



2025:DHC:5309



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

% *Date of decision: July 03, 2025.*

+ **C.O. (COMM.IPD-TM) 327/2022**

BHALLA SPORTS PVT. LTD.Petitioner
Through: Ms. Suman Gupta, Adv.

Versus

**ASHUTOSH BHALLA M/S VINEX ENTERPRISES
PVT. LTD. & ANR**Respondents
Through: None.

**CORAM:
HON'BLE MR. JUSTICE SAURABH BANERJEE**

J U D G M E N T

1. The petitioner, by way of the present rectification petition seeks removal/ cancellation of the trademark **SOFT-TOUCH** registered in the name of the respondent no.1 *vide* trademark application no.1796255 in *Class 28* of the Trade Marks Act, 1999¹, and its consequent removal from the Register of Trade Marks.

2. The petitioner, Bhalla Sports Pvt. Ltd., is a company incorporated in the year 1988 and is engaged in the business of manufacturing and marketing a wide range of sports goods. The petitioner adopted the trademark 'SOFT TOUCH'/ **SOFT TOUCH** in the year 2001 and has since been continuously using the same on its products and packaging. The petitioner applied for registration thereof *vide* application no.1807977 in *Class 28* of the TM Act on 17.04.2009 claiming usage since 07.08.2001. At

¹Hereinafter referred as "*TM Act*"



present, the petitioner is the registered proprietor of the trademark 'SOFT TOUCH'/ **SOFT TOUCH**. Since the petitioner has invested substantial revenue for promotion and advertisement of its trademark 'SOFT TOUCH'/ **SOFT TOUCH**, it has acquired a formidable reputation nationally and the petitioner has also earned huge profit therefrom.

3. The respondent no.1 is the Director of M/s. Vinex Enterprises Pvt. Ltd., a company incorporated in the year 2003. The respondent no.2 is the Registrar of Trade Marks.

4. The respondent no.1 also applied for registration of the impugned trademark **SOFT-TOUCH** vide application no.1796255 on 17.03.2009 in Class 28 of the TM Act, claiming usage from 01.09.2003. At present, the respondent no.1 is the registered proprietor of the impugned trademark **SOFT-TOUCH**.

5. The petitioner filed an application for rectification/ cancellation of the impugned trademark **SOFT-TOUCH** vide Original Application ORA/41/2017/TM/DEI before the erstwhile Intellectual Property Appellate Board², however, after abolition of the IPAB, it has been transferred to this Court. Thus, the present cancellation petition.

6. The respondent nos.1 and 2, despite being duly served, failed to enter appearance or file their respective replies. Consequently, their right(s) to file reply was closed vide order(s) dated 03.11.2023 and 16.08.2023, whereafter they were proceeded *ex parte* vide order dated 02.04.2025.

7. Ms. Suman Gupta, learned counsel for petitioner contends that the

²Hereinafter referred as "IPAB"



2025:DHC:5309



petitioner is the 'prior user' of the trademark 'SOFT TOUCH'/ **SOFT TOUCH** and has been continuously using the said trademark on its products and packaging since its adoption on 07.08.2001. The respondent no.1, despite being aware of the petitioner's prior use of the trademark 'SOFT TOUCH'/ **SOFT TOUCH** since its product under the said trademark were present in the market since 2001 itself, *mala fide*ly applied for registration of the impugned mark **SOFT-TOUCH**. Thus, as per Ms. Suman Gupta, the respondent no.1 fraudulently obtained the registration of the impugned mark by falsely claiming user since 09.01.2003. Also, as per Ms. Suman Gupta, the use, if any, by the respondent no. 1 is not *bona fide* and it has no intention to use the same in connection with sports goods falling under *Class 28*.

8. Ms. Suman Gupta then contends that the impugned trademark **SOFT-TOUCH** is identical/ deceptively similar to the petitioner's trademark 'SOFT TOUCH'/ **SOFT TOUCH**, and that too in relation to sports goods falling under *Class 28*.

9. Since the aforesaid registration in favour of the respondent no.1 is contrary to *Sections 9, 11, 47 and 57* of the TM Act, therefore, the impugned trademark ought not to have been registered at the first instance. *Ergo*, the registration is liable to be cancelled and, consequently, the same deserves to be removed from the Register of Trade Marks.

10. This Court has heard Ms. Suman Gupta, learned counsel for the petitioner, as also perused the pleadings along with the relevant documents filed in support thereof.



11. At the outset, this Court finds that none of the averments made or the documents filed by the petitioner have been responded/ denied by respondent no.1, who, despite being duly served, failed to enter appearance before this Court. Accordingly, all such averments and documents filed by the petitioner are deemed to be admitted by the respondent no.1.

12. The same is relevant since the petitioner has placed on record substantial documents in the form of Invoices since 2001, wholesale Price List since 2002, Brochure along with other relevant materials *qua* the use of the trademark 'SOFT TOUCH'/ **SOFT TOUCH**, as also the Registration Certificate for the said trademark in *Class 28* and that the respondent no.1

has claimed usage of the impugned trademark **SOFT-TOUCH** since and from 09.01.2003. More so, since all the aforesaid predate the claim of the respondent no.1 in its application for the impugned trademark **SOFT-TOUCH** and also since they are pertaining to the very same goods in the very same Class, not only has the petitioner been able to show substantial usage thereof but also that it is a '*prior user*'/ '*first user*' thereof.

13. The above clearly reflects that the petitioner has been able to show/ prove that it is indeed the '*prior user*'/ '*first user*' of the trademark 'SOFT TOUCH'/ **SOFT TOUCH**. Under such circumstances, when it is a trite law that the rights of anyone like the petitioner, who is the '*prior user*', has better rights as it overrides the rights of any subsequent user like the respondent no.1. Any registration obtained by the subsequent user i.e. the respondent no.1 cannot thus come to the aid of the respondent no.1. The rule of being a '*first user*' is a seminal part of the TM Act and, in fact, has been recognized in *Neon Laboratories Ltd v. Medical Technologies Ltd. &*



*Ors.*³, wherein the Hon'ble Supreme Court has held that the right of a 'prior user' is superior to a registrant of the trademark as under:-

"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. WhirlpoolCorpn. [N.R. Dongre v. Whirlpool Corpn., (1996) 5 SCC 714] and MilmetOftho Industries v. Allergan Inc. [MilmetOftho 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 [MilmetOftho 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]

14. Even otherwise, the impugned trademark **SOFT-TOUCH** is visually, phonetically and deceptively similar/ nearly identical to that of the trademark 'SOFT TOUCH'/ **SOFT TOUCH** belonging to the petitioner. So much so, it is nothing short of being a copy, at best, a variation thereof. This can easily lead to every likelihood of confusion amongst the people of average intelligence, particularly, since they are pertaining to identically similar goods in the very same Class. This cannot be permissible as registration thereof would be against the tenets of the TM Act and the very

³2016 (2) SCC 672



2025:DHC:5309



purpose of registration. All the above, play a major role when this Court is dealing with cancellation/ rectification of the impugned trademark which cannot be permitted to wrongly remain on the Register of Trade Marks.

15. The respondent no.1 chose neither to appear nor controvert the averments and documents filed by the petitioner herein, casts a shadow of doubt, in fact, leads this Court to presume that there is an element of '*bad faith*' in adoption of the impugned mark **SOFT-TOUCH** by the respondent no.1, which has been dealt with by a learned Single Judge of this Court in *BPI Sports LLC v. Saurabh Gulati & Anr*⁴. The said element of '*bad faith*' also constitutes an 'unfair practice' involving lack of honest intention by the respondent no.1.

16. In view of the aforesaid, the petitioner has been able to make out a case in its favour. As such, the present petition is allowed and the Registrar of Trade Marks is directed to remove/ cancel the impugned trademark **SOFT-TOUCH** registered in favour of the respondent no.1 vide trademark application no.1796255 in *Class 28* of the TM Act from the Register of Trade Marks.

17. Accordingly, the present petition is disposed of in the above terms.

18. A copy of this order be forwarded to the Registrar of Trade Marks for compliance.

SAURABH BANERJEE, J.

JULY 3, 2025/NA

⁴2023:DHC:2920