



2025:DHC:10443-DB



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

Reserved on: 29 July 2025

Pronounced on: 26 November 2025

+ **FAO (COMM) 175/2025 & CM APPL. 41218/2025**

SAURABH GUPTAAppellant
Through: Mr. Manav Kumar Adv., Manoj
Kumar Sahu Adv. with Appellant Saurabh
Gupta, Advs.

versus

SHEOPALS PVT LTDRespondent
Through: Mr. C.M. Lall, Senior Advocate
with Mr. S.S. Rana, Ms. Rima Majumdar,
Mr. Kashish Vij, Ms. Aashi Nema, Ms.
Annanya Mehan, Advs.

+ **FAO (COMM) 187/2025, CM APPL. 43596/2025 & CM
APPL. 43597/2025**

SHEOPALS PVT. LTD.Appellant
Through: Mr. C.M. Lall, Senior Advocate
with Mr. S.S. Rana, Ms. Rima Majumdar,
Mr. Kashish Vij, Ms. Aashi Nema, Ms.
Annanya Mehan, Advs.

versus

SAURABH GUPTARespondent
Through: Mr. Manav Kumar Adv., Manoj
Kumar Sahu Adv. with Appellant Saurabh
Gupta, Advs.

CORAM:
HON'BLE MR. JUSTICE C. HARI SHANKAR
HON'BLE MR. JUSTICE OM PRAKASH SHUKLA

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Page 1 of 34



2025:DHC:10443-DB



JUDGMENT
26.11.2025

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C. HARI SHANKAR, J.

The *lis*

1. These are cross appeals. They challenge order dated 22 April 2025, passed by the learned District Judge (Commercial Court-05), Saket¹ in CS (Comm) 3590/2024². By the said order, the learned Commercial Court has allowed an application filed by Sheopals Pvt. Ltd.³ under Order XXXIX Rule 4 of the Code of Civil Procedure, 1908⁴ and, has thereby dismissed the application filed by Saurabh Gupta⁵ under Order XXXIX Rules 1 and 2 of the CPC.

2. Saurabh's application under Order XXXIX Rules 1 and 2 had earlier been allowed, and SPL's application under Order XXXIX Rule 4 dismissed by the learned Commercial Court, *vide* order dated 7 September 2024. SPL challenged the order before this Court by means of FAO (Comm) 216/2024⁶. By judgment dated 20 November 2024, a coordinate Division Bench of this Court allowed the said FAO, set aside the order dated 7 September 2024 of the learned Commercial Court and remanded SPL's application under Order XXXIX Rule 4 of the CPC to the learned Commercial Court for consideration afresh. The coordinate Bench found the reasoning of the learned Commercial Court, which was predicted on bisection of

¹ "learned Commercial Court", hereinafter

² **Saurabh Gupta v Sheopals Pvt. Ltd.**

³ "SPL", hereinafter

⁴ "CPC" hereinafter

⁵ "Saurabh", hereinafter

⁶ **Sheopals Pvt. Ltd. v Saurabh Gupta**



the mark SHEOPAL'S into SHE and OPAL as violative of the anti-dissection rule applicable in such cases. The Coordinate Bench further noted that the learned Commercial Court had itself observed that the marks OPAL and SHEOPAL'S were not phonetically similar. If the marks were not phonetically similar, the learned Commercial Court, according to the Division Bench, could not have arrived at a finding of likelihood of confusion.

3. The application of SPL under Order XXXIX Rule 4 of the CPC was, therefore, remanded for fresh consideration and decision keeping in mind the observations of this Court. While doing so, the coordinate Bench clarified that its observations were merely for disposal of the appeal before it. We, therefore, do not feel inhibited by the said observations, as we are somewhat at variance therewith.

4. The presently impugned order dated 22 April 2025 is the culmination of the *de novo* consideration by the learned Commercial Court, in compliance with the order dated 20 November 2024 passed by the Division Bench of this Court in FAO (Comm) 216/2024.

Rival contentions raised before the learned Commercial Court

5. Contentions of Saurabh

5.1 CS (Comm) 3590/2024 stands instituted by Saurabh against SPL, alleging that SPL has, by using the mark "SHEOPAL'S", infringed the trademark "OPAL" which stands registered in favour of Saurabh Gupta in Class 3 with effect from 1992 for "gels, bathing



2025:DHC:10443-DB



soaps, foundation cakes etc.”, under Section 23 of the Trade Marks Act, 1999. Saurabh asserted, in the suit, that he had, since 1992, been continuously using the mark OPAL for the goods in respect of which it stands registered and that, by dint of continuous use, the mark OPAL had gained considerable goodwill and reputation. To support this assertion, Saurabh filed, with the suit, proof of his annual turnover, which increased from ₹ 93,60,686/- in 2006-07 to ₹ 28,50,74,632.18 in 2023-24.

5.2 Saurabh further pointed out, in the suit, that SPL was incorporated only on 17 June 2016, much after Saurabh had commenced use of the mark OPAL for various cosmetics items. SPL applied under the Trade Marks Act for registration of the mark SHEOPAL’S in Class 3 on 23 November 2018 and 28 October 2022. Both applications stood opposed by Saurabh. Despite this, the suit asserted that Saurabh had come to learn, in February 2024, that SPL had launched cosmetics products bearing the mark SHEOPAL’S in the market.

5.3 In these circumstances, Saurabh instituted the suit against SPL, alleging that the use of the mark SHEOPAL’S by SPL for items which were similar to those being manufactured and sold by Saurabh under the registered trademark OPAL, resulted in consumer deception and likelihood of confusion in the market. This, it was submitted, amounted to infringement of Saurabh’s registered OPAL trademark,



2025:DHC:10443-DB



within the meaning of Section 29(2)(b)⁷ of the Trade Marks Act, as well as an attempt to pass off SPL's goods as those of Saurabh's.

5.4 Predicated on these allegations and assertions, Saurabh, in the suit, sought a decree of permanent injunction, restraining SPL from using the mark SHEOPAL'S or any other mark which was deceptively similar to Saurabh's registered OPAL trademark for cosmetics or any other similar goods.

6. Contentions of SPL

6.1 Contesting the suit, SPL contended, before the learned Commercial Court, that it had adopted the mark SHEOPAL'S in 2016 for Ayurvedic, herbal, beauty, health and wellness products and had been continuously using the mark since then. The mark SHEOPAL'S, it was submitted, was derived from the name of Sheopal Meena the late father of one of the founding members of SPL, who was, at the time of the institution of the suit, its Chief Operating Officer. It was also pointed out that the mark SHEOPAL'S was registered in favour of SPL under Section 23 of the Act, under Class 5 with effect from 23 November 2018 for "pharmaceutical preparations, pharmaceutical drugs, protein supplement, protein powder dietary supplement, protein supplement shakes, medicines for human purposes, health food supplements made principally of vitamins, health food supplements

⁷ (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;



made principally of minerals, medicinal health care preparations, vitamin preparations, medicines for veterinary purposes, medicinal tea, medicinal oils, glucose for medical purposes and glucose dietary supplements”.

6.2 SPL further contended that the mark OPAL was common to the trade and that, even otherwise, the word “opal” was the name of a semi-precious stone and, therefore, a generic expression lacking in distinctiveness, over which no monopoly could be asserted by anyone. It was pointed out that the word OPAL was not coined by Saurabh. SPL further contended that there was no similarity, deceptive or otherwise, between the marks OPAL and SHEOPAL’S. As such, as there was no likelihood of confusion, the suit was completely bereft of merit.

The impugned order

7. The learned Commercial Court has, after reproducing the respective submissions of both sides before it, proceeded to reason and hold as under:

- (i) The anti dissection rule was subject to the dominant mark test, as held by the Division Bench of this Court in ***South India Beverages v General Mills Marketing***⁸. The dominant mark test provided that, if part of the plaintiff’s mark was dominant and that part had been copied by the defendant in its mark, the

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

⁸ (2015) 61 PTC 231 (Del)



2025:DHC:10443-DB



Court could rely upon that fact to hold that the two marks, compared as wholes, were deceptively similar to each other and that, therefore, there was likelihood of confusion. Saurabh's registered trademark was OPAL. The dominant part of the SPL's registered trademark SHEOPAL'S was also OPAL. As such, the dominant part of both the marks was the same, i.e., OPAL, thereby resulting in likelihood of confusion even when the two marks were compared in their entirety.

(ii) If both the marks were kept side by side, it was also clear that they were phonetically similar. This, again, was a factor which could result in confusion.

(iii) SPL's contention that the mark SHEOPAL'S was derived from the name of its founder's late father Sheopal Meena was unacceptable, as "nobody can claim the copyright only on the basis of the fact that it has been derived from the name of the family member because the case is to be considered from all the aspects and not only on the basis of name only."

(iv) The plea of SPL that the word OPAL was generic and common to the trade was also unacceptable, as the trademark OPAL stood registered in favour of Saurabh under Class 3 for cosmetics goods, gels, bathing shops etc. and was in use by Saurabh since 1992, for the said goods and for shampoos, face packs etc. since 2015. By 2023-24, the sales turnover of Saurabh was in the region of ₹ 28.5 crores. Even though, therefore, "opal" was a common word, as Saurabh had been



2025:DHC:10443-DB



running his business since long, he could claim a right over the said word as a registered trade mark.

(v) The suit was, however, grossly belated. It was filed only on 13 August 2024. Saurabh had opposed the applications of SPL dated 23 November 2018 and 28 October 2022 for registration of the trademark SHEOPAL'S in Class 3. Calculated from the date of the first application filed by SPL for registration of the mark SHEOPAL'S, the suit had been filed after six years. The submission of Saurabh that he did not come to know of the fact of use by SPL, of the mark SHEOPAL'S, for six years, was not believable.

(vi) Such unexplained and unjustified delay was sufficient to decline injunction. For this purpose, the learned Commercial Court places reliance on the judgment of the Supreme Court in *Power Control Appliances v Sumeet Machines (P) Ltd*⁹ and of this Court in *Intex Technologies Limited v AZ Tech (India)*¹⁰.

(vii) Besides, SPL had incurred considerable expenditure towards promotional marketing of its products, and its turnover had increased year to year. Rejection of SPL's application under Order XXXIX Rule 4 of the CPC would, therefore, result in irreparable loss to SPL.

⁹ (1994) 2 SCC 448

¹⁰ 2017 SCC Online Del 7392



2025:DHC:10443-DB



8. On this basis, the learned Commercial Court has proceeded to allow SPL's application under Order XXXIX Rule 4 of the CPC and reject Saurabh's application under Order XXXIX Rules 1 and 2. Resultantly, the *ex parte ad interim* order dated 14 August 2024 stands vacated.

9. Saurabh and SPL have both challenged the impugned order. Saurabh seeks setting aside of the impugned order dated 22 April 2025 and restoration of the *ex parte ad interim* order dated 14 August 2024. SPL seeks setting aside of the adverse findings returned against it on merits, by the learned Commercial Court, in paras 8 to 11.

10. We have heard Mr. Manav Kumar, learned Counsel for Saurabh Gupta and Mr. Chander M. Lall, learned Senior Counsel for the SPL, at length.

11. Learned Counsel have basically re-addressed, before us, the arguments advanced before the learned Commercial Court.

Analysis

12. It would be best to deal with the impugned order, finding by finding, as we find, without meaning any disrespect to the learned Commercial Court, that it is in error in most of the findings returned in the impugned order. As it would become apparent from the discussion hereinafter, the ultimate conclusion at which we would arrive is the same as that arrived at by the learned Commercial Court i.e. that SPL's application under Order XXXIX Rules 4 of the CPC deserves



to be allowed and Saurabh cannot be treated as entitled to an injunction against SPL, travelling, however, along a different pathway.

13. Re. findings with respect to anti-dissection principle, application of the dominant part test and findings returned in that regard

13.1 As we have already noted, the learned Commercial Court has held that

- (i) the principle of anti-dissection is subject to the dominant part¹¹ test,
- (ii) OPAL constitutes the dominant part of the mark SHEOPAL'S and
- (iii) as the dominant part of SPL's SHEOPAL'S mark thus replicated Saurabh's registered trademark OPAL, the marks, when seen as whole marks, were deceptively similar.

13.2 We are of the considered opinion that the learned Commercial Court has erred both in its understanding as well as application both of the anti-dissection principle as well as of the dominant part test. However, the final conclusion of the learned Commercial Court, that there is no deceptive similarity between the marks OPAL and SHEOPAL'S, is, to our mind, correct.

13.3 The anti-dissection rule and the dominant part principle – Neither applicable in the facts of the present case

¹¹ At times wrongly referred to as the “dominant mark” test, as the test refers to the dominant part of a mark, and not to one of two or more marks being dominant.



13.3.1 The anti-dissection principle is contained in Section 17(2)(a)¹² of the Trade Marks Act. Section 17(1) confers, on the proprietor of a registered trademark, exclusive right to use that trademark *as a whole*. Section 17(2) starts with a non-obstante clause, i.e. “notwithstanding anything contained in sub-section (1)”. Ergo, the right under Section 17(1) is conditioned by, and subject to, Section 17(2).

13.3.2 Section 17(2)(a) prohibits the proprietor of a registered trademark from claiming exclusivity over part of such trademark, where that part is not separately registered as a trademark and no application, for registration of that part of the mark, is pending. The clause applies, therefore, to a trade mark which contains “parts” and which is, therefore, to use the commonly employed phrase, a “composite mark”.

13.3.3 It is important to note that Section 17(2)(a) proscribes claiming of an exclusive right in part of the whole registered trademark which is not separately registered as a trademark or in respect of which no application for registration is pending. Claiming of exclusivity, in an infringement proceeding, is the privilege of the plaintiff. *The very reference, in Section 17(2)(a), to claiming of an exclusive right, and the engrafting of a proscription thereto, indicates that Section 17(2)(a) applies to the plaintiff and not to the defendant.* In other

¹² (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.



words, if the plaintiff is the registered proprietor of a composite mark, the plaintiff cannot claim any exclusive right over any *part* of that mark, unless that part is separately registered, or an application for such registration is pending. This is the principle of anti-dissection and, by its very nature, it applies only to the mark of the plaintiff.

13.3.4 The first error committed by the learned Commercial Court, in applying the principle of anti-dissection is, therefore, in its applying the said principle to the mark SHEOPAL'S, which is the mark of the defendant i.e. SPL.

13.3.5 In fact, in the present case, there was no occasion to apply the anti-dissection principle at all, as Saurabh's mark was OPAL, which is ordinarily not capable of being divided into parts, and Saurabh was, in any case, claiming exclusivity over the whole mark OPAL and not over any particular part thereof. *Ex hypothesi*, were Saurabh to have claimed exclusivity over "PAL", then it would have been possible to invoke the anti-dissection principle in Section 17(2)(a) as PAL is a part of Saurabh's registered trademark OPAL, and is not separately registered in his favour under the Trade Marks Act. However, as Saurabh was claiming exclusivity in respect of the entire mark OPAL, the principle of anti-dissection, contained in Section 17(2)(a), was not applicable at all to the facts of the present case.

13.3.6 As the anti-dissection principle was not applicable, equally inapplicable, in the facts of the present case, would be the dominant part principle. The dominant part test, which was expounded by the Division Bench of this Court in *South India Beverages* and which



stands reiterated, recently, by the Supreme Court in its judgment in ***Pernod Ricard India (P) Ltd v Karanveer Singh Chhabra***¹³, was intended to be explanatory of the anti-dissection rule in the case of composite marks, of which a part was dominant. Even in a situation in which the mark of the plaintiff was a composite mark, capable of being divided into parts, if any one part of that mark was dominant, the replication of that dominant part in the defendant's mark could be held, by the Court, to result in confusion when the two marks were compared in their entirety. This is because the human mind, particularly the perception of a consumer of average intelligence and imperfect recollection, tends to absorb and remember the dominant part of a mark, where a mark contains any such dominant part. Where, therefore, such a dominant part exists in the plaintiff's mark, the average consumer would immediately recollect the plaintiff's mark on the basis of that dominant part and if the same dominant part were to be contained in the defendant's mark, there would be a likelihood of confusion when the two marks were compared as wholes.

13.3.7 The dominant part test is, therefore, merely explanatory of the anti-dissection rule and the principle of likelihood of confusion, in a situation in which part of the plaintiff's mark is dominant and that dominant part is replicated in the defendant's mark. The Division Bench has, therefore, in ***South India Beverages***, clarified that there is no conflict between the anti-dissection rule and the dominant part test.



13.3.8 In the present case, however, as we may again reiterate, there was no claim of exclusivity, by Saurabh, over part of its mark. The registered trademark of Saurabh was OPAL, and Saurabh claims exclusivity over the whole mark OPAL. There was no occasion, therefore, to apply either the anti-dissection rule contained in Section 17(2)(a) or the dominant part test.

13.3.9 The learned Commercial Court was, therefore, required to compare the marks OPAL and SHEOPAL'S as whole marks, without meandering into the labyrinth of the anti-dissection rule and the dominant part test.

13.4 Comparison of the rival marks as wholes

13.4.1 When we compare the marks OPAL and SHEOPAL'S, we are unable to convince ourselves that there is any likelihood of confusion between them. The mere fact that OPAL happens to be a part of SHEOPAL'S is insufficient, to our mind, to cause confusion in the mind of the consumer. Even a consumer of average intelligence and imperfect recollection, who sees the whole mark SHEOPAL'S, would be unlikely to break up that mark into SHE and OPAL'S and, after thus breaking up the mark, get confused because he has earlier seen the mark OPAL.

13.4.2 "Sheopal", undisputedly, was the name of the father of the founder of the respondent. It is, therefore, an ordinary name used in Indian society, and is, in fact, a somewhat modernized version of the traditional name "Shivpal". No consumer of average intelligence, in



2025:DHC:10443-DB



this country at least, would be likely, therefore, to recollect the mark “SHEOPAL’S” as “She + Opal’s”. He would either recollect the name as “SHEOPAL’S”, or not recollect it at all.

13.5 Had, for example, SPL’s mark been, on the other hand, BLUE OPAL, or NEW OPAL, the situation would have been decidedly different.

13.6 We, therefore, are unable to sustain the finding of the learned Commercial Court that, because of OPAL forming part of the SPL’s mark, there was a likelihood of confusion between SHEOPAL’S and OPAL.

14. Re. Finding that, when viewed side by side, the rival marks are phonetically similar

14.1 The learned Commercial Court has held that Saurabh’s mark OPAL and SPL’s mark SHEOPAL’S, when placed side by side, are phonetically similar.

14.2 In the first place, trademark infringement is not to be examined by placing the marks side by side. The test to be applied is whether a consumer of average intelligence and imperfect recollection, who has seen or come across the plaintiff’s mark at one point of time and, later, comes across the defendant’s mark, is likely to be confused between them or to believe the existence of an association between the two, owing to the similarity of the marks and the similarity of the goods or services in respect of which the marks are used. This is classically



exposed close to a century ago, by the Privy Council in *Coca-Cola Co. of Canada Ltd v Pepsi-Cola Co. of Canada Ltd*¹⁴, thus:

“In these circumstances, the question for determination must be answered by the Court, unaided by outside evidence, after a comparison of the Defendant's mark as used with the Plaintiff's registered mark, not placing them side by side, but by asking itself whether, having due regard to relevant surrounding circumstances, the Defendant's mark as used is similar (as defined by the Act) to the Plaintiff's registered mark as it would be remembered by persons possessed of an average memory with its usual imperfections.”

This passage stands quoted, with approval, by the Supreme Court, as recently as in *Pernod Ricard*.

14.3 By testing the similarity of the rival marks by placing them side by side, therefore, the learned Commercial Court has fundamentally erred in law.

14.4 While testing similarity of the marks phonetically, the Court is to bear in mind the test elucidated by Parker J. in *In the Matter of an Application by the Pianotist Company Ltd for the Registration of a Trade Mark*¹⁵, which has been consistently followed by courts in this country while dealing with the aspect of similarity in respect of the trademark infringement. Adverting to the said test in its recent pronouncement in *Pernod Ricard*, the Supreme Court held thus:

“35.5. The foundational test for assessing deceptive similarity remains the *Pianotist Test*, as laid down in *Pianotist Co. Ltd's Application* by Justice Parker. Indian courts continue to apply this holistic standard, which requires consideration of the visual and phonetic similarity of the marks, the nature of the goods, the class

¹⁴ AIR 1942 PC 40

¹⁵ (1906) 23 RPC 774, often abbreviated to “*In re. Pianotist*”



of consumers, and all surrounding circumstances. Justice Parker framed the test as follows:

“You must take the two words. You must judge of them, both by their look and by their sound. You must consider the goods to which they are applied, the nature and kind of customer who would be likely to buy the goods, and all the surrounding circumstances. You must further consider what is likely to happen if each of these trademarks is used in a normal way for the respective goods. If, considering all these circumstances, you come to the conclusion that there will be confusion - not necessarily that one trader will be passed off as another - but that there will be confusion in the mind of the public leading to confusion in the goods, then registration must be refused.”

35.6. *This multifactorial framework complements the modern average consumer test, ensuring that the analysis of deceptive similarity remains practical and context-sensitive. It focuses on the overall commercial impression left by the marks, rather than conducting a mechanical or analytical breakdown. Indian courts have consistently adopted this approach in determining the likelihood of confusion in both infringement and passing off actions.”*

(Emphasis supplied)

14.5 What is needed in such cases is, therefore, adherence to a “multifactorial framework”, resulting in a “practical and context-sensitive” comparison of the rival marks, while examining the aspect of deceptive similarity. No one factor, such as visual or phonetic similarity between the marks, can usually be determinative in such cases, unless, to the mind of the consumer blessed with average intelligence and imperfect recollection, that one factor would be so predominant, in his psyche, as to result in confusion, overshadowing all other factors. Infringement assessment being dependent on psychoanalysis of a mythical consumer of average intelligence and imperfect recollection, the Court has to tread carefully.



2025:DHC:10443-DB



14.6 When assessing the existence, or otherwise, of phonetic similarity between rival trademarks in an infringement action, the Court must be conscious of the fact that it is dealing with the question of whether, because of that similarity, there is a likelihood of confusion between the marks or a likelihood of a presumption of association between the marks, in the mind of a consumer of average intelligence and imperfect recollection. It is for this reason that, in *Pianotist*, Parker J. has held that, when examining the aspect of similarity between rival trademarks in an infringement action, the Court must judge the marks both by their look and sound, and, while doing so, consider

- (i) the goods to which they are to be applied,
- (ii) the nature and kind of consumer who would be likely to buy those goods,
- (iii) all surrounding circumstances, and
- (iv) what is likely to happen if each of those trademarks is used in a normal way as a trademark for the goods of the respective owners of the marks.

All these factors are, therefore, to be kept in mind by the Court while examining the aspect of similarity between two marks in the case of an infringement action. The Court cannot blindly come to the conclusion that merely because two marks sound the same or because they are phonetically similar, there is *ipso facto* a likelihood of confusion. The nature of the consumer dealing with the marks, the nature of the goods to which the marks pertain, all surrounding circumstances and, in particular, the likely effect of use of the rival marks in a normal way as trademarks for their respective goods, has to



2025:DHC:10443-DB



be assessed. It is in this backdrop that the Court has to come to a conclusion as to whether, if there is phonetic similarity between the marks, that phonetic similarity is likely to result in confusion in the minds of the public.

14.7 Expressed otherwise, the mere existence of phonetic similarity does not *ipso facto* result in likelihood of confusion. Even if the Court comes to a finding that there is phonetic similarity between the marks, the Court has to independently assess whether the mere existence of that phonetic similarity is likely to result in confusion in the mind of the consumer of average intelligence and imperfect recollection who comes across those marks when used for their respective goods in the course of trade in the market.

14.8 Viewed thus, keeping all circumstances in mind, though there is some degree of phonetic similarity between OPAL and SHEOPAL'S, keeping in mind the fact that SHEOPAL'S is a name which the average consumer is unlikely to read, or remember, by breaking it up into SHE and OPAL'S, we are of the considered opinion that there is little likelihood, if at all, of an average consumer getting confused into mistaking SPL's SHEOPAL'S products with Saurabh's OPAL merchandise.

14.9 We, therefore, are unable to agree with the learned Commercial Court in its finding that, owing to phonetic similarity between the marks OPAL and SHEOPAL'S, when placed side by side, there is likelihood of confusion in the minds of the average consumer.



15. Re. argument that OPAL is a generic word and, therefore, incapable of monopolization

15.1 Before the learned Commercial Court, SPL argued that OPAL was a generic word, used to describe a semi precious stone and could not, therefore, be monopolized by anyone and that no exclusivity could be claimed in respect thereof.

15.2 The learned Commercial Court has agreed with the submission of the SPL that OPAL is a common word. However, the plea of SPL has been rejected on the ground that Saurabh has been running his business since long, with a turnover, as in 2023-24, of over ₹ 28.5 crores.

15.3 Again, we are of the opinion that the learned Commercial Court has erred on both counts. Specifically,

- (i) OPAL cannot be said to be a generic word incapable of monopolization in the facts of this case, and
- (ii) if OPAL were in fact a generic word incapable of monopolization, the turnover of the plaintiff Saurabh Gupta could not constitute a basis to allow him exclusivity over the word when used as a trademark.

15.4 So far as the aspect of whether OPAL is a generic word and, therefore, whether any exclusivity could be claimed in respect thereof, one has to refer to Section 17(2)(b)¹⁶ of the Trade Marks Act. Section

¹⁶ 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—



17(2)(b) proscribes any claim of exclusivity over a mark or a part of a mark which is common to the trade or is otherwise of a non-distinctive character.

15.5 To understand the expression “of a non-distinctive character”, as employed in Section 17(2)(b), one has to juxtapose that provision with Section 9(1)(a)¹⁷ of the Trade Marks Act. Section 9(1)(a) also refers to lack of distinctive character in a mark. The clause prohibits registration of a trademark which is devoid of any distinctive character and goes on to explain the expression by stating that a mark would be treated as devoid of a distinctive character if it is “not capable of distinguishing goods or services of one person from those of another person”.

15.6 Of course, the proviso to Section 9(1)(a) accepts the applicability of the proscription in a case where the mark has acquired distinctive character before registration or is a well-known mark within the meaning of Section 2(1)(zg)¹⁸ of the Trade Marks Act. That, however, is not an aspect which concerns us in this case.

(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.

17 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;

shall not be registered:

Provided that a trade mark shall not be refused registration if before the date of application for registration it has acquired a distinctive character as a result of the use made of it or is a well-known trade mark.

¹⁸ (zg) “well-known trade mark”, in relation to any goods or services, means a mark which has become so to the substantial segment of the public which uses such goods or receives such services that the use of such mark in relation to other goods or services would be likely to be taken as indicating a connection in the course of trade or rendering of services between those goods or services and a person during the mark in relation to the first-mentioned goods or services.



2025:DHC:10443-DB



15.7 Returning to our juxtaposition of Section 17(2)(b), *vis-à-vis* Section 9(1)(a) of the Trade Marks Act, a mark is said to be lacking indistinctive character when it is incapable of distinguishing the goods or services in respect of which it is used, from the goods or services of another person.

15.8 Thus, the aspect of whether a mark is distinctive or non-distinctive cannot be assessed merely referring to the mark *in vacuo*. The distinctive nature, or otherwise, of the mark, has to be assessed by examining its use in the context of the goods or services for which it is registered and is being used. Every common word, therefore, is not *ipso facto* lacking in distinctive character. The question of whether it possesses, or does not possess, distinctive character, can be decided only when the use of that word is considered in the light of the goods or services in respect of which it is used. A word which is otherwise perfectly common may become distinctive when used for goods or services with which it has no connection at all. *Use of a “common” word as a trade mark is not proscribed by the Trade Marks Act. What is proscribed is use of a mark which is lacking in distinctiveness. If, therefore, the use of an otherwise common word, as a trade mark for goods or services, is such as would distinguish those goods or services from goods or services of others, it becomes ipso facto distinctive.* This would frequently be the case where the mark, though otherwise a common word, has nothing to do with the goods or services for which it is used, so that its use in respect of those goods or services is in a sense unique and distinct, thereby sufficing to distinguish those or goods or services from goods



2025:DHC:10443-DB



or services of others. “AND”, for example, we are told, and find from online study, is a niche brand of perfumery.

15.9 The present case is yet another classic case in point. OPAL, no doubt, is a common word which refers to a semi-precious stone. However, semi precious stones have nothing to do with cosmetics, in respect of which the mark OPAL is registered in favour of Saurabh, and for which it is used. When used for cosmetics, therefore, the mark OPAL is certainly distinctive, as there is no connection otherwise between the semi-precious stone opal and cosmetics. The lack of any connection between opals and cosmetics by itself renders the use of the mark OPAL, for cosmetics, distinctive.

15.10 The learned Commercial Court is, therefore, clearly in error in holding that the mark OPAL lacks distinctive character as it is a word of common English usage.

15.11 Though this contention of SPL, though recorded in the impugned order, has not been approved by the learned Commercial Court, we may also observe, here, that there is no requirement, in the Trade Marks Act, of the mark having to be “original” or “inventive” or “coined” by the proprietor of the mark. Originality and inventiveness are requirements which pertain to the realms of designs and patents, not trade marks.

15.12 Though, with this finding of ours, it is not necessary to refer to the connected observations of the learned Single Judge with respect to the turnover of Saurabh, we may observe, for the sake of setting the



2025:DHC:10443-DB



legal position clear, that if, in fact, OPAL was a mark lacking in distinctiveness when used in respect of cosmetics, Saurabh could not have claimed exclusivity over the mark merely because of his turnover. The turnover of the plaintiff, and the aspect of whether the mark asserted by the plaintiff is, or is not, distinctive, are aspects which have no connection with each other. No exclusivity can be claimed in respect of a mark which is not distinctive. The turnover of the plaintiff cannot override the proscription contained in Section 17(2)(b) and enable the plaintiff to claim exclusivity over a non-distinctive trademark.

15.13 That said, however, in the present case, we are of the view that the mark OPAL, as used for cosmetic items, is certainly distinctive and, therefore, that the learned Commercial Court has erred in holding otherwise.

16. Section 31(1)¹⁹ of the Trade Marks Act

16.1 In this context, we may also advert to Section 31(1) of the Trade Marks Act, which we find to be often overlooked in orders passed by Commercial Courts in such cases.

16.2 Section 31(1) is a provision which is of prime significance while dealing with applications under Order XXXIX Rules 1 and 2 of the CPC. At the stage of an interim application under Order XXXIX,

¹⁹ 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.



a plaintiff is only required to set up a *prima facie* case, coupled, of course, with balance of convenience and irreparable loss. Section 28(1)²⁰ of the Trade Marks Act entitles every proprietor of a registered trademark, if the registration is valid, both to exclusive use of the mark in respect of the goods or services for which it is registered, as well as to relief against infringement, where infringement, within the meaning of Section 29, is found to exist. The reliefs available, in a case of infringement, as per Section 135(1)²¹, include injunction. Undoubtedly, one of the preconditions for the right to exclusivity, as well as to relief against infringement, to be available to the proprietor of a registered trademark, is that the registration is valid.

16.3 At the Order XXXIX stage, however, the plaintiff is only required to set up a *prima facie* case. As such, the plaintiff is only, qua the aspect of validity of the registered trademark, required to adduce *prima facie* evidence of validity. That requirement is statutorily satisfied by Section 31(1), which holds that the very registration of a trademark would operate as evidence of *prima facie* evidence of validity of the mark. Thus, the onus to establish, *prima facie*, that the registration of the trademark of the plaintiff is valid, stands discharged by Section 31(1).

²⁰ **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.

²¹ **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.



16.4 While, in an extreme case, it may be possible for the Court to hold that the registration of a mark is *prima facie* invalid – as in a recent matter, in ***Quantum Hi-Tech Merchandising Pvt Ltd v L.G. Electronics India Pvt Ltd***²², which came before this Bench, in which registration was sought of one mark and granted of another – in normal cases, the Court would accept the very registration of the plaintiff's trademark as satisfying the requirement of *prima facie* validity of the mark.

16.5 The corollary would be, therefore, that the registration of the mark would *prima facie* be treated as overcoming the objections to registrability as contained in Sections 9 and 11 of the Trade Marks Act.

16.6 Applying this principle to the present case, the very fact that Saurabh's trademark OPAL stands registered in Class 3 for cosmetics, etc., would be treated as satisfying the requirement of *prima facie* validity of the mark for the purposes of entitling Saurabh to relief against infringement under Section 28(1) of the Trade Marks Act.

17. Re. Delay in bringing the action and the finding of acquiescence

17.1 Having thus held in favour of Saurabh on merits, the learned Commercial Court has, nonetheless, proceeded to dismiss Saurabh's application under Order XXXIX Rules 1 and 2 of the CPC and allow SPL's application under Order XXXIX Rule 4 on two considerations. The first is that the suit was belated and the second is that SPL had



expended a considerable amount on promotion and marketing of its products.

17.2 On the aspect of delay, the learned Commercial Court holds that, as he had opposed SPL's applications for registration of the trademark SHEOPAL'S in Class 3 in 2018 and 2022, there was a delay of six years, in institution of the suit by Saurabh, from the date of the first application moved by SPL for registration of its mark.

17.3 In the first place, we find it difficult to understand how the learned Commercial Court has computed the delay from the date *of application by SPL* for registration of the mark SHEOPAL'S. There is no justification for such a computation. The application by SPL for registration of the mark SHEOPAL'S cannot connote knowledge on the part of Saurabh of such an application having been filed. At the earliest, therefore, the aspect of delay could have been computed from the date when Saurabh filed his opposition to SPL's first application for registration of trademark SHEOPAL'S. The learned Commercial Court has, therefore, clearly erred in holding that the suit was belated as six years had elapsed between the date of application by SPL for registration of the mark SHEOPAL'S and the date of filing of the suit. These two dates refer to two events which are unconnected with each other.

17.4 Even if, however, one were to presume that some time had elapsed between the filing of opposition, by Saurabh, to SPL's application dated 23 November 2018, and the institution of the suit, Saurabh's claim for relief against infringement cannot be rejected on



that ground. This position of law stands settled by the judgment of the Supreme Court in *Midas Hygiene Industries (P) Ltd v Sudhir Bhatia*²³, thus:

“5. The law on the subject is well settled. In cases of infringement either of trade mark or of copyright, normally an injunction must follow. Mere delay in bringing action is not sufficient to defeat grant of injunction in such cases. The grant of injunction also becomes necessary if it prima facie appears that the adoption of the mark was itself dishonest.”

Thus, the Supreme Court has held that, where infringement is found to exist, injunction must follow and that delay in bringing the action is no ground to reject the prayer for injunction.

17.5 The learned Commercial Court has, in this context, relied on the judgment of the Supreme Court in *Power Control Appliances* and of this Court in *Intex Technologies*. These decisions deal with the principles of acquiescence, and not merely the principle of delay. *Power Control Appliances* holds that mere inaction does not connote acquiescence but that, if the plaintiff has sat back and consciously allowed the defendant to continue to use the allegedly infringing mark for a long period of time, thereby generating goodwill and reputation, he cannot, thereafter, seek to injunct such use.

17.6 Thus, mere inaction does not amount to acquiescence. Acquiescence implies positive conduct on the part of one party, sitting back and allowing the other to continue the injurious act and, thereby, build up a reputation. In the ultimate analysis, the question of whether the plaintiff, in fact, sat back and allowed the defendant to continue



2025:DHC:10443-DB



his business, using the infringing mark, over an extended period of time and thereby build up his goodwill and reputation, would be a question of fact, which might necessitate a trial.

17.7 Harmonising the decisions in *Midas Hygiene* and *Power Control Appliances*, the position that emerges is that, wherever a *prima facie* case of infringement is made out, an injunction must follow, and delay in bringing the action cannot be a ground to disentitle the plaintiff to injunction. If, however, the defendant is able to establish, through evidence which ordinarily would have to be led in trial, that the plaintiff has sat back and knowingly allowed the defendant to continue using the infringing mark for an extended period of time, thereby building up the defendant's reputation, the plaintiff might ultimately fail in obtaining an injunction. To our mind, in a clear cut case of infringement, the Court has ordinarily to grant an injunction, and denial of an injunction on the ground of acquiescence can, if at all, only be a conclusion which follows a trial.

17.8 Besides, in the present case, there is no question of any acquiescence on the part of Saurabh. Saurabh had clearly evinced his objection to the use, by SPL, of the mark SHEOPAL'S, by his oppositions to the applications filed by SPL for registration of the said mark. Once the plaintiff has expressed his objection to the use of the allegedly infringing mark by the defendant, there can ordinarily be no question of any acquiescence. Acquiescence implies consent. One can either object or acquiesce. Acquiescence and opposition cannot exist side by side, and the existence of opposition belies any presumption of acquiescence.

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Digitally Signed By: APTO (COMM) 175/2025 and connected matter
KUMAR
Signing Date: 26.11.2025
11:39:54

Page 29 of 34



17.9 If, even after Saurabh had tendered his opposition to the applications of SPL for the registration of the mark SHEOPAL'S, SPL nonetheless continue to use that mark, it did so at its own risk and peril. In such circumstances, SPL cannot, later, be sought to raise the plea of acquiescence.

17.10 Thus, we are not in agreement with the learned Commercial Court that Saurabh would not be entitled to an injunction because of any delay in institution of the suit. Even otherwise, we do not find the delay to be exorbitant or inordinate.

18. Re. Finding about expenditure having been incurred by SPL

This finding, to our mind, is completely foreign to all principles relating to trademark infringement and the right to an injunction against infringement. There is no principle, known to law, which insulates an infringing defendant against injunction merely because the defendant has spent money in promoting or advertising the product. No equities are created by expenditure which is spent by the defendant on promotion or advertising of goods bearing an infringing mark. It is always open to the defendant to continue to manufacture and sell the goods, using a mark which is non infringing in nature. Expenses and promotional advertisement, therefore, are not grounds on which a defendant can escape an injunction.

19. The Sequitur



2025:DHC:10443-DB



19.1 The sequitur of the above discussion is somewhat involved.

19.2 The learned Commercial Court has held that

- (i) the anti dissection principle is counter balanced by the dominant part principle,
- (ii) OPAL is the dominant part of the rival marks OPAL and SHEOPAL'S,
- (iii) owing to OPAL being the dominant part of the rival marks, there is likelihood of confusion if both the marks are allowed to co-exist,
- (iv) there is phonetic similarity between the rival marks OPAL and SHEOPAL'S,
- (v) this phonetic similarity is also likely to result in confusion between the marks,
- (vi) OPAL is a common word, over which no monopoly can be claimed,
- (vii) nonetheless, as Saurabh has been running his business since long, he is entitled to claim a right over the mark OPAL, though it is a common word,
- (viii) however, there is unexplained and unjustified delay of six years in institution of the suit by Saurabh which disentitles him to injunction, and
- (ix) besides, Saurabh would also be disentitled to injunction as SPL has expended considerable amounts towards promotion of its SHEOPAL'S mark.

19.3 Thus, having held, on merits, in favour of Saurabh, injunction has been refused, by the learned Commercial Court, on the ground of

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Digitally Signed By:  APO (COMM) 175/2025 and connected matter
KUMAR
Signing Date: 26.11.2025
11:39:54

Page 31 of 34



2025:DHC:10443-DB



delay in bringing the action and the expense incurred by SPL in promoting its SHEOPAL's mark.

19.4 As against this, our findings are as under:

(i) There is no occasion to apply either the anti dissection principle or the dominant part test, as these apply to the plaintiff's mark, and not to the defendant's mark, where the plaintiff's mark is composite. In the present case, Saurabh's mark is not a composite mark but consists of the single word OPAL, and Saurabh is not claiming exclusivity over any individual part of that mark. There was, therefore, no question of applying the anti dissection or the dominant part test.

(ii) Seen as whole marks, OPAL and SHEOPAL'S are not deceptively similar, from the perception of a consumer of average intelligence and imperfect recollection, as such a consumer would not remember or recollect the mark SHEOPAL'S into SHE and OPAL.

(iii) There is some degree of phonetic similarity between OPAL and SHEOPAL'S. However, applying the *Pianotist* test, read with the principles elucidated by the Supreme Court in *Pernod Ricard*, and in the facts of the present case, it cannot be said that the phonetic similarity if any between the two marks is such as is likely to result in confusion in the mind of the consumer of average intelligence and imperfect recollection.



2025:DHC:10443-DB



(iv) The aspect of likelihood of confusion is not to be seen by placing the marks side by side, but by considering a situation in which the average consumer has come across the plaintiff's mark at one point of time and, at another point of time, comes across the defendant's mark.

(v) The word OPAL cannot be treated as common or generic or lacking in distinctiveness when used in the context of cosmetics. As such, Saurabh cannot be disentitled from claiming exclusivity over the mark on the ground that it is lacking in distinctiveness, which would require invoking of Section 17(2)(b) of the Trade Marks Act.

(vi) Nor can the suit instituted by Saurabh be claimed to be delayed by such an extent as to disentitle Saurabh to interim injunction. Even otherwise, interlocutory injunction, in a case of infringement, is a necessary and immediate consequence, and cannot be disallowed on the ground of delay in bring the action to the Court.

(vii) The expenses incurred by SPL in promoting the mark SHEOPAL'S cannot be a relevant consideration while examining the aspect of infringement or the entitlement of Saurabh to injunction.

Conclusion

20. The overall outcome of the above discussion is that, as there is

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KUMAR
Signing Date: 26.11.2025
11:39:54

Page 33 of 34



2025:DHC:10443-DB



no deceptive similarity between the marks OPAL and SHEOPAL'S, Saurabh cannot be entitled to any interim injunction against SPL. The final conclusion of the learned Commercial Court, i.e., that Saurabh's application under Order XXXIX Rules 1 and 2 of the CPC has to be dismissed and SPL's application under Order XXXIX Rule 4 of the CPC has to be allowed, is sustained. However, we do so for reasons of our own which are completely distinct and, to a great extent, at variance with the findings of the learned Commercial Court, as already set out hereinabove.

21. Resultantly, FAO (Comm) 175/2025 filed by Saurabh is dismissed.

22. SPL has also filed FAO (Comm) 187/2025, against the findings returned against it by the learned Commercial Court in paras 8 to 11 of the impugned order. We have already returned our findings in respect of those aspects hereinabove.

23. The appeal of the SPL, therefore, stands disposed of in terms of the said findings.

24. Both the appeals are accordingly disposed of with no order as to costs.

C. HARI SHANKAR, J.

OM PRAKASH SHUKLA, J.

NOVEMBER 26, 2025/aky/ar

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11:39:54

Page 34 of 34