



2025:DHC:6317-DB



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

+ **FAO(OS) (COMM) 73/2024 & CM APPL. 22687/2024**

**BODHISATTVA CHARITABLE TRUST
AND ORS.**

.....Appellants

Through: Mr. Jayant K Sud, Sr. Adv. Mr. Vishal Dabas, Ms. Shayal Anand, Mr. Sai Manik Sud, Mr. Sahib Kochhar, Mr. Aishwarya Sharma, Advs.

versus

**MAYO FOUNDATION FOR MEDICAL
EDUCATION AND RESEARCH**

.....Respondent

Through: Mr. Raunaq Kamath, Mr. Yash Raj, Ms. Yashi Bajpai and Ms. Aishwarya Kane, Advs.

CORAM:

HON'BLE MR. JUSTICE C. HARI SHANKAR

HON'BLE MR. JUSTICE OM PRAKASH SHUKLA

JUDGMENT (ORAL)

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28.07.2025

C. HARI SHANKAR, J.

The lis

1. CS (Comm) 920/2022¹ stands instituted by the respondent Mayo Foundation for Medical Education and Research against the appellant Bodhisatva Charitable Trust and other defendants. The respondent alleged, in the suit, infringement, by the appellants, of the registered trademarks of the respondent, as well as passing off, by the appellants, of the services provided by them, as services of the respondent.

¹ "the suit" hereinafter



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2. The suit was accompanied by IA 22385/2022, filed under Order XXXIX Rules 1 and 2 of the CPC, praying for interim injunction, pending disposal of the suit, against the appellants, restraining them from using the marks MAYO, MAYO INSTITUTE OF MEDICAL SCIENCES, MAYO MEDICAL CENTRE, MAYO MEDICAL CENTRE PRIVATE LIMITED, MAYO HOSPITAL, MAYO CLINIC, MAYO SCHOOL OF NURSING, MAYO PHARMACY and MAYO GASTRO- LIVER CLINIC.

3. A learned single Judge of this Court has, by judgment dated 29 May 2023, allowed IA 22385/2022 and has restrained the appellants in the terms sought by the respondent.

4. Aggrieved thereby, the appellants have instituted the present appeal.

5. We have heard Mr. Jayant Sud, learned Senior Counsel for the appellants and Mr. Raunaq Kamath, learned Counsel for the respondent, at length.

Facts

6. The Complaint

6.1 The Respondent asserted, in its complaint, that it was a leading internationally known Medical Centre which provided medical care through a diverse physician-led team and that the persons involved with the respondent offered clinical, educational, diagnostic and research services in a unified multi-campus system. The primary base



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of the respondent was in the US where, according to US News and World Report, the respondent had been named the “# 1 hospital nationwide”. Owing to regular publication and citation in Indian newspapers, magazines and online publications, it was asserted that the respondent had received widespread exposure and acceptance in the field of health and medicine in India. It was further asserted that, on the respondent’s website www.mayoclinic.org, there had been over 33 crore sessions by Indian users, and on its website www.mayo.edu, there had been over 10 lakh sessions to Indian users between 2014 and 2022.

6.2 The following marks, among others, stand registered in favour of the respondent under the Trade Marks Act, 1999:

MARK	CLASS	DATE	GOODS/SERVICES
MAYO	16	June 16, 1992	Periodicals, medical or other journals, printed matter
MAYO (Device)	16	June 16, 1992	Periodicals, medical or other journals, printed matter
MAYO CLINIC	16	June 16, 1992	Periodicals, medical or other journals, printed matter
MAYO CLINIC	10	August 26, 2008	Surgical, medical and dental apparatus and instruments, artificial limbs, eyes and teeth, orthopedic articles; suture materials
MAYO CLINIC	41	August 26, 2008	Educational services, namely, providing courses of instruction in medicine, dentistry, pharmacology, nursing and health care through a graduate medical school, medical school and



			school of health-related sciences, providing continuing medical education and seminars for professionals in the fields of medicine, dentistry, pharmacology, nursing and health care, conducting seminars and workshops for volunteers, patients and their families in the fields of health care and wellness, and distributing course materials in connection therewith
MAYO CLINIC	44	August 26, 2008	Biomedical and clinical research; medical laboratory services; medical health care services; medical clinical services; physician services; medical testing services; pharmacy services; nursing, health care and hospital services

6.3 It was further contended, in the plaint, that MAYO was also the respondent's house mark and constituted an essential and dominant part of its trading style, which included its domain names www.mayoclinic.org, www.mayo.edu and www.mayoclinic.com.

6.4 Appellant 1 Bodhisatva Charitable Trust is a non-government trust. Appellant 2 operates a multi-specialty health care Centre under the name "Mayo Medical Centre", Appellant 3 Mayo Medical Centre is a super specialty hospital established by Appellant 1, Appellant 4 Mayo institute of Medical Sciences was established by Appellant 1 in 2012, Appellant 5 Mayo School of Nursing was established by Mayo



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Medical Centre in 2003, Appellant 6 Mayo Hospital is a clinic/hospital operated by the trustees of Appellant 1 and Appellants 7 and 8 are the Directors of Appellant 4. The plaint alleged that the appellants had dishonestly adopted the MAYO registered trademark of the respondent in 2014. A cease-and-desist notice was issued by the respondent to the appellants on 11 April 2014, to which the appellants responded on 9 June 2014.

6.5 Admittedly, the appellants have no registration for any trademark in their name. Appellant 1 had applied for registration of the device mark  in Class 41; however, by order dated 21 March 2018, the Trade Marks Registry confirmed that the application had been abandoned. Nonetheless, the appellants continued to use the mark MAYO in relation to healthcare and educational services.

6.6 In these circumstances, the respondent instituted CS (Comm) 920/2022 against the appellants, alleging that they were infringing the registered trademarks of the respondent by use of MAYO as part of their marks as well as part of their domain names www.mayomedicalcentre.com and www.mayoschoolofnursing.com. The respondent, therefore, sought a decree of permanent injunction, restraining the appellants from infringing their registered marks and from passing off the services provided by them as the services of the respondent.

7. Written Statement



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7.1 The appellants, in the written statement, contended that the Mayo Institute of Medical Sciences and the Mayo Hospital were established in 2012 and the Mayo School of Nursing was established in 2003. The Mayo Medical Centre was set up by Appellant 2 in Lucknow in 1999-2000, and offered specialty and super specialty medical services.

7.2 The appellants contended that their institutions catered to patients from small towns of eastern Uttar Pradesh, who had never heard of the respondent and that, therefore, there was no likelihood of confusion as a result of the use, by the appellants, of the MAYO mark. It was further contended that MAYO was not a coined term and could not, therefore, be monopolised by the respondent.

7.3 The appellants also pleaded delay, laches and acquiescence on the part of the respondent, as the respondent was aware of the use of the mark MAYO by the appellants since 2011-2012, and did not take any action.

8. Submissions of respondent before the learned Single Judge

8.1 Before the learned Single Judge, the respondent submitted that as there were only 34 classes in which trademarks could be registered prior to 15 September 2003, the marks MAYO and MAYO CLINIC were registered in favour of the respondent in Class 16 in 1992. Class 16 dealt with “medical journals and printed matter”. It was submitted that hospitals and education services were allied in cognate to medical journals, periodicals and printed matter and that, therefore, use of the



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respondent's mark, or any deceptively similar mark, by the appellants, for health care and education, would amount to infringement.

8.2 It was further submitted that the adoption of the mark MAYO, by the appellants, was not honest, as the website of the Mayo Institute of Medical Sciences clearly stated that the appellants had got inspiration from Dr. William Mayo of Mayo Clinic, USA and that the founder of the appellants had studied medicine and worked in hospitals in the US. Where the adoption of the mark by the appellants was dishonest, it was submitted that the right of the respondent to injunction could not be defeated by delay in instituting the suit.

8.3 The respondent further submitted that, as it had issued a legal notice to the appellants on 11 April 2014, there could be no question of acquiescence.

8.4 The respondent further contended that, apart from the respondent's Class 16 registrations of the MAYO and MAYO CLINIC word marks dating back to 16 June 1992, the use of the mark MAYO by the appellants also infringed the MAYO CLINIC word mark registered in favour of the respondent in Class 41 w.e.f. 26 August 2008. It was submitted, in this context, that the appellants commenced use of the mark MAYO for education only in 2011/2012, which was after the mark MAYO CLINIC had been registered in favour of the respondent for identical educational services, in Class 41, w.e.f. 26 August 2008. Thus, it was alleged that the appellants had infringed not only the Class 16 MAYO and MAYO CLINIC registrations of the respondent of 16 June 1992, but also the MAYO CLINIC word mark



registered in favour of the respondent in Class 41 w.e.f. 26 August 2008.

8.5 The respondent further placed reliance on the judgment of the Supreme Court in *Milmet Oftho Industries v Allergan Inc.*² to submit that, in healthcare services, priority of user would have to be determined not on the basis of user in India but use worldwide. Inasmuch as the respondent had been using the MAYO mark since the late nineteenth century, albeit overseas, it was submitted that the respondent enjoyed priority of user, over the appellants, of the mark MAYO.

9. Submissions of appellants before the learned Single Judge.

9.1 The appellants contended, before the learned Single Judge, that there was no infringement, by the appellant, of the 1992 registrations of the marks MAYO or MAYO CLINIC in favour of the respondent, as the appellants were not using the mark MAYO for any goods or services in respect of which the marks MAYO and MAYO CLINIC stood registered in favour of the respondent in 1992. In so far as the 2008 registration of the mark MAYO CLINIC, in favour of the respondent in Class 41 was concerned, the appellants submitted that they had been using the mark MAYO since 1995, i.e. for over 13 years by the time of the said registration.

² (2004) 12 SCC 624



9.2 As such, it was submitted that priority of user of the mark MAYO was with the appellants and not the respondent. No case of infringement could, therefore, be said to have been made out.

9.3 Apropos passing off, the appellants contended that, in order to succeed in a claim for injunction on that ground, the respondent would have to establish that, prior to 1995, when the appellants commenced use of the mark MAYO, the respondent had already acquired sufficient goodwill and reputation in the said mark. No such case, it was submitted, had been made out by the respondent. The submission of the respondent that worldwide user would have to be taken into account to consider priority of user, based on the decision of the Supreme Court in *Milmet Oftho* was sought to be met by submitting that, in *Toyota Jidosha Kabushiki Kaisha v Prius Auto Industries Ltd.*,³ the Supreme Court had already considered the decision in *Milmet Oftho*, apropos the aspect of goodwill.

9.4 The appellants also pleaded acquiescence and delay as factors which would disentitle the respondent to injunction. It was submitted that the respondent, even as per its own showing, had come to learn of use of the mark MAYO by the appellants in 2014. CS (Comm) 920/2022 was instituted by the respondent eight years thereafter. By allowing the appellants to use their mark for these eight years, the respondent had disentitled itself to any injunctive relief, applying the principle of acquiescence. There was no justifiable explanation for the eight year delay in the respondent approaching this Court after having

³ (2018) 2 SCC 1



come to learn of the use, by the appellants, of the mark MAYO, in 2014.

9.5 The appellants also contested the territorial jurisdiction of this Court to entertain the suit, relying, for the said purpose, on the judgment of the Division Bench of this Court in *Banyan Tree Holding (P) Ltd. v A. Murali Krishna Reddy*⁴.

9.6 It was finally contended that MAYO is a common Indian name and was in fact the name of one of the Viceroys of India, in recognition of whom the Mayo College had been established at Ajmer, Rajasthan. MAYO was also an abbreviation for Mayonnaise. It was submitted, therefore, that no one, including the respondent, could seek to monopolise the use of the word MAYO.

10. Submissions of the respondent before the learned Single Judge by way of rejoinder

The respondent contended in its rejoinder before the learned Single Judge, that the appellants could not seek benefit of Section 34⁵ of the Trade Marks Act and that for the purposes of passing off, the common law rights of the respondent in the trademark MAYO in India at present would have to be considered. It was further submitted relying on the judgment of the Supreme Court in *Kaviraj Pandit Durga Dutt*

⁴ (2010) 42 PTC 361

⁵ 34. **Saving for vested rights.** – Nothing in this Act shall entitle the proprietor or a registered user of registered trade mark to interfere with or restrain the use by any person of a trade mark identical with or nearly resembling it in relation to goods or services in relation to which that person or a predecessor in title of his has continuously used that trade mark from a date prior—

(a) to the use of the first-mentioned trade mark in relation to those goods or services be the proprietor or a predecessor in title of his; or

(b) to the date of registration of the first-mentioned trade mark in respect of those goods or services in the name of the proprietor of a predecessor in title of his;

whichever is the earlier, and the Registrar shall not refuse (on such use being proved) to register the second mentioned trade mark by reason only of the registration of the first-mentioned trade mark.



*Sharma v Navaratna Pharmaceutical Laboratories*⁶, that added matter was irrelevant in an infringement action. The very use, by the appellants, of the MAYO mark inevitably lead to an inference of association between the appellants and the respondent. It was further contended that MAYO, as a mark, was arbitrary and distinctive when used for healthcare services. Besides, as the appellants had also applied for registration of the mark, MAYO for healthcare services, they could not be heard to contend that the mark was lacking in distinctiveness.

Impugned Judgment of the learned Single Judge

11. By the impugned judgment dated 29 May 2023, the learned Single Judge has allowed IA 22385/2022 and has consequently passed an order of restraint against the appellants in the following terms:

“42. Accordingly, the defendants, their directors, officers, servants, agents, distributors, stockists, representatives and anyone acting for or on their behalf are restrained from using the plaintiff’s trade mark/ name “MAYO” or any mark/name deceptively similar thereto, in any manner including the marks/names “MAYO INSTITUTE OF MEDICAL SCIENCES”, “MAYO MEDICAL CENTRE”, “MAYO MEDICAL CENTRE PRIVATE LIMITED”, “MAYO HOSPITAL”, “MAYO CLINIC”, “MAYO SCHOOL OF NURSING”, “MAYO PHARMACY”, and “MAYO GASTRO-LIVER CLINIC”, the domain names www.mayomedicalcentre.com and www.mayoschoolofnursing.com and listings on any social media platforms and third-party websites till the final adjudication of the suit.

12. In arriving at its decision, the learned Single Judge has observed that, on 16 June 1992 when the marks MAYO and MAYO CLINIC were registered in favour of the respondent, the Nice

⁶ AIR 1965 SC 980



Classification had not yet been made applicable, and there were only 34 classes in which the mark could be registered. The closest class in which the MAYO and MAYO CLINIC marks could be registered in favour of the respondent were Class 16 as neither Class 41 which dealt with educational services nor Class 44, which dealt with medical and healthcare services, existed at that time. The registration of the word marks, MAYO and MAYO CLINIC, in favour of the respondent was, therefore, granted on 16 June 1992 under class 16.

13. Besides, holds the learned Single Judge, “periodicals, medical or other journals printed matter” in respect of which the marks MAYO and MAYO CLINIC stood registered in favour of the respondent in Class 16 with effect from 16 June 1992 were allied and cognate to hospitals and education services providing courses of instruction in medical and healthcare, in respect of which the appellants were using the marks MAYO and MAYO CLINIC with effect from 1995. For this purpose, the learned Single Judge has relied on the judgment of the Supreme Court in *Renaissance Hotel Holdings Inc v V. Vijaya Sahi*⁷. As such, the learned Single Judge has held that a *prima case* of infringement, by the appellants, of the marks MAYO and MAYO CLINIC, which were registered in favour of the respondent in Class 16 with effect from 16 June 1992 was made out.

14. The learned Single Judge also notes that even in Class 41, which dealt, *inter alia*, with education, the mark MAYO CLINIC stood registered in favour of the respondent with effect from 26 August 2008 whereas the appellants had commenced using the mark

⁷ (2022) 5 SCC 1



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MAYO for education purposes only in 2011-2012.

15. The learned Single Judge has also rejected the appellant's contention that MAYO was an expression of common usage. The impugned judgment holds that, in relation to healthcare services, MAYO was an arbitrary and distinctive mark. In any event, having itself applied for registration of the device mark  (Mayo Institute of Medical Sciences), the appellants could not be heard to contend that the mark MAYO was not deserving of a registration or that it was common to the trade.

16. The learned Single Judge further holds that the adoption of the mark MAYO, by the appellants was not honest. Reliance has been placed in this context on information provided on the website of the MAYO School of Nursing, which states that it was established in 2000 with a mission to serve the society with an inspiration from Dr. William Mayo, of MAYO CLINIC, USA. Reference has also been made to the website of Mayo Institute of Medical Science, which acknowledges the fact that the founder of the institute Dr. Kailash Narayan Singh had completed his MD from Pennsylvania Medical School and was working in the U.S. before shifting base to India in 1996.

17. Based on these representations contained on the website of the Mayo School of Nursing and the Mayo Institute of Medical Science, the learned Single Judge has held that K.N. Singh was not only aware of the Mayo Clinic in the US, but also draw inspiration from its founder Dr William Mayo. Also noting the fact that Dr K.N. Singh



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had studied extensively in the US and had worked as a doctor in the US before shifting to India, the learned Single Judge holds that there was no reason for adoption, by the appellants, of the mark MAYO. The adoption has, therefore, been held to be dishonest.

18. The plea of delay and laches and acquiescence have been rejected by the learned Single Judge. Reliance has been placed, for this purpose, on the judgment of the Supreme Court in *Midas Hygiene Industries (P) Ltd v Sudhir Bhatia*⁸ and of this Court in *Hindustan Pencils Limited v India Stationary Products Co. & Anr.*⁹. On the aspect of acquiescence, the learned Single Judge has held that, as the cease and desist notice had been issued by the respondent to the appellant, the respondent could not be said to have acquiesced in the use, by the appellants, of the MAYO mark.

19. The learned Single Judge has further relied on the judgment of the Supreme Court in *Milmet Oftho Industries* to hold that, as the respondent was the first in the world market, insofar as the use of the mark MAYO or MAYO CLINIC was concerned, it enjoyed priority of user over the appellants.

20. The aspect of territorial jurisdiction has been held, by the learned Single Judge, to be a mixed question of fact and law, regarding which he was not inclined to express any *prima facie* view at this stage.

⁸ (2004) 3 SCC 90

⁹ AIR 1990 Del 19



21. Following the above reasoning, the learned Single Judge has held that a *prima facie* case of infringement, as well as passing off, was made out in favour of the respondent and against the appellants. Inasmuch as the use, by the appellants, of the mark MAYO was likely to cause confusion in the minds of the public, it has been held that the balance of convenience is also in favour of grant of an interlocutory injunction. The learned Single Judge has also held that the respondent would continue irreparable loss of its goodwill and reputation if the appellants were to be allowed to continue to use the mark MAYO.

22. Following the above finding, the learned Single Judge has enjoined the appellants in the terms already set out in paras 2 and 3 *supra*.

23. Aggrieved by the aforesaid judgment of the learned Single Judge, the appellants have instituted the present appeal before this Court.

Rival Submissions

24. Submissions of Mr. Jayant Sud

24.1 Mr. Sud has sought to contend that the appellants enjoyed priority of user, over the respondent, with respect to the mark MAYO. It is sought to be contended that the respondent cannot capitalize on the registration of the marks MAYO and MAYO CLINIC in the respondent's favour in 1992, as those registrations were not in relation to goods or services which were allied or cognate to the services rendered by the appellants under the mark MAYO. Reliance has been



placed, in this context, on para 3 of the judgment of a learned Single Judge of this Court in *Gopal Engg. & Chemical Works v POMX Laboratory*¹⁰.

24.2 Mr. Sud further sought to submit that the respondent had disentitled itself to any injunctive relief even on the principle of acquiescence, for which purpose, he has placed reliance on Section 33(1)¹¹ of the Trade Marks Act. He submits that the issuance, by the respondent, to the appellants, of the legal notice on 11 April 2014, could not wish away the effect of acquiescence, as, even after that date, the respondent waited for eight years before instituting the suit before this Court.

24.3 Insofar as the aspect of priority of user is concerned, Mr. Sud placed reliance on paras 8 and 9 of *Milmet Oftho Industries*. He submits that, despite having obtained registrations for the MAYO and MAYO CLINIC marks in 1992, there was no use, by the respondent, of the said marks, for 30 years till 2022. In the meanwhile, the respondent had been using the MAYO mark continuously and without interruption since 1995. These factors, according to Mr. Sud, justified denial of injunction as sought by the respondent.

24.4 In any event, having acquiesced to the use of the mark MAYO by the appellants for the 30 years, it could not be said that, by the said

¹⁰ AIR 1992 Del 302

¹¹ 33. Effect of acquiescence. –

(1) Where the proprietor of an earlier trade mark has acquiesced for a continuous period of five years in the use of a registered trade mark, being aware of that use, he shall no longer be entitled on the basis of that earlier trade mark—

(a) to apply for a declaration that the registration of the later trade mark is invalid, or

(b) to oppose the use of the later trade mark in relation to the goods or services in relation to which it has been so used,



use, any irreparable loss was resulting to the respondent as would justify grant of interim relief. He has relied, in this context, on Section 47¹² of the Trade Marks Act, para 39 of the judgment of the Supreme Court in *Toyota* and para 16 of the judgment rendered by one of us (C. Hari Shankar, J.) sitting singly, in *Trustees of Princeton University v Vagdevi Educational Society*¹³.

25. Submissions of Mr. Kamath

25.1 As against this, Mr. Kamath, appearing for the respondent, submits that the findings of the learned Single Judge are unexceptionable and in sync with the existing legal position. Inasmuch as the mark used by the appellants, MAYO, was the same as the MAYO mark registered in favour of the respondent, he submits that the case would attract Section 29(2)(c)¹⁴ read with Section 29(3)¹⁵ of

unless the registration of the later trade mark was not applied in good faith.

12 47. Removal from register and imposition of limitations on ground of non-use. –

(1) A registered trade mark may be taken off the register in respect of the goods or services in respect of which it is registered on application made in the prescribed manner to the Registrar or the High Court by any person aggrieved on the ground either—

- (a) that the trade mark was registered without any bona fide intention on the part of the applicant for registration that it should be used in relation to those goods or services by him or, in a case to which the provisions of Section 46 apply, by the company concerned or the registered user, as the case may be, and that there has, in fact, been no bona fide use of the trade mark in relation to those goods or services by any proprietor thereof for the time being up to a date three months before the date of the application; or
- (b) that up to a date three months before the date of the application, a continuous period of five years from the date on which the trade mark is actually entered in the register or longer had elapsed during which the trade mark was registered and during which there was no bona fide use thereof in relation to those goods or services by any proprietor thereof for the time being;

Provided that except where the applicant has been permitted under Section 12 to register an identical or nearly resembling trade mark in respect of the goods or services in question, or where the Registrar or the High Court, as the case may be, is of opinion that he might properly be permitted so to register such a trade mark, the Registrar or the High Court, as the case may be, may refuse an application under clause (a) or clause (b) in relation to any goods or services, if it is shown that there has been, before the relevant date or during the relevant period, as the case may be, bona fide use of the trade mark by any proprietor thereof for the time being in relation to—

- (i) goods or services of the same description; or
- (ii) goods or services associated with those goods or services of that description being goods or services, as the case may be, in respect of which the trade mark is registered.

¹³ 2023 SCC OnLine Del 5524

¹⁴ (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—



the Trade Marks Act and that, therefore, there would be a presumption of likelihood of confusion. He further submits that the learned Single Judge has correctly held the nature of services in respect of which the marks MAYO and MAYO CLINIC stood registered in favour of the respondent in 1992 to be allied and cognate to the nature of the services provided by the appellants under the identical mark MAYO, from 1995.

25.2 Mr. Kamath submits that, in fact, the appellants have infringed not only the registrations of the mark MAYO and MAYO CLINIC in favour of the respondent in 1992, but also the registration of the mark MAYO CLINIC in favour of the respondent in Class 41 in 2008. He submits that the said registration pertained to education services and it was only in 2011-12 that the appellants commenced providing educational services under the mark MAYO. As such, even in respect of educational services, priority of user of the mark MAYO was with the respondent *vis-à-vis* the appellants.

25.3 Mr. Kamath further submits that no case is made out even for interfering with the view of the learned Single Judge that the adoption, by the appellants, of the mark MAYO, was lacking in *bona fides*. He has drawn our attention to the recitals contained on the website of the Mayo School of Nursing and the Mayo Institute of Medical Science, which indicated that the appellants had consciously adopted MAYO

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- (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.

¹⁵ (3) In any case falling under clause (c) of sub-section (2), the court shall presume that it is likely to cause confusion on the part of the public.



as the mark under which they were providing their services, being fully aware of the reputation of the respondent in the US. In these circumstances, he submits that the learned Single Judge was correct in holding lack of *bonafides* and honesty on the part of the appellants.

25.4 Mr. Kamath, therefore, exhorts this Court to approve the impugned judgment of the learned Single Judge and reject the present appeal.

Analysis

26. Identity of appellants' mark with respondent's registered mark circa 1992 – Registration of respondent prior to commencement of user by appellants

26.1 The rival marks in question are MAYO of the appellants and MAYO/MAYO CLINIC of the respondent. The word marks MAYO and MAYO CLINIC stand registered in the respondent's favour since 1992, in Class 16 for "periodicals, *medical or other journals*, printed matter". As the learned Single Judge has correctly observed, there was, at that time, no more proximate Class in which the mark could have been registered in favour of the appellants.

26.2 Even otherwise, applying the law laid down by the Supreme Court in *Renaissance Hotel Holdings*, the services provided by the appellants under the infringing MAYO mark i.e., hospitals and education services providing courses of instructions in medical and healthcare are clearly allied and cognate to periodicals, medical and other journals and printed matter in respect of which the mark MAYO and MAYO CLINIC stood registered in favour of the respondent.



26.3 Without, therefore, having to extrapolate the issue of user to the extent envisaged in the judgment of the Supreme Court in *Milmet Oftho*, we are of the clear opinion that, even in India, the respondent enjoyed priority of registration of the MAYO and MAYO CLINIC marks *vis-à-vis* the user of the MAYO mark by the appellants, as the registration of MAYO and MAYO CLINIC mark in favour of the respondent was of 16 June 1992 whereas the appellants admittedly commenced use of the MAYO mark only in 1995.

27. Re. plea of non-user

27.1 The fact that the respondent may have not used the MAYO and MAYO CLINIC marks, despite the registration of the marks in its favour in 1992, cannot make any substantial difference. We have dealt with this aspect, in detail, in our recent decision in *Kamal Raheja v Hahnemann Pure Drug Co.*¹⁶, from which we deem it appropriate to reproduce the following paragraphs:

“8. We have considered the submissions, but are constrained to observe that they are completely foreign to the issue of infringement of trademark under the Trade Marks Act.

9. The right to relief against infringement is provided, under Section 28(1)¹⁷, consequent on the factum of registration of a mark. Commercial user of the mark is not required in order for an infringement action to lie.

10. The fact that the registration of the respondent’s “MARKS GO” mark under the Trade Marks Act is subsisting is not in

¹⁶ MANU/DE/5068/2025

¹⁷ 28. **Rights conferred by registration.** –

(1) Subject to the other provisions of this Act, the registration of a trade mark shall, if valid, give to the registered proprietor of the trade mark the exclusive right to the use of the trade mark in relation to the goods or services in respect of which the trade mark is registered and to obtain relief in respect of infringement of the trade mark in the manner provided by this Act.



dispute.

11. Once the registration of the mark is subsisting, Section 28(1) grants, to the registrant, the right to seek relief against infringement.

12. Infringement, as defined in the various sub-sections of Section 29¹⁸ of the Trade Marks Act, is not dependent on user, but on registration. Each sub-section of Section 29 commences with the words “a registered trade mark”. Thus, the plaintiff’s trade mark is required to be registered, and the registration subsisting; nothing more.

13. As such, commercial user of the registered mark is not a *sine qua non* for an infringement action to lie.

14. Lack of commercial user of a registered trade mark does constitute a ground, under Section 47(1)¹⁹ of the Trade Marks Act,

¹⁸ 29. **Infringement of registered trade marks. –**

(1) 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 is identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark.

(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.

(3) In any case falling under clause (c) of sub-section (2), the court shall presume that it is likely to cause confusion on the part of the public.

(4) 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—

- (a) is identical with or similar to the registered trade mark; and
- (b) is used in relation to goods or services which are not similar to those for which the trade mark is registered; and
- (c) the registered trade mark has a reputation in India and the use of the mark without due cause takes unfair advantage of or is detrimental to, the distinctive character or repute of the registered trade mark.

¹⁹ 47. **Removal from register and imposition of limitations on ground of non-use. –**

(1) A registered trade mark may be taken off the register in respect of the goods or services in respect of which it is registered on application made in the prescribed manner to the Registrar or the High Court by any person aggrieved on the ground either—

- (a) that the trade mark was registered without any bona fide intention on the part of the applicant for registration that it should be used in relation to those goods or services by him or, in a case to which the provisions of Section 46 apply, by the company concerned or the registered user, as the case may be, and that there has, in fact, been no bona fide use of the trade mark in relation to those goods or services by any proprietor thereof for the time being up to a date three months before the date of the application; or
- (b) that up to a date three months before the date of the application, a continuous period of five years from the date on which the trade mark is actually entered in the register or longer had elapsed during which the trade mark was registered and during which there was no bona fide use thereof in relation to those goods or services by any proprietor thereof for the time being;



to remove the trademark from the register of trademarks, but that is subject to (i) an application being moved by an aggrieved person seeking removal of the mark and (ii) continuous non-user of the mark, by its registered proprietor, for a period of 5 years, up to 3 months prior to the date of the application. In any event, there is no provision which enables the Registrar *suo motu* to remove a mark from the register of trade marks. It has to be on application by an aggrieved person.

15. There is no provision, in the Trade Marks Act, which can deem a registered trademark not to be registered, or divest the proprietor of a registered trade mark from the rights conferred by Section 28(1) as a consequence of such registration, merely because the mark is not in commercial use. We, therefore, are of the firm view that it is not open to an infringing defendant to escape the consequences of infringement of a registered trade mark on the ground that the proprietor of the registered trade is not subjecting it to commercial use. The defendant would, in that case, have to apply under Section 47(1) to have the registered trade mark removed from the register of trademarks and can only, thereafter, defend the case.

16. Section 28(1) commences with the words “Subject to the other provisions of this Act, the registration of a trade mark shall, *if valid*, give to the registered proprietor of the trade mark the exclusive right...” No doubt, therefore, the right to relief against infringement enures only in favour of the proprietor of a registered trademark, *which is valid*. At the interlocutory injunction stage, however, the plaintiff is only required to establish a *prima facie* case. Section 31(1)²⁰ of the Trade Marks Act unequivocally provides that the very registration of a trade mark shall be *prima facie* evidence of its validity in all legal proceedings relating to the registered trade mark. Thus, at the interlocutory stage, mere registration of the trade mark of the Plaintiff would suffice to constitute *prima facie* evidence of its validity. It is not open, therefore, to the defendant, at the interlocutory stage, to ordinarily contend that the plaintiff is not entitled to any injunction against

Provided that except where the applicant has been permitted under Section 12 to register an identical or nearly resembling trade mark in respect of the goods or services in question, or where the Registrar or the High Court, as the case may be, is of opinion that he might properly be permitted so to register such a trade mark, the Registrar or the High Court, as the case may be, may refuse an application under clause (a) or clause (b) in relation to any goods or services, if it is shown that there has been, before the relevant date or during the relevant period, as the case may be, bona fide use of the trade mark by any proprietor thereof for the time being in relation to—

- (i) goods or services of the same description; or
- (ii) goods or services associated with those goods or services of that description being goods or services, as the case may be, in respect of which the trade mark is registered.

²⁰ 31. **Registration to be *prima facie* evidence of validity.**—

(1) In all legal proceedings relating to a trade mark registered under this Act (including applications under Section 57), the original registration of the trade mark and of all subsequent assignments and transmissions of the trade mark shall be *prima facie* evidence of the validity thereof.



the defendant, even where infringement is found to exist, as the registration of the Plaintiff trade mark is invalid. The Trade Marks Act itself contains provisions²¹ in which, even if the ingredients of Section 29 are found to exist, no infringement can be set to take place. It also contains provisions which insulate an infringing defendant from injunction²². Short of these provisions, an infringing defendant must suffer the consequences of infringement as envisaged by Section 135(1)²³ of the Trade Marks Act.

17. We may also refer, in this context, to the definition of use of a mark as contained in Section 2(2)(b) and 2(2)(c)²⁴ of the Trade Marks Act, which make it apparent that the concept of “use of a mark” under the Trade Marks Act is much wider than mere affixation of the mark on products which may be bought and sold in the market.

18. Besides, the cancellation of licence of the respondent has taken place under the Drugs and Cosmetics Act. The respondent may have his remedies against such cancellation and we cannot, at this stage, predict as to whether that cancellation would persist forever.

19. The right to seek relief against infringement, under Section 28(1) read with Section 135(1) of the Trade Marks Act cannot, in any event, be sacrificed at the altar of user.”

27.2 Section 28(1) entails, as a consequence of the mere registration of a mark, a right, in favour of the registrant, to relief against infringement. The moment a trade mark is validly registered, Section 28(1) clothes the registrant, not only with the right to exclusive user of the mark, but also the right to relief against infringement of the mark

²¹ Refer Sections 30(1) and 30(2)(a)

²² Refer Sections 30(1), 33, 34 and 35

²³ **135. Relief in suits for infringement or for passing off. –**

(1) The relief which a court may grant in any suit for infringement or for passing off referred to in Section 134 includes injunction (subject to such terms, if any, as the court thinks fit) and at the option of the plaintiff, either damages or an account of profits, together with or without any order for the delivery-up of the infringing labels and marks for destruction or erasure.

²⁴ (2) In this Act, unless the context otherwise requires, any reference—

(b) to the use of a mark shall be construed as a reference to the use of printed or other visual representation of the mark;

(c) to the use of a mark,—

(i) in relation to goods, shall be construed as a reference to the use of the mark upon, or in any physical or in any other relation whatsoever, to such goods;

(ii) in relation to services, shall be construed as a reference to the use of the mark as or as part of any statement about the availability, provision or performance of such services;



by any third person. The nature of reliefs which are available against infringement are set out in Section 135 of the Trade Marks Act and includes, apart from damages, injunction. As such, mere registration of a mark, by itself, entitles the registrant to injunction against any third party who may infringe the mark.

27.3 The definition of “infringement” in Section 29(1) to (4) of the Trade Marks Act is also not dependent on user of the mark by the registrant. Each sub-section of Section 29 starts with the word “a registered trademark is infringed where”. As such, it is registration of the mark in favour of the plaintiff which entails infringement, if the acts of the defendant fall within one or other of the sub-sections of Section 29. Whether the plaintiff uses or does not use the registered mark, is entirely irrelevant.

27.4 In fact, the Trade Marks Act in Section 47 has set out the consequences of non-user. A mark which is not used for a considerable period of time is liable to be removed from the register of Trade Marks. That, however, cannot be *suo motu* but only on an application by an applicant who seeks removal of the mark from the register. Further the mark must not have been in disuse for a continuous period of five years, upto a period of three months prior to the filing of the application.

27.5 No application under Section 47, seeking removal of the respondent’s registered trade mark from the register, has been moved by the appellants.

27.6 Until the mark is removed from the register in the manner



envisaged by the Trade Marks Act, it continues to remain a valid and subsisting registration. In fact, Section 31(1) of the Trade Marks Act specifically ordains that the very registration of a mark shall operate as *prima facie* evidence of its validity. As such, the requirement of setting up a *prima facie* case regarding validity of registration of the mark in favour of the plaintiff is statutorily satisfied by Section 31 of the Trade Marks Act, the moment the mark is registered in the plaintiff's favour and till the registration subsists. Nothing further is required to be established by the plaintiff in so far as *prima facie* validity of the plaintiff's trade mark is concerned.

27.7 In that view of the matter, the plea of non-user of the registered trademarks of the plaintiff till 2022 does not make any difference to the respondent's entitlement to interim injunction against the appellants.

28. Re. plea of acquiescence

28.1 The plea of acquiescence, as raised by Mr. Sud, has also no legs to stand on. In the first place, Section 33, which deals with the effect of acquiescence, applies only to a registered trademark. Inasmuch as the appellant does not have any registered trademark, it cannot seek the benefit of Section 33.

28.2 Even otherwise, the plea of acquiescence is belied by the fact that the respondent had issued a cease and desist notice to the appellant as far back as on 11 April 2014. If the appellants, despite the said notice, continued to use the MAYO mark till 2022, they did so at their own peril. They cannot seek to derive any equities from such



user having been put on notice by the respondent in that regard. Equally, the respondent having put the appellant on notice regarding the infringing use, by it, of the MAYO mark and having called upon the appellants to cease and desist from continuing use the mark, it cannot be said that the respondent had acquiesced to the use of the mark by the appellants. One may refer, in this context, to the judgment of the Supreme Court in *Power Control Appliances v Sumeet Machines Pvt Ltd*²⁵ which deals with acquiescence. The following passage from the said decision may be reproduced:

“26. Acquiescence is sitting by, when another is invading the rights and spending money on it. It is a course of conduct inconsistent with the claim for exclusive rights in a trade mark, trade name etc. It implies positive acts; not merely silence or inaction such as is involved in laches. In *Harcourt v White*²⁶ Sr. John Romilly said: “It is important to distinguish mere negligence and acquiescence.” Therefore, acquiescence is one facet of delay. *If the plaintiff stood by knowingly and let the defendants build up an important trade until it had become necessary to crush it, then the plaintiffs would be stopped by their acquiescence. If the acquiescence in the infringement amounts to consent, it will be a complete defence as was laid down in Mouson (J.G.) & Co. v Boehm*²⁷. The acquiescence must be such as to lead to the inference of a licence sufficient to create a new right in the defendant as was laid down in *Rodgers v Nowill*²⁸.

27. The law of acquiescence is stated by Cotton, L.J. in *Proctor v Bannis*²⁹ as under:

“It is necessary that the person who alleges this lying by should have been acting in ignorance of the title of the other man, and that the other man should have known that ignorance and not mentioned his own title.”

In the same case Bowen, L.J. said:

“In order to make out such acquiescence it is necessary to establish that the plaintiff stood by and knowingly allowed the defendants to proceed and to expend money in

²⁵ (1994) 2 SCC 448

²⁶ (1860) 28 Beav 303 : 54 ER 382

²⁷ (1884) 26 Ch D 406

²⁸ (1847) 2 De GM&G 614 : 22 LJ KCH 404

²⁹ (1887) 36 Ch D 740



ignorance of the fact that he had rights and means to assert such rights.”

28. In *Devidoss and Co.*³⁰ at pages 33 and 34 the law is stated thus:

“To support a plea of acquiescence in a trade mark case it must be shown that the plaintiff has stood by for a substantial period and thus encouraged the defendant to expend money in building up a business associated with the mark. In *Rowland v Mitchell*³¹ Romer J. observed:

‘If the plaintiff really does stand by and allow a man to carry on business in the manner complained of to acquire a reputation and to expend money he cannot then after a long lapse of time, turn round and say that the business ought to be stopped.’”

In the same case, but on appeal Lord Russel, C.J. said:

“Is the plaintiff disentitled to relief under that head by injunction because of acquiescence? Of course it is involved in the consideration of that that the plaintiff has a right against the defendant and that the defendant has done him a wrong and the question is whether the plaintiff has so acted as to disentitle him from asserting his right and from seeking redress from the wrong which has been done to him. Cases may occasionally lay down principles and so forth which are a guide to the court, but each case depends upon its own circumstances.

Dealing with the question of standing by in *Codes v Addis and Son*³² at p. 142, Eve, J. said:

‘For the purpose of determining this issue I must assume that the plaintiffs are traders who have started in this more or less small way in this country, and have been continuously carrying on this business. But I must assume also that they have not, during that period, been adopting a sort of Rip Van Winkle policy of going to sleep and not watching what their rivals and competitors in the same line of business were doing. I accept the evidence of any gentleman who comes into the box

³⁰ *Devidoss and Co. v Alathur Abboyee Chetty & Co.*, AIR 1941 Mad 31

³¹ (1896) 13 RPC 464

³² (1923) 40 RPC 130, 142



and gives his evidence in a way which satisfies me that he is speaking the truth when he says that he individually did not know of the existence of a particular element or a particular factor in the goods marketed by his opponents. But the question is a wider question than that : ought not he to have known : is he entitled to shut his eyes to everything that is going on around him, and then when his rivals have perhaps built a very important trade by the user of indicia which he might have prevented their using had he moved in time, come to the Court and say : “Now stop them from doing it further, because a moment of time has arrived when I have awakened to the fact that this is calculated to infringe my rights.” Certainly not. He is bound, like everybody else who wishes to stop that which he says is an invasion of his rights, to adopt a position of aggression at once, and insist, as soon as the matter is brought to Court, it ought to have come to his attention, to take steps to prevent its continuance; it would be an insufferable injustice were the Court to allow a man to lie by while his competitors are building up an important industry and then to come forward, so soon as the importance of the industry has been brought home to his mind, and endeavour to take from them that of which they had legitimately made use; every day when they used it satisfying them more and more that there was no one who either could or would complain of their so doing. The position might be altogether altered had the user of the factor or the element in question been of a secretive or surreptitious nature; but when a man is openly using, as part of his business, names and phrases, or other elements, which persons in the same trade would be entitled, if they took steps, to stop him from using, he gets in time a right to sue them which prevents those who could have stopped him at one time from asserting at a later stage their right to an injunction.’

In *Mc. Caw Stevenson & Orr Ltd. v Lee Bros.*³³ acquiescence for four years was held to be sufficient to preclude the plaintiff from succeeding. In 1897 the plaintiffs in that case registered the word ‘glacier’ as a trade mark in respect of transparent paper as a substitute for stained glass. As the result of user the word had become identified with the plaintiffs’ goods. In 1900 the defendants

³³ (1960) 23 RPC 1



commenced to sell similar goods under the name ‘glazine.’ In 1905 the plaintiffs commenced an action for infringement. The defendants denied that the use of the word ‘glazine’ was calculated to deceive and also pleaded acquiescence. A director of the plaintiff company admitted that he had known of the use of the word ‘glazine’ by the defendants for four years — he would not say it was not five years. It was held that the plaintiffs failed on the merits and by reason of their delay in bringing the action.

Delay simpliciter may be no defence to a suit for infringement of a trade mark, but the decisions to which I have referred to clearly indicate that where a trader allows a rival trader to expend money over a considerable period in the building up of a business with the aid of a mark similar to his own he will not be allowed to stop his rival's business. If he were permitted to do so great loss would be caused not only to the rival trader but to those who depend on his business for their livelihood. A village may develop into a large town as the result of the building up of a business and most of the inhabitants may be dependent on the business. No hard and fast rule can be laid down for deciding when a person has, as the result of inaction, lost the right of stopping another using his mark. As pointed out in *Rowland v Mitchell*, each case must depend on its own circumstances, but obviously a person cannot be allowed to stand by indefinitely without suffering the consequence.”

29. Infringement

29.1 Inasmuch as the appellants were using the same MAYO mark as was registered in favour of the respondent as a word mark, and were providing services which fell within the scope of the services in respect of which the mark was registered in favour of the respondent, there is *prima facie* substance in Mr. Kamath’s contention that the case would fall within Section 29(2)(c) read with Section 29(3) of the Trade Marks Act and that, therefore, there would be a presumption of likelihood of confusion. Even if the nature of activities in respect of which the MAYO and MAYO CLINIC marks stood registered in favour of the respondent and the MAYO mark being used by the



appellants, may not be treated as identical, they were, at any rate, similar, which would also make out a *prima facie* case of infringement within the meaning of Section 29(2)(b) of the Trade Marks Act.

29.2 Where infringement is made out, the decision of the Supreme Court in *Midas Hygiene* is clear and categorical in requiring that an injunction has to follow. The Supreme Court has also held that, in such cases, even delay is of no consequence. To quote:

“5. The law on the subject is well settled. 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.”

30. Section 34

30.1 In these circumstances, the appellants cannot derive any advantage from Section 34 of the Trade Marks Act either. The use of the words “whichever is earlier” in Section 34 results in the Section being applicable only where the defendant has been using the infringing mark from a point of time prior to the date of *registration as well as user of the plaintiff’s mark*. The user, by the defendant, of the infringing mark has, therefore, to pre-date both the registration and user of the asserted mark of the plaintiff. In the present case, the registration of the marks MAYO and MAYO CLINIC in favour of the respondent in Class 16 is of 1992 whereas, admittedly, the user of the MAYO mark by the appellants is only of 1995.

30.2 Insofar as educational services are concerned, the mark MAYO CLINIC was registered in favour of the respondent with effect from



26 August 2008 in Class 41 whereas the appellants have admittedly been using the mark MAYO for educational services only with effect from 2011-2012 even as per para 30 of the reply filed by the appellants to IA 22385/2022, which reads thus:

“30. It is submitted that the Plaintiff was aware from very beginning that *the Defendants are using the word MAYO in connection with healthcare facilities since 1995 and in relation to Medical Education since 2011/2012*, still Plaintiff kept waiting to bring the action of infringement against the Defendants, which amounts to acquiescence on the part of the Plaintiff and therefore, the Application of the Plaintiff is liable to be rejected on this ground alone. The Application under reply is also hit by laches, delay and limitations. Moreover, not a single instance of confusion has been cited by the Plaintiff during this long period of user by the Defendant.”

30.3 Ergo, reckoned *vis-a-vis* the respondent’s registration of the MAYO and MAYO CLINIC marks with effect from 16 June 1992 in Class 16 or of the MAYO CLINIC mark for educational services in Class 41 with effect from 26 August 2008, the registration of the marks in favour of the respondent is prior, in point of time, to the first user of the marks by the appellants.

30.4 In these circumstances, the appellants cannot even seek the benefit of Section 34 of the Trade Marks Act.

31. Mere priority of user no defence to infringement

Priority of user is not a defence to an action for infringement. It becomes a defence only if it falls within the parameters of Section 34 of the Trade Marks Act. That, in its turn, requires user, by the defendant or the infringing mark, predating both the user as well as the registration of the asserted mark of the plaintiff. In other words, it is



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only if the defendant has been using the allegedly infringing mark, from a point of time prior to the registration as well as the user of the asserted mark of the plaintiff, that the defendant, despite being an infringer can escape an injunction by seeking recourse to Section 34. Else, mere priority of user by the defendant is no defence to infringement, or the injunction which must inexorably follow a finding of infringement.

Conclusion

32. For the reasons aforesaid, inasmuch as we find the judgment of the learned Single Judge as sustainable on the aspect of infringement, we are not entering into the aspect of passing off or on the aspect of condonation of delay in filing the appeal.

33. The impugned judgment of the learned Single Judge does not, therefore, call for any interference.

34. The appeal is, therefore, dismissed with no orders as to costs.

C. HARI SHANKAR, J.

OM PRAKASH SHUKLA, J.

JULY 28, 2025

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