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

COMMERCIAL APPEAL (L) NO. 10963 OF 2021

IN

INTERIM APPLICATION (L) NO. 8940 OF 2020

IN

COMMERCIAL IP SUIT (L) NO. 8936 OF 2020

Meher Distilleries Private Limited  
a Company incorporated under the  
Companies Act, having its registered  
office at 2<sup>nd</sup> Floor, GRD, Plot-1/283,  
Ratnanbad CHS, Jahangir Bagi Street,  
Khatuawadi, Bhatia Hospital, Grant  
Road, Mumbai- 400 007, Maharashtra.

AND

having its factory at Village Aswa,  
Taluka- Dahanu, Pin- 401 602,  
District Palghar, Maharashtra.

... Appellant

V/s.

1. SG Worldwide Inc.  
an entity organised under the laws of  
The United States of America, having its  
place of business at Edison, N.J., USA.
2. Radico Khaitan Ltd.  
A Company incorporated under the  
Companies Act, 1966 having its registered  
office at Bareli Road, Rampur- 244 901,  
Uttar Pradesh.  
AND  
having its Corporate Office at Plot No.J-1,  
Block B-1, Mohan Co-operative Industrial  
Area, Mathura Road, New Delhi- 110 044. ... Respondents.

Dr. Birendra Saraf, Senior Advocate a/w. Mr. Ashutosh Kane, Ms. Apurva Gupte, Mr. Nikhil Sharma and Ms. Merin Mathew i/b W. S. Kane & Co. for the Appellant.

Mr. Sharan Jagtiani, Senior Advocate a/w. Mr. Hiren Kamod, Mr. Mahesh Mahadgut, Mr. Rohit Bandekar, Mr. Prem Khullar, Ms. Poonam Teddu, Mr. Kaivalya Shete, Ms. Ishani Chandra, Mr. Sagar Chandra, Mr. Raghu Singh i/b Mr. Mahesh A. Mahadgut for the Respondents.

**CORAM :**            **NITIN JAMDAR AND**  
**C. V. BHADANG, JJ.**  
**(Through Video Conferencing)**

**RESERVED ON :**            **28 July 2021**  
**PRONOUNCED ON :**        **23 August 2021**

**JUDGMENT:**    (Per Nitin Jamdar, J.)

The Appellant-Meher Distilleries is a registered proprietor of the trademark *THE ASWA* for the class alcoholic beverages. Respondent No.2- Radico Khaitan launched a product in the same class, a single malt whiskey, using the mark *ASĀVA*. Appellant filed a commercial suit for trademark infringement and took out an interim application to restrain the Respondents from using *ASĀVA* as a trademark. The learned Single Judge by the impugned order dismissed the interim application. Challenging the judgment and praying for a restraint order, Appellant has filed this commercial appeal under Section 13 of the Commercial Courts Act, 2015.

2. The Appellant-Meher Distilleries is referred to as the Plaintiff. HG Worldwide Corporation as Defendant No.1 and Radico Khaitan Limited as Defendant No.2.

3. Plaintiff produces and deals with alcoholic beverages. The distillery of the Plaintiff is in village Aswa in Dahanu Taluka of Palghar District in the State of Maharashtra. On 11 April 2014, Plaintiff applied for registration of the trademark *THE ASWA* under the Trade Marks Act, 1999(the Act). The application was granted in the year 2016, and Plaintiff got registration of the trademark *THE ASWA* under Registration No.2716867 in Class-33 in respect of whiskey, vodka, brandy, rum, gin, wine, alcoholic coolers, alcoholic mixes, country liquor. Plaintiff was researching before launching the product. Plaintiff sought permission to use the label with trademark *THE ASWA* as per the State Excise Rules and was granted the same on 18 August 2020.

4. Plaintiff came to know that Defendant No.2 was manufacturing and exporting a single malt whiskey to Defendant No.1 under the trademark *ASĀVA*. The Excise Department approved Defendant No.2's label for the product in question on 3 September 2020. Defendant No.1-HG Worldwide United States imports and markets alcoholic beverages from Defendant No.2. Plaintiff filed Commercial I.P. Suit No.8926/2020 on 11 December 2020, joining Defendant Nos.1 and 2 as party defendants. The

Plaintiff contended that the Defendants trademark *ASĀVA* is identical/deceptively similar to the Plaintiff's trademark *THE ASWA*, the goods in respect of which the Defendants are using the trademark are identical to the goods in which the Plaintiff has registered the trademark, and it will likely to cause confusion on the part of the public or is likely to have an association with the registered trademark. Plaintiff alleging infringement sought prayer for restraining the Defendants from using the mark *ASĀVA*. Plaintiff also sought damages.

5. Plaintiff took out Interim Application (L) No.8940/2020 wherein the averments and grounds taken in the plaint were reiterated. The Plaintiff prayed that the Defendants be restrained from infringing the Plaintiff's registered trademark *THE ASWA* bearing Registration No.2716867 in Class 33, by using the impugned trademark *ASĀVA* and any other trademark identical with or deceptively similar to the Plaintiff's registered trademark *THE ASWA* in relation to alcoholic beverages including single malt whiskey and any other goods which similar to the goods in relation to which the Plaintiff had the registration for the trademark *THE ASWA*. Plaintiff also sought the appointment of receiver and to seize and take charge, possession and control of the goods bearing the trademark *ASĀVA*.

6. Plaintiff moved for an *ex parte* ad-interim before the learned Single Judge on 14 December 2020. The learned Single

Judge directed the Plaintiff to give notice to the Defendants and, accordingly, the Defendants were served.

7. Defendant No.2 filed its reply, briefly stating as follows. Defendant No. 2 was earlier known as Rampur Distillery, which was established in the year 1943 and, in the year 1992, it adopted house/ trademark "RADICO" and has launched various products. The word *ASĀVA* is a Sanskrit term meaning an alcoholic beverage or fermented drink, and it has been adopted bonafide by Defendant No.2. It is stated that *Asav* means wine in Hindi, and *Asav / ASĀVA* are herbal fermentation of traditional Ayurvedic system which are alcoholic medicaments. It also means Ayurvedic Medicated Wine. The term *ASĀVA* is always used in conjunction with mark *RAMPUR* as a particular type of single malt whiskey. Defendants No.2's mark is '*RAMPUR ASĀVA*', and its adoption is bonafide. Plaintiff has suppressed the trademark application filed by it to register the word mark *ASĀVA*; thus, Plaintiff acknowledges that *ASWA* and *ASĀVA* are different. Defendant No.2 has adopted the mark '*RAMPUR ASĀVA*' since January 2020 and is being used since August 2020. The label bearing mark '*RAMPUR ASĀVA*' for export is approved by the Excise Department on 3 September 2020. *RAMPUR ASĀVA* is available in the international market. Defendant No.2 has won various awards for their Indian single malt whiskey sold under the trademark *RAMPUR*. Defendant No.2 has been using the expression "*ASĀVA*" along with the trademark

RAMPUR openly, continuously and extensively and has generated substantial sales. Defendant No.1 SG Worldwide Inc. is an entity incorporated in the United States of America. It has supported Defendant No.2, and the main contesting Respondent in the appeal is Defendant No.2.

8. Plaintiff filed an affidavit in rejoinder on 11 January 2021 in response to the Defendants' reply. The contention that *ASĀVA* is a Sanskrit word that means an alcoholic beverage was denied. The contention that the expression *ASĀVA* used in a suggestive sense is not correct. It was reiterated that using the word RAMPUR along with *ASĀVA* will make no difference as the same is identical and deceptively similar with Plaintiff's registered trademark "*THE ASWA*". Plaintiff applied for registration of *ASĀVA* for better protection. On these and other grounds the Plaintiff refuted the assertions of the Defendants.

9. The learned Single Judge considered Plaintiff's application for an injunction. The learned Single Judge concluded that Plaintiff has not made out a case for grant of injunction. The learned Single Judge in the impugned order gave the reasons for the conclusion as follows. The words '*THE ASWA*' and '*ASĀVA*' are not visually, phonetically or structurally similar. The Defendants have not used the word '*ASĀVA*' as a trademark. *ASĀVA* suggests the manner of maturing or finishing the whiskey as a transliteration of the Sanskrit word '*ASAV*' and '*ASĀVA*'. The mark consists of the

words ‘RAMPUR’ and ‘ASĀVA’ used together. In the packaging and the manner of writing on the label, RAMPUR is given more prominence. Plaintiff has so far not used the mark, and that is a relevant factor. Plaintiff has suppressed the fact that it has applied for registration of the mark ‘ASĀVA’. The application for registration by Plaintiff is an admission by Plaintiff that ‘ASWA’ and ‘ASĀVA’ are not deceptively similar, and the filing of the application operates as estoppel against Plaintiff from contending to the contrary. Accordingly, the learned Single Judge, by the impugned order dated 17/18 February 2021, 18 & 22 March 2021, dismissed the application for an injunction and directed the Plaintiff to pay the cost of Rs.12,56,000/- to the Defendants. Being aggrieved, Plaintiff is before us with this Appeal under Section 13 of the Commercial Courts Act.

10. We have heard Dr. Birendra Saraf, learned Senior Advocate for the Plaintiff and Mr. Sharan Jagtiani, learned Senior Advocate for the Defendants. The appeal is admitted. Defendants waive service of notice after admission. As per the order passed on 15 July 2021, directing that appeal will be heard finally, is taken for disposal.

11. Though the learned Counsel have argued the matter at length, we find, with respect, that crucial findings in the impugned order are arrived at by applying incorrect tests and analysis of facts of the case in various critical areas is missing. There is a need to remand

the matter after referring to the law governing the correct tests to be applied and facets where factual findings are necessary. We now proceed to elaborate on these aspects.

12. Plaintiff's mark is registered for Class-33, which includes alcoholic beverages. Defendants are also using the mark in manufacturing and dealing with alcoholic beverages in Class-33 in its trade.

13. The case of Plaintiff is that action of Defendants in using the mark *ASĀVA*, which is identical or deceptively similar (especially phonetically) to the Plaintiff's trademark *ASĀVA*, violates its rights acquired by it by way of registration under the Act and the case under Section 29 of the Act is made out. According to the Defendants, no such infringement case as envisaged under Section 29 of the Act is made out. According to the Defendants, the moot question is the identity of the mark used by Defendant No.2 regarding the goods in question. According to them, the mark used by them is *RAMPUR ASĀVA* and not *ASĀVA* alone. Plaintiff responds that *ASĀVA* is used as a trademark by Defendant No.2, and merely adding *RAMPUR* will not prevent infringement of Plaintiff's registered mark.

14. Defendants firstly contended that the entire case of the Plaintiff is by placing emphasis on deceptive similarity and the likelihood of confusion between *THE ASWA* and *ASĀVA* and



having come to the Court with that case with no other pleadings and if it is shown that the mark used by the Defendant No.2 is *RAMPUR ASĀVA*, then the entire case of the Plaintiff must fall for lack of pleadings.

15. We have examined the pleadings of Plaintiff in the context of this opposition. In the plaint, Plaintiff has referred to registration and the background of registration of its mark. The plaint is not elaborate, and it does not need to be so in law. The plaint is in 21 paragraphs. The first few paragraphs are descriptions, and the latter paragraphs are formal paragraphs and prayers. In paragraph 9, Plaintiff has stated that Defendant No.2's impugned trademark *ASĀVA* is identical with the registered trademark of Plaintiff *THE ASWA*. After stating so, Plaintiff has stated that- "*the use of word RAMPUR in the trademark of Radico does not and cannot save infringement of the registered trade mark THE ASĀVA*". Order 6 of the Code of Civil Procedure deals with the pleadings. Order 6 Rule 2 states that every pleading shall contain only a concise format of material facts and not the evidence. The purpose and object of pleadings is to enable the other side to know the case. The courts read the plaint as a whole to understand the case of the parties. Paragraph 9 of the plaint clearly refers to both cases. First, that there is a deceptive similarity between *THE ASWA* and *ASĀVA*. Second, even if *RAMPUR* is added, it cannot avoid infringement. Therefore, this objection of Defendants has no merit.

16. In this regard, the reasoning in impugned order needs to be noticed. The paragraphs-1 to 6 of the impugned order refers to brief facts and reproduces Section 29 and paragraph-9 of the plaint. In paragraph-7, the learned Single Judge has observed that the first test is whether or not there is any similarity between the Plaintiff's registered mark "*THE ASWA*" and the Defendants' mark "*ASĀVA*". Then in paragraph-8, the learned Single Judge referred to the provenance of these two words and the Plaintiff's case that Aswa is the name of a village in Dahanu Taluka, where its factory is located and the case of the Defendants that the word *ASĀVA* is not geographic but is a transliteration into English of a Sanskrit word. Then in paragraph-9, the learned Single Judge outlined the structure of the case and observed that if there is no similarity between the rival marks, then the matter ends there itself, and if there is any oral, phonetic or structural similarity, however slight, then it needs to be decided against the parameters of Section 29. In paragraph-10, it is stated that the first issue of similarity is sufficient to close the matter. The learned Single Judge, in paragraph-15, referred to the submission of law that *ASĀVA* is a sub-brand. Second, it is used with the word *RAMPUR* and *RAMPUR* is the mark and *ASĀVA* is only suggested of manner of maturing the whiskey. The learned Single Judge then has observed that the word *ASĀVA* is used by Defendant No.2 to distinguish one product from the other under the name *RAMPUR*. Thus impugned order accepts the Defendants contention that the words *RAMPUR* and *ASĀVA* cannot be

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separated, and they have been used together and have to be read as a whole. According to the learned Single Judge, there is no similarity between the two marks and the discussion regarding the likelihood of confusion was superfluous.

17. Defendants rely on the material on record to demonstrate that *RAMPUR* and *ASĀVA* have always been used together. The material is emails about designing a banner in a trade fair, emails for printing labels, emails for purchase orders of Defendant No.2, and internal emails of Defendant No.2 containing the description trading invoices relating to export showing the product. Approval from Excise Department Uttar Pradesh to use the mark for export, print out from web pages for media coverage of the launch and screenshots from international online liquor stores. Defendant No.2 has placed the photographs of the goods in question depicting the bottle and the casing on record. Based on this material, Defendants contends *ASWA* has never been used separately from *RAMPUR*; even the third party referred to it as *RAMPUR ASĀVA* and not *ASĀVA* alone. Plaintiff, in response, contends that it is not that these words are merged like *RAMPURASĀVA*, but used separately even in all this material, and these are not used in conjunction and cannot be considered as one mark.

18. We have examined the material and the photographs of the bottle and the case. In the invoices and emails, *RAMPUR* and *ASĀVA* (many places *ASAVA* without macron) is used. The bottle

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of ASĀVA is kept in a cylindrical box. On the top rim, there is a  
golden colour strip. Below it, there is a symbol of RAMPUR  
Distilleries with two crossed swords. Below that, there is the word  
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RAMPUR then a divided line, and below it are the words "Indian  
Single Malt Whiskey Non-Chill Filtered". Then there is another  
dividing line, and below it, there is the word "ASĀVA". On both  
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sides of the word ASĀVA, there is text in a small script. Below the  
word ASĀVA, there are words "Cabernet Sauvignon". Below that,  
there is some text in a small script. Below that, there is another  
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symbol. The words "RAMPUR" and "ASĀVA" are more or less of  
the same size. A similar depiction appears on the bottle of the  
whiskey, except that the label background is of light colour.  
Defendant No.2 has not used the mark as *RAMPURASĀVA* with  
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these two words joined. It is not, of course, necessary to examine if,  
even in that situation, there would be infringement, as that is a  
hypothetical situation for the present case. Therefore at the most, it  
could be said that both words RAMPUR and *ASĀVA* feature on the  
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product.

19. Defendants in the Reply have taken a stand that the  
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term *ASĀVA* is a descriptor /sub-brand of a particular type of single  
malt whiskey. Then it is stated that this term is only suggestive of a  
nod to the Indian character and the quality of whiskey stored in an  
Indian wine cask, indicating it as a description. In Paragraph 7 of  
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the Reply, it is stated that Asav means wine, and Asava is self-  
generated herbal fermentation of alcoholic medicaments. It also

stated that information in the public domain shows that Asava means ayurvedic medicated wine. Then in paragraph 10, it is stated as under:-

*"10. I say that the term 'ASAVA' was added to the trademark and brand 'Rampur' of Defendant No.2 as a descriptor of a sub-brand/ particular type of Single Malt whisky. I say that the use of the word 'ASAVA' is only in a suggestive sense as Defendant No.2 is uniquely maturing/finishing its whisky in Indian Wine Casks, which are used for making Indian wine using Indian Grapes. I say that these Indian ingredients impart a certain uniqueness that gets transferred to Defendant No.2's Malt during the finishing process. Therefore, I say that this usage of the term 'ASAVA' is only suggestive of the expression of the Single Malt of Defendant No.2 as a nod to the Indian character and quality of the whiskey being stored in Indian Wine Casks. I say that the term 'ASAVA' is used by Defendant No.2 in conjunction with its trademark 'RAMPUR' removing all likelihood of confusion with any other mark. I say that the mark 'RAMPUR ASAVA' has been adopted and used bonafide by the Defendant No.2."*

*(emphasis supplied)*

The impugned order refers to both these versions of Defendant No.2. In the impugned order, there is a reference in paragraph-14 as the case of Defendant No.2 being ASĀVA a Sanskrit word. In paragraph-15, there is a reference to ASĀVA being a sub-brand and also that it is suggestive of a manner of maturing or finishing the RAMPUR whiskey. There is, therefore, no clarity as to the case of Defendant No.2 as to whether the word ASĀVA is a sub-brand to narrow down within the range of RAMPUR single malt whiskey, or it is a description of the kind that it falls in any class under Section 30(2)

(a) of the Act. Plaintiff had shown to us judicial pronouncements where terms description and descriptor are used interchangeably.

20. On the version that *ASĀVA* is used as a description of the process or quality, Defendant No.2 has stated that *ASĀVA* means self-generated herbal fermentation for alcoholic medicament. Defendant No.2 has launched four products, i.e. *RAMPUR Sherry PX Finish*, *RAMPUR Vintage Select Casks*, *RAMPUR Double Cask* and *RAMPUR ASĀVA*. The first three, i.e. Sherry PX Finish, Vintage Select Casks and Double Cask, are not unique words. They refer to a process, type or quality. On Defendants own showing the word *ASĀVA* is a Sanskrit word. If *ASĀVA* is used to denote the process of herbal fermentation, its meaning will have to be clear to the average consumer. McCarthy on “*Trademarks and Unfair Competition*” (2019, 5<sup>th</sup> Edition), while dealing with obscure terms, has given the example of word ‘*origan*’, an old English word, meaning a wild ‘marjoram’ flower and has observed that such a phrase would be known only to botanist and not to an average consumer. Thus the test to be applied that for a word *ASĀVA* to be taken as a description of a process or quality, it ought to have been in a language that the average consumer understands. However, it is unnecessary to labour on this point as the Defendants in the oral arguments have, apart from faintly suggesting that *ASĀVA* is an indicator of process or quality, has not elaborated it. In fact, the Defendants' contention before us is that Plaintiff has wrongly interpreted the Defendants'

defence as *ASĀVA* being a description that is not, but it is a descriptor. Therefore, Section 30(2)(a) of the Act also does not come into play.

21. The Defendants contend that *ASĀVA* is a descriptor to identify the product within the Rampur Range. In paragraph 22 of the Reply, the Defendants referred to Rampur single malt whiskey sub-brands, such as Rampur PX Sherry Finish and Rampur Vintage Select Casks Rampur Double Cask and Rampur Asava. Para 23 of the impugned order notes that *ASĀVA* is used to distinguish one product from another under the RAMPUR mark. Further, in para 33, the impugned order suggests that a discerning consumer will first go by the house name RAMPUR and the word *ASĀVA* would facilitate drilling down within the RAMPUR range of single malt whiskeys. Plaintiff contends that if the *ASĀVA* is a descriptor/sub-brand as something that will identify the product in the range, it will be a trademark unless it falls within the class referred to in Section 9 of the Act. Plaintiff contends that sub-brand is a trademark in itself and relies upon the decisions of the Supreme Court and this Court to buttress its contention.

22. Section 2(1)(m) of the Act defines Mark as follows.

*"mark" includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof;*

Thus a “mark” includes various concepts such as devices, brands and

words. A trademark, is defined in section 2(1)(zb) to mean:

*(zb) "trade mark" means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours; and--*

*(i) in relation to Chapter XII (other than section 107), a registered trademark or a mark used in relation to goods or services for the purpose of indicating or so as to indicate a connection in the course of trade between the goods or services, as the case may be, and some person having the right as proprietor to use the mark; and*

*(ii) in relation to other provisions of this Act, a mark used or proposed to be used in relation to goods or services for the purpose of indicating or so as to indicate a connection in the course of trade between the goods or services, as the case may be, and some person having the right, either as proprietor or by way of permitted user, to use the mark whether with or without any indication of the identity of that person, and includes a certification trademark or collective mark;*

*(emphasis supplied)*

It is also relevant to note Section 9 of the Act, which lays down the absolute grounds for refusal to register a trademark. Section 9 reads thus :-

***“9. Absolute grounds for refusal of registration.— (1) The trademarks—***

- (a) which are devoid of any distinctive character, that is to say, not capable of distinguishing the goods or services of one person from those of another person;*
- (b) which consist exclusively of marks or indications which may serve in trade to designate the kind, quality,*



- quantity, intended purpose, values, geographical origin or the time of production of the goods or rendering of the service or other characteristics of the goods or service;*
- (c) *which consist exclusively of marks or indications which have become customary in the current language or in the bonafide and established practices of the trade,*

*shall not be registered:*

*Provided that a trademark shall not be refused registration if before the date of application for registration it has acquired a distinctive character as a result of the use made of it or is a well-known trademark.*

- (2) *A mark shall not be registered as a trademark if—*
- (a) *it is of such nature as to deceive the public or cause confusion;*
- (b) *it contains or comprises of any matter likely to hurt the religious susceptibilities of any class or section of the citizens of India;*
- (c) *it comprises or contains scandalous or obscene matter;*
- (d) *its use is prohibited under the Emblems and Names (Prevention of Improper Use) Act, 1950 (12 of 1950).*
- (3) *A mark shall not be registered as a trademark if it consists exclusively of—*
- (a) *the shape of goods which results from the nature of the goods themselves; or*
- (b) *the shape of goods which is necessary to obtain a technical result; or*
- (c) *the shape which gives substantial value to the goods.*

*Explanation.—For the purposes of this section, the nature of goods or services in relation to which the trademark is used or proposed to be used shall not be a ground for refusal of registration.”*

23. Question that arose for consideration was whether the word marks *RAMPUR* and *ASĀVA* are trademarks in law and, if so, the implications. The impugned order states that it is true that an

identified range may be a trademark, but it must be shown that it is used as a distinctive mark as its own and that not all sub-brands are trademarks. However, there is no finding or reasoning with reference to the facts and pleadings as to why the sub-brand in question is not a trademark. We do not find any reference in the impugned order to the legal position and the pleadings of Defendants themselves, which Plaintiff emphasized before us.

24. The case of Defendant No.2, as pleaded in the reply, is that term *ASĀVA* was added to the trademark and brand *RAMPUR* as a descriptor of a sub-brand/particular type of single malt whiskey. The impugned order has also referred that mark *ASĀVA* is to identify amongst variants of *RAMPUR* mark. If the case of the Defendants themselves that “*ASĀVA*” is being used for identifying their product, albeit a drilled down or two-step process as called, it is capable and used in aid of distinguishing the goods in question. If a mark is not used as a description of the process; but to narrow down the product within the range, then it is used for the "purpose of indicating" as envisaged under Section 2(1)(zb) unless it falls in some of the well-settled parameters such as common to trade or a description. Section 9 of the Act refers to the absolute ground for refusal of registration. It is not found from the Defendants' case that the mark *ASĀVA* falls in any of the categories in Section 9 of the Act. The Defendants pleadings indicate that the mark *ASĀVA* is in the aid of distinguishing the Defendants' product. Defendants do

not contend that *ASĀVA* is a description as contemplated in law, nor is it common to trade. The impugned order does not note these aspects and also that it could be a unique word for the average consumer and is that the pleadings demonstrate that it used to identify the Defendants product.

25. It had to be examined whether the mark *ASĀVA* is used in the course of trade by Defendant No.2 to indicate a connection between the trade and the person and its goods to ascertain whether it is a trademark. The test to be applied is not the infringer's terminology but whether the use of a mark is to distinguish or it is capable of distinguishing the goods or services of a person or used for the "purpose of indicating" to fall under Section 2(1)(zb).

26. Therefore, merely because Defendant No.2 uses both the words *RAMPUR* and *ASĀVA* on the product, straightaway it could not have been concluded that they constitute one trademark. It had to be seen whether that they have their own uses in the identification process as per the case of the Defendants themselves. This line of enquiry is missing from the impugned order.

27. In *Hem Corporation Pvt. Ltd. v. ITC Ltd.*<sup>1</sup>, the learned Single Judge of this Court considered the implications of Section 2(1) (zb) read with Section 29 of the Act. In this case, the plaintiff was a registered proprietor of the words "MADHUR" and

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1 2012 SCC Online Bom 551

"MADHUR GULAB". The defendants argued that MADHUR alone was not its trademark, but it was used with its umbrella brand MANGALDEEP. An attempt was made to show that MANGALDEEP was more prominent than MADHUR. The learned Judge held that a case of infringement was made out. The relevant paras from the decision are as follows.

*“23. The defendant contended that its agarbattis are sold under the mark and its various variants containing descriptive sub-brands such as “MOGRA”, “JASMINE”, “SANDALWOOD”, “MADHUR” and “MADHUR 100”; that “MANGALDEEP” is the umbrella brand and that it uses this brand in conjunction with descriptors such as “MADHUR” and “MADHUR 100” and that the descriptors are used to signify the quality and characteristics of the products and are used only in conjunction with the umbrella brand “MANGALDEEP”.*

*24. Even assuming that the defendant genuinely intended using the mark only to describe the aroma of the products, it would make no difference if the use of the mark is likely to be taken as being used as a trademark. Dr. Tulzapurkar's reliance upon section 29(1) and section (2)(zb)(ii) of the Trade Marks Act, 1999, is well-founded. Sections 29(1) and 2(zb)(ii) read as under :-*

*“29. Infringement of registered trademarks.- ...*

*.....*

*2. Definitions and interpretation.-(1) .....*

*.....*

*(zb) ...*

*(ii) ...*

*25. The intention to use a mark as a trademark is not the only factor that constitutes infringement. A registered*

*trademark is infringed by a person if he uses it in such a manner as to render the use of the mark likely to be taken as a trademark. In other words, the use of a registered trademark would constitute an infringement if it indicates a connection in the course of trade between the person and his goods or services irrespective of his intention. This is clear from the phrase in section 2(1)(zb)(ii) “for the purpose of indicating or so to indicate”.*

*(emphasis supplied)*

Thus the Court observed that even assuming that the defendant generally intended to use the mark to describe the product's aroma, it would be of no difference if the use of the mark is taken as the use of a trademark.

28. The position that a house mark/brand and the product mark/sub-brand have their own uses is made clear by the learned Authors- K.C. Kailasam and Ramu Vedaraman in the book *Law of Trade Marks*. A passage from the Book is quoted with approval by the Supreme Court the decision of *CCE v. Kalvert Foods*<sup>2</sup> as under.

34. *In the book Law of Trade Marks by K.C. Kailasam and Ramu Vedaraman the distinction between “product mark” and “house mark” has been beautifully delineated, which is as under:*

*“It is possible that the proprietor may use several trade marks in respect of his goods (known as product mark), besides using a common mark in all his products to indicate the origin of the goods from the enterprise (known as house mark). This practice is more predominant in the pharmaceutical trade.*

Though both are trade marks and are registerable as such, each has its own distinct function. While the house mark represents the image of the enterprise from which the goods emanate, the product mark is the means by which goods are identified and purchased in the market place and it is the focal point of presentation and advertisement.”

(emphasis supplied)

This clearly shows that both, house mark and product mark/sub-brand have their independent uses. The impugned order has proceeded on the premise that *ASĀVA* is not used as a trademark without considering this position of law and the tests to be applied. There is no reasoning in the impugned order as to why *ASĀVA* cannot be considered as a trademark by itself to support the conclusion.

29. Second fundamental error that has occurred in the impugned order is while ascertaining the identity/similarity of the mark *ASĀVA* with the registered trademark of Plaintiff *THE ASWA*. The case of the Plaintiff in that regard is paragraph 9 of the plaint, which reads thus:-

“9. The Plaintiff says and submits that the Defendants’ impugned trademark “ASAVA” is almost identical with, especially phonetically, or closely and deceptively similar to the Plaintiff’s registered trade mark “THE ASWA” bearing Registration No. 2716867. The goods in respect of which the Defendants are using the impugned trade mark are also identical with the goods in respect of which the Plaintiff has secured the registration of its said trade

*mark. Therefore, the use of the impugned trade mark by the Defendants in relation to the impugned goods is likely to cause confusion and deception on the part of the public which includes likelihood of association of the impugned trade mark with the Plaintiff's said registered trade mark. ...The Plaintiff submits that the use of the word "Rampur" in the impugned trade mark by the Defendants does not and cannot avoid infringement of the Plaintiff's registered trade mark "THE ASWA". ..."*

Thus, this is, with the underlined portion(by us), the case of Plaintiff.

30. In paragraph 22 of the impugned order, the learned Single Judge considering the case phonetic similarity with Plaintiff's case of stating *THE ASWA* against *ASĀVA* has observed thus:

*22. But let us take Plaintiff's case at its highest and at its optimal and set THE ASWA against ASĀVA. The fact that there are three common letters — one vowel repeated twice and one consonant — does not necessarily mean that there is either structural, phonetic or visual similarity. THE ASWA is bisyllabic. ASĀVA is carefully rendered with a diacritical mark over the 'A' — Ā — to indicate the AH sound. Thus, the emphasis is on the middle of three syllables: ahs-AH-VA. Therefore: I find no structural similarity. I find no visual similarity. I find no phonetic similarity.*

These are the only observations on the aspect of phonetic similarity. With these observations, the learned Single Judge found the marks are not identical or deceptively similar. In paragraph 25, the learned Single Judge observed that because of this conclusion, the matter ends, and other aspects were considered though not necessary. So

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the primary finding in the impugned order is that *THE ASWA* and *ASĀVA* have no structural, phonetic or visual similarity.

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31. The observations in paragraph-22 of the impugned  
order that the rival marks are not phonetically similar because the  
word *ASĀVA* is carefully rendered with a diacritical mark and  
emphasis is on the middle of three syllables produces a different  
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sound, finds no reference in the pleadings of Defendants. There is  
no claim in the Defendants' pleadings that the word *ASĀVA*, in view  
of a diacritical mark, produces a different sound than *ASWA*. We do  
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not find from the reply of Defendant No.2 that they have tried to  
put forward a case that the use of macron (diacritical mark) makes  
"*ASĀVA* " phonetically different from *ASWA*. Plaintiff has placed  
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the definition of macron from Collins Dictionary on record to  
contend that by use of macron, the sound of an alphabet will become  
double AA and not AH.

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32. In a series of judicial pronouncements, guidance is  
provided as to how the courts should examine the aspect of phonetic  
similarity. In the case of *Aristoc Ltd. v. Rysta Ltd.*<sup>3</sup>, the House of  
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Lords considered the marks 'Rysta' and 'Aristoc'. While holding that  
they were phonetically similar; it was observed that the answer to the  
question of whether the sound of one word resembles too nearly the  
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sound of another for the purpose of trademark action will nearly  
always depend on the first impression because a person familiar with

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3 (1943) 60 RPC 87



both words will neither be confused nor deceived. What will have to be seen is how a person who only knows one word and perhaps has an imperfect collection is likely to be deceived or confused. Therefore, there cannot be a thorough comparison of two words, letter by letter and syllable by syllable, pronounced with the clarity expected from an elocution teacher. This decision has been followed in various decisions of the Courts in this India as well. In the case of *Amritdhara Pharmacy v. Satyadeo Gupta*<sup>4</sup>, before the Supreme Court, the phonetic similarity of 'Amritdhara' and 'Lakshmandhara' was considered. The Supreme Court disapproved of the approach of the High Court, whose order was under challenge in dissecting and analyzing while considering the phonetical similarity. The Supreme Court held that a critical comparison of the two names might disclose some points of difference, but an unwary purchaser of average intelligence and imperfect recollection would be deceived by the overall similarity of the two names having regard to the nature of the medicine he is looking for with a somewhat vague recollection that he had purchased a similar product on a previous occasion with a similar name. The Supreme Court approved the view that it is an ill-advised method to dissect words to ascertain similarity. In the decision in *Encore Electronics Ltd. v. Anchor Electricals & Electronics Pvt. Ltd.*<sup>5</sup>, the Division Bench of this Court, considered the phonetic similarity between 'Anchor' and "Encore". The defendant had submitted before the Court that while 'Encore' is a

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4 AIR 1963 SC 449

5 2007 SCC Online Bom 147

word of French origin, 'Anchor' is a word of English usage, and the pronunciation of the two words must differ. The Bench observed that the case before the Court was not about how an Englishman would pronounce 'Anchor' or a Frenchman would pronounce 'Encore' but the usage of words in India. The Court observed that how an Englishman pronounces the 'a' as in 'anchor' might be distinct from a Frenchman's pronunciation, but for the ordinary consumer in markets in Ahmedabad, Mumbai etc., are deceptively similar. The Court underlined that one must keep in mind the makeup of an Indian consumer and, associated with that, the cultural traits that underlie the spelling and pronunciation of words. The Delhi High Court, in the case of *Mohan Meakin Ltd. v. A.B. Sugars Ltd.*<sup>6</sup>, while considering the action of rival marks "OLD MONK" and "TOLD MOM XXX RUM", analysed the marks OLD MONK and TOLD MOM XXX RUM held that if they are repeatedly spoken, they may not appear similar; however, it is not the test of microscopic examination in the court room but how they would be pronounced and will be phonetically similar where they are used. Learned Single Judge of this Court, in the case of *Neon Laboratories Ltd. v. Themis Medicare Ltd.*<sup>7</sup>, after comparing the plaintiff's mark 'LOX' and the defendant mark 'XYLOX', observed that defendant's mark XYLOX is substantially and deceptively similar to the plaintiff's mark LOX and, accordingly, granted injunction.

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6 2013 SCC Online Del 4120

7 2014 SCC Online Bom 1087

33. Thus, the test applied to determine similarity would be how an average consumer would pronounce the word, and now a person having imperfect recollection will perceive them. Each dialect will result in different pronunciations and what needs to be looked at the overall phonetical similarity. Indian consumers tend to mispronounce the English words written in Roman script; and the plaintiff contends that it will be more so for a Sanskrit word written in Roman script. Plaintiff contends that a large volume of sales of single malt whiskey takes place in restaurants and bars, which are often noisy places, an order placed verbally can produce variants. The impugned order does not refer to these aspects and the line of decisions regarding how phonetic similarity is determined.

34. The test of comparing the rival marks such as 'DROPROVIT' and 'PROVIT' where VIT denoting vitamin preparation and VIT was a description common in the trade or the cases of PANDERM and POLYDERM, where *derm* is an indication of a dermatological product, are different. Such situations are not applicable where there is no such component of the rival marks common to trade.

35. As per the settled law, a microscopic analysis to adjudge similarity is not permissible. Therefore, the conclusion that there is not even phonetic or visual similarity between *THE ASWA* and *ASĀVA* is arrived at by ignoring the well-settled tests and with no reasoning as to what will be the result if the well-settled tests are

applied. Thus the conclusion in the impugned order will have to be set aside. Keeping in mind the settled law enumerated above, the aspect of identity and similarity will have to be decided.

36. According to us, these two errors in the impugned order go to the root of the case. Now we will indicate key areas of factual adjudication which the impugned order has not addressed.

37. The impugned order relies on the Division Bench of this Court in *Meso Pvt. Ltd. v/s. Liberty Shoes Ltd. and Ors.*<sup>8</sup> and culls out an absolute proposition that the use of house mark along with product mark will obviate any likelihood of confusion regarding expensive consumer products, as these purchasers are always discerning and choosy. The facts in the decision of *Meso* were that Plaintiff Meso had registered trademarks *Legend* and *Flirt* for its two perfumes. Defendant Liberty launched two perfumes with the name *Legend* and *Flirt*. Before the Division Bench, the Meso contended that *Legend* and *Flirt* are arbitrary marks and have no connection whatsoever, and they cannot be considered common to trade. The Division Bench observed that both *Legend* and *Flirt* have a connection with the qualities of the perfumes and supposed to suggest that the wearer of the perfumes would be perceived in a particular manner as having certain desirable attributes. Liberty – the defendant, had contended that it had not infringed the *Legend* and *Flirt* marks they were common to trade words, however, Liberty

had clarified that it is not its central defense but one of the defenses. The Division Bench prefixed the discussion observing that the question will have to be answered on a specific set of facts and circumstances of each case. The Division Bench then noted that various international business houses used the marks 'Legend' and 'Flirt'. Following are the observations of the Division Bench.

*31. Liberty has placed on record that the marks Legend and Flirt are being used along with respective house marks by various established brands. This fact has also been referred to by the learned Single Judge. In the reply filed before the learned Single Judge, Liberty has placed on record pictorial depiction of various companies which have used both the words Legend and Flirt along with their house marks. Mont Blanc is selling the product with product name "Mont Blanc Legend"; Azzaro Perfumes with "Chrome Legend"; De Rigo Vision with "Police Legend"; Sniff Perfumes with "I am Legend"; Empire Perfumes and Cosmetics with "Legend Black"; Yardley London with "Yardley London Gentleman Legend"; McNroe Consumer Products with "Wild Stone Legend"; Pierre Cardin with "Pierre Cardin Legend"; Mont Blanc Legend with "Legend Pour Femme"; Steve McQueen with "Steve McQueen Legend"; Michael Jordon with "Michael Jordon Legend Cologne"; Jafra with "Legend Hero"; and Jafra Legend with "Legend for Men".*

*32. Similarly, the word Flirt is also used by renowned brand sellers. Flirt-Roll on Perfume use the said mark with "Flirt-Roll on Perfume"; Ramsons with "Flirt Eau de Parfum"; HNI with "B Flirt Perfume"; Eva Deo Spray, Flirt with "Eva Flirt"; Victoria's Secret with "Such A Flirt Body Mist"; Secret Temptation with "Flirt Deo Spray"; Perspective with "Flirt"; Pure romance with "flirt perfume"; EAU FLIRT by Harvey Prince with "Eau Flirt"; Victoria's Secret with "Pink Total Flirt*

*Mist*"; Omerta with "Desirable Pure Flirt"; Victoria's Secret with "Love to Flirt"; Ulric de Varens with "Mini Flirt"; and Victoria's Secret with "Such a Flirt Perfume". The Liberty has also placed the details of various third-party marks in respect of products in Class-3 both for Legend and Flirt. Thus it can be seen that words Legend and Flirt have been used regarding perfumes falling in Class-3 along with house names by various companies.

After noting these facts, the Division Bench dismissed the appeal.

38. The peculiar facts in *Meso* were that various international brands were using the mark along with their house mark. The decision in the case *Meso* will have to be understood in the facts of the case as noted in the decision itself. The decision in *Meso* was rendered in the facts of that case, and no absolute proposition as the impugned order refers to was laid down. Having relied upon the decision of *Meso* thus, the impugned order does not indicate as to what will be the position in the case at hand. No decision is cited before us laying down an absolute proposition that even though a mark constitutes as a trademark under Section 2(1) (zb), if it is used with a house name, will not infringe a registered trademark in cases of all premium consumer products, irrespective of the factual situation of the case. If such an absolute proposition is accepted, almost every registered trademark in premium consumer products will be vulnerable. On the other hand, the impugned order does not refer to a series of decisions holding that mere addition of a word or a mark to an objected mark would not by itself make any

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difference to the action for infringement. These are : the decision of the Supreme Court in *Ruston & Hornsby Ltd. v. The Zamindara Engineering Co.*<sup>9</sup>; the decision of the learned Single Judge of this Court in the case of *Pidilite Industries Ltd. v. Jubilant Agro Consumer Products Ltd.*<sup>10</sup>; the decision of the Division Bench of the Madras High Court in *Rhizome Distilleries Pvt. Ltd v. Union of India*<sup>11</sup> ; and the decision of the Division Bench of the Madras High Court in *K.R. Chinnikrishna Chetty v. K. Venkatesa Mudaliar*,<sup>12</sup>. Therefore the direct conclusion that the use of house marks in all circumstances in expensive consumer products of all types will obviate the likelihood of confusion as a proposition was not correct in law. Consequently, factual inquiry about the facts of the present case is missing in the impugned order.

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39. Second aspect where factual enquiry is missing is on the aspect of the likelihood of confusion. The impugned order has referred to the decisions of the Supreme Court in the case of *Khoday Distilleries Limited v. Scotch Whiskey Association*<sup>13</sup>, and of this Court in *Carew Phipson Limited v. Deejay Distillers Pvt. Ltd.*<sup>14</sup> to hold that the purchasers of single malt whiskey are always discerning and there is no likelihood of confusion in this class of products. The Supreme Court in *Khoday Distilleries* had taken a

9 AIR 1970 SC 1649

10 2014 SCC Online Bom 50

11 2015 SCC OnLine Mad 11996

12 1972 SCC OnLine Mad 173

13 (2008) 10 SCC 723

14 AIR 1994 Bom 231

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review of case-laws from jurisdictions of different countries. While reviewing the case law from other countries, reference is made to the decision of the Federal Court of Australia in *Scotch Whiskey Association v. Marton De Witt*<sup>15</sup>. This decision is noted in the impugned order. However, the impugned order does not notice that in *Khodey Distilleries*, the Supreme Court, after referring to the decisions from various other countries, para 77 of the judgment, has observed that it may be true that the tests which are to be applied in a country like India may be different from the tests in countries like of England, the United States of America, or Australia. Further, in *Gorbatschow Wodka KG v. John Distilleries Limited*<sup>16</sup>, dealing with the proposition that the consumers of expensive alcoholic beverages being discerning different tests must apply, the Court noted that gullibility is a character that pans across social or economic attributes and capacity to discern is not necessarily relatable to social class or financial status. The point is that there cannot be an absolute proposition as the likelihood of confusion irrespective of the circumstances of each case, which will have to be examined. This enquiry in the facts of the case at hand is missing in the impugned order. To ascertain the likelihood of confusion full spectrum of potential purchasers and manner of purchase will have to be looked at. Many facets would arise for consideration in this case. Whether the focus of enquiry should be only on the metropolises or the manner of consumption of single malt whiskey in the rest of the

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15 (2008) FCA 73

16 2011 (47) PTC 100 (Bom.)



country should also be taken into consideration? While there may be purchasers of expensive alcoholic beverages who are discerning, attentive and well versed with various Indian and international brands of single malt whiskey, do they constitute the entire class? Has the pattern of consumption of expensive whiskey in the country changed in recent years with rapid economic progress and the rise in purchasing power of the average consumer? For example, the increase in prices of agricultural lands around cities has gone up substantially, and such land transactions yield a substantial income. Or, for instance, the construction sector, where education is not the sole prerequisite for financial success. There are many such examples. Secondly, the manner of consumption of single malt whiskey is a relevant aspect regarding the likelihood of confusion. Plaintiff contends a large volume of sale of single malt whiskey takes place in restaurants and bars. Further aspects would arise regarding the legal and factual implications of the position if the rival marks are identical, giving rise to the statutory presumption and that the Plaintiff's product is not in the market. Also, the legal and factual implications of the position if the rival marks are deceptively similar and the Plaintiff's product is not in the market.

40. Next aspect in the impugned order is of suppression and estoppel. The Defendants contended that Plaintiff is guilty of suppressing the application made by Plaintiff for registration of word and device mark *ASĀVA* before filing the suit. Defendants contend

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that generally, if a defendant in infringement action applies for registration of very mark, he acknowledges the similarity and, therefore, is estopped from claiming otherwise. Defendants contend that reverse position will also apply to a plaintiff who alleges infringement and applies for registration of the defendant's mark; therefore, the principle of estoppel must equally apply to a plaintiff. The learned Single Judge accepted these contentions. A Court would indeed consider suppression of material documents while deciding grant of an equitable remedy, but equally, it is not for the plaintiff to place before the Court what can be taken as a defence by the defendant. We have not been shown any judicial precedent in which it is laid down that if a plaintiff applies for registration of a deceptively similar mark used by the Defendant, he would be estopped from contending that it is not distinctive. The implications flowing from the filing of this application by Plaintiff was the defence of the Defendants. Therefore, merely because a fact was brought on record by Defendants in their defence, it would not *ipso facto* mean that there was suppression by the Plaintiff. The impugned order does not examine this aspect.

41. Plaintiff contends that once it is found that Defendant No.2 was using a deceptively similar mark, it applied for registration of that mark for better protection along with other variants of the word. According to Defendants, the application of registration of the mark for *ASĀVA* by Plaintiff should be considered as an admission that it is not identical and similar to *THE ASWA*, and Plaintiff is

estopped from contending otherwise. The impugned order has accepted this contention of the Defendants. The Defendants relied upon the decisions of *Ultra Tech Cement Ltd. v. Alaknanda Cement Pvt. Ltd.*<sup>17</sup> and *Jagdish Gopal Kamath and Ors. v. Lime & Chilli Hospitality Services*<sup>18</sup>. However, in the decisions in the cases of *Ultra Tech Cement* and *Jagdish Kamath*, the principle of estoppel was applied to a defendant facing an infringement and not to a plaintiff. The present case is the opposite. The converse of a statement is not always automatically true. Therefore, if a completely new legal ground by substituting opposite concepts without reference to any precedent or statutory provision was to be advanced, it needed detailed scrutiny. Plaintiff has placed on record various examples where the proprietors of registered marks have applied for registration of variants to have better protection, to show that it is a standard trade practice and under Section 16 of the Act the registration of a trademark could be done as associated trademarks. The impugned order has not carried out any enquiry in this regard.

44. Plaintiff has contended that Defendant No.2, in its Opposition to the Application for the mark *ASĀVA*, has taken a contrary stand that it uses the word *ASĀVA* in a descriptive sense. This Opposition was filed after the impugned order. Plaintiff contends that if that is the stand of Defendant No.2, then there should be no objection to others using the mark, yet Defendant No.2 opposes the application. Both parties have alleged that the other is

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17 2011(5) BomCR 588

18 2015(3) BomCR 496

taking differing stands. The issue to be decided is whether infringement is made out as envisaged in Section 29 of the Act. Therefore, these aspects are secondary.

46. Therefore, to recapitulate, the finding in the impugned order that there were not even visual or phonetic similarity, is arrived at contrary to the settled tests to be applied. The impugned order noted that once there was no visual, phonetic and structural similarity, the matter ended there, and further discussion was unnecessary. While concluding that *ASĀVA*, though styled as a descriptor/sub-brand, is not a trademark, there is no reference to the Defendants' pleadings and analysis of the facts of the case in the context of the statutory provision. A mention in the impugned order that all sub-brands are not trademarks is not elaborated further. As to why *ASĀVA*, which is styled as a sub-brand, should not be considered as a trademark is not elaborated. The impugned order proceeds on the premise that in respect of expensive consumable products, the use of house mark with the product mark will obviate the likelihood of confusion. There is no enquiry in the facts of the case as it has been taken as an absolute proposition of law based on decision of this Court which does not lay down any such fundamental proposition. Similarly, an absolute proposition is sought to be relied upon to consider the likelihood of confusion that all consumers of single malt whiskey are discerning and aware of the different national and international brands in all circumstances. The other nuances regarding the manner of purchase and the class of

consumers of single malt whiskey have not been referred to. As a consequence, there is no factual enquiry as to the likelihood of confusion in respect of the rival marks in question. Also, after the question of identity/similarity is determined, further questions will arise as to the legal and factual implications if the rival marks are identical, giving rise to the statutory presumption and that the Plaintiff product is not in the market. Also, the legal and factual implications if the rival marks are deceptively similar and that the Plaintiff product is not in the market. This being the position and that it is not possible for us to decide these aspects first time in appeal, the matter will have to be remanded with the observations as above.

47. While we remand the matter, we set aside the finding of the learned Single Judge that *RAMPUR ASĀVA* and not *ASĀVA* alone is the trademark of Defendant No.2. This aspect will be considered in light of what is observed above. We also set aside the finding that there is no visual, phonetic or structural similarity between *THE ASWA* and *ASĀVA* and the similarity/identity will have to be decided as per the settled principles enumerated above. For determining the likelihood of confusion between the two rival marks the facts of the case cannot be ignored and absolute propositions cannot be drawn from the judicial pronouncements that do not lay down any such final propositions. The finding that Plaintiff has suppressed the application for registering the mark THE

ASWA, which dis-entitled Plaintiff for applying for equitable relief, is set aside as there is no such suppression. The finding that a Plaintiff who applies for registration of the mark of the defendant-infringer is estopped from contending that they are similar is based upon alternating the opposite concepts without referring to any legal or statutory principle and is set aside for lack of any reasons in support.

48. The learned Single Judge has imposed costs of Rs.12,56,000/- on the Plaintiff holding imposition of costs is a norm in commercial matters to be deviated from only by giving reasons. Plaintiff contended that Section 35 of Code of Civil Procedure, 1908 (as amended) does not lay down that it is mandatory to impose the costs, and in any case, an opportunity will have to be given. The Defendants have advanced no counter submissions before us to support the imposition of costs. Since we are setting aside the impugned order with the above reasoning, the order awarding costs is also set aside.

49. Thus, the Appeal is allowed. The impugned order is quashed and set aside. Interim Application (L) No.8940 of 2020 in Commercial IP Suit (L) No.8936 of 2020 is restored to file to be disposed of in light of what is observed in this judgment.

50. The Registry will place the interim application before the learned Single Judge, subject to the concurrence of the learned Single Judge, for Directions in the week commencing from 30

August 2021, so that the learned Judge can fix a schedule for time bound completion of arguments on the interim application.

51. The learned Senior Advocate for the Appellant presses for the costs of the Appeal. Considering the facts and circumstances of the case and the reasons for remand, there will be no order for costs.

(C.V. BHADANG, J.)

(NITIN JAMDAR, J.)

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