

IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
IN ITS COMMERCIAL DIVISION

INTERIM APPLICATION (LODGING) NO.28196 OF 2024
IN
COMMERCIAL IP SUIT (LODGING) NO.27857 OF 2024

Asian Paints Limited, registered under Indian Companies Act 1913 and existing under the provisions of Companies Act, 2013, having its registered office at 6-A, Shantinagar, Santacruz (E), Mumbai-40005300

...Applicant

IN THE MATTER BETWEEN :

Asian Paints Limited, registered under Indian Companies Act 1913 and existing under the provisions of Companies Act, 2013, having its registered office at 6-A, Shantinagar, Santacruz (E), Mumbai-40005300

...Plaintiff

Versus

1. Tarun Paints Private Limited, a company incorporated under the Companies Act, 1956, having its manufacturing unit at F 527-528 Phase 2, M. G. Road, UPSIDC, Masoori, Ghaziabad, Uttar Pradesh-201302.

2. Tarun Brush Industries, whose constitution is unknown, having its address at SI-54, Shastri Nagar Ghaziabad, Uttar Pradesh - 201002.

...Defendants

Mr. Vinod Bhagat a/w Ms. Twisha Singh i/b Mr. Vinod A. Bhagat for the Applicant/Plaintiff

Mr. Atmaram Patade a/w Mr. Pranav Manjrekar, Mr. Bhagawan Kasture, Ms. Shraddha Patil, Mr. Atharva Kudtarkar and Mr. Rahul R. Dubey i/b Mr. Atmaram Patade for the Defendants

CORAM : SHARMILA U. DESHMUKH, J.

RESERVED ON : FEBRUARY 13, 2026

PRONOUNCED ON : MARCH 13, 2026

ORDER :

1. This is an action for infringement of trade mark, copyright and passing off. By way of the interim relief, the Plaintiff seeks to restrain the Defendants from using the impugned label marks RED OXIDE metal primer, WOOD primer, APCA GOLD enamel, ASIA TUFF cement paint, ASIA TUFF wall putty, APCA GOLD primer and APCA GOLD enamel or any other deceptively similar mark. Vide order dated 13th September 2024, this Court had granted ad-interim relief in terms of prayer clauses (a), (b) and (d) of the Plaint. Subsequently, by order dated 21st August 2025, Leave Petition came to be allowed. By order of 5th February 2026, the statement of learned counsel for the Defendants was recorded that the Defendants are willing to revise the (a) word and label mark of APCA GOLD, (b) label mark and artwork of WOOD PRIMER, and (c) label mark and artwork of RED OXIDE METAL PRIMER. By the present order, the submission is accepted as undertaking given to this Court. In view of the said submission, the

dispute in the present case is now confined to the infringement of the trademark "ASIAN PAINT" by use of the word mark "ASIA TUFF".

2. The Plaintiffs' case is that it is using the word "ASIAN PAINTS" as a trademark continuously since the year 1952 and by virtue of the long association of the mark with the Plaintiff's goods, the trademark has lost its primary significance and acquired a secondary meaning. The Plaintiff is the registered proprietor of the trademark ASIAN PAINTS and of the formative marks wherein the word ASIAN occupies the leading and essential feature. The registration certificates, statement of year-wise total sales turnover, advertisement expenses, specimen of sales invoices, and promotional material are placed on record. The Plaintiff's mark is declared as well known trade mark by the registrar of trade marks. It is pleaded that the Plaintiff became aware of the use of the impugned mark ASIA TUFF cement paint, ASIA TUFF wall putty, which is deceptively similar to the Plaintiff's registered trademark in or around the first week of August 2024. A search in the trademark registry revealed that the Defendant No 1 had filed an application on 2nd February, 2018 for registration of the impugned mark ASIA TUFF in Class 2 claiming user since 8th April, 2007 which registration has been refused under Section 11 of the Trade Marks Act, citing the Plaintiff's trademark ASIAN PAINTS. On 31st July 2002, the

Defendant No.2 applied for registration of the impugned word mark ASIA TUFF claiming user since 31st February, 2002. The Plaintiff has filed the necessary notice of opposition on 31st July 2002 and no counter statement appears to have been filed implying abandonment of the application.

3. The affidavit-in-reply raises an objection to jurisdiction on the ground that the Plaintiff's subordinate office is located in Uttar Pradesh where the cause of action arose. The Defendant No. 2 which was constituted on 10th January, 1992 ceased its operations after incorporation of Defendant No 1 on 8th January 2007 and since 1992 the Defendants are in paint industry operating from Ghaziabad, Uttar Pradesh. The flow chart produced at Paragraph 12.8 shows that the trade mark application for registration of trade mark ASIA TUFF filed on 31st July, 2002 by Defendant No 2 and on 2nd February, 2018 by Defendant No 1 have been abandoned. The Defendants are copyright owners in the original artistic work and have gathered enormous goodwill and reputation in the labels/artistic work of its products marketed under the mark ASIA TUFF. The Defendants have adopted the impugned trade mark in the year 2002 and are prior adopters. The impugned mark and the copyright is distinct and unique and without prejudice, the Defendants are willing to revise the label / artistic work

of the products sold under the mark ASIA TUFF in order to avoid unwanted litigation. The action suffers from delay, laches and acquiescence as the Plaintiff was aware about the Defendant No.2 as on 2nd March 2005 and had complete knowledge about the Defendants' products. It is contended that the Defendants' presence is active in the market since 2002 followed by the trademark registration application in the year 2002 and the present Suit has been filed in the year 2024. It is pleaded that some of the distributors/whole-sellers/retailers have stated on affidavit that the Plaintiff's and the Defendants' products have been prominently displayed in their business premises and the Plaintiff's representative has been aware of the Defendants' products since long.

4. Mr. Bhagat, learned counsel appearing for the Plaintiff submits that the contest is between ASIAN PAINTS vs. ASIA TUFF. He submits that in the impugned mark, the word ASIA is given prominence and the word TUFF is written below the word ASIA. He submits that the word TUFF is descriptive and the registrar of trademark has held that it should be disclaimed in view of the registration of the Plaintiff's mark of ASIAN and ASIAN PAINTS. He submits that the trade mark ASIAN PAINTS has been granted registration without any disclaimer. He points out the invoice showing the use of the device mark of

ASIAN PAINTS since the year 1968 and the product of ASIAN REDOXIDE POWDER being sold since the year 1970. He submits that the mark ASIAN PAINTS has been declared as a well-known mark in the list published on 24th February 2020. He submits that insofar as the Defendants are concerned, few invoices are produced of the year 2017 which does not demonstrate extensive and continuous use. He submits that the examination report in respect of the application filed by the Defendant No.1 states that the word TUFF should be disclaimed and that the objection is on the ground that the name of the continent is not a distinctive mark. He submits that the application of the Defendant No.2 for the word mark ASIA TUFF has been abandoned. He submits that there is no explanation given for adoption of the mark ASIA TUFF which is claimed to have been adopted since the year 2002 and the invoices which have been annexed shows the use of the mark ASIA TUFF is of the year 2017. He submits that no stand alone turnover statement is produced and only composite sales turnover is produced on record. He submits that the leading feature of the Plaintiff's registered mark is ASIAN and the Defendants' impugned mark ASIA is deceptively similar to the Plaintiff's registered mark. In support he relies upon various interim orders passed by this Court and Delhi High Court and the following decisions :

**(i) Manugraph India Ltd. vs. Simarq Technologies Pvt. Ltd.
& Ors.¹**

(ii) Asian Paints (India) Ltd. vs. Satish Kumar & Ors.²

5. Mr. Patade, Learned counsel appearing for the Defendants would submit that there is no registration of the word mark ASIAN PAINTS and the marks have to be compared as a whole and when so compared, the marks are dissimilar. He submits that the plaint proceeds on the ground of infringement of the word ASIAN PAINTS / ASIAN, whereas, there is no registration obtained for the stand alone mark of ASIAN. He would point out that the Defendants' sales turn over produced on record is in respect of all trademarks including ASIA TUFF. He submits that the pleading in Paragraph 12.10 of reply would indicate the use of the mark at least since the year 2008. He submits that the Plaintiff had knowledge of the Defendants since the Defendants are carrying on business since about 22 years and no action has been taken. He submits that the Plaintiff mark is declared as a well-known mark in the year 2020 and is not in respect of the word ASIAN. He would further point out the affidavit of the common distributor stating that it was distributing the products of the Plaintiff and Defendants and are displayed in his business premises next to

1 2016 SCC OnLine Bom 5334 : (2016) 4 AIR Bom R. 712
2 CS (OS) 1319/2005 dated 17.07.2013 (Delhi High Court)

each other for over 10 years and there is no complaint of any confusion. He further points out that in the prayer clause, the Plaintiff seeks action against use of the trademark ASIAN without any registration secured by the Plaintiff in respect of ASIAN. He submits that even the ex-parte order speaks of ASIAN / ASIAN PAINTS, without noticing that there was no registration for the word ASIAN. In support, he relies upon the following decision :

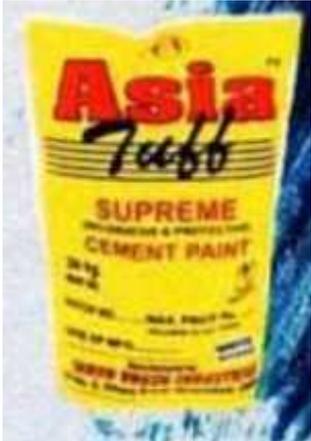
(i) Pernod Ricard India Pvt. Ltd. & Ors. vs. Karanveer Singh Chhabra³

6. Rival contentions now fall for determination:

7. In view of the statement recorded on 5th February 2026, the contest has narrowed down between the Plaintiff's registered trademark ASIAN PAINTS vs. ASIA TUFF-the Defendants' mark. The relief sought is against infringement of the registered trade mark and against passing off and no relief of copyright infringement is sought in respect of the impugned mark AISA TUFF. This Court is therefore called upon to assess the deceptive similarity between the marks ASIAN PAINTS vs ASIA TUFF.

8. The rival marks are reproduced hereinbelow for the purpose of comparison:

³ MANU/SC/1095/2025

Plaintiff's Products	Defendant's products
	

9. In *Pernod Ricard India Pvt. Ltd. & Ors. vs. Karanveer Singh Chhabra* (supra), the Hon'ble Apex Court noted that the anti-dissection rule and the dominant feature test, are not mutually exclusive and identifying a dominant feature can serve as an analytical aid in the holistic comparison of the marks. In certain cases the infringing component may overshadow the remainder of the mark to such an extent that confusion or deception becomes virtually inevitable. While assessing deceptive similarity, due weight must be

given to the dominant element, without disregarding the composite nature of the mark. The Hon'ble Apex Court held that the emphasis on a dominant feature alone will not be determinative and the ultimate test remains whether the mark viewed as a whole, creates a deceptive similarity likely to mislead an average consumer of ordinary intelligence and imperfect recollection.

10. In *M/s. Hiralal Prabhudas V/s. M/s. Ganesh Trading Co.*⁴, this Court has aptly summarized the principles for deciding the question of deceptive similarities in paragraph 5 as follows :-

"5. What emerges from these authorities is (a) what is the main idea or salient features, (b) marks are remembered by general impressions or by some significant detail rather than by a photographic recollection of the whole, (c) overall similarity is the touchstone, (d) marks must be looked at from the view and first impression of a person of average intelligence and imperfect recollection, (e) overall structure, phonetic similarity and similarity of idea are important and both visual and phonetic tests must be applied, (f) the purchaser must not be put in a state of wonderment, (g) marks must be compared as a whole microscopic examination being impermissible, (h) the broad and salient features must be considered for which the marks must not be placed side by side to find out differences in design and (i) overall similarity is sufficient. In addition, indisputably must also be taken into consideration the nature of the commodity, the class of purchasers, the mode of purchase and other surrounding circumstances."

11. Applying the well settled principles to the facts of the present case, *prima facie* comparison of the rival marks will inevitably point out that the dominant feature of the Plaintiff's mark is the word ASIAN which overpowers the word PAINTS. The impugned mark of Asia Tuff

⁴ 1983 SCC OnLine Bom 284 : AIR1984 Bom. 218

prominently displays the word ASIA with the word TUFF written below the word ASIA. Insofar as, the word TUFF is concerned, the same is descriptive, which has been *prima facie* held so by the Registrar, while considering the Defendant No.2's registration application. The products marketed under the rival marks are paints/wall putty etc, and the relevant consumers would be contractors or labourers involved in renovation, construction work etc. The test of average man with imperfect recollection when applied, considering the relevant consumer base, *prima facie* the consumers would ask for the Plaintiff's product by referring to the name ASIAN which is the striking element and will most probably be likely to be confused when confronted with the Defendant's product bearing the mark ASIA TUFF. There is deceptive visual and phonetic similarity between the two marks. Keeping in mind the use and registration of the formative marks of ASIAN PAINTS, there is strong likelihood of consumers being misled into presuming that the Plaintiff has introduced another trademark by using the word TUFF and would associate the Defendant's product with that of the Plaintiff constituting infringement under Section 29(2) of Trade Marks Act, by reason of likely association with the Plaintiff. The Defendant No 1's registration of the word mark ASIA TUFF has been refused registration by citing the Plaintiff's mark "ASIA PAINTS WOOD TECH TERMISHIELD". The registrar of trade marks was of the

opinion of likelihood of confusion being created by reason of registration of the impugned mark. The Defendants accepted the position and abandoned its application. Upon considering the overall impression created by ASIAN PAINTS, the prominence is given to the word ASIAN, which is distinctive. Greater weightage must be given to the dominant element. The Defendants mark ASIA TUFF gives prominence to word ASIA, which is likely to be taken as ASIAN. There is overall visual and phonetic similarity between the rival marks.

12. The Plaintiff is the registered proprietor the word mark and device mark of ASIAN PAINTS, with the earliest registration of ASIAN PAINTS word mark applied on 20th July, 1990 on proposed to be used basis. At Exhibit A-2 , the list of registrations secured by the Plaintiff in respect of ASIAN PAINTS and its formatives, which are about 40 in number are set out. On the other hand, the Defendants are using the unregistered mark ASIA TUFF. The application for registration of the mark ASIA TUFF firstly by Defendant No 2 in the year 2002 and thereafter by the Defendant No 1 in the year 2018 have been abandoned. The Defendants have annexed the copy of the trade mark application at Page 269 of the reply which shows that the application was made on 31st July, 2002 for registration of the word mark ASIA TUFF with user claim of 31st January, 2002. The examination report

states that the disclaimer of the word "TUFF" should be agreed to and that objection arises because the name of continent is not distinctive mark. The application is thereafter stated to have been abandoned. The examination report *prima facie* indicates that the word "TUFF" was held to be descriptive and that the word "ASIA" was non distinctive. The abandonment of the applications *prima facie* indicates acceptance of the position that the Defendants mark is incapable of registration. Section 9 and Section 11 of Trade Marks Act, which deals with absolute and relative grounds of registration respectively places an embargo on registration of a mark which is non-distinctive or is likely to cause confusion. The objection of likelihood of confusion raised by the Registrar by citing the mark "ASIA PAINTS WOOD TECH TERMISHIELD" can be extended to the mark ASIAN PAINTS as what is missing is one alphabet "N", which is terminating word and likely to be slurred over.

13. One of the contentions of Mr. Patade is that the Plaintiff cannot seek injunctive relief in respect of the word "ASIAN" as there is no stand alone registration of the word. The said contention is premised on Section 17 of the Trade Marks Act, which reads as under:

"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 trademark 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."

14. Considering the statutory provisions, the right conferred on the registered proprietor is to the use of the trade mark taken as a whole. The provisions of Section 17 was considered by the Calcutta High Court in the case of *Three-N-Products Private Limited vs Emami Ltd.*⁵, where it was held as under:

"35. The words 'the registration thereof shall not confer any exclusive right' towards the end of [Section 17\(2\)](#) have to be understood in the context. The import of such words is that the registration of the composite mark will not ipso facto confer any exclusive right as to the parts of the composite mark. But if the owner can establish exclusivity aliunde, the owner can assert the exclusivity. The registered owner is entitled to protection of its goodwill in such prominent feature as in an action for passing off unless the registered owner seeks to rely on [Section 17\(2\)\(b\)](#) of the Act in respect of a distinctive matter not common to the trade."

15. By seeking injunctive relief against the use of the word ASIAN, the Plaintiff claims distinctiveness under Section 17(2)(b) of Trade Marks Act, 1999. The Plaintiff's mark having been registered without

⁵ (2008) SCC OnLine Cal 589

any disclaimers *prima facie* satisfies the test of distinctiveness. The word ASIAN is arbitrary and unconnected with the products in question and it is not the case of the Defendants that the word is common to the trade. Having *prima facie* established the test of exclusivity, being the essential feature of the registered trade mark, the Plaintiff is entitled to protection of the word ASIAN.

16. One of the defences raised by the Defendants is under Section 34 of the Trade Marks Act, 1999 of being prior user of the mark ASIA TUFF since the year 2002. Firstly, the Plaintiff has secured registration of its word mark ASIAN PAINTS on 20th July, 1990 and has produced specimen invoice issued on 8th July, 1968 showing the use of the device mark of ASIAN PAINTS. Section 34 of Trade Marks Act, 1999 saves the vested right of the user of the mark which has been used continuously from a date prior to the use of the registered trade mark or the date of registration of the trade mark whichever is earlier. In present facts, to avail the benefit of Section 34 of Trade Marks Act, it was necessary to *prima facie* demonstrate user of the mark ASIA TUFF prior to user shown on 8th July, 1968 or atleast prior to the date of registration of ASIAN PAINTS in the year 1990. There are in all four invoices dated 11th July, 2017, 14th July, 2017, 22nd July, 2017 and 1st October, 2017 produced with the reply affidavit reflecting the mark

ASIA TUFF. The only other document is the trade mark application by the Defendant, which even if accepted as material to substantiate the use by the Defendants, claims user of the mark since 31st January, 2002 which user is subsequent to the registration of the Plaintiff's trade mark of ASIAN PAINTS of the year 1990.

17. The other defences raised is about the knowledge, delay and acquiescence, by relying on the affidavit of common distributor. It is well settled that delay by itself, is no defence in an action for infringement and for the purpose of showing acquiescence, it is necessary to show some positive act on part of the Plaintiff, which is missing in the present case. There is specific pleading in the plaint that the Plaintiff had come across the goods bearing the mark ASIA TUFF in August, 2024. The Defendants have not produced material on record to demonstrate that the mark was used in respect of its products prior to the year 2017. The invoices are sporadic and fails to establish such extensive use so as to have visible presence in the concerned segment to come to the knowledge of the Plaintiff. The affidavit of one single distributor is inadequate to show the Plaintiff's knowledge about existence of the Defendants

18. Even accepting, for the purpose of argument that the Plaintiff's mark has been declared as a well-known mark in the year 2020, the

long-standing and extensive user of the mark ASIAN PAINTS by the Plaintiff cannot be denied. The Defendants being late entrants in the market, are *prima facie* presumed to be aware of the Plaintiff's existence, especially when the Plaintiff is in the same industry. There is no explanation tendered by Plaintiff for accepting the bonafide adoption of the deceptively similar mark by the Defendants. Considering that the Registrar had refused the registration of the mark by citing the Plaintiff's conflicting mark way back in the year 2002, the Defendants ought to have been put to notice of the fact that continuation of the use of the mark would be at the Defendants' own peril.

19. The objection to jurisdiction is sufficiently answered by Section 134 (2) of the Trade Marks Act. There is no application filed under Order VII, Rule 10 for return of plaint. The averments in the plaint pertaining to jurisdiction *prima facie* satisfy the requirements of Section 134(2) of Trade Marks Act. This Court, by order dated 21st August 2025, has already granted the Leave Petition and the action of passing off was permitted to be combined with the action for infringement of trade mark and copyright.

20. For the purpose of considering the action of passing off, it is settled that an intent to deceive is not a necessary element but

requires proof of likelihood of confusion or deception and actual deception or damage need not be proved. The classic trinity would require proof of goodwill and reputation, misrepresentation and likelihood of damages. In a case for passing off, the Defendants can escape liability, if it can show that the added material is sufficient to distinguish the goods of the Defendants from that of the Plaintiff. The manner of packaging, the use of different colour scheme, the added elements of vertical lines, additional words forming part of the Defendant's trade dress would indicate that the products are not designed so as to pass off as goods of the Plaintiff. *Prima facie*, it is not possible to come to a finding of misrepresentation, intended or unintended as there are sufficient points of distinction. The Defendants cannot claim balance of convenience by reason of existence since long as the Defendants in the year 2002 were refused registration of their mark. Having proceeded with the use of the mark, the Defendants have done so at its own peril.

21. In light of the above, *prima facie* case has been made out for confirming the ad-interim relief which was granted by the order dated 13th September 2024, in respect of the impugned mark ASIA TUFF wall putty and ASIA TUFF cement paint, in terms of prayer clause (a), restraining the Defendants from manufacturing, marketing, or using,

in any manner whatsoever, in relation to its cement paint/wall putty, paints or other like goods used in paint industry, the impugned mark of ASIA TUFF cement paints and ASIA TUFF wall putty, or any other mark identical with or similar to the Plaintiff's trade mark ASIAN, ASIAN PAINTS so as to infringe upon the Plaintiff's registered trademark of ASIAN PAINTS.

22. The Interim Application stands allowed in above terms.

[SHARMILA U. DESHMUKH, J.]