



2026:DHC:1306-DB



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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**
+ **FAO(OS) (COMM) 216/2025, CM APPLs. 82771/2025 & 1823/2026**

**STAR SMITH EXPORT
PRIVATE LIMITED & ANR.**

.....Appellants

Through: Mr. Manoj Chouhan, Mr.
Ujjwal Singh Parmar and Ms. Neha Raj
Singh, Advs.

versus

A O SMITH CORPORATION & ANR.

.....Respondents

Through: Mr. Ranjan Narula, Mr. Shakti
Priyan Nair and Mr. Parth Bajaj, Advs.

CORAM:

HON'BLE MR. JUSTICE C.HARI SHANKAR

HON'BLE MR. JUSTICE OM PRAKASH SHUKLA

JUDGMENT(ORAL)

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13.02.2026

OM PRAKASH SHUKLA, J.

1. The present appeal has been filed under Section 13 of the Commercial Courts Act, 2015, read with Order XLIII Rule 1(r) of the Code of Civil Procedure, 1908¹, assailing the impugned judgments dated 22.03.2024 and 24.12.2025 passed by learned Single Judge of this Court in C.S. (COMM) 532 of 2022. By way of the impugned judgments, the application preferred by the respondents under Order XXXIX Rules 1 and 2 of CPC, seeking interim injunction restraining the appellants from using impugned trademarks as a trade name, trademark, or domain name, was allowed.



¹ "CPC" hereinafter



2. The aforementioned suit was instituted by the respondents herein (“plaintiffs”) against the appellants (“defendants”) seeking a decree for permanent injunction, restraining the appellants’ use of “STARSMITH”, “STAR SMITH”, “BLUE DIAMOND”,



(“impugned mark” hereinafter) on the ground that it is deceptively similar to respondents’ marks, i.e., “A.O. SMITH”, “BLUE

DIAMOND”, “”, & “”, along with passing off, delivery-up, damages and costs.

3. The learned Single Judge, *vide* order dated 03.08.2022, *prima facie* concluded that the use of the impugned marks by the appellants in respect of said products would amount to infringement of the respondents’ registered mark and thus granted an *ex-parte ad-interim* injunction restraining the appellants from using the marks “STARSMITH”, “STAR SMITH” and “BLUE DIAMOND” or any deceptively similar mark in relation to the manufacture and sale of geysers, water purifiers, RO systems and allied goods. However, the appellants were allowed to use Appellant No.1’s corporate name (‘Star Smith Export Pvt. Ltd.’), so long as no undue emphasis was made on “STAR SMITH”. The relief *qua* appellants’ use of domain name was deferred till they entered appearance.



4. Accordingly, *vide* judgment dated 22.03.2024 (*first impugned judgment*), the interim order was made absolute, though the learned Single Judge noted that the aspects relating to the impugned trade name and domain name were yet to be adjudicated.

5. Thereafter, the appellants filed an application under Order XXXIX Rule 4 of CPC seeking vacation of the *ex-parte ad interim* injunction.

6. Pursuant thereto, *vide* judgment dated 24.12.2025 (*second impugned judgment*), the appellants were restrained from using the corporate name and the domain name (www.starsmith.in), or any other trade name or domain name identical or deceptively similar to the respondents' trademark, trade or domain name.

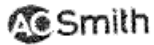

BRIEF FACTS

7. Shorn off unnecessary details, the brief factual background necessary for the adjudication of the present dispute is as follows.

8. As per the plaint, Respondent No. 1 is a US-based company and Respondent No. 2 is its wholly owned Indian subsidiary incorporated in 2006, with its registered office in Bengaluru. They claim use of "AO SMITH" internationally since 1874 and in India since 2006 for geysers, purification systems, water heaters and other allied goods. The respondents sell their products through e-commerce sites such as Amazon, etc. and retail channels such as Vijay Sales, etc. They claim use of "AO SMITH" and "BLUE DIAMOND" as both word and



device marks. They also assert worldwide turnover of around USD 3.5 billion as in 2021, with 20 offices globally and significant presence in India. They registered the domain names www.aosmith.com in 1994 and www.aosmithindia.com in 2008. They contest the use of the impugned marks by the appellants, claiming that the impugned marks are deceptively similar to their registered marks, which are as follows:

| Trade mark | Class | Regn. No. | Regn. Date | Goods and Status |
|---|----------|-----------|----------------|---|
| A. O. SMITH | 7 and 11 | 1668622 | March 25, 2008 | Registered & renewed until March 25, 2028 |
|  | 7 and 11 | 1679131 | April 22, 2008 | Registered & renewed until April 22, 2028 |
|  | 7 and 11 | 1679132 | April 22, 2008 | Registered & renewed until April 22, 2028 |
| A.O. SMITH | 11 | 1968839 | May 20, 2010 | Registered & renewed until May 20, 2030 |
| BLUE DIAMOND | 11 | 1700822 | June 19, 2008 | Registered & renewed until June 19, 2028 |

9. On the other hand, Appellant No. 1 was incorporated in August 2020, with Appellant No.2 as its Director. As per the Written Statement, “STAR ENTERPRISES” was incorporated in 1990 for manufacturing electrical appliances. Thereafter, it was converted to “AEROSTAR” in 2005 and subsequently to Appellant No. 1 in 2020. It was averred that “SMITH” was adopted from the nickname of Appellant No. 2’s son and in ordinary sense, it meant ‘worker’. Purportedly, the nickname was added to Appellant No. 2’s grandmother’s name “SUMITRA” to coin the trade name. Trademark Application No. 4580404 was filed for the word mark “STAR SMITH” on proposed-to-be-used basis for identical products such as geysers, RO systems, etc. The respondents opposed the said



application, pursuant to which the registration stands suspended. Consequently, the appellants do not hold any registration in the impugned marks as of today. They also claim to have registered the domain name “www.starsmith.in” on 07.04.2020 and assert honest adoption, denying any similarity between the rival marks.

10. Against this factual backdrop, the respondents were aggrieved by alleged dishonest adoption and use of impugned marks for identical products.

11. Consequently, the respondents instituted a suit seeking, *inter alia*, a decree of permanent injunction restraining the appellants from using the impugned marks as trade name, trademark and domain name, along with passing off and reliefs of delivery-up, damages and costs.

IMPUGNED JUDGMENTS

12. The learned Single Judge in the impugned judgment dated 22.03.2024 made the *ex-parte ad interim* injunction absolute but the aspect of corporate name and domain name remained open. It was observed as follows:

- (i) The appellants’ mark was not registered. The appellants and respondents sold identical products. By placing reliance on various judgments², the dominant part test was employed to

² *Kaviraj Pandit Durga Dutt Sharma v. Navaratna Pharmaceutical Laboratories², PhonePe Pvt. Ltd. v. EZY Services & Anr.², Vasundhra Jewellers Pvt. Ltd. v. Kirat Vinodbhai Jadvani & Anr.², Under Armour, Inc. v. Aditya Birla Fashion & Retail Ltd.², Amritdhara Pharmacy v. Satya Deo Gupta² and M/s South India Beverages Pvt. Ltd. v. General Mills Marketing Inc. & Anr.²,*



determine deceptive similarity between the rival marks when viewed as a whole and the likelihood of confusion among consumers thereof. “SMITH” was found to be the dominant and distinctive element of both marks, whereas “AO” lacked significance.

(ii) “SMITH” is of uncommon usage in India and was not used in subservient manner to other parts of the mark. “SMITH” is specific and more familiar since it is a name and also used as a suffix and prefix in locksmith, blacksmith etc.

(iii) Appellants’ contention that “SMITH” was adopted since the proprietor’s son was named so, was not proved.

(iv) Onus was on the appellants (defendants) to show significant business turnover by third party users of similar marks or that they pose a threat to respondents’ (plaintiffs’) distinctiveness. The respondent/plaintiff is not mandated to take action against infringement which does not prejudice it.

(v) The respondents were prior adopters and extensively used the mark.

(vi) Appellants were using different marks (‘AERO STAR’ and “STAR ENTERPRISES”) and only adopted the impugned mark in 2020. They had predilection for “STAR” not “SMITH”, hence, the sudden adoption of “SMITH” in 2020 for identical goods, *prima facie* indicates dishonesty.

(vii) Appellants cannot claim that ‘SMITH’ is generic, since they themselves applied for registration of ‘STAR SMITH’.

13. The learned Single Judge *vide* judgment dated 24.12.2025 granted interim injunction against the appellants’ use of the



deceptively similar corporate and domain names. It was observed as follows:

- (i) The Court proceeded on the finding in the first impugned decision that “SMITH” was the dominant part, the impugned mark was deceptively similar, and that the appellants had *prima facie* dishonestly adopted the impugned mark.
- (ii) As per *Telecare Network India Pvt. Ltd. v. Asus Technology Pvt. Ltd. & Ors.*³, after the registration of a trademark, only the registration certificate is to be considered. Respondents’ marks were registered without a disclaimer; hence, respondents can claim exclusive use of the same.
- (iii) Respondents established their prior use, goodwill and reputation through the various documents placed on record. They commenced use in India in 2008, whereas the appellants adopted the impugned mark in 2020.
- (iv) Impugned trademarks are nearly identical; class of consumers and the channels of trade directly overlap. Hence, there is likelihood that consumers may mistakenly associate appellants’ goods with those of the respondents’ or perceive them as a variant of respondents’ products.
- (v) The appellants are estopped from claiming that ‘SMITH’ is generic and common to trade, since they themselves applied for registration of ‘STAR SMITH’.
- (vi) Use of similar marks by third parties is not a valid defense for infringement under the Trade Marks Act, 1999⁴.
- (vii) Appellants’ trade name is deceptively similar to that of

³ MANU/DE/1838/2019

⁴ “Act” hereinafter



respondents'. The said trade name is also used for dealing in identical and cognate products. Since infringement is made out with respect to the impugned marks, injunction must also follow with respect to the trade name as under Section 29(5) of the Act. (viii) As per *Satyam Infoway Ltd. v. Sifynet Solutions Pvt. Ltd.*⁵, domain names are also protected. Appellants' domain name subsumes the respondents' trademarks, and is, therefore, deceptively similar thereto. Such use is likely to cause confusion among consumers. Even if consumers ultimately realise the distinction prior to consummating a transaction, the diversion of internet traffic to appellants' website constitutes 'initial interest confusion'.

14. Aggrieved, the appellants approached this Court alleging that the impugned judgments suffer from perversity, thereby warranting interference.

RIVAL SUBMISSIONS BEFORE THIS COURT

15. Mr. Manoj Chouhan, the learned Counsel for the appellants submits that the impugned orders are untenable; "STAR SMITH" is distinct from "AO SMITH" and doesn't cause confusion with respondents' mark.

16. Mr. Chauhan argues that the learned Single Judge erred in holding that "SMITH" was the dominant part and uncommon in Indian parlance since distinctiveness depends on a mark's ability to

⁵ AIR 2004 SC 3540; (2004) 6 SCC 145



identify the source and not linguistic rarity as per Section 9(1)(a). Being a common English surname and noun, “SMITH” is descriptive and non-distinctive.

17. Relying on Section 17(2)(b), it is submitted that registration of a composite mark confers no exclusive rights in a part thereof; hence, the respondents could not claim exclusivity over “SMITH”. Reliance is placed on *PhonePe Pvt. Ltd. (supra)*. Further, it is submitted that assuming acquired distinctiveness, the respondents failed to establish such distinctiveness prior to registration under Section 9(1)(b) of the Act⁶. In absence thereof, as per *Pernod Ricard India (P) Ltd. v. Karanveer Singh Chhabra*⁷, they cannot claim exclusivity over “SMITH”.

18. The application of the “dominant part” test is argued to be violative of Section 17(2) and the anti-dissection rule. Appellants’ adoption of “STAR SMITH” was honest and the contrary finding of the learned Single Judge was unsupported by any evidence. It is also submitted that exclusivity over common words such as “SMITH” is antithetical to commercial morality.

19. It is further submitted that, as per their response to the Examination Report, the respondents accepted that the marks must be compared as a whole, hence, they cannot restrain others from use of a generic part thereof. In support, reliance is placed on *People*

⁶ “9. Absolute grounds for refusal of registration.— (1)(b) which consist exclusively of marks or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, values, geographical origin or the time of production of the goods or rendering of the service or other characteristics of the goods or service;”

⁷ 2025 SCC OnLine SC 1701



Interactive (India) Pvt. Ltd. v. Vivek Pahwa⁸ and ***Raman Kwatra & Anr. v. KEI Industries Ltd***⁹. It is also contended that failure to disclose third-party use of “SMITH” misrepresented exclusivity over the said mark, rendering the impugned judgments liable to be set aside as per ***Ramjas Foundation v. Union of India***¹⁰. In further support of their contentions, reliance was placed on ***Registrar, Trade Marks v. Ashok Chandra Rakhit Ltd.***¹¹, ***Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd.***¹² and ***Laxmikant V. Patel v. Chetanbhai Shah***¹³.

20. *Per contra*, Mr. Ranjan Narula, the learned Counsel for the respondents submits that impugned orders are well-reasoned and warrant no interference. They assert prior adoption, continuous use since 2008 and registration of their trademarks, trade name, and domain name in India.

21. Mr. Narula submits that appellants dishonestly adopted the dominant part of their mark, i.e., “SMITH”; the appellants’ use of deceptively similar marks in respect of identical goods through overlapping trade channels constitutes infringement under Section 29. It is contended that once infringement is established, an injunction must necessarily follow. Further, use of a deceptively similar domain name is argued to cause diversion of internet traffic and initial interest confusion. Reliance was placed on ***Wow Momo Foods Private***

⁸ 2016 SCC OnLine Bom 7351

⁹ 2023 SCC OnLine Del 38

¹⁰ (2010) 14 SCC 38

¹¹ (1955) 1 SCC 655

¹² (2001) 5 SCC 73

¹³ (2002) 3 SCC 65



*Limited v. Wow Burger and Ors.*¹⁴, *Amar Singh Chawal Wala Vs. Shree Vardhman Rice and Genl. Mills*¹⁵, *M/s South India Beverages (supra)*, *K.R. Chinna Krishna Chettiar v. Shri Ambal and Co. and Ors.*¹⁶, *Pidilite Industries Ltd. v. Jubilant Agri & Consumer Products Ltd.*¹⁷, *Shree Nath Heritage Liquor Pvt. Ltd. and Ors. v. Allied Blender & Distillers Pvt. Ltd.*¹⁸, *Bloomberg Finance Ltd. v. Prafull Saklecha & Ors.*¹⁹, *Satyam Infoway Ltd. (supra)*, *Kaviraj Pandit Durga Dutt Sharma (supra)*, *Under Armour (supra)* and *Zyduz Wellness Products Ltd. v. Cipla Health Ltd. & Anr.*²⁰

22. Mr. Narula highlights the inconsistent explanations for adoption of “SMITH” by appellants, asserting it to be a common dictionary word, a nickname, and a coined term. Hence, it is argued that the appellants’ adoption of the impugned marks was dishonest and that, as subsequent adopters, they ought to have conducted due diligence regarding existing similar marks. Reliance is placed on *Aktiebolaget Volvo of Sweden v. Volvo Steels Ltd. of Gujarat (India)*²¹, *Ciba Geigy Ltd. v. Crosslands Research Laboratories Ltd.*²², *Midas Hygiene Industries P. Ltd. and Ors. v. Sudhir Bhatia and Ors.*²³, *Ishi Khosla v. Anil Aggarwal and Ors.*²⁴, *Infosys Limited v. Southern Infosys Ltd.*²⁵ and *Laxmikant V. Patel (supra)*.

¹⁴ MANU/DE/8039/2025

¹⁵ MANU/DE/0745/2009

¹⁶ MANU/SC/0303/1969

¹⁷ MANU/MH/0019/2014

¹⁸ MANU/DE/1933/2015

¹⁹ MANU/DE/3673/2013

²⁰ 2023:DHC:4344; CS(COMM) 115/2023

²¹ MANU/MH/0076/1997

²² MANU/DE/1267/1995

²³ MANU/SC/0186/2004

²⁴ MANU/DE/7192/2007

²⁵ MANU/DE/4097/2024



23. It is submitted that the tripartite test for grant of interim relief is satisfied, i.e., *prime facie* case and balance of convenience favored the respondents since they were prior adopters, users and registrants of “AO SMITH” marks and that once the aforesaid factors are established, irreparable damage may be presumed, as held in ***Ramdev Food Products Pvt. Ltd. v. Arvinbhai Rambhai Patel & Ors.***²⁶

24. On passing off, the respondents assert substantial goodwill and reputation through extensive use of their registered marks in India since 2008, supported by sales and promotional figures; by 2020, when the appellants commenced use of the impugned marks, respondents generated approximately Rs. 269 crores in sales and incurred promotional expenditure of Rs. 20 crores. Thus, it is argued that continued use of the impugned marks would cause monetary loss, dilution of goodwill and distinctiveness of the respondents’ marks. Reliance is placed on ***Mahendra & Mahendra Paper Mills Ltd. v. Mahindra & Mahindra Ltd.***²⁷ and ***N.R. Dongre and Ors. v. Whirlpool Corpn. and Ors.***²⁸.

25. The appellant’s contention that respondents concealed existence of third-party registrations of the mark “SMITH” was refuted by contending that mere registrations do not establish actual use of the mark in trade and that a plaintiff is not required to sue every infringer. Reliance was placed on ***Allied Blender (supra), Shri Pankaj Goel v. M/s Dabur India Ltd.***²⁹, ***Automatic Electric Ltd. v. R.K. Dgawan and***

²⁶ MANU/SC/3725/2006

²⁷ MANU/SC/0724/2001

²⁸ MANU/SC/1223/1996

²⁹ 2008:DHC;1941-DB; FAO(OS) 82/2008



*Ors.*³⁰ and *Dr. Reddy's Laboratories Ltd. v. Reddy Pharmaceuticals Ltd.*³¹. It is further contended that likelihood of confusion among consumers is sufficient to grant relief and proof of actual confusion is not mandatory as per *Toyota Jidosha Kabushiki Kaisha v. Prius Auto Industries Ltd. and Ors.*³².

FINDINGS AND ANALYSIS

26. We have heard the learned Counsels for both parties and carefully perused the material on record.

27. It goes without saying that appellate interference under Order XXXIX Rules 1 and 2 of the CPC is limited, as crystallized by the Supreme Court in *Wander Ltd. v. Antox India (P) Ltd.*³³ and reiterated in *Ramakant Ambalal Choksi v. Harish Ambalal Choksi & Ors.*³⁴.

28. It warrants no elaboration that at an interlocutory stage, an appellate court must not substitute its own view for the view adopted by the court of first instance, unless the same is found to be arbitrary, capricious, perverse or is in teeth of settled legal principles. Mere plausibility of a reasonable alternative based on the material on record is insufficient.

29. Accordingly, the impugned judgments are examined within this

³⁰ MANU/DE/0461/1991

³¹ MANU/DE/0658/2004

³² MANU/SC/1619/2017

³³ 1990 Supp SCC 727

³⁴ 2024 SCC OnLine SC 3538



narrow scope to ascertain if any of the infirmities delineated above exist, so as to warrant interference.

30. The appellants argue that “SMITH” is generic, commonly used, and also a surname, and that their adoption of “STAR SMITH” is honest. They emphasize that respondents cannot claim exclusivity over generic elements. In contrast, respondents’ case is that “SMITH” is the dominant part of their mark which is dishonestly adopted by appellants. As per the respondents, when viewed as a whole, the impugned mark is deceptively similar to their mark, creating likelihood of confusion, particularly since the impugned mark is used for identical goods. They rely on prior adoption, registration and goodwill to justify the grant of interim relief.

31. Therefore, the short issue for consideration of this Court is whether the appellants’ use of the impugned mark infringes respondents’ registered marks, trade name or domain name, necessitating interim relief.

32. At the outset, we deem it relevant to note that the appellants do not hold any valid registration in the impugned marks as on date. Conversely, the respondents’ registrations are valid and subsisting.

33. The Supreme Court in *Pernod Ricard (supra)* clearly laid down the applicable standard for assessing deceptive similarity. The relevant observation reads as under:

“41. It is a settled principle of trademark law that deceptive similarity does not necessitate exact imitation. What is material is the likelihood of confusion or association in the minds of



consumers arising from an overall resemblance between the competing marks. The applicable standard is that of an average consumer with imperfect recollection.

42. While comparing rival marks, Courts must assess the marks in their entirety, rather than dissecting composite trademarks into isolated components. The dominant feature of a mark may assist in crossing the preliminary threshold of analysis, but the ultimate inquiry must focus on the overall impression created by the mark – especially in the context of the relevant goods, trade channels, and target consumers. The proper test is not to place the two marks side by side to identify dissimilarities, but to determine whether the impugned mark, when viewed independently, is likely to create an impression of association or common origin in the mind of the average consumer. Even if a particular component of a mark lacks inherent distinctiveness, its imitation may still amount to infringement if it constitutes an essential and distinctive feature of the composite mark as a whole.

43. Section 17(1) of the Trade Marks Act, 1999 grants exclusive rights only in respect of the mark as registered. Section 17(2) excludes protection for common or non-distinctive elements unless such elements have acquired secondary meaning. Sections 27(2) and 29 preserve the right to institute passing off actions and define the contours of infringement, respectively. Notably, Section 29(3) presumes confusion only where identical marks are used for identical goods – a condition not met in the present case as the marks.”

(emphasis supplied)

34. Thus, upon a plain reading it can be discerned that in assessing deceptive similarity, the marks must be compared as a whole and from the perspective of an average consumer of ordinary intelligence and imperfect recollection. Therefore, the dominant part of a mark assumes significance, since consumers are likely to recollect or recall this part for purposes of future identification. The test is one of overall impression and likelihood of confusion, not a meticulous comparison of individual components placed side by side. Additionally, even where a mark is composite, its essential or dominant feature may be relevant, but infringement depends on whether the impugned mark,



viewed in its entirety and in the context of the goods, trade channels and class of purchasers, is likely to cause confusion or suggest association.

35. Needless to state that Section 17 grants exclusivity over a composite mark as a whole but such exclusivity does not extend to any constituent part thereof which is not separately registered (or for which separate application is made), or which is common to trade or non-distinctive.

36. Further, as recognized in *Satyam Infoway Ltd. (supra)*, courts have consistently invoked the common law remedy of passing off to resolve domain name disputes. Domain names serve as source identifiers in the virtual marketplace; their deceptive similarity may lead to diversion of online consumers. Therefore, domain names possess attributes of a trademark capable of protection in a passing off action.

37. Adverting to the facts of the present case, the learned Single Judge, *vide* judgment dated 22.03.2024 whereby the interim order was made absolute, returned the following findings:

*“21. After considering the pleas taken by the Plaintiffs and reply given by the Defendants, this Court is convinced that the use of the mark 'STAR SMITH' / 'STARSMITH' and 'BLUE DIAMOND' for an identical set of products is completely dishonest, inasmuch as the Defendants could not have hit upon both the marks belonging to the Plaintiffs, which are registered trademarks. The Plaintiffs have a global reputation as also reputation in India. **The adoption and use of the mark 'STAR SMITH'/'STARSMITH' which is deceptively similar to 'A.O. SMITH' and 'BLUE DIAMOND' which is identical to the mark of the Plaintiffs, would clearly lead***



to likelihood of confusion and infringement of trademarks of the Plaintiffs as per Section 29(2) of the Trade Mark, 1999.”

(emphasis supplied)

38. The learned Single Judge, in the second impugned judgment dated 24.12.2025, returned the following findings:

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

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

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

(emphasis supplied)

39. We are in agreement with the findings of the learned Single Judge that there exists a likelihood of confusion.



40. According to us, both marks “STAR SMITH” and “AO SMITH” share “SMITH” this dominant part. Since the marks are used for identical goods, target the same consumer class through overlapping retail and online trade channels and owing to imperfect recollection, the rival marks may lead to confusion among consumers.

41. Additionally, the inconsistent explanations offered by the appellants for adopting “SMITH” in 2020, such as ‘Smith’ is the nickname of Appellant No.2’s son or a coined term derived from the names of Appellant No.2’s son and grandmother, militate against their *bona fides*, particularly since “STAR” has been the recurring element in all their previous marks/trade names (M/s Star Enterprises, Aerostar etc.). These circumstances justify a *prima facie* inference of dishonest adoption.

42. Further, this Court is not convinced regarding the existence of any perversity in the impugned decisions. In light of *Wander Ltd. (supra)*, dehors any perversity or arbitrariness, we cannot intervene in the view adopted by the learned Single Judge merely because another view is plausible.

43. Having concluded that the rival marks are deceptively similar and likely to cause confusion among consumers, the essential ingredients of infringement are *prima facie* established. The admitted use of the impugned marks in relation to identical goods by the appellants is fatal in terms of Section 29 of the Act. Consequently, once infringement is made out, an injunction must follow as under



Section 135 of the Act.

44. In view of the aforesaid, the use of the impugned mark as part of the appellants' trade name in relation to identical and cognate and allied goods is equally impermissible by virtue of Section 29(5) of the Act³⁵.

45. Further, the respondents are the undisputed prior users in India since 2008, and have, by extensive sales, promotional activities and significant presence in Indian cities, successfully established *prima facie* goodwill and reputation well before the appellants' adoption in 2020³⁶. Therefore, the respondents are entitled to protect such goodwill from encroachment.

46. In the present case, the impugned mark, which is found to be *prima facie* infringing, is also used as the domain name and wholly incorporates the dominant part of the respondents' registered mark.

47. The appellants own www.starsmith.in and the respondents own www.aosmith.com and www.aosmithindia.com. When the rival domain names are juxtaposed, we find that the similarity in the domain names may lead an online consumer of average intelligence and imperfect recollection to either confuse the source of the products or assume a business connection between them, particularly since both parties deal in identical and cognate goods. Owing to such overlap of the domain names and the goods in relation to which they are used,

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

³⁶ *Pernod Ricard (supra)*; *Toyota Jidosha Kabushiki Kaisha v. Prius Auto Industries Ltd.*, (2018) 2 SCC 1



actual loss to respondents is highly probable.

48. Given the *prima facie* finding of deceptive similarity, the respondents' established goodwill in their registered mark prior to the adoption by the appellants and the likelihood of confusion and consequential damages, a case of passing off in respect of the domain name is made out. The appellants' domain name wholly subsumes the respondents' registered mark, creating both initial interest confusion and likelihood of confusion, hence, the learned Single Judge rightly concluded that an injunction must follow.

49. We do not agree with the contention of Mr. Chouhan that the learned Single Judge erred in holding that "SMITH" is the dominant part of the respondent's mark and that as per Section 17(2)(b), no exclusive rights were conferred on a part of a composite mark which is common to trade or non-distinctive. This contention is in the teeth of the well-settled principle laid down in *Pernod Ricard (supra)* and *South India Beverages (supra)* and is thereby rejected. In our considered view, the respondents are not claiming exclusivity over "SMITH", instead, it is their case that the impugned mark as a whole is deceptively similar to their registered marks. The respondents are, therefore, aggrieved by the use of deceptively similar marks for identical goods by the appellants. With respect to generic nature of "SMITH", the Act does not prohibit the use of common or generic words but the ones lacking distinctiveness. Rather, even an ordinary or common word may, upon acquiring secondary meaning and association with the proprietor's products, merit protection by way of



injunction³⁷. The assessment of distinctiveness of a mark is to be done in relation to the goods and services for which it is used. The appellants cannot, after filing for registration of “STAR SMITH”, contend that “SMITH” is not distinctive, as also rightly observed by the learned Single Judge that a party cannot approbate and reprobate³⁸. Thus, the learned Judge correctly held that the appellants were estopped from contending that “SMITH” was not distinctive since they themselves sought to register “STAR SMITH”.

50. The reliance on *Raman Kwatra (supra)* is misplaced, as the respondents’ trademark registration certificate, which lacks any disclaimer, should be the sole consideration³⁹. The appellants’ claim of third parties using similar marks is devoid of merit, as mere third-party use does not dilute respondents’ rights. As held in *Pankaj Goel (supra)*, significant business turnover or volume of sales must be proven to show dilution or commonality in trade. The contention of concealment is also refuted since that suppression is fatal only if it pertains to something material which may alter the court’s decision⁴⁰.

51. Thus, upon perusal of the impugned judgments, we find little room for cavil with the *prima facie* conclusion reached by the learned Single Judge that the appellants’ marks are deceptively similar to those of the respondents. Accordingly, the direction to keep the use of the impugned marks as a trademark, corporate name or domain name, at abeyance till final adjudication of the suit was rendered on the

³⁷ *Leayan Global Pvt Ltd. vs Bata India Ltd.*; 2025:DHC:11331-DB

³⁸ *Automatic Electric Limited (supra)*

³⁹ *Telecare Network India Pvt. Ltd. (supra)*

⁴⁰ *Arunima Baruah v. Union of India & Ors.*, (2007) 6 SCC 120



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correct anvil of settled principles, so as to obviate any further loss to the respondents.

52. The appeal is accordingly dismissed. Pending applications, if any, stand disposed of. No order as to costs.

53. However, twelve weeks' time is granted to change the name of the company and two weeks' time to change the domain name.

54. Needless to say, all observations made by this Court are confined to the present adjudication and do not have any bearing on the merits of the pending suit.

OM PRAKASH SHUKLA, J.

C.HARI SHANKAR, J.

FEBRUARY 13, 2026/gunn/pa