



* IN THE HIGH COURT OF DELHI AT NEW DELHI

%

+ FAO(COMM) 201/2021 & CM APPL.45018/2021 and 11665/2023

Reserved on: May 08, 2023
Pronounced on: May 31, 2023

TATA SIA AIRLINES LIMITED

..... Appellant

Through: Mr. Rajshekhar Rao, Sr. Adv. with
Ms. Kruttika Vijay, Mr. Aditya Gupta
and Mr. Mukul Kochhar, Advocates.

Versus

VISTARA HOME APPLIANCES PRIVATE LIMITED

& ORS.

..... Respondents

Through: Mr. Chander M. Lall, Sr. Adv. with
Ms. Kanika Sinha, Ms. Gunjan Gupta
and Ms. Maitreyi Joshi, Advocates.

CORAM:

HON'BLE MR. JUSTICE MANMOHAN

HON'BLE MR. JUSTICE SAURABH BANERJEE

JUDGMENT

SAURABH BANERJEE, J.

1. The present appeal is one whereby the appellant (*original plaintiff*) seeks to impugn the order dated 28th October, 2021 passed by the learned Trial Court¹ dismissing its application under *Order XXXIX rules 1 & 2* read with *Section 151²* of The Code of Civil Procedure, 1908³ in a suit for infringement of trademark, passing off and other ancillary reliefs against the respondents (*original defendants*).

¹ Hereinafter referred as “*impugned order*”

² Hereinafter referred as “*interim application*”

³ Henceforth referred as “*CPC*”



CASE OF THE APPELLANT BEFORE THE LD. TRIAL COURT:

2. As per facts, appellant is a joint venture between TATA Sons Private Limited and Singapore Airlines Limited operating a full-fledged service airline under its trademark 'VISTARA' covering as many as 36 destinations with over 200 flights a day on the date of institution of the suit before the learned Trial Court. The said trademark 'VISTARA' of appellant, since its declaration as a 'well-known trademark' as per *Section 2(1)(zg)⁴* of The Trade Marks Act, 1999⁵ by this Court in ***TATA SIA Airlines Limited v M/s. Pilot18 Aviation Book Store & Anr.***⁶, is entitled to a higher degree of protection under law. The appellant is offering its services in the Travel and Hospitality Industry through its website 'www.airvistara.com' and mobile app by expending huge amounts towards advertisements and sales promotion of its trademark 'VISTARA'. The appellant has also received various Awards in recognition of its widely recognized services under the trademark 'VISTARA'.

3. The appellant adopted the trademark 'VISTARA' on 11th August, 2014, deriving it from the Sanskrit word 'Vistaar' meaning "limitless expanse of possibilities" and has since extensively and uninterrupted used it. The trademark 'VISTARA', being arbitrary, is distinctive of the products and services of the appellant. In India, the appellant has since obtained registration of the trademark 'VISTARA' (word & logo) in Classes 12, 39, 16, 21, 25, 27, 28, 18, 9, 35, 39, 43 and 45 from time to time, the earliest being TM no.2748039 in Classes 12 and 39 on 2nd June, 2014 for the trademark 'VISTARA' (Word). Interestingly, even though a third party also became the owner of the same trademark 'VISTARA' in Class 39

⁴ Hereinafter referred as "***well-known mark***"

⁵ Hereinafter referred as "***TM Act***"

⁶ 2019 SCC OnLine Del 9535



subsequently, *however*, the same has since been assigned with goodwill to the appellant on 11th February, 2016, prior to the date of user claimed by the respondents. Additionally, the appellant has also obtained registration of its trademark 'VISTARA' in various jurisdictions across the globe in almost all the Classes mentioned hereinabove.

4. The respondent no.1 is a company duly incorporated under the laws of India with respondent nos.2 to 4 as its directors. The appellant came to know upon accessing the website 'www.vistarahome.com' of respondents in September 2020 that the respondent no.1 was using its trademark 'VISTARA' as its corporate name 'Vistara Home Appliances Private Limited'; as its domain name 'www.vistarahome.com' and as its device

marks  and  without any authorization whatsoever from it. Not only that, the respondents were also found selling and offering home appliances like LED TV, OTG, fans and coolers under the impugned mark VISTARA (device) on its website and on third party websites and was active on social media platforms, like Facebook and YouTube since their adoption in December 2018, also without any authorization from the appellant. Not stopping there, the appellant contends that the respondents falsely claiming use of the mark



since July 2016, also applied for its registration in Classes 7, 9 and 11 before the Trademark Registry.

5. The appellant, vide its Legal Notice dated 9th September, 2020 followed by a reminder notice dated 16th March, 2021, called upon the respondents to cease and desist their acts of infringing and passing off the



trademark 'VISTARA'. Non receipt of response to either of them by respondents despite due receipts led to institution of a suit for infringement of trademark, passing off by the appellant in May 2021 seeking a decree of permanent injunction from infringing and/ or passing off by advertising, directly or indirectly offering any goods or services, using or registering corporate names, domain names or in any other manner using the trademark

 and the domain name www.vistarahome.com and/ or any mark deceptively similar to the appellant's trademarks and/ or formative marks, rendition of accounts, delivery up and damages against the respondents before the learned Trial Court. As per the appellant, the unfair advantage of using the impugned mark VISTARA (device) for home appliances by respondents is resulting in confusion in the minds of the public and is likely to cause incalculable damage and loss to the business and goodwill of the appellant. More so, as TATA Sons, a 51% majority shareholder of appellant, is itself a pioneer in the industry offering a variety of FMCG products, appliances and household goods. The adoption of the impugned mark VISTARA (device) by the respondents is without any justification and thus, the use thereof is dishonest and the same is leading to whittling away and erosion of the trademark 'VISTARA' of appellant.

CASE OF THE RESPONDENT BEFORE THE LD. TRIAL COURT:

6. The respondents, after being served with the summons in the suit and the interim application, filed their reply to the interim application, without written statement, contending that the respondent no.1 applied for registration of the impugned mark VISTARA (device) in Classes 7, 9 and 11 and the appellant is neither using the trademark 'VISTARA' nor has



applied for registration for products falling in the said Classes. The fact that appellant has registration of its trademark 'VISTARA' in other Classes barring in Classes 7, 9 and 11 shows, it has no intentions to use the trademark 'VISTARA' in those Classes. Further, there could be no confusion as VISTARA was a dictionary word and the respondent no.1, since existence as a Company from 2015, "*... ...has entered into various contracts and established very deep trade channels and business networks.*" and also "*built a reputation*" and "*made extensive investments*". Resultantly, the business has "*grown multifold*" and if the respondents are restricted

from using the mark  after more than five years of its incorporation, it would be catastrophic for them causing loss of customers, trade channels and industry of operation as the home appliances segment is very competitive for which they can never be adequately compensated. As per respondents, the trademark 'VISTARA' of appellant was not a 'well-known mark' when the respondent no.1 commenced using the impugned mark VISTARA (device) as its tradename in the year 2015 or subsequently as its trademark in the year 2016 or lately as its domain name "www.vistarahome.com" since 2018 and was declared so only in the year 2019.

7. The respondents candidly submitted in their reply to the impugned interim application of being "*... ...themselves very cautious and they do not their mark to be confused with that of the plaintiffs which is why they have represented their mark in a completely different manner... ...*" in choosing a different color combination, font, style of writing, structure and overall



representation of the impugned mark



of the appellant. As per respondents, VISTARA is neither a coined word nor an invented word but is a word found in Sanskrit and other languages and commonly found in the dictionary. Moreover, there were various other VISTARA marks users in Classes 3, 10, 14 and 17. The respondents honestly adopted the impugned mark VISTARA and have been an honest and concurrent user since then. Further, relying upon the submissions made by appellant in its response to an Examination Report before the Trade Mark Registry wherein with respect to a trademark 'Vistar' belonging to a third party, it stated that the said mark 'Vistar' was filed in relation to services wholly distinct from the primary business of the appellant as its "... planned services are in leased aircrafts and flight operations and all ancillary services relating thereto under the brand 'VISTARA' and all its activities will relate solely to the said services... ...". As per respondents, the appellant is estopped from contending anything contrary thereto. As per respondents, as they commenced operation of the impugned mark VISTARA (device) within one year after the appellant, there is no passing off by them and further as they are dealing in goods totally unrelated to those of the appellant and they are not unauthorized users as per *Section 29* of the TM Act.

IMPUGNED ORDER:

8. Based upon the facts involved and after hearing the parties, the learned Trial Court agreed with the contention of the appellant qua its adoption and uninterrupted extensive use of the trademark 'VISTARA'



since 2014 and qua it being arbitrary and inherently distinctive with respect to travel services even though it was a Sanskrit word ‘Vistaar’ meaning limitless expansion. Qua the submission made before the Trade Mark Registry with respect to an already registered trademark ‘Vistar’ of a third party, the learned Trial Court despite holding that there is no estoppel against the statute and the appellant cannot be restrained from exercising its rights qua its registered trademark merely because it took a certain stand before the Trade Mark Registry, gave more weightage to the fact that the impugned mark VISTARA of the respondents is registered since 2016. Similarly, the learned Trial Court, though finding not “... *...much dissimilarity... ...*” between the two competing marks as they both “... *...have the phonetic similarity*”, but as they were used in different classes of goods and catered to different customers, no injunction against respondents was granted, as there were remote chances of respondents encashing upon the goodwill and reputation of the appellant. Though the learned Trial Court found appellant to be a prior adopter of the trademark ‘VISTARA’, *however*, the same had no bearing as it was not a ‘well-known mark’ at the time of adoption of the impugned mark VISTARA by respondents.

9. The learned Trial Court, after taking note of the various steps diligently taken by appellant, then held that there was no delay, latches and acquiescence on the appellant’s side as it had not abandoned its right over its registered trademark ‘VISTARA’. Similarly, though relying upon ***Clinique Laboratories LLC & Anr. vs Gufic Limited & Anr.***⁷ wherein it is held by this Court that a suit by one registered proprietor under *Section 31* of TM Act is maintainable against another (subsequent) registered proprietor, *however*, the learned Trial Court extended no benefit to the



appellant as the subsequent registration by respondents *prima facie* was neither invalid nor cancelled, as neither any objection to the applications for registration of the impugned mark VISTARA (device) of respondent no.1 in Classes 7, 9 and 11 nor objection to use of the website “www.vistarahome.com” of respondents since 2018 was filed and as the respondents were using the said impugned mark for unrelated goods. The learned Trial Court held that since TM Act does not prevent or prohibit any registered proprietor of a registered trademark to initiate action against another registered proprietor of a registered trademark, similarly, Courts are also free to grant any interim reliefs therein.

10. The learned Trial Court, although finding that the trademark ‘VISTARA’ of appellant since declaration as a ‘well-known mark’ under *Section 2(1)(zg)* of TM Act is entitled to the highest degree of protection, held that the same was not relevant as it was declared so only after registration of the impugned mark VISTARA (device) of respondents in Classes 7, 9 and 11 wherein the appellant was not offering any services. It further held that since VISTARA is not an invented word and has a dictionary meaning, it cannot be monopolized by appellant. The learned Trial Court then held that as the respondents have, over the years, entered into various contracts and established deep trade channels and business networks and have many dependent employees, they would lose customers, trade channels and industry of operation as home appliances segment is very competitive. Thence, relying upon *Nandhini Deluxe vs Karnataka Co-operative Milk Products Federations Ltd.*⁸ and *Pritikiran Rajendra Katole vs Harsha Ravindra Katole*⁹, it was held that there could be no likelihood of confusion in the minds of general public and that no case of

⁸ 2018 SCC OnLine SC 741

⁹ 2013 SCC OnLine Bom 1552



passing off was made out against the respondents and they “... ...have adopted a mark which has the dictionary meaning.” and once again about the statement made by appellant before the Trade Mark Registry with respect to an already registered trademark ‘Vistar’ in the name of a third party.

11. Accordingly, the learned Trial Court held that it was too early to say that the impugned mark VISTARA was adopted by the respondents to encash upon the goodwill and reputation of the appellant or that they were indulging in passing off or that there was any likelihood of confusion. The learned Trial Court, on the strength of *Section 12* of the TM Act, also held that the respondents were entitled to use the said impugned mark VISTARA for the goods falling in Classes 7, 9 and 11 as the customers, trade channels and industry of operations of both parties being different/ unrelated, they can be easily distinguished. Further, finding both parties to be registered proprietors of the trademark ‘VISTARA’, the learned Trial Court dismissed the interim application of the appellant.

APPEAL PROCEEDINGS BEFORE THIS COURT:

12. The appellant has preferred the present appeal largely raising the same contentions as raised before the learned Trial Court. During the course of arguments, learned senior counsel for appellant, after drawing the attention of this Court to an extract downloaded from the website of the Ministry of Corporate Affairs, wherein it was mentioned that the respondents were related to one ‘Shyam Group’, contended that the same reveals that the adoption of the impugned mark “VISTARA” by the respondents and the subsequent registration obtained by the respondent no.1 thereof are *mala fide* as the said ‘Shyam Group’ had no connection whatsoever with the trademark ‘VISTARA’ of the appellant.



13. Then, drawing attention of this Court to *Clinique (supra)*, *Indian Hotels Company Ltd. vs Ashwajeet Garg*¹⁰ and *Dabur India Ltd. vs Alka Ayurvedic Pvt. Ltd.*¹¹, it was contended that as the registration of the impugned mark “VISTARA” was invalidly obtained under *Sections 9 and 11* of TM Act by respondents, the Court, irrespective of the registrations of the impugned mark VISTARA in favour of respondent no.1, has the power to pass any interlocutory order restraining them. The learned senior counsel, relying upon numerous judgments contended that, *admittedly*, the appellant is the prior adopter and user of the trademark ‘VISTARA’, which has since been declared as a ‘well-known mark’ and that the competing marks are phonetically similar to each other and also that there was no delay, latches or acquiescence by it in approaching the learned Trial Court.

14. Contrary thereto, learned senior counsel for the respondents primarily contended that a simpliciter declaration of the trademark ‘VISTARA’ as a ‘well-known mark’ by this Court in *Tata Sia Airlines Limited (supra)* is not sufficient since the test laid down by this Court in *Tata Sons Ltd. Vs Manoj Dodia & Ors*¹² has not been followed. It was then contended that the appellant was not entitled to the relief of injunction as the respondent no.1 was itself already a registered proprietor of the impugned mark ‘VISTARA’ in different classes. Then, relying upon *Bhole Baba Milk Food Industries Ltd. vs Parul Food Specialties Pvt. Ltd.*¹³, *Carlsberg India Pvt. Ltd. vs Radico Khaitan Ltd.*¹⁴, *Marico Limited vs Agro Tech Foods Limited*¹⁵ and *Skyline Education Institute Pvt. Ltd. vs S.L. Vaswani & Ors.*¹⁶, it was contended that the appellant cannot claim monopoly on the dictionary word

¹⁰ 2014 SCC OnLine Del 282

¹¹ 2017 SCC OnLine Del 7268

¹² 2011 SCC OnLine Del 1520

¹³ 2011 SCC OnLine Del 4422

¹⁴ 2011 SCC OnLine Del 5497

¹⁵ 2010 SCC OnLine Del 3806

¹⁶ (2010) 2 SCC 142



VISTARA which is a Sanskrit word meaning expansion and further relying upon *Nandhini Deluxe (supra)*, *S.M. Dyechem Ltd. vs Cadbury (India) Ltd.*¹⁷ and *Cadila Health Care Ltd. vs Cadila Pharmaceuticals Ltd.*¹⁸, it was contended that the impugned mark VISTARA is a (device) mark whereas the trademark 'VISTARA' of appellant is a (word) mark and on comparison of both together as a whole, including the trade dress, design, additional characters added to the dominant mark, mere phonetic similarity would not render them similar. It was also contended that as there was no triable issue raised, there was no infringement and there was enough material on record before this Court to show that the trademark registry was satisfied while granting registration of the impugned mark VISTARA to the respondent no.1. It was also contended that the appellant was estopped from contending anything contrary to its own statement made before the Trade Mark Registry with respect to mark 'Vistar' of a third party. Lastly, relying upon *Wander Ltd. & Anr vs Antox India Pvt. Ltd.*¹⁹, it was contended that the appellate Court ought not to interfere with the discretion exercised by the learned Trial Court.

15. Learned senior counsel for the appellant while addressing rejoinder arguments once again reiterated its position and sought setting aside of the impugned order and grant of an interim injunction instead.

FINDINGS & ANALYSIS:

16. This Court, after hearing the learned senior counsel for both parties and perusing the relevant documents finds that, *admittedly*, (i) the appellant was incorporated in the year 2013, i.e. prior to the formation of the respondent no.1; (ii) the appellant was already using the trademark

¹⁷ (2000) 5 SCC 573

¹⁸ (2001) 5 SCC 73

¹⁹ 1990 Supp SCC 727



‘VISTARA’ prior to the respondents, and (iii) the respondents have not given any plausible basis or reason for adopting the impugned mark VISTARA at any stage. The aforesaid factors are extremely vital and relevant, going to the very root of the dispute involving the trademark as the word ‘VISTARA’ is forming a prominent part in the competing marks, more so, as the respondents subsequently adopted an already existing registered trademark ‘VISTARA’ of the appellant *firstly* as its corporate name ‘Vistara Home Appliances Private Limited’ in the year 2015, *secondly* as a (device) mark in the year 2016 and *thirdly* as its domain name ‘www.vistarahome.com’ in the year 2018. That the appellant was already incorporated, already using the trademark ‘VISTARA’ prior to the formation of respondent no.1 and that the respondents were unable to give any plausible basis or reason for adopting the impugned mark VISTARA were sufficient reasons for the learned Trial Court to allow the interim application of appellant.

17. The respondents were always well-aware of the appellant and its registered trademark ‘VISTARA’, both while adopting and while filing for registration of the impugned mark VISTARA is apparent from their own reply to the interim application wherein they pleaded that they were “...*very cautious and they do not their mark to be confused with that of the plaintiffs which is why they have represented their mark in a completely different manner... ...*”. Thus, both adoption and usage of the impugned mark VISTARA by respondents were *per-se*, dishonest since inception. The same, *however*, has been ignored in the impugned order. Irrespective of that, their contentions qua adoption of the said mark and reasons thereof are being separately dealt hereunder.



18. The contention that the impugned mark VISTARA is a common dictionary word having a meaning in different languages including Sanskrit is incorrect, as the word VISTARA is neither a common word nor found in the dictionary in any language and is, at best, a mere derivative of the Sanskrit word 'Vistar'. The same is not sufficient to categorize the word 'VISTARA' as a common dictionary word. The trademark 'VISTARA' adopted by appellant is an invented word having no meaning, especially as it is distinct, unconnected, arbitrary and neither synonymous nor related to a particular class of services/ goods of any kind whatsoever and which was bona fide and genuinely adopted by it. The said trademark 'VISTARA' of appellant is thus arbitrary and distinctive. Interestingly, the respondent no.1 itself applied for registration of the impugned mark VISTARA shows that they were mindful of the value and importance attached to it. Having done so, the respondents are estopped from taking a contrary stand under the garb of it being a common dictionary word in various languages. Furthermore, it is settled law that an applicant having itself sought registration of the same word/ mark cannot agitate that it is a common dictionary word. There is no reference thereto in the impugned order.

19. The fact that though the respondent no.1 sought registration of the

impugned mark  but instead has always been using

the impugned mark  further shows the importance/ relevance of the word VISTARA and that the same has always been a prominent selective factor in both, which meant that they were always aware of the importance of the word VISTARA and were only interested in



that. It would not be wrong to infer that the respondent no.1 mala fide chose to apply for registration of a (device) mark instead of a (word) mark simply to circumvent the hurdles in the way qua the appellant and its registered trademark 'VISTARA'. In any event, as the impugned mark VISTARA (device) of respondents will always be referred visibly, seen and called by the general public as the word VISTARA, it is highly improbable that a man of average intelligence and normal recall will be able to differentiate the said mark with the registered trademark 'VISTARA' of appellant which in all likelihood will lead to confusion. There is no mention of the above in the impugned order.

20. Similarly, in the opinion of this Court, after finding that there was not "... *much dissimilarity*..." between the two competing marks as they both "... *have the phonetic similarity*"", there was no occasion for the learned Trial Court to deny the relief of injunction merely because the respondents adopted and used the impugned mark VISTARA in different Classes/ products, *more so*, whence the adoption was itself tainted and was not backed by any material particulars. This is so, as it is trite law that competing marks are to be seen and taken as a whole. In effect, what has to be taken into consideration is the overall impact/ impression which they are going to have and leave on the minds of the general public and members of the trade. At the end of the day, a trademark is 'what it is', i.e. the name by what it is identified, more than what it sounds like or looks like or what is its type, as in the opinion of this Court, the aforesaid despite being relevant factors for consideration are secondary to what a trademark is actually known as. For this, even if one mark is a (word) mark and the other is a (device) mark, the same is of hardly any importance, once the learned Trial Court had already held that the conflicting marks were not much dissimilar



and were phonetically similar. The similarity was material as both competing marks are same, despite one of them being a (device) mark.

21. Though the respondents also contended of adopting the impugned mark VISTARA as it means expansion, *however*, this Court is unable to agree with the said contention, once again, as it is neither a common nor a dictionary word in existence. Moreover, though respondent no.1 has registration of the impugned mark VISTARA in Classes 7, 9 and 11 for juicer, mixer, grinder, blander, washing machine, television, LCD, LED, DVD, home-theatre, mobile, computer, laptop, printers, mobile accessories, air cooler, fans, torch, iron, A.C., fridge etc., the Invoices and publicity materials show that the respondents are only dealing in raw materials with respect to Air Coolers having extremely low sales. Evidently, respondents have not expanded in any new products since adoption thereof. Thus, the said contention is clearly an after-thought and without merits. In any event, it is settled law that mere existence or presence of a mark in the market or in the Register before the Trade Mark Registry are not sufficient, more so, whence there is no proof of usage as respondents are unable to show any iota of proof of usage thereof for any of the products falling in Classes 7, 9 and 11 being the classes in which it is registered. The above has not been dealt with in the impugned order.

22. Similarly, despite pleading/ contending that respondents have entered into various contracts, established deep trade channels, business networks and industry of operations, and that they have many dependent employees and an injunction will result in their loss of customers, there is/ are no proof of anything qua that. Moreover, as the adoption of the impugned mark by respondents is shrouded in mystery, such usage can be of little relevance. As such, the learned Trial Court fell in grave error in going by the bald



assertions made by the respondents, especially whence there was nothing qua those anywhere on record before it. Furthermore, even if it is assumed to be so, the same coupled with the dishonest adoption of the impugned mark VISTARA by respondents, *Section 12* of TM Act cannot come to the aid of the respondents under suspicious circumstances. It is a settled principle in trademark law that 'adoption' takes precedence over 'usage' and any subsequent usage after wrongful adoption of a mark cannot/ ought not be given any credence. This Court opines that undue importance has erroneously been given to the wrongful adoption and unwarranted usage of the impugned mark VISTARA by the respondents as the same was dissimulating without any explanation from them.

23. Non-adoption and non-usage of the impugned mark VISTARA in the same Class and for the same goods as that of the appellant are of no essence to the present proceedings as Class discrimination and/ or Class distinction are of no consequence when the adoption of the mark by a party like the respondent no.1 is itself deceitful and tainted under suspicious circumstances and without any palpable reasons. What is required to be valued more is the intention of the adopter, particularly when it is the case of a subsequent adopter like the respondent no.1, *de hors* the same mark in a different Class. *Admittedly*, it is undisputed that appellant is both a prior adopter and a prior user of the trademark 'VISTARA' and the adoption and usage by respondents is all subsequent in point of time. As such, simply because the competing marks are used and registered in a different Class is immaterial, *more so*, when the adoption *per se* is sans clarity from the respondents. TM Act does not recognize the wrongful adoption of the mark by any party, much less, a third party as any such adoption will run contra to *Section 29* of the Act. The learned Trial Court, ignoring the bona fide



adoption and continuous usage of the trademark 'VISTARA' by appellant has instead taken the Class/ products for which it was/ is being used into account, ignoring the settled principles of law and facts.

24. Further, while considering the registered trademark 'VISTARA' of the appellant to be a 'well-known mark', the learned Trial Court neglected to give due weightage to its association, existence and popularity with the appellant as those are certainly relevant factors worthy of consideration for any mark to be declared as such, *more so*, when the legislature in its wisdom has knowingly recognized and accorded a better protection than to an already existing registered trademark. That services and products are available/ being used under numerous common existing words found in the dictionary and further that they have been duly registered from time to time itself shows that a common dictionary word, *per-se*, is entitled for its qualification and registration as a trademark over the passage of time leading to an entity acquiring monopoly over it, provided it is adopted and used for particular services or products falling in a particular Class with which it has no direct reference, connection or connotation and also if it has over time not only acquired distinctiveness but also has a secondary meaning attached to it. It is reiterated that once a trademark is registered it is well and truly entitled to all the statutory protection recognized and available under the TM Act. This is why, as per the Statute (TM Act) when a word is adopted under *Section 2(m)* as a 'mark' under the TM Act it can not only qualify to become a trade mark as per *Section 2(p)* of TM Act but can also, with the passage of the time, certainly progress and qualify to become a 'well-known mark' as per *Section 2(zg)* of TM Act. The status of the mark is ever-evolving and changing from time to time and is never static. Regardless of that, in the present factual matrix, the trademark



‘VISTARA’ of the appellant is a coined and invented word with no direct reference or meaning found in the dictionary or the common parlance. This Court finds no reference qua the above in the impugned order.

25. Although the appellant has the trademark registration for the trademark ‘VISTARA’ in other Classes barring Classes 7, 9 and 11, *however*, it issued a legal notice followed by a reminder notice to respondents and thence instituted a Suit against them meaning that the appellant had clear intentions of expanding its footprint. Further, TATA Sons, a 51% majority shareholder in the appellant was/ has already been dealing in FMCG products since long meaning that the appellant was already involved and dealing with the products falling in Classes 7, 9 and 11, in which the respondents had applied for registration. All these were discerning facts which ought to have been taken into account by the learned Trial Court for adjudication of the interim application. As such, merely because the competing marks were registered in separate Classes for different products could not be a ground to deny the relief of interim injunction to appellant. The aforesaid, in view of this Court, is contrary to the settled position of law.

26. Tainted adoption of the impugned mark VISTARA by respondents, under suspicious circumstances, is a discerning factor playing a dominant role throughout which leaves no doubt in the mind of this Court that the interim application of appellant deserves to be allowed. Having once adopted the impugned mark ‘VISTARA’ with their eyes and ears open, there is no scope left for the respondents to take refuge of the usage or projected loss of customers, trade channels and industry of operation as it is already too late in the day and when much water has flown under the bridge since then. The respondents are estopped from pleading so and cannot be



allowed to take benefit of their alleged wrongful, continuous usage for adoption without any cogent reasons. The fact that the respondents can neither claim nor avail benefit of their alleged reputation in and to the impugned mark VISTARA as they are inconsequential were overlooked while deciding the interim application.

27. Existence of third parties apart from the respondent no.1, who are either using VISTARA as their corporate name or using it as a mark, is immaterial and of no relevance for the purposes of adjudication of the present dispute as, in view of settled law, a registered proprietor is a master of its own ring and is not expected to be on its toes always to chase each and every infringer passing off its trademark and is free to initiate appropriate actions, if any, against any infringing party of its choice, on its own volition. Depending upon the facts and circumstances, a registered proprietor like the appellant herein is well within its rights to initiate action(s) against any party of choice and the respondents can have no say/ defense qua it and the same is a matter of choice has been completely ignored in the impugned order.

28. Similarly, the fact that the appellant, at the time of registration of its trademark 'VISTARA' in Classes 12 and 39 before the Trade Mark Registry had made some statement in response to the Examination Report issued with respect to an already registered trademark 'Vistar' in the name of a third party cannot come to the aid of the respondents as the same was neither in a proceeding pertaining to the parties involved herein nor was it made in context of the impugned mark VISTARA. The said proceedings therein being *in personam* are not applicable to the disputes involving the parties before this Court. Even otherwise, the fact that the said statement was made in the year 2014 whereas the present suit was instituted in 2021,



after a lapse of a period of almost *seven years* whence the trademark 'VISTARA' has grown in stature, built a substantial goodwill and reputation for itself and is also solely recognized and associated with the appellant was a relevant factor that was not considered.

29. Having found appellant to be the prior adopter, and accordingly a prior user of the trademark 'VISTARA', in the opinion of this Court, there was no occasion for the learned Trial Court to deny injunction simply because it was not a 'well-known mark' at the time of adoption of the impugned mark VISTARA by respondents without recording reasons therefor.

30. Further, the suit instituted by appellant, being a registered proprietor against the respondent no.1, also being a registered proprietor, is very much maintainable as the TM Act does not proscribe the appellant, being a registered proprietor and holder of a validly subsisting registered trademark to institute a suit against the respondent no.1. A Court is also, depending upon the facts and circumstances involved, free to grant any interim reliefs therein in favor of a registered proprietor.

31. The fact that the appellant never initiated any proceedings against respondents before the Trade Mark Registry is hardly of any consequence, as dawn of a new day brings with it fresh beginnings. Likewise, adoption of the impugned mark 'VISTARA' by the respondents without bona fide intentions, justification and cogent reasons gives rise to fresh cause of action with each passing day (**Bengal Waterproof Ltd. vs Bombay Waterproof Manufacturing Company & Anr**²⁰). Even otherwise, it is established that appellant was vigilant in pursuing its concern with the respondents as on becoming aware of the adoption of the impugned mark



VISTARA by respondents, it issued a legal notice followed up with a reminder thereto, both of which were never replied despite due service, and had instituted the suit before the learned Trial Court pleading that it was contemplating taking action *qua* the registration of the impugned mark VISTARA by respondents. Further, *admittedly*, that the respondent no.1 obtained registration of the impugned mark VISTARA subsequent to that of the appellant without any tenable basis was a vital factor ignored by the learned Trial Court.

32. The above reveals that the learned Trial Court erred in overlooking the fact that the respondents had, *admittedly*, not initiated any proceedings against the appellant, either before the Trade Mark Registry or before any Court of law in all the time while the interim application was being heard till passing of the impugned order. Meaning thereby, the registration for trademark 'VISTARA' was intact and was thus very much liable for protection under the Statute/ TM Act and common law. Therefore, it would not be wrong for this Court to conclude that the defenses raised by the respondents are after-thoughts and the learned Trial Court ought to have ignored them while passing the impugned order.

CONCLUSION:

33. In essence, this Court, being in agreement with the contentions put forth by learned senior counsel for appellant, finds the impugned order contrary to the settled principles of law, and does not concur with either the reasonings or the findings given by the learned Trial Court therein. The aforesaid leads to the conclusion that the learned Trial Court has either not considered them or if considered, has done so wrongly being against the settled principles of law and facts. Thus, this Court has more than one reason for interfering with the findings arrived by the learned Trial Court,



which this Court can do, *albeit*, depending upon the facts and circumstances, to undo what is unreasonable and not right.

34. In view of the factors enumerated hereinabove, to rectify the serious errors of law and facts, the impugned order requires intervention by this Court at the appeal stage and is liable to be set aside. This Court finds support from what is laid down by the Hon'ble Supreme Court in ***Ramdev Food Products (P) Ltd. Vs Arvindbhai Rambhai Patel & Ors.***²¹ and ***Skyline Education Institute (India) Pvt. Ltd.(supra)*** and what has been held in ***Wander (supra)*** as under:

“14. The appeals before the Division Bench were against the exercise of discretion by the Single Judge. In such appeals, the appellate court will not interfere with the exercise of discretion of the court of first instance and substitute its own discretion except where the discretion has been shown to have been exercised arbitrarily, or capriciously or perversely or where the court had ignored the settled principles of law regulating grant or refusal of interlocutory injunctions. An appeal against exercise of discretion is said to be an appeal on principle. Appellate court will not reassess the material and seek to reach a conclusion different from the one reached by the court below if the one reached by that court was reasonably possible on the material.”

35. Consequently, in view of the aforesaid reasonings and findings, this Court has no hesitation in allowing the present appeal, along with application, *if any*, and setting aside the impugned order dated 28th October, 2021 of the learned Trial Court, leaving the parties to bear their own respective costs.

SAURABH BANERJEE, J.

MANMOHAN, J.

MAY 31, 2023/akr