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

+ **FAO (COMM) 24/2024**

KRBL LIMITED

.....Appellant

Through: Mr. Anirudh Bakhru, Mr. SK Bansal, Mr. Deepak Shrivastava and Mr. Vijay C Rathi, Advs.

versus

PRAVEEN KUMAR BUYYANI & ORS.

.....Respondents

Through:

CORAM:

HON'BLE MR. JUSTICE C. HARI SHANKAR

HON'BLE MR. JUSTICE AJAY DIGPAUL

JUDGMENT(ORAL)

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15.01.2025

C.HARI SHANKAR, J.

[Statutory provisions have been reproduced in the footnotes to the extent relevant.]

1. Learned Counsel who appears on behalf of the respondents submits that his client is not in touch with him. He seeks discharge, which is allowed.

2. Notice was issued in this matter as far back as on 12 February 2024. On 23 August 2024, this Court had directed that this matter be listed for final hearing in the category of final hearing matters. Thereafter, the matter has been listed twice. The respondents is the



beneficiary of the order under challenge in this appeal, whereby the *ad interim* injunction granted to the appellant-plaintiff by his predecessor has been vacated by the learned District Judge (Commercial Court)¹. Given the nature of the order which is under challenge and the fact that this case has been listed on several earlier occasions, we are not inclined to adjourn the matter awaiting the convenience of the respondents.

3. In our view, the impugned order is patently illegal and cannot sustain.

Facts

4. The facts are brief.

5. The appellant was the registered owner of the trademark INDIA GATE, of which it has been using the mark since 1993 for rice. The respondents also started dealing with rice under the name BHARAT GATE.

6. In these circumstances, the appellant approached the learned Commercial Court by way of CS (Comm) 284/2020², seeking a permanent and mandatory injunction against the respondents using the name BHARAT GATE, apart from attendant reliefs, submitting that it amounted to infringement of the appellant's registered trademark

¹ "the learned Commercial Court" hereinafter

² **KRBL Ltd v Praveen Kumar Buyyani**



“INDIA GATE” within the meaning of Section 29³ of the Trade Marks Act, 1999 as well as an attempt by the respondents to pass off its product as the product of the appellant. The plaint was accompanied by an application under Order XXXIX Rules 1 and 2 of the Code of Civil Procedure, 1908⁴, seeking interlocutory injunction restraining the respondents, pending disposal of the suit, from using the mark BHARAT GATE for rice or any allied or cognate products.

7. Photographic reproductions of the packs of the appellant and respondents, depicting the rival marks, may be provided thus:

³ 29. **Infringement of registered trade marks. –**

(1) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which is identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark.

(2) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which because of—

- (a) its identity with the registered trade mark and the similarity of the goods or services covered by such registered trade mark; or
- (b) its similarity to the registered trade mark and the identity or similarity of the goods or services covered by such registered trade mark; or
- (c) its identity with the registered trade mark and the identity of the goods or services covered by such registered trade mark,

is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trade mark.

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

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

(6) For the purposes of this section, a person uses a registered mark, if, in particular, he—

- (a) affixes it to goods or the packaging thereof;
- (b) offers or exposes goods for sale, puts them on the market, or stocks them for those purposes under the registered trade mark, or offers or supplies services under the registered trade mark;
- (c) imports or exports goods under the mark; or
- (d) uses the registered trade mark on business papers or in advertising.

(7) A registered trade mark is infringed by a person who applies such registered trade mark to a material intended to be used for labelling or packaging goods, as a business paper, or for advertising goods or services, provided such person, when he applied the mark, knew or had reason to believe that the application of the mark was not duly authorised by the proprietor or a licensee.

⁴ “CPC”



Appellant's pack	Respondent's pack
	

8. On 9 October 2020, the learned Commercial Court granted an *ex parte ad interim* injunction in favour of the appellant and against the respondents, restraining the respondents from using the trademark BHARAT GATE in respect of rice or any other associated or allied product.

9. The impugned order dated 9 January 2024 finally adjudicates the application filed by the appellant under Order XXXIX Rules 1 and 2 of the CPC seeking interlocutory injunction against the respondents. By the impugned order, the learned Commercial Court has vacated the *ad interim* injunction granted by the Predecessor on 9 October 2020 and has dismissed the Order XXXIX application filed by the appellant.

10. Before the learned Commercial Court, the respondents sought to contend that there was no phonetic or visual similarity between the marks INDIA GATE or BHARAT GATE and also that the appellant



could not claim a monopoly over the words INDIA GATE which were words of common usage. The appellant, on the other hand, placed reliance on the judgments of the Supreme Court in *Renaissance Hotel Holdings Inc v B Vijaya Sai*⁵, *Amritdhara Pharmacy v Satyadeo Gupta*⁶ and *Kaviraj Pandit Durgadutt Sharma v Navaratna Pharmaceutical Laboratories*⁷ as well as the judgments of this Court in *South India Beverages Pvt Ltd v General Mills Marketing Inc*⁸, *Amar Singh Chawalwala v Vardhman Rice*⁹ and *Shree Nath Heritage Liquor Pvt Ltd v Allied Blender & Distillers Pvt Ltd*¹⁰.

The impugned order

11. The learned Commercial Court holds, in the impugned order, that there is no phonetic similarity between BHARAT GATE and “INDIA GATE”. Besides, the impugned order holds that as the two marks were distinct in packaging, colour and design with blue and green colours predominating the appellant’s mark and red predominating the respondent’s mark, which had a different design, there was no chance or likelihood of confusion.

12. On the aspect of confusion, the learned Commercial Court further holds that the Constitution of India recognises “India that is Bharat” in its preamble. The learned Commercial Court has opined that mere registration of the name INDIA GATE in favour of the

⁵ (2022) 5 SCC 1

⁶ 1962 SCC OnLine SC 13

⁷ 1964 SCC OnLine SC 14

⁸ 2014 SCC OnLine Del 1953

⁹ 2009 SCC OnLine Del 1690

¹⁰ 2015 SCC OnLine Del 10164



appellant could not preclude all other citizens of this country from using any other name of this country including BHARAT. The word GATE, it has been further held, is *publici juris*, over which no one could claim monopoly.

13. Addressing the submission of the appellant that the image of the India Gate was present on the packings of the appellant as well as of the respondents, the learned Commercial Court has held that India Gate is a national monument, and not the personal property of anyone. He further holds that it is only when a person takes note of the rival marks with great concentration that their similarity would become apparent.

14. The learned Commercial Court has further held that the appellant's and the respondent's product do not cater to the same commercial segment, as the appellant deals with high quality rice, which caters to its own consumers who would not, even by mistake, purchase the respondent's products.

15. In view of these findings, the learned Commercial Court has vacated the *ad interim* injunction granted by his Predecessor and has dismissed the appellant's application under Order XXXIX Rules 1 and 2 of the CPC.

Contentions and Analysis

16. A brief preliminary digression



16.1 Mr. Bakhru, learned Counsel for the appellant has drawn our attention to an observation in the impugned order which, we are constrained to observe, is not very happily worded. It reads as under:

“Reliance has also been placed on *The Timken Company v Timken Services Private Ltd*¹¹ and *KRBL Ltd v Ramesh Bansal and Anr.*¹² However, these two citations are of no use and avail to the Plaintiff as both the orders were passed by Hon'ble High Court of Delhi while dealing as the Court of first instance due to pecuniary jurisdiction and hence would not constitute a binding precedent on this Court.”

16.2 We are constrained to observe that the learned Commercial Court ought not to have held that judgments passed by this Court were not binding on him merely because they were passed as a Court of first instance, owing to the pecuniary jurisdiction vested in this Court. It is axiomatic that all decisions passed by this Court, in whatever capacity, are binding on the District Courts. This is fundamental to our judicial hierarchical structure and is part of the basic structure of our Constitutional scheme. It cannot lie in the mouth of any Court to even suggest that an order or judgment passed by a hierarchically superior Court is not binding on it.

16.3 We are sanguine this clarification would disabuse the learned Commercial Court of the apparent misconception harboured by it regarding the binding nature of orders passed by this Court.

17. We are of the opinion, as we have already noted, that the

¹¹ IA No. 21/2010 in CS(OS) no. 3/2010 order dated 30/5/2013 (J. J. R. Midha)

¹² 2009 (41) PTC 114 Del (Reva Kehtrapal J)



impugned judgment proceeds on fundamentally erroneous premises.

18. We are aware of the note of caution sounded by the Supreme Court in *Wander Ltd v Antox (India) Pvt Ltd*¹³, relating to the scope of appreciation of orders passed by courts below while exercising discretionary jurisdiction under Order XXXIX of the CPC. The relevant paras may be reproduced as under:

“14. The appeals before the Division Bench were against the exercise of discretion by the Single Judge. In such appeals, the appellate court will not interfere with the exercise of discretion of the court of first instance and substitute its own discretion *except where the discretion has been shown to have been exercised arbitrarily, or capriciously or perversely or where the court had ignored the settled principles of law regulating grant or refusal of interlocutory injunctions*. An appeal against exercise of discretion is said to be an appeal on principle. Appellate court will not reassess the material and seek to reach a conclusion different from the one reached by the court below if the one reached by that court was reasonably possible on the material. The appellate court would normally not be justified in interfering with the exercise of discretion under appeal solely on the ground that if it had considered the matter at the trial stage it would have come to a contrary conclusion. *If the discretion has been exercised by the trial court reasonably and in a judicial manner the fact that the appellate court would have taken a different view may not justify interference with the trial court's exercise of discretion*. After referring to these principles Gajendragadkar, J. in *Printers (Mysore) Private Ltd. v Pothan Joseph*¹⁴:

“... These principles are well established, but as has been observed by Viscount Simon in *Charles Osenton & Co. v Jhanaton*¹⁵ ‘...the law as to the reversal by a court of appeal of an order made by a judge below in the exercise of his discretion is well established, and any difficulty that arises is due only to the application of well settled principles in an individual case’.”

¹³ 1990 Supp SCC 727

¹⁴ AIR 1960 SC 1156

¹⁵ 1942 AC 130



15. The appellate judgment does not seem to defer to this principle.”

19. While this Court always believes in circumspection while dealing with orders passed by courts below in exercise of its jurisdiction under Order XXXIX, that does not mean that an order which is passed on fundamentally erroneous premises can be allowed to sustain. For the reasons which would become apparent hereinafter, the impugned judgement of the learned Commercial Court, we are convinced, eminently falls within the limited categories of cases in which the appellate Court can, and in fact, should, interfere, even as per para 14 of *Wander*.

20. The impugned judgement proceeds on several erroneous principles.

21. Deceptive similarity

21.1 The first finding of the learned Commercial Court is that there is no phonetic similarity between BHARAT GATE and INDIA GATE. No reason, for this finding, is forthcoming in the impugned order.

21.2 The finding is clearly erroneous.

21.3 Certain basic principles of infringement assessment do not seem to have been factored, by the learned Commercial Court, into consideration.



21.4 It is settled – indeed, practically axiomatically by now – that the possibility of likelihood of confusion, for the purpose of trade mark infringement, has to be assessed from the perspective of a customer of average intelligence and imperfect recollection.¹⁶

21.5 “Likelihood of confusion”, by a consumer of average intelligence and imperfect recollection, is all that is needed. “Confusion”, again, need not extrapolate, in every case, to the consumer mistaking one mark for the other. It is enough – as Section 29(4) itself clarifies – if the similarity between the marks conveys an impression of “association” between them, to the mind of such a consumer. Again, all that is needed is “initial interest confusion”¹⁷, *without placing the marks side by side*. In other words, if, on seeing the defendant’s mark some time after the first, the consumer of average intelligence and imperfect recollection is likely to pause, even if for the fraction of a minute, and ponder as to whether it was not the same, or at was not associated with, the plaintiff’s mark which he had seen earlier, the tort of infringement stands, *ipso facto*, committed by the defendant. The following passage from Kerly’s Law of Trade Marks and Trade Names, 9th Edn, was approvingly cited by the Supreme Court, in *Parle Products (P) Ltd v J.P. & Co.*¹⁸:

“Two marks, when placed side by side, may exhibit many and various differences, *yet the main idea left on the mind by both*

¹⁶ Refer *Amritdhara Pharmacy*, AIR 1963 SC 449, *Cadila Health Care v Cadila Pharmaceuticals*, (2001) 5 SCC 73, *Satyam Infoway Ltd v Sifynet Solutions (P) Ltd*, (2004) 6 SCC 145, *Mahendra & Mahendra Paper Mills Ltd v Mahindra & Mahindra Ltd*, (2002) 2 SCC 147

¹⁷ *Google LLC v DRS Logistics (P) Ltd*, 305 (2023) DLT 506 (DB), *Shree Nath Heritage Liquor Pvt Ltd v Allied Blender & Distillers Pvt Ltd*, 221 (2015) DLT 359 (DB)

¹⁸ (1972) 1 SCC 618



may be the same. A person acquainted with one mark, and not having the two side by side for comparison, might well be deceived, if the goods were allowed to be impressed with the second mark, into a belief that he was dealing with goods which bore the same mark as that with which he was acquainted. Thus, for example, a mark may represent a game of football; another mark may show players in a different dress, and in very different positions, and yet the idea conveyed by each might be simply a game of football. It would be too much to expect that persons dealing with trade marked goods, and relying, as they frequently do, upon marks, should be able to remember the exact details of the marks upon the goods with which they are in the habit of dealing. Marks are remembered rather by general impressions or by some significant detail than by any photographic recollection of the whole. Moreover, variations in detail might well be supposed by customers to have been made by the owners of the trade mark they are already acquainted with for reasons of their own.”

(Emphasis supplied)

21.6 Having reproduced the above passage from Kerly, the Supreme Court, in ***Parle Products***, went on to hold:

“9. It is, therefore, clear that in order to come to the conclusion whether one mark is deceptively similar to another, *the broad and essential features of the two are to be considered. They should not be placed side by side* to find out if there are any differences in the design and if so, whether they are of such character as to prevent one design from being mistaken for the other. It would be enough if the impugned mark bears such an overall similarity to the registered mark as would be likely to mislead a person usually dealing with one to accept the other if offered to him.”

(Emphasis supplied)

In view of the express words employed by Section 29(2) of the Trade Marks Act, it is clear that the propensity of the average consumer to accept the defendant’s product, if offered to him, owing to the similarity between the plaintiff’s and defendant’s marks, cited as a definitive test in ***Parle Products*** may as much be because she, or he, confuses the defendant’s mark for the plaintiff’s, *as because, owing to*



the similarity between the two marks, he believes the existence of an association between them. A fascinating study on the contours of confusion is to be found in *Shree Nath Heritage*.

21.7 The opening sentence in the above paragraph from *Parle Products* introduces a further concept of “idea infringement”. If, in other words, the *idea* conveyed by one mark is copied by another, it amounts to idea infringement which, too, is prohibited as likely to result in confusion in the mind of the consumer of average intelligence and imperfect recollection, as the above passage from *Parle Products* holds. The logic is apparent. The human mind captures ideas conveyed by images, or words, and often it is the idea which remains impressed on the mind. The conveying of the same idea by two marks, therefore, clearly results in likelihood of the human mind – especially if average in intellect and imperfect in recollection – confusing one for the other, or at least presuming an association between them. Instances where this Court has held “idea infringement” to exist are to be found in *Holyland Marketing (P) Ltd v Vijay Pal Vineet Kumar & Co*¹⁹, *Hari Chand Shri Gopal v Evergreen International*²⁰, *Bvlgari SPA v Notandas Gems (P) Ltd*²¹ and *Pernod Ricard India Pvt Ltd v A.B. Sugars Ltd*²².

21.8 The House of Lords, in *Reckitt & Colman Ltd v Borden Inc.*²³, also postulated the “trinity” or “triple identity test”, which deems infringement to exist where identical (or deceptively similar) marks

¹⁹ 2023 SCC OnLine Del 2640

²⁰ (2020) 83 PTC 267

²¹ (2022) 90 PTC 171

²² 2023 SCC OnLine Del 6966

²³ 1990 (1) All ER 873 (HL)



are used for more or less identical products, having a common market. Similarity of marks, identity/similarity of the goods on which the marks are used, and commonality of market, therefore, predicate a legitimate inference of infringement.

21.9 Applying these principles, deceptive similarity between the INDIA GATE and BHARAT GATE marks, as is likely to result in confusion or a presumption of association between the marks, is starkly apparent.

21.10 The latter common “Gate” part of the rival marks itself renders them phonetically similar. One need only refer, in this regard, to the oft cited decision in *Amritdhara Pharmacy*. The Supreme Court was, in that case, concerned with the marks AMRITDHARA and LAXMANDHARA, both used for Ayurvedic medicinal preparations. On the aspect of the likelihood of the two marks to be confused with each other, the Supreme Court held thus:

“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 Shangrila Food Products Ltd.*²⁴ 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*

²⁴ (1960) 1 SCR 968



“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.”

(Emphasis supplied)

21.11 Applying the above principles, it is clear that the mark BHARAT GATE clearly infringes the mark INDIA GATE. Both are used for the same goods. They are phonetically similar. “Bharat” and “India” convey the same idea, Preambularly and otherwise. Both are used for rice. The triple identity test, too, therefore, stands satisfied.

22 Design difference

22.1 The learned Commercial Court then proceeds to note the difference in packaging colour and design between the INDIA GATE and BHARAT GATE rice bags, with different colours predominating.



22.2 Assuming such visual differences the marks, seen as images on the packs, exist, they do not serve to mitigate the existence of infringement, and the law in this regard is, again, not *res integra*. The issue stands concluded by the judgment of the Supreme Court in ***K.R. Chinna Krishna Chettiar v Shri Ambal & Co***²⁵. In that case, the Supreme Court was dealing with the marks “SRI AMBAL” and “SRI ANDAL”, used for snuff in both cases. Ambal and Andal were Hindu divinities, worshipped in the South of India. There is a specific finding by the Supreme Court in the said decision that the two rival marks were visually completely dissimilar. Despite this, the Supreme Court has held that, as “ANDAL” and “AMBAL” were phonetically similar, a clear case of confusion existed. The relevant paragraphs from ***K.R. Chinna Krishna Chettiar*** may be reproduced thus:

“7. There is no evidence of actual confusion, but that might be due to the fact that the appellant's trade is not of long standing. *There is no visual resemblance between the two marks, but ocular comparison is not always the decisive test. The resemblance between the two marks must be considered with reference to the ear as well as the eye. There is a close affinity of sound between Ambal and Andal.*

9. *The name Andal does not cease to be deceptively similar because it is used in conjunction with a pictorial device.* The case of ***De Cordova v Vick Chemical Co.***²⁶ is instructive. From the appendix printed at p. 270 of the same volume it appears that Vick Chemical Company were the proprietors of the registered trade mark consisting of the word “Vaporub” and another registered trade mark consisting of a design of which the words “Vicks Vaporub Salve” formed a part. The appendix at p. 226 shows that the defendants advertised their ointment as “Karsote Vapour Rub”. It

²⁵ (1969) 2 SCC 131

²⁶ (1951) 68 RPC 103



was held that the defendants had infringed the registered marks. Lord Radcliffe said: "... a mark is infringed by another trader if, even without using the whole of it upon or in connection with his goods, he uses one or more of its essential features".

22.3 This finding of the learned Commercial Court also effectively obfuscates the distinction between infringement and passing off, as noted by the Supreme Court in *Kaviraj Pt Durga Dutt Sharma v Navaratna Pharmaceutical Laboratories*²⁷, of which the impugned order itself takes pointed notice. *Kaviraj* clearly outlined the distinction thus, in the process also underscoring the essential ingredients of the two torts:

"28. The other ground of objection that the findings are inconsistent really proceeds on an error in appreciating the basic differences between the causes of action and right to relief in suits for passing off and for infringement of a registered trade mark and in equating the essentials of a passing off action with those in respect of an action complaining of an infringement of a registered trade mark. We have already pointed out that the suit by the respondent complained both of an invasion of a statutory right under Section 21 in respect of a registered trade mark and also of a passing off by the use of the same mark. *The finding in favour of the appellant to which the learned counsel drew our attention was based upon dissimilarity of the packing in which the goods of the two parties were vended, the difference in the physical appearance of the two packets by reason of the variation in the colour and other features and their general get-up together with the circumstance that the name and address of the manufactory of the appellant was prominently displayed on his packets and these features were all set out for negating the respondent's claim that the appellant had passed off his goods as those of the respondent. These matters which are of the essence of the cause of action for relief on the ground of passing off play but a limited role in an action for infringement of a registered trade mark by the registered proprietor who has a statutory right to that mark and who has a statutory remedy for the event of the use by another of that mark or a colourable imitation thereof.* While an action for passing off is a Common Law remedy being in substance an action for deceit, that is, a passing off by a person of his own goods as those of another,

²⁷ AIR 1965 SC 980



that is not the gist of an action for infringement. The action for infringement is a statutory remedy conferred on the registered proprietor of a registered trade mark for the vindication of the exclusive right to the use of the trade mark in relation to those goods” (Vide Section 21²⁸ of the Act). The use by the defendant of the trade mark of the plaintiff is not essential in an action for passing off, but is the sine qua non in the case of an action for infringement. No doubt, where the evidence in respect of passing off consists merely of the colourable use of a registered trade mark, the essential features of both the actions might coincide in the sense that what would be a colourable imitation of a trade mark in a passing off action would also be such in an action for infringement of the same trade mark. But there the correspondence between the two ceases. 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

²⁸ Parallel to Section 28(1) of the Trade Marks Act, which reads:

“28. Rights conferred by registration. –

(1) Subject to the other provisions of this Act, the registration of a trade mark shall, if valid, give to the registered proprietor of the trade mark the exclusive right to the use of the trade mark in relation to the goods or services in respect of which the trade mark is registered and to obtain relief in respect of infringement of the trade mark in the manner provided by this Act.



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.”*

22.4 Thus, infringement is made out where there is deceptive *phonetic, visual, or idea* similarity between the marks. The presence of any one element, as is sufficient to confuse the consumer, would be sufficient. All other features of distinction would, then, pale into insignificance. The marks, moreover, have to be compared as wholes, taking into account the essential features of the appellant's mark. There is no inherent contradiction in this principle; if the essential features of the appellant's mark stand replicated by the respondent, either by plain copying or usage of features which are confusingly similar, in such a manner as to render the respondent's and appellant's marks, seen as wholes, confusingly similar to each other, the tort of infringement stands committed.



22.5 When one compares, visually, the appellant's INDIA GATE and respondent's BHARAT GATE marks, as used on their respective packs, it is apparent that the respondent has, besides using a word mark which is phonetically similar and representing the same idea as the appellant's mark, also copied the essential features of the appellant's mark. Most tellingly, the figure of the India Gate figures prominently on both the packs. I am, quite frankly, unable to appreciate how the learned Commercial Court could hold that, in the respondent's mark, seen by the eye, the Taj Mahal was prominent, and that the India Gate is visible only when the viewer views the package "with great care and concentration". It appears that the learned Commercial Court might have been referring to some other mark, as, in the respondent's mark, it is the image of the Taj Mahal, if anything, which is disproportionately small as compared to the India Gate, which occupies the entire foreground:



22.6 In any event, applying the *K.R. Chinna Krishna Chettiar* principle, therefore, the fact that there may be other visual



dissimilarities would not make any difference to the aspect of infringement.

22.7 It is relevant to note, in this context, that, in *K.R. Chinna Krishna Chettiar*, there was no similarity whatsoever, visually, between the rival marks as depicted on the rival products, as is apparent from the following factual recital in the opening paragraph of the judgement:

“...Trade Mark No. 126208 consists of a label containing a device of a goddess Sri Ambal seated on a globe floating on water enclosed in a circular frame with the legend “Sri Ambal parimala snuff” at the top of the label, and the name and address “Sri Ambal and Co., Madras” at the bottom. Trade mark No. 146291 consists of the expression “Sri Ambal”. The mark of which the appellant seeks registration consists of a label containing three panels. The first and the third panels contain in Tamil, Devanagari, Telugu and Kannada the equivalents of the words “Sri Andal Madras Snuff”. The centre panel contains the picture of goddess Sri Andal and the legend “Sri Andal”.”

Even in the case of marks which had thus *no* visual similarity between them at all, the Supreme Court held that infringement stood established because of the phonetic similarity between “Ambal” and “Andal”. As against this, in the present case, not only is there phonetic similarity between the rival marks; the case is further one of blatant idea infringement, with, further, the most prominent visual feature of the appellant’s mark, namely the India Gate, having been slavishly copied by the respondent.

22.8 The reliance, by the learned Commercial Court, on the visual dissimilarities between the appellant’s INDIA GATE and respondent’s BHARAT GATE marks is, therefore, completely misplaced.



23 “Bharat” being a synonym for India – *Munday* and *Slazenger*

23.1 While observing that “Bharat” is a synonym of “India”, the learned Commercial Court, unfortunately, fails to notice the most obvious sequitur.

“India Gate” has a well-known and well-recognized connotation, being referable to one of our proudest national monuments, in the heart of the Delhi. This is underscored by the pictorial representation of the India Gate on the appellant’s package, accompanying the INDIA GATE mark. “Bharat Gate”, on the other hand, has *no* meaning whatsoever, except as a corrupted synonym of “India Gate”. The usage, by the respondent, of the figure of the India Gate prominently covering nearly the whole of the packing clearly indicates a deliberate attempt, by the respondent, to deceive consumers into confusing the respondent’s product with the appellant’s. The use of “Bharat”, a synonym for “India” is, obviously, merely a misguided attempt to avoid an allegation of slavish adoption. The case is, therefore, *prima facie* one of a *mala fide* and deliberate attempt to capitalize on the goodwill of the appellant. There is no conceivable explanation as to why the respondent used “BHARAT GATE” for rice where the appellant’s well-known mark “INDIA GATE” was already in existence. The reason can only be to capitalise on the appellant’s goodwill and ensure sales of the respondent’s product.

23.2 In such cases, the exordiums of Kekewich J in *Munday v*



*Carey*²⁹, and of Lindley, LJ in *Slazenger & Sons v Feltham & Co.*³⁰ squarely apply. In *Munday*, Kekewich J held:

"...Where you see dishonesty, then even though the similarity were less than it is here, you ought, I think, to pay great attention to the items of similarity, and less to the items of dissimilarity."

Lindley LJ emphasized the rigidity of the approach to be adopted in the case of deliberate copying, in *Slazenger*, thus:

"One must exercise one's common sense, and, if you are driven to the conclusion that what is intended to be done is to deceive if possible, I do not think it is stretching the imagination very much to credit the man with occasional success or possible success. Why should we be astute to say that he cannot succeed in doing that which he is straining every nerve to do?"

23.3 Applying these principles to the case at hand, as the respondent has deliberately copied the essential features of the appellant's registered INDIA GATE trade mark, by adopting a meaningless, but phonetically similar BHARAT GATE mark which conveys the same idea, "Bharat" being a synonym for "India", the Court was required to concentrate on the similarities between the marks, rather than their minor dissimilarities. Also, in such a case, the Court is required to presume that the attempt at deception, adopted by the respondent, would succeed, rather than otherwise. A clear case of likelihood of confusion, thereby, stands made out.

24 Re. the *publici juris* finding and the decision in *Shree Nath Heritage*

²⁹ 1905 RPC 273

³⁰ (1889) 6 RPC 531



24.1 The learned Commercial Court has further held that, as “India” is the name of our country, the appellant could not seek to monopolize it, and that “Gate” is *publici juris*, over which no exclusive proprietary rights could be claimed by anyone including the appellant. Ergo, holds the learned Commercial Court, the use, by the respondent, of the mark BHARAT GATE was legitimate, and could not be enjoined by the appellant on the ground that it was a prior registrant and user of the mark INDIA GATE. The learned Commercial Court has also sought, in the process, to distinguish the judgement of the Division Bench of this Court in *Shree Nath Heritage* on the ground that, there, the two marks had a common first word, “Officer”.

24.2 The observation of the learned Commercial Court apropos the decision in *Shree Nath Heritage*, we may straightaway observe, is vitiated by clear non-application of mind. This Court was, in that case, concerned with *two* allegedly infringing marks, “Officer’s Special” and “Collector’s Choice”, of the appellant-defendant, vis-à-vis the respondent-plaintiff’s mark “Officer’s Choice”. The learned Commercial Court appears to have overlooked, perhaps inadvertently, the fact that one of the rival marks was “Collector’s Choice”, which did not involve any Officer.

24.3 In fact, para 63 of the report in *Shree Nath Heritage* squarely covers this case, and also addresses, once again, the finding of the learned Commercial Court on the aspect of difference in trade dress or



visual appearance of the rival marks. It reads:

“63. Since the marks ‘*Officer's Choice*’ and ‘*Collector's Choice*’ are prima-facie deceptively similar as they convey the same meaning, the impact of different trade dress is highly unlikely to rule out consumer confusion between the two products in this case, especially since consumers expect manufacturers of alcoholic beverages to churn out variants.”

Both the observations in this single-sentence paragraph apply to the facts before us. As in the case, the marks INDIA GATE and BHARAT GATE convey the same meaning. Again, as in that case, this renders the marks deceptively similar, so that the difference in trade dress between the marks as visually depicted on the packages of the appellant’s and respondent’s products would not mitigate the confusion created by the infringement.

24.4 The learned Commercial Court has, however, unfortunately failed to notice that “Collector’s Choice” was one of the infringing marks in *Shree Nath Heritage* and has, therefore, brushed aside the said decision as distinguishable on facts. In fact, on more than one point, the decision squarely covers the present controversy.

24.5 The findings of the learned Commercial Court, regarding the appellant’s mark being *publici juris*, is erroneous on various counts.

24.6 In the first place, while returning such a finding, the learned Commercial Court could not have vivisected the appellant’s mark into INDIA and GATE, especially as the appellant was claiming exclusivity over the whole INDIA GATE mark, and was not seeking



to contend that, owing to the common GATE feature, the respondent's BHARAT GATE mark was infringing. Section 17³¹ of the Trade Marks Act, in fact, proscribes any claim to exclusivity by vivisecting a mark, registered as a whole, into its parts, unless such parts are individually registered.

24.7 Secondly, the learned Commercial Court has erred in failing to notice that the appellant was not claiming exclusivity over the word INDIA or the word GATE, but over the mark INDIA GATE. Expressed otherwise, the appellant's case was not that no could use either "India" or "Gate" as part of its mark for rice, but that the mark BHARAT GATE was infringing. The learned Commercial Court appears, erroneously, to have treated the appellant's case as a claim for exclusivity over the words "India" and "Gate".

24.8 Thirdly, the issue of whether a mark is, or is not, *publici juris*, has to be examined by considering *the whole mark, vis-à-vis the goods in respect of which the mark is used*. Facially common words might, in the context of the goods or services in which they are used, be rendered inventive, justifying a claim of exclusivity. This is one such case. The mark INDIA GATE cannot, clearly, be regarded as *publici*

³¹ 17. **Effect of registration of parts of a mark.** –

- (1) When a trade mark consists of several matters, its registration shall confer on the proprietor exclusive right to the use of the trade mark taken as a whole.
- (2) Notwithstanding anything contained in sub-section (1), when a trade mark—
 - (a) contains any part—
 - (i) which is not the subject of a separate application by the proprietor for registration as a trade mark; or
 - (ii) which is not separately registered by the proprietor as a trade mark; or
 - (b) contains any matter which is common to the trade or is otherwise of a non-distinctive character,
 the registration thereof shall not confer any exclusive right in the matter forming only a part of the whole of the trade mark so registered.



juris when used for rice. INDIA GATE, most certainly, is not a mark or name of common usage, for rice. As a moniker for rice, therefore, INDIA GATE is decidedly inventive, and would, on its registration, insure the registrant – the appellant before us – from the use, by anyone else, of a deceptively similar mark.

24.9 The finding of the learned Commercial Court, predicated on the *publici juris* principle is also, therefore, unsustainable on facts and in law.

25 The price aspect

25.1 On the aspect of price, too, the finding of the learned Commercial Court is a trifle disquieting. The impugned order, in this context, observes and holds thus:

“Though the Hon’ble High Court had held that difference in price is of no use and avail for the defendants to cite any distinction with the product of the Plaintiff or a registered Trade Mark user, however, in the given set of facts and circumstances, I am of the considered view that keeping in view the kind of product involved in the present case, the customers’ segment of the Plaintiff’s product is entirely different from the customers’ segment of defendants’, because the brand owned by the Plaintiff is not within the reach of the common man and is popular only amongst upper strata of society who are well educated, rich and conscious about the products and their brands.”

The learned Commercial Court has earlier, in the impugned order, noted that the Supreme Court has held, in ***Renaissance Hotel Holdings Inc v B. Vijaya Sai*** that, where infringement stands committed, the difference in price between the rival goods or services becomes irrelevant. The exact words used in the impugned order, in



this context, read:

“Renaissance Hotel Holdings Inc v B. Vijaya Sai and Ors ... wherein it was held by the Apex Court that a price difference between two similar products of same class would not negate the effect of infringement and thus Plaintiff could not be held disentitled for an injunction in its favour. However, in the cited case, respondent had used the original name of Plaintiff by merely putting a prefix of “Sai”.”

(Emphasis supplied)

25.2 One may also, in this context, note what the Supreme Court held, in *Renaissance Holdings*:

“52. It could thus be seen that this Court again reiterated that the question to be asked in an infringement action is as to whether the defendant is using a mark which is same as, or which is a colourable imitation of the plaintiff's registered trade mark. It has further been held that *though the get-up of the defendant's goods may be so different from the plaintiff's goods and the prices may also be so different that there would be no probability of deception of the public*, nevertheless even in such cases i.e. in an infringement action, *an injunction would be issued as soon as it is proved that the defendant is improperly using the plaintiff's mark*. It has been reiterated that no case of actual deception nor any actual damage needs to be proved in such cases. This Court has further held that though two actions are closely similar in some respects, in an action for infringement, where the defendant's trade mark is identical with the plaintiff's trade mark, the Court will not enquire whether the infringement is such as is likely to deceive or cause confusion.”

The marks with which the Supreme Court was dealing, in *Renaissance Holdings*, being RENAISSANCE and SAI RENAISSANCE were not, strictly speaking, identical. Nonetheless, in view of the above paragraph from the judgement, it is clear that, where infringement is found to exist and the overall similarity of the rival marks is such as is likely to result in confusion or deception, the mere fact that the goods, on which the rival marks are to be found, are



sold at different – or even widely different – prices, would not make any substantial difference.

25.3 We may also reiterate, in this context, the *Munday* and *Slazenger* principles that, where there is, *prima facie*, a clear intent to copy and deceive, the Court would presume that the attempt is successful, rather than that it is not. The defendant, as a dishonest user of a deceptively similar mark, must suffer contrition and penance for the deception, and the Court would incline, in such circumstances, in favour of holding that the consumer of average intelligence and imperfect recollection *would* be deceived, rather than otherwise.

25.4 A mechanical view that there is no likelihood of confusion, predicated on the difference in price between the marks also, in our view, ignores stark trade realities. It is a matter of common knowledge that the same manufacturer may manufacture, under different marks, goods which are of widely varying prices. Though the author of this judgement is a stranger to their charms, we are given to understand that, for example, the Johnny Walker brand of whiskies is sold under various “Labels”, commanding widely varying prices, with Blue Label probably being the most exclusive and highly priced, and Red Label being the cheapest. The possibility of goods, widely differing in prices, being sold by the same manufacturer under different marks, depending on the perceived quality of the product is, therefore, a common trade reality, which the impugned order ignores.

25.5 We may also note, in this context, the submission of Mr



Bakhru, appearing for the appellant, that such a defence was never even raised in the written statement filed by the respondent before the learned Commercial Court. In that view of the matter, we also fail to understand the basis for the finding, of the learned Commercial Court, that the appellant's product catered to the cognoscenti, and the respondent's to the laity. The impugned order provides no basis for this finding, even *prima facie*. Needless to say, it is not open to any Court to rely on personal knowledge while passing a judicial order. Even on this ground, the finding, in the impugned order, that as the appellant's and respondent's products commanded different prices, they catered to different customer segments, cannot sustain.

25.6 In fact, as the product, in each case, was cooking rice, they catered to the *same* consumer segment, as already noted earlier in this judgment.

The sequitur

26. The learned Commercial Court has, therefore, proceeded on the following premises which are erroneous, both in fact and in law:

- (i) that there is no phonetic similarity between INDIA GATE and BHARAT GATE,
- (ii) that the fact that there are differences in colour and design between the appellant's and respondent's marks mitigates the possibility of confusion,
- (iii) that the appellant could not seek injunction as
 - (a) the appellant could not claim exclusivity over the



word “India”, and it was open to anyone to use the said word, or its synonyms including “Bharat”, for any goods, and

(b) the word “Gate” was *publici juris*,

(iv) that the image of the India Gate was not prominently visible on the image of the BHARAT GATE mark as printed on the respondent’s packs, and

(v) that the appellant’s and respondent’s products were so differently priced as to render their customer segments different, thereby mitigating any likelihood of confusion.

27. We find, on the other hand, for the reasons already elucidated hereinbefore, that the respondent had, with clear intent to capitalize on the appellant’s goodwill, adopted a mark which is transparently and deceptively similar to the registered trade mark of the appellant. The case is clearly one of infringement, within the meaning of Section 29(2)(b) of the Trade Marks Act. Where *prima facie* infringement is found to exist, an injunction must necessarily and inexorably follow. The exordium to this effect, as contained in the following passage from judgement of the Supreme Court in *Midas Hygiene Industries (P) Ltd v Sudhir Bhatia*³², is entirely applicable to the present case:

“5. The law on the subject is well settled. In cases of infringement either of trade mark or of copyright, normally an injunction must follow. Mere delay in bringing action is not sufficient to defeat grant of injunction in such cases. The grant of injunction also becomes necessary if it *prima facie* appears that the adoption of the mark was itself dishonest.”

³² (2004) 3 SCC 90



28. The learned Commercial Court has proceeded, in the impugned order, on premises which are fundamentally erroneous on fact as well as in law. Even within the peripheries chalked out by the Supreme Court in ***Wander***, therefore, a case for interference, in appeal, is eminently made out.

Conclusion

29. Resultantly, the impugned order, dated 9 January 2024, passed by the learned Commercial Court, is quashed and set aside. The *ad interim* order dated 9 October 2020, passed by the learned Commercial Court, stands restored and is made absolute pending disposal of the suit.

30. The appeal stands allowed in the aforesaid terms, without any orders as to costs.

31. Needless to say, observations in this judgement are only intended to dispose of the appeal preferred against the impugned order, disposing of the application filed by the respondent under Order XXXIX of the CPC.

C. HARI SHANKAR, J.

AJAY DIGPAUL, J.

JANUARY 15, 2025/ar

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