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

+ **FAO (COMM) 44/2023**

SUNIT SHAH

..... Appellant

Through: Mr.Satish Kumar with Mr.Umesh
Mishra and Mr.Vishal Patel,
Advocates.

versus

SUNSHINE FOOD PRODUCTS

..... Respondent

Through: None

Date of Decision: 23rd February, 2023

CORAM:

HON'BLE MR. JUSTICE MANMOHAN

HON'BLE MR. JUSTICE SAURABH BANERJEE

J U D G M E N T

MANMOHAN, J (Oral):

C.M.No.8668/2023

Exemption allowed, subject to all just exceptions.

Accordingly, the application stands disposed of.

FAO (COMM) No.44/2023 & C.M.No.8667/2023

1. Present appeal has been filed challenging the order dated 17th November, 2022 passed by the District Judge (Commercial Court), East District, Karkadooma Courts, Delhi in CS (Comm) No.126/2022.

2. Learned counsel for the appellant/plaintiff states that the Trial Court has erred in not appreciating the fact that the word HOT MIX cannot be termed as descriptive as the mark does not identify any characteristic of the product to which the mark pertains.
3. He emphasises that though the earlier registration for the trademark SHAH HOT MIX had a disclaimer with respect to the word HOT MIX, however, the fresh applications filed by the appellant/plaintiff for registration of the word HOT MIX thereafter have been accepted and published in the journal without any disclaimer which clearly suggests that the word HOT MIX is not a descriptive mark as claimed by the respondent.
4. To further contend that the word HOT MIX is not a descriptive mark, he also points out that the word HOT MIX has since also granted registration in favour of an entity based in Kolkata vide Certificate No.557206 dated 18th September, 2006.
5. In the alternative, he states that the appellant/plaintiff is the registered proprietor of SHAH HOT MIX label/device mark and has been using the same since 01st April, 1997 and on account of the usage of the said trademark/label since last so many years, the said trademark/label has acquired distinctiveness and secondary meaning. Consequently, he contends that even if it is presumed that the word HOT MIX is descriptive in nature, it qualifies the test of having acquired distinctiveness and secondary meaning by virtue of its long standing use and its association with the goods of the appellant/plaintiff.

6. He then submits that the Trial Court has erred in holding that the appellant/plaintiff's trademark registration is with a disclaimer to the effect that the appellant/plaintiff would have no right over the descriptive matter appearing on the label in view of the above and as it is without considering the judgement of this Court in ***Sanofi India Limited Vs. Universal Neutraceuticals Pvt Ltd. MANU/DE/2670/2014***, wherein it was held that an action for passing off is maintainable in case it is established that the defendant has infringed the common law right of the plaintiff.

7. Having heard learned counsel for the appellant/plaintiff, this Court is in agreement with the *prima facie* view of the Trial Court that the word HOT MIX describes the nature of namkeen contained in the packet, that is to say, that it contains a spicy mixture. Just because the appellant's application for registration of the word HOT MIX has been advertised, does not mean that it has been registered. Consequently, no exclusivity can be claimed with regard to the expression/word, HOT MIX as it is descriptive in nature.

8. This Court is of the view that the issue as to whether the impugned mark has acquired secondary significance or not can be decided only after evidence has been led by the appellant/plaintiff before the Trial Court.

9. As far as the judgment in ***Sanofi India Limited*** (supra) is concerned, there is no quarrel with the proposition that a passing off action would lie even with regard to a registered trademark where relevant portion of the said trademark has been disclaimed. However, the issue whether the trademark in question is associated with the appellant/plaintiff is a disputed question, especially, keeping in view the fact that word HOT MIX has been

registered in favour of an entity based in Kolkata as far back as from its date of application, i.e. 29th January, 2003.

10. However, to meet the ends of justice, this Court directs the Trial Court to decide the appellant/plaintiff's suit as expeditiously as possible, preferably within six months from today, without being influenced by any observation made by this Court. With the aforesaid direction, present appeal along with pending application stands disposed of.

MANMOHAN, J

SAURABH BANERJEE, J

FEBRUARY 23, 2023
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