IN THE HIGH COURT OF KERALA AT ERNAKULAM

PRESENT

THE HONOURABLE MR. JUSTICE S.MANU

FRIDAY, THE 10TH DAY OF APRIL 2026 / 20TH CHAITHRA, 1948

FAO NO. 1 OF 2026

AGAINST THE ORDER DATED 17.09.2025 IN IA 1/2021 IN OS NO.48 OF 2021 OF II ADDITIONAL DISTRICT COURT, ERNAKULAM

APPELLANT/RESPONDENT/DEFENDANT:

TASTE BOX
M/S TASTE BOX, NEERUNGAL,NEAR RAJAGIRI POST OFFICE KALAMASSERY,THRIKKAKARA NORTH,ERNAKULAM,, PIN - 683104
REPRESENTED BY ITS MANAGING PARTNER,SHIHAB N.A.

BY ADVS.SRI.BENOY K.KADAVAN
SMT.LAYA GEORGE
SRI.S.GOPAKUMAR
SHRI.SYRIAC T.V.
SMT.T.M.BINITHA
SMT.SREELAKSHMI S.J.

RESPONDENT/PETITIONER/PLAINTIFF:

JSF HOLDINGS PRIVATE LIMITED
M/S JSF HOLDINGS PRIVATE LIMITED,PLOT NO.6A, 1ST PHASE, INDUSTRIAL AREA,KUMBALGODE,BANGALORE-560074,REPRESENTED BY ITS DIRECTOR JOHN FRANCIS

BY ADVS.
SRI.P.ABRAHAM CHERIAN
SHRI.JAISON S. ROZARIO
SMT.NIMMY K. JOSEPH
SHRI.JOE JOSEPH
SHRI.ARAVIND VARGHESE
SMT.POOJA JOSE
SHRI.V.VARUN

THIS FIRST APPEAL FROM ORDERS HAVING COME UP FOR ADMISSION ON 05.03.2026, THE COURT ON 10.04.2026 DELIVERED THE FOLLOWING:

S.MANU, J.

F.A.O.No.1 of 2026

Dated this the 10th day of April, 2026

JUDGMENT

Appellant is the defendant in O.S.No.48/2021 of the Additional District Court-II, Ernakulam. Respondent/plaintiff filed the suit alleging that it belongs to a group of companies established in the year 1972 and is engaged in the business of manufacture and sale of goods such as ice creams, frozen desserts, milk products, non-alcoholic beverages, syrups and other foodstuffs and services related to providing said goods by way of establishing restaurants, parlours and kiosks in India and various foreign countries. Goods and services of the respondent are manufactured, sold and supplied under the trademarks Lazza, Uncle John, Skei and I & U. According to the respondent, the trademark Lazza has been in use since the year 1990 and the word has become distinctive in relation to the goods and

services and are being supplied and sold across the country and in various foreign countries through a well established business network. It is one of the most popular branches in south India with regard to the above mentioned goods and services. Through extensive advertisements the goods and services under the trademark Lazza have been promoted. Trademark Lazza and Lazza device marks are registered under the Trade Marks Act. Hence, the respondent claimed that it has the exclusive right to use the trademark Lazza and no other person has any right to use the said trademark or any mark identical or deceptively similar to it.

2. Further, the respondent claims that the trademark Lazza has acquired goodwill and trade reputation and it is a well-known trademark. On account of registration as also with long, exclusive and extensive use, the respondent has acquired legal, vested, statutory and common law rights to the exclusive use of the trademark Lazza. The respondent claims that it has

been vigilantly protecting the intellectual property rights associated with the trademark.

3. The respondent contends that on 16.8.2021 its lawyer came across an advertisement in the Trademark Journal inviting objections against an application for registration of a trademark 'HAZZA' in Class 43. The respondent immediately filed notice of opposition against the said application before the office of the Registrar of Trademarks at Chennai and the same is pending. Thereafter it was noticed by the respondent that the appellant has started a restaurant-cum-bakery under the trademark 'HAZZA' at Kalamassery in Ernakulam District. Respondent alleges that the essential, leading and prominent feature in the trademark of the appellant is the word 'HAZZA', derived by replacing the letter 'L' in the mark LAZZA with 'H'. The respondent uses colour combination of gold and black in the trademark 'LAZZA'. Similar colour combination has been used by the appellant in its trademark 'HAZZA'. Therefore, the

appellant has adopted a phonetically, visually and structurally similar trademark. The further allegation is that the appellant is infringing the registered trademark of the respondent and obviously the intention is to deceive and mislead consumers and members of trade/public.

4. I.A.No.1/2021 was filed to pass an order of temporary injunction restraining the appellant from using in any manner the trademark 'HAZZA' and/or the device mark 'HAZZA' or any other trademark identical and/or deceptively similar to the trademark 'LAZZA' registered in the name of the respondent and also from using the sign board or hoarding with the inscription/writing 'HAZZA' and/or the device mark 'HAZZA' so as to pass off the appellant's business as that of the respondent or in some way connected with the respondent. The learned Additional District Judge heard the parties and allowed the I.A. by order dated 17.9.2025. The said order is under challenge in this appeal.

5. Heard the learned counsel for the appellant and the learned counsel for the respondent.

6. The learned counsel for the appellant, Sri.Benoy K.Kadavan, submitted that the impugned order was passed in violation of the settled principles regarding infringement of trademark and passing off. He submitted that the appellant is using the trademark 'HAZZA Kitchen' in respect of running restaurants falling in Class 43 and the major trademarks obtained by the respondent are in Class 30. The learned counsel submitted that the appellant and the respondents are operating in different fields of services. The respondent is not operating ordinary restaurants. Its registration under Class 43 is also for limited activities specifically mentioned in the registration certificate. The appellant is running a restaurant specialising in Malabar and Middle Eastern cuisine. The respondent cannot be permitted to claim any monopoly in the matter of running restaurant for the reason that it has obtained

registration under Class 43. The appellant's mark 'HAZZA Kitchen' is distinctive, original and honestly adopted. The word 'HAZZA' is derived from Arabic and means 'delight or pleasure'. It is totally different from the trademark of the respondent. The visual and conceptual impression given by the trademark 'HAZZA' is not in any way deceptively similar to 'LAZZA'.

7. The learned counsel also submitted that the respondent is not running any ordinary restaurants though registration under Clause 43 was also obtained. There is no case for the respondent that any consumer had any confusion regarding the trademark of the appellant and there is no specific pleading to that effect. Not even a single instance has been pleaded. Since the field of activity of the appellant and the respondent are different there is no scope for any confusion or deception. He submitted that the matter is to be analysed from the point of view of a layman and since the trademarks are materially different, no confusion is created.

8. The learned counsel for the appellant further submitted that registration under Class 43 is not a conclusive proof of use and reputation. The same is a matter of evidence which can be considered only during the trial of the suit. The learned counsel further submitted that the approach of the learned Additional District Judge in analysing the dispute involved in the instant case was totally erroneous. He submitted that a reading of the impugned order would show that the learned Judge proceeded in the matter ignoring the well settled principles regarding anti-dissection and dominant feature. He submitted that the learned Additional District Judge analysed the comparability by dissecting the trademarks. The learned Judge also failed to properly analyse whether the mark, viewed as whole creates a deceptive similarity likely to mislead an average consumer of ordinary intelligence and imperfect recollection.

9. The learned counsel also submitted that the appellant has invested huge amounts to conduct the restaurant business and it has been functioning for the past several years. On account of the impugned order, the functioning of the restaurant was affected causing huge loss to the appellant. He submitted that the basic considerations in the matter of granting interim injunction were not properly taken note of by the learned Additional District Judge while passing the impugned order. He contended that no prima facie case was established by the respondent. Balance of convenience is in favour of the appellant. He therefore submitted that the impugned order is liable to be set aside and the I.A. is liable to be dismissed.

10. The learned counsel for the respondent Shri.Abraham Cherian supported the impugned order. He submitted that the order passed by the trial court is not liable to be lightly interfered with by this Court in the appeal. He further submitted that unless the order is illegal and perverse no interference is

warranted. He also submitted that discretionary orders in the nature of the impugned order passed by the trial court are not liable to be substituted by the discretion of the appellate court. He added that no ground sufficient to hold that the impugned order is arbitrary, perverse or capricious is made out by the appellant.

11. The learned counsel for the respondent submitted that the trademark LAZZA has been registered for various services and products. He submitted that the registration under Class 43 obtained by the respondent covers all categories of restaurants. He further submitted that it is immaterial as to whether the respondent is actually running any restaurant or not. He disputed the contention of the learned counsel for the appellant in this regard and submitted that if it is insisted that an action for infringement would lie only if the registered trademark is put in use, the very purpose of registration as provided under the Act would be defeated. He referred to the

definition of trademark as also Section 18 of the Act in this regard. He also referred to the law laid down in various judgments in this connection. The learned counsel further submitted that LAZZA is a well-known trademark. It has been recognized as such. He alleged that the appellant by using a similar trademark HAZZA and opening a restaurant on the opposite side of a factory of the respondent has acted with dishonest intention. He submitted that the trademark HAZZA is similar in idea and it is deceptively similar to the trademark of the respondent. He also pointed out that both entities are involved in food industry.

12. The learned counsel submitted that the appellant has not given any explanation for adopting the deceptively similar trademark with a closely resembling colour scheme. He argued that the apparent intention is to deceive the customers and to make use of the goodwill of the respondent. He submitted that the respondent has a case regarding infringement of trademark

as also passing off. He pointed out that the trial court on analysing the materials placed before it concluded prima facie that the trademark HAZZA is deceptively similar. The learned counsel further submitted that though the appellant contends that it is offering Arabic food, in fact it is not dealing exclusively with Arabic food.

13. The learned counsel submitted that on various considerations, the order of injunction granted by the trial court is perfectly justified. He pointed out that the trademark of the respondent was registered long back. So also, the respondent has been using the trademark continuously over a long period of time. The trial court was convinced about the deceptively similar nature of the trademark of the appellant. The court therefore prima facie found that there is infringement of trademark as well as passing off. Hence, the court restrained the appellant by issuing the impugned order.

14. The learned counsel also submitted that the intended customers of both the appellant and the respondent are the same. The use of the trademark HAZZA by the appellant is likely to cause confusion to the customers. He further submitted that the prominent feature in the trademark of the appellant, the word HAZZA is coined by just replacing the first letter, 'L' in the trademark LAZZA. The trademark HAZZA is phonetically, visually and structurally is similar to the trademark LAZZA. The respondent has been extensively advertising and promoting the trademark LAZZA for the past several decades by spending huge funds. He therefore submitted that if the appellant is permitted to use the trademark HAZZA incalculable and irreparable damage and injury will be caused to the respondent. He hence prayed that the instant appeal may be dismissed, upholding the impugned order.

15. I shall hereafter refer to the various precedents cited by both sides. First, I shall refer to the judgments cited by the

learned counsel for the appellant.

16. In **Renaissance Hotel Holdings Inc. v. Vijaya Sai** [(2022) 5 SCC 1], the Hon'ble Supreme Court held as under;

> "57. The perusal of sub-section (4) of Section 29 of the said Act would reveal that the same deals with an eventuality when the impugned trade mark is identical with or similar to the registered trade mark and is used in relation to goods or services which are not similar to those for which the trade mark is registered. Only in such an eventuality, it will be necessary to establish that 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. The legislative intent is clear by employing the word "and" after clauses (a) and (b) in sub section (4) of Section 29 of the said Act. Unless all the three conditions are satisfied, it will not be open to the proprietor of the registered trade mark to sue for infringement when though the impugned trade mark is identical with the registered trade mark, but is used in relation to goods or services which are not similar to those for which the trade mark is registered. To sum up, while sub-section (2) of Section 29 of the said Act deals with those situations where the trade mark is identical or similar and the goods covered by such a trade mark are identical or similar, sub-section (4) of Section 29 of the said Act deals with situations where though the trade mark is identical, but the goods or services are not similar to those for which the trade mark is registered."

17. In **Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd.**[(2001) 5 SCC 73], the Hon'ble Supreme Court held as under,

> "35. Broadly stated, in an action for passing-off on the basis of unregistered trade mark generally for deciding the question of deceptive similarity the following factors are to be considered:
> (a) The nature of the marks i.e. whether the marks are word marks or label marks or composite marks i.e. both words and label works.
> (b) The degree of resemblances between the marks, phonetically similar and hence similar in idea.
> (c) The nature of the goods in respect of which they are used as trademarks.
> (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."

18. In **Pernod Ricard India Private Limited and Another v. Karanveer Singh Chhabra** [2025 SCC OnLine SC 1701], the Hon'ble Supreme Court held as follows;

> "31. Trademark protection - whether based on name,

colour combination, trade dress, or structural features - centres on a mark's ability to distinguish the commercial origin of goods or services in the minds of consumers. The likelihood of confusion remains the cornerstone of both infringement and passing off actions.

31.1. A registered trademark is infringed when a person, in the course of trade, uses a mark that is identical or deceptively similar to a registered trademark in relation to similar goods or services. Section 2(1)(h) of the Trade Marks Act, 1999 defines 'deceptively similar' to mean 'a mark shall be deemed to be deceptively similar to another mark if it so nearly resembles that other mark as to be likely to deceive or cause confusion'.

31.2. Whether a trade mark is likely to deceive or cause confusion is a question of fact. Courts have consistently held that the broad and essential features of the rival marks must be considered. The assessment focuses on visual appearance, phonetic similarity, the nature of the goods, the class of purchasers, and the manner of sale.

31.3. As held in Parker - Knoll Ltd. v. Knoll International Ltd. [1962 RPC 265], proof of an intention to deceive is not required; a likelihood of confusion is sufficient to establish infringement or passing off. The evaluation must be made from the standpoint of an average consumer with imperfect recollection, emphasizing the overall commercial impression rather than engaging in a minute or mechanical comparison.

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32. A foundational principle in trademark law is that marks must be compared as a whole, and not by dissecting them into individual components. This is known as the anti-dissection rule, which reflects the real-world manner in which consumers perceive trademarks - based on their overall impression,

encompassing appearance, sound, structure, and commercial impression. In Kaviraj Pandit Durga Dutt Sharma v. Navratna Pharmaceuticals Laboratories (supra), this Court underscored that the correct test for trademark infringement is whether, when considered in its entirety, the defendant's mark is deceptively similar to the plaintiff's registered mark. The Court expressly cautioned against isolating individual parts of a composite mark, as such an approach disregard how consumers actually experience and recall trademarks.

32.1. While Section 17 of the Trade Marks Act, 1999 restricts exclusive rights to the trademark as a whole and does not confer protection over individual, non-distinctive components per se, courts may still identify dominant or essential features within a composite mark to assess the likelihood of confusion. However, this does not permit treating such features in isolation; rather, they must be evaluated in the context of the overall commercial impression created by the mark.

32.2. This approach finds further support in the observations of scholars such as McCarthy in Trademarks and Unfair Competition, who note that consumers seldom engage in detailed, analytical comparisons of competing marks. Purchasing decisions are instead based on imperfect recollection and the general impression created by a mark's sight, sound, and structure. The anti-dissection rule thus aligns the legal test for infringement with the actual behaviour and perception of consumers in the marketplace.

32.3. Consequently, in disputes involving composite marks, the mere presence of a shared or generic word in both marks does not, by itself, justify a finding of deceptive similarity. Courts must undertake a holistic comparison examining visual, phonetic, structural, and conceptual elements, to assess whether the overall impression created by the rival marks is likely

to mislead an average consumer of ordinary intelligence and imperfect memory. If the marks, viewed in totality, convey distinct identities, the use of a common element - particularly if it is descriptive or laudatory - will not by itself amount to infringement.

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33. In determining whether a mark is deceptively similar to another, courts often consider the dominant feature of the mark - that is, the element which is most distinctive, memorable, and likely to influence consumer perception. While the anti-dissection rule requires marks to be compared in their entirety, courts may still place emphasis on certain prominent or distinguishing elements, especially where such features significantly contribute to the overall commercial impression of the mark.

33.1. The principles of the anti-dissection rule and the dominant feature test, though seemingly in tension, are not mutually exclusive. Identifying a dominant feature can serve as an analytical aid in the holistic comparison of marks. In certain cases, an infringing component may overshadow the remainder of the mark to such an extent that confusion or deception becomes virtually inevitable. In such instances, courts - while maintaining a contextual and fact-specific inquiry - may justifiably assign greater weight to the dominant element. However, emphasis on a dominant feature alone cannot be determinative; 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.

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35. The average consumer test is a central standard in trademark and unfair competition law. It assesses whether there exists a likelihood of confusion between two marks, or whether a mark lacks

distinctiveness or is merely descriptive. The test is grounded in the perception of the average consumer - a person who is reasonably well informed, observant, and circumspect, but not an expert or overly analytical. As held by the European Court of Justice in Lloyd Schuhfabrik Meyer v. Klijsen Handel BV, the average consumer forms an overall impression of a mark rather than dissecting it into individual components.

35.1. A key feature of this test is the recognition that consumers rarely recall trademarks with perfect accuracy. For example, this Court in Amritdhara Pharmacy v. Satyadeo Gupta (supra) emphasized that the comparison must be made from the perspective of a person of average intelligence and imperfect recollection. Thus, minor phonetic or visual similarities may cause confusion if the marks share prominent or memorable features. The test also considers that the degree of consumer attentiveness may vary depending on the nature of the goods: greater care may be exercised when purchasing luxury items than in the case of everyday consumer goods.

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36. The Trade Marks Act, 1999 does not prescribe any rigid or exhaustive criteria for determining whether a mark is likely to deceive or cause confusion. Each case must necessarily be decided on its own facts and circumstances, with judicial precedents serving to illuminate the applicable tests and guiding principles rather than to dictate outcomes.

36.1. As a general rule, a proprietor whose statutory or common law rights are infringed is entitled to seek an injunction to restrain further unlawful use. However, this remedy is not absolute. The considerations governing the grant of injunctions in

trademark infringement actions broadly apply to passing off claims as well. That said, a fundamental distinction remains: while a registered proprietor may, upon proving infringement, seek to restrain all use of the infringing mark, a passing off action does not by itself confer an exclusive right. In appropriate cases, the court may mould relief in passing off so as to permit continued use by the defendant, provided it does not result in misrepresentation or deception.

36.2. The grant of injunction - whether for infringement or passing off - is ultimately governed by equitable principles and is subject to the general framework applicable to proprietary rights. Where actual infringement is established, that alone may justify injunctive relief; a plaintiff is not expected to wait for further acts of defiance. As judicially observed, "the life of a trademark depends upon the promptitude with which it is vindicated."

36.3. The principles laid down in American Cyanamid Co. v. Ethicon Ltd. continue to guide the Courts while determining interim injunction applications in trademark cases. The following criteria are generally applied:

(i) Serious question to be tried/triable issue: The plaintiff must show a genuine and substantial question fit for trial. It is not necessary to establish a likelihood of success at this stage, but the claim must be more than frivolous, vexatious or speculative.

(ii) Likelihood of confusion/deception: Although a detailed analysis of merits is not warranted at the interlocutory stage, courts may assess the prima facie strength of the case and the probability of consumer confusion or deception. Where the likelihood of confusion is weak or speculative, interim relief may be declined at the threshold.

(iii) Balance of convenience: The court must weigh

> the inconvenience or harm that may result to either party from the grant or refusal of injunction. If the refusal would likely result in irreparable harm to the plaintiff's goodwill or mislead consumers, the balance of convenience may favor granting the injunction.
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> (iv) Irreparable harm: Where the use of the impugned mark by the defendant may lead to dilution of the plaintiff's brand identity, loss of consumer goodwill, or deception of the public - harms which are inherently difficult to quantify - the remedy of damages may be inadequate. In such cases, irreparable harm is presumed.
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> (v) Public interest: In matters involving public health, safety, or widely consumed goods, courts may consider whether the public interest warrants injunctive relief to prevent confusion or deception in the marketplace.
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> 36.4. In conclusion, the grant of an interim injunction in trademark matters requires the court to consider multiple interrelated factors: prima facie case, likelihood of confusion, relative merits of the parties' claims, balance of convenience, risk of irreparable harm, and the public interest. These considerations operate cumulatively, and the absence of any one of these may be sufficient to decline interim relief.
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> 41. It is a settled principle of trademark law that deceptive similarity does not necessitate exact imitation. What is material is the likelihood of confusion or association in the minds of consumers arising from an overall resemblance between the competing marks. The applicable standard is that of an average consumer with imperfect recollection."

19. The Hon'ble Supreme Court in **Nandhini Deluxe v.**

Karnataka Cooperative Milk Producers [(2018) 9 SCC 183]

held as under :-

> "32. Having arrived at the aforesaid conclusion, the reasoning of the High Court that the goods belonging to the appellant and the respondent (though the nature of goods is different) belong to the same class and, therefore, it would be impermissible for the appellant to have the registration of the trade mark concerned in its favour, would be meaningless. That apart, there is no such principle of law. On the contrary, this Court in Vishnudas Trading v. Vazir Sultan Tobacco Co. Ltd., (1997) 4 SCC 201 has decided otherwise as can be seen from the reading of paras 47 and 48 of the said judgment: (SCC pp. 223-25)
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> > "47. The respondent Company got registration of its brand name "Charminar" under the broad classification "manufactured tobacco". So long such registration remains operative, the respondent Company is entitled to claim exclusive use of the said brand name in respect of articles made of tobacco coming under the said broad classification "manufactured tobacco". Precisely for the said reason, when the appellant made application for registration of quiwam and zarda under the same brand name "Charminar", such prayer for registration was not allowed. The appellant, therefore, made application for rectification of the registration made in favour of the respondent Company so that the said registration is limited only in respect of the articles being manufactured and marketed by the respondent Company, namely, cigarettes. In our view, if a trader or manufacturer actually trades in or manufactures only one or some of the

articles coming under a broad classification and such trader or manufacturer has no bona fide intention to trade in or manufacture other goods or articles which also fall under the said broad classification, such trader or manufacturer should not be permitted to enjoy monopoly in respect of all the articles which may come under such broad classification and by that process preclude the other traders or manufacturers from getting registration of separate and distinct goods which may also be grouped under the broad classification. If registration has been given generally in respect of all the articles coming under the broad classification and if it is established that the trader or manufacturer who got such registration had not intended to use any other article except the articles being used by such trader or manufacturer, the registration of such trader is liable to be rectified by limiting the ambit of registration and confining such registration to the specific article or articles which really concern the trader or manufacturer enjoying the registration made in his favour. In our view, if rectification in such circumstances is not allowed, the trader or manufacturer by virtue of earlier registration will be permitted to enjoy the mischief of trafficking in trade mark. Looking to the scheme of the registration of trade mark as envisaged in the Trade Marks Act and the Rules framed thereunder, it appears to us that registration of a trade mark cannot be held to be absolute, perpetual and invariable under all circumstances. Section 12 of the Trade Marks Act prohibits registration of identical or deceptively similar trade marks in respect of goods and description of goods which is identical or deceptively similar to the trade mark already

registered. For prohibiting registration under Section 12(1), goods in respect of which subsequent registration is sought for, must be (i) in respect of goods or description of goods being same or similar and covered by earlier registration, and (ii) trade mark claimed for such goods must be same or deceptively similar to the trade mark already registered. It may be noted here that under sub-section (3) of Section 12 of the Trade Marks Act, in an appropriate case of honest concurrent use and/or of other special circumstances, same and deceptively similar trade marks may be permitted to another by the Registrar, subject to such conditions as may deem just and proper to the Registrar. It is also to be noted that the expressions "goods" and "description of goods" appearing in Section 12(1) of the Trade Marks Act indicate that registration may be made in respect of one or more goods or of all goods conforming a general description. The Trade Marks Act has noted distinction between description of goods forming a genus and separate and distinctly identifiable goods under the genus in various other sections e.g. goods of same description in Section 46, Sections 12 and 34 and class of goods in Section 18, Rules 12 and 26 read with Fourth Schedule to the Rules framed under the Act.

48. The "class" mentioned in the Fourth Schedule may subsume or comprise a number of goods or articles which are separately identifiable and vendible and which are not goods of the same description as commonly understood in trade or in common parlance. Manufactured tobacco is a class mentioned in Class 34 of Fourth Schedule of the Rules but within the said class, there are a

> number of distinctly identifiable goods which are marketed separately and also used differently. In our view, it is not only permissible but it will be only just and proper to register one or more articles under a class or genus if in reality registration only in respect of such articles is intended, by specifically mentioning the names of such articles and by indicating the class under which such article or articles are to be comprised. It is, therefore, permissible to register only cigarette or some other specific products made of "manufactured tobacco" as mentioned in Class 34 of Fourth Schedule of the Rules. In our view, the contention of Mr Vaidyanathan that in view of change in the language of Section 8 of the Trade Marks Act as compared to Section 5 of the Trade Marks Act, 1940, registration of trade mark is to be made only in respect of class or genus and not in respect of articles of different species under the genus is based on incorrect appreciation of Section 8 of the Trade Marks Act and Fourth Schedule of the Rules."
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> (emphasis supplied)

33. We may mention that the aforesaid principle of law while interpreting the provisions of the Trade and Merchandise Marks Act, 1958 is equally applicable as it is unaffected by the Trade Marks Act, 1999 inasmuch as the main object underlying the said principle is that the proprietor of a trade mark cannot enjoy monopoly over the entire class of goods and, particularly, when he is not using the said trade mark in respect of certain goods falling under the same class. In this behalf, we may usefully refer to Section 11 of the Act which prohibits the registration of the mark in respect of the similar goods or different goods but the provisions of this section do not cover the same class of goods."

20. Now I shall mention the judgments cited by the learned Counsel for the respondent. In **Corn Products Refining Co. v. Shangrila Food Products Ltd.**, [1959 SCC OnLine SC 11] the the Hon'ble Supreme Court held as under :-

> "21. It is true that in both the abovementioned cases the two competing trade marks were absolutely identical which is not the case here. But that in our opinion makes no difference. The absolute identity of the two competing marks or their close resemblance is only one of the tests for determining the question of likelihood of deception or confusion. Trade connection between different goods is another such test. Ex hypothesi, this latter test applies only when the goods are different. These tests are independent tests. There is no reason why the test of trade connection between different goods should not apply where the competing marks closely resemble each other just as much as it applies, as held in the "Black Magic" and "Panda" cases, where the competing marks were identical. Whether by applying these tests in a particular case the conclusion that there is likelihood of deception or confusion should be arrived at would depend on all the facts of the case.
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> 22. It is then said that biscuits containing glucose are manufactured with liquid glucose whereas the appellant's mark only concerns powder glucose. We will assume that only liquid glucose is used in the manufacture of biscuits with glucose. But there is nothing to show that an average buyer knows with what kind of glucose, biscuits containing glucose are or can be made. That there is trade connection between glucose and biscuits and a likelihood of confusion or

> deception arising therefrom would appear from the fact stated by the appellant that it received from a tradesman an enquiry for biscuits manufactured by it under its mark 'Glucovita'. The tradesman making the enquiry apparently thought that the manufacturer of 'Glucovita' glucose was likely to manufacture biscuits with glucose; he did not worry whether biscuits were made with powder or liquid glucose. Then again it is stated in one of the affidavits filed by the appellant that the respondent's director told the appellant's manager that the respondent had adopted the name 'Gluvita' to indicate that in the manufacture of its biscuits glucose was used. Those statements on behalf of the appellant are not denied by the respondent. So, a trade connection between glucose and biscuits would appear to be established. We are therefore of opinion that the commodities concerned in the present case are so connected as to make confusion or deception likely in view of the similarity of the two trade marks. We think that the decision of Desai, J., was right."

21. In **T.V. Venugopal v. Ushodaya Enterprises Limited.**, [(2011) 4 SCC 85] the Apex Court held as extracted hereunder:-

> "28. The respondent Company has argued before this Court that the descriptive nature of the mark has to be determined with respect to the appellant's goods. This approach according to the appellant is completely erroneous. While determining the nature of the mark—for the purpose of registration or for the purpose of passing off/infringement, the first inquiry which the court ought to carry out is to determine whether the applicant's/plaintiff's mark is invented,

> arbitrary/suggestive, descriptive or generic. The nature of the mark is always determined with respect to the plaintiff's/applicant's goods. For example, if a person applies for a trade mark called "Extra Strong", the Registrar of Trade Marks has to examine whether the mark is descriptive or laudatory for the goods for which it is applied i.e. the applicant's goods. The inquiry does not depend on the person opposing the use of the said mark. Thus, to hold that the nature of the mark has to be determined by the nature of the appellant's goods is stating the proposition in the reverse.
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> .....
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> 78. The learned counsel for the respondent Company also submitted that the protection qua common field of activity has now expanded and been interpreted to mean extending to other product lines than what is manufactured by the plaintiff and hence common field of activity is not restricted to same or similar products but extend to all other products. The test of common field of activity now accepted is that of "common class of consumers". The reason for this is the likelihood of such consumers identifying the defendant's goods as originating from the same source as the plaintiff. The question therefore would be, whether from the factual situation, an inference can be drawn that a purchaser of the defendant's product could assume such product as originating from the plaintiff."

22. In **Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd.**,[(2001) 5 SCC 73] Hon'ble Supreme Court held thus:-

> "18. We are unable to agree with the aforesaid observations in Dychem case [(2000) 5 SCC 573]. As

far as this Court is concerned, the decisions in the last four decades have clearly laid down that what has to be seen in the case of a passing-off action is the similarity between the competing marks and to determine whether there is likelihood of deception or causing confusion. This is evident from the decisions of this Court in the cases of National Sewing Thread Co. Ltd. case [(1953) 1 SCC 794 : AIR 1953 SC 357], Corn Products Refining Co. case [AIR 1960 SC 142 : (1960) 1 SCR 968], Amritdhara Pharmacy case [AIR 1963 SC 449], Durga Dutt Sharma case [AIR 1965 SC 980] and Hoffmann-La Roche & Co. Ltd. case [(1969) 2 SCC 716]. Having come to the conclusion, in our opinion incorrectly, that the difference in essential features is relevant, this Court in Dyechem case [(2000) 5 SCC 573] sought to examine the difference in the two marks "piknik" and "picnic". It applied three tests, they being: (1) is there any special aspect of the common feature which has been copied? (2) mode in which the parts are put together differently i.e. whether dissimilarity of the part or parts is enough to make the whole thing dissimilar, and (3) whether, when there are common elements, should one not pay more regard to the parts which are not common, while at the same time not disregarding the common parts? In examining the marks, keeping the aforesaid three tests in mind, it came to the conclusion, seeing the manner in which the two words were written and the peculiarity of the script and concluded (at SCC p. 597, para 39) that "the above three dissimilarities have to be given more importance than the phonetic similarity or the similarity in the use of the word picnic for piknik".

19. With respect, we are unable to agree that the principle of phonetic similarity has to be jettisoned when the manner in which the competing words are written is different and the conclusion so arrived at is clearly contrary to the binding precedent of this Court

in Amritdhara case [AIR 1963 SC 449] where the phonetic similarity was applied by judging the two competing marks. Similarly, in Durga Dutt Sharma case [AIR 1965 SC 980] it was observed that: (AIR p. 990, para 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 plaintiffs 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."

.....

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

> (a) The nature of the marks i.e. whether the marks are word marks or label marks or composite marks i.e. both words and label works.
>
> (b) The degree of resemblances between the marks, phonetically similar and hence similar in idea.
>
> (c) The nature of the goods in respect of which they are used as trademarks.
>
> (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."

23. In **Seematti Silks Vs. T. Beena** [MANU/KE/2463/2023], this Court held as follows:-

> "10. In Wander Ltd. v. Antox India (P) Ltd., MANU/SC/0595/1990 : 1990 Supp SCC 727, in paragraph No. 14, it was held as follows :
>
> 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 [MANU/SC/0001/1960 : (1960) 3 SCR 713 : AIR 1960 SC 1156]:(SCR 721)
>
> > "... These principles are well established, but as has been observed by Viscount Simon in Charles Osenton & Co. v. Jhanaton [1942 AC 130] '...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'."

11. The apex court has, a number of times cautioned that the appellate court should not interfere with the exercise of discretion of the court at the first instance and substitute its own discretion except where the discretion has been shown to have been exercised arbitrarily, capriciously or perversely. The learned Additional District Judge had exercised his discretion and found that irreparable injury and hardship would be caused to the respondent/plaintiff, if the appellant/defendant is allowed to use the trade name 'SEEMATTI SILKS', which is very similar to the name of plaintiff 'SEEMATTI'. The learned District Judge also found that since the suit is stayed under Section 124 of the Act, the defendant if not restrained and will be using the said name will cause irreparable injury, hardship and loss to the plaintiff also. The learned Judge also found prima facie case and balance of convenience in favour of the plaintiff and irreparable injury would be caused if an interim injunction is not granted. Therefore, in view of the dictum laid down by

> the apex court in Wander Ltd. (supra) and also the fact that the learned Judge found that the respondent will be put to irreparable injury, hardship and loss will be caused and the balance of convenience is in favour of the respondent, I am of the view that the learned Additional District Judge is perfectly justified in granting interim injunction as prayed for. Therefore, the First Appeal from Orders lacks merit and it is dismissed."

24. In **Kamal Raheja v. Hahnemann Pure Drug Co.** [2025 SCC OnLine Del 7718] the Delhi High Court held that commercial use of the mark is not required for an infringement action to lie. Once the registration of the mark is subsisting, Section 28(1) grants to the registrant, the right to seek relief against infringement. Infringement, as defined in the various sub-sections of Section 29 of the Trade Marks Act, is not dependent on use, but on registration. Each sub-section of Section 29 commences with the words "a registered trade mark". Thus, the plaintiff's trade mark is required to be registered, and the registration subsisting; nothing more. As such, commercial user of the registered mark is not a sine qua non for an infringement action to lie. There is no provision, in

the Trade Marks Act which can deem a registered trademark not to be registered, or divest the proprietor of a registered trade mark from the rights conferred by Section 28(1) as a consequence of such registration, merely because the mark is not in commercial use. The right to seek relief against infringement under Section 28(1) read with Section 135(1) of the Trade Marks Act cannot, in any event, be sacrificed at the altar of use.

25. In **Bayerische Motoren Werke Ag v. Om Balajee Automobile (India) Private Limited** [2020 SCC OnLine Del 484] the Delhi High Court held that the brand of the defendant was visually and phonetically similar to the mark of the plaintiff. Further, the plaintiff's mark was a well-known trade mark and use of the aforesaid mark by the defendant on its product constituted infringement within the meaning of Section 29(4) of the Trade Marks Act. The defendant was obviously seeking to encash upon the brand quality and goodwill which the mark

BMW enjoys in the market. Such use by the defendant was held detrimental to the reputation of the registered mark BMW of the plaintiff company. The defendant was therefore held prima facie guilty of infringement of the trade mark of the petitioner.

26. In **FDC Limited v. Docsuggest Healthcare Services Pvt. Ltd. & Anr** [2017 SCC OnLine Del 6381] the Delhi High Court held that While the Act is silent on the factors to be considered for similarity in goods/services, the Courts in India - relying upon international cases and literature, have consolidated the guiding principles and factors found relevant in ascertaining the similarity between goods/services. These principles were outlined in detail.

27. In **Metro Playing Card Co. v. Wazir Chand Kapoor** [1972 SCC OnLine Del 109] the Delhi High Court held that no doubt registration may be granted for concurrent user as provided by the law but till registration is granted there can be no doubt that the respondent's trade mark is infringed by

the appellant and that the statutory right which the respondent has under Section 28 of the Act is violated.

28. In **Satyam Infoway Ltd. v. Sifynet Solutions Pvt. Ltd.** [(2004) 6 SCC 145], the Hon'ble Supreme Court held as under:

> "13. The next question is, would the principles of trade mark law and in particular those relating to passing off apply? An action for passing off, as the phrase "passing off" itself suggests, is to restrain the defendant from passing off its goods or services to the public as that of the plaintiff's. It is an action not only to preserve the reputation of the plaintiff but also to safeguard the public. The defendant must have sold its goods or offered its services in a manner which has deceived or would be likely to deceive the public into thinking that the defendant's goods or services are the plaintiff's. The action is normally available to the owner of a distinctive trade mark and the person who, if the word or name is an invented one, invents and uses it. If two trade rivals claim to have individually invented the same mark, then the trader who is able to establish prior user will succeed. The question is, as has been aptly put, who gets these first? It is not essential for the plaintiff to prove long user to establish reputation in a passing-off action. It would depend upon the volume of sales and extent of advertisement.
> 14. The second element that must be established by a plaintiff in a passing-off action is misrepresentation by the defendant to the public. The word misrepresentation does not mean that the plaintiff has to prove any mala fide intention on the part of the defendant. Of course, if

> the misrepresentation is intentional, it might lead to an inference that the reputation of the plaintiff is such that it is worth the defendant's while to cash in on it. An innocent misrepresentation would be relevant only on the question of the ultimate relief which would be granted to the plaintiff [Cadbury Schweppes v. Pub Squash, 1981 RPC 429 : (1981) 1 All ER 213 : (1981) 1 WLR 193 (PC); Erven Warnink v. Townend, 1980 RPC 31 : (1979) 2 All ER 927 : 1979 AC 731 (HL)]. What has to be established is the likelihood of confusion in the minds of the public (the word "public" being understood to mean actual or potential customers or users) that the goods or services offered by the defendant are the goods or the services of the plaintiff. In assessing the likelihood of such confusion the courts must allow for the "imperfect recollection of a person of ordinary memory" [Aristoc v. Rysta, 1945 AC 68 : (1945) 1 All ER 34 (HL)].
>
> 15. The third element of a passing-off action is loss or the likelihood of it."

29. In **Gujarat Bottling Co. Ltd. And Others v. Coca Cola Co. and Others** [(1995) 5 SCC 545], the Apex Court analysed the provisions and scheme of the Trade Marks Act. It was held that in respect of a trade mark registered under the provisions of the Act certain statutory rights have been conferred on the registered proprietor which enable him to sue for the infringement of the trade mark irrespective of whether or not the mark is used.

30. In **American Home Products Corporation v. Mac Laboratories Pvt. Ltd. and Another** [(1986) 1 SCC 465], the Apex Court held as follows:-

> "36.....
> When a person gets his trade mark registered, he acquires valuable rights by reason of such registration. Registration of his trade mark gives him the exclusive right to the use of the trade mark in connection with the goods in respect of which it is registered and if there is any invasion of this right by any other person using a mark which is the same or deceptively similar to his trade mark, he can protect his trade mark by an action for infringement in which he can obtain injunction, damages or an account of profits made by the other person. In such an action, the registration of a trade mark is prima facie evidence of its validity. After the expiry of seven years from the date of the registration a trade mark is to be valid in all respects except in the three cases set out in Section 32. The proprietor of an unregistered trade mark whose mark is unauthorisedly used by another cannot, however, sue for the infringement of such trade mark. His only remedy lies in bringing a passing-off action, an inconvenient remedy as compared to an infringement action. In a passing-off action the plaintiff will have to prove that his mark has by user acquired such reputation as to become distinctive of the plaintiff's goods so that if it is used in relation to any goods of the kind dealt with by the plaintiff, it will be understood by the trade and public as meaning that the goods are the plaintiff's goods. In an infringement action, the plaintiff is not required to prove the reputation of his mark. Further, under Section 37 a registered mark is assignable and transmissible either with or without goodwill of the business concerned while under Section 38, an

> unregistered trade mark is not assignable or transmissible except in the three cases set out in Section 38(2).”

31. In **Ruston & Hornsby Ltd. v. Zamindara Engineering Co.** [(1969) 2 SCC 727], Hon'ble Supreme Court held as under:-

> “5. The action for infringement is a statutory right. It is dependent upon the validity of the registration and subject to other restrictions laid down in Sections 30, 34 and 35 of the Act. On the other hand the gist of a passing off action is that A is not entitled to represent his goods as the goods of B but it is not necessary for B to prove that A did this knowingly or with any intent to deceive. It is enough that the get-up of B's goods has become distinctive of them and that there is a probability of confusion between them and the goods of A. No case of actual deception nor any actual damage need be proved. At common law the action was not maintainable unless there had been fraud on A's part. In equity, however, Lord Cottenham, L.C., in Millington v. Fox [(1838) 40 ER 956 : 3 My & Cr 338] held that it was immaterial whether the defendant had been fraudulent or not in using the plaintiff's trade mark and granted an injunction accordingly. The common law courts, however, adhered to their view that fraud was necessary until the Judicature Acts, by fusing law and equity, gave the equitable rule the victory over the common law rule.
>
> 6. The two actions, however, are closely similar in some respects. As was observed by the Master of the Rolls in Saville Perfumery Ltd. v. June Perfect Ltd. [(1941) 58 RPC 147 at 161]:
>
> “The statute law relating to infringement of trade marks is based on the same fundamental idea as the law

> relating to passing-off. But it differs from that law in two particulars, namely (1) it is concerned only with one method of passing-off, namely, the use of a trade mark, and (2) the statutory protection is absolute in the sense that once a mark is shown to offend, the user of it cannot escape by showing that by something outside the actual mark itself he has distinguished his goods from those of the registered proprietor. Accordingly, in considering the question of infringement the Courts have held, and it is now expressly provided by the Trade Marks Act, 1938, Section 4, that infringement takes place not merely by exact imitation but by the use of a mark so nearly resembling the registered mark as to be likely to deceive.
> 7. In an action for infringement where the defendant's trademark is identical with the plaintiff's mark, the Court will not enquire whether the infringement is such as is likely to deceive or cause confusion. But where the alleged infringement consists of using not the exact mark on the Register, but something similar to it, the test of infringement is the same as in an action for passing off. In other words, the test as to likelihood of confusion or deception arising from similarity of marks is the same both in infringement and passing off actions."

32. In **National Garments, Kaloor, Cochin v. National Apparels, Ernakulam, Cochin** [1989 SCC OnLine Ker 115], this Court made the following observations:-

> "6……
> The plaintiff in an action for passing off therefore has to establish that his products have derived from the advertising a distinctive character recognised by the market. Plainly stated the principle of law is that "nobody has any right to represent his goods as the

> goods of somebody else" and sell it in the market for his own aggrandisement. This rule has been treated as a special instance carved out of the general rule that any misrepresentation calculated to give one trader the benefit of another's goodwill is actionable. Generally stated any misrepresentation calculated to injure another in his trade or business can be regarded as passing off (See Burberrys v. Cording, (1909) 26 RPC 693 at 701). Nonetheless in an action for passing off, a plaintiff need not prove any malice unlike the plaintiff in a tortious action for injurious falsehood. Likewise proof of damage as such is not essential to enable the plaintiff to maintain an action for passing-off. Why it is said so is that the confusion brought about by the action of the defendant puts the plaintiff's goodwill at risk. To put it briefly "the plaintiff in an action for passing off must show, if not that he has some sort of business which is threatened by the defendant's activities, at least that his interest is something akin to that of the owner of a business". (See Kean v. Mc Given, (1982) FSR 119)."

33. In **Ashok Leyland Limited v. Blue Hill Logistics Pvt. Ltd.** [2010 SCC OnLine Mad 6126], the Madras High Court held that the reputation of a trade mark has to be assessed on the basis of several factors, such as the publicity that preceded and succeeded the launch of the product carrying the mark, the volume of turnover and the impact that the mark has created in the minds of the public, enabling them to associate the mark

with the product. The reputation of the mark need not always be reflected by the volume of turnover alone. The goodwill of a business depends upon a variety of circumstances or a combination of them. The location, the service, the standing of the business, the honesty of those who run it, and the lack of competition and many other factors go individually or together to make up the goodwill, though locality always plays a considerable part. Shift the locality, and the goodwill may be lost. At the same time, locality is not everything. The power to attract customers depends on one or more of the other factors as well. In the case of a theater or restaurant, what is catered, how the service is run and what the competition is, contribute also to the goodwill. It was also held that there are two distinct features in Section 29(4)(c). One is with regard to the reputation of the mark in contra-distinction to the reputation of its maker. The other is that Section 29(4)(c) deals only with the reputation of the mark and not the reputation of "well known

trade mark". The Act defines a well-known trade mark under Section 2(1)(zg). The lawmakers have been careful enough not to incorporate the expression "well known trade mark" in Section 29(4)(c), though they chose to use the expression "reputation". In other words, Section 29(4)(c) does not expect the registered trade mark of the Plaintiff to have become a 'well known trade mark' within the meaning of Section 2(1)(zg). Section 29(4)(c) requires the registered trade mark only to have acquired a reputation in India.

34. In **Crompton Greaves Consumer Electricals Limited v. V-Guard Industries Limited** [2024 SCC OnLine Del 1838] the Delhi High Court held that Section 29(4) of the Trade Marks Act essentially relates with the dilution principle which does not require the presence of deception and confusion. The provision was inserted by way of amendment in the year 1999. However, the doctrine of anti-dilution was recognised through judicial precedents. The law recognised the protection

of those marks which are reputed in character. It is important to note that the Trade Marks Act provides a definition of a well-known trade mark in Section 2(1)(zg) and the factors that are required to be considered while determining a mark as a well-known mark are provided in Section 11(7) of the Trade Marks Act. However, Section 29(4) of the Trade Marks Act uses the expression "reputation" and not "well-known mark". Thus, it is not required for the proprietor of the registered mark to show that the mark is a well-known mark as defined in Section 2(1)(zg) of the Trade Marks Act but has to prima facie satisfy that the mark has a reputation in India. (Ref. : Bloomberg Finance LP v. Prafull Saklecha [2013) SCC OnLine DEL 4159]). At the stage of deciding the application under Sections 39(1) and (2) of the CPC, the plaintiff has to prima facie satisfy about the existence of reputation in India. It is recognised that the prima facie indicator of the reputation of the mark can be sales figure and the promotional expenses qua a particular product on which the

registered trade mark is applied. The court has to consider whether the plaintiff has built up a goodwill where a damage will be caused to it in case the mark is allowed to be used by a third party. The law, therefore, recognises that even in case where there is no likelihood of confusion, the use of the trade mark by a third party can be protected in case it is shown that the registered mark has a reputation and a distinctive character. The law, in fact, affords a stronger protection to such marks and, therefore, protects even if the same is used on goods and services which are not similar. The proprietor does not have to demonstrate the likelihood of any confusion.

35. In an appeal arising from an interim order, the appellate court shall be careful to analyse whether the lower forum has exercised its discretion in an arbitrary, capricious or perverse fashion. If no such vitiating factor exists, the appellate court will not be justified in interfering with the discretion exercised by the lower forum. Substituting the view adopted by

the lower forum with its own views by the appellate forum, without any vitiating factors established, would not be a proper exercise of the appellate powers. Keeping in mind these principles, I shall now analyse the contentions of both sides.

36. The learned counsel for the appellant had submitted that the respondent, though obtained registration under Class 43 is not actually running any restaurants. He submitted that merely for the reason that the respondent has obtained registration under Class 43, it cannot claim monopoly and on account of non-user, it cannot be permitted to object to the appellant being granted registration for its trademark and running of the restaurant. Heavy reliance was placed by the learned counsel for the appellant on the judgment of the Hon'ble Supreme Court in **Nandhini Deluxe** (Supra). It was held therein that proprietor of a trademark cannot enjoy monopoly over the entire class of goods particularly when he is not using the said trademark in respect of certain goods falling under the

same class. The learned counsel for the respondent, on the other hand, maintained that user is not a relevant factor when infringement is alleged. He relied on the judgment of the Hon'ble Supreme Court in **Gujarat Bottling Co. Ltd. And Others**(Supra). The Apex Court held explicitly that registration of a trademark confers certain statutory rights on the registered proprietor, enabling him to sue for infringement irrespective of whether or not that mark is used. In **American Home Products Corporation** (Supra) the Hon'ble Supreme Court held that registration of a trademark gives the proprietor exclusive right to use the trademark and if there is any invasion of this right by any other person using a mark which is identical or deceptively similar, the registered proprietor can protect his right by resorting to an action for infringement. As rightly pointed out by the learned counsel for the respondent, in **Nandhini Deluxe** (Supra) the Hon'ble Supreme Court was considering an appeal pertaining to an application for

registration of a trademark. Context of the case considered by the Hon'ble Supreme Court being totally different, I am of the view that the judgment in **Nandhini Deluxe** (Supra) cannot be of any support to the appellant in this regard. On the contrary, in view of the law laid down in **Gujarat Bottling Co. Ltd. And Others**(Supra) the contention of the appellant is liable to be rejected.

37. It was vehemently argued by the learned counsel for the appellant that the appellants' trademark 'HAZZA' is an Arabic word having no similarity with the registered trademark of the respondent LAZZA. The respondent has no case that the marks are identical. However, it contends that the mark of the appellant is deceptively similar. It is pointed out that the said word is coined by substituting letter 'L' in the trademark of the respondent with letter 'H'. It is also alleged that the two marks are phonetically similar. Moreover, it is contended that the colour scheme of both marks are identical with black and golden

colours. It is trite law that the test in this regard shall be as to whether any deception and confusion is likely to be created. The trial court on a detailed analysis held that the trademark 'HAZZA' of the appellant is likely to cause deception and confusion. The learned counsel for the appellant contended that the trial court has violated anti-dissection rule in analysing the marks and arriving at the conclusion. On perusal of the impugned order, I am not in a position to agree with the submission of the learned counsel for the appellant in this regard. What is relevant is the overall impression created by the mark. In **Pernod Ricard India Private Limited and Another**(Supra), the Hon'ble Supreme Court held that, in an infringement analysis, the test is whether there is likelihood of confusion or association in the mind of the public. It is not a matter dependent on testimonial evidence. It is a matter of judicial determination. There is no requirement to prove actual deception or damage. Trademarks are remembered by their

overall commercial impression and even minor variations may be perceived by consumers as brand extensions or sub-brands. When the marks of the appellant and the respondent are compared, keeping in mind the above principles, on account of phonetic similarity, adoption of similar colour scheme, and the fact that the variation is minor, involving the change of a single alphabet, there is very high likelihood of the mark of the appellant being perceived as a sub-brand or brand extension of the respondent. Though the learned Counsel for the appellant submitted that the trademark of the appellant is unique and distinct with a graphic design and the word kitchen below the word "HAZZA" , the prominent feature of the mark is the word "HAZZA" and the graphic design and addition of the word "kitchen" in comparatively small fonts are not sufficient to weaken the visual and phonetic similarity.

38. It is to be kept in mind that the Court need not look into as to whether there is proof of an intention to deceive. A

likelihood of confusion is sufficient to establish infringement or passing off. The overall commercial impression is what matters. Engaging in a minute or mechanical comparison is not a right approach. The court has to keep in mind that consumers seldom engage in detailed and meticulous comparisons of different marks. Impression created by the visual appearance, structure and sound may influence the decision of the consumer. Phonetic or visual similarities may cause confusion to average consumers. It is well accepted that alertness of the consumer may not be at a higher degree when involving in purchasing as part of daily affairs. If the trademarks of the appellant and the respondent are compared keeping in mind the above aspects the inevitable conclusion is that the trademark of the appellant is deceptively similar to that of the respondent.

39. It is very significant in this regard to note that the appellant chose to open the restaurant on the opposite side of the road in the same locality where the factory of the

respondent is functioning. Appellant is not operating an eatery anywhere else in the same trade name and using the same trademark. Hence there is every reason to prima facie assume that the intention was not honest.

40. In the case at hand, the respondent has two contentions in the suit: infringement of the rights under the Trademark Act as well as passing off. In **Ruston & Hornsby Ltd.** (Supra), the Hon'ble Supreme Court held as under:-

> "7.In an action for infringement where the defendant's trade mark is identical with the plaintiff's mark, the Court will not enquire whether the infringement is such as is likely to deceive or cause confusion. But, where the alleged infringement consists of using not the exact mark on the Register, but something similar to it, the test of infringement is the same as in an action for passing off. In other words, the test as to likelihood of confusion or deception arising from similarity of marks is the same both in infringement and passing off actions."

41. Respondent contends that the action of the appellant in using the allegedly deceptively similar trademark amounts to infringement of trademarks under Section 29(1) and 29(2)(b) of

the Trademarks Act, apart from constituting passing off. It is also contended that 'LAZZA' is a well-known trademark included in the list published by the Trademark Registry. For the reasons already discussed in the preceding paragraphs, in my view, the appellant, by adopting and using the mark 'HAZZA' that is similar to the registered trademark 'LAZZA' of the respondent in Class 43, for running a restaurant close to the factory of the respondent, has prima facie infringed the registered trademark of the respondent. It is also to be noted that the trial court, in the impugned order, has held that infringement under Section 29(4) is also involved. Since the respondent's trademark is included in the list of well-known trademarks, it must be prima facie assumed that it has acquired a reputation. Even if the contention of the appellant that it is engaged purely in running a restaurant, that the respondent, though having obtained registration in Class 43, is not actually engaged in running any restaurant, and that both are engaged in the business of

different sets of products is accepted, the circumstances mentioned under Section 29(4) of the Act are still satisfied.

42. The respondent has a case that the appellant is liable to be proceeded against also for passing off. In **Satyam Infoway Ltd.**(Supra), the Hon'ble Supreme Court held that the action for passing off is intended not only to preserve the reputation of the plaintiff, but also to safe-guard the public. The defendant must have sold its goods or offered its services in a manner that has deceived or would be likely to deceive the public into thinking that the defendant’s goods or services are those of the plaintiff. The second element to be established by the plaintiff is misrepresentation by the defendant to the public. The third element of a passing off action is loss or likelihood of it. It is also relevant to keep in mind the factors delineated by the Hon'ble Supreme Court in **Cadila Health Care Ltd.**(Supra). If the facts and circumstances of the instant case, as noted already are analysed, keeping in mind the parameters laid

down by the Hon'ble Supreme Court, it must be held that the respondent has prima facie established a strong case for action against passing off also.

43. In **Pernod Ricard India Private Limited and Another**(Supra), the Hon'ble Supreme Court held that the principles laid down in **American Cyanamid Co. v. Ethicon Ltd.** [(1975) AC 396] continue to guide the Courts while determining interim injunction applications in trademark cases. It was pointed out that the following criteria are generally applied:-

> "36.3. …….
>
> (i) Serious question to be tried / triable issue: The plaintiff must show a genuine and substantial question fit for trial. It is not necessary to establish a likelihood of success at this stage, but the claim must be more than frivolous, vexatious or speculative.
>
> (ii) Likelihood of confusion / deception: Although a detailed analysis of merits is not warranted at the interlocutory stage, courts may assess the prima facie strength of the case and the probability of consumer confusion or deception. Where the likelihood of confusion is weak or speculative, interim relief may be declined at the threshold.
>
> (iii) Balance of convenience: The court must weigh

> the inconvenience or harm that may result to either party from the grant or refusal of injunction. If the refusal would likely result in irreparable harm to the plaintiff's goodwill or mislead consumers, the balance of convenience may favor granting the injunction. (iv) Irreparable harm: Where the use of the impugned mark by the defendant may lead to dilution of the plaintiff's brand identity, loss of consumer goodwill, or deception of the public harms which are inherently difficult to quantify the remedy of damages may be inadequate. In such cases, irreparable harm is presumed.
>
> (v) Public interest: In matters involving public health, safety, or widely consumed goods, courts may consider whether the public interest warrants injunctive relief to prevent confusion or deception in the marketplace."

44. In the case on hand, definitely, substantial issues arise for trial. The suit claim is not frivolous or vexatious. As found already, there is a real likelihood of consumer confusion or deception. Since the respondent is a reputed entity having its trademark registered long ago, the balance of convenience is in its favour. If the appellant is not restrained by an interim injunction during the pendency of the suit, irreparable harm is likely to be caused to the respondent. So also, the services of

the appellant are likely to be perceived by the general public as an extension or sub-brand of the respondent. Hence, permitting the appellant to continue its business under the impugned trademark would be against public interest also. Therefore, the case on hand is an eminently fit one for the grant of an interim injunction.

In the light of the afore discussion, I uphold the impugned order. The appeal is accordingly dismissed. No costs.

Sd/-
S.MANU
JUDGE

skj