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

% Judgment delivered on: 17.01.2026

\+ **C.A.(COMM.IPD-TM) 23/2024 & I.A. 9027/2024**

KARAN RATHORE .....Appellant

versus

REGISTRAR OF TRADE MARKS & ANR. .....Respondents

Advocates who appeared in this case

For the Appellant : Mr. Kunal Khanna, Mr. Vishal Patel, Mr. Nishant Dwivedi and Ms. Divya Verma, Advocates.

For the Respondents : Ms. Avshreya Pratap Singh Rudy, CGSC with Ms. Usha Jamnal, Mr. Mohammad Junaid Mahmood and Ms. Prajna Pandita, Advocates for R-1.
Mr. Rahul Kumar, Advocate for R-2.

CORAM:
HON'BLE MR. JUSTICE TEJAS KARIA

JUDGMENT

TEJAS KARIA, J

1. The present Appeal has been filed by the Appellant under Section 91 of the Trade Marks Act, 1999 ("**Act**") assailing the order dated 14.03.2024

("**Impugned Order**") passed by Respondent No. 1, whereby the Appellant's Opposition bearing No. 1221460 ("**Appellant's Opposition**") to the Trade Mark Application bearing No. 5854000 in Class 12 ("**Subject Application**") for the registration of the Mark 'JBR' ("**Impugned Mark**") in the name of Respondent No. 2, has been dismissed by Respondent No. 1.

FACTUAL BACKGROUND:

2. Mr. Jagdish Joshi, the proprietor M/s Tushar Auto Spares and the predecessor-in-interest of the Appellant, assigned the Mark ' ', ("**Appellant's Mark**") in favour of the Appellant by way of the Deed of Assignment dated 03.05.2023 ("**Assignment Deed**"). The Appellant's Mark was registered under the Trade Mark Application bearing No. 2010008 in Class 12 ("**Appellant's Application**"), for goods - motor parts.

3. It is the Appellant's claim that the Appellant is the prior user of the Appellant's Mark and has been extensively using the same since 04.06.2000 through its predecessor. Further, due to long, continuous and extensive use of the appellant's Mark in addition to the advertisement and promotional activities carried out by the Appellant, the Appellant claims that the Appellant's Mark is exclusively identified with the Appellant throughout the world, including in India.

4. On 18.03.2023, Respondent No. 2 filed the Subject Application in respect of goods, i.e., car cover, bike cover and vehicle cover, in Class 12 for the registration of the Impugned Mark with a user claim of 16.07.2020. Subsequent to the process of examination, the Subject Application was accepted and advertised in the Trade Marks Journal bearing No. 2104 dated 15.05.2023.

5. The Appellant filed a Notice of Opposition against the Subject Application on 27.05.2023. Respondent No. 2, thereafter filed the Counter-Statement on 07.07.2023 against the Appellant's Notice of Opposition. Subsequently, both the Appellant and Respondent No. 2 filed their respective evidences.

6. Respondent No. 1 issued a Hearing Notice scheduling a hearing for the purpose of advancing arguments on 04.03.2024. Subsequent to the said hearing being conducted, Respondent No. 1 passed the Impugned Order dismissing the Appellant's Opposition against the Subject Application of Respondent No. 2.

7. On 14.03.2024, Respondent No. 1 proceeded with the issuance of the Registration Certificate for the Impugned Mark in favour of Respondent No. 2.

8. Aggrieved by the same, the present Appeal has been filed by the Appellant before this Court.

SUBMISSIONS ON BEHALF OF THE APPELLANT:

9. The learned Counsel for the Appellant made the following submissions:

9.1. The Appellant's Mark was coined and adopted on 04.06.2000 by the Appellant's predecessor-in-interest, Mr. Jagdish Joshi trading as Tushar Auto Spares, and has continuously been in use since its adoption. The Appellant's Mark was validly assigned to the Appellant through an Assignment Deed.

9.2. Respondent No. 2, being a cousin of the Appellant, had previously obtained explicit permission from the Appellant's predecessor *vide* Authorization Letter dated 06.07.2020 to use

the Impugned Mark to sell its products on Flipkart and Amazon, thereby admitting the Appellant's rights in the Appellant's Mark.

9.3. Respondent No. 2's Subject Application was filed despite prior knowledge of the Appellant's Mark and its long-standing commercial use. The conduct of Respondent No. 2 clearly evidences *mala fide* on its part in adopting the Impugned Mark.

9.4. Respondent No. 1 *vide* Impugned Order erroneously held that vehicles covers and motor parts are goods of different description without any reasoning or discussion regarding the same. Both categories are automotive accessories, which are targeted at the same consumer pace and sold through common trade channels such as automotive part retailers and e-commerce platforms.

9.5. Reliance was placed on this Court's judgment in ***FDC Limited v. Docsuggest Healthcare Services Pvt. Ltd.***, 2017 SCC OnLine Del 6381, to argue that similarity of goods need not be considered to establish infringement under Section 29(4) of the Act.

9.6. Relying upon the decision in ***Punjab Tractors Ltd. V. Pramod Kumar Garg***, 85 (2000) DLT 567, it was argued that the criteria for determining what is likely to deceive or cause confusion is whether the Trade Mark by its resemblance to another Trade Mark already on the register, is likely to deceive in the normal course of its legitimate use in the trade and that the goods are such that by virtue of some similarity, affinity or other circumstance, the purchasing public will consider them as

coming from the same source if marketed under similar Trade Marks.

9.7. The Appellant's Mark, which is a Device Mark, prominently incorporates the Impugned Mark, which is a Word Mark and forms the dominant and essential component of the Appellant's Mark.

9.8. Respondent No. 2, in its pleadings, has admitted that there exists a valid assignment between the Appellant and its predecessor, regarding the Appellant's Mark. It is further acknowledged by Respondent No. 2 that the Appellant's predecessor was the earlier user of the Appellant's Mark and that there is no document placed on record by Respondent No. 2, which evidences adoption or use of the Impugned Mark prior to seeking authorization by Respondent No. 2 from the Appellant's predecessor.

9.9. In view of the foregoing submissions, it is prayed that the present Appeal be allowed and the Impugned Order be set aside.

SUBMISSIONS ON BEHALF OF RESPONDENT NO. 2:

10. The learned Counsel for Respondent No. 2 has made the following submissions:

10.1. The Appellant is not the prior user and adopter of the Word Mark 'JBR' / Impugned Mark, which is registered in the name of Respondent No. 2. The Subject Application for the registration of the Impugned Mark was filed by Respondent No. 2 prior to the Assignment Deed between the Appellant and the Appellant's predecessor. Further, the Appellant's

predecessor never traded the goods, i.e., vehicle cover, car cover and bike cover, using the Appellant's Mark.

10.2. The Appellant has taken the ground that it was the prior user of the Appellant's Mark by virtue of the Assignment Deed, despite knowing that the Appellant's predecessor was not dealing in the aforesaid goods, using the said Mark.

10.3. Respondent No. 2 filed the Subject Application for the registration of the Word Mark 'JBR' / the Impugned Mark, whereas the Appellant's Mark is a Device Mark, which is totally different from the Impugned Mark.

10.4. The Authorization Letter given by the Appellant's predecessor to Respondent No. 2 was not related to the goods that Respondent No. 2 deals with and, therefore, Respondent No. 2 did not seek extension of the said authorization.

10.5. After the Appellant filed its Objection to the Subject Application, detailed reply and evidence were filed by Respondent No. 2 before Respondent No. 1 and after giving a proper hearing to the Appellant and Respondent No. 2, Respondent No. 1 passed the Impugned Order.

10.6. Reliance was placed upon the Supreme Court's decision in ***Nandhini Deluxe v. Karnataka Coop. Milk Producers Federation Ltd.,*** (2018) 9 SCC 183, and ***Vishnudas Trading v. Vazir Sultan Tobacco Co. Ltd.***, AIR 1996 SC 2275, to argue that identical Marks can be used for different goods. The Appellant's predecessor has obtained registration of the Appellant's Mark for goods related to motor parts and they

cannot claim any right over the whole range of goods mentioned in Class 12.

10.7. The Appellant's predecessor and Respondent No. 2's goods for which they sought registration of their respective Marks are not similar and their intended purposes are different as seat covers cannot be considered as motor parts. Motor parts are essential components used to run the vehicle, whereas seat covers are not necessarily required and are optional in nature. The motor parts are directly installed in the vehicles to ensure their proper functioning, whereas vehicle covers are additionally applied upon vehicles to safeguard the appearance of the vehicles.

10.8. The physical nature of the Appellant's predecessor and Respondent No. 2's trade goods, trade channels and sectors are different. Both the motor parts and vehicle covers are typically not distributed and sold through similar trade channels within the automotive industry.

10.9. It is a settled law that if a trader or manufacturer actually trades or manufactures only one or some of the goods under a Trade Mark and has no *bona fide* intention to trade in or manufacture other goods falling under that Class but has obtained registration under the said Class covering several other goods, such registration needs to be rectified by confining it to the specific goods, which are actually intended to be traded in or manufactured by the registrant. In the present case, the Appellant's predecessor had secured registration for the

Impugned Mark in respect of motor parts but never dealt in vehicle covers at any point of time.

10.10. In view of the foregoing submissions, it is prayed that the present Appeal be dismissed.

ANALYSIS AND FINDINGS:

11. Heard the learned Counsel for the Parties and perused the material placed on record.

12. It is a matter of record that the Appellant's Mark was registered in Class 12 for the goods - motor parts, with user claim dating back to the year 2000. On the other hand, the Subject Application for the registration of the Impugned Mark claims user date of 16.07.2020 for the goods - car covers, bike covers and vehicle covers. By way of the Assignment Deed, the Appellant's Mark was assigned by the Appellant's predecessor in favour of the Appellant.

13. The Appellant objected to the Subject Application, however, *vide* the Impugned Order, the Appellant's Opposition was dismissed by Respondent No. 1. The relevant portion of the Impugned Order reads as under:

> "*7. The main ground of the opposition is that the opponent is the prior adopter and user of the mark "JBR" for various goods falling under class 12. Whereas, the Applicant asserts that the goods of the opponent are altogether different and the applicant is prior adopter of the impugned mark for 'VEHICLE COVERS' and have been using it since 16/07/2020 and has provided invoices from July 2020 to substantiate their claim of use of the impugned mark for 'VEHICLE COVERS' since July 2020. The Opponent, on the other hand, claims to have used the trademark "JBR" since 2000 for various goods falling in class 12. In support of this claim, it is noteworthy that the applicant has relied upon a registration of the mark "JBR" under application no. 2010008 and invoices. It is important to emphasize that the said registration under application no. 2010008 is limited to*

the 'MOTORS PARTS" only. The other application (application no. 5954778) relied upon by the opponent to show the use of the mark "JBR" for 'VEHICLE COVERS' was filed on 27/05/2023 and pending for registration, and the earliest invoices produced by the opponent to show the use of the mark for 'VEHICLE COVERS' is for September 2023. Consequently, it is evident that the opponent is subsequent adopter of the mark "JBR" for the goods 'VEHICLE COVERS" and failed to show the use of their mark, "JBR," for 'VEHICLE COVERS' prior to the applicant.

8. The registration relied upon by the opponent to show the use of the mark "JBR" for class 12 goods is limited only in respect of MOTORS PARTS", whereas, the goods of the applicant are limited to 'VEHICLE COVERS' only. It is evident from the records available before me that the goods of rival parties are different from each other, and the law is settled that proprietor of trademark cannot claim monopoly over the entire class on the basis of registration for some particular goods falling under that particular class. The Supreme Court in MIS. Nandhini Deluxe vs. Karnataka Co-Operative Milk Producers Federation Ltd., has held that the proprietor of a trade mark cannot enjoy monopoly over the entire class of goods particularly when he is not using the said trade mark in respect of certain goods falling under the same class.

9. The other ground of opposition is that the adoption of the impugned mark by the applicant is dishonest. In response, the applicant has argued that the opponent has copied the applicant's mark and applied for the registration for the mark "JBR" in May 2023 under application no. 5954778, much subsequent to the applicant. It was also submitted by the applicant that the opponent has copied their other marks also such as; "DOTMIE" and "DROMIE" pending for registration under applications no. 4478691 and 4504111, the identical marks are applied by the opponent under applications no. 6048005 and 4530760. It is clear from the records that the opponent has filed all the three aforementioned applications subsequent to the applicant for identical marks in respect of identical goods as to the applicant's. Though the user claimed by the opponent under application no. 5954778 for the mark "JBR" in respect of 'VEHICLE COVER' is from 04/06/2020, but the earliest

document/invoice produced by the opponent to show the use of the mark "JBR" in respect of 'VEHICLE COVERS' is for September 2023. The Applicant has been able to establish that he is the prior adopter and continuous user of the impugned mark for 'VEHICLE COVERS.'

10. Based on the aforementioned analysis and findings, it is evident that the applicant's adoption of the impugned mark for 'VEHICLE COVERS' predates the opponent's claim. I uphold the proprietary claims of the applicants under Section 18(1) of the Act. Therefore, the application is entitled to registration."

14. In the Impugned Order, it is observed that the Appellant's Application for the registration of the Appellant's Mark establishes use only in respect of motor parts in Class 12, whereas the goods for which the Subject Application of Respondent No. 2 seeks registration of the Impugned Mark in Class 12 are vehicle covers. Accordingly, Respondent No. 1 held that the goods of the Appellant and Respondent No. 1 are different, and the Appellant's Mark cannot enjoy monopoly over the entire class of goods.

15. It is the Appellant's case that Respondent No. 1 erroneously held that vehicles covers and motor parts are goods of different description without any reasoning to support the said conclusion. *Per contra,* Respondent No. 2 contended that the Appellant's predecessor had obtained registration of the Appellant's Mark for goods related to motor parts and the Appellant cannot claim any right over the whole range of goods mentioned in Class 12.

16. In the present case, it is to be determined whether there exists a likelihood of confusion when the Impugned Mark is used on the goods sold by Respondent No. 2. There is no cavil that the prominent feature of the Appellant's Mark is the word 'JBR' and the Appellant cannot be precluded from the right to exclusive use of the said word in relation to the goods for which it holds registration. Accordingly, the competing Marks of the

Appellant and Respondent No. 2 are structurally, phonetically and conceptually identical. Therefore, the real controversy lies in whether the competing goods of the Appellant and Respondent No. 2 can be considered similar, so as to refuse the registration of Respondent No. 2's Impugned Mark.

17. In ***FDC Limited*** (supra), a coordinate bench of this Court laid down the relevant principles and factors relevant for determining if there exists similarity between goods/services. The relevant portion of the said decision is extracted below:

> "**53.** *Now, to determine whether the defendants' services are allied and cognate to plaintiff's goods, it is essential to first discuss the law on similarity in goods/services in trademarks and its development so far. While the Act is silent on the factors to be considered for similarity in goods/services, the Courts in India - relying upon international cases and literature, have consolidated the guiding principles and factors found relevant in ascertaining the similarity between goods/services. They are as follows:*
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> 1. *In Assam Roofing Ltd. v. JSB Cement LLP 2015 SCC OnLine Cal 6581, the learned Single Judge in Para 80 observes- "**The test of similarity of goods is looked at from a business and commercial point of view**. The nature and composition of the goods, the respective uses of the articles and the trade channels through which they are brought and sold all go into consideration in this context". (emphasis supplied)*
> 2. *In Kerly's Law of Trade Marks and Trade Names, 15th Edition 2011, the learned Author in Para 9-073 has stated as under : -*
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> *"As para.23 of the decision in Canon v. MQM (1999) R.P.C. 117 makes clear, all factors relating to the goods or services themselves must be taken into account. **These include, inter alia, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary**. It is clear that goods in different classes*

may nevertheless be considered similar, and likewise that goods or services within the same class may be found to not be similar." (emphasis supplied)

3. *In Para 9-075, the Learned Author has mentioned some illustrations on similar goods or services including under Para 9-078 ""Services offered by beauty salons; solarium services" similar to "business assistance with beauty preparations, sales" and "beauty preparations, perfumery, cosmetics dietetic substances"". The said illustration sources from the case of Beauty Shop Application v. Opposition of Evora BV [1999] E.T.M.R. 20, wherein the Office for Harmonization in the Internal Market (Trade Marks and Designs) also known as the Opposition Division held the defendant's services to be similar to the plaintiff's services and goods by observing that "the goods and services of the conflicting marks could be offered together and be intended for the same public."*
4. *In British Sugar Plc. v. James Robertson & Sons Ltd. [1996] R.P.C. 281 at 294-297, relied upon in Balkrishna Hatcheries v. Nandos International Ltd. 2007 SCC OnLine Bom 449 and Advance Magazine Publishers, Inc. v. Just Lifestyle Pvt. Ltd. 2016 SCC OnLine Bom 8417, the court laid down the objective test for similarity of description of goods/services as follows:*
   - ***(a) "The uses of the respective goods or services;***
   - ***(b) The users of the respective goods or services;***
   - ***(c) The physical nature of the goods or acts of service;***
   - ***(d) The trade channels through which the goods or services reach the market;***
   - ***(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves; and***
   - ***(f) The extent to which the respective goods and services are in competition with each other : that inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of***

course act for industry, put goods or services in the same or different sectors."

5. *Kerly 15th ed. while relying upon Canon (supra), further observes in Para 9-065 that the element of* ***distinctive character of a trademark and its reputation*** *is also viewed when determining similarity between the goods and services and whether such similarity is sufficient to give rise to the likelihood of confusion."*

18. The goods sold by the Appellant are motor parts, whereas the goods sold by Respondent No. 2 are vehicle covers. Both the category of goods form part of automative accessories employed for usage with vehicles. The consumer base and purchasing public for both the goods is primarily the same and the trade channels through which they are bought and sold are also the same, which is evident from the fact that the Appellant itself deals in both the competing goods in question.

19. Perusal of the Authorization Letter dated 06.07.2020 makes it clear that Respondent No. 2 was authorized to sell car body covers, bike body covers, scooty body covers and other motor accessories under the Appellant's Mark on Flipkart and Amazon, for a period of six months from 06.07.2020 to 05.01.2021. Therefore, there was implicit acceptance on the part of Respondent No. 2 regarding the rights of the Appellant in the Appellant's Mark with respect to motor accessories including vehicle covers.

20. It is well-established in law that an owner of a Mark is always entitled to expand its goods and services, as a natural consequence in expansion of its business. In accordance with the law laid down in ***FDC Limited*** (supra), when the present controversy is perceived from the commercial and business

point of view, there could be confusion in the minds of the purchasing public that the competing goods stem from the same trade source.

21. Therefore, in the present case, not only the identity of the competing Marks, but also the similarity of the competing goods is established. If there is any likelihood of confusion on account of identity of competing Marks and similarity of competing goods sold under them, the prohibition under Section 11 of the Act comes into operation, where the registration of the Mark is likely to cause confusion. Accordingly, the Subject Application for the registration of the Impugned Mark is covered by the prohibition for registration under Section 11 of the Act and ought to have been refused by Respondent No. 1.

22. In view of the above analysis, the present Appeal is allowed and the Impugned Order dated 14.03.2024 passed by Respondent No. 1 dismissing the Appellant's Opposition, is set aside. Accordingly, the registration granted in favour of Respondent No. 2 in the Subject Application for the Impugned Mark 'JBR' is cancelled / rectified / expunged / removed from the Register of Trade Marks under Section 57 of the Act.

23. A copy of this Order is directed to be sent to the Office of Controller General of Patents, Designs and Trade Marks of India through email at llc-ipo@gov.in, for necessary compliance.

TEJAS KARIA, J

JANUARY 17, 2026
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