



2025:DHC:9630-DB



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* **IN THE HIGH COURT OF DELHI AT NEW DELHI***Reserved on: 30 October 2025**Pronounced on: 4 November 2025*+ **FAO (COMM) 22/2022, CM APPLs. 6363/2022 & 26546/2022****QUANTUM HI-TECH MERCHANDISING
PVT. LTD.**

.....Appellant

Through: Mr. Anirudh Bakhru, Mr. Vikas
Khera, Ms. Sneha Sethia and Mr. Yash
Sharma, Advs.

versus

**LG ELECTRONICS INDIA
PVT. LTD. & ORS.**

.....Respondents

Through: Mr. Hemant Singh, Ms. Mamta
Jha, Mr. Sambhav Jain, Mr. Sidhant Oberoi
and Ms. Sanya Srivastava, Advs.**CORAM:****HON'BLE MR. JUSTICE C. HARI SHANKAR****HON'BLE MR. JUSTICE OM PRAKASH SHUKLA****JUDGMENT**

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04.11.2025**C. HARI SHANKAR, J.**

1. The appellant Quantum Hi-Tech Merchandising Private Limited has instituted CS (Comm) 263/2021 before the learned District Judge (Commercial Court-II), Shahdara¹, alleging infringement, by the respondents LG Electronics India Private Limited, its parent company in Korea² and its Brand Store in Delhi, of the registered trademarks of the appellant, and passing off, by the respondents, of their goods as

¹ "the learned Commercial Court", hereinafter

² "LG Korea" hereinafter



the goods of the appellant. Predicated on these allegations, the appellant, in its suit, sought a decree of permanent injunction, restraining the respondents, and all others acting on their behalf, from using the marks QUANTUM, QUANTUM PLUS, QUANTUM DISPLAY, IPS QUANTUM, RGB QUANTUM, SMART QUANTUM and G QUANTUM, for the goods in respect of which the respondents used the said marks. The prayer is predicated on the ground that the respondents' marks are deceptively similar to the appellant's "famous and registered trademarks QUANTUM and .

2. The suit is presently pending before the learned Commercial Court.

3. In the suit, the appellant has filed an application under Order XXXIX Rules 1 and 2 of the Code of Civil Procedure, 1908³, seeking an interim injunction restraining the respondents from using the marks QUANTUM, QUANTUM PLUS, QUANTUM DISPLAY, IPS QUANTUM, RGB QUANTUM and SMART QUANTUM, G QUANTUM or any other mark which would be deceptively similar to the appellant's marks QUANTUM and , in relation to the goods in respect of which the respondents used the said marks.

4. By an *ad interim* order dated 4 October 2021, passed in the application filed by the appellant under Order XXXIX Rules 1 and 2, the learned Commercial Court restrained the respondents from using



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the aforementioned marks. The respondents filed an application under Order XXXIX Rule 4 of the CPC, for vacating the interim order.

5. By the impugned order dated 15 December 2021, the learned Commercial Court dismissed the appellant's application under Order XXXIX Rules 1 and 2 and allowed the respondents' application under Order XXXIX Rule 4 of the CPC.

6. Aggrieved thereby, the appellant is before this Court by means of the present appeal.

7. We have heard Mr. Anirudh Bakhru, learned Counsel for the appellant, instructed by Mr Vikas Khera, and Mr. Hemant Singh, learned Counsel for the respondents, at length.

8. Written submissions have also been filed by both sides.

Facts

9. Mr. Khera clarifies, before us, that his client is restricting its prayer to a restraint against the respondents using the mark QUANTUM and QUANTUM DISPLAY, and was not seeking any injunction against using their registered trade marks QUANTUM PLUS, IPS QUANTUM, RGB QUANTUM, SMART QUANTUM and G QUANTUM.

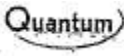
10. Case of the appellant before the learned Commercial Court



10.1 The case setup by the appellant, in its plaint before the learned Commercial Court, was as follows.

10.2 The appellant, which was incorporated on 1 August 1997, adopted the trademark QUANTUM in 1992 through its predecessor Quantum Hi-Tech Merchandising⁴, and was using the mark QUANTUM with the consent of QHM. QHM transferred the marks “QUANTUM” and “Quantum” to the appellant in April 2006. The marks “QUANTUM” and “Quantum” were registered in favour of the appellant in Class 9 under Section 23 of the Trade Marks Act, 1999⁵.

10.3 The respondents were manufacturing TV sets and their accessories, headphones, earphones, portable communication apparatus and other similar goods under the trademark QUANTUM and had also applied for registration of various marks containing the mark QUANTUM. The respondents were the proprietors of the registered trademarks SMART QUANTUM for display panels for TVs etc., RGB QUANTUM for mobile phones, IPS QUANTUM for wearable portable media players and G QUANTUM for televisions and similar goods.

10.4 The marks QUANTUM and QUANTUM DISPLAY were alleged to be infringing the registered trademarks QUANTUM and  of the appellant.

11. The impugned order

⁴ “QHM”, hereinafter
⁵ “the Act” hereinafter



11.1 The learned Commercial Court has, by the impugned judgment, rejected the appellant's application under Order XXXIX Rules 1 and 2 of the CPC. The learned Commercial Court has proceeded essentially on three considerations, in so holding, which may be enumerated thus:

(i) No case of infringement was maintainable against the respondents' registered trademarks SMART QUANTUM, RGB QUANTUM, IPS QUANTUM and G QUANTUM, in view of Section 28(3)⁶ read with Section 30(2)(e)⁷ of the Act. We need not comment on this aspect as the appellant does not seek any injunction against use, by the respondents, of the marks SMART QUANTUM, RGB QUANTUM, IPS QUANTUM and G QUANTUM.

(ii) The appellant had no registration of the mark QUANTUM for the goods in respect of which the mark was used by the respondents, i.e., TV receiver sets or any goods which were allied or cognate thereto.

(iii) As such, the case of the appellant, against the respondents, could only be one of passing off.

(iv) No case of passing off could sustain on merits, as the

⁶ (3) Where two or more persons are registered proprietors of trade marks, which are identical with or nearly resemble each other, the exclusive right to the use of any of those trade marks shall not (except so far as their respective rights are subject to any conditions or limitations entered on the register) be deemed to have been acquired by any one of those persons as against any other of those persons merely by registration of the trade marks but each of those persons has otherwise the same rights as against other persons (not being registered users using by way of permitted use) as he would have if he were the sole registered proprietor.

⁷ (2) A registered trade mark is not infringed where—

(e) the use of a registered trade mark, being one of two or more trade marks registered under this Act which are identical or nearly resemble each other, in exercise of the right to the use of that trade mark given by registration under this Act.



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respondents were not using the marks QUANTUM or QUANTUM DISPLAY for the goods in respect of which the appellant's marks were registered and used. As the goods in respect of which the rival marks were used were different, there was no likelihood of confusion.

(v) Moreover, the appellant was using the composite mark

 . The only material produced by the appellant to sustain its allegation of passing off was a coloured representation of the mobile display of the respondents, which itself was extracted from the affidavit filed by the Vice President of LG Korea, filed in evidence in support of an application under Section 21(4) of the Act, following an opposition to the application filed by QHMPL. The affidavit itself clearly stated that the picture was in the nature of promotional material. Apart from this, the appellant had not filed any material to show user of the allegedly infringing marks by the respondents for commercial purposes.

(vi) The appellant sought to contend, before the learned Commercial Court that, in the aforesaid affidavit, the Vice President of LG Korea had admitted that the marks QUANTUM and QUANTUM DISPLAY were adopted as trademarks by the respondents in 2014 and had been in use since 2015 for television receivers and displays for mobile phones. It was submitted, therefore, that the respondents were estopped from pleading non-user of the infringing marks. The



learned Commercial Court did not accept this submission, in view of the following assertion in para 26 of the plaint:

“.....The defendant no.2 filed the evidences by way of affidavits under Rule 46 in oppositions filed against the trademarks QUANTUM and QUANTUM display bearing application nos. 2918701 and 2918702 on 13.05.2021 wherein it claimed its user under the impugned marks but failed to file any cogent documents to prove the same.”

Thus, as the appellant had itself stated that the respondents had failed to file any documents to prove user of the infringing marks in respect of television receiver displays or mobile phones display, the mere statement of the Vice President of LG Korea, as contained in the affidavit filed before the Trade Marks Registry, could not constitute a cause of action to sustain a passing off suit.

(vii) There was no material to indicate any sale of goods, in the market, by the respondents, using the allegedly infringing marks. In the absence of any evidence of sale, no case of passing off could be said to be made out.

(viii) The appellant was also guilty of concealment of facts. The appellant's Application No. 1291193 had been opposed by Quantum Corporation, USA⁸. In the affidavit filed by way of response to the said opposition, it was submitted by the appellant, thus, in paragraph 16(1):

“16 (1)..... it is submitted that opponents have permitted



a good number of companies worldwide to use the trademark QUANTUM or trademark consisting of word Quantum, for different goods rendering the trademark QUANTUM not at all distinctive of goods and services of the opponents. The agreement at Annexure-8 and Annexure-9 indicate that more than a dozen of companies in USA and other countries which have been allowed by opponents to use the trademark QUANTUM and the trademark consisting of word Quantum in respect of various goods of same description as that of goods and services for which opponents have claimed to have use the trademark QUANTUM. In view of these facts on record, placed by the opponents themselves.....there are many others to who have a lawful right to use the trademark QUANTUM and the trademark consisting of the word Quantum.”

Having adopted such a stand in its affidavit filed by way of reply to the opposition by Quantum USA to its application for registration of its mark, the appellant could not seek to claim exclusivity over the mark QUANTUM. These facts had been concealed by the appellant in its plaint.

(ix) In the same affidavit, the appellant had contended that the mark of which it sought registration was the composite mark “Quantum Hi-Tech QHMPL Group”, which was different, when seen as a whole, from Quantum USA’s marks. There was, therefore, no likelihood of confusion between the two. This stand would also operate with respect to the possibility of likelihood of confusion between the appellant’s and the respondents’ marks.

(x) The appellant was, therefore, not entitled to interim relief even on the ground of concealment of facts. For this purpose, the learned Commercial Court has placed reliance on the



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judgments of the Supreme Court in **S.P. Chengalvaraya Naidu v Jagannath**⁹ and **Kishore Samrite v State of UP**¹⁰.

For all these reasons, the impugned order of the learned Commercial Court has dismissed the appellant's application under Order XXXIX Rules 1 and 2 of the CPC and has allowed the respondents' application under Order XXXIX Rule 4.

Rival Contentions

12. Submissions of Mr. Bakhru

12.1 Arguing for the appellant, Mr. Bakhru, instructed by Mr. Khera, advances the following submissions:

(i) The benefit of Section 28(3) read with Section 30(2)(e) of the Act would be available to the respondents only in respect of the registered trademarks SMART QUANTUM, RGB QUANTUM, IPS QUANTUM and G QUANTUM, in respect of the goods or services for which they were registered. The appellant would still be able to maintain an infringement suit against the respondents to restrain them from using QUANTUM as a standalone mark, or any mark of which QUANTUM forms the dominant feature, in view of the registration held by the appellant in the word mark QUANTUM, with effect from 21 June 2004, and in the device

⁹ (1994) 1 SCC 1
¹⁰ (2013) 2 SCC 398



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mark  .

(ii) The learned Commercial Court erred in holding that there was no evidence of user, by the respondents, of the marks QUANTUM or QUANTUM DISPLAY. Our attention was invited, in this context, to para 4 of the affidavit filed by the LG Korea as evidence in support of Application No. 2918701, for registration of the word mark QUANTUM in Class 9:

“4. The words "QUANTUM/QUANTUM DISPLAY" were honestly conceived and fancifully adopted as a trademark by my company in 2014 and *have been put to use since 2015*, in respect of display for television receivers and display for mobile phones. The word "QUANTUM" in Latin means "amount" and is defined in the English dictionary simply as "quantity or amount". The marks QUANTUM/QUANTUM DISPLAY therefore, have no direct reference to or obvious association with the nature and quality of the goods on which they have been applied by my company. Consequently, QUANTUM / QUANTUM DISPLAY as applied to our claimed goods, are inherently distinctive marks and are capable of functioning as a source indicator and of distinguishing our goods from those of others and deserving of the highest level of protection.

My company's goods under the marks QUANTUM/QUANTUM DISPLAY are being sold in several countries worldwide namely United States of America, Canada, Mexico, Germany, United Kingdom, France, Italy, Russia, Turkey, China, Japan, Korea, India, Australia, Indonesia, Thailand, Philippines, Malaysia, Vietnam, Brazil, Argentina, Columbia, Saudi Arabia, United Arab Emirates, Egypt, Nigeria and South Africa. In India, my company's marks QUANTUM/QUANTUM DISPLAY *have been used and promoted at least since April 2015* and have thereby acquired secondary distinctiveness, and come to be associated with our goods in the eyes of Indian consumers and the general public. Annexed hereto and marked as **Exhibit-B series** are documents in support of use of my company's marks QUANTUM/QUANTUM DISPLAY in various countries including India.”

Signature Not Verified

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KUMAR
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(Emphasis supplied)

In view of the assertions contained in para 4 of the above affidavit, the learned Commercial Court could not have held that the appellant was remiss in establishing the factum of the user by the respondents, of the infringing marks.

(iii) Para 16 of the affidavit filed by the appellant in response to the opposition by Quantum USA to the appellant's trademark Application No. 1291193, which was alleged to have been suppressed by the appellant, did not, in any manner, adversely impact the appellant's case. In the said paragraph, the appellant had stated that the mark QUANTUM was not distinctive of the goods and services of *Quantum USA*. That assertion, therefore, has no bearing on the distinctiveness of the mark QUANTUM, in so far as the appellant's goods are concerned.

(iv) In any event, the said affidavit having been filed in an opposition by Quantum USA against the appellant's Application No. 1291193, no statement made by the appellant in the said proceedings, could be treated as relevant for the present purposes, in view of the law laid down by the Division Bench of this Court in **Raman Kwatra v KEI Industries Ltd**¹¹.

12.2 In support of his submissions, Mr. Bakhru places reliance on the judgments of the Division Bench of this Court in **Newgen IT**



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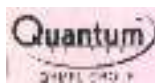


Technologies Ltd v Newgen Software Technologies Ltd¹². as well as various interim orders rendered by learned Single Judges of this Court.

13. Submissions of Mr. Hemant Singh

13.1 In response to the submissions advanced by Mr. Bakhru, Mr. Hemant Singh, appearing for the respondents, advances the following contentions:

(i) The appellant has no valid word mark registration for the mark QUANTUM. Certificate No. 2191381, dated 3 June 2019, whereby the word mark QUANTUM was registered in favour of the appellant, was not a valid registration. Application No. 1291193, submitted by the appellant, which culminated in the said registration, was an application for the device mark



. Any right under Section 28(1)¹³ of the Act, for relief against infringement, was predicated on the premise that the appellant's trade mark is valid. Inasmuch as the appellant had never applied for registration of the word mark QUANTUM and had obtained a word mark registration for QUANTUM against an application for registration of the device mark , the registration was *ex facie* invalid.

¹² 2025 SCC Online Del 4462

¹³ 28. **Rights conferred by registration.** –

(1) Subject to the other provisions of this Act, the registration of a trade mark shall, if valid, give to the registered proprietor of the trade mark the exclusive right to the use of the trade mark in relation to the goods or services in respect of which the trade mark is registered and to obtain relief in respect of infringement of the trade mark in the manner provided by this Act.



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(ii) The appellant had concealed, both before the learned Commercial Court as well as in the present appeal, the fact that it had actually applied for registration of the device mark  and that the said application had culminated in registration of the word mark QUANTUM in the appellant's favour. It was for this reason that a predecessor Division Bench of this Court had, on 17 December 2024, while directing the parties to attempt an amicable resolution of the dispute, further directed thus:

“However in case the matter cannot be resolved amicably between the parties, the appellant will, before the next date, place on record a copy of Form TM-16 along with a supporting affidavit and other relevant documents leading to the issuance of Registration Certificate bearing Registration No. 1291193.”

This direction was issued in view of the fact that the respondents pointed out to the Court that the appellant had never applied for registration of the word mark QUANTUM and that the registration was, therefore, *ex facie* invalid. Mr. Singh submits that the appellant, in response, submitted that there may have been an amendment of the application submitted by the appellant whereby registration of the word mark QUANTUM was sought. Any such amendment would have to be by way of an application in Form TM 16. It was for this reason that the predecessor Division Bench called upon the appellant to produce the TM 16 form filed by it. No such form has been placed on record by the appellant. As such, it is clear that the registration of the word mark QUANTUM in the appellant's favour is an invalid



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registration. No claim of infringement can be predicated on such an invalid registration.

(iii) The reliance, by Mr. Bakhru, on para 4 of the affidavit in evidence filed by the Vice President of LG Korea in response to the opposition by QHMPL to LG Korea's Application No. 2918701, for registration of the word mark QUANTUM in Class 9, was misdirected. The said statement cannot be regarded as determinative of the factum of user by the respondents, of the marks QUANTUM or QUANTUM DISPLAY, in the course of trade. User in the course of trade, by the defendant, is a *sine qua non* for infringement under Section 29 of the Act, each of sub-sections (1) to (4) of which start with the words "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* ...". There is, in fact, no evidence of any such user by the respondents, of the marks QUANTUM or QUANTUM DISPLAY, in the course of trade. In fact, in para 24 of the plaint, filed by the appellant before the learned Commercial Court, it was the appellant's own contention that the respondents had failed to provide any cogent evidence of user by them of the marks QUANTUM or QUANTUM DISPLAY in the course of trade. To support these submissions, Mr. Singh places reliance on the judgment of the Supreme Court in **K. Narayanan v S. Murali**¹⁴ and of this Bench in **Deepak Kumar Khemba v Yogesh Kumar Jaiswal**¹⁵.

¹⁴ (2008) 10 SCC 479

¹⁵ 2025 SCC OnLine SC 5095



(iv) The learned Commercial Court has also correctly observed that the appellant was guilty of contumacious concealment of facts and was, therefore, disentitled from any equitable interim relief even on this score. In support of this submission, Mr. Singh draws our attention to the affidavit filed by the appellant to answer the opposition by Quantum USA against the appellant's Application No. 1291193. He particularly draws attention to paras 8, 12 and 16(1) of the said affidavit, which read as under:

“8. That by virtue of the extensive and continuous use of the composite trade mark QUANTUM - HI-TECH - QHMPL GROUP represented in the unique artistic manner, the said trademark has acquired a strong reputation amongst the consumers to the extent that the consumers identify only the goods of the applicant under the said trade mark.

12. That the applicant's trade mark namely QUANTUM-HI-TECH-QHMPL GROUP being the composite trade mark represented in very special and particular manner is different pole apart from the opponent's trade mark QUANTUM, hence, there is no question of any likelihood of confusion or deception in the minds of the consumers. The registration of the mark applied for is therefore not at all hit by the provisions of Section 11 of the Trade Marks Act, 1999.

16(1). In reply to the contents of Para 13, it is submitted that the opponents have permitted a good number of companies world wide to use the trade mark QUANTUM or the trade mark consisting of the word QUANTUM, for different goods rendering the trade mark QUANTUM not at all distinctive of the goods and services of the opponents. The agreements at Annexure- 8 and Annexure -9 indicate more than a dozen companies in U.S.A. and other countries which had been allowed by the opponents to use the trade



mark QUANTUM and the trade mark consisting of the word QUANTUM in respect various goods of the same description as that of goods and services for which the opponents have claimed to have used the trade mark QUANTUM. In view of these facts on record, placed by the opponents themselves, the opponents do not have the exclusive right to use the said trade mark QUANTUM but there are many others too who have the lawful right to use the trademark QUANTUM and the trademark consisting of the word QUANTUM. Under these circumstances the opponent have no claim to be the sole proprietor of the trade mark QUANTUM.”

(v) In Mr. Singh’s submission, the admissions contained in para 16(l) of the aforesaid affidavit were by themselves sufficient to completely non-suit the appellant. In the said paragraph, the appellant clearly stated that there could be no exclusive right to the mark QUANTUM *per se*. Having obtained registration of the word mark QUANTUM by so asserting in its response to the opposition of Quantum USA, the appellant could not thereafter seek to monopolise the word mark QUANTUM by claiming exclusivity in respect thereof.

(vi) Mr. Singh, thereafter, draws attention to the following assertions in paras 23, 24, 26, 32, 34 and 35 of the plaint:

“23 That the defendant no. 1, defendant no. 2, and defendant no. 3 are engaged in the identical trade and business as that of the plaintiff namely manufacturing and marketing and sale of Headphones; Earphones; Bluetooth headphones; Smart phones; Portable communications apparatus namely handsets, walkie-talkies, satellite telephones and personal digital assistants [PDA]; Audio components; Apparatus for recording, transmission or reproduction of sound or images; Computer application software for mobile phones; Television receivers; Wireless audio/video receivers for smart phones; wearable mobile



phones; wearable smart phones; Wearable computers; Wearable electric audio and visual apparatus and instruments; Display for mobile phones; Display for televisions; Wearable portable media players; Mobile phone cases; Mobile phone stands; Phone cases etc. {hereinafter referred to as "the impugned goods and 'business'"). The Plaintiff is not aware of the constitution of the defendants and they are called upon to disclose the same upon causing appearance before this Hon'ble Court. The defendants are related to each other and are acting in unison. (Defendant Nos. 1, 2 and 3 hereinafter collectively referred to as the Defendants).

24 That the Defendants have adopted and have started using the impugned mark QUANTUM (hereinafter referred to as 'the impugned marks') in relation to its impugned goods and business. The term impugned Trade Mark includes, all its essential features. The malafide intention of the defendants is apparent from the facts that the defendants have adopted the impugned mark for identical and related goods.

26The defendant no. 2 filed the evidences by way of affidavits under Rule 46 in oppositions filed against the trademarks QUANTUM and QUANTUM DISPLAY bearing application nos. 2918701 and 2918702 on 13/05/2021 wherein it claimed its user under the impugned marks but failed to file any cogent documents to prove the same.

32 That the defendants have started using the impugned Marks dishonestly, fraudulently and out of positive greed with a view to take undue advantage and to trade upon the established colossal goodwill, reputation and proprietary rights of the Plaintiff in the Plaintiff's said Trade Mark. By the defendants' impugned use, deception and confusion in the market is ensuing and is inevitable to so ensue. The Plaintiff's said Trade Mark, is otherwise being diluted and eclipsed thereby. Any person not knowing clearly the relationship between the parties to this action is bound to be confused by the defendants' impugned use and might well do business with the defendants thinking that the same is dealing with the Plaintiff or that some strong, vital and subtle links exist between the Plaintiff and the Defendants.



34 That due to the defendants' impugned activities, the plaintiff is suffering huge losses both in business and in reputation and such losses are incapable of being assessed in monetary terms. Unwary purchasers and traders are being deceived as to the origin of goods or business. Defendants' gains are Plaintiff's losses. The Plaintiff has no access to the defendants' accounts and the defendants are liable to render their accounts to the plaintiff and to make good to the plaintiff, "the profits and business earned by them. In the alternative and without prejudice to the same, the plaintiff submits that in view of its aforesaid standing in business, goodwill, impeccable reputation and proprietary rights in its said trade' mark/trade name which have all been, adversely effected due to the defendants' impugned activities, the defendant is liable to pay damages to the plaintiff.

35 That the cause of action for filing the present suit has been detailed in the preceding, paragraphs. The cause of action for filing the present suit first time arose in or about last week of August, 2020, when the Plaintiff came to know through their advocate about the registration of trademarks IPS QUANTUM, RGB QUANTUM and SMART QUANTUM bearing registration nos. 2965636, 3070815 and 3072531 in Class 09 in favour of Defendant No. 2. The cause of action further arose on 27/08/2020 when the plaintiff filed rectification petitions against the impugned trademarks of Defendant No.2, The cause of action further arose on 23/09/2020 when the Plaintiff filed notice of oppositions against the defendant no. 2's advertised marks QUANTUM and QUANTUM DISPLAY bearing application nos. 2918701 and 2918702. in Class 09- The cause of action further arose on 27/02/201 when the Plaintiff filed opposition against the defendant no.2's advertised mark QUANTUM PLUS bearing application no. 3031656 in Class 09. The cause of action further arose on 13/05/2021 when the Plaintiff received the evidence by way of affidavits filed in. oppositions against the "marks QUANTUM and' QUANTUM DISPLAY bearing application nos. 2918701 and 2918702 in Class 09 wherein the defendants have claimed use of the impugned mark. The cause of action further arose on 20/05/2021 when the Plaintiff came, to know about the registration of impugned mark G QUANTUM bearing registration no. 3031655 in Class 09. The cause of action further arose when the plaintiff filed rectification petition on 28/05/2021. It is



submitted that the defendants are selling the impugned goods bearing the impugned mark *inter alia* within the jurisdiction of this Hon'ble Court on daily basis and thereby continuously violating the said trade mark of the, Plaintiff. Therefore, the cause of action for filing the present suit is accruing on daily basis and is subsisting till the defendants are restrained from carrying out the impugned activities under the impugned trademark/labels.”

Mr. Singh submits, with considerable consternation, that the assertions in para 36 of the plaint that the defendants were selling goods bearing the mark QUANTUM and QUANTUM DISPLAY, on a daily basis, *inter alia*, through dealers and distributors in Shahdara, constitute a tissue of lies. There has, in fact, been no sale by the respondents of any goods bearing the mark QUANTUM or QUANTUM DISPLAY after 2017 in India. Such false assertions, as contained in the plaint, were by themselves sufficient to disentitle the appellant from any relief, and the learned Commercial Court has in this context correctly placed reliance on the judgments in **S.P. Chengalvaraya Naidu v Jagannath** and **Kishore Samrite v State of UP**.

(vii) As the appellant had no valid word mark registration for the mark QUANTUM, the case at best could be one of passing off. Without any evidence of sale of goods by the respondents bearing the respondents' marks in the market, the learned Commercial Court was correct in holding that no case of passing off could be made out.

13.2 For all these reasons, Mr. Singh submits that the present appeal is completely devoid of merits and deserves to be dismissed.



14. Submissions of Mr. Bakhru in rejoinder

14.1 In rejoinder, Mr. Bakhru is unable to satisfactorily dislodge Mr. Singh's contention that the appellant has no valid word mark registration for QUANTUM and that Certificate No. 2191381, whereby the word mark QUANTUM was registered in favour of the appellant was in fact invalid, as Application No. 1291193, which culminated in the issuance of the said certificate, was for the device



mark and not for the word mark QUANTUM. Mr. Bakhru's only contention in this regard is that no such plea was advanced by the respondent in its written submissions before the learned Commercial Court and cannot, therefore, be permitted to be raised for the first time before this Court. The sustainability or otherwise of the impugned order of the learned Commercial Court has, he submits, to be assessed on the basis of the pleadings and material which were before the learned Commercial Court.

14.2 Even so, submits Mr. Bakhru, the appellant does have a



registration for the device mark . The word QUANTUM constitutes the dominant feature of the said device mark and, applying the principles laid down by the Supreme Court in its decision in **K. R. Chinna Krishna Chettiar v Shri Ambal & Co.**¹⁶, the aspect of infringement or passing off has to be examined with respect to QUANTUM as the dominant part of the plaintiff's registered device



mark.

14.3 Mr. Bakhru further submits that, on the aspect of infringement, the learned Commercial Court has rejected the appellant's prayer solely on the ground that 'QUANTUM' constitutes the dominant part of the respondents' registered trademarks. Such a theory, submits Mr. Bakhru, is unknown to law. The appellant cannot be non-suited from seeking injunction against infringement by the respondents of the mark , merely because it may constitute a part, even if a dominant part, of the respondents' registered trademarks. The protection under Section 28(3) and 30(2)(e) of the Act would be available only for the registered trademarks of the respondents and not for any part of such registered trademarks.

Analysis

15. The impugned judgment

15.1 The learned Commercial Court has dismissed the appellant's interim application on merits as well as on the ground of concealment of facts.

15.2 On the aspect of concealment of facts, the learned Commercial Court finds fault with the appellant in concealing the affidavit filed by the appellant in its response to the opposition by Quantum USA to the appellant's application No. 1291193, which ultimately culminated in the grant of registration, to the appellant, of the word mark



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QUANTUM. The learned Commercial Court has held that, in view of the stand adopted by the appellant in para 16(l) of the said affidavit [reproduced in para 11.1 (viii) *supra*], the appellant could not claim exclusivity over the mark QUANTUM. In the same affidavit, the appellant had also contested Quantum USA's opposition on the ground that it was seeking registration of the composite mark "Quantum Hi-Tech QHMPL Group" which was distinct and different from the marks of the Quantum USA. The learned Commercial Court has regarded these two assertions of the appellant, in its affidavit in the proceedings relating to Application No. 1291193, as defeating the appellant's case. Ergo, holds the learned Commercial Court, concealment of the said affidavit was a material concealment, which disentitled the appellant to equitable relief under Order XXXIX Rules 1 and 2 of the CPC.

15.3 On merits, the learned Commercial holds, primarily, as under:

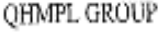
- (i) No proceeding for infringement could lie against the respondents, as the appellant had no registration of the mark QUANTUM in respect of TV receiver sets or any goods which were allied or cognate thereto, in respect of which goods the respondents was using its marks.
- (ii) No case of passing off could lie, either, as there was no evidence of user, by the respondents of the mark QUANTUM and QUANTUM DISPLAY.



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Quantum

(iii) The appellant was using the logo  . As against this, the appellant could not produce any evidence of user, by the respondents, of the allegedly infringing marks.

(iv) The reliance, by the appellant, on the statement of the Vice President of LG Korea, in the affidavit filed by him in evidence in support of the application under Section 21(4) of the Act, on which the appellant sought to rely, itself belied the appellant's contention that the respondents were using the marks QUANTUM and QUANTUM DISPLAY. Thus, in fact, the appellant had no sustainable cause of action against the respondents even for a claim of passing off.

16. Issues arising for consideration

The following issues arise for consideration:

- (i) Was the appellant guilty of concealment of facts?
- (ii) Does the case of infringement, levelled against the respondents, have merit?
- (iii) Can a case of passing off sustain against the respondents, in the facts of the case?
- (iv) Does the impugned judgment of the learned Commercial Court, in the light of the above, call for interference?



17. Our view

17.1 On these aspects, our view is as under:

(i) The appellant is guilty of concealment of material facts. As the concealment is serious and material, the appellant would, even on this sole ground, stands disentitled to interim relief.

(ii) On merits, the appellant has a sustainable case of infringement against the respondents. The finding of the learned Commercial Court, to the effect that the case is only one of passing off, and that no case of infringement could lie, is not correct in law.

(iii) The learned Commercial Court is correct in its finding that no case of passing off could be made out, in the facts of the case, against the respondents.

(iv) Inasmuch as we are in agreement with the respondents finding that the appellant is guilty of contumacious and wilful concealment of facts, given the fact that we are dealing with an appeal against a decision under Order XXXIX Rules 1 and 2 of the CPC, we are not inclined to interfere with the impugned order.

17.2 Though, therefore, we are of the view that the present appeal has to fail even on the basis of our finding in respect of Issue (i), we



would, nonetheless, borrowing a leaf from Order XIV Rule 2(1)¹⁷ of the CPC, read with the judgment of the Supreme Court in **Sathyanath v. Sarojamani**¹⁸, be expressing our opinion on all the issues.

18. Our reasons

18.1 On the aspect of concealment of facts

18.2 The learned Commercial Court has held the appellant guilty of concealment of facts on the ground that it suppressed the affidavit filed by the appellant, in response to the opposition by Quantum USA to the appellant's Application No. 1291193. The learned Commercial Court has proceeded on the premise that the averments contained in para 16(l) and para 12 of the said affidavit would defeat or, in any event, be seriously prejudicial to, the appellant's case. The failure on the part of the appellant, to advert to the said affidavit or place it on record has, therefore, been treated by the learned Commercial Court as deliberate. The appellant is, therefore, found to be disentitled to interim relief.

18.3 The finding of suppression and concealment of facts as, returned by the learned Commercial Court is, according to us, sustainable, though we are not in entire agreement with the reasoning of the learned Commercial Court on this aspect. The learned Commercial Court has found the suppression of the said affidavit to

¹⁷ 2. **Court to pronounce judgment on all issues. –**

(1) Notwithstanding that a case may be disposed of on a preliminary issue, the Court shall, subject to the provisions of sub-rule (2), pronounce judgment on all issues.

¹⁸ (2022) 7 SCC 644



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be contumacious *both* because of the contents of para 16(l) of the affidavit as well as of para 12 in the said affidavit. We are of the view that, while the averments contained in para 16(l) of the affidavit may not be inimical to the appellant's case, the contents of para 12 of the same affidavit were seriously detrimental to it.

18.4 We agree with Mr. Bakhru in his contention that the averments in para 16(l) of the appellant's affidavit by way of response to the opposition of Quantum USA are with respect to the entitlement of Quantum USA to claim exclusivity over the mark QUANTUM. The reference to "opponents" in the said paragraph is obviously with reference to Quantum USA. What the appellant has stated in the said paragraph is, therefore, that, as Quantum USA had permitted several entities to use the trademark QUANTUM, it was not open to Quantum USA to contend that the mark QUANTUM was distinctive of its goods or services. Thus, in para 16(l), the contest by the appellant was to the entitlement of Quantum USA to claim exclusivity over the mark QUANTUM, so as to oppose the appellant's application.

18.5 We, therefore, are of the view that the contents of para 16(l) of the affidavit filed by the appellant, in response to the opposition of Quantum USA, do not seriously impact the appellant's case.

18.6 However, in para 12 of the same affidavit, the appellant has also contested the assertion of Quantum USA that the mark of which the appellant was seeking registration was similar to the marks of Quantum USA. The ground on which the appellant had so contested Quantum USA's assertion is that the appellant's application was for

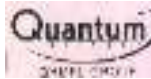


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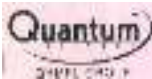
the composite mark . The appellant contended that the said composite mark was in no way similar to the marks used by Quantum USA and that, therefore, the registration of the  mark in the appellant's favour would not result in any likelihood of confusion.

18.7 By suppressing the above affidavit, the appellant has concealed its own admission, in para 12 of the said affidavit, that Application No.

1291193, submitted by it, was for the composite mark , and not for the QUANTUM word mark. This concealment was serious, as disclosure of the affidavit would have clearly indicated that the registration of the word mark QUANTUM, in favour of the appellant, was an invalid registration.

18.8 On this aspect, however, the appellant was guilty of even more serious concealment. The appellant was well aware of the fact that it had never applied for registration of the word mark QUANTUM. Its

application was for the device mark . For reasons which we are unaware of, but which appear, at the least, to be recondite, the Trade Marks Registry granted, to the appellant, a word mark registration for the mark QUANTUM against an application for the

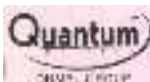
device mark . This registration is obviously invalid. The appellant successfully concealed this fact from the learned Commercial Court by not placing, on record, Application No. 1291193 or disclosing, in its plaint, the fact that the registration of the



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word mark QUANTUM in its favour was against an application which, in fact, sought registration of the device mark .

18.9 The seriousness of the matter is compounded by the failure, of the appellant, to disclose this fact even in the present appeal. The appellant's Application No. 1291193 was, in fact, placed on record by the respondents under cover of a separate index. The paragraph from the order dated 17 December 2024, by the predecessor Division Bench, reproduced in para 13.1(ii) *supra* makes it apparent that the predecessor Division Bench was made aware of the discrepancy between the mark for which the appellant had sought registration in Application No. 1291193 and the word mark QUANTUM which ultimately got registered in its favour against the said application. When this fact was brought to the notice of the predecessor Division Bench, advanced the contention that the application may have been amended. It was for this reason that the predecessor Division Bench directed the appellant to place, on record, Form TM 16, which was required to be filed in case of amendment of an application under Form TM 1. No such Form TM 16 has been filed by the appellant, thereby indicating that the initial application of the appellant, which was for registration of the  device mark, was in fact never amended, and proceeded, for unknown reasons, to grant, to the appellant, of registration for the word mark QUANTUM. Had the appellant been *bona fide*, it ought, even at that stage, to have apprised the Trade Marks Registry that it had been granted registration for the word mark QUANTUM for which it had never applied. Instead, the



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appellant deemed it appropriate, apparently, to keep quiet and take unfair advantage of the invalid registration of the word mark QUANTUM in its favour.

18.10 To our mind, this is an extremely serious act of deliberate and wilful concealment of facts. Any presumption that the omission may be inadvertent is belied by the further omission, on the part of the appellant, to place on record the affidavit filed by the appellant in response to the opposition of Quantum USA, in para 12 of which the appellant had admitted the fact that its Application No. 1291193 was



for the device mark . The two documents which could have enlightened the Court that the registration of the word mark QUANTUM, in favour of the appellant, was invalid were, therefore, studiously concealed both from the learned Commercial Court as well as from this Court.

18.11 No injunctive relief, under Order XXXIX Rules 1 and 2, is available to a party which approaches the Court with unclean hands. Equity inheres in Order XXXIX Rules 1 and 2. In **Seema Arshad Zaheer v Municipal Corporation of Greater Mumbai**¹⁹, it was held:

“30. The discretion of the court is exercised to grant a temporary injunction only when the following requirements are made out by the plaintiff : (i) existence of a prima facie case as pleaded, necessitating protection of the plaintiff's rights by issue of a temporary injunction; (ii) when the need for protection of the plaintiff's rights is compared with or weighed against the need for protection of the defendant's rights or likely infringement of the



defendant's rights, the balance of convenience tilting in favour of the plaintiff; and (iii) clear possibility of irreparable injury being caused to the plaintiff if the temporary injunction is not granted. *In addition, temporary injunction being an equitable relief, the discretion to grant such relief will be exercised only when the plaintiff's conduct is free from blame and he approaches the court with clean hands.*"

(Emphasis supplied)

To the same effect is the judgment of the Division Bench of this Court in **S.K. Sachdeva v Shri Educare Ltd**²⁰.

18.12 Though Mr. Bakhru sought to contend that the reliance placed by Mr. Hemant Singh on Application No. 1291193, and its contents, travelled beyond the pleadings contained in the respondents' written statements before the learned Commercial Court, we are, in the facts of the present case, least inclined to countenance such a submission. Having deliberately omitted to draw the attention of the Court to the invalidity of the registration of the word mark QUANTUM, obtained by it, the appellant cannot be heard to say, in proceedings under Order XXXIX Rules 1 and 2 CPC, that the respondents could not bring these facts to the notice of the Court. Ample time has passed since the placing, by the respondents, on record in the present appeal, of the appellant's Form TM 1 pertaining to Application No. 1291193. The appellant has not chosen to place any clarificatory affidavit on record and is unable, as we have already noted, to dislodge Mr. Hemant Singh's allegation even during oral arguments. Nor has the appellant placed on record any Form TM 16 filed by it, to amend its original Application No. 1291193, despite directions to that effect issued by the predecessor Division Bench.



18.13 The proverbial cat is, therefore, so to say, out of the bag.

18.14 We, therefore, reiterate our entire agreement with the learned Commercial Court that the appellant was guilty of deliberate and wilful concealment of facts and a transparent attempt to mislead the learned Commercial Court as well as this Court.

19. Re. the aspect of infringement

19.1 Clearly, in the absence of any valid registration for the word mark QUANTUM, the appellant could not have maintained an infringement action against the respondent on the basis of the said mark. The presumption under Section 31(1)²¹ of the Act can also not, in our opinion, come to the aid of the appellant. The expression “trade mark registered under this Act”, as employed in the said sub-section, to our view, cannot apply to a case in which the trade mark which is registered is not the one for which the registrant had applied. To extend the benefit of Section 31(1) to such a case would, in our view, result in absurdity. That no legal provision can be so interpreted as to result in absurd consequences, is trite.²²

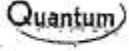
19.2 We are constrained, however, to observe that, had it not been for the aforementioned deliberate concealment of facts, the appellant has a

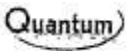
²¹ 31. **Registration to be prima facie evidence of validity.** –

(1) In all legal proceedings relating to a trade mark registered under this Act (including applications under Section 57), the original registration of the trade mark and of all subsequent assignments and transmissions of the trade mark shall be *prima facie* evidence of the validity thereof.

²² Refer **Commissioner of Customs v Tullow India Operations Ltd, (2005) 13 SCC 789**



good case, on merit, against the respondents, for an injunction on the aspect of infringement, on the basis of the appellant's registered device mark . The learned Commercial Court has observed that no case for infringement could lie as the respondents were not using their marks for the goods in respect of which the marks stand registered in favour of the appellant.

19.3 The registration of the device mark , in the appellant's favour, is under Class 9 for "all computer hardware components and accessories except hard disk drives but including motherboards, monitors, keyboards, mouse, CPU fan, headphone mike, multimedia speakers, sound card, lan cards, computer cabinets, SMPS, Networking accessories external hubs, information kiosks, cat 3 cable 305 mtr/100 mtr, PCI to USB card port and also electronic machine such as electro stat, video games."

19.4 The Vice President of LG Korea had, in para 4 of his affidavit, filed as evidence in support of Application No. 2918701 [reproduced in para 12.1(ii) *supra*], clearly acknowledged that the respondents had been using and promoting the marks QUANTUM and QUANTUM DISPLAY since April 2015. The affidavit further goes on to state that, by virtue of said use, the marks QUANTUM and QUANTUM DISPLAY *had acquired secondary distinctiveness and had come to be associated with the respondents' goods in the eyes of the consumers.* This clearly admits commercial exploitation, in the course of trade, of the marks QUANTUM and QUANTUM DISPLAY by the respondents.



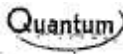
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19.5 We cannot allow the respondents to resile from this stand. An affidavit is on oath. What is stated in the affidavit is by way of solemn affirmation. The contents of para 4 of the affidavit of the Vice President of LG Korea, to our mind, are clear affirmation of the fact that the respondent was using the marks QUANTUM and QUANTUM DISPLAY, in the course of trade, since 2015.

19.6 Though Mr. Hemant Singh sought to contend that the said use was discontinued in 2017, nothing to that effect has been brought on record. In any event, in view of the said assertion, we cannot agree with the learned Commercial Court that the appellant could not maintain an injunction action against the respondents.

19.7 The mere fact that, in para 26 of its plaint, the appellant averred that the respondent had failed to file cogent documents to prove user, cannot mitigate or reduce the effect of the findings contained in para 4 of the affidavit dated 2 May 2021 of the Vice President of the LG Korea.

19.8 The resultant position is that there was admitted user, by the respondents, of the marks QUANTUM and QUANTUM DISPLAY for TV sets and similar goods since 2015. The respondents have no registration for the marks QUANTUM or QUANTUM DISPLAY. The appellant, on the other hand, has a valid and subsisting registration for the device mark . As has been held by the Supreme Court in **K. R. Chinna Krishna Chettiar**, where the main



part of the device mark of the plaintiff consists of a word, the plaintiff is entitled to claim exclusivity over the word and is also entitled to an injunction against third parties adopting marks of which the same word constitutes the dominant part, in an infringement action.

19.9 This also follows from the judgments of the Division Bench of this Court in **South India Beverages Pvt Ltd v General Mills Marketing Inc.**²³ as well as the recent decision of the Supreme Court in **Pernod Ricard India (P) Ltd v Karanveer Singh Chhabra**²⁴. In both these decisions, the Court has lent its imprimatur to the “dominant part”²⁵ principle, which counterbalances the principle of anti-dissection contained in sub-section (2) of Section 17²⁶ of the Act. While, ordinarily, it is not permissible for the proprietor of a registered composite mark to claim exclusivity over any individual part of a composite mark, unless that individual part is separately registered, nonetheless, where any particular element of such composite mark constitutes its dominant part, the claim of exclusivity over the composite mark itself can be assessed by reference to the dominant part. In other words, while the right of the plaintiff-registrant would still only be for claiming exclusivity over the entire composite mark,

²³ 2015 (61) PTC 231 (Del)

²⁴ 2025 SCC OnLine SC 1701

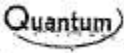
²⁵ somewhat inaccurately referred to, in the judgment, as “dominant mark”

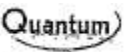
²⁶ 17. **Effect of registration of parts of a mark.** –

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



the likelihood of confusion can be assessed on the basis of dominant part of the composite part, vis-à-vis the marks of others. If the dominant part of the composite mark is replicated in the marks of another, the mark of such other party becomes *ipso facto* confusingly similar to the composite mark of the plaintiff. This is the principle laid down in **South India Beverages** as well as in **Pernod Ricard**.

19.10 QUANTUM is, unquestionably, the dominant part of the registered  device mark of the appellant.

19.11 The appellant would, on the basis of its valid and subsisting registration for device mark , be entitled to an injunction against any other person using a mark of which QUANTUM is a dominant part, for goods or services which are identical to, or similar to the goods or services in respect of which the  device mark stands registered in the appellant's favour.

19.12 Section 29(2)(b)²⁷ of the Act treats any such use as infringing if, owing to the similarity of the marks and similarity of the goods or services in respect of which the marks are used, a likelihood of confusion or of a consumer of average intelligence and imperfect

²⁷ 29. Infringement of registered trade marks. –

(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—

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

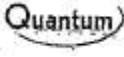
is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trade mark.



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recollection believing the existence of an association between the marks, can be said to exist.

19.13 We are not in agreement with the learned Commercial Court's view that television sets and similar goods in respect of which the respondents use their marks are not similar to the goods in respect of which the device mark  stands registered in the appellant's favour. In the present day and age, when one brand is used for a wide variety of goods, at times spanning the entire consumer spectrum, the scope of the definition of "similar goods" for the purposes of Section 29(2)(b) of the Act, has to be proportionately enlarged. It is a well-known fact that several major companies, such as Samsung, Sony and the like, make televisions, television accessories and other associated goods such as speakers, alongside computers and computer peripherals. This fact is apparently recognized even by the NICE classification of goods, which clubs computers, computer peripherals and televisions and their accessories in the same Class 9. It cannot, therefore, be said that goods in respect of which the appellants  device mark stands registered are not "similar" to televisions and their accessories, within the meaning of Section 29(2)(b), as to disallow a claim of infringement.

19.14 On merits, therefore, we are of the view that the appellant did have a sustainable case for injunction against the respondents, based on the registration of the device mark  in the appellant's favour.



19.15 Unfortunately, by resorting to concealment of relevant facts both from the learned Commercial Court as well as from this Court, the appellant has allowed the chance of securing interlocutory relief to go abegging.

20. Re: Passing Off

20.1 We agree with the learned Commercial Court that in the facts of the present case, no case of passing off could lie against the respondents.

20.2 A claim for passing off, unlike a claim for infringement, is not based on a mark-to-mark comparison. The goods in respect of which the mark is used by the defendants, and the manner of such use, are of prime significance when examining an allegation of passing off. This becomes apparent from the following paragraphs from the judgment of the Supreme Court in **Kaviraj Pandit Durga Dutt Sharma v Navaratna Pharmaceutical Laboratories²⁸**, which still endure as the *locus classicus* to distinguish between infringement and passing off:

“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 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.

29. When once the use by the defendant of the mark which is claimed to infringe the plaintiff's mark is shown to be "in the course of trade", the question whether there has been an



infringement is to be decided by comparison of the two marks. Where the two marks are identical no further questions arise; for then the infringement is made out. When the two marks are not identical, the plaintiff would have to establish that the mark used by the defendant so nearly resembles the plaintiff's registered trade mark as is likely to deceive or cause confusion and in relation to goods in respect of which it is registered (Vide Section 21). A point has sometimes been raised as to whether the words "or cause confusion" introduce any element which is not already covered by the words "likely to deceive" and it has sometimes been answered by saying that it is merely an extension of the earlier test and does not add very materially to the concept indicated by the earlier words "likely to deceive". But this apart, as the question arises in an action for infringement the onus would be on the plaintiff to establish that the trade mark used by the defendant in the course of trade in the goods in respect of which his mark is registered, is deceptively similar. This has necessarily to be ascertained by a comparison of the two marks — the degree of resemblance which is necessary to exist to cause deception not being capable of definition by laying down objective standards. The persons who would be deceived are, of course, the purchasers of the goods and it is the likelihood of their being deceived that is the subject of consideration. The resemblance may be phonetic, visual or in the basic idea represented by the plaintiff's mark. The purpose of the comparison is for determining whether the essential features of the plaintiff's trade mark are to be found in that used by the defendant. The identification of the essential features of the mark is in essence a question of fact and depends on the judgment of the Court based on the evidence led before it as regards the usage of the trade. It should, however, be borne in mind that the object of the enquiry in ultimate analysis is whether the mark used by the defendant as a whole is deceptively similar to that of the registered mark of the plaintiff."

20.3 Though para 4 of the affidavit filed by the Vice President of LG Korea testifies to the effect that the respondents had been using the marks QUANTUM and QUANTUM DISPLAY since 2015, the manner of such use is not set out in the affidavit. In fact, as the learned Commercial Court has noted, the stand of the appellant, in its plaint, was that the respondents had not produced any proof of such use. In the absence of cogent material to indicate the manner in which the



respondents were using the marks QUANTUM and QUANTUM DISPLAY, no case of passing off could lie against the respondents.

20.4 The very basis of a passing off tort is an attempt to pass off one's goods as the goods of another. The issue of whether a case of passing off is, or is not, made out has, therefore, to be assessed on the basis of the manner in which the defendants' goods are sold in the market. In the absence of any evidence of such sale, the learned Commercial Court, we agree, was in no position to return any positive finding on the appellant's plea of passing off.

20.5 Even if the manner of use of the marks QUANTUM and QUANTUM DISPLAY by the respondents were known, a claim of passing off could sustain only if the appellant could establish accumulation of sufficient goodwill prior to 2015²⁹, as would justify injuncting the respondents from using the marks QUANTUM and QUANTUM DISPLAY. This is another aspect which the appellant would have had to satisfy to obtain an injunction on the ground of passing off against the respondents. However, as the learned Commercial Court did not proceed to any detailed examination of the plea of passing off, on merits, choosing to reject the plea on the ground that no proof of user of the marks QUANTUM and QUANTUM DISPLAY was available, the aspect of goodwill has remained unexplored.

20.6 In any event, in such circumstances, we agree with the learned

²⁹ In view of the judgment of the Supreme Court in **Toyota Jidosha Kabushiki Kaisha v Prius Auto Industries Ltd., (2018) 2 SCC 1**, which holds that the plaintiff, in a case of passing off, has to establish accumulation of goodwill *prior to the commencement of user of the objectionable mark by the defendant*.



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Commercial Court that the appellant could not have successfully obtained an injunction against the respondents from use of the marks QUANTUM and QUANTUM DISPLAY on a plea of passing off.

21. The sequitur

21.1 As a result, we are in agreement with the finding of the learned Commercial Court that the appellant has resorted to wilful and deliberate concealment of facts.

21.2 As we have already observed, the entitlement to interim injunction under Order XXXIX is dependent on a party coming to the Court with clean hands, which requirement, in the present case, in our view, is not satisfied.

Conclusion

22. For the above reasons, we uphold the finding of the learned Commercial Court that the appellant has resorted to deliberate concealment of facts and, on that ground, decline to interfere in the present appeal, which is, accordingly, dismissed with no orders as to costs.

C. HARI SHANKAR, J.

OM PRAKASH SHUKLA, J.

NOVEMBER 4, 2025/aky/yg