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

INTERIM APPLICATION NO. 2515 OF 2025

IN

COMMERCIAL IP SUIT NO. 432 OF 2025

SML Limited (formerly known as Sulphur Mills ... Applicant Limited), a company incorporated under the (Org. Plaintiff) Companies Act, 1956 and having its registered office at 604/605, 349 Business Point, 6th floor, Western Express Highway, Andheri (East), Mumbai 400 069.

Versus

Safex Chemicals (India) Ltd a company incorporated ... Defendant under the Companies Act, 1956 and having its registered office at 4th and 5th Floor, Block-A, NDM 1, Netaji Subhash Place, Delhi 110034

Mr. Hiren Kamod a/w Lata Dhruv, Anushka Divakaran, Charu Budhadev i/by Dharu & Co., for Applicant/Plaintiff.

Adv. Vaibhav Vutts a/w Aamna Hassan, Aarya Deshmukh, j, Amal Anand i/by Vutts & Associates for Defendant.

Coram : Sharmila U. Deshmukh, J.

Reserved on: August 12, 2025.

Pronounced on: September 22, 2025.

(Through Video Conferencing)

ORDER:

1. This is an action for infringement of trade mark and for passing off.
2. The case of the Plaintiff is that the Plaintiff had applied for registration of its trade mark on 3rd January, 2018 on proposed to be

used basis and had secured registration on 2nd November, 2019 of the word mark "TRACKON" in Class 1 in respect of "Fertilizers, Plant Nutrients, Organic Manures, Manures, Organic Fertilizers, Biofertilizers, Compost, Biochemical Catalyst, Plant Growth regulating preparations, chemicals used in Industry, Agriculture, Horticulture and Fertilizers."

3. On 7th May, 2021, the Plaintiff applied for registration of the trade mark "TRACKON GOLD" in Class 1 and was granted registration on 2nd November, 2021. At the time of filing the applications for registrations, the name of the Plaintiff Company was "Sulphur Mills Limited" and w.e.f. 18th October, 2022 the Plaintiff's Company name was changed to "SML Limited". Accordingly the Plaintiff filed Form TM-P for recording the name change and the registration of the word marks are thereafter reflected in the name of "SML Limited".

4. In the last week of November-2024, the Plaintiff came across the Defendant's application for registration of the impugned word mark "TRACKON" in Class 5 in respect of "Pesticides, insecticides, fungicides, herbicides, vermicides, rodenticides, weedicides, Preparations for killing weeds and destroying vermin, disinfectants and poisons" with a user claim of 16th August, 2020, upon its publication in the Trade Mark Journal No. 2167 on 29th July, 2024. On 27th November, 2024, the Plaintiff filed its Opposition No. 1363130 to the grant of registration of impugned mark in favour of the Defendant.

5. It is submitted that the Plaintiff conducted market search to procure the Defendant's goods bearing the impugned mark after the filing of opposition on 27th November, 2024, however, the Plaintiff did not come across any impugned goods bearing the impugned mark. The Plaintiff was therefore under *bona fide* belief that in view of the Opposition the Defendant's must have stopped use of impugned mark and did not adopt any immediate action.

6. The Registrar of Trade Marks vide its notice dated 18th March, 2025 forwarded to the Plaintiff, the copy of the Defendant's counter statement dated 28th January, 2025, asserting its right to the impugned mark. It is submitted that the Plaintiff once again conducted search in market and in April-2025, the Plaintiff for the first time came across the Defendant's product i.e. a Selective Insecticide sold under the impugned mark "TRACKON". On 8th April, 2025, the Plaintiff procured a sample of the infringing product from M/s. Fasal Suraksha Kender, New gain Market Shop No. 73A Mandi Dabwali, Haryana – 125104. It is submitted that upon general search of the internet the Plaintiff came across the Defendant's website however the infringing product bearing the impugned mark is not listed on the Defendant's website and is listed on 3rd party website i.e. www.indiamart.com.

7. It is submitted that in the past, action for infringement was instituted by the Plaintiff against the Defendant in respect of the

Plaintiff's another registered mark "PEARL" , in which the Defendant submitted to a decree on admission. It is submitted that the Defendant is habitual infringer of several other marks of third parties and is suffering injunction in those proceedings.

8. The Defendant by its affidavit-in-reply dated 27th May, 2025 has set out that its incorporation is of the year 1991 and it is in the business of marketing various agrochemicals including herbicides, weedicides, fungicides, and insecticides, boasting of product line of over 120+ goods. The Defendant conceived and adopted the mark "TRACKON" in the year 2020, and has been continuously, extensively and uninterruptedly using the same since its adoption. Prior to the adoption of the mark, the Defendant had conducted a search and had not found any such mark existing in the market. The Defendant is an honest and concurrent user of the mark and *bonafide* adopter of the trade mark since past 5 years and to demonstrate the goodwill and reputation enjoyed by the Defendant, the sales figure and expenses incurred towards the packaging have been set out.

9. The defence is that the Defendant's use of its trade mark is in respect of products different from the Plaintiff's products. It is submitted that there is no likelihood of confusion in view of the vast price difference and the difference in the trade dress, product getup & colour combination of the rival products.

10. It is further submitted that the Plaintiff has suppressed its stand taken before the trade mark registry in the examination report citing the mark “TRICON” that the trademark “TRACKON” and the cited mark “TRICON” are not visually, phonetically, and structurally similar and that the goods for which the cited marks are registered are dissimilar ruling out any likelihood of confusion amongst the public. The further defence taken is of delay and acquiescence contending that the Plaintiff had knowledge about the Defendant since atleast 2024.

11. In the rejoinder Affidavit, it is contended that there is no case of suppression or estoppel as the cited mark “TRICON” does not belong to the Defendant and is not the same as the impugned mark i. e. “TRACKON”. It is submitted that the rival products are similar/allied/cognate/complementary and that the classification of trade mark is only for administrative purpose. It is submitted that the customer of the Plaintiff goods and the trade channels are same and there is likelihood of confusion and deception. It is stated that there is no delay and acquiescence as it is well settled that delay is immaterial in the case of trade mark infringement and there is no positive act on part of Plaintiff to infer acquiescence. It is submitted that in event the Defendant had conducted search in the trade mark registry it would have come across the Plaintiff’s prior registered mark.

12. By an additional affidavit-in-reply of Defendant, the invoices filed

by the Plaintiff are assailed as false and fabricated as the invoices of the year 2018 onwards bears the name "SML Limited (formerly Sulphur Mills Limited)" as it is Plaintiff's own case that the Plaintiff's name was changed to SML Limited only on 18th October, 2022.

13. The Plaintiff's additional affidavit-in-rejoinder annexes the user affidavit filed in support of its trade mark application with the illustrative sales invoices of the year 2018. An explanation has been tendered about the use of an ERP software which results in the re-generated invoices bearing the changed template. To demonstrate genuineness of the invoices, it is submitted that the re-generated invoices bears the unique IRN number generated while making payment of GST. In addition, the respective ledger accounts for the relevant periods maintained by the Plaintiff are also annexed to the additional affidavit-in-rejoinder.

SUBMISSIONS:

14. Mr. Kamod, learned Counsel for the Plaintiff points out the registration certificates, the invoices, the sales and promotional figures to substantiate the Plaintiff's claim of being prior user and registered proprietor of the trade mark "TRACKON". He submits that the Defendant's application for registration is subsequent on 3rd February, 2023 with the user claim since 16th August, 2020, which has not been substantiated as the invoices annexed are from September, 2022. He

submits that the Defendant's mark has been duly opposed. He submits that the Defendant is aware of the Plaintiff's existence since in the earlier infringement proceedings, the Defendant has submitted to decree on admission. He submits that there is no question of any delay or acquiescence as there is no positive act on part of the Plaintiff and it is well settled the delay by itself is no defence in infringement action. He submits that in any event it is only in the last week of November-2024 that the Plaintiff came across the Defendant's trade mark registration and the suit has been filed in April-2025.

15. He submits that the Defendant has not tendered any explanation for adoption of the identical mark "TRACKON" which is an arbitrary mark. He submits that there was no search conducted by the Defendant in the trade mark registry before adopting the mark, which is at the Defendant's own peril. He submits that there is no question of estoppel or suppression as the conflicting mark cited at the time of Plaintiff's registration was "TRICON" whereas in the present case the marks are identical.

16. He would submit that the marks are identical, the consumer base are farmers and rival products are likely to be sold through the same trade channels. He submits that under the provisions of Section 29(2) of the Trade Marks Act, 1999 ("**T. M. Act**"), even if there is likelihood of association with the Plaintiff's mark, a case of

infringement is established. He submits that the difference in the packaging is immaterial in case of infringement of the trade mark. He submits that there is no question of any honest and concurrent user firstly as Section 12 of T.M. Act is not a defence in infringement action and secondly the the Defendant's documents shows user since September, 2022 and there is no honesty in adoption. In support he relies upon following decisions:

1	<i>Allied Auto Accessories Ltd. vs. Allied Motors Pvt. Ltd.</i>¹
2	<i>Eagle Potteries Pvt. Ltd. vs. Eagle Flask Industries Pvt. Ltd.</i>²
3	<i>Mahyco Pvt. Ltd vs. Seamons Seeds Pvt. Ltd decision of this Court in Interim Application (L) No. 33512-2024 in COMIP (L) No. 26353 of 2024 dated 24th June, 2025.</i>
4	<i>Ruston & Hornsby Ltd. vs. Zamindara Engineering Co</i>³
5	<i>Glenmark Pharmaceuticals Ltd vs. Gleck Pharma (OPC) Pvt Ltd.</i>⁴
6	<i>Hab Pharmaceuticals and Research Ltd vs. Regain Laboratories decision of this Court in Interim Application (L) No. 2307 of 2023 in COMIPR Suit No. 489 of 2022 dated 18th July, 2023.</i>
7	<i>Pidilite Industries Ltd. vs. Riya Chemy</i>⁵

17. *Per contra*, Mr. Vutts, learned Counsel for the Defendant would submit that the word "TRACKON" is an arbitrary word coined and adopted by the Defendant. He submits that the Defendant is not fly by night operator and has been incorporated in the year 1991 having product line of over 120+ goods. He submits that in August-2020, the

1 2002 SCC OnLine Bom 1138

2 1992 SCC OnLine Bom 490.

3 (1969) 2 Supreme Court Cases 727

4 2024 SCC OnLine Bom 1660

5 2022 SCC OnLine Bom 5077

Defendant adopted the mark and points out to the user affidavit at page 197 of the Plaintiff's application and the invoice at Page 198 of August, 2020.

18. He submits that the Plaintiff's claim of user since the year 2018 is doubtful as the invoices annexed bears the name of "SML Limited" which name was changed in the year 2022. He submits that the invoices did not exist and have been generated for the purpose of filing the suit. He would further submit that the list of documents annexed to the plaintiff shows that the invoices were hand written and evidence about genuineness of invoices is required to be led. He submits that in the Plaintiff's application for registration of the mark, the user claim is on proposed to be used basis and the user affidavit has not been filed in the present proceeding and hence there is suppression of material fact. He submits that the Defendant is prior user since the year 2020 and point out the invoices annexed to his affidavit-in-reply.

19. He would further submit that there is suppression as the stand taken in the examination report is not part of the plaintiff. He submits that the Defendant had conducted a search in respect of Class 5 goods and the Plaintiff's mark was not found. He would further submit that the products are packaged differently and there is huge price difference between the two products and there is no question of any confusion. He further submits that the comparison of the rival goods would indicate that the labels, trade dress, product, getup & colour

combination are entirely different. He submits that there is no confusion as the Plaintiff's products are fertilizers whereas the Defendant's products are insecticides. He submits that by reason of the earlier decree on admission, it cannot be accepted that the Defendant is habitual infringer. He submits that there is no equity in Plaintiff's favour and considering the use of the mark by the Defendant since the year 2020, the balance of convenience is not in favour of the Plaintiff. In support, he relies upon following decisions:

1.	<i>Mandali Ranganna vs. T. Ramachandra</i>⁶
2.	<i>S. P. Chengalvaraya Naidu vs. Jagannath</i>⁷
3.	<i>Rubaljit Singh vs. M/s. Kanz Overseas, decision of Delhi High Court in CS(OS) No. 213 of 2009 dated 20.11.2009.</i>
4.	<i>Chandra Shashi vs. Anil Kumar Verma</i>⁸
5.	<i>Poly Medicure Limited vs. Polybond India Pvt. Ltd.</i>⁹
6.	<i>Phonepe Pvt Ltd vs. Resilient Innovations Pvt. Ltd</i>¹⁰
7.	<i>Unichem Laboratories Ltd vs. Ipca Laboratories</i>¹¹
8.	<i>Wander Ltd vs. Antox India P. Ltd.</i>¹²
9.	<i>Nandhini Deluxe vs. Karnataka Cooperative Milk Producers Federation Limited</i>¹³
10.	<i>AMPM Designs vs. Intellectual Property Appellate Board</i>¹⁴
11.	<i>Cadila Health Care Ltd vs. Cadila Pharmaceuticals Ltd.</i>¹⁵
12.	<i>Star Bazaar Pvt. Ltd. vs. Trent Ltd.</i>¹⁶

6 (2008) 11 SCC 1

7 (1994) 1 SCC 1

8 (1995) 1 SCC 421

9 2019 SCC OnLine Del 11967

10 2023 SCC OnLine Bom 764

11 2011 SCC OnLine Bom 2114

12 1990 (Supp) Supreme Court Cases 727

13 (2018) 9 SCC 183

14 2021 SCC OnLine Bom 14029

15 (2001) 5 SCC 73

16 2010 SCC OnLine Del 4764

20. In rejoinder, Mr Kamod would submit that the Plaintiff has submitted a valid explanation in respect of the invoices bearing the mark "SML Limited" and there is no fabrication. He submits that the Defendant's dishonesty is evident from the fact that the Defendant's other marks except "TRACKON" are placed on its website and there is no denial to the said fact in the replies. He submits that the rectification application by the third parties have been disclosed and there is no challenge to the validity of the Plaintiff's mark. He submits as the word marks are identical, passing off is established. He submits that question of balance of convenience is to be considered only in exceptional cases.

REASONS AND ANALYSIS:-

21. There is no debate that the rival marks are phonetically, structurally and visually identical i.e. "TRACKON" and "TRACKON GOLD" vs. "TRACKON". The mark "TRACKON GOLD" comprises of the word "TRACKON" as its leading essential and prominent feature and the Defendant's impugned mark copies the essential feature of the Plaintiff's registered mark. The Plaintiff had applied for registration of its trademark "TRACKON" in Class 1 on 3rd January, 2018 with user claim of proposed to be used and secured registration on 2nd November, 2019 and "TRACKON GOLD" on 2nd November, 2021. The

Defendant applied for registration of its trade mark "TRACKON" in Class 5 on 3rd February, 2023 with user claim since 16th August, 2020, which registration is opposed by the Plaintiff.

22. Section 29 of T.M. Act, 1999 governs the infringement of the trade mark and sub section (2) of Section 29 covers infringement involving allied/cognate goods and services and reads as under:

"(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."

23. For an injunction to follow by reason of Section 29(2)(a) of T.M. Act, 1999, it is necessary to decide the aspect of similarity of goods before turning to the issue of likelihood of confusion or likely association with the registered trade mark. To put it simply, the threshold question to be decided is whether the Plaintiff's and the Defendant's goods are allied and cognate. The dictionary meaning of the word "allied" is "relating in subject or kind" and "cognate" as having

common ancestor or origin. In the case of ***Corn Products Refining Co., vs. Shangrila Food Products Ltd.***,¹⁷ 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 were the 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.

24. The Defendant seeks to raise the defence of classification of the rival goods in different classes to avoid liability of infringement. 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.

25. ***British Sugar Plc. v. James Robertson & Sons Ltd*** ¹⁸ identified the following objective tests to be applied for deciding whether the goods are of the same description:

- (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;

¹⁷ AIR 1960 SC 142

¹⁸ [1996] R. P. C. 281

- (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; and
- (f) The extent to which the respective goods and services are in competition with each other : that inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put goods or services in the same or different sectors."

26. Closer home, in ***Indchemie Health Specialities (P) Ltd vs Intas Pharmaceuticals Ltd***¹⁹ 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 they are generally traded. The three need not even concurrently co-

19 2017 SCC OnLine Bom 10127

exist.

27. Applying the aforesaid principles to the facts of the present case the following position would emerge:

(a) Physical nature of goods: The Plaintiff's product is micro nutrient mixture and the Defendant's product is insecticide. Summarized in common parlance, the Plaintiff's products are fertilizers used in plant growth whereas the Defendant's products are utilized for eliminating pests which harm plant growth. Fertilizers enhance the plant growth by providing essential nutrients whereas the pesticides control or eliminate pests that harm crops.

(b) Respective Uses: Fertilizers and pesticides are both agrochemicals used in agricultural sector for improving the crop yield; one by supplying nutrients to the soil and plants to improve growth and yield and the other to eliminate pests for purpose of enhanced crop yield. In that respect, the rival products are complementary in the agricultural sector.

(c) Respective Users and trade channel: The relevant consumer base are farmers and usually fertilizers and pesticides are retailed at common shop which cater to comprehensive farmers needs and are sold through the same trade channels.

It is settled that the one of the considerations for examination of similarity of goods is from the business and commercial point of view. The commonality of purpose of fertilizers and insecticides demonstrates a strong trade connection and apparent similarity and association between the Plaintiff's products and Defendant's products.

28. Having passed the threshold test of similarity of the goods, the aspect of likelihood of confusion on part of the public and likely association with the Plaintiff's goods requires consideration. The issue of likelihood of association with the Plaintiff's registered trade mark would have a nexus with the reputation acquired by the Plaintiff as the continued long user by the Plaintiff of its registered mark in respect of Plaintiff's product would result in achieving certain degree of distinctiveness. *Prima facie*, the use of an identical mark by the Defendant would naturally result in an association with the Plaintiff's goods mark by an average consumer with imperfect recollection.

29. In order to demonstrate its reputation and goodwill the Plaintiff has annexed Chartered Accountant Certificate which certifies that the total turn over of the Plaintiff's product "TRACKON" for the financial year 2018-2019 to 2024-2025 is in the range of Rs. 6,37,52,869/-. Considering the sales figure which has been placed on record *prima*

facie the Plaintiff's trademark has acquired reputation and goodwill in the market and the cumulative effect of the identical mark and the commercial trade connection between the Plaintiff's and the Defendant's goods is likely to lead the average customers to mistake the Defendant's goods as that of the Plaintiff. Even if the difference in packaging of the rival products might mitigate the likelihood of confusion, the likely association with the Plaintiff's registered trade mark is *prima facie* satisfied. In the present case the Plaintiff is an early entrant in the market and the relevant consumer base are farmers who are likely to get confused when confronted with the Defendants product which also relates to the agricultural sector and *prima facie* would associate the Defendant's product with that of the Plaintiff considering the identical mark. It cannot be said to be an uncommon phenomenon that an entity dealing in fertilizers would foray into the pesticide sector being agrochemicals.

30. The trademark "TRACKON" coined by the Plaintiff is an arbitrary mark which is an inherently distinctive mark and by reason of the continuous and uninterrupted use since the year 2018 is *prima facie* associated with the Plaintiff's products. *Prima facie*, the goods of the Plaintiff and the Defendant being commercially connected are similar in nature and there is identity of trade making out a case of infringement is under Section 29 (2) of the T.M. Act. The aspect of

difference in trade-dress pricing are irrelevant considerations in infringement action.

31. Coming to the defences, one of the defence is of prior user and to substantiate the same, the contention raised is that the invoices annexed to the plaint are fabricated. The Plaintiff in order to substantiate the use of its mark since the year 2018 has relied upon the sales invoices for the period from April-2018 at Exhibit- A-1 to A-31 of the plaint. The Defendant has assailed the claim of user of the mark by the Plaintiff since the year 2018 by contending that the invoices annexed to the plaint have been fabricated for the purpose of filing the suit. The contention is that the invoices of the year 2018 bears the name "SML LTD (Formerly-Sulphur Mills Limited) whereas the admitted position is that the name of the Plaintiff was changed from "Sulphur Mills Limited" to "SML Limited" only on 18th October, 2022 and subsequently in the year 2023 the Plaintiff filed form TM-P for recording the name change which registrations thereafter reflects the name of "SML Limited". To respond to the said contention, the Plaintiff has submitted an explanation in its rejoinder affidavit that in the year 2018, the Plaintiff was using ERP Software called "SAP ECC module", for generating invoices and under this software the Plaintiff could change the format/template of the invoices generated by the Plaintiff. Pursuant to the change in the name in October-2022, the template of

the invoice was changed as appearing Exhibit A-1 to A-19 and after the change of name, invoices if generated or reprinted for the period prior to October-2022 would be in the template set out in Exhibit A-1 to A-19. It is further explained that the Plaintiff upgraded its software version in January-2023 and modified the invoice template to reflect the format as shown in Exhibit A-21 to A-31. The averments *prima facie* explains the reason for the changed template of invoices and the conclusive finding about the genuineness of the invoices can be arrived at only after evidence is led.

32. The Plaintiff has however not based its contention of genuineness of invoices only on the explanation and has further annexed the invoices filed along with the user affidavit while applying for registration of its mark which invoices are of the year 2018. In order to demonstrate the sample invoice, if regenerated today, by using the earlier software, the same invoices which were annexed along with affidavit user would reflect the changed template after change of the name. *Prima facie* it appears that due to the use of the software, upon regeneration of the invoice of prior period, the invoice would be printed in the template used upon the change of the name.

33. Further Mr. Kamod, has also pointed out that upon the registration of invoice on the GST website portal a unique invoice reference number is embedded with each invoice and when the said

number is juxtaposed with the invoice at page 81 which is invoice of 29th June, 2021, though the invoice at page 81 reflects the changed name the IRN number is the same. The Plaintiff has also produced the respective ledger account for the relevant period referring to the respective invoices. The material which has been brought on record by the Plaintiff is sufficient at this stage to *prima facie* demonstrate the use of the mark since the year April-2018.

34. To escape the liability of infringement, the prior use by the Defendant is required to be demonstrated from a date prior to the use of the first mentioned trade mark or date of registration of the first mentioned trade mark, whichever is earlier. It is the Defendant's own stand of user since the year 2020 and even if the Plaintiff's registration date is considered, the Plaintiff's adoption is prior in point of time. The defence of Section 34 of T.M. Act, 1999 is not available to the Defendant.

35. Dealing next with the issue of suppression by the Plaintiff of the examination report issued by the Registrar of Trade Mark at the time of the registration of Plaintiff's mark, the cited mark in that case is "TRICON" whereas in the present case the mark is identical i.e. "TRACKON". The cited mark "TRICON" is not identical to the impugned mark and therefore the stand taken by the Plaintiff in the examination report was not a material fact to be pleaded. The non disclosure of the

examination report does not amount to suppression so as to disentitle the Plaintiff to the interim relief. It needs to be noted that the Plaintiff has disclosed the application filed by a third party for rectification of the Plaintiff's registered trade mark.

36. On the aspect of delay, the contention of Mr. Vutts is that the Plaintiff was aware of the use of the Defendants mark since at least November-2024. It is well settled the delay by itself is not ground in an action for infringement. In ***Midas Hygiene Industries (P) Ltd. v. Sudhir Bhatia***²⁰ the Hon'ble Apex Court has held that in case of infringement either of trade mark or copyright, normally injunction must follow and mere delay in bringing the action is not sufficient to decline the grant of injunction in such cases. In ***Jagdish Gopal Kamath v. Lime & Chilli Hospitality Services***²¹, this Court in the context of infringement of trade mark considered the submissions of delay and balance of convenience. The Co-ordinate bench held that in such cases, delay on its own, unaccompanied by acquiescence, is no answer to an application for an injunction in an action in infringement and passing off. The Co-ordinate bench noted the decision of Delhi High Court in ***Hindustan Pencils Pvt. Ltd. v. India Stationery Products***²² in paragraph 33 as under :

20 (2004) 3 SCC 90

21 2015 SCC OnLine 531

22 1989 SCC OnLine Del 34

“33. Similarly on the issue of delay, the Delhi High Court in Hindustan Pencils (P) Ltd. vs. India Stationery Products Co. & Anr. : AIR 1990 Delhi 19 has also held that delay by itself is not a sufficient defence to such an action especially where the use by the defendants is fraudulent.In Hindustan Pencils, the Delhi High Court considered the question of acquiescence and held that, in law, the question arises where the proprietor of a mark, being aware of his rights, and being aware that the infringer may be ignorant of them, does some affirmative act to encourage the infringer's misapprehension so that the infringer worsens his position and acts to his detriment. A mere failure to sue without a positive act of encouragement is no defence and is no acquiescence. A defendant who infringes the plaintiffs' mark with knowledge of that mark can hardly be heard to complain if he is later sued upon it. A defendant who begins an infringement without searching the trade marks register is in no better a position. One who does take a search, finds the plaintiffs' mark and nonetheless continues his act of infringement is, however, certainly much worse off. Certainly he cannot allege acquiescence. That door is closed to him.”

37. The doctrine of delay was held by itself not to be sufficient defence to an action for infringement especially where the use by Defendant is fraudulent. The Plaintiff has specifically pleaded that the infringing product is not listed on the Defendant's website, which is not disputed. There is no explanation for the clandestine manner in which the Defendant is dealing with its product bearing the impugned mark. The pleading is that the Plaintiff became aware of the Defendant's existence in last week of November, 2024 and on 27th November, 2024, the Plaintiff filed its opposition to the registration. The suit has been filed on 16th April, 2025. It is settled that mere failure to sue without a positive act of encouragement is no defence and is no

acquiescence. The Defendant was well aware of Plaintiff's existence as there was prior action initiated for infringement of trade mark and having infringed the registered trade mark with full knowledge the Defendant cannot be heard on the question of delay. There is no defence of acquiescence available and delay by itself without acquiescence cannot constitute valid defence in an action for infringement.

38. The contention of honest and concurrent use does not assist the case of the Defendant as Section 12 of the T. M. Act, 1999 dealing with honest and concurrent use permits registration of the mark by more than one proprietor. Section 12 of T.M. Act, 1999 cannot constitute a defence in an action for infringement. In any event there is no concurrent use as the Plaintiff had adopted the trade mark in the year 2018 whereas the Defendant had adopted mark in the year 2020. Pertinently the Defendant was aware of the existence of the Plaintiff and in the earlier round of litigation had submitted to decree on admission which imposed an added responsibility on the Defendant to ensure that the mark adopted by the Defendant does not in any manner infringe on the Plaintiff's registered mark. It is not shown that such caution was exercised by the Defendant before adopting the mark in the year 2020. There is no explanation tendered in the affidavit-in-reply for adoption of an identical arbitrary mark which is unconnected

with the product of the Defendant. In such circumstances it cannot be said that the adoption of the mark is *bonafide* or honest. The reliance on Section 12 of T.M. Act, 1999, if permitted, would strengthen the Plaintiff's case as registration of identical/similar mark is permitted in such case in respect of same or similar goods or services and would thus constitute an admission that the Plaintiff's and Defendant's goods are similar. In my view, the Plaintiff has *prima facie* made out case of infringement of its registered trade mark and where there is infringement of registered mark, injunction must follow. (***See Ruston & Hornsby Ltd vs Zamindra Engineering Company***) (*supra*).

39. The Plaintiff had commenced the use of the mark in the year 2018 whereas the Defendant has adopted the mark in the year 2020. There is no justification for adoption of an identical mark by the Defendant despite being aware of the Plaintiff's existence in light of the prior litigation. In case of registered trade mark, a statutory protection is afforded under the T.M. Act, 1999. As it has been held that *prima facie* the consumers may identify the Defendant's goods as that of the Plaintiff, in event the injunction is not granted, the Plaintiff will suffer irreparable loss by way of damage to the reputation and goodwill. The subsequent adoption of the identical trade mark by the Defendant in the year 2020 was at the Defendant's own peril. The balance of convenience therefore tilts in favour of the Plaintiff.

40. The Plaintiff also seeks injunction against the Defendant from passing off its goods as that of the Plaintiff. It is probable that even if the rival marks are identical, there is difference in the trade dress that no passing off could be alleged. It is settled that the intent of the Defendant is not necessary and it is enough for the Plaintiff to satisfy the trinity test of goodwill, misrepresentation and damage. The relevant date to consider the reputation and goodwill acquired by the Plaintiff in respect of its mark is the date of adoption by the Defendant i.e. in the year 2020 and it has to be shown that the Plaintiff's mark has acquired such distinctiveness that the consumers identify the registered mark with the Plaintiff's product. The sales turnover duly certified by the Chartered Accountant for the year 2020-2021 is Rs 1,66,59,110/- and there is no further material to demonstrate the distinctiveness achieved by the Plaintiff's registered mark.

41. In case of **Kaviraj Pandit Durga Dutt Sharma v. Navaratna Pharmaceuticals Laboratories**,²³ the Hon'ble Apex Court held in paragraph 28 as under:

"28. The other ground of objection that the findings are inconsistent really proceeds on an error in appreciating the basic differences between the causes of action and right to relief in suits for passing off and for infringement of a registered trade mark and in equating the essentials of a passing off action with those in respect of an action complaining of an infringement of a registered trade mark. We have already pointed out that the suit by the respondent complained both of an invasion of a statutory

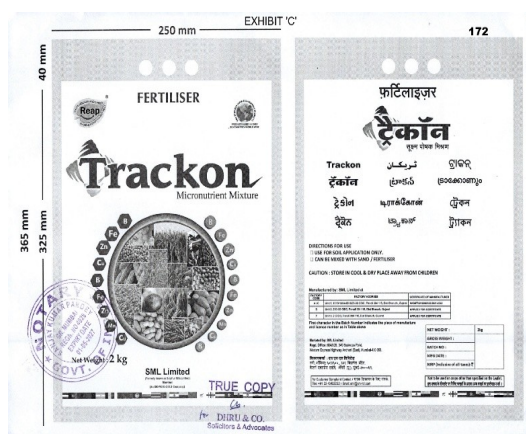
23 1964 SCC OnLine SC 14

right under Section 21 in respect of a registered trade mark and also of a passing off by the use of the same mark. The finding in favour of the appellant to which the learned counsel drew our attention was based upon dissimilarity of the packing in which the goods of the two parties were vended, the difference in the physical appearance of the two packets by reason of the variation in the colour and other features and their general get-up together with the circumstance that the name and address of the manufactory of the appellant was prominently displayed on his packets and these features were all set out for negating the respondent's claim that the appellant had passed off his goods as those of the respondent. These matters which are of the essence of the cause of action for relief on the ground of passing off play but a limited role in an action for infringement of a registered trade mark by the registered proprietor who has a statutory right to that mark and who has a statutory remedy for the event of the use by another of that mark or a colourable imitation thereof. While an action for passing off is a Common Law remedy being in substance an action for deceit, that is, a passing off by a person of his own goods as those of another, that is not the gist of an action for infringement. The action for infringement is a statutory remedy conferred on the registered proprietor of a registered trade mark for the vindication of the exclusive right to the use of the trade mark in relation to those goods" (Vide Section 21 of the Act). The use by the defendant of the trade mark of the plaintiff is not essential in an action for passing off, but is the sine qua non in the case of an action for infringement. No doubt, where the evidence in respect of passing off consists merely of the colourable use of a registered trade mark, the essential features of both the actions might coincide in the sense that what would be a colourable imitation of a trade mark in a passing off action would also be such in an action for infringement of the same trade mark. But there the correspondence between the two ceases. In an action for infringement, the plaintiff must, no doubt, make out that the use of the defendant's mark is likely to deceive, but where the similarity between the plaintiff's and the defendant's mark is so close either visually, phonetically or otherwise and the court reaches the conclusion that there is an imitation, no further evidence is required to establish that the plaintiff's rights are violated. Expressed in another way, if the essential features of the trade mark of the plaintiff have been adopted by the defendant, the fact that the get-up, packing and other writing or marks on the goods or on the packets in which he offers his goods for sale show marked differences, or indicate clearly a trade origin different from that of the registered proprietor of

the mark would be immaterial; whereas in the case of passing off, the defendant may escape liability if he can show that the added matter is sufficient to distinguish his goods from those of the plaintiff."

42. The contention of the Defendant is that the goods are packaged in a manner which sets apart the Defendant's goods from that of the Plaintiff and therefore there is no likelihood of causing confusion. The Defendant has tendered a comparative chart showing the Plaintiff's and Defendant's use of the mark "TRACKON". The rival products are reproduced herein below.

Comparison of the Plaintiff's and Defendant's Products



43. The comparison of the rival products would show that the Plaintiff uses the mark “TRACKON” and “TRACKON GOLD” along with pictorial representation of the crops in a circular shape whereas the Defendant’s product bears a different pictorial representation in rectangle label shape. The colour combination and the depiction of the mark “TRACKON” in the rival products is completely different. There is difference in the physical appearance as there is no similarity of general get-up/trade dress/colour scheme of the products. The question to be asked as set out in ***Ruston & Hornsby Ltd. vs. Zamindara Engineering Co., (supra)*** is whether the Defendant is selling the goods so marked as to be designed or calculated to lead purchasers to believe that they are the Plaintiff’s goods. Upon overall comparison of the rival packaging/trade dress/layout, the consequence of the apparent dissimilarity in the packaging/trade dress of the rival products is that no *prima facie* case of passing off is made out. *Prima facie* it cannot be said that the Defendant has designed its product in a manner so as to pass off its goods as that of the Plaintiff. The added material are sufficient to distinguish the goods of the Defendant from that of the Plaintiff. In my view, there is no *prima facie* case of misrepresentation made out by the Plaintiff and therefore *prima facie* case of passing off is not made out.

44. Coming now to the decisions cited by Mr. Vutts, in case of ***Mandali Ranganna vs. T. Ramachandra (supra)*** the Hon'ble Apex Court set out the tests to be satisfied while granting injunction laying emphasis on the conduct of the parties. There is no quarrel with the said proposition and in the present case in my view the conduct of the Plaintiff would not disentitle the Plaintiff to grant of interim relief.

45. The next decision in the case of ***S. P. Chengalvaraya Naidu (Dead) by Lrs. vs. Jagannath (Dead) by Lrs (supra)*** is landmark decision laying down that fraud vitiates all acts. The decision of ***Chandra Shashi vs. Anil Kumar Verma (supra)*** is again on the issue of fraud. Once this Court has come to *prima facie* conclusion that the invoices produced by the Plaintiff are not forged or fabricated the said decisions are inapplicable to the facts of the present case.

46. The next decision of ***Rubaljit Singh vs. M/s. Kanz Overseas (supra)*** was rendered by the Delhi High Court in an infringement action. It is in the facts of that case, the Court came to finding that the documents relied upon by the Plaintiff have been fabricated. In the present case, the discussion above would indicate that sufficient explanation has been tendered by the Plaintiff in respect of the invoices produced on record and the said decision does not assist the case of the Defendant.

47. The decision in the case of ***Poly Medicure Limited vs. Polybond***

India Pvt. Ltd., (supra) was relied upon to support the contention that there was suppression by Plaintiff and that being so the Plaintiff would not be entitled to any relief. In that case, the stand taken by the Plaintiff before the Registrar of Trade Mark in response to the examination report was as regards the comparison of the marks as a whole and not in parts. The Plaintiff acquired registration of series of mark with the prefix 'poly' and sought to restrain the Defendant from using the word 'poly' as prefix to its mark. Before the Registrar of Trademark, the stand taken by the Plaintiff was that the marks were required to be compared as a whole which was in variance with the stand taken by the Plaintiff in the plaint. In the present case the marks are identical i.e. "TRACKON" and the reply to the examination report by the Plaintiff was in respect of mark "TRICON" and therefore there was no suppression.

48. The next decision in the case of **Phonepe Pvt Ltd vs. Resilient Innovations Pvt. Ltd (supra)** dealt with the prosecution history estoppel. The Plaintiff's mark was 'PhonePe' whereas the Defendant's mark was 'BharatPe'. The Court took into consideration the shifting stands adopted by the Plaintiff therein as the Plaintiff claimed exclusivity in 'Pe' and also claimed that the suffix 'Pe' had acquired distinctiveness and secondary meaning and in the suit the Plaintiff had taken a contrary stand. It is in that context that this Court denied the

interim injunction by applying the principle of prosecution history estoppel. As noted above, the mark cited as conflicting with that of the Plaintiff's mark was "TRICON" and the said decision is distinguishable on facts.

49. In the case of ***Unichem Laboratories Ltd vs. Ipca Laboratories (supra)*** the learned Single Judge of this Court also applied principle of prosecution history estoppel to deny the interim relief.

50. The decision in the case of ***Wander Ltd & Anr. vs. Antox India P. Ltd (supra)*** lays down the test which are required to be satisfied before grant of interim injunction. There is no quarrel with the said proposition.

51. The decision in the case of ***Nandhini Deluxe vs. Karnataka Cooperative Milk Producers Federation Limited (supra)*** arose out of rectification proceeding. In that case the Respondent adopted the mark Nandini for selling milk and milk product and got registration under Class 29 and 30 whereas the Appellant was in business of running restaurant and adopted the mark Nandhini for its restaurant. The Hon'ble Apex Court considered that the goods of the Appellant are different from that of the Respondent and that the word 'Nandhini' is generic term and not an invented or coined word. The Hon'ble Apex Court further found that the manner in which they are trading by the parties respectively, it was difficult to imagine that the average man of

ordinary intelligence would associate the goods of the Appellant as that of the Defendant. In the present case this Court has come to *prima facie* finding that the goods of the Plaintiff and the Defendant are traded through the same trade channel and that there is likelihood of association of the Defendant's goods with that of the Plaintiff.

52. In the case of ***AMPM Designs, vs. Intellectual Property Appellate Board (supra)***, the proceedings arose out of the rectification application. The learned Single Judge in that case considered the decision of the Hon'ble Apex Court in the case of ***Nandhini Deluxe vs. Karnataka Cooperative Milk Producers Federation Limited (supra)*** and held that there is no principle of law that once trade mark is registered in respect of goods/services falling in one class it would be impermissible to have the registration of trademark, where there is prior user of the trademark though the nature of goods and services is different. The learned Single Judge has upheld that the registration of similar trade mark in case of different goods or services where a prior user of the trade mark is shown. In the present case the admitted position is that the Defendant adopted its mark in the year 2020 by which time the Plaintiff had obtained registration of its mark and defence of prior user is not available.

53. In the case of ***Cadila Health Care Ltd vs. Cadila Pharmaceuticals Ltd (supra)*** the Hon'ble Apex Court has laid down the test to be

applied in an action for passing off for deciding the question of deceptive similarity. There is no quarrel with the said proposition.

54. In the case of *Star Bazaar Pvt. Ltd. vs. Trent Ltd (supra)* the Delhi High Court considered the case of the Appellant seeking injunction against use of the same trade marks “Star Bazaar” was of prior user. The Delhi High Court declined to grant injunction on the ground that both are *bonafide* concurrent users of the mark Star Bazaar. In that case the Delhi High Court was considering the requirement for grant of temporary injunction in case of passing off.

55. The principle of law which are laid down in the quoted decisions cannot be debated, however, in the case of an infringement of trade mark and passing off by applying well settled test, each case has to be decided on its own merits. Applying well settled test to the facts of the present case, in my view the Plaintiff has made out *prima facie* case for grant of injunction restraining the Defendant from use of the registered mark “TRACKON”. In so far as the passing off action is concerned the added material is sufficient to distinguish the goods of the Defendant from that of the Plaintiff and no case for passing off is made out.

56. In light of the above discussion, on the aspect of infringement, use of identical trade mark by the Defendant *prima facie* infringes the Plaintiff’s registered trade mark. In so far as the aspect of passing off is

concerned, the Plaintiff has failed to make out a *prima facie* case. It cannot be accepted *prima facie* that by use of the identical mark with a different trade dress, the Defendant is attempting to pass off its product as that of the Plaintiff. The Interim Application is hence allowed in terms of prayer clause (a)(i) which reads as under:

“a. That pending the hearing and final disposal of this Suit, this Hon’ble Court be pleased to issue a temporary order of injunction restraining the Defendant by itself and/or through its servants and/or agents or anyone claiming under it or in any manner whatsoever from, directly or indirectly:

(i) manufacturing, selling, advertising, distributing, marketing, exhibiting for sale, trading or otherwise dealing in the Infringing Product and/or the impugned goods and/or any goods that are similar or allied or complimentary to the goods covered by the Applicant’s registered trade marks “TRACKON” and/or “TRACKON GOLD” bearing registration Nos. 3718321 and 4966896 respectively by using and/or adopting the Impugned Mark “TRACKON” or any other mark deceptively similar to the Applicant’s aforesaid registered trademarks “TRACKON” and “TRACKON GOLD” so as to infringe the Applicant’s said registered trademarks; and”

[Sharmila U. Deshmukh, J.]