



2025:DHC:11885



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

% *Judgment delivered on: 24.12.2025*

+ **CS(COMM) 532/2022**

A.O. SMITH CORPORATION AND ANR.Plaintiffs

versus

STAR SMITH EXPORT PVT. LTD. AND ANR.Defendants

Advocates who appeared in this case

For the Plaintiffs : Mr. Ranjan Narula, Ms. Shakti Nair & Mr. Parth Bajaj, Advocates.

For the Defendants : Mr. Manoj Choudhan, Mr. Ujjwal Singh Parmer, Ms. Neha Raj Singh & Ms. Ridhi Krishna, Advocates.

**CORAM:
HON'BLE MR. JUSTICE TEJAS KARIA**

JUDGMENT

TEJAS KARIA, J

I.A. No. 12253/2022

1. The present Application has been filed under Order XXXIX Rules 1 and 2 of the Code of Civil Procedure, 1908 (“CPC”) seeking an interim injunction restraining infringement of the Trade Marks, ‘A.O. SMITH’, ‘



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, ‘**AC Smith**’, and ‘**BLUE DIAMOND**’ (“**Plaintiffs’ Trade Marks**”) and restraining the Defendants from using the Marks, ‘**STARSMITH**’, **STAR SMITH**’, ‘**BLUE**



DIAMOND’, ‘**STAR SMITH**’, and ‘**BLUE DIAMOND**’ (“**Impugned Trade Marks**”) either as a Trade Name or Trade Mark and / or any other deceptively similar Marks.

2. The Plaintiffs further sought an interim injunction restraining the Defendants from using the Domain Name, <http://www.starsmith.in/>, (“**Impugned Domain Name**”) which is deceptively similar to the Domain Names, <https://www.aosmith.com/>, and, <http://www.aosmitindia.in/> (“**Plaintiffs’ Domain Names**”).

PROCEDURAL BACKGROUND:

3. *Vide* Order dated 03.08.2022, an *ex-parte ad-interim* order was granted in favour of the Plaintiffs restraining the Defendants from using the Marks, ‘**STARSMITH**’, ‘**STAR SMITH**’, and ‘**BLUE DIAMOND**’ or any other Mark that is deceptively similar to the Plaintiffs’ Trade Marks for manufacture, distribution, sale of geysers, purification systems, water purifiers, RO systems and other cognate and allied goods. However, insofar as the Trade Name of Defendant No. 1, Star Smith Export Pvt. Ltd., (“**Impugned Trade Name**”) was concerned, so long as the same is only used as a Corporate Name, without giving undue prominence to ‘**STAR SMITH**’, the same was allowed to be continued till the pleadings were



completed in the matter. Further, the relief qua the Impugned Domain Name was also left to be considered after the Defendants entered appearance.

4. *Vide* Judgment dated 22.03.2024, the *ex-parte ad-interim* Order dated 03.08.2022 was made absolute and although it was observed that the exceptions in the Order dated 03.08.2022 with respect to granting an injunction against the Impugned Trade Name and the Impugned Domain Name, remained to be adjudicated the present Application was disposed of. The Plaintiffs filed a review petition against the Judgment dated 22.03.2024 seeking clarification as the present Application was disposed of even when the exceptions carved out vide Order dated 03.08.2022 regarding the Impugned Trade Name and the Impugned Domain Name were left to be adjudicated.

5. *Vide* Order dated 18.10.2024, the Review Petition filed by the Plaintiffs was allowed and the present Application was revived to the extent that the issues of injunction against the Impugned Trade Name and against the Impugned Domain Name, which forms part of the reliefs sought in Paragraph No. 15(b) of the present Application is to be decided.

6. *Vide* Order dated 09.09.2025, after conclusion of Arguments by the Parties, the Judgment was reserved in the present Application.

SUBMISSIONS ON BEHALF OF THE PLAINTIFFS:

7. The learned Counsel for the Plaintiffs made the following submissions:

7.1 Plaintiff No. 1 has been using the Trade Name, 'A.O. SMITH' ("**Plaintiffs' Trade Name**") as its House Mark since its inception in 1874 for residential and commercial water heaters and boilers and water purification equipment. The Plaintiffs' Trade Name is



present on a substantial majority of the products manufactured by the Plaintiffs and all products that the Plaintiffs sell in India. Plaintiff No. 1 is headquartered in Milwaukee, Wisconsin, USA and employs 16,300 employees having operations in Canada, China, India, Mexico, Europe, Turkey, United Kingdom, and U.S.A. Plaintiff No. 1 has more than 20 offices globally and its products are available in over 60 countries of the world. Plaintiff No. 1 has sold products worth \$ 3.5 billion in 2021. Plaintiff No. 1 is also listed on New York Stock Exchange.

7.2 The Plaintiffs have extensive presence over social media platforms, which are accessible to consumers in India. The Plaintiffs' widespread internet presence through their websites and also through various online public forums, blogs, discussions, reviews, etc. have heightened the awareness and knowledge of the Plaintiffs' Trade Name. As a result, the relevant trade and public at large identify the Plaintiffs through the Plaintiffs' Trade Name.

7.3 The Plaintiffs' Trade Name has been in use since 1874 internationally and in India since 2006. The domain names www.aosmith.com and www.aosmithindia.com are registered since 1994 and 2008 respectively which are much prior to the Defendants' adoption and use of the Impugned Trade Name and the Impugned Domain Name. The Defendants have failed to provide cogent reasons for the adoption of the Impugned Trade Name.



- 7.4 *Vide* Judgment dated 22.03.2024, it has been held that ‘SMITH’ is the dominant part of the Plaintiffs’ Trade Marks and the Impugned Trade Marks and the Impugned Trade Marks are deceptively similar to the Plaintiffs’ Trade Marks. Further, the adoption of ‘SMITH’ in conjunction with ‘STAR’ in 2020 is *prima facie* dishonest adoption in order to ride on the goodwill of the Plaintiffs and cause confusion in the market, particularly for identical goods and cognate and allied goods.
- 7.5 The Defendants have also applied for registration of the Impugned Trade Marks, the essential feature of which is ‘SMITH’ and, therefore, are estopped in claiming that ‘SMITH’ is generic. A party cannot approbate and reprobate as has been held in ***Automatic Electric Limited v. R. K. Dhawan***, 1999 SCC OnLine Del 27. The Plaintiffs are not expected to sue every small infringer. Further, use by third-party is not a valid defence for infringement of Trade Marks as has been held in ***Pankaj Goel v. Dabur India Ltd.*** 2008 SCC OnLine Del 1744, ***Shree Nath Heritage Liquor vs. Allied Blender***, MANU/DE/1933/2015 and ***Dr. Reddy Laboratories v. Reddy Pharmaceuticals***, 2004 (29) PTC 435.
- 7.6 Section 29(5) of the Trade Marks Act, 1999 (“**Act**”) specifies that a registered Trade Mark is infringed by another if he used the registered Trade Mark as a Trade Name or part of a Trade Name. The Defendants’ use of the Impugned Trade Name is infringing upon the Plaintiffs’ Trade Marks by virtue of Section 29(5) of the Act. Section 29(5) of the Act reads as under:



“29(5) A registered trade mark is infringed by a person if he uses such registered trade mark, as his trade name or part of his trade name, or name of his business concern or part of the name, of his business concern dealing in goods or services in respect of which the trade mark is registered.”

- 7.7 In ***Bloomberg Finance LP v. Prafull Saklecha***, 2013 SCC OnLine Del 4159, it has been held that Section 29(5) of the Act applies in circumstances where, first, the infringer uses the registered Trade Mark as the Trade Name or as part of the trade name, or part of that Trade Name, and second, the business concern or trade deals in the similar goods or services for which the Trade Mark stands registered. If the proprietor of the registered Trade Mark demonstrates that these two elements are satisfied, an order of injunction against the infringer ought to follow as a matter of course. For the application of Section 29(5) of the Act, it is not necessary to establish that the Trade Mark possesses distinctive character or that the infringer’s use of the registered Trade Mark as part of its Trade Name is likely to cause any confusion.
- 7.8 This Court in ***Satyam Infoway Ltd. v. Siffynet Solutions (P) Ltd.***, (2004) 6 SCC 145, held that the use of an identical or similar Domain Name can cause users to be diverted, since they may mistakenly visit one domain name in place of another. This risk is heightened in e-commerce because of its speed, its immediate and practically unlimited reach, and the likelihood of overlap in specific sectors. Ordinary consumers or users who intend to access the functions available under a particular



Domain Name may become confused if they inadvertently land on another similar website that does not provide those functions. Such users may even believe that the original Domain Name owner misrepresented its goods or services in its promotional material, resulting in a loss of business for that owner. It is therefore clear that a Domain Name can possess all the attributes of a Trade Mark and can support a passing off action.

7.9 In India, there is no statute that specifically addresses the resolution of disputes relating to domain names. Although the Act does not operate extraterritoriality and may not by itself provide complete protection for Domain Names, this does not imply that Domain Name are without legal protection. They can still be safeguarded, to the extent permissible, through the principles governing passing off.

7.10 The Registrar of Trade Marks, after going through the submissions and representations made by the Plaintiffs in Trade Mark Application No. 1668622 for registration of the word Mark 'A.O. SMITH', saw it fit to not put a disclaimer or a condition while granting the registration or limiting the rights in the word 'SMITH'. This Court in ***Telecare Network India Pvt. Ltd. v. Asus Technology Pvt. Ltd. And Ors.***, MANU/DE/1838/2019, held that once a Trade Mark is registered only the certificate of registration is to be seen and the stand taken by the plaintiff in reply to the examination report is irrelevant.



7.11 Accordingly, the use of the Impugned Trade Name and Impugned Domain Name shall also be enjoined along with the injunction already passed in favour of the Plaintiffs.

SUBMISSIONS ON BEHALF OF THE DEFENDANTS:

8. The learned Counsel for the Defendants made the following submissions:

8.1 The Defendants never represented its goods as those of the Plaintiffs and goods of the Defendants are clearly distinguishable for the shape, size and logo. The Marks 'STAR SMITH' and 'AO SMITH' are not deceptively similar. The Plaintiffs' Trade Marks are not distinctive and are adopted out of common dictionary names which can be adopted by anyone. The Mark 'SMITH' is common to trade and the Plaintiffs does not have the exclusive rights over the Mark 'SMITH'.

8.2 The Plaintiffs have not disclosed the fact that the Plaintiffs submitted before the Trade Marks Registry while seeking registration of the Plaintiffs' Trade Marks that the Plaintiffs will not claim exclusivity in the Mark 'SMITH'. In ***Yatra Online Ltd. v. Mach Conferences & Events Ltd.***, 2025 SCC OnLine Del 5610, ***Nilkamal Crates & Containers v. Reena Rajpal***, 2023 SCC OnLine Del 7129 and ***Parakh Vanijya (P) Ltd. v. Baroma Agro Product***, (2018) 16 SCC 632, it has been held that once a mark has been registered with a disclaimer that the registration of the mark does not give the proprietor of the mark the exclusive right to use the mark, the proprietor does not have the exclusive right to use the registered mark.



8.3 There are several other water heater companies which are manufacturing the water heaters and other electrical appliances under the Mark 'SMITH'. 'SMITH' is also a common name and the Plaintiffs cannot claim exclusivity over it.

ANALYSIS AND FINDINGS:

9. A Trade Mark indicates the source of the goods or services, in respect of which it is used. A Trade Mark is an indicator of origin, distinguishing the goods and services of a party from those of its competitors. Thus, a Trade Mark is said to possess a distinctive character, when it serves to identify and distinguish the goods or services of a party from those of others.

10. The present Application has been decided in part vide Judgment dated 22.03.2024, wherein the *ex-parte ad-interim* order dated 03.08.2022, restrained the Defendants from using the Marks, 'STARSMITH', 'STAR SMITH', and 'BLUE DIAMOND' or any other Mark that is deceptively similar to the Plaintiffs' Trade Marks for manufacture, distribution, sale of geysers, purification systems, water purifiers, RO systems and other cognate and allied goods, was made absolute. The issue of injunction against the Impugned Trade Name and against the Impugned Domain Name, which forms part of the reliefs sought in Paragraph No. 15(b) of the present Application is yet to be decided.

11. In the Judgment dated 22.03.2024, there is already a finding that 'SMITH' is the dominant part of the Plaintiffs' Trade Marks and the Impugned Trade Marks and the Impugned Trade Marks are deceptively similar to the Plaintiffs' Trade Marks. Further, the adoption of 'SMITH' in conjunction with 'STAR' in 2020 is *prima facie* dishonest adoption in order



to ride on the goodwill of the Plaintiffs and cause confusion in the market, particularly for identical goods and cognate and allied goods.

Plaintiffs' Statutory Rights

12. The Plaintiffs' Trade Marks have been registered without a disclaimer and, accordingly, the Plaintiffs are entitled to claim the exclusive rights over the use of the Plaintiffs' Trade Marks. As the Plaintiffs' Trade Marks are registered in the Trade Marks Register without a disclaimer and as long as the Plaintiffs' Trade Marks are validly subsisting on the Trade Marks Register, the Plaintiffs are entitled to protect the Plaintiffs' Trade Marks from infringement.

13. The registration of a Mark is to be looked at as they are registered and only the registration certificate is to be looked at, as has been held by this Court in *Telecare Network India* (supra) and the registration certificate of the Word Mark, A.O. SMITH, under Trade Mark Application No. 1668622 does not portray that the Mark, has been registered with a disclaimer and, therefore, the judgments in *Yatra Online Ltd.* (supra), *Nilkamal Crates* (supra) and *Parakh Vanijya* (supra) relied upon by the Defendants does not help the case of the Defendants.

Generic and Common to Trade

14. It is contended on behalf of the Defendants that 'SMITH' is a generic word and common to trade and 'SMITH' is a common name and no person can be allowed to monopolise a common name. This submission is contrary to the stand taken by the Defendants in the Trade Mark Applications filed by the Defendants. The Defendants themselves have applied for registrations of the Marks bearing the word 'SMITH'.



15. Defendants have also applied for registration of the Impugned Trade Marks, the essential feature of which is 'SMITH' and, therefore, are estopped in claiming that 'SMITH' is generic and common to trade. A party cannot approbate and reprobate as has been held in *Automatic Electric Limited* (supra). The Plaintiffs are not expected to sue every small infringer. Further, use by third-party is not a valid defence for infringement of Trade Marks as has been held in *Pankaj Goel v. Dabur India Ltd.* (supra), *Shree Nath Heritage* (supra) and *Dr. Reddy Laboratories* (supra).

Injunction with respect to Impugned Trade Name

16. The infringing nature of the Impugned Trade Marks having been already established an injunction must follow with respect to the Impugned Trade Name also. Section 29(5) of the Act specifies that a registered Trade Mark is infringed by another if the registered Trade Mark is used as a Trade Name or part of a Trade Name. The Plaintiffs had adopted the name 'A.O. SMITH' in 1874 and in India since 2006 while the Defendants have adopted the Impugned Trade Name only in 2020.

17. The Defendants' use of the Impugned Trade Name is infringing upon the Plaintiffs' Trade Marks by virtue of Section 29(5) of the Act. The Impugned Trade Name is deceptively similar to the Plaintiffs' Trade Marks and, therefore, the Impugned Trade Name is infringing upon the Plaintiff's Trade Marks. The Impugned Trade Name is also being used for dealing in identical and cognate and allied goods and, therefore, an injunction must follow against the Impugned Trade Name as well as has been held in *Bloomberg Finance LP* (supra).



Injunction with respect to Impugned Domain Name

18. The Impugned Domain Name completely subsumes the Plaintiffs' Trade Marks and is similar to the Plaintiffs' Domain Names. The Impugned Domain Name is also deceptively similar to the Plaintiffs' Domain Names. Use of a Domain Name that is deceptively similar to a reputed Trade Mark is impermissible.

19. The Defendants' adoption and use of the Impugned Domain Name creates a strong likelihood of consumer confusion and, prospective / future customers of the Plaintiffs may visit the Impugned Domain Name believing it to be that of the Plaintiffs. Even if pursuant to visiting the Impugned Domain Name they realise that the Defendants' products are in fact not the services of the Plaintiffs, the same still gives rise to the category of confusion identified as 'Initial Interest Confusion'.

20. If a web search for the Plaintiffs' products using the Plaintiffs' Trade Marks, the initial interest confusion caused by the Impugned Domain Name may deceive and lure the web user to the website associated with the Impugned Domain Name. Even when the web users access the Impugned Domain Name they may find that it is not the Plaintiffs' platform, the Defendants have succeeded in luring users to their site thus, resulting in passing off. The Plaintiffs and the Defendants are dealing with similar and allied and cognate goods and there exists a strong likelihood of deception through the Impugned Domain Names. Although, the Act does not provide for protection of Domain Names per se, Domain Names can be protected under the Act as has been held by this Court in **Satyam Infoway Ltd.** (supra).



CONCLUSION

21. Having considered the submissions advanced by the learned Counsel for the Parties, the pleadings and the documents on record, a strong *prima facie* case has been made out on behalf of the Plaintiffs for grant of an interim injunction against the Impugned Trade Name and the Impugned Domain Name.

22. The Plaintiffs have established their prior user as well as goodwill and reputation, on the basis of the documents on record. Injunction is a relief in equity, and in view of the aforesaid discussion, the same is in favour of the Plaintiffs and against the Defendants. Further, the balance of convenience also lies in favour of the Plaintiffs and against the Defendants and grave prejudice is likely to be caused to the Plaintiffs if interim injunction as prayed for is not granted in favour of the Plaintiffs and against the Defendants.

23. A clear case of infringement of the Plaintiffs' Trade Marks is made out. The Impugned Trade Marks are nearly identical, the class of consumers targeted by both parties directly overlaps, and the channels of trade are identical. Consequently, there exists a likelihood that consumers may mistakenly associate the Defendants' products with those of the Plaintiffs' or perceive them as a variant of the Plaintiffs' products, causing irreparable harm to the Plaintiffs' goodwill and reputation.

24. Accordingly, the Defendants, their partners, associates, assigns or assignee in interest, successors in interest, permitted assigns, sister concerns or group companies and all others acting for and on the Defendants' behalf are restrained from using, soliciting, providing services and advertising and directly or indirectly dealing in geysers, purification systems, water



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purifiers, RO systems and other cognate and allied goods under the Impugned Trade Name, Star Smith Export Pvt. Ltd., or the Impugned Domain Name, <http://www.starsmith.in/>, or any other Trade Name or Domain Name, which is identical or deceptively similar to the Plaintiffs' Trade Name, 'A.O. SMITH', or the Plaintiffs' Domain Names <https://www.aosmith.com/>, and, <http://www.aosmitindia.in/>, or the



Plaintiffs' Marks 'A.O. SMITH', ' , ' ,



' and 'BLUE DIAMOND' so as to cause infringement and/ or passing off of the Plaintiffs' Trade Marks.

25. In view of the above, the present Application is allowed and stands disposed of.

TEJAS KARIA, J

DECEMBER 24, 2025

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