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

+ CS(COMM) 848/2022

**FOODLINK F AND B HOLDINGS INDIA PRIVATE  
LIMITED**

..... Plaintiff

Through: Mr. Chander Mohan Lall, Sr.  
Adv. with Mr. Sarthak Sachdeva, Mr.  
Ashish Batra, Ms. Ananya Chugh, and Mr.  
Wattan Sharma, Advs.

versus

**WOW MOMO FOODS PRIVATE LIMITED** .... Defendant

Through: Mr. Shuvasish Sen Gupta, Mr.  
Kumar Vivek Vibhu and Mr. Abhrajit Roy  
Chowdhry, Advs.

**CORAM:**

**HON'BLE MR. JUSTICE C. HARI SHANKAR**

**JUDGMENT (ORAL)**

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**03.08.2023**

**I.A. 9418/2023 (condonation of delay of 15 days in filing replication)**

1. For the reasons stated therein, the delay in filing replication is condoned.

2. The application stands disposed of.

**I.A. 20611/2022 (under Order XXXIX Rules 1 and 2 of CPC)**

3. The plaintiff alleges infringement, by the defendant, of its registered trade mark, registered w.e.f. 11 January 2012 in class 43, for all kinds of restaurants, bars, snack bars, hotels, cafeterias and canteens.



4. The plaintiff's mark is . The defendant was, till 2019, using the mark WOW! CHINA, depicted as .

5. In 2019, however, the defendant added, below the word China in the logo, the word "BISTRO". The mark, thus, became .

6. The plaintiff's case is that with the addition of "BISTRO" below "CHINA" in the mark , the defendant's mark became deceptively similar to that of the plaintiff, inasmuch as both now read CHINA BISTRO, with the "WOW!" above "CHINA" in the defendant's mark being the only differentiating feature. The plaintiff's case is that this added word "WOW!" would not in any way mitigate the possibility of confusion or deception between the two marks, from the point of a customer of average intelligence and imperfect recollection.

7. There is no dispute about the fact that, while the plaintiff's mark  stands, as already noted, registered in favour of the plaintiff in class 43 w.e.f. 15 December 2003 and, thereafter, w.e.f. 1 April 2015, the defendant has no registration of the impugned mark





8. Equally, there is no dispute about the fact that both the marks are used for providing similar services, as, under the “BISTRO” tag, both the plaintiff and the defendant run upmarket restaurants offering Chinese – or Indo Chinese – cuisine.

9. The dispute, therefore, does not admit of much complexity. From the rival submissions of learned Counsel, only two issues arise, viz. (i) whether the plaintiff’s and defendant’s marks are confusingly or deceptively similar so as to result in infringement within the meaning of Section 29(2)<sup>1</sup> of the Trade Marks Act, 1999 and (ii) whether the plaintiff is entitled to so claim.

The aspect of confusing or deceptive similarity

10. Though Mr. Sengupta, learned Counsel for the defendant, sought to submit that, seen as a whole, the plaintiff’s and the defendant’s marks are not deceptively similar, I am not inclined, *prima facie*, to accept the submission.

11. Though both are device marks, the plaintiff’s mark consists of the word CHINA BISTRO and the defendant’s mark consists of the word WOW! CHINA BISTRO, with certain added visual/pictorial

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<sup>1</sup> (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.



matter.

12. Infringement, unlike passing off, is to be decided on a plain comparison of the rival marks. Goodwill and reputation have little, if any, part to play in the process. The matter has to be examined from the perspective of the customer of average intelligence and imperfect recollection, who is neither a genius, nor a fool. One may, in a sense, liken him to Laxman's immortal "common man" who, even while being observant and discerning, always has that slightly befuddled look on his face. The consumer, moreover, must be one who is not overly familiar with either mark. The classical test is whether such a consumer, endowed with average intelligence and imperfect recollection, who chances on the plaintiff's mark at one point of time, and on the defendant's some time later, is given to wonder whether he has seen the mark, or a mark associated with it, earlier. What is required, for infringement to be said to exist, is "initial interest confusion". In other words, if the initial interest generated by seeing the defendant's mark places the consumer in a "state of wonderment" – to borrow the felicitous expression used by the Division Bench of this Court in *Shree Nath Heritage Liquor (P) Ltd v. Allied Blender & Distillers (P) Ltd*<sup>2</sup> - as to whether the mark is the same as the one, he had seen earlier, or bears an association therewith, the tort of infringement stands, *ipso facto*, committed.

13. This, in precis, may be said to be the litmus test for infringement.

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<sup>2</sup> 221 (2015) DLT 359 (DB)



14. The Supreme Court addressed, as far back as in *Where the words consisting of the dominant parts of the device marks are thus similar, the fact that the added visual matter accompanying the words in the device marks would not make any difference to the aspect of infringement stands already conclusively decided by the Supreme Court in *Kaviraj Pt. Durga Dutt Sharma v. Navratana Pharmaceutical Laboratories*<sup>3</sup> and *K.R. Krishna Chettiar v Shri Ambal & Co.*<sup>4</sup>*

15. *Kaviraj*<sup>3</sup> – as the decision is often fondly referred to – lucidly expounded the applicable principles thus:

“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 negating 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

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<sup>3</sup> AIR 1965 SC 980

<sup>4</sup> AIR 1970 SC 146



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, 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). 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 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.*"

(Emphasis supplied)

**16. *K.R. Krishna Chettiar***<sup>4</sup> involved two device marks, which were, as is categorically observed in the decision, visually totally dissimilar. Both were used for snuff. The textual matter in one was "Shri Andal"; in the other, "Shri Ambal". So phonetically similar was the textual matter in the rival marks – which constituted their essential feature – that the Supreme Court held the visual dissimilarity between them to be of no consequence. Thus ruled the Supreme Court:

"5. Now the words "Sri Ambal" form part of Trade mark no. 126808 and are the whole of trade mark no. 146291. There can be no doubt that the word "Ambal" is an essential feature of the trade marks. The common "Sri" is the subsidiary part, of the two words "Ambal" is the more distinctive and fixes itself in the recollection of an average buyer with imperfect recollection.

6. The vital question in issue is whether, if the appellant's mark is used in a normal and fair manner in connection with the snuff and if similarly fair and normal user is assumed of the existing registered marks, will there be such a likelihood of deception that the mark ought not to be allowed to be registered (see *In the matter of Broadhead's Application for registration of*



*a trade mark*<sup>5</sup>). It is for the court to decide the question on a comparison of the competing marks as a whole and their distinctive and essential features. We have no doubt in our mind that if the proposed mark is used in a normal and fair manner the mark would come to be known by its distinguishing feature "Andal". There is a striking similarity and affinity of sound between the words "Andal" and "Ambal". Giving due weight to the judgment of the Registrar and bearing in mind the conclusions of the learned Single Judge and the Divisional Bench, we are satisfied that there is a real danger of confusion between the two marks.

7. There is no evidence of actual confusion, but that might be due to the fact that the appellant's trade is not of long standing. There is no visual resemblance between the two marks, but ocular comparison is not always the decisive test. The resemblance between the two marks must be considered with reference to the ear as well as the eye. There is a close affinity of sound between Ambal and Andal.

8. In the case of *Coca-Cola Co. of Canada v. Pepsi Cola Co. of Canada Ltd.*<sup>6</sup>, it was found that cola was in common use in Canada for naming the beverages. The distinguishing feature of the mark Coca Cola was coca and not cola. For the same reason the distinguishing feature of the mark Pepsi Cola was Pepsi and not cola. It was not likely that anyone would confuse the word Pepsi with coca. In the present case the word "Sri" may be regarded as in common use. The distinguishing feature of the respondent's mark is Ambal while that of the appellant's mark is Andal. The two words are deceptively similar in sound.

9. *The name Andal does not cease to be deceptively similar because it is used in conjunction with a pictorial device.* The case of *De Cordova & Ors. v. Vick Chemical Co.*<sup>7</sup> is instructive. From the appendix printed at page 270 of the same volume it appears that Vick Chemical Company were the proprietors of the registered trade mark consisting of the word "Vaporub" and another registered trade mark consisting of a design of which the words "Vicks Vaporub Salve" formed a part. The appendix at p. 226 - shows that the defendants advertised their ointment as 'Karsote vapour Rub". It was held that the defendants had infringed the registered marks. Lord Radcliffe said: ". . . a mark is infringed by another trader if, even without using the whole of it upon or in connection with his goods, he uses one or more of its essential features."

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<sup>5</sup> (1950) 57 RPC 209, 214

<sup>6</sup> 1942 59 RPC 127

<sup>7</sup> 1951 68 RPC 103



17. There can, *prima facie*, be no doubt that the words CHINA BISTRO, in the case of the plaintiff's mark, and the words WOW! CHINA BISTRO, in the case of the defendant's mark, constitute their essential feature.

18. The sequitur, at least *prima facie* is, to my mind, clear. A customer of average intelligence and imperfect recollection comes, one day, across the plaintiff's CHINA BISTRO eatery. A few days later, he chances across the defendant's WOW! CHINA BISTRO outlet. He is *not* a customer who is aware of the reputation of one mark or the other, for we are dealing, presently, with infringement, not passing off. To my mind, the likelihood of the customer being given to wonder whether the two outlets are not managed by one person, or whether there is no association between the two, is apparent. That, *prima facie*, satisfies the indicia of infringement, as envisaged by Section 29(2) of the Trade Marks Act.

19. On the aspect of confusing or deceptive similarity, *vis-à-vis* Section 29(2) of the Trade Marks Act, therefore, the plaintiff has, in my view, a clear *prima face* case.

#### Entitlement of plaintiff to plead infringement

20. Mr. Sengupta, however, seeks to question the entitlement of the plaintiff to plead infringement on the ground that, while securing registration of the mark CHINA BISTRO, the plaintiff had clearly disclaimed exclusivity both for the word "CHINA" as well as for the



word “BISTRO”. Additionally, Mr. Sengupta would seek to contend that neither the word “CHINA” nor the word “BISTRO” is individually registrable as a mark, as “CHINA” is the name of a country and “BISTRO” is *publici juris*, as it is a commonly used expression regarding the restaurants, cafes and the like. Having disclaimed exclusivity both in respect of “CHINA” and “BISTRO”, Mr. Sengupta would submit that the plaintiff cannot now claim exclusivity for the composite mark CHINA BISTRO.

**21.** The first question to be addressed, therefore, is whether the plaintiff has, in fact, disclaimed exclusivity for both “CHINA” and “BISTRO”.

**22.** Mr. Sengupta has invited my attention to the various trade mark registrations granted to the plaintiff.

**23.** The first registration, No.1470912, granted to the plaintiff was for the device mark  w.e.f. 18 July 2006, in Class 42 for “restaurant, Bar, Snack Bar, Hotels, Cafes, Cafeterias, Canteens, Catering, Outdoor Catering, food court, food stalls”. The following disclaimer was entered in hand below the registration in the Trade Mark Journal:

“No exclusive right over the word China and Bistro, except as substantially<sup>8</sup> shown.”

**24.** The second registration (No. 2264846) of the device mark

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<sup>8</sup> This word is somewhat illegible.



was w.e.f. 11 January 2012, in Class 43 for “all kind of restaurant, bar, snack bar, hotels, cafes, cafeterias, canteens, catering, outdoor catering, food court and food stalls”. This registration contained the following disclaimer:

“Registration of this trade mark shall give no right to the exclusive use of the word china. This is subject to association with registered/pending registration no.1470912.”

Thus, there was no express disclaimer of “Bistro” in Registration No.

2264846, granted for .

**25.** The third registration (No. 3582562), chronologically, was for the mark , w.e.f. 1 July 2017, in Class 43 for “restaurants, services relating to providing food and drinks; cafeterias, lounges, bars, pubs; catering services, providing food counters, temporary accommodation, hospitality services, hotels, motel and restaurant booking and reservations; providing of boarding and lodging services hotel information services”. Though this registration did not incorporate any disclaimer, it contained that the comment that it was

“associated with 2264846”, whereunder the mark  was registered.

**26.** The fourth registration (No. 5579338) obtained by the plaintiff, which, at the time of filing of the present suit, was still pending and has, since, been registered on 5 July 2023, was for the word mark CHINA BISTRO, without any disclaimer but, again, indicating



Registration No. 3582562, whereunder the mark  was registered.

27. Mr. Sengupta's contention is that, as by entering a rider, in Registrations Nos 3582562 and 5579338, whereunder the device mark  and the word mark CHINA BISTRO respectively were registered, that they were to be associated with earlier marks which contained such disclaimers, the disclaimers became *mutatis mutandis* applicable to the latter marks as well.

28. Mr. Lall, learned Counsel for the plaintiff, seriously questions the correctness of this submission and, in that regard, relies on Section 44<sup>9</sup> of the Trade Marks Act 1999. He submits that a plain reading of Section 44 reveals that the only purpose of associating trademarks is so that they are assignable and transmissible as a whole and not separately. Barring this consideration, all trademarks, even if associated with each other, are to be treated as separate trademarks. As such, he submits that the disclaimer to which trade mark no. 1470912 and 2264846 were subject to, would not apply to the later trademarks, as no such disclaimer was to be found in the certificates registering the said trademarks.

29. My attention has not been invited to any provision by which, by mere association of a later trade mark with an earlier trade mark in the certificate of registration, a disclaimer in the earlier trade mark would

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<sup>9</sup> 44. **Assignability and transmissibility or associated trademarks.** – Associated trademarks shall be assignable and transmissible only as a whole and not separately, but, subject to the provisions of this Act,



*ipso facto*, apply to the later trade mark as well. Indeed, there is no reason why the certificate of registration of the later marks would not expressly include such disclaimers, if such was the intent of the registering authority.

**30.** In that view of the matter, and keeping in mind Section 44 of the Trade Marks Act, *prima facie*, it would appear that the disclaimer in the present case apply only to the first two registered trademarks, i.e. Mark No. 1470912 for  and Mark No. 2264846 for , and not to the latter three trademarks, including the word mark CHINA BISTRO.

**31.** The finding of confusing similarity of the impugned  mark would apply to all the plaintiff's marks, including the device mark  and the word mark CHINA BISTRO, neither of which is caveated by any disclaimer.

**32.** Though, therefore, the aspect of disclaimer may not be of much significance, I deem it appropriate, nonetheless to address the rival submissions advanced by learned Counsel for the parties in that regard.

**33.** Even if, arguendo, one were to presume that, for all the marks of the plaintiff, there is a disclaimer of "CHINA" and "BISTRO"

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they shall, for all other purposes, be deemed to have been registered as separate trademarks.



individually, the only consequence of such disclaimer, in my opinion, is that the plaintiff would not be able to urge infringement of a mark of another person solely because the said mark uses the word “CHINA” or the said mark uses the word “BISTRO”. However, that would not inhibit the plaintiff from alleging infringement of the mark of another person on the ground that it is deceptively similar to the composite mark CHINA BISTRO when seen as a whole. Simply put, disclaiming exclusivity in respect of the individual parts of a mark would not *ipso facto* result in disclaiming exclusivity over the composite mark as a whole.

**34.** Two ordinary words, though completely lacking in distinctiveness when seen individually may, when combined together, be distinctive. This is, in my considered opinion, *prima facie* one such case.

**35.** On the aspect of disclaimer, Mr. Lall has cited decisions of the Supreme Court in *Registrar of Trade Marks v. Ashok Chandra Rakhit Ltd*<sup>10</sup> as well as the judgments of the Division Bench of this Court in *Vardhman Buildtech v. Vardhman Properties Ltd*<sup>11</sup>, the judgment of this Bench in *Zydus Wellness Products Ltd. v. Cipla Health Ltd*<sup>12</sup> and the judgment of the High Court of Bombay in *Pizza Hut International LLC v. Pizza Hut India P. Ltd*<sup>13</sup>.

**36.** *Ashok Chandra Rakhit*<sup>10</sup> was rendered in the context of the

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<sup>10</sup> AIR 1959 Supreme Court 558

<sup>11</sup> (2016) 233 DLT 25 (DB)

<sup>12</sup> 2023 SSC OnLine Del 3785

<sup>13</sup> 2022 SCC OnLine BOM 688



erstwhile Trade Marks Act, 1940 (“the 1940 Act”). Mr Lall points out, correctly, that Section 13 of the 1940 Act incorporated the elements of Section 17<sup>14</sup> of the Trade Marks Act, 1999, as well as the concept of a disclaimer, thus:

“13. **Registration subject to disclaimer.** – If a trade mark contains –

- (a) any part not separately registered as a trade mark in the name of the proprietor, or for the separate registration of which no application has been made, or
- (b) any matter common to the trade, or otherwise of a non-distinctive character.

the tribunal, in deciding whether the trade mark shall be entered or shall remain on the register, may require, as a condition of its being on the register, that the proprietor shall either disclaim any right to the exclusive use of such part or of all or any portion of such matter, as the case may be, to the exclusive use of which the tribunal holds him not to be entitled, or make such other disclaimer as the tribunal may consider necessary for the purpose of defining the rights of the proprietor under the registration:

Provided that no disclaimer shall affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made.”

On the effect of a disclaimer, para 9 of the report went on to observe and hold:

“9. The last feature of the section is its proviso. That proviso preserves intact any right which the proprietor may otherwise under any other law have in relation to the mark or any part thereof. The disclaimer is only for the purposes of the Act. It does not affect the rights of the proprietor except such as arise out of registration. That is to say, the special advantages which the Act

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<sup>14</sup> **Effect of registration of parts of a mark.**—(1) When a trade mark consists of several matters, its registration shall confer on the proprietor exclusive right to the use of the trade mark taken as a whole.

(2) Notwithstanding anything contained in sub-section (1), when a trade mark—

- (a) contains any part—
  - (i) which is not the subject of a separate application by the proprietor for registration as a trade mark; or
  - (ii) which is not separately registered by the proprietor as a trade mark; or
- (b) contains any matter which is common to the trade or is otherwise of a non-distinctive Character the registration thereof shall not confer any exclusive right in the matter forming only a part of the whole of the trade mark so registered.



gives to the proprietor by reason of the registration of his trade mark do not extend to the parts or matters which he disclaims. In short, the disclaimed parts or matters are not within the protection of the statute. That circumstance, however, does not mean that the proprietor's rights, if any, with respect to those parts or matters would not be protected otherwise than under the Act. If the proprietor has acquired any right by long user of those parts or matters in connection with goods manufactured or sold by him or otherwise in relation to his trade, he may, on proof of the necessary facts, prevent an infringement of his rights by a passing off action or a prosecution under the Indian Penal Code. Disclaimer does not affect those rights in any way.”

**37.** *Vardhman Buildtech*<sup>11</sup>, in para 10, observed that, though neither “VARDHMAN” nor “PLAZAS” was individually distinctive, “the two words taken together – “VARDHMAN PLAZAS” – is a distinctive element of the label/mark” and that “thus, if the appellants were to use words “VARDHMAN” and “PLAZAS” in conjunction, then the respondent may have had a right to restrain them from using the same”.

**38.** The principle enunciated in these decisions also enforce my *prima facie* view that the mere insertion of disclaimers with respect to the words “CHINA” and “BISTRO” in the registrations granted to the plaintiff for the composite marks CHINA BISTRO would not disentitle the plaintiff from claiming exclusivity for the composite mark.

**39.** I may note, here, that in support of his submissions predicated on the aspect of disclaimer, Mr. Sengupta cited the judgment of the Supreme Court in *Parakh Vanijya Private Ltd v. Baroma Agro*



*Product*<sup>15</sup> and the judgment of a learned Single Judge of the High Court of Bombay in *International Foodstuffs Co. LLC. V. Parle Products Pvt. Ltd.*<sup>16</sup> .

40. Mr. Sengupta further sought to contend that, as the words “CHINA” and “BISTRO” are individually bereft of any distinctive character, the former being the name of a geographical area and the latter being an often used expression for restaurants, cafes and the like, it would be for the plaintiff to show that the mark CHINA BISTRO is distinctive.

41. I am unable to agree with the said submission. Even if individual parts of a composite mark are by themselves not distinctive, the composite mark, which combines the individual non-distinctive parts together, may partake of distinctiveness.

42. Where a mark is registered, at a *prima facie* stage, the plaintiff is entitled to the benefit of Section 31(1)<sup>17</sup> of the Trade Marks Act. The court would, therefore, presume, unless it is demonstrated to the contrary by the defendant, that the mark is valid. Of course, it would always be open to the defendant to show that the mark is lacking in validity, but the onus in that regard, would be on defendant, in view of Section 31(1) of the Trade Marks Act. In other words, in the facts of the present case, it would be for the defendant to establish that the mark CHINA BISTRO is lacking in distinctiveness, so as to disentitle

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<sup>15</sup> (2018) 16 SCC 632

<sup>16</sup> MANU/MH/0508/2016

<sup>17</sup> 31. Registration to be *prima facie* evidence of validity. –

(1) In all legal proceedings relating to a trade mark registered under this Act (including applications under Section 57), the original registration of the trade mark and of all subsequent assignments and transmissions of the trade mark shall be *prima facie* evidence of the validity



the plaintiff to claim exclusivity over the said combined/composite mark.

**43.** No material to that effect has been placed on record and no submission to that effect has been advanced by Mr. Sengupta. Even otherwise, plainly seen, I am unable to convince myself that the mark CHINA BISTRO is lacking in distinctiveness. It cannot be said that the mark CHINA BISTRO is an ordinary combination of two words, completely wanting in any element of inventiveness or ingenuity. Even if “BISTRO” is treated as a synonym for cafeteria or café, it is not an expression which is normally used. It may have been quite different if, for instance, the defendant’s mark was CHINESE CAFÉ. The mark would then be plainly descriptive, and lacking in any element of distinctiveness which would distinguish it from any other Chinese eating house. The composite mark CHINA BISTRO, however, in my view, cannot be said to be lacking in distinctiveness, when seen as a whole, in the absence of any evidence or material to that effect led by the defendant.

**44.** For the same reason, the reliance, by Mr. Sengupta, on the fact that, while obtaining registration for the mark CHINA BISTRO, the plaintiff had disclaimed exclusivity for both “CHINA” and “BISTRO” individually, cannot result *ipso facto* in a disclaimer of exclusivity over the composite mark CHINA BISTRO.

**45.** This is, of course, *de hors* what I have already noted, hereinabove, that the disclaimer attaches only to the Registrations No.



1470912 for  and No. 22647846 for  and does not attach to the remaining marks including the word mark CHINA BISTRO.

46. Ultimately, in view of Section 17 of Trade Marks Act, it is not permissible for the court to dissect the individual rival marks while examining the infringement. It is a well-settled principle that the court has to compare the marks as wholes. When compared as wholes, the court is *prima facie* convinced that the individual marks



and



are deceptively similar, as the textual components of the two marks, which constitute their essential and distinctive features, are deceptively similar to each other. In fact, they are identical, the only difference between the two marks being that, in the defendant's mark there is an added prefix "WOW!".

47. Insofar *Parakh Vanijya*<sup>15</sup>, on which Mr. Sengupta placed reliance is concerned, I do not see that the said decision rules any way contrary to the decisions cited by Mr. Lall. In that case, having disclaimed exclusivity over the word "MALABAR", the plaintiff was seeking to urge infringement solely on the basis of the common word "MALABAR" between the mark of the plaintiff and the mark of the defendant. Having disclaimed exclusivity for "MALABAR", it is obvious that the plaintiff could not have alleged infringement solely on the basis of the common word "MALABAR" in the two marks. That is quite different from the case at hand in which exclusivity has been disclaimed only over the individual parts of the composite mark



CHINA BISTRO and not over the composite mark itself.

48. In view of the aforesaid, the grounds on which Mr. Sengupta has sought to contend that the plaintiff was disentitled from claiming exclusivity over the mark CHINA BISTRO fail, *prima facie*, to convince.

49. Where a *prima facie* case of infringement is found to exist, an injunction *must* follow, as held by the Supreme Court in *Midas Hygiene Industries (P) Ltd v. Sudhir Bhatia*<sup>18</sup>.

50. Accordingly, the defendant, as well as all others acting on its behalf, shall stand enjoined from using the mark/name  or WOW CHINA BISTRO as a trademark, label, device, trading style, trade name, logo, keyword, meta tag, domain name, or in any other manner, identical or deceptively similar to the Plaintiff's mark CHINA BISTRO till further orders to be passed in the suit. It is clarified, however, that the defendant would be entitled to use WOW!

 CHINA or , and that there is no interdiction in that regard.

51. IA 20611/2022 stands allowed accordingly.

**CS(COMM) 848/2022 & I.A. 14194/2023 (under Order XI Rule 1(5) of CPC)**

<sup>18</sup> (2004) 3 SCC 90



**52.** List before the learned Joint Registrar (Judicial) for completion of pleadings and marking of exhibits on 6 September 2023, whereafter the matter would be placed before the Court for case management hearing and further proceedings.

**C. HARI SHANKAR, J.**

**AUGUST 3, 2023**

*dsn*