



2024:DHC:3791



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

% **Reserved on: 15th April, 2024**

Pronounced on: 03rd May, 2024

+ **CS(COMM) 917/2018 & I.A. 14711/2019**

RELAXO FOOTWEARS LIMITED

..... Plaintiff

Through: Mr. Saif Khan, Mr. Shobhit Agarwal
and Mr. Prajjwal Kushwaha, Advs.

versus

XS BRANDS CONSULTANCY PRIVATE LIMITED & ORS.

..... Defendants

Through: Mr. Chander M. Lall, Sr. Adv. with
Mr. Ankur Sangal, Ms. Pragya Mishra,
Mr. Shaurya Pandey and Mr. Abhinav,
Advs.

**CORAM:
HON'BLE MR. JUSTICE ANISH DAYAL**

JUDGMENT

ANISH DAYAL, J.

I.A. 14711/2019 (Application under Order XXXIX Rules 1 & 2, CPC)


1. This application under Order XXXIX Rules 1 and 2 of the Code of Civil Procedure, 1908 [*'CPC'*] has been filed as part of the suit filed by plaintiff seeking permanent injunction restraining the defendants and all those




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acting for/on their behalf from manufacturing, selling, advertising, dealing with, in any manner footwear, apparel, accessories, and other products using







the mark  [*'impugned mark'* or *'defendants' X mark'*] or any other

mark identical or deceptively similar to the plaintiff's trademark  [*'plaintiff's X mark'*] and other attendant relief.

Factual Background

2. Plaintiff's X mark is derived from their '**SPARX**' logo and has been used in a standalone form in relation to its footwear products sold under the '**SPARX**' brand. Plaintiff's grievance is against the defendants who started using defendants' X mark, which was deceptively similar, for footwear as well, being identical goods. Defendants' brand and trademark is '**HRX**'/'**HRX BY HRITHIK ROSHAN**' and the defendants' X mark has been used as a standalone mark on their products causing confusion, passing off, and dilution of the plaintiff's mark. Representations of the rival marks, the placement, and actual use on the products have been tabulated by the plaintiff as under:



Plaintiff's "X" Device Mark	Defendants' "X" Device Mark
	
<p>Similarities between both the "X" device marks:</p> <p>a) The artistic and arbitrary choice to extend the right corner of the "X" device mark in an upward diagonal direction.</p> <p> </p> <p>b) The artistic and arbitrary choice of keeping the arm tilted towards left wider and shorter than the other arm of the "X".</p> <p> </p>	

Plaintiff's Product	Defendants' Product
	




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Submissions on behalf of the Plaintiff

3. Mr. Saif Khan, counsel for plaintiff claimed that plaintiff has the following registration:

TRADEMARK	
APPLICATION NO.	2271841
CLASS	25
USER CLAIMED SINCE	01st April, 2002
APPLIED ON	25th January, 2012
REGISTERED ON	28th June, 2019

4. Plaintiff claims prior user of the mark, being engaged in manufacture and sale of footwear since 1976 and, as of today, claims to be one of the largest producers of footwear in India, manufacturing over 4 lakh pairs every



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day and over 12 crores pairs in a calendar year. To substantiate and prove user by the plaintiff, advertisements appended in the suit documents for the year 2006 onwards have been relied upon. One such advertisement is extracted herein for ease of reference:



5. Invoices showing sales since August 2005 have also been relied upon which are the advertisement bookings in various newspapers for the product



‘**SPARX**’. As opposed to this, it was submitted that the defendants launched their products in November 2013 under the ‘**HRX**’ brand and the use of the defendants’ X mark came up much later. Some other invoices were also relied upon from the year 2005 which showed sales of products under the brand ‘**SPARX**’.


6. In addition, plaintiff also has the following copyright registration:



LABEL	‘ SPARX ’
REGISTRATION NO.	A-100638/2013
APPLIED ON	07th December, 2011
GRANTED ON	27th May, 2013

7. Plaintiff, thus, claims valuable goodwill and reputation in plaintiff’s X mark stating that they have extensively advertised the same in all forms of media, including celebrity endorsements. Plaintiff claims to have spent large amounts of money towards marketing and promotion, stating that the sales of the products marked with plaintiff’s X mark run into massive annual sales, upwards of Rs.500 Crores in the Financial Year 2015-2016. Plaintiff’s X mark is claimed to be inherently distinctive and entitled to highest level of protection. Defendants, on the other hand, had dishonestly adopted the plaintiff’s X mark by using a similar device mark.

8. It was clarified that the plaintiff was not claiming any rights *per se* over the letter ‘**X**’ but only in the stylistic representation thereof, and use in



relation to footwear and related goods. It was further clarified that plaintiff was only concerned about footwear products and did not have any issue relating to other products. Counsel for plaintiff submitted that a unique mark is usually adopted for shoes like the device mark adopted by Nike ,

Adidas , and New Balance . While defendants had applied for their X mark in other classes, it had no registration in Class 25, and their earliest invoice as per their own documents was of January 2014. It was, therefore, submitted that the similarity of marks was evident from – *first*, a perusal of the said marks; *secondly*, the manner of use; *thirdly*, placement on identical products; *fourthly*, the average consumer would not be able to notice any marginal differences; *fifthly*, there was phonetic and conceptual similarity in the said marks; *sixthly*, the class of consumers would be identical i.e. for footwear; *seventhly*, defendants' adoption is evidently dishonest having used of the plaintiff's 'X' mark; *eighthly*, there is no other footwear brand of repute using such a stylized mark; *ninthly*, defendants' X mark would cause confusion and association with the plaintiff's products; *tenthly*, an initial interest confusion would be caused to a potential consumer in view of both the products; and *lastly*, defendants' X mark erodes distinctiveness and source of identification of the plaintiff's X mark.

9. It was pointed out that despite the defendants' claim that their brand 'HRX' had been created from the attributes of the Bollywood Actor Hritik Roshan (*originally defendant no.4 in the suit and deleted later from the array*



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of parties), the actor himself filed an affidavit dated 5th November, 2019 stating that the brand ‘**HRX**’ was not his and he was only endorsing the same.


Submissions on behalf of the defendants

10. Mr. Chander M. Lall, Senior Counsel, on behalf of the defendants, refuting submissions made by the plaintiff’s counsel, stated that the issue was only relating to stylization of ‘X’ which was an extremely small variation and, in any event, stylization of the letter ‘X’ would not allow too much ingenuity. He contended that plaintiff could not have a monopoly over the letter ‘X’ which, in any case, they do not seek. There are numerous uses of the mark ‘X’ on products and plaintiff had not disclosed to the Court that the marketplace was crowded with such marks.




11. Attention was particularly drawn to a settlement that the plaintiff had arrived at with one ‘*Soccer International Pvt. Ltd*’ [‘***Soccer International***’], where both parties had agreed to mutually co-exist in the market and not oppose each other’s trademark applications for ‘X’ device marks. The marks of plaintiff previously opposed by *Soccer International*, and that of *Soccer International* previously opposed by plaintiff were annexed by the defendants; extracted as follows:



A. Trademark Applications of Relaxo opposed by Vector

S.no.	Application no.	Trademark	Class	Opposition no.
1	2271841		25	933780

B. Trademark Applications of Vector opposed by Relaxo


S.no.	Application no.	Trademark	Class	Opposition no.
1	2771803		25	968547
2	2771805		35	967999
3	3572887	VECTOR 	25	910677

12. Senior Counsel strongly asserted that plaintiff should have disclosed this agreement to the Court which estopped them from claiming that the ‘X’ device mark was their own and no one else could have a right over it. Having agreed to co-exist with another similar device mark in the same Class 25, it would not lie in the mouth of the plaintiff to assert exclusivity. Reliance in this regard was placed on the decision in *Corn Products Refining Company v. Shangrila Food Products Ltd.*, AIR 1960 SC 142.

13. The defendants adopted the trademark ‘**HRX**’ and defendants’ X mark in the year 2010 for the lifestyle brand dedicated towards fitness. The products were launched in the year 2013 for which reliance was placed on news articles annexed in the defendants’ documents. The device mark had been carved out from defendants’ ‘**HRX**’ mark, standing for “*extreme*”, which is commonly used in the context of sportswear.



14. Defendants applied for the registration of their device mark 'X' as follows:

TRADEMARK	
APPLICATION NO.	2092193
CLASS	25
USER CLAIMED SINCE	01st May, 2010
APPLIED ON	31st January, 2011

15. The defendants have been selling their products since 2013 for which various news articles, promotional materials were appended as part of the defendants' documents. It was submitted that there was no document filed by the plaintiff to show that any consumer had been confused between the products of the respective parties in the last 10 years. It was reiterated that the 'X' device marks are used in relation with the plaintiff's main trademark and brand 'SPARX' and there is no standalone reputation of the device mark of the plaintiff's 'X' mark. All invoices, sales figures, and advertisements are in relation to the trademark 'SPARX' and no invoice mentions the plaintiff's 'X' mark. The use by the plaintiff of its mark on few shoes:



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16. Plaintiff, while registering its 'X', mark admitted that the mark was different from various third party's 'X' trademarks and could co-exist in the market. The marks cited during the registration of the plaintiff's mark were tabulated by the defendants as under:



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S. No.	Name of the Entity	Images of Products Bearing the Mark 'X'
1.	XTEP	 <p>The third image shows a side view of a sneaker with a black upper, white midsole, and green and orange accents. It features a white 'X' logo on the side panel.</p>



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		<p>XEP</p>  <p>STYLISH & SPORTY SHOES</p> 
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2.	Payntr X	 Three images of Payntr X shoes. The top image shows a white shoe with orange accents and a black cross logo. The middle image shows a white shoe with blue accents and a black cross logo. The bottom image shows a white shoe with black and red accents and a black cross logo.
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3.	Vector X	   
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17. The defendants placed on record the search report for the 'X' label mark by the Registry as part of the examination report to the plaintiff's mark. The extract is reproduced as under:

GOVERNMENT OF INDIA
TRADE MARKS REGISTRY

INTELLECTUAL PROPERTY INDIA
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LOCATION: SECTION: EXM REPORT: EXM007 WORD MARK SEARCH REPORT APPLICATION NUMBER: 2271841 Class: -- TRADEMARK: 'X (LABEL)' USER: PRI PAGE: 1 DATE: 28/12/2012

APPL NO.	CLASS	CONFLICTING MARK	JOURNAL No.	PROPRIETOR NAME	PROPRIETOR ADDRESS	STATUS	TM IMAGE
GOODS SERVICES							
788232	26 X	5330	SUMESH KAMFAM	28843 1ST FLOOR BEADON PURA, AJMAL KHAN ROAD KARDOL BAGH DELHI-5	Opposed		
APPLICATION DATE 22/01/1998 18:58:57 GOODS/SERVICE HOSEYRY & READYMADE AGREEMENTS							
888893	25 X ZONE (I AMFI)	8999	ASHOKNI KUMAR MEHRA	4589, SUNDER NAGAR, LUDHIANA, (PB)	Registered		
APPLICATION DATE 28/11/1989 15:55:23 GOODS/SERVICE HOSEYRY AND READYMADE GARMENTS							
1038626	25 X PLUS	1316	YUNUS PATHAN	ROOM NO.1, SHAKH RAZAK CHAWL, PATEL WADI, BEHRAM BAUG, JODESHWARI (W), MUMBAI.	Opposed		
APPLICATION DATE 21/08/2081 15:45:56 GOODS/SERVICE READYMADE GARMENTS INCLUDED IN CLASS 25							
1168903	25 X	8889	LATTUPALLI JAIPAL REDDY,	C-8, ROAD NO. 22, M.L.D.C. ANCHERI (EAST), MUMBAI-400 051.	Opposed		
APPLICATION DATE 26/03/2003 18:01:00 GOODS/SERVICE ready-made garments & hoseyry, articles of clothing, footwear and all items included in class-25							
1186970	25 X (LABEL)	1336	LATTUPALLI JAIPAL REDDY,	C-8, ROAD NO. 22, M.L.D.C. ANCHERI (EAST), MUMBAI-400 051.	Registered		
APPLICATION DATE 28/03/2003 15:21:00 GOODS/SERVICE READY-MADE GARMENTS & HOSEYRY, ARTICLES OF CLOTHING, FOOTWEAR AND ALL ITEMS INCLUDED IN CLASS-25							
1199289	25 X (DEVICE)	1328	LATTUPALLI JAIPAL REDDY,	C-8, ROAD NO. 22, M.L. D. C., ANCHERI (EAST), MUMBAI - 400 051.	Registered		
APPLICATION DATE 19/05/2003 14:02:59 GOODS/SERVICE READY-MADE GARMENTS & HOSEYRY, ARTICLES OF CLOTHING, FOOTWEAR INCLUDED IN CLASS 25.							
1253971	25 XXXO	1373	SUBTOMO RUBBER INDUSTRIES, LTD.	6-8, 3-CHOME, WAKINOHAMA-CHO, CHUO-KU, KOBE-SHI, HYOGO, JAPAN	Registered		
APPLICATION DATE 08/12/2003 GOODS/SERVICE CLOTHING, FOOTWEAR, HEADGEAR AND BELTS FOR CLOTHING.							
1308888	25 X (LOGO)	1356	ESPN, INC.	ESPN PLAZA, BRISTOL, CONNECTICUT 06010 UNITED STATES OF AMERICA.	Registered		
APPLICATION DATE 15/09/2004 GOODS/SERVICE CLOTHING FOR MEN, WOMEN AND CHILDREN NAMED T - SHIRTS, SHIRTS, BLOUSES, https://ipindiaonline.gov.in/registar/examreport.asp?APPLICATION_NUMBER=11718114&KSeJkCBkFzZwXQD							



SWEATERS, CARDIGANS, TURTLENECKS, VESTS, SWEAT SHIRTS TANK TOPS, JERSEYS, BASEBALL SHIRTS, GOLF SHIRTS, JOGGING SHIRTS, SHIRTS, SHORTS, GYM SHORTS, TENNIS SHORTS, JEANS, PANTS, WORK PANTS, TROUSERS, SLACKS, TUNICS, DRESSES, JUMPERS, SUITS, SUN SUITS, COVER-ALLS, OVERALLS, SWEATSHIRTS, SWEAT PANTS, SWEAT SUITS, WARM-UP SUITS, JACKETS, BLAZERS, GLOVES, MITTENS, SCARVES, COATS, SHAWLS, SKI JACKETS, SKI PANTS, PARKAS, CAPES, PONCHO'S, RUNNING SUITS, SMOCKS, JUMP SUITS, RAIN WEAR, UNDERWEAR, LINGERIE, HOSIERY, SOCKS, TIGHTS, LEGGINGS, LEG WARMERS, NECK WEAR, NAMELY NECK TIES, COSTUMES, SLEEPWEAR, ROBES, DRESSING GOWNS, SWIMWEAR, BABY CLOTHES, SNOWBOARD PANTS AND SNOWBOARD JACKETS, SKATEBOARD PANTS, SKATEBOARD SHORTS, BELTS, BANDANNAS, NECKBANDS, WRISTBANDS, SUSPENSORS, BEACH WEAR, SHOES, SNEAKERS, ATHLETIC SHOES, BOOTS, SANDALS, SKATEBOARD FOOTWEAR, SLIPPERS AND BOOTIES, CAPS, HATS, BEANIES, HEADBANDS, SWEATBANDS, BANDANAS, EAR MUFFS, VISORS AND SUN VISORS.

5302000 25 X (LABEL) 1337 X-TECHNOLOGY SWISS GMBH KANTONSTRASSE 148,8887 FRIENBACH, SWITZERLAND. Opposed
 APPLICATION DATE 17/10/2006 14:40:30
 GOODS/SERVICE CLOTHING, FOOTWEAR, HEADGEAR.

1407102 25 X (LABEL) 1300 HINDUSTAN LEVER LIMITED, HINDUSTAN LEVER HOUSE, 355/106, BACKBAY RECLAMATION, MUMBAI - 400 026. Registered
 APPLICATION DATE 19/12/2005
 GOODS/SERVICE READYMADE GARMENTS, FOOTWEAR, SHOES.



1407091 25 X (LOGO) 1371 NOBLE FIBER TECHNOLOGIES, INC. 300 PALM STREET, SCRANTON, PENNSYLVANIA 18505, U.S.A. Registered
 APPLICATION DATE 20/12/2006
 GOODS/SERVICE CLOTHING, NAMELY, BATHING SUITS, INFANT CLOTH DIAPERS, GLOVES, HATS, INFANT UNIFORMS, SHOES, SOCKS, PANTYHOSE, PANTS, SHORTS, TIGHTS, SWEATSUITS, UNDERWEAR, UNDERWEAR, DRIVING GLOVES, JERSEYS, T-SHIRTS AND WAISTBANDS IN THE NATURE OF BELTS.



1413100 25 X (LOGO) 1388 LEINWEBER GMBH & CO. KG. WITTEKINDSTRASSE 16 - 18, 32051 HERFORD, GERMANY. Opposed
 APPLICATION DATE 12/01/2006 12:50:30
 GOODS/SERVICE ARTICLES OF CLOTHING, SPORTSWEAR, BELTS, SHOES, SPORTS SHOES, HEADGEAR, CLOTHING INCLUDING BOOTS, SHOES AND SLIPPERS, ALL OTHER GOODS INCLUDED IN INTERNATIONAL CLASS 25

1415535 25 X (LOGO) 1388 LEINWEBER GMBH & CO. KG. WITTEKINDSTRASSE 16 - 18, 32051 HERFORD, GERMANY. Registered
 APPLICATION DATE 22/01/2006
 GOODS/SERVICE ARTICLES OF CLOTHING, SPORTSWEAR, BELTS, SHOES, SPORTS SHOES, HEADGEAR, CLOTHING INCLUDING BOOTS, SHOES AND SLIPPERS, ALL OTHER GOODS INCLUDED IN INTERNATIONAL CLASS 25

1415300 25 X (LOGO) 1383 LIFESTYLE INTERNATIONAL (P) LTD. SIGMA SOFT-TECH PARK, 8TH FLOOR, DELTA TOWER NO.7, VARTHUR MAIN ROAD WHITEFIELD, BANGALORE-500066, KARNATAKA STATE. Opposed
 APPLICATION DATE 06/02/2006 18:50:30
 GOODS/SERVICE GARMENTS & CLOTHING INCLUDING READY MADE CLOTHING; SPORTS WEAR; CHILDREN'S CLOTHING INCLUDING UNDERWEAR AND BABY'S NAPKINS, BODY LINEN, CLOTHING, FOOTWEAR, HEADGEAR



1477017 25 X LOGO, WALTER ALBINI 1372 GRAZIANI ANDREA VIA PO 371A, ORVIETO (TERNI), ITALY. Registered
 APPLICATION DATE 07/08/2006
 GOODS/SERVICE OVERCOATS, OVERALLS, SHIRTS, BLOUSES, BRASSIERES, CORSETS, SINGLET'S, PANTS, NIGHTGOWNS, PYJAMAS, DRESSING GOWNS, PULLOVERS, BATH ROBES, BATHING SUITS, BATHING GLOVES AND MUFFS, CARDIGANS, JERSEYS, NECKTIES, NECKERCHIEFS, SCARVES, SWEATERS, SWEATSHIRTS, STOCKINGS, TIGHTS, TROUSERS, LEGGINGS, SHORTS, JACKETS, JERKINS, VESTS, WAISTCOATS, JUMPERS, TRACK SUITS, JEANS, PANTIES, PANTS, BERMUDA SHORTS



1470061 25 X 20 (LABEL) 1373 MR. BASU SINGH M. INDIA HUGU BUREAU 3RD FLOOR, ROOM NO.22, ABBAJI PHALAV NARD, DADAR (E), MUMBAI-400014. Opposed
 APPLICATION DATE 11/09/2006 12:55:00



https://ipnl/online.gov.in/ereg/status/examreport.aspx?APPLICATION_NUMBER=WF16110K5KulC8Np2V7z0XQ==



GOODS/SERVICE READYMADE GARMENTS.

1517673 25 XD 1382 SUNIL ASKNAM SHOP NO.1, SHIV COMPLEX, OPP. VARANDBHAI, DODDBHANDAR, ULHASNAGAR-421 585. Opposed



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APPLICATION DATE 05/01/2007 14:17:30

GOODS/SERVICE READYMADE GARMENTS INCLUDED ALL IN CLASS 25.

1543886 28 XS (LABEL) 1382 DEEPSIKHA MARKETIN (P) LTD. 10A, MADAN MOHAN BURMAN STREET, KOLKATA 700007. Opposed

APPLICATION DATE 26/03/2007 14:26:00

GOODS/SERVICE ALL KIND OF UNDER GARMENTS.

1288460 25 X 1399 M/S. INX MEDIA PRIVATE LIMITED LOGIX INFOTECH PARK, D-5, SEC-09, NOIDA-201301 U.P. Registered



APPLICATION DATE 05/08/2007 16:26:38

GOODS/SERVICE CLOTHING, FOOTWEAR, HEADGEAR, BEING GOODS INCLUDED IN CLASS 25

1689148 25 X (LABEL) 1433 MR. KALPESH SHAH SHOP NO.81E, DHAMJI KHERAJ BLDG, JUNCTION OF RRT ROAD, G.G. ROAD, MULUND (W) MUMBAI - 400 089. Opposed



APPLICATION DATE 21/06/2008 12:44:56

GOODS/SERVICE READYMADE GARMENTS, CLOTHING, FOOTWEAR, HEADGEAR.

1700126 25 X (DEV) 1464 SANDIP HALDER 115-R SARAT GHOSH GARDEN ROAD, KOLKATA 700031. Registered



APPLICATION DATE 17/04/2008 18:11:25

GOODS/SERVICE SPORTSWEAR & READYMADE GARMENTS, CASUAL WEAR.

1789527 25 X (DEVICE) 1433 X-TECHNOLOGY SWISS GMBH SAMSTAGERSTRASSE 45, 8832 WOLLERAUS, SWITZERLAND. Registered



APPLICATION DATE 19/08/2008 13:50:18

GOODS/SERVICE CLOTHING, FOOT WEAR, HEADGEAR.

1747372 25 X4 ABDUL GAFOOR, M.V. 1ST FLOOR, CALICUT MALL, STADIUM JUNCTION PUTHYARA ROAD, CALICUT-673 802, KERALA. Objected



APPLICATION DATE 23/10/2008 16:19:06

GOODS/SERVICE CLOTHING (PARTICULARLY DOTTIES).

1760925 25 X5 MR. RAKESH KUMAR 6241, SHOP NO.-4, GALI NO.-1, BLOCK, NO.- 4, DEV NAGAR, KAROL BAGH, NEW DELHI - 110 005. Objected

APPLICATION DATE 05/12/2009 16:30:54

GOODS/SERVICE READYMADE GARMENTS.

1881438 25 X 1803 SARABJEET SINGH KOHLI A-2027 JANALPURI MEW DELHI-68 Registered

APPLICATION DATE 17/08/2009 17:21:58

GOODS/SERVICE FOOTWEAR, HOSIERY AND READYMADE GARMENTS.

https://ipindiaonline.gov.in/registereexamreport.aspx?APPLICATION_NUMBER=VF16V16SkKc8n0T8W8XQ=



SIT32319		Examination Report	
1986901	35 X-10	MANOJ PRDHANDAS MAKHUJA	MOTI MAHAL BUILDING, SHOP NO.2, OPP: SWAMI SHANTI PRAKASH GALLIHALA, ULHASNAGAR - 421035. Objected
APPLICATION DATE 19/07/2018		GOODS/SERVICE 'READYMADE GARMENTS AND HOSIERY FOR GENTS, LADIES AND CHILDREN WEAR.	
2009880	25 X (WITH DEVICE)	MANOJ KUMAR	FLAT NO 305, ELEPHANT HEIGHT, PLOT NO 41 SEC-10 DWARKA NEW DELHI-75. Objected
APPLICATION DATE 09/08/2010		GOODS/SERVICE TRADING & MANUFACTURING OF ALL TYPE OF GARMENTS, LIKE PANT, SHIRTS, TROUSERS, FORMAL CASUAL, LADIES TOP, GENTS T-SH ETC AND LEATHER PRODUCTS & ALL OTHER ITEMS COVERED UNDER CLASS -25.	
2519284	25 X	ZHANG QI ZHEN	FLAT/RM 3208, 32/F, CENTRAL PLAZA, 18 HARBOUR ROAD, WANCHAI (HONG KONG). Objected
APPLICATION DATE 18/08/2018		GOODS/SERVICE CLOTHING, FOOTWEAR, HEADGEAR, READYMADE, GARMENTS OF MEN, WOMEN AND KIDS, SPORTS WEAR LIKE TRACK SUIT, SWIM WEAR, BRIEFS AND VESTS FOR ALL MEN, HOSIERY, SPORTS SHOES, PARTY SHOES AND BOOTS FOR MEN, WOMEN AND KIDS, HATS AND CAPS.	
2190968	35 X	NILESH C. JANI	25, ASHISH IND ESTATE, DORNALE ROAD 151, DADAR (WEST), MUMBAI - 400022. Objected
APPLICATION DATE 18/08/2011		GOODS/SERVICE READYMADE SHIRTS INCLUDED IN CLASS 25	
2271841	25 X (LABEL)	RELAXO FOOTWEARS LTD	316-319 ALLIED HOUSE INDERLOK CHOK OLD ROHTAK ROAD DELHI 110025. Marked for Exam
APPLICATION DATE 23/01/2012		GOODS/SERVICE FOOTWEARS	

PRETI DAHOTRE
For REGISTRAR OF TRADE MARKS

18. In the reply to the examination report, the plaintiff had commented that various cited 'X' marks were dissimilar to the applicants' mark. The said reply is extracted as under:



ASHOKA LAW OFFICE

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INTELLECTUAL PROPERTY LAW CONSULTANTS & LAWYERS
ASHOKA HOUSE 8, CENTRAL LANE, BENGALI MARKET CONNAUGHT PLACE, NEW DELHI-1, INDIA
Ph. 23713492, 23752162, 9868280797 Fax: 23351300
email: ip@ashokalawoffice.com

Unit Section: EXM.
Reply to Examination Report

The Registrar of Trade Marks
Office of the Trade Marks Registry
NEW DELHI.

Dated: 05-03-2013

Agent Code: 4263
Attorney Code: 6032

Application no./date	2271841 dt.25-01-2012.
Applicant	Relaxo Footwear Ltd.
Trade Mark	
Class	25



Dear Sir,

This is in reference to the examination report dated 28-12-2012.

On the basis of the following submissions, we request the Ld. Registrar/Hon'ble tribunal to reconsider the subject trademark matter by removing/waving the objection(s) raised in the examination report and allow the subject trademark application to proceed to registration.

With respect to objection raised under section 11 of the Trade Marks Act, 1999, the details of marks cited in the search report are as follows:-

Cited Mark	Application/Registration no.	Current Status	Comments
X	788233 Dt.20-01-1998.	Opposed by Chanel Ltd.	The cited mark is dissimilar to the applicant's subject trademark. The goods under the cited mark are also dissimilar.
	888890 Dt.29-11-1999.	Registered but not renewed after 29-11-	The cited mark is not renewed till date. The goods under the cited mark are also dissimilar.

Handwritten signature/initials







Trade Marks Registry
Dy. No. 388/05
Date: 10/3/2013



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		2009.	
X PLUS	1038625 Dt.21-08-2001.	Opposed by Hybo Hindustan	The cited mark is dissimilar. The goods under the cited mark are also dissimilar. The cited mark is already under opposition.
X	1185969 Dt.26-03-2003.	Opposed by Expose Apparels.	The cited mark is opposed. The cited mark is dissimilar.
	1185970 Dt.26-03-2003.	Registered.	The cited mark is dissimilar. The cited mark is subsequent in adoption.
	1199259 Dt.19-05-2003.	Registered.	The cited mark is dissimilar. The cited mark is subsequent in adoption.
xx/10	1253971 Dt.08-12-2003.	Registered.	The cited mark is dissimilar. The cited mark is subsequent in adoption.
	1308959 Dt.15-09-2004.	Registered.	The cited mark is dissimilar. The cited mark is subsequent in adoption.
	1392000 Dt.17-10-2005.	Opposed by Hybo Hindustan.	The cited mark is dissimilar. The cited mark is subsequent in adoption. The cited mark is opposed.
	1407183 Dt.19-12-2005.	Registered.	The cited mark is dissimilar. The cited mark is subsequent in adoption. The goods under the cited mark are also dissimilar.
	1407591 Dt.20-12-2005.	Registered.	The cited mark is dissimilar. The cited mark is subsequent in adoption.

By
T.C.



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X LOGO	1413168 Dt.12-01-2006.	Opposed by Maxwell Industries Ltd.	The cited mark is dissimilar. The cited mark is subsequent in adoption. The cited mark is opposed.
	1415535 Dt.23-01-2006.	Registered.	The cited mark is dissimilar. The cited mark is subsequent in adoption.
	1419309 Dt.06-02-2006.	Opposed by Maxwell Industries Ltd.	The cited mark is dissimilar. The cited mark is subsequent in adoption. The cited mark is opposed.
	1477117 Dt.07-08-2006.	Registered.	The cited mark is dissimilar. The cited mark is subsequent in adoption.
	1478061 Dt.11-08-2006.	Opposed by Maxwell Industries Ltd.	The cited mark is dissimilar. The cited mark is subsequent in adoption. The cited mark is opposed.
	1517673 Dt.05-01-2007.	Opposed by Maxwell Industries Ltd.	The cited mark is dissimilar. The cited mark is subsequent in adoption. The cited mark is opposed.
XS LABEL	1543680 Dt.26-03-2007.	Opposed by Maxwell Industries Ltd.	The cited mark is dissimilar. The cited mark is subsequent in adoption. The cited mark is opposed.
	1588460 Dt.08-08-2007.	Registered.	The cited mark is dissimilar. The cited mark is subsequent in adoption.
	1689149 Dt.21-05-2008.	Opposed by Maxwell Industries Ltd.	The cited mark is dissimilar. The cited mark is subsequent in adoption. The cited mark is opposed.

A
T.C



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	1700126 Dt.17-06-2008.	Registered.	The cited mark is dissimilar. The cited mark is subsequent in adoption. The goods under the cited mark are also dissimilar.
	1700827 Dt.19-06-2008.	Registered.	The cited mark is dissimilar. The cited mark is subsequent in adoption.
	1747372 Dt.23-10-2008.	Objected.	The cited mark is dissimilar. The cited mark is subsequent in adoption. The goods under the cited mark are also dissimilar.
X5	1760925 DT.05-12-2008.	Objected.	The cited mark is dissimilar. The cited mark is subsequent in adoption.
	1851438 DT.17-08-2009.	Registered.	The cited mark is dissimilar. The cited mark is subsequent in adoption. The goods under the cited mark are also dissimilar.
X-10	1995001 Dt.19-07-2010.	Objected.	The cited mark is dissimilar. The cited mark is subsequent in adoption. The goods under the cited mark are also dissimilar.
	2005890 Dt.09-08-2010.	Objected.	The cited mark is dissimilar. The cited mark is subsequent in adoption. The goods under the cited mark are also dissimilar.
	2010984 Dt.18-08-2010.	Objected.	The cited mark is dissimilar. The cited mark is subsequent in adoption.

T.C



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	2190956 Dt.16-08-2011.	Objected.	The cited mark is dissimilar. The cited mark is subsequent in adoption. The goods under the cited mark are also dissimilar.
<input checked="" type="checkbox"/>	2271841 Dt.25-01-2012.	Objected.	The cited mark is applicant's subject trademark.

At the outset, we submit that the objection raised under section 11 of the Trade Marks Act, 1999 by the Ld. Registrar in the examination report pertaining to cited marks in the search report should be waived/removed on the basis of following submissions:-

- The cited mark under no.2271841 is the subject trademark of the applicant. Hence, the objection pertaining to it should be removed.
- As regards the other cited marks, upon applying the judicial principle of entirety, the subject trademark is visually, phonetically, structurally and conceptually dissimilar from the other cited marks in the search report.
- As the other cited marks are visually, phonetically, conceptually and structurally dissimilar from the subject trademark, the likelihood of confusion and deception among the consumers, traders, etc. of trade channels is completely ruled out.
- Apart from being dissimilar, the cited mark under no.888890 is not renewed and hence, not valid till date. Accordingly, the objection pertaining to the said cited mark should be waived/removed.
- Apart from being dissimilar, the cited mark under no.788233, 1038625, 1185969, 1392000, 1413168, 1419309, 1478061, 1517673, 1543680, 1689149 are opposed by third person and hence, no rights entail in respect of it till date. Accordingly, the objection pertaining to the said cited mark should be waived/removed.
- Apart from being dissimilar marks, the goods mentioned under the cited marks under nos.888890, 1038625, 1407591, 1477117, 1478061, 1517673, 1543680, 1700126, 1747372, 1760925, 1851438, 1995001, 2005890 and 2190956 are entirely dissimilar. Therefore, the consumers and traders of trade channels would also be dissimilar by virtue of which fact the likelihood of confusion and public deception does not arise. Hence, the issue of conflict also does not arise with respect to the same.
- Further, since the subject trademark is being used by the applicant since 01-04-2002 in respect of the subject goods, which is prior to the adoption and alleged use, if any (which is denied) of the cited marks, the applicant possesses better proprietary rights in respect of the subject trademark. By virtue of prior adoption and use, the consumers, traders, etc. of the trade channels have associated the subject trademark in respect of the subject goods with the applicant only.

FC



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On the basis of above, it is duly submitted that the objections raised by the Ld. Registrar should be removed/waived and the subject trademark application should proceed to Registration.

An opportunity of being heard may also be granted to the applicant by the Ld. Registrar before passing any adverse order in the subject trademark matter.

All communications relating to these proceedings of the application may be sent to the following address for service of applicant in India:-

ASHOKA LAW OFFICE
INTELLECTUAL PROPERTY LAW CONSULTANTS & LAWYERS
ASHOKA HOUSE 8, CENTRAL LANE, BENGALI MARKET CONNAUGHT PLACE,
NEW DELHI-1, INDIA
Ph. 23713492, 23752162, 9868280797 Fax: 23351300
email: ip@ashokalawoffice.com

Thanking you,


ASHOKA LAW OFFICE
Counsel for the Applicant.

19. The plaintiff, therefore, cannot approbate and reprobate, having stated that various 'X' devices were dissimilar to their mark. In any event, this minor variation in 'X' should be permissible.

20. Therefore, it was claimed by Senior Counsel for defendants that this was a crowded marketplace and the plaintiff would have to discharge the burden of proof to show that these 'X' marks are not being utilized by the parties.



21. The dissimilarities between the two marks were also brought out by Senior Counsel for defendants. There were stark differences in the two



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visuals, as per them. The defendants had provided the following table to articulate their points of differences, extracted hereunder for ease of reference:

Plaintiff	Defendants
	
<ul style="list-style-type: none">• Straight First line of X• Tilted Second Line of X• Flat ending on the top right• No taper from left to right• Single block left to right	<ul style="list-style-type: none">• No tilt• First line tilted in the manner in which the alphabet X is commonly written• Second line titled in the manner in which the alphabet X is commonly written• Sharp ending on top right• A marked taper from left to right• Multicolour two lines from bottom to top



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22. Senior Counsel for the defendants also pointed out that third parties were in fact using the said mark as is evident from the listings on Amazon and other sites. As an illustration, for the brand ‘X-STEP’ and ‘PAYNTR-X’ and ‘VECTOR-X’, the following Amazon listings were shown as under:



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amazon.in Deliver to New Delhi 110065 Shoes & Handbags Search Amazon.in EN Hello, sign in Account & Lists Returns & Orders

All Amazon miniTV Sell Best Sellers Today's Deals Mobiles New Launches from Mobiles, Electronics & more | Shop now

Amazon Fashion Women Men Kids Bags & Luggage Sportswear Sales & Deals **30 DAY RETURNS** Restrictions Apply

Shoes & Handbags > Shoes > Men's Shoes > Sports & Outdoor Shoes > Running Shoes



Click to open expanded view

Visit the XTEP Store
XTEP Lightweight Sports Running Shoes for Men
 4.7 ★★★★★ 3 ratings

-20% ₹4,159
 M.R.P.: ₹5,199

Inclusive of all taxes
 EMI starts at ₹200. No Cost EMI available EMI options >

Offers

No Cost EMI
 Upto ₹187.26 EMI interest savings on Amazon Pay ICICI...
 1 offer >

Bank Offer
 Upto ₹207.9 discount on Cashback Cr...
 1 offer >

Free Delivery Pay on Delivery 10 days Return & Exchange

₹4,159⁰⁰

FREE delivery Wednesday, 2 August. Order within 15 hrs 1 min. Details

Deliver to New Delhi 110065

In stock

Sold by Xtep and Fulfilled by Amazon.

Quantity: 1

Add to Cart

Buy Now

Secure transaction

Add gift options

Add to Wish List

Have one to sell?

Sell on Amazon

Size:

8.5 UK

Colour: Black



Size Chart

- Sole: Rubber
- Closure: Lace-Up
- Shoe Width: Medium
- Running Shoes for Men : The Upgraded Sole is flexible and comfy provides dynamic responsiveness for running
- Soft Textile Upper : The Shoes for men upper is constructed with textile materials to enhance the breathability. Lace up Closure for Firm Fit
- Medium Heel : The Sports Shoes for men had medium heel for stability and comfort
- Upgraded IP Sole : The EVA Foam sole material enhance the sports and running feature. Move faster than ever
- Care Instructions : Recommending hand wash, do not twist, pull or drag shoes, it may cause a damage in technical structure of product. Wipe shoes with clean dry cloth

amazon business

Are you a business? Get GST invoice and

bulk discounts Sign in/Create a free business account



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amazon.in Deliver to New Delhi 110055 Shoes & Handbags Payntr X Rubber Stud CAMO EN Hello, sign in Account & Lists Returns & Orders

All Amazon miniTV Sell Best Sellers Today's Deals Mobiles New Launches from Mobiles, Electronics & more | Shop now

Amazon Fashion Women Men Kids Bags & Luggage Sportswear Sales & Deals 30 DAY RETURNS Restrictions Apply

Back to results



Click to open expanded view

Brand: Payntr
Payntr X Rubber Stud CAMO

-25% ₹2,849

M.R.P.: ₹3,799

Inclusive of all taxes

EMI starts at ₹138. No Cost EMI available EMI options

Offers

No Cost EMI
 Upto ₹128.31 EMI interest savings on Amazon Pay ICICI...
 1 offer >

Bank Offer
 Upto ₹142.4 discount on Cashback Cr...
 1 offer >

- Free Delivery
- 10 days Return & Exchange
- Amazon Delivered
- Secure transaction

Size:

11 UK

Colour: White

Size Chart

- Sole: Ethylene Vinyl Acetate
- Closure: Lace-Up
- Fit Type: Regular
- Shoe Width: Medium
- Sole: Ethylene Vinyl Acetate
- Closure: Lace-Up
- Fit Type: Regular

Show More

amazon business Are you a business? Get GST invoice and bulk discounts

Sign in/Create a free business account

LIMITED QUANTITY

Note: The order quantity is limited to 3 units per customer.

Please note that orders which exceed the quantity limit will be auto-canceled. This is applicable across sellers.

₹2,849⁰⁰

FREE delivery Monday, 31 July. Details

Deliver to: New Delhi 110065

In stock

Sold by GAURIK FASHIONS PVT LTD. and Delivered by Amazon.

Quantity: 1

Add to Cart

Buy Now

Secure transaction

Add to Wish List

Have one to sell?

Sell on Amazon



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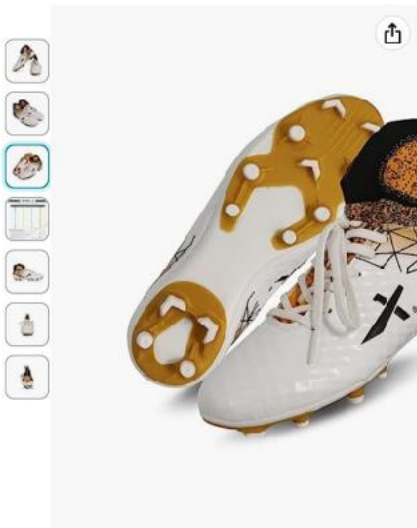


amazon.in Deliver to New Delhi 110065 Shoes & Handbags Vector X football shoes EN Hello, sign in Account & Lists Returns & Orders

All Amazon miniTV Sell Best Sellers Today's Deals Mobiles New Launches from Mobiles, Electronics & more | Shop now

Amazon Fashion Women Men Kids Bags & Luggage Sportswear Sales & Deals 30 DAY RETURNS Restrictions Apply

< Back to results



Click to open expanded view

Visit the Vector X Store

Vector X Fantastic Football Shoes for Men's (Pearl White-Black)

3.7 ★★★★★ 148 ratings
28 answered questions

Ends in 01h 57m 38s

₹1,754

Inclusive of all taxes
EMI starts at ₹86. No Cost EMI available EMI options

Offers

Partner Offers
Price Promotion
2 offers >

No Cost EMI
Upto ₹79.00 interest savi
Amazon Pay
1 offer >

Free Delivery Pay on Delivery 7 days Return & Exchange

Size:
7 UK

Colour: Pearl White-Black

- Sole: Polyurethane
- Closure: Lace-Up
- Fit Type: Snug
- Shoe Width: Medium
- Material :- Synthetic upper provides durability and a soft touch.
- The Stretchy Primeknit sock creates a supportive and snug fit around the ankle.
- Padded ankle collar, Padded Footbed Cushioned, Full lace fastening.

> Show More

amazon business Are you a business? Get GST invoice and bulk discounts

Sign in/Create a free business account

LIMITED QUANTITY Note: The order quantity is limited to 3 units per customer.

Please note that orders which exceed the quantity limit will be auto-canceled. This is applicable across sellers.

₹1,754⁰⁰

FREE delivery Sunday, 30 July. Details

Or fastest delivery **Tomorrow, 29 July.** Order within 4 hrs 8 mins. Details

Deliver to New Delhi 110065

In stock
Sold by RetailEZ Pvt Ltd and Fulfilled by Amazon.

Quantity: 1

Add to Cart Buy Now

Secure transaction
 Add gift options
Add to Wish List

New (2) from ₹1,754⁰⁰ Fulfilled FREE Delivery.

Other Sellers on Amazon

₹1,995.00 Add to Cart
Fulfilled FREE Delivery, Details
Sold by: CW96

Have one to sell?
Sell on Amazon





23. It was also pointed out in relation to ‘VECTOR-X’ that they had stated that they entered India in 1999 under the said brand and ‘X-STEP’ in 1987. It was, therefore, submitted that these ‘X’ device marks had prior user and, therefore, the plaintiff could not claim any exclusivity in that regard. Moreover, the registration application by the defendants was made in 2011 while the registration application of the plaintiff was made in 2012. Besides, it was argued that there was no balance of convenience in favour of the plaintiff since the defendants had been using the trademark for over 10 years and had built goodwill and reputation in the said mark. Furthermore, there was no scope of confusion between the products as they both use their primary trademarks ‘SPARX’ and ‘HRX’ on their products and the respective ‘X’ marks were only used along with the same.

24. Senior Counsel for defendants relied upon the following decisions in support of their arguments:

24.1 *Corn Products Refining Company v. Shangrila Food Products Ltd.*, AIR 1960 SC 142 on the issue of two marks containing a common element which is also contained in a number of other marks and, therefore, causes purchasers to pay attention to other features of the respective marks. This reliance was placed on the “*other features*” test.

24.2 *J.R. Kapoor v. Micronix India*, 1994 Supp (3) SCC 215 which was an issue between ‘MICRONIX’ and ‘MICROTEL’ where the word ‘M’ was used as part of the logo where the Hon’ble Supreme Court stated that the visual effect of both the logos cannot be the same on the minds of the users;



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24.3 *Renaissance Hotel Holdings Inc. v. B. Vijaya Sai &Ors.*, (2022) 5 SCC 1, where reliance was placed on para 48 of the said decision.

24.4 *Kaviraj Pandit Durga Dutt Sharma v. Navratna Pharmaceutical Laboratories*, 1964 SCC OnLine 14 where reliance was on para 29 of the decision.

24.5 *Intex Technologies v. AZ Tech*, 2017 SCC OnLine Del 7392 where reliance was placed on para 31 and 32.

24.6 On the aspect of use by third parties, reliance was placed on *Premiere SPG and WVG Mills Pvt. Ltd. v. Football Association Premiere League Ltd. & Anr.*, 2024:DHC:427 where it was stated that the appellant therein could not have a monopoly over the word 'PREMIERE' considering it is a word of general use;

24.7 *Vasundhara Jewellers Pvt. Ltd. v. Kirat Vinodbhai Jadwani*, 2022 SCC OnLine Del 3370 in particular para 38 to 41.

24.8 On concealment by the plaintiff of fact, reliance was placed on *S.K. Sachdeva &Anr. v. Shree Educare Ltd. &Anr.*, 2016 SCC OnLine Del 6708 where reliance on para 17 and 18.

24.9 On balance of convenience, reliance was placed on *Colgate Palmolive India Ltd. v. Hindustan Lever Ltd.*, (1999) 7 SCC 1 wherein guidelines for grant of interlocutory injunction had been culled out in para 24.



Submissions in Rejoinder on behalf of the Plaintiff

25. Counsel for plaintiff dealt with the issue of their settlement with *Soccer International* for the ‘X’ device mark stating that it was a different device and the said entity was not a big player. Even otherwise, agreement to co-exist with a third party does not take away the right in itself of the plaintiff. Further, there were no third parties who had a prior user than that of the plaintiff. Reliance was placed on *Pankaj Goyal v. Dabur India Ltd.*, 2008 SCC OnLine Del 1744 to substantiate that private settlement with the third party cannot offer license to use the same wherein para 24 of the said decision was highlighted which in turn relies upon the decision in *Prakash Roadline v. Prakash Parcel Service*, 42 (1992) DLT 390.

26. Moreover, the 2011 application that the defendants were referring to as being prior to that of the plaintiff was in Class 18 and not Class 25. Moreover, the Act does not recognize the concept of a crowded marketplace, for this reliance was placed on para 32 of the decision in *Under Armour Inc. v. Aditya Birla Fashion & Retail Ltd*, (2023) 300 DLT 573.

27. Reliance was also placed on *Glaxosmithkline Pharmaceuticals Ltd. v. Horizon Bioceuticals Pvt. Ltd.*, 2023:DHC:2390 where it was noted by the Court that “*common to register*” is qualitatively different from “*common to trade*” and that one may register a mark and leave it unused or at best make sporadic appearances. Such registrations do not divest the mark of distinctiveness to disentitle the plaintiff to an injunction.



28. Reliance was also placed on *Automatic Electric Ltd. v. R K Dhawan & Anr.*, 77 (1999) DLT 292 on the proposition that if defendant itself ascertained rights in the trademark, it cannot contend that the trademark is generic or common. Reliance was further placed on *Swiss Bike Vertriebs GMBH Subsidiary of Accell Group v. Reliance Brands Ltd.*, 2024:DHC:1884 to contend that estoppel can only apply *inter se* parties and not with regards to third parties.

Sur Rejoinder by the Defendants

29. Senior Counsel for the defendants placed a short sur rejoinder stating that – *firstly*, the amended plaint was filed in December 2019 and settlement with a third party was still not disclosed; *secondly*, that the 2011 application was indeed in Class 25; *thirdly*, that there was a different enforcement criteria for device mark; *fourthly*, it was agreed that ‘X’ had to be disregarded by the plaintiff since it was common to market place, and, therefore, other features would have to be seen as per *Corn Products (supra)*; *fifthly*, the decision in *Under Armour (supra)* was distinguished on crowded market place stating that its concept was not rejected on law but only rejected on facts; *sixthly*, the decision in *Glaxo Smith Kline (supra)* was distinguished on the basis of para 7.2.9; and *lastly*, reliance was made on *Pankaj Goyal (supra)* in particular para 23 stating that that was not a case of permitted use but a settlement agreeing to co-exist.



Analysis



30. Having considered the submissions by the counsel and perused the documents on record, this Court is of the opinion that the plaintiff is not entitled to the injunction for *inter alia* the following reasons:

30.1 The respective 'X' device marks of the plaintiff and the defendants are being used not in isolation but in conjunction with their respective trademarks 'SPARX' and 'HRX'. It is evident that the consumer is not purchasing a product under the mark 'X' but for the brand 'SPARX' and 'HRX', respectively. The confusion, therefore, does not arise in the first place for a consumer. The 'X' device marks are only placed on certain parts of the shoe/footwear by the respective companies. The question of it being mistaken for an isolated device mark to identify the source of goods does not arise.

30.2 A perusal of the mark cited in examination of the plaintiff's registration show that there were a number of 'X' marks which were available on the Trade Marks Register including device marks. With regard to one of these device marks being used by *Soccer International Pvt. Ltd.*, the plaintiff did enter into a settlement and agreed to co-exist. Even though the plaintiff's assertion is that they were not big players, it goes to show that the plaintiff had accepted the presence of other 'X' device marks in the market. This would dilute the plaintiff's unqualified stand that they were entitled to



monopolise on the device mark ‘X’ with the stylization that it had adopted. There was no palpable difference between the plaintiff’s ‘X’ mark and that used by *Soccer International*. A comparison of the two marks is shown as under:





Plaintiff’s X mark	X mark of Soccer International
	

30.3 One of the arms of ‘X’ in the *Soccer International*’s mark/device had a slightly different take than that of the plaintiff's mark. This comparison also shows that it would be impossible to even document the various minor variations which could occur in the stylization of the letter 'X' considering it consists of two simple lines intersecting each other.

30.4 To substantiate the above, a comparative table is provided under to show the plaintiff's and the defendants' 'X' marks, the one used by *Soccer International* and the ones which are available on Amazon listings as shown by the defendants for ‘X-STEP’ and ‘PAYNTR-X’.

Entity	Mark
Plaintiff	



Defendants	
Soccer International Private Ltd.	
X-STEP	
PAYNTR-X	

30.5 The plaintiff had clearly stated that it was not claiming monopoly over the use of the letter ‘X’ but only in its stylization. However, difference in stylization of ‘X’ could be various and numerous, and considering that neither of these companies including the plaintiff and the defendants were using the ‘X’ device mark as an isolated identification for their products, but instead selling goods under the principal brand names, the confusion would not arise.

30.6 The plaintiff would have a case in the event somebody had exactly copied its ‘X’ mark in order that it is identical and there was evidence on the record to show that it sought to counterfeit the plaintiff’s products, or



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otherwise were using a principal trademark which was similar to that of the plaintiff's principal trademark being '**RELAXO**' or '**SPARX**'.

30.7 It is an admitted position that the defendants' application in Class 25 was filed a year earlier in 2011 and that of the plaintiff in 2012. The launch by the defendants of their products in 2013 does not *per se* offer evidence of the fact that there was dishonest adoption by them. '**HRX**' and '**HRX BY HRITIK ROSHAN**' was a distinctive mark and brand developed by the defendants with a unique identity, unique celebrity endorsement, and a full-storyboard based upon their inspiration from the Actor Hritik Roshan. It is stated in their written statement that the respondent's mark has been created from the first letters of the name '**HR**ITHIK' '**R**OSHAN' along with the word '**EXTREME**'.

30.8 Having spent substantially on developing their brand to be distinctive, it cannot be said that the defendants have dishonestly adopted the plaintiff's 'X' device mark, since it would not be of any substantial purpose. It would have been a different situation if both the plaintiff and the defendants were using the 'X' device marks purely and simply on their shoes and the packaging without their principal brand names or otherwise listing them as such on online sites without the principal brand names, which is not the case herein. Besides the defendants having been in the market now since 2013 i.e. more than a decade, the balance of convenience also leans in their favour.

30.9 Though it may strictly not apply on the facts of this case, but the principle of "*added matter*" as relied on in *Corn Products* (*supra*) by the



Supreme Court, and *Intex Technologies* (*supra*) by this Court may be instructive.

30.10 Relevant portions of *Corn Products* (*supra*) are extracted as under:

15. Now it is a well recognised principle, that has to be taken into account in considering the possibility of confusion arising between any two trademarks, that, where those two marks contain a common element which is also contained in a number of other marks in use in the same market such a common occurrence in the market tends to cause purchasers to pay more attention to the other features of the respective marks and to distinguish between them by those features. This principle clearly requires that the marks comprising the common element shall be in fairly extensive use and, as I have mentioned, in use in the market in which the marks under consideration are being or will be used.

(emphasis supplied)

30.11 Relevant portions of *Intex Technologies* (*supra*) are extracted as under:

31. Insofar as the issue of added matter is concerned, there is no doubt that if the added matter is so prominent as to completely distinguish one product from the other, then there would be no case for confusion whether it be confusion proper or, initial confusion or reverse confusion. In the present case, we find that the mark “Intex” is as prominent, if not more, than the mark “AQUA” in the appellant's product packaging. This is also evident from the images of the packaging employed by the parties as given below:

(emphasis supplied)

30.12 Considering that the issue relates to the ‘X’ device marks used respectively by the parties with their respective stylisations, the “*added*



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matter”, if at all, could be taken to be the main brands *viz.* ‘**SPARX**’ and ‘**HRX**’ respectively under which they sell their products.

31. In view of the above discussion, this application under Order XXXIX Rules 1 & 2 of the CPC is dismissed. It is made clear that these observations are *prima facie* at this stage since the trial is yet to commence.

32. Application stands disposed of accordingly.

CS(COMM) 917/2018

1. List before the Joint Registrar on 16th July, 2024 for further proceedings.
2. Judgment be uploaded on the website of this Court.

**ANISH DAYAL
JUDGE**

MAY 03, 2024/MK/sc