

## M/S Laxmi Trading vs M/S B.R. Oil Mills on 31 May, 2023

**Author: Yashwant Varma**

**Bench: Yashwant Varma, Dharmesh Sharma**

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\* IN THE HIGH COURT OF DELHI AT NEW DELHI  
+ FAO (COMM) 121/2023 & CM APPLs. 30394-97/2023  
M/S LAXMI TRADING ..... Appellan  
Through: Ms. Aakanksha Kaul, Mr.  
Harsh Ojha, Ms. Versha Singh  
and Mr. Pranav Gupta, Advs.  
versus

M/S B.R. OIL MILLS .  
Through:

CORAM:  
HON'BLE MR. JUSTICE YASHWANT VARMA  
HON'BLE MR. JUSTICE DHARMESH SHARMA

ORDER

% 31.05.2023

1. The defendant / appellant impugns the order dated 15 May 2023 passed by the Trial Judge confirming the ex parte injunction that was granted on 08 December 2022 and consequently rejecting the application made by the appellant referable to Order XXXIX Rule 4 of the Code of Civil Procedure, 19081.

2. The suit registered as CS (Comm.) 692/2022 and titled B.R. Oil Mills v. Laxmi Trading and Anr. had been brought by the plaintiff / respondent herein seeking the following reliefs: -

"a). Issue an ad-interim injunction restraining the defendants by themselves as also through their individual proprietors/partners, agents, representatives, distributors, assigns, heirs, successors, stockists and all others acting for and on their behalf from using, manufacturing, selling, soliciting, exporting, displaying, advertising or by any other mode or manner dealing in or using the impugned trademark/label MAA RANI and/or any other trademark/label which may be identical with and/or deceptively similar to the plaintiff's trademark RANI BRAND in relation to their impugned goods and business of Mustard Oil and all other edible oil and allied/related products and from doing any other acts Code This is a digitally signed order.

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or deeds amounting to or likely to:

(i) Infringement of plaintiff's aforesaid registered trademark/ label RANI BRAND.

(ii) Passing off by defendants of their goods as those of the plaintiff by use of impugned trademark/label MAA RANI and/or copyright in the artwork thereof in violation of the plaintiff's trademark/label RANI BRAND and copyright in the artwork thereof;

(iii) Infringement of the plaintiff's copyright in the artwork of RANI BRAND.

(b) Restraining the defendant from disposing off or dealing with his assets including the premises at the address mentioned in the Memo of Parties and stocks-in-trade or any other assets as may be brought to the notice of the Hon'ble Court during the course of the proceedings and on the defendant's disclosure thereof and which the defendant is called upon to disclose and/or on its ascertainment by the Plaintiff as the Plaintiff is not aware of the same as per Section 135(2)(c) of the Trade Marks Act, 1999 as it could adversely affect the Plaintiff's ability to recover the costs and pecuniary reliefs thereon.

(c) Having regard to the aforesaid and delay being fatal an ex-

parte order of injunction in terms of the above be also issued. AND Such other and further order(s) may also be passed in favour of the plaintiff, which this Hon'ble Court may deem fit and proper in the facts and circumstances of the case."

3. As would be evident from a reading of the reliefs that were sought, the plaintiffs sought an injunction restraining the appellant from manufacturing, selling, soliciting, exporting, displaying, advertising or in any manner dealing in or using the trademark "MAA RANI/ " or any other label deceptively similar to the This is a digitally signed order.

The authenticity of the order can be re-verified from Delhi High Court Order Portal by scanning the QR code shown above. The Order is downloaded from the DHC Server on 08/10/2023 at 06:06:40 plaintiff s trademark "RANI BRAND/ ". The suit was based on allegations of infringement and passing off and on consideration of the application for ex parte ad interim injunction, the Trial Judge on 08 December 2022 had framed the following interim directions: -

"6. Consequently, the defendants by themselves as also their individual proprietors/partners, agents, through representatives, distributors, assignees, heirs, successors, stockists and all others acting for and on their behalf are restrained till next date of hearing from using, manufacturing, selling, soliciting, exporting, displaying, advertising or by any other mode or manner dealing in or using the impugned trademark/label MAA RANI and/or any other trademark/label which may be identical with and/or deceptively similar to the plaintiff's trademark RANI

BRAND in relation to their impugned goods and business of Mustard Oil and all other edible oil and allied/related products and from doing any other acts or deeds amount to or likely to infringing the plaintiff's aforesaid registered trademark/label "RANI BRAND"; passing off of their goods as those of the plaintiff by use of impugned trademark/label "MAA RANI" and/or copyright in the artwork thereof in violation of the plaintiff's trademark/label "RANI BRAND" and copyright in the artwork thereof, and infringing the plaintiff's copyright in the artwork of "RANI BRAND".

4. Alongside the same, the Trial Judge invoking powers conferred in terms of Order XXVI Rule 9 read with Order XXXIX Rule 7 of the Code also appointed a Local Commissioner who was directed to visit the premises and warehouse of the defendant and take into his custody all impugned goods bearing the trademark "MAA RANI" and/or any word mark or label deceptively identical and similar to that of the plaintiff namely "RANI BRAND". It is the said order that has come to be confirmed in terms of the impugned order.

5. For the purposes of disposal of the instant appeal, the following This is a digitally signed order.

The authenticity of the order can be re-verified from Delhi High Court Order Portal by scanning the QR code shown above. The Order is downloaded from the DHC Server on 08/10/2023 at 06:06:41 essential facts would merit notice. As per the averments made in the plaint, the plaintiff adopted the trademark "RANI BRAND" and the "RANI" label in relation to its goods and business. Both the plaintiff / as well as the respondent deal in Mustard Oil. As per the disclosures made in the plaint, its application for registration of "RANI BRAND"

as a trade word was made on 13 February 1975 with a user claim of 01 January 1965. Similarly, the trade dress "RANI BRAND" was registered on 06 September 2004 with a user claim of 08 October 1965. The plaintiff further asserted that it derived knowledge of the appellant's impugned trademark and label in the last week of August when it came across its application for registration of that mark and which was advertised in the Trademark Journal in its edition of 09 May 2022 inviting public objections. Admittedly, the application for registration was filed by the appellant on 09 November 2021 on a "proposed to be used" basis.

6. The plaintiff on 07 September 2022, filed its notice of opposition and proceedings in respect thereof are presently pending before the competent authority. The cause of action for institution of the suit is stated to have arisen when the plaintiff came to know that the plaintiff had started distributing Mustard Oil under the impugned trademark and label and was soliciting trade and business in various parts of South Delhi. It was further averred that the appellant had also commenced supply of goods under the brand name "MAA RANI" to various dealers, shopkeepers and retailers in different markets in South Delhi.

7. For the purposes of appreciating the challenge which stands raised, it would be apposite to extract a comparative chart which has been placed by the appellant itself and forms part of ground „H of

the appeal: -

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The authenticity of the order can be re-verified from Delhi High Court Order Portal by scanning the QR code shown above. The Order is downloaded from the DHC Server on 08/10/2023 at 06:06:41 "CATEGORY PLAINTIFF'S MARKS DEFENDANT'S MARK Word Marks "Rani Brand" in Class 29 "MAA RANI" in Class 29 (bare words) in which the along with device.

Device	words "BRAND" is disclaimed as per disclaimer in Note Sheet dated 16.02.1983.
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Classes	In Class 31 The Device of a Women is placed on the top left-ha side corner and the Women is looking to her right. Word Mark in Class 29 "RANI BRAND" ("BRAND" Disclaimed) and Device in Class 31 with word "Rani" in HINDI.
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Language	English in Word Mark and the word "RANI" in Hindi in the Device.
Colour Combination	Women facing to her right on a Light Blue Background

8. The Trial Judge has upon due consideration of the submissions addressed ultimately found that the mark utilized by the appellant was deceptively similar to the plaintiff s trademark/label in many respects.

It has, in fact, observed that the resemblance is so close that it would appear to be a case of deliberate imitation. It has also alluded to the similarity in the colour scheme as well as the close resemblance between the two competing labels and trade dress visually as well as structurally in

their placement as also in their artistic features.

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9. Assailing the order impugned, Ms. Kaul learned counsel for the appellant, contended that the Court clearly lacked the territorial jurisdiction to entertain the suit since no evidence had been laid by the plaintiff to establish that its goods were being sold, distributed or marketed within the territorial jurisdiction of the Trial Court. The submission was that the business of the appellant is principally concentrated in the State of Bihar and that the plaintiff had woefully failed to place any cogent material on the record to establish its assertion that those goods were available in South Delhi. According to Ms. Kaul, this itself constituted sufficient ground for the Trial Court to have rejected the plaint and, in any case, refuse the prayer for injunction.

10. In our considered opinion, the aforesaid objection has been rightly negated by the Trial Judge who while dealing with the same has observed thus: -

"9. Regarding the first contention of Ld. Counsel for defendant no. 1 that this court has no territorial jurisdiction to try the present suit, as the plaintiff is based in Bharatpur, Rajasthan and defendant no. 1 is based in Siwan, Bihar. The defendant no. 2 is also based in Jaipur, Rajasthan, as per the memo of parties. Further no cause of action or part thereof has arisen within the territorial jurisdiction of Delhi or of this Court.

10. It has been held by the Hon ble High Court in case titled as Shyam Lal Mulwani & Anr. Vs. ABC Chashmewale LLP CRIPD 3/2022 decided on 28.11.2022 as under :

9. Although Petitioners had invoked Order VII Rule 11 of CPC before the Trial Court for rejection of plaint, thrust of their arguments is lack of territorial jurisdiction, which, in the opinion of the Court, would attract Order VII Rule 10.

Nonetheless, the premise for seeking rejection of the plaint, or to put it aptly, return of the plaint, is that no cause of action occurred within territorial jurisdiction of Courts in Delhi.

10. In order to demonstrate lack of territorial jurisdiction, mindful of the position in law relating to proposition advanced, counsel for Petitioners essentially argues that Petitioners do not conduct operations in Delhi and merely on the basis of Respondent's averments, and without any This is a digitally signed order.

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law is well-settled. This Court, in M/s RSPL Limited (Supra), held that if material facts have been pleaded by Plaintiff to the effect that Defendant has been transacting in infringed goods or services within the court's jurisdiction, the suit can be entertained on that basis, however, veracity of such statements would have to be proved by Plaintiff during the course of trial. In that light, the cause of action pleaded in the plaint reads as under:

"22. That in the month of April 2017, plaintiff for the first time came to know that the defendants have changed its Trade Name ABC CORNER to ABC CORNER CHASHMEWALE and also started using ABC CORNER CHASHMEWALE as its trademark in relation to impugned goods and business. Plaintiff vehemently objected this. Partners of Plaintiff and Defendants being members of same family, plaintiff tried to avoid litigation however despite repeated objections defendants not relented. Plaintiff then in or around last week of April, 2020 noticed that the defendant no.1 has filed Cancellation Petition against Plaintiff's registered trademark ABC CHASHMEWALE registered under nos. 1613654, 3090490, 3090491, 3090492, 3090493 and 3090495 and opposition to the application for registration of trademark ABC CORNER bearing no. 3090496 on 25.01.2020 and has started promoting its business by the name ABC CORNER CHASHMEWALE by distributing leaflets and adverting materials. It is stated that the defendant filed the said Cancellation Petitions despite having knowledge of plaintiff right over the trademark ABC CHASHMEWALE since 1990 and grant of registration on 20.06.2014. The said Cancellation Petitions were filed to pre-empt the Plaintiff from taking legal action against illegal and violative use of impugned trademark and trade name ABC CORNER CHASHMEWALE which the defendants adopted and started using to cash in on the vast goodwill of the Plaintiff under the trademark and trade name ABC CHASHMEWALE. Plaintiff tiled detailed Counter- Statement in the said Cancellation Petitions and notice of opposition on 06.06.2020. Plaintiff's enquiry in the market and trade revealed that the defendants have recently in the month of October 2020, started selling and supplying their impugned goods in the markets South Delhi in clandestine and surreptitious manner and have started soliciting/networking with various dealers/ shopkeepers/retailers of spectacles/optical in the This is a digitally signed order.

The authenticity of the order can be re-verified from Delhi High Court Order Portal by scanning the QR code shown above. The Order is downloaded from the DHC Server on 08/10/2023 at 06:06:41 market of South Delhi viz. Saket, Mehrauli, Malviya Nagar, HauzKhas etc. and adjoining areas etc. for sell and distribution of their goods under the impugned trademark and trade name. Defendant is also conducting impugned activities through website like just dial.com which is accessed by the consumer is South Delhi.

23. That the cause of action for filing the present suit has been detailed in the preceding paras. Cause of action for the first time arose in the month of April 2017 when plaintiff for the first time came to know that the defendants have changed its

Trade Name ABC CORNER to ABC CORNER CHASHMEWALE and also started using ABC CORNER CHASHMEWALE as its trademark in relation to impugned goods and business. Cause of action further arose on each time when Plaintiff objected the use of impugned trademark and trade name by the defendant though avoided litigations being the members of same family. Cause of action further arose when despite repeated objections defendants not relented and Plaintiff in or around last week of April, 2020 noticed that the defendant no.1 has tiled Cancellation Petition against Plaintiff's registered trademark ABC CHASHMEWALE and opposition to the application for registration of trademark ABC CORNER on 25.01.2020 as mentioned and they started promoting its business by the name ABC CORNER CHASHMEWALE by distributing leaf-lets and advertizing materials. Cause of action further arose when Plaintiff filed Counter-Statement in the said Cancellation Petitions and notice of opposition on 06.06.2020. Cause of action further arose when Plaintiff's enquiry in the market and trade revealed that the defendants have recently in the month of October, 2020 started selling and supplying their impugned goods in the markets South Delhi in clandestine and surreptitious manner and are soliciting/networking with various dealers/ shopkeepers/retailers of spectacles/optical in the market of South Delhi viz. Saket, Mehrauli, Malviya Nagar, Hauz Khas etc. and adjoining areas etc. for sell and distribution of their goods under the impugned trademark and trade name. Cause of action in the present case is accruing day-to-day and shall continue to so accrue till the defendants cease with their impugned adoption and soliciting/networking impugned business under the impugned trademark and trade name and intended use of impugned trademark and trade name.

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24. That this Hon'ble Court has the jurisdiction to entertain and try the instant suit. The defendants are selling and soliciting impugned goods and business under the impugned trademark and trade name in the markets of South Delhi. Defendants have every intention to sell/provide their impugned goods under the impugned trademark/ trade name in the markets of South Delhi viz. Saket, Mehrauli, Malviya Nagar, Hauz Khas etc. The defendant are committing the impugned acts of infringement and passing-off in the markets of South Delhi area viz. Saket, Mehrauli, Malviya Nagar, Hauz Khas and adjoining areas etc. within the jurisdiction of this Hon'ble Court by selling, soliciting marketing networks in relation to the impugned goods under the impugned trademark and trade name. Defendant is conducting impugned activity through website like justdial.com which is accessed in South Delhi. Defendants' impugned activities are likely to have a dynamic effect on the Plaintiffs business, both current and forthcoming, within the jurisdiction of this Hon'ble Court

as the plaintiff has tremendous goodwill and reputation its said trademark and trade name which are also made available within the jurisdiction of this Hon'ble Court which is being tarnished or likely to be so tarnished within the jurisdiction of this Hon'ble Court by the defendants' impugned activities. Hence a part of cause of action has arisen within the Jurisdiction of this Hon'ble Court."

[Emphasis Supplied]

11. The above-noted averments qua territorial jurisdiction make a positive statement that cause of action arose within the jurisdiction of the Court. Therefore, since material facts have been pleaded, at this juncture, the question of jurisdiction has to be decided on a demurrer by taking the statements made in the plaint to be true and absence of any documentary proof in support thereof, cannot be a ground to reject the plaint. These assertions have been vehemently controverted by Petitioner and therefore, Respondent would have to prove the same before Trial Court. Similar view has been adopted by the Supreme Court in *Expfar SA and Anr. v. Eupharma Laboratories Ltd. And Anr.* and this Court in *Dassault Systemes S.E. and Anr. v. Automobile Corporation of Goa Limited and Ors. and Allied Blenders & Distillers Pvt. Ltd. Vs. Prag Distillery Pvt. Ltd.*

12. Further, since Petitioners' objections are based solely on the question of jurisdiction under Section 20 of CPC, their contentions qua Section 134 of Trademark Act, 1999 and the effect thereof, are not required to be examined by This is a digitally signed order.

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11. In the present case also, in para 22 of the plaint, the plaintiff has stated as under :

22. That this Hon'ble Court has the territorial jurisdiction to try and adjudicate the present suit.

Defendants are soliciting trade and business under the impugned trademark/label and are supplying their impugned goods bearing the impugned trademark/label to the dealers and distributors in the markets of South Delhi viz. Saket, Mehrauli, Malviya Nagar, HauzKhas etc. who are making clandestine and surreptitious sales thereof to unwary consumers. Hence a part of cause of action has arisen within the jurisdiction of this Hon'ble Court. Further the plaintiff is also carrying on its said goods and business under its said trademark/label in South Delhi through exclusive dealers and special agent and has extensive goodwill and reputation under the said trademark/label on account of voluminous sales within the jurisdiction of this Hon'ble Court. This Hon'ble Court thus further has the territorial jurisdiction within the meaning of Section 134 (2) of the Trade Marks Act, 1999 and Section 62 (2) of the Copyright Act, 1957.

12. The above mentioned averments in para 22 qua territorial jurisdiction makes a positive statement by the plaintiff that the cause of action or part thereof has arisen within the jurisdiction of



this Court, therefore, since material facts have been pleaded in the plaint, the question of jurisdiction has to be decided by way of demurrer by taking the statement made in the plaint to be true in absence of any documentary support thereof, which the plaintiff of course will have to prove during the trial. Therefore, it cannot be said at this stage that this court has no territorial jurisdiction to try the present suit."

11. It may only be additionally noted that the issue of territorial jurisdiction in such cases has to necessarily proceed on the basis of a demurer and await parties being accorded the requisite opportunity to lead evidence in greater detail.

12. The sheet anchor of the challenge to the injunction which ultimately came to be granted was based on the decision rendered by the Court in *Phonepe Pvt. Ltd. v. EZY Services and Another*<sup>2</sup> with 2021 SCC OnLine Del 2635 This is a digitally signed order.

The authenticity of the order can be re-verified from Delhi High Court Order Portal by scanning the QR code shown above. The Order is downloaded from the DHC Server on 08/10/2023 at 06:06:42 Ms. Kaul contending that the plaintiff could not claim exclusivity over the use of the word "RANI". It was also her submission that the plaintiff had deliberately concealed the existence of the Disclaimer appended to the grant and in terms of which the plaintiff had agreed that it would have no exclusive right over the word "BRAND".

13. Ms. Kaul submitted that Phonepe had while expounding upon the principles of similarity clearly held that the mark has to be considered as a whole and it is the overall similarity of composite words which would constitute the guiding test. The submission was that the entire claim as raised by the plaintiff would be contrary to the well-recognised Anti-Dissection rule.

14. Ms. Kaul then submitted that as would be manifest from a comparison of the two competing marks, there was no phonetic or visual similarity which could be said to have met the test of the product of the appellant being deceptively similar. Ms. Kaul had also drawn the attention of the Court to the judgment rendered by the Madras High Court in *Rani Food Products v. Stine Food Products*<sup>3</sup> and which had held that no person could claim an exclusive right over the word "RANI" which is a common word.

15. Having conferred our thoughtful consideration on the aforesaid submissions, we find ourselves enable to sustain the challenge laid to the impugned order for the following reasons.

16. As we peruse the comparative chart which was placed along with the appeal, we find that the word "RANI" is common to both the trademarks "MAA RANI" and "RANI BRAND". While it is true that the Anti-Dissection Rule bids us to view the rival marks in entirety and to desist from dissecting composite expressions, we also bear in mind the principle of dominance which must also be kept in view. As This is a digitally signed order.

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perusal of the trade dress and mark would indicate, the word "RANI" is prominently utilized both by the appellant as well as the plaintiff and constitutes a dominant part of the competing labels.

17. The appellant has replicated the word "RANI" prominently in both English as well as the vernacular. The Court thus comes to conclude that the dominant characteristic accorded to the word "Rani" could have justifiably been taken into consideration while deciding the question of infringement. The Court draws sustenance in this regard from the following pertinent observations as are found in the decision of South India Beverages Pvt. Ltd. v. General Mills Marketing Inc. & Anr.4:-

"19. Though it bears no reiteration that while a mark is to be considered in entirety, yet it is permissible to accord more or less importance or „dominance to a particular portion or element of a mark in cases of composite marks. Thus, a particular element of a composite mark which enjoys greater prominence vis-à-vis other constituent elements, may be termed as a „dominant mark .

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21. The view of the author makes it scintillatingly clear, beyond pale of doubt, that the principle of „anti dissection does not impose an absolute embargo upon the consideration of the constituent elements of a composite mark. The said elements may be viewed as a preliminary step on the way to an ultimate determination of probable customer reaction to the conflicting composites as a whole. Thus, the principle of „anti-dissection and identification of „dominant mark are not antithetical to one another and if viewed in a holistic perspective, the said principles rather compliment each other.

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23. It is also settled that while a trademark is supposed to be looked at in entirety, yet the consideration of a trademark as a whole does not condone infringement where less than the entire trademark is appropriated. It is therefore not improper to identify elements or features of the marks that are more or less important for purpose of analysis in cases of composite marks."

18. We also bear in mind that an average consumer is not expected 2013 SCC OnLine Mad 537 4 2014 SCC OnLine Del 1953 This is a digitally signed order.

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as propounded by courts. We also find that on a visual examination also, the infringing mark and label appear to be misleadingly similar.

19. The learned Judge in Phonepe itself had enunciated the principal factors which must be borne in mind while assessing the question of deceptive similarity. While doing so, it had observed as follows: -

"(i) In assessing deceptive similarity, the class of the customer who would purchase the product is relevant. The look/appearance, and the sound, of the trade marks, as well as the nature of the goods, are all relevant considerations. Surrounding circumstances are also relevant.

(ii) The onus of proof is on the plaintiff who alleges passing off. As against this, in an opposition to the registration of a trade mark, the onus to prove deceptive similarity is on the defendant who seeks non-registration, or removal of the trade mark from the register.

(iii) "Confusion" refers to the state of mind of the customer who, on seeing the mark, thinks that it differs from the mark on the goods which he has previously bought, but is doubtful whether that impression is not due to imperfect recollection. The question is one of first impression.

(iv) This is especially true in the matter of phonetic similarity. A meticulous comparison of the words, syllable by syllable, is to be avoided. The possibility of careless pronunciation and speech, both on the part of the buyer walking into the shop, as well as the shop assistant, is also required to be factored into consideration.

(v) The matter has to be examined from the point of view of a person of average intelligence and imperfect recollection. It has to be seen as to how such a purchaser would react to the trade mark, the association which he would form and how he would connect the trade marks with the goods he would be purchasing.

(vi) The Pianotist test, postulated over a century ago, has repeatedly been endorsed by the Supreme Court, as the definitive test to be adopted while comparing rival trade marks. According to this test, the Court is required to judge the rival trade marks by their look and sound, and consider,

(a) the goods to which they are to be applied

(b) the nature and kind of customer who would be likely to buy those goods, This is a digitally signed order.

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(c) all surrounding circumstances and

(d) the consequences which would follow if each of the marks is used in the normal way as the trade mark for the goods of the respective owners.

While doing so, the common part of the words forming the competing marks may not be decisive. The overall similarity of the composite words is required to be seen, having regard to the circumstance (if applicable) that both are on like goods of similar description. The test to be applied is whether, if the two marks are used in a normal and fair manner, there is likelihood of confusion or deception.

(vii) The whole word/mark is to be considered. An ordinary man would not split a word or name, in a trade mark, into its components, but would go by the overall structural and phonetic similarity of the marks at the nature of the goods previously purchased, or of which he has been told and which he wants to purchase. It has to be examined whether the totality of the trademark of the defendant is likely to cause deception/confusion or mistake in the minds of the persons accustomed to the existing trade mark of the plaintiff.

(viii) The resemblance may be phonetic, visual or in the basic idea represented by the plaintiff's mark. The Court is, however, required to apply both the phonetic and the visual tests. At times, ocular similarity may be sufficient to find possibility of confusion/deception, even if the marks are visually dissimilar, though ocular similarity, by itself, may not, generally, be the decisive test. Where, however, (i) in all other respects, the marks of the plaintiff and defendant are different, (ii) the word/words, in the marks, which are phonetically similar, cannot be regarded as the dominant word, or essential feature, in the marks, and (iii) the surrounding circumstances also belie any possibility of confusion, it has been held that deceptive similarity cannot be found to exist merely on the basis of phonetic similarity or even identity. The matter, apparently, is always one of fact. The Court would have to decide, on a comparison of the two marks, and the parts thereof which are phonetically similar, as to whether such phonetic similarity is likely, considering all other circumstances, to confuse or deceive a purchaser of average intelligence and imperfect recollection, always bearing in mind the nature of the goods, and the degree of circumspection which would be expected of the purchasers who would purchase such goods.

(ix) The Court is required to examine whether the essential features of the plaintiff's mark are to be found in the mark of the defendant. Identification of the essential features is a question of fact, left to the discretion of the Court.

(x) No objective standards are possible, regarding the degree of similarity which is likely to cause deception. It has to be seen from the viewpoint of the purchasers of the goods.

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(xi) The test to be applied would depend on the facts of the case. Precedents are valuable only to the extent they specify tests for application, and not on facts.

(xii) On the issue of deceptive similarity, and especially with respect to the aspect of phonetic similarity, English cases are not of relevance. English cases are useful only to the extent they aid in understanding the essential features of trade mark law. The tests for deceptive similarity, which apply in other jurisdictions, may not always apply in India."

20. Bearing in mind those principles leads us to the irresistible conclusion that the Trial Judge has rightly answered the question of deceptive similarity. As noted hereinabove, applying the phonetic as well as the visual tests, it is manifest that the prima facie view as taken by the Trial Judge is clearly sustainable. We additionally hold that the view expressed would have warranted interference provided it had been established that the prima facie opinion suffered from a perversity, material irregularity or was an outcome of an arbitrary exercise of discretion. The impugned order fails to satisfy the aforementioned tests which must guide the exercise of power by the appellate court.

21. We also bear in mind the undisputed fact that the plaintiff had claimed a prior user from January 1965. The application which came to be made by the appellant in 2021 was on a "proposed to be used"

basis. The Trial Judge has also taken into consideration the undisputed fact that the appellant itself had sought registration of the word "RANI" albeit on a proposed to be used basis. This too was a factor which clearly weighed against the appellant. For all the aforesaid reasons, the Trial Judge clearly appears to have been justified in confirming the ex parte injunction.

22. Insofar as the issue with respect to the Disclaimer is concerned, it becomes pertinent to note that the same as submitted by the plaintiff was restricted to the use of the word "BRAND". Thus nothing This is a digitally signed order.

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23. It may be lastly noted that in Phonepe, the prayer for injunction came to be rejected with the Court significantly observing as follows: -

"(x.) Barring the common "Pe" suffix, it cannot be said that the "PhonePe" trademark of the plaintiff and the "BharatPe" trademark of the defendant are confusingly or deceptively similar. As words, they are entirely different, except for the "Pe" suffix. "Phone" and "Bharat" are not even phonetically similar. Besides, the triangular device is unique to the defendants, and is not to be found in the plaintiff's mark. Indeed, the case set up by the plaintiff is essentially on the basis of the "Pe" suffix.

Deceptive similarity, between the plaintiff's and defendants' marks is claimed, apart from the common "Pe" suffix, only on the ground that both are in purple colour, and in similar font. Besides the fact that these are, prima facie, insufficient to make out a case of confusing or deceptive similarity, it does not appear, at a plain glance, that the colouring of the letters in the two marks, or their font, is the same.

(xi) Besides, the nature of services provided by the plaintiff and the defendant's is also different. The plaintiff provides a plaintiff online payment portal. The written statement of the defendants, on the contrary, avers that the defendants provide a single QR code, on the basis of which the customer could work with all consumer UPI-based applications, including the "PhonePe" application of the plaintiff. Consumers who deal with such applications may be expected, prima facie, to know the difference. No prima facie case of passing off can, therefore, be said to exist, even on this ground."

The facts that obtained in Phonepe were thus clearly distinct and distinguishable from those which formed part of the present proceedings.

24. Accordingly and for all the aforesaid reasons, we find no merit in the challenge laid to the impugned order. The present appeal fails and shall stand dismissed.

YASHWANT VARMA, J.

DHARMESH SHARMA, J.

MAY 31, 2023/bh This is a digitally signed order.

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