



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

**INTERIM APPLICATION NO. 4642 OF 2025
IN
COMMERCIAL IP SUIT NO. 336 OF 2024**

The Supreme Industries Limited

...Applicant/Plaintiff

vs.

Moorthi Rabeha

...Respondent/Defendant

Mr. Vinod Bhagat a/w Mr. Siddhant Gupta i/b U. A. Bhagat, for the Plaintiff.

Mr. Satyaprakash Sharma a/w Ms. Vaishali Malekar, for the Defendant.

**CORAM : SHARMILA U. DESHMUKH
RESERVED ON : 12th DECEMBER, 2025
PRONOUNCED ON : 19th JANUARY, 2026**

ORDER:

1. This is an action for infringement of trade mark, copyright and passing off.
2. The Plaintiff came with the case that in the year 1987, the Plaintiff conceived and adopted the trade mark "SUPREME" in respect of its plastic products which are marketed globally. The trade mark is in use by the Plaintiff since the year 1987. The word "SUPREME" is the Plaintiff's house mark and is also part of the Plaintiff's corporate name. By reason of its continuous and uninterrupted extensive use since the year 1987, the Plaintiff has acquired valuable common law rights. The statutory rights are secured by reason of the registration of the mark

“SUPREME” and its formatives of which “SUPREME” forms the leading and essential features. Paragraph 7 of the plaint sets out the details of the eleven registrations secured by the Plaintiff with the earliest registration of the label mark “SUPREME” in the year 2003 in Class 17.

3. It is pleaded that since the year 1987, the trade mark is depicted in a stylized label bearing an original artwork, which artwork was revised by the Plaintiff in the year 1997. The new label while retaining the stylized manner of depicting the mark SUPREME added a tagline “People who know plastics best” written beneath the SUPREME Label. The artwork was designed by the author under a contract of service for the Plaintiff and the Plaintiff is the owner of the copyright subsisting in the artwork.

4. The reputation and good will is demonstrated by placing on record the sales turn over duly certified by the Chartered Accountant indicating sales turn over for the year 2023-2024 in excess of Rs. 10,000 crores and expenditure of more than Rs. 140 crores towards advertisement and promotion.

5. It is stated that in the fourth week of June 2024, while conducting a routine public search of the trademark registry records, the Plaintiff came across the registration granted for the impugned label mark “SUPREMES GOLD” with the logo “SG” in the name of the Defendant under registration no 5223553 dated 25th November, 2021. The validity

of the Defendant's registration is assailed as the impugned mark "SUPREMES GOLD" with the logo "SG" is deceptively similar to the Plaintiff's registered trade mark in respect of the identical goods. A Rectification Application has been filed by the Plaintiff seeking cancellation of the registration of the impugned mark which is pending. It is stated that up to October 2024, the Plaintiff did not come across the Defendant's goods, and therefore, there was no cause of action to institute any suit against the Defendant. It is stated that the word "SUPREME" is a well known trade mark and has acquired secondary meaning having lost its primary significance and is associated solely with the Plaintiff in the minds of the public.

6. The Defendant has adopted her written statement as her affidavit-in-reply. It is contended that the word "SUPREME" is descriptive word and no one can claim trade mark for said word. It is contended that the general search of the Ministry of Corporate Affairs shows approximately 500 companies having the word SUPREME as a part of its trade name. The Plaintiff's trade mark does not find place in the list of well known trade marks as published by the Registrar of trade mark. The other defence taken is the absence of Plaintiff's registration of its mark in Class 19 in which the Defendant's label mark is registered. The Plaintiff is alleged to have concealed material fact by non disclosure of refusal of registration of the word mark "SUPREME" in Class 19.

7. The dis-similarity in the rival marks is claimed by reason of difference in colour, artwork, font and layout. The Defendant is in the business of manufacturing and marketing of PVC pipes since the year 2015 and has secured registration of the trade marks (i) SG Supremes Gold and (ii) SG Sabariplast . It is stated that Defendant's trade mark is a coined word being "SUPREMES GOLD" and when taken as a whole it is not descriptive and unique and is not similar to any other existing prior trade mark including the Plaintiff's trade mark. The Defendant claims to have generated substantial revenue, goodwill and reputation in respect of its mark.

8. In the affidavit in rejoinder, the claim of dis-similarity is denied by pointing out that the Defendant has copied the entire registered trade mark of the Plaintiff and has merely added an alphabet 's' while suffixing the word "GOLD" written in a different form. It is stated that the claim for infringement is not based on the registration which was refused and there is no concealment of any material information. It is stated that in the examination report in respect of the Plaintiff's application no 2410806 for registration of the label mark of SUPREME, the marks cited were in respect of cement, plywood, etc. which are not the goods manufactured by the Plaintiff. The examination report does not cite the Defendant's mark and there is no pleading of estoppel.

9. In sur-rejoinder, it is stated that the reference to the order at

page 306 of plaint as regards the Plaintiff's mark being well known trade mark is *prima facie* observation of this Court arrived at without looking into any other material particularly the order dated 14.12.2017 refusing the application of Plaintiff for registration of the word mark "SUPREME".

10. Mr. Bhagat, learned counsel for the Plaintiff points out the side by side comparison to demonstrate deceptive similarity between the rival marks. He submits that the word "GOLD" is written in a different form and the entire trade mark of the Plaintiff has been copied by adding the alphabet 's'. He submits that the defence of the Defendant is that the word SUPREME is descriptive in unacceptable as the Defendant herself has applied and secured registration of the mark "SUPREMES GOLD". He draws attention of this Court to the registrations set out in paragraph 7 of the plaint to emphasize the proprietary right of the Plaintiff in the mark "SUPREME". He submits that the application for registration of the label mark of "SUPREME" was filed in the year 2006 with a user claim of 1997 in Class 17 and Plaintiff has secured registrations of the device mark/word mark of "SUPREME" of which infringement is claimed. He would further submit that the Plaintiff has also obtained copyright registration in the original art work.

11. He would further point out the sales turn over duly certified by the Chartered Accountant and the advertising material to demonstrate

goodwill and reputation. He would point out the invoice of the year 1993 placed on record to contend the long standing use of the mark by the Plaintiff. He submits that this Court in various orders have held the trade mark "SUPREME" to be a well known trade mark. He submits that the Defendant has applied for registration of the device mark "SG SUPREMES GOLD" which was accepted without citing the Defendant's mark which registration is ex-facie illegal and fraudulent as against which Rectification Application is pending. He submits that the Defendant has not produced any document to show the use of the mark. He would point out the pleading in paragraph 28 of the written statement stating that the Defendant is ready to change the mark.

12. *Per Contra*, Mr. Sharma, learned counsel for the Respondent submits that the Defendant is the registered proprietor of the mark "SUPREMES GOLD" and no infringement can be claimed against the Defendant for use of its own registered mark. He submits that the Plaintiff's mark is a unique coined word and non-descriptive. He submits that in the absence of registration of the word mark "SUPREME", the cannot seek monopoly in use of the word "SUPREME". He would further submit that there are about 500 companies using the word "SUPREME" and no exclusivity can be claimed in the said word "SUPREME". He would further point out that the Plaintiff's application seeking registration of the word mark "SUPREME" in class 19 was objected in the Examination

Report citing various marks using the word "SUPREME", which was refused registration and the Plaintiff cannot claim any exclusive right to use the word "SUPREME". He would further submit that the Defendant's mark is distinct as the mark is "SUPREMES GOLD" with the logo "SG". He submits that the marks are dissimilar as the color combination is different and the style of writing is different. He submits that the Defendant's mark was registered after considering the response of the Defendant to the examination report in which the cited marks were not the Plaintiff's marks. He would submit that the Defendant has ISO certification in respect of its goods.

13. I have considered the submissions and perused the record.

14. There is no dispute about that the Plaintiff is the registered proprietor of the mark "SUPREME". The prior user of the mark is also not disputed by the Defendant. Paragraph 7 of the plaint sets out the details of registration obtained of the mark SUPREME (label), SUPREME AQUA (label), SUPREME VARSHA (word), SUPREME E-LITE (label), SUPREME NEO(label), all in Class 17. In Class 19, the Plaintiff has secured registration of SUPREME (label) on 12.10.2012, SUPREME ULTRA on 14.09.2015, SUPREME ULTRA PLUS (label) on 17.03.2016 and SUPREME E-LITE (label) on 27.03.2019. The earliest registration is of the year 2003 of the label mark "SUPREME".

15. Under Section 29 of the Trade Marks Act, 1999, infringement of a

registered trade mark occurs by use of an identical/deceptively similar trade mark by a person who is not a registered proprietor in relation to the goods and services in respect of which the trade mark is registered. Dealing first with the aspect of deceptive similarity, in order to assess the deceptive similarity, it is the broad and essential features of the mark which is to be considered. In **Parle Products Private Limited vs J. P. & Co.**¹ the Hon'ble Apex Court observed in paragraph 9 as under:

"9. It is therefore clear that in order to come to the conclusion whether one mark is deceptively similar to another, the broad and essential features of the two are to be considered. They should not be placed side by side to find out if there are any differences in the design and if so, whether they are of such character as to prevent one design from being mistaken for the other. It would be enough if the impugned mark bears such overall similarity to the registered mark as would be likely to mislead a person usually dealing with one to accept the other if offered to him."

16. In paragraph 5 of **M/s Hiralal Prabhudas vs M/s Ganesh Trading Company**², it is held as under:

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

17. In paragraph 28 of **National Sewing Thread Co. Ltd vs Jamesh Chadwick & Bors**³, the Hon'ble Apex Court observed as under:

18. "(28) The principles of law applicable to such cases are well-settled. The burden of proving that the trade mark which a person seeks to register is not likely to deceive or to cause confusion is upon the applicant. It is for him to satisfy the Registrar that his trade mark does not fall within the prohibition of Section 8 and therefore it should be registered. Moreover in deciding whether a particular trade

1 1972 (1) SCC 618

2 AIR 1984 Bom 218

3 (1953) 1 SCC 794

mark is likely to deceive or cause confusion that duty is not discharged by arriving at the result by merely comparing it with the trade mark which is already registered and whose proprietor is offering opposition to the registration of the mark. The real question to decide in such cases is to see as to how a purchaser, who must be looked upon as an average man of ordinary intelligence, would react to a particular trade mark, what association he would form by looking at the trade mark, and in what respect he would connect the trade mark with the goods which he would be purchasing."(Emphasis supplied)

18. In Amritdhara Pharmacy vs Satya Deo Gupta⁴, the Hon'ble Apex Court observed thus in paragraph 7:

"(7).....An unwary purchaser of average intelligence and imperfect recollection would not, as the High Court supposed, split the name into its component parts and consider the etymological meaning thereof or even consider the meaning of the composite words as "current of nectar" or "current of Lakshman". He would go more by the overall structural and phonetic similarity and the nature of the medicine he has previously purchased, or has been told about, or about which has otherwise learnt and which he wants to purchase. Where the trade relates to goods largely sold to illiterate or badly educated persons, it is no answer to say that a person educated in the Hindi language would go by the etymological or ideological meaning and see the difference between "current of nectar" and current of Lakshman". "Current of Lakshman" in a literate sense has no meaning; to give it meaning one must further make the inference that the "current or stream" is as pure and strong as Lakshman of the Ramayana. An ordinary Indian villager or townsman will perhaps know Lakshman, the story of the Ramayana being familiar to him, but we doubt if he would etymologise to the extent of seeing the so-called ideological difference between "Amritdhara" and "Lakshmandhara" He would go more by the similarity of the two names in the context of the widely known medicinal preparation which he wants for his ailments."

19. What is thus significant is the overall similarity, assessed by considering the essential features of the two, which similarity would have the effect of causing confusion, leading to acceptance of the other mark by a person accustomed to the first mark.

20. It would apposite to reproduce the rival marks for purpose of comparison:

Plaintiff's Mark	Defendant's Impugned Mark
	

⁴ AIR 1963 SC 449

21. The consistent judicial view is the applicability of the test of average consumer with imperfect recollection. The products marketed by both the parties are plastic products of common use not dominated by discerning consumers. *Prima facie* the striking and essential feature of the Plaintiff's mark is the word "SUPREME" written in a distinct stylised font, which is likely to be fixated in the public mind as associated with the Plaintiff's goods considering the use of the mark since the year 1987. The Defendant's mark "SUPREMES GOLD" subsumes the entire mark of the Plaintiff and on visual comparison, the similarity is absolutely striking.

22. The Plaintiff's label mark is "SUPREME" is depicted in a stylised font which is copyrighted by the Plaintiff. The starting alphabet "S" written in a distinctive style followed by the subsequent alphabets in smaller case in a stylised manner. The Defendant's trade mark "SUPREMES GOLD" depicts the word "SUPREME" differently from the depiction of the word "GOLD". The word "SUPREMES" is written in an identical stylised font as that of the Plaintiff's mark "SUPREME" with the starting alphabet "S" depicted identically with the rest of the alphabets in smaller case. The word "GOLD" is separated from the word "SUPREMES" and is written in straight english alphabets. The depiction of the word "SUPREMES" in an identical font as that of the Plaintiff highlights the word "SUPREMES" with the possibility of the suffix

“GOLD” being ignored. According to Kerly’s Law of Trade Marks and Trade (9th edition, paragraph 838) which was noted by the Hon’ble Apex Court, in the case of **Parle Products Private Limited vs. J. P. & Co. (supra)**

“(8) Two marks, when placed side by side may exhibit many and various differences, yet the main idea left on the mind by both may be the same. A person acquainted with one mark and not having two side by side for comparison, might well be deceived, if the goods were allowed to be impressed with the second mark, in the belief that he was dealing with the goods which having the same mark as that with which he was acquainted. Thus, for example, a mark may represent a game of football; another mark will show the players in different dress, and in very different position and yet the idea conveyed by each might be simply a game of football. It would be too much to expect that person dealing with trade mark goods and relying, as they frequently do, upon marks, should be able to remember the exact details of the mark upon the goods with which they are in the habit of dealing. Marks are remembered rather by general impression or by some significant detail, then by any photographic recollection of the whole. Moreover variations in detail might well be supposed by customers to have been made by the owners of the trade mark they are already acquainted with for reasons of their own”.

23. The use of the SG logo is in negligible font and is barely noticed. The Defendant has admitted in paragraph 19 of the written statement that it may be true that while purchasing the Defendant’s product a customer would refer to the impugned mark as SUPREMES GOLD and not with SG logo. The Defendant therefore admits that the SG logo is insignificant to distinguish the Defendant’s trademark from that of the Plaintiff. The Defendant has further shown her willingness to carry out suitable additions to the impugned mark, though not accepting the similarity between the rival marks.

24. In any event, the addition of the suffix “GOLD” is immaterial as the Plaintiff’s entire mark has been subsumed in the Defendant’s mark. There is visual, structural and phonetic similarity between the rival

marks. The addition of the alphabet “s” does not take away the phonetic similarity as there is tendency to slur over the termination and the Defendant’s mark is likely to be pronounced as SUPREME instead of SUPREMES. An average consumer would recollect only the word “SUPREME” and would be confused upon being confronted with the Defendant’s mark. There is *prima facie* possibility of the consumers associating the Defendant’s product as that of the Plaintiff by considering that the impugned mark is one of the Plaintiff’s formative marks particularly considering the stylised depiction of the word “SUPREMES” by the Defendant. The use of different colour by the Defendant is insufficient to strike out the similarity. Pertinently, the Defendant has annexed its product catalogue at page 421 of its written statement, which depicts the mark “SUPREMES GOLD” in red colour, identical to that of the Plaintiff, whereas the Defendant’s registration of the mark “SUPREMES GOLD” is in green colour. *Prima facie* it appears that the Defendant’s use of its mark is different from the registered mark, which shows dishonest use of the mark. There is no explanation tendered as to the different fonts of depiction of the word “SUPREMES” and “GOLD” in the Defendant’s mark.

25. Section 29 of the Trade Marks Act speaks of use of the registered trade mark by a person who is not the registered proprietor. However, despite the registration of the trade mark by the Defendant, there is no

absolute embargo on grant of injunction as Section 28 uses the expression "if valid". In ***The Indian Hotels Company Limited v. Ashwajeet Garg & Ors,***⁵ an injunction for infringement of trade mark was granted against the Defendant who was a registered proprietor. After considering the law on the subject, the Court summarised the legal position as under:

"(45) The legal principles that thus emerge are the following:

(i) Action for infringement is a statutory remedy conferred on the registered proprietor of a registered Trade mark.

(ii) Registration of Trade mark gives the proprietor the exclusive right to the use of the Trade mark in connection with the goods in respect of which I say that is registered. American Home Products (Supra).

(iii) 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 shows marked differences, or indicate clearly as trade origin different from that of the registered proprietor of the mark would be immaterial.

(iv) Mere delay in filing of a suit for infringement is not fatal.

(v) Phonetic similarity constitutes an important index of whether a mark bears a deceptive or misleading similarity to another.

(vi) The Court must consider the usage of words in India, the manner in which a word would be written in Indian languages and the similarity of pronunciation if the rival marks are used.

(vii) Resemblance between the two marks must be considered with reference to the ear as well as the eye.

(viii) The rival marks have to be compared as a whole. The two competing marks must be judged by both by their looks and by their sound. All the surrounding circumstances must be considered.

(ix) Where the similarity between the Plaintiffs and the Defendant's mark is so close either visually, phonetically or otherwise and the Court reaches the conclusion that there is an imitation, no further evidence is required to establish that the Plaintiffs rights are violated.

(x) Competing marks have to be compared keeping in mind an unwary purchaser of average intelligence and imperfect recollection.

(xi) Broad and essential features of the two are to be considered. They should not be placed side by side to find out if there are any marked differences in the design and get up.

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(xii) A single actual use with intent to continue such use eo instanti confers a right to such mark as a Trade mark.

(xiii) The Applicant has to establish user of the aforesaid mark prior tin point of time than the impugned user by the non-Applicant.

(xiv) A suit for infringement is maintainable by a registered proprietor against another registered proprietor.

(xv) While staying the further proceedings pending decision of the registrar on rectification, an interim order including of injunction restraining the use of the registered Trade mark by the Defendant can be made by the Court.

(xvi) A trade mark shall not be registered if it is identical or similar to an earlier Trade mark in respect of goods or services covered by the Trade mark and is likely to cause confusion amongst the public.

(xvii) Registration of an identical or similar Trade mark shall also be refused for goods and services not covered by the earlier Trade mark if it is shown that the earlier Trade mark is a well known Trade mark.

(xviii) The mere fact that the Plaintiff has not chosen to take any action against other parties cannot disentitle the Plaintiff from taking the present action."

26. The Hon'ble Full Bench of this Court in **Lupin Ltd. vs. Johnson and Johnson**⁶ dealt with the power of the Court to venture into the question of validity of registration of the trademark at an interlocutory stage upon defence of invalidity of registration being taken. The Hon'ble Division Bench concluded the findings relevant for our purpose in paragraph 59(3), (5), (6) and (8) as under:

"59. (3) A challenge to the validity of the registration of the trade mark can finally succeed only in rectification proceedings before the Intellectual Property Appellate Board. However, there is no express or implied bar taking away the jurisdiction and power of the Civil Court to consider the challenge to the validity of the trade mark at the interlocutory stage by way of prima facie finding. (Paras 34 and 53)

(5) However, a very heavy burden lies on the defendants to rebut the strong presumption in favour of the plaintiff on the basis of the registration at the interlocutory stage. The plaintiff is not required to prove that the registration of a trade mark is not invalid, but only in the cases where the factum of registration is ex facie totally illegal or fraudulent or shocks the conscience of the Court that the Court may decline to grant relief in favour of the plaintiff. (Paras 25, 27 and 55)

(6) It is not sufficient for the defendant to show that the defendant has an arguable case for showing invalidity. The prima facie satisfaction of the Court to stay the trial under section 124 of the Act is not enough to refuse grant of interim injunction. It is only in exceptional circumstances, such as,

6 [2015(1) Mh.L.J. 501]

the registration being ex facie illegal or fraudulent or which shocks the conscience of the Court that Court will refuse the interim injunction in favour of the registered proprietor of the trade mark. (Para 57)

(8) Though it is considered as a practice of this Court in granting injunction in favour of the plaintiff having a registered trade mark, the same cannot be treated as a total embargo on the power of the Court to refuse grant of interim injunction. In exceptional cases, that is in cases of registration of trade mark being ex facie illegal, fraudulent or such as to shock the conscience of the Court, the Court would be justified in refusing to grant interim injunction. (Para 33)"

27. The Hon'ble Full Bench has upheld the power of the Court at the interlocutory stage to travel beyond the registration with the caveat that the case must fall within the small window left open by demonstrating that the registration of the impugned mark is *ex-facie* illegal or fraudulent or which shocks the conscience of the Court.

28. As already discussed, the impugned mark is visually, structurally and phonetically similar to the Plaintiff's mark, which was registered prior in time. Section 9 and Section 11 of the Trade Marks Act, 1999 rules out registration of a trade mark which is likely to deceive the public or cause confusion. The Defendant has copied the essential features of the Plaintiff's registered trade mark and secured registration in respect of identical goods. The statutory provisions does not speak of only identical mark but also of deceptively similar mark as infringement takes place even by use of deceptively similar mark. The Plaintiff has secured registration of its mark "SUPREME" without any disclaimer. The Registrar had cited two marks bearing the words "Supreme Gold" as conflicting marks in the examination report, without

applying the well settled tests for ascertaining confusion and deception i.e. the essential feature of a registered mark. The Registrar has considered the identical mark as conflicting mark whereas the registration of the Plaintiff's mark without any disclaimer ought to have put the Registrar to caution. The registration of the Defendant's mark in view of the registration of the Plaintiff's mark is *ex-facie* illegal considering the deceptive similarity and likelihood of confusion being caused amongst the relevant consumer base. The Defendant has bodily lifted the essential feature of the Plaintiff's registered mark and incorporated it in the Defendant's mark with the suffix "GOLD" which is immaterial. This Court is convinced that the registration secured by the Defendant is *ex facie* illegal. *Prima facie* the subsequent registration ought not to have been granted.

29. To overcome the difficulty of the Plaintiff's prior user and registration of its trade mark, Mr. Sharma would contend that the Plaintiff has secured registration of label mark and not the word mark "SUPREME". Though not stated in so many words, the defence is based on Section 17 of the Trade Marks Act, 1999. The Plaintiff's label mark "SUPREME" is nothing but the word "SUPREME" written in stylised font. Apart from the word "SUPREME" there is no other element or feature of the label mark. There is thus "no part of the whole" as used in Section 17 of the Trade Marks Act, 1999. There is no composite label consisting

of elements apart from the word "SUPREME" and the issue of label mark vs word mark does not arise.

30. In **Ultra Tech Cement Limited v. Alaknanda Cement Pvt. Ltd.**⁷, this Court has observed as under:

"32. The Defendants have next relied on Section 17 of the Trade & Marks Act, 1999 in support of their contention that the registration granted to the plaintiff does not confer any exclusive right in the matter "ULTRA" and "ULTRATECH" which form only a part of the whole of the plaintiff's registered trade mark. Section 17 of the Act is for the sake of convenience reproduced here under:-

"17. (1) When a trade mark consists of several matters, its registration shall confer on the proprietor exclusive right to the use of the trademark taken as a whole.

(2) Notwithstanding anything contained in sub-section (1), when a trade mark -

(a) contains any part -

(i) which is not the subject of a separate application by the proprietor for registration as a trade mark; or

(ii) which is not separately registered by the proprietor as a trade mark; or

(b) contains any matter which is common to the trade or is otherwise of a non-distinctive character;

The registration thereof shall not confer any exclusive right in the matter forming only a part of the whole of the trade mark so registered."

33. From the language used in Section 17 it is clear that when a trade mark consists of several marks the registration confers upon the proprietor exclusive rights to the use of trade mark taken as a whole. As held in the aforesaid decisions while comparing the marks, the Court has to consider and compare the essential features of both the marks. If the essential features are similar, then confusion and deception can be said to arise. As submitted by the plaintiff, all that Section 17 lays down is that the registration of a trade mark shall not confer any exclusive rights in the matter forming only a part of the whole of trade mark so registered unless the part is the subject matter of a separate application for registration or is separately registered or is distinctive. The provisions of Section 17 contained in Sub Section 2(a)(i) and 2(a)(ii) and Sub Section (b) show that the three things mentioned therein are disjunctive and not cumulative. In the present case the word ULTRATECH is distinctive. As submitted by the plaintiff the fact that the plaintiff's mark is registered without any disclaimers or limitations itself shows that the word ULTRATECH is a distinctive mark and the plaintiff have satisfied the criteria laid down in Sections 9 and 11 of the Trade & Marks Act, 1999. Therefore in the present case though the word ULTRATECH is not separately registered nor is a subject of a separate application, the same being distinctive shall not be hit by Section 17(2) as submitted by the defendants. Both the Ld. Advocates have relied on various paragraphs of the decision of the Calcutta High Court in the case of Three-N Products Private Ltd., V. Emami Ltd., GA Nos. 2951 and 3976 of 2007 and CS No.204 of 2007, Paragraph 35 of the said decision is relevant and is reproduced hereunder:

⁷ 2011 (4) AIR Bom R 612

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

34. In view thereof, the defendants' contentions/arguments with regard to reliance on section 17 of the Trade Marks Act, is misplaced."

31. The Defendant claims that the Plaintiff can seek no right in the mark "SUPREME" as the word is descriptive. The fact that the Defendant has applied for and has been granted registration in respect of its mark containing the word "SUPREME" estops the Defendant from contending that the registered trade mark "SUPREME" is descriptive. In ***Pidilite Industries Limited vs Jubilant Agri & Consumer Products Limited***⁸, this Plaintiff's mark was Fevicol Marine and injunction was sought against use of the mark Jivanjor Marine plus. The main defence taken was that the word Marine was descriptive, devoid of any distinctive character and is incapable of being claimed to be trade mark of the Plaintiff even though forming part of the registered trade mark. The Court held in paragraph 10.3 and 10.4 as under:

"10.3 The Defendant has submitted that there are several products available in the market containing the mark 'MARINE'. However, the Defendant has been unable to show the sales of the other 'MARINE' products. Therefore, the extensive and continuous sales of the Plaintiff's 'MARINE' products/use of the 'MARINE' mark has to be seen in the backdrop of the fact that the Defendant has been unable to place before this Court sufficient material to show any significant sales of other 'MARINE' products. Consequently as submitted by the Plaintiff, the position that emerges is that the Plaintiff was the only one who was manufacturing and/or selling products (of any significant volume) with the 'MARINE' trademark. Resultantly, a person who wanted the 'MARINE' adhesive would ask for 'MARINE' and not 'FEVICOL MARINE' as there was no other 'MARINE' branded products in the market for him to need the addition of the prefix 'FEVICOL' to distinguish one 'MARINE' from the other. The Plaintiff has also correctly submitted that when a customer goes to a shop to buy biscuits depending on what he wants, he simply

8 2014 SCC Onl Bom 50

asks for them by their product identification mark/brand or sub-brand e.g. 'Marie' or 'Monaco' or 'Goodday' or 'Krackjack' or '50:50' or 'Maska Chaska'. He does not preface it with the name of the manufacturer i.e. Parle or Britannia.

10.4 In the circumstances, it is clear that by reason of open, continuous and extensive sales over a period of about nine years, the mark 'MARINE' either by itself or as a component/constituent of the registered trademark 'FEVICOL MARINE' has acquired a secondary meaning/further distinctiveness and has become exclusively associated with the Plaintiff."

32. The registration of the Plaintiff's label mark "SUPREME" containing only the word "SUPREME" without any disclaimer shows that the Plaintiff has passed the test of its mark being distinctive. The Defendant himself having applied and granted registration of the impugned mark containing the word "SUPREMES" cannot be heard to contend that there are substantial trade names incorporating the word SUPREME as part of their trade name. Apart therefrom, there is no material produced on record by the Defendant to support the contention that the word SUPREME is in such extensive use so as to become *publici juris*. It is also well settled that the Plaintiff is not expected to go behind every infringer. The existence of several other trade names incorporating the word "SUPREME" cannot obstruct the Plaintiff in seeking interim injunction against the Defendant.

33. In so far as copyright infringement is concerned, the Plaintiff has subsisting right in the original artwork secured by copyright registration and the Defendant's mark is substantial reproduction of the Plaintiff's original artwork. There are no submissions canvassed by Mr. Sharma in respect of copyright infringement.

34. In a recent decision of **Pernod Ricard India Private Limited and Ors. vs. Karanveer Singh Chhabra Trading⁹**, the Hon'ble Apex Court summarized the legal principles governing the infringement of trade mark and passing off. In so far as the action of passing off is concerned, the Hon'ble Apex Court noted that 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 and key distinction between the two lies in the requirements of proof. It held that 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. It held that an intent to deceive is not a necessary element nor actual deception or damage be proved but proof of likelihood of confusion or deception is required. It also held 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. Passing off is grounded in equitable principles and imposes a higher evidentiary burden to safeguard commercial goodwill under common law.

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35. It is trite that passing off action is a tortious action of deceit and injunction against passing off cannot be granted for asking. The Plaintiff had conceived and adopted the mark "SUPREME" since the year 1987 and the invoice of the year 1993 is produced on record, which shows use of the mark atleast since the year 1993. The sales turnover and the advertisement expenses for the year 2023-2024 is in excess of Rs 10,000 crores and Rs 140 crores respectively, which shows the enormous sale of the Plaintiff's product bearing the registered trade mark. The substantial sales demonstrates the goodwill and reputation of the Plaintiff and *prima facie* asserts that the registered trade mark of the Plaintiff is associated by the general public with the Plaintiff's goods. The Defendant has not justified as to how it adopted a mark which is deceptively similar to the Plaintiff's registered trade mark in respect of identical goods. The application for registration of the Defendant's mark is filed on 24th November, 2021 on proposed to be used basis. The Defendant is a late entrant in the market and there is no pleading that search was conducted of the trade mark registry before seeking registration of its mark. The Defendant has designed its mark in a manner so as to convey an impression that the goods of the Defendant are that of the Plaintiff. In absence of any explanation denoting the honest and bonafide adoption of the impugned mark, it can be *prima facie* held that the adoption was for unjust enrichment at

the cost of the Plaintiff. The Plaintiff has *prima facie* made out case for passing off.

36. In so far as the objection raised that the Plaintiff has suppressed the fact of refusal of registration of the word mark, *prima facie* the device mark of the Plaintiff containing the word "SUPREME" is the mark of which the infringement is claimed. The refusal of the registration of the word mark "SUPREME" does not assist the case of the Defendant as (a) the Plaintiff has secured registration of its mark "SUPREME" and its formative of which SUPREME forms the essential feature and (b) there is no case of prosecution history estoppel pleaded.

37. In light of the above, *prima facie* case of infringement of trade mark, copyright and passing off is made out. Interim Application is made absolute in terms of prayer clause (a), (b) and (c).

(SHARMILA U. DESHMUKH, J.)