

CS (Comm.) No.383/2024: M/s Macha Consumer Products Private Limited V/s  
M/s Chai Sutta Bar Trading Private Limited

**IN THE COURT OF VINOD YADAV: DISTRICT JUDGE:**  
**(COMMERCIAL COURT)-02: NORTH-WEST DISTRICT: ROHINI**  
**DISTRICT COURTS: DELHI**

CNR No.DLNW01-005535-2024

CS (Comm.) No.383/2024

**In the matter of:-**

**M/s MACHA CONSUMER PRODUCTS PRIVATE LIMITED,**

Registered Office At: PLOT No.253,  
SECTOR-7, IMT MANESAR GURUGRAM  
HARYANA-122050, INDIA.

Tel. No.0124-2577506

E-mail: info@machatea.co

.....Plaintiff

**Versus**

**M/s CHAI SUTTA BAR TRADING PRIVATE LIMITED,**

Registered Office At 405-407,  
SILVER ARCH PLAZA, 21/1, NEW PALASIYA,  
INDORE, Madhya Pradesh-452001, INDIA.

.....Defendant

**ORDER**

**17.01.2026**

Present: Shri Harish Kumar, Ld. Counsel for the plaintiff (**through VC**).

Shri Kunal Khanna and Shri Ankit Tiwari, Ld. Counsels for the defendant (**through VC**).

1. Vide order dated 28.05.2025, passed in “**CM(M)-IPD No.23/2025**”, titled as, “**M/s Chai Sutta Bar Trading Pvt. Ltd. V/s M/s Macha Consumer Products Pvt. Ltd.**”, the Hon’ble High Court of Delhi has been pleased to direct this Court to decide application under Order XXXIX

Rule 1 & 2 CPC filed by the plaintiff and application under Order XXXIX  
Rule 4 CPC filed by the defendant expeditiously.

2. The arguments on both these applications have been heard in detail.

3. The facts of the case in brief, relevant for consideration on the aforesaid applications are that plaintiff is a private limited company, incorporated on 24.02.2016, having its Head Office and production plant at Plot No.253, Sector-7, IMT Manesar, District Gurugram, Haryana-122050 and engaged in the business of manufacturing and selling tea under the brand name “**MACHA TEA**” with tagline “**MAA KE HAATH KI CHAI**”, since the year 2015.

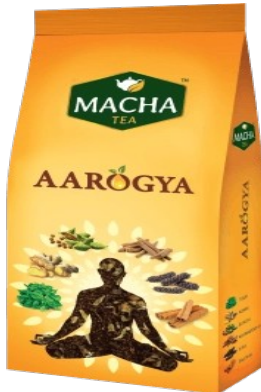
4. It has been stated that over a period of time, plaintiff company has launched several different variants such as Macha Tea Classic, Macha Tea Premium, Macha Tea Magic, Macha Tea Gold, Tulsi+Adrak, Macha Tea Har-pal, Macha Tea Elaichi, etc., the images whereof are provided hereunder:

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| S.No. | Products                 | IMAGES                                                                                |
|-------|--------------------------|---------------------------------------------------------------------------------------|
| 1.    | Macha tea classic        |    |
| 2.    | Macha tea gold           |   |
| 3.    | Macha tea classic<br>box |  |

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|    |                    |                                                                                      |
|----|--------------------|--------------------------------------------------------------------------------------|
| 4. | Matcha tea magic   |   |
| 5. | Matcha tea Elachi  |  |
| 6. | Matcha tea premium |  |

|    |                                    |                                                                                       |
|----|------------------------------------|---------------------------------------------------------------------------------------|
| 7. | Matcha tea Harpal                  |    |
| 8. | Matcha tea Aarogya                 |   |
| 9. | Matcha tea Gold<br>(Tulsi + Adrak) |  |

|     |                                                     |                                                                                       |
|-----|-----------------------------------------------------|---------------------------------------------------------------------------------------|
| 10. | Matcha tea<br><br>Sampoorn                          |     |
| 11. | Macha tea classic<br><br>(Elachi, Adrak box)        |    |
| 12. | Macha tea classic<br><br>(Tulsi, Adrak &<br>Elachi) |  |

|     |                                      |                                                                                                                                                                                                                                                                                                           |
|-----|--------------------------------------|-----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| 13. | Macha tea classic<br>(Elachi, Adrak) |  A yellow and green sachet of Macha Tea Classic Elaichi Adrak. The top is yellow with the Macha Tea logo and 'Classic Elaichi Adrak' text. The bottom is green with an image of a yellow cup of tea and cardamom pods. |
| 14  | Macha Noon Chai                      |  A green sachet of Macha Noon Chai. It features a gold teapot illustration and the word 'نون چای' (Noon Chai) in Urdu. A 'NEW PACK' label is visible at the top.                                                      |
| 15  | Macha Shakti Dust                    |  A red and yellow sachet of Macha Shakti Dust. It features a yellow cup of tea illustration and the word 'Shakti' in a stylized font. The text 'DUST' is below it.                                                   |

|    |                       |                                                                                      |
|----|-----------------------|--------------------------------------------------------------------------------------|
| 16 | Macha Urja            |   |
| 17 | Macha Classic<br>Dust |  |

5. It has been averred that plaintiff is the registered owner of the Trademark **MACHA** in **Class 30** having Application No. 3113604; the



मैं के हाथ की चाय

device , bearing Application No.5441577 and the word **MACHA** in **Class 43** having Application No.5742378, under the Trademark Act, 1999. The details of the applications filed by plaintiff qua mark **MACHA** in **Class 30** and the status thereof is given hereunder:

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| S.No | Application No. | Class | MARK                                                        | Status  | Image                                                                                 |
|------|-----------------|-------|-------------------------------------------------------------|---------|---------------------------------------------------------------------------------------|
| 1    | 6027009         | 30    | DEVICE AS PER LABEL WITH WORD MACHA TEA CLASSIC             | Opposed |    |
| 2    | 6027010         | 30    | DEVICE AS PER LABEL WITH WORD MACHA TEA GOLD                | Opposed |   |
| 3    | 6027011         | 30    | DEVICE AS PER LABEL WITH WORD MACHA TEA HAR-PAL             | Opposed |  |
| 4    | 6027012         | 30    | DEVICE AS PER LABEL WITH WORD MACHA TEA CLASSIC TULSI ADRAK | Opposed |  |

|    |         |    |                                                              |         |                                                                                     |
|----|---------|----|--------------------------------------------------------------|---------|-------------------------------------------------------------------------------------|
|    |         |    | ELAICHI                                                      |         |                                                                                     |
| 5  | 6027013 | 30 | DEVICE AS<br>PER LABEL<br>WITH<br>WORD<br>MACHA<br>TEA MAGIC | Opposed |  |
| 6. | 5054256 | 30 | MACHA                                                        | Opposed |  |

6. (i) It has been contended that plaintiff has been selling different variants of tea under brand “**MACHA**” and its trademark and logo **MACHA TEA** have gained immense popularity and goodwill all over the market. It is stated that plaintiff has been doing business in two ways, one is offline by way of appointment of various distributors and other is online by creating a well-reputed website/domain name <https://machatea.co> in the year 2016. The plaintiff also owns **Facebook, Instagram, and LinkedIn page** under the name MACHA TEA and its products are also available on leading online platform such as [www.amazon.in](http://www.amazon.in). (Copy of images of products of plaintiff from online platform Amazon has been annexed as “**Annexed-10**”; while the images of official website, domain receipt, facebook, instagram and LinkedIn have been annexed as “**Document-16 Colly**” with the plaint).

(ii) It has been further stated that plaintiff has also been continuously promoting its business under its said device trademark through dif-

ferent media and modes such as advertisement by hoarding and billboards in various cities such as Hisar, Meerut, Saharanpur, Dehradun, and Karnal highway and through its website campaign Facebook and also in newspaper Dainik Jagran etc.

7. It has been emphasized that on account of long and continuous use of the trademark MACHA TEA and its high-quality product, plaintiff has amassed handsome sales over the last eight years has attained growth for its product having turnover in the year 2022-2023 as Rs. **46,99,65,211/- (Forty-Six Crores Ninety-Nine Lacs Sixty-Five Thousand Two Hundred Eleven Rupees only)** and in the year 2023-2024 as Rs.58,99,70,505/- **(Fifty-Eight Crores Ninety- Nine Lacs Seventy Thousand Five Hundred Five Only)** (details of the same have been filed as Document No.14 alongwith the plaint).

8. (i) It has been stated that on account of its good quality, standards of manufacturing and untiring efforts in advertising and marketing, the products of the plaintiff have acquired enviable reputation and goodwill. Further, the plaintiff spends huge amount of money in advertising and promotion of its products under the said trade marks/logos, due to which the products of plaintiff under the said trade marks/logos enjoy comprehensive goodwill and reputation in business community and public in general.

(ii) It has been further stated that in view of the plaintiff's proprietary rights both under statutory and common law in its said trademarks, its goodwill & reputation, it has the exclusive right to the use thereof and nobody can be permitted to use the same or any other deceptively similar trademark/label in any manner whatsoever in relation to any specification of goods without the leave and license of the plaintiff.

9. (i) Defendant is stated to be a private limited company, engaged in the similar business of marketing of tea and related products under the trademark  with the tagline "MAA KA PYAR, DESH KA SWAAD".

(ii) It has been contended that in the first week of April' 2024, plaintiff got information that defendant had been engaged in the similar trade/business of marketing of tea and related products under the trademark  with the tagline "MAA KA PYAR, DESH KA SWAAD", which is phonetically identical and deceptively similar to the mark **MACHA MAA KE HATH KI CHAI**, which in turn is creating confusion among the general public.

10. (i) It has been contended that defendant has been running a brand under the name of "**MAATEA**" and selling its products through their website <https://maatea.in/> and <https://www.chaisuttabarindia.com/> and

running some other social networking website such as INSTAGRAM, FACEBOOK, etc., thereby causing confusion and deception in the market and also corroding and tarnishing the goodwill and reputation of the trade



mark “ ” of the plaintiff.

(ii) It has been further averred that defendant has also been selling impugned product of impugned trademark “**MAATEA**” on various online selling websites such as Amazon, <https://maatea.in/> and <https://www.chaisuttabarindia.com/> which have a pan India presence and thus customers from every corner of the country could see and buy products with just a click of the mouse button. Moreover, the products of the plaintiff are also available on same online marketplace in all over India and the same is creating confusion in the minds of ordinary people who associate the products of the defendant as that of plaintiff.

11. It has been further averred that defendant has applied for the registration for the mark “**MAATEA**” under class 30 on **proposed to be used basis** and the trademark registry by fault has accepted some of the defendant’s mark **MAATEA**, however, the same has been opposed by the plaintiff bearing application Nos.**6104992, 6306824 and 6306825**. The status of the application as getting reflected on the website of Trademark Registry is given hereunder:

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| <u>S.NO</u> | <u>TRADEMARK</u>            | <u>APPLICATION NO.</u> | <u>CLASS</u> | <u>STATUS</u> |
|-------------|-----------------------------|------------------------|--------------|---------------|
| 1           | MAATEA                      | 5956886                | 30           | Objected      |
| 2           | MAATEA By<br>CSB            | 6104992                | 30           | OPPOSED       |
| 3           | MAATEA                      | 6104993                | 30           | Objected      |
| 4           | MAATEA By<br>Chai Sutta Bar | 6107157                | 30           | Objected      |
| 5           | MAATEA By<br>Chai Sutta Bar | 6107158                | 30           | Objected      |
| 6           | MAATEA                      | 6306818                | 30           | Objected      |
| 7           | MAATEA                      | 6306819                | 30           | Objected      |
| 8           | MAATEA                      | 6306820                | 30           | Objected      |
| 9           | MAATEA                      | 6306821                | 30           | Objected      |
| 10          | MAATEA                      | 6306824                | 30           | OPPOSED       |

|    |        |         |    |         |
|----|--------|---------|----|---------|
|    |        |         |    |         |
| 11 | MAATEA | 6306825 | 30 | OPPOSED |

12. (i) It has been contended that defendant is not the proprietor of

the impugned trademark “MAATEA ” and it also does not have any registration in the name MAATEA in Class 30 for tea products. The defendant is using the said impugned mark without the leave and license of the plaintiff, as the plaintiff is the prior and the registered owner of the trademark “MACHA”. It is submitted that the adoption of the impugned mark by the defendant is very recent.

(ii) It has been emphasized that defendant has adopted the impugned trade dress/packaging style and Trademark/label, with a view to misrepresent and trade upon the tremendous goodwill and reputation of the plaintiff’s said trade mark/label/trade dress. It is claimed that on account of aforesaid action/illegal trade activities of defendnat, plaintiff is not only suffering the loss of sales on account of business diversion, but also is suffering irreparable damages and injury on account of misappropriation of the plaintiff’s goodwill and reputation that vests in its trademark.

13. It has been emphasized that defendant has been running/selling the impugned product all over India through online e-

commerce platforms, distributors, retailers, and their store outlets of CSB which are having presence all over India. The plaintiff further came to know that defendant has also been selling its product MAATEA in the North-West District of Delhi through its distributors through online and offline modes. It is further claimed that defendant has also been displaying its products and conducting business on e-commerce website which is accessible all across India including North-West District of Delhi (**the copies of Amazon Invoice, Online transaction alongwith images of the defendant's products have been annexed as Document No.21 Colly with the plaintiff**). The defendant has been

14. It has been averred that by doing so, the defendant is not only damaging the reputation and goodwill of the plaintiff, but is also causing financial loss to the plaintiff by reaping unfair advantage of the repute and distinctive character of the trademark of the plaintiff .

15. Pursuing to filing of suit by the plaintiff, this Court vide order dated 02.07.2024 granted ad-interim ex-parte injunction in favour of plaintiff and against the defendant, the operative part whereof reads as under:

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*23. For the foregoing reasons and till further orders, the defendant by itself as also through its individual proprietors/partners, agents, representatives, distributors, assigns, heirs, online promoters, advertising agents, publishers, channel*

*partners, INSTAGRAM, FACEBOOK, X (FORMERLY KNOWN AS TWITTER), LINKEDIN, AMAZON and all others acting for and on their behalf are hereby restrained from using, selling, soliciting, exporting, displaying, advertising or any other mode or manner dealing in or using the impugned trademark/label/packaging/trade dress*



*“MAATEA/MAA/” or any other trademark/label/packaging/ trade dress similar to the*



*plaintiff’s trademark “MACHA TEA” in relation to their impugned goods and from doing any other acts or deeds, thereby, infringing plaintiff’s registered trademarks and passing off their products as that of plaintiff.*

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16. (a) After getting served with the summons, defendant filed written statment, inter alia taking preliminary objections as under:

- (i) That the plaintiff has suppressed material facts;
- (ii) That the plaintiff cannot claim proprietary right over its trademark, being imitation of generic word/term **MATCHA**;
- (iii) That no passing off action is maintainable against the defendant as defendant has Trademark Registration in **Class 35** and

**Class 16** in respect of mark “MAATEA / ”.

(b) On merits, the validity of mark of plaintiff has been challenged. It has been further contended that the two marks are not identical or deceptively similar. It has been further contended that plaintiff cannot claim monopoly over tagline “**MAA KE HAATH KI CHAI**”. It has been further stated that plaintiff has failed to establish any dishonesty on the part of defendant in adopting or using mark “MAATEA/



”. The traddress of both the marks is stated to be materially different and is not likely to cause any confusion or deception among the consumers. In the end, it has been contended that the validity of the registration of the trademark of the defendant has so far not been challenged by the plaintiff before the competent Court.

17. The arguments of the learned counsel for the plaintiff are summarized as under:

(i) It has been contended that the plaintiff has been using



trademark “**MACHA TEA**” since the year 2015 and has a valid registration in its name under **Class 30** since the the year 2016;

(ii) The Director of plaintiff namely Shri Munesh Sharma has individual registration in the mark **MACHA** per se in his name, which he

has put in the corporate hotchpotch and as such, he is the Director of plaintiff company having more than 80% shares therein;

(iii) That defendant has only registration in the name of MAATEA /



in **Class 35**, which has nothing to do with the manufacturing of tea.

(iv) That the defendant has filed ten applications for registration of



its mark MAATEA / in **Class 30**, out of which seven have been objected to by the Trade Mark Registry itself and three marks have been opposed by the plaintiff;

(v) The plaintiff has a strong goodwill, as at the time of filing of the present suit, its trade volume was to the extent of Rs.59 Crores annually; whereas, the defendant has very minuscule volume and trade and thus, trying to encash upon the goodwill of plaintiff.

(vi) MATCHA which means green powder in respect of green leaves in Japanese language is not a generic terms in relation to Indian context; and

(vii) That the consumers of plaintiff and defendant are same.

18. Per contra, the arguments advanced by learned counsel for the defendant are summarized as under:

- (i) That the suit filed in the matter is bad for non-joinder of Shri Munesh Sharma and there is no valid assigning of trademark word **MACHA** per se by him to the plaintiff;
- (ii) That the defendant has registration in Class 35 for drinks, which includes tea as well; and
- (iii) That the plaintiff has not been using tagline on all its products, meaning thereby it cannot claim goodwill in tagline “**MAA KE HAATH KI CHAI**”.

19. I have given thoughtful consideration to the arguments advanced at Bar. Let us see, whether the trinity principle of grant of ad-interim injunction is satisfied by the plaintiff in the present matter.

**Prima facie case:**

20. The learned counsel for the defendant has very vehemently argued that although Shri Munesh Sharma is Director in the plaintiff company and having share holding, but he has not executed a valid assigning of trademark in favour of plaintiff and as such, the present suit is bad for misjoinder of necessary party. Per contra, learned counsel for the plaintiff has contended that the plaint in the matter has been signed, verified and instituted by Ms.Chahat Chaudhary, who has been validly authorized by the Directors of plaintiff company, including Shri Munesh

Sharma, which is prima faice indicative of the fact that Shri Munesh Sharma, who is admittedly the individual owner of trademark **MACHA** per se has put the same in corporate hotchpotch and is deemed to have assigned the same to plaintiff in which he has majority shareholding as Director. In any case, this is internal matter of the plaintiff and that itself does not give any right, title or entitlement to the defendant to question the validity of the trademark of the plaintiff.

21. As regards the prior user of the plaintiff, admittedly Shri Munesh Sharma, the Director of the plaintiff has a valid trademark



registration in **Class 30** in respect of trademark “MACHA TEA” since the year 2015. Even the trademark of plaintiff has been registered since the year 2014 in Class 30; whereas, the defendant admittedly got his trademark on 05.05.2024 with the claim of using the same since the year 2023.

22. The Trademark Registration Certificate of the defendant in **Class 35** under the title/heading “**Goods & Service Details**” reads as under:

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**[Class 35]**

*Advertising, marketing, business promotion,  
business administration, office functions related to  
services of providing food and drinks, temporary  
accommodation.*

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23. (i) On the aspect of “**prior adoption and user**”, the Hon’ble High Court of Delhi in case reported as, “**AIR 1978 Delhi 250**”, titled as, “**Century Traders V/s Roshan Lal Duggar**” (DOD: 27.04.1977)” has been pleased to observe as under:

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*(11) In Consolidated Foods Corporation v. Brandon and Co., Private Ltd., , it was observed that "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 ana 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. Priority in adoption and use of a trade mark is superior to priority in registration.*

*(12) For the purpose of claiming such proprietorship of a mark, it is not necessary that the mark should have been used for considerable length of time. As a matter of fact, a single actual use with intent to continue such use eo instanti confers a right to such mark as a trademark. It is sufficient if the article with the mark upon it has actually become a*

*vendible article in the market with instent on the part of the proprietor to continue its production and sales. It is not necessary that the goods should have acquired a reputation for quality under that mark. Actual use of the mark under such circumstances as showing an intention to adopt and use it as a trade-mark is the test rather than the extent or duration of the use. A mere casual, intermittent or experimental use may be insufficient to show an intention to adopt the mark as a trade mark for specific article or goods. . "*

*(13) The Supreme Court in **Corn Products Refining Co. v. Shangrila Food Products Ltd.**, laid down the rule vis-a-vis user of a mark as opposed to registration of mark. It observed that the onus of proving user is on the person who claims it. It did not approve of looking into the register of trade marks where a mark may be entered to be any proof of user. To quote from the speech of A.K. Sarkar, J. : "Now, of course, the presence of a mark in the register does not prove its user at all. It is possible that the mark may have been registered but not used. It is not permissible to draw any inference as to their user from the presence of marks in the register.*

*(14) Thus, the law is pretty well-settled that in order to succeed at this stage the appellant had to establish user of the aforesaid mark prior in point of time than the impugned user by the respondents. The registration of the said mark or similar mark prior in point of time to user by the appellant is irrelevant in an action passing off and the mere presence of the mark in the register maintained by the trade mark registry did not prove its user by the persons in whose names the mark was registered and was*

*irrelevant for the purposes of deciding the application for interim injunction unless evidence had been led or was available of user of the registered trade marks. In our opinion, these clear rules of law were not kept in view by the learned Single Judge and led him to commit an error.*

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(ii) Further, in case reported as, **“First Appeal No.262/1994”**, titled as, **“N.R Dongre & Ors. V/s Whirlpool Corporation & Ors.”** (DOO: 21.04.1995), the Hon’ble High Court of Delhi has been pleased to lay down as under:

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*(31) According to section 28(1) of the Act, registration of a trade mark gives to the registered proprietor thereof exclusive right to use the same in relation to the goods in respect of which it has been registered. But from the opening words of section 28(1) namely, "subject to other provisions" it is clear that the right conferred on a trader is not an indefeasible right as the same is expressly made subject to other provisions of the Act. This is further, made clear by section 27(2) of the Act, which provides that "nothing in this Act shall be deemed to affect the right of action against any person for passing off the goods as goods of another person or the remedies in respect thereof." Thus it is manifest that Section 28 of the Act and all other provisions come within the "'over riding sway of section 27(2) of the Act. Similarly section 33 of the Act also saves vested rights of a prior user. It lays down that nothing in the Act shall entitle a registered proprietor of a trade mark to interfere with the use of*

*the trade mark by a prior user of the same. Thus the right created by section 28(1) of the Act in favor of a registered proprietor of a trade mark is not an absolute right and is subservient to other provisions of the Act namely sections 27(2), 33 etc. Neither section 28 nor any other provision of the Act bars an action for passing off by an anterior user of a trade mark against a registered user of the same.- In other words registration of a trade mark does not provide a defense to the proceedings for passing off as under section 27(2) of the Act a prior user of a trade mark can maintain an action for passing off against any subsequent user of an identical trade mark including a registered user thereof. Again this right is not affected by section 31 of the Act, under which the only presumption that follows from registration of a mark is its prima facie evidentiary value about its validity and nothing more. This presumption is not an unrepeatable one & can be displaced. Besides section 31 is not immune to the over-riding effect of section 27(2). Placing reliance on section 28(3) of the Act, the I warned counsel for the appellant contended that when two registered proprietors of identical or near similar trade marks cannot be deemed to have acquired exclusive right to the use of any of those trade marks against each other, how can an unregistered user of the trade mark maintain an action for passing off against a registered user of the same mark and seek an injunction restraining him from using it. This argument of the learned counsel seems to stem from a misconception about the real purpose and intent of section 28(3). Actually section 28(3) protects registered proprietor of a trade mark from an infringement action by another registered proprietor of an identical or near similar trade mark. In this regard it will also be necessary to*

*extract Section 28(3) and section 30(1)(d) which carries of the intent of section 28(3). These sections read as under:-*

*"28(3) Where two or more persons are registered proprietors of trade marks, which are identical with or nearly resemble each other, the exclusive right to the use of any of those trade marks shall not (except so far as their respective rights are subject to any conditions or limitations entered on the register) be deemed to have been acquired by any one of those persons as against any other of those persons merely by registration of the trade marks but each of those persons has otherwise the same rights as against other persons (not being registered users using by way of permitted use) as he would have if he were the sole registered proprietor.*

*30(1)(d) Notwithstanding anything contained in this 'Act, the following acts do not constitute an infringement or the 'right to the use of a registered trademark- .....the use of a registered trade mark, being, one of two or more trade marks registered under this Act which are identical or nearly resemble each other, in exercise of the right to the use of that trade mark given by registration under this Act. " '*

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24. It is admitted position on record that at the time of filing of the suit, plaintiff had annual turnover for the year 2023-24 as almost Rs.59.00 Crores. There is also material on record that plaintiff has well established network pan India. The plaintiff has well known Bollywood celebrities endorsing its brand; whereas, defendant had annual turnover of around Rs.70,00,000/- (Rupees Seventy Lakhs Only).

25. It is also admitted position on record that defendant does not have single registration in the name of MAATEA /  in **Class 30 and 40 products**. It has already been set out in the preceding paragraph that defendant has filed ten applications seeking registration under Class 30, out of which seven were objected to by the Trademark Registry itself and the other three are lying opposed by the plaintiff.

26. Let us analyze as to whether the registration under **Class 35** gives any right to the defendant to use its mark “MAATEA / ” as a brand name for a product in respect of tea and further whether the defendant can use registration as a shield to oppose the mark of plaintiff. The answer to the aforesaid queries can be found in the following judgments.

(i) Case reported as, “**CS (Comm.) No.51/2022**”, titled as, “**Minda Spectrum Advisory Limited & Ors. V/s Minda Oils India Pvt. Ltd. & Ors.**” (DOD: 20.09.2022), wherein the Hon’ble High Court of Delhi has been pleased to lay down as under:

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*8. Be it noted that this contention cannot be accepted for an additional reason that in the present case the offending goods are lubricants, industrial oils and grease which are allied and cognate to the goods of the Plaintiffs sold under the trademark UNO MINDA. It is a matter of common knowledge that automobile spare parts, lubricants and grease are sold from the same shops and therefore, the trade channels are identical and the consumer base is the same. This Court draws strength from the judgment of the Bombay High Court in H.M. Saraiya and Ors. (Supra), where the alternate contention of the Plaintiffs was that even if it is held by the Court that Plaintiffs have accrued no reputation in their brand ‘Ajanta’ in respect of their goods, i.e., toothpaste still once the reputation is established in the allied product, i.e., toothbrush, Plaintiffs are entitled to injunction on the principle that Defendant cannot sell a cognate or allied product and should be enjoined in a passing off action. Relying on the judgment of the Supreme Court in **Corn Products Refining Co. v. Shangrila Food Products Ltd., (1960) 1 SCR 968** the Bombay High Court observed as follows:-*

*“58. In the present case we are not concerned with the super brand status or universal status of any brand because*

*it is not even the case of the plaintiffs that their brand has acquired any such super status so as to entitle the plaintiffs to protect their transborder and trans product reputation. The case of the plaintiffs is that the goods relating to the same field and/or in any event a cognate and allied products aforesaid are so similar products that it is likely to result in confusion in the minds of public. In my opinion, the principle of cognate and allied product is very much in existence and has been well recognised both by the learned author Kerly in the aforesaid paras as well as various judgments which are cited before me by the plaintiffs. In the case of Corn Products Refining Co. (supra), the Apex Court was dealing with the brand name 'Glucovita' glucose vita in respect of glucose powder mixed with vitamin and other product being glucose biscuits. The Apex Court as far back as in 1960 held that even though the goods are different but by virtue of fact that glucose powder is used in manufacture of biscuits and, therefore, the person is entitled to injunction though the goods are not identical.”*

59. In case of **Prakash Industries Ltd. v. Rajan Enterprises**, 1993 SCC OnLine Del 522, this Court observed as under:-

*“34. ....The plaintiff whose goods have acquired a reputation in the market through a trade mark or name*

*with which the goods have become associated has a right to restrain the defendant from using the trade mark or name which is identical with or similar to that of the plaintiff and such right extends not only to the particular goods sold by the plaintiff but also to cognate classes of goods provided the cumulative effect of the similarity of the mark, the commercial connection between the plaintiff's goods and those of the defendant's goods and surrounding circumstances is such as to lead the unwary customers to mistake the defendant's goods for those of the plaintiff."*

*60. Plaintiffs have thus made out a prima facie case of passing off against the Defendants. The tests laid down in the judgments aforementioned are met as the Plaintiffs have prima facie established that the nature of marks, nature of goods, class of purchasers, high degree of resemblance between the mark and misrepresentation coupled with likelihood of confusion.*

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(ii) Case reported as, **"IA No.6690/2015 & IA No.3733/2016 in CS (OS) No.893/2015"**, titled as, **"FDC Limited V/s Docsuggest Healthcare Services Pvt. Ltd. & Anr."** (DOD: 03.01.2017), wherein the Hon'ble High Court of Delhi has been pleased to lay down as under:

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*77. The plaintiff has also made out a prima facie case of passing-off as against the defendants. The test as laid down on deciding the question of deceptive similarity in a passing off action as provided in Cadila Healthcare Ltd. v. Cadila Pharmaceuticals Ltd. (supra) have been squarely met. As aforementioned and discussed, plaintiff has, prima facie, inter alia been able to establish that the nature of marks, nature of goods and services, class of purchasers/ consumers are similar; there is a high degree of resemblance between the marks, and also that there exists a likelihood of confusion and association because of the similarity between the marks and goods/services.*

*78. Thus, I am of the prima facie view that the use of the mark “ZIFFI” by the defendants in respect of their services is infringing the trademark of the plaintiff “ZIFI” used in respect of its pharmaceuticals preparations and it also tantamounts to passing off its business, website and services as that of the plaintiff. I am also convinced that the balance of convenience lies in favour of the plaintiff and not the defendants owing to their goodwill, reputation and growing business. Further, irreparable loss and injury would be suffered by the plaintiff, if the ad-interim injunction is not granted.*

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(iii) Case reported as, “**Civil Appeals No.1360-61 of 2005**”, titled as, “**Skyline Education Institute (India) Pvt. Ltd. V/s S.L Vaswani & Anr.**” (DOD: 05.01.2010), whereby the Hon’ble Supreme Court has been pleased to lay down as under:

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*18. In our opinion, the findings recorded by the learned Single Judge and Division Bench on the crucial factors like prima facie case, balance of convenience and equity are based on a correct and balanced consideration of various facets of the case and it is not possible to find any fault with the conclusions recorded by them that it is not a fit case for restraining the respondents from using the word 'Skyline' in the name of the institute established by them. It has not been disputed on behalf of the appellant that the word 'Skyline' is being used as trade name by various companies / organizations / business concerns and also for describing different types of institute/institutions. The voluminous record produced by the respondents before this Court shows that in India as many as 117 companies including computer and software companies and institutions are operating by using word United 'Skyline' States of as part America, of at their least name/nomenclature. In educational/training institutions are operating with different names using 'Skyline' as the first word. In United Kingdom also two such institutions are In view of this, it is not possible to agree with the counsel for the appellant that the Skyline is not a generic word but is a specific word and his client has right to use that word to the exclusion of others.*

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27. The learned counsel for the defendant has very vehemently argued that plaintiff has not challenged the registration of the trademark of the defendant. In my considered opinion, the plaintiff was not required to challenge the same, as it hardly concerns the plaintiff because the

defendant does not have any valid trademark in manufacturing tea. The defendant has only registration qua advertising, business management, business administration and office function. It appears that in the garb of aforesaid registration, the defendant has been very astutely selling its product by its tradename which is not permissible under the law.

28. Now, comes the most important aspect on which extensive arguments were advanced by both the sides. The learned counsel for the defendant termed the trademark of the plaintiff to be invalid since the same is merely misspelling of word MATCHA, a well known variety of green tea. It is claimed that word MACHA is structurally, visually and phonetically similar to the term MATCHA which is a generic term of *public juris* and is used by various traders in tea industry. It is contended that the said term cannot be allowed to be monopolised as a trademark just like any other generic term. He has emphasized that a misspelt variant of a generic term cannot be allowed to be monopolised as a trademark. In this regard, reliance has been placed upon case reported as, “**CS (Comm.) No.217/2020**”, titled as, “**Delhivery Private Limited V/s Treasure Vase Ventures Private Limited**” (DOO: 12.10.2020), whereby the Hon’ble High Court of Delhi has been pleased to observe as under:

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*59. Mr. Grover’s submission was that the mark ‘DELHIVERY’ is a combination of two words ‘DELHI’ and ‘VERY’. According to him, it is neither a generic word nor a descriptive word but a*

*coined word and the registration has to be seen as a prima-facie evidence of its validity.*

60. *On the other hand, Mr. Lall stated that the defendant's trademark 'DELIVER-E' comprises of the dictionary word 'deliver', which is accompanied by a suffix 'E'.*

61. *It is a conceded position that the plaintiff has registrations in the mark 'DELHIVERY' and its variants, whereas the defendant does not have registration in the mark 'DELIVER-E'. No doubt, registration of a mark in favour of the plaintiff confers rights as per Section 28 of the TM Act, however, the rights of a registered trademark holder are not absolute, in as much as both Sections 28 and 29 are subject to exceptions carved out to infringement of trademark.*

62. *It is also a settled law that a mark can either be phonetically or visually similar and has to be seen disjunctively and not conjunctively. It is also a settled law that whether two marks are deceptively similar, has to be seen from the perspective of an unwary purchaser of average intelligence and imperfect recollection (Re: AIR 1963 SC 449 Amrit Dhara Pharmacy vs. Satyadeo Gupta).*

63. *Having said that, the attempt of Mr. Grover is to read the term / mark 'DELHIVERY' by separating them as 'DELHI' and 'VERY'. In other words, the mark 'DELHIVERY' is different from the generic word 'delivery' and the plaintiff does not intend to stop anyone from using the word 'delivery' in a generic sense.*

*64. According to Mr. Grover, there is no justification for the defendant to adopt and use the impugned mark 'DELIVER-E' or any other mark, which is identical or deceptively similar to the registered mark of the plaintiff, 'DELHIVERY' in respect of identical or related services.*

*65. The above submissions of Mr. Grover are contradictory and not appealing. This I say so, being a coined mark 'DELHI' 'VERY' and not the generic word 'delivery', there can't be any comparison with the mark 'DELIVER-E' as the origin of the marks are different. But the fact, Mr. Grover's submission is that the mark 'DELIVER-E' is deceptively similar to the plaintiff's mark 'DELHIVERY' it becomes clear that the attempt of Mr. Grover is to relate the plaintiff's mark to the generic word 'delivery', which is a simple English dictionary word meaning of which is 'the act of taking goods, letters etc to the people they have been sent'. In fact, the services so offered, are for delivery of goods ordered by consumers from e-commerce websites, so the mark signifies such services. Further, the mark 'DELHIVERY' if pronounced in a routine manner shall mean 'delivery' and being a generic word, cannot be registered as a trademark.*

*66. The attempt of the plaintiff is to tweak the word in the English language, which is clearly impermissible. Similar is the position with regard to the mark 'DELIVER-E' coined by the defendant, which also if pronounced in a routine manner means 'delivery'. In fact, Mr. Lall concedes to the fact that the underlying word in both the marks is the dictionary word 'delivery'. The plea that the pronunciation is different cannot be accepted. The*

*plaintiff and defendant had only added / substituted one alphabet each to their marks to contend that the pronunciation is different. The plaintiff has added the alphabet 'H' in the word 'delivery' and the defendant has replaced the alphabet 'Y' with 'E'. In any case, the marks phonetically are the generic English word 'delivery'. The position of law is well settled that a generic word cannot be registered, that is, a generic word cannot be appropriated by one party to the exclusion of others. It is rightly stated by a Coordinate bench of this Court in Parveen Kumar Jain vs. Rajan Seth and Ors. 2019 SCC Online 8499 if the registrations are wrongly granted when applied for in respect of a completely generic expression, the Court cannot ignore the generic nature of marks and confer monopoly on the same in favour of any party. In this regard, I may note the position of law laid down by this Court in **SBL vs. Himalaya Drug Co (Supra)**:*

*"19.1... that 'LIV' is an abbreviation of liver. This abbreviation has been used in over 100 registrations as a constituent of the name under which the products relating to treatment associated with liver in the field of medicinal and pharmaceutical preparations - Homoeopathic and Ayurvedic are being marketed. The work 'LIV' is, therefore, generic and common to trade as describing the medicines associated with the treatment of liver. It has become public juris. In the field of medicines and pharmaceuticals, it is common practice that the drugs are named either by the*

*name of the organ which it treats or by the principal ingredients or the name of the ailment. This enables a doctor to associate a particular trade name with the organ, ingredient or ailment, thereby reducing chances of error. No trader can therefore restrain another trader from using the description of the organ, ingredients or ailment. The learned counsel has cited a host of authorities in support of his submission that a word or its abbreviation having become public juris ceases to be subject matter of proprietorship, also ceases to be source of deception or confusion for the person likely to deal with such goods would ignore the public juris and go distinguishing the products by the prefixes and/or suffixes.*

*(Emphasis supplied)*

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29. The learned counsel for the defendant has further placed reliance upon case reported as, “**IA No.3464/2010 in CS (OS) No.514/2010**”, titled as, “**Stokely Van Camp Inc. & Anr. V/s Heinz India Private Ltd.**” (DOD: 31.05.2010), whereby the Hon’ble High Court of Delhi has been pleased to observe as under:

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*9.1 I have heard the learned counsel on both sides as well as considered the documents placed on record. Given the background the first issue which arises for consideration in this case is that: in view of the fact that, the plaintiffs have obtained*

*registration of the mark/expression —Rehydrate Replenish Refueℓ, could the Court firstly, go behind the registration at an interlocutory stage and secondly, examine the defence of the defendant in respect of the impugned mark used by it. It is submitted by the learned counsel for the plaintiffs that the Court was required to accept prima facie, the validity of the registered mark/expression without more, at this stage and, grant the injunction sought for given the similarity of marks, the goods produced and also the similarity in profile of the consumers to which both, the plaintiffs and the defendants catered.*

*9.2 I tend to disagree with the aforesaid proposition of law enunciated by the learned counsel for plaintiffs. The reason being: if it was so, it would render the provisions of Section 30, 35 and 124 of the T.M. Act, 1999 quite meaningless. Since I had the occasion to deal with somewhat similar issue in the Marico's case, prolixity may well be avoided if I were to extract my observations in the said case :-*

*—15. CONCLUSIONS:On a consideration of submissions and the judgments:*

*(i) The court can at an interlocutory stage take a prima facie view as to the validity of a registered trade mark. This view can be taken based on averments made in the written statement/ pleadings. [See **Lowenbrau AG (supra)**]. The pleadings in this regard, as in every other case, has to be read —meaningfullyℓ (see **Begum Sabiha Sultan vs Nawab Mohd. Mansur Ali Khan & Ors (2007) 4 SCC 343**)*

*(ii) Some marks are inherently incapable of distinctiveness. [See **Asian Paints Ltd (supra)**]*

*(iii) The rights under Section 28 are subject to other provisions of the Trade mark Act. Also the registered proprietor or the permitted user can exercise his rights if the registered mark is valid‘.*

*(iv) A descriptive mark can be registered provided it has acquired secondary meaning [See **Girnar (supra)**]*

*(v) If a descriptive mark is one, which is, essentially a combination of common English words the user of the marks has to bear the risk of, some amount of confusion. No monopoly can be claimed by the user of the*

*(vi) The mark can be impugned both at the stage of registration and post registration. See provisions of Section 9(1)(a) to (c) of the Trade Marks Act for challenge at time of registration and Section 30 and 35 for challenge after registration.*

*(vii) If the registered mark and the rival mark are not identical; in other words the two marks are similar then the same test as in the case of passing off is applicable; which is, is there a likelihood of deception or cause for confusion. [See **Ruston and Hornby Ltd (supra)**]*

*16. In view of the discussion above in my opinion the use of the expression by the defendant —LOW ABSORB or —LOW ABSORB TECHNOLOGY*

*cannot be injuncted at this stage, since they are descriptive of the character or the quality of the defendant's goods unlike a trade mark which identifies the origin. . This defence is available even against registered mark under Sections 30(2)(a) and 35 of the Trade Marks Act. In the very least, this defence cannot be ruled out at the interlocutory stage. The use by the defendant cannot be said to be not bonafide since not only does it contain the additive which reduces oil absorption by food stuffs during the process of frying but the PFA Rules also recognize such an eventuality. ....*||

*9.3 A similar view has been expressed by another Single Judge of this Court in the case of **Lowenbrau AG & Anr vs Jagpin Breweries Limited & Anr: 157 (2009) DLT 791.***

*9.4 In addition to above, in my view, the provisions of Section 124 of the TM Act, 1999 are a clear pointer to the fact that the Court while hearing an application for grant of interlocutory order can come to a prima facie view of the validity of the mark. Section 124(1)(i)(a) of the TM Act 1999 provides that in any suit for infringement of a trade mark the defendant pleads that the registration of the plaintiff's trade mark is invalid the court under clause (i) of sub-section (1) of section 124 has the power to stay the suit till the disposal of the proceedings entered for rectification before the Registrar or Appellate Board are concluded. Where no proceedings are pending under sub-clause (ii) of sub-section (1) of Section 124 the Court an adjourn*

*the suit for a period of three months from the date of framing of issues to enable the concerned party to apply to the Appellate Board for rectification of the Register provided it is satisfied that the plea regarding invalidity of the registered mark is prima facie tenable. Sub-section 5 of Section 124 of the TM Act, 1999 exemplifies the power to the court to make any interlocutory order notwithstanding the fact that the suit has been stayed. It is quite axiomatic where the Court comes to a prima facie view that the registration obtained is invalid, an injunction cannot follow.*

*9.5 In the instant case, similarly, in my opinion the registered mark/expression of the plaintiffs is prima facie suspect. The word(s) which form a part of the plaintiffs' registered mark are an intrinsic part of the —current language commonly used in trade. What is persuaded me to come to this conclusion is the plethora of material placed on record which at least prima facie seems to suggest that these words are commonly used to describe the character, quality and attributes of an Isotonic drink. The defendant, as noticed hereinabove, has relied upon the advertisements by Nutrilite wherein, the brochure carries the words —Rehydrate, Replenish Refuel. Similarly, the website of UNAHCO, (which refers to a particular product prescribed for gamefowl; as a supplement, sold under the brand name electrogen D+) also uses the words and expressions similar to those used in the plaintiffs' mark. The advertisement is paraphrased in the following manner —maintains fighting cocks in top form by rehydrating, recharging, replenishing and refueling lost fluids, energy and electrolytes brought about by heat and stress. The argument of the plaintiffs' counsel that*

*the manner in which it is displayed on the plaintiffs' product is what the plaintiffs have difficulty with, is: in my opinion, untenable in view of the provisions of Section 30(2)(a) and Section 35 of the T.M. Act, 1999. Once one were to come to the conclusion that the expression —Rehydrate Replenish Refue℥ are commonly used in the trade which relates to energy drinks or supplements then it matters little where it is displayed on the product — as it prima facie establishes that the said words/expressions are commonly used in the trade to describe the characteristic of the goods in issue. In this context the defendant has referred to yet another product sold under the brand name —SOLGAR℥. The computer download shows the use of the words/expression “Rehydrate Re-energize”. Similarly, there is also a reference to another sports drink —GRAPE℥ which on the packaging itself uses the expression —Recharge℥. There are several such examples. The reason evidently is that all of them claim to be —isotonic drinks℥ or —supplements℥. Typically, an isotonic solution is described in the World Book Medical Encyclopedia as “a solution of salts in water that closely resembles body's normal fluids in strength”. The Web Dictionary, Wikipedia ascribes the following attributes to a sports drink. “.....A Sport drink is a beverage designed to help athletes rehydrate, as well as restore electrolytes, carbohydrates, and other nutrients, which can be depleted after training or competition. Electrolyte replacement promotes proper rehydration, which is important in delaying the onset of fatigue during exercise. As the primary fuel utilized by exercising muscle, carbohydrates are important in maintaining exercise and sport performance.....”*

*9.6 In the case of a sports drink or an energy drink such like words or expressions which are akin to the plaintiffs' mark are not only common but perhaps in a sense, necessary to describe, the characteristics or attributes of the product. Therefore, notwithstanding the fact that there is a registration in favour of the plaintiffs if, the expression which is registered or an expression similar to the one which is registered is used to describe the character of the product then, within the meaning of Section 30(2)(a) of the T.M. Act, 1999, the user will not be guilty of infringement. The argument of Mr Singh that what is protected in Section 30(2)(a) of the T.M. Act, 1999 is confined to the directions found on most packed products, that is, information as regards its ingredients, is a submission which does not find resonance in the provisions of Section 30(2)(a) of the T. M. Act, 1999. As is well known, the reference to the ingredients on most packed products is a statutory obligation under the Prevention of Food Adulteration Act, 1954 (in short 'PFA') and the Prevention of Food Adulteration Rules, 1955. If the contention of Mr Singh was in line with what is provided by the legislature in Section 30(2)(a) of the T. M. Act, 1999 then the legislature would not have gone to the extent of providing what all would not constitute an infringement. It would have simply referred to the provisions of the PFA and Rules framed thereunder.*

*9.7 The other contention of the plaintiff that descriptive words and expressions are registerable, or that the expression —Rehydrate Replenish Refue℥ has acquired secondary meaning would not, in the instant case, help the cause of the plaintiff. It is not disputed, as it cannot be, that descriptive*

*words are registerable and can be used as trade marks. The only caveat being that they ought to have acquired a —secondary distinctive meaning. The use of the mark by itself does not necessarily translate in the mark acquiring a —secondary distinctive meaning. In the present case even though the plaintiffs‘ have alluded to the revenue achieved in India and world over in respect of its product Gatorade, there is nothing on record to back the claim that the expression in issue, i.e., —Rehydrate Replenish Refue. purportedly used in relation to its product was instrumental in achieving the sales revenue as claimed in the plaint. As a matter of fact, the plaintiff curiously has not adverted to the turnover between the date of launch of the product in October, 2004 and 2007. The plaintiff again curiously has not even filed its invoices in respect of the sales of its product in India. There is no evidence in the form of consumer survey or otherwise which would at least prima facie have me believe that the registered mark —Rehydrate Replenish Refue. has achieved trade mark significance— in as much as the use of the expression brings to mind the trade origin of the product. Mere use of the mark alone does not necessarily translate in the mark obtaining —secondary distinctive meaning. In other words in my opinion, at this stage, based on the material placed on record, I am not persuaded to hold that the expression —Rehydrate, Replenish Refue. is distinctive of the plaintiff’s product.*

*9.8 The submission of the plaintiff that the defendant’s use of the impugned mark, that is, —Rehydrates Fluids, Replenishes Vital Salts and Recharges Glucose. is dishonest, in my view, is*

*again untenable. The reason for this is that both products are isotonic drinks. The trade liberally uses such like words or expression in one or the other form. The defendant's use of the expression does not prima facie appear to be dishonest for the reason that these are words or expressions used commonly to describe what appears to be the functional utility of an isotonic drink. The defendant, as a matter of fact, has gone further by using a suffix with each of the words, as in, —Rehydrate Replenish Refue℥ so as to describe in greater detail as to what it achieves. As a matter of fact, to me, they appear as short sentences. It is quite possible that the plaintiff at the trial is able to garner evidence to establish that the mark —Rehydrate Replenish Refue℥ has acquired —secondary distinctive meaning℥ relatable to the plaintiff's product. At this stage, however, as indicated hereinabove, no such prima facie conclusion can be drawn in favour of the plaintiffs. I find merit in the submission made on behalf of the defendant that the plaintiffs are selling its sports drinks under the trade mark Gatorade, and that the expression —Rehydrate Replenish Refue℥ is used in a descriptive sense. This submission finds support in a document placed on record by the plaintiffs which shows a bottled container carrying the label Gatorade sans the expression —Rehydrate, Replenish Refue℥. As a matter of fact in court, the defendant's counsel did show such bottled containers which did not bear the mark —Rehydrate Replenish Refue℥ —to which the plaintiffs' counsel had no reasonable explanation.*

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30. In my considered opinion, word **MATCHA** may not be termed as generic term in the Indian context and even if as of now, it may be treated as a term indicative of Japanese Green Tea. From the material placed on record, it is prima facie evident that the plaintiff started using word **MACHA** in respect of tea in the year 2015; whereas, term **MATCHA** came to be adopted in Indian trade only at or around the year 2017. Therefore, the plaintiff cannot be said to be manipulator of generic term **MATCHA** in respect of tea.

31. (i) Further, **on the aspect of identical and/or a deceptively similar mark and causing misrepresentation**, the Hon'ble Supreme Court of India in case reported as, "**Civil Appeals No.522 & 523/1962**", titled as, "**Kaviraj Pandit Durga Dutt Sharma V/s Navaratna Pharmaceutical Laboratories**" (DOD: 20.10.1964) has been pleased to lay down as under:

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*28. The other ground of objection that the findings are inconsistent really proceeds on an error in appreciating the basic differences between the causes of action and right to relief in suits for passing off and for infringement of a registered trade mark and in equating the essentials of a passing off action with those in respect of an action complaining of an infringement of a registered trade mark. We have already pointed out that the suit by the respondent complained both of an invasion of a statutory right under s. 21 in respect of a registered trade mark and also of a passing off by the use of the same mark. The finding in favour of the appellant to which the learned Counsel drew our attention was*

*based upon dissimilarity of the packing in which the goods of the two parties were vended, the difference in the physical appearance of the two packets by reason of the variation in their colour and other features and their general get-up together with the circumstance that the name and address of the manufacture of the appellant was prominently displayed on his packets and these features were all set out for negating the respondent's claim that the appellant had passed off his goods as those of the respondent. These matters which are of the essence of the cause of action for relief on the ground of passing off play but a limited role in an action for infringement of a registered trade mark by the registered proprietor who has a statutory right to that mark and who has a statutory remedy in the event of the use by another of that mark or a colourable imitation thereof. While an action for passing off is a Common Law remedy being in substance an action for deceit, that is, a passing off by a person of his own goods as those of another, that is not the gist of an action for infringement. The action for infringement is a statutory remedy conferred on the registered proprietor of a registered trade mark for the vindication of the exclusive right to the use of the trade mark in relation to those goods (Vide s. 21 of the Act). The use by the defendant of the trade mark of the plaintiff is not essential in an action for passing off, but is the sine qua non in the case of an action for infringement. No doubt, where the evidence in respect of passing off consists merely of the colourable use of a registered trade mark, the essential features of both the actions might coincide in the sense that what would be a colourable imitation of a trade mark in a passing off action would also be such in an action for infringement of*

*the same trade mark. But there the correspondence between the two ceases. In an action for infringement, the plaintiff must, no doubt, make out that the use of the defendant's mark is likely to deceive, but where the similarity between the plaintiff's and the defendant's mark is so close either visually, phonetically or otherwise and the court reaches the conclusion that there is an imitation, no further evidence is required to establish that the plaintiff's rights are violated. Expressed in another way, if the essential features of the trade mark of the plaintiff have been adopted by the defendant, the fact that the get-up, packing and other writing or marks on the goods or on the packets in which he offers his goods for sale show marked differences, or indicate clearly a trade origin different from that of the registered proprietor of the mark would be immaterial; whereas in the case of passing off, the defendant may escape liability if he can show that the added matter is sufficient to distinguish his goods from those of the plaintiff.*

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(ii) On somewhat similar aspect, the Hon'ble Supreme Court in case reported as, **“Civil Appeal No.404/2022”**, titled as, **“Renaissance Hotel Holdings Inc. V/s B. Vijaya Sai & Ors.”** (DOD: 19.01.2022) has been pleased to observe as under:

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*42. It could thus be seen that in all legal proceedings relating to trade mark registered under the said Act, the original registration of the trade mark and of all subsequent assignments and transmissions of the trade mark shall be prima facie evidence of the*

*validity thereof.*

.....

*48. In the present case, both the trial court and the High Court have come to the conclusion that the trade mark of the respondents defendants is identical with that of the appellant plaintiff and further that the services rendered by the respondents defendants are under the same class, i.e., Class 16 and Class 42, in respect of which the appellant plaintiff's trade mark "RENAISSANCE" was registered. In such circumstances, the trial court had rightly held that the goods of the appellant plaintiff would be covered by Section 29(2)(c) read with Section 29(3) of the said Act.*

.....

*51. It is further clear that in case of an eventuality covered under clause (c) of subsection (2) of Section 29 in view of the provisions of subsection (3) of Section 29 of the said Act, the Court shall presume that it is likely to cause confusion on the part of the public.*

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32. Now, let us have a brief analysis of the trademarks of both the parties.

**SIMILARITIES BETWEEN PLAINTIFF AND DEFENDANT PRODUCTS AS THE MARKS ARE DECEPTIVELY SIMILAR**

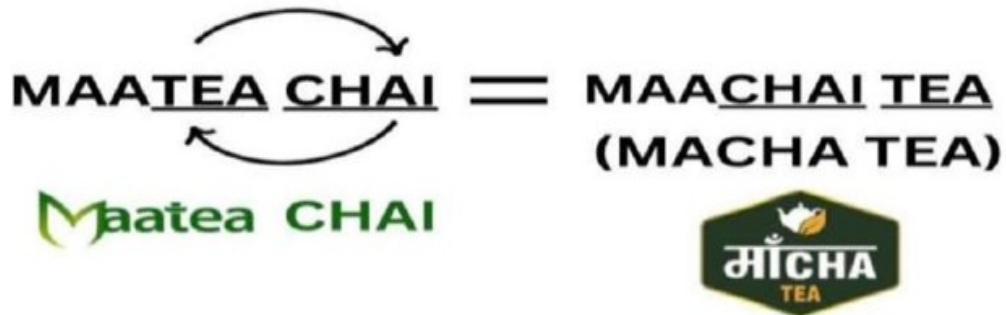
CS (Comm.) No.383/2024: M/s Macha Consumer Products Private Limited V/s  
M/s Chai Sutta Bar Trading Private Limited

|                                         | Plaintiff                                                                                         | Defendant                                                                                            |
|-----------------------------------------|---------------------------------------------------------------------------------------------------|------------------------------------------------------------------------------------------------------|
| <b>NAME</b>                             | <b><u>MACHA TEA</u></b>                                                                           | <b><u>MAATEA CHAI</u></b>                                                                            |
| <b>DEVICE</b>                           | <br>MA as prefix | <br>MAA as prefix |
| <b>MEANING / TRANSLATION IN ENGLISH</b> | Maa (Mother)<br>Cha (Tea)                                                                         | Maa (Mother)<br>Tea (Tea)                                                                            |
| <b>PROMINENT MARK</b>                   | Maa                                                                                               | Maa                                                                                                  |
| <b>PRODUCT</b>                          | Tea                                                                                               | Tea                                                                                                  |
| <b>MODE OF BUSINESS</b>                 | Online and offline                                                                                | Online and offline                                                                                   |
| <b>DOMAIN</b>                           | <a href="https://machatea.co/">https://machatea.co/</a>                                           | <a href="https://maatea.in/">https://maatea.in/</a>                                                  |
| <b>TRADE DRESS</b>                      |                 |                  |
| <b>TAG LINE</b>                         | “माँ के हाथ की चाय”                                                                               | “माँ का प्यार देश का स्वाद”                                                                          |
| <b>WEBSITE</b>                          |               |                 |

It says “MAATEA CHAI”, which is nothing but a reversal of Plaintiff’s MACHA TEA, where the words TEA and CHAI/CHA have been interchanged. Following is an easier representation:

**Defendant's Trademark**

**Plaintiff's Trademark**



33. Section 17 of Trade Marks Act, 1999 mandates that rival marks are to be compared as a whole while assessing the overall impression of both of same. Therefore, even if the defendant's mark is not phonetically similar, but it conveys the same meaning to end customers who are same; whether the adoption of the mark of plaintiff by the defendant can be termed to be dishonest will be seen at the time of trial. Suffice it to say that **MAATEA** is a translation of the plaintiff's prior trademark **MACHA**. It appears that mark of the defendant mimics sound and structure of the plaintiff's marks, but it conveys the same commercial impression, thereby prima facie infringing the valid trademark of the plaintiff and in any case passing off the goods of the plaintiff.

34. I find substance in the arguments of learned counsel for the plaintiff that **MACHA** is not a generic word, but it appears to be a distinctive fusion of "MAA" and "CHA", forming a distinct mark in reference to tea. I prima facie do not find any substance in the arguments

of learned counsel for the defendant that word MAATEA is derived from hindi word MAATI, meaning soil, suggesting any affiliation with nature and the earth. The said reference appears to be unreasonable because if the defendant was inspired from soil (Maati) then the brand name could be MAATI and not MAATEA.

35. The defendant has taken the ground of invalidity of the trademark of plaintiff, but I prima facie do not find the trademark of the plaintiff being invalid. Therefore, I find prima facie case in favour of plaintiff.

**Balance of Convenience:**

36. The balance of convenience lies in favour of plaintiff as it has common law right of protecting its valid registered trademark in respect of designated goods. His trade volume is far more than that of defendant. Even the plaintiff has more goodwill then that of defendant.

**Irreparable loss and injury:**

37. It is the plaintiff who is going to suffer irreparable loss and injury which is no recompass in law in case the defendant is permitted to violate the plaintiff's trademark and pass off its goods as that of plaintiff.

38. (i) In view of the above discussion, the application filed by plaintiff under Order XXXIX Rule 1 & 2 CPC is allowed. **Consequently, interim order dated 02.07.2024 stands confirmed during the pendency of this case.**

(ii) The application filed by defendant under Order XXXIX Rule 4 CPC accordingly stands dismissed.

39. It is hereby clarified that anything stated hereinabove shall not be construed as expression of opinion on the merits of the case.

40. Ahlmad is directed to separate the application filed under Order XXXIX Rule 2A CPC and maintain a separate miscellaneous file in respect thereof.

41. Renotify the matter for framing of issues/case management hearing now on **16.04.2026**.

Dictated & Announced in the  
open Court on 17.01.2026

(Vinod Yadav)  
District Judge (Commercial Court)-02  
North-West/Rohini Courts