

**IN THE HIGH COURT AT CALCUTTA
CIVIL APPELLATE JURISDICTION
INTELLECTUAL PROPERTY RIGHTS APPELLATE DIVISION
APPELLATE SIDE**

Present:

The Hon'ble Justice Debangsu Basak

And

The Hon'ble Justice Md. Shabbar Rashidi

FMAT-IPD/2/2026
BISWANATH HOSIERY MILLS LIMITED
VS
ANILA KEDIA
IA NO: CAN/1/2026

For the Appellant :Mr. Soumendra Nath Mookherjee, Ld. Sr. Adv.
Mr. Ranjan Bachawat, Ld. Sr. Adv.
Mr. Soumya Ray Chowdhury, Advocate
Mr. Debayan Sen, Advocate
Ms. Mohima Chobera, Advocate
Ms. Yamini Mookherjee, Advocate
Ms. Susrea Mitra, Advocate
Mr. Niket Ojha Advocate

For the Respondent :Mr. Jishnu Saha, Sr. Adv.
Mr. Suvasish Sengupta, Advocate
Mr. Syed. E. Huda, Advocate
Ms. Pratiksha Sharma, Advocate
Mr. Sahadat Ali, Advocate
Mr. Sk. Aptabuddin, Advocate
Ms. Nabeela Akbar, Advocate

Heard & Judgment on: May 15, 2026

Debangsu Basak, J.

1. Appeal is directed against Order No. 13 dated December 23, 2025 passed in TS(Com) 14 of 2025 by the learned Judge, Commercial Court at Rajarhat.

2. By the impugned order, learned Judge dismissed an application under Order XXXIX Rules 1 and 2 of the Code of Civil Procedure, 1908 read with Section 151 thereof dated July 3, 2025 filed by the appellant.
3. Learned Senior advocate appearing for the appellant submits that, the appellant is a manufacturer and seller of hosiery products. There exists in favour of the appellant various registered words and label marks in respect of the products of the appellant. He refers to the registration of such word and label marks. He submits that, the word and label mark 'ONN' was registered with the authorities.
4. Referring to Section 28 of the Trade Mark Act, 1999, learned Senior advocate appearing for the appellant submits that, since, the word and label mark stands registered in favour of the appellant, the respondent is guilty of infringement and passing off. Appellant is entitled to protection as sought for in the application.
5. Learned Senior advocate appearing for the appellant refers to the pleadings of the plaint. He submits that, the objection initially registered by the Registrar of Trade Mark Act in 2011 with regard to the registration of the word mark so made by the appellant. He submits that, the respondent herein is not prior user. He refers to the documents of claim for user made by the respondent. He submits that, the registration of the appellant is of 2011 and user thereof is of 2011. The invoice that was disclosed by the respondent was of 2016. Therefore, according to him, the respondent cannot be construed to be a prior user.
6. Learned Senior advocate appearing for the appellant submits that, since, the appellant possessed exclusive rights with regard to the word mark 'ONN', the appellant is entitled to an order of injunction, as prayed for.

7. Learned Senior advocate appearing for the respondent submits that, the appellant is guilty of suppressing material facts. He submits that, the appellant suppressed the fact that, the appellant approached the Registrar of Trade Marks for registration in the year 2011 and that, the Registrar raised an objections under Section 11 of the Act of 1999. He draws the attention of the Court to the objections raised by the Registrar in the year 2011.
8. Learned Senior advocate appearing for the respondent submits that, the advocates for the appellant responded to the objection raised by the Registrar by a letter dated September 30, 2011. He draws the attention of the Court to the contents of such reply. He submits that, the stand of the appellant in such response is that, the word 'ONN', is coined and is a meaningless expression. Such word is also visually, structurally and conceptually different from the other marks.
9. Learned Senior advocate appearing for the respondent submits that, the respondent is using the word 'ON & ON'. He refers to the objection raised by the Registrar to the application for registration of the appellant. He submits that one of the objections was, existence of a registration of ON-N-ON. He submits that, the appellant itself, claimed that ON-N-ON is visually and structurally dissimilar to 'ONN'. Consequently, on the parity of the same logic, the appellant is estopped from contending that 'ONN' that is the word and label mark of the appellant is similar to one used by the respondent 'ON & ON'.
10. We are considering an appeal from an order which refused to grant injunction under Order XXXIX Rules 1 and 2 of the Code of Civil Procedure, 1908 read with Section 151 thereof.

11. It is trite law that, in considering an application for injunction, the Court is to assess the *prima facie* case, balance of convenience and the irreparable loss which may be caused to the plaintiff by non-grant of an order of injunction.
12. In the facts and circumstances of the present case, we find that there exists a word and label mark in favour of the appellant in respect of 'ONN'. While considering the application for registration, the Registrar of Trade Mark raised an objection with regard thereto on July 27, 2011. The objection of the Registrar was under Section 11 of the Act of 1999. The Registrar was of the view that same/similar trade mark(s) is/are already on record of the Registrar for same/similar goods/services.
13. In response thereto, the advocate for the respondent by a letter dated September 30, 2011, stated as follows:-

"..... We refer to the unnumbered First Examination Report dated 27 July, 2011, which has not been received by us as yet. However, following the recent directions of the Trademarks Office, we have downloaded the Examination Report from the Trademarks Registry's electronic records on 22 September, 2011, and submit our response to the official objections.

"Objection: Relative Grounds for Refusal under Section 11:

► We have noted that an objection has been raised under Section 11 on the grounds similarity with the prior marks ON (Registration Number 1405167) and ON-N-ON (Application Number 1889062). The mark ONN [label] (Application Number 2002521) cited in the Official Search Report is the subject trademark.

- *The said objection is respectfully denied and in this regard, we submit as follows:*
- *We submit that the objection is not maintainable as the subject mark consists of the coined and meaningless expression ONN represented in an artistically stylised label which taken as a whole is visually, structurally and conceptually different from the cited marks.*
- *Cited mark ON has significance in the English language while the subject mark is a coined and meaningless expression.*
- *Further, cited mark ON-N-ON is a variant of the expression "on and on" meaning "continuous" and therefore, distinguishable from the subject coined and meaningless trademark.*
- *The visual and structural dissimilarities between the subject mark and the cited marks can be observed from the following table –*

<i>Subject Mark</i>	<i>Cited Mark</i>	<i>Registration/Application No.</i>
<i>ON</i>	<i>ON</i>	<i>1405167</i>
		<i>1889062</i>

Here we refer to:

Chanda Softy Ice Cream and others vs "MARS" Incorporated & Anr. (PTC MAD. 703), wherein it was stated that when the visual appearance of rival trade marks are totally dissimilar, any claim of phonetic similarity may not be tenable.

Finally the subject mark of applicant has been in continuous and extensive use since February 2010, and has been launched and promoted by none other than well-known film personality Mr. Shah Rukh Khan. Despite continuous promotion and use and significant visibility among the public and trade of the applicant's mark for over a year, no conflict has been brought to applicant's notice. Consequently, the appears to be no likelihood of confusion due to the registration of applicant's mark.

► In view of the above, we request you to kindly waive the objection and allow the subject mark to proceed to advertisement or in the alternate please appoint a hearing."

14. The appellant proceeded to obtain registration on the basis of the respondent's letter dated September 30, 2011 with regard to the mark 'ONN'.
15. According to the appellant, therefore, the word and label mark 'ONN' was a coined and meaningless expression. It distinguishes itself from ON-N-ON.
16. The defendant /respondent herein is using 'ON & ON' to market its products. On the parity of the reasoning as contained in its letter dated September 30, 2011, of the advocates for the appellant, it cannot be said that, there are similarities between 'ONN' and 'ON & ON'. At least on a *prima facie* level while considering a petition for grant of injunction, similarity finding cannot be returned.
17. In such circumstances, we are not minded to interfere with the order passed by the learned Judge.

18. **FMAT-IPD/2/2026** along with connected application are **dismissed** without any order as to costs.

(Debangsu Basak, J.)

19. I agree

(Md. Shabbar Rashidi, J.)

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