



2025:DHC:37



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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

+ C.O. (COMM.IPD-TM) 225/2021

DIAMOND MODULAR PVT. LTD.Petitioner

Through: Mr. Ajay Amitabh Suman with
Mr. Shravan Kumar Bansal, Mr. Rishi
Bansal, Mr. Pankaj Kumar, Mr.
Siddhartha Swain, Mr. Deepak
Srivastava, Mr. Risabh Gupta and Mr.
Mankaran Ahluwalia, Advocates.
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versus

YASH ARORA AS TRADING AS SIDDHI VINAYAK TRADERS
AND ANR.Respondents

Through: Mr. Gaurav Prakash with Mr. Mohit
Rana, Mr. Monty Singh and Mr. S.
Chauhan, Advocates for respondent
no. 1.

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CORAM:
HON'BLE MS. JUSTICE MINI PUSHKARNA

J U D G M E N T
08.01.2025

MINI PUSHKARNA, J:

1. The present rectification petition has been filed seeking removal/cancellation of the trademark 'GREEN DIAMOND' (Device)



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registered under No. 4290006 in Class 09 registered in the name of Yash Arora trading as Siddhi Vinayak Traders/respondent no. 1 from the register or rectification of the register under Section 57/125 of the Trade Marks Act, 1999.

2. The case as canvassed by the petitioner, is as follows:

2.1. The petitioner, through its predecessors, is engaged in the business of manufacturing and marketing electrical goods, LED light, switches, and electrical accessories since the year 1975. Petitioner's predecessor adopted and started using the trademark and trade name DIAMOND in relation to their goods and business in the year 1975 itself.

2.2. Over the years, the petitioner's goods and business under the said trademark has seen a consistent growth and has become a household name that is synonymous with 'LED' in India.

2.3. The petitioner has emerged as a multi-edition, multi-product organization, and a clear leader in the segments it operates in, and had a turnover of Rs. 23,70,90,206/- Crores during the Financial Year 2020-2021 in respect of the retail stores under the said trademark.

2.4. The petitioner has acquired formidable goodwill and reputation in the industry under its said trademark by adhering to the highest standard of quality, extensive advertising, and marketing. An illustrative list of the trademark 'DIAMOND' duly registered under the Trade Marks Act, 1999, as given in the petition, is reproduced as under:



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Trademark	Application No.	Class	Status	User Claimed	Valid Upto
DIAMOND (Word Mark)	426403	9	Registered	01/04/1975	28/08/2025
DIAMOND (Word Mark)	709611	9	Registered	Proposed to be used	08/04/2023
DIAMOND (Word Mark)	831578	9	Registered	01/01/1975	10/12/2028
DIAMOND (Device)	337296	11	Registered	01/04/1975	08/06/2026
DIAMOND (Word Mark)	831577	11	Registered	01/01/1975	10/12/2028

2.5. The petitioner is also carrying on its business activities under the said trademark on the internet through its website namely <https://www.diamondindia.co.in/>. The petitioner has been using the said domain name in course of trade and as a proprietor thereof in relation to its said goods and business under the said trademark, and has built up a valuable trade, goodwill, and reputation there under.

2.6. The petitioner has built up a valuable trade under its said trademark and conducted handsome business thereunder running into crores of rupees worldwide. The year wise sales figures of the petitioner, under the said trademark, as given in the petition, are as follows:



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<u>S.No</u>	<u>Financial Year</u>	<u>Sales (Rs.)</u>
1.	2013-2014	20,973,125
2.	2014-2015	53,613,027
3.	2015-2016	94,879,118
4.	2016-2017	111,900,843
5.	2017-2018	296,029,421
6.	2018-2019	386,623,267
7.	2019-2020	393,001,616
8.	2020-2021	237,090,206
Total		1,594,110,626

2.7. The said trademark has become distinctive, associated, and acquired secondary significance with the petitioner and petitioner's said goods and business. The purchasing public, the trade and industry at large worldwide and in India identify and distinguish the petitioner's said goods and business under the said trademark with the petitioner's source and origin alone.

2.8. The respondent no. 1 claims to be engaged in the identical trade and business as that of the petitioner. The impugned trade mark 'GREEN



DIAMOND' (Device) applied for under Trade Mark



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No. 4290006 in Class 09 in relation to *Electrical Accessories including Wire and Cables, Electrical Conduit, Switch & Switches Accessories etc.*, is not registrable under the Act.

2.9. The impugned trade mark is neither distinctive nor capable of distinguishing the impugned goods applied for and nor does it satisfy the requirements of the Trade Marks Act, 1999 as to its registrability.

2.10. The respondent no. 1 by its impugned adoption, registration, and user of the impugned trademark “GREEN DIAMOND” (Device)



is violating the petitioner’s said trademarks/labels and thereby infringing or likely to infringe the petitioner’s said trademarks/labels and registered copyright, and pass off their goods and business as that of the petitioner.

2.11. The petitioner was not aware of impugned registration as the advertisement thereof in the Trade Marks Journal escaped the attention of the petitioner. The petitioner came to know about the impugned adoption of the respondent no. 1 in February 2021, when it came across the impugned registered trademark from the website of the Trade Marks Registry.

2.12. The use by respondent no. 1 of the impugned trade mark is likely to deceive or cause confusion in the market and trade and accordingly the registration of the impugned trademark is contrary to the provisions of Section 11 of the Trade Marks Act, 1999.



2.13. Thus, the present rectification petition has been filed for removal of



the respondent's trademark GREEN DIAMOND (Device) from the register or rectification of the register.

3. On behalf of the petitioner, it is contended that the impugned trademark is identical and/or deceptively similar with the petitioner's trademark in each and every respect, including, phonetically, visually, structurally, in its basic idea and in its essential features. The petitioner's trademark forms an essential and distinguishing feature of the respondent no. 1's impugned trademark. The Trade Mark Registry has failed to cite the petitioner's prior registrations for its trademarks in the Examination Report issued in the respondent no.1's impugned trademark application.

4. It is further submitted by the petitioner that the respondent no.1 has adopted and started using the impugned trademark dishonestly and fraudulently. The respondent no.1 is an ex-distributor of the petitioner and was well aware of the rights of the petitioner. The petitioner had filed a suit seeking permanent injunction to restrain the respondent no.1 herein from infringement and passing off the trademark of the petitioner herein in the Saket District Court. Vide judgment dated 09th July, 2024 passed in CS (COMM) 125/2021, the respondent no.1 herein has been permanently restrained from using the trademark "GREEN DIAMOND" in respect of any goods falling under the categories 9 and 11.

5. On behalf of respondent no.1, it is submitted that its trademark was duly registered after following the due process. The mark of the respondent



is not similar to the petitioner's mark. The marks are completely different. While the mark of the petitioner is a word mark, the mark of the respondent is a device mark. Further, 'Diamond' is a generic and common word and the petitioner cannot claim any monopoly over the word 'Diamond'.

6. I have heard learned counsel for the parties and have perused the records.

7. This Court notes that the petitioner herein had filed a suit for permanent injunction against the respondent no.1 herein in the District Court, Saket. The said suit has been decreed in favour of the petitioner herein and consequently, respondent no.1 herein has been restrained from using the trademark 'GREEN DIAMOND' in respect of any goods falling under categories 9 and 11. Relevant excerpts from the judgment dated 09th July, 2024 passed in *CS (COMM) 125/2021, Diamond Modular Pvt. Ltd. Versus Yash Arora trading as Siddhi Vinayak Traders and Another*, are reproduced as under:

"xxx xxx xxx

*32. In so far as argument of Ld. Counsel for defendant regarding continuous and uninterrupted proof of advertisement, sales and promotion activity, though the plaintiff has given evidence of continuity of use since 2013; qua the use since 1978, Ld. Counsel for plaintiff has relied upon judgment in **Century Traders Vs. Roshan Lal Duggar & Co AIR 1978 Delhi 250**, wherein the Hon'ble Court held that actual use of the trademark under such circumstances as showing an intention to adopt and use it as a trademark is the test rather than extent or duration of the use to prove proprietorship of the trademark. Be it whatever, there is no dispute that the trademarks were registered in the name of predecessors of plaintiff since as early as 1978, 1984, 1996 and 1998, and it has proved the sales figure for more than 10 years as of now since 2013-2014. Further there is admission of DW-1 that his father's firm M/s. Satish Electrical Store was having business dealings with plaintiff for 10-15 years and the products of defendant used to have trade-mark Diamond on the device of product, the defendant cannot*



dispute continuous and uninterrupted use of trademark “Diamond” by the plaintiff, which was prior in time.

33. **It is admitted fact claimed by plaintiff and admitted by the defendant that the defendant was plaintiff’s distributor and that in 2018, the defendant severed its relations with plaintiff whereafter it started manufacturing its own goods in similar categories under the trademark ‘Green Diamond’ with a picture of trees.** Regarding the picture of tress, DW-1 stated in cross-examination that he had copied it from Internet. The claim of plaintiff that the trademark Green Diamond with picture of trees is thus falsified.

34. **DW-1 in his cross-examination stated that his father used to run business in the name of M/s. Satish Electrical Store before 2018 and that under the said name and style they were distributors of different brands. He admitted that he was the distributor of the plaintiff company. Initially he stated that he used to deal with wires and cables but volunteered that he was not dealing with wires and cables with plaintiff company and that he used to deal with plaintiff company in switches and its accessories. The fact, however, remains that the articles mentioned fall in the category of electrical goods.**

35. The witness admitted that plaintiff company was having trademark “Diamond” on its devices of products. He stated that he did not know anything about the trademark registration for the word “DIAMOND” of the plaintiff company. He stated that he had applied for trademark registration of green diamond in 2018 under class 9 & 11. Witness stated that dispute between his father’s firm M/s. Satish Electrical Store and plaintiff company had started before he got proprietorship of business in 2018 under the name and style of M/s. Siddhi Vinayak Traders. There is no document brought on record to show as to when the dispute had actually arisen.

36. **The defendant stated in his cross examination that he was using the trademark Green Diamond even while he was dealing with plaintiff. The statement, however, is falsified from the two statements of PW1 and DW1 having come on record. PW1 stated in his cross examination that he was dealing with defendants till 16.01.2020. DW1 stated in his cross examination that he started using trademark Green Diamond in 2020. The invoices filed by DW1 are also of 2020. Therefore, the claim of defendant that he was using the impugned trademark while dealing with plaintiff is contrary to record.**

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41. In so far as Judgment of Hon'ble Supreme Court in Skyline (supra) N. Rangarao (Supra) & other cited judgments are concerned, the defendant could have gotten benefit of the judgment had the case of defendant been that he was one of the random users of trade-mark GREEN DIAMOND having chosen DIAMOND like several others. The facts of the present case, however, are distinguishable since the defendant is definitely not a random bonafide adopter of trade-mark 'GREEN DIAMOND'. He was distributor of plaintiff for a good 10-15 years before he decided to adopt the impugned trade-mark.

DW-1 has admitted in his cross-examination this fact and also the fact that he used to deal with plaintiff in switches and accessories. It can also be seen from the record that defendant applied for registration of trademark 'GREEN DIAMOND' after dispute arose between him and plaintiff as it is admitted in cross-examination by DW-1 that he had applied for registration in 2018 and also that the dispute between his father's firm M/s. Satish Electrical Store arose before he got proprietorship of business in 2018. It is not the case of defendant that he was dealing with more than one dealer who had 'DIAMOND' as a trade-mark or any similar trade-mark for the goods under categories 9 & 11.

Since the defendant admittedly was dealing with the products of plaintiff for a considerable time of 10-15 years, the chances of confusion amongst the public that the goods being sold by it under the trade name 'GREEN DIAMOND' also belonged to plaintiff, were much higher than it would have been in case if a stranger- having no dealing whatsoever with plaintiff- had adopted the trademark like that of the defendant.

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49. There is not much evidence on the aspect of infringement of copyright in the artistic work of plaintiff, the plaintiff, however, in view of above discussion, facts, evidence and cited judgments has been able to prove the issue of passing off of goods by the defendant under the trademark 'GREEN DIAMOND'. Since the plaintiff and defendant are in the trade of identical products and the defendant was a dealer of plaintiff's goods, and as such was fully aware of plaintiff's prior use of the trademark and sale of the products under the trade name 'DIAMOND', therefore, adoption of similar trademark by the defendant after making some addition and some alternation in the get-up etc., makes the impugned trademark 'GREEN DIAMOND' a fraudulent and dishonest adoption. It can be inferred from the facts that Defendant wants to encash on the reputation and goodwill of the Plaintiff, for



illegal gains. **General public, traders and consumers who were dealing with defendant for the products of plaintiff because of reputation of the Plaintiff and the quality of the goods sold under the trademark 'DIAMOND' might have continued and may continue to buy the products of the Defendant under the assumption that they emanate from the Plaintiff with a slightly changed trade name and get up. The plaintiff thus has been able to establish that the defendant with dishonest intention started using trademark 'GREEN DIAMOND' which is deceptively similar to the trade-mark 'DIAMOND' belonging to the plaintiff.**

50. The plaintiff thus is entitled for an injunction against the defendant in respect of trade-mark 'GREEN DIAMOND' using which the defendant has attempted to pass off its goods as that of plaintiff. A decree of injunction therefore, is passed in favour of plaintiff and against defendant restraining the defendant from passing off its goods under the trade name/trade-mark 'GREEN DIAMOND'.

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59. **Issue No.7:- Relief.** The plaintiff has been able to prove its case against the defendant. The defendant is hereby restrained from using trade-mark 'GREEN DIAMOND' in respect of any goods falling under the categories 9 & 11. The defendant is also directed to file its statement of account showing the profit earned by it from the date of adoption of trade-mark 'GREEN DIAMOND' till the date of grant of injunction by the court, generated by it using the trade-mark 'GREEN DIAMOND'. The cost is also awarded in favour of plaintiff as detailed while deciding issue no.6. Decree sheet be drawn up accordingly. File be consigned to record room.

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(Emphasis Supplied)

8. Perusal of the aforesaid judgment brings forth the fact that the firm of the father of respondent no.1 was having business dealings with the petitioner for 10-15 years for goods with the trademark 'DIAMOND'. Further, it is established that the respondent no.1 was the distributor of the petitioner and respondent no.1 has dealt with the goods of the petitioner having trademark 'DIAMOND'.



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9. It is also established that the respondent no.1 started using the trademark 'GREEN DIAMOND' only in the year 2020, with invoices filed with regard thereto of the year 2020. On the other hand, the documents on record show the registration of the word mark 'DIAMOND' in favour of the petitioner, with user from 01st January, 1975. Compared to this, the registration in favour of the respondent no.1 for the trademark 'GREEN DIAMOND' with device shows the date of application for registration as 11th September, 2019 on 'proposed to be used' basis. Therefore, the prior and continuous user of the petitioner is clearly established. Besides, the petitioner has also established high sales for its products under its mark 'DIAMOND'.

10. Considering the fact that the respondent no.1 was a distributor of the petitioner and even his father's firm had business dealing with the petitioner, the adoption of the mark 'GREEN DIAMOND' with device by the respondent no.1 cannot be considered to be *bonafide*. The present is not a case of honest and concurrent user. Rather, the facts on record clearly bring forth the dishonest intention and *malafide* of the respondent no.1 in adopting the impugned mark.

11. The fact that the respondent no.1 as well as his father's firm dealt with the petitioner's goods under the mark 'DIAMOND' in the course of their business dealings, manufacturing and marketing of goods by respondent no.1 under the impugned mark, will clearly give an impression to the general public that the goods of the respondent no.1 have association with the goods of the petitioner. The manner in which the respondent no.1 has obtained registration of a similar mark for similar class of goods, *ex facie* discloses bad faith on the part of respondent no.1 to capitalize upon the



goodwill of the petitioner.

12. The contention of the respondent no.1 that the word ‘DIAMOND’ is generic and common has essentially to be rejected. Common words or names which may be used for long periods are entitled to registration under the law and are also entitled to protection. When a word has been in use for a long time, the name acquires distinctiveness and secondary meaning in the business or trade circle. Thus, this Court in the case of *Amit Sood Versus Union of India and Others*, 2024 SCC OnLine Del 3226, has held as follows:

“xxx xxx xxx

27. In *Mahendra & Mahendra Paper Mills Ltd. v. Mahindra & Mahindra Ltd.*, (2002) 2 SCC 147 the Court also observed that when a word has been in use for a long time, the name acquires distinctiveness and secondary meaning in the business or trade circle. The relevant portion of the said judgment has been extracted below:

“24. Judging the case in hand on the touchstone of the principles laid down in the aforementioned decided cases, it is clear that the plaintiff has been using the words “Mahindra” and “Mahindra & Mahindra” in its companies/business concerns for a long span of time extending over five decades. The name has acquired a distinctiveness and a secondary meaning in the business or trade circles. People have come to associate the name “Mahindra” with a certain standard of goods and services. Any attempt by another person to use the name in business and trade circles is likely to and in probability will create an impression of a connection with the plaintiffs’ Group of Companies. Such user may also affect the plaintiff prejudicially in its business and trading activities. Undoubtedly, the question whether the plaintiffs’ claim of “passing-off action” against the defendant will be accepted or not has to be decided by the Court after evidence is led in the suit. Even so for the limited purpose of considering the prayer for interlocutory injunction which is intended for maintenance of status quo, the trial court rightly held that the plaintiff has established a prima facie case and irreparable



prejudice in its favour which calls for passing an order of interim injunction restraining the defendant Company which is yet to commence its business from utilising the name of “Mahendra” or “Mahendra & Mahendra” for the purpose of its trade and business. Therefore, the Division Bench of the High Court cannot be faulted for confirming the order of injunction passed by the learned Single Judge.”

28. Common words or names which may be used for long periods are entitled to registration under the law and are also entitled to protection. In Dr. Reddy's Laboratories Ltd. v. Reddy Pharmaceuticals Limited, 2004 SCC OnLine Del 668 the Court was dealing with a common surname such as Reddy but still held that it was exclusively associated with the Plaintiff and hence protectable. The relevant portion of Dr Reddy's Laboratories (supra) is set out below:

“13. Thus, it prima facie stands established on record that the defendant is endeavouring to pass off its products under the trade mark “Reddy” with a view to confuse and mislead the customers by making them believe that the products are manufactured by the plaintiff company. Even now, the defendant appears to be having no manufacturing unit for manufacturing pharmaceutical preparations and it is only putting the name “Reddy” on the pharmaceutical preparations manufactured by others. The absence of the registration of the trade mark in favour of the plaintiff and the pendency of the application in this regard is of no consequence for the reason that the defendant's impugned action is squarely covered within the definition of “passing off”. The Apex Court in the case of Mahendra & Mahendra Paper Mills Ltd. v. Mahindra & Mahindra Ltd., (2002) 24 PTC 121 (SO, had examined a similar controversy. The name “Mahindra & Mahindra Ltd.” was held to have acquired a distinctiveness and secondary meaning in the trade circle and people had come to associate this name with a certain standard of goods and services. The effort of the defendant/Mahendra & Mahendra Paper Mills Ltd., to use the said name was held to be capable of creating an impression of a connection with the plaintiffs group of Companies and it was held that such user may affect the plaintiff prejudicially in the business and trading activities. The plaintiffs plea for ad interim injunction was found justified.

14. The plea raised by the defendant that it has a bona fide



*statutory right to use the trade name “Reddy” as its Managing Director is Mr. Reddy is also liable to be rejected for the reason that the trade mark “Dr. Reddy” in spite of not bring registered has acquired considerable trade reputation and goodwill in the community dealing with drugs and pharmaceutical not only in India but abroad also. This trade mark is now distinctively associated with the plaintiffs company. Its long and continuous user by the plaintiff is prima facie established. The use of trade name/mark “Reddy” by the defendant is capable of causing confusion and deception resulting in injury to the goodwill and reputation of the plaintiff company. No other “Reddy” has a right to start a rival business by using the same trade name on the plea that it is his surname. This would encourage deception. If such a plea is allowed, rivals in trade would be encouraged to associate in their business ventures persons having similar surnames with a view to encash upon the trade reputation and goodwill acquired by others over a period of time. In *Bajaj Electrical Limited, Bombay v. Metals & Allied Products, Bombay, AIR 1988 Bom 167*, the user of a family name by the defendants was held to be an act of passing off the goods and it was observed that the use of such family name as a trade mark was not permissible. The plea of the defendants that the surname of the partners of its firm could be used to carry on trade in their own name was rejected. It was held that prima facie the defendants were intentionally and dishonestly trying to pass off their goods by use of name “Bajaj” and as such the plaintiff had made out a case for grant of injunction.”*

29. After having perused that the name adopted by the Respondents is identical to that of the Petitioner's and considering the fact that this is a case where services are similar and are in the same geographical area i.e., Panchkula, the trade channel and the target audience will automatically be similar. This makes it a case of ‘TRIPLE IDENTITY’.

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31. Recently in *Heifer Project International Ltd. v. Heifer Project India Trust, 2024 : DHC : 3178*, the Court observed that identical and deceptively similar marks are likely to create confusion and deception amongst the general public when the mark, area of operation and segment of target is same. The operative portion of the said judgment is extracted hereinbelow:



“30. Indeed, the present case is a classic instance of ‘triple identity.’ The Impugned trademarks are nearly identical, as are the areas of operation, and the segments of the public they target. Therefore, the Defendants’ use of these nearly identical and deceptively similar marks is certain to cause deception and confusion among the general public. Besides, the Defendants have persistently engaged in activities that unlawfully exploit Plaintiff’s reputation and goodwill. Even after the termination of their contractual relationship and the explicit withdrawal of rights to use the Plaintiff’s trademarks and logos, Defendants have unauthorisedly continued use of their deceptively similar marks. This defiance not only violates the agreement but also misleads the public and the relevant stakeholders regarding the nature of Defendants’ affiliation with Plaintiff. Defendants have further compounded their infringement by falsely representing their relationship with Plaintiff. They have insinuated to the public and stakeholders that they remain affiliated or integrally connected with Plaintiff, thereby undermining Plaintiff’s brand/trademark integrity and causing confusion about its unique identity in the marketplace. Defendants lack any legal right or justification to the use of contested marks, or applying for their registration of identical marks for conducting any business activities.”

xxx xxx xxx”

(Emphasis Supplied)

13. The mark adopted by respondent no. 1 is substantially similar to the mark of the petitioner. The word ‘DIAMOND’ is a pre-dominant part of both the competing marks, and an average consumer with imperfect recollection would recall only the pre-dominant part. The respondent no.1 has copied the essential and pre-dominant part of the trademark of the petitioner. The overall similarity between the two marks in respect of same description of goods is likely to cause confusion in the mind of an unwary purchaser of average intelligence and imperfect recollection that the goods sold by respondent no.1 have in fact emanated from the petitioner.



14. Holding that when trademarks are encountered in their natural commercial environment, consumers often rely on quick recognition rather than a detailed analysis of each mark's components, this Court in the case of *Gm Modular Pvt. Ltd. Versus Mayur Electromeck Pvt. Ltd. and Another*, 2024 SCC OnLine Del 2045, has held as under:

“xxx xxx xxx

6. Similar to the Petitioner's commercial activities, Respondent No. 1 has adopted the Impugned Mark in relation to manufacture and trade of wires and cables. Notably, Petitioner holds prior registrations of the



marks “GM INDIA” and “GM” for inter alia wires and cables, dating 25th November, 1999 and 26th June, 2000, respectively. While Respondent No. 1 argues that the competing device marks are dissimilar when assessed comprehensively, the Court nonetheless finds there to be substantial resemblance between the rival marks. Respondent No. 1's reliance on the unique visual and textual components of the Impugned Mark overlooks the fact that “GM”, being the dominant portion of the competing marks, would be recalled by an average consumer with imperfect recollection. The argument posited by them, emphasizing the visual and structural distinctions of the Impugned Mark, fails to fully mitigate the risk that consumers may overlook these differences in the marketplace. **When trademarks are encountered in their natural commercial environment, consumers often rely on quick recognition rather than a detailed analysis of each mark's components. This similarity between the marks is further accentuated by the intersection between the nature of goods and services offered by both parties. Therefore, the resemblance between the rival marks extends beyond mere appearance, to the core attributes that define their identity and recognition in the marketplace. Such close overlap enhances the potential for confusion among consumers, who may struggle to distinguish between the origins of the goods and services offered under these closely associated trademarks.** Therefore, even subtle similarities between the “GM” and “GMW” marks, especially given their use in the same class of goods, cannot dispel the possibility of confusion.

xxx xxx xxx”

(Emphasis Supplied)

15. Courts have time and again underscored that dishonest adoption of



somebody else's trademark and trying to ride on the goodwill created by the competitor who entered the market prior in time, ought to be discouraged. In the present case, it is evident that the petitioner's mark has been completely subsumed in the impugned mark, and in relation to similar, allied and cognate goods. The respondent no. 1, being an ex-distributor of the petitioner, was well aware of the mark of the petitioner. Thus, in the case of *ACL Education Centre Pvt. Ltd. and Another versus Americans' Centre for Languages and Another*, 2007 SCC OnLine Del 2010, it has been held as follows:

“xxx xxx xxx

10. I had the occasion to discuss the issue of dishonest adoption in my recent judgment in the case of *Ishi Khosla v. Anil Aggarwal*, (2007) 3 AD (Delhi) 421. While confirming the injunction, I observed:—

23....It is not to suggest that the plaintiff has monopoly over these products. Any other person may enter the trade and be a competitor. Competition is healthy for not only consumers but for manufacturer as well and is, therefore, in public interest. **However, what is to be discouraged is the dishonest adoption of somebody else's trademark and trying to ride on the goodwill created by the competitor who entered the market prior in time.** This is what is sought to be done by the defendants by clever manipulation, namely, adding the word 'DIET' in their mark after adopting identically the entire trademark of the plaintiff i.e. 'Whole Foods'. This intention of the defendants becomes manifest as they have also adopted same style of the trademark and same labels/packing etc.....

11. In the case of *Munday v. Carey*, 1905 RPC 273 the Court held:

“**....I believe that it is a rank case of dishonestly, and where you see dishonesty, then even though the similarity were less than it is here, you ought, I think, to pay great attention to the items of similarity, and less to the items of dissimilarity**”.

12. Further, in the case of *Midland Counties Dairy Ltd. v. Midland Dairies Ltd.*, 1948 RPC 429 it was held that:



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“...For if the Court comes to the conclusion that the defendant was actuated in adopting the style complained of by the dishonest motive of filching some part of the plaintiffs' reputation, then the Court will not be astute to find that this nefarious design has failed.”

xxx xxx xxx”

(Emphasis Supplied)

16. Considering the detailed discussion hereinabove, continuance of the impugned mark on the Register of Trademarks, cannot be upheld. The impugned mark is liable to be removed from the Register of Trademarks.

17. Accordingly, the present petition is allowed with the following directions:

17.1 Registration of the trademark ‘GREEN DIAMOND’ (Device)



registered under No. 4290006 in Class 9, is cancelled.

17.2 Registrar of Trade Marks is directed to issue an appropriate notification to this effect.

18. Registry of this Court is directed to supply a copy of this order to the Trade Marks Registry at llc-ipo@gov.in, for compliance.

19. The present petition is disposed of, with the aforesaid directions.

**(MINI PUSHKARNA)
JUDGE**

JANUARY 08, 2025

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