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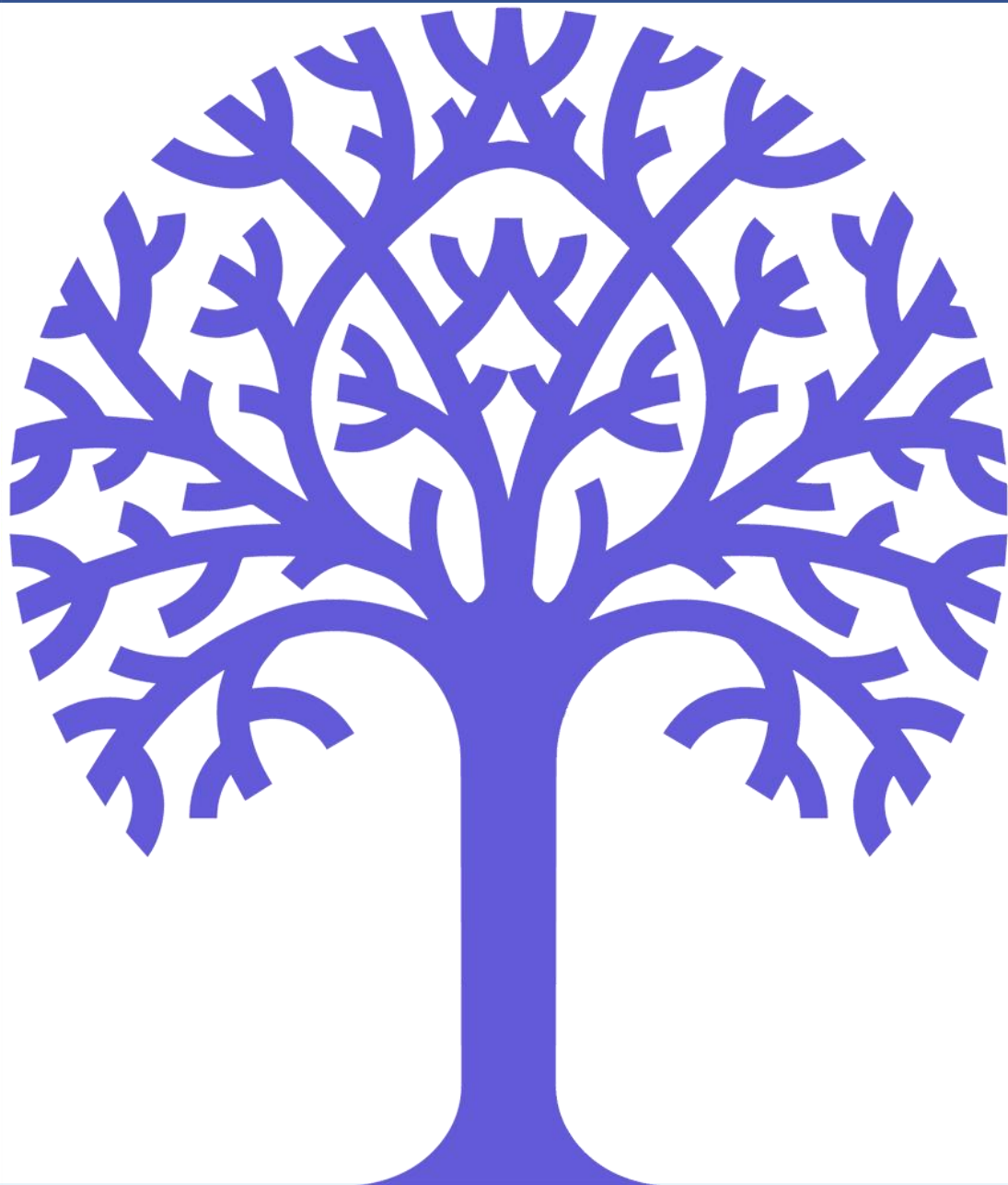
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Article

Battle of the Armours: When 'Under' meets 'Aero' in trademark turf war

By Kriti Sood, Divya Vishvapriya and Geethanjali Kv

The article in this issue of IPR Amicus discusses a recent Delhi High Court decision which not only brings into focus the legal standards applied to determine trademark infringement but also explores the boundaries of protection for globally recognized brands under Indian law. Elaborately discussing the judgement of the Division Bench which overruled the Single Bench decision, the article notes that the decision establishes that initial interest confusion is sufficient for infringement under Section 29 of the Trade Marks Act, 1999. The decision also revolved around the likelihood of confusion, dishonest adoption, protection for strong marks, non-dissection rule, global appreciation, and consumer sophistication. According to the authors, the decision marks a pivotal moment in Indian trademark jurisprudence, as the recognition of the doctrine of initial interest confusion brings Indian law in alignment with international standards and better reflects the realities of digital consumer behaviour.

Battle of the Armours: When 'Under' meets 'Aero' in trademark turf war

By Kriti Sood, Divya Vishvapriya and Geethanjali Kv

In an evolving marketplace where brand identity is pivotal to consumer trust and commercial success, the protection of trademarks has become more critical than ever. The case of *Under Armour Inc. v. Aero Armour & Ors.*¹, decided by the Division Bench of the Delhi High Court on 23 May 2025, presents a significant examination of trademark law in India. It not only brings into focus the legal standards applied to determine infringement but also explores the boundaries of protection for globally recognized brands under Indian law. This case serves as a touchstone for understanding how Indian courts interpret key concepts such as deceptive similarity, initial interest confusion, and the legal weight of dominant elements within composite marks.

Introduction

In the case of *Under Armour Inc. v. Aero Armour & Ors.*, the Division Bench (two-judge Bench) of the Delhi High Court overturned a Single Judge's decision that declined interim relief to the Appellant/Plaintiff, and addresses critical questions

surrounding trademark infringement and the scope of brand protection under the Trade Marks Act, 1999.

At the heart of the dispute lies a conflict between Under Armour Inc., a globally recognized U.S.-based sportswear brand, and the Respondents, who marketed clothing under the name 'Aero Armour'. The case stems from an appeal filed by Under Armour challenging a Single Judge's refusal to grant an interim injunction against the Respondents' use of the allegedly infringing mark, albeit, placing certain specified limitations on the Respondent/Defendant.

The central legal issues revolve around the concepts of deceptive similarity, initial interest confusion, and the potential dilution of a well-established trademark. This decision is significant in reinforcing the principles governing composite marks, the relevance of dominant elements in trademark comparison, and the level of protection afforded to strong, well-known brands when facing potentially misleading or opportunistic market entrants.

¹ *Under Armour Inc. v Anish Agarwal & Anr.* (23.05.2025 - DELHC): 2025:DHC:4243-DB; FAO(OS) (COMM)-174/2024

The legal foundation of the ruling: Section 29 of the Trade Marks Act

The Court's decision was largely based on Sections 29(1), 29(2), and 29(4) of the Trade Marks Act, 1999. These sections confirm that using a similar or identical mark without permission constitutes trademark infringement, that even pre-purchase confusion is enough to prove infringement, and that well-known brands receive stronger legal protection. The order specifically upheld 'initial interest confusion', where a consumer is drawn to an infringing mark before buying, as a valid basis for infringement.

These provisions collectively assert that unauthorized use of an identical or deceptively similar mark constitutes infringement, that the likelihood of confusion (even at a pre-purchase stage) is sufficient to establish such infringement, and that well-known marks are afforded enhanced protection. The order particularly emphasized the concept of 'initial interest confusion', affirming that if a consumer's attention is initially captured by an infringing mark due to its similarity, even if they later realize the distinction, it satisfies the test for trademark infringement under Indian law, especially for strong, established brands like Under Armour.

Section 29(1) broadly states that a registered trademark is infringed when someone, without authorization, uses a mark identical or deceptively similar to it in the course of trade, in relation to goods or services for which the trademark is registered. This provision lays the foundational principle that unauthorized use of a confusingly similar mark for similar goods or services constitutes infringement.

Section 29(2) elaborates on the likelihood of confusion, stipulating that a registered trademark is infringed if an unauthorized mark, due to its identity or similarity with the registered mark and the identity or similarity of the goods or services, is likely to cause confusion on the part of the public, or is likely to have an association with the registered trademark. Crucially, the order in *Under Armour* affirmed that this likelihood of confusion can exist even at a pre-purchase stage, introducing and reinforcing the concept of 'initial interest confusion'. This means that if a consumer's attention is captured by an infringing mark and they are initially led to believe there's a connection to the original brand, even if they later realize the distinction before purchase, it can still be considered infringement.

Furthermore, Section 29(4) extends protection to well-known marks, even if the infringing mark is used for goods or

services that are not similar to those for which the trademark is registered. This subsection is particularly relevant for brands with a strong reputation, as it protects against dilution and unfair advantage. It essentially prevents others from 'riding on the coattails' of a famous brand's established goodwill and reputation, even in unrelated product categories, if such use is detrimental to the distinctive character or repute of the registered trademark or takes unfair advantage of it. The *Under Armour* order emphasized that even a brief consumer misdirection, such as clicking a link under mistaken assumptions due to a perceived association with a premium brand, can damage the original brand's market position, falling within the purview of these protective provisions.

Brief background and facts

Under Armour Inc., the Appellant in this case, is a globally recognized U.S.-based sportswear and accessories brand founded in 1996 by Kevin Plank, with trademark registrations and brand presence extending across multiple jurisdictions, including India. Anish Agarwal and another, the Respondents, on the other hand, are engaged in the manufacture and distribution of clothing under the trademark 'Aero Armour' and 'ARMR'.

A Single Judge of the Delhi High Court earlier ruled against Under Armour's request for an interim injunction to restrain the Respondents from using the allegedly infringing mark. Applying the Global Appreciation Test, the Court concluded that there was no deceptive similarity or likelihood of confusion between the two marks, particularly in the light of the differing commercial features and unique selling points of the respective brands.

Challenging this decision, the Appellants filed an appeal and the Division Bench reversed the Single Judge's decision. Central to their argument was the concept of 'Initial Interest Confusion' the idea that even if consumers are briefly misled into associating Aero Armour with Under Armour, such momentary confusion is sufficient to constitute trademark infringement. The Appellants contended that this initial association allows the Respondents to unfairly benefit from the established goodwill and market recognition of the Under Armour brand, thereby creating an uneven playing field in the competitive sportswear market.

Questions of law for determination

- I. **Trademark Infringement:** Whether the Respondent infringed the registered trademarks of the Appellant.

- II. **Initial Interest Confusion:** Whether initial interest confusion where consumers are momentarily misled is sufficient to establish trademark infringement.
- III. **Likelihood of Confusion:** Whether there exists any likelihood of confusion or deceptive similarity between the Appellant's and Respondent's marks.

Appellant's contention

The Appellant argued that the Respondents' marks closely resembled their 'Under Armour' trademark in structure, font, and overall presentation, creating a deceptive similarity likely to confuse the average consumer. They contended that the use of the mark 'AERO ARMOR' was a deliberate attempt to exploit the goodwill and reputation of the Under Armour brand, amounting to passing off. Furthermore, the continued use of such marks risked diluting the brand's distinctiveness, especially as the respondents' products were sold at significantly lower prices, potentially misleading consumers and undermining the premium image of the appellant's brand.

Respondents' contention

The Respondents contended that the Appellant cannot claim exclusive rights over the word 'Armour', which is

commonly used in trademarks across various industries. Once 'Armour' is excluded, the remaining elements 'Under' and 'Aero' bear no visual or phonetic similarity, eliminating any likelihood of confusion. They further argued that their branding draws inspiration from military themes, distinct from the appellant's sports-focused identity, and is targeted at a different consumer base. Highlighting their intent, the respondents explained that the name 'Aero Armour' was chosen based on personal and thematic relevance, without dishonest motive. Their logo and design elements, emphasizing military aesthetics, further differentiate their mark from that of the appellant.

Decision of the Court

The Division Bench, after reviewing both sides' arguments, determined that the Single Judge misapplied the initial interest confusion test. They clarified that even a brief association of the Respondent's marks with Under Armour's marks by a customer constitutes trademark infringement. The court also found that the Single Judge incorrectly used the anti-dissection rule by isolating the word 'ARMOUR' instead of comparing the marks in their entirety. Furthermore, the Bench dismissed the Respondent's attempt to distinguish between casual wear and sportswear, recognizing that the goods were, in fact, identical.

Consequently, the Division Bench overturned the Single Judge's decision, finding it to be without merit.

Law settled in the case

In this case, the Court clarified several key aspects of trademark law. It established that initial interest confusion is sufficient for infringement under Section 29 of the Trade Marks Act, 1999, meaning even momentary consumer association with a registered mark is enough. The Court reiterated that the likelihood of confusion is judged from the perspective of an average, imperfectly recollecting consumer. Dishonest adoption of similar marks, especially those mimicking well-known brands, warrants an injunction. The degree of protection for a trademark is directly proportional to its strength, requiring new entrants to maintain greater distance from strong marks. While acknowledging the non-dissection rule and global appreciation test, the court found the initial assessment of no confusion erroneous due to strong phonetic and visual similarities and similar trade channels. Finally, it clarified that consumer sophistication does not negate infringement, as even informed consumers can experience initial confusion, particularly in dynamic market environments.

The Ruling's main tenets:

- ***Initial Interest Confusion:*** Brief consumer confusion linking a mark to a registered trademark is infringement under Section 29, Trade Marks Act, 1999.
- ***Likelihood of Confusion:*** Infringement is assessed by whether an average consumer would briefly associate the challenged mark with the registered one.
- ***Dishonest Adoption:*** Adopting a mark deceptively similar to a well-known trademark, particularly dishonestly, merits an injunction.
- ***Protection for Strong Marks:*** Well-known trademarks receive greater protection, requiring new marks to be significantly distinct.
- ***Non-Dissection Rule & Global Appreciation:*** Courts evaluate overall phonetic and visual similarity, trade channels, and product placement, not just isolated elements, to determine confusion.
- ***Consumer Sophistication:*** Even informed consumers can experience initial confusion due to modern market trends, which doesn't negate infringement.

Analysis

This case addresses the nuanced contours of trademark infringement, specifically examining the doctrine of initial interest confusion and its relevance in contemporary consumer environments. At issue was whether the Respondent's marks 'Aero Armour' and 'Aero ARMR' created a likelihood of confusion with Under Armour's registered trademarks. The Division Bench of the Delhi High Court held that confusion need not be confined to the point of purchase, even momentary misdirection or mistaken association in the early stages of consumer engagement can constitute infringement.

This Division Bench order rejected the Single Judge's assumption that modern consumers would discern brand distinctions and appropriately integrates behavioral insights, recognizing that consumers often form impressions within milliseconds,² and that these impressions are shaped by cognitive biases,³ online algorithms, and rapid digital interactions.⁴ The Court held that initial confusion, such as

clicking a link under mistaken assumptions, harms a brand's market position by creating an unfair association. The Court acknowledged that consumers typically do not dissect trademarks analytically but rather rely on overall commercial impressions. The use of the dominant term 'Armour', combined with the phonetic similarity of 'ARMR', supports a finding of deceptive similarity, especially when these products are sold under the same class (Class 25) on similar e-commerce platforms like Amazon and Myntra.

The case also demonstrates the vulnerability of strong marks with established goodwill.⁵ Even absent direct confusion, the perception of association, however brief, can erode brand distinctiveness and amount to unfair advantage. The Respondents' arguments based on thematic distinctions, such as military imagery or the prefix 'Aero', were found irrelevant, as they failed to negate the dominant consumer impression. The order applies a global assessment of similarity,⁶ taking into account visual, phonetic, and conceptual

² Gitte Lindgaard et al., Attention Web Designers: You Have 50 Milliseconds to Make a

Good First Impression! 25 BEHAV. & INFO. TECH. 115, 115 (2006)

³ Michael Hopkin, Web Users Judge Sites in the Blink of an Eye, NATURE NEWS, Jan. 13,

2006, <http://www.nature.com/news/2006/060109/full/060109-13.html>

⁴ Jacoby, J., Speller, D. E., & Berning, C. K. (1974). Brand Choice Behavior as a Function of Information Load: Replication and Extension. *Journal of Consumer Research*, 1(1), 33–42. <http://www.jstor.org/stable/2488952>

⁵ *Hamdard National Foundation (India) and Another v. Sadar Laboratories Pvt. Ltd.*, 2022 SCC OnLine Del 4523

⁶ *Adidas-Salomon AG v. Fitnessworld Trading Ltd.*, Case C-408/01, [2003] ECR I-12537

elements, reinforcing the principle that brand protection must evolve in response to digital marketing and real-world consumer behaviour.

Conclusion

The Delhi High Court's ruling in this case marks a pivotal moment in Indian trademark jurisprudence, affirming that even initial consumer confusion, however momentary, is sufficient to establish infringement, particularly when strong marks are involved. The recognition of the doctrine of initial interest confusion⁷ brings Indian law in alignment with international standards and better reflects the realities of digital consumer behaviour.

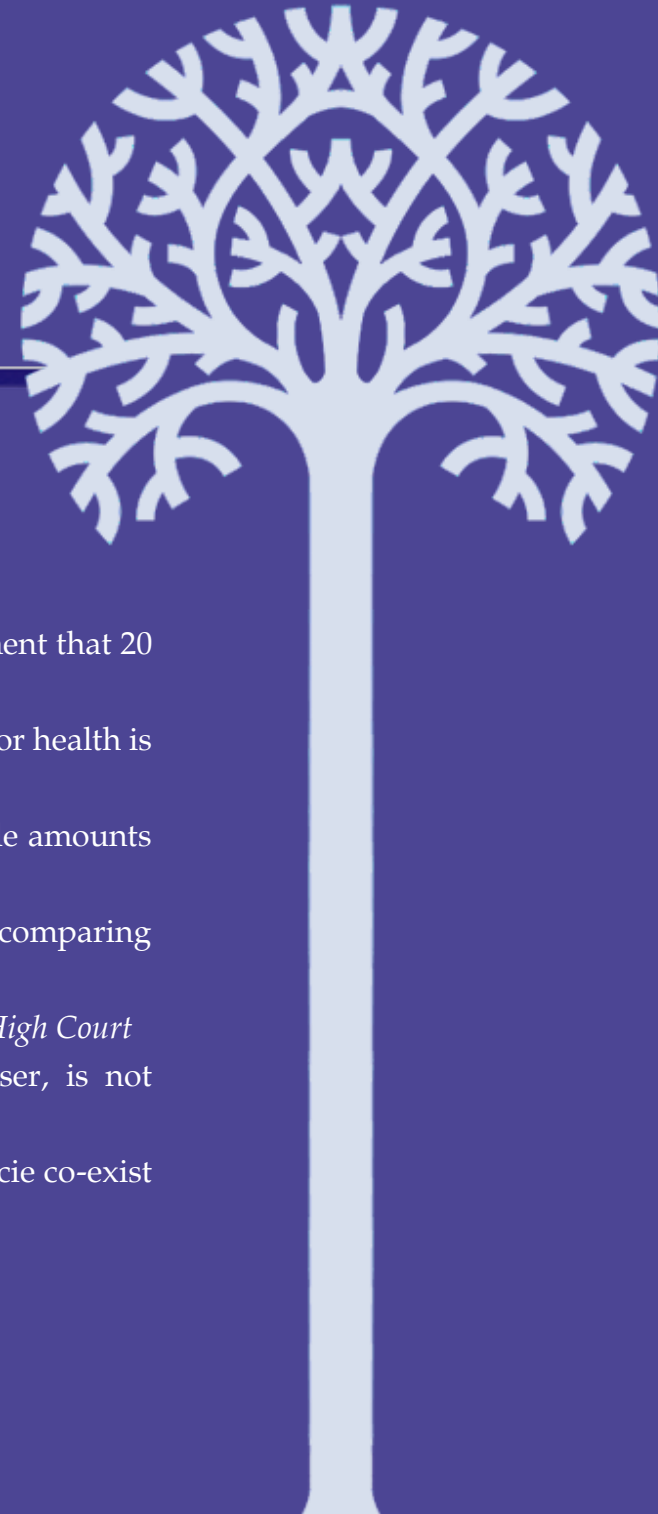
By dissecting composite trademarks and emphasizing dominant mark components, the Court has strengthened the

legal safeguards for reputed brands against dilution and misappropriation. The ruling sends a clear signal that imitation, whether phonetic, visual, or thematic, will not be tolerated when it exploits the goodwill of established trademarks. This precedent is valuable not just for trademark proprietors but also for legal practitioners and entrepreneurs, urging greater caution in brand development and stronger vigilance in protecting brand equity. It underscores a progressive shift in Indian trademark law, toward more robust, behaviorally attuned protection for intellectual property in an algorithm-driven economy.

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⁷ First used in U.S. case of *Grotrian Steinway & Sons* 365 F. Supp. 707 (1973); later used in *Google LLC v. DRS Logistics Ltd.*, 2023 SCC OnLine Del 4809

Ratio Decidendi



- Patents – No discrepancy or inherent contradiction in Section 53 vis-à-vis Section 11A – Argument that 20 years tenure should commence from date of grant/publication, rejected – *Calcutta High Court*
- Patents – Rejecting patent under Section 3(b) with subjective concerns of morality, public order or health is wrong – *Calcutta High Court*
- Copyrights – Compulsory license – Unreasonable terms for making copyrighted work available amounts to ‘refusal’ under Section 31(a) on part of the owner – *Delhi High Court*
- Designs – No inflexible principle in design law for not breaking up features of a design while comparing with a registered design – *Delhi High Court*
- Trademark rectification – Timelines for notice, as provided in Rule 100, are mandatory – *Delhi High Court*
- Trademark infringement – Defence that the allegedly infringed mark had died by non-user, is not sustainable – *Delhi High Court*
- Trademarks ‘Pro-ease’ used for hygiene products and ‘Pruease’ used for medicine can prima facie co-exist – *Delhi High Court*

Patents – No discrepancy or inherent contradiction in Section 53 vis-à-vis Section 11A – Argument that 20 years tenure should commence from date of grant/publication, rejected

The Calcutta High Court has held that there is no discrepancy or inherent contradiction in Section 53 *vis-à-vis* Section 11A of the Patents Act, 1970. The Court also rejected the contention that Section 53 should be struck down on the grounds of being *ultra vires* Constitution of India.

As per Section 53, the term of a patent is 20 years from the date of filing of the application, while Section 11A(7) allows certain privileges and rights to the patent applicant from the date of publication of the patent application. Relying on this, the patent holder-petitioner had submitted that twenty years' tenure of a patent ought to commence from the date of its grant or at least its publication, and not from the date of its application.

Rejecting the submission, the High Court held that the gradation of the stages and the associated rights for each stage is not unreasonably discriminatory, thus fulfilling the test of Article 14 of the Constitution, and constitutional viability in general. The Court was of the view that Section 53 is not mutually exclusive or inherently contradictory with Section 11A, which confers

certain additional privileges on an applicant in the interregnum between the publication and grant of a patent.

It was thus held that such conferment of additional rights on publication, which are limited in nature inasmuch as litigation for infringement cannot be instituted (within the period as specified in Section 11A), is entirely within the domain of legislative discretion. According to the Court, such conferment of limited rights *ipso facto* cannot be a ground for demanding further rights.

Also, discussing the three stages of a patent – filing, publication and grant, the Court was of the view that since said gradation was intended by the Parliament and there being no patent arbitrariness in the same, such discretion cannot be interfered with in judicial review.

It may be noted that the High Court for this purpose noted that legislative wisdom cannot be readily interfered with by the courts merely because a different perspective is, in the opinion of the court, possible. It was noted that the standard of interference with legislation stands on a much higher footing of constitutionality than an administrative action, since the starting point of such an adjudication is a presumption of constitutionality of a statute.

20 years' term from the date of the application was also held in consonance with Section 45 of the Patents Act and in tune with the Article 33 of the Agreement on Trade-Related Aspects of Intellectual Property Rights ('TRIPS Agreement') of the WTO.

[*Gunjan Sinha @ Kanishk Sinha and another v. Union of India – Judgement dated 7 May 2025 in WPA No. 8691 of 2023, Calcutta High Court*]

Patents – Rejecting patent under Section 3(b) with subjective concerns of morality, public order or health is wrong

The Calcutta High Court has observed that Section 3(b) of the Patents Act, 1970 ought not to be interpreted to deal with all subjective concerns of morality, public order or health regardless of any scientific or technical evidence or any cogent reasoning.

Setting aside the rejection of patent to the invention titled 'A Heater Assembly to Generate Aerosol', the Court observed that the impugned order erroneously proceeded on the basis that the invention shall exclusively be only used with substrates comprising of active tobacco compounds and thus cause prejudice to human life and health. The Court in this regard also observed that the preconceived and subjective notion that all tobacco products cause serious prejudice to human life and

health, without any reliance on scientific or technical evidence or any other supporting facts, is unsustainable.

It was also held that the Controller erroneously interpreted Section 83(e) in assuming that the grant of patent would commercialize the product and would affect public health. The Court noted that the grant of patents does not control whether or how an invention is exploited, as the grant does not confer upon the patentee the right to use, sell or otherwise manufacture the subject invention.

Remanding the matter back to the Controller to decide the same afresh, the Court noted that the Controller had not provided any reasons nor furnished any justification while rejecting the patent citing Section 3(b). While setting aside the impugned order, the Court also noted that there was violation of principles of natural justice as three additional documents were cited in the impugned order without providing an opportunity to the applicant to deal with the same.

[*ITC Ltd. v. Controller of Patents Designs and Trademark – Judgement dated 20 May 2025 in IPDPTA/13/2024, Calcutta High Court*] Also, see May 2025 issue of LKS IPR Amicus ([here](#)) for another Calcutta High Court decision holding that Section 3(b) is the intent principle and not the effect or harm principle.

Copyrights – Compulsory license – Unreasonable terms for making copyrighted work available amounts to ‘refusal’ under Section 31(a) on part of the owner

The Delhi High Court has held that offer to make copyrighted work available on unreasonable terms, would also amount to ‘refusal’ under Section 31(a) of the Copyrights Act, 1957, on the part of the owner of the copyright. Alleging that the license fee being charged by the respondent (owner of copyright in certain sound recordings) was huge, the petitioner (an event organizing company) had in this case sought grant of a compulsory license in its favour with regard to the repertoire of sound recordings in which the respondent had copyrights, so that the petitioner could communicate the said sound recordings to the public.

Finding merit in the prayer of the petitioner for a compulsory licence on fair and reasonable tariff, the Court observed that if the petitioner is required to pay the licence fee for each event they organise, as per the respondent’s tariff rate, it will place an undue burden on the petitioner and the general public. The High Court noted that the licence fee demanded by the respondent was not commensurate with market standards, as compared to

another such society which charged lesser licence fee for their repertoire of songs.

Rejecting the contention that for refusal in terms of Section 31(a), there must be a downright refusal, the Court also did not agree with the submission that there is no withholding of copyrighted work, as the same was available to the public on the tariffs as available on the respondent’s website. According to the Court, there is an obligation upon the respondent to charge fair and reasonable licence rates.

Further, the High Court also rejected the contention that the Court cannot go into the issue of reasonableness of the terms while dealing with cases covered under Section 31(a) dealing with performance in public. The respondent had pleaded that the term ‘reasonable’ appears only in Section 31(b) dealing with broadcast. The High Court here for this purpose, relied upon the tenor of the principles laid down by the Supreme Court in *Entertainment Network (India) Limited v. Super Cassette Industries Limited* [(2008) 13 SCC 30]. The Court noted that the Apex Court had deprecated unfair trade practice and had laid down in categorical terms that monopoly is not encouraged in our constitutional scheme of statute.

The High Court also rejected the contention that the right to ‘perform the work in public’, is limited to literary, dramatic and

musical works. Taking note of the definitions of ‘work’, ‘publish’ and ‘communication to the public’, the Court observed that ‘performance in public’ of the work, would also include sound recording, and thus the performance in public of a sound recording, when refused, which includes raising unreasonable and arbitrary demand towards tariff/licence fee, would attract the rigors of Section 31(a).

According to the Court, it can thus proceed to determine the terms and conditions of license for the copyrighted work if it finds that the terms offered by the copyright owner were not reasonable.

[*Al Hamd Tradenation v. Phonographic Performance Limited* – Judgement dated 13 May 2025 in C.O.(COMM.IPD-CR) 8/2024, Delhi High Court]

Designs – No inflexible principle in design law for not breaking up features of a design while comparing with a registered design

The Delhi High Court has rejected the contention that the features of a design of the new proposed product (self-inking stamp here) cannot be broken up while effecting a comparison with a registered design. Rejecting the submission that the article must be seen as a whole *vis-a-vis* the registered design, the Court

observed that the principle regarding comparison of rival marks as a whole is present in trademark law, and that there is no such inflexible principle in design law.

Dismissing the appeal in *limine*, the Division Bench of the High Court was of the view that when the configuration of the article constitutes one of the main elements of a design registration, comparing the individual elements of the design of the new product with the elements of the registered design cannot be faulted.

Further, the Court upheld the finding that while examining a charge of design piracy, it has not to proceed from the point of view of a ‘person of average intelligence and imperfect recollection’ but must examine the article *vis-à-vis* the registered design as it would appear to an ‘instructed eye’, which is aware of the features of the registered design.

The impugned decision of the Single Judge, examining the individual features of the new self-inking stamp of the respondent *vis-à-vis* the registered design of the appellant, and finding that the former was not infringing in nature, was thus upheld.

It may also be noted that the Division Bench also noted that the appeal was against an interlocutory order passed by the Single

Judge, and hence there was no basis for interference even if there was a *prima facie* different view.

[*Trodat Gmbh & Anr. v. Addprint India Enterprises Pvt. Ltd. & Anr.* – Judgement dated 20 May 2025 in FAO(OS) (COMM) 93/2025, Delhi High Court]

Trademark rectification – Timelines for notice, as provided in Rule 100, are mandatory

The Delhi High Court has observed that the requirements and timelines prescribed under Rule 100 of the Trade Marks Rules, 2017 are mandatory.

The Trademark Registry had given a notice to the trademark owner-appellant calling upon him to show cause as to why the registration granted in his favour should not be cancelled. The notice dated 31 October 2022 gave an opportunity to the appellant to file response/ submissions within 21 days and called upon him to be present for hearing on 17th November 2022.

Observing that Rule 100 provides that the Registrar of Trade Marks is required to give at least one month's notice, the Court held that the notice was not only in violation of the provisions of the Act but was also against the principles of natural justice.

The submission that the appellant never took this objection in the hearing before the Registrar was rejected while the Court held that there cannot be any question of waiver of such requirements and timelines as prescribed under Rule 100.

[*Romil Gupta trading as Sohan Lal Gupta v. Registrar of Trade Marks & Anr.* – Judgement dated 14 May 2025 in C.A.(COMM.IPD-TM) 1/2023, Delhi High Court]

Trademark infringement – Defence that the allegedly infringed mark had died by non-user, is not sustainable

The Delhi High Court has observed that no one can infringe the mark and, thereafter, plead, as a defence to infringement, that the allegedly infringed mark had 'died' by non-user.

Noting that the Trade Marks Act, 1999 does not envisage any such automatic death of a registered trademark, the Court also held that there is no provision which disentitles the proprietor of a registered trademark from seeking relief against infringement on the ground that the mark had not been used or substantially used. The Court was of the view that Section 28(1) of the Trade Marks Act does not make the right to seek relief against infringement dependent on user of the mark. It was also noted



that 'infringement', as defined in Section 29, solely requires the allegedly infringed mark to be registered (not used), and that non-user of the mark is not one of the circumstances envisaged in Section 30 (limits on effect of registered trademark) either.

The High Court in this regard noted that any person who desires to use an identical mark has to apply to the Registrar of Trade Marks for invalidation of the mark on the ground of non-user under Section 47, and once it is invalidated and removed from the register, he is free to use the mark or any mark similar thereto.

Delhi High Court's earlier decision by a Division Bench in the case of *Veerumal Praveen Kumar v. Needle Industries (India) Ltd.* [93 (2001) DLT 600 (DB)] was distinguished by the Court here while it observed that the earlier decision did not notice Section 47. The Court was of the view that *Veerumal* decision cannot be regarded as laying down a universal principle that, in every case, an infringer of a registered trademark can plead, as a defence to infringement, that the trademark had perished for non-use.

[*MS Oxygun Health Pvt. Ltd. & Ors. v. Pneumo Care Health Pvt. Ltd. & Anr.* – Judgement dated 13 May 2025 in RFA(COMM) 271/2025, Delhi High Court]

Trademarks 'Pro-ease' used for hygiene products and 'Pruease' used for medicine can *prima facie* co-exist

The Delhi High Court has upheld the rejection of interim relief in a case where the appellant-plaintiff was using its mark/label 'PRO-EASE'  for goods like sanitary napkins, sanitary towels, pads etc., while the respondents-defendant was using the mark 'PRUEASE'  for medicine claimed to be giving relief against constipation.

Upholding the decision by the District Court, the High Court noted that the two goods were neither allied nor cognate, and that the nature of goods, their trade channel, their purpose, and the intended consumers were distinct. It was thus held that there was no likelihood of confusion being caused by the use of the marks for such goods.

The High Court also noted that no case of passing off was made out as the packaging of the products and the manner of the depiction of the mark along with other additional ingredients of the label did not indicate any likelihood of confusion resulting in the use of the same.

The High Court also rejected the Appellant's pleas that non-grant of injunction may prevent the appellant from expanding

its business to pharmaceuticals, and that the respondents may venture out to the products like sanitary napkins, etc. In respect of the second plea, the Court noted that the respondent had stated that they do not intend to use their marks for sanitary goods, etc., as also evidenced from the fact that they had withdrawn their oppositions to the appellant's applications seeking registration of its mark.

Dismissing the appeal and holding that there was absence of *prima facie* case, the Court also noted that respondents had taken

the first three alphabets from the chemical compound prucalopride and added the word 'Ease' to the same, for reflecting the ultimate use of the medicine, that is, giving relief to constipation. According to the Court, the adoption appears to be *bona fide* and in accordance with industry practice.

[*RSPL Health Pvt. Ltd. v. Sun Pharma Laboratories Limited & Anr.* – Judgement dated 12 June 2025 in FAO (COMM) 65/2025, Delhi High Court]



News Nuggets

- Trademarks – Action for infringement whether can lie against a registered trademark – Matter referred to Larger Bench of Delhi High Court
- Trademarks – Trade channel test must be applied with greater contextual sensitivity
- Patents – Rejection of patent without elaborating as to how the amendment broadens the scope of original claim is serious infirmity
- Patents – Rejection under Section 3(d) – Controller to identify ‘known substance’ in hearing notice
- Design and Copyright – Registration of photograph of a product, which is covered under Design law, is correct under Copyright law
- Trademarks – Stay of suit to file rectification petition – Provisions of Section 124(1)(b)(ii) are not available as matter of right
- Trademarks – Priority of user by itself cannot sustain a finding of passing off or justify grant of interim injunction
- Trademark ‘FIZIFREAK’ is visually, structurally, phonetically and conceptually similar to ‘fi’zi:k’ and ‘FREE:K’
- RITZ and RITZ-CARLTON declared well-known marks in hotels and other related services in hospitality industry
- LV (acronym of LOUIS VUITTON) declared well-known mark for leather goods, apparel, footwear, watches and accessories
- TikTok – Bombay HC upholds rejection of recognition as well-known mark
- EU releases report on intellectual property rights in third countries, counterfeit & piracy watch list

Trademarks – Action for infringement whether can lie against a registered trademark – Matter referred to Larger Bench of Delhi High Court

The Division Bench of the Delhi High Court has disagreed with the coordinate Division Bench which had held that an action for infringement can lie against a registered proprietor of a trademark and that an injunction against use of the mark by such registered proprietor can also be granted by a Court. The Court in the present case was of the view that the right to grant an injunction against the use of a registered trademark, by its proprietor, in respect of the goods or services for which the mark is registered, would violate Section 29(1) to (4), Section 28(1), Section 28(3) and Section 30(2)(e) of the Trade Marks Act, 1999. Thus, the Court in *Abros Sports International Pvt. Ltd. v. Ashish Bansal and Ors.* [Judgement dated 13 May 2025] referred to the Larger Bench the question as to whether a suit for infringement can lie against the proprietor of a registered trademark, with respect to the use of such trademark. The Larger Bench will also look into the question as to whether, if such suit is permissible, the Court can pass any interlocutory order, injunction the use, by the defendant, of the allegedly infringing registered trademark.

Trademarks – Trade channel test must be applied with greater contextual sensitivity

The Delhi High Court has observed that the mere fact that both categories of goods are sold in the same retail shops or even placed on the same shelves is not, by itself, sufficient to erase their functional and commercial distinctions. The Court in *Inder Raj Sahni Proprietor Sahni Cosmetics v. Neha Herbals Pvt. Ltd. and Anr.* [Judgement dated 19 May 2025] observed that department stores, supermarkets, and online marketplaces now offer a wide range of products, from food items to cosmetics and household goods, within a single retail environment and thus consumers may encounter unrelated categories of goods side by side. According to the Court, the co-location of dissimilar goods may increase the possibility of incidental exposure or association, but does not, by itself, establish a likelihood of confusion as to the source. It was thus held that in the absence of any evidence showing that consumers associate these goods as emanating from the same source, the likelihood of confusion arising solely on account of co-location in retail spaces is too remote to meet the statutory standard under Section 29(2)(a). The case involved dispute on use of mark 'Neha' by both the parties – while the plaintiff used it for Heena products, the defendant was using it for personal care creams.

Patents – Rejection of patent without elaborating as to how the amendment broadens the scope of original claim is serious infirmity

The Calcutta High Court has remanded the matter for decision afresh in a case where the conclusion of the Patent office that the methods claims had changed to a system claims and hence were beyond the scope of the original claims, was found to be unsubstantiated and bereft of any reasoning. The Court in this regard observed that there were no reasons in the decision of the Patent office in concluding as to how the proposed amendments broadened, expanded or widened the claims. The Patent office had earlier rejected the patent application solely on the ground of non-compliance with Section 59 of the Patents Act, 1970.

The High Court in *Andreas Gutzeit v. Controller* [Judgement dated 15 May 2025] also observed that whether it is a system to method or product to process, one has to examine the original specification and ascertain the intrinsic worth of the invention *vis-a-vis* the proposed amendment. According to the Court, the omission of the Patent office in adjudicating or elaborating upon as to how the features or elements of the proposed amendments broaden the scope of the original claim, was a serious infirmity.

Patents – Rejection under Section 3(d) – Controller to identify ‘known substance’ in hearing notice

The Delhi High Court has set aside the rejection of a patent under Section 3(d) of the Patents Act, 1970 as the Controller had not identified any particular ‘known substance’ in the hearing notice. The Court was of the view that thus the patent applicant was not afforded a fair opportunity to respond to the notice, by demonstrating, through comparative research data, that the claimed compound possesses enhanced therapeutic efficacy over the particular ‘known substance’. The High Court in *Taiho Pharmaceutical Co. Ltd. v. Controller of Patents* [Judgement dated 15 May 2025] observed that the applicant cannot be expected to infer a ‘known substance’ and furnish efficacy data based on such inference.

Design and Copyright – Registration of photograph of a product, which is covered under Design law, is correct under Copyright law

The Madras High Court has rejected the challenge to the registration of copyright for an artistic work titled ‘Artistic work photograph of pump assembly for air compressor’. The Court observed that the ‘Pump Assembly for Air Compressor’ and not the photograph was registered as a design. It was noted that the

photograph was an artistic work, and thus excluded from the definition of design under the Designs Act, 2000. Objection under Section 15(1) of the Copyrights Act, 1957, which provides that copyright shall not subsist under said Act in any design, was thus dismissed by the Court in *Mr. A. Ruthramoorthy v. Mr. P. Moorthy* [Order dated 10 June 2025].

Trademarks – Stay of suit to file rectification petition – Provisions of Section 124(1)(b)(ii) are not available as matter of right

The Delhi High Court has observed that while there is no bar for anyone to approach a Court for seeking permission to file a rectification petition under Section 124(1)(b)(ii) of the Trade Marks Act, 1999, however, the essential elements of the said section must still be satisfied. Thus, the Court was of the view that the provisions under Section 124(1)(b)(ii) are not available to anyone as a matter of right. The High Court in *Steelcase Inc. v. K.J. Bhuta and Anr.* [Judgement dated 28 May 2025] also noted that the provisions of Section 124(1)(b)(ii) must be read in tandem with those envisaged in Section 29. The Court aptly summarized the scenario, stating that it is a straight road ahead, but not without speed breakers/ hurdles in the way.

Trademarks – Priority of user by itself cannot sustain a finding of passing off or justify grant of interim injunction

The Delhi High Court has held that the priority of user by itself cannot sustain a finding of passing off or justify grant of interim injunction on that basis. Allowing the appeal against an interim order granting relief to the plaintiff (respondent before the High Court), the Court observed that for passing off, the primary ingredients that must be satisfied are the existence of goodwill, the attempt of the defendant to pass off the defendant's product as the product of the plaintiff and the resultant damage that has resulted to the plaintiff. The Court noted that the impugned order did not examine any of these aspects at all, and there was particularly no specific finding regarding the acquisition, by the respondent-plaintiff, of sufficient goodwill. Remanding the dispute for *denovo* consideration, the Court in *Vishal Gupta and Ors. v. Rahul Bansal* [Judgement dated 8 May 2025] noted that the impugned order proceeded on the mere premise that the plaintiff was entitled to an interim injunction as the user of the mark MATA AMAR SHAKTI was prior to the user, by the defendant, of the mark OM AMAR SHAKTI / SARKAR OM AMAR SHAKTI.

Trademark 'FIZIFREAK' is visually, structurally, phonetically and conceptually similar to 'fi'zi:k' and 'FREE:K'

The Delhi High Court has observed that the mark 'FIZIFREAK' when looked through the eyes of an ordinary consumer with imperfect recollection, appears to be visually, structurally, phonetically as well as conceptually similar to the registered trademarks 'fi'zi:k' and 'FREE:K', often referred to as 'fizik' and 'freak'. The Court in *Selle Royal Group S.P.A. v. Ace Footmark (P) Ltd. and Anr.* [Judgement dated 28 May 2025] was hence of the view that the adoption and registration of the mark FIZIFREAK by the respondent, for identically similar goods as that of the petitioner, was a deliberate attempt by the respondent to come as close as possible to the petitioner's world-renowned registered trademarks fi'zi:k and FREE:K.

RITZ and RITZ-CARLTON declared well-known marks in hotels and other related services in hospitality industry

The Delhi High Court has declared the RITZ and RITZ-CARLTON marks as well-known trademarks in respect of hotels and other related services in the hospitality industry. The High Court for this purpose noted the long duration for which the

marks have been in use, wide geographical area of their use, their knowledge among the general public, their goodwill and reputation due to the extensive promotion, publicity, and extensive revenue generated by the owners, in India as well as other countries. The Court in *The Ritz Hotel Limited v. M S Hotel Ritz & Ors.* [Decision dated 29 May 2025] was thus of the view that the plaintiffs fulfil all the criteria set out in Section 11(6) read with Section 11(7) of the Trade Marks Act, 1999.

LV (acronym of LOUIS VUITTON) declared well-known mark for leather goods, apparel, footwear, watches and accessories

The Delhi High Court has declared the mark 'LV' (acronym of LOUIS VUITTON) a well-known mark for leather goods, apparel, footwear, watches and accessories. According to the Court, the letters 'L' and 'V' have evolved beyond merely functioning as an acronym for 'LOUIS VUITTON' and have come to serve as independent and distinctive source identifiers of the luxury brand. The Court noted that the standalone letters 'L' and 'V', as the central elements of the interlocked logo, have acquired substantial recognition and distinctiveness, such that their use immediately evokes an association with the luxury brand's products, owing to their long-standing connection with

the brand's heritage and goodwill. It may be noted that the Court also observed that the mark 'LOUIS VUITTON' was earlier declared as a well-known mark, and the mark 'LV' serves as an acronym for the name 'LOUIS VUITTON'. The High Court in *Louis Vuitton Malletier v. Abdulkhaliq Abdulkader Chamadia* [Decision dated 15 May 2025] also took note of the long duration of the use of the mark, its wide geographical area of use, its knowledge among the general public, brand's goodwill and reputation due to the extensive promotion, publicity, and extensive revenue.

TikTok – Bombay HC upholds rejection of recognition as well-known mark

The Bombay High Court has dismissed a petition filed by TikTok Ltd that challenged the refusal by the trademarks registrar to recognise 'TikTok' as a well-known mark under the trademark laws. As per *Times of India* news report, as available [here](#), the High Court noted that it was undisputed that the TikTok app remains banned in India for reasons pertaining to the sovereignty and integrity of India, its defence, and public order,

and was hence of the view that the registrar did take into consideration relevant factors while refusing to include TikTok in well-known marks.

EU releases report on intellectual property rights in third countries, counterfeit & piracy watch list

The European Commission has on 22 May 2025 released report on intellectual property rights in third countries, and the Counterfeit & Piracy Watch List. While the biennial Report on the Protection and Enforcement of Intellectual Property Rights (IPR) in Third Countries (available [here](#)) identifies IPR deficiencies in third countries that cause the greatest economic harm to EU interests, the Counterfeit and Piracy Watch List (available [here](#)) describes the latest trends in counterfeiting and piracy, and lists websites and physical marketplaces reported by stakeholders as putting up pirated content and counterfeit goods. As per the Reports, China remains a top priority for EU efforts to protect the intellectual property rights (IPR) of its businesses, innovators or creators, followed closely by India and Türkiye as second priority countries.

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