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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

\+ FAO (COMM) 79/2025 & CM APPL. 15598/2025

BHOLE NATH FOODS LTD .....Appellant

Through: Mr. Junaid Alam, Mr. Nishant Mahtta, Mr. S. Nithin, Advs.

versus

KIRORIMAL KASHIRAM MARKETING AND AGENCIES PVT LTD .....Respondent

Through: Mr. Rishi Bansal and Ms. Shruti Manchanda, Advs.

CORAM:
HON'BLE MR. JUSTICE C. HARI SHANKAR
HON'BLE MR. JUSTICE OM PRAKASH SHUKLA

JUDGMENT (ORAL)

% 09.01.2026

C. HARI SHANKAR, J.

1. This appeal assails judgment dated 6 November 2024, passed by the learned District Judge (Commercial Court-13), Central District, Tis Hazari Courts, Delhi[1] in CS (Comm) 709/2023[2], whereby the learned Commercial Court has allowed an application filed by the respondent Kirorimal Kashiram Marketing and Agencies Pvt. Ltd.[3]. Resultantly, the order injuncts the appellant Bhole Nath Foods Ltd.[4], during the pendency of the suit from using, in any manner, the word

[1] "learned Commercial Court", hereinafter
[2] **Kirorimal Kashiram Marketing and Agencies Pvt. Ltd. v. Bhole Nath Foods Ltd**., referred to, hereinafter, as "the suit"
[3] "KKM", hereinafter
[4] "BNF", hereinafter

mark CHEETAL as well as the device mark 

[5], in relation to rice classifiable in Class 30 of the Nice Classification of Trade Marks.

2. Aggrieved thereby, BNF has instituted the present appeal under Section 13 of the Commercial Courts Act, 2015 read with Order XLIII Rule 1(r) of the Code of Civil Procedure, 1908[6].

Facts

3. The case of KKM in the plaint

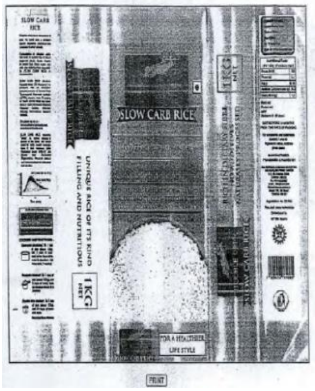
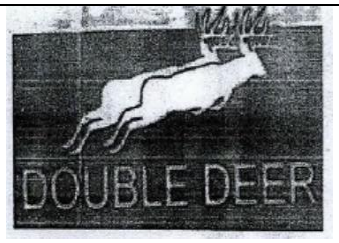
3.1 The list of registered trademarks of KKM were thus provided in the plaint:

Mark (Profile name)	Applica-tion No.	Class	User Claimed	Date of registration
DOUBLE DEER BRAND (DEVICE)	531665	30	Proposed to be used	18 June 1990
DOUBLE DEER (WORD)	1348681	35	1 January 1966	4 April 2005
DOUBLE DEER DEVICE	1802180	30	1 January 1966	1 April 2009
DOUBLE DEER DEVICE	2590582	30	1 January 1966	3 September 2013

3.2 The devices which stand registered against Application Nos.

[5] "the Cheetal device mark" hereinafter
[6] "CPC", hereinafter

531665, 1802180 and 2590582 are the following:

Application No. 531665	
Application No. 1802180	
Application No. 2590582	

3.3 The earliest registration held by KKM was, therefore, of 1 January 1966 vintage.

3.4 KKM further contended, in the plaint, that the labels used by it constituted original artistic works within the meaning of Section 2(c) of the Copyright Act, 1957. A list of the copyright registrations held by KKM were also provided in the plaint.

3.5 By dint of continuous and uninterrupted use, KKM contended

that the DOUBLE DEER word and device marks had attained universal goodwill and reputation and had become source identifiers of KKM. KKM also provided details of advertisement and promotional expenses spent by it, in promoting the goodwill and reputation of its marks. It was further pointed out that, KKM was also maintaining and managing the domain name www.doubledeer.co.in and that, through its website, it was actively promoting and selling its products. KKM therefore pleaded that its marks also qualified as well known trademarks within the meaning of Section 2(1)(zg) of the Trade Marks Act, 1999.

3.6 BNF is trading in rice under the CHEETAL word and device marks, which now stands injuncted by the impugned judgment of the learned Commercial Court. KKM alleged that the word and device marks of BNF were deceptively similar to those of KKM. In this context, KKM placed reliance on the fact that "cheetal" is the vernacular for a particular specie of spotted deer. KKM contended that the adoption, by BNF, of a mark which referred to a kind of spotted deer, in full knowledge of the fact that KKM was, since 1966, using the DOUBLE DEER word and device mark for the same product i.e. rice, was obviously deliberate.

3.7 The word mark CHEETAL was registered in favour of the BNF in Class 30 for rice with effect from 9 September 2005.

3.8 KKM pleaded, however, that it had not come across BNF's CHEETAL branded rice in the market and therefore, instituted the suit

only after it came to learn of the said use in March 2023.

3.9 Alleging that the CHEETAL word and device marks of BNF were phonetically, visually, structurally and conceptually deceptively similar to the DOUBLE DEER marks of KKM and were bound to resultant in confusion as both marks were used for rice, KKM sought, by way of the suit, a decree of permanent injunction restraining BNF from using the CHEETAL word and device marks for rice. The suit was accompanied by an application under Order XXXIX Rules 1 and 2 of the CPC in which the impugned judgment has come to be passed, seeking an interlocutory injunction restraining BNF from using the allegedly infringing CHEETAL word and device marks for rice, pending disposal of the suit.

4. Case of BNF before the learned Commercial Court

4.1 BNF contended, *per contra*, that as it had a registration for the word mark CHEETAL and CHEETAL constituted the main feature of its device mark, no infringement action was maintainable and no injunction against use of its marks could be granted on the ground of infringement.

4.2 We may note here that Mr. Rishi Bansal, who appears for the KKM, before us, candidly acknowledged the correctness of this legal position in view of recent decision of this Court in ***Vaidya Rishi India Health (P) Ltd v. Suresh Dutt Parashar***[7].

[7] **2025 SCC OnLine SC 6147**

4.3 BNF opposed the suit as barred by time, as it was filed 11 years after KKM had filed its opposition against the application of BNF for registration of the CHEETAL mark before the Registrar of Trade Marks on 13 March 2012. BNF asserted that it had been using the CHEETAL marks since 1 April 2003, which was the user claimed in its trade mark application. In these circumstances, BNF submitted that KKM was barred from seeking any interdictory relief against BNF, on the principles of acquiescence as well as delay and laches.

4.4 BNF further submitted that "Deer" is a generic expression and that therefore, no one could seek to monopolize the word "Deer" or, for that matter, its vernacular equivalent CHEETAL.

4.5 It was further submitted that there is no similarity of any kind between the marks of KKM and BNF. BNF asserted that it had originally conceived and adopted the CHEETAL device mark 

with its unique colour combination and unique lettering and that in fact the said logo was also entitled to protection as an original artistic work under Section 2(c) of the Copyright Act. BNF provided a comparison of the rival marks thus, to emphasize the fact that there was no similarity between them :

Manner of use / presentation by the plaintiff/ respondent	Manner of use / presentation by the defendant/ appellant
Double Deer	Cheetal BASMATI RICE
	
	

4.6 Asserting that there was no visual or phonetic similarity between the CHEETAL word and device marks and the marks asserted by the KKM in the plaint, it was submitted that the suit was completely devoid of any sustainable cause of action and deserved to be dismissed.

5. Findings of the learned Commercial Court

The learned Commercial Court has granted the prayer for interim injunction as advanced by the KKM on the following reasoning :

(i) KKM enjoyed priority both of registration and user of the DOUBLE DEER word and device marks.

(ii) Though BNF was the registrant of the CHEETAL word mark, the right to exclusive user of the mark, as conferred by Section 28(1) of the Trade Marks Act, was conditional on the registration being valid. Section 31(1) of the Trade Marks Act only provided that registration would operate as a *prima facie* evidence of validity. Registration was not, therefore, conclusive proof of validity of the registered trade mark.

(iii) Injunction can be granted even against a registered trade mark.

(iv) On the aspect of deceptive similarity and likelihood of

confusion, it was held thus:

(a) KKM's DOUBLE DEER device mark had deer as a prominent feature thereof. In some of the marks, there were two deer and in others there were three. In any case, deer constituted a dominant feature of KKM's DOUBLE DEER device mark.

(b) BNF's CHEETAL device mark also had the image of three deer, though they were differently positioned.

(c) The difference in positioning of the three deer in BNF's CHEETAL device mark was not sufficient to show that the marks were not deceptively similar. An average consumer would remember the rival marks on the basis of the common deer feature.

(d) Given these common features, the difference in colour and other difference in visual appearances between the marks became immaterial. Equally, the fact that the marks were not phonetically similar would also not mitigate the aspect of deceptive similarity.

(v) In support of these findings, the learned Commercial Court has relied on the judgment of the Division Bench of this Court in ***Kirorimal Kashiram Marketing and Agencies Pvt Ltd***

v. Shree Sita Chawal Udyog Mill[8].

(vi) As the DOUBLE DEER mark of KKM was arbitrary, it was entitled, on that ground, to a greater degree of protection.

(vii) The adoption of the CHEETAL mark by BNF was dishonest.

(viii) BNF had provided no explanation for registering the device mark CHEETAL with three deers, when it had earlier registered the plain word mark CHEETAL.

6. On the above reasoning, the learned Commercial Court has granted interlocutory injunction as sought by KKM and allowed the application of KKM under Order XXXIX CPC.

7. Aggrieved by the said decision, BNF is before us in appeal.

8. We have heard Mr. Junaid Alam, learned counsel for the BNF and Mr. Rishi Bansal, learned counsel for the KKM.

Analysis and findings

9. In our view, the impugned order is *ex facie* unsustainable in law, for the reasons, which follow hereinafter.

[8] **(2010) 44 PTC 293**

10. BNF is the registered proprietor of the word mark CHEETAL. Section 28(1)[9] of the Trade Marks Act, therefore, confers on BNF exclusive right to use the mark CHEETAL, even by the very aspect of its registration. Equally, Section 30(2)(e)[10] entitles BNF to plead, as a defence to any allegation of infringement, the fact that it was merely exercising the right to use the mark CHEETAL, following on the registration of the mark in its favour.

11. <u>No infringement action against registered trade mark</u>

11.1 Even otherwise, the definition of infringement, as contained in sub-sections (1) to (4) of Section 29[11] of the Trade Marks Act

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[9] **28. Rights conferred by registration**. –
(1) Subject to the other provisions of this Act, the registration of a trade mark shall, if valid, give to the registered proprietor of the trade mark the exclusive right to the use of the trade mark in relation to the goods or services in respect of which the trade mark is registered and to obtain relief in respect of infringement of the trade mark in the manner provided by this Act.

[10] **30. Limits on effect of registered trade mark-**
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(2) A registered trade mark is not infringed where—
*****
(e) the use of a registered trade mark, being one of two or more trade marks registered under this Act which are identical or nearly resemble each other, in exercise of the right to the use of that trade mark given by registration under this Act.

[11] **29. Infringement of registered trade marks**. –
(1) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which is identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark.
(2) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which because of—
(a) its identity with the registered trade mark and the similarity of the goods or services covered by such registered trade mark; or
(b) its similarity to the registered trade mark and the identity or similarity of the goods or services covered by such registered trade mark; or
(c) its identity with the registered trade mark and the identity of the goods or services covered by such registered trade mark,
is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trade mark.
(3) In any case falling under clause (c) of sub-section (2), the court shall presume that it is likely to cause confusion on the part of the public.
(4) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which—
(a) is identical with or similar to the registered trade mark; and

envisages the infringer being a person who is not the registered proprietor of the allegedly infringing mark or the permissive user thereof. Registered marks, therefore, cannot alleged to be infringing in nature.

11.2 Though the judgment of a Division Bench of this Court in ***Raj Kumar Prasad v. Abott Healthcare (P) Ltd***[12] held that an infringement action could lie against a registered trade mark, the Supreme Court, subsequently, in ***Syed Mohideen v. P. Sulochana Bai***[13], authoritatively ruled to the contrary thus:

> "24. *The effect of registration is provided in Chapter IV of the Act in Section 27. This Section provides that no infringement will lie in respect of an unregistered trade mark*. However, Section 27(2) recognises the common law rights of the trade mark owner to take action against any person for passing off goods as the goods of another person or as services provided by another person or the remedies thereof. …
>
> 25. Section 28 which is very material for our purpose, as that provision confers certain rights by registration, is reproduced below in its entirety:
>
> *****
>
> 26. A bare reading of this provision demonstrates the following rights given to the registered proprietor of the trade mark:
>
> (i) Exclusive right to use the trade mark in relation to the goods or services in respect of which the trade mark is registered.
>
> (ii) To obtain relief in respect of infringement of trade

(b) is used in relation to goods or services which are not similar to those for which the trade mark is registered; and
(c) the registered trade mark has a reputation in India and the use of the mark without due cause takes unfair advantage of or is detrimental to, the distinctive character or repute of the registered trade mark.

[12] **(2014) 60 PTC 51 (Del-DB)**
[13] **(2016) 2 SCC 683**

mark in the manner provided by this Act.

27. *Sub-section (3) of Section 28 with which we are directly concerned, contemplates a situation where two or more persons are registered proprietors of the trade marks which are identical with or nearly resemble each other. It, thus, postulates a situation where same or similar trade mark can be registered in favour of more than one person. On a plain stand-alone reading of this Section, it is clear that the exclusive right to use of any of those trade marks shall not be deemed to have been acquired by one registrant as against other registered owner of the trade mark (though at the same time they have the same rights as against third person). Thus, between the two persons who are the registered owners of the trade marks, there is no exclusive right to use the said trade mark against each other, which means this provision gives concurrent right to both the persons to use the registered trade mark in their favour. Otherwise also, it is a matter of common sense that the plaintiff cannot say that its registered trade mark is infringed when the defendant is also enjoying registration in the trade mark and such registration gives the defendant as well right to use the same, as provided in Section 28(1) of the Act*.

28. However, what is stated above is the reflection of Section 28 of the Act when that provision is seen and examined without reference to the other provisions of the Act. *It is stated at the cost of repetition that as per this Section owner of registered trade mark cannot sue for infringement of his registered trade mark if the appellant also has the trade mark which is registered.* Having said so, a very important question arises for consideration at this stage, namely, whether such a respondent can bring an action against the appellant for passing off invoking the provisions of Section 27(2) of the Act. In other words, what would be the interplay of Section 27(2) and Section 28(3) of the Act is the issue that arises for consideration in the instant case. As already noticed above, the trial court as well as the High Court have granted the injunction in favour of the respondent on the basis of prior user as well as on the ground that the trade mark of the appellant, even if it is registered, would cause deception in the mind of the public at large and the appellant is trying to encash upon, exploit and ride upon on the goodwill of the respondent herein. Therefore, *the issue to be determined is as to whether in such a scenario, the provisions of Section 27(2) would still be available even when the appellant is having registration of the trade mark of which he is using*.

29. After considering the entire matter in the light of the various provisions of the Act and the scheme, our answer to the aforesaid question would be in the affirmative. Our reasons for

arriving at this conclusion are the following.

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30.3. *Section 28(3) of the Act provides that the rights of two registered proprietors of identical or nearly resembling trade marks shall not be enforced against each other*. However, they shall be same against the third parties. Section 28(3) merely provides that there shall be no rights of one registered proprietor vis-à-vis another but only for the purpose of registration. *The said provision 28(3) nowhere comments about the rights of passing off which shall remain unaffected due to overriding effect of Section 27(2) of the Act and thus the rights emanating from the common law shall remain undisturbed by the enactment of Section 28(3) which clearly states that the rights of one registered proprietor shall not be enforced against the another person.*

30.4. Section 34 of the Trade Marks Act, 1999 provides that nothing in this Act shall entitle the registered proprietor or registered user to interfere with the rights of prior user. Conjoint reading of Sections 34, 27 and 28 would show that the rights of registration are subject to Section 34 which can be seen from the opening words of Section 28 of the Act which states "Subject to the other provisions of this Act, the registration of a trade mark shall, if valid, give to the registered proprietor…." and also the opening words of Section 34 which states "Nothing in this Act shall entitle the proprietor or a registered user of registered trade mark to interfere…." Thus, the scheme of the Act is such where rights of prior user are recognised superior than that of the registration and even the registered proprietor cannot disturb/interfere with the rights of prior user. The overall effect of collective reading of the provisions of the Act is that the action for passing off which is premised on the rights of prior user generating a goodwill shall be unaffected by any registration provided under the Act. This proposition has been discussed in extenso in ***N.R. Dongre v. Whirlpool Corpn.***[14] wherein the Division Bench of the Delhi High Court recognised that the registration is not an indefeasible right and the same is subject to rights of prior user. The said decision of ***Whirlpool*** was further affirmed by the Supreme Court of India in ***N.R. Dongre v. Whirlpool Corpn.***[15].

30.5. The above were the reasonings from the provisions arising from the plain reading of the Act which gives clear indication that the rights of prior user are superior than that of registration and are

[14] **AIR 1995 Del 300**
[15] **(1996) 5 SCC 714**

unaffected by the registration rights under the Act."

(Emphasis supplied)

11.3 Following ***Syed Mohideen***, this Court, in ***Vaidya Rishi India Health (P) Ltd v. Suresh Dutt Parashar***[16] held that ***Raj Kumar Prasad*** could not be regarded as good law to the extent it held that an infringement action would lie against a registered trade mark. We reproduce, in this regard, the following passages from ***Vaidya Rishi***:

> "19.9 *Thus, the Supreme Court, in* ***S. Syed Mohideen****, has clearly held that there can be no infringement action against the proprietor of a registered trademark and that no injunction can be granted against use, by the proprietor of a registered trademark, of the mark in the class in which it is registered in his favour, on the ground of infringement.*
>
> 19.10 A passing off action, we may note, would lie even against the proprietor of a registered trademark, as the right to sue against passing off arises under common law, and is not a statutory tort. ***Syed Mohideen***, therefore, clarifies that the view that there can be no injunction against the use of a registered trade mark is the position as it emerges from Section 28(3) of the Trade Marks Act. That would not, however, inhibit the Court from granting injunction against the use of a registered trade mark, by its proprietor, *on the ground of passing off*. Section 27(2) of the Trademarks Act expressly saves passing off actions.
>
> 19.11 However, as we have already noted, the impugned order has not been passed on the ground of passing off, but on the ground of infringement. Mr. Nagpal, learned counsel for the respondent is also candid in his submission that his case is one of infringement against the appellant.
>
> 19.12 Insofar as infringement is concerned, we are bound by the law laid down in ***Syed Mohideen***. To reiterate, the Supreme Court has clearly held, in the afore-extracted passages, that no infringement action will lie at the instance of one registered proprietor of a trademark against another registered proprietor of a trademark, seeking an injunction against the use, by the latter, of the registered trademark, in the class(es) in which it is registered. The only exception, as ***Syed Mohideen*** itself holds, is in cases of

[16] **2025 SCC OnLine Del 6147**

passing off. No injunction on the ground of infringement can therefore, be granted.

19.13 It is true that ***Syed Mohideen*** does not notice Section 124 of the Trade Marks Act. That, however, would not make any difference, for more than one reason.

19.14 Firstly, Section 124 does not, in express terms, state that an infringement suit would lie against a registered trade mark, or that the use of a registered trade mark could be injuncted on the ground of infringement. That is, at best, an *inference* which ***Raj Kumar Prasad*** draws, from Section 124(5)[17]. Thus, there is no reason to assume that, even if Section 124 were to be noticed, the decision in ***Syed Mohideen*** would be any different.

19.15 Secondly, we, as a hierarchically lower judicial authority *vis-à-vis* the Supreme Court, are bound, by Articles 141 of the Constitution of India, by the law declared by the Supreme Court. It is not within our remit to wish away the declaration of law by the Supreme Court on the ground that a particular provision was not noticed by it. In effect, that would amount to our holding the judgment of the Supreme Court in ***Syed Mohideen*** to be *per incuriam*, which, as the decision in ***South Central Railway Employees Cooperative Credit Society Employees Union v. B. Yashodabai***[18] categorically rules, no High Court can venture to hold.

19.16 Ergo, in view of ***Syed Mohideen***, we find ourselves inhibited from following either ***Raj Kumar Prasad*** or ***Corza***[19].

11.4 Mr. Bansal also did not also press the aspect of infringement. He, however, sought to submit that the impugned judgment was sustainable even on the ground of passing off.

12. <u>No case made out of passing off</u>

[17] (5) The stay of a suit for the infringement of a trade mark under this section shall not preclude the court from making any interlocutory order (including any order granting an injunction, directing account to be kept, appointing a receiver or attaching any property), during the period of the stay of the suit.

[18] **(2015) 2 SCC 727**

[19] **Corza International v. Future Bath Products (P) Ltd, 2023 SCC OnLine Del 153**, which followed **Raj Kumar Prasad**.

12.1 Comparison of the marks

12.1.1 There is a fundamental difference between infringement and passing off, which the impugned judgment has overlooked. In fact, the impugned judgment has effectively applied the tests of infringement in an action which can lie only for passing off.

12.1.2 The difference between infringement and passing off stands tellingly underscored in the following passages from ***Kaviraj Pandit Durga Dutt Sharma v. Navaratna Pharmaceutical Laboratories***[20]:

> "28. The other ground of objection that the findings are inconsistent really proceeds on an error in appreciating the basic differences between the causes of action and right to relief in suits for passing off and for infringement of a registered trade mark and in equating the essentials of a passing off action with those in respect of an action complaining of an infringement of a registered trade mark. We have already pointed out that the suit by the respondent complained both of an invasion of a statutory right under Section 21 in respect of a registered trade mark and also of a passing off by the use of the same mark. The finding in favour of the appellant to which the learned counsel drew our attention was based upon dissimilarity of the packing in which the goods of the two parties were vended, the difference in the physical appearance of the two packets by reason of the variation in the colour and other features and their general get-up together with the circumstance that the name and address of the manufactory of the appellant was prominently displayed on his packets and these features were all set out for negativing the respondent's claim that the appellant had passed off his goods as those of the respondent. These matters which are of the essence of the cause of action for relief on the ground of passing off play but a limited role in an action for infringement of a registered trade mark by the registered proprietor who has a statutory right to that mark and who has a statutory remedy for the event of the use by another of that mark or a colourable imitation thereof. While an action for passing off is a Common Law remedy being in substance an action for deceit, that is, a passing off by a person of his own goods as those of another,

[20] **1964 SCC OnLine SC 14**

that is not the gist of an action for infringement. The action for infringement is a statutory remedy conferred on the registered proprietor of a registered trade mark for the vindication of the exclusive right to the use of the trade mark in relation to those goods" (*Vide* Section 21 of the Act[21]). The use by the defendant of the trade mark of the plaintiff is not essential in an action for passing off, but is the sine qua non in the case of an action for infringement. No doubt, where the evidence in respect of passing off consists merely of the colourable use of a registered trade mark, the essential features of both the actions might coincide in the sense that what would be a colourable imitation of a trade mark in a passing off action would also be such in an action for infringement of the same trade mark. But there the correspondence between the two ceases. In an action for infringement, the plaintiff must, no doubt, make out that the use of the defendant's mark is likely to deceive, but where the similarity between the plaintiff's and the defendant's mark is so close either visually, phonetically or otherwise and the court reaches the conclusion that there is an imitation, no further evidence is required to establish that the plaintiff's rights are violated. Expressed in another way, if the essential features of the trade mark of the plaintiff have been adopted by the defendant, the fact that the get-up, packing and other writing or marks on the goods or on the packets in which he offers his goods for sale show marked differences, or indicate clearly a trade origin different from that of the registered proprietor of the mark would be immaterial; whereas in the case of passing off, the defendant may escape liability if he can show that the added matter is sufficient to distinguish his goods from those of the plaintiff.

29. When once the use by the defendant of the mark which is claimed to infringe the plaintiff's, mark is shown to be "in the course of trade", the question whether there has been an infringement is to be decided by comparison of the two marks. Where the two marks are identical no further questions arise; for then the infringement is made out. When the two marks are not identical, the plaintiff would have to establish that the mark used by the defendant so nearly resembles the plaintiff's registered trade mark as is likely to deceive or cause confusion and in relation to goods in respect of which it is registered (Vide Section 21). A point has sometimes been raised as to whether the words "or cause confusion" introduce any element which is not already covered by the words "likely to deceive" and it has sometimes been answered by saying that it is merely an extension of the earlier test and does not add very materially to the concept indicated by the earlier

[21] The Trade Marks Act, 1940

> words "likely to deceive". But this apart, as the question arises in an action for infringement the onus would be on the plaintiff to establish that the trade mark used by the defendant in the course of trade in the goods in respect of which his mark is registered, is deceptively similar. This has necessarily to be ascertained by a comparison of the two marks - the degree of resemblance which is necessary to exist to cause deception not being capable of definition by laying down objective standards. The persons who would be deceived are, of course, the purchasers of the goods and it is the likelihood of their being deceived that is the subject of consideration. The resemblance may be phonetic, visual or in the basic idea represented by the plaintiff's mark. The purpose of the comparison is for determining whether the essential features of the plaintiff's trade mark are to be found in that used by the defendant. The identification of the essential features of the mark is in essence a question of fact and depends on the judgment of the Court based on the evidence led before it as regards the usage of the trade. It should, however, be borne in mind that the object of the enquiry in ultimate analysis is whether the mark used by the defendant as a whole is deceptively similar to that of the registered mark of the plaintiff."

12.2 Thus, while an infringement action requires only mark to mark comparison, and added matter is of no relevance, in a passing off action, added matter, as well as other circumstances, may make all the difference.

12.3 Viewed from that perspective, it is clear that there is no similarity between the marks of BNF and KKM as would sustain a claim of passing off. The mere fact that both the marks contain images of deer as part of the marks would not render them visually similar. A bare glance at the two images does not convey any impression of likelihood of confusion between them even when viewed from the perspective of a consumer of average intelligence and imperfect recollection[22].

[22] Refer **Amritdhara Pharmacy v. Satyadeo Gupta, AIR 1963 SC 449**

12.4 The learned Commercial Court has held that as deer constitutes the dominant feature of the rival marks, other visual dissimilarities such as colour, appearance, the positioning of the deer and other such aspects were rendered immaterial. This finding, to our mind, is directly contrary to the law enunciated in the afore-extracted paragraphs from ***Kaviraj Pandit Durga Dutt Sharma***, which emphasizes the importance of "added matter" in passing off actions.

12.5 There is no basis for the finding of the learned Commercial Court that an average consumer would only remember the rival marks by the common deer feature. When one views the marks in juxtaposition, it is clear that, except for the fact that deer figure in both the marks, there is no other similarity between them.

12.6 Most prominently, in the case of BNF's label, the word CHEETAL is clearly and boldly depicted on the face of the mark. This single feature even by itself is sufficient to disabuse any consumer, however average his intelligence and however imperfect his recollection might be, into presuming any kind of association between BNF's and KKM's marks. This fact has been completely overlooked by the learned Commercial Court.

12.7 In fact, in para 42 of the impugned order, the learned Commercial Court has reversed the onus of proof by observing as under:

> "42. ...Though, it is true that the mark/label/device of defendant in the name of CHEETAL shows or contains three deers (*sic* deer) and they are shown in a different position than that of the two deers (*sic* deer) shown in label/device of plaintiff, but *the same is not prima facie sufficient to hold that the rival marks/labels/devices being used by the parties are different or that there is no deceptive similarity or resemblance between the two marks*…"
>
> (Emphasis supplied)

The test applied in the aforesaid sentence by the learned Commercial Court is completely contrary to the basic principles of onus of proof in passing off actions. The onus to prove deceptive similarity, whether in an infringement or passing off action, is on the plaintiff who so pleads. It is the plaintiff who has to establish that the marks are deceptively similar. The legal position contained in the afore-extracted sentence from para 42 of the impugned judgment indicates that the learned Commercial Court has examined the marks from the point of view of whether they contain features which would render them dis-similar. This, to our mind, is a completely erroneous approach.

13. Misplaced reliance on ***Kirorimal Kashiram Marketing***:

The reliance, by the learned Commercial Court, on the earlier decision in ***Kirorimal Kashiram Marketing***, is again misdirected. The rival marks under consideration in the said decision were GOLDEN DEER and DOUBLE DEER. There can obviously be no similarity between such a case and the present case in which the rival marks are CHEETAL and DOUBLE DEER. The word "deer" in fact forms no part of the mark of BNF.

14. In this context, reliance by the learned Commercial Court on the fact that CHEETAL happens to be a kind of spotted deer is again, to our mind, misconceived. The use of the mark DOUBLE DEER by the KKM did not afford it complete monopoly over the word "deer" in every known language.

15. Idea infringement

15.1 Mr. Bansal sought to invoke the principle of idea infringement and relied, for that purpose, on the judgment of this Bench in ***Madan Lal Purshottam Dass Foods Pvt. Ltd v. B.L. Agro Industries Ltd.***[23] and of an earlier Division Bench in ***Shree Nath Heritage Liquor Pvt. Ltd v. Allied Blender & Distillers Pvt Ltd***[24]. He also cited judgment of a Division Bench of this Court in ***KRBL v. Praveen Kumar Buyyani***[25].

15.2 The principle of idea infringement is, to our mind, not applicable in the present case.

15.3 ***Madan Lal Purushottam Das*** is a case which clearly explains the principle of idea infringement. The rival marks, in that case, were used for mustard oil. Both the marks reflected the figure of an ox tethered to a grinding wheel, using which oil was ground from mustard seeds. It was in these circumstances that the Court held that the idea of using the image of an ox tethered to the grinding wheel by

[23] **2025 SCC Online Del 6811**
[24] **2015 SCC Online Del 10164**
[25] **2025 SCC Online Del 198**

which the oil was extracted from mustard seeds, i.e., using the pictorial depiction of the process of extraction of the oil as the logo under which the oil was manufactured and sold, was conceived by the plaintiff (in that case) and that, by adopting an identical idea of the ox tethered to the grinding wheel as the label under which the defendant was marketing and selling its oil, the idea conceived by the plaintiff had been infringed. For a claim of idea infringement to sustain, therefore, the plaintiff would have to establish that the idea reflected in its asserted mark was unique, and that the defendant had adopted the same idea as the basis for its mark.

15.4 Similarly, the judgment in ***Shree Nath Heritage Liquor*** has no similarity to the case at hand. The Court in that case was concerned with rival marks used for whisky. The marks were Officer's Choice and Director's Choice. The Division Bench held that though Officer and Director were not synonyms, keeping in view the fact that the Director is also a senior officer, the depiction of the whisky, in the marks, as the choice of a Director in one case and of an Officer in the other, was likely to result in confusion as the average consumer could remember in each case that the beverage was the favoured drink of a person in authority and would not be likely to differentiate between the marks, by remembering that the personal authority in one case was a Director and the other case was an Officer.

15.5 ***KRBL***, again, is completely distinguishable. The rival marks, in that case, were also used for rice. The marks, however, were INDIA GATE and BHARAT GATE. India is a synonym for Bharat, as the

opening words of our Constitution teaches us. Indeed, the expression BHARAT GATE has no etymological meaning. In these circumstances, this Court held that the adoption, by the defendant, in that case, of the mark BHARAT GATE, for rice, with an image of the India Gate on the face of the mark, was an obvious attempt at confusing the consumer with the plaintiff's INDIA GATE mark.

15.6 These cases cannot, in any way, be analogised to the case before us. There is no visual similarity between the two marks. The fact that deer happen to be part of the image in each case cannot be of significance, as the very positioning of the images of the deer is different. If one views the rival marks as a whole, there are enough added features in each mark which could differentiate one from the other. As we have earlier noted, the most visible and prominent distinguishing feature is the very name of the product, which is also prominently displayed on the label.

15.7 In no way, to our mind, can it be said that BNF adopted or borrowed the idea contained in KKM's mark while conceiving its CHEETAL word or device mark.

16. Ergo, no case of passing off

16.1 We, therefore, are of the opinion that there is no similarity between the rival marks, whether phonetic, visual, conceptual or structural. The learned Commercial Court has held that the mere fact that the DEER in the rival marks are in different positions is not

sufficient to indicate that the marks are not deceptively similar. This finding, as we have noted, is fundamentally unsound, as it reverses the onus of proof. That apart, we would hold, rather, that the mere fact that DEER form part of the rival marks before us is insufficient to make out a case of confusing or deceptive similarity between them.

16.2 In returning these findings, we clarify that we have examined the matter from the point of view of passing off. BNF is a registered proprietor of the word mark CHEETAL. It cannot, therefore, be restrained from using the mark CHEETAL, on the ground of infringement. Inasmuch as the device mark of BNF also prominently uses the word "CHEETAL", there can be no injunction against use of the device mark, either, on the basis of a finding of infringement.

16.3 The material on record does not make out any case of deceptive similarity between the rival marks, as can sustain a finding of passing off, even *prima facie*.

17. <u>No finding of goodwill</u>

17.1 There is yet another glaring error in the impugned judgment, which we have come across in several orders emanating from learned Commercial Courts in passing off cases. There is no finding of goodwill. The most fundamental requirement, in any case of passing off, is the existence of goodwill in the plaintiff's mark. Goodwill, misrepresentation and damage are the three classical ingredients of passing off. Goodwill has to be established by empirical data. Even at

the *prima facie* stage, the plaintiff is required to produce the details of all the expenses incurred by it in promoting its mark and of the sales figures relating to sale of goods bearing the marks asserted in the plaint. The manner in which goodwill has to be established in cases of passing off has most recently been explained by the Supreme Court in the following passages from ***Brihan Karan Sugar Syndicate Pvt Ltd v. Yashwantrao Mohite Krushna Sahakari Sakhar Karkhana***[26]:

> "12. There is a finding recorded by the High Court in the impugned judgment that the labels used on the bottle of country liquor sold by the appellant and the labels on the bottle of country liquor sold by the respondent are similar. At this stage, we may note the legal position regarding the factual details which are required to be proved in a passing off action. Firstly, we may refer to a decision of this Court in ***Satyam Infoway Ltd. v. Siffynet Solutions (P) Ltd.***[27] Paras 13 to 15 of the said decision read thus:
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> > "13. The next question is, would the principles of trade mark law and in particular those relating to passing off apply? An action for passing off, as the phrase "passing off" itself suggests, is to restrain the defendant from passing off its goods or services to the public as that of the plaintiff's. It is an action not only to preserve the reputation of the plaintiff but also to safeguard the public. The defendant must have sold its goods or offered its services in a manner which has deceived or would be likely to deceive the public into thinking that the defendant's goods or services are the plaintiff's. The action is normally available to the owner of a distinctive trade mark and the person who, if the word or name is an invented one, invents and uses it. If two trade rivals claim to have individually invented the same mark, then the trader who is able to establish prior user will succeed. The question is, as has been aptly put, who gets these first? *It is not essential for the plaintiff to prove long user to establish reputation in a passing off action. It would depend upon the volume of sales and extent of advertisement.*
> >
> > 14. The second element that must be established by a

[26] **(2024) 2 SCC 577**
[27] **(2004) 6 SCC 145**

> plaintiff in a passing off action is misrepresentation by the defendant to the public. The word "misrepresentation" does not mean that the plaintiff has to prove any mala fide intention on the part of the defendant. Of course, if the misrepresentation is intentional, it might lead to an inference that the reputation of the plaintiff is such that it is worth the defendant's while to cash in on it. An innocent misrepresentation would be relevant only on the question of the ultimate relief which would be granted to the plaintiff [***Cadbury-Schweppes (Pty) Ltd. v. PUB Squash Co. (Pty) Ltd.***[28]; ***Erven Warnink Besloten Vennootschap v. J. Townend & Sons (Hull) Ltd.***[29]]. What has to be established is the likelihood of confusion in the minds of the public (the word "public" being understood to mean actual or potential customers or users) that the goods or services offered by the defendant are the goods or the services of the plaintiff. In assessing the likelihood of such confusion the courts must allow for the "imperfect recollection of a person of ordinary memory" [***Aristoc Ltd. v. Rysta Ltd.***[30]].
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> 15. The third element of a passing off action is loss or the likelihood of it."
>
> (emphasis supplied)

13. Thus, the volume of sale and the extent of advertisement made by the appellant of the product in question will be a relevant consideration for deciding whether the appellant had acquired a reputation or goodwill.

14. At this stage, we may also refer to the decision of this Court in ***Toyota Jidosha Kabushiki Kaisha v. Prius Auto Industries Ltd.***[31]. In this decision, this Court approved its earlier view in ***S. Syed Mohideen*** that the passing off action which is premised on the rights of the prime user generating goodwill, shall remain unaffected by any registration provided in the Act. In fact, this Court quoted with approval, the view taken by the House of Lords in ***Reckitt & Colman Products Ltd. v. Borden Inc.***[32]. The said decision lays down triple tests. One of the tests laid down by the House of Lords was that the plaintiff in a passing off action has to prove that he had acquired a reputation or goodwill connected with the goods. Thereafter, in para 40 of ***Toyota***, this Court held

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[28] **(1981) 1 WLR 193**
[29] **(1979) 3 WLR 68**
[30] **1945 AC 68 (HL)**
[31] **(2018) 2 SCC 1**
[32] **(1990) 1 WLR 491 (HL)**

that if goodwill or reputation in a particular jurisdiction is not established by the plaintiff, no other issue really would need any further examination to determine the extent of the plaintiff's right in the action of passing off.

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17. For establishing goodwill of the product, it was necessary for the appellant to prove not only the figures of sale of the product but also the expenditure incurred on promotion and advertisement of the product. Prima facie, there is no evidence on this aspect. While deciding an application for a temporary injunction in a suit for passing off action, in a given case, the statements of accounts signed by the Chartered Accountant of the plaintiff indicating the expenses incurred on advertisement and promotion and figures of sales may constitute a material which can be considered for examining whether a prima facie case was made out by the appellant-plaintiff. However, at the time of the final hearing of the suit, the figures must be proved in a manner known to law."

(Italics in original; underscoring supplied)

18. Even assuming that the allegation of deceptive similarity in the labels used by the respondent was established by the appellant, one of the three elements which the appellant was required to prove, has not been proved. Therefore, we find that the High Court was justified in staying that particular part of the decree of the trial court by which injunction was granted for the action of passing off."

17.2 In the present case, there is no examination, by the learned Commercial Court, of the aspect of goodwill at all. There is no finding that the data produced by KKM made out a case of existence of goodwill or reputation in the mark DOUBLE DEER, whether as a word mark or a device mark. In this context, we may also note, that, in passing off cases, the plaintiff has to establish the existence of sufficient goodwill and reputation in the asserted marks prior to commencement of user of the marks by the defendant. This position stands crystallised by the judgments of the Supreme Court in ***Toyota*** and ***Pernod Ricard India Private Limited v. Karanveer Singh***

Chhabra[33].

17.3 There is no finding, by the learned Commercial Court, that KKM had amassed sufficient goodwill or reputation, in its asserted DOUBLE DEER mark, prior to commencement of user of BNF CHEETAL word and device marks, as would sustain a plea of passing off.

18. Mr. Bansal prays that, if the impugned judgment of the learned Commercial Court suffered from the absence of any finding on the aspect of goodwill, the matter could be remanded to the learned Commercial Court to return a finding in that regard.

19. We are not inclined to adopt the said approach as, to our mind, even on the aspect of misrepresentation or deceptive similarity, there is no case made out, to sustain even a *prima facie* finding of passing off, by BNF, of its goods as those of KKM.

Conclusion

20. Having heard learned Counsel for the parties and for the aforesaid reasons, we are of the considered opinion that the impugned judgment is unsustainable in law and on facts.

21. Accordingly, the impugned judgment dated 6 November 2024 is quashed and set aside.

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[33] **2025 SCC OnLine SC 1701**

22. The application filed by the respondent under Order XXXIX Rules 1 & 2 before the learned Commercial Courts shall stand dismissed.

23. Needless to say, the above findings in this judgment are only intended to dispose of the Order XXXIX Rules 1 and 2 application of the respondent and would have no binding effect on the learned Commercial Courts while adjudicating the suit.

C. HARI SHANKAR, J.

OM PRAKASH SHUKLA, J.

JANUARY 9, 2026/*At/aky/yg*