

## Legal Issues in ‘Remedies and Defenses in IP matters’

**Issue: Whether a registered proprietor can restrain bona fide use of one’s own name?**

## Relevant Legal Provisions

### ❖ Section 35 of the Trade Marks Act, 1999

Nothing in this Act shall entitle the proprietor or a registered user of a registered trade mark to interfere with any **bona fide use by a person of his own name** or that of his place of business, **or of the name, or of the name of the place of business, of any of his predecessors in business**, or the use by any person of any bona fide description of the character or quality of his goods or services.

### ❖ Section 29 (1) of Trade Marks Act, 1999

Infringement of registered trade marks.—(1) 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 is identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark.

## Relevant Judicial Decisions

- ❖ **Varun Gems Vs M/S Precious Jewles & Anr (RFA(OS)(COMM) 6/2019) ; Delhi High Court; Division Bench; Judgement Dated October 6, 2022**

“23. Section 35 of the Act entitles a person to use his own name even if that name is the registered trademark of some other person. However, the pre-condition is that the said person must be using his name bona fide and is not to deceive the public or to create a doubt or confusion in the mind of public. Section 35 of the Act does not permit passing off.”

“25. Therefore, the issue to be decided in this case is whether the use of its own name by defendant is bona fide or is for the purpose of riding on popularity of an established trademark.

26. The bona fide use in terms of Section 35 of the Act would mean an honest use by a person of his own name without any intention to deceive and without any intention to ride on the popularity or goodwill of a registered mark.”

## Relevant Judicial Decisions

*“29. In the present case, it is not in dispute that the plaintiff has a valid registration in respect of the label ‘RAKYAN’S FINE JEWELLERY’. The word ‘RAKYAN’S’ is the prominent feature of the trademark. The artistic representation of the trade name ‘RAKYAN’S FINE JEWELLERY’ is also registered in favour of the plaintiff under the Copyrights Act, 1957. It is not disputed that use of the word ‘RAKYAN’S’ for similar goods is causing confusion on part of the public.”*

*“32. In view of the specific evidence being filed, which remain uncontested, it cannot be said that the use of the name ‘RAKYAN’ by the defendant was bona fide. The very fact that the business was started initially by the defendants under the name ‘DIAMEZ’ and later on changed as ‘NEENA & RAVI RAKYAN’. This coupled with the fact that the business was commenced from the adjoining premises are sufficient to reach a conclusion that the defendants were not entitled to the benefit of Section 35 of the Act.” (emphasis supplied)*

## Relevant Judicial Decisions

❖ **Jindal Industries Private Limited Vs Suncity Sheets Private Limited and Anr [CS(COMM) 679/2023]; Delhi High Court; Single Bench; Judgement Dated March 7, 2024**

*“15. “Use”, per se, is neither defined in Section 35, nor elsewhere in the Trade Marks Act. Section 2(2)(b), however, ordains that, unless the context otherwise requires, any reference, in the Trade Marks Act, “to the use of the mark shall be construed as a reference to the use of the printed or other visual representation of the mark”. I see no reason, moreover, not to extend the benefit of Section 35 to the use of the name in the form of initials either. In other words, Defendant 2 would be entitled to the benefit of Section 35, in respect of the use, by her, of “Rachna Nitin Jindal” or, for that matter, “R N Jindal” or even “RNJ”. In each case, what is clearly been referenced is her name.”*

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*“34. Indeed, one who obtains registration of a common name, or surname, like JINDAL, as a trade mark in his favour, does so with all the risks that such registration entails. It is open to anyone, and everyone, to use his name on his goods, and, therefore, the possibility of there being several JINDAL’s looms large.....*

## Relevant Judicial Decisions

*....The plaintiff cannot, by obtaining registration for JINDAL as a word mark, monopolize the use of JINDAL even as a part – and not a very significant one at that – of any and every mark, even in the context of steel, or SS pipes and tubes. The Trade Marks Act, and the privileges it confers, cannot be extended to the point where one can monopolize the use of a common name for goods, and, by registering it, foreclose the rest of humanity from using it.”*

*“35. For that reason, Mr. Lall’s lament that, if the defendants are permitted to use the impugned mark, the plaintiff’s statutory rights in its registered JINDAL word mark would be jeopardized is really misplaced. The risk of having others bona fide using “JINDAL” as a name for their products, and in the marks used on their products, is a risk that the plaintiff consciously took, when it obtained registration of the mark. If one registers a mark which lacks inherent distinctiveness, the possibility of others also using the same mark for their goods, and of the registrant being powerless to restrain such use, is a possibility that looms large, which the registrant has to live with.”*

## Relevant Judicial Decisions

*“37. To the extent it protects against interference with the use of one’s name, Section 35 has to be understood in the context of the law enunciated in the above decision, and those cited within it. The right of a person to use her, or his, own name on her, or his, own goods, cannot be compromised; else, it would compromise the right to use one’s name as an identity marker, which would *ex facie* be unconstitutional.*

*38. In the absence of any such caveat to be found in Section 35, it may be arguable, at the very least, whether, while the use of one’s name as an identity marker is permissible under Section 35, but the instance it spills over into “trade mark” territory, it is rendered impermissible. Any such interpretation, in my *prima facie* view, would be reading a non-existent proviso into Section 35 and, in effect, rewriting the provision.” (emphasis supplied)*

## Relevant Judicial Decisions

- ❖ **Vasundhra Jewellers Pvt. Ltd. vs M/S Vasundhara Fashion Jewellery LLP & Anr. (FAO(OS) (COMM) 232/2023]; Delhi High Court; Division Bench; Judgement Dated August 18, 2025**

*“38. The respondents seek the benefit of Section 35 of the Act. It is contended that, as the mark VASUNDHARA was adopted as the name of Vasundhara Mantri, who was the original proprietor of the proprietorship in whose name the registration of the device mark was obtained on 17 June 2003 claiming user from 1 June 2001, Section 35 operates as a proscription against the appellant injuncting use by the respondents of the said mark.”*

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*“54. We, therefore, are of the opinion that, irrespective of the merits of the matter, there could have been no injunction restraining the respondents from using the mark VASUNDHARA in view of the protection available under Section 35 of the Trade Marks Act.”*

## Relevant Judicial Decisions

“55. Of course, the benefit of Section 35 is available only in the case of bona fide use by a defendant of her, or his, name as a mark. In this regard, we are in entire agreement with the learned Single Judge that the use by the VASUNDHARA is completely bona fide. VASUNDHARA was used by respondents of the mark Vasundhara Mantri. It was her own name. There is nothing whatsoever on record on the basis of which her bona fides could be questioned. She has been using the mark without interruption since 2001 or, even as per the appellant’s own showing, since 2005. The use of the mark VASUNDHARA by Vasundhara Mantri, and later by Respondent 1 has, therefore, necessarily to be treated as bona fide.

56. It is, therefore, clear that the respondents would be entitled to the benefit of Section 35 of the Trade Marks Act. De hors the issue of infringement or passing off, therefore, the respondents cannot be denied the right to use the mark VASUNDHARA, in view of Section 35 of the Trade Marks Act.” (emphasis supplied)

## Relevant Judicial Decisions

❖ **Dindayal Industries Ltd. Vs Dindayal Ayurved Bhawan. & Anr [FAO (COMM) 15/2024 & CM APPL. 46503/2025]; Delhi High Court; Division Bench; Judgement Dated December 22, 2025**

*“23. In the present case, the mark “DINDAYAL” is the common and prominent element across the plaintiff’s composite trademark registrations in Class 5 for ayurvedic related goods....”*

*24. “....There is no doubt that a consumer of average intelligence with imperfect recollection, who is familiar with the plaintiff’s products bearing registered composite trademarks containing the mark “DINDAYAL,” would, upon later encountering the defendants’ products marketed under the impugned marks and the trade name “Dindayal Ayurved Bhawan”, naturally assume an association with the plaintiff.....This likelihood is heightened by the fact that both parties offer an extensive range of ayurvedic goods running into hundreds of products, making it plausible that an average purchaser would regard the impugned marks on the defendant’s products as extension of the plaintiff’s product line.....”*

## Relevant Judicial Decisions

*“26. Further, the defendants also raised the contention that to claim rights on the mark “DINDAYAL”, the plaintiff must have obtained registration of the standalone mark “DINDAYAL”. However, the court held that once the essential features of the mark are identified, the ultimate question is as to whether the defendant’s mark, when viewed as a whole, is deceptively similar to the plaintiff’s registered trademark or not. In the present case, upon a comparison of the marks in its entirety, the impugned marks are deceptively similar to the plaintiff’s registered trademarks. The absence of a standalone registration for the mark “DINDAYAL” merely disentitles the plaintiff from asserting exclusive rights over “DINDAYAL” in isolation; however, it does not preclude the plaintiff from enforcing its statutory rights in the composite registered trademarks in which “DINDAYAL” constitutes the essential feature, which shatters the focal point of the argument led by the learned Counsel for the defendants.”*

*“33. Thus, if the defendants use the mark “DINDAYAL” as a part of a combined and composite trademark in relation to ayurvedic products, an impression that the product is associated with the product of plaintiff is bound to arise.”*

## Relevant Judicial Decisions

“34. *The mere fact that “DINDAYAL” is a personal name does not entitle the defendants to unrestricted use of it in the course of trade in ayurvedic products and particularly in the class where the plaintiff has a registration....*”

“35. *Further, the death certificate and address documents relied upon by the defendants appear to establish family lineage rather than evidencing any use of the mark “DINDAYAL” in relation to ayurvedic goods. Additionally, no cogent and compelling documents have been brought on record to suggest any prior use of the impugned marks prior to that of the plaintiff.....These circumstances, the defendants’ adoption of the impugned trademarks containing the mark “DINDAYAL” was not regarded as bona fide within the meaning of Section 35 of the Trade Marks Act.....*”  
*(emphasis supplied)*

## Conclusion

- ❖ Section 35 does not grant automatic immunity—bona fide use of one's own name fails where the name constitutes the dominant or distinctive element of a prior registered mark and causes consumer association or confusion.
- ❖ Courts diverge on analytical approach, oscillating between the *dominant feature doctrine* and the *whole-mark comparison test*, leading to inconsistent outcomes.
- ❖ Bona fide use is intention-centric, with courts closely scrutinising timing of adoption, prior knowledge, proximity of business, and conduct suggestive of goodwill appropriation.

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- ❖ The law remains unsettled, with no uniform threshold for “bona fide” use under Section 35 when own-name use overlaps with a distinctive registered trademark, leaving outcomes heavily fact-dependent and discretionary.

# THANK YOU!

## Questions?

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