



2025:DHC:649



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

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*Date of decision: 28<sup>th</sup> January, 2025*

+ C.O. (COMM.IPD-TM) 81/2024 &amp; I.A. 1681/2025

GOODAI GLOBAL INC

.....Petitioner

Through: Mr. Cheitanya Madan, Mr. C.D. Mulherkar, Mr. R. Vigneshwar and Ms. Megha Saha, Advocates

versus

SHAHNAWAZ SIDDIQU &amp; ANR.

.....Respondents

Through: Ms. Nidhi Raman, CGSC with Mr. Zubin Singh and Mr. Amit Acharya, Advocates for R-2/UIO

**CORAM:****HON'BLE MR. JUSTICE AMIT BANSAL****AMIT BANSAL, J. (Oral)**

1. The present rectification petition has been filed under Section 57 of the Trade Marks Act, 1999 (hereinafter, 'the Act') seeking removal of the registration of a device mark registered under application number 5635163 in class 3 in favour of the respondent no.1 on 3<sup>rd</sup> October, 2022 on a '*proposed to be used basis*'.

**PROCEEDINGS IN THE PETITION**

2. Notice in the petition was issued on 4<sup>th</sup> July, 2024 and four weeks' time was granted to the respondent no. 1 to file reply.

3. Despite service, neither any reply was filed on behalf of the



respondent no. 1, nor any appearance was made on behalf of the respondent no. 1.

4. Accordingly, the right of the respondent no.1 to file reply to the petitions was closed *vide* the order of Joint Registrar dated 8th October, 2024.


5. Consequently, the respondent no.1 was proceeded against *ex-parte vide* order dated 21<sup>st</sup> October, 2024 and an *interim* injunction was passed in favour of the petitioner.

6. Even today, none appears on behalf of the respondent no. 1.

### **BRIEF FACTS**

7. Brief facts leading to the filing of the present petition are as follows:

7.1. The petitioner is a South Korean entity, engaged in the business of manufacturer of Korean beauty and personal care products across 54 (Fifty-four) countries under the brand name 'Beauty of Joseon'.

7.2. The petitioner in the year 2010 launched the distribution of skin care products ranging from serums, cleansing oil, sunscreen, pore masks inspired from traditional Korean beauty under the brand name 'Beauty of Joseon' with the device mark  (hereinafter referred to as

“petitioner’s device mark”).

7.3. On 2<sup>nd</sup> March, 2017, the petitioner registered the website <https://beautyofjoseon.com/>, which can be accessed from anywhere in the world, including India, for its products.

7.4. It is stated that owing to its high quality, effectiveness and popularity



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amongst the consumers, various international magazines have applauded the quality of the products of the Petitioner. The URL Links and screenshots of the same are given in paragraph 10 of the plaint.

7.5. In and around August 2022 the petitioner commenced exporting its skin care products to India and the petitioner's products became available in India under its brand name 'Beauty of Joseon' with the petitioner's Device Mark through multiple e-commerce websites.

7.6. In response to the petitioner's International Trade Mark Application seeking registration of the petitioner's device mark, on 28<sup>th</sup> December, 2023, the Trade Mark Registry (respondent no.2) sent a notification of provisional refusal of protection of an international registration on the ground that the Petitioner's Device Mark is not distinctive. It is submitted that the Petitioner's Device Mark has been registered in approximately 30 international countries.

7.7. Accordingly, the petitioner filed its response dated 27<sup>th</sup> January, 2024 and came across the Impugned Device Mark registered by the respondent no. 1 on a '*proposed to be used*' basis.

7.8 At this juncture, it is pertinent to mention that the respondent no.1 has also sought registration of petitioner's brand name 'Beauty of Joseon' as a word mark under application no.6236043 on a '*proposed to be used*' basis. The petitioner has filed a notice of opposition to the aforesaid application on 7<sup>th</sup> March, 2024.

### **SUBMISSIONS OF THE PETITIONER**

8. Mr. Cheitanya Madan, counsel appearing on behalf of the petitioner submits that the impugned registration has been obtained dishonestly and in



bad faith by the respondent no.1. He places reliance on the judgments of this Court in *Kia Wang v. Registrar of Trademarks and Another*, (2023) SCC OnLine Del 5844 & *BPI Sports LLC v. Saurabh Gulati and Another*, (2023) 3 HCC (Del) 164.

9. He further submits that the respondent no. 1 registered the impugned mark on the '*proposed to be used*' basis after the petitioner entered the Indian market for skin care products and was already widely popular across the world.

10. It is submitted that the petitioner has spent immense amount of time, resources, effort and expense in use and promotion of its device mark and due to such voluminous use and promotion of the petitioner's device mark, the same is inextricably linked with the petitioner and the relevant section of the public is well aware of the goods under the applied mark as being rendered by the petitioner alone.

11. It is submitted that the impugned goods claimed under the impugned mark are identical to the goods under the petitioner's prior trade mark which increases the chances of confusion between the respondent no.1 and the petitioner. It is stated that the respondent no.1 has registered the impugned mark with an intent to cause confusion to the public at large.

12. In light of the above, it is stated that the impugned mark has been wrongly entered in the Register of Trade Marks and therefore, is liable to be cancelled in terms of Section 57 of the Act.

13. Accordingly, the petitioner has filed the present petition.

#### **ANALYSIS AND FINDINGS**



14. I have heard counsel for the petitioner and perused the record of the present petition.

15. The respondent no.1 has not filed his reply to the present petition,



which indicates that he has nothing substantial to put forth on merits, by way of a response to the averments made in the petition. In view of the above, the averments made in the petition are deemed to be admitted.

16. A side-by-side comparison of the petitioner’s device mark and the impugned device mark is tabulated below:

Petitioner’s Device Mark	Impugned Device Mark
	

17. A perusal of the aforesaid would show that respondent no. 1 has adopted a mark which is almost identical to the mark of the petitioner.

18. The petitioner’s mark features black Hangeul characters spelling “Joseon” and “Mi Nyeo” arranged in two lines at the centre. Complementing this arrangement is a red square seal located on the lower right side, encapsulating the white Hangeul text “Cracle In.” The transliteration of the petitioner’s device mark is “Joseon Mi Nyeo” and “Cracle In.” Hangeul is the Korean alphabet, which is used to write the Korean language and “Joseon” is a historical Korean dynasty. The term “Joseon” has no relation to any person or place in India. There is absolutely no reason for Respondent No.1 to adopt a device mark of a Korean name, that too in Hangeul (Korean) characters.

19. As evident from the aforesaid, the impugned mark is identical with



the petitioner's device marks and is registered in class 3 in relation to identical/similar goods and services. Further, the target consumers of the competing parties are identical.

20. Considering the aforesaid, I am 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, especially as the petitioner has been using the petitioner's device mark since the year 2010 and has acquired immense goodwill and reputation thereunder.

21. In *Kia Wang* (supra) the Court was dealing with a rectification petition filed against a registered trademark "Rockpapa" which was identical to the petitioner's mark adopted in the UK in 2014 and subsequently became highly popular worldwide. The petitioner therein had registrations for the said mark across various jurisdictions across the world. Relying upon *BPI sports* (supra), the Court held that the petitioner therein had been able to establish his case of being a prior user of the trademark and held that the respondent therein had no reason for adopting and registering a deceptively similar mark as that of the petitioner, except the *malafide* intention of taking unfair advantage of the goodwill generated by the petitioner. Accordingly, it was held that the registration of such a mark was liable to be cancelled due to the 'bad faith' involved in terms of Section 11 (10) (ii) of the Act.

22. In the present case as well, the manner in which the respondent no.1 has obtained the registration of the impugned mark in respect of identical goods for which the petitioner's device mark stands registered across 40 countries discloses clear 'bad faith' on the part of the respondent no.1



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23. The respondent no.1's registration of the impugned mark was executed with a clear intent to appropriate the petitioner's device mark and to block the petitioner's right to have it registered in its name in India. Such acts of respondent no.1 constitute trade mark squatting and amount to 'bad faith' and fall squarely within the scope of sub-section (10) (ii) of Section 11 of the Act. Additionally, the respondent no.1's failure to contest the present suit further indicates that they registered the impugned mark in 'bad faith'.

24. In the light of the aforesaid, it is clear that the impugned trade mark has been adopted by the respondent no.1 dishonestly to trade upon the established goodwill and reputation of the petitioner and to project itself to be associated with the petitioner. The attempt on the part of respondent no.1 was to appropriate the petitioner's device mark and therefore the continuation of the registration of the impugned mark granted in favour of respondent no.1 is in violation of Section 11(10)(ii) of the Act and is liable to be cancelled under the provisions of Section 57 of the Act.

25. Accordingly, the present petition is allowed and the trade mark Registry is directed to remove the impugned registered trade mark



bearing trade mark registration No. 5635163 in class 3 from the Register of Trade Marks.

26. The Registry is directed to send a copy of the present order to the Trade Mark Registry at e-mail - llc-ipo@gov.in for compliance.



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27. The pending application stands disposed of.

**JANUARY 28, 2025**

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**AMIT BANSAL, J**