

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

% Judgment delivered on: 13.10.2022

+ **FAO(OS)(COMM) No.287/2022 & CM No.43497/2022**

VASUNDHRA JEWELLERS PVT. LTD. Appellant

versus

KIRAT VINODBHAI JADVANI & ANR. Respondents

Advocates who appeared in this case:

For the Appellant : Mr. Sagar Chandra, Mr. Prateek Kumar, Mr. Shubic Wahi, Ms. Sanya Kapoor, Ms. Aarushi Jain & Mr. Yojit Pareek, Advs.

For the Respondents : Mr. Raghvendra M. Bajaj, Mr. Anshuman Upadhyay, Mr. Naseem and Mr. Prashant, Advs.

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HON'BLE MR JUSTICE VIBHU BAKHRU

HON'BLE MR JUSTICE AMIT MAHAJAN

JUDGMENT**VIBHU BAKHRU, J**

1. Vasundhra Jewellers Private Limited (hereafter '**the appellant**') has filed the present appeal impugning a judgment dated 21.09.2022 (hereafter '**the impugned judgment**') passed by the learned Single Judge, whereby the appellant's application under Order XXXIX Rules 1 and 2 of the Code of Civil Procedure, 1908 (hereafter '**the CPC**') was dismissed.

2. Respondent no. 1 carries on business in textiles and garments. The appellant had sought interim orders, *inter alia*, restraining



respondent no.1 from using the trademark “VASUNDHRA FASHION/



”, in connection with its business, claiming that the use of the said mark infringes its trademarks and amounts to passing off. The said interim relief was rejected and this has led the appellant to file the present appeal.

Factual Context

3. The appellant states that it was incorporated on 28.10.1999 and thereafter, it adopted the mark “VASUNDHRA/VASUNDHRA JEWELLERS” to commence the business of “*jewellery in precious metals and gems*”. It operates one showroom at Pitampura in Delhi. It further states that it has been using the said name extensively, continuously and uninterruptedly. Therefore, the said marks have acquired immense goodwill and reputation.

4. Thereafter, on 23.05.2003, the appellant applied for registration



of the device mark “”, claiming use of the mark since 01.01.1999, under Class 14 (trademark application no: 1200939). The said mark is registered and valid up till 23.05.2023. The appellant also states that on 26.06.2011, it obtained registration for its domain name, that is, www.vasundhrajewellers.com, and has further, obtained registrations of various other domain names, which are listed below:-



- i. www.vasundhra.com
- ii. www.vasundhara.com
- iii. www.vasundhra.in
- iv. www.vasundhrajewellers.in
- v. www.vasundhrajewellers.com
- vi. www.vasundhrajeweller.in

5. On 19.12.2017, the appellant applied for the registration of the



device mark “”, claiming use of the mark since 17.08.2016, under Class 14 (trademark application no: 3705706). The said mark is registered and valid till 19.12.2027.

6. On 22.05.2019, the appellant also applied for registration of the



device mark “”, under Class 14 (trademark application no: 4183139), claiming use of the mark since 28.10.1999. The said mark is registered and valid till 22.05.2029.

7. The aforesaid registered trademarks of the appellant are hereafter collectively referred to as the ‘**VASUNDHRA Trademarks**’.

8. The appellant applied for registration of various other trademarks, including the word marks “VASUNDHRA JEWELLERS” and “VASUNDHRA JEWELLERS PRIVATE LIMITED”. However, the registration of the aforesaid marks were opposed at the Trademark Registry.



9. The appellant claims that on account of the above-mentioned registrations, it has the exclusive right to use the VASUNDHRA Trademarks, including the name “Vasundhra”. It further claims that it has spent a considerable amount of money and effort to establish its brand identity through the promotion and advertising of the said marks and the promotion expenses to advertise its brand have increased from ₹43,254/- in the financial year 1999-2000 to ₹8,65,055/- for the period 2021 till 04.03.2022. The appellant further claims that since the launch of its brand, its sales have increased from ₹19,80,812/- in the year 1999-2000 to ₹79,71,49,118/- for the period 2021 till 04.03.2021.

10. The appellant claims that in the month of April, 2022, it came across the publication of respondent no. 1’s mark “VASUNDHRA



FASHION / ” under Class 25 (trademark applications no.: 5277967 dated 08.01.2022), for the goods being “*textile, textile goods and fabrics*”. Respondent no. 1 claims use of the said mark since 02.12.2020. The appellant further contends that the domain name of respondent no.1 is also identical to its domain name.

11. The appellant contends that whilst respondent no. 1 applied for



registration of the mark “”, however, it uses the mark “



” on its stores and thus, dishonest intention



on part of respondent no. 1 is evident from the said fact. The appellant also states that respondent no. 1 has opposed three applications preferred by it for trademark registration before the Trademark Registry.

12. Disputes have arisen between the parties in respect of the said marks. The appellant claims that respondent no. 1 is using the mark

“VASUNDHRA FASHION / ”, which is identical/deceptively similar to the VASUNDHRA Trademarks.

13. On 24.05.2022, the appellant filed a suit under Sections 29, 27(2) and 135 of the Trade Marks Act, 1999, (hereafter ‘**the TM Act**’) *inter alia*, seeking permanent injunction against respondent no. 1 from infringement, passing off, its relevant trademarks.

The Appellant’s Case

14. The case set up by the appellant is that it is the prior and registered proprietor of the VASUNDHRA Trademarks, registered for goods falling under Class 14 and thus, the impugned marks used by respondent no.1, dealing in allied goods, is deceptively similar to its marks. The appellant relies on the decision of the Supreme Court in ***Kaviraj Pandit Durga Dutt Sharma v. Navaratna Pharmaceutical Laboratories: (1965) 1 SCR 737*** and on the strength of the said decision, contends that the word ‘Vasundhra’ is an essential feature of its trade mark and thus, in terms of Section 29(2)(b) of the TM Act, the



use of the impugned marks by respondent. 1 for allied and cognate goods would amount to infringement of the VASUNDHRA Trademarks.

15. The appellant claims that the mark ‘VASUNDHRA’ has no prior connection with the business of jewellery and thus, are identified with its business and therefore, the same is entitled to protection as a trade mark. The appellant further claimed that since respondent no.1 has applied for registration of its mark under Class 25, it is estopped from contending that the said mark is not entitled to protection. It referred to the decision in the case of *Automatic Electric Limited v. R.K. Dhawan & Anr.: (1999) SCC OnLine Del 27*, in support of its contention.

16. The appellant further contended that mere presence of a mark in the Register of Trade Marks is not evidence of its use. It referred to the decision of *Century Traders v. Roshan Lal Duggar & Co.: (1977) SCC OnLine Del 50*, in support of his contention.

The Respondent's Defence

17. The case of respondent no. 1 is that the class of goods dealt by the appellant is different than the class of goods, which are dealt by it. Further, its goods are supplied to different class of purchasers and 80% of its business is derived from Gujrat and the balance 20% is through online sales, wherein the appellant has no presence and thus, there is no scope for any confusion being caused by use of the mark “VASUNDHRA”.



18. Respondent no. 1 claims it has employed around eighty people for operations of four warehouses, two manufacturing units and seven offline stores, whereas the appellant, admittedly, operates only one shop at Pitampura in Delhi and thus, it cannot claim pan-India reputation of the mark.

19. Respondent no. 1 contends that it has acquired immense reputation and goodwill in its mark and the statistics relating to the period 31.05.2021 to 22.05.2022 prove that through Flipkart alone, the products advertised by it were viewed 60.14 crore times by the target consumers and 1.82 crore clicks were made on its product listings leading to 1.89 lakh numbers of units of its products being purchased, which resulted in gross sales of ₹8.66 crores on Flipkart alone. Further, its gross sales between the period of December, 2020 to April 2022 were quantified at ₹13,30,84,966.80/-.

20. Respondent no.1 also claims that the word “Vasundhra” is a common name in India and further, various companies have registered marks containing the said word under various classes and thus, the appellant cannot claim exclusive right to use the said term.

21. Respondent no. 1 referred to the appellant’s reply dated 01.07.2019 to the Registrar of Trademarks against the Examination Report and on the strength of the said report, contended that the appellant could not be allowed to “*approbate and reprobate*” as it had claimed that the mark has to be read as a whole; and since the



appellant's marks are device marks, no confusion would be caused with the other marks that use the word "Vasundhra".

22. Respondent no. 1 had further claimed protection under Section 34 of the TM Act as it uses its device mark for goods falling under Classes 24 and 25, and admittedly, the appellant has not preferred any application for registration of its goods under the abovementioned classes.

The Impugned Judgment

23. The learned Single Judge found that albeit the VASUNDHRA Trademarks were registered, however, the appellant did not hold any registration for the word mark "VASUNDHRA". The learned Single Judge further held that *"device mark, the essential feature of the same is equally entitled to protection... at the same time, it has to be remembered that in extending such protection, the party does not lay a claim of exclusivity in a mark to which otherwise he would have been unable to do so. The possibility of the proprietor attempting to expand the operation of his trade mark cannot be ignored or overlooked."*

24. The learned Single Judge further referred to the decision in the case of ***Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd.: 2001 PTC 300 (SC)***, wherein the Supreme Court had laid down the following test for deciding the question of deceptive similarity:-

"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 works.
- 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.”

25. The learned Single Judge considered the rival submissions and *prima facie*, did not find merit in the appellant’s arguments. The learned Single Judge found that the appellant was unable to make out a *prima facie* case for grant of prohibitory injunction against respondent no. 1. The relevant extract of the impugned judgement is set out below:-

“43. Keeping in view the above parameters, in my view, the plaintiff has not been able to make out a *prima facie* case for grant of prohibitory interim injunction against the defendant no.1. As noted hereinabove, the registration and use of the mark of the plaintiff is in a device of it, though



‘VASUNDHRA’ is a predominant part. Equally, ‘VASUNDHRA’ is a common name in India and an exclusive right to use the same cannot be granted to the plaintiff. The goods of the plaintiff and the defendant no.1, though cognate, are distinct. Presently, the plaintiff has not even contended that it has plans of trade progression, that is, to expand its business to other goods including those of the defendant no.1. The area of operation of the plaintiff and the defendant no.1 is also distinct; with the plaintiff being in Delhi, while the defendant no.1 being predominantly in the State of Gujarat. The defendant no.1 also has developed suitable goodwill of the mark in its favour, as is evident from its claim of having a gross sale of Rs. 13.30 Crore approximately between the period of December, 2020 to April 2022. Merely because the plaintiff deals in jewellery items, which by themselves are more costly thereby resulting in a higher turnover for the plaintiff, will not give a better right to the plaintiff over an otherwise a common name in India.”

26. In terms of the impugned judgment, respondent no. 1 was further bound down to the statement made before the learned Single Judge that it would not use the impugned mark “” in the future.

Submissions

27. The learned counsel appearing for the appellant has assailed the impugned judgment on, essentially, two fronts. First, he submitted that the reasoning that the word ‘Vasundhra’ is a common name in India and therefore, an exclusive right to use the same cannot be granted, is palpably erroneous. He submitted that the word ‘Vasundhra’ is not a generic term, which is associated with jewellery. Thus, even if the said



word is a generic word and used in common language, it nonetheless can be recognised and registered as a trademark if it is exclusively associated and identified with the business of the appellant. He submitted that exclusivity in use of the word ‘Vasundhra’, as a mark, cannot be denied solely on the ground that it is a common name.

28. Second, he submitted that the learned Single Judge erred in not appreciating that the word ‘Vasundhra’ is a dominant part of the VASUNDHRA Trademarks and therefore, it was entitled to protection under the provisions of the TM Act. He submitted that the learned Single Judge grossly erred in not restraining the respondents from using mark “VASUNDHRA FASHION”/ “”.

Reasons and Conclusion

29. We find the aforesaid contention unpersuasive and are unable to agree that the impugned judgment warrants any interference. The VASUNDHRA Trademarks are device marks and the registration of the said trademarks does not automatically grant the appellant exclusive right in respect of the word ‘Vasundhra’.

30. The reliance placed by the appellant on the decision in the case of ***Kaviraj Pandit Durga Dutt Sharma v. Navaratna Pharmaceutical Laboratories: (1965) 1 SCR 737***, is of little assistance to it. There is no dispute that the question whether there is any deceptive similarity between the two competing marks, which are not identical, is to be determined by comparing the two marks and answering the key question whether any similarity in the said mark is likely to cause



confusion or deceive. The Court had also clarified that that the question whether there is any deceptive similarity between the marks is to be determined by examining the marks as a whole. The relevant passage of the said decision is set out below-

“29. When once the use by the defendant of the mark which is claimed to infringe the plaintiff's mark is shown to be “in the course of trade”, the question whether there has been an infringement is to be decided by comparison of the two marks. Where the two marks are identical no further questions arise; for them the infringement is made out. When the two marks are not identical, the plaintiff would have to establish that the mark used by the defendant so nearly resembles the plaintiff's registered trade mark as is likely to deceive or cause confusion and in relation to goods in respect of which it is registered (Vide Section 21). A point has sometimes been raised as to whether the words “or cause confusion” introduce any element which is not already covered by the words “likely to deceive” and it has sometimes been answered by saying that it is merely an extension of the earlier test and does not add very materially to the concept indicated by the earlier words “likely to deceive”. But this apart, as the question arises in an action for infringement the onus would be on the plaintiff to establish that the trademark used by the defendant in the course of trade in the goods in respect of which his mark is registered, is deceptively similar. This has necessarily to be ascertained by a comparison of the two marks - the degree of resemblance which is necessary to exist to cause deception not being capable of definition by laying down objective standards. The persons who would be deceived are, of course, the purchasers of the goods and it is the likelihood of their being deceived that is the subject of consideration. The resemblance maybe phonetic, visual or in the basic idea represented by the plaintiff's mark. The purpose of the comparison is for determining whether the essential



features of the plaintiff's trademark are to be found in that used by the defendant. The identification of the essential features of the mark is in essence a question of fact and depends on the judgment of the Court based on the evidence led before it as regards the usage of the trade. It should, however, be borne in mind that the object of the enquiry in ultimate analysis is whether the mark used by the defendant as a whole is deceptively similar to that of the registered mark of the plaintiff.”

(Underlined for emphasis)

31. In ***Pinto v. Badman: (8) RPC (181)***, Lord Esher had observed that “*the truth is that the label does not consist of each particular part of it, but consists of the combination of them all*”. In ***Registrar of Trade Marks v. Ashok Chandra Rakhit Ltd: AIR 1955 SC 558***, the Supreme Court had referred to the aforesaid observation and held as under:-

“14. It is true that where a distinctive label is registered as a whole, such registration cannot possibly give any exclusive statutory right to the proprietor of the trade mark to the use of any particular word or name contained therein apart from the mark as a whole.....”

32. It is well settled that a composite trademark or label trademark is not required to be dissected to determine whether there is any deceptive similarity with another trademark. The question whether there is any deceptive similarity between two trademarks has to be ascertained by examining the marks in question as a whole. In ***South India Beverages India Private Limited v. General Mills Marketing Inc: 2014 SCC OnLine Del 1953***, the Division Bench of this Court had explained the ‘anti-dissection rule’ in some detail. The Court reiterated that



“conflicting composite marks are to be compared by looking at them as a whole, rather than breaking the marks up into their components parts for comparison”. However, the Court had also observed that “while a mark is to be considered in entirety, yet it is impermissible to accord more or less importance or ‘dominance’ to a particular portion or element of a mark in cases of composite marks”.

33. Having stated the above, it is also necessary to bear in mind that examining the dominant part of the trademark for comparing it with the conflicting mark is solely for the purpose of determining whether competing marks are deceptively similar when viewed as a whole. It is, thus, not permissible to hold that two competing marks are deceptively similar by examining a portion of one mark and comparing it with the portion of another mark, if the composite marks viewed as a whole are dissimilar. It is relevant to refer to the text from ***McCarthy on Trademarks and Unfair Competition***, which explains the said principle as under:-

“23.15 Comparing Marks : Differences v. Similarities

[1] The Anti-Dissection Rule

[a] Compare composites as a Whole : Conflicting composite marks are to be compared by looking at them as a whole, rather than breaking the marks up into their component parts for comparison. This is the “anti dissection” rule. The rationale for the rule is that the commercial impression of a composite trademark on an ordinary prospective buyer is created by the mark as a whole, not by its component parts. However, it is not a violation of the anti-



dissection rule to view the component parts of conflicting composite marks as a preliminary step on the way to an ultimate determination of probable customer reaction to the conflicting composites as a whole. Thus, conflicting marks must be compared in their entirety. A mark should not be dissected or split up into its component parts and each part then compared with corresponding parts of the conflicting mark to determine the likelihood of confusion. It is the impression that the mark as a whole creates on the average reasonably prudent buyer and not the parts thereof, that is important. As the Supreme Court observed: “The commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety.” The anti-dissection rule is based upon a common sense observation of customer behavior : the typical shopper does not retain all of the individual details of a composite mark in his or her mind, but retains only an overall, general impression created by the composite as a whole. It is the overall impression created by the mark from the ordinary shopper's cursory observation in the marketplace that will or will not lead to a likelihood of confusion, not the impression created from a meticulous comparison as expressed in carefully weighed analysis in legal briefs. In litigation over the alleged similarity of marks, the owner will emphasize the similarities and the alleged infringer will emphasize the differences. The point is that the two marks should not be examined with a microscope to find the differences, for this is not the way the average purchaser views the marks. To the average buyer, the points of similarity are more important than minor points of difference. A court should not engage in “technical gymnastics” in an



attempt to find some minor differences between conflicting marks.

However, where there are both similarities and differences in the marks, there must be weighed against one another to see which predominate.

The rationale of the anti-dissection rule is based upon this assumption: “An average purchaser does not retain all the details of a mark, but rather the mental impression of the mark creates in its totality. It has been held to be a violation of the anti-dissection rule to focus upon the “prominent” feature of a mark and decide likely confusion solely upon that feature, ignoring all other elements of the mark. Similarly, it is improper to find that one portion of a composite mark has no trademark significance, leading to a direct comparison between only that which remains.”

[Underlined for Emphasis]

34. In the facts of the present case, the learned Single Judge had found that the appellant held registration of the device marks/composite marks that contain the word ‘Vasundhra’ but it did not have any registration of the word mark ‘VASUNDHRA’. It is material to note that the appellant had applied for registration of the word mark but the same has not been granted to it as yet. The Court had, thus, found that the appellant did not have an exclusive right to use the word ‘Vasundhra’ except as part of its device trademarks.

35. This Court finds no infirmity with the said view. This Court concurs with the view that a proprietor of a trademark cannot expand



the area or protection granted to the mark. Indisputably, the appellant does not enjoy the monopoly for use of the word ‘Vasundhra’.

36. This Court is also of the view that competing marks viewed as a whole – ‘The VASUNDHRA Trademarks’ and the device mark



“VASUNDHRA FASHION/” – are not deceptively similar.

The contention that the word ‘Vasundhra’ is a dominant part of the trademarks and therefore, entitled to protection is, *prima facie*, unpersuasive for several reasons.

37. First, that on a plain comparison of the VASUNDHRA



Trademarks with the device mark “/VASUNDHRA FASHION”, it is apparent that the trademarks are not similar. Even if it is accepted that the word ‘Vasundhra’ is a dominant part of the



VASUNDHRA Trademarks, the device label “/VASUNDHRA FASHION” cannot be accepted to be deceptively similar merely because it includes the word ‘Vasundhra’. The dominant part of the said trademark is a leaf, which is not common to the competing marks.

38. Second, the word ‘Vasundhra’ is a generic word and it is brought on record that there are several registered trademarks, which include the word ‘Vasundhra’. Further, ‘Vasundhra’ in Hindi means the earth or the bearer of all. Thus, intrinsically, the word ‘Vasundhra’ would be a weak trademark. Although it is possible for a proprietor to claim exclusive



right in respect of the word ‘Vasundhra’, however, for that, it would be necessary to establish on account of extensive use, the said common word has been identified exclusively with the business of the proprietor and no other. *Prima facie*, it is difficult to accept that the appellant meets the said threshold. The learned Single Judge had noted that the appellant has a single store. Although the appellant’s turnover is about ₹79 crores, it pertains to high value items and therefore, does not necessarily establish the reputation associated with the VASUNDHRA Trademarks.

39. The observations in the impugned judgment that “*‘VASUNDHRA’ is a common name in India and an exclusive right to use the same cannot be granted to the plaintiff*” has to be read in the aforesaid context. The learned Single Judge had found that the word ‘Vasundhra’ was a part of the composite marks and the appellant did not have exclusive monopoly over the word ‘Vasundhra’ merely on account of registration of composite marks including the said words.

40. It is also relevant to note that the learned Single Judge had also noted that before the Registrar of Trademarks, the appellant had sought to distinguish other trademarks, which included the word ‘Vasundhra’, by claiming that the VASUNDHRA Trademarks were required to be considered as a whole. Thus, it is not open for the appellant now to take a contrary stand and claim that the device mark “VASUNDHRA



FASHION/” is deceptively similar to the VASUNDHRA Trademarks on the ground that it includes the word ‘Vasundhra’.



41. Plainly, if the appellant had sought an exclusive right to register the word mark 'VASUNDHRA' on a standalone basis, it would not be open for the appellant to claim that its marks were dissimilar to the marks cited by the Registrar of Trademarks on the aforesaid ground (that, its marks must be considered as a whole).

42. This Court is unable to accept that the appellant can now, by indirect means, secure the benefit of the registration for the word mark 'VASUNDHRA' after having secured the registration of its mark by claiming that it was not similar to other cited marks, which contain the word 'Vasundhra'.

43. This Court does not find any ground to interfere with the impugned judgment.

44. The appeal is unmerited and, accordingly, dismissed. Pending applications, if any, are disposed of.

VIBHU BAKHRU, J

AMIT MAHAJAN, J

OCTOBER 13, 2022

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