

\* IN THE HIGH COURT OF DELHI AT NEW DELHI

*Reserved on: May 09, 2025*

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*Pronounced on: May 28, 2025*

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**C.O.(COMM.IPD-TM) 196/2022**

**SELLE ROYAL GROUP S.P.A..... Petitioner**

Through: Mr. Dhruv Anand, Ms. Udit Patro,  
Ms. Vaishali Sharma and Ms. Nimrat  
Singh, Advocates.

Versus

**ACE FOOTMARK (P) LTD. AND ANR. .... Respondents**

Through: None.

**CORAM:**

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

**J U D G M E N T**

**Preface:**

1. By virtue of the present petition, originally filed as an application before the Intellectual Property Appellate Board (**IPAB**) and transferred therefrom after its abolition and promulgation of Tribunal Reforms (Rationalization and Conditions of Service) Ordinance, 2021, the petitioner seeks cancellation of registration of the mark **FIZIKFREAK**<sup>1</sup> of the respondent no.1 and removal thereof from the Register of Trade Marks on the ground that the same is identical and/ or confusingly similar to the trademark **fi'zi:k** belonging to the petitioner.

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<sup>1</sup> Hereinafter '*impugned mark*'

**Brief facts:**

2. As per pleadings, the petitioner is a global company founded in Italy in 1956 and is engaged in manufacture and sale of bicycle accessories, saddles, handlebars, jackets, etc. which it is exporting to over 70 countries worldwide.

3. For a certain class of high-performance saddles launched in the United States of America and then handmade in Italy, the petitioner adopted and has been continuously using the trademark **fi'zi:k** since the year 1995. The said trademark **fi'zi:k** was also subsequently adopted with respect to a new line of shoes for professional cyclists, as also other footwear, since the year 1997. The said products are in circulation in India through authorized distributors since the year 2004 as also available on the registered website [www.fizik.com](http://www.fizik.com), also operational within the territory of India, along with the respective websites of such authorized distributors.

4. The said trademark **fi'zi:k** is registered in the name of the petitioner in numerous jurisdictions across the world, including in India through a multiclass application dated 01.06.2016 under the Trade Marks Act, 1999<sup>2</sup>, which was granted on 12.07.2019. Barring the said trademark **fi'zi:k**, the petitioner is also using the trademark **FREE:K** which is registered in the European Union.

5. The petitioner has generated substantial revenue in relation to its trademark **fi'zi:k** and has built a reputation as a racing brand across the world. So much so, the said trademark **fi'zi:k** has garnered considerable

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<sup>2</sup> Hereinafter '*TM Act*'

goodwill and reputation and is exclusively associated with the petitioner in the specific trade, with various publications in print and electronic media such as Mountain Bike Rider magazine, Big Bike magazine, etc.

6. The respondent no.1 *vide* application no.2762781 applied for registration of the impugned mark **FIZIFREAK** under *Class 25* of the TM Act on 26.06.2014, with a claimed user from 01.06.2014, and was granted registration of the same *vide* certificate no.164457 issued on 07.09.2017 for “footwear including slippers, flip-flops, sandals, shoes, boots, soles; clothing”. The said registration stands expired since 26.06.2024, and despite service of renewal/ O-3 notice upon the respondent no.1 by the respondent no.2, registration *qua* the impugned mark has not been renewed by the respondent no.1 till date.

7. The impugned mark has dishonestly been adopted by the respondent no.1, combining the *fi’zi:k* as well as the **FREE:K** trademarks being used by the petitioner to cause confusion amongst the public. Further, that the petitioner’s trademark being a coined mark without any dictionary meaning, is entitled to the highest form of protection.

**Arguments on behalf of the petitioner:**

8. Based thereon, Mr. Dhruv Anand, learned counsel for the petitioner submitted that this is a fit case for grant of cancellation of the impugned mark **FIZIFREAK**.

9. Mr. Dhruv Anand submitted that the lackadaisical attitude of the respondent no.1 in not renewing the registration for the impugned mark **FIZIFREAK**, as well as in not appearing before this Court, despite service

through WhatsApp on 16.04.2024 and through *e-mail* on 19.04.2024, is clear evidence of *mala fide* on its part, as also of the fact that the impugned mark has been adopted by the respondent no.1 without any real basis. The learned counsel then submitted that the maximum period of one year for renewal of a trademark under *Section 25(4)*<sup>3</sup> of the TM Act is on the verge of coming to an end on 26.06.2025. Thereafter, taking this Court through various other deceptively similar versions of popular third-party trademarks for which the respondent no.1 has maliciously filed application for registration, learned counsel submitted that the respondent no.1 is a habitual offender.

10. Mr. Dhruv Anand then, drawing the attention of this Court to the date of user, i.e. 01.06.2014, claimed by the respondent no.1 in its application for registration of the impugned mark **FIZIFREAK**, submitted that the same itself shows that the petitioner is the prior user of the trademark *fi'zi:k* since its adoption for bicycle saddles in the year 1995, and for shoes and other footwear in the year 1997, it has been in use specifically in India since the year 2004. As per Mr. Dhruv Anand, the respondent no.1 is a subsequent user of the impugned mark **FIZIFREAK**. Hence, the very registration thereof is bad in law, and the same is barred by *Section 11(1)(b)*<sup>4</sup> of the TM Act,

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<sup>3</sup> “25. *Duration, renewal, removal and restoration of registration.*-

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(4) *Where a trade mark has been removed from the register for non-payment of the prescribed fee, the Registrar shall, after six months and within one year from the expiration of the last registration of the trade mark, on receipt of an application in the prescribed form and on payment of the prescribed fee, if satisfied that it is just so to do, restore the trade mark to the register and renew the registration of the trade mark either generally or subject to such conditions or limitations as he thinks fit to impose, for a period of ten years from the expiration of the last registration.*”

<sup>4</sup> “11. *Relative grounds for refusal of registration.*-

being similar to the petitioner's earlier trademark as well as being in respect of identical goods, i.e. footwear.

11. Then, relying upon *H&M Hennes & Mauritz AB & Anr. v. HM Megabrand Pvt. Ltd. & Ors.*<sup>5</sup> as also upon *Article 6bis* of the Paris Convention for Protection of Industrial Property (1883), Mr. Dhruv Anand submitted that any mark which is identical and/ or confusingly similar to the mark of an aggrieved party exclusively identifying and associated with such party, cannot proceed for registration under *Section 11(3)(a)*<sup>6</sup> of the TM Act even if such prior mark is not yet registered, since the same amounts to passing off. Also, relying upon *Alfred Dunhill Limited v. R.P.S. Chawla and Ors.*<sup>7</sup>, Mr. Dhruv Anand submitted that registration of the impugned mark **FIZIFREAK** amounts to not only violation of the petitioner's prior rights under *Section 28* of the TM Act but also amounts to infringement under *Section 29* of the TM Act as well.

12. On the aspect of **fi'zi:k** trademark being registered as a 'device' mark and not a 'word' mark, Mr. Dhruv Anand, relying on *Vishesh Films Private*

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(1) Save as provided in section 12, a trade mark shall not be registered if, because of-  
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(b) its similarity to an earlier trade mark and the identity or similarity of the goods or services covered by the trade mark, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark. "

<sup>5</sup> 2018 (74) PTC 229 (Del)

<sup>6</sup> "11. Relative grounds for refusal of registration.-

(3) A trade mark shall not be registered if, or to the extent that, its use in India is liable to be prevented—

(a) by virtue of any law in particular the law of passing off protecting an unregistered trade mark used in the course of trade; (\*\*\*)"

<sup>7</sup> 2004 (29) PTC 39 Del

*Limited v. Super Cassettes Industries Limited*<sup>8</sup>, submitted that although the position is as stated above, however, the trademark *fi'zi:k* appears in a simple font without any other stylization or accompanying images or designs which could take the attention away from the word itself, and so, any deceptive similarity would have to be tested in the context of the said word itself. Further, Mr. Dhruv Anand took this Court through numerous publications in journals across the world where the petitioner and its products have been *simpliciter* referred to as '*Freek*' and '*Fizik*' without any extraneous elements/ punctuations, to support the conclusion that the *words* themselves, being *fizik* and *freek*, are associated with the petitioner, and the same have been combined by the respondent no.1 to arrive at the impugned mark **FIZIFREAK**.

13. Lastly, placing reliance on *Tata Sons Ltd. v. Prakash Yadav & Ors.*<sup>9</sup>, learned counsel submitted that the respondent no.1 is liable to be burdened with heavy costs by virtue of being a habitual offender.

**Analysis and Findings:**

14. This Court has heard learned counsel for the petitioner, as also gone through the pleadings and documents on record and also gone through the judgments cited at Bar.

15. While adjudicating the present petition, this Court has to take into account that despite the respondent no.1 being duly served, since there was neither any appearance on its behalf nor did it file any response thereto, the

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<sup>8</sup> 2024:DHC:6691

<sup>9</sup> CS(COMM) 383/2018

respondent no.1, *vide* order dated 29.04.2025 was proceeded *ex parte*. The conduct of the respondent no.1 in abstaining from participating in the present proceedings speaks volumes. As such, since there is no general/ specific denial of the pleadings by the respondent no1., therefore, under such circumstances, all the said averments made before this Court, are deemed to be admitted as true.

16. It has also to be borne in mind that the registration of the impugned mark **FIZIFREAK** already stands expired since 26.06.2024 and the maximum period of one year for renewal thereof under *Section 25(4)* of the TM Act is also on the verge of coming to an end on 26.06.2025, and that despite the same, the respondent no.1 has not taken any steps *qua* renewal of its trademark also speaks volumes.

17. Based on the pleadings, this Court finds that the trademark *fi'zi:k* of the petitioner is a coined word, which is neither generic to the trade of footwear nor descriptive or suggestive of the products of the petitioner.

18. Though, the petitioner did not have a registration for the trademark *fi'zi:k* in India on the date of registration of the impugned mark **FIZIFREAK**, however, the petitioner has been able to show proof of adoption of the trademark *fi'zi:k* by it across the world since as far back as 1996 and its actual market presence in India since 2004. An affidavit to that effect on behalf of one Naren International, one of the authorized distributors of the petitioner, has also been annexed with the present petition. In fact, considering that the respondent no.1 filed application for registration of the impugned mark **FIZIFREAK** subsequent to the adoption of the trademark



*fi'zi:k* by the petitioner across the world, including India, only on 26.06.2014, there is no doubt that the petitioner is the prior adopter and user of the trademark *fi'zi:k*, which in turn has given birth to goodwill and reputation [*N.R. Dongre v. Whirlpool Corporation*<sup>10</sup>]. In fact, as observed by this Court in *H&M Hennes & Mauritz (supra)*, referring to another judgement rendered by this Court in *Cadbury UK Ltd. v. Lotte India Corporation Limited*<sup>11</sup>, even visibility in India through webpages, keeping in view the high exchange of human and other resources across borders, is sufficient to establish reputation.

19. In any event, it is worthy of noting that even though in the present case the respondent no.1 has filed an application for registration of the impugned mark **FIZIFREAK** prior to the petitioner herein in India, but that in itself under the aforesaid circumstances, is not sufficient to allow the registration thereof to remain in the Register of Trade Marks or to allow it to steal a march over the petitioner and/ or its world-renowned/ well-established trademark *fi'zi:k*.

20. Under such circumstances, the petitioner is entitled to the benefit of *Section 11(3)(b)* of the TM Act, particularly, since the same bars the registration of any mark, use whereof would amount to passing off of a prior mark, even if the same is unregistered.

21. The registration of the impugned mark **FIZIFREAK** is also liable for cancellation as both the registered trademarks *fi'zi:k* and **FREE:K** of the

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<sup>10</sup> (1996) 5 SCC 714

<sup>11</sup> 2014 SCC OnLine Del 367



petitioner have been referred to as *fizik* and *freak*. In this backdrop, viewing the impugned mark **FIZIFREAK** of the respondent no.1 through the eyes of an ordinary consumer with imperfect recollection, the same appears to be visually, structurally, phonetically as well as conceptually similar to the petitioner's registered trademarks *fi'zi:k* and **FREE:K**, often referred to as *fizik* and *freak*. So much so, the former part of the impugned mark '**FIZIFREAK**' is phonetically identical to the '*fizik*' in the petitioners *fi'zi:k* trademark, and the latter part of '**FIZIFREAK**' is also phonetically identical to, rather completely incorporates the '*freak*'/ **FREE:K** trademark also being used by the petitioner.

22. The adoption and registration of the impugned mark **FIZIFREAK** by the respondent no.1, for identically similar goods as that of the petitioner, appears to be a deliberate attempt by the respondent no.1 to come as close as possible to the petitioner's world-renowned registered trademarks *fi'zi:k* and **FREE:K**, often referred to as *fizik* and *freak*, to exploit the petitioner's goodwill and reputation by creating confusion in the minds of the general public exposed to the deceptively similar impugned mark through identical trade channels for the exact same class of products.

23. This is more so, since the petitioner has from the documents on record, been able to show that the conduct of the respondent no.1 has always been to try to squat upon the goodwill and reputation of well-established mark(s), as it has been repeatedly filing application for registration of marks such as '**CRUZE**' identical to '**CHEVROLET CRUZE**', or '**TOYOYO**' identically similar to '**TOYOTA**', amongst others. This, *prima facie*, leads this Court to

infer that the respondent no.1 is a habitual offender and the adoption of the impugned mark **FIZIFREAK** by the respondent no.1 is shrouded in mystery.

**Conclusion:**

24. In view of the aforesaid, this Court has no hesitation in directing the Registrar of Trademarks/ respondent no.2 to proceed for cancellation of the impugned mark **FIZIFREAK** registered in the name of the respondent no.1 pursuant to application no.2762781 dated 26.06.2014, *vide* certificate no.164457 issued on 07.09.2017 under *Class 25* of the TM Act and remove the impugned mark **FIZIFREAK** from the Register of Trade Marks.

25. Accordingly, the present petition is disposed of with no order as to costs.

**SAURABH BANERJEE, J.**

**MAY 28, 2025/AB**