

**IN THE COURT OF DISTRICT JUDGE (COMMERCIAL
COURT)-01,
CENTRAL, TIS HAZARI COURTS, DELHI
PRESIDED BY: MR. SANJEEV KUMAR AGGARWAL**

IN THE MATTER OF:

CS (COMM) NO. 1722/20

The Polo / Lauren Company L.P.

....Plaintiff

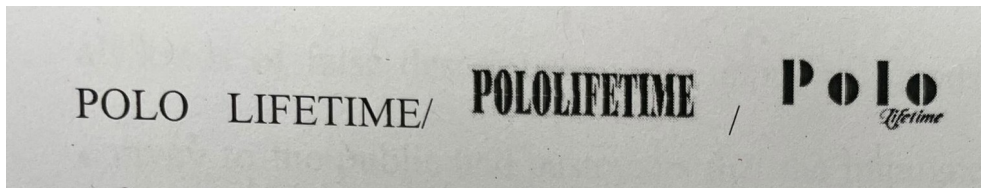
Versus

M/s. Home Needs

.... Defendant

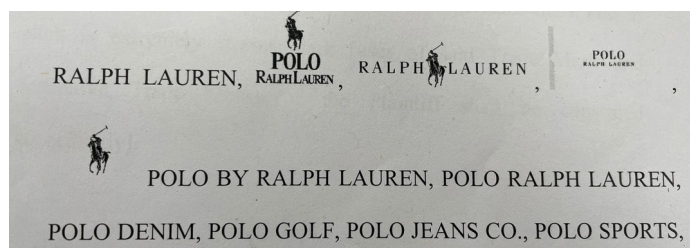
**ORDER
(14.07.2023)**

1. Vide this order, I shall decide the application filed by plaintiff under Order XXXIX Rule 1 & 2 CPC seeking interim injunction restraining the defendant to export, manufacture, marketing, using, selling/ soliciting, advertising etc., the trade mark /label




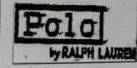
2. Brief facts of the case as set up in plaint are that plaintiff is engaged in its celebrated and world renowned business of manufacture, distribution, trade and sale of a wide range of clothing, fashion and lifestyle products including spans fashion wear, sportswear, eye wear, luggage, bags and luxurious home decor including bedding, towels, area rugs, wall covering, tabletop and table covering and other allied and related goods and offering

services in connection therewith. It has been further stated that the plaintiff adopted of the Trademark POLO in the year 1967 and subsequently using the formative POLO marks word per se and in stylized manner in conjunction with other marks / words and device of polo player in relation to its said goods and business in the course of trade and in addition to word per se user of the said Trademark POLO, the plaintiff over a period of time has been using its formative trademark in conjunction with other words / marks in various stylized and artistic formats with and /or without device of Polo Player, which have been created and are being created over a period of time viz POLO, POLO RALPH LAUREN



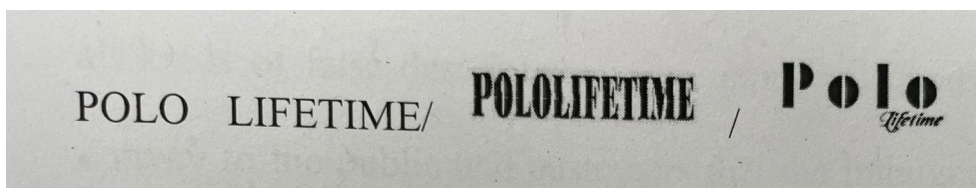
3. Further, the case of the plaintiff is that the art works involved in the plaintiff's said trademark/label/Trade name are original artistic works and the plaintiff is the owner and propri-

etor of the copyright therein. Hence, nobody has any right to use the aforesaid trademark. It has been further stated that plaintiff has following trademark registrations in India under the Trade-marks Act, 1999:-

Mark (Profile Name)	Applicat ion No.	Class	Status	User Claimed	Date of registration	Valid Upto	Disclaimer
	1349783	25 & 18	Registered	01/01/1994	08/04/2005	08/04/2025	No
POLO (DEVICE)	489215	25	Registered	Proposed to be used	14/04/1988	14/04/2029	No
 POLO BY RALPH LAUREN (DEVICE)	674214	25	Registered	Proposed to be used	24/07/1995	24/07/2025	No

4. It has been further stated that plaintiff has been honestly & bonafidely, continuously, commercially, openly, exclusively and to the exclusion of others, uninterruptedly and in the course of trade and as proprietor thereof been suing its trademark / label/trade name as trade marks in relation to its said goods and business and carrying on its said goods and business there under and has built up a worldwide and globally valuable trade, goodwill and reputation there under and acquired propriety rights therein. It has been further stated that substantial reputation and goodwill has accrued to the POLO Trademarks through extensive use and advertising worldwide. It has been further stated that Aditya Birla Fashions & Retail Ltd. has become licensee of the plaintiff in India and plaintiff has launched its first store at DLF Emporio, Vasant Kunj.

5. It has been further stated that defendant is engaged in the business of manufacturing, marketing, soliciting, selling, displaying and trading of range of household products and kitchen utensils, including but not limited to, stainless steel vacuum insulated bottles, single wall bottles, trays, cookware's, dinnerware and other allied/related products and defendant has adopted and started using the trademark,



in relation to its impugned goods and defendant adoption of the said trademark is complete violation of plaintiff's statutory and common law right in the said trademark and copyright.

6. It has been further stated that mere addition of the word 'LIFETIME' to the term POLO does not render it distinctive and distinguishable. It has been further stated that the impugned trade mark/label adopted and being used by the Defendant in relation to their impugned goods and business are identical with and deceptively similar to the Plaintiff's said trade mark/label in each and every respect including phonetically, visually, structurally, in its basic idea and in its essential features. It has been further stated that defendant has also copied the artistic features involved in the Plaintiff's trade mark/label and is thus infringing the Plaintiff's copyrights involved in its said trade mark. It has been further stated that defendant is using all kinds of false description on its impugned goods to wrongly convey to the public and cus-

tomers that the impugned goods are coming from the source and origin of the Plaintiff.

7. It has been further stated that in the first week of February, 2009 the Defendant had applied for registration of its impugned trademark application POLO (Word Mark) bearing number 1537943 in Class 21 which was in the name of one Ms Sun Star (Defendant's predecessor firm). It has been further stated that the Plaintiff in the first week of June, 2009 instituted opposition proceedings against the trademark application POLO (Word Mark) bearing number 1537943 in Class 21 by filing a notice of opposition before the Trademark Registry, New Delhi but the impugned trademark application POLO (Word Mark) bearing number 1537943 in Class 21 was abandoned vide Order dated 07.03.2016 due to non-pursuance of the opposition proceedings by the Defendant.

8. It has been further stated that in the third week of October, 2020, Plaintiff came across the impugned trademark applications bearing Application Number 3836918 [POLO LIFETIME (Label)] and 3836919 [POLO LIFETIME (Word Mark) in Class 21 in the name of the Defendant, therefore, the Plaintiff accordingly instituted opposition proceedings against the impugned trademark applications and the Plaintiff again through its investigative resources made an enquiry in the markets of New Delhi and learnt that the Defendant through its physical premises and is also offering for sale and soliciting the impugned goods manufactured by it through its website <http://homeneedsindia.net/>, online marketplaces and social media applications, including but not limited to, Facebook, Amazon, Flipkart, and Paytm mall, which are inter-

active in nature and can be accessed by general consumers in New Delhi.

9. It has been further stated that In the last week of October, 2020, the Plaintiff for the first time learnt about the registration of the impugned trademark POLO LIFETIME (LABEL) under No. 2105994 in Class 21 in the name of the Defendant and thereafter recently in the first week of November 2020, the Plaintiff took appropriate steps by filing a cancellation petition before the Intellectual Property Appellate Board (IPAB) for cancellation of the trademark POLO LIFETIME (LABEL) under No. 2105994 in Class 21 in the name of the Defendant and the said cancellation proceedings before the Intellectual Property Appellate Board (IPAB) is pending and.

10. It has been further stated that earlier, the predecessor firm of Mr. Vikas Jain, namely, Ms Sun Star addressed at 6A/ 69-70, W.E.A, Near Channa Market, Karol Bagh, New Delhi had vide assignment deed dated 23.09.2014 assigned the trademark POLO LIFETIME under Application No. 2105994 in Class 21 in favor of the Defendant's firm, namely, M/s Home Needs, which is a partnership firm of Mr. Vikas Jain & Mr. Shashank Gupta.

11. It has been further stated that defendant has adopted and started using the impugned trade mark dishonestly, fraudulently and out of positive greed with a view to take advantage and to trade upon the establish good will, reputation and proprietary rights of the Plaintiff in the said trade mark. Thus, applicant/plaintiff has prayed for decree of permanent injunction restraining the defendant to export, manufacture, marketing,

using, selling/ soliciting, advertising etc., the trade mark /label etc.,

12. My learned predecessor vide order dated 26.11.2020 has granted ex-parte interim stay in favour of plaintiff and also appointed Ms. Shreya Saxena, Adv. as Local Commissioner to visit the premises of the defendant i.e. M/s Home Needs, 111, First & Second Floor, Tip-Top Shopping Centre No. 12/14, Saraswati Marg, Karol Bagh, New Delhi-110005 and he

13. Summons of the suit and notice of the application under Order XXXIX Rule 1 & 2 CPC was issued to the defendant and defendant filed the WS and reply of the said application.

14. Defendant in his WS and reply of the said application has taken the defence that plaintiff claims registration over the trademark POLO in class-25 but the trademark POLO is not a registered trademark of the plaintiff in class -21 or in respect of the goods covered under the registration held by the defendant.

15. It has been further stated that the trademark POLO is not a registered trademark word-per se in India and the label form as is claimed by the plaintiff is entirely different from the trademark POLOLIFETIME/ 'POLO LIFETIME' being used by the defendant. Further, it is stated that no action for passing off is maintainable in law as the plaintiff has not used the trademark POLO in India much less in class-21 for which defendant held a registration under the trademark POLOLIFETIME.

16. Further, objection taken by the defendant is that the plaintiff is guilty of delay, laches and acquiescence and the suit thus is liable to be dismissed because cause of action for filing the suit arose in the first week of February 2009 but the suit was filed by

plaintiff in year 2020. It has been further stated that the plaintiff was fully aware regarding the long, continuous and extensive use of the trademark POLO/'POLOLIFETIME' by defendant and the plaintiff kept sleeping in respect of the said goods falling in class-21 and thus guilty of delay, laches and acquiescence.

17. Further, objection taken by the defendant is that no suit for infringement is maintainable under Section 30(e) of the Trademarks Act as the filing of the suit for injunction is specifically prohibited on behalf of one registered proprietor against another registered proprietor. It has been further stated that trademark POLOLIFETIME is a registered trademark in the name of defendant under no. 21055994 in class-21 in respect of 'household or kitchen utensils and containers(not of precious metal or coated therewith);combs and pongs; brushes (except paints brushes); brush making materials; for cleaning purposes; steel-wool ; or semi-worked glass (except glass used in building); glass-ware, porcelain and earthenware not included in other classes dated 25.02.2011. It has been further stated that under Section 29(4) of the Trademarks Act, a registered trademark is not infringed by a person who is a registered proprietor and is using the identical with or similar trademark to the registered trademark.

18. Further objection taken by the defendant is that in India number of manufacturers and traders are using the trademark POLO alone and / or in conjunction with other prefix and suffix since long time and therefore, the plaintiff cannot claim that it is using the trademark POLO to the exclusion of others and defendant has also filed the list of such manufactures / traders having obtained registration in respect of various goods and services

falling in different classes including in class-25, obtained from website of the Trademark Registry. Thus, defendant has prayed that prima facie case is not made out in favour of plaintiff, therefore, plaintiff is not entitled relief of injunction.

19. Arguments were heard from Sh. Rishi Bansal & Sh. Rishabh Gupta, Ld. Counsels for plaintiff and Sh. R.K. Jain & Sh. Diwan-shu Jain, Ld. Counsels for defendant.

Submission of the Plaintiff Counsel

20. It is argued by the Ld. Counsel for plaintiff that plaintiff is the owner of the registered trademark POLO since 1988 in India and the main feature of the trademark is POLO. He further argued that defendant with malafide intention adopted the trademark POLO Life Time. He further argued that prominent of the said trademark is POLO and thus, the trademark of the defendant is deceptively similar to the registered trademark of plaintiff and thus defendant is infringing the trademark of the plaintiff and violating the copyright. He further argued that in the first week of February, 2009 defendant's predecessor firm M/s Sun Star had applied the registration of its impugned trademark POLO (word marks) vide application no. 1537943 in class and plaintiff filed the opposition proceedings against the said trademark application by filing a notice of opposition before the Trademark Registry, New Delhi, therefore, predecessor of the defendant abandoned the said application and same was dismissed on 07.03.2016 due to non-pursuance of the defendant's predecessor.

21. Ld. Counsel for plaintiff further argued that in the last week of October, 2020 plaintiff for the first time learnt about the registration of the impugned trademark POLO Lifetime (Label)

under No. 2105994 in class -21 in the name of the defendant and thereafter, in the first week of November, 2020 plaintiff took appropriate steps by filing a cancellation petition before the IPAB and the said cancellation proceedings is still pending, therefore, defendant has obtained the said trademark POLO Lifetime (Label) by misleading and it would be cause confusion in the mind of the public and if the defendant is continuously allowed to use the said trademark goes as the public would presume that they are purchasing the goods from the plaintiff which is reputed trademark.

22. Ld. Counsel further argued that the plaintiff's trademark was declared well known by the Hon'ble High Court in the cases i.e. (1) The Polo Lauren Company L.P. Vs. Rohit S. Bajaj in CS (OS) No. 1763/2005 & (2) The Polo/Laurean Company L.P Vs. Europa Bevcorp & Ors. Dated 19.10.2022 in CS (Comm) No. 730 of 2022. Ld. Counsel further submitted that when a trademark declared well known no person can use the said trademark not only in class in which the said trademark is registered but also in every classes. He further argued that suit can be filed against the registered proprietor, hence, plaintiff cannot be denied infringement because defendant has been able to get registered the Polo Lifetime by concealing the facts from the Trade Mark Registry.

23. In support of his contentions, he has relied upon the following judgments :-

i. Clinique Laboratories Lic & Anr. Vs. Gufic Limited & Anr., 2009 SCC OnLine Del 751 : (2009) 41 PTC 41

ii. Abbott Healthcare Pvt. Ltd. Vs. Raj Kumar Prasad & Ors., ILR (2014) III DELHI 1734

iii. Dhani Aggarwal Vs. Mahesh Yadav & Ors., 2022 : DHC : 3188

iv. S. Syed Mohideen Vs. P. Sulochana Bai, MANU/SC/0576/2015

Submission of the Defendant Counsel

24. On the other hand, Ld. Counsel for defendant has argued that plaintiff is alleging that it is using the POLO since 1967 but no document has been placed on record that same is being used in India from the said date. He further argued that the document filed by the plaintiff it has entered into an agreement with Aditya Birla Fashion and Aditya Birla Fashion has become license clearly shows that the plaintiff has started using the trademark only. It is further argued by Ld. Counsel for defendant that plaintiff has not produced any documents of sales in India to prove that plaintiff was selling its goods in India under the trademark POLO. Ld. Counsel for defendant further argued that more than hundred persons in India are using the trademark POLO as evident from the website of Ministry of Corporate Affairs. He further argued that plaintiff has claimed that plaintiff is the originator of trademark POLO but the trademark POLO is also used POLO Association. He further argued that initially defendant is registered trademark, therefore no case for infringement can be filed against the defendant and only case for passing off it be made out but since plaintiff has failed to prove it is selling any goods in India, therefore, no case for passing off even is made out.

25. He further argued that plaintiff's trademark was declared well known by Hon'ble Delhi High Court in case "The Polo Lau-

ren Company L.P. Vs. Rohit S. Bajaj in CS (OS) No. 1763/2005” was declared after the date when petitioner started using the said trade mark therefore judgement is not applicable to the present case.

26. He further argued that defendant is dealing in the goods in different class i.e. kitchen items whereas plaintiff’s trademark is in the business of fashion, therefore, no question of any passing off the goods by defendant is prima facie made out, therefore, in these circumstances, plaintiff is not entitled any relief of injunction, therefore, application be dismissed.

27. Ld. Counsel for defendant further argued that there are more than hundred companies which was registered with trade mark POLO and plaintiff has not taken any action qua them.

28. In support of above contentions, Ld. Counsel for defendant has relied upon the following judgments :-

i. Relaxo Rubber Limited and Another Vs. Aman Cable Industries and Another, 1998 PTC (18)

ii. Yonex Kabushiki Kaisha Vs. Phillips International and Anthers, 2007 (35) PTC 345 (Del.)

iii. Toyota Jidosha Kabushiki Kaisha Vs. Prius Auto Industries Ltd. & Ors., 2018 (73) PTC 1[SC]

iv. Vikas Makhija Vs. The Bengal Phenyle & Allied Products (P) Ltd., 2001 (21) PTC 612 (Del).

29. I have heard the arguments and gone through the records and judgements relied upon by the parties. The golden principle while granting interim stay is that there must be prima facie case in favour of plaintiff, balance of convenience should be in favour of plaintiff and irreparable loss which cannot be compensated in terms of money as held by Hon’ble High Court while deciding

the appeal filed by appellant against the interim order passed by my Ld. Predecessor in this case itself.

30. The ambit and scope of the connotation “prima facie” case has been explained by the Hon’ble Supreme Court in the case *Martin Burn Ltd. v. R.N Banerjee* [AIR 1958 SC 79.] interalia as under:

“A prima facie case does not mean a case proved to the hilt but a case which can be said to be established if the evidence which is led in support of the same were believed. While determining whether a prima facie case had been made out the relevant consideration is whether on the evidence led it was possible to arrive at the conclusion in question and not whether that was the only conclusion which could be arrived at on that evidence. It may be that the tribunal considering this question may itself have arrived at different conclusion. It has, however, not to substitute its own judgement for the judgement in question. It has only got to consider whether the view taken is a possible view on the evidence on the record.”

31. Thus, the first requirement is to see whether the plaintiffs have been able to establish a prima facie case in their favour warranting passing of an order by way of interim measure, or not. Certainly, the plaintiffs are not required to make out a clear legal title but has only to show that there is a substantial question to be investigated and that matters should be preserved in status quo until the question can be finally disposed of.

32. The plaintiffs are next required to show that irreparable injury will accrue to them if the injunction is not granted, and that there is no other remedy open to them by which they could protect themselves from the consequences of the apprehended

injury. In the leading case of *American Cyanamid Co. v. Ethicon Ltd.* [1975 AC 396.] , the House of Lords pronounced the principle as under:

“the governing principle is that the court should first consider whether, if the plaintiff were to succeed at the trial in establishing his right to a permanent injunction, he would be adequately compensated by an award of damages for the loss he would have sustained as a result of the defendant continuing to do what was sought to be enjoined between the time of the application and the time of the trial. If damages in the measure recoverable at common law would be adequate remedy and the defendant would be in financial position to pay them, no interlocutory injunction should normally be granted, however strong the plaintiff's claim appeared to be at that stage. If on the other hand, damages would not provide an adequate remedy for the plaintiff in the event of his succeeding at the trial, the court should then consider whether, on the contrary hypothesis that the defendant were to succeed at the trial in establishing his right to do that which was sought to be enjoined, he would be adequately compensated under the plaintiff's undertaking as to damages for the loss he would have sustained by being prevented from doing so between the time of the application and the time of the trial. If damages in the measure recoverable under such an undertaking would be an adequate remedy and the plaintiff would be in a financial position to pay them, there would be no reason upon this ground to refuse an interlocutory injunction.”

33. Lastly, the balance of convenience must also be in favour of granting the injunction.

In Dalpat Kumar v. Prahlad Singh [(1992) 1 SCC 719] , the Hon'ble Supreme Court stated that the court while granting or refusing to grant injunction should exercise sound judicial discretion to find the amount of substantial mischief or injury which is likely to be caused to the parties, if the injunction is refused, and compare it with that which is likely to be caused to the other side if the injunction is granted. If on weighing competing possibilities or probabilities of likelihood of injury and if the court considers that, pending the suit, the subject-

matter should be maintained in status quo, an injunction would be issued. Thus, the court has to exercise its sound judicial discretion in granting or refusing the relief of ad interim injunction pending the suit."

34. In Clinique Laboratories Lic & Anr. Vs. Gufic Limited & Anr.(supra) relied by Ld. Counsel for plaintiff The Hon,ble High Court has held that suit for infringement is made out against a party having registered trade mark if registration of trade mark is not valid. The Relevant para of judgement is reproduce as below:

" 8. In my view, Section 29 of the Act providing for infringement of the registered trademark does not contemplate infringement by another registered proprietor. Sections 29(1), (2) & (4) expressly provide that "registered trademark is infringed by a person who, not being a registered proprietor " Though, Section 29(5) which has been newly introduced in the 1999 Act does not use the same language but in my view the same would be irrelevant for the present purposes. Section 30 (2) (e) further fortifies the said position by expressly providing that the registered trademark is not infringed where the use being as one of two or more trademarks registered under the Act which are identical or nearly resemble each other and in exercise of the right to use of that trademark given by registration thereof. However, Sections 28(3), 29 & 30(2) (e) cannot be read in isolation. If the intent was that there could be no action for infringement against the registered proprietor, the legislature while giving the right for rectification before the Registrar would not have in Section 31 made the registration as only prima-facie evidence of validity thereof. If that had been the intention all that would have been said is that as long as the registration exists it is valid, without any question of prima-facie or not. Then the courts would have had to wait for the outcome of the rectification proceedings.

9. Registration has been made only prima-facie evidence of the registration otherwise being in accordance with the Act under Section 31(1) as contended by senior counsel for plaintiff but I find that even Section 28 (1) while being subject to other provisions of Act, further provides that "registration of the trademark, if valid, give to the registered proprietor" exclusive right to use the trademark. Thus the validity of registration can be gone into, wherever permissible under the Act. Section 124(1) (b) also indicates that it was within the contemplation of

the legislature that there could be a suit for infringement of trademark where the defendant takes a plea under Section 30 (2) (e) i.e. that use by him is not infringement because of his mark being also registered. The legislature while further providing for stay of suit in such cases, in sub Section (5) expressly provided that such stay would not preclude the court from making any interlocutory order. Section 31 r/w the scheme of 124 leads to an un-escapable conclusion that (A) there can be a suit for infringement against the registered proprietor (B) that upon the defendant taking the plea of his registration and of there being thus no infringement, such suit has to be stayed awaiting the rectification proceedings and (C) the court is empowered in such case to pass any interlocutory order. The court while passing interlocutory order will necessarily have to prima facie adjudicate the validity of the two competing registrations. Upon inquiry, it was informed that the Registrar while trying the rectification application has no power to grant interim relief. The legislature under Section 124 (5) has thus empowered the court under Section 124 (5) to grant injunction against use of a registered trademark also if the court is satisfied of the invalidity thereof. Though in view of Section 31, the test would be much stricter;

10. In my opinion, unless the provisions are so read, effect cannot be given thereto.

11. Once having reached a conclusion that registration is only prima facie evidence of validity, it is axiomatic that if the court is satisfied otherwise on the basis of material on record and in the facts of the case, the court is empowered to injunct use of registered trademark also. I do not find any reason to limit/restrict the applicability of sub Section (5) as suggested by the senior counsel for the defendant, in the absence of the legislature providing so. If the legislature had felt that there could be no infringement by a registered trademark, there was no need to provide for such a suit as in Section 124 (1) (b) and (i). In fact, sub-clause (i) of 124 (1) shows that the suit can be instituted even where the rectification proceedings are pending i.e. where the plaintiff is even at the time of institution of the suit aware of the defendant having a registered trademark.

12. I also find merit in the contention of the senior counsel for the plaintiff with reference to Section 31 (2) of the Act. Section 31 (2) suggests that the court notwithstanding registration being prima- facie evidence of validity as provided in Section 31(1) can hold the registered trademark to be invalid. The court can hold the registration to be invalid, on any ground or for non compliance of any of the conditions for registration provided under the Act. It further provides that if the invalidity of

registration is averred for the reason of non compliance of Section 9 (1), i.e. of evidence of distinctiveness having not been submitted before the Registrar, then the party pleading validity of registration shall be entitled to give evidence in legal proceedings where validity is challenged, of the mark having acquired distinctiveness on date of registration. Section 32 permits evidence of acquisition of distinctive character within the meaning of Section 9(1) post registration, also being led in such proceedings. It follows that where validity of registration is challenged on grounds other than provided in Section 9(1) of the Act, the test is whether the criteria laid down in such other provisions of the Act, for registration has been satisfied or not. Since, Section 124 otherwise provides for stay of proceedings in such suit and only permits passing an interlocutory order, such finding of invalidity naturally has to be on the touchstone of principles for interlocutory order only and not as at the time of final decision of the suit, in as much as the finding in the rectification proceedings has been otherwise made binding in the suit and on all aspects of validity i.e. under Section 9 as well as under Section 11.

13. Neither counsel has cited any direct judgment on this aspect. Nor have I been able to find any.

14. I thus conclude that a suit for infringement of registered trademark is maintainable against another registered proprietor of identical or similar trademark and in such suit, while staying the further proceedings pending decision of the registrar on rectification, an interim order including of injunction restraining the use of the registered trademark by the defendant can be made by the court, if the court is prima facie convinced of invalidity of registration of the defendant's mark.

35. In the matter of Peretti Van Melle Benelux BV Vs. Ramkrishna Food Products & Ors., CS (OS) No. 2099/2003 dated 6.3.2012 our High Court took contrary view that suit for infringement is not maintainable against a registered trade mark and held that only passing off action is made out. The relevant para of said Judgment is reproduced as below:

“32. The question as to whether a suit against a registered proprietor is maintainable on the basis of Common Law remedy of passing off, is no longer res integra. A Division Bench of this Court in the case of [N.R. Dongre And Ors. vs Whirlpool Corporation and Anr.](#), reported as AIR 1995 Delhi

300 answered the same in affirmative, wherein it was held as under:

"According to [section 28\(1\)](#) of the Act, registration of a trade mark gives to the registered proprietor thereof exclusive right to use the same in relation to the goods in respect of which it has been registered. But from the opening words of [section 28\(1\)](#) namely, "subject to other provisions" it is clear that the right conferred on a trader is not an indefeasible right as the same is expressly made subject to other provisions of the Act. This is further, made clear by [section 27\(2\)](#) of the Act, which provides that "nothing in this Act shall be deemed to affect the right of action against any person for passing off the goods as goods of another person or the remedies in respect thereof." Thus it is manifest that [Section 28](#) of the Act and all other provisions come within the "over riding sway of [section 27\(2\)](#) of the Act. Similarly [section 33](#) of the Act also saves vested rights of a prior user. It lays down that nothing in the Act shall entitle a registered proprietor of a trade mark to interfere with the use of the trade mark by a prior user of the same. Thus the right created by [section 28\(1\)](#) of the Act in favour of a registered proprietor of a trade mark is not an absolute right and is subservient to other provisions of the Act namely [sections 27\(2\), 33](#) etc. Neither [section 28](#) nor any other provision of the Act bars an action for passing off by an anterior user of a trade mark against a registered user of the same.- In other words registration of a trade mark does not provide a defence to the proceedings for passing off as under [section 27\(2\)](#) of the Act a prior user of a trade mark can maintain an action for passing off against any subsequent user of an identical trade mark including a registered user thereof. Again this right is not affected by [section 31](#) of the Act, under which the only presumption that follows from registration of a mark is its prima facie evidentiary value about its validity and nothing more. This presumption is not an unrepeatably one & can be displaced. Besides [section 31](#) is not immune to the over-riding effect of [section 27\(2\)](#). Placing reliance on [section 28\(3\)](#) of the Act the learned counsel for the appellant contended that when two registered proprietors of identical or near similar trade marks cannot be deemed to have acquired exclusive right to the use of any of those trade

marks against each other, how can an unregistered user of the trade mark maintain an action for passing off against a registered user of the same mark and seek an injunction restraining him from using it. This argument of the learned counsel seems to stem from a misconception about the real purpose and intent of [section 28\(3\)](#). Actually [section 28\(3\)](#) protects registered proprietor of a trade mark from an infringement action by another registered proprietor of an identical or near similar trade mark. In this regard it will also be necessary to extract [Section 28\(3\)](#) and [section 30\(1\)\(d\)](#) which carries out the intent of [section 28\(3\)](#). These sections read as under:-

"28(3) Where two or more persons are registered proprietors of trade marks, which are identical with or nearly resemble each other, the exclusive right to the use of any of those trade marks shall not (except so far as their respective rights are subject to any conditions or limitations entered on the register) be deemed to have been acquired by any one of those persons as against any other of those persons merely by registration of the trade marks but each of those persons has otherwise the same rights as against other persons (not being registered users using by way of permitted use) as he would have if he were the sole registered proprietor.

30(1)(d) Notwithstanding anything contained in this 'Act, the following acts do not constitute an infringement or the 'right to the use of a registered trademark-

.....the use of a registered trade mark, being, one of two or more trade marks registered under this Act which are identical or nearly resemble each other, in exercise of the right to the use of that trade mark given by registration under this Act." ' (32) A reading of [section 28\(3\)](#) with [section 30\(1\)\(d\)](#) shows that the proprietor of a registered trade mark cannot file an infringement action against a proprietor of an identical or a similar trade mark. While [sections 28\(3\)](#) and [30\(1\)\(d\)](#) on the one hand deal with the rights of registered proprietors of identical trade marks and bar action of infringement against each other. [Section 27\(2\)](#) on the other hand deals with the passing off action. The rights of action under [section 27\(2\)](#) are not affected by [section 28\(3\)](#) and [section 30\(1\)\(d\)](#). Therefore, registration of a trade mark under the Act would be irrelevant in an action for passing off. Registration of a trade mark in fact does not

confer any new right on the proprietor thereof than what already existed at common law without registration of the mark. The right of goodwill & reputation in a trade mark was recognised at common law even before it was subject of statutory law. Prior to codification of trade mark law there was no provision in India for registration of a trade mark. The right in a trade mark was acquired only by use thereof. This right has not been affected by the Act and is preserved and recognised by [sections 27\(2\)](#) and [33](#)."

33. From a bare reading of the observations made by the Division Bench it becomes clear that [Section 27\(2\)](#) of the Trade Marks Act, 1999 read with [Section 29](#) gives the [Section 27\(2\)](#) an overriding effect over and above the other provisions of the act due to its opening words "nothing in this act....". Therefore, the passing off remedy is a broader remedy and can defeat even the rights of a registered trademark and consequently the suit against the registered proprietor is maintainable on the ground of prior use and trans-boarder reputation. This has also been affirmed by Hon^{ble} Supreme Court in the said judgment of the Whirlpool (Supra)".

36. In Peretti Van Melle Benelux BV Vs. Ramkrishna Food Products & Ors.(supra) the Hon,ble High Court with respect to passing off action has held that:

“ (14) Thus, the law is pretty well-settled that in order to succeed at this stage the appellant had to establish user of the aforesaid mark prior in point of time than the impugned user by the respondents. The registration of the said mark or similar mark prior in point of time to user by the appellant is irrelevant in an action passing off and the mere presence of the mark in the register maintained by the trade mark registry did not prove its user by the persons in whose names the mark was registered and was irrelevant for the purposes of deciding the application for interim injunction unless evidence had been led or was available of user of the registered trade marks”. As far as judgment relied upon by the learned counsel for plaintiff is con-

cerned, in my view, in none of the judgment it has been held that action of infringement of trademark is made out against the registered owner of the trademark. As far as contention of Ld. Counsel for plaintiff that action for passing off is concerned, there are most stringent criteria for granting then in case of infringement of trademark because in a case of passing off plaintiff not only has to prove that defendant was using its trademark or deceptively similar to its trademark but also has to prove that by using the same it was causing confusion in the mind of the public that they are purchasing the goods of the plaintiff to get relief of infringement. For this plaintiff need to prove that its trademark is so well known that public identify the same as of plaintiff and defendant by using the trademark dishonestly passing off its goods as the goods of the plaintiff.

37. *Recently in Himalaya wellness Company and others vs WIPRO Enterprises private LTD., CS COM no. 118/2023 has held that:*

13. The present suit has been filed by the plaintiffs for infringement as well as for passing off. Section 27(2) of the Trade Marks Act provides that de hors the provisions of the Act, an action of passing off would be maintainable. A reference in this regard may be made to the judgment of S. Syed Mohideen v. P. Sulochana Bai, 2016 (2) SCC 683, wherein the Supreme Court held that an action for passing off shall remain unaffected by any registration provided under the Trade Marks Act. Therefore, even if the marks of the plaintiffs and the defendant are both registered, an action for passing off would still be maintainable.

38. Further in this case in para 14 it is held that :

Passing off is an action founded in common law, which is based on the principle that no-one has the right to represent their goods or services as those of someone else. In Cadila Health Care Ltd v. Cadila Pharmaceuticals Ltd., 2001 (5) SCC 73, the essential elements for constituting passing off have been elucidated by the Supreme Court in the following terms:

“10. Under Section 28 of the Trade and Merchandise Marks Act on the registration of a trade mark in Part A or B of the register, a

registered proprietor gets an exclusive right to use the trade mark in relation to the goods in respect of which the trade mark is registered and to obtain relief in respect of infringement of the trade mark in the manner provided by the Act. In the case of an unregistered trade mark, Section 27(1) provides that no person shall be entitled to institute any proceeding to prevent, or to recover damages for, the infringement of an unregistered trade mark. Sub-section (2) of Section 27 provides that the Act shall not be deemed to affect rights of action against any person for passing off goods as the goods of another person or the remedies in respect thereof. In other words in the case of unregistered trade marks, a passing-off action is maintainable. The passing-off action depends upon the principle that nobody has a right to represent his goods as the goods of somebody. In other words a man is not to sell his goods or services under the pretence that they are those of another person.

39. From the aforesaid judgement it is evident that suit for injunction against registered trademark is maintainable for passing off. As far as passing off is concerned, the Hon,ble Supreme Court in Cadila Health Care Ltd v. Cadila Pharmaceuticals Ltd., 2001 (5) SCC 73, Hon’ble Supreme Court laid down the test for passing off:-

“35. Broadly stated, in an action for passing-off on the basis of unregistered trade mark generally for deciding the question of deceptive similarity the following factors are to be considered:

(a) The nature of the marks i.e. whether the marks are word marks or label marks or composite marks i.e. both words and label works.

(b) The degree of resemblance between the marks, phonetically similar and hence similar in idea.

(c) The nature of the goods in respect of which they are used as trade marks.

(d) The similarity in the nature, character and performance of the goods of the rival traders.

(e) The class of purchasers who are likely to buy the goods bearing the marks they require, on their education and intelligence and a degree of care they are likely to exercise in purchasing and/or using the goods.

(f) The mode of purchasing the goods or placing orders for the goods.

(g) Any other surrounding circumstances which may be relevant in the extent of dissimilarity between the competing marks.”

The principles relating to passing off have also been crystalised by the Supreme Court in *Satyam Infoway v. Siffynet Solution Pvt. Ltd.*, (2004) 6 SCC 145 in the following manner:

“13. The next question is, would the principles of trade mark law and in particular those relating to passing off apply? An action for passing off, as the phrase “passing off” itself suggests, is to restrain the defendant from passing off its goods or services to the public as that of the plaintiff’s. It is an action not only to preserve the reputation of the plaintiff but also to safeguard the public. The defendant must have sold its goods or offered its services in a manner which has deceived or would be likely to deceive the public into thinking that the defendant’s goods or services are the plaintiff’s. The action is normally available to the owner of a distinctive trade mark and the person who, if the word or name is an invented one, invents and uses it. If two trade rivals claim to have individually invented the same mark, then the trader who is able to establish prior user will succeed. The question is, as has been aptly put, who gets these first? It is not essential for the plaintiff to prove long user to establish reputation in a passing-off action. It would depend upon the volume of sales and extent of advertisement.

14. The second element that must be established by a plaintiff in a passing-off action is misrepresentation by the defendant to the public. The word misrepresentation does not mean that the plaintiff has to prove any mala fide intention on the part of the defendant. Of course, if the misrepresentation is intentional, it might lead to an inference that the reputation of the plaintiff is such that it is worth the defendant’s while to cash in on it. An innocent misrepresentation would be relevant only on the question of the ultimate relief which would be granted to the plaintiff [*Cadbury Schweppes v. Pub Squash*, 1981 RPC 429 : (1981) 1 All ER 213 : (1981) 1 WLR 193 (PC); *Erven Warnink v. Townend*, 1980 RPC 31 : (1979) 2 All ER 927 : 1979 AC 731 (HL)] . What has to be established is the likelihood of confusion in the minds of the public (the word “public” being understood to mean actual or potential customers or users) that the goods or services offered by the defendant are the goods or the services of the plaintiff. In assessing the likelihood of such confusion the courts must allow for the “imperfect recollection of a person of ordinary memory” [*Aristoc v. Rysta*, 1945 AC 68 : (1945) 1 All ER 34 (HL)] .

15. The third element of a passing-off action is loss or the likelihood of it.” (Emphasis Supplied). In *V-Guard* (supra), relied upon by the defendant, while holding that infringement under Section 29(2) is not made out as the competing goods are not similar, the Court, nevertheless, held that the defendants therein were passing off their goods as those of the plaintiff. The relevant extracts from the judgment are set out below:

“ 56. In the context of passing off, once again a crucial question arises as to why and with what intent the Defendant adopted the word PEBBLE as a

part of its mark and the answer in my prima facie view could only be to confuse an unwary purchaser and create an impression that the purchaser is buying the goods of the Plaintiff. Learned counsel for the Plaintiff rightly contended that in the absence of any plausible reason for the Defendant to adopt the word PEBBLE, the only inference that can be drawn is that the intent was to pass off its goods as those of the Plaintiff. Defendant, as claimed in the reply, has an enviable and formidable reputation and does not need to ride over the goodwill of the Plaintiff. If that be so, it intrigues the Court as to why the Defendant adopted the word PEBBLE in addition to its house mark CROMPTON. In this context, I may refer to a few lines from the passage in the case of *Thomas Bear and Sons (India) Ltd. v. Prayag Narain*, (1941) 58 RPC 25, wherein Lord Langdale observed:

“A man is not to sell his own goods under the pretence that they are the goods of another man; he cannot be permitted to practise such a deception nor to use the means which contribute to that end. He cannot, therefore, be allowed to use names, marks, letters or other indicia, by which he may induce purchasers to believe that the goods which he is selling are the manufacture of another person.””

A reference in this regard may also be made to the judgment of the Gujarat High Court in *Good Life Industries v. J R J Foods Pvt Ltd.*, MANU/GJ/3045/2022. In the aforesaid case, an injunction was denied on the basis that the defendant was the registered proprietor of the mark. However, injunction was granted on the basis of passing off. The relevant extracts with regard to the passing off in *Good Life Industries*

(supra) are set out below:

“17. The plaintiff has filed Suit for infringement as well as for passing off action. Even if the defence of the defendant that it being registered owner of the disputed trademark, and therefore, no infringement action would lie against it, is accepted, for the sake of argument, then in that case also, the similarity between the two marks, which is likely to cause confusion in the public at large, can be considered for protecting the right of the plaintiff, under the head of passing off action. Passing off action has its origin, as an action in tort to restrain the wrongful conduct of the defendant in passing off his goods as the goods of the plaintiff. This might be done by using the trade name, trademark or other get-up of the plaintiff so as to induce any potential purchaser the belief that his goods or business were those of the plaintiff's. The tort list in the mis-representation by the defendant. Mis-representation is aimed at the potential buyers of the goods or the services, who are invited to buy goods believing that the goods are of the plaintiff. This might be done through confusion or

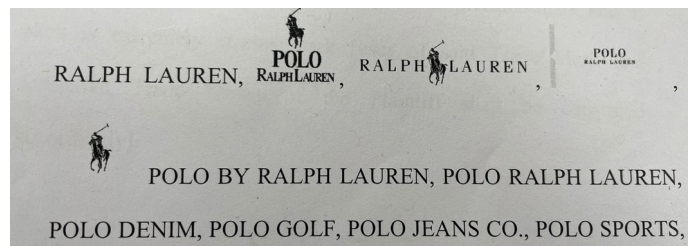
deceitful use of the trade name or mark with or other indication used by the plaintiff in respect of such goods or service. The passing off action is to create an actionable wrong based on the border principles of law that nobody has any right to represent his goods or business as the goods or business of somebody else. The principle is that "trading must not only be honest but must not even unintentionally be dis-honest". The purpose of passing off action is to protect commercial goodwill and to ensure that the purchaser are not exploited and dis-honest trading is prevented. For that, the plaintiff must establish that his business or goods have acquired the reputation. Whether the defendants goods are marked with the trademark of the plaintiff or made-up or described as calculated to mislead the ordinary purchaser, it is thus tendency to mislead or confuse which forms the gist of passing off action. There is no need to establish fraud or actual deception or actual damages in such cases. In passing off action it is necessary to prove that an ordinary person is likely to buy goods in a belief that the goods are that of plaintiff, though it is not necessary to show that actual sale took place.

18. It is well settled that while considering the likelihood of confusion in the mind of a purchaser, the wisdom of an ordinary person is to be taken into consideration. If an ordinary person exercising ordinary caution is likely to be confusion or is likely to be deceived into buying the product of the defendant, believing the same to be originating from the plaintiff, the injunction must follow. Intention to pass of is neither necessary nor is required to be shown. There is no necessity to prove actual damage to the plaintiff. Of course, the plaintiff has to establish that he has build-up good reputation and goodwill on the trademark. The plaintiff has also to establish deception similar so as to cause confusion in the minds of consumer and also likely suffering of substantial damages either to his business financially or to the reputation and goodwill of his trademark.”

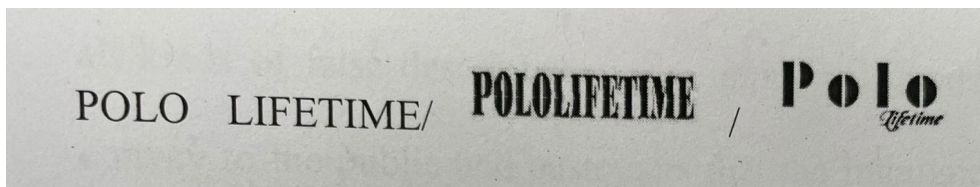
19. In *Mother Sparsh Baby Care v. Aayush Gupta and Others*, 2022 SCC OnLine Del 1061, relied upon by the plaintiffs, both the plaintiff and the defendant therein were registered proprietors of the mark ‘Plant Powered’, though the plaintiff was the prior adopter and user. While granting an interim injunction in favour of the plaintiff, the Court observed that both the plaintiff and the defendant were selling the same kind of products and since the

plaintiff was the prior adopter and user of the said mark, the defendant's user of the said mark was not bona fide.

40. Applying the principles of passing off as set out in the aforesaid precedents to the facts of the present case. The plaintiff's trademarks are as under :-



whereas defendant's trademark are as under :-



41. In most of the Plaintiff trade mark Besides Polo word Ralph lauren is also used besides POLO player on horse whereas in

defendant trade mark besides POLO Lifetime is also used hence except the word POLO there is no similarity between plaintiff's trademark and defendant's trademark. Hence except the word POLO there is no similarity between plaintiff's trademark and defendant's trademark.

42. From the documents file by the plaintiff it is prima facie evident plaintiff is in the business of manufacturing / selling fashion wears like i.e. cloth and other fashion accessories whereas the defendant is admittedly in the business of manufacturing / selling the kitchenware goods, therefore, they are dealing with in different goods and so there is very less scope of customers / purchasers of the goods of defendant is being confused that they are purchasing the goods of the plaintiff. I am not agree with the contention of Ld. Counsel for the plaintiff that plaintiff has such a goodwill and reputation in India that they will relate defendant goods being of plaintiff due to use of word POLO in defendant Trade Mark.

43. As far as contention of the Ld. Counsel for plaintiff that plaintiff is prior user of the trade mark being using trademark POLO for its goods since 1967 but from perusal of plaint itself it is evident that plaintiff nowhere stated from which year its selling its goods in India. Further, plaintiff has not given the detail of the sales made by it in India. Even he has not stated that there is no showroom or outlet or factory in India. The plaintiff has only mentioned that plaintiff Aditya Birla Fashions & Retail Ltd. has become licensee of the plaintiff in India and plaintiff has launched its first store at DLF Emporio, Vasant Kunj. The plaintiff has not even mentioned the the year when Aditya Birla Fash-

ions has become its licensee or launched its first store. However, from the documents filed by the plaintiff i.e. letter dated 30.01.2018 sent by Aditya Birla Fashions & Retail Ltd. has approved entering into a store license and distribution agreement with plaintiff Ralph Lauren Asia Pacific Limited on 30.01.2018 and date of launch of store was in the year 2018. Hence, plaintiff started selling its fashion goods in India as per the said agreement in the year 2018.

44. On the other from the documents by the defendant it is evident hand Further, undisputedly defendant's predecessor or even defendant started using trademark POLO much before 2018. The document i.e. invoice filed by defendant prove that it producing selling goods with trademark POLO since 2005. Defendant's predecessor applied for registration of trademark POLO in the year 2009 though later on he abandon, defendant got registered POLO Lifetime in the year 2011, therefore, in my view, plaintiff has prima facie even failed to prove that it is prior user in India.

45. As far as contention of Ld. Counsel for plaintiff that its trade mark has been declared well known by Hon,ble High Court and thus even in other class also same or deceptively similar trade mark would amount to infringement and plaintiff would be entitle to injunction and in support of the injunction relied upon. I have gone through the judgement relied upon by Ld. Counsel for plaintiff i.e. TATA Sons Ltd. Vs. Manoj Dodia & Ors.. In this case Hon,ble High Court. In this Hon'ble Court explained what is the well known trademark. Relevant paras 5 to 14 are reproduced as below :-

5. *A well known trademark is a mark which is widely known to the relevant general public and enjoys a comparatively high reputation amongst them. On account of advancement of technology, fast access to information, manifold increase in international business, international travel and advertising/publicity on internet, television, magazines and periodicals, which now are widely available throughout the world of goods and services during fairs/exhibitions, more and more persons are coming to know of the trademarks, which are well known in other countries and which on account of the quality of the products being sold under those names and extensive promotional and marketing efforts have come to enjoy trans-border reputation. It is, therefore, being increasingly felt that such trademark needs to be protected not only in the countries in which they are registered but also in the countries where they are otherwise widely known in the relevant circles so that the owners of well known trademarks are encouraged to expand their business activities under those marks to other jurisdictions as well.*

The relevant general public in the case of a well known trademark would mean consumers, manufacturing and business circles and persons involved in the sale of the goods or service carrying such a trademark.

6. *The doctrine of dilution, which has recently gained momentum, particularly in respect of well known trademarks emphasises that use of a well known mark even in respect of goods or services, which are not similar to those provided by the trademark owner, though it may not cause confusion amongst the consumer as to the source of goods or services, may cause damage to the reputation which the well known trademark enjoys by reducing or diluting the trademark's power to indicate the source of goods or services.*

7. *Another reason for growing acceptance of trans-border reputation is that a person using a well known trademark even in respect of goods or services which are not similar tries to take unfair advantage of the trans-border reputation which that brand enjoys in the market and thereby tries to exploit and capitalize on the attraction and reputation which it enjoys amongst the consumers. When a person uses another person's well known trademark, he tries to take advantage of the goodwill that well known trademark enjoys and such an act constitutes an unfair competition.*

8. *The concept of confusion in the mind of consumer is critical in actions for trademark infringement and passing off, as well as in determining the registrability of the trademark but, not all use of identical/similar mark result in consumer confusion and, therefore, the traditionally principles of likelihood of confusion has been found to be inadequate to protect famous and well known marks. The world is steadily moving towards stronger recognition and protection of well known marks. By doing away with the requirement of showing likelihood of confusion to the consumer, by implementing anti-dilution laws and recognizing trans-border or spill over reputation wherever the use of a mark likely to be detrimental to the distinctive character or reputation of an earlier well known mark. Dilution of a well known trademark occurs when a well known trademark loses its ability to be uniquely and distinctively identify and distinguish as one source and consequent change in perception which reduces the market value or selling power of the product bearing the well known mark. Dilution may also occur when the well known trademark is used in respect of goods or services of inferior quality. If a brand which is well known for the quality of the products sold or services rendered under that name or a mark similar to that mark is used in respect of the products which are not of the quality which the consumer expects in respect of the products sold and/or services provided using that mark, that may evoke uncharitable thoughts in the mind of the consumer about the trademark owner's product and he can no more be confident that the product being sold or the service being rendered under that well known brand will prove to be of expected standard or quality.*

9. *[Article 6bis](#) of Paris Convention, 1967 enjoined upon the Countries of the Union, subject to their legislation so permitting or at the request of the interested parties, to refuse or to cancel the registration and to prohibit the use of trademark which constitutes a representation and imitation or translation liable to create confusion of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of Convention and used for identical or similar goods. This provision was also to apply when the essential part of the mark constituted a reproduction of any such well known mark or an imitation liable to create confusion therewith. The prohibition against use of a well known trademark, under Paris Convention, was, thus, to apply only when the impugned use was in*

respect of identical or similar goods. Vide [Article 16](#) of TRIPS Agreement 1994, it was decided that [Article 6bis](#) of Paris Convention, 1967 shall apply mutatis mutandis to services as well as to goods or services, which are not similar to those in respect of which a trademark is registered, provided that the use of that trademark in relation to those goods or services would indicate a connection between those goods or services and the owner of the registered trademark and the interests of the owner of the registered trademark and are likely to be damaged by the impugned use. It was further decided that in determining whether the trademark is well known, the members shall take account of the knowledge of the trademark in relevant sectors of the public, including knowledge in the member concerned which has been obtained as a result of the promotion of the trademark. Thus, the TRIPS Agreement, 1994 brought about a material change by prohibiting use which constitutes a representation or imitation and is likely to create confusion even if such use is in relation to altogether different goods or services, so long as the mark alleged to have been infringed by such use is a well known mark. This Article, thus, grants protection against dilution of a trademark, which may be detrimental to the reputation that the business carried under a well known trademark enjoys.

10. Well known marks and trans-border reputation of brands was recognized by Courts in India, even before [Trade Marks Act, 1999](#) came into force. In *Daimler Benz. Aktiengesellschaft v. Hybo Hindustan*, AIR 1994 Del 239, the manufacturers of Mercedes Benz sought an injunction against the defendants who were using the famous „three pointed star in the circle“ and the word „Benz“. The Court granted injunction against the defendants who were using these marks for selling apparel. Similarly, in [Whirlpool Co. & Another v. N.R. Dongre](#), (1996) PTC 415 (Del.), the plaintiff Whirlpool had not subsequently registered their trademark after the registration of the same in 1977. At the relevant time, the plaintiff had a worldwide reputation and used to sell their machines in the US embassy in India and also advertised in a number of international magazines having circulation in India. However, the defendant started using the mark on its washing machines. After an action was brought against them, the Court held that the plaintiff had an established „transborder reputation“ in India and hence the defendants were enjoined from using the same for their products. In the *Kamal trading Co. vs. Gillette UK Limited*, (1998 IPLR 135), injunction was sought against the defendants who were using the mark 7'O Clock on their

toothbrushes. This was further reaffirmed by the Bombay High Court, which held that the plaintiff had acquired an extensive reputation in all over the world including India by using the mark 7'O Clock on razors, shaving creams. The use of an identical mark by the defendant would lead to the customer being deceived.

11. [The Trade Marks Act, 1999](#) accords a statutory protection to well known marks, irrespective of whether they are Indian marks or foreign marks. [Section 29\(4\)](#) of Trade Marks Act, 1999, which is relevant in this regard, reads as under:-

29(4) A registered trade mark is infringed by a person who, not being a registered proprietor or a person. using by way of permitted use, uses in the course of trade, a mark which-

- (a) is identical with or similar to the registered trade mark; and
- (b) is used in relation to goods or services which are not similar to those for which the trade mark is registered; and
- (c) the registered trade mark has a reputation in India and the use of the mark without due cause takes unfair advantage of or is detrimental to, the distinctive character or repute of the registered trade mark.

[Section 11\(6\)](#) which deals with determination of trademark as a well known marks, reads as under:- 11(6) The Registrar shall, while determining whether a trade mark is a well-known trade mark, take into account any fact which he considers relevant for determining a trade mark as a well-known trade mark including -

- (i) the knowledge or recognition of that trade mark in the relevant section of the public including knowledge in India obtained as a result of promotion of the trade mark;
- (ii) the duration, extent and geographical area of any use of that trade mark;

- (iii) the duration, extent and geographical area of any promotion of the trade mark, including advertising or publicity and presentation, at fairs or exhibition of the goods or services to which the trade mark applies;*
- (iv) the duration and geographical area of any registration of or any publication for registration of that trade mark under this Act to the extent they reflect the use or recognition of the trade mark;*
- (v) the record of successful enforcement of the rights in that trade mark, in particular, the extent to which the trade mark has been recognised as a well-known trade mark by any court or Registrar under that record.*

Sub-Section (7) of Section 11 of the Trademarks Act, 1999 specifies the factors which the Registrar has to take into account while determining whether a trademark is known to the relevant section of the public or not and reads as under:-

"(7) The Registrar shall, while determining as to whether a trade mark is known or recognised in a relevant section of the public for the purposes of sub-section (6), take into account-

- (i) The number of actual or potential consumers of the goods or services;*
- (ii) The number of persons involved in the channels of distribution of the goods or services;*
- (iii) The business circles dealing with the goods or services To which that trade mark applies."*

Sub-section 9 of Section 11 circumscribes the power of Registrar while determining whether the trademark is a well known trademark and reads as under:-

11(9) The Registrar shall not require as a condition, for determining whether a trade mark is a well-known trade mark, any of the following, namely: -

- (i) that the trade mark has been used in India;*
- (ii) that the trade mark has been registered;*
- (iii) that the application for registration of the trade mark has been filed in India;*
- (iv) that the trade mark -*
 - (a) is well known in; or*
 - (b) has been registered in; or*
 - (c) in respect of which an application for registration has been filed in, an jurisdiction other than India; or*
 - (v) that the trade mark is well-known to the public at large in India.*

12. *The owner of a well known trademark may (i) seek cancellation or (ii) prevent registration of a trademark which is same or similar to the well known mark irrespective of whether the impugned mark is in relation to identical or similar goods or services or in relation to other categories of goods or services. He may also prevent others from incorporating the well known trademark as a part of their corporate name/business name. Even if a well known trademark is not registered in India, its owner may avail these rights in respect of the trademark registered/used or sought to be registered/used in India, provided that the well known mark is otherwise known to or recognized by the relevant section of public in India.*

The existence of actual confusion or a risk of confusion is, however, necessary for the protection of a well known trademark, as a result of infringement.

13. *Trademarks Act, 1999 does not specify the factors which the Court needs to consider while determining whether a mark is a well known mark or not, though it does contain factors which the Registrar has to consider whether a trademark is a well known mark or not. In determining whether a trademark is a well known mark or not, the Court needs to consider a number of factors including (i) the extent of knowledge of the mark to, and its recognition by the relevant public; (ii) the duration of the use of the mark; (iii) the extent of the products and services in relation to which the mark is being used; (iv) the method, frequency, extent and duration of advertising and promotion of the mark;*

(v) the geographical extent of the trading area in which the mark is used;
(vi) the state of registration of the mark;
(vii) the volume of business of the goods or services sold under that mark; (viii) the nature and extent of the use of same or similar mark by other parties; (ix) the extent to which the rights claimed in the mark have been successfully enforced, particularly before the Courts of law and trademark registry and (x) actual or potential number of persons consuming goods or availing services being sold under that brand. A trademark being well known in one country is not necessarily determinative of its being well known and famous in other countries, the controlling requirement being the reputation in the local jurisdiction.

14. It is difficult to dispute that as far as India is concerned, TATA is almost a household name. The house of TATAs is one of the oldest business houses in our country and the group has substantial presence in a large number of sectors.

.....17. Considering that (a) the mark TATA whether word mark or device or in conjunction with other words is being used for last more than 100 years, in respect of a large number of goods and services, (b) Tata Group, which is probably the oldest and largest industrial and business conglomerate having turnover of Rs.96,000 crores in the year 2005-06, Tata Group comprises a number of large companies, millions of consumers are using one or more Tata products throughout India, but also in other countries, (c) there are more than hundred registrations of the trademark TATA either by way of word mark or device or use of the name TATA with other words, (d) the Courts having in a number of judgments/orders recognized TATA as a well known mark, (e) there is no evidence of any other person holding registration of or using the trademark TATA and (f) the reputation which companies of TATA group enjoys not only in India but also in many other countries, it is difficult to dispute that the trademark TATA is a famous and well known brand in India. I, therefore, have no hesitation in holding that the mark TATA whether word mark or device or when use in conjunction with some other words is a well known trademark within the meaning of Section 2(z)(b) of the Trademarks Act, 1999. The use of the trademark TATA in relation to any goods or services is, therefore, likely to be taken as a connection between house of TATAs and the goods or services, which are sold under this trademark or a trademark which is similar to it.....

20. Since the trademark TATA is a well known trademark, use of the aforesaid mark by the defendant on the products being sold by him also constitutes infringement within the meaning of Section 29(4) of the Trademarks

Act, 1999 since by using the trademark TATA, he obviously has tried to take an unfair advantage by encashing upon the brand quality and goodwill, which the mark TATA enjoys in the market. Since the defendant has not come forward to contest the suit, the presumption is that use of the mark A-ONE TATA by him is not bona fide, but is deliberate, intended to encash the popularity and reputation, which TATA brand enjoys. Such use by the defendant is likely to be detrimental to the reputation and distinctive character of the registered trademark TATA of the plaintiff company because if this mark is allowed to be used on the products, which do not originate from TATA group of companies, that may diminish the ability of the trademark TATA to identify the source of the goods in respect of which this trademark is used, besides lowering its reputation in case the quality of the goods is not of expected standard.

51. In my view said judgement is not applicable because first of all in this case plaintiff has failed to prove that it is using the trade mark POLO in India that it has become a household name like TATA. Secondly the defendant through its predecessor is using the trade mark POLO with suffix LIFETIME much prior to declaration of plaintiff trade mark as a well known trade mark by Hon,ble High Court. Thirdly plaintiff is not in business of multiple fields as TATA that confusion could be caused in the mind of public that the business of defendant is actually started by TATA group.

52. As far as judgment of Dhani Aggarwal Vs. Mahesh Yadav & Ors.(Supra) is concerned, in the said case an appeal was filed against the Order u/o XXXIX Rule 1 & 2 CPC for vacating the temporary injunction on respondents from using its mark 'RAMMA' and 'RAMMA MUNAKKA' in appeal. Ld. Counsel for appellant has urged that the two marks that is RAMU and

RAMMA are phonetically similar and appellant is prior user of the trademark and using since 1995 whereas it came to the knowledge of the appellant that the respondents have obtained registration of its mark on a 'proposed to be used' basis vide application no. 3772367 under Class 29 filed on 07.03.2018. respondent contended that appellant is not using the label for which she had obtained registration. Hon'ble High Court held that appellant has been able to show goodwill and reputation of her mark / label in which the word RAMU is clearly the most predominant part. Further, Hon'ble Court has relied upon various judgments that the words RAMU and RAMMA are the predominant part of the two label marks and the same closely resemble each other both structurally as also phonetically and the class of purchasers are those who would not pay much attention to the dissimilarities in the two labels but go by their imperfect recollection of the marks. Further it is held that the appellant being the prior adopter of the mark, certainly has a superior right over the respondents in the said mark and is entitled to protection of the same. Whereas in the instant case the mark of plaintiff and defendant appear quite distinctive as except the word mark POLO there is no similarity. The defendant mark as suffix LIFETIME which is predominant whereas plaintiff marks as suffix Ralph Lauren & picture of polo player. Further, the class which used the goods are quite different as plaintiff is in the business of fashion wears whereas defendant is dealing in the selling of kitchenware articles / goods, therefore, the alone said judgment does not apply to the facts and circumstances of the instant case.

53. On the other hand, I found the judgement relied upon by Ld. Counsel for the defendant much more applicable in the present case. Defendant has relied upon the judgment Relaxo Rubber Limited and Another Vs. Aman Cable Industries and Another, in this case plaintiff has failed the application u/o 39 Rule 1 & 2 CPC praying for temporary injunction against the defendant from infringing its trademark Relaxo. Case of the plaintiff is that the trademark RELAXO is being used by the plaintiffs in respect of different varieties of footwears whereas the defendants are using the same trademark in respect of wires cables and PVC pipes. Hon'ble High Court held that case of passing off is not made out since the nature of trading and the goods dealt with by the plaintiffs and the defendants are distinct and separate having no connection with each other at all and since the trade mark of the plaintiff is held to be not an invented word it cannot be said that a case of passing off has been made out by the plaintiffs on the user of the defendants of the same trade mark in relation to its goods of wires, cables and PVC pipes. Further, defendants have placed on record the documents indicating the defendants dealing with the mark RELAXO for last about 8 years, the bills and the receipts placed on record indicate that the aforesaid mark is being used atleast from 25.12.1993 and the suit was filed in the year 1997. Thus, there was also delay on the part of the plaintiffs in approaching the Court. Thus, refused to grant injunction. In the instant case also admittedly defendant has applied for trademark in the year 2011 and accordingly to the defendant was using the trademark since 2003 whereas as stated above, the plaintiff has failed to

show any documents that its selling the goods prior to defendant in India by producing any cogent evident.

54. Further in judgment Yonex Kabushiki Kaisha Vs. Phillips International and Anthers plaintiff has filed an application u/o 39 Rule 1 & 2 CPC for grant of interim injunction for its trademark YONEX as accordingly to him defendant was using its trademark YONEKA which is infringing the trademark of the plaintiff. Hon'ble High Court is held that defendant had adopted the trade mark YONEKA in the year 2001. Six years have passed since then and the defendant is having an established business with significant sales and it has created a market of its own and is having wide sales network and giving its sale figure, at this state it would not be proper to grant injunction thus dismissing the application for grant of said.

55. Further in case Toyota Jidosha Kabushiki Kaisha Vs. Prius Auto Industries Ltd. & Ors., the appellant who was automobile manufacturer has filed suit for permanent injunction and passing of damages to protect its trademark TOYOTA, TOYOTA INNOVA, TOYOTA DEVICE from defendant restraining him from using the said trademark. The defendant has taken the objection that they are using the the words TOYOTA, TOYOTA INNOVA, TOYOTA DEVICE on the packaging materials in which the auto parts manufactured by them are / were packed for the purpose of item identification and nothing more. According to defendants, they are / were entitled to indicate the cars for which the spare parts have been manufactured by displaying the same name on the packaging of the product. Further, as far as mark Prius is concerned, they had obtained registration of the

said mark in the year 2002 and continuously using the same since year 2011. Hon'ble High Court held that the trademark PRIUS used in the year 2001 and there was limited exposure and the car under the brand name 'Prius' was introduced in the Indian market in the year 2009-10. The News item relating to the launching of the product in Japan isolatedly and singularly in the Economic Times (issued dated 27.03.1997 and 15.12.1997) do not establish the acquisition and existence of goodwill and reputation of the brand name in the Indian market. Thus, refused to grant the said of Prius.

56. In view of the aforesaid facts and judgment I held that plaintiff has prima facie failed to establish that defendant is infringing the trade mark of plaintiff or passing off its goods as the goods of the plaintiff. Further, in my view, plaintiff has failed to show that the balance of convenience lies in its favour and that irreparable injury or loss will be caused to the plaintiff rather it would be caused to the defendant as it would amount to shut down of his business despite the fact that defendant is the registered owner of the trademark POLO Lifetime and till date the said registration is not cancelled, therefore, in my view, plaintiff is not entitled to relief of injunction. Hence, I dismiss the application under Order XXXIX Rule 1 & 2 CPC. The interim stay granted by my Ld. Predecessor vide order dt. 26.11.2020 stand vacated.

**Pronounced in open Court
on 14.07.2023**

**(Sanjeev Kumar Aggarwal)
District Judge (Commercial Court)-01,
Central, Tis Hazari Courts, Delhi**