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

% *Date of Decision: 13th July, 2026*

\+ CS(COMM) 962/2025

NEW BALANCE ATHLETICS INC. .....Plaintiff
Through: Mr. Urfee Roomi, Ms. Janaki Arun, Mr. Ayush Dixit and Ms. Vanshika Bansal, Advocates.

versus

ASTORMUELLER AG AND ORS. .....Defendants
Through: Mr. Rohan Rohatgi and Ms. Muthu Praba, Advocates.

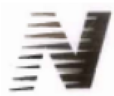
CORAM:
HON'BLE MS. JUSTICE JYOTI SINGH

JUDGEMENT

JYOTI SINGH, J.

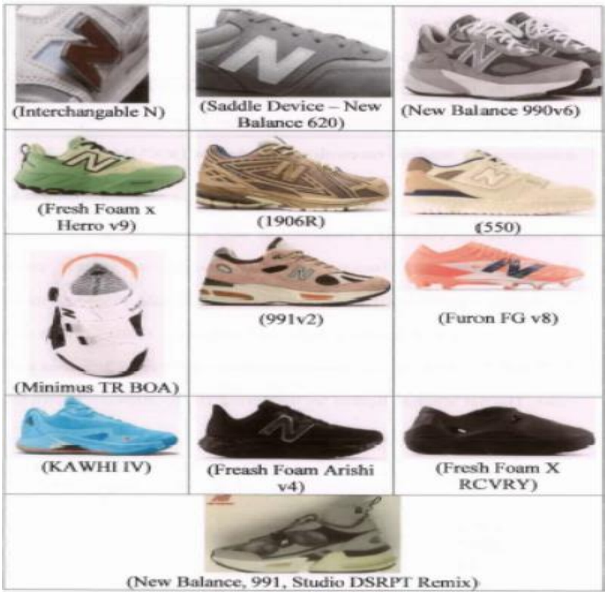
I.A. 22346/2025

1. This judgment will dispose an application filed on behalf of the Plaintiff under Order XXXIX Rules 1 and 2 CPC seeking ad interim injunction against the Defendants.

2. Plaintiff is a company incorporated under laws of State of Massachusetts, USA and had its beginnings in 1906 with the founding of New Balance Arch Support Company, the predecessor-in-interest, which was engaged in manufacture and sale of footwear. Plaintiff is engaged in designing, manufacturing, marketing and selling of footwear, headgear, readymade clothing, bags and backpacks in over 120 countries, including India. Plaintiff is the proprietor of various trademarks, internationally and in India, which include the device trademarks , , 

and ('N-marks'), in relation to footwear, readymade clothing, bags and backpacks.

3. It is stated that Plaintiff first used the logo 'N' as a trademark on footwear in USA in 1970s, when it launched its new '320' model of athletic shoe, which became increasingly popular among fitness enthusiasts and was lauded by 'Runner's World', one of the world's most prestigious magazines for runners, as the best running shoes in the world. Currently, Plaintiff employs more than 14,000 employees worldwide and has numerous subsidiaries and related entities including in India, UK, Singapore etc. and sells through retail stores as also online on Plaintiff's website www.newbalance.com and other third-party e-commerce websites. Over time, due to extensive and uninterrupted use, multiple variants of N-marks have been introduced including in collaboration with designers and the N-marks are a core component of Plaintiff's brand identity such that Plaintiff introduced footwear featuring interchangeable N-Logos, allowing consumers to personalize their appearance. Illustratively, some of the iterations are as follows:-


(Interchangable N)
(Saddle Device – New Balance 620)
(New Balance 990v6)
(Fresh Foam x Herro v9)
(1906R)
(550)
(Minimus TR BOA)
(991v2)
(Furon FG v8)
(KAWHI IV)
(Freash Foam Arishi v4)
(Fresh Foam X RCVRY)
(New Balance, 991, Studio DSRPT Remix)

4. It is stated that Plaintiff's N-marks are today affixed on hundreds of millions of pairs of footwear as also readymade clothing, bags and backpacks, sold annually in many countries worldwide and the net revenue has steadily increased from 2013 to 2024 as follows:-

Year Ending	Net Revenue (in billion USD)	Net Revenue (in 000' crore INR) (as of September 2, 2025)
2013	2.7	23.7
2014	3.1	27.2
2015	3.4	29.9
2016	3.7	32.5
2017	4.1	36.1
2018	4.5	39.6
2019	3.4	29.9
2020	2.7	23.7
2021	4.4	38.7
2022	5.3	46.6
2023	6.5	57.2
2024	7.8	68.6

5. It is stated that Plaintiff has expended enormous amount of money on promoting and advertising its footwear, clothing, bags and backpacks bearing one or more N-marks and the promotional expenditure for the period 2013 to 2020 is as follows:-

Year Ending	Advertising Expenses (in million USD)	Advertising Expenses (in thousand crore INR)
		(as of September 2, 2025)
2013	201	1.76
2014	253	2.26
2015	306	2.69
2016	294	2.58
2017	295	2.59
2018	343	3.01
2019	341	3.00
2020	244	2.14

6. It is stated that the advertisements of the N-marks are accessible to consumers worldwide, including India and Plaintiff incorporates the N-

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marks even in the 'headline copy' by replacing the ordinarily written letter 'N' with Plaintiff's N-marks. The products under N-marks are also promoted through product placement in various movies and television/OTT shows. The extensive media coverage has left an indelible impression in the minds of public that Plaintiff's N-marks are associated with the Plaintiff and none else. Plaintiff has expanded its reach on World Wide Web by establishing official accounts on Facebook (9.4 million followers), X (formerly, Twitter) (316.3 K followers) and Instagram (8.4 million followers), three of the world's most popular and trafficked social networking sites, as also on YouTube (191 K subscribers), the highly trafficked video sharing website and LinkedIn (641K followers), one of the world's most popular professional networking sites. These sites have been enormously popular with consumers worldwide, including in India and Plaintiff's N-marks feature prominently on these sites. Plaintiff has sponsored and continues to sponsor exclusive endorsement deals with many sports teams, leagues and individuals and its footwear with N-marks are often worn by many celebrities and personalities such as Kate Middleton, Princess of Wales, Bill Clinton, Barak Obama, Vladmir Putin, Steve Jobs, Taylor Swift, Jack Harlow, Rihanna, Seth Rogen, Pharrell Williams, Robert Downey Jr., Ed Helms, Leonardo DiCaprio, Tom Holland, Steve Carell, Jim Carrey, Kim Kardashian, Ranbir Kapoor, Vidyut Jammwal and Sonakshi Sinha etc. Several awards including some of the prestigious awards received by the Plaintiff find mentioned in the documents filed along with the plaint.

7. It is stated that in order to secure statutory rights in addition to existing common law rights, Plaintiff has obtained registrations in the N-marks covering *inter alia* footwear, clothing, bags and backpacks in Classes 18 and 25 in various jurisdictions such as USA, Australia, Canada,

Germany etc. including India. Registrations in the N-marks in India are as follows:-

S. No.	Mark	Reg. No.	Class	Reg. Date	Status
1.		472335	25	May 18, 1987	Registered
2.		768874	25	September 10, 1997	Registered
3.		768875	18	September 10, 1997	Registered
4.		1537347	25	March 6, 2007	Registered
5.		IRDI No. 5296933	25	December 9, 2021	Protection Granted

8. It is stated that in order to strengthen its relationship with Indian consumers, Plaintiff incorporated subsidiary companies namely, New Balance IT Services India Pvt. Ltd. (2007) and New Balance India Pvt. Ltd. (2022). Way back in 2004 and 2005, Plaintiff organized various events in India to launch its new models of footwear bearing N-marks and pertinently, the famous Australian cricketer Mr. Brett Lee launched the product and the events were widely covered and reported by various media houses in India. In 2006, Plaintiff signed an agreement with Moja, an Indian manufacturer, to outsource shoe production in India and later, in the same year Zee Business, one of India's popular Hindi business news channel telecasted a talk show, showcasing and discussing various models of footwear with the N-marks. In 2016, Plaintiff entered into a Franchisee Agreement with an Indian party for opening retail stores and the same year, its flagship store was opened in Noida, UP, which was widely covered by numerous media

organizations and this was followed by many more stores in various cities such as Delhi, Gurugram, Chandigarh, Ahmedabad etc. Plaintiff's footwear with N-marks featured in IPL as early as in 2016. The 2025 series of IPL also saw many cricketers wearing footwear bearing the N-marks. The matches were witnessed by hundreds of thousands of spectators at the stadium and through television broadcast/OTT platforms and consequently, the N-marks received immense attention and popularity. Since 2013, Plaintiff has operated a cricket focused page by the name *New Balance Cricket* on Facebook, which has attracted a global audience, including followers from India.

9. It is stated that Plaintiff's shaded logo as also NEW BALANCE and NB marks have been declared as well-known trademarks within the meaning of Section 2(l)(zg) of the Trade Marks Act, 1999 ('1999 Act') by this Court in ***New Balance Athletics Inc. v. Jitender Kumar and Others, 2023 SCC OnLine Del 8061*** and ***New Balance Athletics Inc. v. New Balance Immigration Private Limited, 2023 SCC OnLine Del 7009,*** respectively. Plaintiff's distinct association with N-marks is also evidenced by the fact that search engine queries on Google and other platforms in respect of the words N-logo shoes, N-shoes, N-footwear, N-logo footwear, consistently return results directing users to Plaintiff's goods.

10. It is stated that Defendant No.1 is a company incorporated under Laws of Switzerland and both Indian companies, Defendant No.2 and 3, as per Plaintiff's information are Indian subsidiaries of Defendant No.1 and are engaged in manufacture, marketing and sale of footwear under the brand name NUBEAT. Defendants are using nu:beat marks including logo mark with a lower case 'n' in relation to sneakers, product packaging,

corporate logo and as a favicon on their website http://www.nubeat.com/, and products are being sold around the country, including to customers in Delhi, through this website as also on third-party e-commerce websites such as Myntra and advertised on Instagram, X, YouTube, Facebook and Pinterest.

11. It is stated that Plaintiff first learnt of the Defendants in April, 2025, when it found the listings for footwear with 'n-marks' on their website http://www.nubeat.com/ and internet searches revealed that the offers for sales were being made on Myntra. Further, research revealed that Defendant No.1 has the following registrations in its favour:-

S. No.	Registration No.	Mark	Date of Registration	Classes and Description of Goods
1.	5239240	n: nubeat	December 8, 2021	[Class: 18] *Leather and imitations of leather; animal skins and hides; luggage and carrying bags, umbrellas and parasols; walking ticks; whips, harness and saddlery; collars, leashes and clothing for animals.* [Class: 25] *Clothing, footwear, headwear.*
2.	5239238	n:	December 8, 2021	[Class: 18] *Leather and imitations of leather; animal skins and hides; luggage and carrying bags, umbrellas and parasols; walking ticks; whips, harness and saddlery; collars, leashes and clothing for animals.* [Class:25] *Clothing, footwear, headwear*
3.	5666070	n:	November 1, 2022	[Class: 25] *Clothing, footwear, headwear.*
4.	5666069	n:	November 1, 2022	[Class: 18] *Leather and imitations of leather; animal skins and hides; luggage and carrying bags, umbrellas and parasols; walking ticks; whips, harness and saddlery; collars, leashes and clothing for animals.*

12. It is stated that in response to Examination reports in respect of registration nos. 5239238, 5666069 and 5666070, Defendant No.1 had stated that **'n:'** is a combination of letters 'n' and 'B' and B is represented as colon (':'). The registrations bearing nos. 5239240, 5239238, 5666070, and 5666069 have been erroneously granted in favour of Defendant No.1 and are liable to be revoked being in violation of Plaintiff's statutory and common law rights and Section 11 of 1999 Act, for which cancellation petitions have been filed by the Plaintiff. Pertinently, even though the registrations are in 2021 and 2022, respectively, the actual user of the marks in India is admittedly, only from April, 2024 and this is also reflected in media articles covering the launch. Despite cease-and-desist notice, Defendants continued their sale of footwear with the impugned n-marks, denying the allegations of similarity in rival marks and likelihood of confusion and claiming that their n-marks were distinctive and adopted honestly.

13. Learned counsel for the Plaintiff argued that Plaintiff is a registered proprietor of the N-marks (logos) i.e., , , . The N-logo was used by the Plaintiff as a trademark on footwear for the first time in USA in 1970s and registration in India for the trademark in Class 25 goes back to 18.05.1987. On 10.09.1997, Plaintiff obtained registrations for the N shaded logo in Classes 25 and 18, followed by grant of protection in 2021 for the mark and therefore,

by virtue of these registrations, Plaintiff has the exclusive right to use the marks in respect of goods for which they are registered as also to restrain third-parties from using the marks without authorization, in terms of Section 28 of 1999 Act. The rival marks of the Defendants are deceptively similar, visually and phonetically and are used for identical products. The consumer base being common and trade channels being the same, coupled with the immense reputation of the N-marks, confusion is inevitable and there is no gainsaying that the confusion gets further aggravated by the number of variants of N-marks used by the Plaintiff over the years as also similarity in brand names: '*New Balance/NB* and '*NUBEAT/NU B*' and therefore, given these glaring facts, Defendants' footwear is likely to be considered as one of the variants and new range of Plaintiff's footwear. Thus, a clear case of infringement is made out against the Defendants under Section 29 of 1999 Act.

14. It was urged that Plaintiff's adoption and use of the N-marks precedes Defendants' use by decades and adoption of the alphabet 'n' from amongst 26 alphabets in English language, is a pointer to the dishonest adoption with an intent to create confusion amongst members of public and trade and potential consumers by misrepresentation. Identity of goods, similar trade channels and common consumers enhances the likelihood of confusion. Defendants' adoption and use of deceptively similar marks and is only to encash on the substantial goodwill and reputation garnered by the Plaintiff in the N-marks, evident from sales turnover, expenditure on promotion, sponsorship of sports events, brand endorsements by celebrities, social media presence, media coverage, prestigious awards

received, number of retail stores, sales through Plaintiff's dedicated websites as also on third-party e-commerce websites and most importantly, declaration of the shaded logo mark , NEW BALANCE and NB as well-known marks by this Court, *albeit* at the very early stage of the proceedings, Defendants had given an undertaking not to use the standalone mark as also not to use **'nu',** separately as 'n' and 'u' on the same pair of shoes, since at that stage, the defence was also that 'nu' together is not deceptively similar. The intent of the Defendants is only to pass off their identical goods as emanating from the house of the Plaintiff or having some association or affiliation with it, which is damaging the goodwill and reputation of the Plaintiff and hence, all three ingredients of passing off are made out and Plaintiff has a *prima facie* case in its favour for grant of temporary injunction.

15. It was argued that Plaintiff has been using the N-marks globally from 1970s and in India the products are being purchased since 1986 and are also available on various e-commerce sites. In 2004 and 2005, Plaintiff organised many events in India to launch its new models of footwear and in 2006, Plaintiff appointed a distributor and tied up with Moja Footwear, a manufacturer to outsource production in India. In 2016, Plaintiff entered into a franchise agreement with an Indian party to open retail stores and also granted license to use the marks. In the same year, Plaintiff opened its flagship store in NOIDA, which was widely covered by media houses. In contrast, Defendants launched the footwear under the impugned n-marks only in April, 2024, in India and thus being a prior and substantial user, with enviable goodwill and reputation, the balance of convenience lies in favour

of the Plaintiff and against the Defendants. Defendants manufacture, market and sell footwear under various brands such as Bugatti, Salamander and TT Bagatt besides NUBEAT and even the footwear sold under NUBEAT brand do not necssarily bear Defendants' n-marks. Compared and contrasted, majority of Plaintiff's footwear, if not all, prominently bear one or other variation of the N-marks. Therefore, if Defendants are permitted to continue using the impugned n-marks and are not injuncted, it will cause irreparable harm and injury to Plaintiff and dilute its N-marks including the well-known declared marks , NEW BALANCE and NB. It was strenously urged that since in the instant case all ingredients of passing off: goodwill; misrepresentation; and irreparable harm and injury are satisfied, order of interim injunction must follow applying the law laid down by the Supreme Court in ***Laxmikant V. Patel v. Chetanbhai Shah and Another, (2002) 3 SCC 65*** and ***S. Syed Mohideen v. P. Sulochana Bai, (2016) 2 SCC 683.***

16. Arguing on behalf of the Defendants, Mr. Rohan Rohatgi, learned counsel submitted that Plaintiff is not entitled to interim injunction and the application is liable to be dismissed, being devoid of merit as no case of infringement and/or passing off is made out. It was urged that Defendant No.1 is a Corporation incorporated under Laws of Switzerland and Defendants No.2 and 3 are subsidiary companies of Defendant No.1 in India. Defendant No.1 is an internationally renowned company engaged in the business of manufacturing and selling footwear amongst other products and traces its roots to 1928, when Mr. Johann Muller, renowned song writer and musician, established a bespoke shoe making workshop in Germany. With heritage spanning generations, Defendant No.1 continuously redefines

footwear standards, seamlessly blending tradition with contemporary design and over 400 professionals work in the dynamic and high skilled environment thriving with precision and innovation. Over the years, Defendant No.1 has established itself as a leading European shoe maker holding exclusive global licenses for brands like Bugatti since 2000 and Daniel Hechter since 2014 and acquired German heritage brand Salamander in 2023, which are available at their official website https://astormueller.com.

17. It is submitted that the footwear manufactured by Defendant No.1 is a collection crafted by highest-grade material and supported by expert European technical precision and there exists a solid distribution network at the global market, where sales are expanding through online and retail stores every day. Defendant No.1 also owns and retails popular footwear brands like Bagatt, TT Bagatt and NUBEAT. In 2007, Defendant No.1 established its direct presence in India with incorporation of Defendant No.2 in Bengaluru and introduced advanced German footwear manufacturing techniques into facilities located in Ambur in Tamil Nadu and Agra in Uttar Pradesh and over the years, Defendants have built immense goodwill and reputation by selling fashionable footwear with unique features and high quality. It was submitted that around October, 2021, Defendants adopted the mark nu:beat, which is the brain child of Johanna Muller as a sneaker line, one that would be all about music, movement and community. The syllable 'nu' is a Greek symbol for frequency used in Physics and audio engineering to represent the rate at which a sound wave oscillates and symbolizes rhythm, energy and movement. The footwear is exclusively designed in Europe and trademark nu:beat has many device mark variants.

18. It was submitted that as an extension of nu:beat range, Defendant

No.1 adopted variants like n:, n: nu:beat, nu:beat and n: and secured registrations in India as also internationally, as follows:-

INDIAN REGISTRATIONS

Trade Mark No.	Trade Mark	Class/es	Date of Registration
5178942	NU:BEAT	18, 25	19.10.2021
5178943	NUBEAT	18, 25	19.10.2021
5239238	n:	18, 25	08.12.2021
5239239	n: nu:beat	18, 25	08.12.2021
5239240	nu:beat	18, 25	08.12.2021
5666069	n:	18	01.11.2022
5666070	n:	25	01.11.2022

INTERNATIONAL REGISTRATIONS

Trade Mark No.	Trade Mark	Class	Country	Date of Registration
TM No. 789031	nu:beat	18,25	Switzerland	15.07.2022
TM No. 784279	n:	18,25	Switzerland	15.07.2022
International Registration No. 1684466	nu:beat	18,25	United Kingdom	15.07.2022
International Registration No. 1691940	n:	18,25	United Kingdom	30.08.2022
TM No. 018733304	n:	18,25	European Union	15.11.2022
TM No. 018733298	nu:beat	18,25	European Union	15.11.2022

19. Learned counsel brought forth that in April, 2024, Defendants started using the nu:beat marks in India with different series for different variants of

the sneakers and in a short span of time, the nu:beat trademarks came to be widely recognised and associated with the Defendants alone and from 01.04.2024 till 30.09.2025, Defendant No.2 earned a net revenue of Rs. 28,22,143/-, from the sale of footwear under nu:beat marks. Defendants have made continuous and rigorous efforts in promoting their goods, both online and offline and have invested substantial money in doing so. Several third-party social media platforms like Facebook and Instagram are used to promote the goods and the marks and in addition, Defendants sell the goods through their website http://nubeat.com/ and the website Myntra. The details of the series are as follows:-

Group/Series	Article Name
Bboy	Anthem
Jazz	Area808 Area909
Punk	C Major C Minor
	Spin
Indie	Groovestar
Rave	Hipsonic

20. It was argued that Defendant No.1 is the registered proprietor of the trademarks n:, n: and n: nu:beat in Classes 18 and 25 in India and hence, Plaintiff cannot lay a claim of infringement *qua* the registered trademarks under Section 29 of 1999 Act, which clearly provides that a registered mark is infringed by a person who is neither a registered proprietor nor a person using by way of permitted use. Reliance was placed on the judgment of the Supreme Court in ***S. Syed Mohideen (supra),*** to support this plea. It was further asserted that in any event, Plaintiff's

N-marks and Defendants' impugned marks have no resemblance or similarity due to difference in picturization of the small case letter 'n' accompanied by a fanciful colon (':') device. Defendants' impugned marks are sufficiently distinct in typography, stylization and overall commercial impression and there is no visual or structural similarity. The pronunciation of N-marks and nu:beat marks is also different in as much as mark is not pronounced as 'n' but as 'n-colon' and nu:beat device mark is pronounced as 'nubeat', thereby negating any argument of phonetic similarity. Moreover, Plaintiff does not have and cannot have monopoly and/or registration in the standalone letter 'N' and it is settled law that registration of the device mark confers no right of exclusivity and monopoly over the components/elements of the mark. Infringement is a mark to mark comparison unlike a claim for passing off and hence, in the absence of any similarity/deceptive similarity in the rival marks and in light of registration of impugned marks, Plaintiff's claim of infringement must fail. To buttress the plea that there can be no monopoly in standalone letters, reliance was placed on the judgment of this Court in ***Relaxo Footwears Limited v. XS Brands Consultancy Private Limited and Others, 2024 SCC OnLine Del 3434,*** where the rival marks were 'X' device marks.

21. It was further argued that Plaintiff is unable to make out a case of passing off and the present suit is only an attempt to destroy Defendants' reputation and goodwill in the market. Defendants have honestly adopted the , and device marks, which are distict from the N-marks of the Plaintiff. Defendants have a longstanding global

reputation and in 2007, Defendant No.1 established its direct presence in India with incorporation of Defendant No.2 in Bengaluru and introduced advanced German footwear manufacturing techniques into facilities located in Ambur, Tamil Nadu and Agra, Uttar Pradesh and over the years, Defendants have built immense goodwill and reputation by selling fashionable footwear with unique features and high quality. Around October, 2021, Defendant No.1 adopted the mark nu:beat, where 'nu' is a Greek symbol and the footwear is exclusively designed in Europe and is of exceptional quality. The nu:beat range was expanded and variants , , and were introduced in which Defendant No.1 has secured registrations in India and internationally. Defendants started using nu:beat marks for their specially designed footwear from April, 2024 and due to the existing reputation, both global and in India, within a short span of time sales were to the tune of Rs.28,22,143/-. With this historical background and goodwill, Defendants have no reason to mispresent their goods as those of the Plaintiff by adopting Plaintiff's marks and/or encash on its reputation and *sans* an element of misrepresentation and deceipt, allegations of passing off have no legs to stand on. Defendant No.1 has been in the business of shoes since 1928 and has manufactured and licensed for many well known brands in the world and has its own goodwill and reputation.

22. It was also contended that there is no similarity in the rival marks inasmuch as Plaintiff's N-marks: and have an upper-case N, formed by two slanted vertical strokes connected by sharp, diagonal,

angled and pointed ends that resemble a rigid zigzag and one of them has a shading, whereas the impugned marks have a lower-case , featuring a short vertical stem and a rounded arch or hump extending from its right side, resembling a horseshoe magnet followed by a distinct punctuation i.e colon. Moreover, Defendants' use various elements on the actual product such as nu:beat, either on the side, back or near the lace area or inner and outer soles and hence, purchasers of the goods of the rival parties will be able to distinguish the source of the goods.

23. It was also argued that Plaintiff is comparing the impugned marks by dissecting them into individual elements as 'n' and ':', which is against the anti-dissection rule and if the rival marks are compared as a whole on an overall impression test, there is no similarity. ***[Ref: Super Cassettes Industries Ltd. v. Union of India and Others, 2010 SCC OnLine Del 1652].*** Plaintiff has not placed any material on record to show actual confusion in the market and/or actual damage to its business or goodwill as a result thereof and therefore, none of the three ingredients of the tort of passing off are made out.

24. It was also vehemently urged that the letter 'N' is non-distinctive and no exclusive right can be claimed over a single letter as that would stifle competition and bar legitimate players from using common alphabets in conjunction with other elements. Moreover, when Defendant No.1 had applied for registration, many existing trademarks with letter N were cited in the Examination Report by the Trade Marks Registry, but none of Plaintiff's marks were cited which in itself is evidence to the fact that Plaintiff's N-marks are not deceptively similar. Additionally, Plaintiff's N-marks have co-existed in India with several third-parties marks on the Register of Trade

Marks, details of which have been placed on record and illustratively, reference was made to a third-party Nicholas Shoes Pvt. Ltd., which adopted and used the N-logo in India, which was subsequently registered and products were sold at https://www.nicholasshoes.net. Reliance was placed on the judgment in ***ARG Outlier Media Pvt. Limited v. Rayudu Vision Media Limited, 2023 SCC OnLine Bom 1825*** of the Bombay High Court, where it was held that where a Plaintiff disclaims monopoly over a single letter or alphabet *per se* or the colour combination, then these cannot be the central or essential feature of the registered device mark and in such a situation, Plaintiff's case can be supported only if it *prima facie* shows that the depiction of the single letter or alphabet in its device mark is in some manner unique or stylized and hence, distinctive. Reliance was also placed on the judgment of the Supreme Court in ***J.R. Kapoor v. Micronix India, 1994 Supp (3) SCC 215,*** where it was held that a descriptive prefix common to a technology ('micro') attracts no monopoly and where the distinguishing suffixes ('tel'/'nix') are phonetically and visually dissimilar, including in their logos and cartons, there is no likelihood of confusion among users familiar with such goods.

25. Arguing in rejoinder, learned counsel for the Plaintiff reiterated that the rival marks are nearly identical/deceptively similar and used for identical products and thus confusion is not only likely but is inevitable and is aggravated by the number of variations of N-mark used by the Plaintiff over the years. It was denied that registration of Defendants' marks is a bar to Plaintiff's claim for infringement and reference was made to Section 28(1) of 1999 Act, which stipulates that registration of a mark, if valid, gives to the registered proprietor of the mark the exclusive right to use the same in relation to goods/services in respect of which it is registered and obtain the

relief of injunction. It was reiterated that the registration of Defendants' marks is illegal and contrary to Section 11(1) of 1999 Act and it is not understood why the Registrar of Trade Marks did not cite Plaintiff's marks, but for that Plaintiff cannot be faulted. In any event, assuming for the sake of argument that no claim for infringement lies, relief of passing off is still available to the Plaintiff, which is a common law right and this position is explicitly clear from the judgement of the Supreme Court in ***S. Syed Mohideen (supra)*** and the judgement of the Division Bench of this Court in ***Vaidya Rishi India Health Private Limited and Another v. Suresh Dutt Parashar and Others, 2025 SCC OnLine Del 6147.***

26. It was also reiterated that all three ingredients of passing off are satisfied in the present case. Defendants' marks are likely to deceive consumers and traders alike, into believing that goods sold or offered for sale by them have an association with the Plaintiff or at least are an extension of Plaintiff's goods, since the N-marks are conceptually, visually and phonetically identical to the impugned marks and there is identity of goods. Letter N as a lower case version is the dominant element in the marks and and addition of colon is not enough to distinguish them from Plaintiff's N-marks and even otherwise this does not take away the phonetic similarity. It is clear that Defendants adopted the n-marks, especially, the two logos and only to come close to the Plaintiff and confuse the unwary purchaser.

27. It was further argued that there is no merit in the contention of the Defendants that the N-mark is common to Register and trade. To support the

proposition, Defendants have relied upon a search report produced by Mike Legal, however, the platform neither constitutes an official source of trademark records nor guarantees the accuracy or current status of the listed marks. Moreover, search reports are not enough to evidence that the marks are used and therefore in light of the judgement in ***Novartis AG v. Crest Pharma Pvt. Ltd. and Another, 2009 SCC OnLine Del 4390,*** this contention merits rejection. Reliance on the mark of an entity called Nicholas Shoes Pvt. Ltd. is equally misplaced as the N-mark of the Plaintiff herein has been used since 1970s in USA and since 09.10.1986 in India for the trademark , which is evident from the Registration Certificate showing registration of the mark from 18.05.1987 and any subsequent user cannot dent this position. In ***Pankaj Goel v. Dabur India Ltd., 2008 SCC OnLine Del 1744,*** Division Bench of this Court held that the defence of marks being common to trade/register is not enough and it must be shown that the said third-parties were actually using the marks and had significant business or turnover. To the same effect is the judgment of Calcutta High Court in ***Express Bottlers Services Private Ltd. v. Pepsico Inc. & Ors., 1988 SCC OnLine Cal 62,*** where it was observed that in the absence of evidence of substantial use of the mark by a third party and the extent of its trade and business, a proprietor of a mark is not expected to sue and run after each and every infringer, no matter how small it is.

28. Heard learned counsels for the parties and examined their rival submissions.

29. The factual narrative in the plaint and documents filed therewith, shows that Plaintiff is the registered proprietor of N-marks: ,

, and in Classes 18 and 25. Plaintiff as successor-in-interest of New Balance Arch Support Company, founded in USA in 1906, used letter N for the first time as a trademark in USA in 1970s on footwear. On 18.05.1987, mark was registered in favour of the Plaintiff in Class 25, followed by registration of mark in Classes 18 and 25 on 10.09.1997 and registration of mark in Class 25 on 06.03.2007. Plaintiff asserts that in India, Plaintiff's products have been purchased by Indian consumers since 1986 and are also available on various e-commerce platforms. This position is untraversed by the Defendants herein and importantly, this is also recorded by the Court in both the judgments ***Jitender Kumar (supra)*** and ***New Balance Immigration (supra),*** declaring three N-marks as well-known marks. In 2004 and 2005, Plaintiff organised many events in India to launch its new models of footwear and the launch was by the famous cricketer Mr. Brett Lee and was widely covered by the media. In 2006, Plaintiff appointed a distributor, who in turn tied up with Moja Footwear, a manufacturer, to outsource production in India. In the same year, the products and the N-marks were showcased in a renowned news channel Zee Business and their popularity spread across the length and breadth of the country. Year 2016 saw the opening of retail stores in India and pertinently, the flagship store of the Plaintiff in Noida, which too was widely covered by many media houses. The retail stores thereafter expanded to many cities such as Gurugram, Chandigarh, Lucknow etc. As averred, Plaintiff's footwear bearing the N-marks featured prominently in 2016 IPL and in 2025 series, many cricketers wore the footwear with N-marks and resultantly, owing to the matches being watched by lakhs of people in the stadium, on television/OTT platforms, the marks received immense attention and the sales increased.

30. On the other hand, Defendant No.1's marks and were registered in India in Classes 18 and 25 on 08.12.2021 and the mark was registered in the same class on 01.11.2022 *albeit* Defendants lay much stress on Defendant No.1's roots in footwear industry dating back to 1928. Admittedly, around October, 2021, Defendant No.1 adopted the mark nu:beat and later as an extension of the nu:beat range, Defendant No.1 adopted variants like , , and . It is categorically stated in paragraph 14 of the written statement jointly filed by the Defendants that Defendant No.1 started using the nu:beat marks in India in April, 2024, with different series launched by it for different variants of the sneakers.

31. Plaintiff seeks injunction against the Defendants *inter alia* for infringement and passing off. The common thread that runs in Section 29(1) and (2) of 1999 Act is that a registered trademark is infringed by a person who, not being a registered proprietor or a permissive user, uses the mark of the registered proprietor, without authorisation. Defendants refute the claim of infringement on the ground that Defendant No.1's nu:beat marks are registered in India also and one registered proprietor cannot sue the other

registered proprietor for infringement. Plaintiff, on the other hand, asserts that even if this argument is accepted without prejudice, registration cannot be a defence to an action for passing off and I agree. In ***S. Syed Mohideen (supra),*** the Supreme Court held that answer to the question whether an owner of registered trademark can bring an action against the other party for passing off, invoking Section 27(2) of 1999 Act, if the other party is also the registered proprietor, is in the affirmative. In other words, the Supreme Court was deciding an interplay between Section 27(2) and Section 28(3) of 1999 Act and rendered four reasons to come to this conclusion. Relevant paragraphs of the judgments are as follows:-

> *"**28.** However, what is stated above is the reflection of Section 28 of the Act when that provision is seen and examined without reference to the other provisions of the Act. It is stated at the cost of repetition that as per this Section owner of registered trade mark cannot sue for infringement of his registered trade mark if the appellant also has the trade mark which is registered. Having said so, a very important question arises for consideration at this stage, namely, whether such a respondent can bring an action against the appellant for passing off invoking the provisions of Section 27(2) of the Act. In other words, what would be the interplay of Section 27(2) and Section 28(3) of the Act is the issue that arises for consideration in the instant case. As already noticed above, the trial court as well as the High Court have granted the injunction in favour of the respondent on the basis of prior user as well as on the ground that the trade mark of the appellant, even if it is registered, would cause deception in the mind of the public at large and the appellant is trying to encash upon, exploit and ride upon on the goodwill of the respondent herein. Therefore, the issue to be determined is as to whether in such a scenario, the provisions of Section 27(2) would still be available even when the appellant is having registration of the trade mark of which he is using.*
>
> ***29.** After considering the entire matter in the light of the various provisions of the Act and the scheme, our answer to the aforesaid question would be in the affirmative. Our reasons for arriving at this conclusion are the following.*
>
> ***30. Firstly**, the answer to this proposition can be seen by carefully looking at the provisions of the Trade Marks Act, 1999 (the Act). Collective reading of the provisions especially Sections 27, 28, 29 and 34 of the Trade Marks Act, 1999 would show that the rights conferred by registration are subject to the rights of the prior user of the trade mark. We have already reproduced Section 27 and Section 29 of the Act.*

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

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

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

***30.4.** Section 34 of the Trade Marks Act, 1999 provides that nothing in this Act shall entitle the registered proprietor or registered user to interfere with the rights of prior user. Conjoint reading of Sections 34, 27 and 28 would show that the rights of registration are subject to Section 34 which can be seen from the opening words of Section 28 of the Act which states "Subject to the other provisions of this Act, the registration of a trade mark shall, if valid, give to the registered proprietor…." and also the opening words of Section 34 which states "Nothing in this Act shall entitle the proprietor or a registered user of registered trade mark to interfere…." Thus, the scheme of the Act is such where rights of prior user are recognised superior than that of the registration and even the registered proprietor cannot disturb/interfere with the rights of prior user. The overall effect of collective reading of the provisions of the Act is that the action for passing off which is premised on the rights of prior user generating a goodwill shall be unaffected by any registration provided under the Act. This proposition has been discussed in extenso in N.R. Dongre v. Whirlpool Corpn. [N.R. Dongre v. Whirlpool Corpn., 1995 SCC OnLine Del 310 : AIR 1995 Del 300] wherein the Division Bench of the Delhi High Court recognised that the registration is not an indefeasible right and the same is subject to rights of prior user. The said decision of Whirlpool [N.R. Dongre v. Whirlpool Corpn., 1995 SCC OnLine Del 310 : AIR 1995 Del 300] was further affirmed by the Supreme Court of India in N.R. Dongre v. Whirlpool Corpn. [N.R. Dongre v. Whirlpool*

Corpn., (1996) 5 SCC 714]

30.5. *The above were the reasonings from the provisions arising from the plain reading of the Act which gives clear indication that the rights of prior user are superior than that of registration and are unaffected by the registration rights under the Act.*

31. Secondly*, there are other additional reasonings as to why the passing off rights are considered to be superior than that of registration rights.*

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

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

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

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

32.1. *The same author also recognises the principle that the Trade Marks Act affords no bar to the passing off action. This has been explained by the learned author as under:*

> *"15-034. Subject to possibly one qualification, nothing in the Trade Marks Act, 1994 affects a trader's right against another in an action for passing off. It is, therefore, no bar to an action for passing off that the trade name, get up or any other of the badges identified with the claimant's business, which are alleged to have been copies or imitated by the defendant, might have been, but are not registered as, trade marks, even though the evidence is wholly addressed to what may be a mark capable of registration. Again, it is no defence to passing off that the defendant's mark is registered. The Act offers advantages to those who register their trade marks, but imposes no penalty upon those who do not. It is equally no bar to an action for passing off that the false representation relied upon is an imitation of a trade mark that is incapable of registration. A passing off action can even lie against a registered proprietor of the mark sued upon. The fact that a claimant is using a mark registered by another party (or even the defendant) does not of itself prevent goodwill being generated by the use of the mark, or prevent such a claimant from relying on such goodwill in an action against the registered proprietor. Such unregistered marks are frequently referred to as 'common law trade marks'."*

32.2. *From the reading of the aforementioned excerpts from Kerly's Law of Trade Marks and Trade Names, it can be said that not merely it is recognised in India but in other jurisdictions also including England/UK (Provisions of the UK Trade Marks Act, 1994 are analogous to the Indian Trade Marks Act, 1999) that the registration is no defence to a passing off action and nor the Trade Marks Act, 1999 affords any bar to a passing off* *action. In such an event, the rights conferred by the Act under the provisions of Section 28 have to be subject to the provisions of Section 27(2) of the Act and thus the passing off action has to be considered independent "Iruttukadai Halwa" under the provisions of the Trade Marks Act, 1999.*

***33. Fourthly**, it is also a well-settled principle of law in the field of the trade marks that the registration merely recognises the rights which are already pre-existing in common law and does not create any rights. This has been explained by the Division Bench of the Delhi High Court in Century Traders v. Roshan Lal Duggar & Co. [Century Traders v. Roshan Lal Duggar & Co., 1977 SCC OnLine Del 50 : AIR 1978 Del 250] in the following words : (SCC OnLine Del para 10)*

> *"10. '16. … First is the question of use of the trade mark. Use plays an all-important part. A trader acquires a right of property in a distinctive mark merely by using it upon or in connection with his goods irrespective of the length of such user and the extent of his trade. The trader who adopts such a mark is entitled to protection directly the article having assumed a vendible character is launched upon the market. Registration under the statute does not confer any new right to the mark claimed or any greater rights than what already existed at common law and at equity without registration. It does, however, facilitate a remedy which may be enforced and obtained throughout 'the State and it established the record of facts affecting the right to the mark. Registration itself does not create a trade mark. The trade mark exists independently of the registration which merely affords further protection under the statute. Common law rights are left wholly unaffected.' [**Ed.** : As observed in L.D. Malhotra Industries v. Ropi Industries, 1975 SCC OnLine Del 172, para 16.] "*

(emphasis supplied)

***33.1.** The same view is expressed by the Bombay High Court in Sunder Parmanand Lalwani v. Caltex (India) Ltd. [Sunder Parmanand Lalwani v. Caltex (India) Ltd., 1965 SCC OnLine Bom 151 : AIR 1969 Bom 24] in which it has been held vide AIR para 32 as follows : (SCC OnLine Bom paras 1 & 2)*

> *"1. A proprietary right in a mark can be ['Iruttukadai Halwa'] obtained in a number of ways. The mark can be originated by a person, or it can be subsequently acquired by him from somebody else. Our Trade Marks law is based on the English Trade Marks law and the English Acts. The first Trade Marks Act in England was passed in 1875. Even prior thereto, it was firmly established in England that a trader acquired a right of property in a distinctive mark merely by using it upon or in connection with goods irrespective of the length of such user and the extent of his trade, and that he was entitled to protect such right of property by appropriate proceedings by way of injunction in a court of law. Then came the English Trade*

Marks Act of 1875, which was substituted later by later Acts. The English Acts enabled registration of a new mark not till then used with the like consequences which a distinctive mark had prior to the passing of the Acts. The effect of the relevant provision of the English Acts was that registration of a trade mark would be deemed to be equivalent to public user of such mark. Prior to the Acts, one could become a proprietor of a trade mark only by user, but after the passing of the Act of 1875, one could become a proprietor either by user or by registering the mark even prior to its user. He could do the latter after complying with the other requirements of the Act, including the filing of a declaration of his intention to use such mark. See observations of Llyod Jacob, J. in Vitamins Ltd.'s Application, In re [Vitamins Ltd.'s Application, In re, (1956) 1 WLR 1 : (1955) 3 All ER 827 : 1956 RPC 1] at RPC p. 12, and particularly the following : (WLR p. 10)

> *'... A proprietary right in a mark sought to be registered can be obtained in a number of ways. The mark can be originated by a person or can be acquired, but in all cases it is necessary that the person putting forward the application should be in possession of some proprietary right which, if questioned, can be substantiated.'*

2. Law in India under our present Act is similar."

(emphasis supplied)

***33.2.** We uphold the said view which has been followed and relied upon by the courts in India over a long time. The said views emanating from the courts in India clearly speak in one voice, which is, that the rights in common law can be acquired by way of use and the registration rights were introduced later which made the rights granted under the law equivalent to the public user of such mark. Thus, we hold that registration is merely a recognition of the rights pre-existing in common law and in case of conflict between the two registered proprietors, the evaluation of the better rights in common law is essential as the common law rights would enable the court to determine whose rights between the two registered proprietors are better and superior in common law which have been recognised in the form of the registration by the Act."*

32. In ***Century Traders v. Roshan Lal Duggar & Co., 1977 SCC OnLine Del 50,*** Division Bench of this Court had earlier held that registration is merely a recognition of pre-existing rights in common law and in case of conflict between two registered proprietors, evaluation of better rights should be under the common law. Recently, in ***Vaidya Rishi (supra),*** the Division Bench re-affirmed that passing off action would lie against a

registered proprietor of a trademark as the right to sue for passing off arises under common law and is not a statutory tort, relying on ***S. Syed Mohideen (supra).*** Therefore, Plaintiff is right in contending that *de hors* the registration of the nu:beat marks in favour of Defendant No.1, including the logo marks and , Plaintiff can bring an action for passing off against the Defendants.

33. The three ingredients that are required to be satisfied by a party bringing an action for passing off have been laid down and reiterated and reaffirmed in many judgments and are: goodwill; misrepresentation in the course of trade; and damage caused. The three ingredients are considered to be the classical trinity and in this context, I may allude to one passage from ***S. Syed Mohideen (supra)*** as follows:-

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

34. It would be useful to refer to few passages from a recent judgment of

the Division Bench of this Court in ***Western Digital Technologies Inc. and Another v. Geonix International Private Limited, Through its Directors, Gaurav Jain Saurabh Jain and Another, 2026 SCC OnLine Del 901,*** against which **Special Leave to Appeal (C) No. 17783/2026** has been dismissed on 26.05.2026. In the said judgment, Court has once again highlighted the three essential ingredients as also the principle of initial interest confusion i.e., the likelihood of confusion by a consumer is to be assessed at the point of 'initial interest' i.e., when the consumer first sees the goods of the Defendant and reiterated that requirement of likelihood of confusion permeates both the tort of infringement as well as that of passing off. Relevant paragraphs are as follows:-

> ***"85.*** *Trade mark rights, in our country, are cabined and confined within the Trade Marks Act. The "saving clause" with reference to passing off is contained in Section 27(2), which clarifies that nothing in the Act would affect the rights of action against "any person for passing off goods or services as the goods of another person or services provided by another person, or the remedies in respect thereof". It is true that the provision does not read "any person for passing off his goods or services as the goods of another person or services provided by another person..." However, we regarded it as implicit, in Section 27(2), that passing off must be of one's goods or services as those of another. In other words, if Mr X were to represent the goods of Mr Y as those of Mr Z, it would not, to our mind, constitute "passing off" as envisaged in Section 27(2).*
>
> ***86.*** *This is also clear from various judicial pronouncements of the Supreme Court which identify the ingredients of "passing off".*
>
> ***87.*** *In Kaviraj Pt Durga Dutt Sharma v. Navaratna Pharmaceutical Laboratories, the Supreme Court observed that "an action for passing off is a Common Law remedy being in substance an action for deceit, that is, a passing off by a person of his own goods as those of another". Similarly, in Satyam Infoway Ltd. v. Siffynet Solutions (P) Ltd., the Supreme Court held that "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". We may reproduce, to advantage, paras 13 to 15 of* ***Satyam Infoway*** *thus:*
>
>> *"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 (Pty) Ltd. v. PUB Squash Co. (Pty) Ltd.; Erven Warnink Besloten Vennootschap v. J. Townend & Sons (Hull) Ltd.]. 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 Ltd. v. Rysta Ltd.].

15. The third element of a passing off action is loss or the likelihood of it."

(Emphasis supplied)

These passages stand approvingly cited by the Supreme Court in its somewhat recent decision in Brihan Karan Sugar Syndicate Pvt. Ltd. v. Yashwantrao Moyhite Krushna Sahakari Sakhar Karkhana.

***88.** Inasmuch as Section 27(2) saves the "rights of action against any person" for passing off, the right of action which is saved is, clearly, the right of action against a defendant for passing off its goods as those of the plaintiff.*

xxx xxx xxx

***98.** The requirement of likelihood of confusion permeates both the tort of infringement as well as that of passing off. The principle of "initial* *interest confusion" requires the aspect of likelihood of confusion by the consumer to be assessed at the point of "initial interest" i.e. when the consumer first sees the goods of the defendant. This principle applies as much to passing off as to infringement, as there is no qualitative difference between confusion in one case and confusion in the other."*

35. I may profitably refer to the principles elucidated in respect of passing off by the Supreme Court in ***Laxmikant (supra),*** including a very important observation that a refusal to grant injunction in spite of availability of facts, which are *prima facie* established by overwhelming evidence and material available on record justifying the grant thereof, occasions failure of justice and such injury to the Plaintiff would not be capable of being undone at a later stage. Relevant passages are as follows:-

"8. *It is common in trade and business for a trader or a businessman to adopt a name and/or mark under which he would carry on his trade or business. According to Kerly (Law of Trade Marks and Trade Names, 12th Edn., para 16.49), the name under which a business trades will almost always be a trade mark (or if the business provides services, a service mark, or both). Independently of questions of trade or service mark, however, the name of a business (a trading business or any other) will normally have attached to it a goodwill that the courts will protect. An action for passing-off will then lie wherever the defendant company's name, or its intended name, is calculated to deceive, and so to divert business from the plaintiff, or to occasion a confusion between the two businesses. If this is not made out there is no case. The ground is not to be limited to the date of the proceedings; the court will have regard to the way in which the business may be carried on in the future, and to its not being carried on precisely as carried on at the date of the proceedings. Where there is probability of confusion in business, an injunction will be granted even though the defendants adopted the name innocently.*

9. *It will be useful to have a general view of certain statutory definitions as incorporated in the Trade Marks Act, 1999. The definition of trade mark is very wide and means, inter alia, a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others. Mark includes amongst other things name or word also. Name includes any abbreviation of a name.*

10. *A person may sell his goods or deliver his services such as in case of a profession under a trading name or style. With the lapse of time such business or services associated with a person acquire a reputation or goodwill which becomes a property which is protected by courts. A* *competitor initiating sale of goods or services in the same name or by imitating that name results in injury to the business of one who has the property in that name. The law does not permit any one to carry on his business in such a way as would persuade the customers or clients in believing that the goods or services belonging to someone else are his or are associated therewith. It does not matter whether the latter person does so fraudulently or otherwise. The reasons are two. Firstly, honesty and fair play are, and ought to be, the basic policies in the world of business. Secondly, when a person adopts or intends to adopt a name in connection with his business or services which already belongs to someone else it results in confusion and has propensity of diverting the customers and clients of someone else to himself and thereby resulting in injury.*

***11.**Salmond & Heuston in Law of Torts (20th Edn., at p. 395) call this form of injury as "injurious falsehood" and observe the same having been "awkwardly termed" as "passing-off" and state:*

> *"The legal and economic basis of this tort is to provide protection for the right of property which exists not in a particular name, mark or style but in an established business, commercial or professional reputation or goodwill. So to sell merchandise or carry on business under such a name, mark, description, or otherwise in such a manner as to mislead the public into believing that the merchandise or business is that of another person is a wrong actionable at the suit of that other person. This form of injury is commonly, though awkwardly, termed that of passing-off one's goods or business as the goods or business of another and is the most important example of the wrong of injurious falsehood. The gist of the conception of passing-off is that the goods are in effect telling a falsehood about themselves, are saying something about themselves which is calculated to mislead. The law on this matter is designed to protect traders against that form of unfair competition which consists in acquiring for oneself, by means of false or misleading devices, the benefit of the reputation already achieved by rival traders."*

***12.** In Oertli v. Bowman [1957 RPC 388 (CA)] (at p. 397) the gist of passing-off action was defined by stating that it was essential to the success of any claim to passing-off based on the use of given mark or get-up that the plaintiff should be able to show that the disputed mark or get-up has become by user in the country distinctive of the plaintiff's goods so that the use in relation to any goods of the kind dealt in by the plaintiff of that mark or get-up will be understood by the trade and the public in that country as meaning that the goods are the plaintiff's goods. It is in the nature of acquisition of a quasi-proprietary right to the exclusive use of the mark or get-up in relation to goods of that kind because of the plaintiff having used or made it known that the mark or get-up has relation to his goods. Such right is invaded by anyone using the same or some deceptively similar mark, get-up or name in relation to goods not of plaintiff. The three elements of passing-off action are the reputation of* *goods, possibility of deception and likelihood of damages to the plaintiff. In our opinion, the same principle, which applies to trade mark, is applicable to trade name.*

13. *In an action for passing-off it is usual, rather essential, to seek an injunction, temporary or ad interim. The principles for the grant of such injunction are the same as in the case of any other action against injury complained of. The plaintiff must prove a prima facie case, availability of balance of convenience in his favour and his suffering an irreparable injury in the absence of grant of injunction. According to Kerly (ibid, para 16.16) passing-off cases are often cases of deliberate and intentional misrepresentation, but it is well settled that fraud is not a necessary element of the right of action, and the absence of an intention to deceive is not a defence, though proof of fraudulent intention may materially assist a plaintiff in establishing probability of deception. Christopher Wadlow in Law of Passing-Off (1995 Edn., at p. 3.06) states that the plaintiff does not have to prove actual damage in order to succeed in an action for passing-off. Likelihood of damage is sufficient. The same learned author states that the defendant's state of mind is wholly irrelevant to the existence of the cause of action for passing-off (ibid, paras 4.20 and 7.15). As to how the injunction granted by the court would shape depends on the facts and circumstances of each case. Where a defendant has imitated or adopted the plaintiff's distinctive trade mark or business name, the order may be an absolute injunction that he would not use or carry on business under that name (Kerly, ibid, para 16.97).*

14. *In the present case the plaintiff claims to have been running his business in the name and style of Muktajivan Colour Lab and Studio since 1982. He has produced material enabling a finding being arrived at in that regard. However, the trial court has found him using Muktajivan as part of his business name at least since 1995. The plaintiff is expanding his business and exploiting the reputation and goodwill associated with Muktajivan in the business of colour lab and photo by expanding the business through his wife and brother-in-law. On or about the date of the institution of the suit the defendant was about to commence or had just commenced an identical business by adopting the word Muktajivan as a part of his business name although till then his business was being run in the name and style of Gokul Studio. The intention of the defendant to make use of the business name of the plaintiff so as to divert his business or customers to himself is apparent. It is not the case of the defendant that he was not aware of the word Muktajivan being the property of the plaintiff or the plaintiff running his business in that name, though such a plea could only have indicated the innocence of the defendant and yet no difference would have resulted in the matter of grant of relief to the plaintiff because the likelihood of injury to the plaintiff was writ large. It is difficult to subscribe to the logic adopted by the trial court, as also the High Court, behind reasoning that the defendants' business was situated at a distance of 4 or 5 km from the plaintiff's business and therefore the* *plaintiff could not have sought for an injunction. In a city a difference of 4 or 5 km does not matter much. In the event of the plaintiff having acquired a goodwill as to the quality of services being rendered by him, a resident of Ahmedabad city would not mind travelling a distance of a few kilometres for the purpose of availing a better quality of services. Once a case of passing-off is made out the practice is generally to grant a prompt ex parte injunction followed by appointment of Local Commissioner, if necessary. In our opinion the trial court was fully justified in granting the ex parte injunction to the plaintiff based on the material made available by him to the court. The trial court fell in error in vacating the injunction and similar error has crept in the order of the High Court. The reasons assigned by the trial court as also by the High Court for refusing the relief of injunction to the plaintiff are wholly unsustainable.*

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16. *There was no delay in filing the suit by the plaintiff. The plaintiff filed the suit with an averment that the defendants were about to commit an injury to the plaintiff. The defendants took a plea that they had already commenced the business with the offending trade name without specifying actually since when they had commenced such business. This has to be seen in the background that the defendants' business earlier was admittedly being carried on in the name and style of Gokul Studio. The commencement of such business by the defendants could therefore have been subsequent to the institution of the suit by the plaintiff and before the filing of the written statement by the defendants. In such a situation, on the plaintiff succeeding in making out a prima facie case, the court shall have to concentrate on the likelihood of injury which would be caused to the plaintiff in future and simply because the business under the offending name had already commenced before the filing of the written statement or even shortly before the institution of the suit would not make any difference and certainly not disentitle the plaintiff to the grant of ad interim injunction.*

17. *We are conscious of the law that this Court would not ordinarily interfere with the exercise of discretion in the matter of grant of temporary injunction by the High Court and the trial court and substitute its own discretion therefor except where the discretion has been shown to have been exercised arbitrarily or capriciously or perversely or where the order of the courts under scrutiny ignores the settled principles of law regulating grant or refusal of interlocutory injunction. An appeal against exercise of discretion is said to be an appeal on principle. The appellate court will not reassess the material and seek to reach a conclusion different from the one reached by the court below 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 (see* Wander Ltd. v. Antox India (P)

Ltd. [1990 Supp SCC 727 : 1991 SCC (Cri) 145] and N.R. Dongre v. Whirlpool Corpn. [(1996) 5 SCC 714]). However, the present one is a case falling within the well-accepted exceptions. Neither the trial court nor the High Court have kept in view and applied their mind to the relevant settled principles of law governing the grant or refusal of interlocutory injunction in trade mark and trade name disputes. A refusal to grant an injunction in spite of the availability of facts, which are prima facie established by overwhelming evidence and material available on record justifying the grant thereof, occasion a failure of justice and such injury to the plaintiff as would not be capable of being undone at a later stage. The discretion exercised by the trial court and the High Court against the plaintiff, is neither reasonable nor judicious. The grant of interlocutory injunction to the plaintiff could not have been refused, therefore, it becomes obligatory on the part of this Court to interfere."

36. The above position of law is reaffirmed by the Supreme Court in a recent decision in ***Pernod Ricard India Private Limited and Another v. Karanveer Singh Chhabra, 2025 SCC OnLine SC 1701,*** holding that passing off action is a common law remedy designed to protect the goodwill and reputation of a trader against misrepresentation by another, which causes or is likely to cause confusion among consumers, referring to an observation in ***Singer Manufacturing Co. v. Loog, 1880 18 Ch.D. 395,*** that no man is entitled to represent his goods as being the goods of another man. It was also held that action of passing off is rooted in the principle that one trader should not unfairly benefit from the reputation built by another and the Supreme Court also culled out the distinctions and commonalities in an action for infringement and passing off as follows:-

"29. *Before delving further, it is important to note that a passing off action is a common law remedy designed to protect the goodwill and reputation of a trader against misrepresentation by another, which causes or is likely to cause confusion among consumers. As observed by James L.J, in Singer Manufacturing Co v. loog, "no man is entitled to represent his goods as being the goods of another man". A passing off action applies to both registered and unregistered marks, and is rooted in the principle that one trader should not unfairly benefit from the reputation built by another. In contrast, an action for trademark infringement is a statutory remedy under the Trade Marks Act, 1999 available only in relation to registered* *trademarks. It is intended to safeguard the exclusive proprietary rights that registration confers.*

29.1. *A key distinction between the two lies in the requirements of proof. In an infringement action, the plaintiff is not required to establish the distinctiveness or goodwill of the mark - registration, by itself, affords the right to seek protection. If the impugned mark is shown to be identical or deceptively similar to the registered mark, no further evidence of confusion or deception is necessary. However, in a passing off action, the plaintiff must prove: (i) the existence of goodwill or reputation in the mark, (ii) a misrepresentation made by the defendant, and (iii) a likelihood of damage to the plaintiff's goodwill.*

29.2. *While an intent to deceive is not a necessary element in either action, passing off requires proof of a likelihood of confusion or deception. It is well settled that actual deception or damage need not be proved - the test is whether confusion is probable in the mind of the average consumer due to the similarity in the marks or the overall get-up of the goods.*

29.3. *Another key distinction is that in a passing off action, the defendant's goods need not be identical to those of the plaintiff - they may be allied or even unrelated, provided the misrepresentation is such that it affects or is likely to affect the plaintiff's business reputation. In contrast, infringement requires that the unauthorised use relate to the same or similar goods or services for which the trademark is registered.*

29.4. *Additionally, in an infringement suit, it is not necessary for the plaintiff to establish use of the mark; even a registered proprietor who has not commenced use can sue for infringement. However, in a passing off action, the plaintiff must demonstrate prior and continuous use, and that the mark has acquired distinctiveness in the minds of the public.*

29.5. *Thus, while both actions seek to prevent unfair competition and protect against consumer confusion, an action for infringement offers broader statutory protection based solely on registration and ownership. In contrast, passing off is grounded in equitable principles and imposes a higher evidentiary burden to safeguard commercial goodwill under common law."*

37. Going back, in ***Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd., (2001) 5 SCC 73,*** the Supreme Court laid down the parameters/factors to be applied by the Court testing an action of passing off for deciding the question of deceptive similarity of competing marks and I quote:-

"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 resembleness between the marks, phonetically similar and hence similar in idea.

(c) The nature of the goods in respect of which they are used as trade marks.

(d) The similarity in the nature, character and performance of the goods of the rival traders.

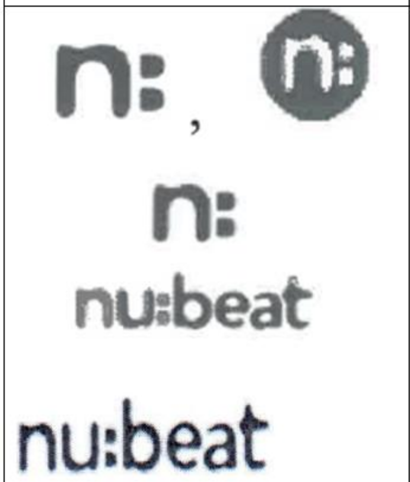
(e) The class of purchasers who are likely to buy the goods bearing the marks they require, on their education and intelligence and a degree of care they are likely to exercise in purchasing and/or using the goods.

(f) The mode of purchasing the goods or placing orders for the goods.

(g) Any other surrounding circumstances which may be relevant in the extent of dissimilarity between the competing marks.

***36.** Weightage to be given to each of the aforesaid factors depending upon facts of each case and the same weightage cannot be given to each factor in every case."*

38. Coming back to the instant case, the first issue that needs examination is whether the N-marks of the Plaintiff and nu:beat marks of the Defendants are deceptively similar. For ready reference, the comparative chart of the competing marks is as follows:-

DEFENDANTS' MARKS	PLAINTIFF'S MARKS
	

39. It is trite that while comparing the rival marks, in order to determine whether they are deceptively similar, the marks have to be seen as a whole.

In ***Corn Products Refining Co. v. Shangrila Food Products Ltd., 1959 SCC OnLine SC 11,*** the Supreme Court held that the two marks GLUCOVITA and GLUVITA were phonetically and visually similar and likely to mislead or confuse an average consumer of imperfect recollection and granted injunction, observing that the difference of 'CO' was not enough to distinguish the two marks. In ***Amritdhara Pharmacy v. Satya Deo Gupta, 1962 SCC OnLine SC 13,*** the marks 'Amritdhara' and 'Lakshmandhara' were held to be deceptively similar, owing to structural and phonetic resemblance, testing the marks on the touchstone of anti-dissection rule and emphasizing that class of consumers was a relevant factor in comparing the trademarks. In ***Kaviraj Pandit Durga Dutt Sharma v. Navaratna Pharmaceuticals Laboratories, 1964 SCC OnLine SC 14,*** the Supreme Court underscored the anti-dissection rule and cautioned against isolating individual parts of a composite mark and this position stands reaffirmed recently in ***Pernod Ricard (supra),*** where the Supreme Court observed that Courts are not expected to adopt a mechanical, side-by-side comparison of the marks. Earlier judgments in ***Khoday Distilleries Limited (now known as Khoday India Limited) v. Scotch Whisky Association and Others, (2008) 10 SCC 723*** and ***Parle Products (P) Ltd. v. J.P. and Co., Mysore, (1972) 1 SCC 618,*** also highlight the same test for mark to mark comparison of the rival marks.

40. Testing the marks on these principles, I am of the *prima facie* view that while the logo marks n: nu:beat, and nu:beat are not deceptively similar and there is enough added matter to the alphabet 'n' to distinguish Plaintiff's N-marks, the other two impugned logo marks

 and  are deceptively similar to the N-marks , , and  of the Plaintiff. As can be seen, on an overall comparison, taking the marks as a whole, letter **‘n’** is the dominant part of the marks  and  and is identical to the N-marks and the defence of the Defendants that the added colon is sufficient to distinguish, is wholly untenable. To any average consumer with imperfect recollection, the prominent and memorable component of the two marks will be the letter ‘n’ and the colon, which constitutes an additional element will be inconspicuous for being retained in an imperfect memory. The distinction sought to be brought out by the Defendants that ‘n:’ marks use a lower case ‘n’ while Plaintiff’s ‘N’ is an upper case, does not aid the Defendants as this does not materially diminsh the likelihood of deception. The distinction between the upper-case and lower-case lettering, particularly, in the given facts to which I shall advert later, is one of typography rather than substance. In the market place, where decisions to purchase are often made on fleeting visual impressions or phonetic similarity, consumers are unlikely to attach significance to such a fine distinction of a colon punctuation or font size and it is evident that the broad and overall visual impression conveyed by Defendants’ ‘n:’ marks will be one of letter **‘n’** and will be associated with the **‘N’** of the Plaintiff, as a source identifier. It is also pertinent to note one other submission of the Plaintiff that the colon is in fact not intended to be a punctuation mark but is a stylized representation of the letter ‘B’ and while this argument may not appeal at the first blush but a closer look of the

mark, does not allow brushing aside of this argument lightly and more particularly, in light of Defendant No.1's own response to the Examination Reports issued by the Registrar of Trade Marks at the time of registration under Nos. 5239238, 5666070 and 5666069 that is a combination of letter 'n' and letter 'B', where 'B' is represented in the style of a colon. If this position is accepted then *prima facie* there is no scope of contest on the deceptive similarity by the Defendants as in this event the mark will be read phonetically as 'NB', which is Plaintiff's mark declared as a well-known mark by this Court. It may also be noted that at the threshold stage of the proceedings in the suit, Defendants have given up the use of mark as a standalone mark, realising the close resemblance to Plaintiff's N-marks.

41. Coming to misrepresentation, which is the next ingredient of passing off, the Court has to see the similarity in the rival marks keeping in mind the aspect of resultant confusion and the classical test is whether an average consumer of imperfect recollection who comes across one mark at one point of time and the other later, is likely to be placed in a state of confusion. In ***Under Armour Inc v. Anish Agarwal and Another, 2025 SCC OnLine Del 3784,*** the Division Bench of this Court underscored the *'initial interest confusion'* test which recognises that confusion in the minds of customers arises only at the stage prior to consummating the purchase *albeit* at the time of completing the transaction, there may not be doubt in consumer's mind regarding the origin of the goods, however, this is sufficient to satisfy the condition of deceptive similarity. Division Bench found deceptive similarity

between the marks UNDER ARMOUR and AERO ARMOUR and observed that given the degree of similarity between the competing marks, nature of goods and use of similar trade channels, there was a likelihood of confusion and even if it was to be accepted, for the sake of argument, that there was no likelihood of confusion at the stage of purchase, there remained a possibility of confusion at the initial stage. The fact that the consumer is confused even if for a moment, would be sufficient and the fact that on closer examination of products and on making further enquiries, he may find that the impugned trademark is not associated with the mark pertaining to goods which he intended to buy, will not take away the fact that the impugned mark had a similarity.

42. In ***Madan Lal Purushottam Das Foods Private Limited v. B.L. Agro Industries Limited, 2025 SCC OnLine Del 6811,*** the Division Bench of this Court reaffirmed that likelihood of confusion has to be assessed from the initial interest stand point and does not require the consumer to be completely befuddled and all that is required is that he is placed in a state of 'wonderment'. In this context, I may refer to the following passages:-

> *"**23.3** The "likelihood of confusion", moreover, has to be assessed from an "initial interest" standpoint. In other words, it is the initial impression that the defendant's mark conveys to the average consumer of imperfect recollection, which is relevant. Further, all that is required is likelihood of confusion, not actual confusion. In other words, if an average consumer of imperfect recollection comes across the plaintiff's mark at one point of time, and the defendant's mark at another, later, point, it has to be assessed whether such a consumer would, on initially viewing the respondent's mark, be placed in a state of confusion as to whether the defendant's mark was the same as that of the plaintiff which he had seen earlier - or was associated with it (to which aspect we would allude immediately).*
>
> ***23.4** Further, "confusion" does not require the consumer to be completely befuddled. All that is required is that he is placed in a state of "wonderment". This is best expressed in the following passage from Shree Nath Heritage Liquor Pvt. Ltd. v. Allied Blender & Distillers Pvt. Ltd.*[13]*, by a Division Bench of this Court:*

"6. When a person knows that the mark in question does not originate from the senior user but the senior user is called to mind, then it's a step before confusion. If on the other hand, the consumer is in a state of wonderment if there's a connection, this is confusion. Further, if this consumer then purchases the junior users product, this is then deception."

Thus, if the consumer, of average intelligence and imperfect recollection, on coming across the defendant's mark, is placed in a state of wonderment if there is a connection between the said mark and the mark of the plaintiff, it amounts to "likelihood of confusion".

xxx xxx xxx

***23.6** In the present case, when viewed overall as whole marks, we are of the opinion that such an average consumer of imperfect recollection would, if he has first seen the respondent's mark and, sometime later, comes across the appellant's mark, at the least wonder whether the two marks are not associated, inter alia because of the common ox tethered to the grinder motif and the similarity between the marks* बैल कोल्हू *("BAIL KOLHU") and* आरोहल कोल्हू *("AAROHAL KOLHU").*

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***23.7.3** Having thus held that a consumer would not bisect the marks into "Amrit" and "Dhara" in one case and "Lakshman" and "Dhara" in the other case, and ascribe, to them, the meanings "stream of nectar" and "current of Lakshman", the Supreme Court nonetheless held that, owing to the overall phonetic similarity between the marks, there was a likelihood of confusion.*

***23.7.4** This decision is, in our view, squarely applicable to the facts at hand. We are conscious that the respondent has, in its plaint, specifically stated that it did not object to the use, by the appellant, of the mark "AROHUL KOHLU" per se. We are citing **Amrit Dhara Pharmacy** only to point out that, when viewed as whole marks, there is every likelihood of the average consumer, at the very least, presuming an association between the marks, given the fact that both the marks employ the ox tethered to the grinder logo accompanied by words which are similar, i.e. BAIL KOLHU and AROHUL KOHLU. The average consumer is, therefore, likely to presume that the appellant's AROHUL KOHLU product is either from the same stable as the respondent's BAIL KOLHU product, especially as both marks use the common ox-grinder motif, or that there is an association between the marks."*

43. If one looks at the rival marks in the instant case, there is every likelihood of confusion applying the test of a man of average intelligence with imperfect recollection and the identitiy of rival goods materially

enhances the confusion. Both parties deal in footwear, which are directed to the same segment of consumers through similar or overlapping channels of trade. There is no gainsaying that where goods are identical even a lesser degree of similarity in the marks may suffice to generate confusion. Looking at the impugned marks and , there is a high probability that consumers may believe that these marks are yet another variant of Plaintiff's N-marks, considering that Plaintiff has been coming up with several variants or that Defendants' goods constitute a new range of footwear launched in association or affiliation with the Plaintiff or under a collaboration arrangement and in either case an unwarranted and unlawful association will be established with the Plaintiff, causing confusion, owing to blatant misrepresentation amongst the public.

44. Coming to next and the third ingredient of passing off i.e., goodwill, Plaintiff has asseverated and placed on record overwhelming material to show the immense goodwill and reputation earned from sale of its products under the N-marks, globally and in India. This includes revenues earned from 2013-2024 under the N-marks; substantial expenses incurred for the same period; wide presence on social media platforms; immense coverage by media over the years; brand endorsements by international political leaders, celebrities in the field of music, sports and cinema as also entrepreneurs; receipt of numerous awards including some highly prestigious ones; large number of retail brick and morter stores; and substantial sales through its own dedicated websites and third-party e-commerce websites. Significantly, the goodwill and reputation of the Plaintiff garnered over decades by sale of products under N-marks as also distinctiveness of the marks, was judicially recognised by this Court in

Jitender Kumar (supra), when the shaded logo was declared as a well-known mark. As noted above, Plaintiff's NEW BALANCE and NB marks have also been declared as well-known in ***New Balance Immigration (supra).***

45. Defendants attempted to justify the adoption of the nu:beat marks including the marks and on the ground that the mark nu:beat is the brain child of Johanna Muller, a famous songwriter and musician and the letters 'nu' come from the Greek symbol used for frequency in Physics and audio engineering to represent the rate at which the sound wave oscillates. Be that as it may, it does not explain adoption of the logo marks and where the dominant part is 'n' and 'u' and 'beat' are missing. The adoption of these marks is only to sail as close as possible to Plaintiff's N-marks, conscious of the goodwill and reputation generated by the use of the marks and their distinctiveness, so as to encash on the formidable goodwill of the Plaintiff and be it noted, at the cost of repetition the identity of goods enhances the likelihood of confusion. In ***Cadila (supra),*** the Supreme Court held that in testing a claim of passing off, nature of marks, degree of resemblance, nature of goods, class of purchasers and overall probability and likelihood of deception have to be seen holistically and *prima facie* in the present case, taking into account the goodwill of the Plaintiff, deceptive similarity of N-marks of the Plaintiff and and marks of the Defendants, the element of

misrepresentation and likelihood of confusion, Plaintiff has made out a *prima facie* case for grant of interim injunction.

46. There is another crucial factor which weighs heavily in favour of the Plaintiff and that is the prior use of the N-marks. From the narrative of facts, it clearly emerges that Plaintiff is the prior user of the N-marks in India. In fact, in the written statement the stand of the Defendants is that the nu:beat marks were used only from April, 2024. By the test of prior user also, Plaintiff is entitled to succeed in its claim for passing off. The superior right of a prior user has been judicially recognised right from the judgment in ***S. Syed Mohideen (supra)*** to the judgment in ***N.R. Dongre and Others v. Whirlpool Corporation and Another, (1996) 5 SCC 714*** and now the recent judgment of the Supreme Court in ***Pernod Ricard (supra).*** In ***Neon Laboratories Limited v. Medical Technologies Limited and Others, (2016) 2 SCC 672,*** the Supreme Court observed that *'first in the market'* test has always enjoyed pre-eminence and relevant passages are as follows:-

> ***"11.** We must hasten to clarify that had the appellant-defendant commenced user of its trade mark ROFOL prior to or even simultaneous with or even shortly after the respondent-plaintiffs' marketing of their products under the trade mark PROFOL, on the appellant-defendant being accorded registration in respect of ROFOL which registration would retrospectively have efficacy from 19-10-1992, the situation would have been unassailably favourable to it. What has actually transpired is that after applying for registration of its trade mark ROFOL in 1992, the appellant-defendant took no steps whatsoever in placing its product in the market till 2004. It also was legally lethargic in not seeking a curial restraint against the respondent-plaintiffs. This reluctance to protect its mark could well be interpreted as an indication that the appellant-defendant had abandoned its mark at some point during the twelve-year interregnum between its application and the commencement of its user, and that in 2004 it sought to exercise its rights afresh. It would not be unfair or fanciful to favour the view that the appellant-defendant's delayed user was to exploit the niche already created and built-up by the respondent-plaintiffs for themselves in the market. The "first in the market" test has always enjoyed pre-eminence. We shall not burden this judgment by referring to the several precedents that can be found apposite to the subject. In the interest of prolixity we may mention only N.R.*

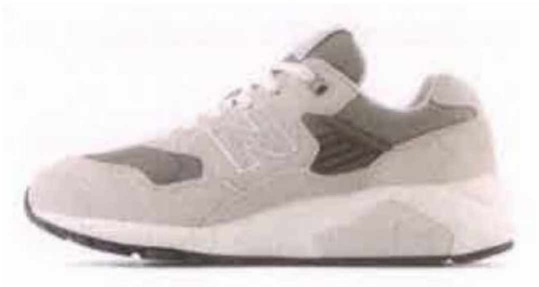
Dongre v. Whirlpool Corpn. [N.R. Dongre v. Whirlpool Corpn., (1996) 5 SCC 714] and Milmet Oftho Industries v. Allergan Inc. [Milmet Oftho Industries v. Allergan Inc., (2004) 12 SCC 624] In Whirlpool [N.R. Dongre v. Whirlpool Corpn., (1996) 5 SCC 714] , the worldwide prior user was given preference nay predominance over the registered trade mark in India of the defendant. In Milmet [Milmet Oftho Industries v. Allergan Inc., (2004) 12 SCC 624] , the marks of pharmaceutical preparation were similar but the prior user worldwide had not registered its mark in India whereas its adversary had done so. This Court approved the grant of an injunction in favour of the prior user. Additionally, in the recent decision in S. Syed Mohiden v. P. Sulochana Bai [S. Syed Mohiden v. P. Sulochana Bai, (2016) 2 SCC 683 : (2015) 7 Scale 136] this Court has pithily underscored that the rights in a passing-off action emanate from common law and not from statutory provisions, nevertheless the prior user's rights will override those of a subsequent user even though it had been accorded registration of its trade mark. The learned counsel for the appellant-defendant has endeavoured to minimise the relevance of Whirlpool [N.R. Dongre v. Whirlpool Corpn., (1996) 5 SCC 714] as well as Milmet [Milmet Oftho Industries v. Allergan Inc., (2004) 12 SCC 624] by drawing the distinction that those trade marks had attained worldwide reputation. However, we think that as world shrinks almost to a global village, the relevance of the transnational nature of a trade mark will progressively diminish into insignificance. In other words, the attainment of valuable goodwill will have ever increasing importance. At the present stage, the argument in favour of the appellant-defendant that we find holds more water is that in both Milmet [Milmet Oftho Industries v. Allergan Inc., (2004) 12 SCC 624] and Whirlpool [N.R. Dongre v. Whirlpool Corpn., (1996) 5 SCC 714] , as distinct from the case before us, the prior user of the successful party predated the date of application for registration of the competing party. The question to examine, then, would be whether prior user would have to be anterior to the date of application or prior to the user by the appellant-defendant. In other words, the question before the Court would remain whether the situation on the date of application for registration alone would be relevant, or whether the developments in the period between this date and the date of grant of registration would have any bearing on the rights of the parties. All these considerations will be cast into a curial cauldron to be appreciated by the Court before which the suit is being contested. In these premises, we cannot conclude that a prima facie case has not been disclosed by the respondent-plaintiffs.

***12.** Since we are confronted with the legal propriety of a temporary injunction, we must abjure from going into minute details and refrain from discussing the case threadbare, in order to preclude rendering the suit itself an exercise in futility and the decision therein a foregone conclusion. All that we would say in the present appeal is that since the respondent-plaintiffs have alleged, and have prima facie supported with proof, that they had already been using their trade mark well before the attempted* *user of an identical or closely similar trade mark by the appellant-defendant, the former would be entitled to a temporary injunction, in light of the abovementioned "first in the market" test. We find that the respondent-plaintiffs have made out a prima facie case. The two other factors in an interim injunction, namely, the balance of convenience and an irreparable loss, are both in favour of the respondent-plaintiffs, given the potential loss of goodwill and business they could suffer should an injunction be denied. The appellant-defendant has been injuncted from using the mark ROFOL since 2005, after having launched products bearing the mark only in the previous year, so the balance of convenience is in favour of allowing the injunction to continue. In Milmet [Milmet Oftho Industries v. Allergan Inc., (2004) 12 SCC 624] , this Court had taken note of the fact that the unsuccessful litigating party had in the duration of the litigation started using another mark, and found that this would prima facie assume significance in assessing "irreparable loss"."*

47. In ***Sana Herbals Private Limited v. Mohsin Dehlvi and Another, 2026 SCC OnLine Del 21,*** the Division Bench was examining a claim of infringement and passing off in an appeal against an order of the learned District Judge, dismissing Appellant's application for interim injunction. Holding that no case of infringement would lie as the Respondents' mark NOKUF was also registered, the Court proceeded to examine the claim for passing off. Noting that Respondents had commenced user of NOKUF trademark in 1994, which was even prior to incorporation of the Appellant *albeit* the registration was granted on 22.09.2020 dating back to 03.06.1996, it was held that the case was clearly in favour of the Respondents being the prior user of the mark. Applying the principles elucidated in the aforesaid judgements to the instant case, Plaintiff scores higher even on this count being the prior user in India.

48. The argument of the Defendants that by placing special elements on the sides of the shoes such as **nu:beat** on the tongue, the confusion is completely ruled out, cannot be accepted. It is common knowledge that shoes, more particularly, running shoes/sneakers are often bought from the visual impression one gets by looking at the footwear from the outside and

the mark of the brand prominently displayed there and therefore, the initial interest confusion test will apply in all fours to the present case and this is substantiated by one look at the manner in which the mark is displayed on the footwear . What enhances the belief that there is dishonest adoption is the placement of the mark, which is identical to the manner in which the Plaintiff displays its N-marks and for ready reference, one screenshot is extracted hereunder:-



49. There is also no merit in the argument of the Defendants that no monopoly can be claimed on the letter 'N', in the facts of the present case, where as noted above, the N-marks have acquired secondary meaning owing to extensive use over decades and in fact many that letters stylized as logos have been registered on acquiring secondary meaning such as (McDonalds) and (Hermes).

50. There is also no merit in the argument that **'N'** is common to Register and trade. Defendants have relied on a search report by Mike Legal. As rightly flagged by the Plaintiff, no reliance can be placed on this report for two reasons. Firstly, the platform does not constitute an official source of

trademark record and secondly, in ***Novartis AG (supra),*** this Court has held that a mere filing of search report from Trade Marks Office does not prove actual user and hence, in the absence of valid and cogent evidence of use of the said mark, this submission cannot be accepted. It is trite that common to Register is qualitatively different from common to trade inasmuch as one may register a mark but leave it unused. In ***Glaxosmithkline Pharmaceuticals Ltd. v. Horizon Bioceuticals Pvt. Ltd. and Another, 2023 SCC OnLine Del 2065,*** this Court held that mere registrations by third-parties cannot divest Plaintiff's mark of distinctiveness or disentitle the Plaintiff to injunction. If Defendant pleads that the mark is common to trade or *publici juris,* the onus is on him to establish the assertion by showing substantial use by the proprietors of that mark, extent of trade in products bearing the said mark and how the mark poses a threat to the distinctiveness of the mark asserted by the Plaintiff, else, the Court cannot return a finding on this aspect. To the same effect are the decisions in ***Pankaj Goel (supra)*** and ***Express Bottlers (supra).*** To avoid prolixity in this context, I may refer to the judgment of the Division Bench of this Court in ***Madan Lal (supra),*** where the Court held as follows:-

> ***"26.3*** *<u>Re. plea that the mark is common to the trade</u>*
>
> ***26.3.1*** *The attempt of Ms. Trehan to contend that the ox-with-grinder logo is common to the trade, by placing on record a plenitude of marks having similar features is legally unsound, for more than one reason.*
>
> ***26.3.2*** *In the first place, the proscription envisaged in Section 17(2)(b) is to any matter, forming part of a mark, which is common to the trade. The use of the article "the" is often overlooked. In order to successfully invoke the defence based on this proscription, therefore, the defendant would have to show that the mark asserted by the plaintiff, or the feature of the mark over which the plaintiff claims exclusivity, is common to <u>the</u> trade in which the rival marks are used. In other words, the defendant cannot successfully invoke this clause by merely citing a plenitude of marks. The defendant would also have to establish that the marks are used in the same trade in which the plaintiff and defendant are engaged, and with which the dispute is concerned.*

26.3.3 *In the present case, the usage to which the marks reflected in the screenshot provided by Ms. Trehan, and extracted in para 20(iii) supra, is put, is unknown. It is not known, therefore, whether these marks are common to the trade of mustard oil extraction, with which the dispute is concerned. Even for this reason, therefore, the screenshot provided by Ms. Trehan would not suffice to make out a defence to the allocation of infringement, predicated on Section 17(2)(b) of the Trade Marks Act.*

26.3.4 *The second reason why this plea cannot sustain is relatable to the law declared by the Division Bench of this Court in Pankaj Goel v. Dabur India Ltd.. The rival marks before the Court, in that case, were HAJMOLA and RASMOLA. The defendant sought to urge that the common suffix 'MOLA' was publici juris and common to the trade and, inasmuch as the only similarity between the rival marks was this common MOLA suffix, no case of deceptive similarity could be said to exist. Addressing this submission, the Division Bench held thus:*

> *"21. As far as the appellant's argument that the word MOLA is common to the trade and that variants of MOLA are available in the market, we find that the appellant has not been able to prima facie prove that the said 'infringers' had significant business turnover or they posed a threat to Plaintiff's distinctiveness. In fact, we are of the view that the respondent/Plaintiff is not expected to sue all small type infringers who may not be affecting Respondent/Plaintiff business. The Supreme Court in National Bell v. Metal Goods, has held that a proprietor of a trademark need not take action against infringement which do not cause prejudice to its distinctiveness. In Express Bottlers Services Pvt. Ltd. v. Pepsi Inc., it has been held as under:—*
>
>> *"….To establish the plea of common use, the use by other persons should be shown to be substantial. In the present case, there is no evidence regarding the extent of the trade carried on by the alleged infringers or their respective position in the trade. If the proprietor of the mark is expected to pursue each and every insignificant infringer to save his mark, the business will come to a standstill. Because there may be occasion when the malicious persons, just to harass the proprietor may use his mark by way of pinpricks…. The mere use of the name is irrelevant because a registered proprietor is not expected to go on filing suits or proceedings against infringers who are of no consequence… Mere delay in taking action against the infringers is not sufficient to hold that the registered proprietor has lost the mark intentionally unless it is positively proved that delay was due to intentional abandonment of the right over the registered mark. This Court is inclined to accept the submissions of the respondent No. 1 on this point… The respondent No. 1 did not lose its mark by not proceeding against insignificant infringers…"*
>
> *22. In fact, in Dr. Reddy Laboratories v. Reddy Paharmaceuticals, a Single Judge of this Court has held as under:—*

"…the owners of trade marks or copy rights are not expected to run after every infringer and thereby remain involved in litigation at the cost of their business time. If the impugned infringement is too trivial or insignificant and is not capable of banning their business interests, they may overlook and ignore petty violations till they assume alanning proportions. If a road side Dhaba puts up a board of "Taj Hotel", the owners of Taj Group are not expected to swing into action and raise objections forthwith. They can wait till the time the user of their name starts harming their business interest and starts misleading and confusing their customers.""

26.3.5 *Two legal postulates emerge from these passages.*

26.3.6 *The first is that the mere fact that the plaintiff's asserted mark may have been infringed by others as well is no ground to deny an injunction against the defendant, where the defendant is also found to be an infringer. This is for the simple reason that it is for the plaintiff to choose his defendant, and there is no legal obligation on a plaintiff to sue every infringer. The plaintiff is not answerable as to why it has not proceeded against another infringer. There may be several reasons. It is, for example, quite possible that the other infringer is too small a player as to pose any threat to the plaintiff or its trademark and that, therefore, it makes no commercial sense to proceed against it. Thus, a defendant cannot escape the consequences of infringement merely by pleading that there are other infringers in the market.*

26.3.7 *The second legal postulate which emerges from the decision in **Pankaj Goel** is that a mark or a part of a mark, cannot be pleaded to be common to the trade by merely providing examples of registrations existing on the Register of the Registrar of Trade Marks, which may be identical or similar to the plaintiff mark. The expression contained in Section 17(2)(b) is "common to the trade". The defendant, in order to seek sanctuary behind this clause, would have to establish that the mark being used by him, and which is alleged by the plaintiff to be infringing in nature, has become common to the trade in which that mark is used by the defendant. In other words, it would have to be shown, by the defendant, that the examples of usage of the same mark, by others, is because, in the trade - and not merely on the Register of Trade Marks - the user of that mark has become common. **Pankaj Goel** makes it clear that, for this, the defendant would have to establish that the other infringers had significant business turnover or posed a threat to the distinctiveness of the plaintiff's asserted trade mark. Mere reference to registrations, present on the Register of the Registrar of Trade Marks, are entirely insufficient in this regard. These registrations do not even indicate actual user of the registered marks. The defendant would have to show not only that the registered marks are being used, but that the user is significant and poses a business threat to the plaintiff's asserted registered trademark. Empirical data in this regard has to be produced by the defendant, failing* *which the plea that the mark, or the part of the mark which, according to the defendant, has become common to the trade, must fail.*

26.3.8 *No such material has been cited or placed on record by Ms. Trehan. The submission, by her, that there are a number of registered trade marks reflecting an ox tethered to a grinding wheel cannot, therefore, advance her case."*

51. The judgments relied upon by the Defendants are also distinguishable. In ***Relaxo Footwears (supra),*** Plaintiff had clearly stated that it was not claiming monopoly over the letter 'X' but only in its stylization and the rival parties were actually not using the X device mark as an isolated identification but were selling goods under the principal brand names and in this context, the Court held that there was no confusion. In ***Super Cassettes (supra),*** the legal proposition is that marks have to be seen as a whole and under Section 17 of 1999 Act, registration of a composite mark confers no exclusive right over a single letter forming part of it and no monopoly can be claimed. There can be no quarrel with the proposition of law, however, in the present case the N-marks of the Plaintiff as stated above, have acquired a secondary meaning with extensive use over the decades. In ***J.R. Kapoor (supra),*** the comparison was between prefixes and suffixes on the touchstone of phonetic and visual similarity, which is not the case here.

52. For all the aforesaid reasons, I am of the *prima facie* view that Plaintiff has made out a *prima facie* case for injunction. Balance of convenience also lies in favour of the Plaintiff and against the Defendants owing to the prior and extensive use of the N-marks, which have become distinctive of Plaintiff's products and Defendants started using the marks and only recently in April, 2024 in India. Irreparable injury and harm shall be caused to the Plaintiff and the distinctiveness of its marks shall be eroded and diluted, if interim injuction is not granted.

53. Accordingly, the present application is allowed, restraining the Defendants and all others acting on their behalf from manufacturing, selling, offering for sale, advertising and/or marketing the impugned goods under the impugned marks and and/or any other mark deceptively similar to Plaintiff's marks , , and , amounting to passing off, during the pendency of the suit with the usual mantra that the observations in the present judgment are only tentative and *prima facie* and will have no bearing on the final adjudication of the suit.

54. Application stands disposed of.

JYOTI SINGH, J.

JULY __13__, 2026/YA