

## Under Armour Inc. vs Ashwani & Anr. on 29 March, 2025

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IN THE HIGH COURT OF DELHI AT NEW DELHI

C.O. (COMM.IPD-TM) 150/2023 & I.A. Nos. 8419/2023 & 8421/2023

UNDER ARMOUR INC.

Through:

Mr. Deepak Shrivastava  
Mr. Rishi Bansal and  
Gupta, Advocates.

Email: unitedmark@unitedand

versus

ASHWANI & ANR.

Through:

Ms. Nidhi Raman, CGSC  
Mr. Arnab Mittal and M  
Mishra, Advocates for  
2.

Email: nidhiraman.offi

CORAM:

HON'BLE MS. JUSTICE MINI PUSHKARNA  
ORDER

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06.03.2025

MINI PUSHKARNA, J: (ORAL)

1. Present petition has been filed seeking removal of entry pertaining to impugned registration of trademark/ label registered under no. 5372621 in Class 25 from the Register of Trademarks.

2. The case, as canvassed by the petitioner, is as follows:

2.1 The petitioner, founded in the year 1996, is engaged in the business of manufacture, distribution, and sale of a large variety of goods, including, casual apparel, sports apparel, footwear, and other allied/related products, including, maintaining its exclusive stores, branding thereon and extensive branding on packaging of products, store paraphernalia, etc. 2.2 The petitioner is known worldwide for its UNDER ARMOUR, UA, and ARMOUR trademarks, also represented through its distinctive logo, i.e. . The said distinctive logo is an impression of interlocking U and A. 2.3 In order to expand its business, the petitioner initially adopted and started using various UA formative trademarks viz., UA RUSH, UA HOVR, UA TECH, UA RECORD, , etc., and/ or combinations, thereof.

2.4 Petitioner acquired international statutory rights in the word mark UA since its first use in the year 1996, under the United States Patent and Trademark Office ("USPTO") registration no. 4076189. Further, the petitioner has also acquired registrations for its said trademarks in India, which are valid and subsisting, till date.

2.5 Petitioner has superior statutory rights over the mark 'UA', in isolation of the rights over the entire mark, 'UNDER ARMOUR', at least since the year 2011, in India, wherein, the trademark UA is registered, having validity upto 12th January, 2031.

2.6 Petitioner is the owner of artistic copyright in its trademark/label and related marks under Section 13(1) of the Copyright Act, 1957, having independently created and adopted them in bona fide manner. As original artistic work, petitioner has the exclusive reproduction rights under Section 14(c) of the Copyright Act, 1957. The enforceability of these trademarks/labels extends under the Copyright Act, 1957, and is further reinforced by India's adherence to international copyright frameworks, including, the Berne Convention, the Universal Copyright Convention, and the International Copyright Order, 1991.

2.7 The petitioner entered India in 2017 through Amazon Fashion, selling its goods directly via Cloudtail India Pvt. Ltd. Consequently, Under Armour India Trading Private Limited (UA India) was established later in October 2018.

2.8 The petitioner operates its business over internet through its website, [www.underarmour.com](http://www.underarmour.com), with [www.ua.com](http://www.ua.com) redirecting to the same. It has owned [www.ua.com](http://www.ua.com) since 1994 and registered [www.uawoman.com](http://www.uawoman.com) on 02nd December, 2002. These domain names, integral to its UNDER ARMOUR and UA trademarks, provide extensive product and business information, attracting significant traffic. The websites are interactive, reinforcing the petitioner's global trade, goodwill, and reputation. 2.9 The petitioner actively promotes and sells its goods through major e-

commerce platforms like Amazon, Myntra, Ajio, and Flipkart, accessible across India, ensuring widespread brand visibility under its trademarks. 2.10 The USPTO's Trademark Trial and Appeal Board recognized UNDER ARMOUR as a "famous mark" in sporting goods and clothing on 21st May, 2009 in Opposition No. 91178653, Under Armour, Inc. Versus Renee Bode. Notably, the petitioner's mark was declared famous in the USA for the same Class of goods in which respondent no.1 now operates under an infringing brand.

2.11 Thus, the petitioner's global presence since 1996, extensive media promotion, vast physical and online reach across India, and international trans-border reputation have collectively established its trademarks as well-known.

2.12 In July 2022, during a routine trademark search, the petitioner discovered the impugned mark, DEVICE OF AU bearing No. 5372621, filed under Class 25 on 16th March, 2022 on a proposed-to-be-used basis. The mark was published in Journal No. 2054-O, dated 30th May, 2022, in Class 25 for goods, including, apparels, footwear, and head gear. 2.13 Further inquiry on the trademark office website revealed that the application was filed by ASHWANI, a single firm located at B-1/19, Vishnu Garden. A market investigation showed that respondent no.1 was also operating a brick-and-mortar store named AU Collection in Delhi. 2.14 Aggrieved, the petitioner sent a Cease and Desist Notice on 02nd July, 2022, but has received no response, till date. Despite the notice,

respondent no.1 continues its infringing activities.

2.15 Respondent no.1 is a dishonest entity and is riding on the goodwill and reputation of the petitioner by using its impugned trade mark, which is identical to that of the petitioner's trademark/ label UA, and . Since, the petitioner missed the four months' deadline in filing the opposition to respondent no.1's application, the said impugned mark came to be registered. Hence, the present rectification petition came to be filed.

3. I have heard learned counsel for the parties and have perused the record.

4. This Court notes that respondent no.1 was first issued notice vide order dated 01st May, 2023, whereby, respondent no.1 was directed to file its reply within four weeks. Subsequently, learned counsel put in appearance for respondent no.1 on 01st February, 2024, and sought time to file reply. Thereafter, further opportunity was granted to learned counsel appearing for the respondent no.1 to file reply, vide order dated 30th April, 2024. However, no reply has come to be filed on behalf of respondent no.1.

5. Since none appeared for respondent no.1 on the last date of hearing, default notice was issued, vide order dated 28th January, 2025. The said order is reproduced as under:

"xxx xxx xxx

1. None appears for the respondent no. 1 when the matter is called out.

2. Issue default notice to Mr. Aman Kumar Singh, the counsel for respondent no. 1 by all modes, including, speed post, whose appearance is recorded in the order dated 30th April, 2024, as well as to respondent no.1.

3. It is made clear that in case none appears for respondent no. 1 despite service of notice, the Court shall proceed to hear the matter.

xxx xxx xxx"

6. Perusal of the Office Noting shows that the respondent no. 1 stands served through his brother, who accepted the notice on his behalf. As none has appeared for respondent no.1, thus, this Court has proceeded with the matter.

7. This Court takes note of the various trademark registrations granted in favour of the petitioner in India, which are valid and subsisting, till date. The details of registrations, are enumerated in the table given in the petition, which is reproduced as under:

8. Thus, it is manifest that the petitioner has registrations in its favour, which are valid and subsisting, the earliest applications for the device mark and word mark, having been made in the year 2004 and 2011, respectively.

9. Per contra, the respondent no.1 filed an application on 16th March, 2022, with the Trademark Registry for registration of the device mark on 'proposed to be used' basis. Hence, clearly the petitioner is the much prior adopter, user, as well as the prior applicant and registered proprietor of both the word mark and label of UA, and .

10. At this stage, it is pertinent to compare the marks of the petitioner and respondent no.1. The said marks are reproduced, as under:

Petitioner's Mark

Respondent no.1's

UA

AU

11. Perusal of the aforesaid marks shows that, the impugned mark is deceptively similar to the petitioner's prior used and registered 'UA' trademarks. It is evident that the respondent no.1 has, in its impugned mark, cleverly imitated the interlocking U & A mark and element of the petitioner's registered and prior trademarks. The impugned mark of respondent no.1, i.e., , also consists of an interlocking of the characters U & A, just as in the case of the petitioner. Therefore, by presenting its mark as AU instead of UA, respondent no.1 seeks to mislead consumers through interchangeable use of the overlapping characters, causing confusion and passing off.

12. Learned counsel appearing for the petitioner relies on the order dated 03rd April, 2024, in CS(COMM) 273/2024, titled Kubota Corporation Versus Kaira Agros & Ors., passed by this Court, wherein, the defendants therein were restrained from using the device mark, which was deceptively similar to the plaintiff's trademark. The relevant extracts of the said order are reproduced as under:

"xxx xxx xxx 17.2. The Defendants' device mark ' ', which is embossed on Defendant No. 1's combine harvester, is deceptively similar to the Plaintiff's trademark ' '. The Defendants' use of a similar colour scheme, as well as an overlapping 'tick' mark, clearly evidences dishonesty on the part of Defendant No. 1. Considering the fact that these marks are used in respect of an identical category of goods, such use amounts to an act of passing off. A side-by-side comparison of the marks is represented as follows:

.....

22.2. Defendants, and/or anybody acting on their behalf, are restrained from using ' ' or any other word mark/ trademark/ label which is identical or deceptively similar to the Plaintiff's trademark ' ' in relation to the impugned products, i.e., combine harvesters.

xxx xxx xxx"

(Emphasis Supplied)

13. He further relies on the judgment passed by the High Court of Madras, in the case of MRF Limited Versus POWERMAX Rubber Factory and Ors., MANU/TN/1481/2024, wherein, it has been held as under:

"XXX XXX XXX

17. The use of the body builder device by the defendants in respect of its tyre business will certainly amount to the infringement of the plaintiff's registered trademark, infringement of the Copyright in the artistic work contained therein as well as the tort of passing off for the following reasons:

a) The Musclemán Device mark has been used by the plaintiff since 1961 and registered under No. 418892 as early as on 09.03.1984 and the said registration is valid and subsisting till date as seen from Ex.P3;

b) The trademarks PAHALWAN has also been used by the plaintiff in respect of its tyres for the last several decades and has been registered under No. 542604 as early as on 28.12.1990 much prior to even the incorporation of the defendants' predecessor Company in 2003;

c) The said PAHALWAN mark of the plaintiff is also a visual depiction of the plaintiff's trademark Musclemán Device for the purposes of Section 29(9) of the Trade Marks Act, 1999;

d) The body builder device mark used by the defendants is identical/deceptively similar to the plaintiff's Musclemán Device mark ; .

.....

51. The torso of a muscular man and the arms are the distinctive elements of the plaintiff's Musclemán Device, which has been registered under the Trade Marks Act. When the essential features of the plaintiff's Musclemán Device has been copied by the defendants and any layman of average intelligence and imperfect recollection will certainly be confused as to whether the defendants' product is also associated with the plaintiff, the ratio laid down in Cadila Health Care Ltd., V. Cadila Pharmaceuticals Ltd. reported in MANU/SC/0199/2001 : 2001:INSC:173 : (2001) 5 SCC 73 for testing deceptive similarity has been satisfied by the plaintiff. They have been able to prove beyond reasonable doubt that the defendants' body builder logo is an imitation of the plaintiff's Musclemán Device mark as the defendants' logo also depicts the torso of a muscular man with two arms. Certainly, if the defendant is allowed to continue using the impugned device, the general public having average intelligence and imperfect recollection will be deceived as they will have an impression that the product of the defendants is also associated with the plaintiff. The decision rendered in Parle Products (P) Ltd. V. J.P. And Co., Mysore reported in MANU/SC/0412/1972 :

1972:INSC:31 : (1972) 1 SCC 618 decision also comes to the aid of the plaintiff. In the said decision, the principle "two marks, when placed side by side may exhibit many and various differences, yet the main idea left on mind by both may be the same" was applied.

52. In the case on hand also the two marks viz., one the "Muscleman Device" of the plaintiff and the other the "body builder" logo of the defendants may have differences but yet the main idea has been copied by the defendants from the plaintiff's Muscleman Device by using the torso of a muscular man and the two arms which has been used in the plaintiff's registered Muscleman Device.

xxx xxx xxx"

(Emphasis Supplied)

14. Considering the discussion hereinabove, this Court is of the view that the impugned mark is likely to cause confusion and deception among the consumers who are ordinary persons of average intelligence and imperfect recollection. The petitioner has been using the UA marks since the year 1996 in the USA and applied for registration of the said mark in India, in the year 2004. The documentary evidence on record clearly evidences that the marks of the petitioner have acquired immense goodwill and reputation worldwide, including, in India.

15. Accordingly, it is directed as follows:

15.1 The trademark registration no. 5372621 for the mark registered in Class 25 in favour of respondent no. 1 is hereby cancelled. 15.2 The respondent no. 2 i.e., the Trade Marks Registry is directed to carry out the requisite rectification in its register. 15.3 Appropriate notification in this regard shall also be issued by the Trade Marks Registry.

16. The Registry is directed to supply a copy of the present order to the Office of the Controller General of Patents, Designs and Trade Marks of India, on E-mail ID: llc-ipo@gov.in, for compliance.

17. The present petition, along with the pending applications, stands disposed of, in the aforesaid terms.

MINI PUSHKARNA, J MARCH 6, 2025 c Corrected and released on:

29th March, 2025