

\$~29

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

+ **CS(COMM) 41/2023, I.A. 1349/2023 & I.A. 4142/2023**

UNDER ARMOUR, INC

..... Plaintiff

Through: Mr. Gaurav Gogia, Mr. Rishi Bansal, Mr. Neeraj Bhardwaj, Mr. Rishabh Gupta and Mr. Mankaran Singh, Advs.

versus

ADITYA BIRLA FASHION & RETAIL LTD. Defendant

Through: Mr. Chander M Lall, Sr. Adv. with M. Ankur Sangal, M. Ankit Arvind, M. Raghu Vinayak Sinha and Mr. Shashwat Rakshit, Advs.

CORAM:

HON'BLE MR. JUSTICE C.HARI SHANKAR

J U D G M E N T (O R A L)

%

20.04.2023

IA 1349/2023 [under Order XXXIX Rules 1 and 2, CPC]

1. I have heard Mr. Rishi Bansal on behalf of the plaintiff and Mr. Chander Lall, learned Senior Counsel on behalf of the defendant at considerable length and proceed, by this judgment, to dispose of I.A. 1349/2023, filed by the plaintiff, whereby interlocutory injunctive reliefs have been sought in this plaint.

2. To facilitate clarity, I would proceed to deal with the individual issues urged before me as and when they arise.

3. The plaintiff

3.1 The plaintiff UNDER ARMOUR, Inc (UA India) is a company

incorporated in the US, with its registered office at Maryland, U.S.A. The plaintiff officially entered the Indian market in 2017, by selling its goods through Amazon and, in October 2018, the plaintiff incorporated its Indian subsidiary under the name Under Armour India Trading Pvt. Ltd. The first physical store of the plaintiff was opened in India in 2019. The plaintiff holds various registrations, *inter alia*, under the Trade Marks Act, 1999, which stands enlisted in a tabular fashion in para 6 of the plaint. Among others, the mark UNDER ARMOUR stands registered in the plaintiff's favour in Classes 18, 25 and 28¹ with effect from 24th February 2009 and the mark UA stands registered in the plaintiff's favour in the same classes 18, 25 and 28 with effect from 12th January 2011. For the present, we need not concern ourselves with the other registrations held by the plaintiff.

3.2 Para 35 of the plaint sets out the receipts from sales effected by UA India during the period 2018 to 2021. During the financial year 2020-21, these receipts are to the tune of ₹ 64 crores whereas, during the period April to August 2021, the receipts are to the tune of ₹ 24.7 crores.

3.3 I may note here, that one of the contentions which were advanced by the plaintiff to vouchsafe its reputation, and which is advanced before the Court in several cases, is that on a Google search being done of the word "ARMOUR", the plaintiff's site was one of the first results which popped up. To my mind, such an argument is misconceived. The mere fact that the particular result may pop up on a Google search being done of a particular search thread cannot, without any other data, suffice to establish good will or reputation of a brand,

¹ of the NICE classification

especially *vis-à-vis* other brands. This Court cannot, even *prima facie*, gauge the market repute of a brand on the basis of how quickly it shows up on a Google search. Much would also depend on the search thread that is fed in. As such, the argument of the plaintiff, predicated on its being near the top of the results thrown up when a Google search for ARMOUR is done, does not, *prima facie*, appeal to me as testimony of market repute.

3.4 Nonetheless, given the sales figures of the plaintiff, which are not disputed, the fact that the plaintiff enjoys considerable goodwill and reputation even in the Indian market may, *prima facie*, be taken to be established.

3.5 The plaintiff also operates the interactive websites www.underarmour.com and www.ua.com.

4. Infringement

4.1 The plaintiff uses its UNDER ARMOUR/UA/UNDR ARMOR mark essentially on sports apparel. The plaintiff is aggrieved by the fact that the defendant is, on identical goods, using the marks “STREET ARMOR”, “SA” and “STRT ARMOR”. While doing so, it is alleged that the defendant is using, for its “ARMOR” part of the mark, a font, style and lettering which is deceptively similar to that used by the plaintiff for “ARMOUR”. Even while using “STREET ARMOR” as a device, the plaintiff alleges that the defendant uses a similar font and lettering for “ARMOR” while using a disproportionately small font and lettering for STREET. This has been attempted to be demonstrated in para 54 of the plaint, in the following tabular fashion:

Plaintiff's Marks	Defendant's Marks
UNDER ARMOUR	STREET ARMOR
UA	SA
UNDR ARMR	STRT ARMR
ARMOUR	ARMOR
ARMOUR	
ARMOURFLEECE	STREET ARMOR

4.2 The defendant's argument, on the aspect of infringement, as advanced by Mr. Chander M. Lall, learned Senior Counsel, did not really concentrate on comparing the complete marks of the plaintiff with those of the defendant. The main gravamen of the submission of Mr. Lall was that, in the plaint, the plaintiff had essentially premised its case on the premise that "ARMOUR" was the dominant part of its marks.

4.3 I shall proceed to deal with that aspect of the matter somewhat later. Suffice it to state, however, that I cannot read the plaint as restricting the case that has been sought to be made therein, merely to pleading that the aspect of infringement or passing off has to be decided solely on the basis of the latter ARMOUR part of the marks of the plaintiff. The plea of infringement, as well as a passing off, are

predicated on the entire marks that the plaintiff asserts, i.e. “UNDER ARMOUR”, “UA”, “UNDR ARMR” as well as “ARMOUR” in the distinctive font used by the plaintiff.

4.4 It is true that, in the plaint, the plaintiff has advanced, as one of its principal submissions, the plea that ARMOUR is the dominant part of UNDER ARMOUR and that, as the defendant’s impugned marks too end with ARMOUR, infringement has taken place. That, however, would not justify the Court restricting the scope of examination only to the latter, ARMOUR, part of the plaintiff’s marks, when what is asserted is the entirety thereof. The task of the Court is to ascertain whether, when viewed as a whole, the defendant’s marks infringe the plaintiff’s or whether, by using the said marks, the defendant can be said to have attempted to pass off its goods as those of the plaintiff.

4.5 Is ARMOUR the dominant part of the plaintiff’s marks?

4.5.1 The “dominant part” plea, which is raised in case after case, owes much of its genesis to the judgement of a Division Bench of this Court in *South India Beverages Pvt Ltd v. General Mills Marketing Inc.*² Section 17(1) and (2)(a)³ of the Trade Marks Act specifically confers exclusivity, to a holder of a registered trade mark, only on the

² (2015) 61 PTC 231

³ 17. **Effect of registration of parts of a mark. –**

- (1) When a trade mark consists of several matters, its registration shall confer on the proprietor exclusive right to the use of the trade mark taken as a whole.
- (2) Notwithstanding anything contained in sub-section (1), when a trade mark –
 - (a) contains any part –
 - (i) which is not the subject of a separate application by the proprietor for registration as a trade mark; or
 - (ii) which is not separately registered by the proprietor as a trade mark; or
 - (b) contains any matter which is common to the trade or is otherwise of a non-distinctive character,

the registration thereof shall not confer any exclusive right in the matter forming only a part of the whole of the trade mark so registered.

right to use the mark *taken as a whole*, and disallows any claim to exclusivity in matter which forms *only a part of the whole of the trade mark so registered*, except where the said part is either subject matter of a separate application seeking registration, or is separately so registered. ***South India Beverages***², however, held:

“The Rule of Anti-Dissection

16. This rule mandates that the Courts whilst dealing with cases of trademark infringement involving composite marks, must consider the composite marks in their entirety as an indivisible whole rather than truncating or dissecting them into its component parts and make comparison with the corresponding parts of arrival mark to determine the likelihood of confusion. The *raison d'être* underscoring the said principle is that the *commercial impression of a composite trademark on an ordinary prospective buyer is created by the mark as a whole and not by its component parts* [***Fruit of the loom, Inc. v. Girouard***⁴; ***Autozone, Inc. v. Tandy Corporation***⁵].

17. The Court of Appeals of the Federal Circuit in its decision reported as ***Shen Mfg. Co. v. The Ritz Hotel***⁶, had the occasion to apply the principle of ‘*anti-dissection*’. The appellant owned and operated hotels under the trademarks ‘RITZ PARIS’ and ‘HOTEL RITZ’. He also operated under the trademark ‘PUTTING ON THE RITZ’ for shower curtains. The respondent owned the trademark ‘RITZ’ and had also been using it in connection with the sale of kitchen textiles, towels, potholders, etc. The respondent opposed the appellant's application for the registration of the trademarks ‘PUTTING ON THE RITZ’. The Court applied the anti-dissection rule and held that the mark must be viewed in its entirety. It observed that the rule ensures that the mark is evaluated in the same way as a prospective buyer i.e. the commercial impression of the mark as a whole needs to be considered. It held that the trademark ‘PUTTING ON THE RITZ’ when evaluated as a whole, conveyed an image of ‘*comfort, sophistication and wealth*’ which was completely different from the commercial impression that respondent's mark gave, which is that of cooking or manual labour.

18. Similarly in the decision reported as ***Fruit of the Loom***⁴, the Court repelled the claim of infringement by applying the principle of ‘*anti-dissection*’. The plaintiff operated under the trademark ‘FRUIT OF THE LOOM’, whereas the defendant operated under the trade name ‘FRUIT FLOPS’ and ‘FRUIT

⁴ 994 F.2d 1359, 1362 (9th Cir. 1993)

⁵ 174 F. Supp. 2d 718, 725 (M.D. Tenn. 2001)

⁶ 393 F.3d 1238 (Fed. Cir. 2004)

CUPS’. Both parties were in the business of manufacturing and selling garments. The plaintiff brought a suit of infringement of trademark against the defendant. The Court compared the ‘FRUIT OF THE LOOM’ mark to ‘FRUIT FLOPS’ and ‘FRUIT CUPS’ mark and found the marks to be dissimilar. The Court observed that the purchasers view the ‘FRUIT OF THE LOOM’ mark as a whole rather than as dissected parts. It was further held that *it is the combination of the terms in its entirety that constitute plaintiff’s distinctive mark.*

The Identification of ‘Dominant Mark’

19. Though it bears no reiteration that while a mark is to be considered in entirety, yet it is permissible to accord more or less importance or ‘*dominance*’ to a particular portion or element of a mark in cases of composite marks. Thus, a particular element of a composite mark which enjoys greater prominence vis-à-vis other constituent elements, may be termed as a ‘*dominant mark*’.

20. At this juncture it would be apposite to refer to a recent decision of this Court reported as ***Stiefel Laboratories v. Ajanta Pharma Ltd***⁷. The Court whilst expounding upon the principle of ‘anti-dissection’ cited with approval the views of the eminent author on the subject comprised in his authoritative treatise-McCarthy on Trademarks and Unfair Competition. It was observed:

“41. The anti-dissection rule which is under these circumstances required to be applied in India is really based upon nature of customer. It has been rightly set out in McCarthy on Trademarks and Unfair Competition about the said rule particularly in Para 23.15 which is reproduced hereunder:

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

⁷ 211 (2014) DLT 296

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.”[Emphasis Supplied]

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

22. We may refer to the decision of the United States Court of Appeals for the Federal Circuit reported as ***Re Chatam Int’l, Inc***⁸, wherein the Court enunciated the interplay between the principle of ‘*anti dissection*’ and identification of ‘*dominant mark*’. The Court, while ascertaining whether the mark ‘JOSE GASPAR GOLD’ was similar to the registered mark ‘GASPAR’S ALE’, held that ‘GASPAR’ was clearly the dominant element in the two marks and resembled the relevant mark enough to cause a likelihood of confusion, to cause a mistake or to deceive. Relevant would it be to note that the defendant in the said case urged that the approach of splitting of the marks was in violation of the anti-dissection rule. The said contention was repelled by the Court and it was pertinently observed that there was no violation of anti-dissection rule because the *marks were any way examined in entirety, and each individual term in the marks were given more or less weightage depending on the overall impression it appeared to create*. The Court was of the view that both marks convey the commercial impression that a name, GASPAR, is the source of related alcoholic beverages, tequila or ale. In other words, the commercial significance of ALE in the registered mark ‘GASPAR’S ALE’ and JOSE and GOLD in appellant’s mark ‘JOSE’S GASPAR GOLD’ assumed less significance in the opinion of the Court.

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

⁸ 380 F.3d 1340

26. Dominant features are significant because they attract attention and consumers are more likely to remember and rely on them for purposes of identification of the product. Usually, the dominant portion of a mark is that which has the greater strength or carries more weight. Descriptive or generic components, having little or no source identifying significance, are generally less significant in the analysis. However, words that are arbitrary and distinct possess greater strength and are thus accorded greater protection.[*Autozone*⁵]

(Emphasis in original)

4.5.2 Thus, where a composite mark consists of various parts, of which one or the other is dominant, the Court can, while assessing whether the mark is infringed by another mark, take into account the dominant part thereof. The decision in *South India Beverages*² holds, unexceptionably, that, as, by doing so, the Court would merely be formulating a mechanism to compare the marks to assess infringement or passing off, Section 17(2) would not be infringed.

4.5.3 This principle would apply, however, where, of the various parts of a mark, a Court could identify one or the other as dominant. I see no reason to regard ARMOUR/ARMOR, either in UNDER ARMOUR or in STREET ARMOR, as the dominant part of the mark. The principal test to determine whether any one part of a mark is dominant is, unquestionably, the test of whether, when the mark is seen by a customer of average intelligence and imperfect recollection, any one part of the mark would impress itself more strongly on his psyche than the others. Viewed empirically and as a mark *per se*, and in the absence of any material or evidence to indicate to the contrary, I am unable to convince myself that UNDER, or STREET, is any less dominant, in UNDER ARMOUR or STREET ARMOR, than ARMOUR or ARMOR, respectively. The plea of the plaintiff that ARMOUR constitutes the dominant part of the plaintiff's UNDER

ARMOUR mark, therefore, does not *prima facie* commend itself to acceptance.

4.6 That, however, would make no real difference as, ultimately, the issue before the Court is whether the plaintiff's marks, seen as whole marks, are, or are not, infringed by the defendants'.

4.7 In my *prima facie* opinion, when viewed as whole marks, the marks of the defendant have to be regarded as infringing the marks of the plaintiff within the meaning of Section 29(2)(b)⁹ of the Trade Marks Act, for the following reasons:

(i) 'ARMOUR' is not descriptive of sports apparel, as the discussion to follow later in this judgement would reveal. To a customer of average intelligence and imperfect recollection, therefore, who first chances across the plaintiff's UNDER ARMOUR mark and, at a later point of time, comes across the defendant's STREET ARMOR mark, *used on identical goods, i.e. sports apparel*, there is every possibility of confusion, or at the very least, of a feeling that there could be an association between the two marks. All that is needed, for possibility of confusion or deception to be said to exist, is for the customer to

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

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

(2) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which because of—

(a) its identity with the registered trade mark and the similarity of the goods or services covered by such registered trade mark; or

(b) its similarity to the registered trade mark and the identity or similarity of the goods or services covered by such registered trade mark; or

(c) its identity with the registered trade mark and the identity of the goods or services covered by such registered trade mark,

is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trade mark.

be placed in a “state of wonderment”. The distinction between “confusion” and “deception” was thus explained in *Shree Nath Heritage Liquor Pvt Ltd v. Allied Blenders & Distillers Pvt Ltd*.¹⁰:

“6. When a person knows that the mark in question does not originate from the senior user but the senior user is called to mind, then it's a step before confusion. If on the other hand, the consumer is in a state of wonderment if there's a connection, this is confusion. Further, if this consumer then purchases the junior users product, this is then deception.”

(ii) The fact that the plaintiff's and defendant's marks are used for identical goods is of considerable significance in this regard. A customer of average intelligence and imperfect recollection who comes across the plaintiff's UNDER ARMOUR, or UNDR ARMR mark on sports wear at one point of time and, some time later, chances on the defendant's STREET ARMOR or STRT ARMR mark on identical sports apparel, is bound, in my considered opinion, to wonder whether there does not exist a connection between the two marks, or whether he has not seen the mark earlier. The use, by the defendant, of a closely similar manner of abbreviating its name – as STRT ARMR, *vis-à-vis* the plaintiff's UNDR ARMR – would only fortify this impression. That fact that a chance of such an inference of association between the marks exists is sufficient to constitute infringement, within the meaning of Section 29(2)(b) of the Trade Marks Act.

(iii) In fact, (a) the abbreviation, by the defendant, of its STREET ARMOR mark to STRT ARMR, similar to the

¹⁰ 221 (2015) DLT 359 (Del – DB)

manner in which the plaintiff has abbreviated UNDER ARMOUR to UNDR ARMR, (b) the use, for the ARMOR part of the STREET ARMOR mark, of a font which is similar to that used by the plaintiff for its ARMOUR mark and (c) the use of an almost imperceptibly small font size for ‘STREET’ in the



logo, compared to ‘ARMOR’, indicates that the defendant was “straining every nerve” to approach as close to the plaintiff’s mark and, thereby, deceive the public, as possible. In such circumstances, the following exordium of Lord Lindley, in *Slazenger & Sons v. Feltham & Co.*¹¹ squarely applies:

“One must exercise one's common sense, and, if you are driven to the conclusion that what is intended to be done is to deceive if possible, I do not think it is stretching the imagination very much to credit the man with occasional success or possible success. Why should we be astute to say that he cannot succeed in doing that which he is straining every nerve to do?”

(iv) The following words of Kekewich, J., in *Munday v. Carey*¹² are also instructive, in this context, regarding the manner in which the Court is required to approach the issue of infringement in such cases:

“Where you see dishonesty, then even though the similarity were less than it is here, you ought, I think, to pay great attention to the items of similarity, and less to the items of dissimilarity.”

The use, by the defendant, of the STRT ARMR abbreviation and of a lettering and style, for ‘ARMOR’, which is strikingly similar to that in which the plaintiff prints ARMOUR, in my view, *prima facie* betokens dishonesty. The use of the suffix

¹¹ (1889) 6 RPC 531

¹² (1905) 22 RPC 273

ARMOR, *vis-à-vis* the plaintiff's ARMOUR, seen in conjunction with the font in which the defendant prints ARMOR, and the fact that the both marks are used for identical goods, would be available at the same outlets, and cater to the same consumer segment (the classical 'trinity test') would, conjointly seen, suffice to constitute enough points of similarity as would lead to a clear possibility of confusion in the mind of the customer of average intelligence and imperfect recollection.

(v) Besides, the matter has to be examined from the point of view of initial interest confusion. It has to be examined from the point of view of a customer of average intelligence and imperfect recollection who, after having come across the goods bearing the plaintiff's mark, comes across the mark of the defendant at a somewhat later point of time. The question that is to be asked is whether, in such a situation, the customer of average intelligence and imperfect recollection is likely to be placed in a state of wonderment as to whether the mark is the same as that one he had earlier seen, or whether the mark which is before him bears an association to the mark that he had seen earlier. If such a feeling arises *when the customer initially views the defendants' mark* – having seen the plaintiff's some time earlier – that feeling, by itself, suffices to make out a case of infringement. The *initial impression* is what, fundamentally, matters.

(vi) Section 29(2)(b) of the Trade Marks Act, 1999 specifically provides that where the marks of the plaintiff and the defendant are similar, and are used on identical goods, and

there is a chance of likelihood or confusion as a result of the similarity in the marks and the similar/identity of the goods on which the marks are used, a case of infringement is made out. In this context, one may analogize the present case to that fact that came before the Supreme Court in *Amritdhara Pharmacy v. Satyadeo Gupta*¹³.

(vii) The *Amritdhara* principles: In *Amritdhara*¹³, which arose under the Trade Marks Act, 1940, the competing marks AMRITDHARA (of the plaintiff) and LAXMANDHARA (of the defendant) were used for similar Ayurvedic preparations. AMRITDHARA was registered as a trade mark. The defendant contended that there was no phonetic similarity between AMRITDHARA and LAXMANDHARA. The Supreme Court identified two issues as arising before it, of which we are concerned only with the first, viz., “whether the name ‘Laxmandhara’ was likely to deceive the public or cause confusion”. In para 6 of the report, the Supreme Court noted the fact that the statute, while using the words “likely to deceive or cause confusion”, did not lay down any criteria in that regard and that, therefore, “every case must depend on its own particular facts, and the value of authorities lies not so much in the actual decision as in the tests applied for determining what is likely to deceive or cause confusion”. The definitive test, in that regard, was postulated, further in the same paragraph, thus:

“...A trade mark is likely to deceive or cause confusion by its resemblance to another already on the Register if it is likely to do so in the course of its legitimate use in a market where the two marks are assumed to be in use by traders in that market. In considering the matter, all the circumstances

¹³ (1963) 2 SCR 484

of the case must be considered. As was observed by Parker, J., in *Pianotist Co Application*¹⁴ which was also a case of the comparison of two words.

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

For deceptive resemblance two important questions are : (1) who are the persons whom the resemblance must be likely to deceive or confuse, and (2) what rules of comparison are to be adopted in judging whether such resemblance exists. As to confusion, it is perhaps an appropriate description of the state of mind of a customer who, on seeing a mark thinks that it differs from the mark on goods which he has previously bought, but is doubtful whether that impression is not due to imperfect recollection. (See Kerly on Trade Marks, 8th Edition, p. 400.)”

These words continue to represent the legal position, on the aspect of confusing or deceptive similarity in the case of rival word marks, to this day. Applying these tests, the Supreme Court went on to hold that the name “LAXMANDHARA” was confusingly similar to “AMRITDHARA” thus, in paras 7 to 9 and 12 of the report:

“7. Let us apply these tests to the facts of the case under our consideration. *It is not disputed before us that the two names “Amritdhara” and “Lakshman-dhara” are in use in respect of the same description of goods, namely a medicinal preparation for the alleviation of various ailments. Such medicinal preparation will be purchased mostly by people who instead of going to a doctor wish to purchase a medicine for the quick alleviation of their suffering, both villagers and townsfolk, literate as well as illiterate.* As we said in *Corn Products Refining*

¹⁴ (1906) 23 RPC 774

*Co. v. Shangrila Food Products Ltd.*¹⁵ the question has to be approached from the point of view of a man of average intelligence and imperfect recollection. To such a man the overall structural and phonetic similarity-of the two names “Amritdhara” and “Lakshmandhara” is, in our opinion, likely to deceive or cause confusion. We must consider the overall similarity of the two composite words “Amritdhara” and “Lakshmandhara”. We do not think that the learned Judges of the High Court were right in saying that no Indian would mistake one for the other. An unwary purchaser of average intelligence and imperfect recollection would not, as the High Court supposed, split the name into its component parts and consider the etymological meaning thereof or even consider the meaning of the composite words as “current of nectar” or “current of Lakshman”. He would go more by the overall structural and phonetic similarity and the nature of the medicine he has previously purchased, or has been told about, or about which has otherwise learnt and which he wants to purchase. Where the trade relates to goods largely sold to illiterate or badly educated persons, it is no answer to say that a person educated in the Hindi language would go by the etymological or ideological meaning and see the difference between “current of nectar” and “current of Lakshman”. “Current of Lakshman” in a literal sense has no meaning; to give it meaning one must further make the inference that the “current or stream” is as pure and strong as Lakshman of the Ramayana. An ordinary Indian villager or townsman will perhaps know Lakshman, the story of the Ramayana being familiar to him; but we doubt if he would etymologise to the extent of seeing the so-called ideological difference between “Amritdhara” and “Lakshmandhara”. He would go more by the similarity of the two names in the context of the widely known medicinal preparation which he wants for his ailments.

8. We agree that the use of the word “dhara” which literally means “current or stream” is not by itself decisive of the matter. What we have to consider here is the overall similarity of the composite words, having regard to the circumstance that the goods bearing the two names are medicinal preparations of the same description. We are aware that the admission of a mark is not to be refused, because unusually stupid people, “fools or idiots”, may be deceived. A critical comparison of the two names may disclose some points of difference, but an unwary purchaser of average intelligence and imperfect recollection would be deceived by the overall similarity of the two names having regard to the nature of the medicine

¹⁵ (1960) (1) SCR 968

*he is looking for with a somewhat vague recollection that he had purchased a similar medicine on a previous occasion with a similar name. The trade mark is the whole thing-the whole word has to be considered. In the case of the application to register "Erectiks" (opposed by the proprietors of the trade mark "Erector") Farwell, J., said in **William Bailey (Birmingham) Ltd. Application**¹⁶:*

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

9. *Nor do we think that the High Court was right in thinking that the appellant was claiming a monopoly in the common Hindi word "dhara". We do not think that that is quite the position here. What the appellant is claiming is its right under Section 21 of the Act, the exclusive right to the use of its trade mark, and to oppose the registration of a trade mark which so nearly resembles its trade mark that it is likely to deceive or cause confusion.*

12. *On a consideration of all the circumstances, we have come to the conclusion that the overall similarity between the two names in respect of the same description of goods was likely to cause deception or confusion within the meaning of Section 10(I) of the Act and the Registrar was right in the view he expressed. The High Court was in error in taking a contrary view."*

(Emphasis supplied)

I may note that though Section 10 of the Trade Marks Act, 1940, which was the statutory provision that applied in **Amritdhara**¹³ was not nearly as comprehensive as Section 29 of the present Trade Marks Act, yet, for the purpose of applicability of **Amritdhara**¹³ as a precedent, sub-section (1) thereof was similar in concept, insofar as it envisaged

¹⁶ (1935) 52 RPC 137

likelihood of confusion or deception as the definitive test for infringement:

“10. Prohibition of registration of identical or similar trade mark. –

(1) Save as provided in sub-section (2), no trade mark shall be registered in respect of any goods or description of goods which is identical with a trade mark belonging to a different proprietor and already on the register in respect of the same goods or description of goods, or which so nearly resembles such trade mark *as to be likely to deceive or cause confusion.*”

What is, however, of considerable significance, when comparing Section 10(1) of the 1940 Trade Marks Act with Section 29(2) of the present Trade Marks Act, and the applicability of *Amritdhara*¹³ as a precedent, is the fact that, in Section 29(2), it is not merely likelihood of confusion or deception that would betoken infringement; infringement would also stand established if there is likelihood of “an association with the registered trade mark”. Section 29(2) of the Trade Marks Act, 1999, therefore, casts a wider net than Section 10(1) of the Trade Marks Act, 1940, did. Keeping this statutory distinction in mind, the principles that emerge from *Amritdhara*¹³ are (taking care to retain, as far as possible, the actual words used by the Supreme Court) that

- (a) the possibility of confusion or deception has to be gauged in the course of the legitimate use of the impugned mark in a market where the two marks are assumed to be in use by traders,
- (b) in doing so, all the circumstances of the case must be considered,
- (c) where the rival marks were word marks, the *Pianotist*¹⁴ test would apply, which requires the Court to

- (i) judge the two words by look and sound,
 - (ii) keep in mind the goods to which the marks apply,
 - (iii) keep in mind the nature and kind of customer who would be likely to buy those goods,
 - (iv) consider, in fact, all circumstances, and
 - (v) also consider what is likely to happen if each of the marks is used in a normal way as a trade mark for the goods of the respective owners of the marks,
- (d) the two important questions are
- (i) who the persons, whom the resemblance must be likely to deceive or confuse, are and
 - (ii) the rules of comparison to be adopted in judging whether such resemblance exists, and
- (e) “confusion” was an appropriate description of the state of mind of a customer who, on seeing a mark thinks that it differs from the mark on goods which he has previously bought, but is doubtful whether that impression is not due to imperfect recollection.

(viii) How the Supreme Court applied the principles to the facts before it: It is also important to note how the Supreme Court applied these principles to the facts before it. In holding that the name LAXMANDHARA was confusingly or deceptively similar to AMRITDHARA, the Supreme Court observed (again retaining, to the extent possible, the words of the Supreme Court) that

- (i) the two names were in use in respect of the same description of goods, namely a medicinal preparation for the alleviation of various ailments,
- (ii) such medicinal preparations would be purchased mostly by people who, instead of going to a doctor, wished to purchase a medicine for the quick alleviation of their suffering, *both villagers and townsfolk, literate as well as illiterate,*
- (iii) the question had to be approached from the point of view of a man of average intelligence and imperfect recollection,
- (iv) the Court had to consider the overall similarity of the two composite words Amritdhara and Laxmandhara,
- (v) *to such a man of average intelligence and imperfect recollection, the overall structural and phonetic similarity of the two names Amritdhara and Lakshmandhara was likely to deceive or cause confusion,* as he would not split the name into its component parts and consider the etymological meaning thereof, but would go more by the overall structural and phonetic similarity and the nature of the medicine he had previously purchased, or told about, or about which he had otherwise learnt and which he wanted to purchase,
- (vi) the Court was required to consider the overall similarity of the composite words, having regard to the circumstance that the goods bearing the two names were medicinal preparations of the same description,
- (vii) though a critical comparison of the two names may disclose some points of difference, an unwary purchaser

of average intelligence and imperfect recollection would be deceived by the overall similarity of the two names having regard to the nature of the medicine he is looking for *with a somewhat vague recollection that he had purchased a similar medicine on a previous occasion with a similar name.*

I have deemed it appropriate to place especial emphasis on the underscored words because, in my opinion, they are words – taken verbatim from the judgment of the Supreme Court – which encapsulate, *in excelsis*, the primordial principle for gauging infringement.

(viii) When we apply *this* test to the present case, on the aspect of infringement, the result appears pre-ordained. An unwary purchaser of average intelligence and imperfect recollection, who has once purchased sportswear bearing the plaintiff's UNDER ARMOUR, or UNDR ARMR, mark has every chance, on later coming across the defendant's STREET ARMOUR, or STRT ARMR, mark, *having a vague recollection that he had purchased a similar piece of sportswear on a previous occasion with a similar name.* That, in the words of the Supreme Court in *Amritdhara*¹³, suffices to constitute infringement.

(ix) Further, as already noted, unlike Section 10(1) of the 1940 Trade Marks Act which applied in *Amritdhara*, Section 29(2)(b) also treats, as indicating infringement, a case in which the customer of average intelligence and imperfect recollection, on seeing the defendant's mark, *is likely to presume an association with the mark of the plaintiff.* To my mind, having

seen, or purchased, an UNDER ARMOUR item of sportswear, if such a customer were, later, see the defendant's STREET ARMOUR sportswear, there is every likelihood of his presuming an association between the mark of the defendant and the earlier mark of the plaintiff which he had seen some time back. That possibility, again, would indicate, *prima facie*, infringement.

(x) As the Supreme Court holds, by so ruling, the plaintiff is not being allowed a monopoly on the suffix ARMOUR. The two marks are compared as wholes, and not in their respective parts.

4.8 As in the case of *Amritdhara*¹³, the latter part of the two marks in the present case is the same, i.e., "ARMOUR" and "ARMOR". The fact that the defendant has chosen to abbreviate its complete name to "STRT ARMR" indicates a conscious attempt to use an abbreviation similar to that used by the plaintiff which is "UNDR ARMR". All these factors, put together, *prima facie*, make out a case of infringement, by the defendant, using the impugned marks, of the marks asserted in the plaint.

5. Is the 'ARMOUR' part of the plaintiff's marks descriptive?

5.1 Mr. Lall sought to contend that in the facts of the present case, the decision which would apply would not be *Amritdhara*¹³, but would be *J.R. Kapoor v. Micronix India*¹⁷. This contention is predicated on the premise that the "ARMOUR" part of the plaintiff's

¹⁷ (1994) Supp (3) SCC 215

mark is descriptive, unlike *Amridhara*¹³, where the “DHARA” part of the mark was not descriptive in nature. Where the common part of the mark is descriptive, and the remainder of the rival marks are dissimilar, Mr. Lall would seek to contend, on the basis of *J.R. Kapoor*¹⁷, that no case of infringement can be said to exist.

5.2 On the fact that, if the common part of the rival marks is descriptive of the goods on which the mark is affixed, and the remaining parts of the marks are dissimilar, *J.R. Kapoor*¹⁷ holds that there is no infringement, I entirely agree with Mr Lall.

5.3 ‘ARMOUR’ is not, however, in my opinion, descriptive of the goods either of the plaintiff or of the defendants.

5.4 In order to support his submission that the “ARMOUR” was descriptive in nature, Mr. Lall has relied on three facts. The first is that, the name “UNDER ARMOUR” was coined in 1996 to be used as a mark on T-shirts made of moisture wicking synthetic fabric which could be worn under the jersey and would absorb sweat (as is mentioned in para 5 of the plaint). As such, it literally conformed to the description of “under armour”. The second basis for Mr. Lall’s contention is predicated to the dictionary meaning of “armour”. Mr. Lall has referred me to the meaning of “armour” which has, resulting from a Google search of the meaning of the expression, which defines “armour” as “clothing, often made of metal that soldiers wore in earlier times to protect themselves”. As such, even when used for clothing, Mr. Lall would submit that the word “armour” is descriptive in nature. The third basis for Mr. Lall’s contention is the application submitted by the plaintiff while seeking to register the mark “UNDER ARMOUR” which includes, among the categories of items

encompassed in the class for which the registration was sought, “protective clothing”.

5.5 Mr. Bansal, learned Counsel for the plaintiff advanced a preliminary objection to this line of argument of Mr. Lall, contending that, as the defendant had itself applied for registration of the mark “STREET ARMOUR”, it was estopped from contending that “ARMOUR” was descriptive. The submission is obviously misconceived, as the defendant’s application was not for registration of “ARMOUR” *per se*, but for registration of the complete mark “STREET ARMOUR”.

5.6 On merits, however, I am unable to subscribe to the point of view espoused by Mr. Lall.

5.7 To my mind, “Armour” when used in the context of clothing, especially in the context of sportswear, cannot, by any stretch of imagination, be treated as descriptive in nature. Sportswear is not armour, nor is it armorial in nature. At the highest, it might have been possible to advance an argument that, if the clothing in respect of which the mark “ARMOUR” was being sought to be used was protective, the mark might have been suggestive in nature. Even then, it could not be said that it was descriptive.

5.8 This Court has, on more occasions than one, recognised the difference between descriptive marks and suggestive marks. Marks which are suggestive can be registered, though marks which are descriptive cannot be registered in view of the proscription contained

in Section 9(1)(b)¹⁸ of the Trade Marks Act. For this purpose, one may refer to the following passages from the judgement of a coordinate bench of this Court in *Telecare Network India Pvt Ltd v. Asus Technology Pvt Ltd*¹⁹:

“22. There are various types of trademarks. Initially four categories of trademarks i.e. (1) generic, (2) descriptive, (3) suggestive, and (4) arbitrary or fanciful were set out in *Abercrombie & Fitch Co. v. Hunting World, Inc.*²⁰. Subsequently in *Two Pesos, Inc. v. Taco Cabana, Inc.*²¹, it was held that there are five categories of trademarks. The relevant portion of the said judgment is reproduced hereinbelow: -

“... Marks are often classified in categories of generally increasing distinctiveness; following the classic formulation set out by Judge Friendly, they may be (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful. ...The latter three categories of marks, because their intrinsic nature serves to identify a particular source of a product, are deemed inherently distinctive and are entitled to protection. In contrast, generic marks-those that “refe[r] to the genus of which the particular product is a species,” Park N Fly, Inc. v. Dollar Park & Fly, Inc.²², citing Abercrombie & Fitch Co²⁰, supra, at 9-are not registrable as trademarks. Park ‘N Fly²², supra, at 194.

Marks which are merely descriptive of a product are not inherently distinctive. When used to describe a product, they do not inherently identify a particular source, and hence cannot be protected. However, descriptive marks may acquire the distinctiveness which will allow them to be protected under the Act. Section 2 of the Lanham Act provides that a descriptive mark that otherwise could not

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

- (1) The trade marks –
- (a) which are devoid of any distinctive character, that is to say, not capable of distinguishing the goods or services of one person from those of another person;
 - (b) which consist exclusively of marks or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, values, geographical origin or the time of production of the goods or rendering of the service or other characteristics of the goods or service;
 - (c) which consist exclusively of marks or indications which have become customary in the current language or in the bona fide and established practices of the trade,

shall not be registered:

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

¹⁹ 262 (2019) DLT 101 : (2019) 79 PTC 99

²⁰ 537 F.2d 4, 9 (2nd Cir. 1976)

²¹ 505 US 763

²² 469 U.S. 189, 194 (1985)

be registered under the Act may be registered if it “has become distinctive of the applicant's goods in commerce.”.

...

The general rule regarding distinctiveness is clear: An identifying mark is distinctive and capable of being protected if it either (1) is inherently distinctive or (2) has acquired distinctiveness through secondary meaning. ...”

23. The said categorisation of trademarks has been accepted by a Coordinate Bench of this Court in ***Evergreen Sweet House v. Ever Green***²³, wherein it was held that the mark ‘Evergreen’ in its application to sweets and confections is an arbitrary one and accordingly is entitled to protection.

24. The term ‘generic’ refers to the ‘genus’ to which a particular product or service is a species of.

25. The term ‘descriptive’ refers to a word/mark which describes an article/service, its qualities, ingredients or characteristics.

26. However, often the lines differentiating different categories of marks are blurred. Often, distinctions between suggestive, fanciful and arbitrary marks may seem artificial.

27. For instance, in ***Abercrombie & Fitch Co.***²⁰ (*supra*) it was explained that “Deep Bowl” when used for an article which is a deep bowl, does not only describe the article, but also identifies it. Therefore, “Deep Bowl” is generic when used for a deep bowl. Similarly the term “spoon” is not merely descriptive of the article i.e. spoon, but identifies the article and therefore, is generic.

28. However, the mark “Deep Bowl Spoon” for a spoon merely describes the significant characteristic of being able to reach deep in a bowl. It is not descriptive of the article i.e. spoon, since the article is not a deep bowl, but a spoon.

29. In common law, neither the generic nor merely descriptive terms are valid trademarks and the exclusive use of such terms is not entitled to legal protection. However, protection is awarded to descriptive marks which have acquired secondary significance.

30. *The category of suggestive marks refers to those marks which are neither exactly descriptive on the one hand, nor truly fanciful on the other. A term is suggestive if it requires imagination, thought and perception to reach a conclusion as to the nature of the goods. If a term is suggestive, it is entitled to registration without proof of secondary meaning.* For instance, as

²³ 2008 (38) PTC 325 (Del)

pointed out in *Abercrombie & Fitch Co.*²⁰ (*supra*) the word “Ideal” when used for hair brushes, is in no sense indicative or descriptive of the qualities or characteristics or merits of a brush. It is therefore not descriptive. However, the word “Ideal” for hairbrushes does suggest that the product meets the very highest ideal mental conception of what a hair brush should be and is therefore suggestive.

31. The term ‘fanciful’ refers to a mark which is an invented word solely for use as trademarks. When a common word is applied in an unfamiliar way, it is called an ‘arbitrary’ mark. For instance, “Ivory” would be generic when used to describe a product made from the tusks of elephants but would be arbitrary when applied to a soap.

32. Fanciful and arbitrary terms enjoy all rights accorded to suggestive marks and are also entitled to registration without proof of secondary meanings.

33. Keeping in view the aforesaid mandate of law, this Court is of the view that a word may be generic *qua* a specific business or trade or industry but not across the board for all business or trades or industries. For instance, the word “Arrow” is a generic word *qua* archery business, but is an arbitrary word *qua* shoes.”

Applying the understanding of suggestive marks contained in para 30 from *Teleecare Network*¹⁹, “armour”, when used for sportswear would, at best, be suggestive, as it would need a degree of imagination to visualize that the term was used because the apparel in question was intended to be protective in nature. In the present case, however, as Mr. Bansal correctly submits, the sports apparel on which the plaintiff’s marks are used is not protective. “ARMOUR”, when used for such apparel, cannot, therefore, be regarded even as suggestive, but is *prima facie* arbitrary.

5.9 The reliance, by Mr. Lall, on the initial provocation for use of the term “UNDER ARMOUR”, at the time when the “UNDER ARMOUR” mark was initially coined, is obviously without substance. What has to be seen is not the provocation for coining the

mark at the time when it was coined, but the nature of the use to which the mark is being put at this point of time. Presently, it is not in dispute that the “UNDER ARMOUR” mark is being used by the plaintiff, not merely for vests or other clothing which to be worn under any other outer apparel but for sportswear *per se*. It cannot, therefore, be said that, as used on date, “ARMOUR” is even suggestive, much less descriptive, in nature.

5.10 Again, the reliance by Mr. Lall, on the dictionary meaning of “ARMOUR” is also, in my considered opinion, bereft of merit. The aspect of whether a particular mark is descriptive, or not, cannot be decided by referring to dictionaries. The test of infringement, or of passing off, is to be decided from the point of view of a customer of average intelligence and imperfect recollection, and such a customer does not walk around with a dictionary in his hand. The test has, therefore, to be one of common parlance. In common parlance, “ARMOUR” cannot be regarded as descriptive of sportswear.

5.11 This is quite apart from the fact that in the present case, we are not concerned with “ARMOUR” *per se*, but with the complete mark “UNDER ARMOUR”. The complete marks used by the plaintiff, when viewed *vis-à-vis* the complete marks used by the defendant and keeping in mind the fact that both sets of marks are used on identical goods, *prima facie*, indicate a case of infringement to exist.

6. The ‘common to trade’ defence

6.1 Mr. Lall also advanced the contention that the mark “ARMOUR” was common to trade and that the plaintiff was,

therefore, operating in what he, interestingly, called a “crowded market place”. He relied, for this purpose, on a tabular statement, filed with the reply to the present application, in which there is a reference to a large number of marks which include the word “ARMOUR”. Thus, submits Mr. Lall, even the register of trade marks, insofar as the word “ARMOUR” is concerned, was crowded.

6.2 With all due respect to the felicity of Mr Lall in presenting, for judicial consideration, the somewhat innovative concept of a crowded market place, the Trade Marks Act does not recognise any such concept. The proscription against claiming of exclusivity in respect of part of a mark is to be found in Section 17(2). That provision proscribes claiming of exclusivity in respect of part of a registered trademark, where the said part is “common to the trade”. A Division Bench of this Court has already examined the ingredients which are required to be satisfied before Section 17(2) can be invoked against the plaintiff, to dispute the entitlement of the plaintiff to seek claim exclusivity in respect of the whole or part of the mark which is asserted in the plaint. In *Pankaj Goel v. Dabur India*²⁴, this Court has spoken thus:

“21. As far as the Appellant’s argument that the word MOLA is common to the trade and that variants of MOLA are available in the market, we find that the Appellant has not been able to prima facie prove that the said ‘infringers’ had significant business turnover or they posed a threat to Plaintiff’s distinctiveness. In fact, we are of the view that the Respondent/Plaintiff is not expected to sue all small type infringers who may not be affecting Respondent/Plaintiff business. The Supreme Court in *National Bell v. Metal Goods*²⁵, has held that a proprietor of a trademark need not take action against infringement which do not cause prejudice to its distinctiveness. In *Express Bottlers Services Pvt. Ltd. v. Pepsi Inc*²⁶, it has been held as under:—

²⁴ (2008) 38 PTC 49 (DB)

²⁵ (1970) 3 SCC 665

²⁶ (1989) 7 PTC 14

“...To establish the plea of common use, the use by other persons should be shown to be substantial. In the present case, there is no evidence regarding the extent of the trade carried on by the alleged infringers or their respective position in the trade. If the proprietor of the mark is expected to pursue each and every insignificant infringer to save his mark, the business will come to a standstill. Because there may be occasion when the malicious persons, just to harass the proprietor may use his mark by way of pinpricks.... The mere use of the name is irrelevant because a registered proprietor is not expected to go on filing suits or proceedings against infringers who are of no consequence... Mere delay in taking action against the infringers is not sufficient to hold that the registered proprietor has lost the mark intentionally unless it is positively proved that delay was due to intentional abandonment of the right over the registered mark. This Court is inclined to accept the submissions of the respondent No. 1 on this point... The respondent No. 1 did not lose its mark by not proceeding against insignificant infringers...”

22. In fact, in *Dr. Reddy Laboratories v. Reddy Pharmaceuticals*²⁷, a Single Judge of this Court has held as under:—

“...the owners of trade marks or copy rights are not expected to run after every infringer and thereby remain involved in litigation at the cost of their business time. If the impugned infringement is too trivial or insignificant and is not capable of harming their business interests, they may overlook and ignore petty violations till they assume alarming proportions. If a road side Dhaba puts up a board of “Taj Hotel”, the owners of Taj Group are not expected to swing into action and raise objections forthwith. They can wait till the time the user of their name starts harming their business interest and starts misleading and confusing their customers.””

(Emphasis supplied)

6.3 Relying on *Pankaj Goel*²⁴, this Bench has, in a recent decision in *Glaxosmithkline Pharmaceuticals Ltd. v. Horizon Bioceuticals Pvt. Ltd*²⁸, observed as under:

“7.2.4 The onus to establish the existence of the ingredients to

²⁷ (2004) 29 PTC 435

²⁸ 2023: DHC: 2390

substantiate a plea that a mark, or a part thereof, is common to the trade, is unquestionably on him who so asserts. It is for Mr. Khera, therefore, to positively establish, at least *prima facie*, that the suffix DEX is common to the trade in pharmaceutical preparations. I do not think that he has succeeded in doing so.

7.2.5 How has Mr. Khera attempted to discharge this burden? He has cited a number of pharmaceutical products, the names of which end in DEX. The question is – does the burden on him thus stand discharged?

7.2.6 **Pankaj Goel**²⁴ would indicate otherwise, but, before advertent to that decision, another facet of this issue merits mention.

7.2.8 For the rest, the issue stands covered by the passages from **Pankaj Goel**²⁴ reproduced supra. Merely citing marks of products containing DEX as a suffix is insufficient to substantiate a contention that DEX, as a suffix, is common to the trade in pharmaceutical preparations. On the defendant, pleading that the part of the brand name, common to the product of the plaintiff and the defendant, is *publici juris*, is cast the onus to establish the assertion. This, according to **Express Bottlers Services**²⁶ and **Pankaj Goel**²⁴, requires the defendant to show (i) substantial use, by the proprietors of the marks cited by it, (ii) the extent of trade in products bearing the said marks and (iii) that the said marks pose a threat to the distinctiveness of the mark asserted by the plaintiff. Else, would not be possible for this Court to return a finding that the mark of the plaintiff, or the part thereof which, according to the defendant, is common to the trade, is indeed so.

7.2.9 By corollary, it would be even more impermissible for the defendant to plead that the plaintiff's mark, or a part thereof, has become common to the trade, thereby invoking Section 17(2)(b) of the Trade Marks Act, by merely citing registrations, existing on the Register of Trade Marks, of names containing the asserted mark, or a part thereof. As is often correctly pleaded in these cases, "common to register" is qualitatively different from "common to the trade". One may register a mark and leave it unused. Products bearing marks which stand registered in the Register of Trade Marks may never see the market, or may, at best, make sporadic appearances. Such registrations cannot divest the plaintiff's mark of distinctiveness, or disentitle the plaintiff to injunction.

7.2.10 Plainly put, a mark, though registered, may not make it "to the trade". Section 17(2)(b) applies only where the asserted mark, or a part thereof, is common "to the trade". The use of the article "the", in Section 17(2)(b) is, in my considered opinion, significant. There is a clear difference between the expressions "common to

trade” and “common to the trade”.

7.2.11 It is an elementary principle of legislative interpretation that the legislature is presumed not to indulge either in superfluity or tautology. Every word used in parliamentary legislation is intended, axiomatically, to have been deliberately used²⁹. This principle applies with greater force where the use of the concerned word or phrase is not necessary to make the provision, in which it is used, syntactically complete. If, therefore, the legislature has, in the phrase “common to trade”, inserted the definitive article “the”, that insertion has to be treated as deliberate and intended to serve a particular purpose. Etymologically, the insertion of the definitive article “the” is obviously intended to make the provision applicable to “the trade” which could, in a manner of speaking, be analogised to “the market”. The use of the definitive article “the” indicates that the accompanying word “trade” is to be understood, in the provision, as a noun, and not a verb. As a noun, “trade” has been defined in several judgements of the Supreme Court. Perhaps the most comprehensive definition is to be found in *Fatechand Himmatlal v. State of Maharashtra*³⁰, which defines “trade”, used as a noun, as meaning “lending, movements of goods, transactions linked with merchandise order, flow of goods, the promotion of buying and selling advance, borrowings, discounting bills and mercantile documents, banking and other forms of supply of funds”. What, therefore, section 17(2)(b) requires is commonness, of the asserted mark or part thereof, to “the trade”; in other words, in the trade relating to the goods to which the mark pertains, the use of part of the mark must be found to be “common”. “The trade” referring to actual flow of goods in the market, it is necessary for the defendant who invokes Section 17(2)(b) to establish that, in the market relating to such goods, the use of the asserted mark, or part thereof, is common.

7.2.12 The word —common, too, has its own significant etymological connotation. Commonality cannot be easily presumed. It has to be established as a statistical reality. —Common is defined in P. Ramanatha Aiyar’s authoritative Advanced Law Lexicon, as —describing something that happens very frequently, or that applies equally to a number of people, without exclusion or differentiation. The Worcester Dictionary, also quoted in Ramanatha Aiyar, defines —common, as an adjective, as meaning —usual, accustomed, shared among several; owned by several jointly; belonging to the public; general; universal; frequent, customary, habitual. Plainly stated, therefore, for the use of an expression to be regarded as —common to the trade, the persons who are asserting as to establish, positively, that the use of the expression in the trade is frequent, customary or habitual. Registering of a multiplicity of marks containing the

²⁹ Refer *Umed v. Raj Singh*, (1975) 1 SCC 76 ; *Dilbagh Rai Jerry v. UOI*, AIR 1974 SC 130

³⁰ AIR 1977 SCC 1825

expression can go no way, whatsoever, towards that end.

7.2.13 In other words, what Section 17(2)(b) envisages is, firstly, the existence of a trade in the articles, or class of articles, in respect of which the asserted mark is used by the plaintiff and, secondly, frequent, customary or habitual use, in that trade, of the mark, or part of the mark, asserted by the plaintiff which the defendant claims to have become —common to the trade. By its very nature, satisfaction of this test would require appreciation of evidence. It would require the Court to be satisfied of (i) the existence of a trade in the article, or class of articles, in respect of which the plaintiff uses the asserted mark and (ii) common, i.e. frequent, customary or habitual use, in that way, of the mark or part thereof. It is only, therefore, where there is sufficiently overwhelming evidence, of the satisfaction of these two ingredients, placed on record by the defendant, that the Court may, at a prima facie stage, justify the invocation of Section 17(2)(b), by holding that the mark asserted by the plaintiff, or a part thereof, has become —common to the trade, thereby disentitling the plaintiff from claiming exclusivity in respect thereof.

7.2.14 Tested on this touchstone, it cannot be said that Mr. Khara has made out a case for holding the plaintiff disentitled from claiming exclusivity on the ground that the suffix DEX is common to the trade. The Court does not have, with it, statistical data regarding the market presence of other pharmaceutical compounds, the brand names of which end with DEX. When one excludes, from the examples cited by Mr. Khara, those products which contain dexamethasone or dextromethorphan, the remaining examples cannot, at the prima facie stage, make out a case under Section 17(2)(b) of the Trade Marks Act. The principle that the mere failure, on the part of the plaintiff, to sue every infringer, cannot disentitle it from claiming exclusivity vis-à-vis the infringer whom it chooses to sue, would also apply in such circumstances.”

6.4 The aforementioned observations apply *mutatis mutandis*, to the facts of the present case. Mere citing of a multitude of marks, which are available on the register of trade marks and which include, as a part or as the whole thereof, “ARMOUR”, cannot make out a case of the marks asserted in the present case, or even of part thereof, being common to the trade.

6.5 Mr. Bansal has pointed out, mark by mark, as to how none of the marks, on which the defendant relies in its reply to the present

application, can detract from the plaintiff's right to claim exclusivity in respect of the marks forming subject matter of the suit. None of the marks, on which the defendant relies can, therefore, discredit the plaintiffs' marks, or indicate that ARMOUR is common to the trade. This may be explained in the following tabular fashion:

S.No.	Mark cited by defendant	Observation
1.		Available only in the United Kingdom
2.		Available only in the United Kingdom
3.		Scantly available
4.		Available only in the United Kingdom
5.		Used only in Car Accessories
6.		- Scantly available - Opposed by the plaintiff

7.	URBAN ARMOR GEAR	Registered in Class 9 for mobile covers
8.	 ANGEL ARMOR® PROTECTION AT A FRACTIONAL PRICE	No evidence of use in India
9.	Tommy Armour	Not available in India
10.	Armour Insect Shield	- No evidence of use - Unrelated Goods
11.	Kung Armour	- Protective gear - Rectification filed by plaintiff
12.	Bee Armour	Registered for laptop bags
13.	 AERO ARMOUR	Opposed by plaintiff
14.	MC-ARMOR  <i>Miguel Caballero</i>	- Available only in US - No evidence of use in India
15.	WOD ARMOUR 	Opposed by plaintiff
16.	Yeezy X Armour: Protected Shoes 	Scantily used

17.		• Used since December 2022 • Armour not found on product
-----	---	---

6.6 That apart, even if it were to be assumed, for the sake of argument, that the “ARMOUR” part of the mark was common to the trade, the proscription in Section 17(2)(b) would apply only if exclusivity were being sought to be claimed by plaintiff *in respect of that common part of the mark*, i.e. “ARMOUR”. Though the plea that ARMOUR is a dominant part of the plaintiff’s mark might have been taken in the plaint, the plaintiff is, quite clearly, asserting its entire mark “UNDER ARMOUR” and the abbreviated forms thereof “UA” and “UNDR ARMR”. This Court has already arrived at the subjective satisfaction that the defendant’s marks are deceptively similar to the said marks. The aspect of whether “ARMOUR”, *per se*, is common to the trade, therefore, actually recedes into insignificance.

7. Suppression of Fact

7.1 Mr. Lall’s final contention, on which he placed considerable emphasis, was that the plaint was liable to be rejected for suppression and misstatement, as the plaintiff had not approached this Court with clean hands. His submission was that the plaintiff has deliberately suppressed the replies filed by it, by way of response to the First Examination Reports (FERs), raised by the Registry of Trade Marks when the plaintiff sought to obtain registration of the “UNDER

ARMOUR” mark. He submits that the various marks which contain “ARMOUR” either by itself or in conjunction with other words suggests “TOMMY” “BHH” etc. were put up as examples by the Registry under Section 11(2)(a) of the Trade Marks Act as being deceptively similar to the mark that the plaintiff sought to register, and the plaintiff’s response was that the aspect of deceptive similarity could not be assessed by merely viewing “ARMOUR” part of the concerned marks, which had to be seen as a whole. The precise contention of Mr Lall was, in fact, that

- (i) the plaintiff had, in its reply to the FER, taken a specific stand that the plaintiff’s marks could not be refused registration under Section 11(2)(a) on the ground that other marks which had ARMOUR as a part thereof were already registered, as the marks had to be seen as a whole,
- (ii) as against this, in the present plaint, the plaintiff’s case is that ARMOUR is a dominant part of the UNDER ARMOUR mark, and exclusivity is being sought to be claimed on that basis,
- (iii) the stand adopted before this Court is, therefore, opposed to the stand taken in the reply to the FERs,
- (iv) this could not be allowed, as it would amount to approbate and reprobate and
- (v) in any event, the plaintiff was bound, in such circumstances, to disclose the replies filed to the FERs with the present plaint, and non-disclosure disentitled the plaintiff to injunctive relief.

7.2 To my mind, the stand that the plaintiff took before the Registry of Trade marks would actually support the stand that they are taking before this Court in the present case. There, as also here, the plaintiff asserts that the entire mark has to be seen as a whole. This Court has also assessed the aspect of infringement and deceptive similarity by comparing the marks of the plaintiff and defendant as a whole. As such, it cannot be said that the stand taken by the plaintiff in their responses to FER is at all inimical to the case that seek to set up in the present plaint.

7.3 Relevance of FER and reply thereto in infringement/passing off proceedings:

7.3.1 Even otherwise, there is a fundamental error in the submission of Mr. Lall. In *Teleecare Network*¹⁹, this Court, speaking through Manmohan, J., held that, post grant of registration of the plaintiff's mark, neither the FER, nor the reply thereto, were relevant documents. Following the judgment of a Division Bench of this Court in *Raman Kwatra v. KEI Industries Ltd*³¹, a notion has emerged that this legal position is no longer good law. That, however, does not, in my view, appear to be the position.

7.3.2 Adverting to *Teleecare Network*¹⁹ on this issue, the Division Bench, in *Raman Kwatra*³¹, held as under:

“43. We also find merit in the appellant's contention that a party, that has obtained the registration of a trademark on the basis of certain representation and assertions made before the Trade Marks Registry, would be disentitled for any equitable relief by pleading to the contrary. The learned Single Judge had referred to the decision in the case of *Teleecare Networks*¹⁹ (*supra*) holding that after grant of registration neither the Examination Report nor the

³¹ (2023) 296 DLT 529

plaintiff's reply would be relevant. We are unable to agree with the said view. In that case, the Court had also reasoned that that there is no estoppel against statute. Clearly, there is no cavil with the said proposition; however, *the said principle has no application in the facts of the present case. A party that has made an assertion that its mark is dissimilar to a cited mark and obtains a registration on the basis of that assertion, is not to be entitled to obtain an interim injunction against the proprietor of the cited mark, on the ground that the mark is deceptively similar.* It is settled law that a person is not permitted to approbate and reprobate. A party making contrary assertions is not entitled to any equitable relief.”

(Emphasis supplied)

7.3.3 Clearly, the reply to the FER, even as per the decision in *Raman Kwatra*³¹, would be a relevant document only where the FER set up the defendant's mark as one of the cited marks against the mark asserted by the plaintiff. It is only in that circumstance that the plaintiff's response, to the defendant's mark having been set up against it, would be a circumstance which the Court would take into consideration as relevant while assessing the plaintiff's right to assert its mark. If the defendant's mark is cited against the proposed mark of the plaintiff in the FER as a similar mark under Section 11(1)(b), then, unquestionably, the stand adopted by the plaintiff while responding to the FER would be relevant, as it could not adopt a contrary stand, opposing *the very same mark of the defendant*, in the infringement suit. Any such contrary stand would amount to approbate and reprobate. The principle has no application where the defendant's mark, as in the present case, was never put up as a similar mark in the FER, while objecting to the application of the plaintiff for registration of the UNDER ARMOUR mark.

7.3.4 It cannot be said that, even if the plaintiff did not refer to the replies to the FERs raised by way of objection to the plaintiff's

application seeking registration, the plaintiff was guilty of suppression.

7.4 In this context, I may also refer to two decisions of the Supreme Court, which deal with the aspect of when suppression can be a ground to non-suit a petitioner or a plaintiff. In *S.J.S. Business Enterprises (P) Ltd. v. State of Bihar*³² and Supreme Court, in para 13 and 14 of the report, held thus:

“13. As a general rule, suppression of a material fact by a litigant disqualifies such litigant from obtaining any relief. This rule has been evolved out of the need of the courts to deter a litigant from abusing the process of court by deceiving it. But the suppressed fact must be a material one in the sense that had it not been suppressed it would have had an effect on the merits of the case. It must be a matter which was material for the consideration of the court, whatever view the court may have taken [*R. v. General Commrs. for the purposes of the Income Tax Act for the District of Kensington*]³³. Thus when the liability to income tax was questioned by an applicant on the ground of her non-residence, the fact that she had purchased and was maintaining a house in the country was held to be a material fact, the suppression of which disentitled her to the relief claimed [*Ibid.*] . Again when in earlier proceedings before this Court, the appellant had undertaken that it would not carry on the manufacture of liquor at its distillery and the proceedings before this Court were concluded on that basis, a subsequent writ petition for renewal of the licence to manufacture liquor at the same distillery before the High Court was held to have been initiated for oblique and ulterior purposes and the interim order passed by the High Court in such subsequent application was set aside by this Court [*State of Haryana v. Karnal Distillery Co. Ltd.*]³⁴. Similarly, a challenge to an order fixing the price was rejected because the petitioners had suppressed the fact that an agreement had been entered into between the petitioners and the Government relating to the fixation of price and that the impugned order had been replaced by another order [*Welcom Hotel v. State of A.P.*]³⁵ .

14. Assuming that the explanation given by the appellant that the suit had been filed by one of the Directors of the Company without the knowledge of the Director who almost simultaneously

³² (2004) SCC OnLine SC 341

³³ (1917) 1 KB 486 : 86 LJKB 257 : 116 LT 136 (CA)

³⁴ (1977) 2 SCC 431 : AIR 1977 SC 781

³⁵ (1983) 4 SCC 575 : 1983 SCC (Cri) 872 : AIR 1983 SC 1015

approached the High Court under Article 226 is unbelievable (sic), the question still remains whether the filing of the suit can be said to be a fact material to the disposal of the writ petition on merits. We think not. The existence of an adequate or suitable alternative remedy available to a litigant is merely a factor which a court entertaining an application under Article 226 will consider for exercising the discretion to issue a writ under Article 226 [*A.N. Venkateswaran v. Ramchand Sobhraj Wadhwani*³⁶]. But the existence of such remedy does not impinge upon the jurisdiction of the High Court to deal with the matter itself if it is in a position to do so on the basis of the affidavits filed. If, however, a party has already availed of the alternative remedy while invoking the jurisdiction under Article 226, it would not be appropriate for the court to entertain the writ petition. The rule is based on public policy but the motivating factor is the existence of a parallel jurisdiction in another court. But this Court has also held in *Chandra Bhan Gosain v. State of Orissa*³⁷ that even when an alternative remedy has been availed of by a party but not pursued that the party could prosecute proceedings under Article 226 for the same relief. This Court has also held that when a party has already moved the High Court under Article 226 and failed to obtain relief and then moved an application under Article 32 before this Court for the same relief, normally the Court will not entertain the application under Article 32. But where in the parallel jurisdiction, the order is not a speaking one or the matter has been disposed of on some other ground, this Court has, in a suitable case, entertained the application under Article 32 [*Tilokchand Motichand v. H.B. Munshi*³⁸]. Instead of dismissing the writ petition on the ground that the alternative remedy had been availed of, the Court may call upon the party to elect whether it will proceed with the alternative remedy or with the application under Article 226 [*K.S. Rashid and Son v. Income Tax Investigation Commission*³⁹]. Therefore, the fact that a suit had already been filed by the appellant was not such a fact the suppression of which could have affected the final disposal of the writ petition on merits.”

7.5 Following *S.J.S. Business Enterprises*³², another Bench of two Hon’ble Judges of the Supreme Court, in *Arunima Baruah v. Union of India*⁴⁰ held as under, in paras 12 and 15:

“12. It is trite law that so as to enable the court to refuse to exercise its discretionary jurisdiction suppression must be of

³⁶ AIR 1961 SC 1506

³⁷ (1963) 14 STC 766, 918 : (1964) 2 SCR 879

³⁸ (1969) 1 SCC 110 : AIR 1970 SC 898

³⁹ AIR 1954 SC 207

⁴⁰ (2007) SCC OnLine SC 586

material fact. What would be a material fact, suppression whereof would disentitle the appellant to obtain a discretionary relief, would depend upon the facts and circumstances of each case. Material fact would mean material for the purpose of determination of the lis, the logical corollary whereof would be that whether the same was material for grant or denial of the relief. If the fact suppressed is not material for determination of the lis between the parties, the court may not refuse to exercise its discretionary jurisdiction. It is also trite that a person invoking the discretionary jurisdiction of the court cannot be allowed to approach it with a pair of dirty hands. But even if the said dirt is removed and the hands become clean, whether the relief would still be denied is the question.

15. In *Spry on Equitable Remedies*, 4th Edn., p. 5, referring to *Moody v. Cox*⁴¹ and *Meyers v. Casey*⁴² it is stated:

“... that the absence of clean hands is of no account ‘unless the depravity, the dirt in question on the hand, has an immediate and necessary relation to the equity sued for’. When such exceptions or qualifications are examined it becomes clear that the maxim that predicates a requirement of clean hands cannot properly be regarded as setting out a rule that is either precise or capable of satisfactory operation.”

Although the aforementioned statement of law was made in connection with a suit for specific performance of contract, the same may have a bearing in determining a case of this nature also.”

7.6 It is only, therefore, where material facts, which would have an impact on the ultimate outcome of the proceeding, are suppressed, that suppression of fact could disentitle the party suppressing the fact to relief.

7.7 Holistically seen, it cannot be said that the plaintiff is guilty of any such material suppression of fact as would disentitle it to release in the present case.

⁴¹ (1917) 2 Ch 71

⁴² (1913) 17 CLR 90

Conclusion

8. As this Court has already held, on the aspect of infringement and passing off, in favour of the plaintiff on merits, an injunction must follow.

9. Pending disposal of the suit, therefore, the defendant shall stand restrained from dealing in or using the impugned marks and logos

“STREET ARMOR/ ”, STRT ARMR, ARMR, ARMOR, SA, ARMR DEPT, SA DEPT, STREET ARMOR CO, STRT ARMR LAB or any other trademarks/labels which are identical with and/or deceptively similar to plaintiff’s registered UNDER ARMOUR, UNDR ARMR or UA word marks or device marks, or any other mark which is confusingly or deceptively similar to the said marks of the plaintiff, in respect of apparel or any other goods or services which may be regarded as similar or allied to the goods in respect of which the plaintiff uses its marks.

10. The application stands allowed accordingly.

11. Mr Lall prayed that the Court may direct that the present order be brought into effect only after a period of about two weeks so that the defendant could avail appellate remedies. On first principles, I am of the view that granting such a request would amount to this Court staying the operation of its own judgment, which it has no power to do. Short of Order XLI Rule 5(2), the CPC does not empower a Court to stay its own judgment or decree.

12. Nonetheless, as this judgment was dictated in Court and has to be finalized, corrected, and proof read, it is directed that it would take effect only on its being uploaded on the website of this Court.

C.HARI SHANKAR, J

APRIL 20, 2023

ar

