluejays, through which its merchandise and services are made available to consumers all around the world. The petitioner also has a substantial presence across various social media platforms.

6. The respondent nos.1 and 2 are the partners of a partnership firm trading as M/s. PMS Creations, having its address at 70B/32 A, Rama Road Industrial Area, New Delhi-110015 and are engaged in manufacturing and trading of shirts, blazers, suits, waist coats, pants, trousers, jeans, jackets and readymade garments and other allied and cognate goods under the impugned mark 'BLUE-JAY'. The respondent no.3 is the Registrar of Trade Marks.

7. The present dispute arises out of the adoption of the impugned mark 'BLUE-JAY' by Mr. Ajay Kumar Gupta and Mr. Sumit Vijay, trading as A.S. Creation⁴, who, after adopting the said mark, applied for its registration on a '*proposed to be used*' basis *vide* application no.815236 on 19.08.1998 in *Class 25*. The said mark was subsequently advertised in Journal No.9999-0, and was published on 25.08.2003.

8. Upon becoming aware of the advertisement of the impugned mark 'BLUE-JAY', the petitioner filed a Notice of Opposition on 03.02.2004, in response to which the erstwhile applicants filed their Counter Statement on 09.11.2004.

⁴Hereinafter referred as the "*erstwhile applicants*"



9. In the meanwhile, the erstwhile applicants, by virtue of an Assignment Deed dated 22.07.2011, assigned the impugned mark 'BLUE-JAY' in favour of M/s. PMS Creations, of which respondents nos.1 and 2 are partners.

10. As the petitioner was unable to file its evidence in support of the Notice of Opposition within time, it filed an Interlocutory Petition seeking condonation of delay in filing the same. However, the Deputy Registrar of Trade Marks *vide* its order dated 08.10.2015, held that the Notice of Opposition was deemed to have been abandoned and accordingly dismissed the same. Aggrieved thereby, the petitioner preferred an appeal *vide* Appeal no.OA/6/2016/TM/DEL before the erstwhile Intellectual Property Appellate Board, however, after its abolition, the same was transferred to this Court and was numbered as C.A.(COMM.IPD-TM) 152/2022.

11. Meanwhile, since the impugned mark 'BLUE-JAY' proceeded for registration on 08.06.2017, this Court, *vide* its order dated 25.09.2023, while disposing of C.A.(COMM.IPD-TM) 152/2022, permitted the petitioner to pursue remedies by way of a cancellation petition. Hence, the present cancellation petition.

Submissions of the petitioner:

12. Mr. Urfee Roomi, learned counsel for the petitioner submitted as under:

12.1. The petitioner, in the year 1976, honestly adopted the trademark 'BLUE JAYS' for the MLB franchise/ Club for the city of Toronto and has been continuously using the mark and its variations to identify, promote, and advertise the said Club. The said trademark has been



consistently depicted on the Club's uniform, the Stadium, where the Club's games were played, and is extensively used in relation to a wide variety of goods and services associated with the Club.

12.2. As a result, 'BLUE JAYS' marks of the petitioner have acquired substantial, irrefutable, and insurmountable reputation and goodwill globally and also attained the status of well-known trademark, and the reputation and goodwill thereof has spilled over into India through broadcast of MLB games, widespread media coverage and accessibility of the petitioner's websites. Reliance in this regard was placed upon *Milmet Oftho Industries v. Allergan Inc.*⁵ and *N.R. Dongre v. Whirlpool Corporation*⁶.

12.3. Furthermore, the petitioner has secured/ filed for 170 trademark registrations for 'BLUE JAYS' marks all over the world, including in leading jurisdictions such as the USA, UK, EU, Australia, Brazil, China, South Korea, etc. In India, it has previously held/ currently holds and has applied for registration for the 'BLUE JAYS' marks under various Class(s). Notably, the earliest application for registration of the 'BLUE JAYS' mark was filed in the year 1983.

12.4. The petitioner is the '*prior adopter*' and '*prior user*' of the 'BLUE JAYS' marks, as the respondent nos.1 and 2's application for registration of a deceptively similar/ nearly identical mark 'BLUE-JAY' was filed almost 22 years after the petitioner adopted and continuously using its mark. By that time, the petitioner's 'BLUE JAYS' marks had already acquired significant reputation and goodwill in India and the only

⁵2004 (12) SCC 624

⁶1996 (5) SCC 714



plausible reason for the respondent nos.1 and 2 for adopting nearly identical impugned mark 'BLUE-JAY' and that too in respect of identical goods, was to ride upon the goodwill and reputation of the petitioner and to confuse the consumers as to the source of the goods. Thus, registration of the mark 'BLUE-JAY' cannot be said to be honest.

12.5. In addition, the respondent nos.1 and 2's bad faith behind adoption of the impugned mark 'BLUE-JAY' is exacerbated by the fact that, in its reply to the present petition, the respondent nos.1 and 2 conjured up a novel and imaginative explanation that the impugned mark was inspired from a resort in Panipat, Haryana, which was never their case and is a new introduction for the first time. Therefore, the impugned registration is tainted with bad faith and thus violative of *Section 11(10)(ii)* of the Act. Reliance in this regard was placed upon *BPI Sports LLC v. Saurabh Gulati & Anr.*⁷, *Kia Wang v. The Registrar of Trade Marks & Anr.*⁸ and *Abdul Rasul Nurallah Virjee and Jalalluddin Nurallah v. Regal Footwear*⁹.

12.6. Moreover, since consumers solely associate the trademark 'BLUE JAYS' with the petitioner, they are bound to mistakenly associate goods bearing the impugned mark 'BLUE-JAY' with the petitioner only, thereby causing substantial damage to the petitioner's goodwill and reputation. Reliance in this regard was placed on *B.K. Engineering v. Ubhi*

⁷2023:DHC:2920

⁸2023:DHC:6684

⁹2023 SCC OnLine Bom 10



*Enterprises*¹⁰ and *Corn Products Refining Co. v. Shangrila Food Products Ltd.*¹¹.

12.7. Lastly, the respondent nos.1 and 2 cannot take advantage of the alleged sales made from the impugned mark ‘BLUE-JAY’, as they are not the *bona fide* adopter thereof, and because the very adoption of the impugned mark is tainted with bad faith.

Submissions of the respondent nos.1 and 2:

13. Mr. Mohan Vidhani, learned counsel for the respondent nos.1 and 2 refuting the contentions of the learned counsel for the petitioner, submitted as under:

13.1. The mark ‘BLUE-JAY’ was adopted independently and in good faith by the respondent nos.1 and 2 in the year 1998, without any inspiration from the ‘BLUE JAYS’ marks of the petitioner. Since its adoption, the respondent nos.1 and 2 have made considerable effort and incurred substantial expenditure for the promotion of the mark ‘BLUE-JAY’, as a result of which, the mark has, over the time, acquired distinctiveness and substantial goodwill amongst the consumers in India. In contrast, any reputation and goodwill claimed by the petitioner in respect of the ‘BLUE JAYS’ marks is exclusively limited to the United States of America and Canada, and there is no spill over of reputation or goodwill of the petitioner’s marks among the Indian consumers as the baseball is neither popular nor widely followed in India.

13.2. The petitioner’s ‘BLUE JAYS’ marks do not qualify as a well-known trademark under *Section 11(6)* of the TM Act. Nevertheless, any

¹⁰AIR 1985 DELHI 210

¹¹1959 SCC OnLine SC 11



alleged international reputation of the petitioner's mark is of no relevance in India, as the petitioner has failed to provide any documentary evidence to suggest that BLUE JAYS marks were/ are known in India. Notably, the petitioner does not have any offices, stores, or operations in India, clearly indicating absence of any business activity associated with the petitioner's 'BLUE JAYS' marks in India. The petitioner's reliance on social media presence alone, in the absence of any evidence of actual use, is insufficient to establish its reputation in India.

13.3. In addition, the petitioner presently does not hold any valid registration for the mark 'BLUE JAYS' in *Class 25* in India and the registrations cited by the petitioner were filed on a '*proposed to be used*' basis and were not renewed before the respondent nos.1 and 2 adopted the mark 'BLUE-JAY', thereby further evidencing the petitioner's non-use of the 'BLUE JAYS' marks in India. On the other hand, the respondent nos.1 and 2 have maintained a valid registration for the mark 'BLUE-JAY' in *Class 25* since 1998 and continue to use it in relation to their business. Therefore, the respondent nos.1 and 2 are the '*prior adopter*' and '*prior user*' of the impugned mark 'BLUE-JAY' in respect of readymade garments under *Class 25*.

13.4. Lastly, since the respondent nos.1 and 2's impugned mark BLUE-JAY is specific to readymade garments, a category which is unrelated to the petitioner's claimed activities, and there is no likelihood of confusion amongst the consumers, hence any claim of harm is baseless and unfounded.

13.5. To buttress all of the aforesaid contentions, reliance was placed upon ***Toyota Jidosha Kabushiki Kaisha v. M/S Prius Auto Industries***



*Limited*¹², *Trustees of Princeton University v. Vagdevi Educational Society*,¹³ and *Pioneer Nuts & Bolts v. Goodwill Enterprises*¹⁴.

Rejoinder submissions of the petitioner:

14. In response thereto/ rejoinder, Mr. Urfee Roomi, learned counsel for the petitioner reiterated his submissions, as captured hereinabove, and further advanced his submissions as under:

14.1. Baseball has significant presence in India for decades and over the years, such reputation has exponentially been increased.

14.2. Moreover, filing of an application on a ‘*proposed to be used*’ basis by the petitioner cannot preclude it from asserting that its ‘BLUE JAYS’ marks have been in use prior to the date of filing of the said application, if demonstrated with sufficient proof. Reliance in this regard was placed on *The Trustees of Princeton University v. Vagdevi Educational Trust (Supra)*

14.3. Not continuing with its application no.5245514 in *Class 25* for the trademark ‘BLUE JAYS’ was solely to ensure that its application no.5245514 in *Class 41* would proceed on time. The same cannot be extrapolated as a concession by the petitioner not to use the same in respect of *Class 25*. In any event, the very fact that the petitioner is pursuing the instant cancellation petition establishes that it has every intention to use its trademark ‘BLUE JAYS’ in *Class 25*.

¹²(2018) 2SCC 1

¹³2023:DHC:6420

¹⁴ILR (2010) 1 Delhi 738



Analysis and Reasoning:

15. This Court has heard Mr. Urfee Roomi, learned counsel for the petitioner, as also Mr. Mohan Vidhani, learned counsel for the respondent nos.1 and 2, perused the pleadings along with the relevant documents filed in support thereof and gone through the judgments cited at the Bar.

16. *Succinctly put*, the petitioner seeks cancellation of registration of the impugned mark 'BLUE-JAY' in *Class 25* on the ground that it is the '*prior adopter*' and '*prior user*' of the trademark 'BLUE JAYS', as such, has superior right over the respondent nos.1 and 2; and also that the respondent nos.1 and 2 have dishonestly adopted nearly identical/deceptively similar impugned mark 'BLUE-JAY' with the sole intention to ride upon the goodwill and reputation of the petitioner and thus the impugned registration is liable to cancelled.

17. While considering a petition seeking cancellation/ rectification of a trademark, its adoption, *per se*, particularly, when the same is pertaining to identically similar goods/ services falling within the same Class, is a vital issue of prime importance. Therefore, that the petitioner first applied for the mark 'BLUE JAYS' on a '*proposed to be used*' basis in *Class 25* only to give it up, and that subsequently the respondent nos.1 and 2 applied for the impugned mark 'BLUE-JAY' also in *Class 25* claiming to have an extensive usage thereof, is to be considered.

18. It is well settled that the circumstances of adoption of the trademark are of significant importance and where the very adoption of the mark is tainted with dishonest intention, no subsequent user or volume of sales can



clean the vices of dishonesty. Romer J. in *J.R. Parkington & Co. Ltd.*¹⁵ observed the aforesaid in the following words:

“The circumstances which attend the adoption of the trade mark in the first instance are of considerable importance when one comes to consider whether the use of that mark has or has not been an honest user. If the user in its inception was tainted, it would be difficult in most cases to purify it subsequently.”

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

¹⁵(1946) 63 RPC 171



region. When Mr. Ajay Gupta and Mr. Sumit Vijay decided to start the business and was looking for a trade mark to be adopted in respect of the goods, Mr. D. K. Vijay suggested the name of BLUE-JAY which is also the name of a very famous bird of North America. Hence, it was decided by Mr. Ajay Kumar Gupta and Mr. Sumit Vijay to adopt the trade mark BLUE-JAY... ..". This shows that the respondent nos.1 and 2 have now concocted an entirely new explanation/ story about the reason/ justification for adoption of the impugned mark 'BLUE-JAY'.

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

21. Moreover, it is also relevant to note here that the only distinction between the rival marks, 'BLUE JAYS' of the petitioner and 'BLUE-JAY' of the respondent nos.1 and 2, is that the respondent nos.1 and 2 have merely omitted letter 'S' from "JAYS" and inserted a hyphen '-' between the words 'BLUE' and 'JAY'.

22. Considering the aforesaid, as also that the whole case of the petitioner vested on the impugned mark 'BLUE-JAY' being identically



similar to its 'BLUE JAYS' marks, the respondent nos.1 and 2 ought to have been more cautious, careful, if not specific.

23. Thus, the adoption *per se* of the impugned mark 'BLUE-JAY' by the respondent nos.1 and 2 was/ being shrouded under a dark cloud of suspicion, the same was/ is bad and without any cogent/ plausible reason(s)/ justification(s).

24. *Qua* the petitioner being a 'prior user', it is pertinent to note that respondent nos.1 and 2 have nowhere denied nor is it their case, that they were unaware of the petitioner and/ or its trademark 'BLUE JAYS', or that petitioner is not a prior world-wide user of the trademark 'BLUE JAYS'. The only defence sought to be raised by the respondent nos.1 and 2 is that the petitioner has no spill over reputation in and to the trademark 'BLUE JAYS', and that it does not hold any registration in *Class 25*, unlike the respondent nos.1 and 2, as the petitioner had abandoned its application for the said trademark in the said *Class*. In view thereof and even otherwise, the respondent nos.1 and 2 dealing with the goods in *Class 25* were/ are always aware of the trademark 'BLUE JAYS' of the petitioner. The petitioner has also applied for registration of the trademark 'BLUE JAYS' in *Class 25*, much before the respondent nos.1 and 2's application for the impugned mark 'BLUE-JAY' in the same *Class*. It is thus highly unlikely that the respondent nos.1 and 2 were unaware of the petitioner's trademark 'BLUE JAYS' when they were applying for registration of the impugned mark 'BLUE-JAY'.

25. Under such a scenario, it was incumbent for the respondent nos.1 and 2 to have come up with a plausible reason/ sufficient justification for adopting the impugned mark 'BLUE-JAY', as the same was/ is, in more



than one way, close enough to the petitioner's trademark 'BLUE JAYS', so as to create a likelihood of its association with the petitioner.

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

27. Even otherwise, it is well established that the rights of a '*prior user*' override the right of a subsequent user, even if it involves a registered trademark. The rule of being a '*first user*' is a seminal part of the TM Act and, in fact, has been recognized. So much so, the Hon'ble Supreme Court held in ***Neon Laboratories Ltd v. Medical Technologies Ltd. & Ors.***¹⁶ that the right of a '*prior user*' is superior to a registrant of the trademark and observed as under:-

¹⁶2016 (2) SCC 672



“11.The “first in the market” test has always enjoyed pre-eminence. We shall not burden this judgment by referring to the several precedents that can be found apposite to the subject. In the interest of prolixity we may mention only N.R. Dongre v. Whirlpool Corpn. [N.R. Dongre v. Whirlpool Corpn., (1996) 5 SCC 714] and Milmet Oftho Industries v. Allergan Inc. [Milmet Oftho Industries v. Allergan Inc., (2004) 12 SCC 624] In Whirlpool [N.R. Dongre v. Whirlpool Corpn., (1996) 5 SCC 714] , the worldwide prior user was given preference nay predominance over the registered trade mark in India of the defendant. In Milmet [Milmet Oftho Industries v. Allergan Inc., (2004) 12 SCC 624] , the marks of pharmaceutical preparation were similar but the prior user worldwide had not registered its mark in India whereas its adversary had done so. This Court approved the grant of an injunction in favour of the prior user. Additionally, in the recent decision in S. Syed Mohiden v. P. Sulochana Bai [S. Syed Mohiden v. P. Sulochana Bai, (2016) 2 SCC 683 : (2015) 7 Scale 136] this Court has pithily underscored that the rights in a passing-off action emanate from common law and not from statutory provisions, nevertheless the prior user's rights will override those of a subsequent user even though it had been accorded registration of its trade mark... ..”

[Emphasis supplied]

28. Furthermore, this Court in **Innovolt Inc v. Kevin Power Solutions Ltd.**¹⁷ and in **Icrave, LLC v. Icrave Design Pvt. Ltd.**¹⁸, has emphasised that determinative test for establishing ‘prior user’ is identifying who was the first to adopt and use the mark in the ‘world market’.

29. In the present proceedings, *admittedly*, the respondent nos.1 and 2 adopted the impugned mark ‘BLUE-JAY’ only in the year 1998, i.e., approximately 22 years after the adoption of the trademark ‘BLUE JAYS’ by the petitioner. In support thereof, the respondent nos.1 and 2 have merely filed self-serving documents in the form of an Assignment Deed dated 22.07.2011 and two Sole Selling Agency Agreement(s) dated 01.04.2002 and 01.04.2005 respectively wherein though the impugned

¹⁷2015 SCC OnLine Del 13730

¹⁸2013 (1) R.A.J. 618(Del)



mark 'BLUE-JAY' are mentioned, however, there are no supporting document(s) showing any corroborative evidence of use thereof. Each of the aforesaid documents was executed much later. In fact, the other documents like the Chartered Accountant certificate, advertisement in magazines, and Invoices bearing the impugned mark 'BLUE-JAY' are all post 2011. This Court while dealing with similar issue regarding the relevance of such documents in *Jolen Inc. v. Doctor & Company*¹⁹ held as follows:

"As regards advertisements, sales figure in respect of sale of cosmetic cream of the Defendant in India from 1981 to 1983, it is of no relevance if the adoption of the trademark is subsequent, tainted and dishonest. In such a case even long user, reasonable reputation and goodwill of the trademark cannot vest the right in the Defendant to protect it."

[Emphasis supplied]

30. The aforesaid documents, when the adoption of the impugned mark 'BLUE-JAY' by the respondent nos.1 and 2 *per se* is shrouded under a dark cloud of suspicion, are merely showing a subsequent use and are, thus, hardly of any relevance and cannot come to the aid of the respondent nos.1 and 2. They hardly evoke any confidence in this Court to count them as usage of the impugned mark.

31. In the light of the aforesaid, *particularly*, considering the dark clouds shrouded over the adoption of the impugned mark 'BLUE-JAY' by the respondent nos.1 and 2, its close resemblance with the petitioner's trademark 'BLUE JAYS', and its suspicious usage for the garments covered in *Class 25* collectively establishes that the adoption thereof was not *bona fide* but was rather tainted with dishonest intention to ride upon

¹⁹98(2002)DLT76



the goodwill and reputation of the petitioner. When the element of ‘*bad faith*’ in adoption is so evident, the petitioner is entitled to the benefit of *Section 11(10)(ii)* of the TM Act as it mandates the Registrar of Trade Marks to take the same into account, more so, if it is affecting the rights of a party relating to a trademark. This Court in *BPI Sports LLC (supra)*, while dealing with what constitutes ‘*bad faith*’, held as under:-

47. “*Bad faith*” is not defined in the Trade Marks Act. Courts have, however, cogitated on the concept, in the context of trade mark law. The court of Appeals of England and Wales, in *Harrison v. Teton Valley Trading Co. Ltd.* [*Harrison v. Teton Valley Trading Co. Ltd.*, (2004) 1 WLR 2577], observed thus:

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

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

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



30. In the *Senso Di Donna Trade Mark case C0006716979/1* [*Senso Di Donna Trade Mark case C0006716979/1 2001 ETMR 5*], the first cancellation division said:

17. *Bad faith is a narrow legal concept in the CTMR system. Bad faith is the opposite of good faith, generally implying or involving, but not limited to actual or constructive fraud, or a design to mislead or deceive another, or any other sinister motive. Conceptually, bad faith can be understood as a 'dishonest intention'. This means that bad faith may be interpreted as unfair practices involving lack of any honest intention on the part of the applicant of the CTM at the time of filing. Example: if it can be shown that the parties concerned had been in contact, for instance at an exhibition in the respective trade, and where then one party filed an application for a CTM consisting of the other party's brand, there would be reason to conclude bad faith. In this case, however, according to the meaning of the term 'bad faith', there is no evidence that Senso di Donna Vertriebes-GmbH was acting dishonestly or that they intended any similar act, or were involved in unfair practices or the like.*

31. *To similar effect was the decision in Lancôme Parfums et Beauté and Cie's Trade Mark case [Lancôme Parfums et Beauté and Cie's Trade Mark case, 2001 ETMR 89]."*

32. In effect, the '*purpose*' of adoption of a trademark plays a very important role, and for this, a purposive interpretation has to be given. If the '*purpose*' of adoption of a trademark is found to be in doubt, it can be inferred that the registration of the trademark is tainted in '*bad faith*' and the same may be taken off the Register of Trade Marks.

33. What emerges from the forgoing is that '*bad faith*' constitutes an '*unfair practice*' involving lack of honest intention. It is a deliberate wrongdoing and not merely an inadvertent mistake. When one examines the adoption of the impugned mark by the respondent nos.1 and 2 herein,



there is no shred of doubt that the same was indeed dishonest and in '*bad faith*' and is thus liable to be cancelled and removed from the Register of Trade Marks.

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

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



basis by the petitioner, however, as held in *Trustees of Princeton University (supra)* the actual usage, if any, prior in point of time can be established by sufficient/ ample evidence. As held hereinabove, the petitioner has been able to show sufficient proof thereof.

36. Abandonment of an application for registration of a trademark by an Opponent/ Person Aggrieved like the petitioner, *per se*, cannot be a bar/ impediment for it to proceed for cancellation/ rectification of any mark (wrongly) remaining in the Register of Trade Marks against any third party like the respondent nos.1 and 2. In the present proceedings, though it was/ is not required, however, the petitioner has been able to give a plausible reason/ justification for abandoning its application for registration of the trademark 'BLUE JAYS' in *Class 25*. Furthermore, it is also not mandatory under *Section 57* of the TM Act that an Opponent/ Person Aggrieved like the petitioner, has to be a Registered Proprietor of a trademark in the same Class as the Registrant like the respondent nos.1 and 2.

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

Conclusion:

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



2025:DHC:5103



mark 'BLUE-JAY' registered *vide* application no.815236 in *Class 25* from the Register of Trade Marks.

39. The present petition is accordingly allowed and disposed of, leaving the parties to bear their own costs.

40. A copy of this judgment be forwarded to the Registrar of Trademarks for compliance.

SAURABH BANERJEE, J.

JULY 01, 2025/SSC