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

Reserved on: 03.06.2021

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Pronounced on: 04.10.2021

+ CS(COMM) 385/2020

AVTAR SINGH & ORS.

..... Plaintiffs

Through Mr.C.M. Lall, Sr.Adv. with  
Ms.Nancy Roy, Ms.Jyotideep Kaur  
and Mr.Abhishek Kotnala, Advs.

Versus

SAKSHI SRIVASTAVA & ANR.

..... Defendants

Through Mr.J.Sai Deepak, Ms.Meenakshi Ogra  
and Ms.Suvangana Agarwal,  
Advocates.

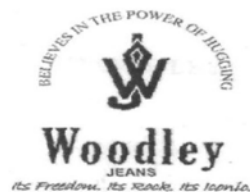
**CORAM:**

**HON'BLE MR. JUSTICE JAYANT NATH**

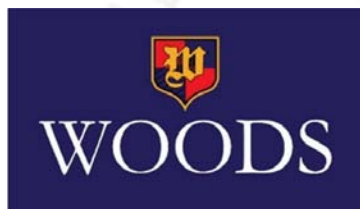
**JAYANT NATH, J.**

**IA Nos.8293/2020 & 9158/2020**

1. IA 8293/2020 is filed by the plaintiffs seeking an injunction to restrain the defendants, their agents etc. from manufacturing or authorizing the manufacture, selling, offering for sale, marketing, retailing, supplying distributing, exhibiting, advertising, promoting, displaying etc. the impugned products and operating the impugned retail stores or any other product and retail store bearing the impugned marks WOODLEY



and NUWOODLEY as a trademark or as a trade name or part of the store name or retail or any other mark which is deceptively similar to the plaintiff's trade name/mark WOODS, WOODS (stylised), WOODS



WOODS  
L O N D O N

WOODLAND

and

WOODLAND

(stylised)/



2. I may point out that when the matter came up for hearing on 18.09.2020, this court in IA No. 8293/2020 noting the averments in the plaint and the documents, concluded that the plaintiffs have made out a prima facie case and that the balance convenience lies in favour of the plaintiffs. An ex parte ad-interim injunction was passed in favour of the plaintiffs in terms of prayer A (i) and (ii) of the said application.

3. IA 9158/2020 is now filed by the defendants under Order 39 Rule 4 CPC for varying/*setting aside* the ad-interim ex parte injunction order dated 18.09.2020 passed by this court.

4. The present suit is filed seeking a decree of permanent injunction against the defendants, their partners, officers, importers, exporters, advertisers, manufacturing, selling, offering for sale, marketing, retailing, supplying, distributing, etc. the aforementioned impugned trademarks or any other mark which is identical or deceptively and confusingly similar to the plaintiff's trademark. Other connected reliefs are also sought.

5. The Plaintiffs Mr.Avtar Singh, Mr.Harkirat Singh, Aero Traders Private Ltd. and Aero Associates Pvt. Ltd. are said to be partners of M/s Aero Club. It is stated that the said concern M/s. Aero club is the lawful owner of the trademark WOODS in India. Details of the registration of the said trademarks are given in the plaint. The first trademark of WOODS was registered on 11.11.1994 claiming a user since October 1994 in class 25. Another registration was obtained in March 1996 also under class 25 and on 12.12.2017 in Class 3. In addition, the plaintiffs have also attained registration for trademarks WOODLAND, WOODLAND (Stylised) and other WOODLAND marks on different dates. It is claimed that by virtue of section 28 of the Trademarks Act, the plaintiffs and their licensees have exclusive right to use the said trademarks in respect of the goods for which the trademarks are registered. Additionally, under section 31 of the Act the original registrations are *prima facie* evidence of their validity.

6. It is further stated that the plaintiffs are the owner of applications for trademarks WOODS (word), WOODS (Stylised) in class 18 which are currently pending. The said applications are under opposition and the matter is being contested by the plaintiffs.

7. It is further stated that it was in 1992 that the plaintiff ventured into the Indian Market with a select specialised line of footwear and launched its

highly distinctive trademark WOODLAND. Since its inception the plaintiffs are said to have honestly conceived and adopted the trademark WOODLAND. In 1994 the plaintiff adopted another highly distinctive and arbitrary trademark WOODS.

8. The plaintiff thereafter made a strategic move to shift focus from footwear to apparel range under its brands WOODS and WOODLAND. The plaintiffs offer jackets, t-Shirts, sweatshirts and casual shirts. It is stated that over a period of 28 years since its inception the plaintiffs has grown steadily from just a single retail store in India to an internationally recognised brand with retail outlets in Hong Kong, China, UAE etc. Starting with two exclusive outlets in Delhi the plaintiffs has become an organisation with its presence in various countries with a sales revenue of more than INR 1300 crores where the plaintiff's brand WOODS contribute alone 25% of the total sales revenue. For the year 2018-19 it is stated that the plaintiff had a revenue turnover of Rs.1020.56 crores. It is also stated that the plaintiff has spent enormous amount of money in promoting its product bearing the said trademarks. Its advertisements regularly appear in all newspapers, magazines, published across India and a large amount is spent on sales promotion. In 2018-19 a sum of Rs.18.11 crores was spent on sales, promotion expenses. It is stated that the plaintiff has been recognised for its success in marketing and strategy, operating under its brands WOODS and WOODLAND. It has registered a growth of 10 to 15 % every year and making inroads into tier-II and tier-III cities. It is stated that the plaintiff enjoys strong common law rights and statutory rights in the trademarks in question.

9. It is stated that as per findings and knowledge of the plaintiff based on

the online records of the trademark registry and the defendant's website, defendants No.1 and 2 are founder/co-owners of the trading concern M/s. Siddhi Vinayak Clothes & Concepts. Defendant No.1 has filed applications

for registration of the impugned marks and NUWOODLEY. Defendants are said to be also engaged in manufacturing, marketing and sale of the impugned products being apparel bearing the

impugned marks WOODLEY,



and



**Woodley**  
JEANS

*its Freedom. its Rock. its Iconic.*

**Woodley**  
LONDON

10. It is further stated that it was around September 2017 that the plaintiffs were shocked when they came across applications for the impugned mark WOODLEY (label) in the name of defendant No.1 when the same was published in the Trademark Journal on 15.5.2017. A perusal of the trademark application showed that the defendant's applications were filed with a user claim dated 1.4.2014. The defendants had filed applications for the impugned mark WOODLEY (label) in classes 18 and 35. Being concerned with the alleged dishonest adoption of the impugned mark



**Woodley**  
JEANS

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WOODLEY, the plaintiff duly opposed the aforesaid trademark application in classes 18, 25 and 35 by filing notices of



opposition.

11. It is stated that in July 2020 the plaintiffs were shocked when its representatives came across a new apparel store under the name “WOODLEY” being constructed in the area of Sarojini Nagar Market in Delhi.

12. It is the case of the plaintiff that a visual comparison of the two trademarks of the plaintiffs and that of the defendants show that the impugned mark WOODLEY is deceptively and confusingly similar to the plaintiff’s earlier trademark WOODS and WOODLAND. The first syllable of the defendant’s impugned mark WOODLEY is virtually identical to the plaintiff’s trademark WOODS. Further, the defendant’s impugned mark WOODLEY is not only visually but also phonetically similar to the plaintiff’s registered trademark WOODLAND and WOODS. It is stated that the trademark WOODLEY is stylised in a font which is extremely similar to the stylisation and font of the plaintiff’s trademark WOODS. Further, it is stated that the defendants have blatantly copied the device of the letter ‘W’. The placement and stylisation of letter WOODLEY and identical colour combination and scheme of a blue background with a white lettering for the impugned mark WOODLEY shows the malafide intent of the defendants. Further, it is stated that the inclusion of “Carnaby St.London” under the impugned name WOODLEY gives a false impression to the consumers and trading public that the defendant’s impugned products and retail stores under the impugned mark are affiliated to the plaintiff’s brand WOODS. Hence, the present suit.

13. The defendants have filed their written statement. They have pleaded that admittedly the plaintiffs were aware of the marks and logos of the

defendants in September, 2017. From September 2017 to 2020, the defendants' have opened 22 stores. The plaintiffs have now belatedly chosen to file the present injunction application. It is further stated that the plaintiffs are estopped from filing the present suit due to unexplained delay and acquiescence on their part. There is a deliberate delay of more than three years in filing the present infringement suit even after knowing that the defendants are investing huge money in their retail ventures.

14. It is further stated that the marks in question 'WOODLAND' and 'WOODS' of the plaintiffs and "Woodley" of the defendants are not deceptively or confusingly similar. It is pleaded that there can be no exclusivity on the mark "wood". Even phonetically answering defendants' mark is pronounced "wud-lee" which is very different. It is urged that considering the device, logo or mark in totality and the differences of the colour scheme, styling, logo, spelling, font size etc. makes the differences all the more stark. Further, it is stated that the target consumer of two entities are vastly different as the plaintiffs' brand caters to rich and upper middle class consumers while the defendants' brand caters to much lower middle class thereby eliminating any chances of confusion whatsoever.

15. It is further stated that the parties are already contesting the issue of 'similarity between the marks' before the specialized authority i.e. the Trademark Registry for the last 3 years. Hence, it is stated that the present suit is only a *malafide* attempt to scuttle the said proceedings.

16. It is further stated that defendant No.2 has a long experience in working for various companies in garment industry. While establishing his own brand, he was inspired to keep the name "Woodley" from an actress Ms.Shailene Woodley who was very active for environmental causes in

2014 especially for her 'tree hugging' initiative.

17. It is further stated that not only the defendants but more than 100 families who work in the 22 retail stores/showrooms are facing grave undue hardship due to the filing of this instant suit along with interim injunction order against the defendants. It is stated that the defendants have *bonafide* adopted their mark and are using it unimpeded since 2014. There is no dishonest adoption by the answering defendants as the marks have been inspired by the name of American actress Ms.Shailene Woodley.

18. It is also pointed out that defendant No.1 has filed applications before the Trademark Registry for registering various devices mark including "Woodley" under classes 25, 35 and 18 in 2014.

19. The defendants have also made the following submissions:-

(i) It is stated that the plaintiffs' cannot claim exclusive propriety over the word 'Wood' by dissecting 's' from Woods and 'land' from Woodland. Further, it is reiterated that visual appearance of the defendants' marks and the plaintiffs' marks are completely different.

(ii) It is further stated that the target consumers of the defendants are middle class/lower middle class strata of the society especially Tier-II and Tier-III cities. The products of the defendants are cheaper than the products of the plaintiffs. The consumers of the plaintiffs belong to high society, elite class having good fashion sense, knowledgeable enough to know the difference between the products of the defendants and the plaintiffs. There cannot be any confusion in the minds of the public.

(iii) It is further stated that on searching of various trademarks that start with the terms 'WOOD', the answering defendants got to know that marks like 'Woods & Woods', 'Woodside', 'Woodscuffer', 'Woodstock',



‘Woodspun’, ‘Woods & Gray’ etc. are all registered in class 25. It is stated that the mark ‘Woods’ has also been registered in the name of a third party Ashutosh Garments Pvt. Ltd. under clause 25 since 1998.

20. It is stressed that the word ‘Wood’ is non-distinctive and generic in nature and accordingly exclusive propriety cannot be claimed on the same by the plaintiffs. It is further stressed that the target customers of the defendants recognize the brand name WOODLEY/WOODLEY LONDON exclusively with the defendants and no one else.

Hence, it is prayed that the interim orders passed by this court be vacated and the injunction application of the plaintiffs be dismissed.

21. I have heard learned senior counsel for the plaintiffs and learned counsel for the defendants. I have also perused the written submissions. Learned senior counsel for the plaintiffs has stressed that the mark WOODS was registered in 1994 although the user is since 1992. The defendants have mischievously sought to use the trade mark WOODLEY allegedly since 2014 though an application for registration of the said mark was filed in 2017. It is stressed that the adoption of the mark WOODLEY by the defendants is dishonest and hence, this court should confirm the interim injunction passed on 18.09.2020.

22. Learned counsel for the defendants has made the following submissions:

(i) It has been strongly urged that the trademark of the defendants WOODLEY is not similar to the trademark of the plaintiffs WOODS or WOODLAND. On a holistic comparison, it cannot be said that the impugned trademark of the defendants is deceptively similar or even in any manner identical to the marks of the plaintiffs.

(ii) It is further pleaded that the defendants are in the area of men's formal wear. On the other hand the plaintiffs do not deal with men's formal wear but deals with footwear and rugged clothes. Category of customers using the products of the defendants is completely different than the category of customers using the product of the plaintiffs. It is pleaded that the class of goods and the class of customers have to be taken into account by this court inasmuch as there is no possibility of any confusion to the customers in question.

(iii) It is further pleaded that section 29(4) of the Trademarks Act does not apply to the facts of this case. The goods of the parties are similar but not identical. At best section 29(2)(b) of the Trademarks Act may apply.

(iv) It is further pleaded that the plaintiffs have no registration over the mark WOOD. In view of section 17(2)(b) of the Trademarks Act, the plaintiffs cannot register the mark WOOD. The plaintiffs are merely trying to rely upon a part of the registered trademark WOODS to try and claim that the impugned mark of the defendants WOODLEY is similar or deceptively similar to the trademark of the plaintiffs, namely, WOODS or WOODLAND. This plea is completely misconceived and misplaced as under section 17 of the Trademarks Act, it is clear that where the trademark consists of several matters its registration will confer on the proprietor's exclusive right to use the trademark taken as a whole. Further the word WOOD is a non distinctive character and cannot be registered as a trademark by the plaintiffs.

(v) It is stressed that the defendants have adopted the mark WOODLEY on 01.04.2014 for men's formal clothing. The defendants have 22 franchisee stores. The defendants sell their products through these 22 stores. The

plaintiffs up to 2019 were not in the businesses of men's formal wear. Their mark is WOODLAND and it relates to mountain wear and rugged stuff. It is further stressed that the defendant is a prior user of the trademark in the men's formal wear section. By the time the plaintiffs entered into men's formal wear, the defendants were already there. Reliance is placed on section 34 of the Trademarks Act to plead that the rights of the defendants are protected. Reliance is placed on the judgment of the Supreme Court in *Nandini Deluxe vs. Karnataka Co-operative Milk Producers Federation Ltd.*, AIR 2018 SC 3516 and on the judgment of this court in *Mittal Electronics vs Sujata Home Appliances (P) Ltd. & Ors.*, MANU/DE/1695/2020 to support the above plea.

23. Learned senior counsel for the plaintiffs in rejoinder reiterates that the target area of the plaintiffs is also the middle class and lower middle class. It is stated that the plaintiffs are also into formal wear and the target cities are the same namely Tier- I, Tier-II and Tier-III cities. It is stressed that WOODS is a formal wear. It is denied that the plaintiffs are into mountain gear. It is further stated that no sale figures have been provided by the defendants to claim user since 2014 in the formal men's wear. Reliance is also placed on documents placed on record to claim that it was in 2013 that the plaintiffs launched men's formal wear. Hence, it is pleaded that the defendants cannot claim to be a concurrent user of men's formal wear. Further, it is pleaded that the defendants are more into informal wear including jeans, T-shirt and casual jackets etc.

24. I may first see as to whether the impugned marks of the defendants can be said to be deceptively similar to the marks of the plaintiffs. This court has to see as to whether the similarity between the plaintiffs' and the

defendants' marks is so close either visually, phonetically or otherwise. In this context reference may be had to the judgment of the Supreme Court in the case of ***Kaviraj Pandit Durga Dutt Sharma vs. Navaratna Pharmaceutical Laboratories, AIR 1965 SC 980*** where the Court held as follows:-

“28. ....In an action for infringement, the plaintiff must, no doubt, make out that 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.”

25. Reference may also be had to the judgment of the Division Bench of this court in the case of ***M/S. South India Beverages Pvt. Ltd. vs. General Mills Marketing INC., (2015) 61 PTC 231*** where the Division Bench held as follows:-

“34. A Division Bench of this Court in the decision reported as (40) PTC 417 (Del.) (DB) Amar Singh Chawal Wala v. Shree Vardhman Rice & Genl. Mills recognised the relevance of phonetic similarity between the constituent elements comprised in the competing marks. The plaintiff was engaged in selling rice under the registered trademarks 'Golden Qilla' and 'Lal Qilla'. The defendant, who was also selling the same product, was operating under the trademark 'Hara Qilla', against which the plaintiff sought injunction. The Court held that the essential


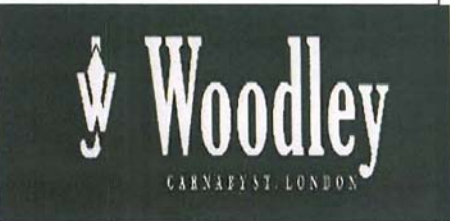
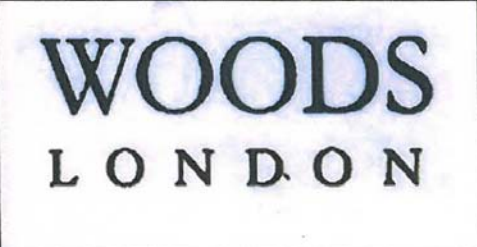
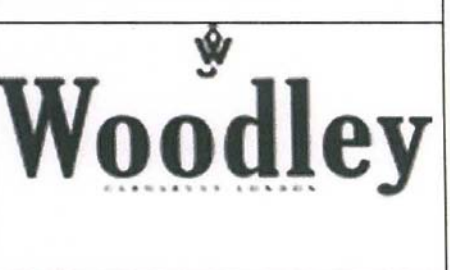
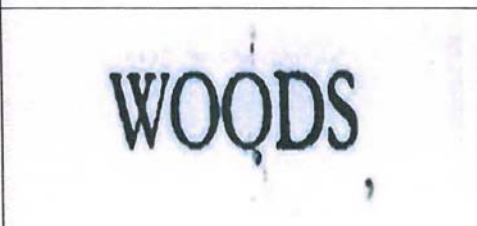
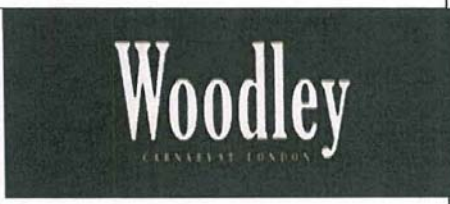

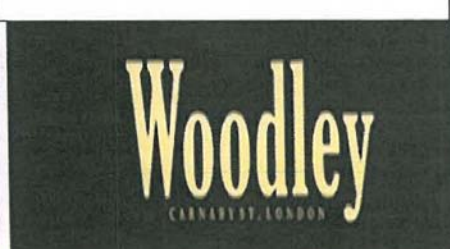

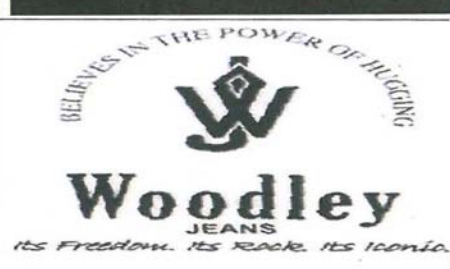
feature of the mark is the word 'QILLA', whether it is spelt as QILLA or KILLA, or even written in a different style or colour combination. It was further observed that for a customer who would seek to purchase the QILLA brand rice, both the names would sound phonetically similar. The Court held that since the trademark QILLA was being utilised for the same commodity i.e. rice, there existed every possibility of there being confusion created in the mind of the purchaser of rice that the product being sold by the defendant was in fact a product that had emanated from or had been manufactured by the plaintiff.

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39. It is also a settled proposition of law that where products are virtually identical, as they are in the present case, 'the degree of similarity in the marks necessary to support a finding of infringement is less than in the case of dissimilar, non-competing products.'

26. Keeping in view the above test, I may now compare the two trademarks in question. The defendants in the written statement have spelt out a pictorial chart depicting the alleged differences between the plaintiffs' and the defendants' marks as follows:



S.No	PLAINTIFFS' MARKS	DEFENDANTS' MARKS
1.		
2.		
3.		
4.		
5.		

27. On a visual inspection of the trademarks of the plaintiffs and the impugned marks of the defendants, prima facie it appears that the defendants' marks are deceptively similar to the registered trademarks of the plaintiffs. The essential features of the trademarks of the plaintiffs have

prima facie been copied by the defendants. The dominant element of the plaintiffs' mark WOOD has been copied by the defendants. The mark of the defendants WOODLEY is likely to cause confusion or a mistake to any person possessed of average memory.

28. I may now deal with some of the submissions made by the learned counsel for the defendants to plead that no relief can be granted to the plaintiffs. It was firstly very strenuously and strongly urged that the plaintiffs do not have a registration over the mark 'WOOD'. In any case, in view of Section 17(2) (b) of the Trademarks Act, the plaintiffs cannot register the mark WOOD. It was stressed that under Section 17, where a trade mark consists of several matters, the registration confers on the proprietor exclusive right to use the trade mark as a whole. The word 'WOOD' is a non-distinctive character and cannot be registered as a trade mark by the plaintiffs. Hence, the plaintiffs cannot say or contend that the impugned mark WOODLEY, merely because it uses the mark WOOD, infringes the trade mark of the plaintiffs.

29. In my opinion, the above plea of the defendants is misconceived. In this context a complete answer to negate the submission of the learned counsel for the defendants is found in the judgment of the Division Bench of this court in the case of *M/S. South India Beverages Pvt. Ltd. vs. General Mills Marketing INC.(supra)*, where the Division Bench held as follows:-

“5. It is the case of the appellant - defendant that the respondent -plaintiff enjoys protection for its mark 'HAAGEN DAZS' as an indivisible whole and not for the individual elements constituting the same. Reliance has been placed on the principle of 'anti-dissection' consistently applied by the Courts since time immemorial while dealing with cases of trademark infringement. It has been further submitted that even if the constituting elements of the mark are considered, 'HAAGEN'

forms the dominant part of the respondent-plaintiff's trademark and any potential similarity with the non-dominant element 'DAZS' in a trademark would not amount to infringement.

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

22. We may refer to the decision of the United States Court of Appeals for the Federal Circuit reported as 380 F.3d 1340 Re Chatam Int'l, Inc, wherein the Court enunciated the interplay between the principle of 'anti dissection' and identification of 'dominant mark'. The Court, while ascertaining whether the mark 'JOSE GASPAR GOLD' was similar to the registered mark 'GASPAR'S ALE', held that 'GASPAR' was clearly the dominant element in the two marks and resembled the relevant mark enough to cause a likelihood of confusion, to cause a mistake or to deceive. Relevant would it be to note that the defendant in the said case urged that the approach of splitting of the marks was in violation of the anti-dissection rule. The said contention was repelled by the Court and it was pertinently observed that there was no violation of anti-dissection rule because the marks were any way examined in entirety, and each individual term in the marks were given more or less weightage depending on the overall impression it appeared to create. The Court was of the view that both marks convey the commercial impression that a name, GASPAR, is the source of related alcoholic beverages, tequila or ale. In other words, the commercial significance of ALE in the registered mark 'GASPAR'S ALE' and JOSE and GOLD in appellant's mark

‘JOSE’S GASPAR GOLD’ assumed less significance in the opinion of the Court.

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

24. In this regard we may fortify our conclusion by take note of the decision reported as 405 F.Supp. 530 (1975) Eaton Allen Corp. v. Paco Impressions Corp. The facts of the said case reveal that the plaintiff manufactured coated paper under the registered trademark ‘Super-KoRec-Type’. The defendant manufactured and advertised a similar product under the mark ‘Super Type’ and ‘Super Type-7’. The defendant contended that the only similarity between the said marks was use of the words ‘Super’ and ‘Type’, terms which were neither significant parts of the plaintiff’s registered trademark nor protectable as a matter of law. The court held that the consideration of a trademark as a whole does not preclude infringement where less than the entire trademark is appropriated.

25. Therefore, the submission of the appellant-defendant predicated upon the principle of ‘anti-dissection’ that action for infringement would not lie since use of the word ‘D’DAAZS’ does not result in complete appropriation of the respondent-plaintiff’s mark ‘HAAGEN DAZS’, which is to be viewed as an indivisible whole, is liable to be rejected.

26. Dominant features are significant because they attract attention and consumers are more likely to remember and rely on them for purposes of identification of the product. Usually, the dominant portion of a mark is that which has the greater strength or carries more weight. Descriptive or generic components, having little or no source identifying significance, are generally less significant in the analysis. However, words that are arbitrary and distinct possess greater strength and are



thus accorded greater protection.[174 F. Supp. 2d 718, 725 (M.D. Tenn. 2001) Autozone, Inc. v. Tandy Corporation]”

30. Reference may also be had to the judgment of this court in the case of ***Jagan Nath Prem Nath vs. Bhartiya Dhoop Karyalaya, AIR 1975 Del 149*** where the court held as follows:-

“6. In *James Chadwick & Bros. Ltd. v. The National Sewing Thread Co. Ltd.*, A.I.R. 1951 Bombay 147 (3) the Court ruled that in an action for infringement what is important is to find out what was the distinguishing or essential feature of the trade mark already registered and what is the main feature or the main idea underlying the trade mark. In *Parle Products (P) Ltd. v. J.P. & Co. Mysore* : (1972) 1 SCC 618 : A.I.R. 1972 Supreme Court 1359 (4) the Supreme Court took the same view.

7. This being the law, it cannot be disputed that in an action for infringement the plaintiff can succeed not only when he proves that the whole of his registered trade mark has been copied but can also succeed if he shows that the defendant's mark is similar to the plaintiff's mark as it would be remembered by persons possessed of an average memory with its usual imperfections of that its essential particular or the distinguishing or essential feature has been copied.”

31. Reference may also be had to the judgment of this court in the case of ***IREO Private Ltd. vs. Genesis Infratech Private Ltd., 2014 SCC OnLine Del. 1162*** where this court has held as follows:-

“26. The second submission of the learned Senior Counsel for the defendant relates to Section 17 of the Trade Marks Act. It is urged that under Section 17 where a Trade Mark consists of several matters, its registration confers exclusive right to use the mark as a whole and the registration does not confer a right on the matter being a part of the trade mark.

27. On the basis of the same it is urged that the registered trade



mark of the plaintiff is “IREO SKYON Space Age Living”. It is urged that what the plaintiff is complaining of is that the defendant has, as part of its mark, copied the word “SKYON.” Hence the present suit has been filed. It is urged that SKYON being only part of the full registered trade mark of the plaintiff, the plaintiff is entitled to no protection for a part of the trade mark, namely, SKYON.

28. Section 17 reads as follows:

“Section 17 — 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.

29. In my view the judgment of this High Court in Jagan Nath Prem Nath v. Bhartiya Dhoop Karyalaya would be a complete answer to the above submissions of the learned senior counsel for the defendant. The court held as follows :

“7. This being the law, it cannot be disputed that in an

action for infringement the plaintiff can succeed not only when he proves that the whole of his registered trade mark has been copied but can also succeed if he shows that the defendant's mark is similar to the plaintiff's mark as it would be remembered by persons possessed of an average memory with its usual imperfections or that its essential particular or the distinguishing or essential feature has been copied.

...

15. Shri P.C. Khanna, learned counsel for the respondent, argued that where a distinct label is registered as a whole such a registration does not confer any exclusive statutory right on the proprietor to use any particular word or name contained therein, apart from the mark as a whole. Reliance in support of this proposition was placed on the observations in Registrar of Trade Marks v. Ashok Chandra Rakhit Ltd. These observations in the cited case were made in the context of exercise of powers conferred on the Registrar by Section 13 of the Trade Marks Act, 1940. This aspect is not at all relevant for the present controversy because the plaintiff can succeed in an action for 'infringement' if he proves that an essential particular of his trade mark has been copied : See Taw Manufacturer Coy. Ltd. v. Notek Engg. Co. Ltd."

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33. I have already held above that the mark which is being used by the defendant is deceptively similar to the mark of the plaintiff. The essential features have been copied. Merely because the word SKYON is the only word copied by the defendant, does not change the legal position. The contention of the defendant in this regard has no merits."

32. Reference may also be had to the judgment of the Division Bench of this court in the case of *United Biotech Pvt. Ltd. vs. Orchid Chemicals &*

*Pharmaceuticals Ltd. & Ors., ILR (2012) 5 Del 325* where the court held as follows:-

“25. The entire arguments are on the wrong premise and it proceeds on the basis of common feature of the two marks suffix “ZID” and since the respondent has registration and trade mark “ORZID”, it cannot bare a part of it, i.e., “ZID”. What has been seen in a case like this is as to whether the mark “FORZID” is deceptively similar to “ORZID”. That is the test which is to be applied and in a process, it is to be seen as to whether the two marks are structurally and phonetically similar and would cause deception in the minds of consumers. When we judge the matter from this angle, we find ourselves in agreement with the view taken by IPAB as well as the learned Single Judge. Although the mark “ORZID” is a label mark, the word mark “ORZID” is an essential feature which has been covered by the registration. Therefore, the learned counsel for the respondent appears to be right in his submission on this aspect, which is predicated on the Supreme Court decision in Ramdev Food Products Ltd. (supra). Following dicta on the said decision is pertinent:”

33. The rule of ‘anti dissection’ does not impose a complete embargo upon consideration of the constituent elements of a composite mark. It is clear that what has to be seen in this case is as to whether the impugned trade mark WOODLEY is deceptively similar to the trademarks of the plaintiffs WOODLAND or WOODS. What has to be seen is whether the two marks are structurally and phonetically similar and cause deception in the mind of consumers. It is clear from a comparison of the two marks that the impugned trade mark of the defendants WOODLEY is structurally and phonetically similar to that of the plaintiffs and is likely to cause confusion in the minds of consumers. ‘WOOD’ is a dominant feature of the mark of the plaintiffs, though it is not the registered trade mark. Hence, there is no merit in the plea of the defendants.

34. The next plea that was strongly urged by the learned counsel for the defendants was that the nature of customers using the products of the defendants is entirely different. It was stressed that the defendants are only into men's formal wear and target a different segment of customers who are mostly in Tier-II and Tier-III cities. On the other hand the products of the plaintiffs are high-end products which target Tier-I cities and there can be no confusion in the minds of the customers of the plaintiffs and they are unlikely to be deceived by the impugned trademarks of the defendants.

35. Learned counsel for the defendants has relied upon the judgment of the Supreme Court in the case of *Khoday Distilleries Ltd. Vs. The Scotch Whisky Association & Ors.*, (2008) 10 SCC 723.

36. I may first look at the said judgment of the Supreme Court in the case of *Khoday Distilleries Ltd. Vs. The Scotch Whisky Association & Ors.*(supra) where the Supreme Court held as follows:-

“74. This Court in *Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd.* (2001) 5 SCC 73 inter alia laid down the law in the following terms:

“35. Broadly stated, in an action for passing-off on the basis of unregistered trade mark generally for deciding the question of deceptive similarity the following factors are to be considered:

xxx

(e) The class of purchasers who are likely to buy the goods bearing the marks they require, on their education and intelligence and a degree of care they are likely to exercise in purchasing and/or using the goods.”

75. The tests which are, therefore, required to be applied in each case would be different. Each word must be taken separately. They should be judged by their look and by their sound. Must

consider the goods to which they are to be applied. Nature and kind of customers who would likely to buy goods must also be considered. Surrounding circumstances play an important factor. What would likely to happen if each of those trade marks is used in a normal way as a trade mark of the goods of the respective owners of the marks would also be a relevant factor. [See Pianotist Co.' Application, Re, (1906) 23 RPC 774].

xxx

77. Where the class of buyers, as noticed hereinbefore, is quite educated and rich, the test to be applied is different from the one where the product would be purchased by the villagers, illiterate and poor. Ordinarily, again they, like tobacco, would purchase alcoholic beverages by their brand name. When, however, the product is to be purchased both by villagers and town people, the test of a prudent man would necessarily be applied. It may be true that the tests which are to be applied in a country like India may be different from the tests either in a country of England, United States of America or Australia.

78. We however, do not mean to suggest that in a case of this nature, the Heightened Scrutiny Test should be applied as urged on behalf of the appellant. *Bollinger, J. and Ors. v. Costa Brava Wine Coy., Ltd.* 1960 (1) RPC 16, whereupon Mr. Desai has strongly relied upon, makes such a distinction. *Bollinger, J.* (supra) was a case on demurrer. It was concerned with sale of Spanish Champagne. In that case, in paragraph 4 of the application, the applicant stated:

Then in Para 4 they deny that this name 'Spanish Champagne' is a false description, and they continue:

'The defendants deny that the said section imposes any statutory duty on the defendants or any statutory duty owed by the defendants to the plaintiffs. Alternatively, if the said section does impose any such statutory duty the same is not actionable at the suit of any of the plaintiffs or at all.'



37. Hence, as noted above, where the class of buyers is educated and rich, the test to be applied is different from the one where the product is to be purchased by others. The question is as to whether in the facts of this case, it can be said that the customers of the plaintiffs' product are rich and educated whereas the customers of the defendants' product are not. I think not. Both the parties claim to be into men's formal wear. The only issue is that the defendants claim that their target area is Tier-II and Tier-III cities and that the price of the products of the defendants is much lower. On the other hand, the product of the plaintiffs is a niche product bought by the affluent class.

38. Factually, both the parties are claiming to be in the field of men's readymade garments. The stated customers and buyers of the goods of the defendants cannot be said to be poor, such a class would normally not be buying readymade garments from the stores.

39. In this context reference may be had to the judgment of the Division Bench of this court in the case of *M/S. South India Beverages Pvt. Ltd. vs. General Mills Marketing INC. & Anr. (supra)* where a similar plea was rejected. The court held as follows:-

“40. Before drawing curtains, a word also needs to be spoken about the effect of the difference in price of the two products. The appellant - defendant has vehemently urged that its products are priced at a substantially lower amount than the product of the respondent - plaintiff. It has been submitted that though the products are similar i.e. frozen desserts, however they cater to entirely distinct class/strata of consumers. It is contended that the consumers of the product marketed by the respondent - plaintiff are sophisticated owing their capacity to afford such expensive ice-creams and this would obviate any likelihood of confusion with the appellant - defendant's mark.

41. We do not find merit in this submission. It would be pertinent to note that the product in question i.e. frozen desserts/ice-creams

is of such nature that it is consumed by people of all age group and strata, transcending all barriers. Experience suggests that ice-cream is cherished by people belonging to all age-group, especially children. As highlighted previously Justice Parker has regarded the 'nature and kind of customer who would be likely to buy the goods' as a relevant consideration in the celebrated 'Rules of Comparison' propounded by him. It cannot be realistically expected that children; who constitute a substantial chunk of consumers, would be in a position to distinguish between the two products by taking into account niceties such as price difference. Doubtless, in assessing cases of trademark infringement and ascertaining the likelihood of confusion, the effect of difference in price between the two products may perhaps be more profound where products such as- premium alcohol, luxury cars, exclusive perfumes etc. are involved since the prospective consumers in such cases are generally expected to be endowed with a greater sense of maturity and a keen eye against deception.

42. In the decision reported as 208 (2014) DLT 612 Ireo Pvt. Ltd. v. Genesis Infratech Pvt. Ltd. this Court repelled the defence of 'pricedifference' adduced by the defendant. The plaintiff was engaged in real estate business under the trademark 'IREO SKYON' whereas the defendant who was also dealing in the same line of business was operating under the trademark 'Genesis SKYON'. A suit was filed by the plaintiff against the defendant for infringement of trademark. It was contended on behalf of the defendant that the cost of the property being sold by the plaintiff is much higher than the cost of property being dealt by him and thus there exists no likelihood of confusion. The Court rejected the said contention and held that the defendant had slavishly copied the mark of the plaintiff and cannot be permitted to continue to use a deceptively similar trademark. In order to fortify its conclusion the Court cited with approval the decision reported as 2011 (45) PTC 329 (Del) Aman Resorts Limited v. Mr. Deepak Narula & Anr. In the said case the plaintiff was engaged in operating hotels, resorts and luxury villas under the trade name 'AMAN' and had brought a suit for permanent injunction restraining the defendant from using the mark

‘AMAN’ in respect of the services offered by him. The defendants argued that the goods and services provided by them were offered at significantly cheaper rates, so there would be no probability of deception of the public. The Court did not accept the said contention and significantly observed:-

“Where a rival or junior mark prices his goods or services at significantly cheaper rates than the plaintiff, there is likelihood of reputation loss. There is perhaps a ring of truth in the defendant's argument, when it says that its room rates are a fraction of what the plaintiff charges. Yet, the Court cannot be unmindful of the fact that in an Internet driven era, the consumer may be led to the defendant's site. There can be cases of confusion. While that may not happen, with some discerning customers, the possibility cannot be ruled out.”

43. Reliance may also be placed upon the decision of the Supreme Court reported as (1996) 5 SCC 714 N.R. Dongre & Ors v. Whirlpool Corporation & Anr. The plaintiff, who was the prior user of the mark ‘WHIRLPOOL’ which enjoyed a trans-border reputation, had instituted a suit for passing off action to restrain the defendant from manufacturing, selling, advertising or in any way using the trade mark 'WHIRLPOOL' or any other trade mark deceptively or confusingly similar to the trade mark of 'WHIRLPOOL' in respect of their goods. The defendants submitted that the washing machines produced by them costs less than 1/3rd the price of the washing machine marketed by the plaintiff; and the full description affixed on the washing machine leaves no room for any confusion in the mind of the buyer. It was held that where a rival, operating in the same trade name as the plaintiff's, prices his goods or services at significantly cheaper rates than the plaintiff, there is likelihood of irreparable injury to the plaintiffs' reputation and goodwill.

44. It may also be observed that even the ‘sophisticated consumers’ are not immune from confusion under all circumstances and the said fact would not lend a complete defence to infringement.”

40. Clearly, the plea of the defendants that the customers of the plaintiffs would not be confused in view of the fact that the products of the defendant deal with a different segment is misplaced and cannot be accepted as a defence to the stated infringement. There is no reason to believe that the customers of the plaintiffs will not get confused because of the price difference.

41. Reliance was also placed by the learned counsel for the defendants on the judgment of the Supreme Court in the case of *Nandhini Deluxe vs. Karnataka Co-Operative Milk Producers Federation Ltd.*, (*supra*) to contend that the class mentioned in the fourth schedule of the Trademarks Act may subsume a number of goods or articles which are separately identifiable and vendible and which are not goods of the same description as commonly understood in trade or in common parlance. The case of the defendants is that the defendants are in the area of men's formal wear and on the other hand, the plaintiffs, it is stated, do not deal with men's formal wear but deal with footwear and rugged clothes. Hence, it was pleaded that the registered mark of the plaintiffs does not prohibit the defendants to use the impugned mark for men's formal wear.

42. The plaintiffs have denied the above submission. It has been pleaded that the plaintiffs are also into men's formal wear. Reliance has been placed on a document dated 05.02.2013 filed by the plaintiffs to show that the plaintiffs launched men's formal wear in 2013 itself prior to that of the defendants. Hence, at this stage it is not possible to conclude that the plaintiffs are not into men's formal wear. Hence, clearly the reliance of the defendants on the aforementioned judgment is misplaced.

43. I may note that in the course of submissions, the learned counsel for

the defendants had made a submission that the defendants would limit themselves only to goods falling under class 25 and class 35. It was further urged that the defendants will not use the blue mark.

44. In view of the findings recorded above, in my opinion, the said submission of the learned counsel for the defendants would not warrant vacation of the interim order passed by this court.

45. Accordingly, the plaintiffs have made out a prima facie case. Balance of convenience is in favour of the plaintiffs and against the defendants. IA No. 8293/2020 is allowed and the interim order dated 18.09.2020 is confirmed. IA No. 9158/2020 is dismissed.

**JAYANT NATH, J.**

**OCTOBER 04, 2021/n/v/st/rb**



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