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IN THE HIGH COURT OF JUDICATURE AT BOMBAY  
ORDINARY ORIGINAL CIVIL JURISDICTION  
IN ITS COMMERCIAL DIVISION

INTERIM APPLICATION (L) NO.25655 OF 2021  
IN  
COM IPR SUIT NO.158 OF 2022

Hind Rectifiers Ltd.

...Applicant /  
Plaintiff

*Versus*

Chrome21 India Pvt. Ltd. and Ors.

...Defendants

Mr. Rashmin Khandekar, Alhan Kayser and Hitisha Patel i/b. Avesh  
Kayser for the Applicant / Plaintiff.

CORAM : R.I. CHAGLA J.

Reserved on : 16th OCTOBER, 2024.

Pronounced on : 26th NOVEMBER 2024.

**ORAL ORDER :**

1. By this Interim Application, the Plaintiff is seeking injunction restraining the Defendants from infringing the Plaintiffs registered Trademark "HIRECT" and passing of the impugned mark "HIRECT" as that of the Plaintiffs registered trademark.

2. The Plaintiff has filed the captioned Suit ("Suit") *inter alia* seeking restraint against the Defendant from infringing the Plaintiff's registered trademarks, for passing off and for ancillary

reliefs. The Plaintiff has also taken out an IA seeking interlocutory reliefs. For convenience, the said reliefs are reproduced hereinunder:

*(a) Pending the hearing and final disposal of the present suit an order and direction that the Defendants, by themselves, their servants, agents, directors, partners, employees, dealers, distributors, exporters, manufacturers, marketers claiming through the said Defendants be restrained by an order of this Hon'ble Court from in any manner whatsoever infringing the registered device marks bearing registration nos. [2840003](#) in class 9 and [2840004](#) in class 35, 5195669 in class 35 and 5195670 in class 9 by the use of the impugned mark/name 'HIRECT', the impugned domain name/website [www.hirect.in](#) and/or [www.hirect.us](#) and/or any other mark and/or domain name identical and/or deceptively similar to the registered marks of the Plaintiff (annexed at **Exhibit J-J3**); and*

*(b) Pending the hearing and final disposal of the present suit an order and direction that the Defendants by themselves, their directors, partners, employees, servants, dealers, distributors, exporters, manufacturers, marketers and agents claiming through the said Defendants be restrained by an order of this Hon'ble Court from in any manner whatsoever passing off their goods and services as for those of the Plaintiff by use of the impugned mark/name 'HIRECT', the impugned domain name/website [www.hirect.in](#) and/or [www.hirect.us](#) and/or any other mark and/or domain name identical and/or deceptively similar to the Plaintiff's mark 'HIRECT' and/or the Plaintiff's logo marks (set out at paragraphs 15 and 16) and/or the Plaintiff's domain name [www.hirect.com](#);*

3. The Plaintiff is a public limited company incorporated under the Companies Act, 1956, and was in collaboration

Westinghouse, Brake & Signal, U.K.D. The Plaintiff's business is spread across various sectors and industries including but not limited to electronics, railway transportation, power, telecommunication and core sector industries such as steel non-ferrous metals, cement, chemicals, metal finishing and a host of other industries. The Plaintiff is also engaged in the business of developing, designing, manufacturing and marketing power semi-conductors, power electronic equipment and railway transportation equipment. The Plaintiff is also engaged in the business of developing and / or selling software in relation to its business.

4. The Plaintiff has stated its current net worth to be approximately 9,000 to 10,000 lakhs. Over the last five years itself the turnover of the Plaintiff has increased from Rs. 93,93,58,966/- (2015-16) to Rs. 305,09,71,000/- (2020-21).

5. The Plaintiff states that it has over 780 employees working in diverse Departments and having diverse educational qualifications and expertise. The Plaintiff also claims to have its own in-house Research and Development Team comprising of 83 qualified personnel from various branches of engineering and has invested

over Rs. 18,94,40,000/- in the last three financial years prior to institution of the Suit.

6. It is stated that Indian Railways are the primary clients of the Plaintiff. 85%-90% of the Revenue generated by the Plaintiff is either through the supply of products directly to the Railways or to private parties who in turn supply the product to the Railways. A few of the prominent clients of the Plaintiff include the Bajaj Group, Ambuja Cement, BHEL Bangalore, the Indian Navy and the Indian Airforce. Plaintiff's products under the "HIRECT" mark are not only sold in India but also foreign countries including Australia, U.A.E., UK, Ukraine, Singapore, Kenya, Indonesia, Thailand, Singapore, Colombia, France, Germany, France, Germany, Austria, Turkey, amongst others.

7. It is stated that over the years, the Plaintiff has garnered tremendous goodwill and reputation, resulting in the Said mark being associated exclusively with the Plaintiff and its products. The Plaintiff since its incorporation has grown by leaps and bounds which is evident from the various achievements and events that took place during several decades of their existence, some of the major such

year wise events are briefly stated below.

(i) On 25<sup>th</sup> April 1958 Plaintiff was incorporated as a Private Limited Company. Mechanical section was started at Reay Road, Mumbai and for that approx. 3000 sq. ft covered area was taken on the rent while manufacturing and testing of rectifiers were started at Colaba factory.

(ii) In the year 1958-59, Government of India approved Plaintiff's project for manufacture of Selenium Plates in India in collaboration with Westinghouse Brakes & Signal Co. Ltd., London and Company signed the aforesaid agreement with U.K. firm.

(iii) In the year 1959-60, Plaintiff purchased about 20,000 sq. yds. of freehold land at Lake Road, Bhandup West, Mumbai and started to construct the factory.

(iv) In the year 1960-61, Manufacturing activities started at Bhandup West, Mumbai by Plaintiff.

(v) In the year 1961-62, Plaintiff company converted into a

Public Company on 11<sup>th</sup> May 1961. During the same period the plant for manufacture of Selenium Rectifier Plates was commissioned.

(vi) In the year 1962-63, Plaintiff commenced manufacture of 150 Amps Silicon Diodes.

(vii) In the year 1963-64, Plaintiff entered into Technical Collaboration Agreement with English Electric Company Ltd. U.K. for manufacture of semiconductor rectifier assemblies for vehicle mounting for traction motor power supplies. It also received the license for extension of the range of manufacture of Silicone Diodes.

(viii) In the year 1966-67, the Plant for manufacture of selenium rectifier plates by vaporized process commissioned.

(ix) In the year 1972-73, the Plaintiff undertook complex turn-key projects requiring installation and commissioning of complete rectifiers plants which include allied subsidiary equipment such as switchgears, tap changers, regulating transformers, auto

transformers, DC isolators, DC busbars etc.

(x) In the year 1973-74, Plaintiff received an industrial license for manufacturing epoxy moulded devices for two million number per year.

(xi) In the year 1975-76, introduced new products viz (a) Low Range Thyristors of 7 amps. 10 amps. and 16 amps. With high voltage capacity; (b) Diffused diodes of 25 amps., 40 amps. and 70 amps.; (c) Fast recovery types of diodes suitable for high frequency operation in the current range of 1 amp. For the first time in India, the Company introduced thyristors with a capacity of 450 amps.

(xii) In the year 1976-77, Plaintiff introduced the new products viz. (a) Thyristor controlled power supply units for Electrostatic Precipitators, (b) Thyristorised static inverters and no break power supplies, (c) Thyristor controls for D.C. and A.C. motors and (d) Thyristorised A.C. Voltage Stabilisers.

(xiii) In the year 1977-78, the Selenium Plant of the Plaintiff

was sold.

(xiv) In the year 1994-95, Plaintiff signed a technical agreement with Electric Research & Development Centre, Kerala for manufacturing Transistorised PWM AC Drives and another technical agreement with FRIEM S.P.A., Italy for high current water cooled rectifiers for electro-chemical and electro-metallurgical applications. The Plaintiff also signed MOU with Powersem, GmbH, Germany for Isopack Bridges. Supreme Powertronics Private Limited, an Associate Company of the Plaintiff, merged with Hind Rectifiers Limited.

(xv) In the year 1995-96, Plaintiff successfully manufactured High Current water cooled Rectifiers based on the technology received from FRIEM S.P.A. Italy.

(xvi) In the year 1998-99, Plaintiff's Equipment Division had been accredited with 9001 certificate dated 18.05.1998 issued by TUV Rheinland Anlagentechnik GmbH.

(xvii) The Plaintiff received awards under the NSCI Safety



Award Scheme for the years 1994 and 1995 and under the Bhandup Mutual Aid Group for the years 1995 and 1996.

(xviii) Since 15<sup>th</sup> December 1998, the Plaintiff has owned, operated and registered a domain name, viz '*www.hirect.com*', through which it advertises, promotes and conducts its business.

(xix) In the year 2000-01, Plaintiff's Semi-Conductor division was accredited with ISO 9002 certificate from KEMA of Netherlands.

(xx) In the year 2001-02, Plaintiff successfully manufactured 25 KVA inverters for air-conditioned coaches.

(xxi) In the year 2003-04, three major foreign collaboration with Transtechnik of Germany for Railway Inverters, FRIEM of Italy for Water Cooled Rectifiers and Nieke of Germany for AC/DC Traction Transformers for Metro Trains were renewed with the Plaintiff.

(xxii) In the year 2006-07, Plaintiff completed the construction

of two new plants in Dehradun, Uttarakhand having lower cost manufacturing advantage to the Company.

(xxiii) In the year 2013-14, the Semi-conductor division of the Plaintiff had been accredited with UL certification and Semi-conductor division of the Company had been accredited with CE certification. Company had successfully supplied 3 phase Transformer for WAP5, WAP7 and WAG9 for Indian Railways.


(xxiv) In the year 2015-16, Plaintiff received following accolades during the year from "National Society of Friends of the Trees": (a) "The Annual Vegetable, Fruit & Flower Show" - Full Garden - Rank I, (b) Any outstanding specimens of Bonsai - Rank II and (c) In collection of Bonsai - Rank III.

(xxv) In the year 2017-18, Plaintiff started commercial production of power supply unit for Electro Static Precipitator (ESP) and Panels for Railways at Nasik plant from October 01, 2017.

8. It is submitted that there is absolutely no doubt with the


fact that the Plaintiff has used the HIRECT mark for over 60 years. Considering the above and the material on record, the HIRECT mark of the Plaintiff has acquired substantial goodwill and reputation and are associated and identified directly with the Plaintiff.


9. It is stated that in or around 1961, the Plaintiff coined and adopted the mark HIRECT by a unique combination of its corporate name **HI**nd **RECT**ifiers. At the same time, the Plaintiff also

created and adopted a logo  using its distinctive HIRECT mark for which registration in class 09 was secured under the provisions of the Trade & Merchandise Act, 1958 (*now the Trade Marks Act, 1999*) (“**said Act**”).

10. It is stated that since 1961, the Plaintiff has been the registered proprietor of the mark ‘HIRECT’ in classes 9 and 35 (“**said mark**”). Since 1961, the Plaintiff has been continuously and extensively using the said mark, not only in India but also in various other countries. Due to the immense goodwill and reputation gained by the Plaintiff in the said mark, members of the trade associate the ‘HIRECT’ mark only with the Plaintiff and no one else.

11. Pursuant thereto, in and around 1972, the Plaintiff also

secured registration for its mark  in class 09 of the said Act. In 2014, the Plaintiff cause slight change in the earlier logo HIRECT and

adopted a logo viz, , the primary feature of which is HIRECT.

12. It is stated that on account of its global presence, the Plaintiff also conducted an online search on WIPO, which reflects until 5<sup>th</sup> May 2021 no entity besides the Plaintiff was using the 'HIRECT' mark across the globe.

13. On 30<sup>th</sup> October 2021, the Plaintiff filed Trade mark applications for the word mark 'HIRECT' in classes 9 and 35 bearing application nos. 5195670 and 5195669, with claim of use since 01<sup>st</sup> February 1961. On 28<sup>th</sup> September 2022, the two applications secured registration.

14. The Plaintiff is a well-established and known organization commonly referred and well known in various industries as 'HIRECT'. Its business its spread across various sectors

and the Plaintiff is not associated with only one particular industry. The Plaintiff is recognized and has re-call value as a brand.

15. It is stated that owing to the Plaintiff's continued efforts along with ubiquitous, continuous and long use of its marks, enormous goodwill and reputation has been acquired by the 'HIRECT' marks. In fact, the 'HIRECT' marks have acquired secondary meaning and have become well-known marks within the meaning as laid down by the Trade Marks Act, 1999.

16. It is submitted that the Plaintiff is entitled to restrain others from using and / or causing to be used any name and/or mark *inter alia* containing the expression 'HIRECT' and / or any other name or mark which is deceptively and/or confusingly similar in any manner whatsoever to the Plaintiff's said mark. The Plaintiff is entitled to protect its mark 'HIRECT' from dilution, debasement and tarnishment. The Plaintiff is entitled in law to restrain the use of any mark that would result in affecting the distinctive character and repute of the Plaintiff's registered marks.

17. It is stated that in or around July 2021, while conducting

an online search the Plaintiff came across Defendant No. 1's domain name [www.hirect.in](http://www.hirect.in) (the "impugned domain name/website") through which Defendant No. 1 is advertising, promoting and offering its recruitment services under its impugned 'HIRECT' mark.

18. It is stated that by Defendant No. 1's use of the 'HIRECT' mark and impugned domain name, on 10<sup>th</sup> July 2021, the Plaintiff, through its advocate, addressed a cease and desist notice to Defendant No. 1.

19. It is stated that on 16<sup>th</sup> August 2021, Defendant No. 1, through its Advocates replied to the Plaintiff's cease and desist notice raising certain frivolous defences. Nonetheless, Defendant No. 1 acknowledged that use of its mark was only since 2020 i.e. 59 years after the Plaintiff's use. Defendant No. 1 also falsely claimed that it was unaware of the Plaintiff's use of its 'HIRECT' mark.

20. Thereafter the Plaintiff claims to have conducted further enquiries about Defendant No. 1's infringing use. This revealed that the impugned domain name is registered in the name of Defendant No.2 whereas the office address provided on the impugned domain is

that of Defendant No.1.

21. The Plaintiff's enquiries also revealed that the impugned domain www.hirect.in also provided access to a domain in the United States region which redirects to www.hirect.us hosted by Defendant No.3 and is registered by Defendant No.2. It is clear that the Defendants are in some manner associated with each other. The Plaintiff craves leave to modify its pleadings suitably on knowing the true association between the Defendants.

22. The Plaintiff states that it came to its notice that Defendant No. 2 has fraudulently applied for registration of its impugned 'HIRECT' mark in the same classes as those of the Plaintiff's prior and subsisting registrations i.e. class 9 and class 35. Two of Defendant No. 2's registrations are objected to while one is showing as 'accepted'. The Plaintiff craves leave to take appropriate steps in this regard.

23. The Plaintiff submits that the malafide and dishonest conduct of the Defendants is also evident from the fact that Defendant No. 1 at paragraph 3 of its notice dated 16<sup>th</sup> August, 2021

has blatantly denied having knowledge of the Plaintiff's use of its mark. However, pertinently the trademark registry in its examination report dated 21<sup>st</sup> September, 2021 in respect of Defendant No. 2's application no. 5114831 of its impugned mark has cited the Plaintiff's mark bearing application no. 2840004 as a conflicting mark and noted: "*identical with or similar to earlier marks in respect of identical or similar description of services and because of such identity or similarity there exists a likelihood of confusion on the part of the public.*"

24. It is stated that on 12<sup>th</sup> November 2020 Defendant No. 2 replied to the examination report raising false and frivolous defenses with respect to its trademark application no. 4676161.

25. It is further stated that the Defendants have always been aware of and had clear knowledge of the Plaintiff's prior use and vast reputation. Defendant No. 1 in its notice dated 17<sup>th</sup> August 2021 has made *ex facie* false and frivolous statements.

26. The Plaintiff submits that there is no doubt that the Defendants have deliberately and dishonestly adopted the impugned



mark and domain with the sole objective of piggybacking upon and/or riding on the goodwill and/or reputation of the Plaintiff's and/or its mark HIRECT, therefore any subsequent justification in adoption and use of the impugned mark cannot be considered to favour the Defendants. The impugned mark adopted by the Defendants is identical to the Plaintiff's mark. In the process, the Defendants are clearly guilty of infringement and passing off.

27. The Plaintiff states that a former employee of the Plaintiff addressed an e-mail dated 17<sup>th</sup> August 2021 that was meant to be addressed to the Plaintiff seeking re-employment in the Plaintiff's established and recognized organization. However, owing to confusion and on account of the misleading domain name of the Defendants, the Plaintiff's former employee also addressed the email to 'support@hirect.in' i.e. an email address belonging to the Defendants. Promptly on the same day, instead of dispelling the confusion and pointing out the mistake, Defendant No. 1's representative replied to the aforesaid e-mail providing information and details to representatives to attract further business for themselves.

28. On further enquiry within its emails the Plaintiff claims to have come across another e-mail dated 5<sup>th</sup> December 2019 addressed by a customer of the Plaintiff which was also addressed to 'marketing@hirect.in' i.e. an e-mail ID belonging to the Defendants; under the mistaken impression that such e-mail ID was that of the Plaintiff.

29. Tendered by the Plaintiff are also two correspondences that depict the confusion between consumers that occurred pursuant to the filing of the Suit.

(i) In September 2023, a dissatisfied customer of the Defendants escalated a complaint to the higher management of the Defendants and being confused between the two entities and the rival marks, also addressed the communication to the management of the Plaintiff, mistaking the Plaintiff and the Defendant to be the same.

(ii) In December 2023, another such instance occurred, when a dissatisfied customer of the Defendant, escalated his grievance to the management of the Defendant and marked the e-mail to the

management of the Plaintiff, as he was unable to differentiate the Plaintiff and the Defendant due to the similarity of the rival marks.

30. These documents have been taken on record by this Court.

31. The Plaintiff submits that it is evident from the above that the Defendants have mischievously and deliberately, with an ulterior motive, adopted and used the impugned mark 'HIRECT' only with a view to trade upon and/or encash on the goodwill, recognition and reputation of the Plaintiff's business operated under the well-known mark 'HIRECT'. There is no doubt that the Defendants have commenced their business with a specific object of pirating the Plaintiff's mark and trading upon and/or piggy backing upon the Plaintiff's goodwill and reputation in its mark 'HIRECT'.

32. Moreover, the dishonesty on part of the Defendants is writ large on account of the fact that they have adopted an identical mark 'HIRECT' which is a coined and invented word by the Plaintiff since 1961. As such, the impugned mark and impugned domain

named are structurally, phonetically and visually identical with and/or deceptively similar to the Plaintiff's reputed mark 'HIRECT', which speaks volumes of the dishonest intention of the Defendants. The Defendants adoption of the impugned mark is as such clearly dishonest.

33. The Plaintiff submits that, the adoption of the impugned mark 'HIRECT' by the Defendants is *ex-facie* dishonest and fraudulent and Defendants have no right whatsoever to make use of the impugned mark 'HIRECT' *inter alia* in respect of goods and services as described under class 9 and 35 in any manner whatsoever or even otherwise on account of the Plaintiff's mark having acquired the status of a well-known mark. The use of the impugned mark 'HIRECT' infringes the Plaintiff's statutory rights, on account of its registration, more particularly set out hereinabove, under the said Act apart from violating the Plaintiff's common law rights accrued into the mark 'HIRECT' and logo of the Plaintiff by virtue of long, extensive and prior use of the same. On account of the identity of the rival marks, the use of the impugned mark 'HIRECT' by the Defendants will inevitably lead to confusion amongst the members of the trade and the general public. As it has already happened in the

past.

34. The Plaintiff submits that the aforesaid clearly establishes that the Defendants continued to intentionally and/or deliberately use the mark of the Plaintiff and to ride upon the Plaintiff's immense goodwill and reputation painstakingly built up over the years. The Plaintiff submits that any person from the general public and members would certainly be led to believe that the Defendants have some association and/or affiliation and/or connection with the Plaintiff' reputed mark 'HIRECT' and their business as they have in the past. Even otherwise, the use of the impugned mark by the Defendants is without due cause and is detrimental to the distinctive character and repute of the Plaintiff's marks and is also leading to the Plaintiff's marks being diluted.

35. In view of the above the Plaintiff submits that the use of the impugned mark by the Defendants is wholly illegal, unauthorized and malafide. The said unauthorized use by the Defendants is in violation of the Plaintiff's statutory as also common law rights. The Plaintiff submits that the use of the impugned mark by Defendants infringes the right of the Plaintiff to use the mark 'HIRECT' to the

exclusion to others. Further, the said use is *ex facie* likely to cause confusion not only in the minds of the general public but also in the minds of the members of the trade.

36. The Plaintiff submits that on account of the extensive use as the Plaintiff's mark 'HIRECT' has become a well-known mark within the meaning of Section 2(1)(zg) of the said Act. The Plaintiff is therefore, entitled to a wider protection within the meaning Section 29(4) of the said Act.

37. Mr. Khandekar, learned Counsel for the Plaintiff submits that the ingredients of Section 29(4) have been entirely satisfied in the present case. Section 29(4) of the Act reads as under:

***29. Infringement of registered trade marks.- ...***

***(4) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which-***

***(a) is identical with or similar to the registered trade mark; and (b) is used in relation to goods and services which are not similar to those for which the trade mark is registered; and***

*(c) the registered trade mark has a reputation in India and the use of the mark without due cause takes unfair advantage of or is detrimental to, the distinctive character or repute of the registered trade mark.*

38. Mr. Khandekar submits that the purpose of Section 29(4) is to protect marks with a “reputation” in India. Such marks should not be used without due cause, thereby taking unfair advantage or being detrimental to the distinctive character and repute of such marks.

39. Mr. Khandekar submits that the Defendant’s contention that the Plaintiff has used the mark ‘HIRECT’ only in respect of rectifiers, transformers and allied products particularly used in relation to Railways, and therefore no case is made out against the use by the Defendants is also misconceived. This is because, firstly, as set out above, the Plaintiff has actually used ‘HIRECT’ in relation to several of its businesses spread across diverse activities and/or fields. Secondly, what is required under the Act, is that the prior mark must have a “reputation” in India, and the impugned use must debase/whittle away such reputation. Thirdly, such reputation may be built up even by extensive, continuous and substantial use in relation to specific goods and/or services. Such use in relation to

specific goods and/or services may of its own, in addition to the distinctiveness that the mark has acquired, make a mark “well-known” within the meaning of the Act. The Plaintiff’s prior and famous ‘HIRECT’ trademark not only satisfies all the requirements for seeking protection in respect of different goods and services under Section 29 of the said Act but goes a step further as the record shows that the Plaintiff’s ‘HIRECT’ mark is clearly well known within the meaning of the Act. The Defendants’ use of the impugned mark in order to take unfair advantage and to identify itself as associated and/or connected with the Plaintiff is detrimental to the distinctive character or repute of the Plaintiff’s prior and famous ‘HIRECT’ mark.

40. Mr. Khandekar has placed reliance upon decision of this Court in *RPG Enterprises Ltd. Vs. Riju Ghoshal & Anr.*<sup>1</sup> in support of his submission as to the applicability of Section 29(4) of the Act in the present case. He has submitted that in the said decision, Section 29(4) was held to be distinct from Section 29(1) to (3) of the Act with respect to the requirement of having to demonstrate the likelihood of confusion which is absent in that provision. He has submitted that this Court has considered the intention of the

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1 (2022 SCC OnLine Bom 626.



legislature which is to afford a stronger protection to those marks that have wide reputation without the registered proprietor of such marks having to demonstrate the likelihood of confusion arising from the use of an identical or similar mark in relation to dissimilar goods and services. Further, this Court in the said decision has held that while claiming infringement under Section 29(4) of the Act, it is necessary in its strict sense for the proprietor of registered mark to show that the mark is a “well known trade mark” as defined in Section 2(1) (zg). If the mark is shown to be well known it makes it easier to satisfy the ‘reputation’ requirement contained in Section 29(4) of the Act. In so determining the Court can consider the pleadings and documentary evidence filed by the Plaintiff while ascertaining whether such mark can be protected as well known trade mark / trade marks with reputation while considering infringement under Section 29(4) of the Act and the same is not dependent upon the mark being recorded in the list of the well known trade marks as maintained by the Trade Mark Registry.

41. Mr. Khandekar has also placed reliance upon the decision of this Court in *Kirloskar Diesel Recon Pvt. Ltd. Vs. Kirloskar*

*Proprietary Ltd.*<sup>2</sup>, where this Court has considered expression “common field of activity” and so called requirement of law that there should be a common field of activity which is now discredited. This Court has held that the real question in each case is whether there is as a result of misrepresentation a real likelihood of confusion or deception of the public and consequent damage to the Plaintiff. The focus is shifted from the external object test of making comparison of activities of parties to the state of mind of public in deciding whether it will be confused.

42. Mr. Khandekar has submitted that the Plaintiff’s mark has reputation within India for the purposes of Section 29(4) of the Act. The Plaintiff’s mark is clearly a well known mark within the meaning of Section 2(1) (zg) of the said Act. The use by the Defendant is without due cause and takes unfair advantage and is detrimental to the distinctive character and repute of the Plaintiff’s registered trade mark. He has submitted that a case under Section 29(4) of the Act for infringement is clearly made out. Similarly, for the same reasons a case for passing off is also made out particularly considering the extent of user of the Plaintiff and the goodwill and

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2 (1995) SCC OnLine Bom 312.

reputation accrued to its marks across a large business activity.

43. Mr. Khandekar has accordingly sought for grant of prayer Clauses (a) and (b) of the Interim Application and in addition a declaration that the Plaintiffs registered trademark “HIRECT” is a well known mark under the meaning of Section 2(zg) of the Act.

44. The Defendant has been given ample opportunity to make an appearance and by previous Order dated 16th October, 2024, this Court had noted that the Advocates for the Defendant Nos.2 and 3 sought discharge in the matter in view of no instructions having been received from the Defendants. This Court had directed that the erstwhile Advocates, obtaining discharge to communicate the orders of this Court to the Defendants for them to make an alternate arrangement. This Court had also made the eventuality of Defendant Nos.2 and 3 inspite of the previous orders failing to make an appearance clear, i.e. the matter will be proceeded with. Accordingly, by the Order dated 16th October, 2024, the Interim Application was proceeded with and the Plaintiff have been canvassed as recorded above.

45. The case of the Defendants which appear from the Affidavit in Reply to the Interim Application is that there has been delay in filing of the present Suit. It is the Defendants contention that they have been offering its goods and services under the Defendants mark in the Indian market since 2020 and in the United States of America since 2010. The Defendant No.2 has also applied for trademark registration of the word mark under Class 35 on 27th September, 2020.

46. This contention of the Defendants as to delay in filing the present Suit is in my view a misconceived contention. The Plaintiff had learnt of the Defendants in July, 2021 and had with utmost dispatch addressed cease and desist notice dated 10th July, 2021. Upon receipt of Reply dated 16th August, 2021, the Plaintiff conducted further enquiries regarding the infringing use by the Defendants and upon gathering the requisite information filed the present Suit in October, 2021. Thus, the Plaintiff has established that it has acted promptly in filing the present Suit without any delay. In any event, it has been held by the Supreme Court in *Midas Hygiene Industries P. Ltd. Vs. Sudhir Bhatia & Ors.*<sup>3</sup> that delay by itself is not a

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<sup>3</sup> (2004) 28 PTC 121 SC

defense available to Defendant to an action in trademark infringement.

47. The Defendants have also contended in their Affidavit in Reply to the Interim Application that the Defendants mark originates from “HIRE-DIRECT” which is stated to be a philosophy behind the services being offered by the Defendants. It is the case of the Defendants that keeping this aim in mind, they coined the impugned mark “HIRECT”. This contention is to be viewed from the adoption of the mark by the Defendants which is a mark identical to that of the Plaintiff’s prior registered mark and which the Defendants would have knowledge of by the Trade Mark Registry. Further, the Plaintiffs prior registered mark was cited as a conflicting mark when the Defendant No.2 sought to register the impugned mark. The Defendants having adopted an identical mark in the same class of goods and / or services. There is no manner of doubt that the Defendants have dishonestly adopted the mark. Further, Defendants have dishonestly contended in the pleadings that the Defendants were unaware of the Plaintiffs trademark. This is despite the examination report in respect of the Application for registration made by Defendant No.2 having specifically cited the Plaintiff’s mark as a

conflicting mark.

48. In any event, the intention of the Defendants in adopting its mark is wholly irrelevant in an action for infringement and passing off. It is well settled that no one can carry out its business in such a way to persuade customers and / or clients into believing that the goods and / or services belonging to someone else are theirs or are associated therewith. When an entity adopts a name and / or mark in connection with their business or services which already belongs and is extensively used by someone else, this results in confusion and has the propensity of diverting customers and clients of someone else to themselves, thereby resulting in injury. Thus, there is no merit in the contention of the Defendants that their mark originates from "HIRE-DIRECT" and / or there was honest adoption of their mark.

49. The Defendants have also raised the contention in their Affidavit in Reply that the Plaintiff secured registration under Class and they actually using its mark in respect of services governed under Class 35 namely Advertising, Business Management and Business Administration, office functions in the field of Rectifiers,

Transformers, Reactors, Inverters, Converters, Diodes, Ser Power Blocks, Modules, Isopack Bridges, Stack, Control Panels and other Electrical Products, without actually using its mark for the stated purpose. This contention is in my view a misconceived contention, particularly viewing that the Plaintiff has been able to establish that it has superior rights in and to the 'well known' trade mark "HIRECT" which had been coined and adopted by the Plaintiff in or around 1961 by a unique combination of its corporate name, "Hind RECTifiers". The Plaintiff has further been able to establish that the Plaintiff has been using its trademark 'HIRECT' continuously, extensively and uninterruptedly in respect of various goods and services. The Plaintiff has further established that it has invested extensive amount of time, efforts and resources for promotion and advertisement of its "HIRECT" mark. By virtue of the extensive and uninterrupted use by the Plaintiff of its "HIRECT" mark, the Plaintiff has acquired enormous goodwill and reputation in its trademark "HIRECT" which has become exclusively associated with the Plaintiff and its diverse range of activities and business conducted under the "HIRECT" mark. Further, the Plaintiff has been using the trade mark "HIRECT" as part of its logo / brand name / identity and therefore, the prior and famous "HIRECT" trademark has become a source

identifier of the Plaintiff.

50. The Plaintiff has also established that its business is spread over across various sectors and industries. The Plaintiff has been able to place material on record in respect of its contention that “HIRECT” has become a well known mark. In addition material which has been produced showing the goodwill, reputation and the Plaintiff’s presence in the various sectors / fields. This include articles published in different magazines which emphasize on the Plaintiffs diverse range of activities and its reputation and goodwill. Further, the purchase orders issued to the Plaintiff for a variety of goods and services across various sectors and industries. There are invoices ranging from a period between June, 2008 to September, 2021 showing the Plaintiff supplying goods and services under its mark “HIRECT” across a variety of sectors / industries and to various different companies. The Plaintiff has also been engaged in developing and supplying associated software and embedded software along with hardware products under its well known mark “HIRECT”. Further, the Railway Year Book / Railway Reviews Journals have been relied upon to provide details about the Plaintiff and its products. There are other promotional material / documents



showing widespread use of the Plaintiff's prior and well known mark "HIRECT". The Plaintiff is a listed company at the NSE and the BSE and its share trading is on an upward trend for the last few years. This has added to the distinctiveness and popularity of the Plaintiff's "HIRECT" mark. Thus, the Plaintiff in my prima facie view has been able to establish that its mark "HIRECT" has acquired a secondary meaning and connotes the Plaintiff alone.

51. The Defendants use of identical and / or deceptively similar will cut into the distinctiveness of the Plaintiff's "HIRECT" mark and result in its dilution and debasement. The distinctiveness of the Plaintiff's mark, used and adopted by the Plaintiff is at least 59 years before the Defendants attempted to imitate and / or copy it. Considering that the Plaintiff has been able to establish that its mark "HIRECT" is distinctive and well known mark, it requires protection against infringement even in respect of different goods and services. This has been held by this Court in the decisions relied upon by Mr. Khandekar viz. *RPG Enterprises Ltd. (Supra)* and *Kirloskar Diesel Recon Pvt. Ltd. (Supra)*. In *Kirloskar Diesel Recon Pvt. Ltd. (Supra)*, this Court has considered that the focus has shifted from the external objective test of making comparison of activities of parties to the

state of mind of public in deciding whether it will be confused. The so called requirement of law that there should be a common field of activity which is now discredited, particularly where the mark of the Plaintiff has acquired secondary meaning and have become a well-known marks. Further, the test of determining whether the mark is a well known mark has been laid down by this Court in ***RPG Enterprises Ltd. (Supra)*** where this Court has held that the pleadings and documentary evidence filed by the Plaintiff is to be considered while ascertaining whether such mark can be protected as a well known trade mark with reputation under Section 29(4) of the Act and the same is not dependent upon the mark being recorded in the list of the well known trade marks as maintained by the Trade Mark Registry.

52. In my considered prima facie view, the Plaintiff has been able to establish that in view of Plaintiff's mark "HIRECT" being identical to the Defendants mark "HIRECT", the customers being persons of average intelligence and imperfect recollection are even otherwise likely to believe that the Defendants' offending services provided under the impugned mark are in some way associated with and / or endorsed by the Plaintiff whereas no such association or

endorsement exists.

53. The Defendants contention that the rival mark are not identical and / or deceptively similar and / or likely to cause confusion in the minds of the public at large is a contention that is only stated to be rejected. The prominent and essential portion of both the logos, being the mark “HIRECT”, the mark of the Defendants would in my prima facie view infringe upon the Plaintiff’s prior and well known mark. I am of the prima facie view that the rival marks are structurally, phonetically and visually identical and / or deceptively similar when compared as a whole. The word “HIRECT” is the important, prominent and essential feature of the registered mark. It is a settled position of law that while comparing two marks, the prominent, essential and distinctive features of the two marks are required to be compared. Applying this principle to the facts of the present case, it is clear that the impugned mark is identical to the Plaintiffs’ prior and well known trade mark “HIRECT”.

54. I am thus of the considered view that a strong prima facie case has been made out by the Plaintiff not only for grant of relief sought for in the Interim Application but also for a declaration

that the Plaintiff's registered mark "HIRECT" is a well known mark under the meaning of Section 2(1)(zg) of the Act. Accordingly, it is declared that the registered mark of the Plaintiff "HIRECT" is a well known mark under meaning of Section 2(1)(zg) of the Act.

55. The Plaintiff has also made out a strong prima facie case for grant of relief in terms of prayer Clauses (a) and (b) of the Interim Application. The Defendants have adopted the impugned mark, "HIRECT" which is identical to that of the Plaintiff's and which adoption and use is several years subsequent to that of the Plaintiff's adoption and use which is from the year 1961. The balance of convenience is also in favour of the Plaintiff, considering that its registered mark, "HIRECT" has been declared as well known mark which is being infringed and passed off by the Defendants' impugned mark. Further, the customers of the Plaintiff have also been confused between the rival marks and which is borne out from the material on record which includes the email id of the Defendants viz. using Plaintiffs registered mark "HIRECT" as part thereof. Thus, irreparable harm and injury would be inflicted upon the Plaintiff if the interim relief sought for is not granted.

56. In view thereof, the Interim Application is allowed in terms of prayer Clauses (a) and (b) which read thus:-

*“(a) pending the hearing and final disposal of the present Suit an order and direction that the Defendants, by themselves, their servants, agents, directors, partners, employees, dealers, distributors, exporters, manufacturers, marketers claiming through the said Defendants be restrained by an Order of this Hon’ble Court from in any manner whatsoever infringing the registered device marks bearing registration Nos.2840003 in Class 9 and 2840004 in Class 35, 5195669 in Class 35 and No.5195670 in Class 9 by use of the impugned domain name / website www.hirect.in and / or www.hirect.us and / or any other mark and / or domain name identical and / or deceptively similar to the registered marks of the Plaintiff (annexed at Exhibit J – J3); and*

*(b) pending the hearing and final disposal of the present Suit and order and direction that the Defendants by themselves, their directors, partners, employees, servants, dealers, distributors, exporters, manufacturers, marketers and agents claiming through the said Defendants be restrained by an Order of this Hon’ble Court from in any manner whatsoever passing off their goods and services as for those of the Plaintiff by the use of the impugned mark / name “HIRECT” the impugned domain name / website www.hirect.in and / or www.hirect.us and / or any other mark and / or domain name identical and / or deceptively similar to the Plaintiff’s mark “HIRECT” and / or the Plaintiff’s logo marks (set out at paragraphs 15 and 16 of Plaintiff) and / or the Plaintiff’s domain name www.hirect.com.*

57. The Interim Application is accordingly disposed of. There shall be no order as to costs.

[ R.I. CHAGLA J. ]