



IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
IN ITS COMMERCIAL DIVISION
INTERIM APPLICATION NO. 1663 OF 2021
IN
COMMERCIAL IP SUIT NO. 215 OF 2021

Bhavesh Suresh Kataria proprietor of and trading as
Kataria Jewellery Insurance Consultancy

... Applicant/
Original Plaintiff

In the matter between:

Bhavesh Suresh Kataria proprietor of and trading as
Kataria Jewellery Insurance Consultancy

... Plaintiff

Versus

Kataria Insurance Brokers Pvt. Ltd.

... Defendant

Mr. Ashutosh Kane a/w. Mr. I.K. Paranjpe & Mr. Kanak Kadam i/b. W.S.
Kane & Co. for the Plaintiff

CORAM : ARIF S. DOCTOR, J.

DATE : 8th DECEMBER 2025

Oral Judgment

1. The Applicant in the captioned Interim Application seeks the following substantive reliefs:

(a) *pending the hearing and final disposal of the suit, the Defendant by itself, its directors, employees, servants, agents and all persons claiming under it be restrained by a temporary order and injunction of this Hon'ble Court from infringing the Plaintiff's registered trade marks bearing Registration Numbers 1969420 and 4174551, both in Class 36 by using the impugned trade mark KATARIA INSURANCE, the impugned domain name/ webs www.katarisinusrance.co.in and the impugned corporate name containing the mark KATARIA INSURANCE and/or any other trade mark, domain name 10) website and corporate name containing the word KATARIA or any other trade mark, domain name, corporate name identical with and/or deceptively similar to the Plaintiff's registered trade marks in respect of the services covered by the Plaintiff's registrations or in any other manner whatsoever;*

(b) *pending the hearing and final disposal of the suit, the Defendant by itself, its directors, employees, servants, agents and all persons claiming through it be restrained by a temporary order and injunction of this Hon'ble Court from rendering, offering, promoting or advertising the impugned services or like services under the impugned trade mark KATARIA INSURANCE, the impugned domain name/ website*

www.katariainsurance.co.in and impugned corporate name containing the mark KATARIA INSURANCE and/or any other trade mark, domain name/ website and corporate name containing the word KATARIA or any other trade mark, domain name/ website and corporate name wading name and style identical with and/or deceptively similar to the Plaintiff's said well-known trade marks, domain name and said trading name and style containing the said trade mark KATARIA so as to pass off or enable others to pass off the Defendant's impugned services and/or business as and for the said well-known services and/or business of the Plaintiff or in any other manner whatsoever;

2. The Defendant has not appeared, despite being served and repeatedly informed about the listing of the matter.
3. It was thus that the Interim Application was taken up for hearing.

Facts in Brief

4. In the year 1999 the Plaintiff started the business of offering life and general insurance policies, including Jeweller's Block Insurance Policy. Thereafter, in the year 2004, the Plaintiff started conducting the business

of providing insurance policies under the name and style “KATARIA INSURANCE CONSULTANCY”.

5. In 2006, the Plaintiff decided to concentrate and develop a niche in the jewellery market, and since then, he has been offering insurance policies and related services for the "Gems and Jewellery Sector". Consequently, the Plaintiff changed its trading name and style to “KATARIA JEWELLERY INSURANCE CONSULTANCY”.

6. The Plaintiff then applied for and secured registration of the following trade marks:

Trade Mark	Registration No.	Date of Registration	User Claim	CI	Services
	1969420	21.05.2010	07/04/2006	36	Real Estate Affairs, Insurance, Financial Affairs, Monetary Affairs
KATARIA	4174551	13.05.2019	07/04/2006	36	Insurance, Financial Affairs, Monetary Affairs,

					Real Estate Affairs
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7. It is the Plaintiff's case that in the fourth week of January 2014 the Plaintiff came to know that the Defendant had registered a company under the Corporate Name "KATARIA INSURANCE BROKERS PRIVATE LIMITED". The Plaintiff thus, through its chartered accountant, addressed a letter dated 28th January 2014, to the Registrar of Companies (ROC), Ahmedabad, objecting to the Defendant's registration of the said corporate name.
8. On 25th February 2014, the ROC informed the Defendant about the Plaintiff's existing trade mark in Class 36 and called upon the Defendant to change its corporate name. It appears that the ROC also drew the Defendant's attention to an undertaking dated 13th December 2013 signed by one of the directors of the Defendant, namely Mr. Rohan Rajendra Kataria, by which he had undertaken to alter the name of the Defendant company, if required.
9. Since, however, the Defendant did not change its name the Plaintiff on 4th August 2014 issued a cease and desist notice to the Defendant.
10. The Defendant, in its letter dated 8th September 2014, responded to the cease and desist notice by denying its contents, among other points. The

Defendant claimed to be entitled to use the name Kataria for several years by virtue of being part of the “KATARIA GROUP” and also on the basis of certain trade mark registrations in the name of “Kataria Automobiles Private Limited”.

11. On 3rd October 2014 the Plaintiff responded to the Defendant’s letter dated 8th September 2014, negating the contentions raised therein. It is the Plaintiff’s case that since the Defendant did not respond to this letter, the Plaintiff was under a *bona fide* belief that the Defendant had discontinued the use of the mark “KATARIA INSURANCE” (“**impugned mark**”) and (“**impugned corporate name**”).
12. It is the Plaintiff’s case that in January 2019 the Plaintiff came across the Defendant’s domain name www.katariainsurance.co.in while conducting an online search, pursuant to which the Plaintiff sent the Defendant another cease and desist notice dated 17th August 2019. Again, there was no response from the Defendant. The Plaintiff accordingly once again informed the ROC and also informed the Insurance Regulatory Development Authority of India (IRDA) regarding the same.
13. The Plaintiff then on 10th March 2021, filed the captioned Suit.

14. By an order dated 4th August, the Plaintiff was granted leave under Clause XIV of Letters Patent to merge the causes of action of infringement and passing off.

Submissions on behalf of the Plaintiff

15. Mr. Kane, Learned Counsel appearing on behalf of the Plaintiff, at the outset submitted that since the beginning, the Plaintiff's family name "KATARIA" formed the leading, essential and memorable feature of his trading name and style and that the Plaintiff had, since the year 2004, been openly, regularly, continuously and extensively using the said trade mark and name in respect of the said services.
16. He submitted that for the past many years, the Plaintiff's turnover has been running into several lakhs of rupees, and the Plaintiff had expended substantial sums on advertisement and promotional expenses as evidenced by the chartered accountant's certificate and the promotional material to the Plaintiff.
17. Mr. Kane then submitted that since the applications for registration of the Plaintiff's trade marks as set out in the table above were filed by the Plaintiff while trading under the name and style "KATARIA JEWELLERY INSURANCE CONSULTANCY", the Plaintiff did not claim user of 2004. However, the Plaintiff has been using the trade mark and name KATARIA in respect of the said business since the year 2004.

18. He submitted that on 29th September, 2007, the Plaintiff registered and started using the domain name/website www.katariainsurance.com.
19. Mr. Kane then submitted that the essential elements for establishing trade mark infringement are (a) the existence of a valid registration; (b) the impugned trade mark or name being identical or deceptively similar to the registered mark in question; and (c) the impugned trade mark being used in relation to goods or services that are identical or similar to those covered by the registration.
20. Mr. Kane then pointed out that in the facts of the present case, all these three requirements had been met since (a) the Plaintiff has registration of not only the label mark but also of the word mark KATARIA in respect of, *inter alia*, insurance services; (b) the impugned trade mark "KATARIA INSURANCE", the impugned domain name "www.katariainsurance.co.in" and the impugned corporate name "KATARIA INSURANCE BROKERS PVT. LTD." were all identical and/or deceptively similar to the Plaintiff's registered trade marks and (c) the services in respect of which the Defendant is using the impugned trade mark, domain name and corporate name is identical to the services covered by the Plaintiff's abovementioned trade mark registrations. He therefore submitted that the Plaintiff had clearly made out and established a case of infringement.

21. Mr. Kane then placed reliance upon the decision of the Supreme Court in the case of *Laxmikant Patel v. Chetanbhai Shah & Anr.*¹ to point out that in order to make out a case of passing off, the Plaintiff was required to show (i) goodwill, (ii) misrepresentation, and (iii) loss and/or likelihood of loss.
22. Mr. Kane then submitted that, given the Plaintiff's prior adoption and long-standing, open, continuous, and extensive use of the trade mark, the existence of goodwill in favour of the Plaintiff was plainly evident. He further pointed out that the identity or deceptive similarity between the rival trade marks, coupled with the fact that both parties offer the same services under their respective marks, domain names, and corporate names, is bound to cause confusion among consumers regarding the source or affiliation of the services. Such confusion, he submitted, necessarily implies misrepresentation by the Defendant which would result in loss for the Plaintiff, or at the very least an imminent likelihood of loss to the Plaintiff.
23. Mr. Kane then pointed out that the Defendant had, in the Affidavit in Reply dated 27th May 2021, resisted the reliefs sought for by the Plaintiff by raising the following defences: (I) that the Defendant was a bona fide user of the impugned trademark; (II) *alternatively*, that the Defendant was

¹ (2002) 3 SCC 65

a prior user; (III) non-joinder of a necessary party; (IV) acquiescence, delay and laches; and (V) that the Plaintiff had taken contrary stands. Mr. Kane submitted that each of these contentions was untenable and would in no manner disentitle the Plaintiff to the interim relief which had been sought for by the Plaintiff. He then dealt with each of the defences raised by the Defendant.

I. The Defendant was a bona fide user of the impugned trade mark

24. Mr. Kane submitted that it is the Defendant's case that it had adopted the impugned trade mark in a *bona fide* manner by using the surname/family name of one of its founding members and was thus entitled to protection under Section 35 of the Trade Marks Act, 1999 ("**the Act**"). He, however, submitted that the defence under Section 35 does not apply to an artificial person, like an incorporated company. He submitted that in cases of incorporated entities, the adoption of the name/mark is by choice, whereas in the case of a natural person, the adoption is not by choice.
25. Mr. Kane then placed reliance upon the decision of the Delhi High Court in the case of *Dr. Reddy's Laboratories Ltd. v. Reddy Pharmaceuticals Limited*² which he pointed out reiterated the findings of the decision of the Division Bench of this Hon'ble Court in the case of *Bajaj Electrical*

² 2004 SCC OnLine Del 668

*Limited, Bombay v. Metals & Allied Products, Bombay*³ and held as follows :

"The use of trade name/mark "Reddy" by the defendant is capable of causing confusion and deception resulting in injury to the goodwill and reputation of the plaintiff company. No other "Reddy" has a right to star a rival business by using the same trade name on the plea that it is his surname. This would encourage deception. If such a plea is allowed, rivals in trade would be encouraged to associate in their business ventures persons having similar surnames with a view to encash upon the trade reputation and goodwill acquired by others over a period of time. In Bajaj Electrical Limited, Bombay v. Metals & Allied Products, Bombay [reported in air 1988 Bom 167], the user of a family name by the defendants was held to be an act of passing off the goods and it was observed that the use of such family name as a trade mark was not permissible. The plea of the defendants that the surname of the partners of its firm could be used to carry on trade in their own name was rejected. It was held that prima facie the defendants were intentionally and dishonestly trying to

³ 1987 SCC OnLine Bom 225

pass off their goods by use of name "Bajaj" and as such the plaintiff had made out a case for grant of injunction."

26. He then also placed reliance upon the decisions in *Kirloskar Diesel Recon (P) Ltd. & Ors. v. Kirloskar Proprietary Ltd. & Ors.*⁴, *Mahindra & Mahindra Ltd. v. Mahendra & Mahendra Paper Mills Ltd.*⁵, *Mahendra & Mahendra Paper Mills Ltd. v. Mahindra & Mahindra Ltd.*⁶, *Mahindra & Mahindra Ltd. & Anr. v. MNM Marketing Pvt. Ltd. & Anr.*⁷, *Montari Overseas Limited vs Montari Industries Limited*⁸, *Reddy Pharmaceuticals Ltd. v. Dr. Reddy's Laboratories Ltd.*⁹ and *Anil Rathi v. Shri Sharma Steeltech (India) Pvt. Ltd. and Ors.*¹⁰ to point out that the Courts have consistently held that where a mark or name has, through long, continuous and extensive use, acquired distinctiveness and a strong proprietary association with a particular trader or business group, the goodwill in such mark will be protected against misuse or dilution. He submitted that these decisions further the defences available to an

⁴1995 SCC OnLine Bom 312

⁵ [Bombay High Court] Order dt. 23th April 1998 in Notice of Motion No. 3143 of 1998 in Suit No. 4007 of 1998

⁶ AIR 2002 SC 117

⁷ 2014 SCC OnLine Bom 1343

⁸ 1995 SCC OnLine Del 865

⁹ 2007 SCC OnLine Del 1416

¹⁰ 2020 SCC OnLine Del 2848

individual under Section 35 of the Trade Marks Act, which are not available to a company.

27. Mr. Kane then submitted that the Defendant's adoption of the impugned name and trade mark KATARIA INSURANCE for insurance services cannot, by any standard, be regarded as being honest or bona fide. He pointed out that, it was incumbent upon the Defendant to have prior to such adoption conducted a basic search of the Trade Marks Register and a market survey. He submitted that had the Defendant undertaken even a rudimentary search, the Defendant would have immediately discovered that the Plaintiff was the registered proprietor of



since the year 2010. He relied upon the decision of this Court in the case of *Bal Pharma Limited v. Centaur Laboratories Limited*¹¹ to support his contention that the Defendant was required to conduct a search and, having failed to do so, must face the consequences. Mr. Kane also further submitted that the law is well settled that a Defendant who adopts and uses a mark with knowledge of the Plaintiff's prior mark cannot later be heard to complain when sued for infringement, and that a Defendant who commences use without

¹¹ 2001 SCC OnLine Bom 1176

conducting a search is in no better position. In support of his contention, he placed reliance upon the decision of this Court in the case of *Arochem Ratlam Pvt. Ltd. v. Arom Alchemists Pvt. Ltd.*¹² He thus submitted that the defendant's user was plainly not *bona fide*.

28. Mr. Kane then submitted that even assuming that the Defendant's adoption of the impugned name and trade mark "KATARIA INSURANCE", was honest and bona fide, nevertheless, it was well settled that fraud was not an essential requirement for maintaining an action for passing off. In support of his contention, he placed reliance upon the decision of this Court in the case of *Wockhardt Ltd vs Torrent Pharmaceuticals Ltd*¹³.

II. Defendant was the prior user

29. Mr. Kane pointed out that the Defendant had in the Affidavit in Reply taken the plea that the impugned trade mark "KATARIA" was well-known and associated with the Defendant and its alleged group companies alone. He also pointed out that it was the Defendant's case that the Defendant had been suing the trade mark "KATARIA" through its predecessor group companies since 1955 and that by virtue of the Defendant being an authorised dealer of Maruti Suzuki India Ltd, the

¹²[Bombay High Court] Order dt. 12th August 2025 in IA (L) No. 32451 of 2024 in COMIP (L) No. 32272 of 2024

¹³ 2017 SCC Online Bom 9666

Defendant had been using the impugned trade mark in respect of INSURANCE SERVICES since 1996 through its predecessor Kataria Automobiles Pvt Ltd (KAPL), since 2002 through Kataria Motors Pvt. Ltd. and since 2011 through M/s Kataria Wheels.

30. Mr. Kane then submitted that the Defendant's plea of prior user, as taken in the Affidavit in Reply, was both misconceived and legally untenable. He pointed out that the alleged prior user relied upon by the Defendant was, firstly, not the Defendant itself but its so-called group companies, and secondly, was not in relation to insurance services at all. He submitted that any purported use of the name or mark "KATARIA" by entities other than the Defendant and that for services unrelated to insurance was wholly irrelevant to the present proceedings and cannot, in any manner, inure to the Defendant's benefit. He pointed out that each company is a separate legal entity, and any use by an independent legal entity cannot benefit the Defendant or be treated as use by the Defendant.
31. Mr. Kane then pointed out that the Defendant was admittedly incorporated in the year 2014, and hence, in the absence of any cogent and clear chain of title, any use of the impugned trademark/name "KATARIA" by any of the entities referred to in the Affidavit in Reply, namely Kataria Automobiles Pvt. Ltd., Kataria Motors Pvt. Ltd. and M/s Kataria Wheels, can neither be construed as the Defendant's use, nor can

a claim of prior user be made on the basis thereof. It is submitted that such alleged stray and isolated use by any entity (particularly in the absence of any written document/assignment) cannot be equated with the Defendant's own use, and hence the Defendant is not and cannot be considered a prior user of the impugned trade mark for the purpose of the Trade Marks Act. In support of his contention, he placed reliance upon the decision in the case of *T. G. Balaji Chettiar v. Hindustan Lever Ltd. Bombay*¹⁴ as also the decisions in the case of *Lords Inn Hotels & Developers Pvt. Ltd. v. Vikas Seth, Trading as Lords Residency*¹⁵, *Yogi Ayurvedic Products Pvt. Ltd. v. Vaishali Industries*¹⁶, *London Rubber Co. Ltd v. Durex Products Incorporated and Another*¹⁷, *Kores (India) Limited v. Whale Stationery Products Ltd.*¹⁸, *Kamat Hotels (India) Ltd. v. Royal Orchid Hotels Ltd.*¹⁹, *Tata Oil Mills Co. Ltd. V. M/s. Wipro Ltd. and Anr.*²⁰, *New Hope Food Industries (P) Limited v. Pioneer Bakeries (P) Limited*²¹, and *Grasim Industries Limited & Anr. v. Saboo Tor Private Limited & Ors.*²²

¹⁴ 1965 SCC OnLine Mad 69

¹⁵ [Bombay High Court] Order dated 05.03.2025 passed in IA/190/2025 in COMIP/247/2025

¹⁶ [Bombay High Court] Order dated 17.02.2025 passed in IA/1598/2023 in COMIP/45/2023

¹⁷ AIR 1963 SC 1882

¹⁸ 2008 (3) Mh.L.J. 523

¹⁹ 2011 (5) Bom C.R. 416

²⁰ AIR 1986 DELHI 345

²¹ MIPR 2008(1) 0173

²² [Bombay High Court] Order dated 16th October 2025 in IA No. 3888 of 2022

III. Non-Joinder of Kataria Automobiles Private Limited

32. Mr. Kane then pointed out that the Suit was also bad for non-joinder of Kataria Automobiles Private Limited ("KAPL"), who was the registered proprietor of the following trade marks in which the Defendant also had statutory rights:

Trademark	Registration No.	Date of Application	Class	User Details	Services
 KATARIA AUTOMOBILES LTD.	1462954	21/06/2006	35	01/01/1996	MARUTI CARS DEALERSHIP SHOWROOMS & ALL OTHER SERVICES INCLUDED IN CLASS 35.
 KATARIA AUTOMOBILES LTD.	1462955	21/06/2006	37	01/01/1996	CAR SERVICE CENTRE & ALL OTHER SERVICES INCLUDED IN CLASS 37.
 KATARIA LOGITRANS	1859016	07/09/2009	39	01/06/2006	TRANSPORT (TRANSPORTATION OF GOODS AND SERVICES NECESSARILY CONNECTED WITH SUCH TRANSPORT; AS WELL AS SERVICES RELATING TO THE STORING OF GOODS IN A WAREHOUSE OR OTHER BUILDING FOR THEIR PRESERVATION OR GUARDING).

Mr. Kane, however, submitted that there was a fundamental fallacy in the Defendants' contention since none of the aforementioned trade marks pertained to insurance-related services. He thus, without admitting that the KAPL was the registered proprietor of the above marks submitted that the Defendant, cannot take refuge of the said registrations obtained by KAPL since the same not only pertain to dissimilar services but were also in the name of a completely distinct legal entity

33. Mr. Kane then submitted that the Defendant's reliance on trade mark registrations standing in the name of "Kataria Automobiles Private Limited" (KAPL) was wholly misconceived. In support of his contention that a registration in a different class and, more importantly, in the name of a different legal entity, cannot constitute a valid defence, he placed reliance on the decision of this Court in *Mahindra & Mahindra Ltd. & Anr v. MNM Marketing Pvt. Ltd. & Anr*. He pointed out that, in that case, the irrelevant registrations were at least held by the Defendants themselves, whereas in the facts of the present case, the registrations were admittedly owned by an entirely separate and distinct legal entity. He thus submitted that the Defendant could not merely by asserting that KAPL was part of its group, appropriate or rely upon trade mark rights that purportedly vest exclusively in KAPL. He thus submitted that any registrations that

KAPL might have would not confer proprietary rights upon the Defendant.

34. Mr. Kane further pointed out that the Defendant was incorporated only in the year 2014 for the exclusive purpose of carrying on business related to insurance services. He therefore submitted that the services for which KAPL was stated to be using the name and mark "KATARIA" were entirely distinct from the insurance-related services offered by the Defendant. He submitted that since the Plaintiff's objection pertains solely to the Defendant's use of the impugned trade mark, corporate name, and domain name in relation to insurance services, there was no question of impleading KAPL, was a distinct entity engaged in completely different and unrelated services. Mr. Kane also submitted that, despite KAPL not being a party to the present Suit, the Defendant had sought to mischievously and in bad faith rely upon the alleged use of the name and mark "KATARIA" by KAPL in connection with wholly dissimilar services.

IV. Acquiescence and Delay and Laches

35. Mr. Kane then submitted that though the Defendant had alleged acquiescence, delay and laches on the part of the Plaintiff, these contentions were untenable. He first placed reliance upon the decision of

the Hon'ble Supreme Court in the case of *Midas Hygiene v Sudhir Bhatia*²³ to point out that in cases pertaining to copyright infringement, for the party against whom infringement was alleged.

36. Mr. Kane then submitted that in the facts of the present case, there was neither acquiescence nor delay and laches on the part of the Plaintiff. He pointed out that the Plaintiff had already objected to the incorporation of the Defendant in 2014, before the Registrar of Companies, Ahmedabad. Further, the Plaintiff had corresponded with Insurance Regulatory Development Authority of India (IRDA) to oppose the registration of the Defendant. Furthermore, the Plaintiff had sent out not one but two separate cease and desist notices to the Defendant one in the year 2014 and another in 2019. In the circumstances, the defence of acquiescence is *non est* as the Plaintiff had time and again objected to the use of the Defendant's trade mark. He then placed reliance upon the decision of this Court in the case of *Schering Corporation & Ors. v. Kilitch Co. (Pharma) Pvt. Ltd.*²⁴ to submit that if the Defendant, after notice, continues the infringing activity, the Defendant does so at its own peril and cannot raise the defences of delay and acquiescence.

²³ (2004) 3 SCC 90

²⁴ 1990 SCC OnLine Bom 425

37. Mr. Kane then submitted that the Defendant's conduct was tainted with mala fides. He pointed out that although the Plaintiff was copied on the ROC, Ahmedabad's letter dated 25th February 2014, informing the Defendant of the Plaintiff's objection to the adoption of the impugned corporate name, the Defendant thereafter did not copy or inform the Plaintiff in any of its subsequent correspondence with the ROC, including the letters dated 13th December 2013 and 27th March 2014. As a result, the Plaintiff was never made aware of the Defendant's response to the ROC or of the Defendant's continued use of the impugned name between 2014 and 2019. He submitted that had the Plaintiff been apprised of such communications, the Plaintiff would have replied on merits.

38. Mr. Kane further submitted that when the Defendant failed to respond to the Plaintiff's letter dated 3rd October 2014, and in the absence of any knowledge of the Defendant's ongoing correspondence with the ROC, the Plaintiff was under a bona fide belief that the Defendant had ceased using the impugned trade mark or corporate name and that it was only in the year 2019, upon discovering the Defendant's impugned website/domain name, that the Plaintiff realised that the misuse continued, prompting it to issue a second cease and desist notice and, thereafter, filed the present Suit.

39. Mr. Kane then relied upon the decisions in *Power Control Appliances v. Sumeet Machines (P) Ltd.*²⁵, *Hindustan Pencils Pvt. Ltd. v. M/s. India Stationary Products Co.*²⁶, *ITC Limited v. NTC Industries Limited*²⁷ and *Petrofer Chemie H. R. Fischer GMBH & Co. KG. & Anr. v. United Petrofer Limited*²⁸ to emphasise that mere delay or inaction does not amount to acquiescence and cannot, by itself, defeat an infringement claim. He submitted that acquiescence requires a positive act by the Plaintiff, i.e., something that encourages, assents to, or induces the Defendant's use of the impugned trade mark, leading the Defendant to alter its position to its detriment. Mere negligence, silence, oversight, or delay without such encouragement is insufficient. He further submitted that even where there is delay or laches, Courts generally do not deny an injunction if public confusion is likely, as consumer protection remains paramount. He submitted that therefore, unless a Defendant can show conscious encouragement by the Plaintiff and bona fide reliance on such conduct, the defence of delay or acquiescence cannot stand.

²⁵ (1994) 2 SCC 448: 1994 SCC OnLine SC 93

²⁶ AIR 1990 Delhi 19

²⁷ 2015 (64) PTC 244 [Bom]

²⁸[Bombay High Court] Order dated 06.11.2025 in IA No. 2143 of 2021

V. **Plaintiff has taken Contrary Stances**

40. Mr. Kane then pointed out that it was the Defendant's contention that the Plaintiff has taken inconsistent positions regarding the claim of user, of the Plaintiffs trade mark "KATARIA" since in the Plaint the Plaintiff had claimed user from the year 2004, however, in the letter dated 20th January 2014 addressed to ROC, the Plaintiff had claimed user from the year 2006. Mr. Kane clarified that there was infact no inconsistency since the Plaintiff's claim of use since 2004 related to the trading style "KATARIA INSURANCE CONSULTANCY", whereas the user claim of 2006 pertained specifically to the name/style "KATARIA JEWELLERY INSURANCE CONSULTANCY". He submitted that these were two distinct trading styles adopted at different points in time, which facts had been fairly disclosed. He thus submitted that the Plaintiff had not taken any contradictory stand as alleged or at all.

41. Mr. Kane then, pointed out that the Hon'ble Supreme Court had, in the case of *Midas Hygiene v Sudhir Bhatia* held as follows :

"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."

He submitted that the above findings were entirely apposite to the facts of the present case since the rival marks/names were identical. The rival services/businesses are also virtually identical. He thus submitted that a strong *prima facie* case of both infringement and passing off had been made out by the Plaintiff. He submitted that the Defendant had not provided any justification for adopting an identical name and mark and the adopting of the mark was plainly dishonest. Thus an injunction must follow.

42. Mr. Kane then placed reliance upon the decisions in the case of *Power Control Appliances & Ors. v. Sumeet Machineries Pvt. Ltd.*²⁹ and *UTO Nederland B.V. & Anr v/s Tilaknagar Industries Ltd and Tilaknagar Industries Ltd v/s Herman Jansen Beverages Nederland B.V. & Ors.*³⁰ submitted that if an injunction was not granted, it would amount to a situation whereby one mark, i.e., KATARIA, would have multiple sources, which would be antithetical to the basic canon of trade mark law, i.e., one mark, one source and one proprietor.

²⁹ (1994) 2 SCC 448

³⁰ 2025 SCC Online Bom 2658

REASONS AND CONCLUSIONS

43. Having heard Learned Counsel for the Plaintiff and having considered the pleadings, documents, and case law upon which reliance was placed, I am satisfied that the Plaintiff has made out a *prima facie* case and are entitled to interim relief for the following reasons.

A. It is well settled that to make out a case of infringement under Section 29 of the Trade Marks Act, a Plaintiff is required to establish (i) the existence of a valid registration, (ii) the impugned trade mark being identical or deceptively similar to the registered mark, and (iii) use of the impugned trade mark in relation to goods or services identical or similar to those for which the mark is registered. In the present case, there is no dispute that the Plaintiff is the registered proprietor of the word and device marks KATARIA in Class 36 for insurance-related services and that the Defendant is using the marks KATARIA INSURANCE, the domain name www.katariainsurance.co.in, and the corporate name KATARIA INSURANCE BROKERS PVT. LTD., all of which are identical or deceptively similar to the Plaintiff's marks. The Defendant's services are in the very field of insurance covered by the Plaintiff's registrations.

Accordingly, the Plaintiff has well established all the requisite ingredients to establish infringement under Section 29 of the Trade Marks Act.

B. As held by the Supreme Court in the case of *Laxmikant Patel v. Chetanbhai Shah*, to establish a case of passing off, a Plaintiff must show goodwill, misrepresentation, and likelihood of damage. In the present case, the Plaintiff has, *prima facie*, shown long, continuous, and extensive use of the mark "KATARIA" since 2004. The Plaintiff has also relied upon cogent material showing substantial turnover and promotional expenditure, which establishes the Plaintiff's goodwill. The rival marks and names are identical and used for the same services, making confusion inevitable and rendering the Defendant's misrepresentation implicit. It cannot be lost sight of that in the insurance industry, trust and reputation. Thus, any confusion would potentially result in damage or, a strong likelihood of damage.

C. The Defendant's plea that "Kataria" is a surname and constitutes bona fide adoption is also wholly untenable. Section

35 of the Trade Marks Act only applies to the person (private party) using their own surname and does not apply to incorporated entities that consciously choose their trade names. The decisions in the case of *Bajaj Electricals*, *Kirloskar*, *Mahindra & Mahindra*, and *Dr. Reddy's Laboratories* have all consistently held that when a mark has acquired distinctiveness and strong association with a specific trader or business group through long, continuous and extensive use, the goodwill of such mark will be protected against misuse. In the present case, the Plaintiff's mark "KATARIA" has, through long, continuous, and extensive use in the insurance sector, come to denote a single and identifiable source. Thus, the Defendant's adoption is therefore *prima facie* dishonest and not bona fide. Moreover, as reaffirmed in *Bal Pharma* and *Arochem Ratlam Pvt. Ltd.*, a Defendant who adopts a mark without conducting even a basic search does so at its own peril. In the present case, had the Defendant undertaken a search in the trade mark registry the same would have immediately revealed that the Plaintiff's mark "KATARIA" was registered in Class 36 in the year 2010.

The Defendant not having done so, the adoption of the impugned trade mark “KATARIA INSURANCE.” by the Defendant is thus *prima facie* negligent.

D. The Defendant’s plea of prior user is, in my view, wholly untenable. In the facts of the present case, not only is the alleged prior use by a separate and distinct legal entity namely KAPL, which the Defendant alleges is a group company but also is in respect of Kataria Automobiles Private Limited. Thus, the Plaintiff's reliance upon the decisions in the case of *T.G. Balaji Chettiar, Lords Inn, London Rubber, Kores, Kamat Hotels* which all lay down that the use of the impugned trade mark “KATARIA” in unrelated fields or by different entities cannot constitute prior user for purposes of defeating infringement or passing off is entirely apposite. Also, and *crucially*, the Defendant itself having come into existence only in the year 2014, use of the impugned trade mark “KATARIA” by distinct legal entities before that cannot inure to the benefit of the Defendant.

E. The Defendant's contention that KAPL is a necessary party is also wholly misconceived. The registrations, which are in KAPL's name and upon which the Defendant has placed reliance, fall under Classes 35, 37, and 39 and pertain exclusively to car dealerships, servicing, and transport services, fields that are entirely unrelated to insurance. As held in the case of *Mahindra & Mahindra v. MNM Marketing*, that the registration in class relating to services will be irrelevant in the dispute wherein the subject matter is registration in class relating to goods, and vice and versa. . In the present case, the Defendant uses the impugned trade mark for insurance services squarely falling in Class 36 and not for any of the goods and services covered under the Classes in which KAPL has valid registrations. Moreover, as already noted above, KAPL is a separate and distinct legal entity, and any trade mark rights vested in KAPL do not, and cannot absent a valid assignment, vest in the Defendant merely because the Defendant is part of an alleged group of companies.

F. The Defendant's plea of delay and acquiescence is wholly untenable. As held in the case of *Midas Hygiene*, delay alone can never defeat an action for infringement, especially when the adoption of the mark is dishonest. In the present case, the Plaintiff has consistently objected to the Defendant's use of impugned trade mark "KATARIA.". Thus, the conduct of the Plaintiff in the present case can, by no stretch of imagination amount to acquiescence. The Plaintiff's reliance upon the decisions in the case of *Power Control Appliances, Hindustan Pencils, ITC Ltd., Petrofer*, and *Wilmott v. Barber*; are therefore entirely apposite.

G. It is not in dispute that the Plaintiff is the registered proprietor and prior adopter of the trade mark "KATARIA.". The Plaintiff has established its goodwill and reputation by placing reliance upon the Chartered Accountant's Certificate that reflects the annual income of the Plaintiff as well as the annual promotional expenses from the year 2004-05 to 2017-18. The Plaintiff has also annexed the advertisement material showing use of the mark "KATARIA". The Defendant though having filed an Affidavit

in Reply has not appeared. Also *crucially*, the Defendant, in the Affidavit in Reply has not taken any substantive plea relating to hardship, if any that would be caused to the Defendant if an injunction were to be granted. Furthermore, the Plaintiff and the Defendant are using the respective marks for the same services, i.e., insurance. This is plainly antithetical to the canon principle of trademark law, which is one mark, one source as recognised in the case of *Power Control Appliances* and the *Tilaknagar*. Hence, given the similarity between the marks, continued use by the Defendant will inevitably lead to confusion, diversion of business, and dilution of goodwill and thus cause irreparable harm to the Plaintiff as also the consumer. Thus, the balance of convenience is entirely in favour of the plaintiff.

44. Hence, for the aforesaid reasons, the Plaintiff has made out a strong *prima facie* case, and the balance of convenience is in favour of the Plaintiff. I am satisfied that in the event an injunction as prayed for is not granted, not only would irreparable injury be caused to the

Plaintiff but also that the prejudice would be caused to the public at large.

45. In view of the foregoing discussion and for the reasons recorded hereinabove, I pass following order:

- (i) The Interim Application No.1663 of 2021 is made absolute in terms of prayer clauses (a) and (b) which are already reproduced above.
- (ii) In the facts and circumstances of the case, there shall be no order as to costs.

[ARIF S. DOCTOR, J.]