



Sharayu Khot.

9-COMIPL-26309-24.doc

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

COMMERCIAL IPR SUIT (L) NO. 26309 OF 2024
WITH
INTERIM APPLICATION (L) NO. 26310 OF 2024
WITH
COURT RECEIVER'S REPORT NO. 417 OF 2024

Girnar Food & Beverages Pvt. Ltd. ...Plaintiff

Versus

TNI Plastics ...Defendant

Mr. Hiren Kamod a/w Mr. Anees Patel, Ms. Blossom Noronha i/by
M/s. Jehangir Gulabbhai & Billimoria & Daruwalla for the Plaintiff.

Mr. Mitesh Parmar a/w Ms. Shweta Kansara for the Defendant.

Mr. Tauhid Khan, Proprietor of Defendant present in present.

Ms. Charushila M. Vaidya, 2nd Asstt. Court Receiver present.

CORAM : R.I. CHAGLA J




DATE : 22 October 2024

ORDER :


SHARAYU
PANDURANG
KHOT


Digitally signed
by SHARAYU
PANDURANG
KHOT
Date: 2024.10.23
18:03:51
+0530

1. Mr. Mitesh Parmar, Ld. Advocate for the Defendant, undertakes to file his Vakalatnama within a period of one week from today.
2. The Plaintiff has filed the present Suit seeking permanent injunction restraining the Defendant from infringing the


Plaintiff's registered trade mark GIRNAR /  and the Plaintiff's copyright subsisting in its original artistic work comprised in the trade mark / logo , for passing off and for other ancillary reliefs. The Plaintiff has also sought a decree of declaration that the Plaintiff's trade mark GIRNAR /  is a well-known trade mark in India.

3. By an order dated 27th August 2024, this Court granted *ex-parte* ad-interim reliefs against the Defendant in terms of prayers clauses (b), (c), (d) and (e) of the Plaintiff's Interim Application for temporary reliefs [Interim Application (L) No.26310 of 2024].
4. Mr. Mitesh Parmar, Ld. Advocate for the Defendant, has tendered an Affidavit-cum-Undertaking dated 21st October 2024 of Mr. Tauhid Ahmed Abdul Kadar Khan, the owner / sole proprietor of the Defendant, which is taken on record and marked 'X' for identification. He submits that the Defendant wishes to submit to a decree in terms of prayer clauses (a), (b) and (c) of the Plaintiff.
5. Mr. Hiren Kamod, Ld. Advocate for the Plaintiff, submits that in view of the averments made in the Plaintiff and the documents / material produced therewith, apart from decreeing the Suit in terms of prayers clauses (a), (b) and (c) of the Plaintiff, the Plaintiff is also entitled to a declaration that the Plaintiff's trade

mark GIRNAR /  is a well-known trade mark in India. He has made detailed submissions regarding the nature of goods/services rendered/business done by the Plaintiff under the trade mark GIRNAR and the kind of wide reputation and goodwill that has been acquired by the Plaintiff in its trade mark GIRNAR.

6. Mr. Kamod submits that the Girnar Group's founders / Plaintiff's predecessors commenced the business of *inter alia* selling tea and spices in the year 1928. He submits that the Plaintiff's goods are sold under the Plaintiff's trade mark GIRNAR since 1975 by the Plaintiff's predecessors and since 1993 by the Plaintiff. He submits that the Plaintiff has since diversified from an entity trading in bulk tea to offering all kinds of tea, coffee, spices and a host of other products such as *inter alia* biscuits, breads, cookies, instant foods, beverages etc. and in providing related services under the trade mark GIRNAR.
7. Mr. Kamod submits that the Plaintiff's said goods are sold under the Plaintiff's well-known trade mark / house mark GIRNAR (word *per se*),  and/or various formative marks comprising 'GIRNAR' as one of their leading, prominent and essential features. He submits that the trade mark GIRNAR is an arbitrary mark having no significance or connection, whether direct or indirect, to the goods / services of the Plaintiff, and that therefore, the same is inherently distinctive and deserves the highest degree of protection. He submits that the

Plaintiff's trading name and style viz. 'Girnar Foods and Beverages Pvt. Ltd.' also contains the trade mark GIRNAR as its leading, prominent and essential feature. He submits that the Plaintiff is, in short, known as 'GIRNAR' by consumers, the public and in trade circles.



8. Mr. Kamod submits that the Plaintiff is the registered proprietor of the word mark GIRNAR as also of the device mark . Details of the Plaintiff's trade mark registrations in respect of the GIRNAR marks are set out in paragraph 10 of the Plaint. The earliest of these registrations for



the label mark bearing GIRNAR dates back to 1977, and for the word mark 'GIRNAR' dates back to 1986 claiming user since 1975. I have perused the table delineating the Plaintiff's registrations for the trade mark GIRNAR / GIRNAR formative marks at Exhibit A to the Plaint, and the copies of legal proceedings certificates / registration certificates at Exhibits B1 to B59 to the Plaint. Mr. Kamod submits that the Plaintiff has also obtained trade mark registrations for the trade mark GIRNAR in various foreign jurisdictions, a list whereof is set out in paragraph 11 of the Plaint, with copies of relevant registration related documents / certificates at Exhibits C1 to C12 to the Plaint.

9. Mr. Kamod submits that the Plaintiff's artistic label


containing the Plaintiff's trade mark 'GIRNAR' as one of its leading, essential and prominent features, is prominently used on all of the said goods of the Plaintiff as also on the Plaintiff's advertisement and promotional material such as letterheads, signboards, banners, hoardings, labels, brochures, pamphlets, flyers, advertising material, papers, stationery etc.


10. Mr. Kamod invited this Court's attention to paragraph 14 to 20 of the Plaint to show the extent of the Plaintiff's business in India to underscore the reputation and goodwill acquired by the Plaintiff in the trade mark GIRNAR /  in India. The Plaintiff's manufacturing capabilities and product quality assurance are also stated in the said paragraphs. He submits that in addition to over 40,727 retailers and over 255 distributors in India, the Plaintiff has over 50 standalone retail outlets in the Western and Southern regions of India.
11. Mr. Kamod has further invited my attention to the illustrative copies of various awards and accolades earned by the Plaintiff from time to time at Exhibit F to the Plaint. He has further invited my attention to paragraph 21 of the Plaint wherein there are tables delineating the Plaintiff's sales and advertisement / promotional expenses, with supporting Chartered Accountants' certificates at Exhibit H1 and H2 to the Plaint. He submits that the Plaintiff's sales revenues for its goods bearing the trade mark GIRNAR /  for F.Y. 2022-23 alone was INR

48,777 Lakhs, and the overall cumulative sales revenues from F.Y. 1974-75 to 2024-25 (till 31/07/2024) was approximately INR 6,89,294.61 Lakhs. He invited this Court's attention to extensive material such as sales invoices, advertisement and promotional material annexed at Exhibits I and J to the Plaintiff.

12. The online presence of the Plaintiff's trade mark GIRNAR /

 is detailed in paragraphs 22 to 25 of the


Plaint; with printouts from the Plaintiff's websites at Exhibits K1 and K2, from the Plaintiff's product listings on various e-commerce websites at Exhibit L, and from the Plaintiff's social media pages at Exhibit M1 and M2 to the Plaintiff. At Exhibit N to the Plaintiff are photographs from various trade fairs / exhibitions attended by the Plaintiff promoting the Plaintiff's trade mark GIRNAR /  and the goods bearing the same.

13. Mr. Kamod submits that the Plaintiff has been vigilant about protecting its intellectual property rights vesting in the GIRNAR marks and the said label . He submits that in the past, the Plaintiff has filed numerous opposition proceedings before the Trade Marks Registry against trade mark applications of third party applicants filed for deceptively similar marks as those of the Plaintiff's GIRNAR marks, details whereof are set out in paragraph 32 of the Plaintiff. He submits that the Plaintiff has in the past also issued various caution notices / public notices and cease and desist notices to third party infringers of its GIRNAR marks, illustrative copies whereof are at Exhibit P

and Exhibits Q to U to the Plaintiff. He submits that the Plaintiff has also filed Suits before this Court against third party infringers of its GIRNAR marks in the past. The details of these actions taken by the Plaintiff are detailed in paragraph 35 of the Plaintiff, with copies of such orders passed / consent terms filed therein at Exhibits V, W, X, Y, Z, AA, AB and AC to the Plaintiff.

14. Mr. Kamod submits that the Plaintiff's trade mark GIRNAR /

 GIRNAR


is today no longer restricted to any particular class of goods or services, but is associated with the Plaintiff across all classes of goods and services. He submits that the trade mark GIRNAR /  has acquired a secondary meaning and connotation, and has come about to enjoy a personality that transcends beyond the scope of mere goods sold and/or services rendered by the Plaintiff thereunder.



15. Mr. Kamod submits that the parameters that are required to be taken into consideration for a well-known trade mark as per Sections 11(6) and 11(7) of the Trade Marks Act, 1999 have been sufficiently fulfilled by the Plaintiff in the present case. He has relied on the following orders / judgments in support of this submissions:






- i) Order dated 03rd December 2018 passed by this Court in the case of *ITC Ltd. Vs. Rani Sati Foods Pvt. Ltd.* (Commercial IP Suit No.1469 of 2018);
- ii) Order dated 08th February 2023 passed by the Delhi High Court in *Hermes International and Ors. Vs. Crimzon*

Fashion Accessories Private Limited [CS (COMM) 919/2022 and I.A. 22377/2022);

- iii) Order dated 11th July 2023 passed by the Delhi High Court in *Chapter 4 Corp. Vs. Dhanpreet Singh* [CS (Comm.) 782/2022 and I.A. 18343/2022, 11834/2023 and 12263/2023];
- iv) Order dated 29th November 2023 passed by the Delhi High Court in *Burger King Company LLC Vs. Virendra Kumar Gupta* [C.O. (Comm.) IPD-TM 686/2022]; and
- v) Order of the Delhi High Court in *Haldiram India Pvt. Ltd. Vs. Berachah Sales Corp and Ors.*, reported in 2024 SCC OnLine Del 2265

16. Mr. Mitesh Parmar submits that the Defendant has no objection for this Court to consider and grant the Plaintiff the relief prayed for declaring the Plaintiff's trade mark GIRNAR /  as a 'well-known' trade mark in India in terms of prayer clause (f) of the Plaint.

17. I have heard the submissions advanced by Mr. Kamod and perused the record. From the documents filed along with the Plaint, it is evident that the Plaintiff's trade mark / label mark  has garnered significant and enduring reputation and goodwill throughout India. Further, the Plaintiff has diligently safeguarded its rights in the trade mark  by initiating appropriate actions including obtaining restraint orders from this Court. Now it is a settled

principle that a trade mark is capable of being protected if either it is inherently distinctive or has acquired distinctiveness. In this spectrum of distinctiveness, the first category of marks is of arbitrary, fanciful, coined or invented marks, which are of absolute distinctiveness. The marks falling under this category deserve the highest degree of protection. Since the trade mark  is an arbitrary mark having no significance or connection, whether direct or indirect, to the goods / services of the Plaintiff, the same is inherently distinctive and therefore deserves the highest degree of protection. The material produced shows that the Plaintiff's trade mark  has acquired immense and long-standing reputation and goodwill throughout India. By reason of the continuous and extensive use of the trade mark  by the Plaintiff and the efforts taken by it in popularizing and protecting the same, the Plaintiff's trade mark  has indeed become a household name in India, and the same enjoys wide and enviable reputation and goodwill amongst the general public in India. There can be doubt that the trade mark  is associated with the Plaintiff and no one else.

18. Mr. Kamod's reliance on the judgment of the Delhi High Court in *Haldiram India (supra)* is apposite. The relevant paragraphs from the said decision are reproduced below:

“55. In so far as the prayer for declaration seeking recognition as a ‘well-known mark’ is concerned, Section 2(zg) of the Act defines a well-known mark as under:

“(zg) ‘well known trade mark’, in relation to any goods or services, means a mark which has become so to the substantial segment of the public which uses such goods or receives such services that the use of such mark in relation to other goods or services would be likely to be taken as indicating a connection in the course of trade or rendering of services between those goods or services and a person using the mark in relation to the first-mentioned goods or services.”

56. Further, Section 11(6) of the Act lays down the factors to be considered for declaration of a mark as a ‘well-known’. The said provision reads as under:

“(6) The Registrar shall, while determining whether a trade mark is a well-known trade mark, take into account any fact which he considers relevant for determining a trade mark as a well-known trade mark including—

(i) the knowledge or recognition of that trade mark in the relevant section of the public including knowledge in India obtained as a result of promotion of the trade mark;

(ii) the duration, extent and geographical area of any use of that trade mark;

(iii) the duration, extent and geographical area of any promotion of the trade mark, including advertising or publicity and presentation, at fairs or exhibition of the goods or services to which the trade mark applies;

(iv) the duration and geographical area of any registration of or any application for registration of that trade mark under this Act to the extent that they reflect the use or recognition of the trade mark;

(v) the record of successful enforcement of the rights in that trade mark, in particular the extent to which the trade mark has been recognised as a well-known trade mark by any court or Registrar under that record.”

57. In *Tata Sons Ltd. Vs. Manoj Dodia*, (2011) 46 PTC 244 (Del), a *ld. Single Judge* of this Court elaborated upon the principles for declaration of a mark as well known. The relevant extracts of the said decision are as under:

“5. A well known trademark is a mark which is widely known to the relevant general public and enjoys a comparatively high reputation amongst them. On account of advancement of technology, fast access to information, manifold increase in international business, international travel and advertising/publicity on internet, television, magazines and periodicals, which now are widely available throughout the world, of goods and services during fairs/exhibitions, more and more persons are coming to know of the trademarks, which are well known in other countries and which on account of the quality of the products being sold under those names and extensive promotional and marketing efforts have come to enjoy trans-border reputation. It is, therefore, being increasingly felt that such trademark needs to be protected not only in the countries in which they are registered but also in the countries where they are otherwise widely known in the relevant circles so that the owners of well known trademarks are encouraged to expand their business activities under those marks to other jurisdictions as well. The relevant general public in the case of a well known trademark would mean consumers, manufacturing and business circles and persons involved in the sale of the goods or service carrying such a trademark.

6. The doctrine of dilution, which has recently gained momentous, particularly in respect of well known trademarks emphasises that use of a well known mark even in respect of goods or services, which are not similar to those provided by the trademark owner, though it may not cause confusion amongst the consumer as to the source of goods or services, may cause damage to the reputation which the well known trademark enjoys by reducing or diluting the trademark's

power to indicate the source of goods or services.

7. Another reason for growing acceptance of transborder reputation is that a person using a well known trademark even in respect of goods or services which are not similar tries to take unfair advantage of the transborder reputation which that brand enjoys in the market and thereby tries to exploit and capitalize on the attraction and reputation which it enjoys amongst the consumers. When a person uses another person's well known trademark, he tries to take advantage of the goodwill that well known trademark enjoys and such an act constitutes an unfair competition.”

58. Further, this Court in *Disruptive Health Solutions Vs. Registrar of Trade Marks* [C.A. (COMM. IPD-TM)] 133/2022, decision dated 8th July 2022] discussed test of distinctiveness of trade marks, wherein it was observed that in the spectrum of distinctiveness, the first category of marks is of arbitrary, fanciful and invented marks, which is of absolute distinctiveness. The relevant extract of the said decision is as follows:

“10. The general rule regarding distinctiveness is that a mark is capable of being protected if either it is inherently distinctive or has acquired distinctiveness through secondary meaning. In the spectrum of distinctiveness, the first category of marks is of arbitrary, fanciful and invented marks which is of absolute distinctiveness. Similarly, suggestive marks can also be registered due to their inherent distinctiveness. Descriptive marks can be registered as trademarks provided secondary meaning is established. Insofar as descriptive marks are concerned, just because some portion of the mark may have some reference or indication as to the products or services intended for, the same may not be liable to be rejected straightaway. In such a case, the merits of the marks would have to be considered along with the extent of usage. Other registrations of the applicant would also have a bearing on the capability of the mark obtaining registration. The

owner of a mark is always entitled to expand the goods and services, as a natural consequence in expansion of business.”



59. Considering the factors delineated under Section 11(6) of the Act, this Court on various instances has considered the grant of declaration of ‘well-known’ mark.




- In **ITC Ltd.** (supra), after considering the legal position regarding the protection of well-known marks in India and the US, this Court declared ‘BUKHARA’ as a well-known mark. The Court held that the mark ‘BUKHARA’ originated in India and enjoys substantial goodwill and reputation not only among Indians but also among foreigners who travel to India and carry back the said reputation.*


- In **Chapter 4 Corp.** (supra), this Court declared the ‘SUPREME’ redbox device mark as a ‘well-known’ mark in respect of apparel and clothing. The said declaration is limited to the ‘SUPREME’ red-box logo and does not extend to the word itself.*

- In **Glaxo Group Ltd. Vs. Manoj Kumar Jain** (2023 : DHC : 6479), this Court declared the mark ‘BETNESOL’ as a ‘well-known mark’ in respect of pharmaceutical and medicinal items as also cognate and allied products.”*

(emphasis supplied)

19. In my view, it can be safely held that the Plaintiff’s trade mark / label mark  has surpassed the scope of merely encompassing products / services sold or rendered under the said trade mark. The recognition, reputation and goodwill of the Plaintiff in its trade mark  now extends beyond any specific class of goods or services, thereby encompassing all classes. It is pertinent that the Defendant has no objection to this

Court considering and declaring that the Plaintiff's trade mark  as a well-known trade mark in India. Consequently, I am of the opinion that the Plaintiff's trade mark  satisfies the criteria and tests of a well-known trade mark as stipulated under Sections 11(6) and 11(7), and other relevant provisions of the Trade Marks Act, 1999. I have no difficulty in affirming that the Plaintiff's trade mark  indeed qualifies as a 'well-known' trade mark in India within the meaning of Section 2(1)(zg) of the Trade Marks Act, 1999.

20. In view of the Defendant's Affidavit-cum-Undertaking dated 21st October 2024, the Suit is decreed in terms of prayer clauses (a), (b) and (c) of the Plaint. Further, since this Court has arrived at the conclusion that the Plaintiff's trade mark  is a 'well-known' trade mark in India, the Suit is also decreed in terms of prayer clause (f) of the Plaint.
21. Suit is accordingly disposed of.
22. In view of the disposal of the Suit, the Plaintiff's Interim Application (L) No.26310 of 2024 also stands disposed of. There shall be no order as to costs.
23. The Court Receiver is discharged without passing of accounts but on payment of costs, charges and expenses, if any, to be borne by the Plaintiff. The Court Receiver's Report No.417 of

2024 accordingly stands disposed of.

24. Drawn up decree is dispensed with unless the parties seek drawn up decree, in which case they are entitled to apply for the same.
25. Court fees are to be refunded in accordance with the Rules. For the purposes of Section 43 of the Maharashtra Court Fees Act and the proviso to that Section, today's date is the date of making a claim for repayment. The Prothonotary & Senior Master will issue a certificate for a refund of Court Fees computed according to the Rules. He will act on production of an authenticated copy of this order without requiring a separate application.

[R.I. CHAGLA J.]