Special Legal Issues Seminar Series

Topic: Year In Review – Notable IP Division Judgments and Developments: Quarter 1 (January To March 2026)

Trademark Law

- ***Oswaal Books and Learnings Private Limited v. The Registrar of Trade Marks, LPA 571/2025, Delhi High Court, C. Hari Shankar And O.P. Shukla, JJ, decided on 10 February 2026; Division Bench***

Facts -

The Appellant, Oswaal Books and Learnings Private Limited, applied for registration of the word mark "ONE FOR ALL" in Class 16 for educational books and allied publications. The Registrar refused the application under Section 9(1)(a) of the Trade Marks Act, 1999, holding that the mark was devoid of distinctive character and that acquired distinctiveness had not been proved.

The Single Judge dismissed the appeal under Section 91 and held that the expression was a common laudatory slogan. According to the Single Judge, the phrase conveyed that the appellant's books were a universal or one stop solution for various examinations and boards. The Single Judge treated the mark as descriptive and lacking inherent distinctiveness.

The Appellant preferred a Letters Patent Appeal before the Division Bench.

Trademark Law

- ***Oswaal Books and Learnings Private Limited v. The Registrar of Trade Marks, LPA 571/2025, Delhi High Court, C. Hari Shankar And O.P. Shukla, JJ, decided on 10 February 2026; Division Bench***

Issue –

Whether the mark "ONE FOR ALL" was disentitled to registration on the ground of want of distinctiveness?

Analysis of the Court –

- *"24. .....Section 9(1)(a) proscribes registration of marks which are incapable of distinguishing the goods of one person from those of another.* ***The proviso, however, statutorily preserves registrability where, before the date of application, the mark has acquired a distinctive twofold; (i) whether the mark is inherently distinctive; and; (ii) if it is not, whether the evidence demonstrates acquired distinctiveness sufficient to attract the proviso****."*
- *"26. It could be understood from the above reading that a mark is descriptive or not has to be assessed in the context of the goods and services it is being used.* ***Also, a common word may also become distinctive if used for goods or services with which it has no immediate connection."*** (emphasis supplied)

Trademark Law

- ***Oswaal Books and Learnings Private Limited v. The Registrar of Trade Marks, LPA 571/2025, Delhi High Court, C. Hari Shankar And O.P. Shukla, JJ, decided on 10 February 2026; Division Bench***

  - *"27. Additionally, it is undisputed that the slogans are clearly capable of constituting a "trade mark" within the meaning of Sections 2(m) and 2(zb) of the Act. These slogans can be represented graphically and can be used in distinguishing the goods of one person from those of another. In some cases, these slogans are used to indicate, in the course of trade, a connection between the goods and the person entitled to use the mark."*
  - *"28. Also, with the rise of heavily digitised marketplace, with digital marketing expanding rapidly,* ***slogans and taglines often perform a source identifying function and, in many cases, may be more readily recognised than the brand or trade name itself. Slogans, taglines, and similar expressions have therefore become an integral component of source identification****."*
  - *"34. We find that the applied mark "ONE FOR ALL" does not evoke a connect, in the mind, between the mark and books. The mark has no relation with books and can be used in any situation to communicate broad coverage or universality. "ONE FOR ALL" does not directly and unequivocally describe books. The applied mark is, at the highest, suggestive in nature. Therefore, satisfies the statutory requirement and is capable of registration."* (emphasis supplied)

Trademark Law

- ***Reckitt and Colman Overseas Hygiene Home Limited & Ors. v. Mr. Akash Arora Trading as M/S Grand Chemical Works, Delhi High Court, CS(COMM) 1052/2024, Hon'ble Justice Tejas Karia, decided on March 28, 2026***

Facts – Reckitt is the owner of the marks HARPIC, COLIN and LIZOL and has used them in India since 1984, 1998 and 1996 respectively, and holds nearly 78% market share in the cleaning products segment. Through extensive use and advertising, the products acquired substantial goodwill, with consumers associating their distinctive bottle shapes, cap designs, colour combinations and label layouts with Reckitt's products. Reckitt also held trademark and earlier design registrations for these trade dress elements.

The dispute arose when Grand Chemical Works, under the mark "GAINDA", launched cleaning products allegedly imitating the essential trade dress and overall get-up of HARPIC, COLIN and LIZOL products, including similar bottle profiles and colour schemes. Reckitt alleged that the products were sold through identical retail and online channels, creating a likelihood of consumer confusion and passing off.

Grand Chemical argued that Reckitt was attempting to "evergreen" its expired design registrations by claiming trademark protection over the same bottle and cap shapes after expiry of the statutory design monopoly. It further contended that common bottle shapes and colour combinations could not be monopolised, and that the prominent use of the "GAINDA" mark sufficiently distinguished its products.

Trademark Law

- ***Reckitt and Colman Overseas Hygiene Home Limited & Ors. v. Mr. Akash Arora Trading as M/S Grand Chemical Works, Delhi High Court, CS(COMM) 1052/2024, Hon'ble Justice Tejas Karia, decided on March 28, 2026 (Contd.)***

Plaintiffs' products under the Mark HARPIC	Defendant's Toilet Cleaner
	

Plaintiffs' products under the Mark LIZOL	Defendant's disinfectant product
	

Plaintiffs' products under the Mark COLIN	Defendant's Glass Cleaner
	

ip@algindia.com

Trademark law

- ***Reckitt and Colman Overseas Hygiene Home Limited & Ors. v. Mr. Akash Arora Trading as M/S Grand Chemical Works, Delhi High Court, CS(COMM) 1052/2024, Hon'ble Justice Tejas Karia, decided on March 28, 2026 (Contd.)***

Analysis – *"16… the overall comparison of the Defendant's Products with the Plaintiffs' Products shows that there is an* ***attempt to imitate the essential features of the Plaintiffs' Trade Dresses by the Impugned Trade Dresses****. The Impugned Trade Dresses are deceptively similar to the Plaintiffs' Trade Dresses as the essential features of the Plaintiffs' Trade Dresses such as the colour of the packaging, the colour of the cap, the colour of the liquid, the shape of the bottle are copied in the Impugned Trade Dresses. The overall comparison of the get-up at the point of sale creates an impression that the Impugned Trade Dresses are an imitation of the essential features of the Plaintiffs' Trade Dresses…"*

"22 The Plaintiffs cannot claim monopoly on the use of blue, red, white or yellow colours or any other colour if they are considered individually. ***However, the distinctive combination, arrangement and presentation resulting in ensemble, which has been in use for a considerably long period have acquired secondary meaning in favour of the Plaintiffs' Products****. Even though the individual components of the Plaintiffs' Trade Dresses are common to the trade, the overall get-up of the Plaintiffs' Trade Dresses requires protection."* (Emphasis Supplied)

Trademark law

- ***Reckitt and Colman Overseas Hygiene Home Limited & Ors. v. Mr. Akash Arora Trading as M/S Grand Chemical Works, Delhi High Court, CS(COMM) 1052/2024, Hon'ble Justice Tejas Karia, decided on March 28, 2026 (Contd.)***

  "..18 The submission of the learned Senior Counsel for the Defendant that ***Plaintiffs' registrations for HARPIC Bottle and Cap Marks are barred by law, being exactly the same as the Plaintiffs' Design Registrations which were granted protection under the Designs Act but stand expired cannot be accepted in light of the decision of the Full Bench of this Court in Mohan Lall (supra), wherein it was held that dual protection from both design and trade mark law may exist where it is alleged that the configuration or shape of a container or article acts as a trade mark or trade dress****. The decision of the Five Judge Bench of this Court in Carlsberg Breweries vs Som Distilleries & Breweries Ltd., MANU/DE/4610/2018 : 2018:DHC:7876-DB : AIR 2019 Delhi 23, did not overrule this decision of the Full Bench in Mohan Lall (supra) and held that as long as the elements of the Design are not used as a trade mark but rather as a larger trade dress, the presentation of the product through its packaging and so on can be protected."* (Emphasis Supplied)

- ***Products and Ideas (India) Pvt. Ltd. v. Nilkamal Limited and Ors., FAO(OS) (COMM) 111/2025, Delhi High Court, C. Hari Shankar And O.P. Shukla, JJ, decided on March 23, 2026; Division Bench***

Facts -

The Appellant, Products and Ideas India Pvt. Ltd., entered into an Exclusive Agency Agreement ("EAA") with Stella Industrial Co. Ltd. ("SIC"), a Taiwanese-Chinese entity holding the STELLA trademark in China, in April 2017. The EAA appointed the Appellant as SIC's sole agent in India for distributing, selling and promoting STELLA-branded cookers, and gave it the authority to decide how those cookers would be branded for the Indian market. The Appellant sold the cookers under the mark STELLADEXIN, an English version of SIC's Chinese mark, and obtained trademark and copyright registrations.

The Appellant found out that the Respondent, Nilkamal Limited and its joint venture Cambro-Nilkamal Pvt. Ltd. ("Cambro-Nilkamal") were selling induction cookers under the STELLA mark. The Appellant sued for trademark infringement and obtained an ex parte ad interim injunction from a Single Judge in August 2024. In July 2025, the Single Judge sided with SIC and Cambro-Nilkamal, vacating the injunction on the basis of prior continuous user under Section 34 and international exhaustion under Section 30(3) of the Act. Aggrieved by this decision, PI Pvt. Ltd. filed the present appeal.

Trademark Law

- ***Products and Ideas (India) Pvt. Ltd. v. Nilkamal Limited and Ors., FAO(OS) (COMM) 111/2025, Delhi High Court, C. Hari Shankar And O.P. Shukla, JJ, decided on March 23, 2026; Division Bench***

Issues –

- Whether the invocation, by the learned Single Judge, of Section 34 of the Act was legal and proper.
- Assuming SIC was entitled to the benefit of Section 34, the second issue is whether, therefore, no action for infringement would lie against Respondent 2.
- Whether the appellant's claim was rightly rejected by applying the principle of international exhaustion, invoking Section 30(3) of the Act.

Trademark Law

- ***Products and Ideas (India) Pvt. Ltd. v. Nilkamal Limited and Ors., FAO(OS) (COMM) 111/2025, Delhi High Court, C. Hari Shankar And O.P. Shukla, JJ, decided on March 23, 2026; Division Bench***

Analysis of the Court –

- *"33. On its plain words, Section 34 requires not mere prior user by the respondent, but prior continuous user, antedating both registration and user of the asserted mark by the plaintiff. Though the learned Single Judge has held that there was proof of prior continuous user, we are unable to uphold this finding…. It is prima facie clear, to us, that there is no evidence even of prior user of the STELLA or STELLADEXIN mark by SIC in India, much less proof of prior continuous user."*
- *"42. Secondly,* ***even if SIC were not to be regarded as guilty of infringement, that would not ipso facto mean that no case of infringement could lie against Respondent 2. Import of goods bearing the registered trademarks bearing the registered trademark of another independently constitutes "use" of the registered trademark, within the meaning of Section 29(6)(c) 11 of the Act, for the purposes of infringement.*** *"* (emphasis supplied)

- ***Products and Ideas (India) Pvt. Ltd. v. Nilkamal Limited and Ors., FAO(OS) (COMM) 111/2025, Delhi High Court, C. Hari Shankar And O.P. Shukla, JJ, decided on March 23, 2026; Division Bench***

Analysis of the Court –

- *"47 . Section 30(3) states that if goods bearing a registered trademark are lawfully acquired by a person, the sale of the goods in the market or otherwise dealing in those goods by that person would not be infringing if the goods have been put in the market by the proprietor of the registered trademark or with his consent. SIC does not have any registration, in India, of any trade mark. The only registered proprietor of the mark is the appellant. Respondent 2 was not importing the goods, bearing the appellant's registered trademark, with the consent of the appellant. As such, Section 30(3) would not apply."*
- *"48. ....* ***The import can only be by the proprietor of the registered trade mark or with his consent, absent which the import would certainly be infringing within the meaning of Section 29 of the Act****."*
- *"49. ...Section 30(3), on its plain words, applies "where the goods bearing a registered trade mark are lawfully acquired by a person". In such a case, the provision would apply where the goods are sold by the lawful acquirer with the consent of the proprietor of the registered trade mark.* ***The words "registered trade mark" cannot include registration outside India….A trade mark which is registered in India alone is, therefore, a "registered trade mark" for the purposes of the Act and, therefore, for the purposes of Section 30(3) thereof as well.****"* (emphasis supplied)

Trademark law

- ***Mr. Sumit Vijay & Anr. v. Major League Baseball Properties Inc. & Anr. Delhi High Court, LPA 475/2025, C. Hari Shankar And O.P. Shukla, JJ., decided on January 5, 2026***

Facts **-** The appellants were proprietors of the trademark "BLUE-JAY" in Class 25, having applied for registration in 1998. MLB, owner of the baseball franchise "Toronto Blue Jays", claimed prior rights in the marks "BLUE JAYS" and "TORONTO BLUE JAYS", asserting worldwide reputation since 1976. Although MLB had earlier obtained registration for "BLUE JAYS" in Class 25 in 1983, the registration had subsequently lapsed and was removed from the register.

MLB initially opposed the appellants' registration before the Trade Marks Registry, but later abandoned its opposition. MLB thereafter filed for rectification before the Delhi High Court, contending that the BLUE JAYS mark enjoyed trans-border reputation and goodwill in India through websites availability, sports broadcasts and merchandise sales etc. The appellants argued that MLB had no commercial presence in India prior to 1998, that baseball had negligible recognition among Indian consumers, that there was no evidence of spillover goodwill in India, and that mere foreign reputation or accessibility of websites in India was insufficient to establish goodwill or prior reputation within India.

The Single Judge ruled in favour of MLB and ordered cancellation of the appellants' "BLUE-JAY" registration. The Court held that MLB had established substantial worldwide reputation and trans-border goodwill extending into India through accessible websites, broadcasts of matches since 1997, and availability of merchandise in India. The Court also inferred dishonest adoption on the part of the appellants, holding that they had sought to capitalize on MLB's reputation and goodwill. The matter was subsequently carried in appeal before the Division Bench.

Trademark law

- ***Mr. Sumit Vijay & Anr. v. Major League Baseball Properties Inc. & Anr. Delhi High Court, LPA 475/2025, C. Hari Shankar And O.P. Shukla, Jj., decided on January 5, 2026 (Contd.)***

Analysis

*"…11.4. The expression **"earlier trade mark"**, for the purposes of Sections 11(1) and 11(2) stands defined in the Explanation below Section 11(4). A mark would qualify as an "earlier trade mark" plainly said, if (i) it was a prior registered trade mark, or (ii) an application for registration of the trade mark was pending before the Registrar, or (iii) it was a well known trade mark on the date of application for registration of the latter mark…11.8. In as much as, therefore, (i) the respondent's BLUE-JAYS mark was not a registered trade mark, (ii) there was no application for registration of the respondent's BLUE JAYS mark pending either on the date of application, by Appellant 1, for registration of the BLUE-JAY mark, or even till the filing of the Section 57 petition by the respondents before this Court, and (iii) the respondent's BLUE JAYS mark cannot be treated as a well known trade mark on 19 August 1998, when Appellant 1 had applied for registration of the BLUE-JAY mark, or even on 8 June 2017, when the appellant's BLUE-JAY mark proceeded to registration, the respondent's BLUE JAYS mark does not qualify as an "earlier trade mark" for the purposes of Sections 11(1) or 11(2) of the Trade Marks Act…"*

*"…12.7.3. There is no evidence of the respondent's having used the BLUE JAYS mark, in India, in any of the modes envisaged in the Trade Marks Act. **The mere fact that the BLUE JAYS mark figured on websites which are accessible in India, or figured on merchandise which could be purchased in India, cannot amount to use of the mark**, by the respondent, within India. At least, prior to 1998, there is little or no evidence of such use…"* (Emphasis Supplied)

Trademark law

- ***Mr. Sumit Vijay & Anr. v. Major League Baseball Properties Inc. & Anr. Delhi High Court, LPA 475/2025, C. Hari Shankar And O.P. Shukla, Jj., decided on January 5, 2026 (Contd.)***

"...12.8.2. ***Acquisition of global goodwill and reputation is entirely irrelevant, while examining an allegation of passing off. It is goodwill and reputation in India that matters****. The Court has to assess whether the "global" goodwill, assuming it exists, has percolated into India. Before arriving at any finding that the BLUE-JAY mark could be cancelled under Section 11(3)(a), therefore, the Court would have to satisfy itself that respondent's BLUE JAYS mark enjoyed goodwill, not merely globally, but also within India, before August 1998 when the appellants adopted the BLUE-JAY mark..."*

"..12.12 ***Goodwill and reputation, it has to be remembered, is a two-way street. One cannot claim to have goodwill and reputation, unless others feel the same.*** *Thumping one's own chest, and claiming to be famous, is mere false hope, and nothing more. Goodwill and reputation are positive attributes, relative to others. The purpose of requiring establishment of goodwill and reputation, in passing off actions, has to be remembered. They are not empty incantations. Passing off, in its very essence, involves misleading the consumer public into believing one's goods or services, to be those of another. If the other has no goodwill or reputation, the very raison d' etre of alleging passing off fails. Why would one pass off one's goods as those of another, if the other has no goodwill or reputation? Ergo, questions Mr. Lall, "Why on earth would my client adopt a mark which belongs to a baseball club based out of Canada?.."* (Emphasis Supplied)

Trademark law

- ***Mr. Sumit Vijay & Anr. v. Major League Baseball Properties Inc. & Anr. Delhi High Court, LPA 475/2025, C. Hari Shankar And O.P. Shukla, JJ., decided on January 5, 2026 (Contd.)***

"..13.6 It has to be remembered that ***bad faith, in order to constitute a basis to remove of mark from the register of Trade Marks has to be found to exist at the time when the applicant applied for registration of the mark. This is because bad faith must reside in the applicant who applies for registration of the mark and not in any other person****. Section 11(10)(ii) envisages the taking into consideration, by the Registrar, of bad faith involved "either of the applicant or the opponent" affecting the rights relating to the trade mark. 13.7 The applicant must, therefore, be shown to have acted with bad faith. Either, therefore, the application made by the applicant must be tainted with bad faith or, after the application has been submitted, but before it is registered, the applicant must have acted with bad faith. No allegation of bad faith, howsoever serious, subsequent to the registration of the mark, can be relevant for the purposes of Section 11(10)(ii) of the Trade Marks Act…" (*Emphasis Supplied)

16

Trademark Law

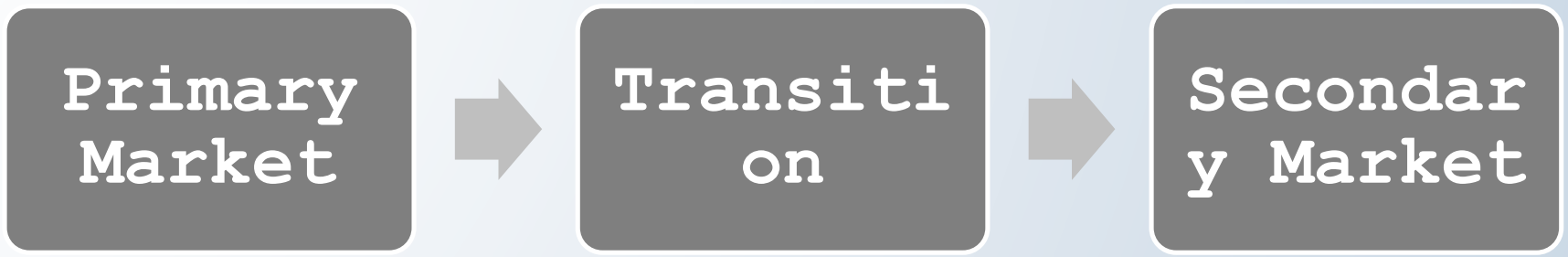
- ***Western Digital Technologies Inc. & Anr. vs. Geonix International Private Limited & Ors., FAO (OS) (COMM) 146/2024, Delhi High Court, C. Hari Shankar And O.P. Shukla, JJ, decided on March 9, 2026; Division Bench***

Facts –

Western Digital and Seagate manufacture HDDs that are supplied to original equipment manufacturers (OEMs) for integration into computers, servers and similar equipment. These drives bear the manufacturers' registered trademarks and are sold with a limited warranty. After the warranty period expires, the drives are treated as end-of-life products. While they remain functional, they are removed from discarded equipment, sold in foreign markets and some are imported into India.

The respondents in the proceedings are refurbishers that acquired such imported drives. Functional drives were refurbished by erasing existing software, reformatting them and removing the original manufacturers' trademarks. The refurbishers then affixed their own brand names, assigned new serial and model numbers, and sold the drives in the Indian market under their own packaging.

Western Digital and Seagate instituted suits alleging trademark infringement under the Trademarks Act 1999, along with passing off and reverse passing off. They argued that the removal of their trademarks, followed by resale under new branding, impaired the condition of the goods and severed the connection between the products and their original source. The appellants also contended that the drives retained distinctive physical features, through which technically literate consumers could identify them as originating from the appellants.



Manufacture
↓
OEM
↓
Device Use

End-of-life
↓
Extraction
↓
Import

Refurbish
↓
De-brand
↓
Rebrand
↓
Resale

18

Trademark Law

- ***Western Digital Technologies Inc. & Anr. vs. Geonix International Private Limited & Ors., FAO (OS) (COMM) 146/2024, Delhi High Court, C. Hari Shankar And O.P. Shukla, JJ, decided on March 9, 2026; Division Bench***

Issues –

- Does import of HDDs bearing the original marks amount to "use of a registered mark" under Section 29?
- If so, does the principle of exhaustion apply under Section 30(3)?
- Were the HDDs lawfully acquired?
- Does refurbishment amount to "change or impairment" under Section 30(4)?
- Is there passing off or "reverse passing off"?

Trademark Law

- ***Western Digital Technologies Inc. & Anr. vs. Geonix International Private Limited & Ors., FAO (OS) (COMM) 146/2024, Delhi High Court, C. Hari Shankar And O.P. Shukla, JJ, decided on March 9, 2026; Division Bench***

Single Judge –

"112. Post exhaustion of warranty, none of these entities i.e. manufacture/OEM/ wholesaler/ distributor/ retailer have any liability or responsibility of the state of those goods, unless of course, there is a mandate under any law, regulation or policy of managing their disposal. In a situation where such policy or regulation does not exist, or even if it exists but does not impose conditions on the manufacturer, the umbilical cord is cut and the goods are in an untethered space. This is exactly where the principle of exhaustion comes into play; therefore, under Section 30(3)(b), the registered owner/manufacturer has no right to object to any dealing."

113. "The only caveat is in Section 30(4) where, if the marks are removed from the original product or it is disfigured or changed in a manner that possibly amounts to 'change' or 'impairment', and when such goods are sold as goods identified with the manufacturer, the manufacturer's right kicks in to prevent the same. This is obviously to prevent the loss of reputation and goodwill of the manufacturer, since a consumer may potentially purchase that product thinking that the changed/impaired product is from the manufacturer."

Trademark Law

- ***Western Digital Technologies Inc. & Anr. vs. Geonix International Private Limited & Ors., FAO (OS) (COMM) 146/2024, Delhi High Court, C. Hari Shankar And O.P. Shukla, JJ, decided on March 9, 2026; Division Bench***

Single Judge –

"114. This is where the necessity of "full disclosure" becomes critical from the customer's perspective. If there is "full disclosure" by the refurbisher that the change has been done by the refurbisher and does not, therefore, resemble the original product , as doled out by the manufacturer, inter alia, in terms of warranty, serviceability, life, manuals and brochures - then consumers are fully warned as to what they are purchasing. The consumer gets "the whole truth"..."

21

Trademark Law

- ***Western Digital Technologies Inc. & Anr. vs. Geonix International Private Limited & Ors., FAO (OS) (COMM) 146/2024, Delhi High Court, C. Hari Shankar And O.P. Shukla, JJ, decided on March 9, 2026; Division Bench***

Single Judge (Directions) –

(i) Packaging to identify the source of the product

(ii) Reference to the original manufacturer is to be made through their word mark and not the device mark

(iii) Packaging must specify that there is no original manufacturer's warranty

(iv) Packaging must specify that the product is "Used and Refurbished'

(v) Statement as to extended warranty by the Refurbisher

(vi) Packaging must reflect an accurate description of the features

(vii) All of the above should also be complied with by the defendants on promotional literature, website, e-commerce listings, brochures and manuals.

Trademark Law

- ***Western Digital Technologies Inc. & Anr. vs. Geonix International Private Limited & Ors., FAO (OS) (COMM) 146/2024, Delhi High Court, C. Hari Shankar And O.P. Shukla, JJ, decided on March 9, 2026; Division Bench***

Division Bench –

"148…..(i) "Reverse passing off" is not an actionable tort, in our trade mark jurisprudence. This is, inter alia, apparent from a reading of Section 27(2) read with Sections 134(1) and 135(1) of the Act, in conjunction with the judgments of the Supreme Court identifying the ingredients of passing off, including, inter alia, Kaviraj Pt Durga Dutt Sharma and Satyam Infoway.

(ii) Assuming, arguendo, that "reverse passing off" was actionable as a tort in India, its ingredients are, nonetheless, absent in the present case as:

(a) the "initial interest" test would apply to reverse passing off as well,

23

(b) the ability of the consumer to be able to identify the goods with the original registered trade mark owner must, therefore, be at the time of initial sale of the goods,

(c) there was nothing to indicate that, at the time of sale of the refurbished HDDs by the respondents, theconsumer would be able to identify them as having been originally manufactured by the appellants,

Trademark Law

- ***Western Digital Technologies Inc. & Anr. vs. Geonix International Private Limited & Ors., FAO (OS) (COMM) 146/2024, Delhi High Court, C. Hari Shankar And O.P. Shukla, JJ, decided on March 9, 2026; Division Bench***

Division Bench –

"(d) the ability to identify the HDDs as having originated from the appellant using the Crystal Disk Info tool, could not make out a case of "reverse passing off", apart from the fact that the very availability and accessibility of the said tool would be matters requiring evidence and trial,

(e) there was no misappropriation, by the respondents, of any goodwill of the appellants, and

(f) no material evidence of any damage which had resulted to the appellants, as a result of the acts of the respondents, was available either.

(iii) For the same reason, no case of passing off could, either, be said to exist. Even if it were to be assumed that the respondents were misrepresenting the HDDs as new and, thereby, misleading consumers, that would not constitute "passing off" as understood in trademark jurisprudence."

Trademark Law

- ***Western Digital Technologies Inc. & Anr. vs. Geonix International Private Limited & Ors., FAO (OS) (COMM) 146/2024, Delhi High Court, C. Hari Shankar And O.P. Shukla, JJ, decided on March 9, 2026; Division Bench***

Division Bench –

"(iv) In so far as infringement was concerned, Section 30(3) does not create a new specie of infringement but only clarifies that, if the act of a person who lawfully acquires goods bearing a registered trade mark of another, sells them in the market, it would not amount to infringement, if the circumstances envisaged in Section 30(3) applied. As such, the question of resort to Section 30(3) would arise only if the defendants' acts amounted otherwise to "infringement" within the meaning of Section 29.

(v) "Infringement", under Section 29, requires use, by the defendant, of the registered trademark of the plaintiff or of a deceptively similar mark. Inasmuch as the respondents efface the appellants' marks from the HDDs before refurbishing and selling them, the respondents' acts cannot constitute infringement. As such, Section 30(3) would not call for application.

(vi) Assuming, arguendo, that Section 30(3) applies, its ingredients stand satisfied, as (a) there is no evidence of any proscription on the OEMs further selling the HDDs, especially after they had reached end-of-life stage, (b) import of the HDDs was not prohibited, (c) the respondents had purchased the HDDs against commercial invoices on which GST was paid, and (d) the appellants had themselves placed the HDDs on the market."

Trademark Law

- ***Western Digital Technologies Inc. & Anr. vs. Geonix International Private Limited & Ors., FAO (OS) (COMM) 146/2024, Delhi High Court, C. Hari Shankar And O.P. Shukla, JJ, decided on March 9, 2026; Division Bench***

Division Bench –

"(vii) Section 30(4) would not apply, as there was no change or impairment of the HDDs by the respondents, the expression "changed" having to be understood noscitur a sociis with the word "impaired", and there was, even otherwise, no legitimate reason for the appellants to object to further dealings in the HDDs by the respondents.

(viii) Thus, no case of infringement, either, could be said to exist.

(ix) The operative portion of the impugned judgment is maintained, as there is no challenge, thereto, from the respondents, and the appellants could not be placed worse off for having preferred an appeal."

Trademark law

- ***Thukral Mechanial Works v. PM Diesel Pvt. Ltd., Delhi High Court, LPA 320/2024, Before C. Hari Shankar And O.P. Shukla, JJ.), decided on February 06, 2026***

Facts - The Respondent, PM Diesels Private Limited (**"PMD**") was the registered proprietor of the word mark 'FIELDMARSHALL' for diesel oil engines and parts thereof from October 16, 1964 ("**PMD Mark**"). Jain Industries ("**Jain**"), the predecessor in title of the appellant, Thukral Mechanical Works ("Thukral") was the registered proprietor of the trademark 'FIELD MARSHAL' for centrifugal pumps ("**Jain Mark**") with effect from May 13, 1965. The Jain Mark was assigned to Thukral by way of a Deed of Assignment in 1986 ("**Deed of Assignment"**).

PMD did not hold any registration of the mark 'FIELDMARSHALL', more specifically even for using it in respect of centrifugal pumps. However, PMD commenced using the mark 'FIELDMARSHALL' for centrifugal pumps in 1975. By the time Thukral commenced use of the Jain Mark in 1988, PMD was in continuous use of the mark 'FIELDMARSHAL' for centrifugal pumps and had acquired substantial goodwill and reputation. The above facts gave rise, inter alia, to actions and counter-actions between the parties before the Trade marks registry, the IPAB, the Delhi High Court, and the Supreme Court.

PMD filed a suit against Thukral alleging that Thukral was manufacturing and selling centrifugal pumps under the Jain Mark. PMD contended that this conduct infringed the PMD Mark and amounted to passing off its goods as those of PMD ("**PMD Suit**"); and Thukral filed a suit inter alia against PMD seeking an injunction restraining PMD from using the PMD Mark on centrifugal pumps on the ground that such use infringed the Jain Mark, which was a registered mark ("**Thukral Suit**").

Trademark law

- ***<u>Thukral Mechanial Works v. PM Diesel Pvt. Ltd., Delhi High Court, LPA 320/2024, Before C. Hari Shankar And O.P. Shukla, JJ.), decided on February 06, 2026</u>***

During the pendency of the PMD Suit and the Thukral Suit, PMD filed an application under Section 46 (1) (b) of the Trade and Merchandise Marks Act, 1958 ("**TMMA"**) for removal of the registration of the Jain Mark from the register of trade marks. The matter was transferred to the Intellectual Property Appellate Board, where it was dismissed on the ground that Thukral's non-use for 5 (five) years had not been made out. The matter travelled up to the Supreme Court of India ("**Supreme Court**") which inter alia held that Jain was the only registered proprietor of the Jain Mark and that PMD in using the 'FIELDMARSHAL' mark for centrifugal pumps had infringed the Jain Mark ("**Supreme Court Order**").

The PMD Suit and the Thukral Suit (amongst others) were disposed of by an order of the Delhi HC ("**Impugned Order**") inter alia holding that:

- It is a settled law that registration alone does not confer rights without corroborative use;
- There was no evidence to indicate that Jain ever used the Jain Mark for centrifugal pumps, while PMD had
- Demonstrated adoption and prior use of the 'FIELDMARSHAL' mark for centrifugal pumps;
- The assignment of the Jain Mark to Thukral by way of the Deed of Assignment was defective due to lack of use by Jain in terms of Section 46 (1)(b) of the TMMA. Therefore, Thukral's adoption of the Jain Mark in the same field as PMD was dishonest and liable to be cancelled; and
- PMD was the prior user of the 'FIELDMARSHAL' mark for centrifugal pumps. The use of the Jain Mark by Thukral constituted passing off as the marks were identical and the goods were cognate and allied.

Trademark law

- ***Thukral Mechanial Works v. PM Diesel Pvt. Ltd., Delhi High Court, LPA 320/2024, Before C. Hari Shankar And O.P. Shukla, JJ.), decided on February 06, 2026***

Analysis – On whether PMD established prior goodwill

155. Having obtained a registration of the FIELD MARSHAL mark for centrifugal pumps, however, Jain never chose to use the mark during the entire period for which it remained its registered proprietor. The first use of the mark FIELD MARSHAL by Thukral for centrifugal pumps, holds the learned Single Judge, is of 1988. We have set out the basis for the learned Single Judge so holding, and, on a perusal of the evidence on record, we are in entire agreement with her. There is nothing to support the purported use of the mark FIELD MARSHAL by Thukral for centrifugal pumps since 1973, though the Assignment Deed so states. No invoices or other documents, to that effect, are on record. The first invoice of Thukral, manifesting such use, is of 1988. Clearly, therefore, no use was made of the registration obtained by Jain, of the FIELD MARSHAL mark for centrifugal pumps for 23 years - close to a quarter of a century - after the registration had been obtained in 1965.

156. As against this, there is clear evidence, both documentary and oral, of PMD having used the FIELDMARSHAL mark for centrifugal pumps at least since 1975. The sales figures and advertisement expenses on record indicate that, by 1988, it had amassed considerable goodwill in the FIELDMARSHAL mark for centrifugal pumps.

157. By the time Thukral commenced using the FIELD MARSHAL mark for centrifugal pumps, therefore, PMD had considerable goodwill in the same mark, for the same goods. ***Viewed thus, there is clearly no reason for us to interfere with the decision of the learned Single Judge from injuncting Thukral from using the FIELD MARSHAL mark for centrifugal pumps***. (Emphasis Supplied)

Trademark law

- ***Thukral Mechanial Works v. PM Diesel Pvt. Ltd., Delhi High Court, LPA 320/2024, Before C. Hari Shankar And O.P. Shukla, JJ.), decided on February 06, 2026***

Analysis – On whether PMD established prior goodwill

*178. This case, to our mind, presents a **classic example of the "Kerly impasse**". While PMD is entitled to an injunction against the use of the FIELD MARSHAL mark by Thukral on the ground of passing off, in view of the goodwill that PMD has amassed between 1975 and 1988, Thukral would equally be entitled to an injunction against PMD on the ground of infringement.*

179. We have spent considerable time reflecting on whether such an injunction, on the ground of infringement, can be granted even where the infringer has acquired goodwill by use of the infringing mark. Indisputably, the right to injunction, in a passing off action, is predicated on goodwill arising from use, whereas the right to injunction, following infringement, is a right arising from registration. This throws, into sharp relief, the oft cited plea that "user trumps registration" in trade mark matters.

192. The rights flowing from registration, under Section 28(1), are subject to the rights of action against any person for passing off. That right of action entitles the owner of goodwill only to injunct the other from continuing to use its mark. It does not, in any way, entitle the owner of goodwill to divest the registrant of the right to obtain relief against infringement, flowing from the registration.

*196. The sequitur is plain. In view of the finding, by the Supreme Court, that PMD had infringed Jain's registration of the FIELD MARSHAL mark for centrifugal pumps, **PMD would be liable to be injuncted against continuing to use the infringing mark**.* (Emphasis Supplied)

Trademark Law

- ***Alkem Laboratories Limited v. Prevego Healthcare and Reaserach Private Limited, CS COMM - 84/2025 Delhi High Court, Hon'ble Justice Tejas Karia, decided on January 17, 2026; Single Judge Bench***

Facts -

The Plaintiff, Alkem Laboratories Limited, asserted longstanding use of the marks, 'A TO Z' since 1998 and 'A TO Z-NS' since 2008, for its multivitamin and multimineral dietary supplement products. The dispute arose in December 2024, when the Plaintiff discovered that the Defendant, Prevego Healthcare and Research Pvt. Ltd., was selling and marketing pharmaceutical tablets under the mark MULTIVEIN AZ, and using a near identical colour scheme on its packaging. The Plaintiff filed a suit for trademark infringement, passing off, and copyright infringement, and obtained an ex-parte ad-interim injunction on 30 January 2025 restraining the Defendant from using the impugned mark. The Defendant subsequently filed an application to vacate that injunction.

Figure 1. Plaintiff's marks versus impugned mark

PLAINTIFF'S MARKS	IMPUGNED MARK
AZ A TO Z - NS A to Z- NS	MULTIVEIN AZ Multivein AZ

32

Figure 2. Plaintiff's trade dress versus impugned trade dress

ip@algindia.com

Trademark Law

- ***Alkem Laboratories Limited v. Prevego Healthcare and Reaserach Private Limited, CS COMM - 84/2025 Delhi High Court, Hon'ble Justice Tejas Karia, decided on January 17, 2026; Single Judge Bench***

Issues –

- Whether the 'A TO Z' mark is generic or descriptive in nature
- Whether the impugned mark 'MULTIVEIN AZ' is deceptively similar to Alkem's registered marks
- Whether Alkem's concealment of material facts regarding its prior trademark applications disentitles it to equitable relief.
- Whether Alkem's copyright in its artistic logo and trade dress is infringed by Prevego's mark and packaging.

- ***Alkem Laboratories Limited v. Prevego Healthcare and Reaserach Private Limited, CS COMM - 84/2025 Delhi High Court, Hon'ble Justice Tejas Karia, decided on January 17, 2026; Single Judge Bench***

Analysis of the Court –

- *"14. Considering the submissions of both Parties, it is clear that 'A TO Z' can represent completeness or comprehensiveness.* ***As the Plaintiff's Products using the Plaintiff's Marks pertain to nutraceuticals and multivitamins, it describes the goods as Vitamins are commonly known by various alphabets. Therefore, multivitamin products can be described by 'ATO Z' encompassing several different types of Vitamins. Therefore, the Mark 'A TO Z' describes the nature of the goods being provided by the Plaintiff as well as the Defendant****. Hence, the Mark 'A TO Z' is descriptive in nature.* *Therefore, the Plaintiff cannot be allowed to monopolize the use of the letters 'A' and 'Z' by seeking exclusivity over the right to use the letters 'A' and 'Z'. The use of letters of the English Language cannot be monopolized by the Plaintiff especially in light of the submission made by the Plaintiff before the Trade Marks Registry in the Opposition proceedings for Trade Mark Application No. 1270049, wherein the Plaintiff conceded that the Device Mark, is stylized and that its protection is limited to its unique, 'intertwined-and conjoined manner.'"* (emphasis supplied)

Trademark Law

- ***Alkem Laboratories Limited v. Prevego Healthcare and Reaserach Private Limited, CS COMM - 84/2025 Delhi High Court, Hon'ble Justice Tejas Karia, decided on January 17, 2026; Single Judge Bench***

Analysis of the Court –

- *"18 . The Plaintiff has obtained registration for the Device Mark ' ' and other associated Marks, however, the Plaintiff has failed to obtain any registration for the word Mark 'A TO Z', further the Plaintiff's Trade Mark Application for registration of the Device Mark for 'A TO Z' in Class 05, i.e., the Class relevant to the present case has been opposed. Accordingly, the Plaintiff's Marks have to be seen as a whole and the Anti-dissection Rule will prohibit dissection of the composite Mark into individual components as per Section 17 of the Trade Marks Act."*
- *"25 . The Plaintiff did not disclose in the present Suit that the Plaintiff had sought registration of the Device Mark for 'A TO Z' in Class 5 vide Trade Mark Application No. 1270049, which has been under opposition since 2007 and that there were other thirdparty applications for registration of the Marks comprising of 'A TO Z' prior to the Application filed by the Plaintiff for registration of the Mark ' ' in 1998.*
- *26 . Accordingly, the Plaintiff is not entitled to any equitable relief on account of concealment of material facts and making contrary assertions…"*

Copyright law

- ***Ustad Faiyaz Wasifuddin Dagar v. A.R. Rahman and Ors., SLP(C) No. 4742/2026, Supreme Court, Hon'ble The Chief Justice Hon'ble Mr. Justice Joymalya Bagchi Hon'ble Mr. Justice Vipul M. Pancholi, Decided on 20 February, 2026***

  Facts - Ustad Faiyaz Wasifuddin Dagar is a well-known Indian classical musician and Padma Shri awardee. He belongs to the famous Dagar Gharana, a lineage of musicians known for the distinctive Dagarvani style of Dhrupad singing. He claimed that his father and uncle (late Ustad N. Zahiruddin Dagar and late Ustad N. Faiyazuddin Dagar, collectively the Junior Dagar Brothers) composed a musical piece titled 'Shiva Stuti' in the 1970s. The composition was performed at several international concerts and released as part of the album 'Shiva Mahadeva by the Dagar Brothers' by PAN Records. After their deaths, Dagar claimed, the rights in their compositions devolved upon him through a family settlement. He continued to perform the 'Shiva Stuti' publicly and teach it to students.

  In 2023, Dagar came across the song 'Veera Raja Veera'. He alleged that its musical composition was similar to the tune of 'Shiva Stuti', though the lyrics were different. Interestingly, the song was sung by two of Dagar's students. They presented 'Shiva Stuti' and other traditional compositions to Rahman in a vocal (tarana-style) form for him to choose from for the film. The movie credits initially stated that the composition was "based on a Dagarvani tradition Dhrupad". Dagar filed a suit before the Delhi High Court, alleging infringement of copyright and violation of moral rights, particularly the right to attribution of the original composers.

Copyright law

- ***Ustad Faiyaz Wasifuddin Dagar v. A.R. Rahman and Ors., SLP(C) No. 4742/2026, Supreme Court, Hon'ble The Chief Justice Hon'ble Mr. Justice Joymalya Bagchi Hon'ble Mr. Justice Vipul M. Pancholi, Decided on 20 February, 2026***

Single Judge's decision

The Single Judge followed a sequential approach, first assessing originality and then examining authorship, ultimately holding both in favour of the plaintiff, and also finding infringement. The Court stated that although 'Shiva Stuti' was based on the Adana Raga, it was not a copy. The Junior Dagar Brothers had selected and arranged the notes, tune and timing to create their own rendition of the raga. The court also recognised that copyright can subsist in Hindustani classical musical works more broadly. On authorship, Dagar's evidence was not the strongest. He was unable to produce documents expressly naming the Junior Dagar Brothers as "composers". Instead, he relied on album covers, international concerts and unsigned musical notes to show that the composition had been created and performed by his father and uncle in the 1970s. For this, the Court took into account the realities of the time. Documentation was not the norm. Many Indian musicians did not read or write musical notation and composed orally, ***with recognition flowing from public performances rather than written records****.. Since the defendants were unable to identify any alternative author, the court concluded that the plaintiff's claim was sufficient, at least at the interim stage, to recognise authorship.* (Emphasis Supplied)

Copyright law

- ***Ustad Faiyaz Wasifuddin Dagar v. A.R. Rahman and Ors., SLP(C) No. 4742/2026, Supreme Court, Hon'ble The Chief Justice Hon'ble Mr. Justice Joymalya Bagchi Hon'ble Mr. Justice Vipul M. Pancholi, Decided on 20 February, 2026***

Division Bench's decision

The Court noted that the Junior Dagar Brothers were the first performers of the composition as the first fixation of the composition was done in 1978 in a concert in Amsterdam. However, the Court stated that while the Junior Dagar Brothers through their material on record could claim performer rights under Section 38 of the Copyright Act, 1994, they could not establish authorship. The Act provides a distinction between performers' rights and authorship rights where a person may be a performer of a work without being its creator. Performance, however skillful, does not amount to any creation.

The Court further noted that to infer authorship solely on the basis of no contrary material would be erroneous as any performer thus can claim authorship by first performing and publishing an original composition. This is problematic specifically in context of Indian classical music, where the music is transmitted orally through generations without formal documentation or any notations. If such a presumption were accepted, it would enable any performer to take any old compositions into their authorship by merely recording them and publishing them first, thereby copyrighting what is unprotected and is in public domain and therefore enjoying the rights under copyright without creating anything. The Court observed that the impugned judgment treated the fixation of performance on the CDs as fulfilling the requirement of fixation and used it as a ground to prima facie hold the plaintiff as authors of the composition. The Court stated that while fixation of performance is a requirement for claiming copyright protection and is one of the grounds for claiming authorship, it would be erroneous to rely on mere performance or fixation to establish copyright especially in traditional Indian music, where work is transmitted orally.

Copyright law

- ***Ustad Faiyaz Wasifuddin Dagar v. A.R. Rahman and Ors., SLP(C) No. 4742/2026, Supreme Court, Hon'ble The Chief Justice Hon'ble Mr. Justice Joymalya Bagchi Hon'ble Mr. Justice Vipul M. Pancholi, Decided on 20 February, 2026***

Division Bench's decision

The Court further stated that even though the Junior Dagar Brothers performed the composition on stage, there was no direct attribution to them as composers, since there were no written notations, continuous attribution, contemporaneous documentation of creation, etc. proving that the Dagar Brothers originally created the melody or were the composers. The Court also discussed A.R. Rahman's contention that the composition was based on and is a part of the broader Dagarvani/Dhrupad tradition and not an exclusive composition of the plaintiff, and opined that it would be contrary to the objective of copyright law to allow the plaintiff to claim exclusive authorship and monopolise such a work as it would provide exclusive ownership rights over what is purported to be a Dagarvani/Dhrupad cultural work. **The Court further stated that it couldn't be oblivious to the fact that Indian classical music preserves lineage by passing on knowledge from Guru to shishya and naturally a shishya emulate their Guru and their styles, cultural norms relating to use. Thus, the appropriation and transmission of works in the realm of Indian classical music stand on a fundamentally different footing from that of an ordinary literary, dramatic or artistic work**. Therefore, the Court held that the song 'Shiva Stuti' is a part of common Dagarvani tradition as it completely undisputedly attributed to it and therefore, the Junior Dagar Brothers were not the authors of the composition. (Emphasis Supplied)

Copyright law

- ***Ustad Faiyaz Wasifuddin Dagar v. A.R. Rahman and Ors., SLP(C) No. 4742/2026, Supreme Court, Hon'ble The Chief Justice Hon'ble Mr. Justice Joymalya Bagchi Hon'ble Mr. Justice Vipul M. Pancholi, Decided on 20 February, 2026***

Special leave petition

5. On the previous date of hearing, the matter was heard at some length. Having regard to the fact that eminent musicians whose performances are broadly acknowledged are in contest in the civil suit, ***we have persuaded the parties to consider an alternative interim arrangement, regardless of the reasons assigned by the learned Single Judge or the Division Bench****. Upon persuasion,* ***respondent No.1 has agreed that, as an interim arrangement, on all OTT and online platforms, the slide depicting the credits*** *in respect of the subject song shall be as follows:*

"Composition inspired from the Dagarvani Tradition Dhrupad, first recorded as "Shiva Stuti" by late Ustad N. Faiyazuddin Dagar and nephew of late Ustad N. Zahiruddin Dagar."

6. ***The respondents have already deposited a sum of Rs.2 crores*** *in terms of paragraph 200(b) of the order of the learned Single Judge dated 25.04.2025. The said amount shall be kept with the Registrar General of the High Court in the same manner as was directed by the learned Single Judge.*

7. Since we have not expressed any prima facie opinion on merits, all the issues are left open for the parties to be agitated in the civil suit. (Emphasis Supplied)

Trademark Law

- ***Landmark Crafts Limited v. Romil Gupta Trading as Sohan Lal Gupta & Anr., LPA 575/2025, Delhi High Court, C. Hari Shankar And O.P. Shukla, JJ, decided on February 25, 2026; Division Bench***

Facts –

The present matter came before the Delhi High Court as an appeal under Section 91 of the Trademarks Act 1999, against an order by the Registrar of Trademarks cancelling the trademark application of the appellant.

The appellant was in the business of self-tapping metal screws and self-drilling screw, and had been using the mark since 2013. He filed a trademark application in Class 6 in 2018. The Registrar issued an Examination Report in November 2018, to which the appellant filed a response in December 2018, along with the following amendment in the applied for mark, as noted by the Court.

The appellant when filing the amendment claimed inadvertent clerical error. In June 2019, the application proceeded towards registration and was subsequently registered. In July 2019, Respondent No. 2, Landmark, filed a rectification petition against the said mark and also obtained an ex-parte interim injunction, which was vacated in October 2019. Later, in July 2020, Respondent No. 2 filed a complaint before the Registrar raising an objection for the first time that the amendment sought in the applied mark was substantial in nature and not permissible under Rule 37 of the Trade Marks Rules, 2017 (‘Rules’), and also that a fresh user affidavit was not filed along with the amendment application..

Trademark Law

- ***Landmark Crafts Limited v. Romil Gupta Trading as Sohan Lal Gupta & Anr., LPA 575/2025, Delhi High Court, C. Hari Shankar And O.P. Shukla, JJ, decided on February 25, 2026; Division Bench***

Facts –

Pursuant thereto, a notice under Section 57(4) was issued on 31 October 2022 stating that the original and amended marks differed substantially and granting 21 days to respond with a hearing fixed on 17 November 2022. By order dated 15 December 2022, the Deputy Registrar cancelled the registration, revoked the registration certificate, and directed re-examination of the application, holding that the amended mark was materially different, the same user date had been wrongly retained, no fresh affidavit or supporting documents for use of the amended mark had been filed, and the amendment had been wrongly allowed. The respondent challenged the order before the Delhi High Court, and by judgment dated 14 May 2025, the learned Single Judge set aside the cancellation order and restored the registration, holding that Rule 100(1) requiring at least one month's notice before exercise of powers under Section 57(4) had been violated since only 21 days' notice was provided, thereby offending principles of natural justice, and further holding that the amendment merely altered the orientation/placement of the letters "SD" without substantially changing the overall structure of the mark, and therefore did not constitute a substantial alteration under Rule 37.

Trademark Law

- ***Landmark Crafts Limited v. Romil Gupta Trading as Sohan Lal Gupta & Anr., LPA 575/2025, Delhi High Court, C. Hari Shankar And O.P. Shukla, JJ, decided on February 25, 2026; Division Bench***

Issues –

- Whether the requirement of giving one month's notice under Rule 100(1) before exercise of powers under Section 57(4) of the Trade Marks Act is mandatory
- Whether the amendment permitted under Rule 37, altering the orientation/placement of the letters "SD" in the device mark, amounted to a "substantial alteration" of the trademark applied for
- Whether Rule 37 required the respondent to file a fresh user affidavit and supporting documents after amendment of the trademark application.

- ***Landmark Crafts Limited v. Romil Gupta Trading as Sohan Lal Gupta & Anr., LPA 575/2025, Delhi High Court, C. Hari Shankar And O.P. Shukla, JJ, decided on February 25, 2026; Division Bench***

Analysis of the Court–

- *"42.* ***The plea that the stipulation of one month's notice, as stipulated in Rule 100(1), has, to our mind, necessarily to be regarded as mandatory****. Mr. Sai Deepak submits that such a provision can be regarded as mandatory only if failure to comply with it results in prejudice. We fail to understand what greater prejudice could result than cancellation of the registration of the trade mark registered in favour of the respondent."*
- *"43. .....w****hen the statute requires a particular act to be done in a particular manner, that act has to be done in that manner alone, or not done at all, all other modes of performance being necessarily forbidden. The prescription of one month's notice in Rule 100(1) is, therefore, clearly mandatory****...."*
- *"54. The proviso to Rule 37, however, restricts its scope, but to an extent. It states, inter alia, that no amendment shall be permitted which shall have the effect of substantially altering the trademark applied for. It does not, however, provide any yardstick by which to gauge whether an alteration of a trade mark, applied for, is, or is not, "substantial"."* (emphasis supplied)

Trademark Law

- ***Landmark Crafts Limited v. Romil Gupta Trading as Sohan Lal Gupta & Anr., LPA 575/2025, Delhi High Court, C. Hari Shankar And O.P. Shukla, JJ, decided on February 25, 2026; Division Bench***

Analysis of the Court–

- *"62. All that remains, then, is to examine whether the view, of the learned Single Judge, that the substitution of , with , as the mark of which registration was being sought, involved no "substantial alteration". The learned Single Judge has arrived at a conclusion that it does not, after a meticulous comparison of the two marks.* ***In the absence of any yardstick, otherwise prescribed, regarding the manner in which the stipulation of "substantial alteration" is to be assessed, and applying the understanding of the expression "substantial" as defined by the Supreme Court in Santosh Hazari, the approach of the learned Single Judge commends deference.*** *The view being purely subjective, we see no reason to differ therewith, within the limited scope of letters patent jurisdiction."*
- *57.* ***We do not find, in Rule 37, any requirement of submitting any fresh affidavit of user. We are clear in our mind that a requirement, which is not to be found in the statute, cannot be imposed by judicial fiat.*** *If the alternation in the mark is substantial, the very application for correction under Rule 37 would be liable to be rejected. The question of a fresh affidavit of user, then, becomes redundant. If, on the other hand, the alteration is not substantial, the claim of user of the original mark would obviously apply, equally, to the altered mark, as the alteration is insubstantial in nature."* (emphasis supplied)

Trademark law

- ***Bhole Nath Foods Ltd v. Kirorimal Kashiram Marketing and Agencies Pvt Ltd, FAO (Comm.) 79/2025, Delhi High Court, C. Hari Shakar, Om Prakash Shukla, JJ. Decided on January 09, 2026***

Facts - This appeal challenged the judgment dated 6 November 2024 of the District Judge, whereby the Commercial Court granted an interlocutory injunction restraining Bhole Nath Foods Ltd. (BNF) from using the word mark CHEETAL and the associated device mark in relation to rice, in favour of Kirorimal Kashiram Marketing and Agencies Pvt. Ltd. (KKM). KKM had sued BNF alleging deceptive similarity between BNF's CHEETAL marks and KKM's registered DOUBLE DEER word and device marks (user since 1966). BNF appealed under Section 13 of the Commercial Courts Act, 2015 read with Order XLIII Rule 1(r) CPC, seeking vacation of the interlocutory injunction.

Manner of use / presentation by the plaintiff/ respondent	Manner of use / presentation by the defendant/ appellant
Double Deer	Cheetal BASMATI RICE
Regal	Cheetal
Double Deer Classic BASMATI RICE	Cheetal

ip@algindia.com ALG India Law Offices LLP www.algindia.com

Trademark law

- ***Bhole Nath Foods Ltd v. Kirorimal Kashiram Marketing and Agencies Pvt Ltd, FAO (Comm.) 79/2025, Delhi High Court, C. Hari Shakar, Om Prakash Shukla, JJ. Decided on January 09, 2026***

Analysis - No infringement action against registered trade mark

"10..BNF is the registered proprietor of the word mark CHEETAL. Section 28(1) of the Trade Marks Act, therefore, confers on BNF exclusive right to use the mark CHEETAL, even by the very aspect of its registration. Equally, Section 30(2)(e) entitles BNF to plead, as a defence to any allegation of infringement, the fact that it was merely exercising the right to use the mark CHEETAL, following on the registration of the mark in its favour. 11.1..Even otherwise, ***the definition of infringement, as contained in sub-sections (1) to (4) of Section 29 of the Trade Marks Act envisages the infringer being a person who is not the registered proprietor of the allegedly infringing mark or the permissive user thereof****. Registered marks, therefore, cannot alleged to be infringing in nature.*

No case made out of passing off

"…12.2. Thus, while an infringement action requires only mark to mark comparison, and added matter is of no relevance, in a passing off action, added matter, as well as other circumstances, may make all the difference. 12.3. Viewed from that perspective, ***it is clear that there is no similarity between the marks of BNF and KKM as would sustain a claim of passing off. The mere fact that both the marks contain images of deer as part of the marks would not render them visually similar****. A bare glance at the two images does not convey any impression of likelihood of confusion between them even when viewed from the perspective of a consumer of average intelligence and imperfect recollection…"* (Emphasis Supplied)

Trademark law

- ***Bhole Nath Foods Ltd v. Kirorimal Kashiram Marketing and Agencies Pvt Ltd, FAO (Comm.) 79/2025, Delhi High Court, C. Hari Shakar, Om Prakash Shukla, JJ. Decided on January 09, 2026***

  Re Idea Infringement

  "...15.3. Madan Lal Purushottam Das is a case which clearly explains the principle of idea infringement. The rival marks, in that case, were used for mustard oil. Both the marks reflected the figure of an ox tethered to a grinding wheel, using which oil was ground from mustard seeds. It was in these circumstances that the Court held that the idea of using the image of an ox tethered to the grinding wheel by which the oil was extracted from mustard seeds, i.e., using the pictorial depiction of the process of extraction of the oil as the logo under which the oil was manufactured and sold, was conceived by the plaintiff (in that case) and that, by adopting an identical idea of the ox tethered to the grinding wheel as the label under which the defendant was marketing and selling its oil, the idea conceived by the plaintiff had been infringed. ***For a claim of idea infringement to sustain, therefore, the plaintiff would have to establish that the idea reflected in its asserted mark was unique, and that the defendant had adopted the same idea as the basis for its mark…****"*

  "...15.6. These cases cannot, in any way, be analogised to the case before us. There is no visual similarity between the two marks. The fact that deer happen to be part of the image in each case cannot be of significance, as the very positioning of the images of the deer is different. If one views the rival marks as a whole, there are enough added features in each mark which could differentiate one from the other. As we have earlier noted, the most visible and prominent distinguishing feature is the very name of the product, which is also prominently displayed on the label…" (Emphasis Supplied)

THANK YOU!

Questions?

Bhavya & Manish Kumar
Associates

Disclaimer: Views, opinions, and interpretations are solely those of the presenters, not of the firm (ALG India Law Offices LLP) nor reflective thereof.

This presentation hosted at: https://www.algindia.com/wp-content/uploads/2026/06/Final-SLIS_PPT_Bhavya_Manish_V2-1.pdf