



2023:DHC:7403



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\* **IN THE HIGH COURT OF DELHI AT NEW DELHI**+ **CS(COMM) 259/2021****SOPARIWALA EXPORTS & ORS. .... Plaintiffs****Through: Ms. Jaya Negi and Mr.  
Yudhajeet Sinha, Advs.**

versus

**ASHRAF V**

..... Defendant

**Through: None****CORAM:****HON'BLE MR. JUSTICE C. HARI SHANKAR****JUDGMENT (ORAL)**

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**09.10.2023****CS(COMM) 259/2021**

1. Plaintiff 1, Sopariwala Exports claims to trace its routes to a small shop set up in Bombay, which sold tobacco, in 1927. It is stated that Plaintiff 1 has been using the trademark AFZAL for tobacco products since 1977. On 16 August 2010, the right to use the trademark AFZAL as well as other trademarks of Plaintiff 1 was assigned to Plaintiff 2 for a period of ten years with effect from 15 September 2006. On 30 March 2015, the said license was extended by a further trademark license agreement, for an indefinite term.


2. Plaintiff 1 has also granted non-exclusive licenses to Plaintiffs 3 and 4 for use of the trademark AFZAL and other associated trademarks on 6 November 2020 and 20 March 2013, respectively.



3. The plaintiffs are primarily engaged in export of tobacco under the trademark AFZAL. However, the plaintiff asserts that tobacco under the trademark AFZAL is also sold in India by Plaintiff 4 Soex India Pvt. Ltd.

4. Plaintiffs also claim to have been recognised by the Government of India as a STAR EXPORT HOUSE. The plaintiff also sets out various encomiums and awards that the plaintiffs have earned over a period of time. It is asserted that, by dint of their experience, reach and reputation, the plaintiffs' trademarks have become source identifiers of the plaintiffs. The plaintiffs also operate a website [www.sopariwala.com](http://www.sopariwala.com).


5. Plaintiff 1 is the registered proprietor of the following trademarks:

S. No.	Trade Mark	Application No.	Class & Goods	Date of Application
1.	AFZAL DE. OF HUKKA' 	445798	34 Tobacco	20/11/1985
2.	AFZAL (Word Mark)	463742	34 Bidis, cigarettes, Zarda, Zafrani Patti, Match Boxes, Quiwam, Tobacco Products and Smokers Articles all being Goods.	27/11/1986



3.		2310475	34 Tobacco Molasses; Tobacco Substitutes, namely, Flavoured Molasses; Tobacco Substitutes, namely, Herbal Molasses; Molasses for use in Smoking through Hookah; Tobacco, Raw or Manufactured; Chewing Tobacco; Qiwam, Bidies, Cigarettes, Cigars; Gudakhu, Gutkha, Zarda, Khaini; Smokers' Articles, Match Boxes; Snuff, Zafrani Patti.	04/04/2003
4.	AFZAL (Label) 	1230032	34 Tobacco, Tobacco Products/ Tobacco Preparations, Bidies, Cigarettes, Gutkha, Gudakhu, Zarda, Hukka, Zafrani Patti, Smokers Articles, Match Boxes.	02/09/2003
5.	AFZAL (Label) 	1530553	34 Tobacco, Tobacco Products/ Tobacco Preparations, Bidies, Cigarettes, Gutkha, Gudakhu, Zarda, Hukka, Zafrani Patti, Smokers Articles, Match Boxes.	02/09/2003
6.		2310495	34 Tobacco Molasses; Tobacco Substitutes, namely, Flavoured Molasses; Tobacco Substitutes, namely,	04/04/2012



			Herbal Molasses; Molasses for use in Smoking through Hookah; Tobacco, Raw or Manufactured; Chewing Tobacco; Qiwam, Bidies, Cigarettes, Cigars; Gudakhu, Gutkha, Zarda, Khaini; Smokers' Articles, Match Boxes; Snuff, Zafrani Patti.	
7.	AFZAL (Device) 	2677784	34 Tobacco, Raw or Manufactured Form or Tobacco, Chewing Tobacco, Tobacco Leaves; Tobacco Products, Tobacco Preparations, Bidies, Cigarettes, Pandharpuri Tobacco; Hukka Tobacco; Qiwam, Gudakhu, Gutkha, Zarda, Khaini; Snuff, Zafrani, patti, Smokers Articles, Matches.	13/02/2014
8.	AFZAL (Word Mark)	3400637	34 Tobacco and Tobacco Products; Gutkha	28/10/2016
9.	AFZAL (Word Mark)	3954055	34 Tobacco, raw or manufactured form of tobacco; chewing tobacco, tobacco leaves; tobacco products; tobacco preparations; bidies cigarettes; molasses; hukka tobacco; qiwam	24/09/2018



			gudakhu; gutkha, zarda, khaini; snuff, zafranin, patti, smokers articles, matches.	
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6. To vouchsafe its reach and reputation, the plaintiffs have placed on record the earnings from sale of products bearing the AFZAL formative trademarks. In the years 2018-19 and 2019-20, the earnings have been to the tune of ₹ 200 crores and ₹ 164.34 crores, respectively.

7. Plaintiff 1 is also the holder of a copyright registration dated 28 August 2018 for the following label:



8. The defendant is also manufacturing and selling tobacco and

tobacco related products from Kerala under the mark



Though the defendant has applied for registration of the said mark, it has not succeeded in obtaining registration till now.



9. The plaintiffs submit that the trade dress of the defendant is imitative of the trade dress of the plaintiffs in which Plaintiff 1 holds copyright registration. This is demonstrated, in para 47 of the plaint, thus:

Plaintiff's mark	Defendant's mark
	

10. In these circumstances, the plaint alleges that the defendant has infringed the plaintiffs' registered trademarks as well as its copyright registration and is also, by using a deceptively similar trademark and a deceptively trade dress, seeking to pass off its product as the product of the plaintiffs. Inasmuch as the product is chewing tobacco, it is submitted that additional vigilance is required to be exercised in order to ensure that such attempts at infringement do not go unchecked.

11. Despite issuance of summons on repeated occasions, the defendant has not either chosen to enter appearance or to file any written statement. The right of the defendant to file written statement




was struck off on 5 September 2022 and he was proceeded *ex parte* on 4 November 2022.

12. The fact that the defendant has not chosen to traverse the present petition indicates that he has really nothing to afford by way of response. The allegations in the plaint have to be treated as admitted on the principle of non-traverse.

13. Even otherwise, at a bare glance, it is clear that the defendant is indeed guilty both of infringement as well as passing off. The



defendant is using the mark . Seen as independent wordmark AFSALs and AFZAL are phonetically nearly identical. The following test, enunciated by Lord Justice Parker in *In re. Pianotist Co. Ltd*<sup>1</sup> is now treated, even in this country, as the authoritative determining test to assess phonetic similarity between marks:


“You must take the two words. You must judge of them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade mark is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion—that is to say, not necessarily that one man will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public which will lead to confusion in the goods—then you may refuse the registration, or rather you must refuse the registration in that case.”


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<sup>1</sup> (1906) 23 RPC 774





The rival marks in the present case are used for chewing tobacco. Chewing tobacco, is a product, panders less to the cognoscenti and more to the laity. Consumers of chewing tobacco cannot be treated as so discerning as to note the difference between the  mark of

the plaintiffs and the  mark of the defendant, as to be able to distinguish one from the other. It has to be remembered that the aspect of confusing or deceptive similarity has to be viewed from the perception of the consumer of average intelligence and imperfect recollection. The very stipulation of the recollection of such a consumer being imperfect factors into itself the absence of any over-familiarity, by such a consumer, between the two marks. The consumer must be one who chances across the plaintiffs' mark at one point of time and the defendant's mark later, and not one who has an opportunity to see the marks side by side. If such a consumer, on seeing the defendant's mark, wonders as to whether he has seen the mark, or an associated mark, earlier the requirement of likelihood of confusion, for the purposes of infringement under Section 29(2)(b)<sup>2</sup> of the Trade Marks Act, 1999 stands satisfied.<sup>3</sup>

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<sup>2</sup> (2) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which because of –

- (a) its identity with the registered trade mark and the similarity of the goods or services covered by such registered trade mark; or
- (b) its similarity to the registered trade mark and the identity or similarity of the goods or services covered by such registered trade mark; or
- (c) its identity with the registered trade mark and the identity of the goods or services covered by such registered trade mark,

is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trade mark.

<sup>3</sup> Refer **Shree Nath Heritage Liquor Pvt. Ltd. v. Allied Blender & Distillers Pvt. Ltd.**; (2015) 221 DLT 359





**14.** Equally settled is the principle enunciated by Lindley, LJ in *Slazenger & Sons v. Feltham & Co.*<sup>4</sup>:

One must exercise one's common sense, and, if you are driven to the conclusion that what is intended to be done is to deceive if possible, I do not think it is stretching the imagination very much to credit the man with occasional success or possible success. Why should we be astute to say that he cannot succeed in doing that which he is straining every nerve to do?"

When one chooses to deceive, therefore, he weaves, to borrow from Scott, a tangled web, from which escape is, at the very least, difficult.

**15.** The visual similarity between the rival marks in the present case, coupled with the phonetic similarity between “Afzal” and “Afsals”, especially when viewed from the perspective of a consumer of chewing tobacco, clearly discloses the intent of the defendant to adopt the mark which is, phonetically as well as visually, as alike to the plaintiffs’ mark as possible. In such a case, the Court would legitimately presume the likelihood of confusion. A transparent attempt of the defendant to pass off his product as that of the plaintiffs’ would also, in such cases, stand exposed.

**16.** Tobacco is, as it is, deleterious to health. Spurious chewing tobacco cannot be allowed to freely circulate in the market. In my opinion, an imitator, being one who chooses to ride, not on his own, but on another’s, reputation, may also legitimately be presumed not to be particularly circumspect with respect to quality of his product.

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<sup>4</sup> (1889) 6 RPC 531




Consumption of imitation or spurious chewing tobacco can result in serious and often irreparable adverse consequences on the health of the consumer. In such cases, additional vigilance, on the part of the Court, would be justified.

**17.** As the defendant has not chosen to enter appearance or file a written statement, and in view of the aforesaid observations, I am of the opinion that the suit can be decreed under Order VIII Rule 10 of the Code of Civil Procedure, 1908 (CPC).


**18.** Accordingly, the suit stands decreed in the following terms:

(i) There shall be a decree of permanent injunction restraining defendant as well as all others acting on its behalf from using the trademark “AFSALs”, either as a word mark or

in the form of device mark , or any other mark which is deceptively similar to any of the plaintiffs’ registered trademarks.

(ii) The defendant shall also stand restrained from using the

impugned trade dress , which is deceptively similar

to the trade dress  of the plaintiffs’ product. The defendant shall also be restrained from adopting any trade dress which is deceptively similar and which would, therefore,



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infringe the copyright held by the plaintiffs in the aforesaid trade dress.

**19.** Ms. Jaya Negi, learned Counsel for the plaintiffs does not press any of the other prayers in the suit.

**20.** Let a decree sheet be drawn up accordingly.

**C.HARI SHANKAR, J**

**OCTOBER 9, 2023**

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