



COMPENDIUM ON LANDMARK CASES:
TRADE MARK

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-PREFACE-

Since there has been rapid development of trade mark jurisprudence in India over the years, various case laws have been instrumental in shaping and evolving the IP jurisprudence.

In an attempt to highlight the evolving IP jurisprudence in the fast developing India which is becoming a centre of innovation and investment, this compendium analyses the developing trends emerging in the court rooms with regard to IP litigation.

The following compendium is a compilation of the landmark cases in the field of Trade Mark laws from courts all over the country pertaining to various ratios that have developed in the field of Trade Mark over the years on the various holdings and ratios pertaining to trade mark infringement and passing off.

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PRIORITY IN ADOPTION AND USE PREVAILS OVER PRIORITY IN REGISTRATION

India follows common law system where prior adoption and user of the mark is of utmost importance. Rights of prior adopter and user of a mark have been held to be superior to even that of a registered proprietor. This is evident from various sections to this effect under Indian Trade Marks Act 1999 wherein Section 31 of the Act clearly provides that registration of a trade mark will only be *prima facie* validity of registration and nothing more. Similarly Section 28(1) of the Act which deals with rights conferred by registration starts with 'subject to other provisions of this Act'. Section 34 of The Trade Marks Act expressly restricts the registered proprietor in interfering the prior user's rights. Section 27(2) of the Act further gives clear mandate that nothing mentioned in the entire Act would affect the rights of any person for instituting an action for Passing-off. Some of the landmark judgments in this regard are:

I. Century Traders v RoshanLalDuggar Co. (1977 SCC OnLine Del 50)

This was an appeal directed against the order of a learned Single Judge dismissing an application under Order 39, rules 1 and 2, read with Section 151 of the Code of Civil Procedure. In this case, the mark in question is the word "RAJARANI" and these two words are written or embossed or printed or stamped in a particular manner. The Appellants manufactured voiles that were processed by the respondent No. 3 from 1973 - 1975, and it was claimed that the appellant has directed Respondent 3 to put the trade mark in question on the voiles. From 1976 they were manufactured by another party, who were given the same direction. In 1976 the Appellant discovered that both the respondents were also using the same mark for their voiles. The Appellant filed a suit in the Delhi High Court. Learned Single Judge of the Hon'ble Delhi High Court, was of the view that neither

of the Respondents or the Appellant could claim proprietary interest in the mark in question on account of the prima facie evidence of earlier registrations of the mark "RAJA RANI". Against the said order, Appellant filed an appeal. Division Bench of Delhi High Court while construing sections 27(2) and 106 of the Act, held as follows:- "*FROM a reading of the above sections it is clear that registration of mark in the trade mark registry would be irrelevant in an action for passing off. The registration of the said mark or similar mark prior in point of time to user by the appellant is irrelevant in an action for passing off and the mere presence of the mark in the register maintained by the trade mark registry did not prove its user.*"

II. N.R. Dongre and Ors. v Whirlpool Corporation And Anr ((1996) 5 SCC 714.)

In this case Whirlpool Corporation brought a suit for passing off to restrain the defendants from manufacturing, selling, advertising or in any way using the WHIRLPOOL mark as part of another mark in respect of its goods. The subject matter of the appeal was the manufacture, sale and advertisement of washing machines under a mark which included WHIRLPOOL. Whirlpool based its claim on its prior use of the WHIRLPOOL mark and a trans-border reputation, which suggested that any goods marketed under the WHIRLPOOL mark had been marketed by the Plaintiff. The Court held that the term 'use' under The Trade Marks Act, 1999 has acquired a broad meaning and does not necessarily mean the physical presence of the goods in India. Presence of the trademark on the Internet and publication in international magazines and journals having circulation in India are also considered as use in India. The Court, therefore, held that a rights holder can maintain a passing off action against an infringer on the basis of the trans-border reputation of its trademarks and that the actual presence of the goods or the actual use of

the mark in India is not mandatory. It would suffice if the rights holder has attained reputation and goodwill in respect of the mark in India through advertisements or other means.

III. **M/s. L. D. Malhotra Industries v. M/s. Ropi Industries,(1975 SCC OnLine Del 172)**

In that case two industries were engaged in the manufacture of dress hooks which are generally used in garments. One was M/s. Ropi Industries and the other was M/s. L. D. Malhotra Industries, respectively referred to in the judgment as Ropis and Malhotras. The latter, i.e. Malhotras got their mark Kismat (word per se) registered with the Registrar of Trade Marks in **December, 1967**. In December, 1969 Ropis made an application for registration of their trade mark KISMAT which was opposed by Malhotras. Ropis had sought registration claiming that 'they were using the label mark Kismat **since 1963**. The Assistant Registrar held that Ropis were **prior users** of the trade mark KISMAT. In April, 1971 Ropis made an application for rectification of the register under Section 56(2) of the Act vis-a-vis the registration granted to Malhotras. That is how the matter came before AvadhBehari, J. He observed :-

*"NOW it will appear that Ropis were **first in the field**. Their user dates back to April 1, 1963. But they are later in registration. Malhotras were the first to get their trade mark registered. In other words Ropis were prior in use and later in Registration while Malhotras were anterior in registration but posterior in use. That is the question in this appeal against the order of rectification four points arise for decision. First is the question of use of the trade mark. **Use plays an all important part**. A trader acquires a right of property in a distinctive mark merely by using it upon or in connection with his goods irrespective of the length of such user and the extent of his trade. The trader who adopts such a mark is*

*entitled to protection directly the article having assumed a vendible character is launched upon the market. Registration under the statute does not confer any new right to the mark claimed or any greater right than what already existed at common law and at equity without registration. It does, however, facilitate a remedy which may be enforced and obtained throughout the State and it established the record of facts affecting the right to the mark. Registration itself does not create a trade mark. The **trade mark exists independently of the registration which merely affords further protection under the statute. Common law rights are left wholly unaffected.**"*

IV. Neon Laboratories Ltd v 2015 SCC OnLine SC 905.) (Civil Appeal No 1018 of 2006)

In this case, Medical Technologies filed a passing off action against Neon after Neon started using the mark ROFOL in 2004, which according to Medical technologies was similar to MedTech's mark PROFOL used since 1998. Neon argued that they were the prior adopters since they registered the mark in 1992. The Supreme Court agreed with the Ahmedabad City Civil Court and the Gujarat High Court's order, giving reference to the "First in the market" test. They held that a prior application for registration of a mark is of no assistance in the use of the said mark has started 12 years after the use of their rival's mark.

V. H&M Hennes&Mauritz AB &Anr. v. HM Megabrands Pvt. Ltd. &Ors. (2018 SCC OnLine Del 9369)

In this case the Delhi High Court issued a permanent injunction against the defendants HM Megabrands confirming that the prior adoption of a mark overseas can be superior to the prior use of the mark in India. The Plaintiff, H&M was first registered in the UK in 1985 and in 2005 in India. The defendants began marketing the garments under "HM Megabrands" in

India in 2011, and applied for registration in 2014. The defendants contented that they adopted the mark in 2011, when the Plaintiff had not entered the Indian Market. The court in this case held that because of increased “foreign travel and exchange of cultures” they presumption is made that they consumers are aware of the top brands worldwide.

VI. S.Syed Mohideen v. P. SulochanaBai (2016) 2 SCC 683

In this case, there was a renowned Hawla shop in Tirunelveli in Tamil Naidu called “IruttuKadhaiHalwa”, who were the Appellant in this case. The Respondent was the registered proprietor of a trade mark “IruttukadaiHalwa”. In this case the Delhi High Court held that a passing off action can even lie against a registered proprietor of the mark against which the action has arisen. They held that a trademark exists independently of the registration which merely affords a further protection under the statute, the common law rights being left completely unaffected. They further held that the registration is only a recognition of the right that have been pre-existing in common law in should a conflict arise between the two registered proprietors, the evaluation of the better rights in common law is essential as the same would determine whose rights between two registered Proprietor are superior. They even said that the latter user of the mark/name in the business cannot misrepresent his business as the business of a prior user.

**REGISTRATION WITH REGARD TO ONE CATEGORY OF GOODS NO BAR TO
REGISTRATION FOR OTHER GOODS IN SAME CLASS**

In case of a trademark proprietor who is using a trademark which may be similar to an earlier registered trademark belonging to a separate proprietor, but the rival goods happen to be dissimilar though falling under the same class, the subsequent proprietor may be able to obtain registration of his trademark, pleading dissimilarity of goods so far as the earlier registered trademark is not held to be a well-known trademark.

I. “Vishnudas Trading as Vishnudas Kishandas Vs Vazir Sultan Tobacco Co. Ltd Hyderabad and another” - (1997) 4 SCC 201

The respondent company obtained registration in respect of ‘manufactured tobacco’. Appellant also manufactured quiam and zarda under same trade mark ‘Charminar’. Appellant applied for registration of said trade mark. Objections raised by respondent company on ground that similar trade mark already been registered. It was held-Where trader or manufacturer actually trades in or manufactures only one or some of articles coming under broad classification and such trader or manufacturer had no *bona fide* intention to trade or manufacture other goods – such trader or manufacturer cannot precludes other traders or manufacturers to get registration of separate and distinct goods which may be grouped under the broad classification.

**II. Nandhini Deluxe v Karnataka Co- Operative Milk Producers Federation Ltd
(2018) 9 SCC 183.**

The trademark dispute in the case pertained to the use of mark 'NANDHINI'. The Respondents who were the Plaintiffs in the original suit, urged that they were registered proprietors of trademark "NANDINI" for milk and milk products in class 29 and 30 adopted by them in the year 1985. The appellant on the other hand, is in the business of running restaurants and it adopted the mark 'NANDHINI' for its restaurants in the year 1989 and applied for registration of the said mark in respect of various foodstuff items sold by it in its restaurants. The respondent had opposed the registration; however the Trademark Registry eventually allowed registration of Appellant's trademark. In appeal, the IPAB and the High Court set aside Appellant's trademark registration on the ground that the Respondent's mark 'NANDINI' had acquired distinctiveness and further held that since milk and milk products fall under Classes 29 and 30 and the goods registered in the name of the appellant also fall in the same class, the average consumer would conclude that goods manufactured by the appellant belonged to the respondent and, therefore, there is likelihood of confusion. Aggrieved by the aforesaid order of High Court, the Appellant approached the Supreme Court, whereby the Two-Judge Bench of the Court allowed the appeal. The Supreme Court in view of the aforesaid principles, in the instant case opined that not only visual appearance of the two marks is different, they even relate to different products. That the proprietor of a trade mark cannot enjoy monopoly over the entire class of goods and, particularly, when he is not using the said trade mark in respect of certain goods falling under the same class.

III. Marc Enterprises Pvt Ltd v Five Star Electricals (India) 2008 SCC OnLine Del 310.

The Plaintiff owned and used the trade mark "MARC" for electrical gadgets and accessories. And although they had obtained registration for a variety of electrical goods

they were only using them for limited items. The Defendant on the other hand was using the word “Marc” with difference in get up, style and layout for that of the Plaintiff’s mark, in respect of electrical switches, sockets, three-pin plugs and holders. The court held that the Plaintiff’s products were different from those of the defendant, and although the Plaintiff had obtained registration of the mark for a variety of electrical goods, it was using it only for limited items and not for the items manufactured by the defendant. The Court went on to say that if the trade mark of the two parties were infringed, they would be entitled to take action against the infringer, however, in this case there was no infringer, since for an act of passing off to arise, there needs to be a likelihood of confusion in the minds of the consumer regarding the source of the product. The court held that in the case that there is dissimilarity between the goods and services the possibility of confusion is reduced, and hence for prima facie case for injunction was made out.

**IV. Sona Spices Pvt. Ltd. v Soongachi Tea industries Pvt. Ltd.
2007(34)PTC91(Del).**

The Plaintiff and the Appellant has been using the trade mark “SONA” since 1975 and selling spices under the mark in Jammu and Kashmir, Punjab, Haryana, Himachal Pradesh, Rajasthan UP, Delhi and Chandigarh. In 1993, the expanded into tea, and the Plaintiff wanted to registered Trademark for tea in 1995. The Defendant had been selling tea since 1978, and they had obtained a registration for “SONA” for tea in 1993. The Court held that the Plaintiff had not utilized their trade mark with regard to tea prior to 1993, while the defendant had been using the same since 1978, and had obtained registration in 1993. Even the Plaintiff’s sales figures are quite insubstantial to that of the Defendant w.r.t. to tea. Since that Plaintiff had not exercise their rights with respect to tea in several years, they were complete dis-entitled to the grant of any interim relief.

REGISTRATION OF A COMPOSITE MARK NOT TO CONFER EXCLUSIVE RIGHTS TO INDIVIDUAL/NON-DISTINCTIVE PARTS OF THE MARK

A registered trademark gives the exclusive rights for the use of a trademark against others. The rights provided under the Act come with a condition that it should be protected in the form in which it is applied and registered. In case of a composite trademark, which has several distinctive and non-distinctive elements, the authority to take action against an infringer is limited to the extent that the distinctive part of the trademark is misused by the infringer. It is a settled law that the proprietor of a trade mark gets exclusive right to the use the trademark taken as a whole. The proprietor has to apply to register the whole and/or each element of such part as separate trademarks to be able to claim right over any part of the mark, and further, they do not have the authority to restrain others from either using any part or word independently or in combination with other words. But if the proprietor acquires any right by long use of those parts or words in relation to his trade, he may, claim his right by a passing off action and prevent exploitation of his mark.

I. Registrar of Trade Marks v. Ashok Chandra Rakhit Ltd 1955 AIR 558

In 1987, the Respondent adopted the trademark “Shree” (written in Bold Bengali on the top and small Hindi below that). After 1932, when the Respondent applied for Trade Mark registration, the Registrar proposed that there should be a disclaimer on the word “Shree”, to which the Respondent objected and said that only their ghee is associated with the said trade mark, so it was registered without a disclaimer. Later it was found that the word Shree had been used by Hindus as an auspicious symbol and there was nothing distinguishable about it, and a notice was issued to the Respondent to show why the register should not be rectified by entering a disclaimer, and when no good reason was

given, The Registrar directed a rectification by inserting a disclaimer. Respondent Appealed to the Calcutta High Court, which was also of the view that the Respondent could not claim exclusive rights over the word Shree, however, they also held that there was no grounds whatsoever for the order made by the registrar as the Respondent company have has claimed that they had any right to the exclusive use of the word "Shree". So, the Appellant further appealed to the Supreme Court. The Supreme Court said that the real purpose of requiring a disclaimer is to define the right of the proprietor under the registration so that there can be a minimization of the possibility of extravagant and unauthorized claims being made from the registration of the trademark. Therefore, while upholding the Registrar's decision, the Supreme Court said that where a distinctive label is registered as a whole, such registration cannot possibly give any exclusive statutory right to the proprietor of the trade mark to the use of any particular word or name contained therein apart from the mark as a whole. Therefore they held that the Delhi High erred when they did not take into account the strong possibility of the respondent company claiming a statutory right to the word "Shree" by virtue of the registration of its trademark and subject others to infringement actions only on the strength of the registration of its trade mark and subject others to infringement actions only on the strength of the registration and without proof of facts which it would have otherwise have to establish in order to succeed in a passing off action or a prosecution under the Indian Penal code.

II. Bhole Baba Milk Food Industries vParul Food Specialties 2010 (44) PTC 736 (Del).

The Appellants (Bhole Baba) manufacture milk and Milk products since 1992 under the label "KRISHNA" which also have a visual depiction of the God Krishna standing on a lotus

flower in class 29. The respondent also manufacture milk products, and started selling ghee under the brand “PARUL’S LORD KRISHNA”, however, the work “Parul” had a very small font, and only the word Krishna caught prominence. The Appellant attempted to retrain the use of the work Krishna, claiming that they had acquired a secondary meaning. The Delhi High Court ruled in favour of the Defendant (Respondent) and said that Lord Krishna is a popular God and Mythological character associated with white butter (ghee). On Appeal to a division bench, the Single Judge held that the name of the deity cannot be monopolized since it was in the public domain, and if done so it would definitely dilute a proprietary claim projected by any person, in relation to Krishna with dairy products. However, the directed the Defendants to print Parul’s Lord” in equal prominence to the word Krishna. The division bench also held that the registration obtained by the Appellant was not per se for the word Krishna but the word Krishna written in a distinctive form. They said that the distinctiveness to which the Appellant can be a claim is to what it has got registered as a whole, and therefore, such registration cannot possibly give an exclusive statutory right to the Appellant qua a particular word of common usage.

iii. Super Cassettes Industries Ltd. v Union of India &ors 2010 SCC OnLine Del 1652.

The Petitioner in this case, Super Cassettes Industries Limited challenged the order given by the IPAB in favour of TELCO (Tata Engineering and Locomotive Company), which directed the Appellant’s to remove the circle around the letter “T” and be granted registration in respect of the mark “T-Series” with the letter “T” within a circle and below that the word “SERIES” in a rectangle. The petitioner has been using their trade mark extensively since 1979 and is registered in a total of 17 classes. TELCO filed a notice of

opposition in June 1991, claiming the proprietorship of the letter T in classes 6, 7, 9 and 12. The petitioner replied with counter statement claiming that they have a distinctive mark that has acquired recognition w.r.t. to the petitioner's goods. The DR rejected the opposition filed by TELCO and directed that Super Cassettes' application in class 9 be accepted since there was no likelihood of confusion and the letter T could not be monopolized. On comparison of the two mark, the court held that the mark are structurally, stylistically and substantially different and a consumer was unlikely to be confused or deceived into mistaking T-Series with Tata Motors. Further, the marks were also being used for different goods and services. The court held that in this case, the well-known mark aspect or priority in use test would not apply because sub-sections (1) (a) and (1) (b) of Section 11 (1) required to be satisfied conjunctively, i.e. both identity or similarity with an earlier trade mark and similarity of goods and services in respect of which were covered by the earlier trade mark had to be shown.

IV. Harjeet Kaur vs Deputy Registrar Of Trade Mark[2005 (30) PTC 330 IPAB]

The Appellants have filed this appeal against the order of the Deputy Registrar of Trade Marks, Delhi. The Appellant's had filed an application for the registration of the trademark "TANU" with the logo of containing two letter 'T' in respect of their hosiery goods, socks, panties and brassieres included in class 25, claiming the user since March 1985. The second Respondent (T. T. Industries) have filed a notice of Opposition opposing the registration of the on the grounds that they deal in hosiery such as ganjjs, jangias, bra, socks, panties, etc., in the name and style 'T.T. Industries', which is their initial of trading style since 1968. They claim that their mark is identical to that of the Plaintiff's. After the entire procedure of the opposition, the DR allowed the Opposition on the grounds that the

two marks looked similar. Then the learned Court held that the marks are not similar, and said that the DR erroneously held that the trademark TANU is not important and only the logo is important. They said that it is a well laid principle that when the conflicting marks are compared; the same should be placed side by side to find out whether they are similar. There should not be any minute or microscopical scrutiny to find out the dissimilarity. Just for the mere outlook whether any ordinary prudent individual would be misled by the similarity of the marks. When a trademark is a composite one, the same cannot be separated by prefix and suffix to find out the similarity and dissimilarity. Although the Appellants are using T.T as well, they are using it in a totally distinctive way. Further, the Appellant has already given an undertaking to not use the mark "T.Tex" and "T.T", there the appeal was allowed and the DR's order was set aside.

MARK INFRINGED BY ANOTHER TRADER EVEN WITHOUT USING WHOLE OF IT, IF ONE OR MORE ESSENTIAL FEATURES COPIED

It is a well-established practice by various Indian Courts in adjudication of infringement matters, that rival trade marks are not to be broken into various integers or elements and are instead to be compared as a whole, a registered proprietor of a trademark may still successfully execute an infringement action, if one or more essential features of his trademark is copied by a different entity. According to the constant case law delivered in the Hon'ble Supreme Court in India, the comparison of trade marks should be based on the overall impression taking into consideration all the distinctive elements of each trade mark.

I. Parle Products Pvt. Ltd. v JP & Co (1972) 1 SCC 618

The Appellant was the manufacturer of biscuits and owners of registered trade mark being a wrapper. The wrapper was used in connection with the sale of their biscuits known as "Parle's Glucose Biscuits" printed on the wrapper. In March 1961 the Appellant came to know that the Respondent was selling biscuits in a wrapper which was deceptively similar to their registered trade mark. The District Court held that there are greater points of dissimilarity than there are of similarity between the two marks, so confusion was unlikely. The High Court concurred with the district court's decision, like the two wrappers limited to the extent that both were partly yellow and partly white in colour and both bore the design of a girl and birds. The girl on the wrapper in the Appellant's product had a pot in her hand while the respondent had a hay-bundle in her hand. Further, the Respondent's wrapper has cows and Appellant's wrapper has 2 calves. The Supreme Court held that the packets were of the same size and colour scheme and although the design was not the same, the

bore a close resemblance that could cause confusion. The Court said that in an action for infringement, the Plaintiff must, no doubt, make out that the use of the Defendant's mark is likely to deceive, but where there similarity between the plaintiff's and the defendant's mark is so close either visually, phonetically or otherwise and the court reaches the conclusion that there is an imitation, no further evidence is required to establish that the Plaintiff rights are violated. Therefore, is one mark is deceptively similar to another, the broad and essential features of the two are to be considered, They should **not** be placed side by side to find out if there are any differences in the design and if so, if the differences are of a character as to prevent one design from being mistaken for the other. It would be enough if the impugned mark bears such overall similarity to the registered mark as would be likely to mislead a person usually dealing with one to accept the other if offered to him.

II. Cadila Health Care Ltd. v Cadila Pharmaceuticals Ltd. (2001) 5 SCC 73

When Cadila Group was restructured, both the plaintiff and defendant got the right to use Cadila as their corporate name. The Plaintiff owned the rights for the trade mark for the drug Falcipharum, sold in India as Falcigo. The Respondent Company got permission a year later to manufacture and import the drug Falcitab with "Fal" being it's essential point of reference. The Plaintiff filed a suit Vadodara District Court claiming that their mark was registered, manufactured and sold in 1996. Falcigo further contains Artesunate for the treatment of cerebral malaria while Falcitab contains Mefloquine Hydrochloride. The plaintiff contended that these were last resort drug and confusion could be harmful. The Defendant noted that it was common practice in pharma to trade to use part of the word of the disease as a trademark to indicate to the doctors and chemists that a particular product/drug is meant for a particular disease. Schedule H drugs are those which can be

sold by the chemist only on the prescription of the Doctor but Schedule L drugs are not sold across the counter but are sold only to the hospitals and clinics, hence no chance of confusion. The interim application filed by the District Court was dismissed and an appeal was filed in the High Court which held there it could not be said that there was a likelihood of confusion. The Supreme Court refused to interfere with the order appeal against, and only examined the principles that are to be kept in mind while dealing with an action for infringement or passing off, especially in medicinal products. They said that there should be extra vigilance in case of medical products, so the likelihood of confusion should require lesser quantum of proof. Factors that should be considered while deciding such a case is:

1. Nature of the goods (word, label, device);
2. Degree of resemblance;
3. Nature of the mark;
4. Similarity in the nature, character and performance of the goods and rival traders;
5. Class of purchasers who are likely to buy the goods bearing the mark they require, on their education and intelligence and a degree of care they are likely to exercise in purchasing and/or using the good;
6. Mode of purchasing;
7. Any other surrounding circumstances.

III. Proctor and Gamble v Joy Creators 2011 (45) PTC 541

The Plaintiff is the manufacturer of "OLAY TOTAL EFFECT" anti aging cream in class 3 since 2007, and in 2008, the Plaintiff saw an advertisement from the registration of the mark "JOY ULTRA LOOKS TOTAL EFFECTS" in respect of the cosmetics of the defendants. The defendant has been using the label since 2001. The Plaintiffs filed the initial opposition proceedings and alleged that the defendant is using the words "TOTAL EFFECT" only in relation to anti-ageing/age defying products. The Plaintiff then initiated a passing off action. The defendant claimed that in their label "JOY ULTRA" is more

prominently portrayed. Delhi High Court allowed the suit and restrained the Defendants from using the trade mark “TOTAL EFFECTS” or any other deceptive variation. After taking note of various judgments, the court noted that for a successful action the plaintiff needs to establish that the trademark of the defendant “resembles its trademark in a substantial degree, on account of extensive use of the main features” of the trademark. It was important to consider that a consumer would not have both products lying side by side and this would increase the chances of deception. The Court reasoned that Total Effects was an essential and integral part of the Plaintiff’s trade mark, and its use with suffix and prefix and packaging will not change or be of significance once the essential part is used, and hence rules in favour of the Plaintiff.

**IV. Max Healthcare Institute Limited vSahrudya Health Care Private Limited 2017
SCC OnLine Del 12031.**

The Plaintiff Company Max Healthcare was established under a JV between Max India Limited and Life Healthcare Corporation. The Healthcare business was later transferred to Max India by Max Finance Services Ltd by virtue of a demerger. The Trade Mark ‘MAX’ was adopted and used by Max Financial Services Limited and its respective group Companies. The Plaintiff is also the registered proprietor of six label marks bearing the word ‘MAX’. After finding out that the defendant carrying on the same business under the mark MAXCURE/MAXKURE HOSPITALS the Plaintiff filed the instant suit before the Hon’ble Delhi High Court for restraining the defendant from using any of the marks. The Court relying on the principle of essential features says that if a word forming a part of a mark has come to be associated with the goods sold under said mark of its owner, it amounts to infringement of the mark itself when the word is adopted as a mark or part of a

mark by another trader. The deceptive similarity between the rival marks must be decided not only based on visual, structural and phonetic comparisons but also the nature of good/services and purchasing public. Therefore, they held that the word MAX forms an essential feature of the plaintiff's registered trademarks. Further they denied the test of infringement of its use on paper and said that in order to decide infringement, apart from ocular examination, the likelihood of confusion from the perspective of a common man of average intelligence and imperfect memory must also be given equal weight, and it is important to take stock of various judgments to decide what constitutes as infringement of an essential part of a mark, the instant case was also decided on the principle of judging similarity by looking beyond just the visual comparison and into the impression the mark has created in the mind of the general public.

V. J. & P. Coats Ltd. vs Chadha & Co. (India) [AIR 1967 Delhi 141]

Plaintiff is a manufacturer in sewing and embroidery threads of all kinds. The goods that have been manufactured by the Plaintiff are sold in India under the trade mark "anchor Handicraft in class 28 in respect of threads of all kinds. According to the plaintiff's plea, the box mentioned above containing the plaintiff's goods is well known in the market and has been associated with the plaintiff-company. Sometime prior to the institution of the suit, the plaintiff came to learn that the defendants had begun manufacturing stranded cotton skeins and selling the same in boxes in which the plaintiff-company sells its goods. The Plaintiff further claimed that a large number of women were illiterate people and women. The defendant pointed out differences like the "anchor" mark for the Plaintiff and the "dog" for the defendant, Plaintiff's "Chandha and Co" and the defendant's "Clark's Company Paisley", while words like "Fast Colour" "Stranded Cotton" and "Nos. Of Skeins" etc., were

common words used by all trades and for which no one could claim any monopoly. The Court held that where colour of rival boxes of thread was similar, even the illiterate users may well be expected to distinguish between the opposite marks 'Dog' and 'Anchor', which are the distinct essential feature of the respective parties. Hence, the Court held that there was no probability of confusion.

ABBREVIATION OF A GENERIC TERM ALSO GENERIC

Abbreviations of generic words and term are also considered to be generic, and therefore, no trade mark protection can be extended to to the same, unless the Applicant can establish that the term has some-how managed to acquire a secondary meaning that is associated with the abbreviation in relation to the products or services of the Applicant. Generic terms are non-protectable terms and requires a higher degree of source identifier abilities to be protected under the Trade Mark law. In general, however, much like the case of the *Registrar v Ashoke Chandra Rakshit* the registry follows a general policy of denying exclusive protection over generic terms and their abbreviation, or allows the registration with a disclaimer.

(i) SUPERON SCHWEISS TECHNIK INDIA V. MODI HI-TECH INDIA LTD. (2018) 250 DLT 308

The plaintiff company has its well-known trademark of SUPERON under which the plaintiff sells its goods, and along with this trademark SUPERON the plaintiff also claims to have adopted from the year 2004 the trademark of VAC-PAC which is indicative of the packing style- vacuum packaging. The defendant is selling its goods under its primary trademark GMM/arc with an addition of the words VAC-PAC on the packaging. The Plaintiff alleged that the Defendant has dishonestly adopted an identical trademark VAC-PAC for the same goods as that of the plaintiffs', such as welding electrodes. Therefore, adoption of "VAC-PAC" is completely dishonest. Hence, the plaintiff has filed a suit before the Court claiming permanent injunction to restrain the Defendants from infringing their mark "VAC-PAC". One of the contentions by the defendant stated that that abbreviation of descriptive words cannot and should not be given protection as a trademark. The court also upheld that no

one can claim exclusive ownership over an ordinary descriptive word or their abbreviation as trademark in view of Section 9, 30 and 35 of the Trade Marks Act, 1999. In the present case, thus the court said that the word VAC PAC was an abbreviated form of Vacuum Pack/packaging as affirmed by plaintiff. This is descriptive in larger term as it is used in packaging a welding shield to give a longer shelf life. Thus, using words like VAC PAC shall not entitle the owner of such word, an exclusive owner.

(ii) Marico Limited Vs. Agro Tech Foods Limited 2010 (44) PTC 736.

Plaintiff's registered Trade Marks "LOSORB" and "LOSORB" in class 3 for different Edible Oil/ghee products along with the trade marks Sweekar and Saffola effective from 2001 and have sought Injunction to restrain Defendant on account of the use of the expression "LOW ABSORB" along with their trade mark "Sundrop" in their edible oil product. The issue in this case was whether the Respondent's user of the expression "LOW ABSORB TECHNOLOGY" in relation to its edible oil product amounts to passing off the goods of the Appellant which uses the unregistered Trade Mark "LOW ABSORB". The court held that the expression "LOW ABSORB" is a common descriptive expression/adjective as it is not a coined word and could be a combination of two popular English words which are descriptive of the nature of the product. It surely and immediately conveys the meaning of the expression that something which absorbs less, and when used with respect to edible oil, it is descriptive in that it refers to less oil being absorbed or low oil being absorbed and the same is incapable of being distinctive. In light of ratio laid down in case of Cadila Healthcare Ltd. v. Gujarat Co-operative Milk Marketing Federation Ltd. and Ors., the Appellant can have no exclusive ownership rights on the Trade Mark "LOW ABSORB". Also, the Respondent is selling its product with a prominent Trade Mark "Sundrop" and

which appears on the packaging of the Respondent in a very prominent size, much larger than the size of the expression "LOW ABSORB TECHNOLOGY". The colour scheme of the respective packaging is different merely because, the consumers are same and the trade channel is also same, it cannot be said that there is a possibility of confusion, because there are more than enough differentiating features on the packaging so as to avoid any issue of the Respondent passing of its goods as that of the Appellant .Thus, even though the two respective products of the parties are identical viz edible oil, it cannot be said that the respondent is passing of its goods as that of the plaintiff .Appeal is dismissed.

(iii) Himalaya Drug Company vs S.B.L Limited 2010 (43) PTC 739 (Del)

In this case the plaintiff Himalaya drug Company is engaged in the manufacture and sale of Ayurvedic medical preparations since 1930. One of the preparations manufactured and marketed by the plaintiff is under the trademark LIV-52 where the LIV stands for LIVER TONIC. It is a liver tonic prescribed for liver disorder and to protect the liver against various dysfunction, damage and hepatotoxins. The defendant SBL also launched its product in the same category under the name 'LIV-T'. Plaintiff claimed that LIV-T is deceptively similar with the mark LIV-52 and is likely to mislead or confuse those who are likely to purchase such preparations in the market. Thus, the court held that- 'Nobody can claim exclusive right to use any generic word, abbreviation, acronym which has become public juris. In the trade of drugs, it is common practice to name a drug by the name of the organ or ailment, which it treats or the main ingredient of the drug. Such an organ ailment or ingredient being public jurisdiction or generic cannot be owned by anyone for use as a trademark.' Hence, the plaintiff claim is not valid.

(iv) **Indo-Pharma Pharmaceutical vs Citadel Fine Pharmaceuticalson AIR 1998
Mad 347.**

The Madras High Court in while dealing with two marks 'Enerjex' and 'Enerjase' held that the abbreviation of a generic word will also be generic. The appellant is engaged in the business of manufacturing and selling pharmaceutical medical preparations. The respondent is also involved in the same business. The appellant filed the suit for permanent injunction restraining the respondent from infringing plaintiff's registered trademark in respect of infants and invalid foods by use of the offending trade mark 'ENERJASE' or any other trade mark which is deceptively or phonetically similar to the plaintiff's trade mark 'ENERJEX'. In this case reliance was placed on the extract from McCarthy in Trademarks and Unfair Competition. Since the components 'Jase' and 'Jex' were completely dissimilar, injunction was refused by the Court to the plaintiff. On appeal the Madras High Court held as follows:

The two rival marks 'ENERJEX' and 'ENERJASE' contain the common feature 'ENERJ' which is not only descriptive but also public juris. Therefore, a customer will tend to ignore the common feature and will pay more attention to uncommon features i.e. 'JEX' and 'JASE'. These two cannot be said to have such phonetic similarity so as to make it objectionable. So, the word 'ENERG/J' used as a prefix in both the trade names is the abbreviation of the generic term of the English word 'energy'. As such, it is descriptive in nature and common in usage. Nobody can claim an exclusive right to the use of the word 'ENERG/J' as the constituent of any trademark.

A PERSON CLAIMING EXCLUSIVE RIGHTS OVER AN EXPRESSION CANNOT CHALLENGE THE SAME AS GENERIC

Here we discuss the Principle of approbate and reprobate, i.e. to accept and reject, this principle says that that which is approved cannot be disapproved, It is equally well-settled that the party cannot be allowed to approbate or reprobate at the same time so as to take one position, when the matter is going to his advantage and another when it is operating to his detriment and more so, when there is a same matter either at the same level or the appellate stage. Therefore, a person who has on one hand claimed exclusive rights over a mark or expression, cannot challenge the same as generic.

(i) Automatic Electric Limited vs R.K. Dhawan & Anr. 1994 SCC OnLine Del 632.

In this case it was held that a person claiming exclusive right over an expression cannot challenge the same expression as generic. Plaintiff adopted in the year 1945, the trade mark 'DIMMERSTAT' in relation to variable voltage auto transformers. Plaintiff was also the registered proprietor of the trade mark 'DIMMERSTAT' in Class 9. The case of the Plaintiff was that the Defendants had adopted the trade mark 'DIMMER DOT' in relation to variable voltage auto transformers and the said mark is likely to cause confusion or deception amongst the members of the public as it was deceptively similar with the trade mark 'DIMMERSTAT' of the Plaintiff. Defendant contended that 'DIMMER' being a generic word is incapable of serving a trade mark function. According to him, the word "DIMMER" signifies and connotes an auto variable transformer, therefore, no trader could monopolies the use of this word in relation to auto variable transformer and registration of such word having a direct reference to the character or quality of the goods is prohibited

under section 9(1)(d) of the Trade and Merchandise Act. He refuted the contention of the counsel for the plaintiff that auto variable transformers are not called "DIMMERS". The court held that the 'DIMMER DOT' of the Defendants is not a registered trade mark. The word 'DIMMER' as is understood in the common parlance is connected with an arrangement for regulating the supply of the electricity, but the product here is not a 'DIMMER', but, a variable transformer. The court further said that the Defendants got their trade mark 'DIMMER DOT' registered in Australia. The fact that the Defendant itself has sought to claim trade proprietary right and monopoly in 'DIMMER DOT', it does not lie in their mouth to say that the word 'DIMMER' is a generic expression. Therefore, injunction was confirmed.

(ii) Blue Hill Logistics Private Ltd. vs. Ashok Leyland Ltd. and Ors 2011 (48) PTC 564 (Mad).

Plaintiff filed suit for infringement and passing off and for various consequential relief's against Defendants. An order granting temporary injunction restraining the 1st Defendant from in any manner infringing the Plaintiff's registered trade mark "LUXURA" by use of similar mark "LUXURIA". The court held that 1st Defendant is using almost identical trade mark "LUXURIA" prominently displayed on the buses in the same position as that of the Plaintiff. 1st Defendant himself had applied for registration of trade mark "LUXURIA" under Classes 39 and 35 despite the fact that there is a prohibition under Section 9(1)(b) of the Act. The person claiming exclusive right over the expression cannot challenge the same expression as generic. Once the First Defendant is permitted to use the mark "LUXURIA" on the buses purchased by them from the competitors of the Plaintiff, the competitors of the Plaintiff [VOLVO] could not also be prevented from using the said mark later on. There

is no bona fide/honest conception of the trade mark "LUXURIA" by the 1st Defendant. Plaintiff has established a case to attract the ingredients of Section 29(4) and the infringing by use of such mark would amount to 1st Defendant taking unfair advantage of reputation of the Plaintiff's mark and would be detrimental to the registered trade mark of the Plaintiff. Having regard to the Plaintiff's exclusive right to use of the mark and weighing the various factors and also balance of convenience, the learned single Judge granted temporary injunction. Hence, appeals were dismissed.

(iii) Anchor Health and Beauty Care Pvt Ltd. vs Procter & Gamble Manufacturing Co Ltd. and Ors 2014 (59) PTC 105 (Del).

In this case the primary point of disagreement involved was whether the plaintiff's mark "ALLROUND PROTECTION" was descriptive or not. The Plaintiff was the registered proprietor and owner of the mark "ALLROUND". The Plaintiff claimed that by virtue of constant and extensive use of the mark "Anchor ALL ROUND PROTECTION", the mark "ALLROUND" is associated exclusively and primarily with the Plaintiff. The Defendant released a tooth paste bearing the mark ORAL-B "ALL - AROUND PROTECTION". The Plaintiff filed a suit against the defendant to stop the Defendant from using "ALL AROUND PROTECTION" / "ALLROUNDER". After going through the rival contentions of the parties, the Court decided that after themselves obtaining and seeking registration for the marks "ALL AROUND PROTECTION" and "ALLROUNDER" it was contrary for the Defendant to state that they are generic marks and therefore not open to the Defendant to content that the Plaintiff's registered trademark "ALLROUND" was descriptive, generic and/or devoid of any distinctive and separate character and/or not capable of being registered. It was

allowed for the Defendant to “approve and reprove” to the detriment of an opponent. Thus, the judgement was in favour of plaintiff.

PROTECTION OF MARK REGISTERED FOR GOODS ENTITLED TO PROTECTION FOR SERVICES IF RELATED TO GOODS

When the trade is applied for a good, it is seen that in most cases the protection under that trade mark would also extend to any services that are in relation to those good, since the likelihood of confusion would exist if there are two different trade marks in goods and services which are closely related to those goods.

I. Blue Hill Logistics Private Ltd. vs. Ashok Leyland Ltd. and Ors. 2011(48) PTC 564 (Mad).

Plaintiff filed suit for infringement and passing off and for various consequential relief's against Defendants. An order granting temporary injunction restraining the 1st Defendant from in any manner infringing the Plaintiff's registered trade mark "LUXURA" by use of similar mark "LUXURIA".The court held that use of the trade mark in relation to goods is distinct from the use of the trade mark in relation to services. Plaintiff has obtained the registration of the trade mark "LUXURA" under Clause 12 - "Goods". Whereas, First Defendant has applied for registration of trade mark in respect of Classes 39 and 35 - "Services". The onus is on the registered proprietor who is invoking the provisions of Section 29 of the Act to establish that the Plaintiff's mark is infringed under Sub-section (2)(a) or Sub-section (2)(b) of Section 29 of Trade Marks Act. Where the rival marks are identical and the goods or services are also identical, there is a statutory presumption of confusion and accordingly, a prima facie case of infringement would exist. The onus then shifts to the Defendant. There is no similarity or association between Plaintiff's goods i.e. buses with the mark "LUXURA" and 1st Defendant's intercity transport services i.e. "LUXURIA". Plaintiff's goods/buses are bought by bus operators, State Transport

Corporation who in turn use the buses for luxurious travel of the passengers. Buyers of buses are totally different from passengers who buy bus tickets. 1st Defendant's services are enjoyed by passengers for a comfortable/luxurious intercity travel. Therefore, Plaintiff cannot complain any infringement under Sub-section (2) of Section 29 of the Trade Marks Act.

II. Bourjois limited vsNaunihal Singh and ors. 2013(53)PTC632(Del).

In this case plaintiff is a foreign company claims to have coined and adopted the trademark BOURJOIS. The plaintiff is engaging in the business of selling cosmetic products and claims presence in over 120 countries including India. The defendant no.2 is stated to be an in-house concern of defendant no.3 and believed to be engaged in providing spa services, beauty services, manicures, pedicures, bridal spa and makeup under the name 'Bourjois Spa'. The case of the plaintiff is that the use of the mark BOURJOIS by the defendants as a trade name and trademark for running its services and as a part of its domain name constitutes infringement of its registered trademark, besides constituting passing off of their services as those of the plaintiff. The plaintiff has accordingly sought injunction restraining the defendants from using, depicting or displaying the trademark and domain name BOURJOIS or any other mark which is deceptively similar to the mark of the plaintiff. The Defendants had not come forward to explain why they have chosen this particular name. So, it was held by the court that -If the product and service are closely related to each other but they also have a trade connection it would be difficult to say that the goods and services are not closely related to each other. The Defendants were passing off their services as those of the plaintiffs by using the impugned trademark/trade name for rendering saloon/spa services and as a part of their domain name. The

defendants are accordingly liable to be enjoined from using the impugned trademark/trade name.

III. Many Kagliwal and Ors. V Mayo Foundation for Medical Education and Research, USA (2018(2)MhLJ720).

The Plaintiff Mayo Foundation for Medical Education and Research/Mayo Clinic is doing activities under the Trade name "MAYO" since 1914. The Defendants are believed to be engaged in the business of marketing and selling pharmaceutical products under the MAYO and MAYO formative marks. The Defendant argues that origin of their mark was "MAAYOGMAYA" and they have been using the mark since 1982, therefore, are first in business. They further argue that the plaintiff is in the business of medical services while the defendant is in the business of marketing and selling pharmaceutical products. The court observed that to be "related" in the parlance of trademark law, the conflicting good or services do not have to be in competition with each others. That the goods or services are noncompetitive does not answer the question of whether the goods are so "related" that a reasonable buyer is likely to think that defendant's goods or services are somehow connected with, or sponsored by, the plaintiff, due to similar marks. There is no simple, one question test for determining whether noncompetitive products are "related" such that confusion is likely as to source, affiliation, connection or sponsorship. "Related" does not mean that there is necessarily any physical relationship between the goods or services identified by the conflicting marks. Rather, it means that the marks as used are "related" in the mind of the consuming public. Goods are "related" if customers are likely to mistakenly think that the infringer's goods come from the same source as the senior user's goods or are sponsored by, affiliated with or connected with the senior user. Based on this the court

observed that there is sufficient proximity between the businesses of the Defendant and the Plaintiff and dismissed the appeal ruling in favor of the plaintiff.

MARK INFRINGED IF USED AS TRADE NAME BY ANOTHER PERSON

This ratio applies to a situation where the trade mark of a company is being used as the trade name of another company. Eventually any product with the same name in the market is likely to be associated with the company, especially in cases where the goods are identical. Therefore, in these situations, where the trade name of a company is so similar to the trade mark of another, a right against the infringement arises.

(i) Cipla Limited v. M/s Cipla Industries Pvt. Ltd. 2016(67)PTC509(Bom).

On August 11, 2017 the Supreme Court of India heard an appeal filed by Cipla Limited. This was against a ruling of the full bench of the Bombay High Court on the issue of the use of a registered trademark as a trade name for dissimilar goods/services, saying that it does not amount to infringement. The plaintiff, Cipla Limited, is a well-known manufacturer of pharmaceutical products which has a registration for the mark CIPLA for “pharmaceutical products” in class 5. The Defendant, registered the mark CIPLA PLAST in Class 21 for “household and kitchen utensils, containers etc.” The plaintiff brought a suit against the defendant claiming that use of their well-known registered trademark CIPLA was a part of the defendant’s corporate name, and hence, it amounted to infringement. The plaintiff further claimed that, since trademarks are inclusive by definition they should also be inclusive of the right to be able to use the mark as a trade name, and hence by using Cipla Limited’s trademark as a corporate name by the defendant would tantamount to infringement. The defendant on the other hand, claimed their goods were neither similar nor identical to the plaintiff’s marks and, there was no infringement caused. The single judge held that the case of *Raymond Limited v. Raymond Pharmaceuticals* [2010 (44) PTC (Bom)] (*Raymond*), was of the view that the decision rendered in the said case—wherein

an injunction had been refused to the plaintiffs whose registered trademark was being used as a corporate name by the defendants—required reconsideration and referred the matter to a larger bench. The full bench considered the interplay of relevant provisions of Section 29 of the Trade Marks Act, which was in regard to infringement of registered trademarks—in particular, Sections 29(4) and 29(5). By giving the provisions a literal interpretation, the bench held that in to be able to invoke Section 29(4), the plaintiff would have to show that the defendant’s mark was identical with or similar to the plaintiff’s registered trademark and was used in relation to dissimilar goods/services. Section 29(5) applied in cases where the plaintiff’s registered trademark had been used as a corporate name by the defendant with respect to same/similar goods/services. The bench affirmed that Sections 29(4) and 29(5) were mutually exclusive and no cause of action would exist when a registered trademark was used as a corporate name with respect to dissimilar goods. While the judgment is based on a literal interpretation of the law, it does affect the statutory rights of holders of well-known trademarks. That said, a passing off action may still be initiated in such scenarios. Owners of well-known marks now eagerly await the decision of the Supreme Court in the appeal. Although the matter was listed on January 4, 2018, a hearing has not yet been held.

**(ii) Mankind Pharma Ltd vs Chandra Mani Tiwari&Anron 6 July, 2018
2018(75)PTC8(Del).**

In this case the plaintiff being the fourth largest pharmaceutical company of the country, is the registered proprietor of the mark “MANKIND” in 42 different classes and has three decades used numerous marks by adding prefix or suffix to the elements MANKIND and/or “KIND” and is also the registered owner of websites with MANKIND in their web

addresses. The plaintiff while searching the records of the Trade Mark Registry, saw that the trade name 'MERCYKIND PHARMACEUTICALS PRIVATE LIMITED' (Defendant No.2) belonged to Chandra Mani Tiwari (Defendant No.-1) who was the director of defendant no-2. The defendant no 2 who had been doing business under the trademark such as 'MERCYMOX', 'MERCYCOUGH' and 'MERCYCOPE'. Therefore, the plaintiff brought the instant suit against the defendants before the Delhi high court for permanent restraining the defendants from using or infringing the plaintiff's trade mark/tradename 'MANKIND' and series of marks with the suffix/prefix 'KIND' and from passing off their business /goods as that of the plaintiff by way of adopting and using the trade name 'MERCYKIND PHARMACEUTICAL PRIVATE LIMITED'. The primary issue that had been brought up in this case was whether the defendant is guilty of infringing the plaintiff's trademark and passing off of was the use of the the work "KIND" by the Plaintiff for their goods. In this regard, the court held that there was no case of prima facie infringement under clauses (1) to (4) of Section 29 of Trade Marks Act, 1999 as had been made out since the mark MERCYKIND was not used as trademark by the defendant. The Court for this purpose observed that pharmaceutical/medicinal products of the defendant were not named MERCYKIND. It rejected the contention of the plaintiff that use of MERCYKIND even in the name of defendant's company, is used as a trade mark. The Court held that mere affixation of the name of the defendant company as manufacturer or marketer of the drugs/medicines sold by the defendants, would not be sufficient use as a trade mark, even under Section 29(6). Similarly, they held that that use of registered trademark as trade name or part of trade name was absent, the Court held that there was no infringement under clause (5) of Section 29. It was held that just by virtue of the fact that MERCYKIND

may be deceptively similar to MANKIND or any other registered trade mark of plaintiff with KIND as prefix or suffix, would not amount to infringement under Section 29(5).

(iii) Kala Niketan v/s kalaNiketan AIR 1983 Delhi 161, ILR 1981 Delhi 592 (Kala Niketan Case) 1981 PTC 213

Plaintiff carried on business of dealing in and selling sarees under the Trade Name 'Kala Niketan'. The Plaintiff had given wide publicity to its Trade Name 'Kala Niketan' through newspapers, radio, boarding and other media, and there was huge market for the sarees of the Plaintiff. The Defendant being aware of the popularity of the Plaintiff's name, adopted the same Trade Name and started business in sarees. The Defendant was served with a notice in December 1977 to stop using the Trade Name 'Kala Niketan' but the Defendant did not stop the usage. Further, the Defendant published a caution notice in the Indian Express, dated May 13, 1978 claiming that Defendant firm was the proprietor of the name 'Kala Niketan' in respect of trade of all kinds of Sarees and textiles. In the subsequent case, the Court found that the adoption of the Trade Name 'Kala Niketan' by the Defendant was to ride on the popularity of the Plaintiff's Trade Name and granted a decree for permanent injunction restraining the Defendant from dealing in Sarees and other textile goods in the name of 'Kala Niketan' or any other identical or deceptively similar Trade Name.

(iv) Atlas Cycles (Haryana) Ltd. vs Atlas Products Pvt. Ltd. 2008 (36) PTC 269 Del (Atlas Case)

The Plaintiff, M/s. Atlas Cycle (Haryana) Limited, a public limited company, filed a suit for permanent injunction restraining the Defendants from using Plaintiff's registered Trade Mark 'Atlas' as Defendant's Trade Mark or as part of its corporate Trade name. The

Defendant introduced the Trade Mark 'House of Atlas' for its bicycles in such a way that the word 'Atlas' appeared in a conspicuous fashion whereas words "House of" was depicted in a smaller font which gave a dominant exposure to the word 'Atlas'. The Court in this case found the Defendant used the said Trade Mark to deceive and confuse the public as to the origin of goods and therefore held against the Defendant. However the court did not restrain the Defendant from using the said Trade Name. The court instead went against the Plaintiff's reasoning that the Plaintiff had raised this issue after 7 years of incorporation of the Defendant Company and that if an injunction is granted, it will cause serious prejudice to the Defendant. The Court held that restraining the Defendant from using its corporate name at this juncture, which it has nurtured for the last more than seven years, would result in a "civil death" for the Defendant.

(v) Raymond Ltd v Raymond Pharmaceuticals 2010 (44) PTC (Bom)

In this case the Plaintiff was Raymond Ltd. dealt in fabric, brought about a suit against Raymond Pharma who were incorporated in 1983 and who were in the business of manufacturing and marketing of medicine. The Plaintiff objected to the use of the mark "RAYMOND" by the defendant as their domain name and other business purposes, since they had adopted the mark 80 years ago, it was an essential feature of their trade mark, and have over the years become well known. The defendant claimed that and that they had using the mark as their corporate name for healthcare products for very long. In this case the Division bench and the Single judge bench of Bombay high Court favoured the defendant by pointing out that they were for different goods, and operated in completely different fields. They also held that the domain name of the Defendant incorporates part of

its corporate name and the corporate name of the Defendant is not actionable as infringement of the mark.

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