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

INTERIM APPLICATION (L) NO.14867 OF 2024
IN
COM IPR SUIT (L) NO.14360 OF 2024

Metro Brands Ltd.

...Applicant /
Plaintiff

Versus

Nice Shoes LLP & Ors.

...Defendants

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

Mr. Raj Dani, i/b. Jyoti Pandey for the Defendants.

CORAM : R.I. CHAGLA J.
DATE : 18TH NOVEMBER, 2024.

ORDER :

1. Mr. Khandekar, the learned Advocate appearing for the Applicant / Plaintiff has at the outset sought amendment to the prayers in the Interim Application on the ground that there are certain blanks, which are required to be filled up. The draft amendment has been tendered and is taken on record and marked 'X' for identification.

2. The Applicant / Plaintiff is permitted to carry out amendment in the relief sought for in the Interim Application in accordance with the draft amendment marked 'X'. The amendment shall be carried out forthwith. Re-verification is dispensed with.

3. By this Interim Application, the Applicant / Plaintiff is seeking an injunction restraining the Defendants from infringing the Plaintiff's registered trade marks, i.e. the 'MOCHI' marks (as identified at paragraph 5 of the Plaint) by the use of the impugned mark "DESIMOCHI" and / or any other marks identical or deceptively similar to the registered mark of the Plaintiff. Further, relief is sought for injunction restraining the Defendants from passing off Defendants goods / services as those of the Plaintiff's and for ancillary reliefs.

4. The Plaintiff states that it is a public limited company incorporated under the Companies Act, 1956. The Plaintiff claims to be one of the largest Indian footwear & accessories specialty retailers and are among the aspirational Indian brands in the footwear categories. Since 1955, the Plaintiff has been a one-stop-shop for all footwear needs. The Plaintiff is in the business of, *inter alia*, trading, marketing, distribution, sale, import, *inter alia*, of shoes; footwear;

boots; sandals; slippers; socks; non slipping devices for boots and shoes; soles for footwear; belts (clothing); heels and heel protectors for shoes; tips for footwear; welts for footwear; also pocket wallets; key cases; imitation leather; handbags; bags; attaché bags; briefcases; pouches of leather; leather unworked or semi-worked and accessories thereof (**'said goods'**). The Plaintiff is also in the business of allied and cognate goods and services. The Plaintiff also provides the services of distribution, marketing, sales of the said goods (**'said services'**) from over 826 stores across India.

5. It is further stated that the Plaintiff is the owner and registered user of the 'MOCHI' marks and have been in open, continuous and extensive use of the said 'MOCHI' marks since 1977, as a result of which the 'MOCHI' marks (as well as their essential and dominant feature 'MOCHI') have become well-known among members of the public in India and globally as markers/identifiers exclusively associated with the Plaintiff's business and brand.

6. It is stated that from 1977 to 2023, the Plaintiff/its predecessor in title claim have marketed, promoted and traded in the said goods and services under the said 'MOCHI' marks *inter alia*

through more than 229 exclusive 'MOCHI' outlets/showrooms/stores set up across India out of which, there are 6 stores in Jaipur, Rajasthan itself, the city in which the Defendant resides and conducts business.

7. The Plaintiff states that the 'MOCHI' marks are not only prominently displayed in the signages at these stores, but also prominently affixed /applied onto the goods / packaging /invoices/paraphernalia used in respect of the Plaintiff's goods and services.

8. It is stated that in and around December 2016, the Plaintiff began operation of a website under the domain name "www.mochishoes.com" ("**Plaintiff's website**"), incorporating the 'MOCHI' mark/brand as an essential and central feature thereof. The Plaintiff's goods and services have also been marketed/sold under the 'MOCHI' marks on the Plaintiff's website ever since. The Plaintiff's website is freely accessible from locations across India. Millions of members of the public/customers have accessed the Plaintiff's website to view and avail the Plaintiff's goods and services as a result of its imminently recognizable 'MOCHI' mark on the webpages as

well as the domain name.

9. It is stated that the Plaintiff's goods and services under the 'MOCHI' marks are also advertised, promoted and sold through prominent e-commerce platforms, including but not limited to Flipkart, Amazon, Myntra, Tata Cliq, Nykaa Fashion, Ajio etc. Over the years and in order to keep up with the digital times, the Plaintiff also spreads awareness of its 'MOCHI' mark and has gained immense reputation and recognition from its social media presence on platforms such as Instagram and Facebook.

10. The 'MOCHI' marks and 'MOCHI' brand have been featured in prestigious and acclaimed publications (*both online and offline*) such as the Times of India, Hindustan Times, infidigit, media4 growth, Economic Times, Global Prime News, Zee 5, Fashion Network, Ani News, prnewswire, Arad Branding, Insights Success, Media Infoline, Business Connect India, etc. As a result, the Plaintiff states that tremendous goodwill and reputation has accrued to the 'MOCHI' marks, the essential/dominant feature of which is the Plaintiff's mark 'MOCHI'.

11. It is stated that the Plaintiff, to ensure that its customers

as well as the public in general are aware of its said goods under the said marks, has spent huge sums of money on advertising and sales promotional activities by using different means, modes and formats which include print as well as online media. The Plaintiff has towards advertising and sales promotional activities for the period 2012 to 2022 spent a sum of Rs. 2,36,04,31,216/- and for the same activity during the financial year 2022-2023 itself, the Plaintiff has spent a sum of Rs.53,73,09,432/-.

12. It is stated that the impressive sales turnover of over Rs. 44,17,12,30,711/- for the period 2000 to 2023 which substantiates beyond an iota of doubt that immense goodwill and reputation accrues to the said 'MOCHI' mark on account of more than 4 ½ decades of continuous, open and extensive use thereof which has resulted in the Plaintiff to have 229 exclusive 'MOCHI' stores (*of which 6 stores are in Jaipur, Rajasthan - the city in which the Defendant resides and conducts business*).

13. The Plaintiff has applied for and/or is a registered proprietor in relation to various 'MOCHI' marks, a table in this regard is reproduced herein below:

Sr. No.	App. No.	Mark	Class	Date of Use	Date of App.	Status
1.	1361711		18	27/06/1977	06/06/2005	Registered
2.	4042031		18	27/06/1977	31/12/2018	Registered
3.	4719223	MOCHI	18	27/06/1977	26/10/2020	Registered
4.	1765851		18	Proposed to be used	19/12/2008	Registered
5.	4042032		25	27/06/1977	31/12/2018	Objected
6.	1765850		25	Proposed to be used	19/12/2008	Registered
7.	1361712		25	27/06/1977	06/06/2005	Registered
8.	4719224	MOCHI	25	27/06/1977	26/10/2020	Registered
9.	4042033		35	27/06/1977	31/12/2018	Registered
10.	4719225	MOCHI	35	27/06/1977	26/10/2020	Registered
11.	5944407		18	Proposed to be used	19/05/2023	Accepted & Advertised
12.	5944408		25	Proposed to be used	19/05/2023	Accepted & Advertised
13.	5944409		35	Proposed to be used	19/05/2023	Accepted & Advertised

14. As can be seen from the material on record, the Plaintiff has secured registration of the word mark 'MOCHI' in classes 18, 25 & 35, (*claimed use since 1977*) among other 'MOCHI' marks in the same classes.

15. It is stated that by virtue of such use and registration, the Plaintiff is statutorily entitled to the exclusive use of the 'MOCHI' marks (*as well as exclusive use of the prominent/essential feature thereof, 'MOCHI'*). The Plaintiff is entitled to restrain others from using/causing to be used, any name and/or mark *inter alia* containing the word/name 'MOCHI' and / or any other name and/or mark which is deceptively and/or confusingly similar in any manner whatsoever to the 'MOCHI' brand and/or 'MOCHI' marks, most particularly in respect of identical /similar/ allied/ cognate goods/services.

16. It is stated that owing to the open, continuous, extensive and uninterrupted use of the 'MOCHI' marks since its inception in 1977 (*in relation to the Plaintiff's goods and services, and particularly in relation to footwear*), the 'MOCHI' marks and/or the brand/name 'MOCHI' have come to be strongly and exclusively

associated and identified with the Plaintiff's business alone. The Plaintiff has over 12 variants of 'MOCHI' marks, which are only associated with the Plaintiff. The mark 'MOCHI' has attained a secondary meaning and is a "*well known mark*" by virtue of such use and popularity. The 'MOCHI' marks and the 'MOCHI' brand/name are associated with the business of the Plaintiff alone, and none else.

17. It is further stated that on account of the extensive use as also statutory recognition, the Plaintiff's mark 'MOCHI' has become a well-known mark within the meaning of Section 2(1)(zg) of the Trade Marks Act, 1999 ("**said Act**").

18. In or around August 2022, the Plaintiff claims to have learnt about the existence of a website, "www.desimochi.com" ('**impugned website**') that was selling footwear. Upon visiting the impugned website, it became clear to the Plaintiff that the Defendants were not only using the impugned website to sell their goods but were also selling footwear using the impugned mark, 'DESIMOCHI'. The Plaintiff further claims that the impugned marks were *ex-facie* identical and/or deceptively similar to the Plaintiff's 'MOCHI' marks and were being used in relation to goods and services

identical with and/or similar to those of Plaintiff.

19. The Plaintiff, through their Advocates, issued cease and desist notices dated 06th September 2022 (“**First Cease and Desist Notices**”) to the Defendants/their representatives at the different postal/e-mail addresses which the Plaintiff/their Advocates could source, which was not delivered and returned to the Plaintiff’s Advocate. Through the first Cease and Desist Notices, the Defendants were *inter alia* informed:

(i) priority of adoption and use of the said mark ‘MOCHI’ and its variants with respect to the said goods and services;

(ii) the immense goodwill and reputation associated with the ‘MOCHI’ marks due to the extensive, open and continuous use thereof since 1977;

(iii) that the adoption and use of the impugned mark/domain name was deliberate and with knowledge of the said mark and the goodwill and reputation that accrues to the said mark;

(iv) that use of the impugned mark and domain name was a violation of the rights of the Plaintiff since it infringed the marks

of 'MOCHI' which were granted registration then;

(v) that by use of the impugned mark and domain name, the Defendant was passing off their goods and services as that of the Plaintiff; and

(vi) that the Defendant was called upon to cease and desist from use of the impugned mark as well as the domain name.

20. Thereafter, on 07th October 2022 and 08th October 2022, the Plaintiff's Advocate sent two cease and desist notices to another address, sourced by the Plaintiff, which were successfully delivered to the Defendants.

21. On 20th October 2022, Defendant No. 1 through its Advocate replied to the Cease and Desist Notice dated 07th October 2022 ("**Defendants' First Reply**"), wherein the Defendants admitted to the use of the impugned marks, claimed to be the proprietor thereof, claimed that the rival words/marks *viz* 'MOCHI' and 'DESI MOCHI' (and variants thereof) are not actionably similar, and did not agree to take steps that the Plaintiff called upon the Defendants to take in the First Cease and Desist Notice. Although, the Advocate for

the Defendants, provided his contact information to amicably resolve the matter; there was no attempt on the Advocate to do so despite being contacted.

22. It is stated that the Plaintiff conducted a search from the available records of the Ld. Registrar of Trade marks. The search resulted in the Plaintiff learning of an application dated 13th February 2018, in respect of the label mark 'DESIMOCHI' having been filed by the Defendants. The application of the Defendants bearing no.3752268 in class 25 filed on '*proposed to be used*' basis was objected. The objection raised by the Ld. Registrar of Trade mark was under Section 9(1)(a) and 9(1)(b) of the Trade mark Act. The Defendant has responded to the objection of the Ld. Registrar of Trade marks and the application of the Defendant, till today, continues to be 'objected' and has not been granted registration.

23. It is stated that in order to make a final attempt at an amicable and pragmatic resolution before precipitating action against the Defendants, the Plaintiff issued further a set of cease and desist notices dated 03rd December 2022 and 12th December 2022 to the partners of Defendant No. 1 ("**Second Cease and Desist Notices**"),

once again setting out the credentials of the Plaintiff's business under the 'MOCHI' marks and calling upon the Defendants once again to *inter alia* cease and desist from using the impugned marks.

24. The Defendants' Advocate issued a further response dated 22nd December 2022 ("**Defendants' Second Reply**") to the Plaintiff's Second Cease and Desist Notice reiterating the stance taken in the Defendants' First Reply and again suggesting that the parties amicably resolve the matter.

25. It is stated that pursuant to this correspondence, the Advocate and representatives of the Plaintiff entered into several verbal discussions with the Advocate of the Defendants to amicably resolve this matter.

26. On 18th October 2023, the Plaintiff again issued a Cease-and-Desist notice to the Defendants as the Plaintiff claimed that the matter was reaching no logical conclusion and the Plaintiff's value in the said mark was diminishing day by day due to the alleged illegal use of the said mark registered in favour of the Plaintiff.

27. On 22nd November 2023, the Plaintiff filed a Complaint

with the WIPO Arbitration and Mediation Centre (the “**WIPO Centre**”). On 30th December 2023, a response was filed by the Defendants with the WIPO Centre.

28. Pursuant to the pleadings being completed, the decision of the WIPO Centre was passed on 23rd January 2024, whereby the Complaint was denied. In order for the decision to be passed in favour of the Plaintiff, three elements were to be established by the Plaintiff under paragraph 4(a) of the Policy, which were: “(i) *The disputed domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights; and (ii) The Respondent lacks rights or legitimate interests in the disputed domain name; and (iii) The disputed domain name was registered and is being used in bad faith by the Respondent.*” With respect to the first element, the WIPO Centre held as follows:

“...The Panel finds the Complainant has shown rights in respect of a trade mark or service mark for the purposes of the Policy WIPO Overview 3.0, section 1.2.1.

The mark is fully incorporated in the disputed domain name. Under the first element, the comparison of the mark and the disputed domain name is done without looking at the manner of actual use. Differences in goods and services,

weakness or strength of the mark are typically not considered under this element, as such factors could be relevant when considering other elements.

The disputed domain name contains the mark and this is sufficient to find confusing similarity with the mark. For the reasons discussed, the Panel finds there is confusing similarity between the disputed domain name and the mark. Although the addition of the term “desi” may bear on assessment of the second and third elements, the Panel finds the addition of the term “desi” does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the first element of the Policy. WIPO Overview 3.0, section 1.8.

The Panel finds the first element of the Policy has been established.”

29. Despite finding that the impugned mark contains the said mark and is sufficient to find confusing similarity with the mark, the Complaint was denied as it was held that the Plaintiff was unable to satisfy the WIPO Centre that the disputed domain name was registered in bad faith.

30. The Plaintiff states that the aforesaid findings are entirely inconsistent with the intellectual property law of India. Once it is found that a deceptively similar mark or domain name is being used with respect to identical goods and services, a case for infringement of trade mark is made out because such usage will

inevitably lead to confusion.

31. Mr. Khandekar, the learned Counsel for the Plaintiff submits that the use of the impugned mark by the Defendants clearly amounts to infringement as also passing off.

32. Mr. Khandekar submits that the mere addition of 'DESI' as a prefix is of no consequence and does not obviate the likelihood of confusion and unmistakable overall impression of similarity/identity between the rival marks/works. 'DESI' merely means 'Indian' (or pertaining to the geography of the Indian subcontinent). The addition of such inconsequential/generic/non-distinctive term does not alter the fact that the impugned mark 'DESIMOCHI' essentially, prominently, substantially comprise the core distinctive element of the said 'MOCHI' marks which the public/businesses have come to recognise as an identifier for the Plaintiff i.e. 'MOCHI'. He has in this context placed reliance upon *Rustom and Hornsby Ltd. Vs. Zamindara Engineering Co.*¹ at paragraphs 9 and 10; *Renaissance Hotel Holdings Inc. Vs. B. Vijaya Sai & Ors.*² at paragraphs 50 – 53; *Indchemie Health Specialities Pvt.*

1 (1969) 2 SCC 727.

2 (2022) 5 SCC 1.

*Ltd. Vs. Nexpar Labs Pvt. Ltd. and Anr.*³ at paragraph 8 and *Pidilite Industries Ltd. Vs. Jubilant Agri & consumer Products Ltd.*⁴ at paragraphs 11, 11.5 – 11.8 in this context.

33. Mr. Khandekar submits that even pre-fixing ‘MOCHI’ with ‘DESI’ plainly triggers an association and business connection with the Plaintiff’s said mark and is likely to be taken by an ordinary member of the public and also trade to mean that the goods are associated with the Plaintiff’s brand ‘MOCHI’ i.e. one of the largest and most reputed brands in the Indian footwear industry. Further, the word ‘DESIMOCHI’ suggests that it is the Indian brand of the Plaintiff’s mark ‘MOCHI’.

34. Mr. Khandekar submits that the said mark ‘MOCHI’ is wholly contained in the impugned mark as also in the domain name of the Defendant i.e. ‘DESIMOCHI’ / ‘DESIMOCHI.COM’. The rival marks which include the impugned domain name are visually, phonetically and structurally similar and seek to convey a common idea; and create a substantially/deceptively similar and/or identical overall impression. The prominent, essential, and differentiating

3 2001 SCC OnLine Bom 868.

4 2014 SCC OnLine Bom50.

feature in the impugned mark is 'MOCHI' which is the whole of the said mark 'MOCHI' which is registered. The Plaintiff and Defendant deal in identical/similar goods/services, catering to same/similar class of target consumers/traders, through overlapping channels and share a common field of activity.


35. Mr. Khandekar submits that the Plaintiff is the registered proprietor of a set of variants of 'MOCHI' marks. Therefore, any variant of the said mark will be associated with the Plaintiff. There is a clear likelihood of confusion and association on account of use of the impugned mark by the Defendant.

36. Mr. Khandekar has submitted that the use by the Defendant of the impugned domain name containing the impugned mark "DESIMOCHI" also amounts to infringement of the Plaintiff's registered trade marks. The Plaintiff is the registered proprietor of the mark "MOCHI". The Defendants contention that the Defendant is using the mark "DESIMOCHI" as an online aggregator which sells identical goods and provides identical services, is of no avail, and clearly a case for infringement of trade mark, and passing off is made out. He has submitted that the bonafide adoption is no defence and

dishonesty in adoption is to be presumed once the Defendant is deemed to have notice of the Plaintiff's mark by virtue of the same being on the register, and there is an obligation on the part of the Defendants to take a search of the public domain registries / sources. He has in this context placed reliance upon the decision of this Court in *Bal Pharma Ltd. Vs. Centaur Laboratories Pvt. Ltd.*⁵ .

37. Mr. Khandekar has also placed reliance upon the decision of this Court in *Merck KgaA and Anr. V/s. Natco Pharma Ltd. & Anr.*⁶ in support of his submission that the intention or bonafides are no defence, and the Plaintiff is not required to show bad faith/ malafides to succeed in an infringement action.

38. Mr. Khandekar has submitted that the Defendants contention is that the Plaintiff's registration is conditional has no merit. He has submitted that the Defendants have conveniently only mentioned two registrations i.e. Application Nos.1361711 and

1361712 that are for device marks  and are registered by the Plaintiff almost 20 years ago. He has submitted that

5 2001 SCC OnLine Bom 1176.

6 2012 SCC OnLine Bom 2331.

the Defendants have misinterpreted the conditions mentioned therein i.e. 'Registration of this trade mark shall give no right to the exclusive use of the letter 'M' and other descriptive matter'. He has submitted

that the letter 'M' is with respect to  and the descriptive matter is with respect to **THE SHOESHOPPE**.

39. Mr. Khandekar has submitted that subsequent registrations of the Plaintiff of the mark "MOCHI" is not derivative of the first application which is registered conditionally and therefore, would suffer the same condition as imposed initially. He has submitted that rival marks are required to be considered as a whole, including (and without ignoring) the disclaimed matters while deciding the question of actionable similarity / infringement. He has in support of his submission that every trade mark registration is separate and independent and a disclaimer in one registration cannot be read or imported into another placed reliance upon the decision of this Court in *Pidilite Industries Ltd. V/s. Dubond Products Indian (P) Ltd.*⁷ paragraph 96; *Pidilite Industries Ltd. Vs. Pom a-Ex Products*⁸ at

7 2024 SCC OnLine Bom 1390.

8 2017 SCC OnLine Bom 7237.

paragraphs 98-100; *Pidilite Industries Ltd. Vs. S.M. Associates*⁹ at paragraphs 70 and 71 and decision of the Delhi High Court in *Shree Nath Heritage Liquor Pvt. Ltd. Vs. Allied Blender and Distillers Pvt. Ltd.*¹⁰ at paragraph 17.

40. Mr. Khandekar has submitted that the contention of the Defendants that the third party has been refused registration for the mark “MOCHI” is of no consequence. He has submitted that the third party application and / or their status has no bearing on the present case. The Plaintiff has secured registration of the “MOCHI” word marks in Classes 18, 25 and 35 with a user claim since 1977, amongst other variants of the “MOCHI” marks.

41. Mr. Khandekar has submitted that the Plaintiff is the registered proprietor of “MOCHI” marks as detailed in the Plaint which are presumed to be distinctive once registered. He has in order to substantiate this argument relied upon the judgment of this Court in *Elektromag Devices & Ors. Vs. Nikhil Ravindra Bhawalkar & Ors.*¹¹ at paragraphs 44 and 45.

9 2003 SCC OnLine Bom 143.

10 2015 SCC OnLine Del 10164.

11 (MANU/MH/3019/2023)

42. Mr. Khandekar has submitted that a Defendant who applied for registration of a mark containing the entirety of the Plaintiff's mark, particularly the distinctive / leading / memorable / essential feature thereof is estopped from contending that the Plaintiff's mark is generic, descriptive or common to trade. He has in support of his submission placed reliance upon decision of this Court in *Rahul Uttam Suryavanshi V/s. Sunil Manikchand Kasliwal*¹² paragraphs 24, 27, 28 and 29.

43. Mr. Khandekar has submitted that the Defendant contention that there has been delay on the part of the Plaintiff in institution of the present Suit is a misconceived contention. He has submitted that mere delay is no defence to grant of ad-interim / interim injunction in a trade mark action. He has in support of his submission placed reliance upon *Anglo French Drugs and Industries Ltd. Vs. Eisen Pharmaceutical Company Pvt. Ltd.*¹³ Paragraph 15 and *Midas Hygiene Industries (P) Ltd. Vs. Sudhir Bhatia*¹⁴ at paragraph 5.

44. Mr. Khandekar has therefore submitted that the reliefs sought for in the Interim Application are required to be granted as a

1 2 2016 SCC OnLine Bom 8822.

1 3 1996 SCC OnLine Bom 580.

1 4 (2004) 3 SCC 90.

clear case has been made out for the grant of reliefs in terms of amended prayer Clauses (a), (b) and (d) of the Plaint.

45. Mr. Khandekar has submitted that the Plaintiff has preferred Leave Petition under Clause XIV of the Letters Patent Act, 1866 on the ground that the Plaintiff's registered office is in Mumbai and therefore, the cause of action in so far as infringement is deemed to have arisen within the territorial jurisdiction of this Court. He has submitted that leave has been sought in view of the products being sold from Jaipur, Rajasthan. However, they are sold also vide their website which is accessible across the world. He has submitted that the combination of cause of action of infringement and passing off is to avoid multiplicity of proceedings and accordingly leave be granted and also prayer for passing off be granted. He has accordingly sought for the Leave Petition to be made absolute in terms of prayer Clauses (a) and (b).

46. Ms. Jyoti Kamlakant Pandey for the Defendants submits that Defendant No.2 acquired the domain name 'DESIMOCHI' in 2017 and permitted Defendant No.1 to use the domain. While production had ceased due to COVID-19, Defendant No.2 relaunched

'DESIMOCHI' in as a shoe aggregator platform selling various brands, potentially raising fair use and distinctiveness arguments against the trade mark infringement claim by the Plaintiff in their 'MOCHI' marks.

47. Ms. Pandey submits that while the Plaintiff holds registration of the mark 'MOCHI' under trade mark application nos.1361711 and 1361712 in classes 18 and 25 respectively, which were filed on 06th June 2005 with user date of 27th June 1977, the Plaintiff has secured these registrations subject to a disclaimer with respect to the word/mark 'MOCHI'. She has submitted that in the absence of statutory exclusivity to the term 'MOCHI' which is a dictionary term and generic to business of manufacturing and trading of shoes and footwear, the Plaintiff has no case at all to seek any relief qua the Defendants.

48. Ms. Pandey submits that the Plaintiff accepted the registration of the trade mark 'MOCHI' vide application no. 1361711 under proviso to Section 9 of the said Act, without any exclusivity to the word 'MOCHI' It is further submitted that, the Plaintiff has not challenged the order of the Ld. Registrar of Trade marks, granting no

exclusivity to the term 'MOCHI', therefore, the order of Ld. Registrar of Trade marks has become absolute and accepted by the Plaintiff.

49. Ms. Pandey submits that the subsequent registrations of the mark 'MOCHI' with colour/prefix/suffix by the Plaintiff are derivatives of their first marks bearing Application nos. 1361711 & 1361712 in classes 18 and 25 respectively, which was registered conditionally and therefore the disclaimer is "imported" into other registrations as well.

50. Ms. Pandey further submits that the Registrar of Trade marks had refused registration for the mark 'MOCHI' which was filed by one Mr. Shamim Ahmed vide application no.667953 under the class 25 for Shoes, Chappal and Footwear of all kinds by sustaining objection under Section 9 of the said Act; and that order sheet dated 06th February 2024 shows that the application was correctly refused registration.

51. Ms. Pandey submits that the Plaintiff's mark 'MOCHI' is a commonly used generic term in India to refer to footwear makers or cobblers. The trade mark law protects distinctive marks that identify the source of products, not generic terms. She submits that by

allowing the Plaintiff to monopolize 'MOCHI' would unfairly restrict others from using this descriptive term in their business names.

52. Ms. Pandey submits that the strength of a trade mark refers to its distinctiveness. 'MOCHI' on its own is a relatively weak mark due to its generic nature; that adding a descriptive prefix like 'DESI' (meaning 'local' or 'of Indian origin' in this context) significantly weakens the similarity between the two marks; and that consumers are unlikely to be confused between 'DESIMOCHI', potentially indicating a local footwear brand, and the Plaintiff's specific use of 'MOCHI'.

53. Ms. Pandey submits that trade mark infringement hinges on the likelihood of confusion among consumers. She has submitted that in this case, the addition of 'DESI' creates a distinct overall impression compared to 'MOCHI' alone. Furthermore, considering the specific goods and services associated with each trade mark is crucial.

54. Ms. Pandey submits that the domain www.desimochi.com was registered on 12th September 2017, and the website was launched in December 2019; that the term 'DESI MOCHI' means local cobbler, which is in no way shows any

connection to the Plaintiff or their business interest; that it is pertinent to note that, the mark of the Defendant is with PREFIX to word 'MOCHI', which makes the trade mark distinctive; that the addition of word 'DESI' to the word 'MOCHI' shows no connection to the marks of the Plaintiff. She further submits that the Defendants website provides a platform for other sellers of footwear to sell their products.

55. Ms. Pandey submits that, the entire complaint of the Plaintiff before the WIPO was disposed of on merits and no relief was accorded to the Plaintiff. The WIPO has held that, www.desimochi.com does not in any manner infringe the 'MOCHI' marks and furthermore, the Plaintiff has failed to demonstrate that, 'MOCHI' has attained secondary meaning qua the Plaintiff. She submits that the ratio of the WIPO Decision, excerpted below, is "*equally applicable*" in the present suit as well.

C. REGISTERED AND USED IN BAD FAITH

"Both parties have acknowledged is the word "mochi" in the Hindi language means cobbler and there is no dispute that the word is considered common to the trade in which the parties offer their products, namely shoes, footwear and related services. Common descriptive word trade marks are

intrinsically weak, therefore the onus on the Complainant to demonstrate secondary meaning is high. A common descriptive word trade mark, which is not used in fanciful manner, but is used in a descriptive sense can be found to have acquired secondary meaning when the word is associated with the trade mark by the public. Such evidence of the mark have acquired secondary meaning for instance would be evidence of actual consumer confusion or of consumer surveys.”

The Complainant’s word mark registration for MOCHI, without additional evidence of the mark having acquired secondary meaning does not give it unencumbered rights, under the circumstances of the present case. The evidence, facts and the material in the present case file does not indicate that the Respondent’s aim in registering the disputed domain name was to profit from or to exploit the Complainant’s trade mark. There is no evidence of targeting, no evidence of consumer confusion, there is no evidence that the Respondent has engaged in a pattern of conduct or other activity which is indicative of intentionally trying to benefit from the Complainant’s mark.

As discussed in the previous section, the Respondent’s use of the disputed domain name does not appear to be used in a fraudulent manner or to infringe or in manner that would be considered abusive registration and use or under the Policy. The evidentiary burden for the Complainant is much higher in a case where the Respondent is clearly not a cyber squatter. Bad faith cannot be found when the Respondent has been found to have shown legitimate rights and interests in the disputed domain name.”

56. Ms. Pandey submits that the entire case of the Plaintiff even in the present Suit falls flat basis the above ratio of the WIPO Decision, and the Defendant claims that since the Plaintiff has not sought for setting aside the order of WIPO dated January 23, 2024 in

this Suit, the order of WIPO in the instant case has achieved finality.

57. Having considered the rival submissions, in my prima facie view, the Plaintiff has established that the Plaintiff has secured registration of the “MOCHI” word marks in Classes 18, 25 and 35 with a user claim since 1977. Further, in my prima facie view, the Plaintiff has been able to establish there has been open, continuous and extensive use of the said ‘MOCHI’ which has become well known among members of the public in India and globally as markers / identifiers exclusively associated with the Plaintiff’s business and brand.

58. The Defendants have contented that its website is a shoe aggregator platform selling various brands and that Defendant No.2 had acquired the domain name “DESIMOCHI” in 2017 and permitted Defendant No.1 to use the domain “DESIMOCHI”. I find that these contentions are irrelevant as it is settled law that dishonesty in adoption is to be presumed once the Defendant is deemed to have notice of the Plaintiff’s mark by virtue of the same being on the register, and is under an obligation to undertake a search of public domain registries / sources. The judgments of this Court in *Bal*

Pharma Ltd. (Supra) and *Merck KgaA & Anr. (Supra)* are apposite. The use by the Defendants of their impugned mark “DESIMOCHI” is clearly after the Plaintiff’s use of its registered mark “MOCHI” which is since inception from 1977.

59. Further, I find that the Defendant’s contention that the Plaintiffs registration is conditional is also misconceived as the subsequent registrations of the Plaintiff of the mark “MOCHI” are without any condition and not derivative of the first application and therefore would not suffer the same condition as imposed initially presuming that the condition is in any manner disclaimer the word “MOCHI”. I find that the two registrations which are conditional i.e. Application nos.1361711 and 1361712 are for device marks and the condition mentioned therein i.e. “*Registration of this trade mark shall give no right to the exclusive use of the letter ‘M’ and other descriptive matter*” is with respect to **THE SHOESHOPPE** and there is no disclaimer in so far as use of the word “MOCHI” is concerned.

60. It is well settled that rival marks are required to be considered as a whole, including (and without ignoring) the

disclaimed matters while deciding the question of actionable similarity / infringement. Every trade mark registration is separate and independent and a disclaimer in one registration cannot be read or imported into another. This has been held in *Pidilite Industries Ltd. V/s. Dubond Products Indian (P) Ltd. (Supra)*; *Pidilite Industries Ltd. Vs. Pom a-Ex Products (Supra)*; *Pidilite Industries Ltd. Vs. S.M. Associates (Supra/)* and decision of the Delhi High Court in *Shree Nath Heritage Liquor Pvt. Ltd. (Supra)*.

61. Further, I find much merit in the submissions on behalf of the Plaintiff that third party application and / or their status has no bearing on the present case. Merely, because third party application was refused registration for the mark “MOCHI” does not in any manner effect the registrations of the Plaintiff of their mark “MOCHI” word marks in Classes 18, 25 and 35 with user claim since 1977, amongst other variants of the “MOCHI” marks.

62. It is well settled that there is presumption of distinctiveness once the Plaintiffs’ mark “MOCHI” has been registered. This has been held by this Court in *Elektromag Devices & Ors. (Supra)*

63. Further, the Defendant has itself applied for registration of the mark “DESIMOCHI” which contains the entirety of the Plaintiffs mark “MOCHI” and would thus be estopped from contending that the Plaintiff’s mark is generic, descriptive or common to the trade. The decision relied on behalf of the Plaintiffs namely *Rahul Uttam Suryavanshi (Supra)* is apposite. In that case the Plaintiff registered mark “MOR CHHAP” was subsumed in the Defendants impugned mark “SUPER MOR CHHAP”. The Defendants having made application for registration of its impugned mark, would be estopped from contending that the Plaintiff’s mark is generic, descriptive and / or common to the trade.

64. I find much merit in the contention on behalf of the Defendant that the mere addition of ‘DESI’ creates a distinction between the rival marks is misconceived and without merit. The Plaintiff holds valid and enforceable rights to the trade mark ‘MOCHI’, including exclusive rights to prevent others from using the same or confusingly similar marks in relation to footwear. Further, even pre-fixing ‘MOCHI’ with ‘DESI’ triggers an association and business connection with the Plaintiff’s mark and is likely to be interpreted by an ordinary member of the public and those also in

trade to mean that the goods are associated with the Plaintiff's brand 'MOCHI' which is one of the largest and most reputed brands in the footwear industry. In my prima facie view, 'DESIMOCHI' would suggest that it is the Indian brand of the Plaintiff's mark 'MOCHI'.

65. It has been well settled that in comparing marks as a whole, mere addition of a generic prefix by the Defendant will not negate the actionable similarity between the rival marks where the Defendants' mark contains the whole of the Plaintiff's mark (particularly the distinctive/leading/memorable/essential feature thereof.). This has been held by the Supreme Court in ***Ruston & Hornsby Ltd. (Supra)*** at paragraphs 9 and 10. The Supreme Court held that "*if the respondent's trade mark is deceptively similar to that of the appellant the fact that the word "INDIA" is added to the respondent's trade mark is of no consequence and the appellant is entitled to succeed in its action for infringement of its trade mark.*" in ***Renaissance Hotel Holdings Inc. (Supra)***, the decision of the Supreme Court in ***Ruston and Hornsby (Supra)*** has been relied upon. Further, this Court in ***Indchemie Health Specialities Pvt. Ltd. (Supra)*** has also held that the Respondents mark *Cherish is deceptively similar to the appellants' mark "Cheri" and is likely to deceive or*

*cause confusion. Merely because the words are different it makes no difference since possibility of confusion remains. Further, this Court in **Jubilant Agri and Consumer Products Ltd. (Supra)**, has held in line with the aforementioned decisions and in that case ‘MARINE’ was held to be not descriptive of the Defendant's product by reason of open, continuous and extensive sales over 9 years has become distinctive of the Plaintiff and its products.*

66. The WIPO decision which has been relied upon by the Defendant has no bearing on the present Suit. In any event, I find that an inconsistent finding has been arrived at by WIPO from the well settled intellectual property law of India. WIPO has found that the Plaintiff has not been able to establish that there was bad faith on the part of the Defendants in adopting their domain name which contains the word “MOCHI”. The WIPO decision has failed to consider the settled law that if its found that a deceptively similar mark or domain name which is being used with respect to identical goods and services, a case for infringement of trade mark is made out because such usage will inevitably lead to confusion. The existence of bad faith per se is not required to secure an Order of infringement for a registered trade mark. It has been held by this Court in **Merck KgaA**

& Anr. (Supra), that intention or *bona fides* are no defence, and that the Plaintiff is not required to show bad faith / *mala fides* to succeed in an infringement action. Further, this has been also held in *Hoffmann-La Roche & Co. Ltd. v. Geoffrey Manner & Co. (P) Ltd.*¹⁵, *Wockhardt Ltd. v. Torrent Pharmaceuticals Ltd.*¹⁶ and *Laxmikant V. Patel v. Chetanbhai Shah*¹⁷, which have also been relied upon by the Plaintiff.

67. The contention of the Defendant that there has been delay on the part of the Plaintiff in institution of the present Suit is misconceived. Apart from there being no delay in institution of the Suit it has been held in *Midas Hygiene Industries Ltd. (Supra)* at paragraph 5 that “in cases of *infringement either of trade mark or of copyright, normally an injunction must follow. Mere delay in bringing action is not sufficient to defeat grant of injunction in such cases. The grant of injunction also becomes necessary if it prima facie appears that the adoption of the mark was itself dishonest.*”

68. Thus, the Plaintiff has made out a strong prima facie case for grant of injunction for infringement as well as passing off. The

15 (1969) 2 SCC 716

16 (2018) 18 SCC 346

17 (2002) 3 SCC 65

Leave Petition which seeks leave under Clause XIV of the Letters Patent Act is required to be allowed. Considering that by not granting leave, it would result in multiplicity of proceedings, particularly since this Court has jurisdiction in so far action for infringement is concerned as the Plaintiffs registered office is in Mumbai. Thus, the Leave Petition is allowed in terms of prayer Clauses (a) and (b).

69. The balance of convenience is also in favour of the Plaintiff as the Plaintiff has abled to establish that it is a user of the registered mark since 1977 and which is open, continuous and extensive use. Hence, non-grant of injunction against a rank infringer such as the Defendants will result in the Plaintiff being made to suffer irreparable loss and harm.

70. Further, apart from the prayer for infringement and passing off, in my view the Plaintiff has been able to establish that its registered mark "MOCHI" is required to be declared as a well known mark under Section 2(1) (zg) of the Act.

71. In view thereof, I declare that the registered mark of the Plaintiff "MOCHI" is a as well known trade mark under Section 2(1) (zg) of the Act.

72. Accordingly, the Interim Application is allowed in terms of amended prayer Clauses (a), (b) and (d) of the Interim Application. Mr. Khandekar has not pressed for prayer Clause (c) and accordingly the same is not granted.

73. Amended prayers Clauses (a), (b) and (d) are reproduced as under:-

(a) a temporary order and injunction, pending hearing and disposal of the Suit, restraining the Defendants, jointly/severally, by themselves or through anyone whomsoever (including but not limited to partners, employees, servants, franchisees, dealers, distributors, exporters, manufacturers, marketers and agents), from in any manner whatsoever infringing the Plaintiff's registered trade marks i.e. the 'MOCHI' marks (as identified at paragraph 05 of the Plaint) by the use of the impugned marks (as identified at Exhibits Q & R) and/or any other mark identical and/or deceptively similar to the said registered marks of the Plaintiff;

(b) a temporary order and injunction, pending hearing and disposal of the Suit, restraining the Defendants, jointly/severally, by themselves or through anyone whomsoever (including but not limited to partners, employees, servants, franchisees, dealers, distributors, exporters, manufacturers, marketers and agents), from in any manner whatsoever passing off the Defendants' goods/services and/or commercial activities and/or offerings and/or business as and for the of the Plaintiff in any manner whatsoever, by the use of the impugned marks (as identified at Exhibits Q & R) and/or any other mark identical and/or deceptively similar to the Plaintiff's 'MOCHI' marks (as defined at paragraph 10 of

the Plaintiff);

(d) a temporary order and injunction, pending hearing and disposal of the Suit, directing the Defendants by themselves, their partners, employees, servants, agents, associates, distributors, franchisees, sister concerns, representatives, affiliates and/or assigns and all persons acting for and on their behalf to transfer and completely hand over the domain name containing the impugned mark 'www.desimochi.com' and/or any other domain name incorporating the 'MOCHI' marks and its access/control/keys to the Plaintiff.

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

[R.I. CHAGLA J.]