

## Legal Issues in ‘Remedies & Defenses in IP Matters’

Issue: Can infringement action be taken against another registered proprietor?

## Relevant Legal Provisions

- **Section 28 (3) of the Trademarks Act, 1999**

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

- **Section 30 (2) (e) of the Trademarks Act, 1999**

*“(2) A registered trade mark is not infringed where—  
(e) the use of a registered trade mark, being one of two or more trade marks registered under this Act which are identical or nearly resemble each other, in exercise of the right to the use of that trade mark given by registration under this Act”*

## Relevant Judicial Decisions

❖ ***Eagle Flask Industries Pvt. Ltd. v. Bon jour International and Ors. on 06 April 2011 [C.S. No. 334 of 2010, High Court of Madras]***

“8. ...Under Section 30(2) (e) of the Trade Marks Act, it is made clear that a registered trade mark is not infringed where the use of the registered trade mark is in exercise of the right to the use of that trade mark given by registration under this Act. Therefore, **no proprietor of the registered trade mark can complain of infringement of his registered trade mark by another, if the other person uses his own registered trade mark.** A similar provision does not exist in the Designs Act, 2000. But, it does not mean that the general principles which guide the Court in deciding an application for injunction cannot be invoked, merely because those principles also find a place in one of the related enactments. The principles which form the basis for the provision contained in Section 30(2)(e) of the Trade Marks Act, 1999 are based upon the general principles relating to the extent upto which the rights conferred by the statute would go. **The rights conferred by statute on a person could travel only as far as the area of operation of another person's similar right commences.**”

## Relevant Judicial Decisions

❖ *Pritikiran Rajendra Katole v. Harsha Ravindra Katole on 06 December 2013 [CAA/1551/2013, High Court of Bombay]*

“5. ...The effect of registration of trademark is well settled and recognized. Under what circumstances both two similarly named trademarks got registered is a matter of trial. However, unless it is set aside, **the effect of registration gives an entitlement/ the right to the registered owner to use the same against the whole world being the honest concurrent user.**

6. ...The above provisions itself makes position clear that **two or more persons, if are registered proprietor of trademark which are identical with and/or nearly resemble each other, the exclusive use of the same trademark is not permissible.** Both can use those trademarks for all the purposes. Such two persons cannot prevent each other from using the same registered trademark...”

## Relevant Judicial Decisions

- ❖ *Raj Kumar Prasad & Anr. v. Abbott Healthcare Pvt. Ltd. on 10 September, 2014, [FAO(OS) 281/2014, High Court of Delhi]*

*“15. It is no doubt true that a reading of sub-Section 1 of Section 28 of the Trademarks Act, 1999 would evidence a legal right vested in the registered proprietor of a trademark to exclusively use the same in relation to the goods or services in respect of which the trademark is registered and to obtain relief in respect of infringement of the trademark. It is also true that a mere reading of sub-Section 3 of Section 28 of the Trademarks Act, 1999 would evidence a mutually exclusive right in two or more registered proprietors of trademarks which are identical with or nearly resemble each other to use the trademarks; none being in a position to sue the other, and each being empowered to sue other persons.”*

## Relevant Judicial Decisions

- ❖ *Corza International and Ors v. Future Bath Products Pvt Ltd and Anr on 12 January, 2023, [FAO(OS) (COMM) 2/2023, High Court of Delhi]*

*“7. Further, the consistent view taken by this Court is that the registered proprietor of a trademark can sue another registered proprietor of a trademark alleging deceptive similarity and the Courts are competent to grant an ad-interim injunction. The Division Bench of this Court in Raj Kumar Prasad & Anr. Vs. Abbott Healthcare (P) Ltd., MANU/DE/2523/2014 has held as under:*

*1. The question: Whether the registered proprietor of a trademark can sue another registered proprietor of a trademark alleging deceptive similarity keeps on arising in this Court. The consistent view taken by learned Single Judges is that such a suit would be maintainable and thus by way of an interim injunction the defendant can be restrained from marketing goods under the offending trademark.”*

## Relevant Judicial Decisions

*Corza International and Ors v. Future Bath Products Pvt Ltd and Anr on 12 January, 2023, [FAO(OS) (COMM) 2/2023, High Court of Delhi]*

*“15. It is no doubt true that a reading of sub-Section 1 of Section 28 of the Trademarks Act, 1999 would evidence a legal right vested in the registered proprietor of a trademark to exclusively use the same in relation to the goods or services in respect of which the trademark is registered and to obtain relief in respect of infringement of the trademark. It is also true that a mere reading of sub-Section 3 of Section 28 of the Trademarks Act, 1999 would evidence a mutually exclusive right in two or more registered proprietors of trademarks which are identical with or nearly resemble each other to use the trademarks; none being in a position to sue the other, and each being empowered to sue other persons.”*

## Relevant Judicial Decisions

- ❖ *Jaquar And Company Private Limited v. Ashirvad Pipes Private Limited on 1 April 2024*  
*[CS(COMM) 670/2023, High Court of Delhi]*

“34.10 1.... Before proceeding to Section 29(1), it is also important to note one other significant legal position. One of Mr. Lall's contentions - indeed the very first contention in the written statement filed by him on behalf of the defendant - is that, as the impugned trademarks of the defendant are registered, no action for infringement can lie against them. **Reliance has been placed, in this context, on the various sub-clauses of Section 29 as well as Section 28(3), which does not permit a registered proprietor of one trade mark to claim exclusivity against the registered proprietor of an identical or nearly resembling trade mark.**”

## Relevant Judicial Decisions

- ❖ *Jaquar And Company Private Limited v. Ashirvad Pipes Private Limited on 1 April 2024*  
*[CS(COMM) 670/2023, High Court of Delhi]*

*“34.10 2. ...Where the plaintiff's mark and the defendant's mark are identical, or where the defendant's mark nearly resembles the mark of the plaintiff, what Section 28(3) proscribes is the plaintiff, or the defendant, seeking to interfere with the use, by the other, of the identical or nearly resembling mark, solely on the basis of the registration held by her or him.”*

## Relevant Judicial Decisions

- ❖ *Abros Sports International Pvt. Ltd v. Ashish Bansal and Ors on 13 May, 2025, [FAO (OS) (COMM) 140/2024, High Court of Delhi]*

*“13.1 ... Section 30(2) sets out certain circumstances in which infringement cannot be said to have taken place. These circumstances, therefore, operate as exceptions to Section 29. In other words, irrespective of whether the rival marks are identical, or deceptively similar, or whether there is, or is not, likelihood of confusion between them, if the case falls within one of the clauses of Section 30(2), there is no infringement.*

*13.2 Clause (e) of Section 30(2) clarifies, in no uncertain terms, that if there are two or more identical or nearly resembling registered trademarks, the use of one cannot be said to infringe the other. This provision is as plain as it can be and needs no explanation or elucidation. The fact that his trademark is registered, therefore, affords the defendant an absolute defence against infringement, by virtue of Section 30(2)(e).”*

## Relevant Judicial Decisions

❖ *Abros Sports International Pvt. Ltd v. Ashish Bansal and Ors on 13 May, 2025, [FAO (OS) (COMM) 140/2024, High Court of Delhi]*

*“13. 2 The plaintiff cannot be heard to contend that, by using his registered trademark, the defendant is infringing the plaintiff's registered trademark.”*

*“14.3 The obvious sequitur is that there can be no concept of "relief against infringement" by a registered trademark, simply because a registered trade mark can never be infringing in nature. As such, if the defendant's trademark is registered, the plaintiff, despite being the proprietor of a registered trade mark himself, cannot obtain any relief against infringement, against the defendant or its trade mark. Expressed otherwise, no "relief against infringement", as envisaged by Section 28(1) of the Trade Marks Act, would be available against the proprietor of a registered trade mark.”*

## Relevant Judicial Decisions

- ❖ *Abros Sports International Pvt. Ltd v. Ashish Bansal and Ors on 13 May, 2025, [FAO (OS) (COMM) 140/2024, High Court of Delhi]*

*“16.2. There can be no infringement by a registered trademark. An unregistered trademark alone can infringe. Use of a registered trademark, for the goods or services in respect of which it is registered, can never be infringing in nature.”*

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*“16.3. Ergo, the right to "relief against infringement", otherwise available to a registered proprietor of a trademark under Section 28(1), can never extend to relief against another registered proprietor of a trademark.”*

## Relevant Judicial Decisions

- ❖ *Abros Sports International Pvt. Ltd v. Ashish Bansal and Ors on 13 May, 2025, [FAO (OS) (COMM) 140/2024, High Court of Delhi]*

*“16.4. The very fact of registration confers, on the proprietor of the mark, exclusive right to use the mark in respect of the goods or services for which it is registered. So long as the mark remains registered, this exclusive right cannot be jeopardised or injuncted by anyone, even by the registered proprietor of another identical or similar trademark.*”

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*“16.5. The obvious consequence is that an action for infringement cannot lie against a registered proprietor or a trademark.”*

## Conclusion

- ❖ A preliminary reading of the statutory provisions and judicial precedents makes one thing evident that the Trade Marks Act, 1999 - Sections 28(3) and 30(2)(e) possibly carve out an exception that registration grants enforceable rights against the world, but not against each other.
  - ❖ While the scheme of the Trade Marks Act is largely clear and unequivocal in disallowing infringement actions between registered proprietors, it has still left a room for judicial discretion, as evident.
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- ❖ Ultimately, while statutory protection exists for registered marks, contextual factors, nature of use, and evidence of dishonesty or confusion remain crucial in determining the case.

**THANK YOU!**  
**Questions?**

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