



4) Salma Mohammed Faisal Shamsi ]  
 Designated partner of Ahmed Al Maghribi ]  
 LLP having its address at 2<sup>nd</sup> Floor, Shop. No. ]  
 25, 14, Shirin Mansion Mumbai, Maharashtra, ]  
 400003 ]

**...Respondents/  
 Defendants**

Mr. Venkatesh Dhond, Senior Advocate a/w. Mr. Hiren Kamod a/w. Mr. Pratik Pansare a/w Mr. Anshul Saurastri a/w. Ms. Preeti Panthaki and Mr. Atif Sayyed i/b. Krishna & Saurastri Associates LLP, Advocate for the Plaintiff/Applicant.

Ms. Shagufta Ansari a/w. Mr. Khwaja Shaikh, Advocate for the Defendant/Respondent.

**CORAM : SHARMILA U. DESHMUKH**  
**RESERVED ON : April 6<sup>th</sup>,2026**  
**PRONOUNCED ON : May 7<sup>th</sup>,2026**

**ORDER :**

1. By the present Interim Application, the Plaintiff seeks injunctive reliefs against the Defendants restraining them from infringing the Plaintiff's copyright in the artistic work comprised in the Plaintiff's logos

viz  ,  ,  ,  and to restrain the Defendants from using the impugned marks i.e. AHMED AL MAGHRIBI,

 ,  ,  , 'Al Ahmed',



, BIN SHAIKH, OUD & ROSES, KAAF and MARJ, and/or the impugned corporate name “Ahmed Al Maghribi LLP” and/or the domain name [www.ahmedindia.com](http://www.ahmedindia.com) so as to pass of its impugned goods as that of the Plaintiff.

2. The Plaintiffs claim that in or around the year 2000, the the Plaintiff No. 2 honestly adopted the name and trademark “Ahmed Al Maghribi” as a trading name for manufacturing and marketing of perfumes and secured a commercial license from Government of Dubai to carry on the business under the said mark. On 6<sup>th</sup> February 2009, the Plaintiff No. 2 obtained registration of the domain name “ahmedalmaghribi.com and launched a website on the said domain name displaying the goods sold under the name and mark “Ahmed Al Maghribi”, which website was accessible from all parts of India and around the world. Subsequently several sub brands were introduced and some of the marks adopted by the Plaintiffs include “Bin Shaikh, Oud and Roses, Kaaf and Marj” under the umbrella mark “Ahmed.”

3. In 2015, the Plaintiff No. 2 adopted a distinctive label mark which



was a unique art work being an Arabic calligraphic symbol which was designed by the employee of Plaintiff No. 2, in which the copyright

subsists in the Plaintiffs. The plaint sets out the details of the



trademark registrations secured in respect of the symbol , symbol with Ahmed and symbol with Ahmed Al Maghribi obtained in United Arab Emirates (UAE). In October, 2020, the Plaintiff adopted the mark “Ahmed Perfumes” and commercial license was secured from the Government of Dubai to carry on business under the name ‘Ahmed Perfumes LLC’ and also obtained license from Plaintiff No. 2 to use the



marks “Ahmed Al Maghribi ” , , and the sub brand marks and a license to use the original art work.

4. On 13<sup>th</sup> November, 2021, the Plaintiff No. 1 filed trademark



application for the mark “Ahmed Perfumes” “ ”with the trademarks office UAE. The Plaintiff No 2 assigned to Plaintiff No 1 the right title and interest in the trade marks and copyright in the artistic work.

5. In so far as India is concerned, it is submitted that in or around 2018, Plaintiff No. 2 commenced exporting the goods to different countries and has effected sales in several countries including India. The Plaintiffs have created profiles on various social media platforms under

the username 'Ahmed Al Maghribi', Ahmed Perfumes etc in 2013, 2014 and 2016, which are freely accessible in India. It is submitted that the Plaintiff's marks and goods are prominently advertised on the social media pages and the goods bearing the Plaintiff's mark have been directly available for purchase in India since at least November 2021. It is submitted that the Plaintiff's goods had a presence in India by reason of the fact that they were brought in India by person who purchased them over seas for sale or for gifting and the Plaintiff's goods enjoyed reputation and goodwill amongst the members of the trade and public even before Plaintiff No. 1 commenced selling the goods in India.

6. The Plaint further sets out the annual revenue of the Plaintiff No. 2 and also annexes the invoice issued by the Plaintiff and their licensees to purchasers in India, showing the use of the Plaintiff's marks in India, as well as the certificate of Chartered Accountant certifying the statement of sales turnover. It is submitted that in or around July 2024, the Plaintiff No. 1 entered into an agreement with an entity in India to distribute its products in India and from July 2024, the Plaintiff has been selling its products in India through its distributor and has also obtained registration of the domain name [www.ahmedalmaghribi.co.in](http://www.ahmedalmaghribi.co.in) in November 2024.



7. It is submitted that in or about August, 2022, the Defendant No. 1 approached the Plaintiff's representative via email with request to

purchase the Plaintiff's goods and be associated as a distributor of the Plaintiff's goods in India. The said request was not acceded by the Plaintiff, and despite the Plaintiff's refusal, Defendant No. 1 continued to purchase the Plaintiff's goods. The copies of the invoice issued in favor of Defendant No. 1 are annexed to the plaint.

8. It is submitted that in or about February, 2023, the Plaintiff No. 1 came across the trademark application filed by the Defendant No 1 on



14<sup>th</sup> September, 2022 for registration of identical mark “”,

“ AHMED AL MAGHRIBI”, “”. on a proposed to be used basis. The Plaintiff's representative approached Defendant No. 1 through telephonic call as well as email dated 28<sup>th</sup> February, 2023, calling upon Defendant No. 1 to withdraw the impugned trademark application to which the Defendant No. 1 through Whatsapp demanded distributorship of the Plaintiffs in India. Despite the Plaintiff's representative sharing a draft of the distributorship agreement with Defendant No. 1, Defendant No. 1 refused to execute the agreement and the Plaintiffs thereafter did not supply any goods to the Defendant.

9. In or around June, 2023, the Plaintiff has filed application for

registration of its mark in the trademark registry in India and also opposed the registration of the Defendant's mark which are pending adjudication. It is submitted that the Defendant No. 1 has filed several trademark applications for the marks "Al Ahmed and Al Ahmed



" and "



" and has associated the said



trademark application with its earlier trademark application of "Ahmed Al Maghribi", which are also identical/deceptively similar to the Plaintiff's registered mark.

10. The Defendant No 1 has also hosted the domain name [www.ahmedindia.com](http://www.ahmedindia.com) displaying the Defendant No. 1's "Al Ahmed" mark and the social media profiles are created under the username 'Al Ahmed India'. The Plaintiff learnt of the existence of Defendant No. 3 LLP incorporated on 10<sup>th</sup> July 2023 bearing the name Ahmed Al Maghribi LLP in which Defendant No. 1 is a designated partner. The Defendants also opened a physical retail shop in Mumbai by the name 'Al Ahmed Perfumes' and a trap purchase was effected and the invoice revealed that the same was issued by Defendant No. 2, which is a partnership firm called 'Al Ahmed India'.

11. It is submitted that in or about October, 2023, the Plaintiff came across the Defendant's use of identical marks "Bin Shaikh", "Oud and

Roses”, “Kaaf and Marj” and the Defendant No. 1 had applied for the registration of the trademark “Bin Shaikh” on 12<sup>th</sup> May, 2023, which trademark application is currently objected. The impugned marks are stated to be Plaintiff’s prior adopted trademark in which the copyright subsists in the Plaintiff by virtue of International Copyright Order, 1999, by which a reciprocal copyright protection is granted to the Plaintiff in India in respect of the artistic work.

12. In the affidavit-in-reply, it is contended that the Defendant No. 1 is carrying on business as sole proprietary concerned i.e. FRS India since the year 2017 and as partnership firm of ‘Al Ahmed India’ since the year 2020. The Defendants have honestly adopted and conceived and used

the trademark “Al Ahmed ”, “  ” for Defendant No. 2 since the year 2020 and are prior users. The explanation given for adoption of the name “Ahmed” is that it is the name of son of Defendant Nos 1 and 4 and name of their grandfather. It is contended that the words “Oud and Roses, Kaaf and Marj” are common perfume substance names used by every perfume brand including the perfume brands in India and the Defendant has a trademark registration for “Bin Shaikh”. The trademark MARJ is already registered by some other person. It is submitted that the Plaintiff did not conduct any business in India until 2024, whereas, the Defendant

started his business of perfumes in the year 2020. The invoices annexed to the plaint have been disputed as being fake invoices, and that only in the year 2024-2025 the Plaintiffs attempted to explore the Indian market to compete with the Defendant's trademark and threatened the Defendants to withdraw its trademark. It is submitted that the Defendants independently registered its trademark and copyright in India and the Plaintiff have no registered business, trademark or physical presence in India.

13. It is submitted that the Plaintiff has failed to produce on record the custom duty challan or the octroi charges paid while trading in India, which raises the doubt about the alleged invoices. It is submitted that the only invoice annexed is of November 2022, which is also questionable in the absence of any delivery challan or details of goods. It is submitted that the impugned marks "Ahmed Al Maghribi" and "Ahmed Perfumes" are visually, structurally and phonetically different from the Defendant's registered trademark "AL- Ahmed" and the mark "Ahmed Al Maghribi" in India was adopted by the Defendants since the year 2020. It is submitted that the Defendants are prior adopter and



prior user of the trade mark " AHMED AL MAGHREBI " in India.

14. It is submitted that the Defendant's product bear a distinct trade dress and are visually different. The mark "Al Ahmed" is a common

Arabic name, and the Plaintiff's cannot claim exclusive proprietary right over the common name 'Ahmed' which is generic and commonly used in Arabic and Islamic culture. It is submitted that the Defendant's product branding, packaging and online content have been created independently or sourced through local and licensed channels for their promotion. The Defendants are the prior users in India and also registered proprietor of the trademark "Al Ahmed India", "Ahmed Al Maghribi", "Bin Shaikh" and "Ahmed".

**SUBMISSIONS :-**

15. Mr. Dhond, learned Senior Advocate for the Plaintiffs submits that the Defendant No. 1 is a former purchaser of the Plaintiff's perfumes, and had also expressed a desire to be distributor. He would submit that the term "Ahmed Al Maghribi" has no meaning and is inspired from the name of the erstwhile Emirati sponsor of Plaintiff No. 2. He would submit that in the year 2000, the Plaintiff No 2 adopted the name and mark "Ahmed Al Maghribi" as a trading name/trade mark. He submits that the term "Bin Shaikh" and "Kaaf and Marj" are arbitrary and not descriptive of the fragrances. He submits that the label mark of Ahmed is a unique artwork being a calligraphic symbol comprising the word 'Ahmed' in respect of which registrations have been obtained in UAE. He submits that in or around 2018, the Plaintiff's commenced exporting its goods to different countries including India and the goods

have been directly available for purchase in India since November, 2021, and even prior thereto, the Plaintiff had presence in India by persons who purchased their goods overseas for sale or gifting. He submits that the Plaintiff's reputation has permeated across borders and spilled over in India much prior to 2021. He would further point out the revenue generated by the Plaintiffs which for the year 2023-2024 was approximately 682.95 crores and have also spent substantial funds towards promoting and publicizing their goods.

16. He would draw attention of this Court to the invoices appended to the plaint to contend that there were sales to Indian customers, the earliest of which dates back to 11<sup>th</sup> November, 2021, which shows that the Plaintiffs are prior users of the marks in India, whereas, the Defendants have not produced any evidence to substantiate their claim of having commenced use of the device mark in 2017 or in 2020. He submits that the Defendants have produced only four invoices all of which are of the year 2025, and even the trademark application where the Defendants are of the year 2022 or 2023 on a proposed to be used basis.

17. He would submit that the Defendants have sought to contend that the sub brands are common perfume names and has produced images or products of certain brands appearing to use the sub brands of the Plaintiff. He submits that merely because there are other infringers,

the same does not constitute a defence to an action for infringement or passing off and the Defendants are bound to show the extent of sale of such other products to claim defence of marks being commonly used in trade.

18. He submits that, although now removed, in the past the Defendants had unlawfully used the Plaintiff's marks and copyright in the artistic work of the Plaintiff's logo under a tab titled UAE Brand.

19. He would submit that the explanation given by the Defendants for adoption of the impugned marks is unacceptable and they have failed to show how they adopted the words "Ahmed Al Maghribi" or "Al Ahmed" or "Ahmed Perfumes". He would submit that the Plaintiffs do not claim any relief of infringement and have sought reliefs against the Defendant for passing off their products as that of the Plaintiff as the rival marks are clearly identical and even the variants adopted by the Defendants are deceptively similar to the Plaintiff's mark.

20. He would submit that the Defendant No 3 has been incorporated on 10<sup>th</sup> July, 2023 and not in the year 2020 as claimed. He submits that there is no specific denial to the invoices raised by the Plaintiff upon the Defendant No 1. He would submit that in its trade mark registration application, the name of Defendant No. 1 is recorded as FRS India which was made by the Defendant No. 1 as Defendant No. 1 was expecting delivery of products from the Plaintiff. He submits that the invoices

were issued to Defendant No. 1, who was then trading as FRS India. In support he relies upon the following decisions :-

***(i) Ramdev Food Products (P) Ltd. vs Arvinbhai Rambhai Patel And Ors.<sup>1</sup>***

***(ii) Empire Spices And Foods Limited vs Sanjay Bhimraoji Deshmukh Trading as M/s Sanskriti Spices<sup>2</sup>***

***(iii) F. Hoffmann-La Roche & Co. Ltd. vs Geoffrey Manner & Co. Pvt. Ltd.<sup>3</sup>***

***(iv) M/s Hiralal Prabhudas vs Ganesh Trading Company And Others<sup>4</sup>***

***(v) Cadila Health Care Ltd. vs Cadila Pharmaceuticals Ltd.<sup>5</sup>***

***(vi) Badat And Co. Bombay vs East India Trading Co.<sup>6</sup>***

***(vii) Lohia Properties (P) Ltd., Tinsukia, Dibrugarh, Assam vs Atmaram Kumar<sup>7</sup>***

***(viii) Thangam And Another vs Navamani Ammal<sup>8</sup>***

***(ix) Century Traders vs Roshanlal Duggar And Co.<sup>9</sup>***

***(x) Marico Limited vs Zee Hygiene Products Pvt. Ltd. And Others.<sup>10</sup>***

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1 (2006) 8 SCC 726

2 2025 SCC Online Bom 2559

3 1969(2) SCC 716

4 1984-PTC-155

5 (2001) 5 SCC 73

6 AIR 1964 SC 538

7 (1993) 4 SCC 6

8 (2024) 4 SCC 247

9 ILR (1977) II Delhi

10 2025:BHC-OS:9444

**(xi) Corn Products Refining Co. vs Shangrila Food Products Ltd.<sup>11</sup>**

**(xii) National Bell Co. And Anr. vs Metal Goods Mfg. Co. (P) Ltd. And Anr.<sup>12</sup>**

**(xiii) Pidilite Industries Ltd. vs S.M. Associates & Ors.<sup>13</sup>**

**(xiv) Jagdish Gopal Kamath And Ors. vs Lime & Chilli Hospitality Services<sup>14</sup>**

**(xv) N.R.Dongre And Ors. vs Whirlpool Corporation And Anr.<sup>15</sup>**

**(xvi) Milmet Oftho Industries And Ors. vs Allergan Inc<sup>16</sup>**

**(xvii) Starbucks (HK) Ltd. And Anr. vs British Sky Broadcasting Group And Ors.<sup>17</sup>**

**(xviii) Toyota Jidosha Kabushiki Kaisha vs Prius Auto Industries Ltd. And Ors.<sup>18</sup>**

**(xix) Bolt Technology OU vs Ujoy Technology Pvt. Ltd. And Anr.<sup>19</sup>**

**(xx) Carlton Shoes Ltd. And Anr. vs VIP Industries Ltd.<sup>20</sup>**

**(xxi) Daiwa Pharmaceuticals Co. Ltd. vs Daiwa Pharmaceuticals Pvt. Ltd. And Ors.<sup>21</sup>**

**(xxii) Midas Hygiene Industries (P) Ltd. And Anr. vs Sudhir**

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11 AIR 1960 SC 142

12 1970 (3) SCC 665

13 2004 (28) PTC 193 (Bom)

14 2015 (62) PTC 23 (Bom)

15 (1996) 5 SCC 714

16 (2004) 12 SCC 624

17 (2015) 1 WLR 2628

18 (2018) 2 SCC 1

19 (2023) 96 PTC 155

20 2023 SCC Online Del 4223

21 2024 SCC Online Bom 1078

***Bhatia And Ors.***<sup>22</sup>

***(xxiii) Amritdhara Pharmacy vs Satya Deo Gupta***<sup>23</sup>

***(xxiv) Parle Products (P) Ltd. vs J.P. & Co.***<sup>24</sup>

21. *Per contra*, Ms. Ansari, learned counsel for the Defendants would point out the different dates in the pleading about the Plaintiff's presence in India. She would submit that the license issued in the year 2000 to the Plaintiffs is in UAE, and though, the partners were of Indian origin the Plaintiff did not come to India till 2024, after the Defendant had started his business. She would further submit that the invoices annexed at page 435 onwards are created for the purpose of filing of the suit as it does not make any mention of the custom duty paid or any details of the customers and there is no delivery challan produced. She would further submit that the Chartered Accountant's certificate certifying the sales turnover has been obtained on 8<sup>th</sup> August, 2024, which certifies sales of the year 2019 in India about which there is no pleading. She would further submit that the invoices produced by the Plaintiff of the year 2021 does not match with the sales turnover of the year 2021.

22. She would further submit that the domain name of Ahmed Al Maghribi was registered on 20<sup>th</sup> November, 2024. She would further point out the promotional material placed on record from page 479

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22 (2004) 3 SCC 90

23 AIR 1963 SC 449

24 (1972) 1 SCC 618

which does not make any mention about any promotion being carried out in India. She would further point out that the regulatory operating cost in so far as India is concerned is almost negligible being AED 0.19. She would deny that any invoices have been raised upon Defendant No 1.

23. She would further submit that Defendant No. 1 applied for registration of its device mark of "Ahmed Al Maghribi" on 14<sup>th</sup> September, 2022 and in so far as the user detail of proposed to be used in concerned, an application is made for correction of the user detail as the same was incorrectly mentioned. She would further point out to the invoices annexed at page 794 onwards to demonstrate the sales under the impugned marks. She would further point out the certificate issued under the MSME shows the date of incorporation of the Defendant as 1<sup>st</sup> July, 2017. She would further point out the affidavit of evidence in support of the application filed before the trademark registry specifically stating that the Defendants are carrying on the business since the year 2020. She would further point out that the Defendants had applied on 12<sup>th</sup> May, 2023 for registration of the mark "Bin Shaikh" which has been accepted and advertised. She would further point out that the sub-brands are common to the trade and have been in extensive use by pointing out to the photographs annexed to the affidavit-in-reply. She would further point out to the Instagram page of

the Defendants as well as the other promotional material in order to demonstrate the Defendant's presence since 2022, whereas, the Plaintiff has joined the social media platforms in January, 2023/2024. She would further point out to the whatsapp chat to demonstrate that the threats were made by the Plaintiff and not by the Defendants. She would further point out that domain name has been registered by the Defendant on 26<sup>th</sup> August, 2022. She would further point out to the trade dress of the Defendant to demonstrate that the packaging is different and there is no question of any confusion and of passing off.

24. She would further point out to the income tax return filed in the name of "Al Ahmed India" which shows the extent of sales. She would further submit that the trademark "MARJ" has been registered in the name of some third party and points out to the application at page 861. She would submit that the Defendants have bonafidely adopted the mark containing the name 'Ahmed' as the same is the name of their son and grandfather. She submits that the name "Al Ahmed" means the family of 'Ahmed' and there is a bonafide explanation for adoption of the mark by the Defendant.

25. In rejoinder, Mr. Dhond submits that the Defendants have not produced any evidence to show their user since 2020 and the subsequent correction in their trademark application is immaterial. He would submit that the Plaintiffs have not taken any contrary stands, as

there are specific pleadings that the products were purchased by Indian customers since November, 2021 which refers to the sales made in middle east to Indian customers and July 2024 refers to the sales made in India by the Plaintiff's distributors. He would further submit that the date of February 2023 was for the purpose of exploring the possibility of expanding operations which means the Plaintiff were looking to enter Indian market directly. He would further submit that the doubt sought to be cast over the Plaintiff's invoices is misconceived as the Plaintiffs sold the goods to the Indian buyer who then took delivery, and it is immaterial that there is no mention of the country or state. He submits that the preparation of Chartered Accountants certificate in the year 2024 was in anticipation of filing of the present suit and the invoices which have been produced are representative in nature and are not required to tally with the figures mentioned in the Chartered Accountant's certificate. He submits that the Defendants have failed to notice the social media presence in India through Facebook, Twitter and other social media handles. He submits that the promotional expenses at Exhibit W of the plaint are the overall promotional expenses incurred by the Plaintiffs in the course of promoting their products bearing their trademark. He submits that the web pages of the Plaintiffs are accessible from India and can therefore be viewed by any person sitting anywhere in India. He would further submit that purchase of the

Plaintiff's products by Defendant No 1 is substantiated by the emails and whatsapp exchanges. He submits that the Defendant's application for registration of the impugned mark is made in September 2022 after the Defendant No. 1's request in August 2022 to be appointed as an Indian distributor. He submits that the invoices produced by the Defendants are fabricated invoices. He submits that the Defendants do not have any registered trademark as the application has only been accepted for the purpose of advertisement. He submits that the social media profiles of the Defendants evidencing presence in India is post August 2022. He submits that even the domain name has been registered on 26<sup>th</sup> August, 2022.

26. He would further submits that the aspect of the packaging being different of the rival products is immaterial as the perfumes are primarily bought by reference to the brand and the Defendants are using the same brands as well as the sub-brands. He submits that, in any event, the brand and the sub-brand on the packaging is very prominent and forms part of overall packaging.

27. He submits that the income tax returns filed by the Defendant No. 2 in the name of "Al Ahmed" do not show any sale or promotional expenses and could constitute a source of income from selling any goods. He submits that the income for the year 2023-2024 is about Rs. 66,860/- which does not show any significant presence and goodwill of











the Defendants in India. He submits that the opening of the bank account in 2021 with the name "Al Ahmed India" cannot imply use of the trademark by the Defendants since 2021. He submits that the Defendants have failed to produce any Chartered Accountant's certificate and supporting document evidencing the extent of sale and or promotional expenditure incurred by them. He submits that the invoices purportedly relating to the advertisement and promotional expenses do not show that they relate to any advertisement of the products bearing the impugned mark.

28. He would submit that the trade mark "MARJ" is pending registration and in any event, the present action by the Plaintiff is for passing off.

29. Rival contentions now fall for determination:

30. The Plaintiff Nos. 1 and 2, are entities incorporated under the laws of UAE and the Defendants are located within the jurisdiction of this Court. The Plaintiffs are the registered owners of the trademark, which registrations have been secured in Dubai. The position in so far as India is concerned is that the Plaintiffs have applied for registration of its device mark in June, 2023 with user claim of November, 2021 and the Defendants have applied for registration of its mark in February, 2023 on proposed to be used basis, which user is later sought to be corrected.

31. The rival marks are reproduced herein below for the purpose of comparison.

| PLAINTIFF'S MARKS   | DEFENDANT'S MARKS<br>(IMPUGNED)  |
|---|--|
| 1. AHMED AL MAGHRIBI  | A. AHMED AL MAGHRIBI   |
| 2. <br>AHMED<br>AL MAGHRIBI    | B. <br>AHMED<br>AL MAGHRIBI                |
| 3.                             | C.  AHMED                                  |
| 4. <br>AHMED                 | D. <br>AL<br>AHMED<br>PREMIUM FRAGRANCES |
| 5. <br>AHMED<br>PERFUMES     | E. <br>AL<br>AHMED<br>PREMIUM FRAGRANCES |
| 6. AHMED PERFUMES   | F. AL AHMED  |
| 6A. <br>AHMED<br>AL MAGHRIBI |  |
| 7. <br>AHMED<br>PERFUMES     | G.   |
| 8. BIN SHAIKH   | H. BIN SHAIKH  |
| 9. OUD & ROSES  | I. OUD & ROSES   |
| 10. KAAF  | J. KAAF  |
| 11. MARJ  | K. MARJ  |

32. As the marks are unregistered, there is no issue of infringement of trade mark and submissions canvassed was in respect of passing off action. To sustain an action for passing off, the well settled tests of goodwill and reputation, misrepresentation and damage remain undisturbed. As the Plaintiffs allege passing off and are foreign entities, the requirement is to show spill over of the goodwill and reputation of its trade marks in India. The judicial pronouncements have settled the tests for passing off and trans border reputation, which can be looked into:

(a) In ***N.R.Dongre And Ors. vs Whirlpool Corporation And Anr.*** (supra), the Plaintiff did not make out case of actual sales in India, however, had advertised its products in international magazines having circulation in India. The Hon'ble Apex Court approved the findings of the Hon'ble Division Bench that even advertisement of the trade mark without existence of goods in the market is also to be considered as use of the trade mark.

(b) In ***Milmet Oftho Industries And Ors. vs Allergan Inc*** (supra), the Hon'ble Apex Court in context of medicinal preparations noted its agreement with the view in ***N.R.Dongre And Ors. vs Whirlpool Corporation And Anr.*** (supra), observing that medical literature is freely available in India, goods are widely advertised in newspapers, periodicals, magazines and other media available in India which results

in products acquiring worldwide reputation.

(c) The decision of ***Toyota Jidosha Kabushiki Kaisha vs Prius Auto Industries Ltd. And Ors.*** (supra) is an authoritative pronouncement on the subject and the Hon'ble Apex Court favoured the territoriality principle over the universality principle. It held that the Courts have to determine if there has been a spillover of the reputation and goodwill of the mark used by the Claimant who has brought the passing off action and to ascertain the existence of not necessarily a real market but the presence of the claimant through its mark within a particular territorial jurisdiction. The Hon'ble Apex Court further held in paragraph 32 as under:

*"32. Prof Christopher Wadlow's view on the subject appears to be that the test of whether a foreign claimant may succeed in passing off action is whether his business has a goodwill in a particular jurisdiction, which criterion is broader than the "obsolete" test of whether a claimant has a business/place of business in that jurisdiction. If there are customers for a claimant's products in that jurisdiction, then the claimant stands in the same position as a domestic trader."*

The Hon'ble Apex Court noted the decision in ***Starbucks (HK) Ltd. And Anr. vs British Sky Broadcasting Group And Ors.*** (supra) , where the UK Supreme Court observed as under:

*"52. As to what amounts to a sufficient business to amount to goodwill, it seems clear that mere reputation is not enough.... The claimant must show that it has a significant goodwill, in the form of customers, in the jurisdiction, but it is not necessary that the claimant actually has an establishment or office in this country. In order to establish goodwill, the claimant must have customers within the jurisdiction, as opposed to people in the jurisdiction who happen to be customers elsewhere. Thus where the claimant's business is carried out abroad, it is not enough for a claimant to show that there are people in this jurisdiction who happens to be its customers when they are abroad. However, it could be enough if the claimant could show that there were people in this jurisdiction, who by*

*booking with, or purchasing from, an entity in this country, obtained the right to receive the claimant's services abroad. And, in such a case, the entity need not be part or branch of the claimant; it can be someone acting for or on behalf of the claimant."* (Emphasis supplied)

The Hon'ble Apex Court noted the decision in ***Athlete's Foot Marketing Associates Inc v Cobra Sports Ltd.***<sup>25</sup> as under:

*"...no trader can complain of passing off as against him in any territory ..in which he has no customers, nobody who is in trade relations with him. This will normally shortly be expressed by stating that he does not carry on any trade in that particular country....but the inwardness of it will be that he has not customers in that country..."*

33. In ***Starbucks (HK) Ltd. And Anr. vs British Sky Broadcasting Group And Ors.*** (supra), the UK Supreme Court considered the issue as to whether a claimant who is seeking to maintain an action for passing off need only establish a reputation among a significant section of the public within the jurisdiction, or whether such a claimant must also establish a business with customers within the jurisdiction. It noted that Goodwill as subject of proprietary rights is incapable of subsisting by itself having no independent existence apart from the business to which it is attached. It held in paragraph 47 as under:

*"47. ....In other words, I consider that we should reaffirm that the law is that a claimant in passing of claim must establish that it has actual goodwill in this jurisdiction, and that such goodwill involves the presence of clients or customers in the jurisdiction for the products or services in question. And, where the claimant's business is abroad, people who are in the jurisdiction, but who are not customers of the claimant in the jurisdiction, will not do, even if they are customers of the claimant when they go abroad."*

34. In ***Bolt Technology OU vs Ujoy Technology Pvt. Ltd. And Anr.*** (supra), the Delhi High Court summarised the principles of ***Toyota Jidosha Kabushiki Kaisha vs Prius Auto Industries Ltd. And Ors.***

<sup>25</sup> [1980] RPC 343

(supra) in passing off and transborder reputation as under:

*“72. Several important principles emerge from these passages, which may be enumerated as under:*

*(i) The territoriality principle applies: not the universality doctrine. Existence of goodwill and reputation has, therefore, to be shown to exist in India. Universal or world wide goodwill and reputation sans any evidence of territorial goodwill and reputation, is not sufficient.*

*(ii) Mere reputation is not enough. The claimant/plaintiff must show that it has significant goodwill.*

*(iii) The actual existence of an office of the plaintiff in the country of the defendant is not necessary.*

*(iv) However, the claimant must have customers within the country of the defendant, as opposed to persons in the defendant's country who are customers elsewhere. Thus where the claimant's business is carried on abroad, it is not enough for the claimant to show that there are people in the defendant's country who happen to be his customers when they are abroad.*

*(v) However, it would be enough if the claimant could show that there were people in the defendant's country who, by booking with, or purchasing from an entity in the defendant's country obtained the right to receive the claimant's service abroad. The person from whom such booking or purchase took place could be the claimant or its branch office or someone acting for or on behalf of the claimant.*

*(vi) The claimant must be “present through its mark in the territorial jurisdiction” of the country of the defendant’ though the existence of “real market” was not necessary.*

*(vii) Such presence could, for instance, be shown by extensive advertisement which had been circulated and seen, or read, in the country of the defendant.*

*(viii) Once the existence of transborder reputation and goodwill was thus established, the claimant was not required, further, to prove the existence of actual confusion. The likelihood of the customer of average intelligence and imperfect recollection being confused, by the use of the impugned mark of the defendant, that the goods or services by the defendant were those of the claimant-plaintiff was sufficient.”*

35. In ***Daiwa Pharmaceuticals Co. Ltd. vs Daiwa Pharmaceuticals***

***Pvt. Ltd. And Ors.*** (supra), this Court held in paragraph 86 as under:

*“86. A relevant factor to be borne in mind is that the Plaintiff's mark is in respect of pharmaceutical products. It has been held by the Supreme Court in Milmet (Supra) which has been followed by the Delhi High Court in Mayo Foundation (Supra), decisions relied upon by the Plaintiff that in the event the material relied upon by the Plaintiff prima facie shows that the Plaintiff's product was advertised before the Defendant entered the filed, the Plaintiff being the first to adopt the mark, is then able to maintain an action for passing off. The mere fact that the Plaintiff has not been using the mark in India would be irrelevant if they were first in the world market. Thus there does appear to be special segment carved out for pharmaceutical*

*products and the test of transborder reputation would in my view have to be liberal and such reputation may be derived from advertisement and publicity of the Plaintiff's mark and cited in Indian newspapers, magazines and online publications..."*

36. The applicable tests in case of passing off action based on transborder reputation stands crystallized. The requirement is of establishing that the claimant have customers within the country of the defendant as opposed to persons in defendant's country who are customers elsewhere and even if there is no existence of real market, the claimant must establish the presence through its mark in the territorial jurisdiction of the country of the defendant.

37. It is firstly essential for the Plaintiffs to *prima facie* prove the spill over of its goodwill and reputation in India and only thereafter an occasion would arise to consider the defences as regards honest adoption, prior user etc. The essence of passing off action is that no trader shall pass off its goods as that of another trader and be unjustly enriched by the goodwill and reputation of the other trader. If there is no goodwill and reputation proved, there is no question of passing off. The Plaintiffs being foreign entities and the unregistered proprietors of the marks in India have to essentially pass the test of transborder reputation.

38. The claim of the Plaintiff is that though it is not located in India, it has business exposure in India inasmuch as it has customers within the jurisdiction of this Court part from the fact that before directly selling

the goods in India it had customers who were purchasing the goods abroad, which were brought in India. It is further the claim that its mark has presence in India through advertisement and promotions.

39. In the plaint, the initial paragraphs are devoted to the goodwill and reputation obtained by the Plaintiffs globally. In paragraph 23, it is pleaded that in or around 2018, the Plaintiff No. 2 commenced exporting its products to different countries around the world, including but not limited to India and have annexed at Exhibit N the copies of specimen sale invoices evidencing large quantum of sale under the Plaintiff's mark in various jurisdictions. The invoices are annexed from page 330 onwards, and shows sales in various countries from the year 2018 except India. The pleading is that the invoices which are readily available were annexed to the plaint, which explanation is unacceptable as the Plaintiffs were aware of the case of transborder reputation, which they had to satisfy. The claim of effecting sales in India in the year 2018 is unsubstantiated from the record.

40. In paragraph 25, it is claimed that the Plaintiff's marks have been directly available for purchase in India since at least November 2021, and even prior to the commencement of export of the Plaintiff's goods to India, the Plaintiff's goods had a presence in India, including by reason of the fact that they were brought into India by person who purchased them overseas for sale or gifting. The law is well settled that

the claimant has to show customers in the jurisdiction of this Court as opposed to persons in this jurisdiction who may be the customers of the Plaintiff in other jurisdictions. In paragraph 26, it is pleaded that the Plaintiffs have licensed its marks to other group entities for sale of Plaintiff's goods to various countries including India. There are no details of the licensees in India through whom the goods were sold to customers in India and no document of license placed on record.

41. To substantiate the plea of sale to customers in India, sales invoices have been annexed at Exhibit "P" from pages 435 onwards stating the same to have been issued by the Plaintiff and their licensees to purchasers in India for showing user of the Plaintiff's marks in India. The tax invoices which are about 24 in number are for the years 2021, 2022 and 2023. The tax invoices reflect the address of the sales office of UAE and majority of the invoices only mention the names of the customers without address or other details and few invoices mention the name of the city and State. In response to the Defendant's contention that the invoices are created as no delivery challan/custom duty receipts are produced, in the written submissions, the Plaintiffs have contended that the Plaintiffs have sold the goods to an Indian buyer who then took delivery thereof. It means that the Plaintiff's goods were sold in UAE to Indian customers, who brought them to India and not that the Plaintiffs have effected direct sales to the customers in

India.

42. The sales invoices from Pages 568 to 575 purportedly raised upon the Defendant No 1 is issued from the sales office of UAE and evidently, the purchase was effected in UAE and the goods were brought in India. There is not a single invoice produced to demonstrate sale to customers in India so as to establish goodwill in India through customers in India. It is clear from ***Starbucks (HK) Ltd. And Anr. vs British Sky Broadcasting Group And Ors.*** (supra) and ***Toyota Jidosha Kabushiki Kaisha vs Prius Auto Industries Ltd. And Ors.*** (supra) that the Plaintiff has to show that its goods were purchased by customers in India and not by customers who had purchased goods abroad and brought them into India.

43. In paragraph 27, it is pleaded that in or around July 2024, the Plaintiff No. 1 entered into an agreement with an entity in India to distribute its product in India and that from July 2024, the Plaintiff No. 1 has been selling its product in India, through its distributor as well. There is not even a mention of the name of the Indian distributor. There is no distributorship agreement produced and neither any invoices have been produced showing sales through the purported Indian distributor.

44. Reliance has been placed on the chartered accountant's certificate to show sales in India including for the year 2019 when it is the Plaintiff's case that the sales in India took place in November, 2021.

The chartered accountant's certificate shows that for the year 2020 there are nil sales in India, for the year 2021 the sales have been shown as 22,959 AED and for the year 2022, it is shown as 5472 AED. As compared to UAE for the same period the sales is 34,648,451 AED and 22,182,877 AED respectively, which shows insignificant sales in India. Taking the exchange rate at Rs 24/ as taken by the Plaintiffs in the written submission, the sales turnover in India would be approximately Rs 5,51,016 for the year 2021 and Rs 1,31,328/ for the year 2022, which is insignificant. In ***Toyota Jidosha Kabushiki Kaisha vs Prius Auto Industries Ltd. And Ors.*** (supra) , while denying the relief of passing off, the Court had observed the minimal sales by Toyota in India.

45. Let us now test whether the Plaintiff's mark has disseminated through media and advertisements, indicating its presence in India even without a real market in India. The Plaintiff's claim is premised on :

- (a) launch of domain name bearing the trademark, webpages of Plaintiff No 2's website for the year 2014 to 2024.
- (b) profiles created on Twitter in September, 2013, Instagram in September, 2014, Facebook under user name "Ahmed Al Maghribi on 18<sup>th</sup> September, 2016, and LinkedIn.
- (c) photographs of fairs, exhibitions, kiosks set up to promote Plaintiff's products
- (d) publicity material, advertisements, publications and

magazines.

(e) newspaper articles, awards, reviews.

46. There is no India dedicated website of the Plaintiffs. The webpages would indicate the internet presence of the Plaintiffs since the year 2014. The mere existence of the Plaintiff's website, which is digital advertisement accessible from any country, by itself, without support of body of tangible evidence to demonstrate the penetration of the advertisements in the Indian market, is not sufficient to accept transborder reputation. The webpages do not indicate targeted customers in India, the product brochures do not demonstrate circulation in India. The social media posts are part of digital advertisements and there is not even a bare assertion of dedicated followers from India. The awareness of the foreign brand is an essential aspect as the evidence of confusion would emanate from the fact that the Indian customers are aware of the foreign brand.

47. The advertisement invoices raised by Meta and Google in respect of the social media handles reflected as India Regulatory Operating Cost for August, 2023 is 0.44 AED, for September, 2023 is Nil, for October 2023 is 0.02 AED, for November, 2023 is 0.53AED and in December 2023 is 0.01 AED. With such operating costs for India, it is difficult to accept the contention of wide scale advertisements in India. The Plaintiffs have expended minimal expenses towards promotions in

India. The certificate produced on record shows the overall promotional expenses of 4085,626 AED for the year 2023 and when compared with the operating costs for India set out in the invoices raised by Meta and Google are minuscule. Further, the Chartered Accountant's certificate does not set out the stand alone advertisement expenses in respect of the Plaintiff's product in India and a consolidated statement is given.

48. There are no genuine documented local sales, no widely circulating advertisements and promotional material in India actually available or shown to be digitally accessed in India. With the material produced on record, I am not inclined to accept that the Plaintiff's marks and products had made an inroad in India and its goodwill and reputation had permeated into India unlike the medical journals which the doctors, physicians and person connected with medical field would regularly access to update themselves.

49. The social media profiles annexed from pages 420 to 434 is not shown to have any followers in India, the publicity material is not demonstrated to have any circulation in India and there is nothing in print media. There is no extensive advertisement in India to satisfy the requirement of wide advertisement of a trade mark without the existence of goods in the local market can well be considered as use of the trade mark in the market. [See ***N.R.Dongre And Ors. vs Whirlpool Corporation And Anr.*** (supra)]. In ***Toyota Jidosha Kabushiki Kaisha vs***

**Prius Auto Industries Ltd. And Ors.** (supra), it was held in paragraph 38 as under:

*“38. ...Indeed the trade mark “Prius” had undoubtedly acquired a great deal of goodwill in several other jurisdictions in the world and that too much earlier to the use and registration of the same by the defendants in India. But if the territoriality principle is to govern the matter and we have already held it should, there must be adequate evidence to show that the plaintiff had acquired a substantial goodwill for its car under the brand name “Prius” in the Indian market also.....Coupled with the above, the evidence of the Plaintiff’s witnesses themselves would be suggestive of a very limited sale of the product in the Indian market and virtually the absence of any advertisement of the product in India prior to April, 2001. This in turn would show either lack of goodwill in the domestic market or lack of knowledge and information of the product amongst a significant section of the Indian population...”*

50. In **Sumit Vijay and Another vs Major League Baseball Properties Inc**<sup>26</sup> the Hon’ble Division Bench of Delhi High Court was considering an appeal against striking of the Appellants trade mark from the register of trade marks. The issue involved consideration of trans border reputation and the Delhi High Court held in paragraph 12.9, 12.10, and 12.11 as under:

*12.9. Secondly, the availability of a mark on websites can again be no indicator of trans-border goodwill or reputation percolating into a particular country such as India. Websites are globally accessible. If the principle that accessibility of a mark on a website is to be treated as an indicator of trans-border reputation, every mark of every entity would have trans border reputation in every country in the world. It is not enough, therefore, to aver that a particular mark is available on a website which is accessible within India, to substantiate a contention that the mark enjoys trans-border reputation in India. Positive assertions regarding the number of times the websites has been accessed in India would have also to be pleaded.*

*12:10. Similarly, the availability of goods bearing a particular mark, for sale on websites, whether they belong to the owner of the mark or are e-commerce websites, can also be no evidence of percolation of the reputation of the mark into India. As in the case of websites in general, e-commerce websites may be accessible within India... even*

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*if they are not hosted from within the country. Similarly, there is no necessity that every product which is available on an e-commerce website commands reputation or goodwill within India. Mere availability of products bearing a mark for sale on an e-commerce website, or on the website of the owner of the mark, would not, however, suffice as proof of trans-border goodwill or reputation. It would further have to be shown that orders were actually placed or purchases effected, to a considerable extent, of the goods bearing the mark, from within India.*

*12.11. The same principle applies to publication of marks in periodicals, magazines, etc. With the proliferation of the internet, most magazines, periodicals and the like are now available globally. Every mark which figures in such magazines or periodicals cannot, therefore, be said to have trans-border reputation within India. There would have to be positive assertions regarding the readership or subscription of such magazines among Indians. Besides, such assertions cannot be merely in the nature of bald statements, but would also have to be supported by disclosure of the material on which the assertion is made, even if positive evidence in that regard may be deferred to the stage of trial. In the case of newspapers or periodicals, empirical material should also be forthcoming that the newspapers or periodicals are widely circulated in the country. Offices of professionals often stock magazines, to occupy the time of those who are awaiting an appointment. The mere fact that some of them may be sports magazines does not ipso facto indicate that every sport, with reference to which an article may be contained in the magazines, has goodwill or reputation.*


51. I am in agreement with the view taken by Delhi High Court and when applied to the facts of present case, do not show percolation of reputation of the mark in India.

52. In so far as copyright violation is concerned, in the written submission tendered by the Plaintiff, it is contended that the Defendants have made a statement that out of the table reproduced therein, the marks at Sr Nos A, B and C will not be used as recorded in the order dated 15<sup>th</sup> October, 2025. It appears that by reason of the same, there were no submissions canvassed by Mr. Dhond on the aspect of copyright infringement. However, perusal of the order of 15<sup>th</sup>


October, 2025 indicates that the said statement was time limited to the next date, which statement was continued from time to time.

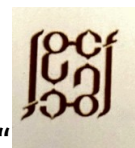
53. The pleading in the plaint in respect of copyright is that in or around the year 2015, the Plaintiff No 2 had conceived and adopted the

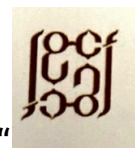


distinctive label mark of “”, which was designed in house and the copyright subsists in favour of the Plaintiff. In paragraph 56, it is pleaded that since UAE is included in the list of WTO convention countries, by virtue of International Copyright Order, 1999, reciprocal copyright protection is granted to the Plaintiff in India in respect of the aforesaid artistic work. In the reply, the Defendants have claimed the



Defendant is prior user of the mark “”.



54. There is specific pleading that the artistic work in “” was designed at the instance of the Plaintiff and the copyright protection extends to the artistic work in India by virtue of International Copyright Order, 1999 which has not been specifically dealt with by the Defendants in their reply. The Defendant’s reply does not give any explanation for adoption of the identical artwork as that of the Plaintiffs. The reply is bereft of any pleading or material to demonstrate

the Defendant's ownership in the artistic work. The Defendants have pleaded that they are prior adopters and users of the marks "



" and "



". It is pleaded in paragraph 42

as under:

*"....that the trademark in respect of Defendant No 4*




*is prior user by the Defendants."*

55. There is no material to show prior user of the artistic work or the manner in which it was conceived and adopted. The Plaintiffs had created the artistic work in the year 2015 and the impugned mark at Serial Nos 2 and 3 of the table reproduced above shows that it is slavish reproduction of the Plaintiff's artistic work and constitutes violation of copyright.




56. In light of the above, the Plaintiffs have failed to make out *prima facie* case for grant of interim relief against passing off. However, the Plaintiffs are entitled to interim relief against copyright infringement. The Interim Application is allowed in terms of prayer clause (b) which reads as under:

*(b) That pending the hearing and final disposal of the suit the Defendant by themselves, their respective proprietors, partners, servants, employees, agents, dealers, stockists, distributors and all persons claiming under them be restrained by an order and injunction of this Hon'ble Court from infringing*






the Plaintiff's copyright in the artistic work, viz. , comprised in the




Plaintiff's logos viz. ,  and  by reproducing, printing, publishing, communicating to the public the said artwork or substantial part thereof by using the impugned marks



 AHMED,  and  and/or any other mark and/or label which is an exact/substantial reproduction or colorable



imitation of the Plaintiff's artistic work, i.e. , comprised in the



Plaintiff's logos viz. ,  and .

**(SHARMILA U. DESHMUKH, J.)**