



IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
IN ITS COMMERCIAL DIVISION

INTERIM APPLICATION NO. 3888 OF 2022
IN
COMMERCIAL IP SUIT NO. 422 OF 2022

- | | | |
|--|---|------------------------------|
| 1) GRASIM INDUSTRIES LIMITED, |] | |
| a company incorporated under the Gwalior |] | |
| Companies Act (1 of Samvat 1963) and at |] | |
| present governed by the Companies Act, |] | |
| 2013 and having its corporate office |] | |
| /principal office at Aditya Birla Centre, "A" |] | |
| Wing, 2 nd Floor, S.K. Ahire Marg, Worli, |] | |
| Mumbai 400030. |] | |
| |] | |
| 2) ULTRATECH CEMENT LIMITED, |] | |
| a company incorporated under the Indian |] | |
| Companies Act, 1956 having its registered |] | |
| office at Ahura Centre, B wing, 2nd Floor, |] | |
| Mahakali Caves Road, Andheri (East), |] | |
| Mumbai 400093 |] | <u>...Applicants.</u> |

In the matter between :

- | | | |
|--|---|------------------------------|
| 1) GRASIM INDUSTRIES LIMITED, |] | |
| a company incorporated under the Gwalior |] | |
| Companies Act (1 of Samvat 1963) and at |] | |
| present governed by the Companies Act, |] | |
| 2013 and having its corporate office |] | |
| /principal office at Aditya Birla Centre, "A" |] | |
| Wing, 2 nd Floor, S.K. Ahire Marg, Worli, |] | |
| Mumbai 400030. |] | |
| |] | |
| 2) ULTRATECH CEMENT LIMITED, |] | |
| a company incorporated under the Indian |] | |
| Companies Act, 1956 having its registered |] | |
| office at Ahura Centre, B wing, 2nd Floor, |] | |
| Mahakali Caves Road, Andheri (East), |] | |
| Mumbai 400093 |] | <u>...Plaintiffs.</u> |

Versus

- | | | |
|----|--|---|
| 1) | SABOO TOR PRIVATE LIMITED |] |
| | a company incorporated under the |] |
| | provisions of the Companies Act 1956 |] |
| | having its registered office at Trilokpur |] |
| | Road, Kala Amb, Sirmour, |] |
| | Himachal Pradesh-173030 |] |
| 2) | BIRLA STEELS (Now BIHAR INFRA STEELS |] |
| | CORPORATIONS) |] |
| | a partnership firm having its address at |] |
| | 1 st Floor, Suprabhat Building, |] |
| | CEAT Compound, Exhibition Road, |] |
| | Patna, Bihar-800001 |] |
| 3) | RAVI PODDAR |] |
| | Partner of Defendant No.2, |] |
| | having his address at Poddar Palace, |] |
| | Jawaharlal Road, Muzaffarpur, |] |
| | Bihar 842001. |] |
| 4) | BIRLA MEDICARE PRIVATE LIMITED, |] |
| | a company incorporated under |] |
| | the provisions of the Companies Act 2013 |] |
| | having its registered office at |] |
| | House no. 17, Sector 4, Panchkula, |] |
| | Himachal Pradesh-134112 |] |
| 5) | BIRLA BIOTECH PRIVATE LIMITED, |] |
| | a company incorporated under |] |
| | the provisions of the Companies Act 2013 |] |
| | having its registered office at |] |
| | House no. 12, Sector 2, Panchkula, |] |
| | Himachal Pradesh-134112 |] |
| 6) | PAWAN KUMAR, |] |
| | Director of Defendant No.1, and having his |] |
| | address at Trilokpur Road, Kala Amb, |] |
| | Sirmour, Himachal Pradesh-173030 |] |
- ...Defendants.**

- *Dr. Veerendra Tulzapurkar, Senior Advocate along with Mr. Hiren Kamod, Mr. Vinod Bhagat, Mr. Anees Patel, Ms. Prachi Shah, Siddhant Gupta for the Plaintiffs.*
- *Mr. Ravi Kadam, Senior Advocate along with Mr. Ashish Kamat, Senior Advocate, Mr. Thomas George, Mr. Rohan Kadam, Ms. Tanvi Sinha, Mr. Navankur Pathak, Mr. Aasheesh Gupta, Ravi Varma, Ms. Neeti Nihal and*

*Ms. Bargavi Baradhwaj i/by Saikrishna & Associates for the Defendants
Nos.1,4,5 and 6.*

Coram: Sharmila U. Deshmukh, J.

Reserved on: August 14, 2025.

**Pronounced on: October 16, 2025.
[Through Video conferencing].**

Uploaded on: October 16, 2025.

Judgment :

1. This is an action for infringement of trade mark and passing off under the Trade Marks Act, 1999 [for short, ***"Trade Marks Act"***]
2. The case as pleaded in the plaint is that the Plaintiff No.1 is the flagship company of global conglomerate Aditya Birla Group. The Plaintiff No.1 is stated to have commenced its business in the year 1947 in textiles and later diversified in various business under **"BIRLA"** and Birla formative marks. The Plaintiffs claim that by virtue of internal business arrangement, only the Birla family group of companies owned or managed by Birla family are entitled to adoption and/or use of the well known trade mark **"BIRLA"** either standalone or in conjunction with other mark. It is stated that one such mark is Aditya Birla Group word mark and logo which was adopted in the year 1996 in multiple classes and has been used in conjunction with other **"BIRLA"** marks. The Aditya Birla Management Corporation Pvt Ltd maintains the website with the domain name www.birlawhite.com since 1st November,1999.

3. The plaint sets out at Exhibit-"A" 112 registrations of "**BIRLA**" trademarks secured in various classes. It is stated that under a scheme of arrangement in nature of demerger, the trade mark "**BIRLA WHITE**" which was registered in favour of Indian Rayon and Industries Ltd in the year 1999 with user claim since the year 1988 came to be transferred to Plaintiff No.1 along with the goodwill and the Plaintiff No.1 came to be registered as the subsequent proprietor of the trade mark "**BIRLA WHITE**" in Class-19. The plaint sets out the list of international registrations of "**BIRLA**" trade marks at Exhibit "D".

4. To demonstrate the goodwill and reputation achieved by the Plaintiffs under its registered trade marks, the plaint sets out various awards and recognition bestowed upon the Plaintiffs, the specimen advertisement and sales and promotional material. The trademark "**BIRLA**" is claimed to have acquired the status of a well known trade mark as contemplated under the Trade Marks Act.

5. It is submitted that the Plaintiffs became aware of the Defendant No.1's existence on or around 27th November 2021 upon receipt of legal notice from Defendant Nos.2 and 3 alleging commission of fraud, cheating, extortion, misrepresentation etc. The notice alleged that relying on false representation and on strength of alleged consent letter issued by Birla family group authorising the Defendant No.1 to adopt and use the impugned mark "**BIRLA**" and

“BIRLA TMT” and sell franchises, the Defendant No.2 acted as franchisee of Defendant No.1.

6. It is submitted that the Plaintiff No.1 caused search on the internet when it came across the website of Defendant No.1 under the impugned domain name, viz., www.birlatmtsteel.com and www.birlaebike.com. The registration of Defendant No.1's trade mark is assailed as fraudulent as the impugned trademarks and domain names are visually, structurally and phonetically identical to the Plaintiff's prior adopted and well known **“BIRLA”** trade mark. Rectification applications have been filed by the Plaintiffs for cancellation of the impugned marks.

7. The Plaintiff's claim of infringement of its registered mark is also by reason of incorporation of companies by the name Birla Medicare Private Limited and Birla Biotech Private Limited by the Defendant No.6 and other Directors claiming that the same is with the intention to trade upon the goodwill and reputation of Plaintiffs and Aditya Birla Group.

8. By its reply Affidavits, the defence of the Defendant No.1 is that being the registered proprietor, the right to sue for infringement cannot be invoked against the Defendant No.1. It is contended that the Defendant No.1 is the registered proprietor of the impugned mark under Class-6 for iron and steel products and under Class-10, Class-11

and Class-18. It is stated that except Class-10, which registration application is also on proposed to be used basis, the Plaintiffs do not have registration in other classes. The Plaintiffs have not secured any registration for the standalone mark **"BIRLA"** and the registration secured is for word Birla in conjunction with other words.

9. It is stated that prior adoption and use of the impugned marks by the Defendant No.1 is since the year 2004. Since November, 2021, the Defendant No.1 has ventured into the business of selling and distributing e-bikes under the mark **"BIRLA E-Bikes"**. Due to floods in July, 2021, the office records of Defendant No.1 were washed away and efforts are being made to obtain records from the purchasers. The Defendant No.1 created the official website on 20th August, 2018. It is stated that prior adoption and user of the mark **"BIRLA TMT"** is highly fanciful and inherently distinctive coined word. It is also stated that the word Birla is common dictionary word.

10. The Defendant No.1 has placed on record the copies of Defendant No.1's specimen invoices, purchase orders, certificates of inspection evidencing the sale of products under its registered trade mark. It is stated that the Defendant No.1 has acquired reputation and goodwill as its products marketed under the trade marks **"BIRLA"** and **"BIRLA TMT"** are supplied to various departments of Himachal Pradesh and since the year 2018, the Defendant No.1 has entered into

various franchise agreements in various States and have more than 1000 distributors across the country. The advertisement expenses and sales figures have also been set out.

11. It is submitted that by reason of the massive advertisement and promotion of Defendant No.1's product under its registered trade mark on various renowned TV channels like NDTV, CNBC Awaz, Aaj Tak, ABP News, ZEE News etc, the Plaintiffs had complete knowledge and have acquiesced in the sale of Defendant's goods bearing the Defendant's mark.

12. It is submitted that the Defendant No.1 has initiated legal proceedings against the Defendant Nos.2 and 3 being C.S. No. 91 of 2022 and by order of 28th July 2022, the Defendant Nos.2 and 3 are restrained from using the trade mark **"BIRLA TMT"**.

13. The Defendant No.1 has contended that about 29 registrations have been secured by third parties using the word **"BIRLA"** and there are at least 84 corporate entities which use the word **"BIRLA"** as their corporate name. It is further submitted that present proceedings suffer from gross delay and laches as the Defendant No.1 has been openly and extensively using their trade mark **"BIRLA"** and **"BIRLA WHITE"** since the year 2004. It is further submitted that the Plaintiff and Defendant No.1 have common dealers and their products are sold through common trade channels. It is further submitted that the

Defendant No.1 and the Plaintiffs, both had filed opposition against the same trade mark applications seeking registration of the mark containing the word **"BIRLA"** and after more than two years thereafter, the present proceedings have been filed.

14. The Defendant Nos.2 and 3 have filed their affidavit-in-reply contending that in the year 2017, they were offered franchise by the Defendant No.6 on misrepresentation of being part of Birla group and subsequently it was realised that there was no association with the Birla group which led to issuance of legal notices and filing of court proceedings. In its additional affidavit-in-reply, the Defendant No.1 has set out the transactions with the Defendant No.3 and the subsequent dispute which arose leading to the institution of civil and criminal proceedings.

15. The Plaintiffs in their rejoinder affidavit have denied that the Defendant Nos.2 and 3 were induced to do business using the infringing mark and name **"BIRLA"** at the instance of the Defendant Nos.1 and 6 who made lucrative offers to the Defendant No.2. It is contended that the Defendant Nos.2 and 3 have acted in collusion with the Defendant No.1 in misusing the infringing trade mark **"BIRLA"** and the registration of mark in favour of the Defendant No.1 is fraudulent and illegal and liable to be cancelled.

16. The Defendant No.4 – Birla Medicare Private Limited has justified its incorporation using the word **“BIRLA”** by placing reliance on the authorisation given by Defendant No.1 who is the registered proprietor of word **“BIRLA”**. The affidavit of the Defendant No.5 repeats the contents of affidavit filed by Defendant No.4. The affidavit-in-reply of Defendant No.6 pleads misjoinder of parties and that the grievance in the suit is restricted against the Defendant Nos.1 to 5.

17. In its rejoinder Affidavit, the Plaintiffs have contended that there is no invoice / document produced by the Defendant No.1 to demonstrate the use of impugned **“BIRLA”** mark since the year 2004. There is not a single sale of impugned goods under the impugned **“BIRLA”** mark from 2008 till March 2021 and the invoices produced do not mention the impugned **“BIRLA”** mark. It is contended that the Defendant No.1's registrations have been fraudulently obtained with a view to ride upon the extensive goodwill and reputation of the Plaintiff by concealing the *factum* of prior adoption, use and registration of Plaintiff of their **“BIRLA”** mark and therefore this is a fit case for going beyond the validity of registration.

SUBMISSIONS:

18. Dr. Tulzapurkar, learned Senior Advocate appearing for the Plaintiffs submits that the Plaintiffs are the prior adopters and user of the **“BIRLA”** trade marks. He submits that infringement has occurred

as the essential feature of the Plaintiffs registered trade mark i.e. the word **"BIRLA"** has been copied and the added descriptive word by Defendant No.1 is immaterial. He submits that the Defendant No.1's adoption of the impugned trade marks is dishonest and contrary stands are taken by stating that the word Birla is common dictionary word and at the same time stating that the word Birla is inherently distinctive coined composite word mark. He submits that the Defendant No.1 having failed to conduct search of trade mark registry before adoption of its mark has done so at its own peril. He submits that the Defendant No.1 ought to have been aware of the goodwill and reputation of Plaintiffs **"BIRLA"** trade mark at the time of its adoption. He submits that as the impugned marks are deceptively similar, honesty in adoption is immaterial. He submits that the Defendant No.1 is a habitual infringer as it has obtained fraudulent registration of Jeendal Steel belonging to renowned third party.

19. He submits that the *Lupin* principles stand satisfied in the present case as the registration of the mark is violative of Section 11 of Trade Marks Act, 1999. He submits that as the registration is fraudulent, this Court can go into the aspect of infringement under Section 29 of Trade Marks Act, 1999 considering that rival marks are identical or deceptively similar. He submits that the fact that the Plaintiffs hold no registration for the **"BIRLA"** trade mark in Classes-6,

11 or 18 and its registration is under different class is immaterial considering the well settled position in law that classification are mere administrative guidelines. He submits that what is necessary to be considered are the nature of goods, the purpose for which goods are used and the trade channels and when so considered as the Defendants goods are TMT bars and Plaintiffs trade mark is registered in respect of building material, cement etc and there is trade connection between the two.

20. He submits that case of infringement is made out under Sub-Sections 1, 2(a) and 2(b) of Section 29 of Trade Marks Act. Without prejudice, he submits that even if it is accepted that the goods are dissimilar, case of infringement is made out under Section 29(4) of Trade Marks Act, 1999 as **“BIRLA”** is a well known trade mark. He submits that for infringement to result under Section 29(4), it is not necessary to demonstrate confusion.

21. Dr. Tulzapukar while addressing on the issue of passing off submits that the Plaintiffs have established the ingredients necessary for passing off as the sales figures, promotional material are all on record. He submits that by using an identical trade mark, the Defendant No.1 is misrepresenting that its goods bearing the impugned trade mark are the Plaintiffs goods. He submits that as on the date of commencement of use of the impugned trade mark from

2008, the net sales of the Plaintiffs amounted to INR 495 crores. He submits that the Defendant No.1 has not produced single document to show sales since the year 2004 or even from the year 2008 till the 2021. Pointing out to the invoices at Exhibit G-1 to G-192, he submits that the invoices does not mention the impugned mark **"BIRLA TMT"**. He submits that there are only three invoices from the year 2021 to 2022 in which the mark is reflected and is evidently superimposed. He submits that the Chartered Accountant's certificate by Defendant No.1 is not in respect of sales under the **"BIRLA"** marks but in respect of overall business.

22. He submits that the defence of delay and acquiescence is not available as the Plaintiffs became aware of the impugned marks only upon receipt of legal notice from Defendant Nos.2 and 3. He submits that mere delay will not come in the way of grant of injunction and the Defendant No.1's adoption of the impugned mark was with full knowledge of Plaintiff No.1's registration, the earliest being of the year 1990 with user claim of the year 1988. He submits that for acquiescence, there must be honesty in adoption of impugned mark and a positive act on the part of Plaintiffs and not mere failure to sue.

23. He submits that the existence of other third party infringers is no defence as it was necessary to establish extensive user by the third parties to prove that the mark is common to the trade. He submits that

the use by the Defendants of identical trade mark dilutes the Plaintiffs Birla trade marks and it is only in unusual circumstances that the balance of convenience comes into play.

24. In support, he relies upon the following decisions :

- ***Hiralal Parbhudas v Ganesh Trading Co.*¹**
- ***James Chadwick & Bros Ltd. v. The National Sewing Thread Co. Ltd.*²**
- ***Sabmiller India Ltd. v. Jagpin Breweries Ltd.*³**
- ***Reckitt & Colman of India Ltd. v. Wockhardt Ltd.*⁴**
- ***Ruston & Hornsby Ltd. v. Zamindara Engineering Co.*⁵**
- ***Eagle Potteries Pvt Ltd. v. Eagle Flask Industries Pvt. Ltd.*⁶**
- ***Bajaj Electricals Ltd, Bombay v. Metals & Allied Products, Bombay*⁷**
- ***Allied Auto Accesories Ltd. v. Allied Motors Pvt. Ltd.*⁸**
- ***FDC Ltd. v. Docsuggest Healthcare Services Pvt. Ltd.*⁹**
- ***Harish Motichand Sariya v. Ajanta India Ltd.*¹⁰**
- ***Ciba Ltd. Basle Switzerland v. M. Ramalingam*¹¹**
- ***Suzuki Motor v. Suzuki (India) Ltd.*¹²**
- ***Schering Corporation v. Kilitch Co. (Pharma) Pvt. Ltd.*¹³**
- ***Aktiebolaget Volvo of Sweden v. Volvo Steels Ltd. of Gujrat (India)*¹⁴**
- ***Cadila Pharmaceuticals Ltd. v. Sami Khatib of Mumbai*¹⁵**

1 1983 SCC OnLine Bom 284.

2 AIR 1951 Bom 147.

3 2014 SCC OnLine Bom 4842.

4 Appeal No. 1180 of 1991 In Notice of Motion No. 2141 of 1991 In Suit No. 2970 of 1991, decided on 8th July 1992.

5 (1969) 2 SCC 727.

6 1992 SCC OnLine Bom 490.

7 1987 SCC OnLine Bom 225.

8 2002 SCC OnLine Bom 1138.

9 2017 SCC OnLine Del 6381.

10 2003 SCC OnLine Bom 375.

11 1957 SCC OnLine Bom 45.

12 2019 SCC OnLine Del 9241.

13 1990 SCC OnLine Bom 425.

14 1997 SCC OnLine Bom 578.

15 2011 SCC OnLine Bom 484.

- ***RPG Enterprises Ltd. v. Riju Ghoshal*¹⁶**
- ***KSB Aktiengesellschaft v. KSB Real Estate and Finance Pvt. Ltd.*¹⁷**
- ***Kalpataru Properties Pvt. Ltd. v. Kalpataru Hospitality & Facility Management Services (P.) Ltd.*¹⁸**
- ***Rolex SA v. Alex Jewellery Pvt. Ltd.*¹⁹**
- ***Midas Hygiene Industries (P) Ltd. v. Sudhir Bhatia*²⁰**
- ***Bal Pharma Ltd. v. Centaur Laboratories Pvt. Ltd.*²¹**
- ***Anglo-French Drugs & Industries Ltd. v. Eisen Pharmaceutical Company Pvt. Ltd.*²²**
- ***Abdul Rasul Nurallah Virjee v. Regal Footwear*²³**
- ***Hindustan Pencils Pvt. Ltd. v. India Stationary Products Co.*²⁴**
- ***Pidilite Industries Ltd. v. S. M. Associates*²⁵**
- ***Medley Pharmaceuticals Ltd. v. Winsome Laboratories Ltd.*²⁶**
- ***Usha Kiran Jogani v. Albury Perfumes LLP*²⁷**
- ***National Bell Co. v. Metal Goods Mfg. Co. (P) Ltd.*²⁸**
- ***Lupin Ltd. v. Johnson and Johnson*²⁹**
- ***Pidilite Industries Ltd. v. Pom a-Ex Products*³⁰**
- ***Pidilite Industries Ltd. v. Riya Chemy*³¹**
- ***Kantilal Premji Maru v. Madan Kumar*³²**
- ***S. Syed Mohideen v. P. Sulochana Bai*³³**
- ***Kirloskar Diesel Recon Pvt. Ltd. v. Kirloskar Proprietary Ltd.*³⁴**

16 2022 SCC OnLine Bom 626.

17 Notice of Motion No. 4019 of 2007 In Suit No. 2930 of 2007, decided on 11-2-2008

18 2011 SCC OnLine Bom 987.

19 2014 SCC OnLine Del 1619.

20 (2004) 3 SCC 90.

21 2001 SCC OnLine Bom 1176.

22 1996 SCC OnLine Bom 580.

23 2023 SCC OnLine Bom 10.

24 1989 SCC OnLine Del 34.

25 2003 SCC OnLine Bom 143.

26 2008 SCC OnLine Bom 923.

27 IA No. 4054 of 2022 In COM IP Suit No. 209 of 2022.

28 (1970) 3 SCC 665.

29 2014 SCC OnLine Bom 4596.

30 2017 SCC OnLine Bom 7237.

31 2022 SCC OnLine Bom 5077.

32 2018 SCC OnLine Bom 21226.

33 (2016) 2 SCC 683.

- *Mahendra & Mahendra Paper Mills Ltd. v. Mahindra & Mahindra Ltd.*³⁵
- *Express Bottlers Services Pvt. Ltd. v. PepsiCo Inco.*³⁶

25. Mr. Kadam, learned Senior Advocate appearing for the Defendant Nos.1, 4, 5 and 6 submits that the Plaintiffs case is essentially based on the claim to the word **"BIRLA"** *per se* as being exclusively associated with them alone. He has taken this Court through the pleadings in the plaint and would submit that the plaint conveys a false impression of entitlement to Birla mark which is traced to the 19th century by pleading association with Birla family or Aditya Birla Group of Companies without any document on record. He submits that there is no document produced to demonstrate as to how the trade mark Birla has devolved from an individual Shivnarayan Birla to the Plaintiffs which are incorporate entities. He would further submit that invoices produced by the Plaintiffs are from the year 2009 and the domain registration in the year 1999 does not establish that it was in use since then. He submits that in view of the cloud over Plaintiff's own title, no interim relief can be granted without evidence being led.

26. He would further submit that the Defendant No.1 adopted its **"BIRLA TMT"** trade mark for TMT steel and mild steel products in

34 1995 SCC OnLine Bom 312.

35 (2002) 2 SCC 147.

36 1991 SCC OnLine Bom 549.

Class-6 in the year 2004 and the Plaintiffs does not manufacture or market these products. He would further point out extract of Hindi dictionary to contend that Birla is common Hindi word which means uniqueness and rarity. He would further point out the purchase orders, confirmation letters issued by distributors, invoices, ISO certificate issued on 28th December 2009 and the agreements executed since the year 2009 with Himachal Pradesh Government for supply of **“BIRLA TMT”** products, the inspection certificates issued by the Government Departments to show that since 2008, the goods were being sold by the Defendant No.1 under its registered mark. He submits that since the year 2004, the sales generated by Defendant No.1 is over Rs.1,560 crores.

27. He would further point out that the Defendant No.1's commercial honesty is established from the material on record and from the fact that the Defendant No.1 has openly advertised its **“BIRLA TMT”** mark and products across print media, radio, social media and national television. He submits that the Defendant No.1 has presence in 17 States and has more than 1000 dealers and distributors and have entered into various franchise agreements. He submits that the promotional material on record would demonstrate that the Defendant No.1 has never advertised or represented any connection with the plaintiffs and thus there is no representation.

28. He further submits that the Defendant No.1 being the registered proprietor of **"BIRLA"** trade mark, under Section 28(3) and Section 30(2)(e) of the Trade Marks Act, 1999 has the right to use its registered trade mark and the infringement under Section 29 of the Trade Marks Act, 1999 occurs only where the use is by an unregistered proprietor. He submits that Plaintiff's case for going beyond Defendant No.1's registration is firstly on the ground that Defendant No.1's registrations are *ex facie* illegal on the allegation that the Defendant No.1 has produced fabricated invoices in support of another trade mark application in Class-17 and secondly on the allegation that the Plaintiffs trade marks are prior adopted and well known **"BIRLA"** mark. He would submit that out of 112 trade mark registrations placed on record at Exhibit-"A" of the plaint, there is not a single trade mark registration in the class in which the Defendant No.1 has obtained registration. He submits that out of 112 trade mark registrations, only 20 registrations are prior to the Defendant No.1's registration and that too in Class-19 for white cement, cement putty, etc., He submits that it is well settled that the registration of trade mark *qua* certain goods in the class does not confer monopoly over the entire class of goods. He would further submit that the allegation of fabricated invoices submitted in support of pending trade mark application of 2016 cannot unsettle the trade mark registration granted in the year 2008. He

submits that the issue of fabricated invoices in pending registration application can be gone into by the Registrar.

29. Mr. Kadam would tender a convenience compilation which includes the annexures to the written statement and would point out the confirmation letters in favour of the Defendant No.1 certifying sale of the Defendant No.1's "**BIRLA TMT**" steel bar since the year 2008. He would further submit that Plaintiff's own statement while prosecuting and pursuing the registration of its "**BIRLA**" mark contains admissions which demolishes its case of exclusivity over "**BIRLA**" mark *per se* and points out to the stand taken by the Plaintiffs which is annexed to Defendant No.4's written statement. He points out that conflicting trade marks containing the word Birla were cited and in response the Plaintiffs made no claim to exclusivity but in fact accepted that the cited marks are wholly dissimilar notwithstanding the fact that the word Birla formed part thereof. He submits that while obtaining its registration, the Plaintiffs made no claim of prior user dating back to 19th century or any family arrangement, which is now sought to be raised in the present proceedings. He would, therefore invoke the doctrine of prosecution history estoppel to resist the claim of infringement. He submits that even if the documents were part of the written statement, it was open for the Plaintiffs to file replication to the written statement.

30. He would further submit that there are 29 third party trade mark proprietors using the mark Birla for their products and at least 113 pending trade mark applications. He would further submit that there are 84 corporate entities having no connection or association with Birla group which use Birla as part of their corporate name.

31. He would submit that Plaintiffs claim of the “**BIRLA**” mark being a well known trade mark is not supported by any documentary evidence and the orders relied upon have no evidentiary value as those are *ex parte* or interlocutory orders or consent decrees without any adjudication on the merits.

32. Mr. Kadam would further submit that for succeeding in an action for passing off, the existence of goodwill is requisite which is a question of fact to be proved by adducing cogent evidence. He submits that the relevant date for determining Plaintiff’s necessary reputation and goodwill is of year 2004 when the Defendant No.1 adopted its registered mark and at the highest the Plaintiffs have established the goodwill only from 2009. He submits that the promotional material on record is sufficient to establish that the Defendant No.1 has not even remotely misrepresented about its connection with the plaintiffs.

33. He would further submit that the Defendant Nos.2 and 3 are disgruntled franchisees and at no point of time, the Defendant No.1

misrepresented to the Defendant Nos.2 and 3 that it was associated or connected with Aditya Birla Group of Companies. He submits that the dispute between the Defendant No.2 and 3 has resulted in Court proceedings and as a counterblast, the present allegations are made.

34. Mr. Kadam would further submit that the Plaintiffs cannot claim to be unaware of the existence of Defendant No.1, considering the wide scale advertisement by the Defendant No.1 across national newspapers and television and in view of the fact that the Defendant No.1's mark was cited in opposition to the plaintiffs trade mark application in the year 2018. He submits that the Defendant No.1 has been permitted to build up its reputation and business through the use of "**BIRLA TMT**" mark which has been running since last 20 years and considering the sale turnover of over Rs.1,500 crores for the last 20 years, the balance of convenience is in favour of the Defendant No.1.

35. In support, he relies upon the following decisions :

- *Renaissance Hotel Holdings Inc. v. B. Vijaya Sai*³⁷
- *Nandhini Deluxe v. Karnataka Coop. Milk Producers Federation Ltd.*³⁸
- *Cipla Ltd. v. Cipla Industries Pvt. Ltd.*³⁹
- *Martin Burn Ltd. v. R N Banerjee*⁴⁰
- *Jagdish Prasad Patel v. Shivnath*⁴¹
- *Cadbury-Schweppes Pty. Ltd. v. The Pub Squash Co. Ltd.*⁴²

³⁷ (2022) 5 SCC 1.

³⁸ (2018) 9 SCC 183.

³⁹ 2017 (2) Mh.L.J. 877.

⁴⁰ AIR 1958 SC 79.

⁴¹ (2019) 6 SCC 82.

- ***Kores (India) Ltd. v. Khoday Eshwarsa & Son*⁴³**
- ***Amritdhara Pharmacy v. Satya Deo Gupta*⁴⁴**
- ***People Interactive (India) Pvt. Ltd. v. Vivek Pahwa*⁴⁵**
- ***Ramdev Food Products (P) Ltd. v. Arvindbhai Rambhai Patel*⁴⁶**
- ***Wander Ltd. v. Antox India P. Ltd*⁴⁷**
- ***Yoshima Boshaha Ka Sha Ltd. v. Dwarkadas Fatehchand*⁴⁸**
- ***Kamat Hotels (India) Ltd. v. R. O. H. Ltd.*⁴⁹**
- ***Essel Propack Ltd. v. Essel Kitchenware Ltd.*⁵⁰**
- ***Charak Pharmaceuticals (India) Ltd. v. Glenmark Pharmaceuticals Ltd.*⁵¹**
- ***S. S. Balu v. State of Kerala*⁵²**
- ***Unichem Laboratories Ltd. v. Ipca Laboratories Ltd.*⁵³**
- ***Medley Pharmaceuticals Ltd. v. Khandelwal laboratories Ltd.*⁵⁴**
- ***Medley Pharmaceuticals Ltd. v. Khandelwal Laboratories Ltd.*⁵⁵**
- ***Medley Pharmaceuticals Ltd. v. Khandelwal Laboratories Ltd.*⁵⁶**
- ***K E Burgmann A/S v. H N Shah*⁵⁷**
- ***Union of India v. Vasavi Coop. Housing Society Ltd.*⁵⁸**
- ***Vishnudas Trading v. Vazir Sultan Tobacco Ltd.*⁵⁹**
- ***PhonePe Pvt. Ltd. v. Resilient Innovations Pvt. Ltd.*⁶⁰**

42 1981 RPC 429.

43 1984 SCC OnLine Bom 65.

44 (1963) 2 SCR 484.

45 2016 SCC OnLine Bom 7351.

46 (2006) 8 SCC 726.

47 1990 (Supp) SCC 727.

48 AIR 1933 Sindh 26.

49 2011 (4) Mh.L.J. 71.

50 2016 SCC OnLine Bom 937.

51 MANU/ MH/ 0601/ 2007.

52 (2009) 2 SCC 479.

53 2011 SCC OnLine Bom 2114.

54 2005 SCC OnLine Bom 1160.

55 Appeal No. 1118 of 2005 In Notice of Motion No. 2808 of 2002 in Suit No. 3323 of 2002, dated 22nd December 2005.

56 SLP (C) No. 5004 of 2006.

57 2011 (124) PTC 526.

58 (2014) 2 SCC 269.

59 (1997) 4 SCC 201.

60 2023 SCC OnLine Bom 764.

- ***Shantapa v. Anna***⁶¹

36. In rejoinder, Dr. Tulzapurkar would submit that the convenience compilation tendered by the Defendant No.1 includes documents which are part of the written statement and cannot be considered as the plaintiffs had no opportunity to deal with the same. He submits that on 29th September 2022, the affidavit-in-reply was filed to which rejoinder was filed on 11th November 2022 and sur-rejoinder was filed on 30th November 2022. He submits that on 4th February 2023, the Defendant No.1 filed additional reply and the written statement was filed on 22nd March 2024. He submits that documents forming part of the convenience compilation were not part of reply affidavits and cannot be considered.

37. He submits that it is only during arguments that cloud is raised over the Plaintiffs title without any pleading in the Affidavit. He would further submit that invoices are *prima facie* fabricated and the contention that Registrar would decide the same is unacceptable. He would submit that the Plaintiffs registration of its trade mark has not been challenged by the Defendant No.1. He submits that in the year 2008-09, the Plaintiff's business was above Rs.400 crores which demonstrates its reputation and goodwill. He submits that CA

61 2023 SCC OnLine Bom 2566.

certificate would show that mark was used since the year 2007 and the user in Class-19 in respect of cement was from the year 1988. He would further submit that there is no pleading in the reply affidavits invoking the doctrine of prosecution history estoppel, which pleading is raised for the first time in the written statement. He submits that there is no positive act on the part of Plaintiffs to allege acquiescence and delay by itself is no defence for action for infringement. He submits that it is not shown that by reason of purported inaction by the Plaintiff, the Defendant had altered its position to his detriment. He would further submit that **"BIRLA"** mark is a well known trade mark and for a claim under Section 29(4) of the Trade Marks Act, 1999, there is no requirement of any confusion. He submits that the existence of other infringing marks cannot inure to the benefit of Defendant No.1. He would further submit that as the rival products are construction material used in the same trade sector and sold through the same trade channels, there is similarity of the goods.

REASONS AND ANALYSIS :

38. The issue to be considered is whether the Plaintiffs have made out *prima facie* case to establish infringement, irreparable harm and loss to the Plaintiffs by use of the impugned marks by the Defendant No.1 and balance of convenience which demands that the Defendant

No.1, who has secured registration of the impugned trade marks in the year 2008 should be restrained from exercising the rights vested by reason of registration of its trade mark under the statutory enactment.

39. The case for injunction is substantially premised on the Plaintiffs association with the Birla group of companies, which according to the Plaintiffs, gives exclusive right only to those companies which form part of Birla group to use trademarks containing the word Birla and to institute action for infringement of well known **“BIRLA”** mark.

40. The pleading in the plaint is that the Plaintiff No.1 is the flagship company of global conglomerate Aditya Birla Group incorporated in the year 1947. The **“BIRLA”** trade marks originated in the 19th century when one Shiv Narayan Birla started trading in cotton and subsequently led to the building of the present global conglomerate Aditya Birla Group. There is an internal arrangement between Birla group of companies which gives the Plaintiffs exclusive right to use the Birla trade marks. The gist of the pleadings is that the use by a third party, outside the Birla group of companies, of the mark using the word Birla infringes upon the exclusive right of the Birla group of companies. Considering the manner in which the plaint has been framed, the basic requirement to be *prima facie* established by the Plaintiffs is to demonstrate its association with the Birla group of companies, even accepting the exclusive right of Birla group. The

Plaintiffs are independent corporate entities who have initiated infringement action on the strength of exclusivity to Birla trade mark, which right has to be *prima facie* demonstrated.

41. The Plaintiffs, though have dedicated substantial portion of the plaint to plead about the Birla Group's reputation, goodwill and association of the Plaintiffs with the Birla group, however, have failed to substantiate the pleading by way of documentary material. There is not a single document on record to *prima facie* demonstrate : (a) the prior use and registration of the **"BIRLA"** marks by the BIRLA group of companies in respect of its products; (b) the registrations of **"BIRLA"** mark and its formative marks secured by Birla group of companies in respect of its diverse products which marks have become distinctive of the BIRLA group (c) the Plaintiffs being part of the Birla group and thus acquires right to use the **"BIRLA"** trade mark and formative trade marks by internal arrangement or the right being devolved upon the Plaintiffs through the Birla group of companies.

42. The plaint makes reference to the internal arrangement between Birla group of companies which includes the Plaintiff No.1 without placing the internal arrangement on record. The Plaintiffs appears to be harboring a misconception that reference to the well known name of Birla family is sufficient to accept the exclusive right of Plaintiffs to use the **"BIRLA"** trade marks. The plaint pleads that Plaintiff No.1 is a

limited company incorporated in the year 1947 in textile business and there is not even a bare assertion of user of the **“BIRLA”** trade mark by the Plaintiff No.1 in the year 1947 for marketing its textiles.

43. The plaint while tracing the origin of the Birla trade mark to 19th century when the trade in cotton was commenced by Seth Shiv Narayan Birla does not plead that the trading by Shiv Narayan Birla was under the **“BIRLA”** trade mark. The claim of the Aditya Birla Group being the user of **“BIRLA”** trade mark since the year 1996 is not substantiated by any document.

44. The history of origin and user of the **“BIRLA”** trade mark, its reputation and goodwill, the prior registration of domain name by Birla group of companies cannot assist the case of the Plaintiffs *sans* any material to demonstrate connection between the Plaintiffs and Birla group of companies. The pleading in paragraph 29 of the plaint is that the website www.birlawhite.com is maintained by Aditya Birla Management Corporation Pvt Ltd since 1st November, 1999. Perusal of Exhibit “L” at page 436 shows that the name of the organisation is Ultratech Cement Ltd and not Aditya Birla Management Corporation Ltd. There is no averment in the plaint to justify this connection between the domain name and Ultratech Cement Ltd. The pleadings *per se* cannot confer any benefits associated with the Birla trade marks upon the Plaintiffs.

45. Though it was sought to be contended that the Defendant No.1 has not taken any plea raising cloud over the Plaintiff's title, the burden is upon the Plaintiffs to make out a *prima facie* case for grant of interim relief. The entire edifice is built by the Plaintiffs upon its association with Birla group which is required to be *prima facie* established by the Plaintiffs, if it seeks to derive any benefit from the association. It needs to be noted that the present suit has been filed under the Commercial Courts Act, 2015 and the provisions of Order-XI Rule 1 of the Code of Civil Procedure, 1908 in its application to the commercial courts mandates filing of all documents relied upon by the Plaintiffs. The Plaintiffs claim to exclusive right to use the word **"BIRLA"** as part of its trademark which stemmed from the association with the Birla group of companies is *prima facie* doubtful.

46. As all reference to Birla group is unsubstantiated, that leaves the Plaintiffs with the claim of being a registered proprietor of its trade mark which has instituted an action for infringement of its registered trade mark. Excluding any association with the Birla group, there is not much difference between the Plaintiff No.1 and the Defendant No.1 which are both registered proprietors of their respective trade marks containing the word Birla. The Plaintiff No.1 claims to be the subsequent proprietor of the registered trade mark **"BIRLA WHITE"**, which trade mark was registered by Indian Rayon and Industries

Limited in the year 1999 with user claim of 1988. Perusal of the registration certificates in respect of the trade mark **"BIRLA WHITE"** under Registration No. 524399 and 524400 annexed at Exhibit B-1 and B-2 indicates that registration is in the name of Indian Rayon and Industries Limited. It is pleaded that by virtue of scheme of arrangement in nature of demerger between Indian Rayon and Industries Ltd and the Plaintiff No.1, the trade mark **"BIRLA WHITE"** came to be transferred to the Plaintiff No.1 from Indian Rayon and Industries Ltd. The scheme of arrangement is not placed on record and surprisingly neither the Form TM-23 dated 4th March, 2005 and the order dated 13th April, 2013 permitting the Plaintiff No.1 to be brought on record as subsequent proprietor. That apart, there is not a single document produced on record to demonstrate user of the trademark by Indian Rayon and Industries Ltd since the year 1988.

47. The position that emerges is that *prima facie* the Plaintiff No.1 cannot claim benefit of the prior user and registration of the mark Birla White *qua* Indian Rayon and Industries Ltd and loses its claim of user since the year 1988 through its purported predecessor in title. Coming to the registrations secured by the Plaintiffs, Exhibit "A" of the plaint lists about 112 registrations, however, there is not a single registration of the stand alone word Birla and with the exclusion of the registration No.524399 and 524400, the earliest registration is of

"BIRLA COASTAL" on 12th January 2001 which is at Exhibit-B3 under registration No. 983400 in Class-19 and registration of the mark **"BIRLA WHITE WALL CARE"** of 31st May, 2001.

48. The earliest sales invoice annexed at Exhibit P4 at page 442 of the plaint is dated 2nd November, 2009 which reflects the trade mark **"BIRLA WHITE"**. The Chartered Accountant's certificate certifying the sales as well as the advertisement expenses under the trade mark **"BIRLA WHITE"** in so far as the Plaintiff No.1 is concerned is for the period 2007-2008 and in respect of Plaintiff No. 2 is from the year 2010 to 2011. There is no document to substantiate the use of the mark **"BIRLA WHITE"** or **"BIRLA COASTAL"** from the year 2001, when the registrations were secured, till at least 2007-2008. *Prima facie* it appears that after securing registration of its trade mark in the year 2001, there was no use of the mark at least till 2007-2008, by which time the Defendant No.1 claims to have commenced the use of the mark.

49. Insofar as the Defendant No.1's registration is concerned, the Defendant No.1 claims use of the registered mark since April 2004. The registration certificates of the Defendant No.1 annexed at page 593 onwards show the earliest registration under Registration No.1766133 of the trademark **"BIRLA"** on 22nd December 2008. The claim of Defendant No.1 is that the mark has been in use by the Defendant No.1

since April 2004 in Class-6, i.e., M.S. bar (TMT), M.S. round, M. S. angle, M. S. channel, M. S. Flat, M. S. girder, M.S. Square, SS flat. The invoices placed on record from pages 312 till 494 does not reflect the mark **"BIRLA TMT"**. It is only in the invoices of the year 2022 that the mark is reflected. Apart from the invoices, the Defendant No.1 has placed on record purchase orders dated 27th October, 2008, 6th May, 2009 and 23rd October, 2008 showing orders placed for products under the **"BIRLA TMT"** mark. The contention of Defendant No.1 is that by reason of floods in the year 2021, the entire record of Defendant No.1 was washed away and certificates were obtained from the purchasers in order to demonstrate the sale under its mark. The Defendant No.1 has placed on record the complaint lodged with the police authorities stating that it's records were destroyed by muddy water and also the photographs of the damage caused. The certificates which are at page 528 to 576 show the earliest sale under the trademark being of the year 2008-2009. What we have on record are certificates issued by purchasers, an ISO certification of the year 2009, the certificate of inspection by Assistant Engineer, Himachal Pradesh of the year 2009. There can be no reason to doubt the government documents. The genuineness of the invoices are disputed by the Plaintiffs. Even disregarding the invoices, there is sufficient material produced on record by the Defendant No.1 to *prima facie* demonstrate that at least

from 2008, the Defendant No.1 has sold its products under the registered trade mark "**BIRLA TMT**".

50. Though by way of convenience compilation, documents forming part of the written statement was sought to be relied upon, an objection was raised by Dr. Tulzapurkar that these documents which did not form part of the reply Affidavits cannot be considered as the Plaintiffs did not have the opportunity to deal with the same. I am in agreement with the submission of Dr. Tulzapurkar. The Defendant No.1 has filed detailed reply affidavits and produced voluminous documents. There is no explanation as to why these documents forming part of written statement were not part of the reply affidavits. The Plaintiffs did not have an opportunity to deal with the documents and it is no answer to say that the Plaintiffs could have filed replication. In my view, the principles of fairness and equity demand that documents should have been part of the reply affidavits so that the Plaintiffs could have had an opportunity to deal with the same. Further, the convenience compilation was tendered only during the Defendant's arguments after the Plaintiffs had finished their arguments and therefore the Plaintiffs did not have an opportunity to deal with the same except by way of rejoinder which is a limited answer. In that view of the matter, I am not inclined to consider the documents or the pleadings or the decisions cited about prosecution

history estoppel which plea is part of the written statement and absent in reply Affidavits.

51. What we have is the claim of the Plaintiff No.1 which is a limited company who has acquired registration of the trade mark "**BIRLA COASTAL**" and formative marks using word Birla as part of its mark, with the earliest registration being of the year 2001 and the user *prima facie* demonstrated from 2007-2008 as against the Defendant No.1 who has obtained registration of the mark "**BIRLA**" and formative marks using the word Birla and has *prima facie* demonstrated user since the year 2008. With this background of the respective dates of registration and user of the rival marks, the issues of infringement and passing off are required to be considered. Without evidence being led, it is not possible to accept that user of the mark by Defendant No.1 is from the year 2004 or that the user by the Plaintiffs pre-decessor was since the year 1988.

52. The Plaintiff No.1 and the Defendant No.1 are both registered proprietor of their respective trademarks which trademarks resemble each other. There are certain provisions of the Trade Marks Act which indicates that the enactment admits of more than one proprietor and saves the rights vested by virtue of registration in respect of identical or nearly resembling trade marks. The registration of identical or similar trade marks is permitted by Section 12 of the Trade Marks Act,

in respect of similar goods in case of honest concurrent use or other special circumstances. The other provision which admits of existence of more than one proprietor is Section 28 of the Trade Marks Act, and Sub-Section (3) of Section 28 recognises the rights conferred by virtue of registration of the trade marks on the proprietors of identical or nearly resembling trade marks by prohibiting the claim of exclusive right to use the trade mark against the other registered proprietor. The other provision is Section 30(2)(e) of the Trade Marks Act which provides that the registered trade mark is not infringed by use of registered trade mark being an identical registered trade mark in exercise of right to use given by registration. We also need to note the provisions of Section 31 of Trade Marks Act, which provides for registration to be *prima facie* evidence of validity.

53. The infringement is claimed under the provisions of Sub-Sections (1), 2(a) and 2(b) of Section 29 of the Trademarks Act. Section 29 contemplates infringement where the use of the infringing trade mark is by a person who is not the registered proprietor. The circumstances in which infringement occurs under Section 29(1) to (4) is not envisaged against the registered proprietor of trade mark.

54. Despite the above statutory position *qua* Section 29 of Trade Marks Act under Section 28(1), it is only the validity of registration of trade mark which gives the registered proprietor the exclusive right to

use the trade mark in relation to the goods or services. The expression “if valid” occurring in Section 28(1) came to be interpreted by the Hon’ble Full Bench of this Court in ***Lupin Ltd vs Johnson and Johnson*** (supra) where the Full Bench considered whether the Court can go into the question of validity of registration of the trademark at an interlocutory stage. The Hon’ble Full Bench held that the words “if valid” occurring in Section 28 and “*prima facie* evidence of title” in Section 31 supports the stand that the defence of invalidity of registration of the trademark can be considered at the interlocutory stage. The Hon’ble Full Bench held in paragraph 55 as under:

“We are, therefore, of the view that while the registered proprietor of a trade mark would ordinarily be entitled to a finding of the Civil Court in its favour that the trade mark registered in its name is *prima facie* valid, the jurisdiction of the Court is not barred for considering the plea of Defendant at the interlocutory stage that the Plaintiffs registration is so fraudulent or is so apparently invalid that the Court should not grant an injunction in favour of the Plaintiff. Of course a very heavy burden lies on the Defendant to rebut the strong presumption in favour of the Plaintiff at the interlocutory stage. The Civil Court obviously cannot give any final finding on this question as the jurisdiction to give such final finding is conferred on Appellate Board in the rectification proceedings, but it is not possible to accept that the Plaintiffs contention that at the interlocutory stage the jurisdiction of Civil Court is completely barred.”

55. The Hon’ble Full Bench held that at the interlocutory stage, the Civil Court is not to embark upon and evolve factual inquiry, but the Civil Court hearing the application for interim injunction to restrain the

Defendant from using the trade mark registered in the Plaintiff's name, is only permitted to consider whether the registration is totally illegal or fraudulent or shocks the conscience of the Court. The Hon'ble Full Bench held that it is only in such exceptional circumstances that the Court may decline to grant relief in favour of Plaintiff. By limiting the exceptional circumstances in which the validity of registered trade mark can be gone into, the Hon'ble Full Bench has left a very small window to challenge the validity of the registration.

56. The Plaintiffs have based its challenge to the validity of Defendant No.1's registration as being violative of Section 11(1), 11(2) and 11(3)(a) of the Trade Marks Act, which provides for the relative grounds for refusal of registration and reads as under:

"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.

(2) A trade mark which—

(a) is identical with or similar to an earlier trade mark; and

(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered in the name of a different proprietor,

shall not be registered if or to the extent the earlier trade mark is a well-known trade mark in India and the use of the later mark without due cause would take unfair advantage of or be

detrimental to the distinctive character or repute of the earlier trade mark.

(3) A trade mark shall not be registered if, or to the extent that, its use in India is liable to be prevented—

(a) by virtue of any law in particular the law of passing off protecting an unregistered trade mark used in the course of trade; or.....”

57. The pleading in this context can be found in paragraph 47 of the plaint. It is pleaded that the Defendant No.1 has fraudulently obtained trade mark registration of **“BIRLA”** marks listed in the said paragraph. The list makes a reference to about six registrations of Birla marks in Class-6, 10, 11 and 18. The list does not include the Defendant No.1’s application No.3196319 in Class-17 which is pending registration. The claim of fraudulent registration is based on the purported forged and fraudulent invoices filed along with the trade mark application bearing No.3196319. It is incomprehensible that the subsequent pending registration application, which is claimed to be supported by forged and fabricated invoices, can form the basis for assailing the validity of registered trade marks of Defendant No.1. As the application is pending for registration before the Registrar, the authenticity of those invoices will be decided by the Registrar. It is contended that these invoices are also annexed by the Defendant No.1 to the present proceedings. The invoices are of the year 2020-2021 and cannot form the basis for assailing the registrations secured in the prior years.

58. The other ground on which the Plaintiffs have assailed the Defendant No.1's registrations is the Defendant No.1's adoption of identical and deceptively similar "**BIRLA**" mark. The said pleading is premised on the violation of Section 11 of the Trade Marks Act, 1999. The provisions of Section 11(1) of the Trade Marks Act, dealing with relative grounds of refusal provides that the trade mark shall not be registered if by reason of identity / similarity with the earlier trade mark and identity or similarity of the goods or services covered by the trade mark, there exists a likelihood of confusion on the part of public which includes the likelihood of association with the earlier trade mark. For Section 11(1) of the Trade Marks, 1999 to apply by reason of identity of the trade marks, there should exist a likelihood of confusion which includes likelihood of association with the Plaintiff No.1's mark. In the instant case, the Defendant No.1's mark has been registered in the year 2008 and has been in use since then. There is not a single pleading in the plaint to *prima facie* demonstrate the likelihood of confusion or likely association with the Plaintiff No.1's mark. The pleading is only that the rival marks are identical or deceptively similar. It is not the mere identity or similarity of rival marks which constitutes ground for refusing registration but the likelihood of confusion or likely association with the earlier trade mark arising by reason of identity or similarity of trade marks.

59. Sub-Section (2) of Section 11 of the Trade Marks Act, 1999 provides that there shall not be registration of identical trade mark in respect of the dissimilar goods if the earlier trade mark is a well-known trade mark in India and the use of later mark without due cause would take unfair advantage of or be detrimental to the distinctive character or repute of the earlier trade mark.

60. Section 2(zg) of the Trade Marks Act, 1999 defines the term “well known trade mark” means a mark which has become so to the substantial segment of public which uses such goods that the use of such mark in relation to other goods or services would be likely to be taken as indicating a connection in the course of trade or rendering of services between those goods or services and a person using the mark in relation to the first-mentioned goods or services. The test of well known trade mark in Section 2(zg) of the Trade Marks Act, 1999 is *qua* the segment of public which uses such goods. The **“BIRLA”** mark even if accepted to be a well known mark, the Plaintiffs have failed to demonstrate *prima facie* association with the Birla group of companies or the internal arrangement by which Plaintiffs have the right to use the **“BIRLA”** trade mark. The aspect of invalidity of registration would have taken a different colour if there was material on record to demonstrate the connection between the Plaintiffs and the Birla Group of Companies and the devolvment of **“BIRLA”** trade mark

upon the Plaintiffs. *Sans* any *prima facie* connection with the Birla group of companies, the simultaneous user of the Plaintiff No.1 and the Defendant No.1 of the registered trade marks containing the word Birla cannot be said to be detrimental to the distinctive character or repute of Plaintiffs trade mark.

61. Section 11(3)(a) of the Trade Marks Act, 1999 provides for refusal of registration if its use is liable to be prevented by any law and in particular the law of passing off protecting an unregistered trade mark used in the course of trade. The registration will be refused by considering the law of passing off which protects an unregistered trade mark, which is not established in the present case.

62. The decision of *Lupin Ltd. v. Johnson & Johnson* (supra) casts a heavy burden to demonstrate the *ex facie* illegality in granting registration to the trade mark. The threshold to be met is not that of *prima facie* arguable case of invalidity but a higher threshold of *ex facie* illegality or fraud or which shocks the conscience of the Court. It needs to be noted that registration of the trademark confers statutory rights on the proprietor which should not be interfered with lightly. The registration of the mark in favour of Defendant No.1 gives protection to the Defendant No. 1 to use of the mark, which use can be interfered with by the Court at interlocutory stage in exceptional circumstances.

(See Mangalam Organics Ltd vs N Ranga Rao and Sons Pvt Ltd⁶²).

63. In my view, the Plaintiffs have not discharged the burden cast upon them for this Court to go beyond the validity of Defendant's registration. As the Plaintiffs have failed to make out a *prima facie* case for this Court to go beyond the validity of Defendant No.1's registration, Section 29 of Trade Marks Act, 1999 will not come to the aid of the Plaintiffs and no right to sue for infringement can be invoked against the Defendant No.1. It is therefore not necessary for this Court to delve into the question of similarity of rival goods or the issue of classification. All these considerations are relevant to decide the aspect of infringement under Section 29(1) to (4) of the Trade Marks Act, 1999. The decisions cited at the bar as regards the tests to be applied for considering the similarity of goods or the deceptive similarity of the rival trade marks or classification are not required to be considered.

64. Dealing with the case of passing off, the registration of marks or common field of activity is irrelevant for considering an action for passing off. A passing off action is common law remedy available for protection of the reputation and goodwill against misrepresentation by another. It is well settled proposition that in passing off action the Plaintiffs have to prove goodwill and reputation, likelihood of damage

62 Interim Application (Ld.) No.7446 of 2025 in Com.IP Suit No. 194 of 2025 decided on 3-9-2025.

to the Plaintiff's goodwill and misrepresentation by the Defendant.

65. The relevant date for deciding the reputation and goodwill existing is the date of use by the Defendant No.1 of its trade mark. *Prima facie* the records indicate user of the mark by the Defendant No.1 since the year 2008. The Plaintiffs are required to show goodwill and reputation acquired by the Plaintiffs in respect of its mark on the date of adoption by the Defendant No.1 i.e. in the year 2008 and that the Plaintiff's mark has acquired such distinctiveness that the consumers identify the registered mark with the Plaintiff's product. The sales figure and promotional expenses for the year 2007-2008 is about 495 crores and 16.19 crores respectively. *Prima facie* the Plaintiffs have commenced the use of its registered trade mark in or around the year 2007 and the Defendant No.1 in or around the year 2008. It cannot be expected that within a period of one year, the Plaintiff No.1's mark has achieved such distinctiveness so that the relevant consumer base would associate the Defendant No.1's goods as that of the Plaintiffs. The Plaintiffs are required to demonstrate prior continuous user of its mark which has achieved distinctiveness in the minds of the public. The reference to the awards in paragraph 24 of plaint shows that the same are of the year 2018 onwards and there is no mention that the awards are conferred *qua* the registered trade marks. The Plaintiffs registered mark is Birla Coastal, Birla Super, Birla

White Wall Care, Birla White Textura etc whereas the Defendant No.1's mark is Birla, Birla TMT, Birla e-bike. The word Birla when used does not immediately signify the commercial origin of the goods associated with the Plaintiffs as in the case of Kodak or Honda. The Plaintiff No.1 does not possess any independent registration for the word "**BIRLA**" but for the word "**BIRLA**" in conjunction with other words. It is not necessary to prove actual deception but an action for passing off requires proof of likelihood of confusion or deception. The Defendant No.1 has been using the impugned trade mark "**BIRLA TMT**" *prima facie* atleast from the year 2008 and the present suit has been filed in the year 2022. In event there was likelihood of confusion being caused or likely association with the Plaintiffs product, there would have occurred some instance of confusion or association within this long span of about 14 years. It is also not *prima facie* demonstrated that by reason of the use by the Defendant No.1 of the impugned marks, the plaintiffs business reputation is likely to be affected or is affected.

66. The question to be asked as set out in ***Ruston & Hornsby Ltd v. The Zamindara Engineering Co.***⁶³ is whether the Defendant No.1 is selling the goods so marked as to be designed or calculated to lead purchasers to believe that they are the Plaintiff's goods. The Defendant No.1 has placed on record the printout of its webpages, its

⁶³ (1969) 2 SCC 727.

promotional activities through different mediums. The promotional material from Page 287 while describing its products specifically mentions that the product is manufactured and marketed by the Defendant No.1. The franchise agreements placed on record makes no reference to the Birla Group of Companies nor gives any impression of any connection with the Birla Group. The Defendant No.1 has carried out extensive promotion of its product, which material is placed on record, and the promotional material markets the product without any reference to the Birla Group of Companies.

67. In *Cadilla Health Care Ltd vs Cadila Pharmaceuticals Ltd* (supra) the Hon'ble Apex Court laid down the parameters to be applied in a passing off action involving deceptive similarity of marks as under:

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

(a) The nature of the marks i.e. whether the marks are word marks or label marks or composite marks i.e. both words and label marks.

(b) The degree of resemblance between the marks, phonetically similar and hence similar in idea.

(c) The nature of the goods in respect of which they are used as trade marks.

(d) The similarity in the nature, character and performance of the goods of the rival traders.

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

(f) The mode of purchasing the goods or placing orders for the

goods

(g) Any other surrounding circumstances which may be relevant in the extent of dissimilarity between the competing marks.

36. Weightage to be given to each of the aforesaid factors depending upon facts of each case and the same weightage cannot be given to each factor in every case."

68. In *Pernod Ricard India Private Limited v. Karanveer Singh*

Chhabra⁶⁴, the Hon'ble Apex Court held in paragraph 29 as under:

"29. Before delving further, it is important to note that a passing off action is a common law remedy designed to protect the goodwill and reputation of a trader against misrepresentation by another, which causes or is likely to cause confusion among consumers. As observed by James L.J, in *Singer Manufacturing Co v. loog*²², "no man is entitled to represent his goods as being the goods of another man". A passing off action applies to both registered and unregistered marks, and is rooted in the principle that one trader should not unfairly benefit from the reputation built by another. In contrast, an action for trademark infringement is a statutory remedy under the Trade Marks Act, 1999 available only in relation to registered trademarks. It is intended to safeguard the exclusive proprietary rights that registration confers.

29.1. A key distinction between the two lies in the requirements of proof. In an infringement action, the plaintiff is not required to establish the distinctiveness or goodwill of the mark - registration, by itself, affords the right to seek protection. If the impugned mark is shown to be identical or deceptively similar to the registered mark, no further evidence of confusion or deception is necessary. However, in a passing off action, the plaintiff must prove: (i) the existence of goodwill or reputation in the mark, (ii) a misrepresentation made by the defendant, and (iii) a likelihood of damage to the plaintiff's goodwill.

29.2. While an intent to deceive is not a necessary element in either action, passing off requires proof of a likelihood of confusion or deception. It is well settled that

64 2025 SCC OnLine SC 1701.

actual deception or damage need not be proved - the test is whether confusion is probable in the mind of the average consumer due to the similarity in the marks or the overall get-up of the goods.

29.3. Another key distinction is that in a passing off action, the defendant's goods need not be identical to those of the plaintiff - they may be allied or even unrelated, provided the misrepresentation is such that it affects or is likely to affect the plaintiff's business reputation. In contrast, infringement requires that the unauthorised use relate to the same or similar goods or services for which the trademark is registered.

29.4. Additionally, in an infringement suit, it is not necessary for the plaintiff to establish use of the mark; even a registered proprietor who has not commenced use can sue for infringement. However, in a passing off action, the plaintiff must demonstrate prior and continuous use, and that the mark has acquired distinctiveness in the minds of the public.

29.5. Thus, while both actions seek to prevent unfair competition and protect against consumer confusion, an action for infringement offers broader statutory protection based solely on registration and ownership. In contrast, passing off is grounded in equitable principles and imposes a higher evidentiary burden to safeguard commercial goodwill under common law." *[Emphasis Supplied].*

69. Applying the tests laid down by the Hon'ble Apex Court, the rival products i.e. steel and cement are used in construction business. The consumers of these products are usually businessmen engaged in construction business placing bulk purchase orders. The test to be applied in such cases is different from the test to be applied in respect of ordinary class of products bought over the shelf by general class of consumers. The class of buyers of the rival products would be well

informed about the origin of product and ordinarily will not be misled by considering only the brand name. It is unlikely that the class of developers and builders would be misled in believing that the Defendant No.1's goods are that of the Plaintiffs. The invoices raised by the respective parties would indicate the use of trade name and not merely the trade mark. The rival products are such that they would not be bought without deliberation and without checking the source as quality is important aspect in case of building material. There are no submissions canvassed for consideration of this Court as regards the use of the mark in respect of e-bikes.

70. As far as the contention regarding the dishonest adoption of the trade mark by the Defendant No.1 is concerned, in ***Kores (India) Ltd vs Khoday Eshwara & Sons*** (supra), it has been held in the context of Section 12(3) of the Trade Marks Act, 1999 that honesty of user is commercial honesty and that fact of knowledge loses much of its significance when honesty of user is established. The Defendant No.1 has secured registrations in respect of products which the Plaintiffs does not manufacture. The Plaintiffs claim dishonesty in adoption as the mark Birla is well-known trade mark and the Defendant No.1 adopted the mark to encash the goodwill and reputation of Birla mark. Firstly, the Plaintiffs have *prima facie* failed to demonstrate association with Birla family or Birla group of companies. There is no pleading that

the Directors of the Plaintiffs are members of Birla family. The adoption by the Plaintiffs of the mark Birla is no different from adoption by the Defendant No.1. Secondly, the dishonest adoption can be in order to ride upon the goodwill and reputation of the Plaintiffs. The Defendant No.1 has been openly and extensively advertising its products marketed under the impugned marks in print, national television and social media. The promotional material of the Defendant No.1 placed on record does not mention even remotely any connection or association with the Plaintiffs or Birla group. Pertinently, though the Defendant Nos.2 and 3 alleged misrepresentation on the ground of purported consent letter put forth by the Defendant No.6 while granting franchise to the Defendant No 2, no such letter has been produced on record.

71. There is no quarrel with the ratio of the decisions laid down in ***Ciba Ltd. Basle Switzerland v. M. Ramalingam*** (supra), ***Suzuki Motor v. Suzuki (India) Ltd*** (supra), ***Schering Corporation v. Kilitch Co. (Pharma) Pvt. Ltd*** (supra) and ***Aktiebolaget Volvo of Sweden v. Volvo Steels Ltd. of Gujrat (India)*** (supra). However, its applicability to the facts of present case is debatable. Insofar as the decision of ***Cadila Pharmaceuticals Ltd. v. Sami Khatib of Mumbai*** (supra), the observations of learned Single Judge were made in context of passing off action. Apart from honesty in adoption, there are several factors to

be taken into consideration and when so considered no case for passing off is made out by the Plaintiffs herein.

72. The registrations secured by the Defendant No.1 permits it to use the word Birla as part of its domain name. The pleading in the plaint is that the Plaintiff group company Aditya Birla Management Corporation Pvt Ltd maintains the website www.birlawhite.com since the year 1999. The extract of Whois website shows that the organisation is Ultratech Cement Ltd in respect of the domain name birlawhite.com. There is no clarity in the pleadings as regards the registration of domain name by the Birla group of companies in the year 1999. In any event, it is required to be pointed out that the domain name was not merely blocked but was put to use since the year 1999. Section 29(5) of Trade Marks Act applies where the registered trade mark is used as part of business / corporate name provided the business of infringer is of dealing with the goods or services in respect of which trade mark is registered. Apart from the fact that the Defendant No.1 uses its registered trade mark as part of its domain name, the condition of use of the domain name in respect of goods for which Plaintiffs trade mark is registered is not satisfied.

73. The legal principles governing grant of injunction were laid down in ***Pernod Ricard India Private Limited v. Karanveer Singh Chhabra*** (supra) in paragraph 36 as under:

“36. The Trade Marks Act, 1999 does not prescribe any rigid or exhaustive criteria for determining whether a mark is likely to deceive or cause confusion. Each case must necessarily be decided on its own facts and circumstances, with judicial precedents serving to illuminate the applicable tests and guiding principles rather than to dictate outcomes.

36.1. As a general rule, a proprietor whose statutory or common law rights are infringed is entitled to seek an injunction to restrain further unlawful use. However, this remedy is not absolute. The considerations governing the grant of injunctions in trademark infringement actions broadly apply to passing off claims as well. That said, a fundamental distinction remains: while a registered proprietor may, upon proving infringement, seek to restrain all use of the infringing mark, a passing off action does not by itself confer an exclusive right. In appropriate cases, the court may mould relief in passing off so as to permit continued use by the defendant, provided it does not result in misrepresentation or deception.

36.2. The grant of injunction - whether for infringement or passing off - is ultimately governed by equitable principles and is subject to the general framework applicable to proprietary rights. Where actual infringement is established, that alone may justify injunctive relief; a plaintiff is not expected to wait for further acts of defiance. As judicially observed, *“the life of a trademark depends upon the promptitude with which it is vindicated.”*

36.3. The principles laid down in *American Cyanamid Co. v. Ethicon Ltd. [1975] 1 All ER 504* continue to guide the Courts while determining interim injunction applications in trademark cases. The following criteria are generally applied:

(i) Serious question to be tried/triable issue: The plaintiff must show a genuine and substantial question fit for trial. It is not necessary to establish a likelihood of success at this stage, but the claim must be more than frivolous, vexatious or speculative.

(ii) Likelihood of confusion/deception: Although a detailed analysis of merits is not warranted at the interlocutory stage, courts may assess the prima facie strength of the case and the probability of consumer

confusion or deception. Where the likelihood of confusion is weak or speculative, interim relief may be declined at the threshold.

(iii) Balance of convenience: The court must weigh the inconvenience or harm that may result to either party from the grant or refusal of injunction. If the refusal would likely result in irreparable harm to the plaintiff's goodwill or mislead consumers, the balance of convenience may favor granting the injunction.

(iv) Irreparable harm: Where the use of the impugned mark by the defendant may lead to dilution of the plaintiff's brand identity, loss of consumer goodwill, or deception of the public - harms which are inherently difficult to quantify - the remedy of damages may be inadequate. In such cases, irreparable harm is presumed.

(v) Public interest: In matters involving public health, safety, or widely consumed goods, courts may consider whether the public interest warrants injunctive relief to prevent confusion or deception in the marketplace.

36.4. In conclusion, the grant of an interim injunction in trademark matters requires the court to consider multiple interrelated factors: *prima facie* case, likelihood of confusion, relative merits of the parties' claims, balance of convenience, risk of irreparable harm, and the public interest. These considerations operate cumulatively, and the absence of any one of these may be sufficient to decline interim relief."

74. The considerations applicable to grant of interim injunction in trade mark matters are *prima facie* case, likelihood of confusion, relative merits of the parties claims, balance of convenience, risk of irreparable harm and public interest and absence of any one is sufficient to decline interim relief. It has been held that passing off is grounded in equitable principles and imposes a higher evidentiary burden to safeguard commercial goodwill under common law. Apart

from the fact that the Plaintiffs have failed to make out a *prima facie* case of infringement or passing off, what tilts the scales in favour of the Defendant No.1 is the registration and user of its registered trade mark atleast since the year 2008. There is sufficient promotional material placed on record to demonstrate the active advertising carried out by the Defendant No.1 atleast since the year 2016. It is difficult to accept that the Plaintiffs were blissfully unaware of the use by the Defendant No.1 of its registered trade mark. Though it is well settled that delay by itself is not a defence available in infringement action, considering that the Defendant No.1 is carrying on its business using its registered trade mark since the year 2008, the grant of interim relief of injunction at this juncture would result in irreparable loss to the Defendant No.1 apart from other considerations as discussed above. It would balance the equities, if the Defendant No.1 is directed to maintain the accounts of sales of its product till the disposal of the suit as directed in case of ***Kamat Hotels (India) Ltd. v. R. O. H. Ltd.*** (supra).

75. In light of the above discussion, the Interim Application is dismissed with direction to the Defendant No.1 to maintain accounts of its sales under the impugned trade marks till the final disposal of the suit.

[Sharmila U. Deshmukh, J.]