



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

INTERIM APPLICATION NO. 752 OF 2024
IN
COMMERCIAL IP SUIT NO. 247 OF 2023.

- | | | |
|----|--------------------------------------|--------------------------------|
| 1) | Ramnish Verma, |] |
| | Adult, Indian Inhabitant residing |] |
| | at 402, Mayfair Building, Kane |] |
| | Road, Bandstand, Bandra (West), |] |
| | Mumbai-400 050, |] |
| | Maharashtra. |] |
| | |] |
| 2) | Finesse Fashions Pvt. Ltd. |] |
| | A Private Limited Company registered |] |
| | under the Companies Act, 1956 |] |
| | having its registered office |] |
| | at Unit No. 10, Ground Floor, |] |
| | Premsons Industrial Estate, |] |
| | Tahira Compound, Caves Road, |] |
| | Jogeshwari (East), |] |
| | Mumbai-400 060, Maharashtra. |] |
| | | <u>...Applicants/</u> |
| | | <u>Org. Plaintiffs.</u> |

In the matter between :

- | | | |
|----|--------------------------------------|------------------------------|
| 1) | Ramnish Verma, |] |
| | Adult, Indian Inhabitant residing |] |
| | at 402, Mayfair Building, Kane |] |
| | Road, Bandstand, Bandra (West), |] |
| | Mumbai-400 050, |] |
| | Maharashtra. |] |
| | |] |
| 2) | Finesse Fashions Pvt. Ltd. |] |
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| | having its registered office |] |
| | at Unit No. 10, Ground Floor, |] |
| | Premsons Industrial Estate, |] |
| | Tahira Compound, Caves Road, |] |
| | Jogeshwari (East), |] |
| | Mumbai-400 060, Maharashtra. |] |
| | | <u>...Applicants.</u> |

Versus

- 1) The Haddad Apparel Group Ltd.,
A Corporation duly organized and
existing under the Laws of
the State of New York,
United States of America
having its Indian office
at 68, Institutional Area,
Sector- 44, Gurugram,
Haryana 122 002 and
its E-mail Ids as
info@rookieindia.com;
customercare@rookieindia.com.
- 2) RJ Corp Ltd.,
A Company registered under
the Companies Act, 1956
having its place of business
at Shop No.S-16, 2nd Floor,
Oberoi Mall, Off., Western Express Highway,
Goregaon (East),
Mumbai-400063, Maharashtra
and its E-mail Id. As
corporategovernance@rjcorp.in.
- 3) Varun Jaipuria,
An Adult, Inhabitant,
the Director of RJ Corp Ltd.
having his place of business
at E-449, 3rd Floor, DLF Mall of India,
Sector-18, Noida-201301, Delhi.

...Respondents /
Org. Defendants.

Mr. Virag Tulzapurkar, Senior Advocate along with Mr.Hiren Kamod, Mr. Mahesh Mahadgut, Mr. Shildendra Thathe, Mr.Kaivalya Shetye, Ms. Neha Joglekar and Mr. Prem Khullar for the Plaintiff.

Dr. Veerendra Tulzapurkar, Senior Advocate along with Ms.Hemlata Marathe and Mr. Vaibhav Khanna i/by Jehangir Gulabbhai and Bilimoria and Davawala for Respondent.

Coram : Sharmila U. Deshmukh, J.

Reserved on : August 14, 2025.

Pronounced on : October 7, 2025.

Uploaded on : October 7, 2025.

Judgment :

1. This is an action for infringement of trade mark and passing off. The case of the Plaintiffs is that the Plaintiff No.1 is the registered proprietor of trade mark **"ROOKIES"** and various "ROOKIES" formative trade marks of which the word "ROOKIES" is the leading and essential features. The registered domain name i.e., "<https://rookiesjeans.com>" also contains the trademark.

2. The Plaintiff No.1 is one of the shareholder and director of Plaintiff No.2 and Plaintiff No. 2 is the permitted user of trade mark **"ROOKIES"**. The Plaintiff Nos.1 and 2 are engaged in the business of designing, importing, manufacturing, marketing and sale of readymade garments and all kinds of clothing collection, footwear and ancillary products for men, women and children and are also engaged in the business of retailing the said goods through their exclusive brand outlets as well as multi brand stores under the name and style **"ROOKIES" / "ROOKIES Jeans"**. The Plaintiffs also have online presence on their own as well as third party e-commerce websites.

3. In the year 2008, the Plaintiff No.1 adopted the word **"ROOKIES"** as its trade mark. The domain name was registered on 1st November,

2008. The Plaintiff No.1 applied for and secured registration of the trade mark **“ROOKIES”** and ROOKIES formative trademarks under Class 25 and subsequently also secured registration under Class 35, the relevant details are set out in paragraph 6(i) of the plaint. The earliest registration of the mark **“ROOKIES”** in class 25 was secured on 22nd December 2008 with user claim of 3rd November 2008. The registration in Class 35 was obtained on 23rd May 2019 with user claim of 3rd November 2008.

4. The Plaintiffs have also secured registration in Class 25 and Class 35 in Nepal, in Class 25 in Sri Lanka and Bangladesh in the year 2022 – 2023. In so far as country of Hong Kong is concerned, in the year 2018, the Plaintiffs filed an application for registration of the mark **“ROOKIES JEANS CO/ROOKIES JEANS”** in Class 25 and 35, which was opposed by the Defendant No. 1 vide notice of opposition dated 25th January 2019 pursuant to which the Plaintiff did not contest the Hong Kong opposition.

5. The plaint sets out the wide array of goods marketed under the trademark **“ROOKIES”** as well as locations at which the multi-brand stores and exclusive brand outlets of Plaintiffs are located. It is stated that the Plaintiffs, as retailer launched their flagship store in Phoenix Mall in Kurla which led to launching of exclusive brand outlets in major cities like Raipur, Patna and Gujarat in India. In order to demonstrate

the goodwill and reputation, the sales figures and promotional expenses duly certified by the Chartered Accountant are placed on record. It is submitted that the Plaintiffs brand is endorsed by celebrities.

6. It is submitted that the Defendant No.3 is the Director of Defendant No.2 and they are the exclusive franchisee of Defendant No.1. In the month of March 2019, the Plaintiffs came across an invite-cum-advertisement by Defendant No.3 announcing the opening of first **“ROOKIE USA”** store in India on 23rd March 2019 at a mall in Noida. Immediately the Plaintiffs issued cease and desist notice to the Defendant No.3 on 23rd March 2019. The Plaintiffs conducted search of the records in the Trade Mark Registry which revealed that the Defendant No.1 has obtained 2 registrations of the mark **“ROOKIE”** on 11th April 2014 in Class 35 with user claim of proposed to be used.

7. Subsequently, there was correspondence exchanged between the Plaintiffs and Defendants in which it was stated that the Defendant No.1 had obtained trade mark registrations for the impugned mark in Class 18 and Class 35. There were certain talks about amicable co-existence of parties. The negotiations continued till 1st August, 2019 going to the extent of Plaintiff No.1 having a meeting in New York with the Defendant No.1. However, there was no fruitful outcome of said negotiations.

8. It is submitted that it is only after the negotiations failed that action was initiated by the Plaintiffs, the first step being filing for rectification of the registered trade mark as being contrary to the provisions of Section 11 of the Trade Marks Act, 1999. The counter statement was not filed within the stipulated period and came to be filed at a belated stage, on 1st December 2022. The Defendants subsequently filed 2 more applications for registration of trade mark “ROOKIE USA” in Class 35 on 7th December 2022 with a user claim of 24th March 2019.

9. The Defendants in affidavit-in-reply pleaded acquiescence contending that despite being aware of the Defendants, the Plaintiffs allowed four years to pass before filing of present suit resulting in the Defendants steadily growing and expanding their business under the **“ROOKIE USA”** brand across India. The adoption of the trade mark by the Defendant No.1 is *bona fide*. In the year 2011, the Defendant No. 1 adopted and created retail concept under the name **“ROOKIE USA”** which is kids only multi brand premium retail destination with emphasis on apparel, accessories and footwear and having global presence. To demonstrate the enormous goodwill and reputation that Defendant No.1 enjoys, the sales figures are placed on record. It is contended that the Defendant No.1 has obtained registration for its **“ROOKIE”** marks in several countries with its earliest registration

being in USA in Class 35 filed on 21st September 2011. In India, the Defendant No. 1 has secured registration of the trademark **“ROOKIE”** in Class 18 and 35 which has been registered since 11th April 2014 and have also filed 2 more trade mark applications for registration of **“ROOKIE”** mark in Class 35 with user claim since 24th March 2019. The launching of the store in March, 2019 and the subsequent correspondence and meeting between the parties is admitted. It is further contended that the Plaintiff No.1 as prior proprietor of **“ROOKIES”** mark in India, used its leverage to attempt to compel the Defendant No.1 to let him enter the market where the Defendant No. 1 has strong presence and to sell the Plaintiffs’ brand through established chain of the Defendant No.1. It is submitted that if the same was permitted, the Defendant No.1 would have lost all its progress and market dominance and would have amounted to allowing the Plaintiff No. 1 to take advantage of its goodwill and reputation to sell its goods and establish its market in other countries which was not acceptable which resulted in failing of settlement talks. The filing of rectification application by the Plaintiffs has been admitted. It is submitted that the Defendant No.1 is the prior adopter and registered proprietor of **“ROOKIE”** mark in India for retail services in Class 35 as the same was registered in 2014 whereas the Plaintiff No.1’s mark was registered in the same class in 2019. The priority of Plaintiffs, if any, is

in respect of goods in Class 25 and not in Class 35 as the Plaintiff's first store was opened in February, 2020 i.e. one year after the opening of Defendant's store.

10. In rejoinder, it is stated that the Defendant has obtained registration by fraud and the registration is *ex facie* illegal, fraudulent and one that shocks the conscience of the Court. It is contended that the Defendants have secured registration in Class 25 in countries abroad, however, with *mala fide* intent applied for registration of the impugned mark in Class 35 being fully aware that their application in Class 25 is bound to be refused on account of Plaintiff's mark. It is submitted that the Defendant No.1's official website www.rookieindia.com does not contain the word "USA" which demonstrates the *mala fide* intention of Defendants to come as close as possible to the Plaintiff's mark "**ROOKIES**" and it is difficult to distinguish between the Defendants domain name and the Plaintiffs domain name. It is submitted that the Plaintiffs believed that registration in Class 25 was sufficient to carry on their business, however in order to avoid any anomaly in future, the Plaintiffs filed its application in Class 35 which is only ancillary to Class 25. It is submitted that the Plaintiff's first retail outlet was opened in Raipur in India in 2017 and the Defendant's agreement with Indian franchise R.J. CORP is dated 1st April 2018. It is further submitted that the Plaintiffs

opened its showroom in February 2020 just before the Covid lockdown started and after easing of restrictions, need of the hour was to kick start the business by opening more outlets leading to some delay in filing the present suit.

SUBMISSIONS:

11. Mr. Tulzapurkar, learned Senior Advocate appearing for the Plaintiffs submits that the Defendants mark **“ROOKIE USA”** prominently displays the word **“ROOKIE”** and the word **“USA”** is in negligible font. He submits that the Plaintiffs’ mark is reputed mark and its product under its mark are retailed in multi-brand and exclusive outlets and points out the distributorship agreements. He submits that the Plaintiffs application for registrations in Hong Kong in April, 2018 came to be opposed by the Defendant No.1. Drawing attention to the notice of opposition filed by Defendant No.1, he submits that the stand of Defendant No.1 in present proceeding is at variance from the stand taken in the opposition proceedings and therefore doctrine of prosecution history estoppel will apply. He would further submit that admittedly the Defendants mark was conceived in the year 2011 and the Plaintiffs have produced substantial material on record to demonstrate use of their trade mark in India since the year 2008. He submits that there is no question of delay as after the cease and desist notice was issued, in order to arrive at an amicable settlement, the

parties were negotiating and it is only in August 2019 that the negotiations failed.

12. He would further submit that the Defendants do not have registration in Class 25 in India and its registration is restricted to Class 18 and Class 35 for which rectification proceedings are pending. He would further submit that in the affidavit-in-rejoinder, the Plaintiffs have pleaded that the first retail store was opened in 2017 which has not been disputed. He submits that the Defendants have admitted that the Defendant No.1's registration is of the year 2014 in India on the proposed to be used basis and its first retail store opened on 23rd March 2019 and therefore Defendants are late entrant. He submits that this is a fit case where this Court can go beyond registration of the Defendants mark as the Lupin's principles stand satisfied and the Defendants mark could not have been granted registration.

13. Pointing out to the registration of Defendant No.1's trade mark, he submits that the Defendant's registration in Class 35 covers articles of clothing which overlaps the registration of Plaintiffs' trade mark in Class 25. Pointing out to the registration certificates, he submits that the Defendant No.1's registration in India does not mention the word **"USA"** and the Defendant No.1 has adopted the stand-alone mark **"ROOKIE"**. He submits that it is only on 7th December 2022, that the Defendant sought registration of the trade mark **"ROOKIE USA"** in

respect of Class 35 whereas the earlier registration was for the word mark **“ROOKIE”**. He submits that in the counter statement to the rectification application filed by the Plaintiffs, the Defendants have contended that **“ROOKIE”** is a common word and none can claim monopoly, which the Defendants are estopped from claiming as it itself sought registration of the said mark.

14. He submits that there is no question of acquiescence in the absence of any positive act on the part of Plaintiffs and the adoption of the mark being dishonest adoption, the defence of acquiescence is not available. He submits that the Defendants have not taken search in the Registry though they were aware of use of the mark since 2008 by the Plaintiffs and use of the mark is at the Defendant's own peril. He submits that the Defendant's international presence in the year 2011 or its international sales is irrelevant and the actual user of Defendant No.1 in India is in the year 2019. He submits that use of the identical mark in respect of identical goods is bound to lead to confusion and adversely affect the Plaintiff's sale and points out Section 29(2) of the Trade Marks Act to contend that in the present case the Plaintiff's goods and Defendant's services are related and have to be viewed in commercial and business sense.

15. He submits that insofar as the action for passing off is concerned, the Plaintiffs are prior registered proprietors and users of

their trade mark since 2008 and as of 2019, when the Defendants started using their mark in India, Plaintiffs had done sales of over Rs. 146 crores. He submits that for the purpose of considering the issue of passing off, the registration of rival mark as also the common field of activity is irrelevant. He submits that the rival trade marks are identical and the Plaintiffs have placed material to demonstrate goodwill and reputation. He submits that the rival trade marks are being used in relation to similar/cognate/allied goods and likelihood of misrepresentation and likelihood of injury to the Plaintiff's goodwill and reputation is inevitable. In support, he relies upon following decisions :

- ***Schering Corporation v. Kilitch Co. (Pharma) Pvt. Ltd*¹.**
- ***Abdul Rasul Nurallah v. Regal Footwear*²**
- ***Mahyco Pvt. Ltd v. Seamons Seeds Pvt. Ltd*³.**
- ***Allied Auto Accessories Ltd. v. Allied Motors Pvt. Ltd*⁴.**
- ***Eagle Potteries Pvt.Ltd. v. Eagle Flask Industries Pvt. Ltd*⁵.**
- ***Manu Kagliwal v. Mayo Foundation for Medical Education and Research*⁶**
- ***Indchemie Health Specialities Pvt. Ltd. v. Intas Pharmaceuticals Ltd*⁷.**
- ***Kores (India) Limited v. Whale Stationery Products Ltd*⁸.**
- ***Reed Elsevier Properties Inc. v. Best Media Associates***

1 1990 SCC OnLine Bom 425.

2 2023 SCC OnLine Bom 10.

3 This Court in IA (L) No. 33512 of 2024 IN COM IP (L) No. 26353 of 2024 dated June 24, 2025.

4 2002 SCC OnLine Bom 1138.

5 1992 SCC OnLine Bom 490.

6 2017 SCC OnLine Bom 9898.

7 2017 SCC OnLine Bom 10127.

8 2007 SCC OnLine Bom 1076.

(India) Pvt. Ltd⁹.

- **RPG Enterprises Ltd. v. Riju Ghoshal¹⁰**

16. *Per contra* Dr. Tulzapurkar, learned Senior Advocate appearing for the Defendants submits that the Defendant No.1 has been granted registration in Class 18 and Class 35 and the Defendant's services are not covered by the Plaintiff's registration. Drawing attention of this Court to Sections 18, 23 and 28 of the Trade Marks Act, he submits that exclusive right to use the trade mark is given only in relation to the goods and services in respect of which the trade mark is registered, which registration in the Plaintiff's case is limited to Class 25. He submits that Section 29(2)(a) and (b) of the Trade Marks Act, 1999 refers to the similarity of goods and the aspect of confusion and association can be considered only after it is ascertained that there is similarity of goods, which issue will be decided in the rectification application.

17. He submits that *ex facie* neither the goods in Class 18 or the services in Class 35 are similar to the Plaintiff's goods. He would further submit that Plaintiff's registration in respect of the goods cannot prevent the Defendants from using the mark in respect of services as the goods and services are distinct and separate. He

9 2009 SCC OnLine Bom 1742.

10 2022 SCC OnLine Bom 626.

submits that there cannot be any *prima facie* finding on aspect of similarity which will require evidence to be led unless the same is self-evident. He submits that the Defendant No. 1 being the registered proprietor cannot be restrained as Section 30(2)(e) and Section 28(3) of the Trade Marks Act protects the use of the mark by the registered proprietor. He submits that the ***Lupin's*** principles leaves a very small window for going beyond registration and in the present case, the Plaintiffs have failed to discharge the heavy burden cast upon them.

18. Pointing to the provisions of Section 12 of the Trade Marks Act, he submits that the statutory provisions recognises more than one proprietor. He submits that the Defendant No.1 had adopted the mark in the year 2011 outside India where the Plaintiffs had no presence. He submits that word **"ROOKIE"** is a dictionary word and not an invented word. He submits that Plaintiff's registration in Class 35 is subsequent to the registration secured by Defendant No.1. He would further submit that there is no evidence to show prior user of Plaintiffs of its mark in Class 35. He submits that the exclusive brand outlet was opened by the Plaintiffs only on 6th February 2020 and there is no material produced by the Plaintiffs to substantiate that the Plaintiff's first retail outlet was opened in Raipur in 2017. He submits that the said averment does not find place in the plaint or in the cease and desist notice as regards Plaintiff's prior user and it is necessary for

evidence to be led in order to establish continuous prior user. He submits that the suit has been filed after 4 years despite being aware about the Defendant's existence and therefore there is acquiescence. In support, he relies upon following decisions :

- ***American Home Products Corporation v. Mac Laboratories Pvt. Ltd*¹¹.**
- ***C. & T. Harris (Calne) Ltd. v. F. S. E. Harris*¹²**
- ***British Sugar Plc v. James Robertson & Sons Ltd*¹³.**
- ***Zippo Trade Mark*¹⁴**
- ***In the matter of an application by Ladislav Jellinek for the registration of a Trade Mark*¹⁵**
- ***Raleigh International Trade Mark*¹⁶**
- ***Harding v. Smilecare Limited*¹⁷**
- ***M/s. Parry & co. v. M/s. Perry & Co*¹⁸.**
- ***Lupin Ltd. v. Johnson & Johnson*¹⁹**
- ***Williams's Ltd. v. Massey Ltd*²⁰.**
- ***Smith Bartlett and Co. v. the British Pure Oil Grease and Carbide Co. Ltd*²¹.**
- ***Balkrishna Hatcheries v. Nandos International Ltd*²².**

19. In rejoinder, Mr. Tulzapurkar would submit that the Trade Marks Act is a territorial enactment and therefore adoption of the mark in the

11 1986 (1) SCC 465.

12 [1934] 51 R.P.C. 98.

13 1996 R.P.C. 281.

14 [1999] R.P.C. 173.

15 [1946] R.P.C. 59.

16 [2001] R.P.C. 11.

17 [2002] F.S.R. 37

18 AIR 1963 Mad 460.

19 AIR 2015 Bom 50.

20 [1911] 28 R.P.C. 512.

21 [1934] 51 R.P.C. 157.

22 2007 SCC OnLine Bom 449.

year 2011 in USA by the Defendant is irrelevant whereas the Plaintiffs adopted the mark in India in the year 2008. He submits that the Defendants' registration was in the year 2014 whereas the mark was used in the year 2019 and the Plaintiffs are the prior users and the registered proprietor of the trade mark. He submits that it is not necessary that evidence be led and *prima facie* case can be considered for the purpose of grant of injunction. He would submit that the classification of goods and services are for administrative purposes and goods falling in different classes can be held to be similar. He would point out the sales invoices of Defendants which shows sale of garments along with backpacks and would contend that Class 25 goods are being offered by the Defendants from their stores in India. He would further submit that there is no pleading in the reply that their goods in Class 18 are different from Plaintiffs' goods in Class 25.

20. He would further submit that there is no argument advanced by Dr. Tulzapurkar on the aspect of passing off. He would submit that under the provisions of Section 2(3) of the Trade Marks Act, the goods and services are associated with each other if it is likely that the goods might be sold and services might be provided by the same business and therefore there is no difference between the sale of goods and rendering of services.

21. He points to the provisions of Section 16 of the Trade Mark Act which provides for registration of the trade mark as associated trade mark and submits that Section 16(2) refers to goods and services which are associated. Mr. Tulzapurkar would tender additional documents and submit that the application of Defendant No.1 for registration of **“ROOKIE USA”** label on 7th December 2022 has been objected under Section 11(1) of the Trade Marks Act.

REASONS AND ANALYSIS.

22. There have been no arguments advanced and rightly so that the rival marks are not identical and /or deceptively similar . The Plaintiff’s mark is **“ROOKIES”** whereas the Defendants mark is **“ROOKIE”** without alphabet “s”. The Defendants other mark is **“ROOKIE USA”** and the manner in which the mark is used indicates that prominence is given to the word ROOKIE and the word USA is in negligible font. The issue of whether the marks are identical/deceptively similar does not arise in the present case. Considering the facts and the submissions advanced, broadly the issues which will require determination are:

[a] Whether there is similarity between the Plaintiffs’ goods and the Defendants goods/service which is likely to cause confusion and likelihood of association so to constitute infringement as contemplated under Section 29(2) of Trade Marks Act, though the rival marks are registered in different

class.

[b] Whether the Defendant No 1 is the prior adopter and user of its registered trade mark “ROOKIES” in India, which use cannot be restrained by the Plaintiffs.

[c] Whether the doctrine of prosecution history estoppel would operate against the Defendants in view of the stand taken by the Defendants while opposing the plaintiff’s registration of its mark **“ROOKIES”** in Hong Kong.

[d] Whether in the facts of the present case, the registration of Defendant No.1’s mark in Class 18 and Class 35 in India is *ex facie* illegal or fraudulent or such that shocks the conscience of Court so as to satisfy the **Lupin** principles.

23. The Plaintiffs as well as the Defendant No.1 are the registered proprietor of their trade marks i.e. **“ROOKIES”** vs **“ROOKIE”** respectively. Let us first re-capsulate the relevant dates of use and registration to ascertain the aspect of prior user. The earliest registration of the Plaintiffs’ trade mark **“ROOKIES”** in Class 25 was secured in the year 2008 in respect of “readymade garments for men, women and children, undergarments and clothing of all kinds including the goods, shoes and slippers, all being goods included in Class 25” with user claim of 3rd November, 2008. The registration of the

Plaintiff's trade marks "**ROOKIES**" and "**ROOKIES JEANS**" in Class 35 was applied on 23rd May 2019 in respect of retail stores, online stores, retail and wholesale services for garment, clothing and footwear, online marketing and advertising services, import-export services, marketing and distribution services for garments, clothing and footwear" with user claim of 3rd November, 2008.

24. In so far as the Plaintiff's claim of launching of exclusive outlet in Raipur, India in the year 2017 is concerned, the averment did not find place in the plaint and came on record by way of Affidavit in rejoinder. To substantiate the claim, there is no material placed on record and on the contrary, the pleading is that on 6th February, 2020, the Plaintiffs launched its flagship store in Phoenix Mall, Kurla which led to launching of exclusive brand outlets subsequently. The registration of the Plaintiffs mark "**ROOKIES**" in the year 2008 in Class 25 and the use of the mark since the year 2008 is *prima facie* demonstrated and there is no debate about the same.

25. Coming to the Defendants registration, the Defendant No.1 secured registration of its mark "**ROOKIE**" in India on 11th April, 2014 in Class 18 in respect of "All purpose sports and athletic bags, book, carry on duffel, diaper, gym, tote and travel bags, fanny packs and waist packs; backpacks; knapsacks;purses; leather key chains; wallets; umbrellas" and registration of the mark "**ROOKIE**" in Class 35 was

obtained on 11th April, 2014, both with user claim of proposed to be used. Despite filing of reply Affidavit running into 1500 pages, the Defendant No.1 has neither pleaded nor brought to the notice of the Court any document which will disclose the date of user of the registered trade mark **"ROOKIE"** in India in respect of goods/services in Class 18 and Class 35. There are no sale invoices regarding sale of goods under Class 18 or commencing of services in Class 35 under the trade mark **"ROOKIE"**. The sales figure at Exhibit "E" is the global sales of the Defendant No.1 of its products under the trademark **"ROOKIE USA"**. The documents from Page 1050 to 1062 of the reply Affidavit indicates that the retail stores outside India were launched under the trade mark **"ROOKIE USA"**. *Prima facie* the Defendant No.1 did not put to use the registered trademark **"ROOKIE"** in respect of goods under Class 18 or services under Class 35. The material on record *prima facie* indicates that the Defendants launched its retail store on 23rd March, 2019 in India under the trade mark **"ROOKIE USA"**, which mark was unregistered in India. The application for registration of the trade mark **"ROOKIE USA"** in Class 35 was made only on 7th December, 2022 and is pending opposition.

26. The effect of a registered trademark remaining dormant was considered by the Hon'ble Apex Court in ***Neon Laboratories Ltd. v.***

Medical Technologies Ltd²³, where the Hon'ble Apex Court held as under:

"We must hasten to clarify that had the appellant-defendant commenced user of its trade mark ROFOL prior to or even simultaneous with or even shortly after the respondent-plaintiffs marketing of their products under the trade mark PROFOL, on the appellant-defendant being accorded registration in respect of ROFOL which registration would retrospectively have efficacy from 19-10-1992, the situation would have been unassailably favourable to it. What has actually transpired is that after applying for registration of its trade mark ROFOL in 1992, the appellant-defendant took no steps whatsoever in placing its product on the market till 2004. It also was legally lethargic in not seeking a curial restraint against the respondent-plaintiffs. This reluctance to protect its mark could well be interpreted as an indication that the appellant-defendant had abandoned its mark at some point during the twelve-year interregnum between its application and the commencement of its user, and that in 2004 it sought to exercise its rights afresh. It would not be unfair or fanciful to favour the view that the defendant's-appellant delayed user was to exploit the niche already created and built-up by the plaintiffs-respondent for themselves in the market. The "first in the market test" has always enjoyed pre-eminence. .."

27. The non user by the Defendant No.1 of the registered trade mark "**ROOKIE**" has the effect of tilting the scales in favour of the Plaintiffs by treating the Defendant No.1's mark as abandoned. The Defendant No.1 secured registration of its mark "**ROOKIES**" in the year 2014 and till date has not shown the use of the mark in India. Taking guidance from the decision of Hon'ble Apex Court, the non user of the registered mark can well be interpreted to mean that the Defendant No.1 has abandoned its registered mark. On the other hand, the

²³ (2016) 2 SCC 672.

Plaintiffs have adopted, used and secured registration of its mark since the year 2008. The registration of the trade mark in the year 2011 cannot enure to the benefit of the Defendant No.1 to resist the claim of infringement by seeking protection of Section 28(3) read with Section 30(e) of the Trade Marks Act. It would cause great prejudice and loss to the Plaintiffs, if the Defendant No.1 having failed to put to use its registered trade mark from the year 2011 is permitted *prima facie* to resist the injunction by relying on the rights granted under the Trade Marks Act, by mere fact of registration of its mark.

28. Proceeding ahead by accepting as subsisting the statutory rights of the Defendant No.1 by virtue of registration, let us test whether there is infringement of the Plaintiff's registered trade mark by the Defendants. The Plaintiffs seek an injunction restraining the Defendants from using the impugned trade mark/trading style/domain name **"ROOKIE"** or using any other trade mark/trading style/logo etc which is identical with and/or deceptively similar to the Plaintiff's registered trade mark **"ROOKIES"** which will include the unregistered trade mark **"ROOKIE USA"**. Section 29 of Trade Marks Act, governs the infringement of registered trade mark by a person who is not the registered proprietor. In the present case, the Defendant No.1 is the registered proprietor of the trade mark **"ROOKIE"** which is not put to use and the mark put to use is **"ROOKIE USA"** which is unregistered.

The first in the market test has always enjoyed pre-eminence. The rights of a prior user will normally override those of the subsequent user even though it had been accorded registration of its trade mark and particularly when the registered trade mark is not put to use.

29. Section 29(1) of the Trade Marks Act contemplates infringement of the registered mark if the impugned mark is "identical with or deceptively similar to" the registered trade mark and is used in relation to the goods and services for which the trademark has been registered. Under Sub-Section (2)(a) of Section 29, infringement takes place where the impugned mark is identical with the registered trademark and the goods or services for which the impugned mark is being used is similar to the goods and services covered by the registered mark. Sub-Section (2)(b) of Section 29 contemplates a situation where the impugned mark is similar to the registered mark and the goods and the services for which is used is identical with or similar to the goods and services for which the registered mark is used. Under Sub-Section (2)(c) of Section 29, infringement occurs where the impugned trade mark is identical to the registered trade mark and the goods or services for which the impugned mark is used is also identical to the goods/services covered by the registered trade mark.

30. For infringement to result by use of the impugned trademark, it is necessary in eventualities contemplated by Section 29(2), that the use of the impugned trade mark "is likely to cause confusion on the part of the public" or "is likely to have an association with the registered trade mark". The statutory provisions of Section 29(2) of Trade Marks Act mandates similarity of the goods and services for the confusion or likely association to take place.

31. Dr. Tulzapurkar would emphasis upon the factum of registration of the Defendant No.1's mark in Class 35 to contend that services cannot be compared with goods and therefore there is no case of infringement. The said submission overlooks the fact that the Defendant No.1 has obtained registration in Class 18 as well. It is by now well settled that classification of the goods and services is not the criterion for deciding the issue of similarity of goods and services. Section 7 of the Trade Marks Act provides for classification of goods and services and that the Registrar shall classify the goods and services into, as far as may be in accordance with, international classification of goods and services for the purpose of registration of trade marks. Sub-Section (2) of Section 7 further provides that any question arising as to the class within which any goods or services falls shall be determined by the Registrar whose decision shall be final. Sub-Section (1) of

Section 7 uses the expression “as far as may be” which indicates that the classification cannot be the sole criterion for deciding whether the goods are similar or not and the fact that despite international classification of goods and services being required to be adhered to, where any issue arises as to the class within goods and services falls, it is the determination by the Registrar whose decision is final. If one looks at the classification lists, there are many articles in different Class which would be overlapping and there is probability that the same article would fall in one class as well as in the other class. The position in law *qua* the classification list is well settled. In case of ***Allied Auto Accessories Ltd. vs. Allied Motors Pvt. Ltd*** (supra), the Learned Single Judge of this Court held that the well settled position is that the guidelines or classification lists which are published by the Trade Mark Registry are only administrative guidelines and do not constitute binding determinations on the proper classification of goods.

32. The comparison between the articles included in Class 18 and Class 25 shows that Class 25 includes clothing, footwear etc, whereas Class 18 articles covers bags, purses, wallets etc. In the case of ***Corn Products Refining Co., vs. Shangrila Food Products Ltd.***,²⁴ it has been held that cognate goods/services can be described *inter alia* as goods or service which have trade connection as in glucose and biscuits which

²⁴ AIR 1960 SC 142

were rival products in that case. Allied and cognate goods are those goods which are intended for the same consumer base as they are complementary to each other. The articles in Class 18 are accessories to the Class 25 articles and are frequently bought together and would be retailed through the same shops. The relevant consumer base is common to both classes and from the aspect of the common consumer, the articles in Class 18 and Class 25 would pertain to the same trade sector being complementary to each other. Mr. Tulzapurkar is right in placing reliance on the sales invoices produced by the Defendants which shows sale of wearing apparel alongwith backpacks. So also the social media posts asserts sale of Class 25 goods being offered by the Defendants from their retail stores. There is no submission canvassed by Dr. Tuljarpurkar to dispute the trade connection between the Class 18 and Class 35 products. *Prima facie* there is similarity in goods under Class 18 and Class 35 as allied/ cognate goods.

33. Coming to the user of the impugned mark **“ROOKIE / ROOKIE USA”** in respect of retail stores featuring clothing and accessories being services offered under Class 35, the comparison would be between goods on one hand and services on the other hand. Strong reliance is placed by Dr. Tulzapurkar on the decision of this Court in case of ***Balkrishan Hatcheries Vs Nandos International Ltd*** (supra). This Court in the said decision held that similarity can be similarity

between goods and goods and cannot be similarity between goods on one hand and services on the other. The Learned Single Judge held that “use of trade mark in relation to goods is distinct from use of the trade mark in relation to the services”. In ***Balkrishna Hatcherires*** (supra), the Plaintiff’s products were processed or frozen meat products and 1st Defendant’s service/goods were restaurants/food outlets, which did not serve frozen meat products and was not in the business of sale of sauces. It also needs to be noted that the Court applied the test of similarity by examining the goods and the services and one of the considerations which weighed with the Court was that the Plaintiff therein had neither pleaded nor attempted to establish any similarity between the goods and services. In any event, the decision of ***Balkrishan Hatcheries*** (supra) considered the point of convergence of goods and services and noted the provisions of Section 2(3) and Section 16 of the Trade Marks Act dealing with associated goods and services. In para 13, it laid down the requirements to be satisfied for the goods and services to be associated, which tests stand satisfied in the present case.

34. Apart from the above, what is so different between the Plaintiff’s products and the Defendants services that there can be no comparison between the two. The Plaintiffs products i.e. readymade garments, clothing collection, footwear etc are sold through stores

which may be owned by third parties and also through their exclusive outlets, whereas the Defendants sells multi brand children's garments which may be of different brands. Can the rival products be said to be so distant and unconnected with each other to eliminate even consideration of aspect of similarity. In my view, the answer is in the negative. The rival products are inextricably linked from business and commercial point of view which assumes significance. A hands off approach cannot be adopted by the Court by refusing to consider the aspect of similarity between the rival products only on the ground that the comparison is between goods and services. For example, if a Company uses trade name "Apple" for computers and other Company starts using "Apple" for computer repair services, it cannot be said that the goods cannot be compared with services as confusion is bound to happen.

35. Perusal of Page 245 to 258 of the Plaint would indicate that the Plaintiff's goods retailed at multi brand outlets have their own dedicated space, which cannot be said to be far from the services of retail stores featuring clothes covered by Class 35. The Defendants offers for sale garments through its retail stores under the impugned trademark **"ROOKIE USA"** which is unregistered in India and the Plaintiff's offers for sale garments through dedicated space at multi-brand outlets/exclusive outlets under its registered trademark

“ROOKIES”. *Prima facie* the Plaintiffs as well as the Defendants sells goods, one through dedicated space at retail stores of its own brand, and, other through retail stores of other brands and there is similarity between the rival products. In the decision in ***British Sugar Plc v. James Robertson & Sons Ltd*** (supra) the Court observed that there was no reason in principle why in some cases the goods should not be similar to services. In facts of the present case, *stricto sensu*, the comparison is not between goods on one hand and services on the other hand but between rival products which are connected in commercial and business sense.

36. It is not disputed that Plaintiffs have adopted and commenced the use of its trade mark in the year 2008 and were retailing through multi brand outlets since then. Even accepting that the first exclusive outlet was launched by the Plaintiffs on 6th February, 2020, by retailing their goods through multi brand outlets, *prima facie* the Plaintiffs are the prior user of its registered trademark in respect of services under Class 35, which right of exclusive user cannot be defeated by the Defendants by use of unregistered trade mark in the year 2019. Viewed thus, this Court has proceeded to decide the aspect of similarity by considering *prima facie* merits for grant of injunction.

37. In ***British Sugar Plc v. James Robertson & Sons Ltd***. (supra) the Court laid down following relevant factors in considering whether or

not there is similarity :

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

38. Closer home, in *Indchemie Health Specialities (P) Ltd vs Intas Pharmaceuticals Ltd*²⁵ the Hon'ble Division Bench of this Court held that it is not sufficient to go merely by the classification against which registration may have obtained. The classification may be one of the considerations, but it cannot be the sole consideration. It held that the usual criteria for determining whether the rival products are of similar description include the nature and composition of the product, their respective uses and functions and the trade channels through which

²⁵ 2017 SCC OnLine Bom 10127

they are generally traded. The three need not even concurrently co-exist.

39. In the case of *Assam Roofing Ltd v. JSB Cement LLP*²⁶ the Calcutta High Court has observed that the test of similarity of goods is looked at from a business and commercial point of view. The nature and composition of goods, the respective uses of the articles and the trade channels through which they are brought and sold all go into consideration in this context.

40. If the well settled tests are applied to the facts of present case, in my view, the plaintiff's goods/services are similar to and associated with the Defendants goods/services. The relevant consumer base for the Plaintiffs and the Defendants products is the same. The Defendants store sells articles falling within Class 25. Considering the nature of the goods/services offered by the Plaintiffs and the Defendants, there is strong trade connection between the two. As the rival products pertain to common trade sector of clothing, it cannot be digested that there is no overlapping between the two. The commonality of clothing sector demonstrates a strong trade connection and apparent similarity and association between the Plaintiff's products and Defendant's products.

41. It cannot be said that the rival products are so unconnected that

²⁶ 2015 SCC OnLine Cal 6581.

there is no likelihood of confusion to be caused on the part of general public and that there would not be any likely association with the Plaintiff's product. The likelihood of association with the Plaintiff's product is strengthened by the fact that the Plaintiffs are retailing its product through its multi-brand/exclusive outlets since the year 2008 and the strong overwhelming possibility of the Defendants outlets being considered as an outlet retailing the Plaintiffs goods cannot be *prima facie* ruled out. *Prima facie*, the general public is likely to be confused between the rival products and when confronted with the Defendants outlets is likely to associate the same with the Plaintiff's goods.

42. Another reason as to why the defence of Defendants cannot be accepted is the varying stand adopted by the Defendants. In the opposition proceedings, while opposing the Plaintiffs registration of its mark "**ROOKIES**" in Hong Kong in Class 25 as well as Class 35, the stand taken by the Defendant No 1 in paragraph 9 and 12 reads as under :

"9. The Opposed Mark is confusingly similar to the Opponents' Marks. The dominant part the Opposed Mark "Rookies" is different from the dominant part of the Opponents Mara "Rookie" only by the suffix "s" at the end. Taking into account of the doctrine of imperfect recollection, it is highly likely for the public to confuse the Opposed Mark and the Opponents' Marks. The Applicant's Goods and Services are identical and/or similar to Opponent's Goods and Services. The Opposed Mark is likely to deceive the public in Hong Kong as it is calculated to cause confusion on the part of the public and to lead the public into the mistaken belief that the Applicant's

Goods and Services are the goods and services provided or authorised by the Opponents. The application for registration of the Opposed Mark is made in bad faith. In the premises, the Opposed Mark shall not be granted as it is contrary to Section 11(4)(b) and or Section 11(5)(b) of the Trade Marks Ordinance. "

"12. The Opposed Mark is similar to the Opponents' Marks. The goods and services for which the Opposed Mark is applied are identical and/or similar to those for which the Opponents' Marks are protected. The use of the Opposed Mark in relation to the applied goods and services is likely to cause confusion on the part of the public. The Opposed Mark shall not be granted registration as it is contrary to Section 12(3) of the Trade Marks Ordinance."

43. It is the Defendant No.1's own stand that the Plaintiff's goods and services for which the marks are applied are identical or similar to the Defendant's goods and services which is likely to deceive the public and likely to cause association between the Defendant's and Plaintiff's goods and services. Mr. Tulzapurkar has rightly invoked the doctrine of prosecution history estoppel which would operate against the Defendants. The Plaintiffs mark was opposed by the Defendant No.1 without making any distinction between the children's clothing or adult clothing or between goods on one hand and services on the other hand. That being the stand adopted, the Defendants cannot take a contrary stand in the present proceedings and create an artificial distinction between goods and services. Even in the reply Affidavit there is no such case of distinction between goods and services pleaded by the Defendants.

44. Mr. Tulzapurkar is also right in pointing out the pleadings in the

affidavit-in-reply while justifying the failure of negotiations for the reason that permitting the Plaintiffs to enter into markets where the Defendant No.1 had strong presence would amount to losing the progress and market dominance and take advantage of the hard earned goodwill and reputation. The converse would also apply in the present case particularly considering that in the year 2008 the Plaintiffs had entered into market in respect of garments and the Defendants have opened its first store in 2019 using identical mark. Being an early entrant into market, the Plaintiffs have acquired reputation and goodwill and by permitting the Defendants to use the mark in respect of similar products would *prima facie* prejudice and cause loss to the Plaintiffs.

45. Adoption of the identical/deceptively similar mark by the Defendants in respect of the similar products cannot be, *prima facie* said to be honest for the following reasons:

(a) The mark which was registered by the Defendant No.1 in 2011 in countries outside India was **“ROOKIE USA”** whereas while entering the Indian market, the Defendant No.1 has registered the mark **“ROOKIE”** without any suffix or prefix. The Defendants mark is identical to that of Plaintiffs mark and there is no explanation given by the Defendants as to why the word **“USA”** has been dropped by the Defendant No.1

while applying for registration in India.

(b) Though the registration was obtained for the mark **“ROOKIE”**, the Defendant No.1 has launched its store under the unregistered trade mark **“ROOKIE USA”** where the word “USA” is written in negligible font and prominence is given to the word **“ROOKIE”** which is dishonest adoption.

(c) The Defendant No.1 had applied for registration in Hong Kong in Class 18, 25 and 35 whereas while applying in India the Defendant No 1 has applied for registration only in Class 35. There is thus a conscious dishonest effort by the Defendants to ensure that its registration does not come into conflict with the Plaintiffs mark in Class 25. By applying only in Class 18 and Class 35 and no explanation having been tendered despite specific argument being made, the adoption of the said mark by the Defendants is dishonest.

(d) The Defendant No.1 has applied for registration of its trade mark **“ROOKIE”** in Class 18 and Class 35 on 11th April 2014 and opened its first store under the different unregistered trade mark **“ROOKIE USA”** in the year 2019. In the year 2018, the Plaintiffs had applied for registration of mark in Hong Kong which was opposed by the Defendant No.1 on 25th January 2019. The Defendants were therefore aware about the existence of Plaintiffs mark in India and despite thereof opened its store in the year 2019 under the

deceptively similar mark which shows the dishonest adoption.

46. Section 28(3) of Trade Marks Act protects the right of use of the trademark of registered proprietor and provides that no exclusive right to use a registered trademark can be claimed against the other registered proprietor of identical trade mark. The Defendant No.1 is the registered proprietor of the trade mark **“ROOKIE”** in India, however, the registration of the impugned mark does not prevent this Court at interlocutory stage to go beyond the validity of trade mark and grant injunction, if it is found that registration of the mark is *ex facie* illegal or fraudulent or such which shocks the conscience of the Court.

47. The Hon’ble Full Bench of this Court in ***Lupin Ltd vs Johnson and Johnson*** (supra) was considering whether the Court can go into the question of validity of registration of the trademark at an interlocutory stage. The Hon’ble Full Bench held that the words “if valid” occurring in Section 28 and “*prima facie* evidence of title” in Section 31 supports the stand that the defence of invalidity of registration of the trademark can be considered at the interlocutory stage. The Hon’ble Full Bench came to a finding that it is only in exceptional circumstances such as the registration being *ex facie* illegal or fraudulent or which shocks the conscience of the Court that the Court may decline to grant relief in favour of Plaintiff. A heavy burden is cast to challenge the validity of

the registered trade mark at interlocutory stage. The decision has left a small window to challenge the validity and in the present case, in my view, *prima facie* the registration of Defendant's mark **"ROOKIE"** is *ex facie* illegal and fraudulent. There is no doubt that the Defendant's mark is identical to that of Plaintiff's mark **"ROOKIES"** which has been granted registration in Class 25 in the year 2008 and is used by the Plaintiffs since then. The Defendant No.1 has secured registration of its mark in the year 2011 in Class 18 and Class 35.

48. The relative grounds of refusal under Section 11(a) of the Trade Marks Act prohibits registration of trade mark which because of its identity with the earlier trade mark and identity or similarity of goods is likely to cause confusion on part of public or likely association with the earlier trade mark. The application for registration by the Defendant in Class 18 and 35 and omitting to seek registration in Class 25, when internationally its registrations are in Class 18, 25 and 35 would *prima facie* indicate a fraudulent act on the part of Defendant to secure registration of its mark without running into the obstacle of Plaintiff's mark being cited. There is no pleading in the reply that prior to the application for registration, the Defendant No.1 carried out search in the trade mark registry to ascertain whether similar marks are registered. The adoption and registration of the mark **"ROOKIE"** internationally is also since the year 2011 i.e. after the adoption of the

mark by the Plaintiffs in the year 2008 in India.

49. The Plaintiffs have not only made out a *prima facie* arguable case for invalidity but has also discharged the burden to rebut the presumption of validity by showing the similarity in goods and services and the likelihood of confusion on the part of public and likely association with the earlier trade mark as noted above. It is not that the Court is powerless to grant an injunction against the registered trade mark if it is found that the registration of later mark would constitute a case of infringement of earlier trade mark and would cause irreparable harm and loss to the proprietor of earlier mark. The value of the trade mark is its ability to simulate the sales and in the present case by reason of the presence of Defendants in clothing sector in which the Plaintiffs have been operating since the year 2008 would result in irreparable loss to the Plaintiffs. In my view, this is a fit case where this Court can go beyond the validity of the mark and grant injunction in favour of the Plaintiffs.

50. In so far as the aspect of delay is concerned, it is well settled that the delay by itself is not a ground available as defence in the infringement action [See ***Midas Hygiene Industries v. Sudhir Bhatia***²⁷]. The contention of the Defendants that the Plaintiffs have acquiesced in use of the mark by the Defendants is sufficiently answered by the

²⁷ 2004 3 SCC 90.

Delhi High Court in ***Hindustan Pencils Private Limited v. India Stationary Products Co***²⁸, holding that in law mere failure to sue without positive act of encouragement is not defence and is not acquiescence.

51. In the present case, it needs to be noted that in the year 2019, upon the announcement of opening of store by Defendant, immediately cease and desist notice was issued on 23rd March 2019 by the Plaintiffs to the Defendant No.3. Subsequently, there was communication between the Plaintiffs and the Defendants and talks were ongoing for amicable co-existence of the parties. It is only in August 2019 that the negotiations failed and thereafter Plaintiff filed rectification application and also instituted the present proceedings. For the purpose of dis-entitling the Plaintiffs from any interim relief on the ground of acquiescence, it is required to be shown that there was some positive act on the part of Plaintiffs which led to an encouragement of the Defendants that the plaintiffs have given up its contention, which positive act is missing in the present case.

52. The present action is for infringement of trade mark as well as passing off. There are no arguments advanced by Dr. Tulzapurkar to oppose the relief of passing off. It is well settled that for the purpose of considering the relief of passing off, registration of the mark and

28 AIR 1990 Delhi 19.

common field of activity are irrelevant. The Defendants commenced use of the impugned trade mark **"ROOKIES USA"** in Class 35 in India on 23rd March 2019 when it opened its store by using the infringing trade mark. The relevant date for the purpose of considering the goodwill and reputation of the Plaintiff is in the year 2019. The Plaintiff is using its mark **"ROOKIES"** since the year 2008 and was marketing its product under the said mark for at least 11 years before the Defendant entered the market in India. The Trade Marks Act being a territorial enactment, the existence of Defendants and registration of the marks in other countries is irrelevant. The Plaintiffs have placed on record material to *prima facie* demonstrate its enormous reputation and goodwill. The Plaintiff's sales turnover in the year 2018-19 was Rs.30,19,08,558/- and the promotional expenses were at the relevant period Rs.17,64,027/-. The Plaintiffs have also placed on record the vendor agreements with multi-brand outlets such as Lifestyle International Private Limited and Globus Stores Private Limited, which indicates that the Plaintiff's goods were being retailed at well known multi-brand outlets. It is also placed on record that Plaintiff's goods are endorsed by celebrities. *Prima facie* from the material on record, I find that the Plaintiff's mark had acquired reputation and goodwill in India at the time when the Defendants commenced the use of its mark.

53. As held in the case of ***Ruston & Hornsby Ltd v. Zamindara***

Engineering Co²⁹, the question to be asked in the case of passing off is whether the Defendant has designed its product in such a manner so as to lead the consumers in believing that goods of Defendant are that of the Plaintiff. In my view, despite being aware of the Plaintiff's trade mark, adoption of an identical mark by the Defendants is *prima facie* an act of misrepresentation on the part of Defendants to ride upon the reputation and goodwill of Plaintiffs in India. The pleadings which have been raised in its affidavit-in-reply by the Defendants that permitting the Plaintiffs to enter into the markets where the Defendant No.1 is already established would dilute the market dominance, would also apply to the Defendants when the Defendants attempt to make late entry in the market which is dominated by the Plaintiffs. There is, therefore, *prima facie* irreparable loss which will be caused to the Plaintiff's reputation and goodwill by use of the impugned mark by the Defendants. The Plaintiffs domain name comprises of the trade mark being "rookiejeans.com" since the year 2008 whereas the Defendant No.1's domain name "rookieindia.com" uses the Plaintiffs registered trade mark. It is well settled that domain names can be legally protected to the extent possible under the law relating to passing off.

(See *Satyam Infoway Ltd v. Siffynet Solutions Pvt Ltd*³⁰.)

54. Dealing with the decisions relied upon Dr. Tulzapurkar, the

²⁹ (1969) 2 SCC 727.

³⁰ AIR 2004 SC 354.

decision of ***American Home Products Corporation v. Mac Laboratories Pvt. Ltd*** (supra) reiterates the ingredients of Section 28(3) of the Trade Marks Act, 1958. There is no quarrel with the said proposition however the Full Bench in ***Lupin*** (supra) considered the significance of the words “if valid” occurring in Section 28(3) to hold that the Court at the interlocutory stage can go beyond the registration.

55. In the case of ***C. & T. Harris (Calne) Ltd. v. F. S. E. Harris*** (supra), the High Court of Justice-Chancery Division held that there was no passing off in that case as the Plaintiff’s reputation extended only to English bacon and the Defendant had made it clear to his customers that he traded in Danish bacon. It further held that the use of his name is *bona fide* and permissible under Section 44 of the Trade Marks Act, 1905 and therefore there was no infringement. The Court considered the dissimilarity between the two variants of bacon and that the Defendant’s surname was “Harris” which was being used by the Defendant. The decision was rendered in the facts of that case after evidence was duly led and in my view, this was one of the extreme cases where the Court differentiated between English bacon and Danish bacon. Closer home, there are several decisions noted above which take into consideration the similarity of goods or services in order to apply the provisions of Section 29(2) of Trade Marks Act.

56. In the case of ***Zippo Trade Mark*** (supra), decision in the case of

British Sugar Plc v. James Robertson & Sons Ltd (supra) was followed and considering the goods which were involved in the said case, the case of invalidation was decided. There is no quarrel with the principles of law laid down in the said case. However, it is the application of the said principles to the facts of each case which differs.

57. In the case of ***Application by Ladislav Jellinek for the registration of a Trade Mark*** (supra) the Court held that shoe and shoe polish were not goods of the same description and the registration should be allowed. The decision came to be rendered in facts of that case and one of the considerations that weighed with the Court was the different trade channels as it held that the great bulk of shoe polish was sold through grocers, dry salters and the like which does not constitute the trade channel for trade of boots and shoes at all.

58. Next is the decision in the case of ***Raleigh International Trade Mark*** (supra) which arose out of the opposition proceedings. The Court held that if the goods and services specified in the opposed application for registration are not identical or self evidently similar to those for which the earlier trade mark is registered, objection should be supported by evidence as to the similarity. In that case, the evidence did not go into the question of similarity of goods and details to support the case and it is in the facts of that case, the Court dismissed the appeal. The said decision does not lay down an absolute

proposition of law that in all cases where there is defence of dissimilarity, no *prima facie* case can be considered for grant of interlocutory relief and the case has to necessarily proceed for trial.

59. In ***Harding v. Smilecare Limited*** (supra) the Court followed the decision of ***British Sugar Plc v. James Robertson & Sons Ltd*** (supra) and held that goods or services were not identical. In that case, the Court did not find any similarity as the claimants were dental practitioner providing traditional dental services under the style “Smile Dental Practice” and the Defendant operated a credit administration scheme to dental practice under the name “Smile Practice”. It is in those facts that the Court came to the conclusion that there was no connection between the services provided by the claimants and the services provided by the Defendant except the word dentist. The factual scenario is different in the instant case and the said decision would not assist the case of the Defendants.

60. In ***M/s Parry and Co v. M/s Perry & Co***(supra), the Court compared the rival marks Parry and Perry and the rival products confectionary and biscuit. The Court held that the registration will not entitle the party to claim exclusive right over the entire class of goods, which was not accepted. The decision is clearly distinguishable as there is no case of the Plaintiffs claiming exclusive right over all the articles covered by the classification.

61. In *Williams' Ld vs Massey Ld* (supra), the injunction was granted as substantial user was established prior to the application for registration of the trade mark. The said case would in fact assist the Plaintiffs as the Defendant No 1 has failed to establish substantial user. The Plaintiffs trademark is being used since the year 2008, whereas the Defendant No 1 applied for registration of the trade mark in the year 2014 and there is no user demonstrated of the registered trade mark **"ROOKIE"**.

62. Considerable reliance has been placed on foreign precedents to substantiate the case of the Defendants. Most of the foreign decisions were rendered at the time when the commercial market was restricted and consumers could well differentiate between the different products as the markets were not flooded with several variants of the same product marketed under various brands. There is also difference between foreign markets and Indian markets and the relevant consumer base. The test of infringement or passing off when considered from the aspect of Indian markets would be of average consumer with imperfect recollection. The relevant consumer base in foreign countries would be better educated and well informed capable of distinguishing the goods from each other. The judicial pronouncements by the Indian Courts have evolved the law on trade marks while retaining the well settled tests but based on the home

truths about the Indian commercial markets and relevant consumers in India, which would be more applicable.

63. In light of the discussion above, the Plaintiffs have made out *prima facie* case for grant of interim relief and in event, the relief is not granted irreparable harm and loss would be caused to the Plaintiffs tilting the balance of convenience in favour of the Plaintiffs. Consequently, the interim application is allowed in terms of prayer clause (a) , (b) and (c) which reads as under:

“(a) that pending the hearing and final disposal of the Suit, Respondents by themselves, their Directors, associates, affiliated companies, assignees in business, franchisees, licensees, distributors, dealers, stockists, sister concerns, representatives, agents and all persons acting for and on their behalf be restrained by a temporary order and injunction of this Hon'ble Court from manufacturing, marketing, exporting, retailing, selling, distributing, whole selling any clothing, readymade garments, apparels, and/or such allied and cognate goods using the impugned trade mark/trading style/domain name 'ROOKIE' and/or using any other trade mark/trading style/domain name containing the word 'ROOKIE' and/or using any other mark either as a trade mark, trade name, trading style, logo, device, domain name, key word, meta tag, hashtag, or in any other manner which is identical with and/or deceptively similar to the Applicants' registered trade mark 'ROOKIES' and/or any 'ROOKIES' family/series of trade marks in relation to any goods and services so as to infringe the Applicant's trade mark 'ROOKIES' and its 'ROOKIES' family/series of trade marks registered under Nos. 1766494, 2802602, 2802603, 4184928, 4184930, 4184932 in Class-25 and 4184927, 4184929, 4184931, 4184934, 4211737 in Class-35 by such use and/or in any other manner whatsoever;

(b) that pending the hearing and final disposal of the Suit, Respondents by themselves, their Directors, associates, affiliated companies, assignees in business, franchisees, licensees, distributors, dealers, stockists, sister concerns, representatives, agents and all persons acting for and on their behalf be restrained by a temporary order and injunction of this Hon'ble Court from manufacturing, marketing, exporting, retailing, selling, distributing, whole selling any clothing, readymade garments, apparels, and/or such allied and cognate goods using the

impugned trade mark/trading style/domain name 'ROOKIE' and/or using any other trade mark/trading style/domain name containing the word 'ROOKIE' and/or using any other mark either as a trade mark, trade name, trading style, logo, device, domain name, key word, meta tag, hashtag, or in any other manner which is identical with and/or deceptively similar to the Applicants' registered trade mark 'ROOKIES' and/or any 'ROOKIES' family/series of trade marks in relation to any goods and services so as to pass off their goods/services as those of the Applicants' goods sold and services rendered under the trade mark/trading style/domain name 'ROOKIES' and its 'ROOKIES' family/series of trade marks or in any other manner whatsoever;

(c) that pending the hearing and final disposal of the Suit, Respondents by themselves, their Directors, associates, affiliated companies, assignees in business, franchisees, licensees, distributors, dealers, stockists, sister concerns, representatives, agents and all persons acting for and on their behalf be directed to transfer and completely hand over to the Applicants, the impugned domain name 'https://rookieindia.com/' and/or any other domain name incorporating the word 'ROOKIE' and its access control to the Applicants. Alternatively, the Respondents be directed to take immediate steps to takedown the website hosted on the impugned Domain Name / other domain name containing the word 'ROOKIE' and to cancel the registration of the impugned domain name/other domain containing the word 'ROOKIE'."

[Sharmila U. Deshmukh, J.]

64. At this stage, request is made on behalf of the Defendants by Dr. Tulzapurkar for stay of the present order. Request is opposed by Mr. Hiren Kamod for the Plaintiffs. Considering that there was no ad-interim relief operating, I am inclined to stay this order for a period of six weeks from the date of uploading of this order on the official website.

[Sharmila U. Deshmukh, J.]