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

\+ CS(COMM) 587/2022

DOMINOS IP HOLDER LLC & ANR.....Plaintiffs
Through: Mr. Pravin Anand, Mr. Shantanu Sahay, Ms. Imon Roy and Ms. Vareesha Irfan, Advs.

versus

MS DOMINICK PIZZA & ANR.....Defendants
Through: None

CORAM:
HON'BLE MR. JUSTICE C.HARI SHANKAR

% **JUDGMENT (ORAL)**
26.09.2023

1. Plaintiff 1 is a Limited Liability Corporation incorporated in Delaware and having its office at Michigan, USA. It owns and manages the intellectual property of Domino's Pizza, Inc. including the trademarks "Domino's Pizza", which the plaintiffs assert in the present case. Plaintiff 1 licensed its trademarks and other intellectual property to Domino's Pizza International Franchising Inc., who entered into a Master Franchise Agreement with Plaintiff 2 Jubilant Food Works Limited, to operate Domino's franchises in India.

2. The Master Franchise Agreement also obligated Plaintiff 2 to assist Plaintiff 1 in enforcement of the intellectual property rights of Plaintiff 1 in India. For the purpose of protection of intellectual property rights, therefore, the plaint asserts that the plaintiffs operate as a single economic entity.

3. The gestational origin of Domino's Pizza may be traced to 1960 in which year Tom Monaghan and his brother James purchased "DomiNick's Pizza", a pizza store owned by Mr. Dominick DiVarti in Michigan, USA. The Monaghan brothers changed the name of the entity to Domino's Pizza in 1965, in which year the following distinctive logo, which has subsequently become a source identifier of the plaintiff, was devised by them:

4. The plaint contains various assertions about the plaintiffs which, as they have not been traversed by the defendants, may be treated as admitted. As of date, Domino's is one of the world's leading pizza and fast food restaurant chains, having expanded its operations to over 90 countries, with over 19,200 stores worldwide. The global retails sales figures of Domino's aggregated over to US$ 17.8 billion in 2021 and US$ 4 billion in 2022. The  logo has been used by the plaintiffs continuously and has, therefore, achieved distinctiveness. It now operates as a source identifier of Domino's Pizza.

5. Consequent to grant of franchise to Plaintiff 2, the plaintiffs commenced operations in India in 1996, when the first Domino's Pizza outlet was opened in New Delhi. As on the date when the suit was filed, the plaintiffs were operating 1,567 outlets in over 337 cities across the country. Plaintiff 2 also operates a website

www.jubilantfoodworks.com. Globally, the plaintiffs work through the India centric website www.dominos.co.in.

6. The plaintiffs claim to have over 6 million followers on Facebook and over 1,40,000 followers on Twitter. The mobile app of the plaintiff has been downloaded over 127 lakh times. Towards promotion of their activities, the plaintiffs expended, in the year 2017-18 alone, over ₹ 132.75 crores, with over ₹ 674.66 crores having been expended between 2011 and 2018. Through sales of their products, in India alone, the plaintiffs have earned, between 2011 and 2018, ₹ 13813.42 crores with ₹ 2916.8 crores having been earned in the year 2017-18 alone. The figures provided are till the year 2018 when the suit came to be filed.

7. The plaint asserts that the mark "Domino's", with the distinctive  logos, featuring faces of a domino, are unique, coined and arbitrary, and that the word "Domino's" has no etymological significance bearing any relation to the services provided under the said mark. By virtue of their being distinctive and arbitrary, the plaint asserts that the mark is entitled to additional intellectual property protection.

8. In India, the plaintiff is the proprietor of the following registered trademarks:

Application No.	Trademark	Application date	Class
463304	DOMINO'S	19/11/1986	30

572312		30/04/1992	30
1238053		18/09/2003	42
1238054		18/09/2003	39
2145011		16/05/2011	29, 30, 39 & 43
2145001		16/05/2011	29 & 30
2145008		16/05/2011	29 & 30
2145009		16/05/2011	29, 30, 39 & 43

9. Para 18 of the plaint also provides details of various orders passed by this Court, protecting the intellectual property rights of the plaintiffs.

10. Defendant 1 provides pizza and fast food services identical to

those of the plaintiffs, under the name DOMINICK PIZZA and the logo 

. Defendant 1 has also replicated the plaintiffs' registered trademarks "CHEESE BURST" and "PASTA ITLAIANO" for different varieties of the food items served by it. The plaintiffs claim to have come to learn of the Defendant 1's activities in January 2020, whereafter an investigation revealed that the Defendant 1 was also running the website www.dominickpizza.com and the Facebook page https://www.facebook.com/dominickpizza/?ref=br_rs. Defendant 1 also applied for registration of the device mark 

on 15 June 2016, but has been unable to secure registration as the Trademark Registry has objected to the application on the ground that it is identical or similar to the plaintiffs' marks "Domino's Pizza" and the Plaintiffs' device marks 

and 

. In April 2021, Defendant 1 applied to the Trademark Registry for withdrawal of its trademark application but, later, in August 2021, withdrew the withdrawal letter through another Counsel.

11. The plaint asserts that pre-litigation mediation was also attempted by the plaintiffs, which had to be closed as a non-starter on 4 April 2022 as Defendant 1 failed to attend the mediation sessions. However, consequent thereon, Defendant 1's website www.dominickpizza.com was pulled down. The plaint avers that, in these circumstances, the plaintiffs were under the impression that

Defendant 1 was discontinuing its activities. It was only in June/July 2022 that the plaintiffs came to know that Defendant 1 was continuing its activities over the online food ordering platform Zomato. The plaintiffs have also placed on record a complaint by a customer Nitin Warikoo, on Google reviews, on which the customer complained of having been confused between the Defendant 1 and the plaintiffs because of the use of a deceptively similar name.

12. Defendant 1, thereafter, started a new website www.dominickpizzaS.com on 16 April 2021. It is further alleged that Defendant 1 was also franchising its business and that outlets of Defendant 1 have now spread to Ghaziabad, Noida, Delhi and various locations in Punjab.

13. In these circumstances, the plaint alleges that defendant has infringed the plaintiffs' registered trademarks and has also, by using a deceptively similar mark, sought to pass off the services provided by it as those of the plaintiff. The plaintiffs have, therefore, instituted the present suit, praying thus:

> "47. It is, therefore, respectfully prayed that this Hon'ble Court may be pleased to grant the following reliefs:
>
> a) An order for permanent injunction restraining the Defendant No. 1, its proprietors, partners, directors, officers, servants, agents, franchisers and all others acting for and on its behalf from advertising, selling, offering for sale, marketing etc. any product, packaging. menu cards and advertising material, labels, stationery articles, website or any other documentation using, depicting, displaying in any manner whatsoever, the marks "Dominick Pizza",

or any other mark which is identical or deceptively similar to the Plaintiff's registered trademarks as detailed in paragraph 13 in any manner whatsoever, amounting to infringement of the Plaintiff's trademarks, specifically as registered under Trade Mark application numbers - 463304, 572312, 1238053, 1238054, 2145011, 2145001, 2145008 and 2145009;

b) An order for permanent injunction restraining the Defendant No. 1, their proprietors, partners, directors, officers, servants, agents, subsidiaries, holding companies, sister concerns, family members, franchisers and all others acting for and on their behalf from advertising, selling, offering for sale, exporting, importing, manufacturing, marketing etc. any product, packaging, menu cards and advertising material, labels, stationery articles, website or any other documentation using, depicting, displaying in any manner whatsoever, the marks "Dominick Pizza",  or any other mark which is identical or deceptively similar to the Plaintiffs' trademark "Domino's Pizza", as well as "Cheese Burst", "PASTA ITLAIANO" in any manner whatsoever, so as to cause confusion or deception leading to passing off of the Defendant No. 1's products and services as those of the Plaintiffs;

c) An order for permanent injunction restraining the Defendant No. 1, their proprietors, partners, directors, officers, servants, agents, subsidiaries, holding companies, sister concerns, family members and all others acting for and on their behalf from advertising, selling, offering for sale, exporting, importing, manufacturing, marketing etc. any product, packaging, menu cards and advertising material, labels, stationery articles, website or any other documentation using, depicting, displaying in any manner whatsoever, the marks "Dominick Pizza"  or any other mark which is identical or deceptively similar to the Plaintiffs' trademark "Domino's Pizza", as well as "Cheese Burst", "PASTA ITLAIANO" in any manner whatsoever, so as to cause dilution or tarnishment of the Plaintiff's trademark and packaging;

d) An order for delivery-up to the Plaintiffs, of all

infringing products, packaging, signage, menu cards and advertising material, labels, stationery articles and all other infringing documentation bearing the impugned marks "Dominick Pizza",  or any other mark which is identical or deceptively similar to the Plaintiff's trademark "Domino's Pizza", as well as "Cheese Burst", "PASTA ITLAIANO" or any other deceptively similar trademark for the purposes of destruction/erasure of the same;

e) An order in the nature of directions to the Defendant No. 1 to withdraw the trademark application number 3285916, dated 15/06/2016 for the impugned mark  .

f) An order in the nature of directions to the Defendant No. 2 to lock, block, suspend and transfer the domain names www.dominickpizza.com and www.dominickpizzas.com and during the pendency of the suit, inform the Plaintiffs when the aforesaid domain names are set to expire.

g) An order for rendition of accounts of profits earned by the Defendant No. 1 by the use of the impugned trademarks "Dominick Pizza",  or any other mark which is identical or deceptively similar to the Plaintiffs' trademark "Domino's Pizza", as well as "Cheese Burst", "PASTA ITLAIANO" or any other deceptively similar trademark for the purposes of destruction/erasure of the same;

h) An order for damages of Rs. 2,00,01,000 to be paid by the Defendant No. 1 to the Plaintiffs;

i) An order for costs in these proceedings;"

14. Summons were issued in the present suit on 29 August 2022, on which date an *ex parte ad interim* order, restraining Defendant 1, as well as others acting on its behalf, from using, depicting or displaying, in any manner, whatsoever, the marks "Dominick Pizza", "Cheese

Burst" and "Pasta Italiano" as well as any other identical or confusingly/deceptively similar marks, was passed. Defendant 2, GoDaddy, being the Domain Name Registrar of www.dominickpizza.com and www.dominickpizzas.com was also directed to block/suspend the said domain names.

15. The said interim orders continue to remain in force till date.

16. Subsequently, Defendant 2 appeared before the Court and stated that it had complied with the direction to block/suspend the domain names www.dominickpizza.com and www.dominickpizzas.com and was willing to transfer the said domain names to the plaintiff.

17. Defendant 1, despite service, never chose to file any written statement. The right of Defendant 1 to file written statement was closed on 2 February 2023.

18. On 15 February 2023, the interim order dated 29 August 2023 was made absolute pending disposal of the suit. Defendant 2 was also deleted from the array of parties on the said date.

19. Affidavit in evidence dated 11 August 2023 has subsequently been filed by the plaintiff, reiterating, *in extenso* and verbatim, the contents of the plaint.

20. In these circumstances, I am of the opinion that the suit is capable of being decreed under Order VIII Rule 10 of the Code of Civil Procedure, 1908 (CPC).

21. The facts stated hereinabove disclose a clear case of infringement as well as passing off. Plaintiff 1 has been using the mark "Domino's Pizza" as well as the distinctive logo  globally since 1965 and in India since 1996. Plaintiff 1 is also the registered proprietor of the marks DOMINO'S,  ,  ,  ,  ,  and  . The registrations are effective from 9 November 1986, 30 April 1992, 18 September 2003 and 16 May 2011. By virtue of being the owner of the said registered marks, the plaintiffs are entitled under Section 28(1)[1] of the Trade Marks Act, 1999 to protect itself against infringement of the said marks.

22. The circumstances in which infringement can be said to have taken place are delineated in Section 29 of the Trade Marks Act. Of the three impugned marks in the present case, the marks "CHEESE BURST" and "PASTA ITLAIANO" replicate the corresponding marks of the plaintiffs. Though, as device marks, they may not be identical to the corresponding marks of the plaintiffs, that factor

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

would not make any difference to the aspect of infringement. The position in law, in this regard, stands crystallised by the judgment of the Supreme Court in ***Kaviraj Pandit Durga Dutt Sharma v. Navaratna Pharmaceutical Laboratories***[2] and ***K.R. Chinna Krishna Chettiar v. Shri Ambal and Co.***[3]. The following passages from ***Kaviraj***[2] exposit the legal principle in this regard, thus:

> "28. The other ground of objection that the findings are inconsistent really proceeds on an error in appreciating the basic differences between the causes of action and right to relief in suits for passing off and for infringement of a registered trade mark and in equating the essentials of a passing off action with those in respect of an action complaining of an infringement of a registered trade mark. We have already pointed out that the suit by the respondent complained both of an invasion of a statutory right under Section 21 in respect of a registered trade mark and also of a passing off by the use of the same mark. The finding in favour of the appellant to which the learned counsel drew our attention was based upon dissimilarity of the packing in which the goods of the two parties were vended, the difference in the physical appearance of the two packets by reason of the variation in the colour and other features and their general get-up together with the circumstance that the name and address of the manufactory of the appellant was prominently displayed on his packets and these features were all set out for negativing the respondent's claim that the appellant had passed off his goods as those of the respondent. These matters which are of the essence of the cause of action for relief on the ground of passing off play but a limited role in an action for infringement of a registered trade mark by the registered proprietor who has a statutory right to that mark and who has a statutory remedy for the event of the use by another of that mark or a colourable imitation thereof. While an action for passing off is a Common Law remedy being in substance an action for deceit, that is, a passing off by a person of his own goods as those of another, that is not the gist of an action for infringement. The action for infringement is a statutory remedy conferred on the registered proprietor of a registered trade mark for the vindication of the exclusive right to the use of the trade mark in relation to those goods" (Vide Section 21 of the Act). The use by the defendant of the trade mark of the plaintiff is not essential in an action for

[2] **AIR 1965 SC 980**
[3] **MANU/SC/0303/1969**

passing off, but is the sine qua non in the case of an action for infringement. No doubt, where the evidence in respect of passing off consists merely of the colourable use of a registered trade mark, the essential features of both the actions might coincide in the sense that what would be a colourable imitation of a trade mark in a passing off action would also be such in an action for infringement of the same trade mark. But there the correspondence between the two ceases. In an action for infringement, the plaintiff must, no doubt, make out that the use of the defendant's mark is likely to deceive, but where the similarity between the plaintiff's and the defendant's mark is so close either visually, phonetically or otherwise and the court reaches the conclusion that there is an imitation, no further evidence is required to establish that the plaintiff's rights are violated. Expressed in another way, *if the essential features of the trade mark of the plaintiff have been adopted by the defendant, the fact that the get-up, packing and other writing or marks on the goods or on the packets in which he offers his goods for sale show marked differences, or indicate clearly a trade origin different from that of the registered proprietor of the mark would be immaterial; whereas in the case of passing off, the defendant may escape liability if he can show that the added matter is sufficient to distinguish his goods from those of the plaintiff.*

29. When once the use by the defendant of the mark which is claimed to infringe the plaintiff's, mark is shown to be "in the course of trade", the question whether there has been an infringement is to be decided by comparison of the two marks. Where the two marks are identical no further questions arise; for then the infringement is made out. *When the two marks are not identical, the plaintiff would have to establish that the mark used by the defendant so nearly resembles the plaintiff's registered trade mark as is likely to deceive or cause confusion and in relation to goods in respect of which it is registered* (Vide Section 21). A point has sometimes been raised as to whether the words "or cause confusion" introduce any element which is not already covered by the words "likely to deceive" and it has sometimes been answered by saying that it is merely an extension of the earlier test and does not add very materially to the concept indicated by the earlier words "likely to deceive". But this apart, as the question arises in an action for infringement the onus would be on the plaintiff to establish that the trade mark used by the defendant in the course of trade in the goods in respect of which his mark is registered, is deceptively similar. *This has necessarily to be ascertained by a comparison of the two marks - the degree of resemblance which is necessary to exist to cause deception not being capable of definition by laying down objective standards. The persons who would be deceived are, of course, the purchasers of the goods and*

> *it is the likelihood of their being deceived that is the subject of consideration. The resemblance may be phonetic, visual or in the basic idea represented by the plaintiff's mark. The purpose of the comparison is for determining whether the essential features of the plaintiff's trade mark are to be found in that used by the defendant. The identification of the essential features of the mark is in essence a question of fact and depends on the judgment of the Court based on the evidence led before it as regards the usage of the trade. It should, however, be borne in mind that the object of the enquiry in ultimate analysis is whether the mark used by the defendant as a whole is deceptively similar to that of the registered mark of the plaintiff.*"
>
> (Emphasis supplied)

23. ***K.R. Krishna Chettiar***[3] involved two device marks which were completely dissimilar in appearance – as is specifically noted in the judgment – of which the textual component was "Sri Ambal" in one case and "Sri Andal" in other. The Supreme Court held that, where the prominent feature of the two marks was the text, and the textual component of the two marks was deceptively similar, the fact that the added visual matter in the two marks may have been different and distinct would not mitigate the aspect of infringement. The following passage from the said decision may be reproduced thus:

> "**7.** There is no evidence of actual confusion, but that might be due to the fact that the appellant's trade is not of long standing. *There is no visual resemblance between the two marks, but ocular comparison is not always the decisive test. The resemblance between the two marks must be considered with reference to the ear as well as the eye.* There is a close affinity of sound between Ambal and Andal.
>
> 8. In the case of ***Coca-Cola Co. of Canada v. Pepsi-Cola Co. of Canada Ltd.***[4] it was found that cola was in common use in Canada for naming the beverages. The distinguishing feature of the mark Coca Cola was coca and not cola. For the same reason the distinguishing feature of the mark Pepsi Cola was Pepsi and not cola. It was not likely that any one would confuse the word Pepsi with Coca. In the present case the word "Sri" may be regarded as in common use. *The distinguishing feature of the respondent's*

[4] **1942 59 RPC 127**

> *mark is Ambal while that of the appellant's mark is Andal. The two words are deceptively similar in sound.*
>
> 9. The name Andal does not cease to be deceptively similar because it is used in conjunction with a pictorial device. The case of ***De Cordova v. Vick Chemical Co.***[5] is instructive. From the appendix printed at p. 270 of the same volume it appears that Vick Chemical Company were the proprietors of the registered trade mark consisting of the word "Vaporub" and another registered trade mark consisting of a design of which the words "Vicks Vaporub Salve" formed a part. The appendix at p. 226 shows that the defendants advertised their ointment as "Karsote Vapour Rub". It was held that the defendants had infringed the registered marks. Lord Radcliffe said: "... a mark is infringed by another trader if, even without using the whole of it upon or in connection with his goods, he uses one or more of its essential features"."

24. In infringement, therefore, the comparison is mark to mark. In the case of device marks, containing textual matter, where the textual matter constitutes a prominent part of the rival device marks, and the textual matter of the defendant's mark is confusingly or deceptively similar to the textual matter of the plaintiff's mark, infringement has necessarily to be held to have taken place. The obvious reason is that the mythical customer of average intelligence and imperfect recollection, through whose imaginary eyes the existence or non-existence of infringement has to be discerned, would remember the textual material in the marks in preference to their visual appearance. That apart, it is a matter of common knowledge that the visual appearance of device marks does not remain constant, and changes from time to time.

25. In the present case, the textual material in the rival "CHEESE BURST" and "PASTA ITLAIANO" is identical, between the

[5] **1951 68 RPC 103**

plaintiffs and Defendant 1, who uses the very same phrase as is used by the plaintiffs, i.e. "CHEESE BURST" and "PASTA ITLAIANO". The case, therefore, stands on an even higher pedestal then ***Krishna Chettiar***[3]. The mere fact that, visually, the two marks may be dissimilar, cannot therefore, detract from the infringing nature of the defendant's marks.

26. Section 29(2)[6] of the Trade Marks Act sets out the circumstances in which infringement would take place, where the rival marks are either identical or similar to each other, and are used in respect of goods or services which are identical or similar. The basic requirement, envisaged in the opening words of the said sub-section, of the defendant not being a registered proprietor of the allegedly infringing trademark, stands satisfied, as the defendant does not have any trademark registered in its favour. The defendant is using the impugned mark in the course of trade, which satisfies the second requirement of the opening words of Section 29(2). Where these two requirements are satisfied, Clauses (a) to (c) of Section 29(2) envisage different circumstances in which infringement could be said to have taken place. Clause (a) applies where the rival marks are identical and cover goods or services which are similar to each other, clause (b) applies where the rival trademarks are similar, but not identical, and

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

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

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

(c) its identity with the registered trade mark and the identity of the goods or services covered by such registered trade mark,

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

cover goods or services which are identical or similar and clause (c) covers cases where the rival marks and goods and services covered thereby are identical.

27. In the present case, the goods and services provided by the plaintiffs and defendant are identical, so that clause (a) would not apply. At the very least, even if they are seen as rival device marks, the marks of the plaintiffs and Defendant 1 are similar to each other, and cover identical goods or services. Phonetically, too, "Domino's Pizza" and "Dominick's Pizza" are similar. The classic test to assess phonetic similarity is that laid down by Parker, J of the Chancery Division of the High Court in ***In the Matter of an Application by the Pianotist Company Ltd for the Registration of a Trade Mark***[7] (generally known as "the ***Pianotist*** test"):

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

28. Mere similarity of the two marks and identity or similarity of the goods or services covered thereby would not, however, *ipso facto*

[7] **(1906) 23 RPC 774**

result in infringement even under Section 29(2)(b). Additionally, the Court would have to be satisfied that the similarity between the rival marks and the identity/similarity of the goods/services covered thereby result in likelihood of confusion on the part of the public or on the public believing the defendant's mark to be associated to the plaintiff's registered trademark.

29. The ***Pianotist***[7] test makes it clear that the aspects of deceptive similarity and likelihood of confusion cannot be viewed in isolated silos even if, statutorily, they are two distinct elements of Section 29(2). They are inextricably interlinked. Deception and conclusion are, after all, two faces of one coin, and the definition of "deceptively similar", as contained in clause (h) of Section 2 of the Trade Marks Act, in a sense, dovetails the two, by providing that "Mark shall be deemed to be deceptively similar to another mark if it so nearly resembles that other mark *as to be likely to deceive or cause confusion*". The difference between "confusion" and "deception" in the Trade Marks Act is, therefore, more superficial than substantial. I may note, however, that a Division Bench of this Court has, in ***Shree Nath Heritage Liquor Pvt Ltd v. Allied Blender & Distillers Pvt Ltd***[8], drawn a distinction between "confusion" and "deception" by holding thus:

> "6. When a person knows that the mark in question does not originate from the senior user but the senior user is called to mind, then it's a step before confusion. If on the other hand, the consumer is in a state of wonderment if there's a connection, this is confusion. Further, if this consumer then purchases the junior users product, this is then deception."

"A state of wonderment if there is a connection" between the two

[8] **221 (2015) DLT 359 (DB)**

marks is, therefore, sufficient to constitute "confusion" and it is not necessary that the wonderment must proceed to the consumer actually mistaking one mark for the other. "Have I seen this earlier?" may, therefore, be said to represent the definitive test for confusion.

30. Viewed thus, the phonetic similarity between "Domino's" and "Dominick's", in conjunction with the similarity in the logos used by the plaintiffs and Defendant 1, and the fact that they are providing identical goods and services under the respective marks, in my considered opinion, render the marks deceptively similar to each other and clearly make out a case of likelihood of confusion between the two marks. "Domino's Pizza" and "Dominick's Pizza" appear, to me, to be *ex facie* deceptively similar to each other. The matter has to be viewed from the perspective of a customer of average intelligence and imperfect recollection, who is not over-familiar with one or the other. If such a customer visits a "Domino's Pizza" outlet of the plaintiff on one occasion and, sometime later, visits a "Dominick's Pizza" outlet of Defendant 1, likelihood of confusion is bound to exist. This likelihood would be exacerbated by the manner in which Defendant 1 has chosen to represent its logo, in a square format using lettering similar to that used by the plaintiffs.

31. The aspect of whether the use of the defendant's mark is or is not likely to result in confusion is essentially a matter which rests with the subjective discretion of the Court, and is not an aspect which is to be decided on the basis of evidence of customers. Nonetheless, the communication from Nitin Warikoo corroborates the plaintiffs' assertion that the use, by Defendant 1 of the impugned marks has

resulted in confusion amongst the consuming public.

32. As such, the case squarely attracts clause (b) of Section 29(2).

33. The intent of Defendant 1 to imitate the plaintiffs is apparent. Of the three rival marks, the marks "CHEESE BURST" and "PASTA ITLAIANO" replicate the corresponding the marks of the plaintiffs. The mark 

is apparently a throwback to the original predecessor "DOMINICK's PIZZA" mark of the plaintiffs, which was adopted by the Monaghan Brothers. The intention of luring the public into believing an association between Defendant 1 and the plaintiffs, therefore, stares one in the face.

34. Where such an intent to imitate is apparent, the principle enunciated by Lord Justice Lindley in ***Slanzenger & Sons v. Feltham & Co***[9] has been held, in several decisions, to be applicable:

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

35. The facts of the case, therefore, clearly make out a case of infringement, by Defendant 1, of the plaintiffs' registered trademarks.

36. The Court is inclined to note, here, that where the marks in question pertain to food items, or eateries where food items are

[9] **(1889) 6 RPC 531**

dispensed and served, a somewhat higher degree of care and caution is expected to be observed. Running an eating house using a mark which is deceptively similar to a reputed mark does not speak well for the enterprise concerned. The intent to capitalise on the reputation of a known and established brand, by using a mark which is deceptively similar to the mark used by the brand, can, in a given case, give rise to a legitimate apprehension of quality compromise by the imitator. Courts have, therefore, to be vigilant in ensuring that, where the marks relate to consumable items or to enterprises such as hotels, restaurants and eating houses where consumable items are served to customers, such imitative attempts are not allowed to go unchecked.

37. Apparently aware of the fact that it really has no substantial defence to offer, Defendant 1 has not chosen even to enter appearance in the present matter, despite service.

38. In the circumstances, a clear case of infringement having been made out, the judgment of the Supreme Court in ***Midas Hygiene Industries P. Ltd. v. Sudhir Bhatia***[10] obligates the Court to grant the relief sought in the plaint. As such, the present suit is decreed in the following terms:

> (i) There shall be a decree of permanent injunction restraining Defendant 1, its proprietors, partners, directors, officers, servants, agents franchisers and all others acting for and on its behalf from advertising, selling, offering for sale marketing etc. any product, packaging, menu cards and

[10] **(2004) 3 SCC 90**

advertising material, labels, stationery articles, website or any other documentation using, depicting, displaying in any manner whatsoever, the marks “Dominick Pizza”, 

, “CHEESE BURST” and “PASTA ITLAIANO” or any other mark which is identical or deceptively similar to the Plaintiffs’ registered trademarks in any manner whatsoever.

(ii) Defendant 1 is directed forthwith to withdraw Application number 3285916 dated 15 June 2016, submitted to the Trade Marks Registry, whereby it has sought to register the mark 

. In the event of failure, on the part of Defendant 1, to so apply, the Registry of Trademarks is directed to treat the application as withdrawn and to pass orders appropriately.

(iii) Defendant 2 is directed to transfer, forthwith, the domain names www.dominickpizza.com and www.dominickpizzas.com to the plaintiff.

(iv) The plaintiffs shall be entitled to actual costs. A bill of costs has been filed by the plaintiffs, working out the costs to Rs. 6,57,564.20. Accordingly, Defendant 1 shall be liable to pay, to the plaintiffs, ₹ 6,57,564.20 being the actual costs incurred by the plaintiffs in the present litigation. Let the costs be paid within a period of four weeks from the date of

uploading of this judgment on the website of this Court.

39. The suit stands decreed in the aforesaid terms.

40. Let a decree sheet be drawn up by the Registry accordingly.

C.HARI SHANKAR, J

SEPTEMBER 26, 2023
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