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

*Date of decision: 2<sup>nd</sup> November, 2023*

+ **CS(COMM) 444/2022 & I.A. 11940/2023**

NEW BALANCE ATHLETICS INC. .... Plaintiff

Through: Mr. Dushyant K. Mahant, Mr. Urfee Roomi, Ms. Janaki Arun, Mr. Anubhav Chhabra, Ms. Anuja Chaudhury, Mr. Alvin Antony, Mr. Jaskaran Singh, Mr. Ayush Dixit, Mr. Ritesh Kumar and Ms. Radhika Arora, Advocates (M: 9818098835).

versus

NEW BALANCE IMMIGRATION  
PRIVATE LIMITED

..... Defendant

Through: None.

**CORAM:  
JUSTICE PRATHIBA M. SINGH**

### **JUDGMENT**

1. This hearing has been done through hybrid mode.
2. The present suit has been filed by New Balance Athletics Inc. a U.S. based Company seeking protection of its marks “NEW BALANCE” and “NB” against misuse by the Defendant- New Balance Immigration Private Limited. Apart from permanent injunction, damages etc., against the Defendant, the Plaintiff also seeks a declaration of its marks as well-known marks.
3. The brief background is that the Plaintiff is engaged in the business of design, manufacture, marketing and sale of footwear, readymade clothing. It



claims rights in the marks “NEW BALANCE”, letter combination “NB” and the “NB” device mark which are extracted hereinbelow:-



4. The Plaintiff is a company established in the year 1906 in the USA, and the mark “NEW BALANCE” is used both as a mark as also as a prominent feature of the corporate name of the Plaintiff’s Company. Though the mark was initially adopted as “NEW BALANCE” in full form, over the years, the mark has come to be known as “NB”. The mark “NB” is also described on the footwear and apparels which are manufactured by the Plaintiff in the US since 1974.

5. The business of the Plaintiff has expanded considerably for more than a century and, presently, the products are stated to be sold in more than 120 countries in the world including in India through retailer stores, departmental stores and e-commerce platforms.

6. The Plaintiff claims to engage more than 25 manufacturers across the world to manufacture footwear and readymade clothing, and also employs more than 8000 employees. The Plaintiff also claims to have granted its Indian licensee a license to use the Plaintiff’s marks in India. Since 2016, several stores has been opened in Delhi, Chandigarh and Lucknow. It also has subsidiaries which are incorporated in several countries in the world including the United States of America, United Kingdom, Hong Kong, Singapore, Australia, New Zealand, Mexico, Canada and South Africa.



7. The use of the mark “NEW BALANCE” dates back to the year 1986 in India for footwear and in retail services, the use dates back to the year 1972. The mark is also registered in several countries in the world including in India. The details of the registered marks in India are set out below:

S. No.	Mark	Reg. No.	Class/es	Registration Date	Renewed Until
1.	NEW BALANCE	472336	25	May 18, 1987	May 18, 2028
2.	NEW BALANCE	525511	18	March 2, 1990	March 2, 2024
3.	NEW BALANCE	5239490	35	December 8, 2021	December 8, 2031
4.		472334	25	May 18, 1987	May 18, 2028
5.		525286	18	February 27, 1990	February 27, 2024
6.		706035	18	May 20, 1996	May 20, 2026
7.		1637760	25	January 3, 2008	January 3, 2028

8. The Plaintiff uses the website [www.newbalance.com](http://www.newbalance.com), as its platform for promoting and advertising its products. The Plaintiff also operates various social media platforms like Facebook, Twitter, Instagram *etc.*

9. The sales figures of the Plaintiff are claimed to be more than 2.7 billion in 2020 and the marketing figures are more than 244 million dollars in 2020.



10. According to the Plaintiff, it sponsors a large number of well-known globally renowned sporting events and a number of celebrities also promote and endorse the Plaintiff's products.

11. The Defendant- New Balance Immigration Private Limited, is a company engaged in the business of providing immigration and visa procurement services. The Defendant operates its business through its website with the domain name [www.newbalanceimmigration.com](http://www.newbalanceimmigration.com). The Defendant's mark "NEW BALANCE" as also the "NB" device mark has been made part of its corporate name. The same has been extracted below:



12. The case of the Plaintiff is that it came to know about the Defendant's mark in May, 2022. The Plaintiff issued cease and desist legal notices dated 18<sup>th</sup> May, 2022 and 27<sup>th</sup> May, 2022 to the Defendant, to make it aware of the Plaintiff's right in the mark "NEW BALANCE" as also in the device mark "NB". However, the Defendant did not reply to the legal notices, leading to the filing of the present suit. A comparative chart of the Plaintiff's and Defendant's mark is as under:



Defendant's Marks	Plaintiff's Marks
NEW BALANCE	NEW BALANCE
	<b>NB</b>  

13. In this suit, initially, the Court vide order dated 15th September, 2022 had proceeded *ex parte* after there was no appearance on behalf of the Defendant, even after being served through all modes of service. Vide judgement dated 12<sup>th</sup> October, 2022, the Court had granted an *ad-interim* injunction restraining the Defendant from using the “NEW BALANCE” and “NB” name and mark in respect of its immigration services. Thereafter, on 1st June, 2023, judgement was passed by the Court in the application for summary judgment under Order XIII A. Accordingly the suit was decreed in terms of paragraphs 60(a), 60(b), 60(c), 60(d) and 60(e) of the prayer clauses. Insofar as the decree for clause 60 (l) is concerned, Rs.4,00,000/- costs were also directed to be paid by the Defendant to the Plaintiff. However, in respect of the prayer clause 60 (h), for well-known declaration, the Court had directed evidence to be filed by the Plaintiff.



**“NEW BALANCE” & “NB”-Well-Known mark**

14. The Plaintiff has now led the evidence of Mr. Harshit Gupta, who has been given power of attorney by the Plaintiff. He has filed his affidavit giving factual details and documentary evidence. Mr. Harshit Gupta claims that the Plaintiff’s marks fulfil all the factors laid down in section 11(6) of the Trade Marks Act, 1999.

- i. ***Factor 1 being the knowledge or recognition of the trade mark in the relevant section of the public, including in India-*** Mr. Gupta avers that the Indian consumers are purchasing the Plaintiff’s products since 1986. The products are also available on various e-commerce platforms like amazon.in, myntra.in, ajio.in *etc.* The Plaintiff has its retail stores in various states including Delhi, Chandigarh, Lucknow and has invested substantial amount of sum on promotions and advertising. The Plaintiff’s goods bearing the Plaintiff’s marks has been widely circulated in magazines, fashion websites, blogs *etc* and is exclusively associated with the Plaintiff.
- ii. ***Factor 2 being the duration, extent and geographical area of any use of the trade mark-*** The use of “NEW BALANCE” mark in India started in the year 1986 in footwears and apparels. The Plaintiff has been operating and selling in more than 120 countries through various retail stores, franchisees, department stores and e-commerce sites across the country. It is further stated that the Plaintiff has strict quality control mechanisms that govern its relationship with third party manufacturers.
- iii. ***Factor 3 being duration, extent and geographical area of any promotion of the trade mark, including advertising or publicity and presentation, at fairs or exhibitions of goods or services to which***



**trade mark applies-** The Plaintiff claims to have spent more than 244 millions on advertising and promotions and has sponsored exclusive sports teams, leagues and individuals like Liverpool FC, Olympic teams of Ireland and Chile at 2016 Rio Olympics *etc.*

iv. **Factor 4 being duration and geographical area of any registration of or any application for registration of trade mark under this Act to the extent that they reflect use or recognition of the mark-** It is averred that the Plaintiff owns substantial registrations in India under different classes i.e., 25,28,35 since 18<sup>th</sup> May, 1987. The Plaintiff has been granted registrations in various other countries as well like U.S.A., European Union, Australia *etc.*

v. **Factor 5: The record of successful enforcement of the, rights in that mark, in particular the extent to which the trade mark has been recognised as a well-known trade mark by any court or Registrar under that record-** Mr. Harshit Gupta relies on the judgement given by the coordinate bench in **2019:DHC:483 titled New Balance Athletics, Inc. v. Apex Shoe Company Pvt. Ltd.** which observed that Plaintiff's "NEW BALANCE" mark is century old and deserves protection. Accordingly, it is stated that the Plaintiff has filed various suits against unauthorized third party use of the Plaintiff's mark.

15. It is averred by Mr. Gupta that the Plaintiff has not only acquired trans-border reputation but has fulfilled all the factors laid down in section 11(6) of the Trade Marks Act, 1999 to be treated as well-known mark.

16. In **Hermes International v. Crimzon Fashion Accessories Pvt. Ltd. [2023 SCC OnLine 883]** the factors outlined by Id. Single judge under Section



11(6) of the Trade Marks Act, 1999 are the factors on which the witness of the Plaintiff has given evidence. The facts have been deposed in the affidavit and documentary evidence has been also exhibited by the evidence of Mr. Harshit Gupta. The evidence is in respect of both marks including the logo device.

17. This Court further notes that the mark “NEW BALANCE” is a unique combination of two distinctive words *i.e.* “New” and “Balance” which have no connection, allusion or description of the products of the services offered



by the Plaintiff. The logo is also quite distinctive and has been repeatedly enforced by the Court orders against misuse. The global reputation of the Plaintiff’s marks have been proved on record. In addition, the Plaintiff has placed on record sufficient documentary evidence in support of the prayer for declaration as a well-known mark.

18. This Court in *Disruptive Health Solutions v. Registrar of Trade Marks, 2022:DHC:2545* discussed test of distinctiveness of trade marks. The relevant extract of the said decision is as follows:

*“10. The general rule regarding distinctiveness is that a mark is capable of being protected if either it is inherently distinctive or has acquired distinctiveness through secondary meaning. In the spectrum of distinctiveness, the first category of marks is of arbitrary, fanciful and invented marks which is of absolute distinctiveness.”*





*Similarly, suggestive marks can also be registered due to their inherent distinctiveness. Descriptive marks can be registered as trademarks provided secondary meaning is established. Insofar as descriptive marks are concerned, just because some portion of the mark may have some reference or indication as to the products or services intended for, the same may not be liable to be rejected straightaway. **In such a case, the merits of the marks would have to be considered along with the extent of usage. Other registrations of the applicant would also have a bearing on the capability of the mark obtaining registration. The owner of a mark is always entitled to expand the goods and services, as a natural consequence in expansion of business.***

19. This Court has, in *Levi Strauss and Co. v. Interior Online Services Pvt. Ltd.* 2022:DHC:1222, after perusing the extent of reputation in the mark, granted a ‘well-known’ status to the Plaintiff’s ‘Arcuate Stitching Mark’. The Court observed as follows:

*“16. In *Lois Sportswear, USA, Inc. v. Levi Strauss & Co.*, 631 F. Supp.735 (S.D.N.Y. 1985), the US District Court for the Southern District of New York, while considering this very ‘Arcuate Stitching Design’ mark, held as under:*

*“Based on the above analysis, Levi’s arcuate mark is a strong mark that qualifies for a high degree of protection. In addition to its status as an incontestable registered mark, the Levi’s arcuate mark is a fanciful design which has no function other than as a source indicator. Furthermore, assuming Levi needed to establish secondary meaning, Levi has presented evidence of widespread advertising and promotion of Levi’s jeans featuring the Levi’s arcuate mark, continuous use of the mark for more than a century, and sales of more than 800 million pair of jeans bearing the Levi’s mark since 1971. Evidence of sales success, advertising expenditures, and*



*length and exclusivity of use are factors relevant to a determination of the strength of a mark. Xxx*

***In the present case, the Levi accurate mark is not merely a fragment of a larger mark including the Levi name but instead has an independent degree of recognition and connection with Levi Strauss, unlike, for example, the McGregor-Drizzle mark in McGregor-Doniger, supra.” ....***

19. *It is important to note that the trade mark in question i.e., the ‘Arcuate Stitching Design’ mark has been used on jeans, pants, and trousers of the Plaintiff since the first pair of jeans were created by it in the year 1873 and it serves as a unique identifier in respect of the goods of the Plaintiff. The first trade mark registration for the ‘Arcuate Stitching Design’ mark dates back to 1943, granted in the US. Since then, the mark has been registered as a trade mark by the Plaintiffs in numerous countries, as is evident from the documents placed on record. ...*

20. ***This Court is of the opinion that the ‘Arcuate Stitching Design’ mark has become ‘well known’ to the public which uses garments carrying the said mark, that the use of the ‘Arcuate Stitching Design’ mark in relation to other goods or services would likely be taken as indicating a connection between those goods and the Plaintiff. The mark of the Plaintiff is thus an extremely distinctive mark which has acquired secondary meaning due to extensive use spanning over one and a half century.”***

**Declaration as well-known mark:**

20. Keeping these decisions in mind, this Court has perused the plaint and the documents filed by the Plaintiff in support of its long-standing repute. On the strength of averments in the plaint, and the documents and evidence in the form of Mr. Harshit Gupta’s affidavit, the above marks “NEW BALANCE”



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and “NB” of the Plaintiff are, accordingly, declared as well-known marks. However, it is made clear that there shall be no monopoly on the word “New” and “Balance”, if separately used in respect of any other goods or services.

21. Since the suit has already been decreed, no further orders are called for.

**PRAITHIBA M. SINGH, J.**

**NOVEMBER 02, 2023**

*mr/ks*