

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

***Reserved on: 28.02.2023***  
***Date of decision: 02.05.2023***

+ **CS(COMM) 509/2020**

PREETENDRA SINGH AULAKH ..... Plaintiff  
Through: Mr.Chander M. Lall, Sr. Adv.  
with Ms.Nancy Roy,  
Ms.Prakriti Varshney,  
Ms.Aastha Kakkar, Mr.Prashant  
& Ms.Ananya Chugh,  
Mr.Prashant, Ms.Nida  
Khananan, Advs.

versus

GREEN LIGHT FOODS PVT. LTD. .... Defendant  
Through: Mr.Jayant Mehta, Sr. Adv. with  
Mr.Sidhant Goel, Mr.Mohit  
Goel, Mr.Abhishek Kotnala,  
Mr.Karmanya Dev Sharma &  
Mr.P.D.V. Srikar, Advs.

**CORAM:**  
**HON'BLE MR. JUSTICE NAVIN CHAWLA**

**J U D G M E N T**

**I.A.10701/2020**

1. The present application has been filed by the plaintiff under Order XXXIX Rules 1 and 2 of the Code of Civil Procedure, 1908 (hereinafter referred to as the 'CPC') praying for an *ad-interim* order of injunction against the defendant restraining it from manufacturing, distributing, exporting, selling, offering for sale, advertising, promoting, displaying, and/or using, in any manner whatsoever the



impugned mark ‘**MONSOON HARVEST**’/ which the plaintiff alleges is similar to his trade mark ‘**MONSOON HARVEST**



**FARMS**/’either as a trade mark/trade or corporate name/domain name or in any manner whatsoever.

2. At the outset, it is to be noted that during the course of hearing of the application, the defendant stated that it has changed its mark and logo to as under:




### **FACTUAL BACKGROUND**

i) **Case of the plaintiff**



3. The plaintiff asserts that it is engaged in the business of agriculture and agricultural products through his family since the 1970s, with the plaintiff entering the business of organic farming in the year 2002.

4. It is the case of the plaintiff that the plaintiff adopted and started using the mark ‘**MONSOON HARVEST FARMS**’ and the device




mark ‘’, on 1.11.2006, for a wide range of agricultural products such as rice, fruits, jaggery, pulses, oils, spices, seeds, grains, pickles, flour and allied products. It is stated that the plaintiff’s products are high quality products and are certified as organic under the United States Department of Agriculture (in short, ‘USDA’) as well as under the National Programme for Organic Production (in short, ‘the NPOP’) standards. The plaintiff’s products are also certified by ‘SGS India Pvt. Ltd.’ and ‘Ecocert India Pvt. Ltd.’ for production of organic products. The plaintiff grows, harvests, and packages its products at its own farm in Punjab and distributes and markets its products across the country with major sales in Punjab and Delhi NCR.

5. The plaintiff has obtained the following registrations of its trade marks under the Trade Marks Act, 1999 (hereinafter referred to as ‘the Act’):-

Trade Mark	Cls.	Regn. No.	Date of Regn.	User date
MONSOON HARVEST FARMS	29	3688135	27/11/2017	01/11/2006
Goods: Edible Oil				
	29	3688134	27/11/2017	01/11/2006
Goods: Edible Oils				
	30	3688137	27/11/2017	01/11/2006

Goods:				
Raw and unprocessed agricultural, horticultural products; raw and unprocessed grains and seeds; fresh fruit and vegetables and fresh herbs.				
MONSOON HARVEST FARMS	31	3688136	27/11/2017	01/11/2006
Goods:				
Raw and unprocessed agricultural, horticultural products; raw and unprocessed grains and seeds; fresh fruit and vegetables and fresh herbs.				

6. The plaintiff has also applied for registration of its following marks, which are pending consideration with the Registrar of Trade Marks:-

Trade Mark	Cls.	Appln. No.	Date of Appln.	User date
MONSOON HARVEST FARMS	30	3688133	27/11/2017	01/11/2006
Goods:				
Rice, Flour and Preparations made from cereals; Sugar, mustard				
	30	3688132	27/11/2017	01/11/2006
Goods:				
organic food, processed and raw and other under this class.				

7. The plaintiff gives its sales figures in paragraph 17 of the plaint. The plaintiff states that it has also spent considerable sums of money on the promotion of the said trade marks. The plaintiff has launched a website by the name of [www.monsoonharvestfarms.com](http://www.monsoonharvestfarms.com). It also has a Facebook page under the name 'Monsoon Harvest Farms', created on 29.01.2013, with 15341 followers as on date of filing of the present suit and is also a part of the Facebook Marketplace under its trade marks. It also has a handle on the social media application- Instagram under the mark/name 'monsoonharvestfarms'. The plaintiff claims that it also promotes its business through Google Business and by way of a Youtube Channel by the name of 'Monsoon Harvest Farms'.

8. It is the case of the plaintiff that the plaintiff learnt of the applications filed by the defendant for the mark '**MONSOON HARVEST**' upon the issuance of the Examination Report by the Trade Marks Registry with respect to the trade mark application no. 3688132 filed by the plaintiff under Class 30, wherein the defendant's impugned mark was cited in the Search Report accompanying the Examination Report.

9. The plaintiff further discloses that in his reply to the Examination Report, the plaintiff made a statement that the marks are different. The plaintiff states that the said statement was inadvertently made and the plaintiff has already filed a request for an amendment of its reply to the Examination Report in Application no.3688132 to state that the defendant's mark is subsequent to that of the plaintiff. The plaintiff states that as far as the other application is concerned, the same has already been advertised and the plaintiff shall make appropriate submissions in its counter-statement, which the plaintiff would be filing to the notice of opposition filed by the defendant.

10. The plaintiff states its application no. 3688133 under Class 30 has been opposed by the defendant in the present case, taking a stand that the two marks are ‘completely identical’ and would mislead the general public and traders to believe that the goods manufactured by the said plaintiff are also of the defendant. The plaintiff asserts that, therefore, the defendant is estopped from taking a defence that the marks are different.

11. The plaintiff has since also filed oppositions against the registrations of the defendant for the word mark ‘**MONSOON**

**HARVEST**’ as also the device mark ‘’.

12. The plaintiff submits that in the counter-statement filed by the defendant for both opposition proceedings, the defendant, while on the one hand claimed that the defendant’s mark is distinctive, on the other hand, claims that the words ‘Monsoon’ and ‘Harvest’ are common to trade and cannot be claimed to be owned by one person/entity.

13. The plaintiff submits that during the pendency of the opposition proceedings before the Trade Marks Registry, the defendant also registered a domain name [www.monsoonharvest.in](http://www.monsoonharvest.in) (registered on September, 2015, which became active only in the year 2017) and is also using the ‘**MONSOON HARVEST**’ marks on the same social media platforms as the plaintiff, that is, Facebook and Instagram. The plaintiff asserts that the activity on the said accounts began in the year 2016 only, that is more than a decade subsequent to the adoption and use of the mark ‘**MONSOON HARVEST FARMS**’ by the plaintiff.

14. The plaintiff contends that in August, 2020, the defendant expanded the scope of his business and started selling his goods not

only through his website but also through third-party e-commerce platforms like [www.amazon.in](http://www.amazon.in).

15. The plaintiff claims that the defendant has copied the marks of the plaintiff with a dishonest intention to deceive the consumer and the public. Such adoption and use of the marks by the defendant amounts to infringement of the plaintiff's trade marks, passing off, and unfair competition.

ii) **Case of the defendant**

16. The defendant, in its written statement as also the counter-claim, states that it is the proprietor of the '**MONSOON HARVEST**' marks, used by the defendant for the goods falling under Class 30. The defendant has been making millet-based nutrition bars, cookies, muesli, granola, breakfast cereals, nut bars, granola bars, energy bars, snack bars and confectionary under the '**MONSOON HARVEST**' marks since the year 2015. The business of the defendant is not solely limited to India but has also expanded to countries such as Singapore, Maldives and the United Arab Emirates.

17. It is stated that the goods of the plaintiff are different from those of the defendant.

18. The defendant further disputes the reputation of the plaintiff in the '**MONSOON HARVEST FARMS**' marks.

19. In paragraph 14 of the Written Statement, the defendant has provided its revenue figures from the sale of the goods bearing the '**MONSOON HARVEST**' marks for the Financial Year 2016-17 to 2019-20. The defendant has also mentioned its promotional expenses in paragraph 15 of the Written Statement. The defendant also lists out accolades which the goods of the defendant bearing the '**MONSOON HARVEST**' marks have received, including but not limited to being


awarded stars by a panel of five hundred global food experts at the 'Great Taste Awards' by the Guild of Fine Foods in the United Kingdom in the year 2019. The defendant, further, goes on to provide the details of its print as also social media presence; having been covered in publications such as the 'Economic Times', 'The Hindu' and 'Vogue India' as also having over 6,000 followers on its Facebook page and more than 15,000 followers on its official Instagram handle.

20. The defendant states that the channel of trade for its goods bearing the 'MONSOON HARVEST' marks is not only limited to premium brick-and-mortar grocery stores such as 'Modern Bazaar', 'Le Marche' and 'Foodhall', but also extends to their own website bearing the domain name [www.monsoonharvest.in](http://www.monsoonharvest.in) and third-party e-commerce platforms like 'Amazon', 'BigBasket' and 'Flipkart'.

21. The defendant states that it has filed the following applications to obtain registrations of its trade marks:-

Registration No.	Class	User Since	Date of application	Status
3645558 (word)	30	09/09/2016	05/06/2017	Opposed by the Plaintiff
Goods: Muesli, Granola in a variety of Flavours, Tastes, Nut Bars, Granola Bars, Energy Bars, Snack Bars in a variety of flavours, Tastes, Muesli and Granola in a variety of flavours, Tastes, Nut Bars, Granola Bars, Energy Bars, Snack Bars in a variety of Flavours, Tastes, Cookies, Biscuits in a variety of Flavours, Tastes, Bread, Pastry and Confectionery, Mustard, Vinegar, Sauces, Condiments, Spices.				
3564047 (device)	30	09/09/2016	27/09/2017	Opposed by the Plaintiff



				
Goods:  Muesli, Granola in a variety of flavours, Tastes, Nut bars, Granola Bars, Energy Bars, Snack Bars in a variety of flavours, Tastes, Muesli and Granola in a variety of flavours, Tastes, Nut Bars, Granola Bars, Energy Bars, Snack Bars in a variety of flavours, Tastes, Cookies, Biscuits in a variety of flavours, Tastes, Bread, Pastry and Confectionery, Mustard, Vinegar, Sauces, Condiments, Spices.				

**SUBMISSIONS OF THE LEARNED SENIOR COUNSEL FOR THE PLAINTIFF**

22. Mr. Chander M. Lall, the learned senior counsel for the plaintiff, submits that the adoption and use of the ‘**MONSOON HARVEST**’ marks by the defendant amounts to a flagrant violation of the plaintiff’s intellectual property rights, infringement of its trade mark, passing off of the goods of the defendant as those of the plaintiff, as also unfair competition.

23. He submits that by virtue of being the prior user as also being the registered proprietor of the marks, the plaintiff has the exclusive right to use the ‘**MONSOON HARVEST FARMS**’ marks in India. He states that unauthorised use of a mark deceptively and confusingly similar to the ‘**MONSOON HARVEST FARMS**’ marks by the defendant would lead to erosion of the distinctiveness of the ‘**MONSOON HARVEST FARMS**’ marks of the plaintiff, which enjoy an enormous reputation and goodwill in India.

24. Placing reliance on the Notice of Opposition filed by the defendant to the trade mark application no. 3688133 of the plaintiff under Class 30, wherein the defendant admits that the marks of the plaintiff and the defendant are exactly similar, the learned senior

counsel for the plaintiff submits that the defendant cannot at this stage be permitted to take a contrary stand and adopt a virtually identical mark and domain name in relation to the identical goods, that is, edible goods.

25. On the submission of the defendant that the goods of the plaintiff and the defendant are different, he submits that the plaintiff and the defendant deal in similar goods, that is, food items and, therefore, the artificial distinction drawn by the defendant is incorrect.

26. He submits that merely because the registration obtained by the plaintiff of its trade marks is restricted to Edible Oils and Raw and unprocessed agricultural products etc., would not make a difference to its claim in the present suit. He submits that the plaintiff had to restrict the goods covered in its application as at that time the plaintiff was dealing only in those goods.

27. He submits that merely because the defendant has transacted in a higher volume of sale would also not come to its aid, inasmuch as, the right of the prior adopter of the mark shall trump that of the subsequent adopter of the mark. He submits that even a single use of the mark is sufficient to entitle the plaintiff to seek protection of its mark. In support, he places reliance on the judgement of this Court in *Century Traders v. Roshan Lal Duggar & Co.*, 1977 SCC OnLine Del 50.

28. He submits that for the purposes of the present application, though the plaintiff has shown instances of actual confusion being caused amongst the customers due to the adoption of a similar mark by the defendant, the plaintiff is not to show that the adoption of the marks by the defendant was fraudulent. Once it is shown that the marks are similar for similar goods, an injunction must follow. In

support, he relies upon the judgement of the Supreme Court in *Laxmikant V. Patel v. Chetanbhai Shah & Anr.*, (2002) 3 SCC 65.

29. Further, placing reliance on the judgment of this Court in *Teleecare Network India Pvt. Ltd. v. Asus Technology Pvt. Ltd. & Ors.*, 2019 SCC OnLine Del 8739, he reiterates that there can be no estoppel against a statute. He submits that therefore, the reply filed by the plaintiff to the Examination Report is not relevant. In any case, for one of such applications, the plaintiff has already filed an application seeking amendment of its reply.

30. He submits that the mere addition of word '**WINGREENS**' is not sufficient to distinguish the mark of the defendant from that of the plaintiff.

**SUBMISSIONS OF THE LEARNED SENIOR COUNSEL FOR THE DEFENDANT**

31. On the other hand, Mr. Jayant Mehta, the learned senior counsel for the defendant, at the outset submits that the defendant has now adopted a new mark, that is, '**WINGREENS MONSOON HARVEST**', which creates an even-wider difference between the marks of the plaintiff and the defendant. He submits that it is trite law that marks have to be compared as a whole and with the affixation of the prefix '**WINGREENS**', there exists no question of either infringement or passing off of the marks of the plaintiff by the defendant. Placing reliance on *Meso Pvt. Ltd., Mumbai v. Liberty Shoes Ltd., Haryana*, 2020 (1) Mh.L.J., he submits that the addition of a house mark, especially when such house mark also has a certain reputation and goodwill, would obviate any chance of confusion in the mind of an unwary consumer.

32. The learned senior counsel for the defendant submits that the plaintiff is estopped from taking a stand that the marks of the plaintiff and the defendant are visually, phonetically and/or structurally similar. Drawing the attention of this Court to the response to the Examination Report filed by the plaintiff in the application no. 3688133 and 3688132, wherein the plaintiff stated that the competing marks were visually, phonetically and structurally different, and accordingly there could not be any confusion as to the source of origin, the learned senior counsel for the defendant asserts that the plaintiff cannot take a contradictory stand now. He submits that for this reason alone, the Suit and the application are liable to be dismissed. He submits that though the plaintiff has moved an application seeking to withdraw such admission in one of the trade mark applications, no such attempt has been made for the other. He submits that even otherwise, the plaintiff shall be estopped from now contending to the contrary. In support, he places reliance on the following orders and judgments of this Court:-

- i) *S.K. Sachdeva & Anr. v. Shri Educare Ltd. & Anr.*, 2016 (65) PTC 614(Del)(DB);
- ii) *Vasundhra Jewellers Pvt. Ltd. v. Kirat Vinodbhai Jadvani & Anr.*, 2022/DHC/004255;
- iii) *Living Media India Limited & Anr. v. Alpha Dealcom Pvt Ltd. & Ors.*, (2014) 3 HCC (Del) 248;
- iv) *Mankind Pharma Ltd v. Chandra Mani Tiwari & Anr.*, CS(COMM) 100/2017;
- v) Order dated 30.07.2019 in *Poly Medicure Limited v. Polybond India Pvt. Ltd.*, CS (COMM) 1292/2016; and
- vi) *Om Logistics Ltd. v. Sh. Mahendra Pandey*, CS (COMM) 447/2021.
- vii) *Raman Kwatra & Anr. v. M/s KEI Industries Limited*, 2023/DHC/000083.

33. The learned senior counsel for the defendant submits that the plaintiff had originally applied for registration of its marks under Application Nos. 3688135 and 3688134 under Class 29 for '*Organic Food, Processed and Raw and Other under this Class*'. On the direction from the Registry to limit the scope of these applications, the plaintiff, by way of an amendment, restricted the scope of the applications only to edible oils. Similarly, for Application No. 3688137 under Class 30, the plaintiff restricted the application to '*Raw and unprocessed agricultural, horticultural products; raw and unprocessed grains and seeds; fresh fruit and vegetable and fresh herbs*'. By the said conduct, the plaintiff has disentitled himself from claiming a right in respect of the goods beyond what are specifically mentioned in the registrations granted. In support, he places reliance on *Mittal Electronics v. Sujata Home Appliances (P) Ltd. & Ors.*, CS(COMM) 60/2020; *Technova Tapes (India) Pvt. Ltd. v. TechNova Imaging Systems (P) Limited*, 2019 SCC OnLine Mad 38987; *Vishnudas Trading as Vishnudas Kishandas v. Vazir Sultan Tobacco Co. Ltd., Hyderabad*, AIR 1996 SC 2275; and *Nandhini Deluxe v. Karnataka Co-operative Milk Producers Federation Ltd.*, (2018) 9 SCC 183, to submit that the proprietor of a trade mark cannot enjoy monopoly over the entire class of goods and particularly when he is not using the said trade mark in respect of certain goods falling under the same class.

34. He submits that the plaintiff has failed to show that the goods in which either the plaintiff or the defendant are carrying on their businesses are allied or cognate, or even similar to the goods of the other.

35. The learned senior counsel for the defendant submits the defendant, in any case, is an honest and concurrent user of the marks and is entitled to protection of its user of the marks under Section 34 of the Act. He submits that the defendant began using the ‘**MONSOON HARVEST**’ marks for processed food items in the year 2015, while the plaintiff began using the ‘**MONSOON HARVEST FARMS**’ marks with respect to pickles, that is a processed food item, only in the year 2017. Therefore, the defendant is the prior user of the marks for the processed food items.

**ANALYSIS AND FINDINGS**

36. I have considered the submissions made by the learned senior counsels for both the parties.

**i. Whether the marks in question are deceptively similar?**

37. The first issue that needs to be determined is whether the two marks, which are, ‘**MONSOON HARVEST FARMS**’ of the plaintiff and ‘**WINGREENS MONSOON HARVEST**’ of the defendant, are deceptively similar to each other. In my *prima facie* view, the two marks are deceptively similar to each other. The addition of the word ‘**WINGREENS**’ to the marks of the defendant is not sufficient to bring about a distinction in the two marks.

38. The test to be applied in determining whether the marks in question are deceptively similar to each other is that of an unwary purchaser with an average intelligence and imperfect recollection. The Supreme Court in *Amritdhara Pharmacy v. Satya Deo Gupta*, (1963) 2 SCR 484, has held as under:

*“6. It will be noticed that the words used in the sections and relevant for our purpose are ‘likely to deceive or cause confusion’. The Act does not lay down any criteria for determining what is likely to deceive or cause confusion. Therefore, every case must depend on its own*

*particular facts, and the value of authorities lies not so much in the actual decision as in the tests applied for determining what is likely to deceive or cause confusion. On an application to register, the Registrar or an opponent may object that the trade mark is not registrable by reason of clause (a) of Section 8, or sub-section (1) of Section 10, as in this case. In such a case the onus is on the applicant to satisfy the Registrar that the trade mark applied for is not likely to deceive or cause confusion. In cases in which the tribunal considers that there is doubt as to whether deception is likely, the application should be refused. A trade mark is likely to deceive or cause confusion by its resemblance to another already on the register if it is likely to do so in the course of its legitimate use in a market where the two marks are assumed to be in use by traders in that market. In considering the matter, all the circumstances of the case must be considered. As was observed by Parker, J. in *Pianotist Co.'s Application, Re* [(1906) 23 RPC 774] which was also a case of the comparison of two words—*

*'You must take the two words. You must judge them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks.'* (p. 777)

For deceptive resemblance two important questions are: (1) who are the persons whom the resemblance must be likely to deceive or confuse, and (2) what rules of comparison are to be adopted in judging whether such resemblance exists. As to confusion, it is perhaps an appropriate description of the state of mind of a customer who, on seeing a mark thinks that it differs from the mark on goods which he has previously bought, but is doubtful whether that impression is not due to

*imperfect recollection. (See Kerly on Trade Marks, 8th Edn., p. 400.)*

7. *Let us apply these tests to the facts of the case under our consideration. It is not disputed before us that the two names 'Amritdhara' and 'Lakshmandhara' are in use in respect of the same description of goods, namely, a medicinal preparation for the alleviation of various ailments. Such medicinal preparation will be purchased mostly by people who instead of going to a doctor wish to purchase a medicine for the quick alleviation of their suffering, both villagers and townfolk, literate as well as illiterate. As we said in Corn Products Refining Co. v. Shangrila Food Products Ltd. [AIR 1960 SC 142 : (1960) 1 SCR 968] the question has to be approached from the point of view of a man of average intelligence and imperfect recollection. To such a man the overall structural and phonetic similarity of the two names 'Amritdhara' and 'Lakshmandhara' is, in our opinion, likely to deceive or cause confusion. We must consider the overall similarity of the two composite words 'Amritdhara' and 'Lakshmandhara'. We do not think that the learned Judges of the High Court were right in saying that no Indian would mistake one for the other. An unwary purchaser of average intelligence and imperfect recollection would not, as the High Court supposed, split the name into its component parts and consider the etymological meaning thereof or even consider the meaning of the composite words as 'current of nectar' or 'current of Lakshman'. He would go more by the overall structural and phonetic similarity and the nature of the medicine he has previously purchased, or has been told about, or about which has otherwise learnt and which he wants to purchase. Where the trade relates to goods largely sold to illiterate or badly educated persons, it is no answer to say that a person educated in the Hindi language would go by the etymological or ideological meaning and see the difference between 'current of nectar' and 'current of Lakshman'. 'Current*



of Lakshman' in a literal sense has no meaning; to give it meaning one must further make the inference that the 'current or stream' is as pure and strong as Lakshman of the Ramayana. An ordinary Indian villager or townsman will perhaps know Lakshman, the story of the Ramayana being familiar to him; but we doubt if he would etymologise to the extent of seeing the so-called ideological difference between 'Amritdhara' and 'Lakshmandhara'. He would go more by the similarity of the two names in the context of the widely-known medicinal preparation which he wants for his ailments.

8. We agree that the use of the word 'dhara' which literally means 'current or stream' is not by itself decisive of the matter. What we have to consider here is the overall similarity of the composite words, having regard to the circumstance that the goods bearing the two names are medicinal preparations of the same description. We are aware that the admission of a mark is not to be refused, because unusually stupid people, 'fools or idiots', may be deceived. A critical comparison of the two names may disclose some points of difference but an unwary purchaser of average intelligence and imperfect recollection would be deceived by the overall similarity of the two names having regard to the nature of the medicine he is looking for with a somewhat vague recollection that he had purchased a similar medicine on a previous occasion with a similar name. The trade mark is the whole thing — the whole word has to be considered. In the case of the application to register 'Erectiks' (opposed by the proprietors of the trade mark 'Erector') Farwell, J., said in William Bailey (Birmingham) Ltd.'s Application [(1935) 52 RPC 136] :

*'I do not think it is right to take a part of the word and compare it with a part of the other word; one word must be considered as a whole and compared with the other word as a whole. ... I think it is a dangerous method to adopt to divide the word up and seek to distinguish a portion of it from a portion of the other word.'* "

(Emphasis supplied)

39. On the submission of the learned counsel for the defendant that since the defendant has added the word ‘**WINGREENS**’ to its mark, the said mark is not deceptively similar to the plaintiff’s mark, I again do not find merit. In *Subhash Chand Bansal v. Khadim's and Another*, 2012 SCC OnLine Del 4326, it has been held that mere use of a prefix may not be sufficient to distinguish the two marks. I quote from the judgment as under:-

*“27. Mere use of the prefix KHADIM'S, would not take the case out of the purview of Section 29 of the Trade Marks Act irrespective of whether the word KHADIM'S is bigger, equal or smaller than the word KHAZANA. There is a strong possibility of customers findings the shoes and boots etc. being sold under the trademark KHADIM'S KHAZANA in the stores of defendant no. 2 and confusing the same with the trademark of the plaintiff on account of use of the word KHAZANA in the trademark of the defendants. Moreover, a customer of average intelligence may presume that it is the product of the plaintiff which is being sold in the stores of the defendants and that is why the word KHAZANA is written on the product and/or its packaging or the customers may presume that there is some kind of trade connection between the plaintiff and defendant no. 2 and that is why the word KHAZANA is being used as a part of the trademark of the defendants, in respect of identical products.*

*28. The impugned trademark, to my mind, is at least deceptively similar to the registered trademark of the plaintiff and since the trademark in question is being used in relation to the goods which are covered by registered trademark of the plaintiff, a case of infringement under Section 29(1) of the Trade*

*Marks Act is clearly made out. Even if I proceed on the assumption that impugned trademark is similar though not deceptively similar to the registered trademark of the plaintiff, it still constitutes infringement within the meaning of Section 29(2) of the said Act since it is being used in respect of the same products which are covered by the plaintiff's registered trademark and as such is likely to cause confusion in the minds of the consumers or they may perceive the impugned trademark to be associated with the registered trademark of the plaintiff."*

40. Therefore, mere addition of the word '**WINGREENS**' cannot reduce the deceptive similarity of the mark of the defendant with that of the plaintiff. I find that even with this addition there is a strong likelihood of the defendant's mark being confused with the mark of the plaintiff. Accordingly, I find that the two marks in question are similar to each other.

**ii. Whether the Rule of Estoppel applies on stand taken before the Registrar of Trade Marks?**

41. This now takes me on to the second issue as to whether the plaintiff, due to the stand taken by him in the reply to the Examination Reports in his application nos. 3688133 and 3688132, is estopped from contending that the two marks are similar to each other.

42. In considering the said issue, it must also be kept in mind that the defendant, in its opposition seeking rectification of the plaintiff's registration under application no. 3688133, has taken a stand that the two marks are exactly similar to each other. The relevant extract from the notice of opposition is reproduced hereinbelow:-

*"9. The Trademark "**MANSOON HARVEST FARMS**" applied for registration by*

**PREETENDRA SINGH AULAKH** vide **APPLICATION NO.3688133 IN CLASS 30** is completely identical to the Trademark of this opponent. The mark applied by the said application is exactly similar with an addition of a suffix i.e., **FARM** to the mark of this opponent. The mark applied by applicant would definitely mislead the general public and traders to believe that the goods manufactured by the said applicant are also of the manufacture of the opponent.

10. The mark applied by the applicant is similar to an earlier trademark and is likely to deceive public or cause confusion and also is prevented from the law of passing off.”

43. Therefore, both the parties to the present suit have taken contradictory stands before the Trade Marks Registry and before this Court. The principle of estoppel, if it is to apply, shall apply equally to both the parties, therefore, leaving for this Court to determine whether the two marks can be said to be similar to each other or not.

44. In **Raman Kwatra** (supra), the Court was confronted with a position where the plaintiff therein had obtained registration of its marks by contending that the mark of the defendant that was cited in the Examination Report was not similar. The Court in the factual background of that case observed as under:-

“43. We also find merit in the appellant’s contention that a party, that has obtained the registration of a trademark on the basis of certain representation and assertions made before the Trade Marks Registry, would be disentitled for any equitable relief by pleading to the contrary. The learned Single Judge had referred to the decision in the case of **Telecare Networks India Pvt. Ltd. v. Asus Technology Pvt. Ltd.** (supra) holding that after grant of registration neither the Examination Report nor the plaintiff’s reply would be relevant. We are unable to agree with the said view. In that case, the Court had also reasoned that that there is no estoppel against statute. Clearly, there is no cavil with the said proposition;

*however, the said principle has no application in the facts of the present case. A party that has made an assertion that its mark is dissimilar to a cited mark and obtains a registration on the basis of that assertion, is not to be entitled to obtain an interim injunction against the proprietor of the cited mark, on the ground that the mark is deceptively similar. It is settled law that a person is not permitted to approbate and reprobate. A party making contrary assertions is not entitled to any equitable relief.*

*44. The respondent had applied for the word mark “KEI” in Class 11 (Application No.3693719). The Trade Marks Registry had cited three marks in its Examination Report including the impugned trademark (Application No.3256919). In its response to the Examination Report, the respondent had, inter alia, stated “.....the services of the Applicant are different to that of the cited marks and therefore, there is not any likelihood of confusion....” Clearly, in view of the aforesaid statement, it would not be open for the respondent to contend to the contrary in these proceedings.*

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*46. Mr. Lall also submitted that the respondent had reserved its right to take the appropriate legal remedies and its response to the Trade Mark Registry was without prejudice to its rights and contentions. Undoubtedly, the respondent had reserved its right to avail of appropriate remedies in respect of the impugned trademark, however, reserving a right to avail of other remedies would not include the right to make a contrary assertion. A party approaching the Trade Marks Registry must be held to its statements made before the Trade Marks Registry and cannot be permitted to make a factual assertion contrary to what it claims before the Trade Marks Registry. For this reason, as well, it was not permissible for the respondent to claim that the goods covered under its trademarks were similar to those of the appellant.”*

45. In the present case, the plaintiff's application, wherein a contradictory stand has been taken by the plaintiff, has not proceeded to registration. The plaintiff is not claiming its relief in the present suit based only on these applications. The plaintiff has also filed an application seeking to amend its reply in one of the applications. Therefore, in my opinion, the above judgment would not come to much assistance for the defendant.

46. Though various other judgments have also been cited by both the parties on this issue, in view of the judgment of this Court in ***Raman Kwatra & Anr. (supra)***, laying down the law on the subject, I need not revisit the same by discussing various other judgments that have been cited by the parties. Suffice it to say that because of both the parties taking contradictory stands before this Court and before the Registrar of Trade Marks, the present application is being decided on merit rather than on the basis of the stand taken by them before the Registrar of Trade Marks.

**iii. Whether the goods in question are similar?**

47. Another question that arises for consideration is as to whether the goods of the plaintiff and that of the defendant are similar. As noted hereinabove, it is the case of the defendant that the plaintiff has registered its marks for edible oils, raw and unprocessed agricultural, horticultural products, and fresh fruits and vegetables etc., while the defendant deals in processed food items like millet based nutrition bars, cookies, muesli etc. and therefore, these goods are not similar. It is, therefore, argued by the defendant that the goods are different and, therefore, there is no possibility of confusion being caused due to the use of the impugned marks by the defendant.

48. In answer to the above, the test of determining ‘allied/cognate goods or services’ laid down by this Court in **FDC Limited v. Docusuggest Healthcare**, 2017 SCC OnLine Del 6381, is reproduced hereinbelow:

“51. .... Allied/cognate goods or services, as understood from the material referred to below, are those goods/services which are not identical, but can be said to be related or similar in nature (See **McCarthy on Trademarks and Unfair Competition, Fourth Edition, Vol 5**). The Shorter Oxford English Dictionary on Historical Principles Fifth Edition 2002, Vol. 1. defines the term “Allied” as “connected by nature or qualities; having affinity” and the term “Cognate” as “akin in origin, nature or quality”. Reference may also be made to New Webster’s Dictionary and Thesaurus of the English Language, 1992 which defines “Allied” as “relating in subject or kind” and “Cognate” as “1. adj. having a common ancestor or origin (of languages or words) having a common source or root (of subjects etc.) related, naturally grouped together.”. Cognate goods/services can be described, inter alia, as goods or services which have a trade connection - as in glucose and biscuits (See **Corn Products Refining Co. v. Shangrila Food Products Ltd.**, AIR 1960 SC 142) or which are intended for the same class of customers - as in television picture tubes (parts thereof, video tapes and cassettes and television tuners etc.) and televisions, tuners and T.V. Kits (See **Prakash Industries Ltd. v. Rajan Enterprises** (1994) 14 PTC 31), or are complementary to each other - as in toothbrushes and toothpaste (See **HM Sariya v. Ajanta India Ltd.** (2006) 33 PTC 4).

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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:

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*, 15 Edition 2011, the learned Author in Para 9-073 has stated as under : -

"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 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 15 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.”*

(Emphasis supplied)

49. Applying the above test to the facts of the present case, it is observed that the respective goods of the plaintiff and the defendant are under the umbrella of food items; the plaintiff deals in the sale of raw and unprocessed agricultural and horticultural products, while the defendant sells processed food items such as granola bars, energy bars, cookies, bread and other confections. The intended purpose for both the plaintiff and the defendant is to market and sell their food items to the public at large. The respective users of the goods of both the parties are the end point retail consumers. The plaintiff and the defendant are entities which come under the food industry. Moreover, the goods of the parties would be normally sold through the same supply chain to the same customers who may consider the items sold by the defendant as emanating from the plaintiff. In fact, the plaintiff has filed on record evidence showing actual complaints of confusion being caused in the mind of an unwary consumer.

50. It, therefore, in my *prima facie* opinion that the goods of the plaintiff and the defendant are allied and cognate products.

51. The plaintiff also claims to be expanding its business into processed food items, which can be considered as a natural progression of its business. In *Montari Overseas Limited v. Montari Industries Ltd.*, 1995 SCC OnLine Del 865, the Court while

considering the question of whether the activities of the appellant therein were likely to cause confusion in the mind of the average consumer and tarnish the goodwill of the respondent therein in its product, observed as under:-

*“21. Regard must also be had to the fact that the expansion of business by the appellant and respondents in future may bring the parties into competition (See *The Dunlop Pneumatic Tyre Co. Ltd. v. The Dunlop Lubricant Co., 1899 (XVI) RPC 12 at page 15 and Crystalate Gramophone Record Manufacturing Co. Ltd. v. British Crystalite Co. Ltd., 1934 (51) RPC 315 at page 322.**

(Emphasis Supplied)

52. In *Sona BLW Precision Forgings Ltd v. Sona EV Private Limited*, 2022 SCC OnLine Del 2321, this Court relied on the decision in *Montari Overseas Limited (supra)*, to affirm that there would be confusion in the minds of the consumers based on a future trade progression of the plaintiff.

53. Applying the above principle, due to the plaintiff expanding into the selling of processed food items, which can be considered as a natural trade progression of its already existing field of business, in my *prima facie* opinion, there would be confusion in the mind of the average consumer who would likely mistake the goods of the defendant bearing the impugned mark with those of the plaintiff or as originating from the plaintiff.

**iv. Whether the goods are dissimilar on account of falling under different Classes or because of restriction of goods for which the plaintiff has been granted registration?**

54. I will now proceed to deal with the submission of the learned senior counsel for the defendant that the goods in question are dissimilar since they fall under different classes. He submitted that

since the plaintiff restricted the scope of the application for registration, it is disentitled from claiming rights over goods falling under different classes.

55. In my opinion, the goods of the plaintiff and the defendant in the present case, being allied and cognate goods, merely because they fall in different Classes for the purposes of grant of registration, cannot be held to be dissimilar goods for the purposes of an injunction.

56. In *FDC Limited* (supra), this Court has observed as under:

*“52.....The classification of goods and services under-Section 7 of the Act is not the criterion for deciding the question of similarity in goods/services. Reliance may be placed on K.C. Kailasam/Ramu Vedaraman's Law on Trade Marks & Geographical Indications 1<sup>st</sup> Edition, 2003 wherein, the learned author on Page 180 has stated as under-*

*“Classification of goods given in the rules not the criterion*

*Whether or not two sets of goods or services are of the same description is not be decided on the basis of the classification of goods and services given in the 4<sup>th</sup> schedule to the Trade Marks Rules, 2002. The description of goods may be narrower or wider than any of the classes according to the circumstances of the case. As was observed by LINDLEY J., in the Australian Wine Importers Trade Mark case [(1889) 6 RPC 311]. “If you come to look at that classification, you will find goods of the same description, in one sense, in different classes; and you will find goods of different description in the same class”. ””*

57. In *Mittal Electronics* (supra), the Court found that the goods being sold by the plaintiff and the defendant were different, with the only commonality being that of a geyser. The Court, therefore,

vacated the *interim* order for the goods that were not found similar to those of the plaintiff.

58. In *Vishnudas (supra)*, the Supreme Court allowed the rectification of the registration granted in favour of the respondent no.1 therein, on the ground of non-user of the registered mark in respect of ‘*quiwam*’ and ‘*zarda*’ by the respondent no.1 company. The Court held that though varieties of articles are made out of tobacco, they are used differently and have a distinctive quality and separate identity; in common trade channels such articles are not only held different and as distinct articles, but are marketed separately. The Court held that if a trader or a manufacturer actually trades in or manufactures only in one or some of the articles coming under a broad classification and such trader or manufacturer has no *bona fide* intention to trade in or manufacture other goods or articles which also fall under the said broad classification, such trader or manufacturer should not be permitted to enjoy a monopoly in respect of all the articles which may come under such broad classification and by that process preclude the other traders or manufacturers to get registration of separate and distinct goods, which may also be part of the product classification. The Court, however, clarified that its observations are only confined to the propriety and validity of the order of rectification of the registration of the trade mark in favour of the respondent company and it is not extended to a question of infringement of trade mark or passing off. In the present case, the claim of the plaintiff is of infringement and passing off and, therefore, has to be determined on the basis of the principles that have been laid down by the Courts for testing the same.

59. In *Nandhini Deluxe*(*supra*), the appellant therein had sought registration for the mark in goods which were held to be different from those of the respondent. The Court held that it was difficult to imagine that an average man of ordinary intelligence would associate the goods of the appellant as that of the respondent. The said judgment, therefore, has no application to the facts of the present case.

60. In *Technova Tapes (India) Pvt. Ltd.*(*supra*), the Court again found that the goods manufactured by the appellant therein and the respondent therein were all together different. The Court further found that the respondent therein had failed to show that it had invented the said mark. The Court also found that the adoption of the mark by the respondent was honest. The said judgment would again have no application to the facts of the present case.

61. In the present case, the plaintiff has explained that it confined its application seeking registration of its marks to only Edible Oil and raw and unprocessed food items as at that time, he was dealing only in those goods. The plaintiff is now expanding to even processed food items. Such food items, in my *prima facie* opinion, are cognate and allied. Therefore, the factum of the plaintiff curtailing the scope of its application for registration of its trade mark; and the goods falling under different classes for the purposes of registration, in my *prima facie* opinion, will not disentitle the plaintiff for grant of an injunction. The reliance of the defendant upon the history of the applications leading to the registration of the marks of the plaintiff, in my *prima facie* opinion, is erroneous and is liable to be rejected as such correspondence is not relevant for the adjudication of the present application.

**v. Whether the exception under Section 34 of the Act applies to the present case?**

62. The learned senior counsel for the defendant has also relied upon Section 34 of the Act to contend that the defendant is the prior user of the processed food items that it manufactures and sells and, therefore, injunction should not follow.

63. Section 34 of the Act is reproduced hereinbelow:-

*“34. Saving for vested rights.—Nothing in this Act shall entitle the proprietor or a registered user of registered trade mark to interfere with or restrain the use by any person of a trade mark identical with or nearly resembling it in relation to goods or services in relation to which that person or a predecessor in title of his has continuously used that trade mark from a date prior—*

*(a) to the use of the first-mentioned trade mark in relation to those goods or services by the proprietor or a predecessor in title of his; or*

*(b) to the date of registration of the first-mentioned trade mark in respect of those goods or services in the name of the proprietor of a predecessor in title of his; whichever is the earlier, and the Registrar shall not refuse (on such use being proved) to register the second mentioned trade mark by reason only of the registration of the first-mentioned trade mark.”*

64. Once it is held that the goods of the plaintiff and the defendant are allied and cognate, the exception carved out in Section 34 of the Act would not apply. It is applicable where the goods of the defendant are different from the ones in which the plaintiff deals in and the defendant is shown to be the prior user of the mark for such goods. It cannot apply where the defendant is using identical or similar marks to that of the plaintiff, and for goods which are similar to those of the plaintiff. The test is also of a claim based on the prior registrations of the mark. In the present case, the plaintiff is the prior adopter and user of the marks to that of the defendant. The defendant, therefore, in my

*prima facie* opinion, is not entitled to the benefit of Section 34 of the Act.

vi. **Whether infringement is made out in the present case?**

65. On the question of infringement of a registered trade mark, we must look to Section 29(2) of the Act. The same is reproduced as under:-

**“29. Infringement of registered trade marks.—**

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(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.”

66. For raising a claim of infringement, the registered proprietor has to *inter alia* show similarity of the registered trade mark and similarity of the goods covered by such registered trade mark with the complained mark used by the other persons and which is likely to cause confusion on the part of the public or which is likely to have an association with the registered trade mark. Identity of the goods and identity of the services is relevant and raises a presumption of the likelihood of confusion in terms of Section 29(2)(c) of the Act, however, is not a *sine qua non*. In the present case the claim of the



plaintiff would fall in the scope of Section 29(2)(b) of the Act as the marks are *prima facie* deceptively similar and the goods are also similar to each other.

67. Though it may be true that on the asking of the Registrar of Trade Marks to limit the scope of protection sought in its applications, the plaintiff conceded to the same by restricting the scope of the registration to edible oils and raw and unprocessed agricultural and horticultural products etc., the plaintiff shall still be entitled to an *interim* injunction as, in my *prima facie* opinion, the plaintiff has been able to make out a case falling under Section 29(2)(b) of the Act.

**vii) Whether the plaintiff is entitled to the claim of passing off?**

68. For the reasons stated hereiabove, the plaintiff has also been able to make out a *prima facie* case of passing of against the defendant.

69. In view of the above, I hold as under:-

- a) The plaintiff is the registered proprietor of the mark '**MONSOON HARVEST FARMS**' and is the prior user thereof;
- b) The mark of the plaintiff and the defendant *prima facie* appear to be similar both visually as also phonetically, with '**MONSOON HARVEST**' being the dominant part thereof. Mere addition of the word '**WINGREENS**' or the logo in the the defendant's mark is not sufficient to distinguish the same on application of the test of an unwary purchaser of an average intelligence with an imperfect recollection;
- c) The plaintiff is claiming evidence of actual confusion caused to the consumer;


d) The goods of the plaintiff and the defendant are similar and allied as they are food items which are sold over the counter and the attempt to distinguish them on one being processed and the other being unprocessed appears to be artificial;


70. The plaintiff, therefore, has been able to make out a *prima facie* case of infringement and passing off against the defendant.


71. The balance of convenience is also in favour of the plaintiff and against the defendant inasmuch as the plaintiff is the prior adopter of the mark and is likely to suffer grave irreparable injury in case the defendant is not restrained from selling its products using similar marks for similar goods.

### **RELIEF**

72. In view of the above, the defendant is restrained from using the

mark ‘**MONSOON HARVEST**’ and/or the logo  and/or

for the new mark  and/or any other mark or name identical and/or deceptively and confusingly similar to the plaintiff’s earlier and registered trademarks **MONSOON HARVEST FARMS**

and/or , either as, a trade mark or part of a trade mark, a trade name or corporate name or as part of a trade or corporate name, part of a domain name or in any other manner whatsoever, so as

to infringe the registered trademarks of the plaintiff or pass off the same, till the pendency of the present suit.

73. The application is disposed of in the above terms.

74. It is made clear that any observation made hereinabove is only *prima facie* in nature and would not influence the Court at the final adjudication of the suit.

**CS(COMM) 509/2020**

75. List on 28<sup>th</sup> July, 2023 before the learned Joint Registrar (Judicial).

**MAY 02, 2023/AB/DJ/KP**

**NAVIN CHAWLA, J.**

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