

Marks must be compared as a whole, with emphasis on their essential features and overall similarity, and Section 17 of the Trade Marks Act does not prevent protection of a prominent part of a composite mark where that part is distinctive

The **Bombay High Court** in the case of **UltraTech Cement vs Shiv Cement [Commercial IP Suit No. 126 of 2016] dated April 28, 2026**, has held that where the plaintiff proves valid and subsisting registration, long and extensive commercial use, distinctiveness, and reputation of its trade mark, and the defendant uses marks in respect of the same goods that contain the essential and leading feature of the plaintiff's mark and are visually, structurally, and phonetically deceptively similar, such use constitutes infringement and passing off.

The Court reaffirmed that marks must be compared as a whole, with emphasis on their essential features and overall similarity, and that Section 17 of the Trade Marks Act does not prevent protection of a prominent part of a composite mark where that part is distinctive. In an undefended action, where the defendant does not contest the evidence, the Court is entitled to grant permanent injunction, delivery up, and substantial costs, and may award monetary relief on a reasonable basis having regard to the defendant's dishonest conduct and the statutory mandate under Section 35 CPC in commercial suits.

Accordingly, High Court granted a permanent injunction restraining a rival cement maker from using marks deceptively similar to UltraTech, holding that the adoption was "entirely dishonest" and "actuated in bad faith." The Court also ordered the Defendant to pay costs of Rs. 50 lakhs to the Plaintiff. Additionally, the Defendant was ordered to pay the Plaintiff a sum of Rs. 16.48 lakhs as per the Statement of Expenses incurred by the Plaintiff.

The High Court observed that there was no dispute that the plaintiffs were the registered proprietors of the UltraTech trade-marks and that the plaintiffs had clearly proved open, continuous, and extensive use of those marks since 2003. It found that UltraTech had acquired distinctiveness, immense goodwill and reputation, and had become exclusively associated in the public mind and in the trade with the plaintiffs alone. The Court also noted that the mark UltraTech had been recognized as a well-known trade mark and had been included in the list of well-known trade-marks.

On comparison of the rival marks, the Court held that the impugned marks "ULTRA PLUS/ULTRAPLUS CEMENT", "ULTRA HITOUCH/ULTRA HITOUCH CEMENT BEMISAL MAJBUTI", and "ULTRA POWER" were visually, structurally, and phonetically virtually identical to, and in any event deceptively similar to, the plaintiffs' registered and well-known UltraTech trade-marks. The Court emphasized that "ULTRA" was the leading and essential feature of the plaintiffs' marks and that the defendant's use of similar get-up, placement, colour scheme, and general idea on cement bags showed mala fide adoption. Since the rival goods were the same, namely cement, the Court held that confusion, deception, and misrepresentation were more than likely.

Thus, the Court treated the defendant's conduct as dishonest and lacking in bona fides, noting not only the adoption and use of the impugned marks but also the defendant's failure to

appear, file a written statement, cross-examine the plaintiffs' witness, or challenge the plaintiffs' evidence. The Court therefore held that the plaintiffs' case had gone uncontroverted and that the evidence remained unchallenged.

On relief, although the Court found that the plaintiffs had not led evidence sufficient to prove damages of Rs. 1 crore, it held that in trade mark infringement and passing off matters, compensatory and punitive damages may be awarded on a reasonable basis where infringement is deliberate and dishonest, and that costs under Section 35 CPC as amended by the Commercial Courts Act must also reflect the conduct of the parties.