IN THE HIGH COURT OF JUDICATURE AT BOMBAY

ORDINARY ORIGINAL CIVIL JURISDICTION

IN ITS COMMERCIAL APPELLATE JURISDICTION

COMMERCIAL APPEAL (L) NO. 42036 of 2025
WITH
INTERIM APPLICATION (L) NO. 42059 OF 2025
IN
COMMERCIAL APPEAL (L) NO. 42036 OF 2025

Kataria Insurance Brokers Pvt. Ltd	..	Applicant/Appellant (original plaintiff)

In the matter between

Kataria Insurance Brokers Pvt Ltd		Appellant (original plaintiff)

Versus

Bhavesh Suresh Kataria, Proprietor of and Trading as Kataria Jewellery Insurance Consultancy	..	Respondent/original defendant

...

Mr. J.P. Sen, Senior Advocate with Mr. Kunal Vaishnav, Ms. Monika Tanna, Ms. Dhara Modi and Ms. Harkirat Kaur i/b Singhania Legal Services for the appellants.

Dr.Virendra Tulzapurkar, Senior Advocate with Ashutosh Kane, Kanak Kadam and Ms. Archita i/b W.S. Kane and Co. for the respondents.

CORAM : BHARATI DANGRE &
R.N. LADDHA, JJ
DATED : 23rd FEBRUARY, 2026

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JUDGMENT:- (Per Bharati Dangre, J)

1. The present Appeal filed by the appellant, 'Kataria Insurance brokers Private Ltd', raise a challenge to the judgment dated 8/12/2025, passed by the learned Single Judge on an Interim Application No. 1663/ 2021 in Commercial IP. Suit No. 215/2021 instituted by Bhavesh Suresh Karatia, Proprietor of and trading as 'Kataria Jewellery Insurance Consultancy'. By the impugned judgment, the Interim Application was made absolute in terms of its prayer clause, by recording that the plaintiff had made out a strong prima facie case, and the balance of convenience is in its favour, and if injunction is not granted, it would cause irreparable injury to the plaintiff, it would also prejudice the public at large.

The defendant in the suit, 'Kataria Insurance Brokers Private Limited' is the appellant before us, and in the Commercial Appeal (L) No. 42036/2025, has taken out Interim Application(L) No.42059/2025, seeking stay of the judgment dated 8/12/2025. By a consensus expressed by the respective learned senior counsel appearing for the appellant and the respondent, it was agreed that the Appeal itself shall be argued finally, instead of the Interim Application for stay of the judgment being taken up for hearing.

2. We have heard learned Senior Counsel Mr. J.P Sen, for the appellant and learned Senior Counsel Mr. Virendra Tulzapurkar representing the respondent.

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Bhavesh Suresh Kataria, an Insurance Consultant, conducting his business as proprietary concern under the name and style 'Kataria Jewellery Insurance Consultancy', claim to be specializing in insurance for Gems and Jewellery, instituted a Suit on the Ordinary Original Jurisdiction of this Court for infringement of Trademark and Passing off by impleading "Kataria Insurance Brokers Private Limited", a Company registered under the Companies Act, as the defendant, who is also offering insurance related services from its address mentioned in the cause title, in Ahmedabad, Gujarat.

3. The claims staked that the plaintiff started the business of offering life and general insurance policy, including Jeweller's Block Insurance Policy since 1999, and since the year 2004, he started conducting business of providing insurance policies and decided to concentrate and developed a niche in jewellery market, and changed his trading name and style from 'Kataria Insurance Consultancy' to 'Kataria Jewellery Insurance Consultancy'.

Pleading that the name, "KATARIA" formed the leading essential and memorable feature of trading, the plaintiff claimed to have been using the mark "KATARIA" openly, regularly, continuously and extensively in respect of said services since the year 2004. He claimed that he had earned huge revenue by rendering the services under the said mark/name and taken efforts for promoting the said services

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under the said trademark and due to the superior quality of the services rendered under the said mark, it has become well known and the plaintiff has acquired immense goodwill and reputation therein, and the Trademark exclusively connotes and denotes to the members of the trade and the public, the services of the plaintiff's origin.

4. As per the plaintiff, on or about 29/9/2007, he registered and started using the domain name/website www. kataria.insurance containing the said trademark, with a view to have presence over the internet and facilitate faster business and plaintiff continue to use the domain name for conducting his business, even after changing the trading name and style i.e. 'M/s. KATARIA JEWELLERY INSURANCE CONSULTANCY'.

According to the plaint, plaintiff applied for and secured registration of trademark/name of 'Kataria' and 'Kataria Jewellery Insurance Consultancy' under the following particulars,

Trade Mark	Registration No.	Date of Registration	Class	Services
KATARIA JEWELLERY INSURANCE CONSULTANCY (label mark)	1969420	21/05/2010	36	Real Estate Affairs, Insurance Financial Affairs, Monetary Affairs.
KATARIA	4174551	13/05/2019	36	Insurance, Financial Affairs, Monetary Affairs, Real Estate Affairs.

The plaintiff claim that the registrations were renewed from time to time and are currently valid and subsisting.

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Pleading that the trade name/name, along with the domain name and the trading name and style had become descriptive for plaintiff's aforesaid services and business, and it was associated by the traders and the members of the public exclusively with plaintiff, and with no one else, the plaintiff claim to have acquired statutory, as well as common law rights in the said trademark/name, and claim that he is entitled to exclusive use thereof in relation to the aforesaid services.

Alleging that in January 2014, the plaintiff gained knowledge about the defendant having registered a Company under the corporate name, "Kataria Insurance Brokers Private Limited", with the Registrar of Companies, Ahmedabad, he objected to the defendant's adoption of the impugned corporate name and the Assistant Registrar of Companies informed the defendant about the plaintiff's objection and also informed that "KATARIA" is a registered trademark in respect of services in Class 36 and called upon the defendant to suggest alternative names. Attention of the defendant was also invited by the Assistant Registrar to an undertaking dated 13/12/2013 signed by one Mr. Rohan Rajendra Kataria, one of the Directors of the Company, who gave an undertaking to alter the name of the Company, if required, in case there is an objection raised. According to the plaintiff, despite a clear direction to the aforesaid effect, the defendant did not take any steps, and the plaintiff send a 'Cease and Desist' notice to the defendant,

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informing about the plaintiff's statutory and common law rights, which received a specific denial from the defendant, who adopted a plea that it is a part of kataria group of companies, which has allegedly been using name 'kataria' for several years, and the Group Company, "Kataria Automobiles Private Ltd" (for short 'KAPL') has been trading in automobiles and ancillary services and providing general insurance services, including automobile/motor vehicles and the name 'KATARIA', was first adopted by defendant's promoter in the year 1955. The defendant, therefore, raised a specific objection that Kataria is its surname/family name and the defendant has a right to use the same in a bonafide manner, and the plaintiff cannot have proprietary right to use the same to the exclusion of others.

Apart from this, it is also the stand adopted by the defendant, that the plaintiff does not hold any registration for the mark 'Kataria Insurance', or 'Kataria', and the defendant is not using the plaintiff's trademark as registered. The contention of the plaintiff that there was correspondence back and forth, the last communication being the letter addressed by the plaintiff to the defendant on 3/10/2014, but since there was no response, the plaintiff was under the bonafide belief that defendant had discontinued the use of impugned trademark and the corporate name. However, during an online search, the plaintiff came across defendant's domain name, 'www.katariainsurance.co.in' through which the defendant was advertising, promoting, and offering insurance services, and

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once again, the plaintiff resorted to issuance of a notice to the defendant to stop the use of the impugned trademark, but did not receive any response, and he addressed a communication to the Registrar of Companies Ahmedabad, who did not take any cognizance of the grievance of the plaintiff.

5. In the aforesaid background, the plaintiff who had it's place of business in Mumbai, instituted the Suit against the defendant by itself, and all persons claiming under it, from infringing its registered trademarks in Class 36 by using the impugned trademark 'KATARIA INSURANCE', the impugned domain name/website www.katariainsurance.co.in, and the impugned corporate name containing the mark "Kataria Insurance" or any other trademark, domain name website and corporate name containing the word 'KATARIA' or any other mark identical with/or deceptively similar to the plaintiff's registered trademark in respect of the services covered by the plaintiffs registration or in any other manner whatsoever. The plaintiff also sought a restraint order against the defendant from rendering, offering, promoting, or advertising the impugned services under the impugned trademark/impugned domain name/website, and impugned corporate name, so as to pass off or enable others to pass off it's services for the well-known services and/or business of the plaintiff.

The plaintiff also sought damages in the sum of Rs. Five lakhs for the act of infringement of trademark and passing off committed by the defendant.

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6. During the pendency of the Suit with the aforesaid reliefs, the plaintiff filed an Interim Application under Order XXXIX Rule 1 and 2 read with Section 151 of the Code of Civil Procedure, seeking a temporary order and injunction against the defendant by itself, it's Directors, employees, servants, and agents from infringing the plaintiff's registered trademark and from rendering, offering, promoting or advertising the impugned services under the impugned trademark/domain name/corporate name, so as to pass off or enable others to pass off the defendant's services and for the well-known services and business of the plaintiff.

It is this application which received consideration from the learned Single Judge, who granted the relief prayed by the plaintiff, accepting the plea of infringement and passing off against the defendant.

7. Perusal of the impugned order would disclose that on the plaintiff making out a prima facie case for infringement u/s.29 of the Trademarks Act, based on the well settled parameters of (1) existence of a valid registration (2) impugned trademark, being identical or deceptively similar to the registered trademark, and (3) use of impugned trademark in relation to goods or services, identical or similar to those for which mark is registered, it is held by the Single Judge that the plaintiff is a registered proprietor of the word and device mark "Kataria" in Class 36 for insurance related services, and the defendant is using the mark 'Kataria Insurance", and the

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corporate name “Kataria Insurance Brokers Private Limited”, all of which are identical or deceptively similar to the plaintiff's mark. Further, recording that the defendant's services are in the very field of insurance covered by the plaintiff’s registration, the plaintiff had established the requisite ingredients u/s.29 of the Trademark Act.

The plea of the defendant that ‘Kataria’ is a surname and constitutes bonafide adoption, was not accepted, as the impugned judgment record a finding that Section 35 of the Trademark Act only applies to person, (private party) using their own surname and does not apply to any any corporate entities, who can consciously choose their trade names. Reaching a conclusion that the plaintiff's mark ‘Kataria’ has proved long continuous and extensive use, in insurance sector, denote a single identifiable source, the defendant’s adoption was found to be prima facie dishonest and not bonafide. The defendant's plea of prior user was also found to be totally untenable by the learned Single Judge, as the alleged user by a separate and legal distinct entity i.e. KAPL, which the defendant alleged to be a group company, was in respect of Kataria Automobiles, and therefore the use of impugned trademark ‘Kataria’ in unrelated fields or different entities was held, not constituting prior user for the purposes of defeating claim of infringement or passing off.

With a clear finding rendered that the plaintiff is a registered proprietor and prior adopter of the trademark

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"KATARIA" and has established its goodwill and reputation, by placing reliance upon the Chartered Accountant's Certificate, reflecting annual income of the plaintiff as well as the annual promotional expenses from the years 2004–05 to 2017–18, the learned Single Judge concluded that the plaintiff and the defendant are using their respective marks for the same service i.e. insurance and it is plainly antithetical to the canon principle of trademark law, which is one mark, one source. Considering the similarity between the marks, the learned Judge concluded that the continued use by the defendant will inevitably lead to confusion, diversion of business and dilution of goodwill of the plaintiff, resulting into irreparable harm, not only to the plaintiff but also to the consumer, hence, the Interim Application was made absolute in terms of prayer clauses (a) and (b).

8. The learned senior counsel Mr.J.P. Sen representing the defendant against whom the injunction was granted i.e. 'Kataria Insurance Brokers Private Limited', the appellant before us would submit that the predecessor of the appellant's promoter incorporated a partnership firm under the name and style of 'Kataria Transport Company' on 9/8/1955, which was dissolved on 20/10/1979, with an understanding that though in the mutual interest of the partners, the business of partnership is discontinued by dissolving the partnership and by allotting the assets and business of the partnership firm to its partners, the partners were permitted to commence their

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business under the mark 'KATARIA'.

Thereafter, several companies were incorporated, which included 'Kataria Infrastructure Private Limited', being incorporated on 30/12/1982, for providing real estate services, whereas "Kataria Automobiles Private Limited" (KAPL), was incorporated on 10/5/1990. KAPL, according to Mr. Sen was the authorised dealer of Maruti Suzuki Ltd since 1996, and extended variety of services, including sales, servicing, transportation, logistics, and also rendering motor vehicle insurance services and other allied services with use of mark 'KATARIA' to it's customers.

On 2/12/2002, Kataria Motors Private Ltd was incorporated, which engaged in business of sale and servicing of automobiles and also provided Motor Vehicle Insurance Services. In 2011, M/s. Kataria Wheelers, a partnership firm was incorporated, which again dealt with the business of dealership of automobiles, and inter alia provided motor vehicle insurance services also. During the course of such activities being undertaken, the appellant "Kataria Insurance Brokers Private Limited", was incorporated for providing insurance services as an authorised agent under Insurance Regulatory Development Authority (IRDA), it being registered with Registrar of Companies (ROC), Ahmedabad, with Rajendra Kumar and Rohan Kataria, being named as its Directors/Promoters.

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9. It is the specific submission of Mr.Sen that the respondent in the Suit was, all the while, engaged in business of automobiles, including its sale and servicing, and also providing motor vehicle insurance services. Kataria Insurance Brokers Private Limited, was specifically incorporated in the year 2014 as insurance broker, and according to him, the activity of Kataria group was implemented through various companies/partnership firm, and though the activity was mostly focused in automobile sector and providing vehicle insurance services, it also expanded to real estate, warehouses, renewable energy generation, as well as vehicle recycling. According to him, the group revenue of Kataria Group for the financial year 2020–21 to 2024–25 is Rs.17,26,885.77 and the amount spent on advertisement and sale promotion is 7905.38 lakhs.

Mr. Sen urge that, the defendant adopted defence of Section 35 in the action of infringement and passing off at the instance of the plaintiff, and this defence was of bonafide use of family name 'KATARIA'. Apart from this, he would submit that the respondent is engaged in general insurance as distinguished from the plaintiff who, according to its own case, was in jewellery insurance, and the nature of business carried out by the two entities is completely distinct. Mr. Sen would invoke the principle laid down by the Delhi High Court in **M/s.Marc Enterprises Private Limited Vs M/s.Five Star Electricals (India)**

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and Anr,[1] where the Court by relying upon the decision of the Apex Court in **Vishnudas Trading as Vishnudas Kishendas Vs. Vazir Sultan Tobacco Co. Ltd,**[2] which held that if a trader or manufacturer trades in or manufactures only one or some of the articles coming under broad classification and such trader or manufacturer has no bonafide intention to trade in or manufacture other goods or articles, which also fall under the said broad classification, such trader or manufacturer should not be permitted to enjoy monopoly in respect of all the articles which may be covered under broad classification, and by that process preclude the other traders or manufacturers to get registration of separate or distinct groups, which may also be grouped under broad classification. According to Mr. Sen, a class of registration, may be broad, but that do not mean that registration of a trademark cannot be absolute, perpetual, and invariable in all circumstances, and one cannot claim right over every item following under a class. According to Mr.Sen, 'Insurance' is a broad category, and there might be different types of insurances, and as the defendant is engaged in automobile insurance, but do not touch jewellery insurance, but the plaintiff is engaged in jewellery insurance consultancy. Mr.Sen on behalf of the appellant (Kataria Insurance Broker Pvt Ltd), make a statement that he will not deal with jewellery insurance, and his undertaking may be recorded to that effect. Mr. Sen would rely upon the following decisions :-

1 2008 SCC Online Del 310
2 (1997) 4 SCC 201

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10. It is the specific contention raised by Mr. Sen that the learned Single Judge has failed to appreciate the scope of Section 35 of the Trademarks Act, 1999 and he would place heavy reliance upon the decision of the Delhi High Court in **Jindal Industries Private Limited Vs Jindal Sanitaryware Private Ltd and another**,[3] where the assertion of the counsel for the plaintiff that 'name' cannot be used as a trademark when Section 35 is read with Section 29 (1) of the Act, was not accepted, and it is categorically concluded that the plaintiff cannot monopolize use of 'Jindal' in the context of PVC pipes and tubes, particularly when there are many marks of 'Jindal', available on the register and the plaintiff have themselves agreed to co-existence with another Jindal user and have sought to plead dissimilar with identical Jindal mark, which was without any basis.

11. Per contra, the learned counsel Mr. Tulzapurkar appearing for the Respondent before us, assertively submit that the business of the plaintiff carried under the mark, 'KATARIA' is not restricted to jewellery only, and when it applied for and secured registration of trademark 'Kataria' vide Registration no. 4174551 on 13/5/19 with the user claim from 7/4/2006, its registration is in Class 36, Insurance, Financial Affairs, monetary affairs.

In addition, the plaintiff has secured registration of "Kataria Jewellery Insurance Consultancy, Gold and Diamond

3 CS(COMM) 251/2023

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Insurance", vide registration no. 1969420 on 21/5/2010, and the services under Class 36 in the Registration Certificate, extend to real estate affairs, insurance, financial affairs, monetary affairs. Thus, according to him, the trademark 'Kataria' is synonymous with services in insurance, real estate, financial affairs, and monetary affairs.

By relying upon Section 28 of the Trademarks Act, 1999, Mr. Tulzapurkar would submit that upon registration of the mark, the plaintiff is entitled to the exclusive right to the use of the trademark, in relation to the goods or services, in respect of which the mark is registered, and he is entitled to obtain relief in case of infringement of the trademark. Thus, according to him, upon securing registration of the mark 'KATARIA', it has given the plaintiff exclusivity over insurance, and definitely it is not restricted. Further by relying upon Section 29 of the Act, it is the submission of Mr. Tulzapurkar, that if a registered trademark is infringed by a person, not being a registered proprietor or a person entitled for permitted user, and if he uses a mark, which is identical with or deceptively similar to the trademark and relation to the services in respect of which the trademark is registered, it amounts to infringement of the registered trademark. If by any manner, a registered trademark is infringed by a person, because of its similarity to the registered trademark, and it is likely to cause confusion on part of the public, or which is likely to have association with the registered trademark, his registered

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trademark deserves protection. Therefore, it is the contention of Mr. Tulzapurkar, that the plaintiff's family name 'KATARIA', form the leading essential and memorable future of his trading name and style, and since the year 2004, the plaintiff has been openly, regularly, and continuously using the trademark and name in respect of the services of insurance. According to Mr. Tulzapurkar, plaintiff has been using the trademark and name 'Kataria' in respect of the business since the year 2004, and it registered and started using the domain name/website. www.kataria.insurance.com.

In order to establish a claim for trademark, infringement, the three pre-requisites being existence of a valid registration, impugned trademark, or name being identically or deceptively similar to the registered mark in question and the impugned trademark being used in relation to the goods or services that are identical or similar to those covered by the registration are all attracted in the present case. It is urged that the plaintiff has registration of not only the label mark, but the word mark 'Kataria', in respect of insurance services, and the impugned trademark 'Kataria insurance', the impugned domain name www.katariainsurance.co.in and the impugned corporate name of the defendant 'Kataria Insurance Brokers Private Limited' are all identical and/or deceptively similar to plaintiff's registered trademark, and not only this, the services in respect of which the defendant is using the impugned trademark, and corporate name is identical to the services covered by plaintiff's

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registered trademark, and therefore, a clear case is made out for infringement.

Apart from this, according to the learned senior counsel, when the plaintiff sought the relief of passing off, it was required to demonstrate its goodwill, misrepresentation and loss, and/or likelihood of loss. The plaintiff's prior adoption and long-standing, open and continuous use of the trademark, the existence of goodwill was evidently clear, as in the Suit for infringement of trademark and passing off, and the Interim Application filed under order XXXIX Rule 1 and 2, the plaintiff prima facie demonstrated that the defendant, by using the impugned trademark, impugned corporate name and impugned domain name/website attempted to trade on the goodwill, of the plaintiff created for years, and in fact, the defendant ought to have conducted a market survey, when it would have come across the plaintiff's trademark, the domain name/website and the training name and style, and the services rendered thereunder, coupled with its immense goodwill and reputation which had accrued. However, the defendant knowingly and deliberately adopted the impugned trademark, impugned domain name/ and the impugned corporate name, with a view to sail close to the wind to trade upon the enviable reputation accrued to the plaintiff over considerable period of time, so as to make unlawful gains.

Mr. Tulzapurkar would submit that the plaintiff clearly established that, by advertising and promoting the

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services through the impugned domain name/website, the defendant was diverting the plaintiff's customers to the impugned domain name/website, the only difference between the plaintiffs domain name, and the defendant's impugned domain name/website being of ".com" and ".co.in". Claiming that the domain name used by the defendant is almost identical with the plaintiff's domain name, the plaintiff's customers or a prospective client in an attempt to access its domain name/ website is likely to be directed to the defendant's impugned domain name/website, as the customer is not likely to notice the minute difference in ".com" and ".co.in".

Since the plaintiff was able to establish the mischievous adoption of the impugned domain name/website, and also the mark 'Kataria Insurance' being compared with the impugned corporate name "Kataria Insurance Brokers Pvt. Ltd" which is phonetically, structurally, closely and deceptively similar to the plaintiff's mark 'Kataria', the defendant had infringed and continued to infringe the plaintiff's trademark with different registration numbers, both in Class 36. By establishing that, with regard to the enviable reputation and goodwill acquired by the plaintiff in the said trademark, and in the trading name and style by including the trademark 'Kataria' as it's leading and essential feature, the plaintiff was able to establish that the use of the impugned trademark by the defendant in respect of the same/similar services is bound to cause confusion and deception amongst the members of the

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trade and public, and/or is bound to pass off the defendant's impugned services rendered under the impugned trademark, the impugned domain name and the impugned corporate name, and a new customer may not be able to notice the difference. Mr. Tulzapurkar would clarify that initially, though the plaintiff had started it's business under trading name 'Kataria Insurance Consultancy' and was offering life and general insurance policies, the members of the trade and public, coming across defendants impugned trademark may be misled to believe that the plaintiff has expanded its business, and once again, offering insurance policies and related services under the impugned trademark/domain name, and the corporate name, and it may enhance the probability of initial interest confusion on account of close and deceptive similarity between the rival trademarks, domain name/website and corporate name/trading name and style.

12. Mr.Tulzapurkar would, therefore, support the impugned order and submit that the learned Single Judge has rightly noted the deceptive use of the registered trademark of the plaintiff by the defendant. He would also place heavy reliance upon the decision of this court in **Kirloskar Diesel Recon (P) Ltd and ors Vs. Kirloskar Proprietory Ltd and ors**,[4] which is a decision delivered on Section 34 of the Old Trademarks Act, and by specifically relying upon the observation of the Division Bench, to the effect that saving for use of name as provided in Section 34 of the Act, do not apply

4 1997 PTC (17)

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to artificial persons like incorporated company, as the company has a choice of adopting the name, which a natural person do not have, it is his submission that the attempt of the respondent to adopt the name, in no way, can be considered to be bonafide and the defence adopted under Section 35 has rightly been not entertained by the Single Judge. He would also place reliance upon the decision of Delhi High Court in case of **Montari Overseas Ltd Vs. Montari Industries Ltd,**[5]

13. The learned Single Judge, while deciding the Interim Application filed by the plaintiff, pending the hearing and final disposal of the Suit for infringement and passing off, considered the prayer for a restraint order against the defendants, by way of temporary order and injunction from infringing its two registered trademarks, both in Class 36 by the impugned trademark of the defendant 'Kataria Insurance', along with the impugned domain name 'www.kataria.insurance.co.in' and the impugned corporate name 'Kataria Insurance', containing the word 'Kataria'. The plaintiff, Bhavesh Suresh Kataria claimed to have started the business of life and general insurance policies, including Insurance in Jewellery, though it is a claim staked that, in the year 2004, it started conducting the business of providing insurance policies in the name of 'Kataria Insurance Consultancy'. However, in 2006, according to the plaintiff, **decided** to focus on jewellery market, and indulged in offering insurance policies and related services in "Gems and Jewellery

5 1996 PTC (16)

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Sector", and therefore changed its trading name to 'Kataria Jewellery Insurance Company'. The plaintiff obtained registration for the aforesaid trademark and secured registration on user claim in Class 36 and it extended to real estate affairs and insurance. In the year 2019, another registration of trademark 'Kataria' is secured again in Class 36 for 'insurance services'. Therefore, the claim of the plaintiff before the learned Single Judge is that it has been using the trademark and name 'Kataria' in respect of the business since 2004, and also registered and started using domain name/website www.katariainsurance.com.

14. The plaintiff staked its claim for an injunction against the defendant, who, according to it, infringed the registered trademark of the plaintiff, which was entitled to protection and being confronted from time to time, failed to take any corrective measures.

The relief sought by the plaintiff was contested by the defendant by adopting the specific stand that it was a bonafide user of the impugned trademark, and it was a prior user.

The claim of bonafide user by the defendant was based on the protection granted u/s. 35 of the Trade Marks Act, as the defendant claimed to have adopted the trademark in a bonafide manner by using the surname/family name of one of its founding members, and therefore, it was entitled to protection u/s.35.

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The bone of contention between the parties is about the protection u/s.35 being applicable to incorporated entities, as the plaintiff claim that it is not available to a Company, as adoption of the name/mark is by choice and in case of natural persons, there is no choice. The defendant, however, contested the contention, and since this was a primary defence in opposing the injunction and the learned Single Judge rendering a finding that the defendant's plea that 'Kataria is a surname and constitutes bonafide adoption is untenable, as Section 35 of the Trademark only apply to the person (private party) using their own surname and is not available to incorporated entities that consciously chose their trade name.

15. We must, therefore, deal with the rival contentions in this regard. Section 35 of the Trade Marks Act reads thus:-

> **"35. Saving for use of name, address or description of goods or services**.- Nothing in this Act shall entitle the proprietor or a registered user of a registered trade mark to interfere with any bona fide use by a person of his own name or that of his place of business, or of the name, or of the name of the place of business, of any of his predecessors in business, or the use by any person of any bona fide description of the character of quality of his goods or services.
>
> Objects and Reasons-Clause 35.-This clause corresponds to section 34 of the existing Act and provides that the registered proprietor or the registered user cannot interfere with any bona fide use by a person of his own name, or his predecessor in business, his place of business or bona fide description of the character or quality of the goods or services."

The above Section thus postulates that no provision in the Trade Marks Act, authorise the owner or registered user of registered trademark to interfere with any authentic use by individuals of their own names, or that of their site of business,

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or the name of the site of business or the name of any of their predecessor in business, or the use by any individual of authentic description of the character or qualities of their goods or services.

16. An issue involving Section 35 arose for consideration on more than one occasion in the past, before the Higher Courts and to begin with, we would refer to the decision of the Apex Court in **Precious Jewels and Anr Vs. Varun Gems[6],** which arose in the background facts that the partners of the plaintiff as well as the defendant firms, belonging to the same family, sharing a common surname "RAKYAN". Both the plaintiff and the defendant were running a family business of jewellery, and the defendants are conducting it in the name and style of 'nina and "ravi rakyan", where the plaintiff was conducting it in the name and style of "RAKYAN FINE JEWELLERY, both businesses being run in New Delhi through shops abutting each other. When the plaintiff claimed trademark of their surname "RAKYAN", and by filing a Suit, sought a restraint order on the defendants from carrying out their business and filed an application for interim relief, the impugned order restrained the defendants from doing their business, and that is how the Appeal came before the Apex Court.

The dispute came to be appreciated in the wake of the admitted fact that the partners of the plaintiff and the defendant belonged to one family, and there are not less than

6 2015 1 SCC 160

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15 business units belonging to the family members. The appellant running a business in the name and style of "NINA and RAVI RAKYAN" urged that they could not be restrained from carrying on his business in their own name, by specifically raising a defence of Section 35. The respondents in the Appeal, contested the stand and urged that they had no right to use the word 'RAKYAN' in the name of their shop.

Restricting the scope of the Appeal to the interlocutory order, the Apex Court observed thus :-

> "9. As stated hereinabove, Section 35 of the Act permits anyone to do his business in his own name in a bonafide manner. In the instant case, it is not in dispute that the defendants are doing their business in their own name and their bonafides have not been disputed. It is also not in dispute that the plaintiff and defendants are related to each other and practically all the family members are in the business of jewellery. We have perused the hoardings of the shops where they are doing the business and upon perusal of the hoardings we do not find any similarity between them.
>
> 10. In our opinion, looking at the provisions of Section 35 of the Act, there is no prima facie case in favour of the plaintiff and therefore, the defendants could not have been restrained from doing their business. We, therefore, quash and set aside the impugned order[1] granting interim relief in favour of the plaintiff and the appeal is allowed with no order as to costs."

17. In **Jindal Industries** (supra) decided by Delhi High Court, the defendants were Suncity Sheets Private Limited & Anr, (SSPL) and Rachna Jindal, the defendant no.2 was Nitinkumar Jindal's wife, Manager of SSPL. The plaintiff, Jindal Industries Private Ltd, filed an interlocutory application, requesting for an order of injunction, as it was its claim that the defendants infringed its trademark 'JINDAL', by using the trademark 'RNJ RN JINDAL SS TUBES" label. The defendants pleaded that they used their surname 'JINDAL' in the trademark,

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and invoked Section 35 of the Trade Marks Act. The defence adopted was 'JINDAL' was a commonly used surname, and if the surname is used as trademark, such usage was authentic.

On a detailed consideration of the rival claims, and with specific reference to Section 35, the learned Single Judge of Delhi High Court observed that when one obtains registration of a common name, or a surname like JINDAL, as a trademark in his favour, does so with all the risk that such registration entails and it is open to anyone and everyone to use his name on his goods, and therefore, the possibility of there being several JINDAL's looms large. A significant observation in the decision reads thus:-

> "The plaintiff cannot by obtaining registration for JINDAL as a word mark, monopolize the use of JINDAL even as a part – and not a very significant one at that-of any and every mark, even in the context of steel, or SS pipes and tubes. The Trade Marks Act, and the privileges it confers, cannot be extended to the point where one can monopolize the use of a common name for goods, and, by registering it, foreclose the rest of humanity from using it."
>
> "If one registers a mark which lacks inherent distinctiveness, the possibility of others also using the same mark for their goods, and of the registrant being powerless to restrain such use, is a possibility that looms large, which the registrant has to live with."

Another pertinent observation also needs reproduction which is to the following effect:-

> "40. To the extent it protects against interference with the use of one's name, Section 35 has to be understood in the context of the law enunciated in the above decision, and those cited within it. The right of a person to use her, or his, own name on her, or his, own goods, cannot be compromised; else, it would compromise the right to use one's name as an identity marker, which would ex facie be unconstitutional.

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> 41. In the absence of any such caveat to be found in Section 35, it may be arguable, at the very least, whether, while the use of one's name as an identity marker is permissible under Section 35, but the instance it spills over into "trade mark" territory, it is rendered impermissible. Any such interpretation, in my prima facie view, would be reading a non-existent proviso into Section 35 and, in effect, rewriting the provision.
>
> 42. The proscription under Section 35 is absolute, and would extend to infringement as well as passing off actions. The restraint against interference with the bona fide use, by a person, of his own name, is not dependent on whether the action is one for infringement or passing off.
>
> 43. The plaintiff's prayer for injunction is, therefore, bound to fail even on the sole anvil of Section 35."

Even on examining the merits of the case, it was concluded that no case for infringement or passing off is made out, as the impugned mark that the defendant's possessed added matter and added features, which clearly distinguished it from the JINDAL mark of the plaintiff and the defendants quite clearly made every effort to minimise any chance of confusion by prominently using initials 'RNJ', along with the complete name of the proprietorship of defendant no.2 "RNJ Stainless Steel" below it. The use of the impugned mark by the defendants, therefore, was held not to be regarded as passing off their goods as to that of the plaintiffs.

The defendants, therefore, enjoyed the benefit of Section 35, the use being bonafide, and in good faith.

18. In **Jindal Industries Private Limited Vs. Jindal Sanitaryware Pvt Ltd. & Anr.**[7], another decision of Delhi High Court, where a Suit was filed by the plaintiff seeking a decree for permanent injunction, restraining the defendants from using

7 CS(COMM)251/2023,I.A.8888/2023&I.A. 13154/2023

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the marks jointly or severally or any other mark deceptively similar to the plaintiff's trademark, 'JINDAL' resulted in an ad-interim injunction granted in favour of the plaintiff. The plaintiff's grievance in essence was, the defendant had no registration for the mark 'JINDAL' in respect of the Poly Vinyl Chloride, ("PVC") pipes and it is the registered holder of the mark, J-Plex, but started using the mark 'JINDAL' for PVC pipes. Asserting prior user in respect of the Jindal for PVC pipes and registration with effect from 1/9/2006, the Court recorded that the user by the defendant no.1 of JINDAL for PVC pipes and fittings is recent and, in any event, later in point of time both to the registration and the user of the said mark in favour of the plaintiff for identical PVC pipes, and by recording a prima facie case for infringement, a restraint order was passed against the defendant.

On consideration of the stand adopted by the defendants upon its appearance after the interim order was passed, the registration of the mark 'JINDAL' in different form as regards the category of goods, i.e. PVC pipes and fittings, along with the galvanized iron pipes and tubes, was taken note of, the registration being in Class 17 and in Class-6. As far as the registration of defendants with mark 'JINDAL' was found to be in Class-11 and 20 for cisterns, toilet seats and parts, PVC and water storage tanks was taken note of. The defendant specifically placed before the Court the list of the entities, who had obtained registration of the mark 'JINDAL', and therefore it

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was claimed that the Plaintiff alone cannot claim exclusivity, as the plaintiff itself is not the owner of the mark 'JINDAL', as another entity 'JINDAL INDIA LIMITED' also claimed ownership and user.

The rival claims with the data placed before the Court for analysis took note of the stand of the plaintiff of exclusivity over 'Jindal' mark was not accepted, and the assertion of the plaintiff that a name cannot be used as a trademark when Section 35 read with Section 29(1) was found without substance and reliance in that regard was placed on the decision in case of **JINDAL Industries Vs. Suncity Sheets Pvt. Ltd. & Anr.** (supra), and a pertinent observation in this regard was recorded as below,

> "46. Reliance by defendant on Neon laboratories (supra) is appropriate as it holds that the proprietor of a mark does not have the right to prevent use by another party of an identical mark, which has user prior to the use or the registration by the proprietor.
>
> 47. Moreover, the plaintiff cannot monopolize the use of JINDAL' in the context of PVC pipes and tubes, particularly, when there are many marks of 'JINDAL' available on the register (as noted in para 28); the plaintiff have themselves agreed to co-existence with another 'JINDAL' user and have sought to plead dissimilarly with identical 'JINDAL' marks, which is without any basis."

19. The learned senior counsel Mr.J.P. Sen has placed reliance upon another decision of Delhi High Court in **M/s. Chandra Engineers versus Mrs. Multifrig Marketing Co. Pvt. Ltd. & Anr.**[8] which again revolved around Section 35 of the Trade Marks Act.

8 RFA (COMM) 352/2025&CM APPL.36957/2025

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The respondents, being the plaintiff in the Suit claiming to be the proprietor of trademark 'Chandra', registered, in Class 11 from 1982 for 'freezing and pulling machines, ice safes, air conditioning apparatus as stablizer for air conditioning apparatus'. It claimed to have amassed considerable goodwill and reputation over a period of time. It gained knowledge that the appellant M/s.Chandra Engineers was providing services in connection with the same item, in respect of mark 'Chandra' by using trade name 'Chandra Engineers', and this according to it amounted to infringement of their registered trademark.

The Commercial Court find favour with the claim in the plaint and granted decree of permanent injunction against the appellant and all others, acting on their behalf from using mark 'CHANDRA' as their business or trade name, which resulted into filing of the Appeal before the Delhi High Court.

Dealing with the statutory exceptions, both to infringement as defined in Section 29, as well as to the remedies available to a person who is registered proprietor of an infringed mark u/s. 28(1), the Court tested whether the case of the defendants fell within the circumstances envisaged u/s. 31 to 35 of the Trade Marks Act. It held that the aspect of infringement became inconsequential, as in such cases, even if infringement existed, no injunctive relief could be granted.

The reference is specifically made to Section 35 which is found to be worded as below:-

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> "28. Once such circumstance is to be found in Section 35, Section 35 proscribes interference, by the proprietor of a registered trademark, with the bona fide use, inter alia, by a person, of the name of any of his predecessors in business. As such, even if the use, by the person, of the name of his predecessor in business would amount, facially, to infringement within Section 29, no injunction against such use can be granted in view of the proscription contained in Section 35."
>
> "32. Though an opinion was mooted, in **Goenka Institute of Education & Research v. Anjani Kumar Goenka**, to the effect that the benefit of Section 35 would be available only if the full name of the proprietor or of the predecessor in interest was used, and not if only part thereof was employed, this Court, in **Vasundhra**, noted that the said proposition was stated even in **Goenka** to be merely orbiter. In **Vasundhra**, we have held that there is no proscription in Section 35 from the use even of the first name or the surname of the proprietor as the mark of the enterprise itself. There is no 'requirement that the complete name should be used. In that case, "Vasundhra" was the first name of the original proprietor who had adopted use of the name, which was Vasundhra Maitri. In the present case, the only difference is that "Chandra" is not the first name, but the surname of Phool Chandra, who was the proprietor of Chandra Enterprises."

The argument of the learned counsel that the case was clearly covered by the decision in case of Vasundhra Jewellers (P) Limited versus Vasundhara Fashion Jewellery LLP, was found to be appropriate, as it was contended that 'Chandra' was the surname of Phool Chandra, who was the sole proprietor of Chandra Engineers, which was the predecessor in interest of appellant firm and therefore, respondent was prohibited, in view of Section 35, on obtaining an injunction against the use of the mark 'Chandra' by the appellant.

20. At this juncture, we also deem it necessary to refer to the decision of Delhi High Court in **Vasundhra Jewellers Pvt Ltd. Vs. M/s. Vasundhara Fashion Jewellery LLP & Anr.**[9] (supra)

9 FAO(OS)(COMM)232/2023&CMAPPL.55117/2023

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dated 18/8/2025.

The appellant Vasundhra Jewellers, sought a decree of permanent injunction restraining the respondents and all others acting on their behalf from using the mark and domain names 'VASUNDHRA JEWELLERS' VASUNDHRA or the domain name www.vasundhra.in or any other mark, label or domain, which is identical or deceptively similar to its mark. The Suit was accompanied with application under Order 39 Rule (1) and (2), which was dismissed resulting into an appeal being filed before the learned Single Judge. It was the claim of the plaintiff/appellant that the respondent no.1 was using the mark 'Vasundhara' and was manufacturing and selling goods similar to it and was also operating a domain name www.vasundhra.in and using mark "Vasundhara" on social media accounts.

The defence adopted was that the name Vasundhara was a common and generic name, often used in indian families, and no party would claim exclusivity over its use. Defence of Section 35 was also pleaded by stating that the mark 'Vasundhara' was adopted by Vasundhara Mantri from her own name in 2001.

On a detail discussion, specifically focussing upon Section 35, as to whether the said provision is available to natural persons only and not corporate entities, and this discussion was found to be unwanted for the following reason :-

> "50. We are not required to enter into the merits of this contention, for the simple reason that the word VASUNDHARA

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> in the present case was coined and adopted by Vasundhara Mantri, who was an individual, for use by her proprietorship. The intellectual property rights of Vasundhara Mantri in the mark VASUNDHARA were assigned to Respondent 1 under the Assignment Deed dated 28 March 2019. Respondent 1, therefore, succeeded to the intellectual property rights of Vasundhara Mantri in the mark VASUNDHARA. Inasmuch as those rights were availed by an individual, the benefit of Section 35 would also be available to Respondent 1 as the assignee-in-interest of the intellectual property rights earlier held by Vasundhara Mantri."

Answering the question, as to whether benefit of Section 35 is restricted to use of full name, the Court expressed that there is no such limitation and the specific observation in that regard deserve a reproduction:-

> "53. In any event, in the absence of any particular stipulation, in Section 35, to the effect that it applies only where the full name is used, we are unwilling to read any such limitation into the provision. It is trite that courts cannot re-write the statute. A name is a name. It cannot be denied that VASUNDHARA was the name of Vasundhara Mantri. Mr. Sagar Chandra's submission that the protection under Section 35 would be available only if the respondents were to use the full name "Vasundhara Mantri", therefore, merely has to be stated to be rejected.
>
> 54. We, therefore, are of the opinion that, irrespective of the merits of the matter, there could have been no injunction restraining the respondents from using the mark VASUNDHARA in view of the protection available under Section 35 of the Trade Marks Act.
>
> 55. Of course, the benefit of Section 35 is available only in the case of bonafide use by a defendant of her, or his, name as a mark. In this regard, we are in entire agreement with the learned Single Judge that the use by the respondents of the mark VASUNDHARA is completely bona fide. VASUNDHARA was used by Vasundhara Mantri. It was her own name. There is nothing whatsoever on record on the basis of which her bona fides could be questioned. She has been using the mark without interruption since 2001 or, even as per the appellant's own showing, since 2005. The use of the mark VASUNDHARA by Vasundhara Mantri, and later by Respondent 1 has, therefore, necessarily to be treated as bona fide.

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> 56. It is, therefore, clear that the respondents would be entitled to the benefit of Section 35 of the Trade Marks Act. *De hors* the issue of infringement or passing off, therefore, the respondents cannot be denied the right to use the mark VASUNDHARA, in view of Section 35 of the Trade Marks Act."

21. Mr.Tulzapurkar appearing for the respondent has placed reliance upon the decision of this Court in Kirloskar Diesel Recon Pvt Ltd (supra), which was delivered in the background fact that "Kirloskar Proprietary Ltd and others" filed three suits for permanent injunction to restrain the appellants "Kirloskar Diesel Recon (P) Ltd." from using the word 'KIRLOSKAR' as a part of the corporate name and/or its trading style, so as to pass off or enable others to pass off the goods as that of respondents. The Suits were restricted to the passing off action and the applications for grant of injunction were filed, which were disposed of, by injuncting the defendants from using the word 'Kirloskar', as a part of its corporate name and the Appeals raised challenge to the same.

Each of the respondents, being a Company duly incorporated and registered under the Companies Act, belonged to 'Kirloskar Group of Companies', and the word "KIRLOSKAR" formed part of the corporate name, and it was a registered holder of various trademarks under the Trade and Merchandise Marks Act, 1958 and the registered holder of artistic word "KIRLOSKAR" in English, Hindi and Marathi, under the provisions of Copyright Act. They claim to be the registered user of various trademarks and/or copyrights, held possessed and owned by them, and some of them were the permitted

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users of the copyrights.

The appellants who opposed the claim in the Suit denied that the plaintiffs are the registered holder of the trademark 'Kirloskar', but it was stated that as many as 27 companies mentioned in the plaints, had used the name 'Kirloskar' as part of their corporate names, though they did not belong to Kirloskar Group of Companies as claimed.

The specific defence adopted was, 'KIRLOSKAR' is a surname, and by virtue of provision of Section 34 of the Act (present Section 35), the person having name 'Kirloskar' are entitled to adopt and use it as their trademark and/or trade name, and therefore the appellants have the right to use the same. It was also pleaded that the word 'Kirloskar' do not connote any distinctiveness, reputation, quality, or goodwill alleged to have been acquired by the plaintiffs.

22. The defence u/s.34 was examined, by recording that there was no force in the submission advanced that incorporation of word 'Kirloskar' as part of the appellant in each Appeal is bonafide, and u/s. 34 of the Act, they are entitled to use the same. The pertinent observation in this regard is :-

> "No doubt as per section 34 of the Act a proprietor or a registered user of a registered trade-mark is not entitled to interfere with any bonafide use by a person of his own name or that of his place of business, or of the name, or of the name of the place of business, of any of his predecessors in business, or the use by any person of any bonafide description of the character or quality of his goods. In the fact of the case, it can not be said that the use of the word "Kirloskar" as part of the corporate name of the 1st Appellant in each appeal is bonafide more particularly when admittedly the 2nd Appellant was associated in a high office with the "Kirloskar Group of Companies" as aforesaid and had participated in the image building campaigns and programmes of the Respondents and "Kirloskar Group of Companies".

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> The very fact that the Appellants have chosen to incorporate the word "Kirloskar" as part of the corporate names of 1st Appellant in each appeal shows that the Appellants want to trade on reputation of the Respondents and "Kirloskar Group of Companies", and also on the goodwill of the trade mark "Kirloskar" of which the 1st Respondent is the registered proprietor and Respondents 2 to 7 are registered users. Moreover saving for use of name, as provided in Section 34 of the Act does not apply to artificial person like an incorporated company."

23. The aforesaid observation, according to us, is delivered in the facts of the case, as the Suits instituted by the plaintiff were restricted to action of passing off, and that is the specific reason why the court noted that in passing off action, the plaintiff is not required to establish fraudulent intention on part of the defendant, and therefore it was not necessary to establish that the defendants, i.e. KIRLOSKAR DIESEL RECON (P) LTD, had fraudulent intention in incorporating the word 'KIRLOSKAR' as a part of their corporate name. It was held that it is not necessary for the plaintiff to prove causing of actual confusion amongst the customers or public at large by adoption of the word 'Kirloskar, and what was only required to be established, was a likelihood of deception or confusion, and therefore the grant of injunction in the claim of passing off was found to be justified.

24. In the facts placed before us, we, on the other hand, are required to pronounce upon the defence u/s. 35, as against the action of infringement along with an action of passing off, as even according to Mr. Tulzapurkar, it is on account of Section 29, the plaintiff with its registered mark is entitled to claim exclusivity on account of its mark being registered, and the

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relief sought in the Suit for infringement and passing off, is premised on its registered trademark being infringed by the defendant, not being a registered proprietor, or person using by way of permitted use, this very same mark, which is identically or deceptively similar to the trademark in relation to the services rendered by the plaintiff.

Dr.Tulzapurkar has also relied upon a decision of the Delhi High Court in **Montari Overseas Ltd Vs. Montari Industries** (supra), which is not a case u/s. 35, but it is a case in revolving around Section 20 of the Companies Act, 1956, providing that no Company will be registered by a name which is similar or identical or too nearly resembling the name by which a Company in existence, has been previously registered and Section 22 of the Act, making a provision for getting the name of the former altered. The pronouncement in the said decision is therefore, as regards the decision of the learned Single Judge in a Suit injuncting the defendant from using the word 'Montari' or any other word deceptively similar thereto as part of its corporate name.

The plaintiff M/s. Montari Industries Limited, being incorporated in 1983, was engaged in manufacturing products like Chemicals, Agro-chemicals, paints, cosmetics, etc, whereas M/s. Montari Overseas Ltd was incorporated in 1993 with a claim that its field of operation, being distinct from that of the plaintiff, and it was specifically noted that when the suit was filed, the factory of Montari Overseas was under construction

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and was not completed, even when the impugned order was passed by the learned Single Judge. Montari Overseas became public only in 1995, and having come to know about its existence in the capital market, the Suit was filed for permanent injunction, and mandatory injunction and damages, along with the application for injunctive relief. An ex-parte injunction was claimed against the defendant from using, trading and making public issue under the name Montari Overseas Limited.

The injunction passed by the learned Single Judge was based upon the reputation or goodwill in business attached with the trade name adopted by house and that copying of the name by competitor is likely to cause injury to its business. Admittedly, the focus was only Section 20 and 22 of the Companies Act, and there was no scope for any defence u/s. 34 and 35 of the Trade Marks Act, as the Suit filed was the use of a name similar to that of the plaintiff by the defendant, and in these background facts, the Court observed thus :-

> "13. It is well settled that an individual can trade under his own name as he is doing no more than making a truthful statement of the fact which he has a legitimate interest in making. But while adopting his name as the trade name for his business he is required to act honestly & bonafidely and not with a view to cash upon the goodwill & reputation of another. An individual has the latitude of trading under his own name is in recognition of the fact that he does not have choice of name which is given to him. However, in the case of a Corporation the position is different. Unlike an individual who has no say in the matter of his name, a company can give itself a name. Normally a company can not adopt a name which is being used by another previously established company, as such a name would be undesirable in view of the confusion which it may cause or is likely to cause in the minds of the public. Use of a name by a company can be prohibited if it has adopted the name of another company.

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> It is well settled that no company is entitled to carry on business in a manner so as to generate a belief that it is connected with the business of another company, firm or an individual. The same principle of law which applies to an action for passing off of a trade mark will apply more strongly to the passing off of a trade or corporate name of one for the other. Likelihood of deception of unwary and ordinary person in the street is the real test and the matter must be considered from the point of view of that person."

25. The crucial aspect of the matter which is noticed and reflected from the order is, that Montari Overseas Limited had entered with capital market recently, and it's products were yet to enter the market. Montari Industries explained why the word 'Montari' was selected by it, as it set out that the word, was coined by the respondent by deriving a part of it from the name of the Chairman of the Company, and part of it from the name of his wife. M/s. Montari Overseas Limited, has also tried to furnish explanation by urging that the word 'Montari' was of significance to it, as it was derived in the name of father of the Managing Director of the Company and his father-in-law, but in the written statement, it was noted that the father of the Managing Director is Mohan Singh while the name of his father-in-law is Avtar Singh, and therefore, the learned Judge concluded that the word 'Montari' has nothing to do with the name of the father of the Managing Director, and no satisfactory explanation was given by the appellant in that regard, and therefore, ultimately the decision turned around the use of word 'Montari' by the defendant in the proceedings, despite the plaintiff's company being registered as 'Montari Industries Limited', much prior to its use by the defendant.

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Thus, according to us, even this decision cited by Mr. Tulzapurkar do not take his case ahead, as the pronouncement did not involve Section 35 of the Trade Marks Act.

26. Reliance placed upon the decision in case of **M/s. Mahindra & Mahindra Ltd. and Anr Vs MNM Marketing Private Limited & Anr**.[10] is also looked into by us, and we have noted the facts, being the suit filed by the plaintiff with its registered trademark "M & M" alleging infringement by the defendants, and for act of passing off along with the Notice of Motion seeking interim relief.

The plaintiff no.1 Company Mahindra and Mahindra Limited registered under the Companies Act, and it's group/subsidiary companies referred to as 'Mahindra group' and the plaintiff no.1, being the flagship company, claim to have established wide range of business activities. The plaintiff no.2 Company being the Retail trade arm of 'Mahindra Group' focussed on premium lifestyle and retail business from selling inter alia, apparels, toys and furnishings, and using the trade mark "Mahindra" and 'MNM". The defendant no.1, a firm Manhar and Manhar was incorporated as 'MNM Marketing Private Limited', whereas defendant no.2 was incorporated as Med India Hospital and Research Centre Private Limited.

The plaintiff no.1, being a registered owner of mark 'Mahindra', word per se and label "Mahindra & Mahindra" and "MNM" in various classes under the Trade Marks Act and Rules, claimed that it had incurred huge expenses in sales, promotion

10 2014(60)PTC 227[Bom]

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and advertisement in relation to the goods and services bearing the mark 'Mahindra', and the corporate name "Mahindra and Mahindra" and the trading style "Mahindra and Mahindra.

MNM, being the natural abbreviation/acronym of Mahindra and Mahindra, according to the plaintiff, the popularity, goodwill, and reputation of the marks was immense amongst the members of the trade and public, and came to be associated even with the acronym 'MNM' and it was used by the plaintiff in use of their business/activities and was in use since atleast 1969.

The plaintiff complained of defendants' impugned mark 'M & M'/'MNM' used by them in the shopping mall/retail business falling in Class 35, it being identical with, or in any event, deceptively similar to the plaintiff's trademark "M and M", registered, *inter alia,* in Classes 35 and 42. Such use was alleged to be constituting infringement of plaintiff's registered trademark, and resulting in passing off the defendants' retail services/business as and for those of the plaintiffs. The defendants defended their action by stating that the impugned mark "M&M" and "MNM" is registered by defendant no.2 since 2002 in several classes viz. 3, 14, 16, 18, 24, and 25, and such registration was projected as a defence u/s.30 (2)(e) of the Act to the plaintiff's case of infringement. It was also contended that the impugned mark is distinctive and therefore registered under different classes, and defendant has no registration under Classes 35 and 42, which was pending for consideration, since

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the plaintiffs have opposed the same, and therefore, they claim that the statutory right of defendant is restricted to goods in respect of which their trademark is registered.

27. Upon this contention being advanced, the Court noted that the defendant's registrations are all in classes other than Classes 35 and 42, and that the use by the defendants of the impugned mark in respect of services falling under Classes 35 and 42 is not a right conferred on the defendants by their registrations, and definitely not protected under Section 30(2)(e) of the Act and with reliance being placed on the decision in case of **Balkrishna Hatcheries v. Nando's International Ltd**[11], the Court recorded thus:-

> "In Balkrishna Hatcheries (supra), this Court has noted the distinction between goods and services, and marks registered for goods on the one hand and for services on the other. The Court has held that registration of a trade mark in relation to goods cannot support the use of that mark in respect of services and vice versa. In the present case, the Defendants have registration of their mark in respect of goods only and not for services. Hence, their registrations cannot afford protection when their mark is used in respect of services. Therefore, an infringement suit does lie against the Defendants, as the Defendants' registrations are not in respect of services in classes 35 and 42 and the registrations in respect of goods in other classes cannot be a defence to a suit based on the Plaintiffs registrations in classes 35 and 42."

The defence sought to be taken u/s.35 was found to be without merit by relying upon Kirloskar Diesel Recon (P) Ltd (supra), to the following effect:-

> "35. In the present case, as already stated hereinabove, the Defendants themselves have admitted at paragraph 22 at page 16 of the affidavit in reply and paragraph 8 of the affidavit in sur rejoinder that "M & M" is an abbreviation of Mahindra & Mahindra. Therefore, in the aforesaid circumstances, the

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> argument of the Defendants will also not hold good. The Hon'ble Supreme Court in Mahendra & Mahendra Paper Mills Ltd. v. M and M Auto Industries Limited (supra) has observed that, "Mahindra & Mahindra" is a well known trade mark and that the mark "Mahindra & Mahindra "has acquired secondary significance. Since "M & M" which is only a natural abbreviation, has also been used since 1969, the reputation of Mahindra & Mahindra will enure to and attach to its natural abbreviation and the abbreviation itself in the normal course will be a well-known mark. Under Section 29(4), the use of the impugned mark by the Defendants in respect of dissimilar goods or services also constitutes infringement of a well known trademark. Any use of the impugned mark by the Defendants in respect of any goods or services will constitute infringement of the Plaintiffs registered trademarks. There are no bona fides in the Defendants' use of the impugned mark. Also, its use will certainly be detrimental to the distinctive character of the Plaintiffs' registered trademark inasmuch as it will get diluted and its indiscriminate use will lead to its destruction."

28. Another important aspect of the matter, which warrant our consideration, is the submission of Mr. Sen that the registration of the plaintiff's trademark under Class 36, in relation to services of real estate affairs, insurance, financial affairs, monetary affairs, does not exhaust the whole class itself.

Inviting our attention to Trademark Class 36, which pertain to insurance, he would submit that Class 36 pertain to financial affairs, monetary affairs, real estate and insurance, and various types of services are classified under Class 36 like services of all banking establishments or institutions connected with them, such as exchange brokerage or clearing services; services of credit institutions, such as corporative credit associations, individual financial companies, lenders, etc. hire or lease purchase financing, services of brokers dealing in shares, services dealing with insurance such as those rendered

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by agents or brokers, engaged in providing services rendered to the insured and insurance underwriting services.

Thus, the registration of the plaintiff in Class 36 will only be restricted to the services mentioned by it in its registration certificate, and that is in relation to real estate affairs, insurance, financial affairs, and monetary affairs.

In support of his submission, Mr. Sen has placed reliance upon the decision in **Osram Gesellschaft Mit beschrankter Haftung vs Shyam Sunder and ors**[12]**,** where reliance is placed on decision in case of Vishnu Das Trading as Vishnunas Kishendas (supra), to the effect that by merely getting registered its electric lamps of all kinds in Class 11, the appellant cannot deprive the registration of respondent's goods, either on ground of its prior registration, or of dishonest intention. Reliance was placed upon the following observations of the Apex Court.

> "If a trader or manufacturer actually trades in or manufactures only one or some of the articles coming under a broad classification and such trader or manufacturer has no bonafide intention to trade in or manufacture other goods or articles which also fall under the broad classification, such trader or manufacturer should not be permitted to enjoy monopoly in respect above of all the articles which may come under such broad classification, and by that process preclude the other traders or manufacturers to get registration of separate and distinct goods which may also be grouped under a broad classification."

Based upon the aforesaid observation, the Delhi High Court, following the said principle, recorded that as a matter of fact, a registered trademark holder cannot in law

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claim exclusive monopoly rights for its trade mark as extended to goods of all descriptions, falling within the same class in which it's sole, and solitary product falls and if that is permitted, it would tantamount to preventing other traders to get registered their descriptive articles which fall under the same class of general classification.

Reliance upon the aforesaid decision is criticized by Dr. Tulzapurkar, by submitting that Vishnudas Trading was a case of rectification of trademark and the principle laid down therein must restrict to the background of the facts involved.

29. We do not subscribe to the above objection raised by Dr.Tulzapurkar, as though we find that the Appeals were filed against the Division Bench of Madras High Court, arising out of a decision of Single Bench, the facts disclose that Vazir Sultan Tobacco Co. was manufacturing cigarettes under the name 'Charminar', and the company obtained registration for trademark in 1942 and 1955 in respect of manufactured tobacco falling in Class 34 of Fourth Schedule to the Rules framed under 1940 and 1950 Act. The Company did not manufacture anything other than cigarettes and the appellant Vishnudas manufacturing Quiwam and Zarda, using the trade name "Charminar" on his bottles and boxes, claim that the device of trademark "Charminar" in the city of Hyderabad is different from the device used by Vazir Sultan. He applied for registration of Quiwam and Zarda with trademark "Charminar", and objection was raised by Vazir Sultan, that the trademark

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sought by the appellant would conflict its own trademark. Despite the contention of the applicant that such registration of trademark was in respect of cigarettes, but Quiwam and Zarda were different goods, and such goods would not cause any conflict with the goods manufactured by Vazir Sultan Tobacco Limited, as the registration was in respect of 'manufacture tobacco', which in its ambit would also take Quiwam and Zarda, it was held at the objection by the respondent company under section 12(1) could not be waived. The order also noted that the counsel for the appellant, i.e. the applicant offered to apply for rectification of the trademark in favour of respondent no.1 company, and when two applications were filed by Vishnudas Trading under section 46 read with Section 56 of the Trade Marks Act before the Registrar for rectifying the registration for existing trademark held by Vazir Sultan Tobacco Co, on the ground of non-user of the same in respect of Quiwam and Zarda, the applications were disposed of by allowing the rectification. The Assistant Registrar, Trademark, ordered the registered trademark to be rectified by making the entries relating to specification of goods to be read as 'cigarettes'.

This being aggrieved Vazir Sultan Tobacco Co. filed its statutory Appeals before the learned Single Judge who allowed the Appeals and set aside the order of Assistant Registrar of Trademark, and the learned Single Judge observed that sub-classification of 'manufacturer tobacco', occurring in

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Class 34 could not have been made.

Thereafter, being aggrieved, Vishnudas Trading carried the matter to the Division Bench, Madras High Court, and the Division Bench affirmed the order passed by the Single Judge. It is in this aforesaid background, the pronouncement comes from the Apex Court, and on reading of the entire judgment, with a conclusion being drawn that the rectification of the trademark registered in favour of the respondent Vazir Sultan Tobacco Co, since allowed by the Assistant Registrar of Trademark, was valid and also justified, and it is held that the order did not warrant any interference in the Appeal. As a result, the appeals were allowed by setting aside the judgment of the High Court and restored the order of rectification passed by the Assistant Registrar of Trademarks, Madras. However, the principle of law flowing from the said decision can be clearly discerned to the following effect :-

> "48. The "class" mentioned in the Fourth Schedule may subsume or comprise a number of goods or articles which are separately identifiable and vendible and which are not goods of the same description as commonly understood in trade or in common parlance. Manufactured tobacco is a class mentioned in Class 34 of Fourth Schedule of the Rules but within the said class, there are a number of distinctly identifiable goods which are marketed separately and also used differently. In our view, it is not only permissible but it will be only just and proper to register one or more articles under a class or genus if in reality registration only in respect of such articles is intended, by specifically mentioning the names of such articles and by indicating the class under which such article or articles are to be comprised. It is, therefore, permissible to register only cigarette or some other specific products made of "manufactured tobacco" as mentioned in Class 34 of Fourth Schedule of the Rules. In our view, the contention of Mr Vaidyanathan that in view of change in the language of Section 8 of the Trade Marks Act as compared to Section 5 of the Trade

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> Marks Act, 1940, registration of trade mark is to be made only in respect of class or genus and not in respect of articles of different species under the genus is based on incorrect appreciation of Section 8 of the Trade Marks Act and Fourth Schedule of the Rules."

30. The aforesaid decision which is followed in **Osram (**supra**)** thus lay down a principle in law that a trademark holder cannot claim exclusive monopoly right for its trademark, as extended to goods of all descriptions falling within the same class, as the class may be broad and as in the present case, as we have noted Class 36 is broad and insurance is one aspect of it. Insurance is the Genus with different species, and admittedly, merely by virtue of registration of a trademark, qua a particular goods or services, the entire broad class is not occupied, as the registration is restricted only to the goods/ services against which it is granted.

Insurance is a broad sector and there may be types of insurance, and in no case, Class 36 cover all types of insurance, as insurance is a contract between the parties and will vary in its terms and conditions, the subject of the insurance etc.

Though we do not want to burden our judgment with multiple authorities, we cannot refrain from referring to the judgment of Delhi High Court in **M/s.Marc Enterprises Vs. M/s. Five Star Electricals (India) and anr,** where the learned Single Judge, by relying upon **Vishnudas Trading** (supra), arrived at a conclusion that the plea of the plaintiff that it was the registered proprietor of registered trademark in Class 9, and

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though the defendant was also a registered proprietor of same trademark of Class 9, noted that the plaintiff is not manufacturing the goods which were being manufactured by the defendant. Even if the plaintiff has got trademark registered for class of items, the plaintiff was not using this trademark for the goods which were being manufactured by the defendant and therefore, the defendant cannot be restrained from being using the trademark 'Marc" for the goods manufactured by it.

31. The scheme of the Trade Marks Act, which aim for protection of trademark for goods and services and for prevention of the use of fraudulent marks, assist customers in recognising brands and their produces from those of other competitors in the market. By registering a trademark, the owner of the trademark enjoy the exclusive right to the use of the trademark in relation to the goods or services in respect of which it is registered and it also enable him to obtain a relief in respect of the infringement of the trademark in the manner prescribed in the Act.

The trademarks assist the customers in recognising brands and their products from those of other competitors in the market. Section 34 of the Act safeguard the right of the owner using unregistered trademark.

Section 29 provide as to when a registered trademark will be infringed by a person who, not being a registered proprietor, uses that mark in the course of the trade, which is identical with or deceptively similar to, the trademark

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in relation to the goods or services in respect of which a trademark is registered. Section 30 to 35 provide exceptions to the right of exclusivity to a registered trademark holder and Section 35 is one of them.

A proprietor or registered user of a registered trademark is not permitted to interfere with any bonafide use by a person of his own name or that of his place of business, or the name of place of business or any of his predecessors in business or the use by any person of any bonafide description of the character or quality of his goods or services. To seek protection u/s.35, it is imperative to satisfy the Court about the bonafide use or bonafide description of the goods or services used by the defendant.

As far as the appellant – original defendant is concerned, it specifically adopted a stand in its reply filed to the application seeking injunction by the plaintiff as well as it is also his stand in the Appeal before us that in or around 1955, the defendants' promoters/predecessors incorporated a partnership firm under the name and style of M/s. Kataria Transport Co, and over the years, Kataria Group of Companies grew and expanded its activities and several companies/partnership firms were incorporated right from 1955. M/s. Kataria Transport Co, a partnership firm, incorporated on 9/8/1955, engaged in business of transportation, was subsequently dissolved, with the partners being permitted to incorporate other firms in different

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territories by use of the mark 'Kataria', as set out in the deed of dissolution. M/s.Kataria Transport Co, a partnership firm was again incorporated in 1969 which was dissolved in 1979, but the partners were permitted to incorporate other firms by using the mark 'Kataria'.

Once again on 8/12/1979, M/s.Kataria Transport Company was incorporated and it engaged itself in the transportation of goods and merchandise and plying of trucks, tractors, trailers, buses and other allied businesses. Thereafter, over passage of time, various companies were incorporated by using the name 'Kataria' which was largely operational in the business of sale and servicing of automobiles but Kataria Motors Pvt. Ltd, incorporated in 1990 along with Kataria Motors Pvt. Ltd incorporated in 2002 involved itself in Automobile dealership and in also rendering motor vehicle insurance services and other allied services with mark 'Kataria'. M/s. Kataria Wheels, a Company incorporated in July 2012, was specifically engaged in the activity of providing motor vehicle insurance services. M/s.Kataria Insurance Brokers Pvt Ltd, was incorporated on 24/1/2014, exclusively engaged in the business of providing of insurance services and it even secured authorization from the Insurance Regulatory Development Authority. It is engaged in providing services of general insurance including motor vehicle insurance, fire insurance, etc.

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All the aforesaid companies include “Kataria” as an essential and vital component of their mark and corporate name and over the years, the defendant and group companies have continued to undertake the business under ‘kataria’ mark and has diversified into fields such as transport, logistics, automobiles, real estate insurance and infrastructure. Through the said companies, the defendant had openly, continuously and exclusively used the ‘Kataria’ mark and have come to be associated exclusively with Kataria companies and Kataria Insurance Brokers Private Limited is a part of the same.

32. Along with the Appeal Memo, the partnership agreement along with the agreement for its dissolution as early as on 20/10/1979, is placed on record. Its reading reveal to us that the partners of M/s. Kataria Transport Co, were the members of Kataria family, Kataria being the surname and all the partners of the partnership firm are the members belonging to Kataria family, and that is the reason why the business in which they engaged themselves in form of partnership firm, was styled as ‘M/s.Kataria Transport Company’. The dealership agreement between Maruti Udyog Ltd, is also with M/s.Kataria Automobile Private Limited, Ahmedabad, which was formed after dissolution of the earlier partnership business. The Partnership Deed dated 3/4/2001 at Ahmedabad made on 3/4/2001 also has the members of the Kataria family, as its partners to carry on the business with its primary business being that of transportation of goods, plying of trucks, tractors,

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trailers, buses and other allied business. The shareholding of the partners, all, belonging to Kataria family, make up 100% of the contribution with the shares in the profit and loss of the firm, being determined by the deed.

It is thus noted by us that 'Kataria Insurance Brokers Pvt Ltd' though incorporated in 2014, for providing insurance services, is not an attempt to take benefit of the goodwill, of the business of 'Kataria Jewellery Insurance Consultancy', another group of Kataria family, but it is it's identity as "Kataria", the name which the family takes. As we have noted that 'Kataria Insurance Brokers Pvt. Ltd' belonging to Kataria Group had its first venture in 1955 through the promoters/predecessors, who incorporated a partnership firm in the year 1955 with presence of members of 'Kataria' family. Since Kataria is a family name which the plaintiff Company continued through its enterprise i.e. Kataria Jewellery Insurance Consultancy, which was initially "Kataria Insurance Consultancy", even the defendants i.e. appellants before us also indulged themselves in business activity by using their surname 'Kataria'.

The appellant's use of surname 'Kataria' is not an attempt to ride on the respondents goodwill, but according to us, it is a legitimate exercise of the right to use the surname or a family name in its trading and business activity. Merely because Kataria Insurance Brokers Pvt. Ltd is a corporate entity, we find that the learned Single Judge has erred in excluding that the benefit of Section 35, by holding that it is not available

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to a Company, but it is only available to an individual, as the Company may chose its own name.

33. We do not approve of the aforesaid finding, since we find that if there are number of entities which run the automobile and allied business activity by using the family name 'Kataria' since 1955, the incorporation of 'Kataria Insurance Brokers Pvt. Ltd' is not a mere matter of choice, but it is a matter of right as all other businesses being carried out by the family, was by the use of their family name 'Kataria', and it is not the appellant Company which is for the first time, engaged in insurance business, but several of the entities from Kataria Group belonging to the appellant prior to incorporation of the appellant Company, were established to engage themselves in insurance business. The appellant has invoked its own goodwill and reputation in the wake of conduct of its business activity from various entities with the name 'Kataria' and the revenue generated by it, as the group entity from 2020-21 to 2024-25, placed before us, is around Rs.17268 crores and therefore, it cannot be assumed that the appellant 'Kataria Insurance Brokers Pvt. Ltd, is a fly-by night operator or a novice who has entered into the business arena, just to encash the goodwill of the 'Kataria Jewellery Insurance Consultancy'. The promoter of the appellant's has been using the name 'Kataria' since 1955 and is involved in automobile dealership business since 1966 and is also providing ancillary services relating to insurance service since 2003.

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Prima facie, we are shown that as group companies, they have gained reputation in the field.

34. As far as the use of the name 'Kataria' by the appellant, according to us, is bonafide, as we find that the mark 'Kataria' happens to be the surname of the promoters and the predecessors of the appellant, and we find that the defence of Section 35 of the Trade Marks Act, raised by the defendant ought to be appreciated at the interim stage, in absence of other contradictory material showing that its use is malafide or, is an attempt to encash upon the goodwill of 'Kataria Jewellery Insurance Consultancy'. Since we find that the use of the mark 'Kataria' by the appellant is bonafide, continuous and though it involve insurance business, the reasoning adopted by the learned Single Judge restricting the applicability of Section 35 to natural persons is also not approved by us as the Trade Marks Act, does not define the term 'person' but as per the General Clauses Act, 1897, a person includes any company or association or body of individuals and peculiar circumstance, as placed before us, the Kataria family joined hands in the partnership firm in 1955, and whether it expanded its business, it on numerous occasions through Private Limited Company or through partnership firms or through LLP, and in the present case, through a corporate entity, as the business was run through different acceptable forums in law, and therefore, there was no question of any choice being exercised by the corporate entity because it is not for the first time that the appellant had

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made the use of the word 'Kataria' which is its family name and therefore, we do not agree with the proposition that Section 35 shall blanketly exclude company/companies and can only be availed by an individual, as in the provision itself, we do not find any such embargo.

35. One important aspect which ought to have been looked into is, the case of the plaintiff before the learned Single Judge that it had created a niche business relating to providing policies in the field of 'gems and jewellery sector' since 2006.

This is clearly indicated that the plaintiff was admittedly operating in different sector of insurance for jewellery, whereas the appellant is operating in the field of vehicular insurance, since automobile and its sale and allied services was the business of the proprietor of the appellant's family and though Class 36 covers 'insurance', we are of the opinion that the class is broad and since the activity of the plaintiff was restricted to gems and jewellery sector, whereas the appellant's activity is restricted to insurance and automobile sector, definitely, the plaintiff could not have claimed complete control over 'Insurance', including vehicle insurance as it is not its case that it anyway deal with insurance in jewellery sector. Since the business activity of the plaintiff and the appellant may be common i.e. insurance, but the character of the goods/services covered are distinct and there is no question of any deceptive similarity, or deception in rendering of the goods or services, as the appellant trade in the field of insurance

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brokerage, whereas the plaintiff is dealing in trade of insurance policies, relating to gems and jewellery, and we do not find any overlap in the area of their operation, and therefore, there is no question of trademark infringement, as contemplated u/s.29.

As far as the prior use of the trademark "Kataria" is concerned, the appellant's mark is not registered, but it is using the mark 'Kataria' being its surname with continuity and have encashed upon it by creating a business world by use of the goodwill of their forefathers/predecessors and are banking upon the same, and if the appellant Company which is not an isolated one, but belongs to a group of companies, with the use of surname 'Kataria, is restrained from conduct of its business, it would cause serious prejudice to it.

36. In any case, Mr.J.P. Sen, has made a statement before us that the appellant shall not touch the insurance business in jewellery and gems and according to us, this would suffice to clear the apprehension expressed by the plaintiff that its business would be impacted and it is admitted that its business is of insurance in gems and jewellery. In any case, whether the use of the mark was 'bonafide' or whether or not, it was continuous and prior use, is ultimately a matter of trial and these issues shall be determined at that stage. However, since we find that the learned Single Judge has not taken into consideration some of the important facets of the matter, to which we had referred to above, we quash and set aside the said impugned order.

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37. Appeal is allowed by quashing and setting aside the said order dated 8th December 2025 passed by the learned Single Judge restraining the defendant from using the trade name 'Kataria', domain name 'www.katariainsurance.co.in' and corporate name 'Kataria Insurance', on the ground that it infringes the registered trademark of the plaintiff and is deceptively similar to its mark in respect of the services covered by the plaintiff's registration.

In view of the disposal of the Appeal, Interim Application do not survive and stand disposed of.

(R.N. LADDHA,J) **(BHARATI DANGRE, J.)**