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

% *Date of decision: 20th September, 2022*

\+ CS(COMM) 51/2022

MINDA SPECTRUM ADVISORY LIMITED & ORS. ..... Plaintiffs

Through: Mr. Chander M. Lall, Senior Advocate with Ms. Bitika Sharma, Mr. Luv Virmani, Ms. Aadya Chawla, Ms. Manmeet Kaur Sareen and Ms. Ananya Chug, Advocates.

versus

MINDA OILS INDIA PVT LTD & ORS. ..... Defendants

Through: Mr. Shiv Charan Garg, Mr. Bharat Bansal, Mr. Rohil Kumar, Mr. Imran Khan and Ms. Pooja Bansal, Advocates.

CORAM:
HON'BLE MS. JUSTICE JYOTI SINGH

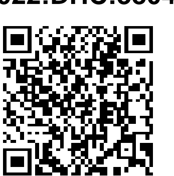
JUDGEMENT

JYOTI SINGH, J.

I.A. 1134/2022 (under Order 39 Rules 1 and 2 CPC, by Plaintiffs) and **I.A. 6456/2022** (under Order 39 Rule 4 CPC, by Defendants)

1. This judgment shall dispose of an application filed on behalf of the Plaintiffs under Order 39 Rules 1 and 2 CPC and an application preferred on behalf of the Defendants, for vacation of *ex parte* ad-interim injunction granted *vide* order dated 20.01.2022, under Order 39 Rule 4 CPC.

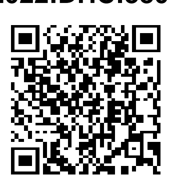
2. Present suit has been filed by the Plaintiffs seeking a decree of permanent injunction restraining the Defendants and/or all others acting on their behalf from infringing the trademarks of the Plaintiffs as well as the copyright in the labels/artistic works and passing off, along with other reliefs of damages, delivery up, etc.



3. On 20.01.2022, this Court granted *ex parte* ad-interim injunction in favour of the Plaintiffs and against the Defendants, as sought for. Upon being served the Defendants challenged the said order before the Division Bench in FAO(OS)(COMM) 68/2022. The appeal was disposed of *vide* order dated 23.03.2022, giving liberty to the Defendants to file an application for vacation/modification of the interim injunction order, leaving the rights and contentions of all parties open and clarifying that the Court had not commented on the merits of the controversy. Pursuant to the liberty granted by the Division Bench, Defendants preferred the aforementioned application, which is being disposed of by the present judgment.

4. Case of the Plaintiffs is that they are part of the well-known and reputed 'Minda Group of Companies' which have wide-spread and enviable presence in the automobile and spare parts sector. Plaintiffs are leading manufacturers of automotive components including but not limited to industrial oils, lubricants, engine oils, etc. and transact business under the house mark/trade name MINDA and its variants and derivatives such as /SPARK MINDA and / /UNO MINDA. Plaintiffs group was founded in the year 1958 by Late Shri Shadi Lal Minda under the flagship name MINDA as a proprietorship. With passing years, business was organised by different companies under the trademark MINDA and its formatives, adopted in the year 2011. Thus the continuous, extensive and uninterrupted use of the mark MINDA as the Group's trade name dates back to the year 1958 and forms an inseparable and essential part of its trade name.

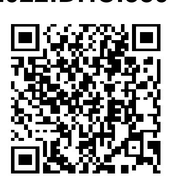
5. It is pleaded that the word mark MINDA and its derivatives are registered in various classes including device marks UNO MINDA and



SPARK MINDA, which are the trademarks relevant to the present suit. The registrations are valid and subsisting and Plaintiffs have diligently protected their Intellectual Property Rights by initiating opposition proceedings against any infringing mark. Plaintiff No. 1 has filed applications for inclusion of trademarks MINDA and UNO MINDA in the list of well-known trademarks while Plaintiff No. 3 has filed applications for inclusion of mark SPARK MINDA and the applications are pending before the Trade Marks Registry. Plaintiffs' Group of Companies has also obtained trademarks registrations in other countries such as Malaysia, Indonesia, Philippines, etc. There are pending applications for registration of certain MINDA formative marks in various classes.

6. It is further pleaded that Minda Group is one of the leading manufacturers of automotive components such as alternate fuel systems, air-brakes, fuel caps, wheel covers, air ducts and washer bottle, etc., which are the products of UNO MINDA Group and Electronic and Mechanical Security Systems, brake shoes, clutch plates, wiper blades, sensors, industrial oils, lubricants, engine oils etc. which are the products manufactured and sold by the SPARK MINDA Group, catering to major vehicle manufactures in India and overseas, such as BMW, Honda, Ford, Escorts, TATA, Mahindra, etc.

7. It is stated that as on 31.03.2021 the annual turnover of Plaintiffs' Group of Companies was Rs.8,741 crores. The Group has more than 104 plants globally and 25 R&D centres across India. Plaintiffs' Group comprises 40 Group Companies and 15 global technology partners, with a workforce of more than 26,000. Some of the invoices on record are in the name of Minda Automotive Solutions Limited, which has amalgamated with



Plaintiff No. 5 *vide* an order dated 19.07.2019, passed by the NCLT. Plaintiffs have spent considerable amounts over the past 3 decades on promotional expenditure and advertisements. Success of the products under MINDA formative marks is borne out from the steadily increasing sales figures. In the year 2009, the sales were to the tune of Rs.934.15 crores, which have since increased to Rs.5989.44 crores in the year 2021. Plaintiffs have several prestigious awards to their credit as detailed in the plaint.

8. It is averred that by virtue of such extensive use, recognition and vast publicity, the trademarks MINDA, SPARK MINDA and UNO MINDA have become distinctive of and are exclusively identified and associated with the Plaintiffs. The said trademarks have been protected by this Court in a number of proceedings filed earlier by the Plaintiffs.

9. Defendant No. 1 is stated to be a company incorporated under the Companies Act, 2013 under the name Minda Oils India Private Limited and claims to be in the business of manufacturing and distribution of automobile lubricants and grease. Defendant No. 2 is also a Company claiming to be in the same business under the impugned trademark MINDA UTO and Defendant No. 3 is a proprietorship entity involved in the business of distribution of lubricants and grease under the impugned mark MINDA UTO and is in the process of entering into the business of lubricants under impugned mark SPARK MINDA. Defendants also operate a website www.sparkmindalube.com.

10. It is pleaded that the suit was filed after the Plaintiffs came across the products of the Defendants bearing the impugned mark MINDA UTO, being sold on www.indiamart.com. It was also found by the Plaintiffs that Defendant No. 3 had applied for registration of the trademarks MINDAUTO

and SPARKMINDA and other formatives of MINDA in various classes, in order to ride on the goodwill and reputation of the Plaintiffs and barring MINDAUTO, which is registered in class 04, other trademarks have been opposed/objected to. Maliciously, Defendant No. 3 filed an application for registration of the impugned mark MINDAUTO by removing the space between the words ‘MINDA’ and ‘UTO’ so that the Registrar is unable to locate a conflicting prior trademark while generating the examination search reports. Opposition filed by Plaintiff No. 3 is pending.

11. It is further averred that since Plaintiffs No. 2 and 3 had filed oppositions and could not find any proof of the usage of the impugned marks in February 2020, it was assumed that Defendant No. 3 had not commenced usage of the impugned marks until it was learnt that the products are being sold under the impugned marks MINDAUTO.

12. It is pleaded that Defendants’ actions constitute infringement of the trademarks and copyright in the artistic work as well as passing off and unfair competition and therefore, the interim injunction order be confirmed.

13. Written statement has been filed on behalf of the Defendants and it was submitted by learned counsel for the Defendants, during the course of arguments that the written statement as well as the application under Order 39 Rule 4 be read in reply to the application under Order 39 Rules 1 and 2 CPC.

14. Learned counsel for the Defendants strenuously urged that the injunction order passed by this Court be vacated on the following grounds:-

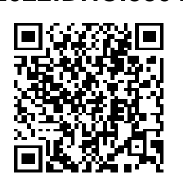
a. Defendants No. 1 and 2 are in the business of manufacturing and distribution of automobile lubricants and grease.

Defendant No. 2 runs its business under the trademark MINDAUTO. Defendant No. 3 is a proprietorship entity and is in the business of distribution of lubricants and grease under the mark MINDAUTO. Defendants No. 1 and 3 are sister concerns of Defendant No. 2 and collectively operate the website www.sparkmindalube.com.

b. Defendants have applied for registration of various trademarks such as 'UNOMINDA', 'SPARKMINDA', 'MINDAUTO PLUS','MINDAUTO MAX' and 'MINDA UTO PRO' in class 04 for lubricants, industrial oil, grease, engine and brake oil. Defendant No. 3 has applied for registration of UNOMINDA on 29.09.2019 in class 04 for lubricants, etc. and has obtained registration for the mark MINDAUTO, applied for under application dated 03.07.2018 in class 04 for lubricants, industrial oil and grease, while applications for other trademarks under classes 01 and 04 are pending registrations. Defendant No. 3 has been continuously using the trademark SPARKMINDA since 2019 and has gathered considerable popularity in the market with considerable sales.

c. Since Defendants have registration for the trademark MINDAUTO, Plaintiffs cannot seek relief of infringement with respect to the goods for which the trademark is registered, in view of the provisions of Section 28(3) of the Trade Marks Act, 1999 (hereinafter referred to as the 'Act').

d. Defendants are not using the word MINDA alone and have used a suffix UTO with the said mark, while the Plaintiffs'



trademark MINDA is with a prefix UNO. 'UNO' and 'UTO' are phonetically different and even from a visual perspective the actual label/mark MINDAUTO is nowhere close to the device mark of the Plaintiffs. The rival trademarks are registered for goods falling in different classes and the nature of goods is also different and thus, there can be no confusion or association in the minds of the public and no case of infringement is made out. Reliance was placed on the judgment of the Supreme Court in ***Nandhini Deluxe v. Karnataka Cooperative Milk Producers Federation Limited, (2018) 9 SCC 183***, more particularly, with respect to the observations made by the Supreme Court that where not only the visual appearance of the two marks is different but if they relate to different products, it is difficult to imagine that an average man of ordinary intelligence would associate the goods of the Appellant with the Respondent. By way of an illustration, it was contended that the trademark 'Jaguar' is a trademark of two companies, where one deals in automobiles and the other in sanitary fittings.

e. Even if the present suit is to be treated as a suit for passing off, no case is made out against the Defendants, who are prior users of the trademark MINDAUTO since the year 2018, in class 04 for lubricants, industrial oils and grease. Plaintiffs have, as per their own case, entered into the business of sale of lubricants only in the year 2021 under the trademark SPARK MINDA and no document has been placed on record by the

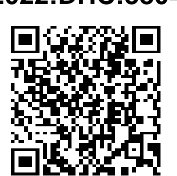
Plaintiffs to show their sales in lubricants, industrial oil, etc., prior to the Defendants.

f. The total sales of Defendant No. 3 for financial years 2018-19 to 2021-22 have increased from Rs.3,49,56,195/- to Rs.4,84,02,415/-, out of which the sales of products under the trademark MINDAUTO have increased from Rs.24,46,933/- in financial year 2018-19 to Rs.72,60,362/- in financial year 2021-22 and similarly the sales under the trademark SPARKMINDA have nearly doubled in the financial year 2021-22. Defendants have spent considerable amount of money in advertising their products.

g. Present suit is not maintainable as the trade name MINDA is a common name and also the name of a village in District Nagaur in Rajasthan and the forefathers of the Defendants belong to the said village. Being a common name, no entity can be given a monopoly or an exclusive right to use the same.

h. Nature of the businesses of the Plaintiffs and Defendants is totally different inasmuch as Plaintiffs are in the business of making and selling automobile spare parts while Defendants are into sale of lubricants, industrial oils and grease.

i. Purpose of a trademark is to identify the source and avoid confusion in the minds of the buyers. In the present case, since both parties are manufacturing different products coupled with the fact that Plaintiffs have not produced any material to show that customers have been confused in the competing trademarks, it is apparent that there is no likelihood of

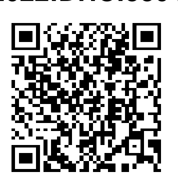


confusion in the minds of the purchasers. Reliance was placed on the judgment in ***Sambhav Kapur v. British Indo German Industrial Organics Private Ltd. and Ors., 2016 SCC OnLine Del 6379***, wherein it was held that if it is found that the suit does not disclose a cause for alleging passing off, on which the relief is based, it can be dismissed at the threshold, merely by looking at the pleadings and the documents filed by the Plaintiff.

j. There are several other entities which have registrations in the trade name MINDA, however, Plaintiffs have not raised any objection against them. Illustratively, Trademarks such as LUMINDA in class 35, MINDALUX, SIGNMINDA, GK MINDA SOLAR and GK MINDA in class 11, and ABMINDA in class 04 were cited by the Defendants. Even though ABMINDA is registered in the same class as the Plaintiffs, no objections have been raised.

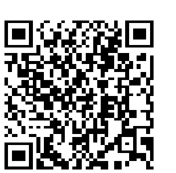
15. Learned Senior Counsel appearing on behalf of the Plaintiffs raised the following contentions and also refuted the submissions made on behalf of the Defendants:-

a. Plaintiffs are registered proprietors, prior users and exclusive owners of the brand name MINDA and its formative trademarks. Use of any trademark which is identical or deceptively similar to the said mark is in violation of the coveted statutory and common law rights of the Plaintiffs. The impugned marks/labels in the present case bear a high degree of similarity with the Plaintiffs registered and prior used



trademarks/labels MINDA, /SPARK MINDA and /UNO MINDA. Apart from the identity with the word MINDA, there is a high degree of visual and conceptual similarity, owing to use of similar colour combinations, font size, style of writing, etc. The colour scheme in the competing marks is a combination of blue and white with the words UNO and MINDA written in two separate boxes and UNO in a white colour on a blue background in the Plaintiffs' mark, while UTO is in a white/blue colour on a blue/white background. It is apparent that trademarks of the Plaintiffs have been slavishly copied to show an association with the Minda Group and encash on its goodwill. The comparative table, as brought forth in the plaint, is as follows:-

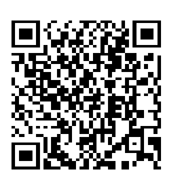
	PLAINTIFFS' MARKS/LABEL	DEFENDANTS' MARK/LABELS
Marks	MINDA UNO MINDA	MINDA UTO
Label		
Description	• The mark/label uses a colour scheme comprising the combination of Blue and White • The words 'UNO' and 'Minda' are	• The mark/label uses a colour scheme comprising the combination of Blue and White • The words 'UTO' and 'Minda' are



	written in two separate boxes with varying background colours • The word 'UNO' is written in white colour on a blue background • The word 'Minda' is written in blue colour in a white background.	written in two separate boxes with varying background colours • The word 'UTO' is written in white/ blue colour on a blue/white background • The word 'Minda' is written in blue/ white colour in a white/blue background.

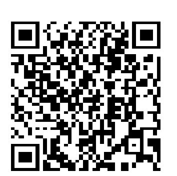
b. The impugned marks so closely resemble the registered trademarks of the Plaintiffs that it is likely to deceive and cause confusion in relation to the goods in respect of which Plaintiffs trademarks are registered. The goods sold by the Defendants, i.e., 'lubricants, industrial oils and grease' are identical to the goods sold by the Plaintiffs', i.e, engine oil. Further the goods are also similar to the other goods sold by the Plaintiffs, categorised as automobile parts, which specifically include fuel systems, fuel hoses and canisters, being allied and cognate. With the similarity in competing trademarks, identity/similarity in goods and identical trade channels and consumer base, the triple test stands satisfied and the likelihood of confusion amongst a purchaser with average intelligence and imperfect recollection, cannot be ruled out.

c. 'MINDA' is the surname of the founder of Minda Group of Companies and Chairman of the UNO MINDA and SPARK



MINDA Group of Companies and has been bonafidely adopted by the Plaintiffs. In any case, no defence under Sections 12, 30 and 35 of the Act can be claimed by the Defendants, since the trademarks of the Plaintiffs have acquired distinctiveness through continuous, extensive and uninterrputed use over the decades, giving rights to the Plaintiffs to restrain and enjoin any third party from using identical or deceptively similar marks. *Per contra* Defendants', on the other hand, have given no explanation to adopt the mark MINDA apart from a vague plea that it is a name of a village where the forefathers lived. No proof of association with the said village has been filed by the Defendants and in any case it is not open to them to contend that MINDA is a generic mark after they have themselves applied for its registration in different forms. Reliance was placed on the judgments in ***Automatic Electric Limited v. R.K. Dhawan & Anr., 1999 SCC OnLine Del 27*** and ***Anchor Health and Beauty Care Pvt. Ltd. v. Procter & Gamble Manufacturing (Tianjin) Co. Ltd. & Ors., 2014 SCC OnLine Del 2968***.

d. Contention of the Defendants that their trademark MINDA UTO is registered for goods in class 04 while Plaintiffs' trademarks are not registered with respect to goods in class 04 and therefore, no infringement is made out, is misconceived. It is a settled law that classification of goods and services adopted by the Registry or the international classification is not the determining factor for ascertaining the similarity of goods. Test



of similarity has to be judged from a business and commercial point of view and factors such as trade channels, nature of goods and use of goods ought to be considered. Reliance was placed on the judgments in ***Assam Roofing Ltd. & Anr. v. JSB Cement LLP & Anr., 2015 SCC OnLine Cal 6581*** and ***Dharampal Premchand Ltd. v. M/S. Ganpati Wood Products, 2002 SCC OnLine Del 839***. The contention that rival goods are disimilar and thus, the Plaintiffs have no case for alleging infringement under Section 29 of the Act, is equally misplaced. Section 29 (2)(b) of the Act clearly provides that a registered trademark 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 because of its similarity to the registered trademark and similarity of goods and services covered by such registered trademark is likely to cause confusion in the public or an association with the registered trademark. It is settled that similarity of goods would include a case where the impugned goods are cognate and allied to the goods of a Plaintiff, for which the trademark is registered. In the present case, there is no gainsaying that the lubricants, industrial oils and grease sold by the Defendants are allied and cognate to the goods of the Plaintiffs, which can be broadly categorised as automobile spare parts.

e. Defendants by adopting a deceptively similar trademark for identical/similar products in the course of trade are misrepresenting to the public that their goods have an

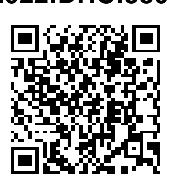
association with the Plaintiffs and are not only deceiving the customers but are also causing irreparable damage and injury to the immense reputation of the Plaintiffs and are thus guilty of passing off.

f. Defendants are operating a website under the name and style www.sparkmindalube.com and the use of the words minda/spark minda indicates a fraudulent association with the Plaintiffs. There is no credible justification for using the domain name with the mark MINDA with such a close phonetic and visual resemblance.

g. Plaintiffs' marks consist of a collection of elements such as colour, text, shape, colour combinations and constitute 'artistic work' under Section 2(c) of the Copyright Act, 1957. Plaintiffs have copyright registrations in the MINDA label as well as the formative device marks and the blatant and deliberate reproduction of the essential and prominent features of the marks by the Defendants amounts to Copyright infringement under Section 51(a)(i) of the said act.

16. I have heard learned Senior Counsel for the Plaintiffs and learned counsel for the Defendants and examined their respective contentions.

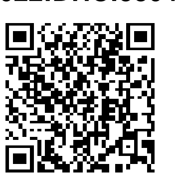
17. The controversy that needs examination in the present application relates to the impugned trademarks/labels MINDA UTO and MINDA UTO and word marks MINDA UTO/SPARK MINDA. It is an admitted position that Defendants do not have registration in the mark SPARK MINDA. A



pictorial representation showing a comparison between the two competing marks as brought forth in the plaint is as follows:-

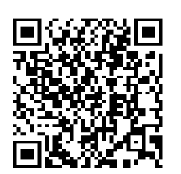
PLAINTIFFS' TRADE MARK	DEFENDANTS' TRADE MARK
SPARK MINDA	SPARK MINDA™

18. Comparing the competing marks, leads to a *prima facie* conclusion that the impugned mark is phonetically identical and structurally and visually similar to the registered trademark of the Plaintiffs. Section 28 of the Act gives to the registered proprietor of the trademark, if valid, subject to other provisions of the Act, two valuable rights: (a) the exclusive right to the use of the trademark in relation to the goods or services in respect of which the trademark is registered and (b) to obtain relief in respect of infringement of the trademark, in the manner provided by the Act. Section 29 deals with infringement of registered trademarks and provides that a registered trademark 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 on account of its identity with the registered trademark and similarity of goods or services covered by such registered trademark or its similarity to the registered trademark and identity or similarity of the goods or its identity with the registered trademark and identity of the goods, is likely to cause confusion on the part of the public or have an association with the registered trademark. In ***Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd., (2001) 5 SCC 73***, wherein the product in question was medicine, sold under the brand name Falcitab and the



competing mark was Falcigo, the Supreme Court formulated the following tests:-

> *"16. Dealing once again with medicinal products, this Court in F. Hoffmann-La Roche & Co. Ltd. v. Geoffrey Manner & Co. (P) Ltd. [(1969) 2 SCC 716] had to consider whether the word "Protovit" belonging to the appellant was similar to the word "Dropovit" of the respondent. This Court, while deciding the test to be applied, observed at pp. 720-21 as follows: (SCC para 7)*
>
> > *"The test for comparison of the two word marks were formulated by Lord Parker in Pianotist Co. Ltd.'s application [(1906) 23 RPC 774] as follows:*
> >
> > > *'You must take the two words. You must judge of them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion, that is to say, not necessarily that one man will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public which will lead to confusion in the goods — then you may refuse the registration, or rather you must refuse the registration in that case.'*
>
> *It is necessary to apply both the visual and phonetic tests. In Aristoc Ltd. v. Rysta Ltd. [62 RPC 65] the House of Lords was considering the resemblance between the two words 'Aristoc' and 'Rysta'. The view taken was that considering the way the words were pronounced in English, the one was likely to be mistaken for the other. Viscount Maugham cited the following passage of Lord Justice Lukmoore in the Court of Appeal, which passage, he said, he completely accepted as the correct exposition of the law:*

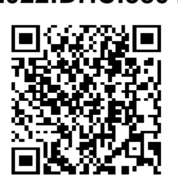


> *'The answer to the question whether the sound of one word resembles too nearly the sound of another so as to bring the former within the limits of Section 12 of the Trade Marks Act, 1938, must nearly always depend on first impression, for obviously a person who is familiar with both words will neither be deceived nor confused. It is the person who only knows the one word and has perhaps an imperfect recollection of it who is likely to be deceived or confused. Little assistance, therefore, is to be obtained from a meticulous comparison of the two words, letter by letter and syllable by syllable, pronounced with the clarity to be expected from a teacher of elocution. The Court must be careful to make allowance for imperfect recollection and the effect of careless pronunciation and speech on the part not only of the person seeking to buy under the trade description, but also of the shop assistant ministering to that person's wants.'*

It is also important that the marks must be compared as wholes. It is not right to take a portion of the word and say that because that portion of the word differs from the corresponding portion of the word in the other case there is no sufficient similarity to cause confusion. The true test is whether the totality of the proposed trade mark is such that it is likely to cause deception or confusion or mistake in the minds of persons accustomed to the existing trade mark. Thus in Lavroma case [Tokalon Ltd. v. Davidson & Co., 32 RPC 133] Lord Johnston said:

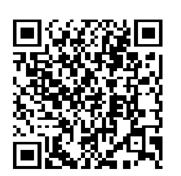
> *'... we are not bound to scan the words as we would in a question of comparatio literarum. It is not a matter for microscopic inspection, but to be taken from the general and even casual point of view of a customer walking into a shop.'*

On the facts of that case this Court came to the conclusion that taking into account all circumstances the words "Protovit" and "Dropovit" were so dissimilar that there was no reasonable probability of confusion between the words either from visual or phonetic point of view."



19. In the aforesaid case, the Supreme Court also held that principle of phonetic similarity cannot be jettisoned, even when the manner in which the competing words are written, is different. In ***Amritdhara Pharmacy v. Satya Deo Gupta, AIR 1963 SC 449***, the test of phonetic similarity was applied by the Supreme Court in judging the two competing marks 'AMRITDHARA' and 'LAKSHMANDHARA'. It would be useful to allude to paras 6 and 7 of the judgment, which are extracted hereunder:-

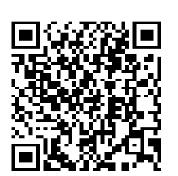
> *"6. It will be noticed that the words used in the sections and relevant for our purpose are 'likely to deceive or cause confusion'. The Act does not lay down any criteria for determining what is likely to deceive or cause confusion. Therefore, every case must depend on its own particular facts, and the value of authorities lies not so much in the actual decision as in the tests applied for determining what is likely to deceive or cause confusion. On an application to register, the Registrar or an opponent may object that the trade mark is not registrable by reason of clause (a) of Section 8, or sub-section (1) of Section 10, as in this case. In such a case the onus is on the applicant to satisfy the Registrar that the trade mark applied for is not likely to deceive or cause confusion. In cases in which the tribunal considers that there is doubt as to whether deception is likely, the application should be refused. A trade mark is likely to deceive or cause confusion by its resemblance to another already on the register if it is likely to do so in the course of its legitimate use in a market where the two marks are assumed to be in use by traders in that market. In considering the matter, all the circumstances of the case must be considered. As was observed by Parker, J. in Pianotist Co.'s Application, Re [(1906) 23 RPC 774] which was also a case of the comparison of two words—*
>
> > *'You must take the two words. You must judge them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact you must consider all the surrounding*



> *circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks.' (p. 777)*

For deceptive resemblance two important questions are: (1) who are the persons whom the resemblance must be likely to deceive or confuse, and (2) what rules of comparison are to be adopted in judging whether such resemblance exists. As to confusion, it is perhaps an appropriate description of the state of mind of a customer who, on seeing a mark thinks that it differs from the mark on goods which he has previously bought, but is doubtful whether that impression is not due to imperfect recollection.

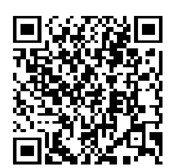
7. Let us apply these tests to the facts of the case under our consideration. It is not disputed before us that the two names "Amritdhara" and "Lakshman-dhara" are in use in respect of the same description of goods, namely a medicinal preparation for the alleviation of various ailments. Such medicinal preparation will be purchased mostly by people who instead of going to a doctor wish to purchase a medicine for the quick alleviation of their suffering, both villagers and townsfolk, literate as well as illiterate. As we said in Corn Products Refining Co. v. Skangrila Food Products Ltd. [(1960) (1) SCR 968] the question has to be approached from the point of view of a man of average intelligence and imperfect recollection. To such a man the overall structural and phonetic similarity-of the two names "Amritdhara" and "Lakshmandhara" is, in our opinion, likely to deceive or cause confusion. We must consider the overall similarity of the two composite words "Amritdhara" and "Lakshmandhara". We do not think that the learned Judges of the High Court were right in saying that no Indian would mistake one for the other. An unwary purchaser of average intelligence and imperfect recollection would not, as the High Court supposed, split the name into its component parts and consider the etymological meaning thereof or even consider the meaning of the composite words as "current of nectar" or "current of Lakshman". He would go more by the overall structural and phonetic similarity and



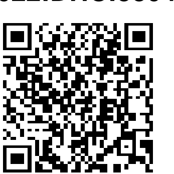
the nature of the medicine he has previously purchased, or has been told about, or about which has otherwise learnt and which he wants to purchase. Where the trade relates to goods largely sold to illiterate or badly educated persons, it is no answer to say that a person educated in the Hindi language would go by the etymological or ideological meaning and see the difference between "current of nectar" and "current of Lakshman". "Current of Lakshman" in a literal sense has no meaning; to give it meaning one must further make the inference that the "current or stream" is as pure and strong as Lakshman of the Ramayana. An ordinary Indian villager or townsman will perhaps know Lakshman, the story of the Ramayana being familiar to him; but we doubt if he would etymologise to the extent of seeing the so-called ideological difference between "Amritdhara" and "Lakshmandhara". He would go more by the similarity of the two names in the context of the widely known medicinal preparation which he wants for his ailments."

20. In ***Kaviraj Pandit Durga Dutt Sharma v. Navaratna Pharmaceutical Laboratories, AIR 1965 SC 980***, the Supreme Court held as under:-

"28. ……
……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 the 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's rights are violated. Expressed in another way, if the essential features of the trade mark of the plaintiff have been adopted by the defendant, the fact that the get-up, packing and other writing or marks on the goods or on the packets in which he offers his goods for sale show marked differences, or indicate clearly a trade origin different from that of the registered proprietor of the mark would be immaterial; whereas in the case of passing off, the defendant may escape liability if he can show that the added matter is sufficient to distinguish his goods from those of the plaintiff.



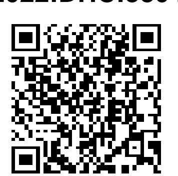
29. When once the use by the defendant of the mark which is claimed to infringe the plaintiff's mark is shown to be "in the course of trade", the question whether there has been an infringement is to be decided by comparison of the two marks. Where the two marks are identical no further questions arise; for then the infringement is made out. When the two marks are not identical, the plaintiff would have to establish that the mark used by the defendant so nearly resembles the plaintiff's registered trade mark as is likely to deceive or cause confusion and in relation to goods in respect of which it is registered (Vide Section 21). A point has sometimes been raised as to whether the words "or cause confusion" introduce any element which is not already covered by the words "likely to deceive" and it has sometimes been answered by saying that it is merely an extension of the earlier test and does not add very materially to the concept indicated by the earlier words "likely to deceive". But this apart, as the question arises in an action for infringement the onus would be on the plaintiff to establish that the trade mark used by the defendant in the course of trade in the goods in respect of which his mark is registered, is deceptively similar. This has necessarily to be ascertained by a comparison of the two marks — the degree of resemblance which is necessary to exist to cause deception not being capable of definition by laying down objective standards. The persons who would be deceived are, of course, the purchasers of the goods and it is the likelihood of their being deceived that is the subject of consideration. The resemblance may be phonetic, visual or in the basic idea represented by the plaintiff's mark. The purpose of the comparison is for determining whether the essential features of the plaintiff's trade mark are to be found in that used by the defendant. The identification of the essential features of the mark is in essence a question of fact and depends on the judgment of the Court based on the evidence led before it as regards the usage of the trade. It should, however, be borne in mind that the object of the enquiry in ultimate analysis is whether the mark used by the defendant as a whole is deceptively similar to that of the registered mark of the plaintiff."



21. It bears repetition to state that there is phonetic identity in the trademark of the Plaintiffs, i.e., SPARK MINDA and that of the Defendants, i.e., SPARK MINDA™, which is an important index, apart from structural and visual similarity. Plaintiffs have demonstrated the steady growth and rise in their business and the immense reputation and goodwill they have acquired over a decade from 2011, when the mark is stated to have been coined, adopted and registered. The user date as reflected from the Registration Certificate dates back to the year 2011 and since then there has been continuous, extensive and uninterrputed use of the trademark, which has acquired distinctiveness.

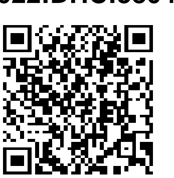
22. Examining the three eventualities contemplated under Section 29(2) of the Act, the second question that needs examination at this stage is whether the goods of the Plaintiffs and the Defendants have an identity/ similarity so as to cause a likelihood of confusion or association, thereby infringing Plaintiffs' Trademark MINDA under Section 29(2).

23. The SPARK MINDA Group under the device mark SPARK MINDA are selling various automobile parts such as Brakeless Handle, Brake Shoes, Clutch Plates, sensors, dashboards, Innovative Technology and IOT Solutions, Electronic and Mechnical Security Systems, wiper blades, dye-casting, starter motors etc. falling in classes 07, 09, 11 and 42, with respect to which the device mark is registered. Defendants, on the other hand, are engaged in the business of lubricants, industrial oils and grease, which fall in class 04. The goods of the respective parties are not identical and hence, the next question that arises is whether they are similar or allied and cognate.



24. This Court in ***FDC Limited v. Docsuggest Healthcare Services Pvt. Ltd. & Anr., 2017 SCC OnLine Del 6381***, delved into the issue of what are allied and cognate goods and carved out parameters which are required to be examined while determining whether the rival goods are allied and cognate, *viz.* (a) respective uses of goods, (b) intended purpose, (c) respective users, (d) physical nature of goods, (e) sector, (f) trade channels, and (g) reputation. The defintions of allied/cognate goods or services, as noted by the Court in para 51, are as follows:

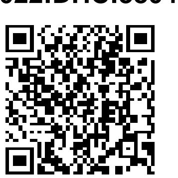
> *"51…….*
> *……Allied/cognate goods or services, as understood from the material referred to below, are those goods/services which are not identical, but can be said to be related or similar in nature (See McCarthy on Trademarks and Unfair Competition, Fourth Edition, Vol 5). The Shorter Oxford English Dictionary on Historical Principles Fifth Edition 2002, Vol. 1. defines the term "Allied" as "connected by nature or qualities; having affinity" and the term "Cognate" as "akin in origin, nature or quality". Reference may also be made to New Webster's Dictionary and Thesaurus of the English Language, 1992 which defines "Allied" as "relating in subject or kind" and "Cognate" as "1. adj. having a common ancestor or origin (of languages or words) having a common source or root (of subjects etc.) related, naturally grouped together.". Cognate goods/services can be described, inter alia, as goods or services which have a trade connection - as in glucose and biscuits (See Corn Products Refining Co. v. Shangrila Food Products Ltd., AIR 1960 SC 142) or which are intended for the same class of customers - as in television picture tubes (parts thereof, video tapes and cassettes and television tuners etc.) and televisions, tuners and T.V. Kits (See Prakash Industries Ltd. v. Rajan Enterprises (1994) 14 PTC 31), or are complementary to each other - as in toothbrushes and toothpaste (See HM Sariya v. Ajanta India Ltd. (2006) 33 PTC 4)."*



25. Reliance was placed by the Court on the judgment in ***British Sugar Plc. v. James Robertson & Sons Ltd., [1996] R.P.C. 281 at 294-297***, where the Court laid down the tests for similarity of description of goods/services, as follow:-

> *"(a) The uses of the respective goods or services;*
>
> *(b) The users of the respective goods or services;*
>
> *(c) The physical nature of the goods or acts of service;*
>
> *(d) The trade channels through which the goods or services reach the market;*
>
> *(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves; and*
>
> *(f) The extent to which the respective goods and services are in competition with each other : that inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put goods or services in the same or different sectors."*

26. In ***Assam Roofing Ltd. (supra)***, the Calcutta High Court observed that the test of similarity of goods is to be looked at from a business and commercial point of view and the nature and composition of goods, respective uses and the trade channels through which they are bought and sold would go into consideration in this context. In Kerly 15th Ed., para 9-065, it is stated that the element of distinctive character of a trademark and its reputation is also viewed when determining similarity between the goods and services and whether such similarity is enough to give rise to a likelihood of confusion.

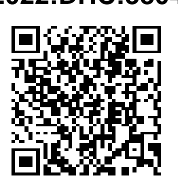


27. In ***Re Pianotist Co.'s Application, (1906) 23 RPC 774, Parker, J.,*** in the context of comparison of two words in the trademarks observed as under:-

> *"You must take the two words. You must judge them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks."*

28. Testing on the anvil of these parameters, in my *prima facie* view, the goods of the Defendants, manufactured and sold under the impugned trademark SPARK MINDA™ are allied and cognate, as they relate to the same sector i.e. automobiles. Lubricants, industrial oils and grease, which are the goods of the Defendants and the automobile parts, which are the goods of the Plaintiffs are used in vehicles and are invariable sold in the same shops. Therefore, the consumer base is the same and the trade channels are identical and there is likelihood of confusion and/or association that the goods of the Defendants are those of the Plaintiffs'. This Court is thus of *prima facie* opinion that the rival goods being similar in nature and the competing trademark being identical/similar, a *prima facie* case of infringement under Section 29(2)(b) of the Act is made out.

29. In this context, I may also refer to the judgment of this Court in ***Ceat Tyres of India Ltd. v. Jai Industrial Services, 1990 SCC OnLine Del 360***, which comes closest to the facts of the present case and where the Court held that fan belts and 'V' belts sold by the Defendants and the tyres sold by the Plaintiff are cognate or allied inasmuch as both are used in

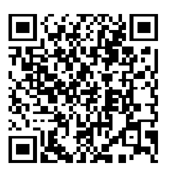


vehicles. In ***Dharam Pal Satya Pal v. Janta Sales Corporation, 1990 SCC OnLine Del 104,*** Plaintiff was manufacturing and selling chewing tobacco under the trademark 'RAJNI', while the Defendant was marketing Pan Masala under the same trademark. Relying on several judgments, the Court found that both class of goods were sold from the same shops and held the goods to be 'cognate and allied'. An injunction was granted by the Court on the basis of the nature of goods, identical trade channels and same consumer base.

30. In ***Thomas Bear and Sons (India) v. Prayag Narain, AIR 1935 All 7,*** the Court held as under:-

> *"The rule deducible from the foregoing cases appears to be that the plaintiffs, whose goods have acquired a reputation in the market through a trade mark or name with which their goods have become associated, have a right to restrain the defendant from using, a trade mark or name which is identical with or similar to that of the plaintiffs, and such right extends not only to the particular goods sold by the plaintiffs, but also to cognate classes of goods, provided the cumulative effect of the similarity of the mark, of the commercial connection between the plaintiffs' goods and those of the defendant, and surrounding circumstances is such as to lead the unwary customers to mistake the defendant's goods for those of the plaintiffs.……"*

31. From the screenshots of the websites of the Defendants, it is evident that the Defendants are using the domain name www.sparkmindalube.com which includes the words 'sparkminda' and there is every likelihood of confusion and/or association with the Plaintiffs and, therefore, the use of the domain name also requires to be injuncted. Screenshots of the website are as under:-



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- Highly Professional Staff, Accurate Testing Processes
- Unrivalled workmanship, Professional and Qualified

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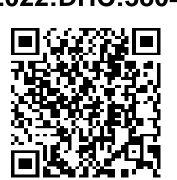
32. Plaintiffs have also alleged that Defendants are passing off their goods as that of the Plaintiffs in order to encash on their formidable and enormous goodwill and reputation. In ***Kaviraj Pandit Durga Dutt Sharma (supra),*** it



was held that an action for passing off is a common law remedy, being an action for deceit. In ***Cadila Health Care Ltd. (supra)***, the Supreme Court *albeit* in the case of the passing off predicated on an un-registered trademark, laid down factors for deciding the question of deceptive similarity which are as follows:-

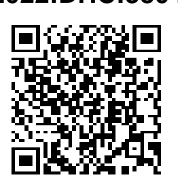
> *"35……..*
>
> *(a) The nature of the marks i.e. whether the marks are word marks or label marks or composite marks i.e. both words and label works.*
>
> *(b) The degree of resembleness between the marks, phonetically similar and hence similar in idea.*
>
> *(c) The nature of the goods in respect of 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."*

33. In ***Erven Warnink BV v. J. Townend & Sons, (1979) 2 All ER 927***, Lord Diplock laid down five elements/ingredients of the tort of passing off *viz.* (1) a misrepresentation, (2) made by a trader in the course of trade, (3) to prospective customers of his or ultimate consumers of goods or services supplied by him, (4) which is calculated to injure the business or goodwill of another trader (in the sense that this is a reasonably foreseeable

consequence), and (5) which causes actual damage to a business or goodwill of the trader by whom the action is brought or (in a *quia timet* action) will probably do so.

34. In ***FDC Limited vs. Faraway Foods Pvt. Ltd., 2021 SCC OnLine Del 1539***, culling out the principles that emerged from the various judicial precedents on the common law rights in passing off, the Court observed that in order to claim passing off, Plaintiff is required to establish misrepresentation by the Defendant, likelihood of confusion in the minds of the public that the goods of the Defendant are those of the Plaintiff, applying the test of a person of average intelligence and imperfect recollection, reputation and goodwill of the Plaintiff and likelihood of loss. While examining the likelihood of confusion, the Court would take into consideration factors such as nature of the market, class of customers, extent of reputation of the Plaintiff, trade channels, trade connection, in conjunction. It is indisputable that passing off is an action predicated on the goodwill, unlike infringement, which is based on a proprietary right conferred by registration of the trademark. It is an action of deceit by the Defendant and gives the common law right to the Plaintiff to protect its goodwill in business against misrepresentation caused in the trade by the Defendant and is based on the principle that no person can be permitted to carry on his or her business on the pretext that it is the business of another.

35. In the present case, defence of the Defendants is premised on the nature of their goods, i.e., lubricants, industrial oils and grease which are claimed to be dissimilar to the goods of the Plaintiffs and on this basis, it is contended that no action for passing off lies. In my view, this contention is completely misconceived and is in the teeth of several judgments of this



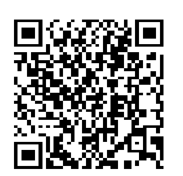
Court, holding to the contrary. In ***Mahendra & Mahendra Paper Mills Ltd. v. Mahindra & Mahindra Ltd., (2002) 2 SCC 147***, the primordial submission of the Appellant was that in the absence of any similarity of goods manufactured or sold by the parties the question of deception or confusion amongst the consumers did not arise. The Supreme Court, rejecting the said contention held that the Plaintiff had acquired immense reputation and the name had become distinctive of the Plaintiff and thus any attempt by any other person to use the name in business and trade circles is likely to create an impression or a connection with the Plaintiff's Group of Companies and would prejudicially effect the business and trading activities of the Plaintiff. In ***Kamal Trading Co. Bombay and Ors. v. Gillettee U.K. Limited, Middle Sex, England, 1987 SCC OnLine Bom 754***, a Division Bench of the Bombay High Court held as follows:

> *"9. Relying on this observation; Mr. Desai submitted that the plaintiffs have not established any of the conditions required for grant of interim relief. It was submitted that the goods manufactured by the plaintiffs and the defendants are different nature; the plaintiffs manufacture blades, while the defendants manufacture "tooth brushes". The goods of the plaintiffs and the defendants are available in the same shop and the customers of these goods are different. The goods sold by the plaintiffs are blades and fall in Class 8, while those of the defendants are tooth brushes which fall in class 21. Relying on these circumstances, it is contended that there was no likelihood of any deception. We are unable to see any merit in this submission. In the first instance, the assumption of the learned counsel that the class of customers for purchase of safety blades and tooth brushes are different and these goods are not available in the same shops is wholly misconceived. We take judicial notice of the fact that these goods are available in every shop including a small shop and each and every person is required to purchase these goods. The safety blades and tooth brushes are items of daily requirement and*

> *are required by every person. It is impossible to accept the submission that as the goods being different and as goods are set out in different Classes in the Schedule to the Act, there is not any likelihood of customer being deceived."*

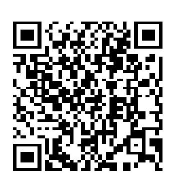
36. In ***Bajaj Electricals Ltd. v. Metals and Allied Products, Bombay and Anr., AIR 1988 Bom 167***, the primary contention of the Defendants was that the goods manufactured by the Plaintiffs and the Defendants were totally different and therefore the use of word 'BAJAJ' would not cause confusion. Be it noted that the Plaintiffs were manufacturing electrical goods and appliances under Class 11, whereas Defendants were manufacturing utensils under Class 21. Holding that Defendants had intentionally and dishonestly tried to pass off their goods by use of the name 'BAJAJ', the Court observed as under:-

> *"**8.** Mr. Tulzapurkar submitted that it is not really necessary to consider different judgments of the House of Lords because Lord Denning had also observed that the defendants would have no defence if the user of the name of the defendants is likely to deceive irrespective of the fact whether the user was honest and that conclusion of Lord Denning is also approved by Lord Devlin who was in minority. Mr. Tulzapurkar submitted that in the present case, there is a specific evidence on record that the word "Bajaj" was used by the defendants dishonestly and deliberately with a view to take advantage of the reputation earned by the plaintiffs. The learned counsel referred to us to a passage at p. 408 in Kerly's Law of Trade Marks and Trade Names, Twelfth Edition, and submitted that once intent to deceive is established, then the defendants could not claim that they were entitled to use word "Bajaj" as a trading sign. In support of the submission, the learned counsel invited our attention to the brochure (Ex. 'G' annexed to the plaint) wherein the defendants have claimed that Bajaj quality is well accepted and appreciated internationally. Mr. Tulzapurkar points out and it is not in dispute that the defendants have never marketed their goods abroad, nor have*



they even claimed that their goods are sold all over the country. Mr. Tulzapurkar is right and we agree with the learned trial Judge that the brochure published in the year 1987 is issued with a view to cause deception or confusion in the mind of the customers. The word 'Bajaj' has quite a great reputation in the country and abroad and the publication of the brochure in year 1987 clearly indicates that the defendants were not honest in the use of the word "Bajaj" and an attempt was made to pass off their goods with the mark "Bajaj" with the intention to secure advantage of the reputation earned by the plaintiffs.

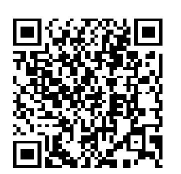
The submission of Mr. Tulzapurkar was controverted by Mr. Cooper by urging that the goods manufactured by the plaintiffs and the defendants are totally different and, therefore, there is no cause or apprehension that the use of the word "Bajaj" is likely to cause deception or confusion in the mind of the public. Mr. Cooper submitted that the articles manufactured by the defendants are utensils and those marketed by the plaintiffs are electrical goods or appliances and, therefore, it is unlikely that the purchasers of utensils would be confused by the use of the word "Bajaj" on the articles of the defendants. The learned counsel submitted that the plaintiffs' goods are sold under registered mark under Class 11, while the goods manufactured by the defendants fall under Class 21. Class 11 refers to installations for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, and other purposes, while Class 21 refers to small domestic utensils and containers (not of precious metal nor coated therewith). The submission of Mr. Cooper is that as the articles manufactured by the plaintiffs and the defendants are different, the question of deception would not arise. It is not possible to accept the submission. ***The articles manufactured by the plaintiffs and the defendants are kitchen wares and are commonly used in almost every kitchen in this country. The mere fact that the articles manufactured by the contesting parties are different in nature is no answer to the claim that the defendants are guilty of passing off. We entirely agree with the conclusion recorded by the learned trial Judge that there is identity of the goods, the mark and***



> ***the consumer and the goods manufactures by both the plaintiffs and the defendants are sold under one shop. Mr. Cooper complained that the electric goods manufactured by the plaintiffs and the stainless steel utensils manufactured by the defendants are not sold in one shop. The submission is not accurate because it is common experience that kitchen ware or kitchen appliances like mixers, grinders, pressure cookers, and stainless steel utensils are sold in the same shop. At this interim stage, we are not prepared to accept the submission of Mr. Cooper on this count and we see no reason to take different view from that of the learned single Judge on this aspect. In our judgment, prima facie, it is clear that the defendants have intentionally and dishonestly tried to pass off their goods by use of name "Bajaj".*"**
>
> *(Emphasis supplied)*

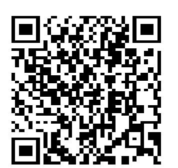
37. From a conspectus of the aforesaid judgments, it is clear that an action for passing off can lie even with respect to dissimilar goods, the other parameters being met. In any event, this defence is even otherwise not available to the Defendants, as their goods are not dissimilar, but are allied and cognate, i.e., similar and thus, the position adopted by the Defendants that passing off action is not maintainable, cannot be accepted. In this context, it would be useful to allude to a judgment of the Bombay High Court in ***H.M. Saraiya and Ors. v. Ajanta India Ltd. and Ors., 2006 SCC OnLine Bom 1394***, where the Court held as under:-

> *"**72.** Insofar as the question of totally distinct goods and biscuits are concerned, it appears that there is a much expansion of law so as to hold that there is no requirement of common field of activity in a passing off action. The judgments which have been relied upon by the learned counsel for the plaintiffs being Kirloskar Diesel Recon Pvt. Ltd. v. Kirloskar Proprietary Ltd., (supra) and Aktiebolaget Volvo v. Volvo Steels Ltd. (supra) supports the aforesaid contention. In my opinion, it is not doubt true that for the purposes of passing off action in respect of totally dissimilar business or in respect of*

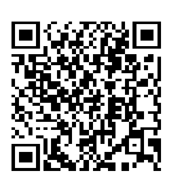


goods which are poles aparts only if it can establish that plaintiffs have acquired such a reputation in a particular name or a brand that the user by the other person even in respect of distinct product would amount to passing off his business and his good will as that of the other person. So as to be entitled to such reliefs the reputation of the brand should have acquired a Global status or super brand status and the business of the plaintiffs must be trans border or trans products. However, that does not mean that in relation of cognate or allied product the plaintiff is not entitled to interim injunction as contended by the learned counsel for the defendants. It is equally not a correct proposition of law advanced by the learned counsel for the defendants that in respect of the allied product or cognate product or supplementary product the plaintiffs must actually prove confusion and/or produce evidence that in market there is an actual confusion and merely likelihood of confusion is not counsel for the plaintiffs indicate that even if there is a likelihood of a confusion by virtue of the fact that the goods are so closely similar and/or are allied products or supplementary that there is a likelihood of confusion in the mind of the public that a person is using the similar brand name merely to pass off his goods as that of the plaintiffs is itself sufficient for the purpose of grant of interim order and injunction in a passing off action.

73. *Even in my judgment in the case of Indiacom Limited v. Tata Teleservices Ltd. dated 28.10.2005 (Notice of Motion No. 1837 of 2003 in Suit No. 1908 of 2003) I have held that in light of series of judgments of this Court a proposition of law is now well settled that the plaintiff is entitled to an injunction on the basis of cognate product and/or allied product and/or complemantary products if the goods are so closely similar to that of the goods of the plaintiffs so as to lead to a likelihood of confusion in market that the goods sold by the defendants in fact belong to the plaintiffs. The learned counsel for the plaintiffs has relied upon two judgments of the Apex Court though arising out of Sales Tax Act in which it is inter alia held that the word "toiletry" includes both tooth paste and tooth brush. In my opinion, tooth paste and tooth brush are undoubtedly complementary products and/or allied*

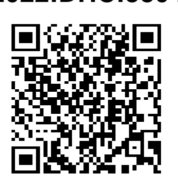


product the use of each other is together and in my opinion dependent on each other. In such a situation it is easily likely to create confusion in the minds of the public that the goods belonging to one party in fact belongs to the other party. I am inclined to accept the contention of the learned counsel for the plaintiffs that they are selling tooth brushes in the market since 1950 would obviously make the people believe that 'Ajanta' tooth paste which has been introduced by the defendants is the product belonging to the plaintiffs and thus there is a likelihood of confusion in the market. I am, therefore, of the opinion that the contention of the learned counsel for the defendants that the said goods even if they are complementary or cognate should not be itself be sufficient enough to grant interim injunction in respect of passing off action on the ground that the plaintiffs have not established actual confusion in the market in respect of the said product is liable to be rejected. I am also of the view that the judgment of the Apex Court in the case of Corn Products *(supra) supports the aforesaid view I have taken that the goods being cognate or allied products by virtue of trade connection or trade relation would be sufficient enough to create a confusion in the mind of the people in the market and, therefore, it is necessary that the injunction should be granted to the plaintiffs insofar as the said product of the defendants being tooth paste is concerned under the brand name 'Ajanta'. In my opinion, once the law is well settled that in respect of the allied product or cognate product the injunction can be granted and further in my opinion that tooth paste and tooth brush being allied and/or cognate products, it is not necessary to make any further enquiry in the matter and the necessary interim order ought to be granted to the plaintiffs herein. However, the learned counsel for the defendants has contended that there is a distinct get up of the box and has tried to bring a distinction in the packet of two products which are sold in the market under the same brand 'Ajanta' and has, therefore, contended that the 'get up' being different, there is no likelihood of any confusion and, therefore, this Court should not grant any interim injunction. I have also compared both the said packets and its get ups. Firstly, 'word mark' is identical.*



> *Secondly phonetically also both the marks are the same. The colour scheme of both the packets is almost identical. Merely because on the defendants tooth paste there is an emblem 'Dento Fresh' and on the tooth brush packet of the plaintiffs there is a photograph of mother and son would not be sufficient enough to create a distinctiveness between the two products so as to hold that there is no likelihood of any confusion in the market. In my opinion, there is no much distinction between 'get up' of the plaintiffs packets and that of the defendants packet look is substantially identical, the word characters are also identical and, therefore, in my opinion the plaintiffs are entitled to injunction of 'passing off' on the ground that the defendants are seeking to pass off their goods as that belonging to the plaintiffs."*

38. Nonetheless, in order to succeed in an action for passing off at this stage, Plaintiffs have to make out a *prima facie* case of goodwill and reputation, which the Defendants are allegedly encashing and deceiving the consumers into buying their goods believing the same to be originating from the Plaintiffs. It is the case of the Plaintiffs, as averred and argued, that they are a part of the MINDA Group of Companies which is a conglomerate comprising several companies, manufacturing diverse auto components for Indian and International Original Equipment Manufacturers. Founded in the year 1958 by late Shri Shadi Lal Minda, Plaintiffs' businesses under the flagship name MINDA have grown multi-fold over the years and it has emerged as one of the largest automotive components' conglomerate. As of 31.03.2021, the annual turnover of the Plaintiffs' group of companies is Rs. 8,741 crores with the goods and services spread over more than seven countries apart from India. It has more than 104 plants globally and 25 R&D centres across India with 40 group companies and 15 global technology partners. It has expended huge sums of money on its promotional activities



which is to the tune of Rs.12.27 crores in the year 2021 alone. The sales turnover for the year 2021 as certified by the Chartered Accountant is Rs.5989.44 crores. Plaintiffs have a number of honours and accolades to their credit, the recent ones being ICSI's prestigious 6th Annual National CSR Award in 2021 and 'Golden Peacock Award for Excellence in Corporate Governance' for the year 2020, besides 26 other awards and honours, details of which are furnished in the plaint. MINDA Group of Companies, is globally known for its quality of products and on account of its formidable goodwill and reputation. Group has several reputed clients, both in India as well as internationally, such as BMW, Ford, Honda, Toyota, Ashok Leyland, Escorts, Bajaj, Hero, Mahindra, TATA etc. None of these facts were traversed by the learned counsel for the Defendants during the course of arguments and even in the written statement there is only a vague and bold denial of the averments and nothing is pleaded to the contrary.

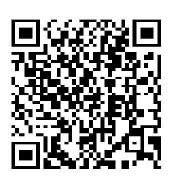
39. From the averments as aforementioned, which are duly supported by documents filed along with the plaint, I am of the *prima facie* view that the Plaintiffs enjoy immense reputation and goodwill in India and in fact, this explains the reason why the Defendants chose to dishonestly adopt the trademark SPARK MINDA, which is phonetically identical and visually deceptively similar to that of the Plaintiffs. It is clear that the Defendants intended to encash upon the reputation and goodwill of the Plaintiffs by misrepresenting to the members of the public that the goods of the Defendants have an association with that of the Plaintiffs and/or emanate from the house of the MINDA Group of Companies. Therefore, Plaintiffs have made out a *prima facie* case of passing off against the Defendants in respect of the goods sold under the impugned mark SPARK MINDA and

have been able to establish that the nature of marks, nature of goods and class of purchasers are similar and that on account of the high degree of resemblance between the marks there exists a likelihood of confusion.

40. I may now examine the claim of the Plaintiffs with respect to infringement by the Defendants of their registered trademarks MINDA (word/device) and UNO MINDA. Defendants have contested the claim on the ground that Defendants are registered proprietors of the trademark MINDA UTO which is registered since 03.07.2018 in class 04, for lubricants, industrial oils and grease, with a user claim from 01.06.2018 and therefore, no action can lie for infringement. The defence is predicated on the provisions of Section 28(3) of the Act. It is also the contention of the Defendants that the Plaintiffs are not registered for the said goods in class 04 and have a registration in separate classes for separate class of goods and registration cannot travel across classes and in any case, in these circumstances, there cannot be any association or confusion, which is one of the pre-requisites for infringement under Section 29(2) of the Act.

41. It is indisputable that Plaintiffs and Defendants hold valid and subsisting registrations in their respective trademarks, registered in different Classes. The issue with regard to the rights of one registered proprietor of a trademark against another registered proprietor of an identical with or nearly resembling each other, is no longer *res integra.* Interpreting Section 28(3) of the Act, the Supreme Court in ***S. Syed Mohideen v. P. Sulochana Bai, (2016) 2 SCC 683***, held as under:-

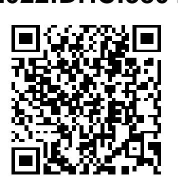
> *"27. Sub-section (3) of Section 28 with which we are directly concerned, contemplates a situation where two or more persons are registered proprietors of the trade marks which are identical with or nearly resemble each other. It, thus,*



postulates a situation where same or similar trade mark can be registered in favour of more than one person. On a plain stand-alone reading of this Section, it is clear that the exclusive right to use of any of those trade marks shall not be deemed to have been acquired by one registrant as against other registered owner of the trade mark (though at the same time they have the same rights as against third person). Thus, between the two persons who are the registered owners of the trade marks, there is no exclusive right to use the said trade mark against each other, which means this provision gives concurrent right to both the persons to use the registered trade mark in their favour. Otherwise also, it is a matter of common sense that the plaintiff cannot say that its registered trade mark is infringed when the defendant is also enjoying registration in the trade mark and such registration gives the defendant as well right to use the same, as provided in Section 28(1) of the Act."

42. The legal position that obtains with respect to the rights of a registered proprietor as against another registered proprietor in respect of a claim for infringement was elaborately dealt with and explained by this Court in ***A. Kumar Milk Foods Pvt. Ltd. v. Vikas Tyagi & Anr., 2013 SCC OnLine Del 3439,*** wherein Plaintiff's trademark SHRIDHAR was registered under class 29 in respect of ghee, oils, dairy products and allied and other related goods while Defendants' trademark SHREEDHAR was registered under class 30 in respect of atta, maida and besan and thus apparently the registrations were not in the same classes of goods. The Court held as follows:-

"28. Section 28(3) of the TM Act cannot be interpreted in a manner that would be contrary to the above scheme of the Act and Rules. In other words Section 28(3) of the TM Act should be understood as not permitting an infringement action being brought by one registered proprietor against another only where two conditions are satisfied : one, that the two

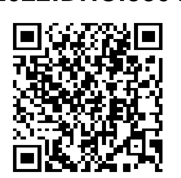


registered marks "are identical with or nearly resemble each other"; and two, they are in respect of the same class of goods and services. This will be in conformity with the object of Section 28(1) read with Section 29 of the TM Act which seeks to grant protection to the registered proprietor of a mark from infringement in respect of the goods for which registration is granted."

43. Reliance in the aforesaid case was placed by the Court on an earlier judgment of this Court in ***Rana Steels v. Ran India Steels Pvt. Ltd., 2008 SCC OnLine Del 399,*** which is evident from para 26. Relevant paras of the judgment in ***A. Kumar Milk Foods Pvt. Ltd. (Supra)*** are extracted hereunder for ready reference:-

"26. The facts of the present case are closer to the facts in Rana Steels v. Ran India Steels Pvt. Ltd., 2008 (102) DRJ 503. The dispute there concerned the use of the Plaintiff's trademark, RANA, registered under Class 6, by the Defendant who had a registered trademark, RANA TOR, under Class 19. While allowing the Plaintiff's prayer for confirmation of an earlier ex parte injunction granted against the Defendant, the Court explained the scope Section 28 of the Act, in para 23, as follows:

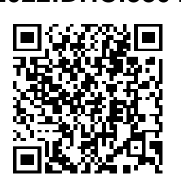
"... Section 28 deals with the rights conferred by registration. And, it has already been clarified that the use of a registered mark must be in relation to the goods or services in respect of which the trade mark is registered. It follows that where the goods or services, in respect of which two or more identical or similar (nearly resemble) marks are registered, are different then Section 30(2)(e) does not come into play. The question of infringement would, itself, not arise as the registered marks would be used in respect of different classes of goods or services by their respective proprietors. A couple of examples would further clarify the position:



Example 1 : Assume that a trade mark "M" has been registered in favor of Mr "X" as well as in favor of Mr "Y" in relation to the same goods or services. In such a situation, by virtue of Section 28(3), neither Mr "X" nor Mr "Y" can claim exclusivity against each other for the use of the said mark in relation to the goods or services for which it was registered. If Mr "X" were to bring an action for infringement against Mr "Y", the latter would have a complete defense under Section 30(2)(e).

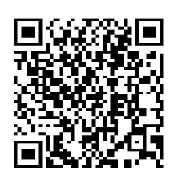
Example 2 : Let us now assume that there are two different goods "A" and "B" in respect of which the same trademark "M" has been registered in favor of different persons "X" and "Y", respectively. Here, although the same mark "M" is registered in favor of both Mr "X" and Mr "Y", Mr "X" has exclusive right to use the same in respect of good "A" and Mr "Y" has exclusive right to use the said mark in respect of good "B". Therefore, Section 28(3) is not attracted. Moreover, if Mr "X" were to bring an action of infringement against Mr "Y" alleging that Mr "Y" was using the said mark "M" in relation to good "A", then, the defense of Section 30(2)(e) would not be available to Mr "Y" as he does not have any right to use the mark "M" in relation to good "A", his registration being in relation to good "B".

27. The case on hand is covered on all fours by Example 2 above. Indeed the legislative intent was to extend the protection of the registered mark against infringement in respect of the goods for which the registration was granted. A reading of Section 7 of the TM Act, which provides for classification of goods and services, with Rule 22 of the Trade Marks Rules, 2002 which provides that for the purposes of registration of trademarks, goods and services shall be classified in the manner specified in the Fourth Schedule, shows that registration of trademarks is meant to be for goods or services that have been specified in the Fourth Schedule under different 'Classes'. This explains the rationale behind indicating the particular class of goods for which the registration has been granted."



44. Having interpreted Section 28(3) of the Act, the Court observed that the Plaintiff was seeking to protect its own trademark SHRIDHAR registered in class 29 from infringement, by restraining Defendants from using SHREEDHAR for goods in class 29 and not for goods for which Defendants hold registration, i.e., class 30 goods. In ***Rana Steels (Supra)*** Plaintiff had registration of the trademark RANA registered in respect of goods falling under class 06, i.e., steel rolled products, angles, channels, guarders, etc. and Defendant was a registered proprietor of the mark RANA TOR in respect to building material (steels) falling under Class 19. On the strength of Section 28(3) and 30(2)(e) of the Act, Defendant claimed that it had not infringed Plaintiff's registered trademark. The Court in this context observed as under:-

> *"**21.** A reading of the relevant provisions of Sections 28 and 29 of the said Act, therefore, reveals that the registration of a trade mark is linked to the goods or services in respect of which the trade mark is registered. If a person uses a registered trade mark in relation to goods and services which are different and distinct from the goods or services in respect of which the trade mark is registered, then he would not be infringing the registered trade mark except in the case covered by Sub-Section (4) of Section 29 which requires that the registered trade mark must have a reputation in India and the use of the mark without due cause would be amounting to taking unfair advantage of or would be detrimental to the distinctive character or repute of the registered trade mark.*
>
> *xxx xxx xxx*
>
> ***24.** At this point, it would be appropriate to refer to Section 7 of the said Act which provides for classification of goods and services. Sub-Section (1) stipulates that the Registrar shall classify the goods and services, as far as may be, in accordance with the international classification of goods and services for the purposes of registration of trade marks. Rule*



22 of the Trade Marks Rules, 2002 provides that for the purposes of registration of trade marks, goods and services shall be classified in the manner specified in the Fourth Schedule. Clearly, registration of trademarks is in relation to specified goods or services. Goods and services have been classified. It is obvious that, prima facie, goods falling under one class would be different from goods falling under another class. Ordinarily, when registration of a trade mark is granted under one class of goods, it does not cover goods of another class.

***25.** The plaintiff is the registered proprietor of the mark RANA w.e.f. 14.12.1994 in relation to "steel rolled products, CTD bars, angles, flats, rounds, channels and girders" falling under class 61 of the Fourth Schedule to the Trade Marks Rules, 2002. The defendant does not have a registered trade mark in respect of goods falling under class 6 of the said schedule. However, as things stand today2, the defendant is the registetred proprietor of the mark "RANATOR" w.e.f. 26.04.2001 in respect of "Buliding materials (steels)" falling under class 193. Whether the registration is liable to be cancelled, as alleged by the plaintiff, or not, as contended by the defendant, is not a matter for consideration before this court. For the present, in view of section 31 of the said Act, the registration of the trade mark is prima facie evidence of its validity. So, considering the defendant's registration to be valid, for the time being, it must be kept in mind that the mark RANATOR is registered in class 19 and not class 6. The plaintiff has brought this suit claiming its exclusive right to the use of the trade mark RANA in relation to "steel rolled products, CTD bars, angles, flats, rounds, channels and girders" falling under class 6 of the Fourth Schedule to the Trade Marks Rules, 2002. The defendant, admittedly, does not have any registration in class 6 (its registration being under class 19). Therefore, the situation which presents itself in the case at hand is similar to the situation explained in Example 2 above. Consequently, neither is section 28(3) attracted nor can the defendant take refuge under section 30(2)(e).*

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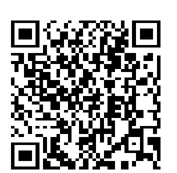


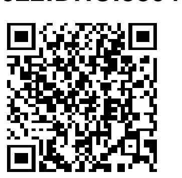
> ***28.*** *....... The plaintiff has a valid registration in relation to steel rolled products, CTD bars, angles, flats, rounds, channels and girders falling under class 6. The defendant has a registration under class 19 but not in relation to steel rolled products, CTD bars, angles, flats, rounds, channels and girders falling under class 6. It is obvious, that it is the plaintiff's statutory right which requires protection and not the defendant's improper use of the mark RANA TOR in relation to steel rolled products, CTD bars, angles, flats, rounds, channels and girders falling under class 6. The balance of convenience is clearly in favour of the plaintiff and against the defendant. Furthermore, in an infringement action, when the plaintiff has demonstrated that it has a prima facie case and also that the balance of convenience lies in its favour, not granting an interim injunction restraining the defendant from further infringing the plaintiff's registered trade mark would result in causing irreparable injury to the plaintiff."*

45. Returning to the facts of the present case and examining them in the light of the aforesaid judgments, this Court comes to a *prima facie* conclusion that Plaintiffs cannot seek a restraint against the Defendants from using their registered trademark MINDA UTO in respect of the goods for which they are registered under class 04, i.e., lubricants, industrial oils and grease, for the reason that Plaintiffs do not have registration for the said goods under class 04, while Defendants are registered for these goods. Whether the registration is liable to be cancelled or not is not a matter for consideration before this Court and for the present, in view of Section 31 of the Act, registration of the trademark is *prima facie* evidence of its validity in favour of the Defendants. Plaintiffs have filed the present suit claiming exclusive use over the registered trademark UNO MINDA, in respect of goods registered in various classes including classes 07 and 12, but in the absence of registration with respect to the impugned goods under

class 04 an action of infringement, in my *prima facie* view will not lie and the Defendants have a complete defence to infringement and the Plaintiffs cannot take refuge under their registration.

46. Having so held with respect to the claim for infringement, the next conundrum that needs to be resolved is with respect to the allegation of the Plaintiffs that the Defendants are passing off their goods under the impugned mark MINDA UTO. Before resolving the conundrum, it would be useful to refer to the judgment in ***S. Syed Mohideen (Supra),*** a reading of which shows the settled position of law that a suit for passing off would lie against the Defendants, despite the registration of their trademark, the essential ingredients of passing off being made out. Relevant paras are as follows:-

> ***"28.*** *However, what is stated above is the reflection of Section 28 of the Act when that provision is seen and examined without reference to the other provisions of the Act. It is stated at the cost of repetition that as per this Section owner of registered trade mark cannot sue for infringement of his registered trade mark if the appellant also has the trade mark which is registered. Having said so, a very important question arises for consideration at this stage, namely, whether such a respondent can bring an action against the appellant for passing off invoking the provisions of Section 27(2) of the Act. In other words, what would be the interplay of Section 27(2) and Section 28(3) of the Act is the issue that arises for consideration in the instant case. As already noticed above, the trial court as well as the High Court have granted the injunction in favour of the respondent on the basis of prior user as well as on the ground that the trade mark of the appellant, even if it is registered, would cause deception in the mind of the public at large and the appellant is trying to encash upon, exploit and ride upon on the goodwill of the respondent herein. Therefore, the issue to be determined is as to whether in such a scenario, the provisions of Section 27(2)*



would still be available even when the appellant is having registration of the trade mark of which he is using.

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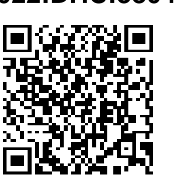
***30. Firstly,** the answer to this proposition can be seen by carefully looking at the provisions of the Trade Marks Act, 1999 (the Act). Collective reading of the provisions especially Sections 27, 28, 29 and 34 of the Trade Marks Act, 1999 would show that the rights conferred by registration are subject to the rights of the prior user of the trade mark. We have already reproduced Section 27 and Section 29 of the Act.*

***30.1.** From the reading of Section 27(2) of the Act, it is clear that the right of action of any person for passing off the goods/services of another person and remedies thereof are not affected by the provisions of the Act. Thus, the rights in passing off are emanating from the common law and not from the provisions of the Act and they are independent from the rights conferred by the Act. This is evident from the reading of the opening words of Section 27(2) which are "Nothing in this Act shall be deemed to affect rights…."*

***30.2.** Likewise, the registration of the mark shall give exclusive rights to the use of the trade mark subject to the other provisions of this Act. Thus, the rights granted by the registration in the form of exclusivity are not absolute but are subject to the provisions of the Act.*

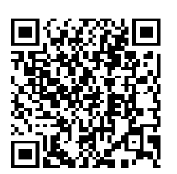
***30.3.** Section 28(3) of the Act provides that the rights of two registered proprietors of identical or nearly resembling trade marks shall not be enforced against each other. However, they shall be same against the third parties. Section 28(3) merely provides that there shall be no rights of one registered proprietor vis-à-vis another but only for the purpose of registration. The said provision 28(3) nowhere comments about the rights of passing off which shall remain unaffected due to overriding effect of Section 27(2) of the Act and thus the rights emanating from the common law shall remain undisturbed by the enactment of Section 28(3) which clearly*



states that the rights of one registered proprietor shall not be enforced against the another person."

47. The Supreme Court gave an additional reason as to why passing off rights are superior to the registration rights and relevant would it be to refer to the following paragraphs in this regard:-

> ***"31. Secondly****, there are other additional reasonings as to why the passing off rights are considered to be superior than that of registration rights.*
>
> ***31.1.*** *Traditionally, passing off in common law is considered to be a right for protection of goodwill in the business against misrepresentation caused in the course of trade and for prevention of resultant damage on account of the said misrepresentation. The three ingredients of passing off are goodwill, misrepresentation and damage. These ingredients are considered to be classical trinity under the law of passing off as per the speech of Lord Oliver laid down in Reckitt & Colman Products Ltd. v. Borden Inc. [Reckitt & Colman Products Ltd. v. Borden Inc., (1990) 1 WLR 491 : (1990) 1 All ER 873 (HL)] which is more popularly known as "Jif Lemon" case wherein Lord Oliver reduced the five guidelines laid out by Lord Diplock in Erven Warnink Besloten Vennootschap v. J. Townend & Sons (Hull) Ltd. [Erven Warnink Besloten Vennootschap v. J. Townend & Sons (Hull) Ltd., 1979 AC 731 at p. 742 : (1979) 3 WLR 68 : (1979) 2 All ER 927 (HL)] ("the Advocaat case") to three elements : (1) goodwill owned by a trader, (2) misrepresentation, and (3) damage to goodwill. Thus, the passing off action is essentially an action in deceit where the common law rule is that no person is entitled to carry on his or her business on pretext that the said business is of that of another. This Court has given its imprimatur to the above principle in Laxmikant V. Patel v. Chetanbhai Shah [Laxmikant V. Patel v. Chetanbhai Shah, (2002) 3 SCC 65].*
>
> ***31.2.*** *The applicability of the said principle can be seen as to which proprietor has generated the goodwill by way of use of the mark/name in the business. The use of the mark/carrying*



on business under the name confers the rights in favour of the person and generates goodwill in the market. Accordingly, the latter user of the mark/name or in the business cannot misrepresent his business as that of business of the prior right holder. That is the reason why essentially the prior user is considered to be superior than that of any other rights. Consequently, the examination of rights in common law which are based on goodwill, misrepresentation and damage are independent to that of registered rights. The mere fact that both prior user and subsequent user are registered proprietors are irrelevant for the purposes of examining who generated the goodwill first in the market and whether the latter user is causing misrepresentation in the course of trade and damaging the goodwill and reputation of the prior right holder/former user. That is the additional reasoning that the statutory rights must pave the way for common law rights of passing off.

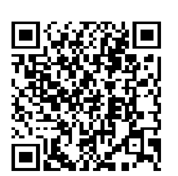
32. Thirdly*, it is also recognised principle in common law jurisdiction that passing off right is broader remedy than that of infringement. This is due to the reason that the passing off doctrine operates on the general principle that no person is entitled to represent his or her business as business of other person. The said action in deceit is maintainable for diverse reasons other than that of registered rights which are allocated rights under the Act. The authorities of other common law jurisdictions like England more specifically Kerly's Law of Trade Marks and Trade Names, 14th Edn., Thomson, Sweet & Maxwell South Asian Edition recognises the principle that where trade mark action fails, passing off action may still succeed on the same evidence. This has been explained by the learned author by observing the following:*

> *"15-033. A claimant may fail to make out a case of infringement of a trade mark for various reasons and may yet show that by imitating the mark claimed as a trade mark, or otherwise, the defendant has done what is calculated to pass off his goods as those of the claimant. A claim in 'passing off' has generally been added as a second string to actions for infringement, and has on*

occasion succeeded where the claim for infringement has failed.""

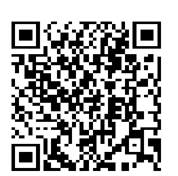
48. The above legal position was reiterated by the Supreme Court in ***Toyota Jidosha Kabushiki Kaisha v. Prius Auto Industries Limited and Others, (2018) 2 SCC 1*** and is thus: an action for passing of could lie despite Section 28(3) of the Act against use of a registered trademark, the *raison d'être* being that the use of a mark confers rights in the person on account of generation of goodwill in the market and a third party cannot misrepresent its business and encash upon the said goodwill and reputation.

49. What remains to be examined is whether the Plaintiffs have made out a *prima facie* case to demonstrate that the action of the Defendants tantamounts to passing off. The ingredients of an action of passing off, as held in various judgments, have been brought out in the earlier part of the judgment and are not being repeated for the sake of brevity. Applying the principles for determination whether passing off is made out, it is an indisputable position that Plaintiffs are the prior user of the trademarks MINDA and UNO MINDA, since the use of the trademark MINDA (word *per se*) commenced in the year 1962 and for the device mark from the year 2001. User date of the label UNO MINDA is 01.12.2011. *Per contra,* as per the case set up by the Defendants, user of the impugned mark commenced from the year 2018 for goods registered under class 04. As averred in the plaint, the UNO MINDA Group is one of the India's leading manufacturers of automotive components and some of the products manufactured are alternate fuel systems, air filtration systems, brake and fuel hoses, alloy wheels, air brakes, fuel caps, air ducts and washer bottles, wheel covers, sensors, horns, etc. The product range expands across all vehicles, i.e., 2, 3



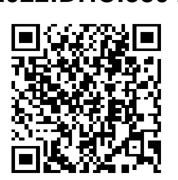
and 4 wheelers. The details with respect to the annual turnover of the Plaintiff's Group of Companies, the goods and services provided in over 7 countries, the manufacturing plants, promotional expenses, etc. have been referred to above. Compared and contrasted with this is the admitted position, going by the averments in the written statement that Defendants have commenced use of their trademark only in 2018 and the total sales of Defendant No. 3 has increased to Rs. 4,84,02,415/- in the year 2021-22 out of which sale of products under the trademark MINDA UTO has increased to Rs.72,60,362/- in the year 2021-22. From the said narrative, it is manifest that Plaintiffs have made out a *prima facie* case of substantial goodwill and reputation in the market and are prior users of the trademarks MINDA and UNO MINDA.

50. Having *prima facie* established formidable reputation and goodwill, Plaintiffs would require to show that the two competing marks are either identical or deceptively similar. It cannot be disputed that Plaintiffs' trademarks and the impugned mark of the Defendants are not identical. In order to determine whether they are deceptively similar, this Court would rely on the principles formulated by the Supreme Court in ***Cadila Health Care Ltd. (Supra)***, as aforementioned. In order to avoid prolixity and burden this judgment with several judgments on the aspect of 'deceptive similarity', I may only allude to judgment in ***FDC Limited v. Faraway Foods Pvt. Ltd., 2021 SCC OnLine Del 1539***, where this Court has culled out the principles premised on judicial precedents. The principles that emerged to the extend relevant to this case are: (a) class of customers who would purchase the product; (b) the look/appearance and sound of the trademarks as well as the nature of goods including surrounding circumstances; (c) confusion refers to



the state of mind of a customer who, on seeing the mark, thinks that it differs from the mark on the goods which he had previously bought, but is doubtful whether that impression is not due to imperfect recollection and the question is thus one of first impression; (d) the test is from the point of a person of average intelligence and imperfect recollection to see how a purchaser would react to the trademark, the association which he would form and how he would connect the trademarks with goods he is likely to purchase; (e) the resemblance may be phonetic, visual or in idea; (f) the whole word/mark is to be considered as an ordinary man would not split a word or name into its components and would go by overall structural and phonetic similarity of the mark; and (g) the Court is required to examine whether the essential features of the Plaintiff's mark are to be found in the Defendant's mark. ***Amritdhara Pharmacy (supra), Kaviraj Pandit Durga Dutt Sharma*** and ***Cadila Health Care Ltd. (Supra)***, [Ref.].

51. Tested on these principles it is to be seen whether the essential features of Plaintiffs' trademarks have been adopted by the Defendants. In this regard it would be useful to refer to the case of ***Ruston & Hornsby Ltd. v. The Zamindara Engineering Co., (1969) 2 SCC 727,*** where the Court found that there was deceptive resemblance between the words RUSTON and the mark RUSTAM and negated the contention that the word INDIA added to Respondent's trademark RUSTAM was of any consequence, *albeit* in the context of infringement. In ***Laxmikant V. Patel v. Chetanbhai Shah and Another, (2002) 3 SCC 65*** the Supreme Court held that it is the word 'Muktajivan' which makes distinctive the business name of the Plaintiff, i.e., 'Muktajivan Colour Lab' and addition of the prefix QSS as an adjective could not be a defence by the Defendant against passing off.

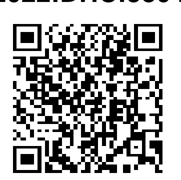


52. Two cases which in my view are closest in facts to the present case are ***Greaves Cotton Limited v. Mr. Mohammad Rafi & Ors., 2011 SCC OnLine Del 2596*** and ***Prem Ratan Rathi & Ors. v. Ashish Iron Trading Co. & Anr., 2013 SCC OnLine Del 3649***. In ***Greaves Cotton (Supra)*** the mark 'GREAVES' was the essential and prominent feature of Plaintiff's trade name, corporate name and business style and the trademark GREAVES was the surname of the founder of Plaintiff's predecessor. The Supreme Court observed that by using the words 'GREAVES INDIA' Defendant No. 1 had lifted and adopted and whole of the registered trademark of the Plaintiff and mere use of the word 'INDIA' would make no difference, since the word GREAVES was the essential and main component of the trademark 'GREAVES INDIA'. Use of the word INDIA as a suffix and not as a prefix is also strong indicator that the Defendant wanted to encash upon the popularity, goodwill and reputation of the word GREAVES though even if it was used as prefix, it would be infringing. It was also observed that GREAVES is not a dictionary word and comes from the surname of the founder of the Plaintiff and neither deletion of a part of a registered trademark nor addition of a prefix or suffix to it would validate the use by an unlicensed user. On this basis, not only infringement but the issue of passing off was decided in favour of the Plaintiff. In ***Prem Ratan Rathi (supra)***, Plaintiff was using the trademark 'RATHI' and the Defendants had adopted an identical trademark by adding a prefix GOLDEN. Plaintiff succeeded in its action for infringement and passing off, despite the Defendants' defence that word RATHI is a common word derived from the name of a village and that the mark is distinguishable by the prefix 'GOLDEN'. Reference may also be made to a judgment in ***B.K.***

Engineering v. U.B.H.I. Enterprises (Regd.) Ludhiana, AIR 1985 Del. 210, where this Court faced with rival trademarks B.K. and B.K.-81, observed that the Defendants' addition of '81' to Plaintiff's mark was a mere garnishing, though even the altered name is likely to mislead. The Defendants' product will deceive people into thinking that their goods are those of the Plaintiffs. Essence of the law of passing off is competition between traders and if Defendants are not injuncted there will a real risk of injury to the reputation of the Plaintiffs.

53. I may usefully allude to para 33 of the judgment in ***Prem Ratan Rathi (supra),*** as the same analogy would apply to the present case. In the present case Plaintiffs are selling their products under the trademark MINDA with various prefixes such as SPARK MINDA and UNO MINDA. The word MINDA forms an essential part of Plaintiffs' trademarks and Defendants *prima facie* cannot claim any right to use the said mark with or without suffixes or prefixes, as that is likely to cause confusion amongst the purchasers. Para 33 is as follows:-

> *"33. The defendant no. 2 in its written statement claims that the word RATHI is a common word and that the name was adopted by them because the great grandfather of the promoter/director of the defendant no. 2 was a resident of Rathi Vas village in Haryana. However no evidence has been placed on record to prove the said contention. Further, applying the ratio in the Greaves Cotton Case (supra), the defendants' use of the word 'GOLDEN' before the mark of the plaintiff 'RATHI' does not entitle them to use the impugned mark. The plaintiff's mark 'RATHI' is the essential part of their registered trademark and has been in use since the year 1980 as proved in Issues No. 1 and 2. Further, it is also seen from the newspaper clippings of the advertisements of the plaintiff's products placed on record, that they sell the products under the trademark 'RATHI' along with suffixes like*



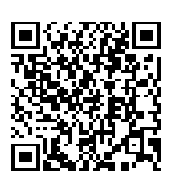
'TOR' and 'THERMEX', thus bearing the marks 'RATHI TOR' and 'RATHI THERMEX'. Furthermore, it is stated by defendant no. 2 in its written statement that the plaintiffs are also selling their products under the names 'RATHI EUROTEM' and 'RATHI PRAGATI'. Therefore it is clear to me that the word 'RATHI' forms an essential part of the plaintiff's trademark and thus, the defendants do not have the right to use the said word with any suffixes or prefixes. Issue No. 7 is decided in favour of the plaintiff."

54. Another crucial question arises in the present case as to why the Defendants chose the word MINDA as a part of their trademark *albeit* with a suffix UTO. The subtle explanation rendered by the Defendants is that MINDA is a common surname in the country and UNO and SPARK are common English words and that MINDA is the name of a village in Rajasthan, where the forefathers of the Defendants (not specified who) lived. Suffice would it be to state that there is no material on record to substantiate the said plea, contrasted to the stand of the Plaintiffs and *prima facie* shown to be correct, as to the origin of their trademark. The explanation of the Defendants, in my view, in choosing the impugned trademark is implausible, farfetched and wholly unconvincing and is designed to encash upon the pronounced and prominent reputation of the Plaintiffs. In view of this, in my *prima facie* view there is deceptive similarity in the rival trademarks as well as dishonest adoption by the Defendants. It is interesting to note the contention of the Plaintiffs that while the registration of the Defendants in class 04 with respect to the trademark MINDA UTO is 'MINDAUTO', i.e., as a single word, Defendants have been using the same as two words 'MINDA UTO'. The intent behind separating the two words is perhaps with a view to lay more emphasis on the word MINDA, so as to encash on the formidable reputation and enormous

goodwill of the Plaintiffs and is in my *prima facie* view malicious and mischievous.

55. The next issue is whether the goods of the parties to the *lis* are similar/identical. Defendants have defended the case predicated on dissimilarity of goods, which in my *prima facie* view is not a sustainable defence. The contention is negated by the observations of the Allahabad High Court in ***Bata India Limited v. Pyare Lal & Co., 1985 SCC OnLine All 79***, which are as follows:-

> *"**21.** Where a trader uses the name or the mark or sign deceptively similar to that of the second trader in relation to goods marketed by the former even though it may not be the same goods or the same type of goods as produced by the second trader, yet a question of passing off may arise. The main consideration will be whether there is a misrepresentation.*
>
> ***22.** If there is a prima facie case of misrepresentation made by the defendants in the course of trade to prospective customers and which is likely to cause injury to the business and the goodwill of the plaintiff-company, he would be entitled to the protection by a Court when a suit of this nature may take years to be decided. In the meantime, the defendants may go on using deceptively similar mark in trade and marketing their goods representing or giving an impression as if the said goods are produced by the plaintiff-company. An injunction to restrain the defendants in such a case would be justified. After all a person long established in business, who has been using a particular mark in this product or products for a long number of years is entitled to protect the same against inroad of another proprietor or producer. This is necessary not only to give protection to the goods and the business of the original producer but also to protect the public at large being duped by such unfair trade practice.*
>
> *xxx xxx xxx*



28. The respondents, however, urged that it was necessary for a passing off action that there was some resemblance in the nature of goods produced by the two traders. In other words, the claim of the plaintiff did not give rise to a cause of action, for the plaintiff did not produce foam. Foam was not one of the products manufactured or marketed by the plaintiff-company. Consequently, there was no question of any injury being suffered by the plaintiff-company........

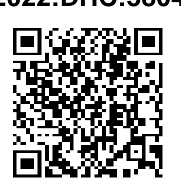
xxx xxx xxx

***36.** Great emphasis was laid by the learned counsel for the respondents on the underlined portion to say that there should be some similarity or correlationship between the two products. This argument is supplemented by another argument that the plaintiff was not producing any goods like foam or analogous product. Consequently, there was no question of any deception being practised on the purchaser of foam materials in the market. This argument loses sight of an important feature viz., how would a lay customer know in the first place that the plaintiff was not producing foam or foam material? How would the customers know that Bata were not producing foam? It is well known that the name represented makers of shoes and analogous products, but a question would also arise in the mind of the lay customers whether Bata were also producing foam. Who is going to answer this question? Does an ordinary customer ask the seller as to whose product it is? The answer generally is in the negative. He buys a thing on the basis of his own impression."*

56. In ***Ellora Industries v. Banarsi Dass Goela & Others, AIR 1980 Delhi 254,*** this Court held as follows:-

*"**41.** In the case of Ellora Industries v. Banarsi Dass, AIR 1980 Delhi 254, it was held by a learned single Judge (at p. 258):—*

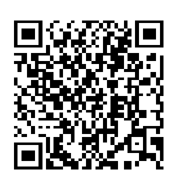
"Confusing customers as to source, as in this case, is an invasion of another's property rights. The unfairness arises from the fact that the purchasing public are likely to be misled. The protection is afforded not for the deceived



> *customer but the rival trader. It is to prevent "dishonest trading", to use a phrase of Danckwerts J. (J. Bollinger v. Costa Brava Wine Co. Ltd., 1961 RPC 116). The Australian Court in Henderson's case (1969 RPC 219) recognised a form of wrongful appropriation of a "trade value". Evatt, C.J. and Myer, J. said:*
>
> > *"The wrongful appropriation of another's professional or business reputation is an injury in itself.""*

57. In ***Reddaway v. Banham, 1896 AC 199,*** one of the question was whether manufacturing the same product was essential for an injunction in a passing off action and the answer was:- '*now it is not always necessary that there must be in existence goods of that other man with which the Defendant seeks to confuse his own*'. As Lord Greene M.R. said:- '*passing off may occur in cases where the Plaintiff do not in fact deal in the offending goods*'. Therefore, similarity in goods is not *sine qua non* in the action by the Plaintiff for passing off. As the action is founded on misrepresentation and deceit to give an impression to the purchaser that the offending goods are the goods of the Plaintiff, where the latter has immense goodwill and reputation in the market.

58. Be it noted that this contention cannot be accepted for an additional reason that in the present case the offending goods are lubricants, industrial oils and grease which are allied and cognate to the goods of the Plaintiffs sold under the trademark UNO MINDA. It is a matter of common knowledge that automobile spare parts, lubricants and grease are sold from the same shops and therefore, the trade channels are identical and the consumer base is the same. This Court draws strength from the judgment of the Bombay High Court in ***H.M. Saraiya and Ors. (Supra)***, where the

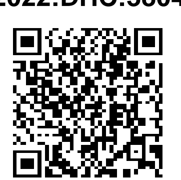


alternate contention of the Plaintiffs was that even if it is held by the Court that Plaintiffs have accrued no reputation in their brand 'Ajanta' in respect of their goods, i.e., toothpaste still once the reputation is established in the allied product, i.e., toothbrush, Plaintiffs are entitled to injunction on the principle that Defendant cannot sell a cognate or allied product and should be injuncted in a passing off action. Relying on the judgment of the Supreme Court in ***Corn Products Refining Co. v. Shangrila Food Products Ltd., (1960) 1 SCR 968*** the Bombay High Court observed as follows:-

> *"58. In the present case we are not concerned with the super brand status or universal status of any brand because it is not even the case of the plaintiffs that their brand has acquired any such super status so as to entitle the plaintiffs to protect their transborder and trans product reputation. The case of the plaintiffs is that the goods relating to the same field and/or in any event a cognate and allied products aforesaid are so similar products that it is likely to result in confusion in the minds of public. In my opinion, the principle of cognate and allied product is very much in existence and has been well recognised both by the learned author Kerly in the aforesaid paras as well as various judgments which are cited before me by the plaintiffs. In the case of Corn Products Refining Co. (supra), the Apex Court was dealing with the brand name 'Glucovita' glucouse vita in respect of glucose powder mixed with vitamin and other product being glucose biscuits. The Apex Court as far back as in 1960 held that even though the goods are different but by virtue of fact that glucose powder is used in manufacture of biscuits and, therefore, the person is entitled to injunction though the goods are not identical."*

59. In case of ***Prakash Industries Ltd. v. Rajan Enterprises, 1993 SCC OnLine Del 522,*** this Court observed as under:-

> *"**34.** ....The plaintiff whose goods have acquired a reputation in the market through a trade mark or name with which the goods have become associated has a right to restrain the defendant from using the trade mark br name*



which is identical with or similar to that of the plaintiff and such right extends not only to the particular goods sold by the plaintiff but also to cognate classes of goods provided the cummulative effect of the similarity of the mark, the commercial connection between the plaintiffs goods and those of the defendant's goods and surrounding circumstances is such as to lead the unwary customers to mistake the defendant's goods for those of the plaintiff."

60. Plaintiffs have thus made out a *prima facie* case of passing off against the Defendants. The tests laid down in the judgments aforementioned are met as the Plaintiffs have prima facie established that the nature of marks, nature of goods, class of purchasers, high degree of resemblance between the mark and misrepresentation coupled with likelihood of confusion.

61. For all the aforesaid reasons, the *ex-parte* order of injunction dated 20.01.2022 passed by this Court is hereby confirmed. Needless to state that the observations in the present judgment are only tentative and *prima facie* and shall not affect the final adjudication of the suit.

62. Accordingly, I.A. 1134/2022 (under Order 39 Rules 1 & 2 CPC) filed by the Plaintiffs is allowed and I.A. 6456/2022 (under Order 39 Rule 4 CPC) filed by the Defendants is dismissed, in the aforesaid terms.

JYOTI SINGH, J

SEPTEMBER 20, 2022/*rk/shivam*