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

Reserved on: 13 July 2023
Pronounced on: 18 July 2023

+ CS(COMM) 36/2021 & I.A. 3851/2022

ZENITH DANCE INSTITUTE PVT. LTD. Plaintiff

Through: Ms. Diva Arora Menon, Ms. Devyani
Nath and Ms. Archita Nigam, Advs.

versus

ZENITH DANCING AND MUSIC Defendant

Through: Mr. Sridharan Ramkumar, Adv.

CORAM:**HON'BLE MR. JUSTICE C.HARI SHANKAR****J U D G M E N T**

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18.07.2023

1. The plaintiff Zenith Dance Institute alleges that, by using the mark “ZENITH” for dance institutes run by it, the defendant is infringing the registered trademarks of the plaintiff and is also passing off the services rendered by it as those rendered by the plaintiff. Accordingly, the plaintiff has instituted the present suit before this Court, seeking an injunction, restraining the defendant from providing services under the mark ZENITH or any other deceptively similar mark, apart from rendition of accounts, damages and costs.



2. The plaintiff has also filed, with the plaint, IA 1114/2021, under Order XXXIX Rules 1 and 2 of the Code of Civil Procedure, 1980 (CPC), seeking interlocutory injunctive reliefs.
3. At the time of issuing summons in the suit on 22 January 2021, this Court passed an *ex parte ad interim* order, restraining the defendant, as well as all others acting on its behalf, from directly or indirectly dealing in goods or services bearing the mark ZENITH, or any other deceptively similar mark. The said interlocutory order has been continued from time to time, and is in force as on date.
4. The defendant has also filed IA 3851/2022 under Order XXXIX Rule 4 of the CPC, seeking vacation of the interlocutory injunction granted by order dated 22 January 2021 *supra*.
5. Pleadings have been completed in IA 1114/2021 and IA 3851/2022. I have heard Ms. Diva Arora Menon, learned counsel for the plaintiff and Mr. Sridharan Ramkumar, learned Counsel for the defendant, at length.
6. This judgment disposes of IA 1114/2021 and IA 3851/2022.

Rival Contentions

Submissions of Ms. Diva Arora Menon



7. Tracing the history of the adoption and use, by the plaintiff, of the mark “Zenith”, Ms. Menon submits that Ritu Kapoor, a finance expert, had a passion for dance, which prompted her to open a dance Institute using the trademark ZENITH, in 1997. In 2001, Ritu Kapoor formed the proprietorship, under the name “Zenith Class Institute”. On 27 May 2005, Zenith Dance Institute Pvt Ltd, i.e. the plaintiff, was incorporated.

8. The plaintiff, submits Ms. Menon, is the proprietor of the registered device mark  and the registered word mark ZENITH ARTS, registered w.e.f. 7 June 2007 and 25 April 2014 respectively, claiming user, in each case, from 1 April 1997. She asserts that the “plaintiff group” has been using “Zenith”, as a part of its registered trademark ZENITH ARTS and device mark  continuously and extensively since 1997, and as part of its trading style “Zenith Dance Institute” and, thereafter, “Zenith Dance Institute Pvt Ltd” since 2001. The plaintiff has, all through, been engaged in providing education in relation to various forms of dance.

9. Furthermore, submits Ms. Menon, the plaintiff also holds a copyright registration, dated 17 July 2014, for the mark , as an original artistic work.

10. Ms. Menon has drawn my attention to various assertions in the plaint, intended at vouchsafing the reputation of the plaintiff. It is asserted that the plaintiff has performed more than 10000 live shows



all over the world and operates fully equipped studios in Delhi and Mumbai. It is further asserted that the plaintiff offers the largest dance troupe in India with 18 international and 120 prominent Indian choreographers. The plaintiff is also the recipient of various awards, and has performed and choreographed for leading names in the film world. The plaintiff also operates through the websites www.zenithdancetroupe.com and www.zenithdanceacademy.in, which were registered in February 2004 and April 2019 respectively.

11. Ms. Menon submits that, the plaintiff, in May 2014, came across the registration, in favour of the defendant, of the mark  in Class 41, in relation to music and dance institutes, w.e.f. 1 September 2006, claiming user since 12 May 1999. The plaintiff applied to the learned Intellectual Property Appellate Board (“the learned IPAB”) under Section 57 of the Trade Marks Act, 1999, for rectification of the Register of Trade Marks by removal, therefrom, of the defendant’s  mark. The said application was allowed by the learned IPAB *vide* order dated 1 May 2018, and directions were issued to the Trade Marks Registry to remove, from the Register of Trade Marks, the defendant’s  mark.

12. Despite this, she submits, the defendant continues to run four dance studios, in Delhi, under the mark ZENITH. The defendant now uses the marks  and . These marks not only replicate



the  logo from the outlawed  mark, but again use ZENITH as their most prominent feature. They, too, are, therefore, essentially “Zenith device marks”. Social media webpages, bearing the said marks, also continue to be operated by the defendant.

13. Ms. Menon asserts that “Zenith” constitutes the prominent part of its registered trademarks and that, therefore, by running a dance Institute under the name “Zenith”, in the face of the plaintiff’s pre-existing registrations, the defendant is infringing the plaintiff’s registered trademarks and passing off its services as those provided by the plaintiff.

14. The plaintiff, submits Ms Menon, enjoys priority of user as well as registration, *vis-à-vis* the defendant. While candidly acknowledging that, though the  device mark and the ZENITH ARTS word mark stand registered in the plaintiff’s favour, with a user claim of 1 April 1997, the plaintiff is not in possession of any positive evidence, presently, to support 1997 user of the said marks, she submits that the plaintiff is, nonetheless, in possession of positive evidence to demonstrate priority of use of the “Zenith” mark, by it, or its predecessor-in-interest, since 1999. She invites my attention, in this context, to the following certificate, dated 23 March 2022, issued by the ICICI Bank:

“Date: 23/03/2022

To the Client



This is to certify that M/s. ZENITH DANCE INSTITUTE was maintaining the Current Account No 629705009646 with ICICI Bank Ltd. Delhi – Mayur Vihar Phase 1 Branch, since 11/12/1999 which was closed on 19/12/2018.

This certificate is issued at the specific request of the customer and in accordance with, and subject to, the terms and conditions applicable to the Current Account. The bank disclaims any liability for any credit related decision taken by any user based on the certificate.

For ICICI Bank Ltd

Authorised Signatory”

15. While this document evidences use, by the plaintiff, of “Zenith” as part of its name, since 1999 at the least, Ms. Menon points out that the defendant has itself placed on record, with its written statement, several documents which evidence the existence of “Zenith Dance Institute” from 2002, till 2014. These are, *inter alia*,

(i) a Payment Voucher dated 24 November 2002 issued by Infra Red Musicians Pvt. Ltd. in favour of the plaintiff Zenith Dance Institute for ₹ 15,000, against dance performances at the Delhi Showtime Events Show which took place on 15, 16, 22 and 23 November 2002,

(ii) orders placed by Rashi Entertainment (P) Ltd on Zenith Dance Troupe on 23 August 2004 and 18 November 2004, for providing dancers for certain events,

(iii) a covering letter dated 18 June 2005 by Swift Corporation to the plaintiff, enclosing a cheque for ₹ 284,310/- as 50% advance payment for performances to be held at 12 cities,



- (iv) a covering letter dated 15 February 2006 from India Club to the plaintiff, enclosing 22 air tickets for artists to visit, and perform at, Dubai,
- (v) an invoice for ₹ 3464/- raised by Air Force Auditorium on the plaintiff for functions held at the Auditorium on 13 July 2010,
- (vi) invoices raised by various persons on the plaintiff on 2 August 2011, 5 March 2012, 29 March 2012 and 30 March 2012,
- (vii) invoices dated 24 June 2002, 29 June 2002, 28 August 2002 raised by the plaintiff towards providing various dance services, and
- (viii) receipts dated 24 June 2002, 19 July 2010, 4 December 2010, 22 November 2010, 30 December 2010, 8 January 2011, 30 March 2011, 20 May 2011, 14 March 2012, 9 September 2012, 12 February 2013, 7 December 2013 and 6 February 2014, issued by the plaintiff.

Submissions of Mr. Sridharan Ramkumar

16. Mr. Ramkumar points out, at the outset, that, though both the trademarks in which the plaintiff holds registrations have been registered with user claim of 1 April 1997, no documentary evidence, supporting the claim of user w.e.f. 1997, is on record, either before this Court or before the learned IPAB.



17. The defendant, he submits, is a proprietorship of Mr. Sanjay Sharma, and is the proprietor of the trademark/trading styles ZENITH,

ZENITH DANCE STUDIO as well as the logos  ,  and



. The defendant claims priority of user of the impugned marks, *vis-à-vis* the user, by the plaintiff, of the marks asserted in the plaint. While the plaintiff, submits Mr. Ramkumar, has provided no evidence of use of ZENITH with effect from 1997, as contended before the Trade Marks Registry while obtaining registration of its trade marks, the defendant has been using the impugned marks as early as 1999. Mr. Ramkumar has invited my attention to copies of various admission forms, whereunder students are stated to have secured admission to the defendant's Institute. The earliest of the admission forms is dated 3 May 1999. He has also invited my attention to affidavits filed by some of the students, vouchsafing the fact of having obtained admission to the defendant-Institute through the said admission forms. He particularly drew attention to the admission forms of Ms Nidhi Rana (then using her maiden name Nidhi Chauhan) and Ms. Soniya Sharma, and to the accompanying affidavits now filed by them in support of the admission forms. He candidly acknowledges, however, that the affidavits have been prepared and filed after the present suit was instituted by the plaintiff. I deem it appropriate to provide an image, here, of the admission form of Ms Nidhi Chauhan (which is identical to the admission form of Soniya Sharma) and to reproduce the affidavits filed by Nidhi Rana and Soniya Sharma:

Admission form of Nidhi Rana



ZENITH DANCING CHANAL & AROBICS CLASSES **340**

Registration Form No. : _____
 Date : 27th Aug 2002
 Name : MISS NIDHI CHAUHAN
 Address : 227-B VIKAS KAILASH VIHAR, GZR
 Telephone No. : 4840255
 Date of Birth : 14-04-84
 Occupation : _____
 Student
 Employed
 Professional
 Other
 Educational Qualification : _____
 Father's/Guardian's Name : MR. M. M. CHAUHAN
 Father's/Guardian's Occupation : SERVICE (Office) : 91-3867684
 Your Favorite actor (Give Two Name) : AKIL KAPoor & SALMAN KHAN
 Your Favorite actress (Give Two Name) : SARITA & AISHA
 Do You Interested Participate Dance competition : _____
 Friends/Relatives Who may be interested Join in dance school : _____
 Name : _____ Name : _____
 Address : _____ Address : _____
 Student Signature : _____ Guardian Signature : _____

Affidavit of Ms Nidhi Rana

“I, Mrs. Nidhi Rana, W/o Sh. Abhishek Rana, of 36 years of age, residing at 175-B, Pawan Vihar, Lane no. 3, Saharanpur, U.P.247001, do hereby solemnly affirm, declare and say as under:

1. I state that Mr. Sanjay Sharma, the Defendant in the present matter, is known to me since the year 2002 when I started taking dance classes the name of M/s Zenith Dancing and Music.
2. I state that as an admission formality, I had filled up the admission form of the dance institute of Mr. Sanjay Sharma. I state that the contents of the said form dated 27th August, 2002 were filled by myself and are true to best of my knowledge. I state that the said form was signed by my father Sh. M M Chauhan. Original copy of the admission form is annexed herewith and marked as Annexure-A.



3. I state that the statements made herein above are true to the best of my knowledge and are being made in good faith.

DEPONENT”

Affidavit of Soniya Sharma

“I, Ms. Soniya Sharma, D/o Sh. Satish Sharma, of 36 years of age, residing at 47C, Sohan Lal Street, Sihani Gate, Ghaziabad, U.P. 201001, do hereby solemnly affirm, declare and say as under:

1. I state that Mr. Sanjay Sharma, the Defendant in the present matter, is known to me since the year _____ when I started taking dance classes the name of M/s Zenith Dancing and Music.

2. I state that as an admission formality, I had filled up the admission form of the dance Institute of Mr. Sanjay Sharma. I state that the contents of the said form dated _____ were filled by myself and are true to best of my knowledge. I state that the said form was signed by my father Shri Satish Sharma. Original copy of the admission form is annexed herewith and marked as Annexure-A.

3. I state that the statements made herein above are true to the best of my knowledge and are being made in good faith.

DEPONENT”

Mr. Ramkumar submits that the defendant applied for registration of its trademark on 1 September 2006, and that the mark was registered on 16 February 2012, both of which dates were prior to any user document filed by the plaintiff, as well as to the date of filing of the application for registration of trademark by the plaintiff.

18. Mr. Ramkumar further submits that the defendant had trained students for participation in dance competitions in 2003 and 2005 under the banner “Zenith Dance”. In support of the submission, the plaintiff has placed on record affidavits of Brijesh Varshney and Vijay



Chandra, who were organising the said events along with photographs thereof. The affidavits of Brijesh Varshney and Vijay Chandra aver that they had organised the dance competition for children in which Sanjay Sharma was providing dance classes and training under the trademark/trading style ZENITH and that, on the request of the organisers, Sanjay Sharma, with his students, participated in the said events. Photographs of the events are stated to have been annexed to the affidavits.

19. Mr. Ramkumar submits that the plaintiff stands *ipso facto* disentitled to any equitable injunctive relief, as it has approached the Court with unclean hands concealing, in the process, its response to the First Examination Report (FER) dated 18 September 2015, of the Trade Marks Registry in reply to the plaintiff's application for registration of the word mark ZENITH ARTS which, he submits, is fatal to the case that the plaintiff seeks to set up against the defendant. Among the marks which were cited by the Trade Marks Registry, in response to the application, as rival marks and which, therefore, could disentitled the ZENITH ARTS mark to registration, in view of Section

11(1)¹ of the Trade Marks Act, 1999 was the  mark of the defendant. To the said FER, the plaintiff respondent thus, on 16 January 2016:

¹ 11. **Relative grounds for refusal of registration.** –

- (1) Save as provided in Section 12, a trade mark shall not be registered if, because of—
- (a) its identity with an earlier trade mark and similarity of goods or services covered by the trade mark; or
 - (b) its similarity to an earlier trade mark and the identity or similarity of the goods or services covered by the trade mark,
- there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.



“Respected Sir,

The applicants most respectfully submit Para-wise reply to the examination report as under: –

1. That our mark is **ZENITH ARTS**.
2. That as per the said report, our mark as a whole is neither registered nor pending in the name of any other person.
3. **MARKS DIFFERENT**: Your Honour will kindly appreciate that *our mark ZENITH ARTS is visually and identically different from the cited marks.*
4. **RESPONSE TO OBJECTION UNDER SECTION-11** With respect to the objection raised by the Learned Examiner, under Section 11 of the Trade Marks Act, 1999, we submit that the Applicant has bona fide adopted the mark **ZENITH ARTS** after conducting complete search in the market. Applicant has been using the mark since **01/04/1997**.
 - a. **Further** we state, *Mark Applied for registration is different visually and identically from all cited marks. Cited Mark bearing Application No. 1250778 is not renewed. Henceforth there is no chance of mislead and/or deception between the cited and the applicant marks.*
 - b. **Further** it is noteworthy that we have bonafidely adopted the mark without any intention to trade upon the goodwill of any mark in the market. We also submit that *there is no cited mark in the examination report which bears any structural and visual resemblance to the mark of the Applicant.*
5. **Applicant’s Mark is to be Associated with RTM NO. 1566046.**
6. The trade mark **ZENITH ARTS** has been depicted in a distinctive manner. The overall concept of the trademarks on record and that of the Applicant’s mark is



completely different/dissimilar and consumers can easily differentiate between them. So Applicant is rightfully entitled to the benefits under **Section 12** of the Act.”

(Italics supplied)

Having, thus, adopted a stand, before the Trade Marks Registry, that the plaintiff’s mark were completely distinct and different from the



mark of the defendant, Mr. Ramkumar submits that the plaintiff cannot, in these proceedings, adopt a contrary stance and plead confusing or deceptive similarity between the plaintiff’s and the defendant’s marks.

20. Mr. Ramkumar further submits that, even before the learned IPAB, the plaintiff suppressed the fact that it had issued a legal notice to the defendant on 21 July 2010. No copy of the said notice has been placed on record even with the plaint. The defendant, in its reply dated 10 August 2010 to the said notice, had adverted to the fact that

the application, of the defendant, for registration of the  mark already stood advertised on 16 February 2010 in the Trade Marks Journal. In the said reply, the defendant had also underscored what, in its opinion, were the features which distinguished the defendant’s mark from those of the plaintiff.

21. Mr. Ramkumar further submits that the plaint does not trace the transfer of the rights in the asserted marks from Ritu Kapoor to the plaintiff-Company. He submits that there is no lawful assignment of the rights in the said mark from Ritu Kapoor to the plaintiff, as



required by the Trade Marks Act or, if there is, material in that regard is not forthcoming in the plaint. As such, he submits that the plaintiff cannot seek to derive benefit from the user of the ZENITH mark by Ritu Kapoor, or to the proprietorship or partnership “Zenith Dance Institute” prior to the incorporation of the plaintiff.

22. In support of his submissions, Mr. Ramkumar has placed reliance on the following judgments of this Court:

- (i) para 12 of *Kisan Industries v. Punjab Food Corporation*²,
- (ii) *Shri Gopal Engineering & Chemical Works v. POMX Laboratories*³,
- (iii) para 9 of *Creative Travels (P) Ltd v. Creative Tours & Travels (P) Ltd*⁴,
- (iv) *S.K. Sachdeva v. Shri Educare Ltd.*⁵,
- (v) *Toyota Jidosha Kabushika Kaisha v. Deepak Mangal*⁶
and
- (vi) *Raman Kawatra v. K.E.I Industries Ltd*⁷.

Additionally, he relies on para 40 of *Essel Propack Ltd. v. Essel Kitchenware Ltd*⁸, rendered by a learned Single Judge of the High Court of Bombay.

Ms. Menon’s submissions in rejoinder

² AIR 1983 Del 387

³ AIR 1992 Del 302

⁴ ILR (2006) II Del 704

⁵ 2016 SCC OnLine Del 473

⁶ 2008 (43) PTC 161 (Del)

⁷ 296 (23) DLT 529

⁸ (2016) 66 PTC 173



23. In rejoinder, Ms. Menon points out, at the outset, that the order dated 1 May 2018 of the IPAB, whereby the plaintiff's challenge to the  mark of the defendant succeeded, had never been impugned by the defendant.

24. Insofar as the petitioner's reply dated 16 January 2016, to the FER dated 18 July 2015, apropos the plaintiff's application for registration of the ZENITH ARTS mark was concerned, Ms. Menon submits that the stand adopted in the said reply was in very general terms, and did not advert to any particular mark, including the particular cited mark of the defendant. She submits that, in such circumstances, the said response cannot disentitle her from pleading, in the present case, deceptive similarity of the impugned marks of the defendant, with the marks of the plaintiff. She cites, in this context, paras 14(O) to (W) and para 15, respectively, of the judgments of this Court in *Insecticides (India) Ltd v. Parijat Industries (India) Ltd*⁹ and *H & M Hennes & Mauritz AB v. H.M. Megabrand Pvt Ltd*¹⁰.

25. Ms. Menon submits that the user documents filed by the defendant with its written statement are, *ex facie*, unreliable. She submits that all the admission forms are handwritten, and there is no way of ascertaining when they were filled in or prepared. Insofar as the affidavits are concerned, she submits that the defendant has candidly acknowledged that the affidavits were prepared after the suit was filed. The affidavits, she submits, are merely self-serving in

⁹ 252 (2018) DLT 124

¹⁰ 251 (2018) DLT 651



nature and suffer from various discrepancies. Vis-à-vis individual affidavits and other evidence filed by the defendant, Ms. Menon seeks to underscore the following discrepant features:

(i) In the affidavit of Ms Nidhi Rana, the name of the defendant's Institute is reflected as "M/s Zenith Dancing and Music", whereas the admission form reflects the name as "Zenith Dancing Chanal & Arobics Classes" (spelt as such in the admission form).

(ii) The same infirmities plague the affidavit of Soniya Sharma, vis-à-vis her Admission Form. Besides, in the affidavit, the year since which Sanjay Sharma was purportedly known to her, and from which she started taking classes with "M/s Zenith Dancing and Music" is left blank.

(iii) Insofar as the photographs annexed to the affidavits of Brijesh Varshney and Vinay Chandra are concerned, Ms Menon points out that the photographs merely showed certain persons dancing, with no indication as to when the photograph was taken and no indication of the mark "Zenith" anywhere in the photograph. The photographs are, moreover, undated.

In fact, submits Ms. Menon, the only document of user, which can aspire at all to validity, is a Release Order dated 27 April 2006 issued to M/s Marketing Avenues, Vaishali, Ghaziabad, relating to release of the advertisements of the defendant. This document, however, she



submits, can be of no avail to the defendant, as the plaintiff's user is prior to 2006.

26. Having itself applied for registration of the  mark, Ms. Menon submits that the defendant cannot seek to contend that the mark ZENITH is ineligible for registration, on account of its being generic or for any other reason.

Analysis

I. The plea of estoppel, based on the response dated 16 January 2016 of the plaintiff before the Trade Mark Registry, and its consequences

27. The first question to be addressed is whether, in view of the stand taken by the plaintiff in its response dated 16 January 2016, to the FER dated 18 September 2015, raised by the Trade Mark Registry against the plaintiff's application for registration of the word mark ZENITH ARTS, the plaintiff is estopped from pleading that the defendant's marks are deceptively similar to the registered trade marks of the plaintiff.

28. The recent decision of a Division Bench of this Court in *Raman Kawatra*⁷, in paras 43 to 46, clearly sets out the legal position in this regard:

“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*¹¹ (*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.*

45. Mr. Lall had contended that the aforesaid statement was not contrary to the stand in the suit. He submitted that a meaningful reading of the respondent's response to the Trade Marks Registry would indicate that the respondent's stand was that there was no likelihood of confusion since it was well-known that the word mark “KEI” was associated with the respondent's goods. Given the unambiguous statement as quoted above, the said contention is unsubstantial. *There is a clear assertion made by the respondent that its services are different to that of the cited marks. It is not open for the respondent to now claim that appellant's goods covered under the impugned trademark are similar to its goods and services.*

¹¹ (2019) 262 DLT 101



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.*”

(Emphasis supplied)

29. The enunciation of the law in paras 43 to 46 of *Raman Kawatra*⁷, in my considered opinion, applies *mutatis mutandis* to the facts of the present case. The case that the plaintiff seeks to make out, in the present plaint, is that, the use, by the defendant, of ZENITH as any part of its mark, would infringe the plaintiff’s registered device mark  and its registered word mark ZENITH ARTS.

30. Inasmuch as the plaintiff’s registered trade marks are not identical to the impugned marks of the defendant, and, as the plaintiff does not have any registration for the word mark ZENITH *per se*, a case of infringement can be made out by the plaintiff against the defendant only if the plaintiff can bring its case under Section 29(2)(b)¹² of the Trade Marks Act. Under this provision, the

¹² 29. **Infringement of registered trade marks. –**

(1) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which is identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark.



defendant's mark would infringe the plaintiff's registered marks if, owing to their similarity, in conjunction with the identity or similarity of the goods or services covered by the said marks, the public is likely to be confused or believe an association between the defendant's mark and the plaintiff's registered marks.

31. The plaintiff seeks to contend that "Zenith" constitutes the most essential feature of both its registered device mark  and the registered word mark ZENITH ARTS. If any person, therefore, uses a mark, of which "Zenith" is the prominent feature, for services which are the same or allied to the services rendered by the plaintiff, there would be likelihood of confusion.

32. To succeed in such a case, however, the law must permit the plaintiff to ventilate a stand that the defendant's mark is deceptively similar to the plaintiff's registered marks and that, owing to such similarity, likelihood of confusion or association, within the meaning of Section 29(2)(b) of the Trade Marks Act, can be said to exist. Section 29(2)(b) of the Trade Marks Act requires cumulative satisfaction of three ingredients; firstly, similarity of the plaintiff's and the defendant's marks, secondly, identity or similarity of the goods or services covered by the rival marks and, thirdly, consequent likelihood

(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.



or confusion on the part of the public or of an association between the defendant's mark and the plaintiff's marks. The words "because of" in Section 29(2) are significant. It is only if the likelihood of confusion or association is *because of* the similarity between the plaintiff's and defendant's marks, and the identity or similarity of the goods or services covered by such marks, that the defendant's marks can be said to infringe the plaintiff's registered marks. In the absence of a *causal link* between the similarity between the rival marks and the identity or similarity of the goods or services provided under the rival marks, and the likelihood of confusion, deception or association, no case of infringement can be said to have been made out. The causal link has necessarily to be shown to exist.

33. The position of law, as enunciated in paras 43 to 46 of *Raman Kawatra*⁷, is crystal clear. If the impugned mark of the defendant is cited against the mark asserted in the plaint, at the time when the plaintiff applied for registration thereof, and the plaintiff, in order to obtain registration, pleaded that the two marks were not so similar as to result in likelihood of confusion or deception, then the plaintiff cannot, in infringement proceedings, seek to injunct the very same cited mark of the defendant by pleading that it *is* confusingly or deceptively similar to the plaintiff's mark. The reason is obvious. Registration is a *sine qua non* in any infringement action. Absent registration, no plaintiff can bring an action for infringement against the mark of another. If, therefore, the plaintiff has secured registration on the basis of a representation that the impugned mark of the defendant is dissimilar to the plaintiff's mark, the plaintiff cannot,



thereafter, use the very same registration as a ground to injunct the very same cited mark of the defendant as infringing, by pleading that it *is* confusingly or deceptively similar to the plaintiff's mark. Allowing the plaintiff to do so would be permitting approbate and reprobate, which the law proscribes. On the principle of approbate and reprobate, the Supreme Court observed thus, in ***Karam Kapahi v. Lal Chand Public Charitable Trust***¹³:

“49. The contentions of the Club cannot be accepted on another legal ground also. *It is clear that the Club has taken inconsistent pleas. On the one hand the Club alleged that the Trust is not its lessor and has no right to receive the lease rent and it questions the title of the Trust. On the other hand the Club is seeking the equitable remedy against forfeiture under Section 114 of the Transfer of Property Act where it has proceeded on the basis that the Trust is its lessor and the Club is the lessee and as a lessee it has to pay the lease rent to the Trust. Therefore, the Club seeks to approbate and reprobate.*

50. The phrase “approbate and reprobate” is borrowed from Scots law where it is used to express the common law principles of election, namely, that no party can accept and reject the same instrument.

54. This principle has also been explained by this Court in ***Nagubai Ammal v. B. Shama Rao***¹⁴. Speaking for a three-Judge Bench of this Court, Venkatarama Ayyar, J. stated in the Report :

“23. ... The doctrine of election is not however confined to instruments. A person cannot say at one time that a transaction is valid and thereby obtain some advantage, to which he could only be entitled on the footing that it is valid, and then turn round and say it is void for the purpose of securing some other advantage. That is to approbate and reprobate the transaction.

¹³ (2010) 4 SCC 753

¹⁴ AIR 1956 SC 593



It is clear from the above observations that the maxim that a person cannot ‘approve and reprobate’ is only one application of the doctrine of election....”

55. On the doctrine of election the learned Judge in *Nagubai Ammal*¹⁴ case has also referred to Halsbury's Laws of England (Vol. XIII, p. 464, Para 512) in which this principle of “approve and reprobate” has been described as a species of estoppel which seems to be “intermediate between estoppel by record and estoppel *in pais*” (p. 602, para 21 of the Report).”

(Emphasis supplied)

34. Besides, it would be illogical as well. Had the plaintiff admitted similarity between the impugned mark of the defendant (as it was cited as rival mark at the time of registration), and the asserted mark of the plaintiff, the asserted mark might never had proceeded to registration. If the asserted mark would not have proceeded to registration, no action for infringement against the defendant’s cited mark could have been brought by the plaintiff at all. At the cost of repetition, therefore, the plaintiff cannot, having obtained secured registration of the asserted mark by pleading dissimilarity with the impugned mark of the defendant, execute a *volte face* and bring an infringement action against the very same mark of the defendant, pleading deceptive similarity for the said purpose.

35. In the present case, the defendant’s  mark was set up as a rival mark to the ZENITH ARTS word mark of the plaintiff, of which the plaintiff sought registration, under Section 11(1) of the Trade Marks Act. The plaintiff’s clear case, in its response to the FER, was that the defendant’s  mark was (i) “visually and identically



different from the plaintiff's ZENITH ARTS mark", (ii) there was no "structural and visual resemblance" between the two marks and (iii) there was, therefore, "no chance of misleading and/or deception" between the two marks.

36. The submission of Ms. Menon that the said statement had been made in a generalized or omnibus fashion, covering all the marks which were cited as rival marks under Section 11(1) in the FER, and

not particularly with respect to the defendant's  mark, obviously cannot pass muster. The law cannot differentiate between a situation in which the plaintiff, in its response to the FER, pleads dissimilarity between the mark, of which registration is sought, and each of the individual cited rival marks, and where it pleads dissimilarity vis-à-vis *all* the cited marks. The legal effect of the two assertions is obviously the same.

37. That being so, it is clearly not open to the plaintiff, in the

present proceedings, to plead that, because of the use of the  mark by the defendant, there is likelihood of confusion or deception,

or of an association, between the  mark of the defendant and the ZENITH ARTS mark of the plaintiff. In other words, it is not open to

the plaintiff to plead that the  mark of the defendant is confusingly or deceptively similar to the ZENITH ARTS word mark of the plaintiff.



38. The plea of confusing or deceptive similarity of the  mark of the defendant, and the ZENITH ARTS word mark of the plaintiff has, therefore, to be rejected.

39. The next question to be addressed is, however, the extent to which the aforesaid estoppel would apply. The principles enunciated in *Raman Kawatra*⁷ would estop the plaintiff only from pleading that

the  logo of the defendant is confusingly or deceptively similar to the ZENITH ARTS registered trade mark of the plaintiff. The reason is not because of any actual similarity or dissimilarity between the two marks, but because, having obtained registration of the ZENITH ARTS mark by pleading dissimilarity vis-à-vis the

defendant's  mark, the plaintiff cannot now seek to injunct the use of the  mark on the ground that it is confusingly or deceptively similar to the ZENITH ARTS mark of the plaintiff. The principle being a principle of estoppel, has to be restricted to its legitimate boundaries. The estoppel belongs to the genre of estoppel *in pais*, or equitable estoppel. In *State of Punjab v. Dhanjit Singh Sandhu*¹⁵, the doctrine of estoppel *in pais* was stated to be a “rule of equity”, by which a person may be precluded, by way of his actions, or conduct, or silence when he has to speak, from asserting a right which he would have otherwise had”. In practical terms, if an

¹⁵ (2014) 15 SCC 144



applicant seeks to register mark A, and pleads, to obtain registration, that mark A is dissimilar to a cited mark B of the defendant, then, having obtained registration, the applicant stands estopped, in future, from contending *that mark B is, in fact, similar to mark A*. The estoppel can extend only to this extent. It cannot envelop any other marks X, Y or Z, be they of the plaintiff or the defendant.

40. It is very important to note this distinction, as it would limit the extent to which the assertions before the Trade Marks Registry estop it in the present proceedings. At the cost of repetition, the estoppel against the plaintiff would apply only to the extent of the right of the plaintiff to assert that the defendant's  mark is confusingly or deceptively similar, or infringes, the plaintiff's ZENITH ARTS registered mark. It cannot apply beyond that.

41. In other words, the stand adopted by the plaintiff in its reply dated 16 January 2016, to the FER dated 18 September 2015, cannot estop it from asserting the plea of infringement of the defendant's marks, or of the use, by the defendant, of "Zenith" *per se* as a part of its marks, of the registered  device mark of the plaintiff.

II. The aspect of confusing or deceptive similarity

42. Mr. Ramkumar sought to contend that, when seen as a whole, the logos of the defendant could not be regarded as confusingly or deceptively similar to the  device mark of the plaintiff. He has



pointed out that, moreover, the defendant now adopts new logos, i.e.,



and



, which are even more dissimilar to the

plaintiff's registered  device mark.

43. The submission fails to convince. There can be no gainsaying that the prominent feature of the plaintiff's device marks, as well as of the logo, is the word "ZENITH". In such a case, the added matter, in the form of the other features of the respective device marks/logos would recede into the background, and cannot disabuse the first confusing impression that would be created. The issue is no longer *res integra*. One may borrow a leaf, in this regard, from **K. R. Chinna Krishna Chettiar v. Sri Ambal & Co.**¹⁶. In **K. R. Chinna Krishna Chettiar**¹⁶, the Supreme Court was concerned with two device marks, which were completely dissimilar to each other, one of which had, as its prominent feature, the words "Sri Ambal" and the other, the words "Sri Andal". The two marks were described thus, in para 1 of the decision:

"Trade Mark No. 126208 consists of a label containing a device of a goddess Sri Ambal seated on a globe floating on water enclosed in a circular frame with the legend "Sri Ambal parimala snuff" at the top of the label, and the name and address "Sri Ambal and Co., Madras" at the bottom. Trade mark No. 146291 consists of the expression "Sri Ambal". The mark of which the appellant seeks registration consists of a label containing three panels. The first and the third panels contain in Tamil, Devanagri, Telgu and Kannada the equivalents of the words "Sri Andal Madras Snuff". The centre panel contains the picture of goddess Sri Andal and the legend "Sri Andal"."

¹⁶ (1969) 2 SCC 131



Dealing with the aspect of similarity between the marks, the Supreme Court held thus:

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

6. The vital question in issue is whether, if the appellant's mark is used in a normal and fair manner in connection with the snuff and if similarly fair and normal user is assumed of the existing registered marks, will there be such a likelihood of deception that the mark ought not to be allowed to be registered (see *In the matter of Broadhead's Application*¹⁷ for registration of a trade mark). It is for the court to decide the question on a comparison of the competing marks as a whole and their distinctive and essential features. *We have no doubt in our mind that if the proposed mark is used in a normal and fair manner the mark would come to be known by its distinguishing feature “Andal”. There is a striking similarity and affinity of sound between the words “Andal” and “Ambal”.* Giving due weight to the judgment of the Registrar and bearing in mind the conclusions of the learned Single Judge and the Divisional Bench, *we are satisfied that there is a real danger of confusion between the two marks.*

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

8. In the case of *Coca-Cola Co. of Canada v. Pepsi-Cola Co. of Canada Ltd.*¹⁸ it was found that cola was in common use in Canada for naming the beverages. The distinguishing feature of the mark Coca Cola was coca and not cola. For the same reason the distinguishing feature of the mark Pepsi Cola was Pepsi and not cola. It was not likely that any one would confuse the word Pepsi with Coca. In the present case the word “Sri” may be regarded as in common use. The distinguishing feature of the respondent's

¹⁷ (1950) 57 RPC 209, 214

¹⁸ 1942 59 RPC 127



mark is Ambal while that of the appellant's mark is Andal. The two words are deceptively similar in sound.

9. *The name Andal does not cease to be deceptively similar because it is used in conjunction with a pictorial device.* The case of *De Cordova v. Vick Chemical Co.*¹⁹ is instructive. From the appendix printed at p. 270 of the same volume it appears that Vick Chemical Company were the proprietors of the registered trade mark consisting of the word “Vaporub” and another registered trade mark consisting of a design of which the words “Vicks Vaporub Salve” formed a part. The appendix at p. 226 shows that the defendants advertised their ointment as “Karsote Vapour Rub”. It was held that the defendants had infringed the registered marks. Lord Radcliffe said: “... a mark is infringed by another trader if, even without using the whole of it upon or in connection with his goods, he uses one or more of its essential features”.”

(Emphasis supplied)

Both marks were used for snuff. The Supreme Court held that words “Ambal” and “Andal” being phonetically strikingly similar, the Sri Andal mark had to be regarded as deceptively similar to the Sri Ambal mark, resulting in likelihood of confusion if both marks were allowed to be registered, though visually the two marks were completely dissimilar, as is specifically noted in the judgment. The Supreme Court held that once the prominent feature of the two marks i.e. “Sri Ambal” in one case and “Sri Andal” in the other case were confusingly similar, the added matter in the form of the images surrounding the marks and forming part of the entire device marks would not detract from the confusing effect initially created.

44. Applying the said principle to the present case, as “Zenith” is the prominent and defining feature of the plaintiff’s marks as well as the defendant’s marks, which stands out in sharp relief and imprints

¹⁹ 1951 68 RPC 103



itself on the psyche of the customer of average intelligence and imperfect recollection, the mere fact that the overall design and layout of the two marks may be different, cannot efface the possibility of confusion. The Court has, moreover, to be conscious of the fact that, in this day and age, changing of logos and pictorial representations of marks is standard commercial practice, and is often used as part of market strategy, to impart novelty to the mark. Marks which have continued for long periods of time and which may, therefore, have created, in the average viewer, a sense of ennui, are often altered or made more attractive so as to replace the feeling of ennui with interest in what appears to be something novel. The pictorial characteristics of a device mark or logo can, therefore, in the present case, matter only so much and no more. If the principle defining feature of two marks, such as the name of the two marks, is the same, or is confusingly similar, the fact that the two marks may be visually distinct from each other may not be of much relevance when one examines the aspect of infringement.

45. In the present case, the word “Zenith” is the distinctive feature of both the plaintiff’s and the defendant’s marks. Both marks are used for providing education in dance. There is bound, therefore, to be also a customer overlap in the marks of the plaintiff and the defendant. The use of “Zenith” as part of the mark of the defendant is bound, therefore, to create confusion in the mind of a customer of average intelligence and imperfect recollection.



46. There is yet another important feature of the defendant's mark in the present case, which may exacerbate the possibility of confusion.

The  “ZD” logo forms a distinctive part of the overall



device mark which was invalidated by the learned IPAB by order dated 1 May 2018. The defendant, however, continues to use the

same “ZD” logo, albeit in different colours, in its later  and



marks. Having already suffered a decision, from the IPAB,

that the device mark  was invalid as being deceptively similar to the plaintiff's marks, it was incumbent on the defendant, while fashioning new marks, to maintain a distance from the plaintiff's marks, and not to include, therein, any prominent feature of the invalidated mark. By continuing to use the “ZD” logo which was a

prominent feature of the invalidated  device mark in its  and

and  marks, the defendant has exposed its later device marks/logos to vulnerability on the ground of infringement.

III. Is “Zenith” incapable of registration as a “common English word”?

47. Mr. Ramkumar sought to contend that “Zenith” was *publici juris*, and a common English expression, over which the plaintiff could not claim a monopoly. This submission, too, has merely to be stated, to be rejected. As Ms. Menon correctly contends, in the context of services relating to education in dance, “Zenith” cannot be



regarded as *publici juris* or as descriptive of the services provided. The Trade Marks act does not contain any absolute proscription against use of common English expressions as trade marks. The proscription attaches only where the expression in question is such as would not suffice to distinguish the goods or services in respect of which it is used from the goods or services of another. That is the expression which is expressly engrafted into Section 9(1)(a)²⁰ of the Trade Marks Act. Marks which are devoid of any distinctive character are absolutely proscribed from registration under Section 9(1)(a). However, the clause explains the expression “which are devoid of any distinctive character” as “not capable of distinguishing the goods or services of one person from those of another”. In order, therefore, to hold that a mark ought not to have been registered as it is a common English word, it would further have to be observed that the common English words was so common, or was otherwise so devoid of any distinctive character that, when applied to any particular goods or services, it would not suffice to distinguish those goods or services from the goods or services of another. For example, it might not be possible to register, as a trade mark, the word mark “is”, or “this”, or “that”, as these words are inherently incapable of distinguishing the goods of one person from those of another, unless they are entitled to the benefit of the proviso to Section 9(1)²¹.

²⁰ 9. **Absolute grounds for refusal of registration.** –

- (1) The trade marks –
 (a) which are devoid of any distinctive character, that is to say, not capable of distinguishing the goods or services of one person from those of another person;

shall not be registered:

Provided that a trade mark shall not be refused registration if before the date of application for registration it has acquired a distinctive character as a result of the use made of it or is a well-known trade mark.

²¹ As, I am informed by some members of the Bar in Court, the mark “AND” stands registered in respect of a luxury perfume brand!



48. Viewed thus, it can hardly be said that the word “Zenith”, when used as a mark in the context of providing services in respect of dance education, is incapable of distinguishing such services from the services provided by another. Plainly put, the word “Zenith” in the name “Zenith Dance Institute” is certainly one as would impress itself on the psyche of a customer, or a client, of average intelligence and imperfect recollection. It cannot, therefore, be treated as a mark which is lacking in distinctive character, such as to disentitle itself to any claim to monopoly.

49. Mr. Ramkumar’s submission that “ZENITH” being a word of common usage, the plaintiff cannot claim monopoly over it, cannot, therefore, sustain.

IV. User

50. The next issue to be addressed is that of user. The plaintiff claims user of its mark since 1997. Ms. Menon was candid in her submission that she does not have, with her, any evidence of use of the word “ZENITH”, even as part of trade name of the plaintiff, circa 1997. She has, however, placed on record a certificate dated 23 March 2022, issued by the ICICI Bank, which certifies that “Zenith Dance Institute” was maintaining a Current Account with the Mayur Vihar Branch of the ICICI Bank since 11 December 1999. This indicates, *prima facie*, that, at least from 11 December 1999, the plaintiff was operating under the moniker “Zenith Dance Institute”.



51. Ms. Menon has also relied, during her submissions, on several documents which have been placed on record by the defendant, which vouchsafe the use, by the plaintiff, of the name “Zenith Dance Institute” from 2002 to 2014. Some of these have been captured in para 15 *supra*.

52. These documents, too, corroborate Ms. Menon’s contention that, from 2002 till 2014, there is *prima facie* evidence of use, by the plaintiff, of “Zenith” as a part of its mark.

53. As against this, the material placed on record by the defendant, to indicate use, by the defendant, of “Zenith”, as part of its mark/name, since 1999, commands very little confidence. The admission forms of students, placed on record, have been entered in hand. The supportive affidavits filed by two of the students, namely, Nidhi Rana and Soniya Sharma, suffer from rank discrepancies, as has been pointed out by Ms. Menon and noticed in para 26 *supra*.

54. A glance at the certificates and the admission forms purportedly issued by the defendant to Nidhi Rana and Soniya Sharma indicate that the name of the institution is noted as “Zenith Dancing Chanal & Arobics Classes”. It is hard to believe that an institution would, on its standard admission forms, make such errors even in the name of the institution as printed on the forms. The watermark on the forms spells “Zenith” as “ZANITH”. These discrepant features, seen in conjunction, cast a serious cloud on the veracity and genuineness of



the admission forms on which Mr. Ramkumar places reliance. The discomfiture of the court is accentuated when one reads the affidavits filed in support of the admission forms. In both the affidavits of Nidhi Rana and Soniya Sharma, the name of the institute is wrongly stated as “Zenith Dancing and Music”. In the affidavit of Soniya Sharma, the date from which she purportedly took admission in the defendant’s institute is itself blank, resulting in the affidavit being worth nothing.

55. The defendant has also placed on record certain photographs, with accompanying affidavits of persons who purportedly organized events in which Sanjay Sharma and his students participated, under the “Zenith Dancing Channel”. The photographs, however, do not reveal any such thing. There is no reference, anywhere in the photographs, to “ZENITH”. They are merely photographs of certain boys and girls dancing, and one cannot make out, from the photographs, when they were taken, where they were taken or the identities of the dancers in the photographs. None of the photographs contain “Zenith”.

56. Moreover, and perhaps most damagingly, all the affidavits relied upon by the defendant, have been prepared after the suit was filed and instituted before this Court by the plaintiff. Their evidentiary value stands, *prima facie*, considerably denuded even on this sole ground.

57. The Court is constrained, in these circumstances, to express a *prima facie* view that the affidavits and accompanying documents



filed by the defendant to vouchsafe user of the impugned marks are afterthoughts, hurriedly created and put together, merely to embellish the case of the defendant with some documentary support. No *prima facie* worth or value can be attached to them.

58. Resultantly, the plea of Ms. Menon that, the plaintiff enjoys priority of user of the asserted  mark and the registered word mark ZENITH ARTS, *vis-à-vis* the defendant, merits acceptance. The result is that the user, by the plaintiff, of the  device marks stand *prima facie* vouchsafed since 1999 at least. The only credible document placed by the defendant on record with respect to user is the release order dated 27 April 2006 placed on Marketing Avenues, Ghaziabad. The plaintiff's user, however, in any case, predates 2006, so that the plaintiff clearly enjoys priority of user of its marks *vis-à-vis* the defendant. The result is that, w.e.f. 7 June 2007, when the device mark  stands registered in favour of the plaintiff's predecessor-in-interest, the use, by the defendant, of "ZENITH" as part of its mark/trade name, for providing dance services, or services relating to dance education, is infringing in nature.

V. Chain of title of the plaintiff

59. Mr. Ramkumar also sought to contend that the plaintiff did not set out the exact chain through which the intellectual property rights, in the  mark, passed on to the plaintiff. At a *prima facie* stage, this contention does not merit acceptance. The plaintiff has averred,



on affidavit, that the “ZENITH” mark was devised by Ritu Kapoor in 2007, who, in 2009, started a proprietorship under the name “Zenith Dance Institute”, which was successively converted into a partnership and a private limited company. The material available, even as placed on record by the defendant, indicates that, even after the incorporation of the said company in 2005, communication continued to be addressed to “Ritu”. At a *prima facie* stage, therefore, this Court is inclined to extend, to the plaintiff, the benefit of user, by Ritu Kapoor, of ZENITH as a part of the mark of the institute which she was running i.e., “Zenith Dance Institute”, at least w.e.f. 1999.

VI. Judgments cited by Mr. Ramkumar

60. Para 40 of *Kisan Industries*² merely observes that, to succeed in an application for temporary injunction, the plaintiff has to establish priority of user. On facts, I have already found, in the present case, that the plaintiff has, *prima facie*, done so. *Shri Gopal Engineering*³ and *Toyota Jidosha Kabushiki Kaisha*⁶, rendered by learned Single Judges of this Court, rejected the prayer for interlocutory injunction in view of trade mark infringement solely on the ground of delay. That view can no longer sustain, in view of the following exordium, to be found in *Midas Hygiene Industries (P) Ltd v. Sudhir Bhatia*²²:

“5. The law on the subject is well settled. In cases of infringement either of trade mark or of copyright, normally an injunction must follow. Mere delay in bringing action is not sufficient to defeat grant of injunction in such cases. The grant of injunction also becomes necessary if it *prima facie* appears that the adoption of the mark was itself dishonest.”

²² (2004) 3 SCC 90



61. The decision in *Essel Propack*⁸, rendered by a learned Single Judge of the High Court of Bombay, proceeds on the principle of acquiescence. Acquiescence operates as a fetter to an injunction even against an infringing trade mark, provided the conditions envisaged, in that regard, by Section 33²³ of the Trade Marks Act, apply. Section 33 envisages 5 years' continuous acquiescence, by the holder of a registered trade mark, to the use of an infringing mark by the another, from the date of acquiring knowledge of the infringement. Mr. Srikumar has sought to contend that the plaintiff cannot plead ignorance of the defendant's marks at least after 21 July 2010, when the plaintiff addressed a legal notice to the defendant. In view of the fact that, within 5 years of that date, rectification proceedings, under Section 57 of the Trade Marks Act, were initiated in May 2014, Section 33 cannot come to the aid of the defendant.

62. Even otherwise, it is trite that acquiescence, in the violation of one's legal rights by another, is not to be lightly assumed. The Trade Marks Act does not delineate the contours of what would constitute "acquiescence", for the purposes of Section 33. On "acquiescence", the Supreme Court held, in *State of Punjab v. Davinder Pal Singh Bhullar*²⁴, thus:

²³ 33. **Effect of acquiescence.** –
 (1) Where the proprietor of an earlier trade mark has acquiesced for a continuous period of five years in the use of a registered trade mark, being aware of that use, he shall no longer be entitled on the basis of that earlier trade mark –
 (a) to apply for a declaration that the registration of the later trade mark is invalid,
 or
 (b) to oppose the use of the later trade mark in relation to the goods or services in relation to which it has been so used,
 unless the registration of the later trade mark was not applied in good faith.

²⁴ (2011) 14 SCC 770



“39. In *Power Control Appliances v. Sumeet Machines (P) Ltd.*²⁵ this Court held as under :

“26. Acquiescence is sitting by, when another is invading the rights.... *It is a course of conduct inconsistent with the claim.... It implies positive acts; not merely silence or inaction such as involved in laches. ... The acquiescence must be such as to lead to the inference of a licence sufficient to create a new right in the defendant....*”

40. Inaction in every case does not lead to an inference of implied consent or acquiescence as has been held by this Court in *P. John Chandy & Co. (P) Ltd. v. John P. Thomas*²⁶. Thus, the Court has to examine the facts and circumstances in an individual case.”

The facts of the present case do not convince me, at least *prima facie*, that the plaintiff must be taken to have acquiesced, by conduct, in the infringement of its rights by the defendant, as to entitle the defendant to the benefit of Section 33.

63. *S.K. Sachdeva*⁵ is on the principle of the entitlement, of a plaintiff, to interlocutory reliefs if it suppresses material facts from the Court. In view of the above discussion, further need to refer to this decision stands obviated.

Conclusion

64. Resultantly, the plaintiff is entitled to interlocutory injunction as sought, as the defendant’s marks infringe the registered  of the plaintiff, within the meaning of Section 29(2)(b) of the Trade Marks Act.

²⁵ (1994) 2 SCC 448

²⁶ (2002) 5 SCC 90



65. The *ad interim* injunction granted by this Court on 22 January 2021 is, therefore, made absolute pending disposal of the present suit.

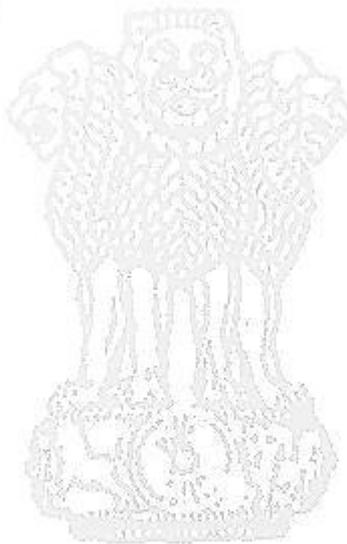
66. IA 1114/2021 is accordingly allowed, and IA 3851/2022 is dismissed.

C. HARI SHANKAR, J.

JULY 18, 2023

dsn

HIGH COURT OF DELHI



सत्यमेव जयते