



IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
IN ITS COMMERCIAL DIVISION
INTERIM APPLICATION NO.820 OF 2021
IN
COMM IPR SUIT NO.1406 OF 2019

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Federal Express Corporation

...Applicant /
Plaintiff

Versus

Fedex Securities Private Ltd. & Ors.

...Respondents/
Defendants

Dr. Veerendra Tulzapurkar, Senior Counsel with Mr. Abhay J.V., Mr. Ameya Gokhale, Mr. Rishabh Jaisani, Mr. Dhruv Grover, Mr. Harit Lakhan and Mr. Abhineet Kalia i/b. Shardul Amarchand Mangaldas for the Applicant / Plaintiff.

Mr. Alankar Kirpekar, Mr. Shekhar Bhagat, Mr. Ayush Tiwari and Mr. Rajas Panandikar i/b. Shekhar Bhagat for the Defendants.

CORAM : R.I. CHAGLA J.

Reserved on : 25TH JULY, 2025.

Pronounced on : 11TH DECEMBER, 2025.

ORDER:-

1. By this Interim Application, the Applicant / Original Plaintiff has sought for an order of injunction restraining the Defendants from using / infringing / passing off the Applicant's trade mark "FEDEX" and for other consequential relief.

2. A brief background of facts is as under:-

(i) The Plaintiff is a corporation organized and existing under the laws of the State of Delaware, United States of America and is a global leader in providing transportation, e-commerce and business services to customers under its reputed and recognized brand known as FEDEX worldwide and in India.

(ii) On 17th April, 1973, the Plaintiff commenced its operations in providing services to customers and businesses for express transportation and delivery of their consignment under the trade mark / name FEDERAL EXPRESS.

(iii) The Plaintiff completed its first public offering of shares and has been listed on New York Stock Exchange under the ticker symbol FDX in 1978.

(iv) The Plaintiff surpassed USD 1 billion in revenues, making history as the first Company in USA to reach this financial hallmark within 10 years of start-up without mergers or acquisitions.

(v) The Plaintiff coined and adopted the trade mark FEDEX,

which was a natural and popular abbreviation of Plaintiff's trade mark / name FEDERAL EXPRESS. The Plaintiff obtained registration of the trade mark FEDEX in various jurisdictions such as Australia, New Zealand, Austria, Benelux, France, USA and UK.

(vi) The Plaintiff acquired Gelco Express International, Courier service and with it gained instant presence in 84 countries including India and propagated its name, branding and identity.

(vii) In 1985, the Plaintiff doubled its revenue and became a USD 2 billion corporation.

(viii) The Plaintiff registered its trademark in India in Classes 12, 16, 35, 38, 39 and 42 in the year 1986.

(ix) The Plaintiff registered its domain fedex.com on 26th February, 1991.

(x) The Plaintiff formerly adopted FEDEX as its primary brand and distinct symbol for its worldwide identity in the year 1994.

(xi) The Plaintiff launched the website www.fedex.com in the year 1994. This was the first transportation website to offer online

online package status tracking, enabling customers to discover news about FEDEX, check service availability, download FEDEX software, and trade their package as it moved through global network.

(xii) In 1996 the Plaintiff became the world's largest express company serving 211 countries and territories and connecting 99% of the world's economy. The Plaintiff's Annual Reports on record illustrate, prominent use of such FEDEX branding on or in relation to corporate identity and services on packaging, boxed, business papers, drop-box kiosks, etc. at least from 1990 onwards.

(xiii) The Defendant No.1 was originally incorporated in the State of Karnataka on 16th January, 1995 under the name of Beandaz Properties and Finvest Private Ltd. Defendant No.1 thereafter changed its name to FEDEX SECURITIES PRIVATE LIMITED on 15th March, 1996. It is pertinent to note that the registered office of Defendant No.1 was changed to Maharashtra from Karnataka on 26th August, 1996.

(xiv) Defendant No.2 was originally incorporated in the State of Karnataka on 5th February, 1996 under the name of Karadama

Resorts and Farms India Ltd. Its name was thereafter changed to FEDEX STOCK BROKING LIMITED in 2001. Defendant No.3 was incorporated under the name of FEDEX FINANCE LIMITED on 8th May, 1998. It is pertinent to note that Defendant No.3 was converted into a private limited company with the name changed to FEDEX FINANCE PRIVATE LIMITED on 31st March, 2010 and its registered office was changed from Karnataka to Maharashtra on 14th September, 2010.

(xv) The Plaintiff became the wholly owned subsidiary of the newly created FDX Corporation which was founded to oversee the operations of Plaintiff and its group of companies in the year 1998.

(xvi) The Plaintiff registered its domain name www.fedexindia.com on 4th November, 2003. Thereafter, the Plaintiff registered its domain name www.fedex.in on 11th February, 2005.

(xvii) The Plaintiff acquired Prakash Air Freight Private Ltd., (PAFEX), one of the largest domestic express companies operating in India and its service provider since 2002.

(xviii) The wholly owned subsidiary PAFEX was renamed FEDEX Express Services (India) Private Ltd. on 17th July, 2010 and which gave the Plaintiff opportunity to serve directly nearly 4400 destinations in the country.

(xix) The Defendant No.1 created the domain name www.fedexindia.in on 6th May, 2011.

(xx) The Plaintiff become aware of the unauthorized domain name 'fedexindia.in' having Plaintiff's registered and reputed trade mark FEDEX as the foremost feature in October, 2011. The Plaintiff found that the website was being controlled and operated by Defendant No.1 touting its business activities and that of its associate Companies viz. Defendant Nos.2 and 3.

(xxi) The Plaintiff sent a letter to the Defendants on 26th October, 2011 inter alia calling for cancellation of the impugned domain name, incorporating the trade mark FEDEX and seeking confirmation that they will not use FEDEX or any similar mark / name in relation to their business.

(xxii) The Defendants failed to respond to the notice. However,

they discontinued the website www.fedexindia.in but registered a new domain name fedsec.in, thereby acknowledging the Plaintiff's rights in the mark / name as contended by the Plaintiff.

(xxiii) The Plaintiff addressed two legal notices, dated 19th March, 2012 and 9th April, 2012 to the Defendants in view of the Defendants continued use of the trade mark / name FEDEX.

(xxiv) The Defendants responded to the legal notices on 11th April, 2012. They refused to comply with the requisitions of the notice, as according to them their activities did not overlap with those of the Plaintiff.

(xxv) The Plaintiffs sent a reply to the Defendants' response on 28th June, 2012.

(xxvi) The Plaintiffs through its Advocates informed the Defendants vide communication dated 11th January, 2013 that it was prepared to offer a reasonable time to change the impugned corporate names so as to delete FEDEX therefrom. This communication had been addressed in light of the proposed settlement between the Plaintiff and Defendants having failed.

(xxvii) On 1st February, 2013, the Defendants' counsel wrote to the Plaintiff's Counsel refusing to give up the mark / name inter alia stating that the reason for adopting FEDEX was that the founding Directors were all former employees of the Federal Bank and the name was a description of their past affiliation.

(xxviii) The Plaintiff filed a lawsuit for trade mark infringement and passing off before Delhi High Court under No.CS (OS) 2213 of 2014 on 25th July, 2014. The Single Judge of the Delhi High Court vide Order dated 11th April, 2017 returned the Plaint under Order VII Rule 10 of the Code of Civil Procedure, 1908 and granted Plaintiff liberty under Order VII Rule 10A of CPC to present the matter before this Court.

(xxix) The Plaintiff presented Plaint before this Court on 4th August, 2017 and the present Suit was registered on 28th November, 2019.

3. Dr. Veerendra Tulzapurkar, the learned Senior Counsel appearing for the Plaintiff has submitted that the claim of the Plaintiff is based on (i) infringement; (ii) passing off; and (iii) dilution of the Plaintiff's well known mark "FEDEX".

4. Dr. Tulzapurkar has submitted that the Plaintiff is the registered proprietor of the mark FEDEX in India from 1986 in respect of goods and services falling in Classes 12, 16, 35, 38, 39 and 42. He has submitted that the Plaintiff has a registration in Clause 36 bearing No.2418893 as of 29th October, 2012 in respect of Insurance Financial Affairs, Monetary Affairs etc. These registrations provide the Plaintiff the following rights under Section 27 of the Trade Mark Act, 1999 (“1999 Act”) : (i) exclusive right to use the said mark FEDEX; and (ii) to prevent any other party, including the Defendants, from using the said mark FEDEX or any other deceptively similar trademark.

5. Dr. Tulzapurkar has submitted that the Defendants name consists of the identical word ‘Fedex’ which is the impugned mark of the Plaintiff. The Defendants have added the word ‘Securities’. He has submitted that by addition of the word ‘Securities’, the Defendants cannot escape the infringement since the registered trademark of the Plaintiff namely ‘Fedex’ forms an essential part of the Defendants corporate name and / or trading style and which is identical with the Plaintiff’s registered trademark. He has submitted that the word “Securities” is not distinctive at all and the addition thereof does not

make any difference. He has placed reliance upon the judgment of the Supreme Court in *Ruston & Hornbey Ltd. Vs. Zamindara Engineering Co.*¹ in this context. The Supreme Court held that the addition of the word 'India' is of no consequence and the Plaintiff was entitled to succeed in the action for infringement.

6. Dr. Tulzapurkar has submitted that the Plaintiff's mark FEDEX is now also declared as a well known trademark as per the Journal No.2144 dated 19th February, 2024. The Plaintiff's mark FEDEX was always a well known mark in India from 1986 when it obtained first registration in Class 16. He has submitted that the aforementioned Notification enables the Plaintiff to file a Suit and make a claim under Section 29(5) of the 1999 Act to prevent any party from using the identical mark FEDEX or any mark deceptively similar thereto in respect of any goods and services.

7. Dr. Tulzapurkar has submitted that under the provisions of Section 29(4), the Plaintiff is required to establish that the Defendant has adopted the impugned mark without due cause and the Plaintiff's mark has reputation in India and by use of the impugned mark, the Defendant has taken unfair advantage of and/or

¹ AIR 1970 SC 1649.

such use is detrimental to the distinctive character or repute of the registered trademark.

8. Dr. Tulzapurkar has submitted that the Plaintiff has established that it had reputation and has produced material to show the extensive use of the mark and the Plaintiff's presence in India. He has submitted that the Defendants by using the impugned mark and / or trading name for which there is no due cause, the Plaintiff's case falls under Section 29(4) of the said Act. The adoption of the impugned mark and name by the Defendants is dishonest and the purported explanations given are untenable and there was no reason for adopting the impugned mark and trading name. By the explanation given for changing the original names in which the word "Fedex" was not there and by using the impugned mark and trading name, the Defendants are trying to show the connection with the Plaintiff and trade upon the Plaintiff's reputation. He has submitted that the impugned use is detriment to the distinctive character and repute of the Plaintiff's registered trademark. He has in this context placed reliance upon:-

(i) *RPG Enterprises Ltd. vs. Riju Kaushal*²;

² [(2022) 90 PTC 312], paragraphs 39 to 45.

(ii) *KSB Bombay Vs. KSB Real Estate* unreported judgment of Chandrachud J.³

(iii) *Kalpataru Properties Pvt. Ltd. vs. Kalpataru Hospitality & Facility Management*⁴ unreported judgment of Justice Vazifdar J.

(iv) *Rolex SA vs. Alex Jewellery Pvt. Ltd.*⁵

9. Dr. Tulzapurkar has submitted that Defendants contention that by reason of Section 159(5) of the 1999 Act, there is no infringement by use of the mark FEDEX is misconceived. He has submitted that this defence is unsustainable for more than one reason. Firstly, the said Section has no application in the facts of the case. Secondly, on a proper construction of the provisions of Section 159(5) what is permitted is a particular use which was not an infringement under the 1958 Act. Thirdly, the continued use in respect of services gives the Plaintiff a fresh cause of action.

10. Dr. Tulzapurkar has submitted that the Defendants have claimed that they have been using the impugned mark prior to the Plaintiff's registration, and prior to the 1999 Act coming into force.

³ [NMS 4019 of 2007 in Suit No. 2930 of 2007, order dated 11.2.2008], page 5.

⁴ NMS 3320 of 2010 in Suit No.2976 of 2010, dated 29.7.2011 in paragraphs 20 & 21.

⁵ 2014 (60) PTC 131 Delhi, paragraphs 33 to 40.

This overlooks the fact that the Plaintiff's mark is well-known mark and the Plaintiff is entitled to sue on the basis of their registered trademark in Class 36. The defence of the Defendants under 159(5) of 1999 Act is not tenable as the use by the Defendants after registration amounts to infringement. He has submitted that every use made by the Defendants of the impugned mark is a new use and is actionable under the 1999 Act. He has placed reliance upon judgment of the Supreme Court in ***Bengal Waterproof Ltd. vs. Bombay Waterproof Manufacturing Co. & Anr***⁶ at paragraph 10. The Supreme Court has observed that the use would give a recurring cause of action to the holder of the trademark to make a grievance about the same and that in the case of a continuing tort, a fresh period of limitation begins to run at every moment of the time during which the breach or the tort continues.

11. Dr. Tulzapurkar has submitted that Section 159 (5) of the 1999 Act does not give any right to the Defendants to continue to use the impugned mark. In the alternative he has submitted that Section 159(5) is not at all applicable.

12. Dr. Tulzapurkar has submitted that the words in Section

⁶ [(1997) 1 SCC page 99].

159(5) viz. “*a particular use of a registered trade mark*” is use centric. It provides that where a particular use of the registered trademark was not an infringement of a trademark registered before the commencement of the 1999 Act, then the continued use of that mark shall not be an infringement under the 1999 Act. He has submitted that the 1999 Act has for the first time included the following uses as amounting to infringement:-

(i) Import and export.

(ii) Use of the mark on business papers or in advertising [See Section 29(6)(c) and (d)].

(iii) Use resulting into dilution as provided in Section 29(8).

(iv) Use of the trademark by its oral words. [See Section 29(9)].

13. Dr. Tulzapurkar has submitted that aforesaid uses did not amount to infringement under the 1958 Act. He has submitted that if a Defendant was using the impugned mark prior to 1999 Act coming into force for the aforesaid uses, and continues to use the impugned mark for the same uses, his acts would not amount to infringement. He has submitted that the continued use in the instant case by the

Defendants in respect of financial services in respect of which the Plaintiff had got registration under the 1999 Act, the Defendants are committing infringement of the Plaintiff's registered trademark in respect of services in Class 36 and also of the Plaintiff's well known mark as provided in Section 29(2), (3), (4) and Section 29(8) of the 1999 Act.

14. Dr. Tulzapurkar has submitted that as the Plaintiff's mark is registered after the commencement of the 1999 Act, the rights conferred on the Plaintiff by such registration under Section 28 cannot be violated by the Defendants by using the impugned mark.

15. Dr. Tulzapurkar has submitted that in view of the provisions of Section 29 (2)(c) and 29(3) of the 1999 Act, this Court will presume that the use by the Defendants in respect of the services covered by the Plaintiff's registration or similar services, confusion on the part of the public is likely to arise. In the circumstances, therefore, the Plaintiff is entitled to get injunction to prevent the Defendants from using the impugned mark under Section 29(2), (3), (4) and (5) of the 1999 Act.

16. Dr. Tulzapurkar has submitted that the Defendants'

contention that the Plaintiff is not using its mark FEDEX in respect of financial services and therefore the Plaintiff is not entitled to injunction on the basis of infringement, is untenable. Firstly, the use by the Plaintiff of its registered trademark is not at all necessary to maintain an action for infringement. He has placed reliance upon the judgment of the Supreme Court in ***Gujarat Bottling Co. vs. Hindustan Coca Cola Ltd⁷*** at paragraph 11; and his submission that the Plaintiff's mark is a well-known mark.

17. Dr. Tulzapurkar has submitted that the use of a trading name which is deceptively similar to the Plaintiff's registered trademark also amounts to infringement under the 1958 Act. He has in this context placed reliance upon the following judgments :-

(i) ***Sarabhai International Ltd. vs. Sara Exports International⁸***. at paragraphs 10, 17, 18 and 21;

(ii) ***Poddar Tyres Ltd. vs. Bedrock Sales Corporation Ltd⁹***. at paragraphs 1, 33, 34 and 46;

7 [(1995) 5 SCC 545].

8 [1987 SCC OnLine Delhi 332].

9 [1992 SCC OnLine Bom. 273].

(iii) *Pizza Hut International LLC vs. Pizza Hutt India Pvt. Ltd.*¹⁰, at paragraphs 26 to 30;

(iv) *Mahendra & Mahendra Paper Mills Ltd. vs. Mahindra & Mahindra Ltd*¹¹. at paragraphs 5, 8, 9, 14, 15 and 25.

18. Dr. Tulzapurkar has submitted that the Plaintiff has in the context of passing off produced sufficient evidence to show that the said mark has acquired distinctiveness. He has submitted that the Plaintiff has shown the presence of the Plaintiff's mark in India since 1977. The Plaintiff has shown revenue as well as the awards received by the Plaintiff and has also produced articles from websites and magazines. The Plaintiff has also shown action taken by them against other infringers. The Plaintiff has also shown trans-border reputation and a tremendous reputation and distinctiveness of their mark FEDEX, and exclusive association thereof all over the world and India exclusively with the Plaintiff. The Plaintiff has also become a household word in India.

19. Dr. Tulzapurkar has submitted that the Defendants' use of the impugned mark is bound to deceive and cause confusion. The

¹⁰ [2002 SCC OnLine Bom. 688]

¹¹ [(2002) 2 SCC 147].

Defendants' use of the word FEDEX as part of their corporate names would result in the Defendants being considered as sister concern of the Plaintiff or a subsidiary of the Plaintiff and / or an agency of the Plaintiff. He has submitted that the Defendants are causing deception and confusion and are therefore liable to be enjoined from committing the tort of passing off.

20. Dr. Tulzapurkar has submitted that for considering the question of passing off, the Court has to consider whether the marks are deceptively similar and in arriving at such a decision, the Court has to consider the essential features of both the marks. He has in this context placed reliance upon following judgments :-

*(i) Hiralal Prabhudas vs. Ganesh Trading Co.*¹² at paragraphs 5 and 10;

*(ii) James Chadwick & Bros. vs. The National Sewing Thread Co. Ltd.*¹³ at paragraphs 10 to 13;

*(iii) Sabmiller India Ltd. vs. Jagpin Breweries Ltd.*¹⁴ at paragraph 5;

¹² [AIR 1984 Bom. 218]

¹³ [AIT 1951 Bom. 147]

¹⁴ [2014 SCC OnLine Bom. 4842]

(iv) *Reckitt & Coleman vs. Wockhardt Ltd*¹⁵ at paragraphs 8 to 10.

21. Dr. Tulzapurkar has submitted that the Supreme Court has determined the factors which are required to be taken into account in a passing off action. He has placed reliance upon decision of the Supreme Court in *Cadila Health Care Ltd. Vs. Cadila Pharmaceutical Ltd*¹⁶, at paragraphs 18 and 35 to 37. He has also relied upon the judgments of High Courts including of this Court which have also determined the factors to be taken into account in a passing off action and which judgments include, *Sunder Paramanand Lalwani Vs., Caltex (India) Ltd*¹⁷ paragraph 21 and 24; *Bata India Ltd. Vs. Pyare Lal & Co.*¹⁸ at paragraph 35; *Kirloskar Diesel Reacon (P) Ltd. Vs. Kirloskar Proprietary Ltd*¹⁹ at paragraph 13.

22. Dr. Tulzapurkar has submitted that passing off action is a broader remedy and is based on deceit, deception and confusion as held by the Supreme Court in *Syed Mohideen Vs., P. Sulochana Bai*²⁰ at paragraph 22.

15 Appeal No. 1180 of 1991 in Notice of Motion No. 2141 of 1991 in Suit No. 2970 of 1991 dated 8.7.1992.

16 (2001) 5 SCC 73.

17 1965 SCC OnLine Bom 151.

18 AIR 1985 Allahabad 242 @ 252.

19 1995 SCC OnLine Bom 312.

20 (2016) 2 SCC 683.

23. Dr. Tulzapurkar has submitted that there is no requirement to establish common field of activity in a passing off action and in this context has placed reliance upon *Kirloskar Diesel Reacon (P) Ltd. (Supra)* and *Mahendra and Mahendra Paper Mills Ltd. (Supra)*.

24. Dr. Tulzapurkar has submitted that the Defendants mark is phonetically identical with the Plaintiff's mark. He has submitted that the Plaintiff's mark is so well known that use by the Defendants is detrimental to the distinctiveness of the Plaintiff's mark. Such use by the Defendants would be without any reasonable cause, and there is likelihood of damage to the distinctive character of the Plaintiff's mark.

25. Dr. Tulzapurkar has submitted that the Defendants adoption of the mark is dishonest. The change of the corporate name and registration of Defendant No.3 with the word FEDEX is also dishonest. He has referred to the earlier names of the Defendants. The name of Defendant No.1 was changed in 1996. He has submitted that there was no justification for adopting the word FEDEX as a trademark or as a part of corporate name. He has submitted that the

Defendants when they changed their name and / or incorporated Defendant No.3 with the name Fedex Finance Ltd., they were aware of the Plaintiff's reputation.

26. Dr Tulzapurkar has submitted that the Defendants' registration of domain name FedexIndia.in in 2011 was with the knowledge of the Plaintiff's registration. If the Plaintiff had taken search, they would have found that the Plaintiff had registrations of the mark FEDEX from 1986. He has submitted that if the Defendants had not taken search before registering their domain name, then they were negligent and therefore the adoption by the Defendants of fedexindia.in is tainted. He has in this context placed reliance upon the judgment of this Court in *Bal Pharma Ltd. Vs. Centaur Laboratories Pvt. Ltd. and Anr*²¹.

27. Dr. Tulzapurkar has submitted that the explanation given by the Defendants for adoption of the word FEDEX viz. that founding directors of the Defendants were former employees of Federal Bank and thus the name FEDEX was chosen as a bonafide and honest description of their past affiliation is clearly an afterthought and implausible. He has submitted that FEDEX could

²¹ (2001) SCC OnLine Bom 1176.

not have been conceived by the Defendants to denote the former employee / executives of Federal Bank. He has submitted that from the Memorandum and Articles of Association of Defendant No.1, it can be seen that only one Director, Mr. Madhavan Kunniyur was, as claimed by the Defendants in their Written Statement, to be a former employee of Federal Bank.

28. Dr. Tulzapurkar has submitted that the Defendants have provided another explanation in paragraphs 12.3 to 12.5 of the Written Statement viz. that in 1995, Defendant No.1 in order to commemorate their previous association with Federal Bank adopted the name FEDEX and that the word FEDEX signifies former executives of Federal Bank. This explanation is implausible. He has submitted that it is pertinent to note that at the time of change of name, Suresh Madhavan Hegde and Sanjeev Krishnaji Shelgikar were the Directors of Defendant No.1 and none of these two claimed or were shown to be employees of Federal Bank. He has submitted that it is pertinent to note that in the resolution dated 5th February, 1996 by the Board of Directors for change of name or in the application filed before the Registrar of Companies on 6th February, 1996 for change of name, the reason for change in the name was not given.

29. Dr. Tulzapurkar has submitted that where the explanation is not honest and gives two different versions with different reasons, which reasons themselves are not proved, such explanation should be disregarded on the principle that things speak for themselves. It has to be held that in such cases, the adoption is dishonest. He has placed reliance upon the following judgments:-

(i) *Aktiebolaget Volvo of Sweden Vs. Volvo Steels Ltd. of Gujarat (India)*²², at paragraphs 82 – 84.

(ii) *Ciba Ltd. Vs. M. Ramalingam and S. Subramaniam*²³, at paragraphs 10 and 11.

30. Dr. Tulzapurkar has submitted if it is shown that the adoption of the mark is dishonest then, it becomes clear that the whole intent in adopting the mark was to cause deception and confusion. He has placed reliance upon the following judgments :-

(i) *Suzuki Motor vs. Suzuki (India) Ltd*²⁴. at paragraphs 55 to 58.

(ii) *Shering Corporation vs. Kilitch Co. (Pharma) Pvt. Ltd*²⁵.

22 1997 SCC OnLine Bom 578.

23 1957 SCC OnLine Bom.45.

24 [2019 (79) PTC 227 (Delhi)]

25 [1990 SCC OnLine Bom. 425.]

31. Dr. Tulzapurkar has submitted that as the conduct of Defendants is dishonest, they are not entitled to raise any equitable plea such as delay or acquiescence. He has submitted that the Plaintiff is entitled to injunction on the basis of dilution. He has submitted that the mark / name adopted by Defendants is being used to take unfair advantage and is against the reputation of the Plaintiff's registered trademark and is detrimental to its distinctive character. He has placed reliance upon following judgments :-

(i) *Hindustan Penciles Private Ltd. Vs. India Stationery Products Co*²⁶. at paragraphs 29 and 30.

(ii) *Kirloskar Diesel Recon Pvt. Ltd. & Anr. Vs. Kirloskar Proprietary Ltd. & Ors*²⁷.

32. Dr. Tulzapurkar has submitted that the Plaintiff became aware in October, 2011 about the Defendants' domain name Fedexindia.in. He has submitted that the Plaintiff by their letter dated 26th October, 2011 objected to the use of the said domain name. Thereafter, the Defendants changed the domain name to Fedsec.in. He has submitted that the Plaintiff upon making enquiries noticed

²⁶ ILR (1989) I Delhi 116.

²⁷ AIR 1996 Bom. 149.

the Defendants impugned mark / name on 19th March, 2012. He has referred to correspondence which ensued till 1st February, 2013 and thereafter the Plaintiff filed Suit in the Delhi High Court on 25th July, 2014. The Plaint was directed to be returned by an Order dated 11th April, 2017 passed by the Delhi High Court. The above Suit was accordingly filed on 4th August, 2017 and which was registered on 28th November, 2019. Thus, that there is no delay on the part of the Plaintiff.

33. Dr. Tulzapurkar has submitted that in any event delay is not a ground for denying injunctive relief. In this context he has placed reliance upon following judgments:-

(i) *Midas Hygiene Industries (P) Ltd. Vs. Sudhir Bhatia*²⁸ at paragraph 5.

(ii) *Anglo – French Drugs & Industries Ltd. Vs. Eisen Pharmaceutical Co. P. Ltd*²⁹ at paragraph 15.

(iii) *Hindustan Penciles Private Ltd. Vs. India Stationery Products Co*³⁰. at paragraphs 29 and 30.

28 (2004) 3 Supreme Court Cases 90.

29 1996 SCC OnLine Bom 580.

30 ILR (1989) I Delhi 116.

(iv) *Abdul Rasul Nurallah Virjee Vs. Regal Footwear*³¹ at paragraphs 116 to 121.

34. Dr. Tulzapurkar has submitted that the Defendants are not entitled to raise equitable pleas of acquiescence as their conduct in adopting the mark is dishonest. The Defendants have adopted their corporate name and the mark with full knowledge of the Plaintiff's reputation in India. The Defendants cannot raise the plea of acquiescence. He has placed reliance upon the judgment of the Chancery Division in *Willmott Vs. Barber*³² at paragraph 105. The equitable plea of acquiescence can only be raised if a Defendant has made an honest mistake in adopting the mark.

35. Dr Tulzapurkar has submitted that the Plaintiff has not at any point of time encouraged the Defendants but as soon as the Plaintiff became aware of the impugned use, the Plaintiff objected to the domain name and later to the corporate name and use of the trademark. He has placed reliance upon the following judgments :-

(i) *Power Control Appliances vs. Sumit Machines Pvt. Ltd*³³.,

³¹ 2023 SCC OnLine Bom 10.

³² L.R. 15 Ch.D. 96.

³³ 1994 (2) SCC 448.

(ii) *Beiersdorf A.G v Ajay Sukhwani and Another*³⁴, at paragraph 37.

(iii) *Atlas Cycles (Haryana) Limited v Atlas Products Private Limited*.³⁵,

(iv) *Jolen Inc. v Doctor & Company*.³⁶,

(v) *Abdul Rasul Nurallah Virjee and Jalalluddin Nurallah Virjee v. Regal Footwear*.³⁷,

36. Dr. Tulzapurkar has submitted that in view of the tremendous reputation acquired by the Plaintiff for which the Defendants were aware of at the time of adoption of the name, the Defendants cannot plead balance of convenience in their favour. He has submitted that given that the Defendants adoption itself is a dishonest, there is no question of allowing the Defendants to escape injunction on the basis of balance of convenience. This will amount to putting a premium on the Defendants' dishonesty. He has submitted that the Plaintiff's marks are registered and in an

³⁴ [2009 (39) PTC 38];

³⁵ [2008 (36) PTC 269].

³⁶ [2002 (25) PTC 29].

³⁷ [2023 SCC OnLine Bom 10].

infringement action, once a prima facie case is made out, injunction ought to follow.

37. Dr. Tulzapurkar has submitted that it is only in unusual circumstances, balance of convenience should play a part in a matter where the Plaintiff is the owner of a registered trademark. In any event, the balance of convenience of dishonest Defendants cannot allow them to escape the liability of infringement and passing off. He has in this context placed reliance upon the following judgments:-

(i) *Express Bottles Services P. Ltd. vs. PepsiCo Inc.*³⁸ at paragraph 17;

(ii) *Sabmiller India Ltd. vs. Jagpin Breweries Ltd*³⁹ paragraph 9.

38. He has accordingly submitted that the Plaintiff is entitled to the interim reliefs as prayed for and their Interim Application should be allowed with costs.

39. Mr. Alankar Kirpekar, the learned Counsel appearing for the Defendants has submitted that the present Suit is barred by law.

He has submitted that the Plaintiff cannot invoke the provisions of

³⁸ [(1991) 11 PTC 296]

³⁹ [2014 SCC OnLine Bom. 4842]

Sections 134 and 135 of the Trade Marks Act, 1999 to claim infringement and passing off in respect of its purported prior registered and well known trade mark 'FEDEX', in view of the bar enacted in Section 159(5) of the 1999 Act.

40. Mr. Kirpekar has submitted that admittedly under the 1958 Act, "Service Marks" were not registrable and there was no protection available under the said regime for service marks. He has submitted that any use of service mark was not amounting to trade mark infringement under the 1958 Act. He has placed reliance upon Section 28(1) and 29(1) of 1958 Act in this context. He has submitted that a combined reading of the aforesaid provisions demonstrates that the 1958 Act was protecting trade mark in relation to 'goods' only and not for 'services'.

41. Mr. Kirpekar has submitted that the Defendant Nos.1, 2 and 3 have all been incorporated prior to the enactment of the 1999 Act. He has submitted that in order to 'save' the businesses who are engaged in providing services from future infringement actions, "saving" in the form of Section 159(5) was provided for. He has submitted that intention of legislature is clear from the wording of

Section 159(5), which is to protect the service marks prospectively, while validating 'continued use of any conflicting service marks' under the 1958 Act.

42. Mr. Kirpekar has submitted that the continue use of the Defendants Corporate names are not an infringement as per provisions of Section 159(5) of the 1999 Act. He has submitted that the Defendants are engaging in providing merchant banking, stock broking and non-banking financial services which are completely different and distinct from the courier, cargo and transportation services and allied activities of the Plaintiff. He has submitted that it is self evident that the Plaintiff could not have invoked the provisions of Section 29 of the 1958 Act to assert infringement against the Defendants.

43. Mr. Kirpekar has submitted that the reliance placed by the Plaintiff on the judgment of *M/s. Bengal Waterproof Ltd. (Supra)* is misplaced as the said authority does not deal with the special provisions of Section 159(5) of the 1999 Act.

44. Mr. Kirpekar has submitted that each use amounting to 'new use' is also liable to be rejected as the legislature considered this

situation and used the phrase 'continued use'.

45. Mr. Kirpekar has submitted that any interpretation contrary to the legislature's clear intention would render the special 'saving' provision of Section 159(5) otiose, which is required to be avoided.

46. Mr. Kirpekar has submitted that without prejudice to the aforesaid contention viz. the Suit being barred for cause of action of infringement as per provisions of Section 159(5), the Suit even otherwise is not maintainable.

47. Mr. Kirpekar has referred to the Plaintiff's registrations of Trademark in Class 12, 16, 35, 36, 38 and 42 of the Fourth schedule of the 1999 Act. He has submitted that it is trite law that if the registered trade mark is used as part of the Company name then the governing law for deciding the infringement of trade mark is Section 29 (5) of the 1999 Act. The aforesaid registrations of the Plaintiff in various classes are not relevant as the Defendants are offering services falling within Class 36 under the Company name.

48. Mr. Kirpekar has submitted that since the use of the

Defendants was always in the trade name sense the relevant law is Section 29(5) and not Section 29(1), (2) and (4) of 1999 Act.

49. Mr. Kirpekar has in this context placed reliance upon ***Cipla Limited Vs. Cipla Industries Private Ltd. & Ors***⁴⁰. at paragraphs 1 to 6, 16 to 20, 24, 25, 30, 31, 33, 39 40 and 43. He has also placed reliance upon the judgment of this Court in ***Raymond Limited Vs. Raymond Pharmaceutical Private Limited***⁴¹ at paragraphs 3 to 6, 11-12, 34-35, 46, 48, 51, 53, 74 to 77.

50. Mr. Kirpekar has submitted that the Plaintiff's registration bearing registration No.2418893 in Class 36 pertains to trade mark "Fedex Trade Networks" which registration was applied on 29th October, 2012. The Application of the Plaintiff claims that the Plaintiff is using the said trade mark since 23rd October, 2009. He has submitted that for the sake of argument without admission it is accepted that the Plaintiff is using the said mark 'Fedex Trade Networks' in relation to services since the year 2009, the user is subsequent to the Defendants use of their company names. He has further submitted that as the Defendants are prior in point of time for

40 2017 (69) PTC 425 (Bom).

41 2017 (69) PTC 79 (Bom.)

adopting the company names / trade names, the Defendants are saved under the provisions of Section 34 of the 1999 Act.

51. Mr. Kirpekar has accordingly submitted that infringement action must fail having regard to clear statutory provisions.

52. Mr. Kirpekar has submitted that the Plaintiffs in so far as action of passing off is concerned, has admitted existence of Defendants since 1996. Having so admitted, the Plaintiff is required to show the existence of goodwill and reputation in India prior in point of time to the year 1996 to demonstrate that the adoption of the Defendants marks / names are in bad faith and / or for alleging passing off.

53. Mr. Kirpekar has submitted that the admission of the Plaintiff in paragraph 15 of the Complaint goes to root of matter that Plaintiff was not using the expression FEDEX in relation to its business anywhere till the year 1994.

54. Mr. Kirpekar has submitted that though in paragraph 14 of the Complaint, the Plaintiff claims the adoption of the mark in 1984,

the Annual Reports of the Plaintiff referred to in the said paragraph do not show any use of the mark 'FEDEX' till 1994.

55. Mr. Kirpekar has submitted that the first use of expression FEDEX according to Plaintiff is in USA in the year 1994. The Defendant No.1 was named as FEDEX SECURITIES PRIVATE LIMITED on 20th February, 1996. He has submitted that there is absolutely nothing on record to show that during such period of less than two years the name FEDEX had acquired goodwill and reputation in India.

56. Mr. Kirpekar has submitted that the Plaintiff's alleged India presence shows nothing but only agreements and not actual use of mark. He has submitted as per the Plaintiff's own case it started its operations in India post 1997.

57. Mr. Kirpekar has submitted that the Plaintiff though relying upon the revenue and shipment details, these are supported by any documentary evidence. He has submitted that this has been disputed by the Defendants and despite which no proof was produced at the time of hearing.

58. Mr. Kirpekar has submitted that the Defendants have produced on record the details to show that the Directors of Defendants are the former Executives of the Federal Bank, who came up together and started the venture. The term FEDEX is derived from FEDERAL EXECUTIVES. He has submitted that the adoption and use of the Defendants Company name is not at all to take advantage of name of Plaintiff as the Plaintiff was admittedly not in such business of merchant banking and financial services in the year 1996 nor conducting business as a merchant banker till date.

59. Mr. Kirpekar has submitted that the Plaintiff has no goodwill and reputation in India in 1996. In view of the same Plaintiff cannot make frivolous allegations of dishonest adoption by the Defendants. He has placed reliance upon the judgment of the *Toyota Jidosha Kabushiki Kaisha Vs. Prius Auto Industries Ltd. and Ors*⁴², paragraph 23.

60. Mr. Kirpekar has submitted that the Plaintiff has grossly misrepresented the fact that the Defendants did not respond to the Plaintiff's legal notice dated 26th October, 2011. He has submitted that 'INNOVINS', the Defendants 'WHOIS' contact had forwarded the

⁴² AIR 2018 SC 167.

said legal notice to the Defendants on 31st October, 2011. On 4th November, 2011, Mr. V. Krishnadas, the Director of the Defendants acknowledged receipt of the said legal notice dated 26th October, 2011. The said email dated 4th November, 2011 was acknowledged by Mr. Brown of the Plaintiff Company vide email dated 7th November, 2011. Thereafter, Mr. V. Krishnadas vide email dated 2nd December, 2011 informed Mr. Brown that the Defendants have used the name FEDEX for more than 12 years and are rendering financial services which are different from the Plaintiff's courier services and that the Defendants do not intend to undertake any activity similar to that of the Plaintiff. However, Mr. V. Krishnadas informed Mr. Brown that in view of the request made by Mr. Brown and as a gesture of goodwill, the Defendants have decided to discontinue use of their registered domain 'fedexindia.in'. The Defendants received an auto response from Mr. Brown on 2nd December, 2011, confirming the receipt of the said e-mail dated 2nd December, 2011.

61. Mr. Kirpekar has submitted that since then the Defendants are using entirely different domain name www.fedsec.in. The Defendants undertake to use the webpages which bear the reference to the Defendants as Fedsec and not Fedex.

62. Mr. Kirpekar has submitted that the Defendants have annexed documents which shows actual usage of Defendants name in the course of trade. Such usage is honest and in accordance with laws of India.

63. Mr. Kirpekar has submitted that the Plaintiff has failed to meet the requirements of passing off by showing classical trinity i.e. goodwill and reputation, misrepresentation and irreparable loss. Hence, the Suit must fail for passing off.

64. Mr. Kirpekar has submitted that the Plaintiff has not shown any ground on which, the Plaintiff can be held to be entitled for grant of injunction against the Defendants who are openly, honestly and bonafidely conducting their business since 1996. He has submitted that the Plaintiff has failed to demonstrate how the business for providing financial services of Defendants would be detrimental to the entirely different business of transportation and cargo of the Plaintiff. He has submitted that there is not a single incidence of confusion that too place in last approximately 30 years which demonstrates that, the filed of activity of Plaintiff and Defendants are entirely different. He has submitted that the balance

of convenience is in favour of Defendants.

65. Mr. Kirpekar has submitted that the existence of the Defendants entities and their businesses are not causing any loss, much less, irreparable loss to the Plaintiff. He has submitted that the contention of dilution is infact imaginary. He has submitted that the existence of Specialized Financial Services under the Defendants company name will not be of any detriment to the Plaintiff.

66. Mr. Kirpekar has submitted that the judgments relied upon by the Plaintiff are distinguishable having regard to the facts and circumstances of the present case. None of the judgments relied upon by the Plaintiff deals with the specific defense raised by the Defendants in the present case. No authority cited by the Plaintiff which deals with Section 159 (5) and the case laws in relation to law relating to pass off are based on entirely different facts and circumstances, hence, the same are not required to be commented upon.

67. Mr. Kirpekar has accordingly submitted that the present Interim Application be dismissed with costs.

68. Having considered the submissions, the main defense of the Defendants to the interim relief sought for by the Plaintiff in respect of its registered and well known trademark 'FEDEX' is that the Suit filed by the Plaintiff is barred by law. The Defendants have placed reliance upon Section 159(5) of the 1999 Act. It is necessary to reproduce this Section which is as under:-

“159(5) : Notwithstanding anything contained in this Act, where a particular use of a registered trademark is not an infringement of a trademark registered before the commencement of this Act, the continued use of that trademark shall not be an infringement under this Act.”

69. Section 159(5) has in my considered view no application to the present Suit. This section is a savings clause (part of repeal and savings under the 1999 Act) which saves the continued use of a particular use which was not an infringement under the 1958 Act. The Defendants contend that there is no infringement by their continuous use of the impugned mark FEDEX as part of their Company name which use was prior to the 1999 Act by reason of Section 159(5) of the 1999 Act. The Defendants were engaged in providing financial services and service marks were for the first time introduced under the 1999 Act. This contention of the Defendants is

in my view misconceived. The Plaintiff is entitled to sue on the basis of its registered trademark in Class 36 as well as on the basis that the Plaintiff's mark is regarded as well-known mark by the Trademark Registry. Any use by the Defendants after registration of the Plaintiffs mark in Class 36 amounts to infringement.

70. In *M/s. Bengal Waterproof Ltd. (Supra)*, which has been relied upon by the Plaintiff, the Supreme Court has held that, *"Wherever and whenever fresh deceitful act is committed, the person deceived would naturally have a fresh cause of action in his favour"*. The Supreme Court has observed that the use would give a recurring cause of action to the holder of the trademark to make a grievance about the same. The Defendants cannot take advantage of the provisions of Section 159(5) to continue to use the impugned mark.

71. Under Section 159(5), the words used are, "a particular use of a registered trade mark". It provides that the particular use of the registered trademark which was not an infringement of the trademark registered before the commencement of the 1999 Act, then the continued use of that mark shall not be an infringement under the 1999 Act. The Plaintiff has referred to the uses which were

for the first time introduced by the 1999 Act and which amounted to infringement. These include: (i) import and export, (ii) use of the mark on business papers or in advertising, (iii) use resulting into dilution and (iv) use of the trademark by its oral words.

72. The aforementioned uses did not amount to infringement under the 1958 Act. Thus, if the Defendant was using the impugned mark prior to the 1999 Act coming into force, for the aforesaid uses, and continues to use the impugned mark for the same purposes, his acts would not amount to infringement. In the present case, the continued use of the impugned mark by the Defendants for financial services, in respect of which the Plaintiff has got registration under the 1999 Act, would not be saved by Section 159 (5) of the 1999 Act. The Defendants are committing infringement of the Plaintiff's trademark registered in respect of Class 36. I find much merit in the submission on behalf of the Plaintiff that the escape route is available only when the Plaintiff's mark was registered prior to the commencement of the 1999 Act. The Plaintiff's mark having been registered after the commencement of the 1999 Act, the rights conferred on the Plaintiff by said registration under Section 28 cannot be violated by the Defendants using the impugned mark.

73. Further, the contention of the Defendants that the Plaintiff is not using its mark FEDEX in respect of the financial services and therefore, the Plaintiff is not entitled to injunction on the basis of infringement, is untenable. The use by the Plaintiff of its registered trademark has been held in ***Gujarat Bottling Co. (Supra)***, to be not necessary to maintain an action for infringement. In any event, the Plaintiff's mark is well known trade mark as per Journal No.2144 dated 19th February, 2024.

74. The Defendants name consists of the identical word FEDEX which is the mark of the Plaintiff. The Defendants have merely added the word 'Securities'. It has been held in ***Ruston & Hornbey (Supra)*** that mere addition, in that case 'India' is of no consequence and the Plaintiff was entitled to succeed in the action for infringement. Here in the present case also, the word 'Securities' is not distinctive at all and the addition thereof does not make any difference.

75. The explanation given by the Defendants for adoption of word "Fedex" is that the founding directors of the Defendants were former employees of Federal Bank and that the name Fedex was

chosen as a bonafide and honest description of their past affiliation, is unacceptable. Fedex could not have been conceived by the Defendants to denote the former employees / executives of Federal Bank. The Plaintiff has been able to show from the Memorandum and Articles of Association of Defendant No.1, that only one director Mr. Madhavan Kunniyur was, as claimed by the Defendants, to be a former employee of Federal Bank. The other explanation given by the Defendants in their Written Statement is that in 1995, Defendant No.1 in order to commemorate their previous association with Federal Bank adopted the name FEDEX and that the word FEDEX signifies former executives of Federal Bank. This explanation appears to be an afterthought and is implausible. The Defendant No.1 had at time of change of name, only Suresh Madhavan Hegde and Sanjeev Krishnaji Shelgikar as Directors and none of them claimed or were shown to be employees of Federal Bank. It is pertinent to note that in the Resolution dated 5th February, 1996 of the Board of Directors for change of name or in the application filed before the Registrar of Companies on 6th February, 1996 for change of name, this reason for change of name was not given.

76. It is well settled that where explanation for adoption of

the mark is not honest and there are two different versions with different reasons and which reasons themselves are not proved, such explanation should be disregarded on the principle that things speak for themselves. The decisions cited by the Plaintiff viz. *Aktiebolaget Volvo of Sweden (Supra)* and *Ciba Ltd. (Supra)* are apposite.

77. Further, it has been held in *Suzuki Motor (Supra)* and *Shering Corporation (Supra)* relied upon by the Plaintiff that where the adoption of the mark is itself dishonest then it becomes clear that the whole intent in adopting the mark was to cause deception and confusion.

78. The Defendants have contended that where the registered trademark is used as part of the Defendants Company name then the governing law for deciding infringement of trade mark is Section 29 (5) of the 1999 Act and under that provision it would not amount to an infringement as the Defendants are not dealing in goods or services in respect of which the trademark is registered. This is on the premise that such use by the Defendants did not amount to infringement under the 1958 Act. This contention has lost sight of the settled law that use of a trading name which is deceptively

similar to the registered trademark also amounted of infringement under the 1958 Act. This has been held in the judgments relied upon by the Plaintiff viz. *Sarabhai International Ltd. (Supra)*, *Poddar Tyres Ltd. (Supra)*, *Pizza Hut International LLC (Supra)* and *Mahendra & Mahendra Paper Mills Ltd. (Supra)*.

79. The Plaintiff has produced sufficient evidence to show that the said mark has acquired distinctiveness. The Plaintiff has shown the presence of its mark in India since 1977. The Plaintiff has also shown its trans-border reputation from the public recognition of the Plaintiff in publications which have been mentioned in the Plaint. The Plaintiff has in my prima facie view been able to establish tremendous reputation and distinctiveness of their mark FEDEX and its exclusive association thereof all over the world and in India. FEDEX has become a household word in India.

80. The Defendants use of the impugned mark is bound to deceive and cause confusion. The Defendants are using the word Fedex as part of their corporate names and by doing so causing deception and confusion as there is a likelihood of the Defendants being considered as sister concerns of the Plaintiff and / or a

subsidiary of the Plaintiff and/or an agency of the Plaintiff. In a case of passing off, the Court has to consider whether the marks are deceptively similar and to arrive at a such decision, the Court has to consider the essential features of both marks. Reference can be made in this context to the judgments relied upon by the Plaintiff viz. *Hiralal Prabhudas (Supra)*; *James Chadwick & Bros. (Supra)*, *Sabmiller India Ltd. (Supra)* and *Reckitt & Coleman (Supra)*.

81. The Supreme Court as well as other Court including this court have laid down the factors which are required to be taken into account in a passing off action. These judgments have been relied upon by the Plaintiff and include, *Cadila Health Care Ltd. (Supra)*, *Sunder Paramanand Lalwani (Supra)*, *Bata India Ltd. (Supra)* and *Kirloskar Diesel Reacon (Supra)*.

82. It has been held in *Syed Mohideen (Supra)* that passing off action is a broader remedy and is based on deceit, deception and confusion. There is no requirement to establish common field of activity in a passing of action as held in *Mahendra & Mahendra Paper Mills Ltd. (Supra)*.

83. The Defendants mark being phonetically identified with

the Plaintiff's mark as well as the Plaintiff's mark being so well-known, any use by the Defendants of the impugned mark is detrimental to the distinctiveness of the Plaintiff's mark and would cause damage to the distinctive character of the Plaintiff's mark.

84. The contention of the Defendants that there has been delay and acquiescence on the part of the Plaintiff, is in my view misconceived. In any event, mere delay is not a ground for denying injunctive relief as held in *Midas Hygiene Industries (P) Ltd. (Supra)*, *Anglo – French Drugs & Industries Ltd. (Supra)*, *Hindustan Penciles Private Ltd. (Supra)* and *Abdul Rasul Nurallah Virjee (Supra)*, judgments relied upon by the Plaintiff. Having arrived at prima facie view that the Defendants have dishonestly adopted their corporate names and mark with full knowledge of the Plaintiff's reputation in India, they are not entitled to raise a plea of acquiescence. Further, the Plaintiff has not at any time encouraged the Defendants to use the impugned mark. As soon as the Plaintiff became aware of the impugned use, the Plaintiff objected to domain name and later to the corporate names and use of the trademark. Hence, the Plaintiff cannot be said to have acquiesced in the use of the impugned mark by the Defendants. The judgment of the Supreme Court in *Power*

Control Appliances (Supra) is apposite.

85. The Plaintiff has been able to make out a strong prima facie case for grant of interim relief. The balance of convenience is also in favour of the Plaintiff. This, in view of the prima facie finding that there are malafides on the part of the Defendants in their adoption of the impugned mark. The Plaintiff's mark is registered and in an infringement action, once a prima facie case is made out, injunction ought to follow.

86. The Plaintiff is thus entitled to grant of interim relief and irreparable loss will be caused to the Plaintiff, in the event interim relief is not granted.

87. Accordingly, interim relief is granted in terms of prayer Clauses (a), (b) and (c) of the Interim Application, which read as under:-

“(a) that pending the final hearing and disposal of the Suit, pass an order of temporary Respondents / Defendants, their injunction directors, restraining promoters. shareholders, officers, managers, assigns, successors-in-interest, licensees, franchisees, subsidiary / associate /group companies, sister concerns, representatives, servants, distributors, agents. family members, employees, etc. and / or any

person or entity acting for them from using / infringing Applicant's / Plaintiff's trade mark FEDEX or any other word(s) deceptively similar thereto singularly or in conjunction with any other words or monogram / logo, as a trade mark, service mark, corporate name, trade name, trading style, domain name, website address, electronic mail identity or in any other manner whatsoever; on or in relation to or any services / business including advertising, business papers, website, etc.;

(b) that pending the final hearing and disposal of the Suit, pass an order of temporary injunction restraining Respondents Defendants, their directors, promoters, shareholders, officers, managers, assigns, successors-in-interest, licensees, franchisees, subsidiary / associate / group companies, sister concerns, representatives, servants, distributors, agents, family members, employees, etc. and/or any person or entity acting for them from passing off their services/business as or for the services / business of Applicant's / Plaintiff from using Applicant's/Plaintiffs FEDEX trade mark(s)/name or any other word(s) deceptively similar thereto singularly or in conjunction with any other words or monogram/logo, as a trade mark, service mark, corporate name, trade name, trading style, domain name, website address, electronic mail identity or in any other manner whatsoever, on or in relation to or any services / business including advertising business papers, website, etc.;

(c) that pending the final hearing and disposal of the Suit, pass Respondents / Defendants, restraining their directors, promote (c) order of temporary injunction family members, employees, etc. and / or any person or entity licensees, franchisees, subsidiary / associate /group companies shareholders, officers, managers, assigns, successors-in-interest sister concerns, representatives, servants, distributors,

agents acting for them from applying for and / or obtaining registration from any competent body or Government authority for FEDEX or any other word(s) deceptively similar thereto singularly or in conjunction with any other words or monogram/logo in respect of any trade mark, trade/corporate name, domain name copyright registration or an other manner whatsoever and/or for the purposes of using the same as a trade mark, service mark, trading style, corporate name, name of a business entity such as a firm or a partnership, website / domain and / or email address and the like;"

88. The Interim Application is accordingly disposed of. There shall be no order as to costs.

[R.I. CHAGLA J.]

89. Upon this judgment and Order being pronounced, the learned Counsel for the Respondents / Defendants has sought for stay in order that they may avail of their appellate remedy.

90. This application for stay has been opposed by the learned Counsel for the Applicant / Plaintiff.

91. In order to give the Respondents time to comply with this judgment and order and /or to avail of their appellate remedy, if they so desire, the operation of this judgment and order is stayed for a period of six weeks.

[R.I. CHAGLA J.]