



2025:DHC:9713-DB



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IN THE HIGH COURT OF DELHI AT NEW DELHI*Reserved on: 2 July 2025**Pronounced on: 6 November 2025*

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FAO (COMM) 82/2025 & CM APPL. 17511/2025

MOHAMMAD TALHA

.....Appellant

Through: Ms. Swathi Sukumar, Sr. Adv.
with Mr. Shayan Khurram, Mr. Osho Mittal,
Mr. Ritik Raghuvanshi, Mr. Rishab
Aggarwal and Mr. Arafat Ali, Advs.

versus

M/S KARIM HOTELS PVT. LTD

.....Respondent

Through: Mr. Darpan Wadhwa, Sr. Adv.
with Ms. Ridhima Goyal, Mr. Saif Uddin
Khan, Mr. Mohd. Affan, Ms. Rashi
Khandelwal, Ms. Divita & Ms. Rhea, Advs.

CORAM:**HON'BLE MR. JUSTICE C. HARI SHANKAR****HON'BLE MR. JUSTICE AJAY DIGPAUL**

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JUDGMENT**06.11.2025****C. HARI SHANKAR, J.**

1. Purportedly on coming to learn, in December 2020, that the appellant Mohammad Talha was operating a restaurant in Moradabad under the name GULSHAN-E-KARIM, serving Mughlai delicacies, the respondent instituted CS (Comm) 1979/2022¹ before the learned District Judge (Commercial Court-13), Central District, Tis Hazari², seeking a decree of permanent injunction, restraining the appellant and all others acting on his behalf from using the mark GULSHAN-E-

¹ “the suit” hereinafter

² “the learned Commercial Court”



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KARIM or any other mark which is deceptively identical or similar to the respondent's registered trade marks, which included the word mark KAREEM and the device mark KARIM.

2. The suit is presently pending. Along with the suit, the respondent filed application under Order XXXIX Rules 1 and 2 of the Code of Civil Procedure 1908³, seeking an interim injunction, restraining the appellant from using the mark GULSHAN-E-KARIM or any other mark which was confusingly or deceptively similar to the registered trade mark of the respondent.

3. By order dated 15 January 2025, the learned Commercial Court has allowed the aforementioned application of the respondent and has restrained the appellant from using the name KARIM as part of his trade mark GULSHAN-E-KARIM or otherwise, for his restaurant or in relation to any goods or services rendered or provided by him.

4. Aggrieved thereby, the appellant, as the defendant in the suit against whom the aforementioned injunction order has been passed, has instituted the present appeal.

5. We have heard Ms. Swathi Sukumar, learned Senior Counsel for the appellant and Mr. Darpan Wadhwa, learned Senior Counsel for the respondent, at length.



Facts and the impugned judgment

6. Stand of the respondent before the learned Commercial Court

6.1 Before the learned Commercial Court, the respondent claimed to have been founded in 1913 by one Haji Karimuddin, whose ancestors were stated to have worked as royal cooks in the kitchen of Mughal Emperors till the 1857 mutiny. While working as cooks, it was asserted that Haji Karimuddin's ancestors had evolved what has later come to be known as Mughlai cuisine. The respondent claimed to have opened the first Karim restaurant in old Delhi in 1913 and also claimed, ever since then, to have been using the mark KARIM for its restaurant in old Delhi as well as its other outlets. The name KARIM, it was asserted, was derived from the name of the founder Haji Karimuddin.

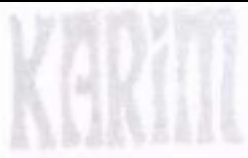
6.2 The respondent is the proprietor of the following trade marks, registered under Section 23 of the Trade Marks Act, 1999⁴:

S. No.	Trade Mark	Date of Registration	Class (es)
1	KAREEM (word mark)	9 November 2010	43, 16 & 30
2		9 November 2010	16
3		9 November 2010	43



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4		9 November 2010	16
5		17 October 2002	29
6		24 December 1998	29
7		26 September 2006	42
8		14 February 2013	43
9		14 February 2013	43
10		9 November 2010	16, 30 & 43
11		9 November 2010	16 & 30
12		9 November 2010	16, 30 & 43
13		9 November 2010	16
14		9 November 2010	30, 43

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15		9 November 2010	30
16		9 November 2010	30 & 43
17		9 November 2010	16, 30 & 43
18		6 February 2015	30
19		6 February 2015	29 & 30
20		6 February 2015	29 & 30
21		6 February 2015	29 & 30
22		6 February 2015	29 & 30
23		6 February 2015	29 & 30
24		6 February 2015	29 & 30

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25		6 February 2015	29 & 30
26		6 February 2015	29 & 30
27		6 February 2015	29 & 30
28		6 February 2015	29 & 30

The respondent also claimed to be operating a website www.karimhoteldelhi.com.

6.3 It was also claimed that, by continuous and uninterrupted user of the mark KARIM, the respondent had amassed considerable goodwill and reputation in the market. Reference was invited to various awards and encomiums been earned by the respondent. As such, it was claimed, in the plaint, that the name KARIM had become synonymous with the respondent and had in fact become a source identifier for the respondent in the eyes of the consumers.

6.4 The plaint asserted that, in December 2020, the respondent had come to learn of the restaurant GULSHAN-E-KARIM being run by the appellant in Moradabad. Contending that the use of “KARIM” as a part of the mark GULSHAN-E-KARIM rendered the mark deceptively similar to the registered trade marks of the respondent, the

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respondent instituted the suit before the learned Commercial Court, seeking injunction as aforementioned, along with an application for interlocutory relief.

6.5 Before the learned Commercial Court, the appellant contended that the GULSHAN-E-KARIM mark had been adopted by his father in 1997 and that the restaurant at Moradabad was opened under the said name by the appellant's father in 2016. Since then, it was contended that the appellant had been continuously using the mark GULSHAN-E-KARIM.

6.6 It was further contended by the appellant that, in Urdu, Gulshan-E-Karim means "Garden of God" and that the name was devised so as to describe the flavours of the items which were available for consumption in the restaurant. The word "Karim", it was further submitted, also means "generous".

6.7 The appellant relied on the fact that it had been granted a license by the Food Safety and Drug Administration of the Govt. of UP to run its restaurant GULSHAN-E-KARIM.

6.8 It was further contended by the appellant that there was no specific emphasis, in the mark GULSHAN-E-KARIM, on "KARIM" and that, when the whole mark was seen in comparison to the respondent's mark, there was no confusing or deceptive similarity, and that no average consumer was likely to mistake one for the other. When the two marks were placed side by side, it was submitted that



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there was no similarity between them. Moreover, submitted the appellant, it was operating only in Moradabad and nearby cities and, therefore, there was no chance of any consumer confusing the outlet of the appellant with the outlet of the respondent.

6.9 The appellant further pleaded acquiescence, as the respondent had instituted the suit in 2022, 25 years after the appellant had commenced user of the GULSHAN-E-KARIM mark in 1997.

7. The impugned judgment

7.1 Having recorded the rival contentions of the parties, the learned Commercial Court proceeds, on the following reasoning, to grant interim injunction as sought by the respondent in the impugned judgment:

(i) The respondent had admittedly 48 registrations, under the Act, of the marks KARIM, KARIM'S and KAREEM both as word marks and as device marks in Classes 16, 29, 30, 42 and 43. These registrations covered running of the restaurants and providing of vegetarian and non-vegetarian food, Mughlai or otherwise.

(ii) The user, by the respondent, of its marks dated back to 1913. As against this, the appellant, even as per its stand, had adopted the mark GULSHAN-E-KARIM only in 1997 and had commenced use of the mark only in 2016, when its first



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restaurant was opened in Moradabad. The respondent, therefore, enjoyed considerable priority of user over the appellant.

(iii) On the aspect of deceptive similarity, the learned Commercial Court relied on the history of the mark KARIM and the assertion, by the respondent, that the ancestors of Haji Karimuddin were royal cooks in the Mughal Empire. The history of the mark KARIM, as well as the assiduous efforts put in by the respondent to ensure protection of the mark were treated, by the learned Commercial Court, as evidence of goodwill and reputation enjoyed by the respondent's KARIM mark in the market.

(iv) Besides, KARIM constituted the dominant part of all the respondent's marks. Even for this reason, the appellant could not be permitted to incorporate KARIM as a part of any mark which it proposed to use for the same business of dispensing of food items. Inasmuch as both marks were used for the same classes of goods and catered to the same consumer segment, likelihood of confusion was apparent.

(v) Adverting to the reliance, placed by the appellant, on the judgment of the Division Bench of this Court in **Vasundhra Jewellers Pvt Ltd v Kirat Vinodbhai Jadvani**⁵, the learned Commercial Court holds that the decision was distinguishable. In that case, injunction was refused by the Division Bench of



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this Court on the ground that “Vasundhra” was a generic word. The learned Commercial Court holds, in the impugned order, that “whereas the word KARIM or KAREEM may though may also be generic, but it has been given to be having a history related to the above named predecessors in interest of plaintiff company, whose ancestors used to be worked as royal cook with Mughal Emperors and can, thus, be related to them”.

(vi) The plea of acquiescence, as advanced by the appellant, was found to be without merit as

- (i) there was no actual evidence of coinage and adoption of the mark GULSHAN-E-KARIM by the father of the appellant in 1997,
- (ii) the appellant had applied for registration of the mark only on 11 November 2020,
- (iii) the restaurant in Moradabad was opened only in 2016,
- (iv) it was the respondent’s contention that it had come to learn of the said restaurant only in December 2020,
- (v) the respondent had in fact filed an opposition before the Trademarks Registry, opposing the application of the appellant for registration of the mark GULSHAN-E-KARIM, and
- (vi) following the COVID pandemic which spanned the years 2020-22, the respondent proceeded to file the suit on 16 August 2022.



(vii) Besides, even in law, relying on **Midas Hygiene Industries (P) Ltd v Sudhir Bhatia**⁶, it was held that acquiescence by itself could not constitute a basis to deny injunction.

(viii) It was not open to the appellant to claim that the mark KARIM was generic as the appellant had itself applied for registration of the mark GULSHAN-E-KARIM.

(ix) Even during the pendency of the suit before the learned Commercial Court, some new outlets had been opened by the appellant. Thus, the appellant was also in the process of expanding its business.

8. For all these reasons, the learned Commercial Court has proceeded to grant interlocutory injunction in favour of the respondent as already noted hereinabove.

Rival Contentions

9. Submissions of Ms. Swathi Sukumar for the appellant.

9.1 Apart from adopting the submissions made before the learned Commercial Court and noted *supra*, Ms. Sukumar further submits that the mark GULSHAN-E-KARIM is an inherently distinctive mark which was coined by the appellant's father. By virtue of its inherently



distinctive nature, it is submitted that the mark is entitled to enhanced protection. She further submits that, having coined the mark GULSHAN-E-KARIM, the continuous and uninterrupted user of the mark by the appellant, even while the respondent was using its marks could, at the worst, be regarded as honest and concurrent user. She submits that it is clear that the appellant had no intention to capitalise on the goodwill of the respondent's marks.

9.2 Ms. Sukumar further submits that, when the mark GULSHAN-E-KARIM of the appellant, as used by it, was compared with the marks of the respondent, it was clear that there was no visual, phonetic or structural similarity between them. The mere existence of the common "KARIM" element would not result in any likelihood of confusion.

9.3 Ms. Sukumar further submits that the anti-dissection rule prohibited bifurcation of the appellant's mark GULSHAN-E-KARIM and extraction, from the said mark, of the "KARIM" part. The comparison between the appellant and the respondent's mark had to be on the basis of the complete GULSHAN-E-KARIM mark, and could not be based on the common feature between the two. Ms. Sukumar also relies on the response, by the respondent, to objections by third parties, to Application 2051019, whereunder the respondent sought to register the KARIM logo. Having adopted a stand, in the said response, that the respondent's marks were deceptively similar to the marks of the objectors, Ms. Sukumar submits that the respondent cannot now seek to contend that, because of the common "KARIM"



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element between the appellant and the respondent's mark, there was likelihood of confusion.

9.4 She has specifically drawn our attention to response dated 27 March 2012, submitted by the respondent before the Registrar of Trade Marks which, to the extent relevant, may be reproduced thus:

“To,

The Registrar of Trade Marks
Intellectual Property Bhawan
Plot No. 32, Sector-14 Dwarka,
New Delhi-110075

Dated: 27/3/2012

Subject: Registration of Trade Mark ‘KARIM’ (Logo) under Application number 2051019 in Class 43 in the name of M/s Karim Hotels Pvt. Ltd, addressed at-16, Gali Kababiyar, Bazar Matia Mahal, Near Jama Masjid, Delhi-110006.

Dear Sir,

We act on behalf of the Applicant in the matter. We refer the Examiner Report issued by the Trademark Registry and in this regard our response may kindly be read as under:

1. We have received the Examination Report issued by the Registrar of the Trade Marks dated 29/02/2012 to our application no. 2051019 on 27 February 2012.

2. Objections raised in the Examination. Report on the relative grounds of the refusal under Section 11 of The Trade Marks Act, 1999 is not maintainable. *The reported marks as annexed with Examination Report are different in all respect in comparison to the applicant's mark as they differ substantially in get up, design and presentation hence the ordinary consumers/purchasers would not be misled. The trade mark 'KARIM' is capable to distinguish the goods/services of applicant to others in the market and trade due to its goodwill and reputation built over the period of time. It is not devoid of any distinctive character. It stands apart and relates to the origin of the goods/services to the applicant only*

(Emphasis supplied)

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9.5 Ms. Sukumar questions as to how, if the respondent's mark KARIM was not deceptively similar to the cited marks, the appellant's mark GULSHAN-E-KARIM could be treated as deceptively similar to the respondent's mark.

9.6 Ms. Sukumar also reiterates the plea of acquiescence. She submits that the learned Commercial Court was in error in observing, on this issue, that there was no actual proof of user, by the appellant, of the GULSHAN-E-KARIM mark since 1997, as asserted by it. She submits that there are various government documents, statutory registrations, proof of tax filings, etc., which manifest use of the mark GULSHAN-E-KARIM by the appellant. She has particularly drawn our attention to a receipt dated 27 March 1998 issued by the Tax authorities, and the registration of the firm GULSHAN-E-KARIM by the Uttar Pradesh Commercial Tax Department on 1 July 1998, in which it is noted that the name was being used to run a restaurant.

9.7 Ms. Sukumar further points out that, in the impugned order of the learned Commercial Court, there is no finding that KARIM is a dominant part of the mark GULSHAN-E-KARIM. KARIM, moreover, she submits, is *pubici juris*, and is a common expression used to refer to the Almighty. Use of such a common expression exposes the user to the possibility of replication of the mark by others, without any injunctive protection being possible. Ms. Sukumar relies, in this context, on an order passed by one of us (C. Hari Shankar, J.), sitting singly, in **Jindal Industries Pvt Ltd v Suncity Sheets Pvt**



Ltd⁷.

9.8 Ms. Sukumar also reiterates the reliance, placed by the appellant before the learned Commercial Court, on the decision in **Vasundhra Jewellers**. She further points out that, while dealing with the said submission, the learned Commercial Court has in fact acknowledged that the word KARIM may be generic. Having thus acknowledged the possibility of KARIM being generic, she submits that the learned Commercial Court fell seriously in error in further proceeding to note that KARIM had, in the case of respondent, acquired exclusivity as the respondent's forefathers were cooks in the Mughal Empire.

9.9 In conclusion, Ms. Sukumar submits, on instructions, that her client is willing to append a disclaimer, with its mark, in any manner suggested by this Court, clarifying that it has nothing to do with the respondent's institution.

10. Submissions of Mr. Darpan Wadhwa, learned Senior Counsel for the respondent.

10.1 Mr. Wadhwa, in response, merely reiterates the contentions already noted earlier and adopts the findings of the learned Commercial Court. He places particular reliance on the following passages from the judgment of the Supreme Court in **Parle Products (P) Ltd v J.P. & Co⁸**:

⁷ 2024 SCC OnLine Del 1632

⁸ (1972) 1 SCC 618



“According to Karly's Law of Trade Marks and Trade Names (9th Edition Paragraph 838) "Two marks, when placed side by side, may exhibit many and various differences, yet the main idea left on the mind by both may be the same. A person acquainted with the one mark, and not having the two side by side for comparison, might well be deceived, if the goods were allowed to be impressed with the second mark, into a belief that he was dealing with goods which bore the same mark as that with which he was acquainted. It would be too much to expect that persons dealing with trademarked goods, and relying, as they frequently do, upon marks, should be able to remember the exact details of the marks upon the goods with which they are in the habit of dealing. Marks are remembered rather by general impressions or by some significant detail than by any photographic recollection of the whole. Moreover, variations in detail might well be supposed by customers to have been made by the owners of the trade mark they are already acquainted with for reasons of their own. It is therefore clear that in order to come to the conclusion whether one mark is deceptively similar to another, the broad and essential features of the two are to be considered. They should not be placed side by side to find out if there are any differences in the design and if so, whether they are of such character as to prevent one design from being mistaken for the character as to prevent one design from being mistaken for the other. It would be enough if the impugned mark bears such an overall similarity to the registered mark as would be likely to mislead a person usually dealing with one to accept the other if offered to him.”

Analysis

11. Right of respondent to sue for infringement and entitlement to injunctive relief – Section 28(1)⁹ of the Act – Basic principles restated

11.1 The respondent is the registered proprietor of various word marks and device marks. These include the word mark KAREEM as well as various device marks of which KARIM is the dominant part.

⁹ 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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11.2 Section 28(1) confers, on the registrant of a *valid* registered trade mark, two rights, viz., the right to exclusive use of the mark for the goods or services in respect of which it is registered, and the right to seek relief against infringement, where infringement, within the meaning of Section 29 of the Act, is found to exist. Of the various sub-sections of Section 29, we are concerned, here, only with Section 29(2)¹⁰. The reliefs available against infringement are detailed in Section 135(1)¹¹ of the Act, and include the relief of injunction against the defendant using the infringing mark.

11.3 The entitlement to interim relief of injunction, in a trade mark infringement suit, would require satisfaction of the classic triad of a *prima facie* case, balance of convenience, and likelihood of irreparable loss were interim relief not to be granted. Section 31(1)¹² of the Act provides that the very fact of registration would, by itself, be *prima facie* evidence of the validity of the registration. The petitioner would not, therefore, be required, at the *prima facie* Order XXXIX stage, to

¹⁰ 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—

- (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.

¹¹ 135. **Relief in suits for infringement or for passing off. –**

(1) The relief which a court may grant in any suit for infringement or for passing off referred to in Section 134 includes injunction (subject to such terms, if any, as the court thinks fit) and at the option of the plaintiff, either damages or an account of profits, together with or without any order for the delivery-up of the infringing labels and marks for destruction or erasure.

¹² 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.



prove that the registration is valid, as that onus stands statutorily discharged by Section 31(1).

11.4 All that the respondent had to show, therefore, was that the appellant was infringing its registered trademarks. If it could do that, it was entitled to an injunction.

11.5 “Infringement” is defined in Section 29 of the Act.¹³ For our purposes, Section 29(2) alone would be relevant, particularly clause (b) thereof. Pared down to its essentials, Section 29(2)(b) envisages infringement as having taken place where

- (i) the marks of the plaintiff and defendant are similar,
- (ii) the goods or services for which they are used are similar, and
- (iii) *because of such similarity in the marks and the goods or services for which they are used*, there is either, in the minds of the public,
 - (a) likelihood of confusion between the marks, or
 - (b) likelihood of the public believing an association between the marks.

11.6 The aspect of assessment of likelihood of confusion for the purposes of infringement, follows certain fundamental principles, which may be thus enumerated:

¹³ Section 30 sets out certain circumstances in which, even if the ingredients of Section 29 are present, there would be no infringement. None of these circumstances apply to the present case; ergo, we need not concern ourselves with Section 30.



(i) Likelihood of confusion has to be assessed from the perspective of a consumer of average intelligence and imperfect recollection.¹⁴

(ii) The rival marks are not to be seen side by side.¹⁵ What has to be seen is whether the consumer of average intelligence and imperfect recollection, who has seen the plaintiff's mark at one point of time and comes across the defendant's mark at a later point of time, is likely to be confused between the two, or to wonder whether there is an association between them. It is enough if the average consumer is placed in a "state of wonderment", on seeing the defendant's mark, as to whether he has seen the same mark, a mark similar to it, or a mark associated with it, earlier.¹⁶

(iii) This has to be assessed on "initial interest" basis. In other words, what has to be seen is whether, on *initially viewing* the defendant's mark, the average consumer is likely to be confused. What matters, and what only matters, is the *initial impression* that the defendant's mark creates, and the initial reaction that it evokes.¹⁷ Even if the initial reaction is likely to be a momentary state of confusion or wonderment, injunction stands proved.

¹⁴ Refer *Amritdhara Pharmacy v Satya Deo Gupta*, AIR 1963 SC 448; *Satyam Infoway Ltd v Siffynet Solutions Pvt Ltd*, (2004) 6 SCC 145

¹⁵ Refer *Parle Products Ltd v J.P. & Co.*; *Pernod Ricard India P Ltd v Karanveer Singh Chhabra*, 2025 SCC OnLine SC 1701

¹⁶ Refer *Shree Nath Heritage Liquor Pvt Ltd v M/s. Allied Blender & Distillers Pvt Ltd*, 221 (2015) DLT 359 (DB)

¹⁷ Refer *Under Armour Inc v Anish Agrawal*, 2025 SCC OnLine Del 3784



(iv) The likelihood of confusion is to be viewed from the judge's subjective and dispassionate perspective, not established by evidence.¹⁸

12. The aspect of deceptive similarity, likelihood of confusion and infringement

12.1 Consider a hypothetical gentleman, whom we would name, for ease of reference, as Mr. X. Being a non-vegetarian, Mr. X partakes, with relish, of the delicacies served at Karim's, the restaurant of the respondent, situated in Delhi. Mr. X is a man of average intelligence and imperfect recollection¹⁹. He cannot, therefore, be expected to remember the pictorial representation of the respondent's mark. He remembers having dined at a restaurant named KARIM's in Delhi. Sometime later, while travelling and crossing Moradabad *en route* to Corbett Park with his friend Mr. Y, he espies the appellant's restaurant GULSHAN-E-KARIM. He turns to Mr. Y and says "well, I seem to have dined at a restaurant belonging to the same chap, in Delhi". *Even if that fleeting impression is created in the mind of Mr. X, that is sufficient to constitute infringement.* Mr. Y may, the very next moment, enlighten Mr. X on the fact that the appellant's restaurant GULSHAN-E-KARIM has nothing to do with the respondent's KARIM chain of restaurants. The fact that Mr. X has thus been disabused of its initial notion of an association between the appellant and the respondent, created by the similarity between the respondent's KARIM and the appellant's GULSHAN-E-KARIM marks, the very

¹⁸ Refer **Dr. Reddys Laboratories v Smart Laboratories**, 2023 SCC OnLine Del 7276

¹⁹ The test of likelihood of confusion has necessarily to be tested from the perspective of a consumer of average intelligence and imperfect recollection as held in **Amritdhara Pharmacy v Satya Deo Gupta and**



next moment, cannot mitigate the infringement which has already taken place. This is because infringement is to be examined from the point of view of initial interest, often called the “initial interest confusion” test. If on initially viewing the respondent’s mark, the consumer of imperfect recollection even fleetingly wonders as to whether there is some association between the respondent’s outlet and the appellant’s outlet, that by itself would suffice to constitute infringement.

12.2 A simpler example may be cited. Mr. X is *aware* that there is a restaurant chain named KARIM’s, of the respondent. Mr. Y informs him that he had Mughlai food at an outlet named GULSHAN-E-KARIM, in Moradabad. Would, or would not, Mr. X be likely to *wonder* whether the two outlets may not be of one person? If he is, infringement stands established.

12.3 The approach of the Court cannot, in such cases, be fanciful. The finding of a likelihood of confusion must be a considered finding. The consumer, being a person endowed with average intelligence and imperfect recollection, may not be a genius or possessing a photographic memory; equally, however, he is not an idiot, or an amnesiac. Inasmuch as the decision rests, not on evidence, but on the subjective impression of the Court, that impression must be carefully made. The right of a citizen to do business, in the manner he chooses, it must be remembered, hangs in the balance.



12.4 We, however, are not examining the issue as a court of first instance. We are an appellate Court, and the peripheries of appellate jurisdiction of the appellate Court, in such cases, stand thus delineated by the Supreme Court, in **Wander Ltd. v Antox (India) Pvt Ltd**²⁰:

“14. The appeals before the Division Bench were against the exercise of discretion by the Single Judge. In such appeals, the appellate court will not interfere with the exercise of discretion of the court of first instance and substitute its own discretion except where the discretion has been shown to have been exercised arbitrarily, or capriciously or perversely or where the court had ignored the settled principles of law regulating grant or refusal of interlocutory injunctions. An appeal against exercise of discretion is said to be an appeal on principle. Appellate court will not reassess the material and seek to reach a conclusion different from the one reached by the court below if the one reached by that court was reasonably possible on the material. The appellate court would normally not be justified in interfering with the exercise of discretion under appeal solely on the ground that if it had considered the matter at the trial stage it would have come to a contrary conclusion. If the discretion has been exercised by the trial court reasonably and in a judicial manner the fact that the appellate court would have taken a different view may not justify interference with the trial court's exercise of discretion. After referring to these principles Gajendragadkar, J. in **Printers (Mysore) Private Ltd. v Pothan Joseph**²¹:

“... These principles are well established, but as has been observed by Viscount Simon in **Charles Osenton & Co. v Jhanaton**²² ‘...the law as to the reversal by a court of appeal of an order made by a judge below in the exercise of his discretion is well established, and any difficulty that arises is due only to the application of well settled principles in an individual case’.”

This principle has been reiterated in the recent decision of the Supreme Court in **Pernod Ricard** by clarifying that an appeal against an interim order in an intellectual property infringement case is an

²⁰ 1990 Supp SCC 727

²¹ AIR 1960 SC 1156

²² 1942 AC 130



appeal on principle. If the learned Commercial Court has applied the correct principle, the appellate court would not interfere.

12.5 The learned Commercial Court holds that such likelihood exists. We find no reason to differ with that finding, within the **Wander** limits.

12.6 That said, even subjectively, we are of the opinion that the very inclusion of “KARIM” as a part of the appellant’s mark is sufficient to create that initial impression of an association between the appellant’s and respondent’s outlets, in the mind of the average consumer of imperfect recollection. The respondent’s outlet is, after all, named KARIM, and the appellant’s “Garden of Karim”. The difference in stylization of the marks, when seen as logos, is irrelevant, for two reasons – firstly, because the marks are not to be seen by placing them side by side, but from the perspective of a consumer who has seen the respondent’s mark at one point of time and sees the appellant’s mark later, and, secondly, because the consumer is a person of average intelligence and *imperfect* recollection who cannot, therefore, for the purposes of an infringement analysis, be credited with the recollection of the intricacies of the respondent’s logo. It is for this reason that the Supreme Court has, in the following classic passages from **Kaviraj Pandit Dura Dutt Sharma v Navaratna Pharmaceutical Laboratories**²³:

“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.*"

(Emphasis supplied)

Thus, infringement, or its absence, has to be tested by comparing



mark to mark.²⁴ Added features, such as difference in getup, colour, appearance, and the like, would not be of significance where the marks, compared to each other, are deceptively similar. For a case of passing off to be made out, however, added features, which may distinguish the two marks from each other, would be of significance.

12.7 Equally, mere phonetic similarity between marks could also suffice to make out a case of likelihood of confusion in infringement analysis. Phonetic similarity is to be gauged by applying the following test enunciated by Parker J. in **Pianotist Co.'s Application**²⁵ and adopted by Courts in our country times without number, from as early as **Amritdhara Pharmacy v Satya Deo Gupta**:

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

Thus, as per **Pianotist**, when assessing likelihood of confusion on the basis of phonetic similarity between the rival marks, the Court has to consider:

- (a) the look, and the sound, of the words,
- (b) the goods or services to which they apply,
- (c) the nature and kind of customer who would be likely to buy the goods,

²⁴ Also refer **Rajasthan Aushdhalaya Pvt Ltd v Himalaya Global Holdings Ltd**, 2025 SCC OnLine Del 4721

(1906) 23 RPC 774



- (d) all surrounding circumstances, and
- (e) what is likely to happen if each of the marks is used in a normal way as a trade mark for the goods of the respective owners of the marks.

In the case on hand, the look and sound of the words are unquestionably similar, as the respondent's mark is KARIM and the appellant's is GULSHAN-E-KARIM. They are used for identical services, viz., restaurants and catering. The consumers who would frequent the outlets belong to the same segment. There are no surrounding circumstances as could be said to mitigate the possibility of confusion. There is, therefore, no infirmity in the view of the learned Commercial Court that the use of the rival marks in a normal way by the respondent is likely to result in confusion.

12.8 We, therefore, are in agreement with the learned Commercial Court that a *prima facie* case of infringement exist in the present case.

13. Re. plea that KARIM is *publici juris* and lacking in distinctiveness

13.1 Infringement is a statutory tort. Any exceptions to infringement have to be found in the statute and not outside it. The principle that no exclusivity can be claimed over a mark lacking distinctiveness is relatable to Section 17(2)(b)²⁶ of the Act.

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—



13.2 Distinctiveness is not to be assessed by viewing the plaintiff's mark *in vacuo*. It has to be assessed by viewing the mark keeping in mind the manner of its use. KARIM may not be distinctive for a place of worship; it is certainly distinctive, in our view, for a restaurant. As such, the plea of lack of distinctiveness has necessarily to fail.

13.3 Besides, the appellant itself applied for registration of the mark GULSHAN-E-KARIM. If "KARIM" is not distinctive for a restaurant, GULSHAN-E-KARIM would be equally lacking in distinctiveness. Section 9(1)(a)²⁷ of the Act proscribes registration of a mark which is lacking in distinctive character. Having himself applied for registration of the mark GULSHAN-E-KARIM, the appellant is estopped from contending that the mark GULSHAN-E-KARIM is not distinctive.

13.4 That apart, KARIM was the registered trade mark of the respondent. As we have already noted under Section 31(1) of the Act, the very fact of registration operates as *prima facie* evidence of validity of the registered mark. Per sequitur, the fact of registration would also operate as *prima facie* evidence of distinctiveness of the

(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.

27 9. Absolute grounds for refusal of registration.—

(1) The trade marks—

(a) which are devoid of any distinctive character, that is to say, not capable of distinguishing the goods or services of one person from those of another person;

(b) which consist exclusively of marks or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, values, geographical origin or the time of production of the goods or rendering of the service or other characteristics of the goods or service;

(c) which consist exclusively of marks or indications which have become customary in the current language or in the bona fide and established practices of the trade,

shall not be registered:

Signature Not Verified



registered mark, as distinctiveness is a *sine qua non* for registration. Even on the ground that the respondent's marks were registered, therefore, the plea of want of distinctiveness, as advanced by the appellant, has necessarily to fail.

14. Re. plea of anti-dissection

14.1 The invocation of the anti-dissection principle, by the appellant, is fundamentally misconceived. The appellant has sought to contend that the learned Commercial Court has erred in dissecting the appellant's mark into GULSHAN and extracting, from it, the latter "KARIM" part. The rule of anti-dissection applies to the plaintiff and not to the defendant. It is relatable to Section 17(2)(a)²⁸ of the Act. If the plaintiff's mark is composite, the plaintiff cannot claim exclusivity over part of any such composite mark, unless such part is separately registered as a trade mark. This is the anti-dissection principle. It, therefore, applies to the plaintiff and not to the defendant.

14.2 The Act does not contemplate any anti-dissection principle, qua the defendant's mark.

14.3 Even otherwise, the anti-dissection principle is subject to the

²⁸ 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;

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.



dominant part test. This legal position has been enunciated in any number of decisions, starting with **South India Beverages (P) Ltd v General Mills Marketing Inc**²⁹ and reiterated, most recently, by the Supreme Court in **Pernod Ricard**. As the Division Bench has held in **South India Beverages**, while assessing whether the rival marks are confusingly similar, it is open to the court, where the plaintiff's mark is composite in nature, and has a dominant part, to examine the aspect of confusion and similarity, *vis-a-vis* the mark of the defendant, by examining whether the defendant has replicated the dominant part. This is because it is characteristic of a human mind that it tends to recall dominant parts of a mark. We may recollect, once again, that the aspect of infringement is to be seen from the point of view of a consumer of average intelligence and imperfect recollection. Where a composite mark has a dominant part, a consumer of average intelligence and imperfect recollection would remember the mark by reference to that dominant part. Expressed otherwise, such a consumer would more readily recollect the dominant part of the mark, than its other features or attributes. It is for this reason that, in **South India Beverages** and **Pernod Ricard**, it has been held that the aspect of lack of confusion between rival marks can, in a case where the mark is composite, be assessed by comparing the dominant parts of the marks.

14.4 Even if the anti-dissection rule and, therefore, the dominant part principle were to apply to the defendant's, i.e. the appellant's mark, "KARIM" would constitute a dominant part thereof, even by the appellant's own translation of the expression GULSHAN-E-KARIM



to mean “Garden of God”. God cannot be treated as less dominant than the garden.

14.5 “KARIM”, therefore, would constitute the dominant part of the appellant’s GULSHAN-E-KARIM mark. The dominant part of the appellant’s mark being the same as the respondent’s mark, no error can be found in the decision of the learned Commercial Court that the use of the two marks simultaneously is likely to result in confusion in the mind of a consumer of average intelligence and imperfect recollection.

15. Acquiescence

15.1 The only other aspect which, in our view, merits consideration, is the plea of acquiescence. The learned Commercial Court has given cogent reasons as to why the plea cannot be accepted. The reasons are convincing, and call for no interference whatsoever.

15.2 There is, clearly, in the present case, no acquiescence at all. There is no evidence of the respondent having used the GULSHAN-E-KARIM mark since 1997. Though, Ms. Sukumar has sought to rely on certain statutory registrations and other government documents which refer to the appellant’s restaurant GULSHAN-E-KARIM, such documents cannot constitute user of the mark GULSHAN-E-KARIM in the course of trade. There is not a single commercial transaction, from 1997 till 2016, evidencing use of the mark GULSHAN-E-KARIM. No such evidence is forthcoming.



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15.3 The learned Commercial Court is, therefore, correct in its view that evidence of user of the mark GULSHAN-E-KARIM is available only from 2016. The application for registration of the mark GULSHAN-E-KARIM was itself made in 2020. Between 2020 and 2022 COVID reigned. The suit was instituted in August 2022. It cannot, therefore, be said that the respondent sat back and allowed the appellant to prosper and expand its business, without taking any action in that regard.

15.4 Besides, acquiescence, applying the principle laid down by the Supreme Court in **Power Control Appliances Pvt Ltd v Sumeet Machines Pvt Ltd**³⁰, requires a positive act. Mere inaction does not constitute acquiescence. In the present case, far from there being a positive act allowing the appellant to expand its business, the respondent in fact not only issued a cease and desist notice to the appellant on 18 May 2022, but also filed an opposition before the Trade Mark Registry opposing the application of the appellant for registration of the mark GULSHAN-E-KARIM. Clearly, therefore, there was no acquiescence on the respondent's part, to the appellant's use of the mark GULSHAN-E-KARIM.

15.5 Thus, though there was no acquiescence, even on facts, we may observe that mere acquiescence cannot constitute a defence against infringement. It is clear from the judgment of the Supreme Court in **Midas Hygiene**, on which the learned Commercial Court has correctly relied. In the said case, the Supreme Court has clearly held



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that delay in institution of an action cannot constitute a defence against infringement and that, where infringement is found to exist, an injunction must follow. Thus, mere acquiescence is no defence to infringement.

15.6 That said, we reiterate that, in the present case, even on facts, no case of acquiescence can be said to have been made out.

16. The Suggestion of a Disclaimer

16.1 Which leaves us with the issue of whether, following our above discussion and conclusions, the respondent should be absolutely enjoined from using the GULSHAN-E-KARIM mark, as the learned Commercial Court has done.

16.2 Section 28(1) of the Act entitles the proprietor of a validly registered trade mark to, *inter alia*, relief against infringement. The reliefs which can be granted in a case of infringement are set out in Section 135. Section 135, no doubt, empowers the Court to grant injunction in a case of injunction, but equally empowers the Court to subject the injunction to terms, as the Court may think fit.

16.3 Ultimately, under Order XXXIX Rules 1 and 2 of the CPC, the Court does equity. An inequitable order cannot be passed under Order XXXIX. The Court has also, while passing any order under Order XXXIX, to keep in mind the balance of convenience and the loss which the parties would suffer were the order to be passed. The



nature, and extent, of injunction, must be modulated keeping these considerations in mind.

16.4 The approach of the Court, in a case of innocent infringement, cannot be the same as the approach in a case of contumacious infringement. Also, where the infringing mark has been in use, by the defendant, for some time, the approach of the Court must factor in this consideration as well. **Wander** itself says so, in para 9:

“9. Usually, the prayer for grant of an interlocutory injunction is at a stage when the existence of the legal right asserted by the plaintiff and its alleged violation are both contested and uncertain and remain uncertain till they are established at the trial on evidence. The court, at this stage, acts on certain well settled principles of administration of this form of interlocutory remedy which is both temporary and discretionary. The object of the interlocutory injunction, it is stated

“...is to protect the plaintiff against injury by violation of his rights for which he could not adequately be compensated in damages recoverable in the action if the uncertainty were resolved in his favour at the trial. The need for such protection must be weighed against the corresponding need of the defendant to be protected against injury resulting from his having been prevented from exercising his own legal rights for which he could not be adequately compensated. The court must weigh one need against another and determine where the ‘balance of convenience’ lies.”

The interlocutory remedy is intended to preserve in status quo, the rights of parties which may appear on a prima facie case. *The court also, in restraining a defendant from exercising what he considers his legal right but what the plaintiff would like to be prevented, puts into the scales, as a relevant consideration whether the defendant has yet to commence his enterprise or whether he has already been doing so in which latter case considerations somewhat different from those that apply to a case where the defendant is yet to commence his enterprise, are attracted.*”

(Emphasis supplied)



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16.5 The respondent has not placed, on record, any material on the basis of which we could arrive even at a *prima facie* opinion that the use of the mark GULSHAN-E-KARIM by the appellant was with intent to copy the respondent's KARIM mark, or to capitalize on its goodwill. The mark, admittedly, was used only for restaurant in Moradabad. "Gulshan-e-Karim" is an expression which has a definite meaning in Urdu, which is "garden of God". The respondent does not dispute this fact. Though not directly laudatory of food items, and, therefore, capable of being characterized as "descriptive" of the appellant's services, or the food that the appellant's restaurant provides, the mark is clearly suggestively laudatory in nature, and apparently used to attract consumers who would believe the nature of the cuisine in the appellant's restaurant to be of a high quality. We, therefore, find no reason to disbelieve the appellant's assertion that the use of the mark GULSHAN-E-KARIM, for its restaurant, was not by way of deliberate infringement, but innocent in nature.

16.6 The appellant's restaurant is located in Moradabad. Even as per the respondent's own assertion, it came to learn of the appellant only in 2022, though the restaurant has been functioning since 2016. Even if the appellant has been advertising or promoting his restaurant over the internet or on social media platforms, that is his constitutional right.

16.7 In these circumstances, it appears disproportionate, to us, to completely injunct the appellant from using the GULSHAN-E-KARIM mark for his restaurant. It is a matter of common knowledge



that, in smaller towns or cities, such marks acquire a local reputation. A change in the name of the restaurant altogether may, therefore, seriously affect the appellant's business. Hypothetically, it may even persuade the appellant's clientele to believe that the management of the appellant has changed. The effects of the appellant having to continue to run his restaurant under a different name, 9 years after the restaurant has been running, are imponderable.

16.8 Of course, these ruminations are speculative to an extent. We merely venture these thoughts to fortify our conclusion that the interests of justice and equity, and the principles of balance of convenience and irreparable loss, may not justify subjecting the appellant to an injunction as extreme as that granted by the learned Commercial Court.

16.9 The apprehension of the respondent is that consumers may mistake the appellant's outlet for the respondent's. We feel, in the circumstances, that this grievance may be assuaged, and the interests of all protected, by requiring the appellant to enter a disclaimer, in bold letters and using the same lettering as is used for the mark GULSHAN-E-KARIM, which must be conspicuous, immediately below the GULSHAN-E-KARIM mark, to the effect that it has no association or relation with the respondent's KARIM outlet. In the disclaimer, the name of the respondent's outlet would be reflected using the respondent's distinctive  logo. Additionally, the disclaimer should also refer to the locations of the respondent's outlets. The disclaimer should read thus:



“This outlet is independent and has no connection with the  group of restaurants. Our outlets are located at _____. We have no other outlet or franchise.”

The disclaimer must be entered in English and in Hindi, one below the other, as the consumers of the appellant may largely consist of local populace, who may not be familiar with English. Additionally, a similar disclaimer must be entered on all online sites where the appellant advertises its outlet. The disclaimer would also be entered on all physical signages or advertisements of the appellant’s restaurant.

Conclusion

17. We, therefore, modify the impugned order of the learned Commercial Court to the extent noted in para 16.9 *supra*. It is, however, clarified that failure to enter the disclaimer, as required by the said paragraph, on all physical and virtual sites where the appellant’s restaurant or catering services are advertised or marketed, within six weeks from today, would result in dismissal of the present appeal, and revival of the directions issued by the learned Commercial Court.

18. The appeal stands allowed to the above limited extent, with no orders as to costs.

C. HARI SHANKAR, J.

AJAY DIGPAUL, J.

NOVEMBER 6, 2025

DSN/AR

Signature Not Verified

Digitally Signed By: AJIT
KUMAR
Signing Date: 06.11.2025
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