SHAGUFTA QUTBUDDIN PATHAN
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IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
IN ITS COMMERCIAL DIVISION

INTERIM APPLICATION (L) NO. 13958 OF 2023
IN
COMMERCIAL IP SUIT NO. 117 OF 2025

Bristol Bakery A Partnership Firm registered under the Partnership Act, 1932 Having its registered office/principal place of business at Pitamber Lane, Tulsi Pipe Road, Mahim West – 400016 Represented through its Partner Aspi Jamshed Irani		]	**...Applicant**
In the matter between :			
Bristol Bakery A Partnership Firm registered under the Partnership Act, 1932 Having its registered office/principal place of business at Pitamber Lane, Tulsi Pipe Road, Mahim West – 400016 Represented through its Partner Aspi Jamshed Irani		]	**...Plaintiff**
	Versus		
1.	Grupo Bimbo S.A.B. DE C.V. A company duly organized and existing under the laws of Mexico having its registered office at Prolongacion Pasco De La Reforma No.1000 Col. Pena Blanca Santa Fe, Mexico D. F., 01201, Mexico Also at AIPL Business Club, Sector 62, Gurugram, Haryana 122102	]	
2.	Modern Food Enterprises Private Limited Having its address at AIPL Business Club, 8th Floor, Wing No. -3, Sector 62, Gurugram – 122102, Haryana Email ID : naresh.kumar@grupoBimbo.com	]	
3.	Ready Roti India Pvt. Ltd.	]	

	Having its address at RZ-167/1, A-Block, Road No. 4, Mahipalpur Extension Delhi – 110037 Also at F-28, RIICO Industrial Area, Sare Khurd, Tehsil Tijara, District Alwar, Rajasthan – 301707 Email id : sc.agrawal@harvestgold.in	]]]]]	**…Defendants**

WITH
INTERIM APPLICATION NO. 5609 OF 2025
IN
COMMERCIAL IP SUIT NO. 189 OF 2025

	Grupo Bimbo S.A.B. DE C.V. A company duly organized and existing under the laws of Mexico having its registered office at Prolongacion Pasco De La Reforma No.1000 Col. Pena Blanca Santa Fe, Mexico D. F., 01201, Mexico Also at AIPL Business Club, Sector 62, Gurugram, Haryana 122102	]]]]]]]]	**...Applicant**
	In the matter between :		
	Grupo Bimbo S.A.B. DE C.V. A company duly organized and existing under the laws of Mexico having its registered office at Prolongacion Pasco De La Reforma No.1000 Col. Pena Blanca Santa Fe, Mexico D. F., 01201, Mexico Also at AIPL Business Club, Sector 62, Gurugram, Haryana 122102	]]]]]]]]]	**...Plaintiff**
	Versus		
1.	**Bristol Bakery** A partnership firm registered under the Indian Partnership Act, 1932, having its registered office/principal place of business at Pitamber Lane, Tulsi Pipe Road, Mahim West, Mumbai – 400016, through its Partner Aspi Jamshed Irani and Cyrus Jamshed Irani	]]]]]]]	
2.	**Arani Foods (India) Pvt. Ltd.** A company under the Companies Act, 2013, having its registered office at Shop No. 3/b, Hiren Light Industrial Premises Co-op. Society Limited,	]]]]	

	Mogul Lane, Mahim West and having its corporate affairs at Pitamber Lane, Mahim, Mumbai 400 016.	]]]	**...Defendants**

Mr. Ravi Kadam, Senior Advocate, a/w Mr. Hiren Kamod, Mr. Vaibhav Keni, *Ms. Neha Iyer, Mr. Mohd Affan and Mr. Vishwajeet Jadhav i/by Legasis Partners for the Applicants/Plaintiffs in IA(L)/13958/2025 and for the Defendant in IA/5609/2025*

Mr. Chander Lall, Senior Advocate a/w. Mr. Ashish Kamat, Senior Advocate, Ms. Shikha Sachdeva, Mr. Rahul Punjabi, Mr. Kranav Kapur, Ms. Annie Jacob, Mr. Jaskaran Bindra and Mr. Ishan Shroff i/by Mr. Rahul Punjabi for the Respondent/Defendant in IA(L)/13958/2025 and for the Applicants/Plaintiffs in IA/5609/2025

CORAM : SHARMILA U. DESHMUKH, J.
RESERVED ON : 24th APRIL, 2026
PRONOUNCED ON : 6th JULY, 2026

ORDER:

1. These cross-suits are filed claiming infringement of identical trade mark “Bimbo” adopted by the Plaintiff and the Defendant, and for passing off. Common submissions were canvassed, and both Interim Applications are being disposed of by this common order. For the sake of clarity, the parties are referred to as `Bristol Bakery’ and `Grupo Bimbo.’

PLEADINGS IN COMMERCIAL IP SUIT NO 117 OF 2025:

2. Commercial IP Suit No. 117 of 2025 was filed on 17th May, 2023 by Bristol Bakery - a partnership firm of Aspi Jamshed Irani and Cyrus Jamshed Irani, claiming to be engaged *inter alia* in the business of

running a bakery, manufacturing bread and other bakery products, marketed by the Plaintiff including its group entities, i.e. Jimmy Boy, Sunshine Fine Foods, and Arani Foods, since at least the year 1979 under the trade mark “Bimbo”, which has been adopted and derived from the expression “**B**EST **I**N **M**AHARASHTRA **B**EFORE **O**THERS” by appropriating the first letters of the quoted words.

3. The plaint pleads that Jamshed Ardeshir Irani, along with the present partners of Bristol Bakery i.e. Aspi and Cyrus, had entered into a partnership deed on 30th March 1964, which was supplemented by Deed of Partnership dated 1st April 1971, followed by Deeds dated 10th April 1974 and 5th April 1979. Jamshed Irani expired on 26th December 1994, and upon his demise, the present partners decided to continue the same business under the terms and conditions set out in the partnership deed dated 23rd March 1995 with effect from 26th December 1994.

4. Bristol Bakery claims proprietary rights in the “Bimbo” label mark containing “Bimbo” as its leading essential feature by virtue of registration secured on 6th March 1979 in Class 30. The registration is subject to a disclaimer that no right shall be claimed to the exclusive use of the word “Super”. In 1999, Bristol Bakery adopted and started using another unique label while retaining the leading feature “Bimbo”. On 31st July 2007, with the permission of Bristol Bakery,

Aspi Irani filed an application for registration of the second label in Class 30, which was opposed by Grupo Bimbo, and the proceedings are pending. Pursuant to Deed of Assignment dated 13th April 2023 entered into between Aspi Irani and Bristol Bakery, an application has been filed on 17th April, 2023 with the Trade Marks Registry to bring the name of the Bristol Bakery on record, which is pending.

5. Paragraph 8 of the plaint sets out Bristol Bakery's clientele of the products bearing the trade mark "Bimbo". The copies of the sales invoices/letters in respect of the products are appended to the plaint. In paragraph 9, the statement of the annual sales figures in respect of the goods bearing the trade mark "Bimbo" from the year 1994–1995 till 2021–2022 is set out. The copies of the pamphlets issued in the year 1992 as promotional material are placed on record along with copies of the invoices raised by the printers/advertisers.

6. It is submitted that Grupo Bimbo filed notice of opposition on 11th February 2010 against the registration of Bristol Bakery's second label mark, based on registrations secured by Grupo Bimbo in Class 30 on 23rd August 1993, in Classes 29 to 33 on 31st January 2007 for the word mark "Bimbo", and for the label mark "Bimbo" on 25th May 2007. A counter-statement dated 6th January 2011 was filed by Aspi Jamshed Irani, and affidavits of evidence have been filed by both parties. It is stated that the affidavit of evidence of Grupo Bimbo

makes it clear that its trade mark registrations were not in use as on the date of filing of notice of opposition and even at the time of filing of affidavit of evidence. No proceedings were initiated by Bristol Bakery against Grupo Bimbo's registrations as there was no use of the trade mark Bimbo in India by Grupo Bimbo.

7. It is only in March, 2023 that Bristol Bakery learnt about the proposed launch by Grupo Bimbo in India, and a trade mark registry search revealed further registrations secured by Grupo Bimbo in India on a proposed-to-be-used basis and as against the registrations, rectification applications have been filed. In April 2023, Bristol Bakery found actual sale of impugned goods in Mumbai and internet search also revealed advertisements and promotion of the impugned goods, and hence the Suit came to be filed.

8. The written statement by Grupo Bimbo takes the defence of delay, acquiescence and estoppel. It traces the incorporation of the entity in Mexico in the year 1945, the adoption of the unique coined mark "Bimbo" by its founder in the year 1943 for his bakery/bakery business and trade and the earliest registration in Mexico in the year 1943. It is stated that Grupo Bimbo has approximately 1,085 trade mark registrations of Bimbo in over 70 countries and, along with its group entities, has operations in 34 countries including India. The historical conception, evolution and use of the trade mark "Bimbo"

has been consistently represented on Grupo Bimbo's websites, which are accessible globally.

9. It is stated that by the year 1970, Grupo Bimbo's "Bimbo" was a leading mark and name in America and Latin America. The worldwide turnover for the year 2022 was to the tune of 22,953 million USD, and the turnover of its Indian arm for the year 2022 was INR 12,429.1 million. The specimen advertisements, press releases, promotional expenses, annual reports are annexed to the written statement to demonstrate goodwill and reputation.

10. Grupo Bimbo's prominent presence in 12 states in India is claimed by virtue of joint ventures with Ready Roti, Modern, and Kitty Bread. The written statement further sets out the sales revenue and promotional expenses incurred by Modern Food Enterprises Limited and Ready Roti in India, pre and post-acquisition by Defendant No. 1, duly certified by a Chartered Accountant. The written statement further sets out the recognition on the global platform of the trade mark Bimbo.

11. Grupo Bimbo's Indian registration was on 23rd August 1993, and the list of Indian registrations is annexed to the written statement. Bristol Bakery's application in the year 2007 for registration of the second label mark of "Bimbo" was opposed by Grupo Bimbo.

12. It is pleaded that Grupo Bimbo's joint venture with Ready Roti in 2017, its acquisition of Modern Food Enterprises Pvt Ltd. in 2020 and of Kitty Breads in the year 2021 were widely publicised. In the year 2019, Grupo Bimbo's trade mark "Bimbo" was affixed on the packaging of products sold under the trade mark "Harvest Gold". It is stated that there were discussions between the parties during October, 2020 to September, 2022 with respect to the acquisition of Bristol Bakery's impugned mark, which negotiations failed, and thereafter the rectification petitions came to be filed.

13. Bristol Bakery's registration is assailed as fraudulent as the label mark registered in the year 1979 is identical to that of Grupo Bimbo's label mark, 14 years after incorporation of the Grupo Bimbo and 35 years after adoption of its trade mark. The explanation given by Bristol Bakery for adoption of the trade mark is assailed as unrealistic as Bristol Bakery operates in a limited area in Mumbai. The recent use of the word mark "Bimbo" along with "Bristol Bakery" on its website is stated to be with the sole intention of riding upon the goodwill, trans-border reputation and brand value of Grupo Bimbo's mark and brand "Bimbo".

PLEADINGS IN COMMERCIAL IP SUIT NO 189 OF 2025:

14. Commercial IP Suit No. 189 of 2025, filed by Grupo Bimbo in September, 2023, is essentially a reproduction of the stand adopted in

the written statement filed in Commercial IP Suit No. 117 of 2025. There is no written statement filed by Bristol Bakery as of date.

15. In the affidavit in reply to the Interim Application, the case of Bristol Bakery in Commercial IP Suit No. 117 of 2025 has been reiterated. In addition, insofar as the passing off action is concerned, it is contended that the relevant date for passing off is 2023, when Bristol Bakery learnt from its market sources that Grupo Bimbo's products bearing the impugned trade mark/name Grupo Bimbo/Bimbo were available for purchase. It is stated that even assuming Grupo Bimbo's presence in India since the year 2017, Bristol Bakery has acquired enormous goodwill and reputation in the said trade mark in India and the annual sales for the years 2016–2017 and 2017–2018 were to the tune of INR 14,53,88,472/- and INR 16,79,47,768/- respectively. The impugned trade mark/name was not used in respect of any goods or services in India, as the trade mark applications dated 23rd September 2022, 4th April 2023, 26th October 2023, and 24th May 2024 were all filed on a proposed-to-be-used basis.

16. It is stated that there is no challenge to Bristol Bakery's registration of the mark "Bimbo" secured on 6th March 1979 and prior to the year 1979, Grupo Bimbo had not acquired any reputation or trans-border reputation in India. Grupo Bimbo's business

expansion/joint venture with Ready Roti India Private Limited around mid-2017 or the acquisition of Modern Food Enterprises Pvt. Ltd. in 2020, and acquisition of Kitty Breads by Grupo Bimbo in 2021 were not within the knowledge of Bristol Bakery.

17. The negotiations between the parties were without prejudice negotiations and cannot be relied upon by Grupo Bimbo. It is submitted that the defence of acquiescence or estoppel cannot be raised, as Bristol Bakery was unaware of Grupo Bimbo's alleged international presence since 1943 or the alleged domestic presence only by reason of registration since 2010 or acquisition since 2017. It is contended that Grupo Bimbo was well aware that Bristol Bakery was prior adopter and registered proprietor of the trade mark in India since 1979, and permitted Bristol Bakery's business to grow and thereby acquiesced/consented to the use of the trade mark by Bristol Bakery.

SUBMISSIONS:

18. Mr. Kadam, learned Senior Advocate for Bristol Bakery, has reiterated the positive case of Bristol Bakery's adoption of the mark Bimbo in India since the year 1979 as set out in the plaint. He has painstakingly taken this Court through the pleadings in Bristol Bakery's plaint, the documents appended to the plaint, the registration secured by Bristol Bakery, the promotional material and

invoices, the sales figures etc. He submits that there is sufficient material on record to show prior open continuous and extensive use of the trade mark Bimbo by Bristol Bakery since the year 1979.

19. He would submit that as both parties are registered proprietors, the inquiry is confined only in respect of passing off action. He submits that Bristol Bakery's adoption and use of the trade mark Bimbo in India is 14 years before Grupo Bimbo's first Indian registration in 1993 and 40 years before Grupo Bimbo placed any Bimbo branded product in the Indian market. To substantiate the said submission, he has taken this Court through the averments in paragraphs 13 and 14 of the plaint and the affidavit of evidence filed by Grupo Bimbo in opposition proceedings before the trade mark registry. He submits that, in the absence of any use of the trade mark in India, Grupo Bimbo's registration even of the year 1993 is of no consequence and is the reason for non-filing of rectification against the registration secured by Grupo Bimbo and for not instituting the Suit for infringement of the trade mark.

20. He submits that the registration applications by Grupo Bimbo were on a proposed-to-be-used basis and in view of Bristol Bakery's prior registration, Grupo Bimbo's trade mark could not have been registered. He submits that Grupo Bimbo secured registration in the year 1993 without conducting any search prior to registration of the

mark. He submits that there is no question of assailing the registration of Bristol Bakery's trade mark Bimbo, as it does not fit within the narrow window left open by the decision in the case of ***Lupin Ltd. vs. Johnson & Johnson***[1]. He would submit that the defence of Section 12 of the Trade Marks Act, 1999 is also not available to Grupo Bimbo, as there is no concurrent user in India. He submits that, even after securing registration in 1993, Grupo Bimbo did not enter the market for over 25 years and only entered the market with Bimbo-branded products in 2019, i.e., 40 years after Bristol Bakery's adoption of the trade mark in India.

21. He submits that there is no trans-border reputation of Grupo Bimbo's "Bimbo" mark in India as it is only in 2019 that the mark "Bimbo' was affixed by Grupo Bimbo to its product. He submits that Grupo Bimbo's 1993 registration is not supported by any sales or advertisements and there is no material to demonstrate Indian customers' awareness of Grupo Bimbo's mark in 1993 and 2019. He would further point out Grupo Bimbo's statement showing the sales figures for Ready Roti in India for the years 2017 to 2022 and there is no specific pleading that the sales figures are in respect of the Bimbo trade mark or for Harvest Gold or Ready Roti sales figures. He would submit that the Chartered Accountant's certificate filed by Grupo

1 [2015(1) Mh.L.J. 501)

Bimbo in the cross suit relates to sales turnover and advertisement expenses of Modern Food and Kitty Industries as a whole and there is no standalone sales figure or advertisement expenses in respect of Bimbo branded products. He submits that the chartered accountant's certificate cannot substantiate Grupo Bimbo's case of goodwill, reputation, or priority of use.

22. He would take this Court through the published articles about the joint venture of Grupo Bimbo to contend that publication was in Mexico City and places outside India reporting acquisition of stake in Ready Roti and not about launch of Bimbo bread in India. He would further point out that the annual reports of Grupo Bimbo for the year 1979, do not show any presence in India. He would further point out the list of magazines at page 3242 and the list of articles from internet featuring Grupo Bimbo at page 3244 and would submit that it does not show that these magazines and articles describe the 2017 joint venture, which were published in Mexico City and places outside India about the acquisitions in Ready Roti. He submits that the Facebook page annexed at page 3782 is of the year 2020 and the website extracts produced by Grupo Bimbo do not disclose any date. He submits that the articles about entry in India are all of Mexico City.

23. He submits that the news articles published in India refer to the deal between Harvest Gold and Grupo Bimbo and do not constitute

evidence of use of the mark in India. He would further point out that the photographs of the product packets produced by Grupo Bimbo show the use of the mark Bimbo in the year 2019. He would further point out that, in the reply affidavit, Grupo Bimbo has claimed recognition by the year 1970 in America and Latin America and in 1980, claims to have been listed on the Mexico National Stock Exchange, whereas Bristol Bakery had secured its registration in the year 1979. He submits that there was no percolation of Grupo Bimbo's reputation and goodwill in India.

24. He submits that, with full knowledge of Bristol Bakery's prior registration and use in India in view of opposition by Grupo Bimbo in the year 2010, Grupo Bimbo entered India in the year 2017 through joint venture and sold Bimbo branded products in the year 2019 and is now estopped from claiming prejudice.

25. He submits that there is no delay or acquiescence as Bristol Bakery instituted the proceedings immediately upon discovering Grupo Bimbo's products in the Indian market in April, 2023. He submits that as Grupo Bimbo had no business and no products in India bearing the trade mark till 2019, there is no occasion for Bristol Bakery to stand by from 1993 to 2019.

26. He submits that, insofar as passing off action is concerned, the relevant date for actionable goodwill in India is the date of Grupo

Bimbo's user in India, i.e. 2017 or 2019. User in India has to be seen and the actionable goodwill as on the date of his entry in India is relevant, i.e. in 2017 or 2019 as injunction is only against use in India.

27. He submits that Bristol Bakery is the prior adopter of the mark, and has produced enough evidence to establish goodwill and reputation since 1979 and points out that the total sales figures from the year 1994 to 2021 is approximately INR 213 crores. He submits that a passing off action lies on the basis of the sales turnover, irrespective of whether the chartered accountant's certificate has been produced on record. In support, he relies upon the following decisions :

> ***(i) Toyota Jidosha Kabushiki Kaisha vs Prius Auto Industries Ltd. And Ors.[2]***
>
> ***(ii) M/s. Kores (India) Limited vs. M/s. Whale Stationery Products Ltd.[3]***
>
> ***(iii) Reed Elsevier Properties Inc. and Ors vs. Best Media Associates (India) Pvt. Ltd.[4]***
>
> ***(iv) Sumit Vijay and Another vs Major League Baseball Properties Inc & Anr.[5]***
>
> ***(v) Neon Laboratories Ltd. vs. Medical Technologies Ltd.[6]***
>
> ***(vi) Sun Pharmaceutical Industries Limited vs. Emcure Pharmaceuticals Ltd.[7]***

2 (2018) 2 SCC 1
3 2008 (3) Mh.L.J. 523
4 2009 SCC OnLine Bom 1742 : (2010) 1 Bom CR 839 : (2010) 1 AIR Bom R 543
5 2026 SCC Online Del 2
6 (2016) 2 SCC 672
7 2012 (49) PTC 243(Bom)

(vii) Cadila Pharmaceuticals Limited vs. Sami Khatib[8]

(viii) Laxmikant V. Patel vs. Chetanbhai Shah & Anr.[9]

(ix) Ramnish Verma & Anr. vs. The Haddad Apparel Group Ltd. & Ors.[10]

(x) Consolidated Foods Corporation vs. Brandon & Company Pvt. Ltd.[11]

(xi) Lupin Ltd. vs. Johnson & Johnson *(supra)*

(xii) Syed Moideen vs. Sulochana Bai[12]

(xiii) Rush & Tompkins Ltd. vs. Greater London Council & Anr.[13]

(xiv) Bal Pharma Ltd. vs. Centaur Laboratories Pvt. Ltd. & Anr.[14]

(xv) Pidilite Industries Ltd. vs. Riya Chemy[15]

(xvi) Dr. Ashok M. Bhat vs. Sandeep Udai Naraian Gupta & Anr.[16]

(xvii) Shaw Wallace & Co. Ltd. vs. Castle Douglas Industries & Mohan Rocky Spring Water Brewery Ltd.[17]

28. Mr. Chander Lall, learned Senior Advocate appearing for Grupo Bimbo would submit that Bristol Bakery has not filed written statement in Commercial IP Suit No. 189 of 2025 and the suit is liable to be decreed. He submits that as Bristol Bakery's registration is illegal and fraudulent, the relief of infringement of trade mark is also pressed along with passing off.

8 AIR 2011 (NOC) 399 (Bom)
9 (2002) 3 SCC 65
10 2025 SCC OnLine Bom 3785
11 AIR 1965 Bom 35
12 (2016) 2 SCC 683 : (2016) 2 SCC (Civ) 201 : 2015 SCC OnLine SC 1084
13 (1988) 3 WLR 939
14 2001 SCC OnLine Bom 1176
15 2022 SCC OnLine Bom 5077
16 2025 SCC OnLine 2177
17 IPLR 2007

29. He has taken this Court through the rival device marks of Bimbo and would submit that Bristol Bakery has not only adopted Bimbo but also Super Bread, a brand similar to Super Pan of Grupo Bimbo used by them since the year 1943, but also a cartoon character.

30. He would submit that Bristol Bakery commenced its business in the year 1964 and claims to have adopted and used the mark "Bimbo" from the year 1979, which adoption is dishonest. He submits that the word "Bimbo" in the English language is a derogatory word and the explanation given by Bristol Bakery for adoption of the mark is unacceptable as it is an admitted position that Bristol Bakery sells its products in a limited area of Mumbai and not in the whole of Maharashtra. He submits that the explanation does not find place in the opposition proceedings of the year 2010 and is clearly an afterthought. He would further point out that in various documents, Bristol Bakery has described its brand as Bimboo.

31. He submits that Bimbo is a coined word as the word has no meaning in the Spanish language and has been invented by Grupo Bimbo from Bingo and Bambi to evoke an innocent child-like association in the year 1943. Drawing the attention of this Court to the pleadings and the documents produced on record, he points out that Bimbo is registered by Grupo Bimbo in several countries with the

earliest registration in Mexico in the year 1943 and Bristol Bakery's registration in India in the year 1979.

32. He submits that Bristol Bakery is not registered proprietor of the trade mark in the year 1979, as the registration certificate reflects the name of Jamshed Irani as proprietor, who was trading as Bristol Bakery along with Aspi Irani and Cyrus Irani and the year 1979 is not the bar for establishing trans-border reputation. He would further point out that Bristol Bakery has claimed that Jamshed Irani expired in the year 1994 and from 26th December 1994 till 23rd March 1995, when the present partners of the Plaintiff decided to continue the business, there is a gap. He submits that there is no pleading as mandated by Section 42 of the Partnership Act, and no assignment of the trade mark from one partnership firm to the other. He would point out the definition of proprietor under Section 2(v) of the Trade Marks Act to contend that it was Jamshed Irani, who was the proprietor.

33. He would submit that, even for the purpose of passing off, there is no evidence of use by Bristol Bakery in the year 1979. He would further point out that the sales turnover set out in paragraph 9 of the plaint is from the years 1994–1995, which is subsequent to Grupo Bimbo's registration in the year 1993 and is unsupported by Chartered Accountant's certificate or invoice. He would submit that the communications annexed to the plaint are merely requests and self-

serving letters and not sales. He would submit that, despite being called upon, there is no inspection of the original documents provided to the Plaintiff. He would submit that it is only in the year 1987 that there is a communication by a third party to Bristol Bakery. He would further point out that Bristol Bakery claimed to have undertaken extensive advertisements of its trade mark "Bimbo" in the counter-statement, and there is not a single document produced on record before this Court.

34. He would point out that the contents of the communication dated 4th January 2010 annexed at page 201 of Bristol Bakery's plaint show that Aspi Irani is a well-travelled person and that, during his stay in Australia, he was bestowed with a Small Baker Award, which indicates awareness of Grupo Bimbo's global reputation. He would further point out that the same communication also admits the sale of the products in and around Mumbai and not in various parts of Maharashtra. He would further submit that, there is no rectification filed against Grupo Bimbo's registrations and there was no objection on the ground of non-user, which amounts to acquiescence. He would submit that the application for registration of the second label mark by Bristol Bakery was filed by Aspi Irani, who is not permissive user, and Aspi Irani is not the Plaintiff in Bristol Bakery's Suit. He submits that it is only in the year 2023, that a Deed of Assignment has been

executed between Aspi Irani and the Plaintiff to bring the name of the Plaintiff on record, which application is also pending.

35. He submits that despite Grupo Bimbo claiming goodwill and reputation in India in the opposition proceedings of the year 2010, Bristol Bakery being aware of Grupo Bimbo's registration has chosen not to take any action. He would submit that there were negotiations between the parties in the year 2022 and, therefore, there is suppression by stating Bristol Bakery became aware of Grupo Bimbo only in the fourth week of March 2023. He would submit that misrepresentation is evident from the fact that Bristol Bakery, on its packaging, the photograph of which is annexed at page 88 of the plaint, mentions "under licence from Bimbo", whereas there is no entity such as "Bimbo", and the same creates an impression that there is a licence from Grupo Bimbo.

36. He would point out the notice of opposition filed by Grupo Bimbo, which repeats and reiterates the registration of Grupo Bimbo's trade mark and its reputation and goodwill in India. He submits that, from the year 1993 to 2007, Grupo Bimbo secured about 15 registrations, which were not opposed by Bristol Bakery. He would further submit that, in its evidence, Grupo Bimbo has furnished an explanation for the adoption of its mark "Bimbo". He submits that

Grupo Bimbo is the registered proprietor of the mark “Bimbo” and is the prior user of the mark in India.

37. He would further submit that Grupo Bimbo had publicised its expansion in India in the year 2017 by extensive advertisements and news articles. He would point out to the various news articles and extracts from magazines produced on record. He would further submit that the products of Modern Foods were branded by Grupo Bimbo’s trade mark and points out to the photographs produced by Grupo Bimbo.

38. He would further submit that there is no explanation which has been tendered by Bristol Bakery for adoption of the word “Super Bread” or the cartoon device, which is identical/deceptively similar to Grupo Bimbo’s trade mark. He submits, based upon the discovery of Grupo Bimbo in the year 2023, Bristol Bakery had pressed for ad-interim reliefs thereby causing irreparable injury to Grupo Bimbo. He submits that even if Grupo Bimbo succeeds after trial, it cannot be adequately compensated and, therefore, the balance of convenience lies in favour of Grupo Bimbo. He submits that the negotiations between the parties failed, as an exorbitant amount of about Rs. 200 crores was demanded by Bristol Bakery and that the present Suit is a consequence of Grupo Bimbo’s refusal to accede to the said demand.

39. He would further submit that it is only upon a party filing an application under Section 124 of the Trade Marks Act raising a plea of invalidity of the Plaintiff's and/or Defendant's registration that the Civil Court can apply its mind to the issue. He submits that Grupo Bimbo has filed an application under Section 124 of the Trade Marks Act, whereas no such application has been filed by Bristol Bakery and therefore, the plea of invalidity of the registration can only be considered *qua* Bristol Bakery and not against Grupo Bimbo. In support, he relies upon the following decisions:

i. ***Caribjet Inc. vs. AIR India Limited***[18]
ii. ***Reed Elsevier Properties Inc. & Ors. vs. Best Media Associates (India) Pvt. Ltd. (supra)***
iii. ***Toyota Jidosha Kabushiki Kaisha vs Prius Auto Industries Ltd. & Ors. (supra)***
iv. ***Carlton Shoes Ltd. & Ors. vs. VIP Industries Ltd.***[19]
v. ***VIP Industries Ltd. vs. Carlton Shoes Ltd. & Anr.***[20]
vi. ***S. C. Cambatta & Co. Pvt. Ltd. vs. Commissioner of Excess Profits Tax, Bombay***[21]
vii. ***Daiwa Pharmaceuticals Co. Ltd. vs. Daiwa Pharmaceuticals Pvt. Ltd. & Ors.***[22]
viii. ***Corona Remedies Pvt. Ltd. vs. Franco-Indian Pharmaceuticals Pvt. Ltd.***[23]
ix. ***Torrent Pharmaceuticals Ltd. vs. Wockhardt Ltd. & Ors.***[24]

18 2005(2) Mh.L.J. 461
19 MANU/DE/4605/2023
20 FAO (OS) (COMM) 151/2023 dated 25/07/2023
21 (1961) 41 ITR 500 : 1960 SCC OnLine SC 231
22 2024 SCC OnLine Bom 1078
23 2023 SCC OnLine Bom 833
24 2017 SCC OnLine Bom 9666

x. ***Brihan Karan Sugar Syndicate Pvt. Ltd. vs. Yashwantrao Mohite***[25]

xi. ***Aktiebolaget Volvo of Sweden vs. Volvo Steels Ltd.***[26]

xii. ***N. R. Dongre & Ors. vs. Whirlpool Corp.***[27]

xiii. ***Milmet Oftho Industries & Ors. vs. Allergan Inc.***[28]

xiv. ***Austin Nichols & Co. vs. Arvind Behl***[29]

xv. ***Brewster Transport Co. Ltd. vs. Rocky Mountain Tours & Transport Co. Ltd.***[30]

xvi. ***Jolen Inc. vs. Doctor and Company***[31]

xvii. ***M/s. SCG Contracts India Pvt. Ltd. vs. K.S. Chamankar Infrastructure Pvt. Ltd.***[32]

xviii. ***Commissioner of Income Tax vs. E. Kathawala & Co.***[33]

xix. ***Patel Field Marshal Agencies & Ors. vs. P. M. Diesels Ltd.***[34]

xx. ***The Trustees of Princeton University vs. The Vagdevi Educational Society & Ors.***[35]

xxi. ***Oswaal Books and Learning Pvt. Ltd. vs. Registrar of Trade Marks***[36]

xxii. ***Grasim Industries Ltd. & Anr. vs. Saboo Tor Pvt. Ltd. & Ors.***[37]

xxiii. ***The Supreme Industries Ltd. vs. Moorthi Rabeha***[38]

xxiv. ***Lacoste & Anr. vs. Crocodile International Pte. Ltd.***[39]

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25 2023 SCC OnLine SC 1163 : (2024) 2 SCC 577
26 1997 SCC OnLine Bom 578
27 1995 SCC OnLine Del 310
28 (2004) 12 SCC 624
29 2005 SCC OnLine Del 1276
30 1930 CanL II 36 (SCC) SC
31 2002 SCC OnLine Del 518
32 2019 SCC OnLine sC 226
33 1983 SCC OnLine Bom 441
34 (2018) 2 SCC 112
35 2025 SCC OnLine Del 6296
36 2025 SCC OnLine Del 4113
37 COMIPL/422/2022
38 COMIPL/336/2025
39 2024 SCC OnLine Del 5591

xxv. ***Minco India Pvt. Ltd. vs. Minco India Flow Elements Pvt. Ltd.***[40]

xxvi. ***Sun Pharmaceutical Industries Ltd. vs. Meghmani Lifesciences Ltd.***[41]

xxvii. ***M/s. Power Control Appliances vs. Sumeet Machines Pvt. Ltd.***[42]

xxviii. ***Rynox Gears vs. Steelite India***[43]

xxix. ***Century 21 Real Estates LLC vs. Century 21 Town Planners Pvt. Ltd.***[44]

xxx. ***Ramnish Verma & Anr. vs. Haddad Apparel Group Ltd. (supra)***

xxxi. ***Grupo Bimbo vs. Ishan Saluja & Ors.***[45]

xxxii. ***Grupo Bimbo vs. Cheferd Foods Pvt. Ltd.***[46]

xxxiii. ***Ramdev Food Products (P) Ltd. vs. Arvindbhai Rambhai Patel & Ors.***[47]

xxxiv. ***Staples INC & Anr. vs. Staples Paper Converters Pvt. Ltd.***[48]

xxxv. ***Wockhardt Limited vs. Eden Healthcare Pvt. Ltd.***[49]

xxxvi. ***Diamond Modular Pvt. Ltd. vs. Vikash Kumar & Anr.***[50]

40. In rejoinder, Mr. Kadam would object to certain documents relied upon by Mr. Lall which are not part of the pleadings of Grupo Bimbo, as well as certain decisions which are overruled and/or are pending before the Appellate Court. He submits that the express

40 COMIPL/12477/2024
41 COMIPL/353/2025
42 (1994) 2 SCC 448
43 COMIPL/35513/2024
44 Com. Misc. Petition/857/2022 Bombay HC Dated 6/3/2026
45 C.S. (COMM) 306/2024 Delhi HC
46 C.S. (COMM) 1016/2024 Delhi HC
47 (2006) 8 SCC 726
48 2014 SCC OnLine Del 2092
49 2014 SCC OnLine Bom 163
50 (2025) 2 High Court Cases (Del) 677

averment in Bristol Bakery's plaint about the surviving partners deciding to continue the same business has not been traversed by Grupo Bimbo, which constitutes an admission. He would further submit that, for the first time, in the written statement it has been alleged by Grupo Bimbo that Bristol Bakery is not the proprietor of the trade mark and it is not a pleaded case in the suit filed by Grupo Bimbo.

41. He submits that the registration details confirming Bristol Bakery's proprietorship of the trade mark are annexed at page 70 of Bristol Bakery's plaint. He submits that, in Bristol Bakery's Suit, there is no application filed under Section 124 by Grupo Bimbo and, therefore, the registration must be treated as valid and subsisting for the purpose of the present proceedings. He would submit that Bristol Bakery has produced 134 documents spanning over four decades showing continuous and extensive use of the trade mark "Bimbo" from 1979 onward, including third-party documents, and the total sales are about INR 213 crores. He submits that the production of a Chartered Accountant's certificate is not a mandatory prerequisite. He would submit that the registrations of Grupo Bimbo's trade mark registrations have been assailed by Bristol Bakery by filing about 15 rectification applications prior to the filing of the present Suit.

42. He would submit that the size of an entity is irrelevant for determining prior user and being a prior registered proprietor in India, Bristol Bakery prevails over the alleged global stature of subsequent entrant Grupo Bimbo.

43. He would further submit that the contention that Aspi Irani was a well-travelled person and, therefore, must have been aware of the mark, is not a pleaded case of Grupo Bimbo. He would deny that the sales of Bristol Bakery are restricted only to Dadar and Mumbai. He submits that, for the purpose of goodwill, what can be considered is a long period of business and a reasonable sales and Bristol Bakery is a senior user of the mark having sufficient goodwill.

44. He submits that being the prior adopter of the mark in India, Bristol Bakery is not required to give any explanation for adoption. He submits that it is preposterous to suggest that, in the year 1979, when Bristol Bakery adopted the mark, it had anticipated Grupo Bimbo's future entry in India. He submits that, at the time of adoption of the mark, Grupo Bimbo had no presence, no sales and no advertisements in India.

45. He would further submit that the negotiations between the parties were without prejudice and cannot be relied upon by Grupo Bimbo to support its case of delay and acquiescence and is an argument more of prejudice and suppression.

46. He would submit that there are no invoices produced by Grupo Bimbo to show use of the mark since the year 2019 and the Chartered Accountant's certificate is about the entirety of the sales and there is no stand-alone figure is shown of "Bimbo". He submits that the mentioning on Bristol Bakery's packet of the words "under licence from Bimbo" is for the reason that "Bimbo" is the source identifier. He submits that there is no question of acquiescence, as in the year 2010, when opposition proceedings were filed, as there was no use of the mark by Grupo Bimbo in India. He would submit that balance of convenience is in favour of Bristol Bakery, as it is in the business since the year 1979 and has produced evidence of user. He submits that Grupo Bimbo's reputation abroad is not a defence to the action for passing off and Grupo Bimbo had knowingly taken a chance of entering the market in India in the year 2019.

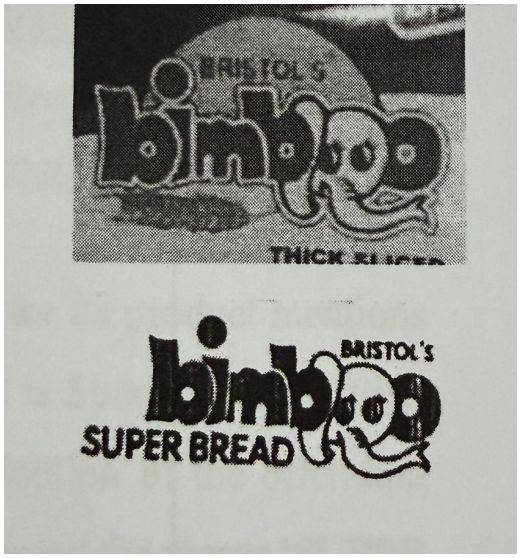
47. He would further submit that there is no suppression of material facts, as the knowledge of Grupo Bimbo's 2017 joint venture is not the same as knowledge of the products bearing the trade mark being sold in the Indian market and, in any event, is a disputed question of fact which cannot be conclusively determined at the interlocutory stage. He would further submit that the period of 120 days for filing the written statement commences from the date of service of the writ of summons and Bristol Bakery disputes that valid

service has been effected and therefore, the time to file the written statement has not yet commenced.

48. Mr. Lall, in sur-rejoinder, would submit that Mr. Kadam has not answered the question as to which firm is the registered proprietor of the trade mark "Bimbo", insofar as Bristol Bakery is concerned.

49. Rival contentions now fall for determination.

50. The cross suits seek to restrain the other party from the use of the identical mark "Bimbo" which is the essential leading feature of their respective trade marks in respect of identical products i.e. bread. The device marks of Grupo Bimbo and Bristol Bakery are reproduced hereinbelow for comparison:

Trade Mark of Grupo Bimbo **BIMBO**	**Trade Mark of Bristol Bakery** BIMBO
	

51. Bristol Bakery had applied and secured registration of its device mark "Bimbo" on 6th March, 1979. The application for registration of the word mark "Bimbo" was filed by Bristol Bakery on 22nd February, 2008 and its status is shown as abandoned. On the other hand, Grupo Bimbo secured registration of its trade mark "Bimbo" in Mexico on 15th January, 1944 and subsequently secured approximately 1,085 trade mark registrations of Bimbo in over 70 countries. In India, Grupo Bimbo secured registration of device mark "Bimbo" on 23rd August, 1993 and thereafter secured various registrations of the trade mark Bimbo.

52. The issue of the similarity between the rival marks is not debated for the simple reason that the essential, leading and prominent feature of both the marks is "Bimbo". Prima facie upon comparison of the device marks, it is "Bimbo" which is prominent. Though Mr. Lall would contend that the cartoon characters of both the marks have the possibility of creating confusion, in my view, the distinction between the cartoon characters is evident. The similarity arises by use of the mark "Bimbo".

53. Mr. Kadam, in view of the registrations secured by both the parties, would confine his relief at this stage only in respect of passing off. Mr. Lall in his arguments would press for infringement as well as passing off, though his written submissions tendered on 27th March,

2026 in paragraph 41 submits that as both parties are registered proprietors, though actions initiated are infringement actions, at present the action would have to be passing off action. To avoid any conflict, this Court has considered Grupo Bimbo's claim for infringement as well.

54. I would first prefer to deal with the relief of infringement of trade mark sought by Grupo Bimbo. The statutory provisions of Section 29 of the Trade Marks Act, 1999 governing the infringement of trade mark explicitly sets out the various acts which constitute infringement by a person who is not a registered proprietor or permitted user.

55. Section 12 of the Trade Marks Act, 1999 permits registration by more than one proprietor of trade marks which are identical/similar in respect of the same or similar goods or services in case of honest concurrent user.

56. Section 28(1) provides that, subject to the other provisions of the Act, the registration of the 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 the Act. Sub-section (3) of Section 28 provides that where two or more

persons are registered proprietors of identical/similar trade marks, the exclusive right to use of the trade mark shall not be deemed to have been acquired against the other person merely by registration but against third-party unregistered users, in the same way as if he was the sole registered proprietor.

57. Section 30 of the Trade Marks Act, 1999 limits the effect of a registered trade mark and sub-section (2) of Section 30 carves out an exception to the exclusive rights conferred by registration of trade marks in eventualities set out in the clauses therein. Clause (e) of sub-section (2) of Section 30 negates infringement where the use of a registered trade mark, being one of two or more trade marks registered under this Act which are identical/similar to each other, in exercise of right to the use of that trade mark given by registration under the Act.

58. The statutory framework would indicate that the enactment recognises existence of more than one registered proprietor of an identical/deceptively similar trade mark in certain eventualities. Upon such registration being secured by more than one person, the statutory exclusivity conferred on the registered proprietor is curtailed. Section 27 of the Trade Marks Act, 1999, however, saves the common law rights of trade mark owners against any person for passing off, be it the registered proprietor of a trade mark. The

Hon'ble Apex Court in the case of ***S. Syed Moideen vs. Sulochana Bai*** (supra) held that as per Section 28(3), the owner of a registered trade mark cannot sue for infringement of it against another trade mark which is registered and that the provisions of Section 27(2) as regards the passing off would still be available.

59. To sustain the claim of infringement against Bristol Bakery, though Bristol Bakery is the registered proprietor, the pleading of Grupo Bimbo in paragraph 22 of its plaint, assails the validity of registration of Bristol Bakery's trade mark as being *ex facie* fraudulent and illegal and violation of Grupo Bimbo's prior existing trade mark. The pleading of illegality and invalidity is premised on the ground that the adoption and consequent registration of Bristol Bakery's trade mark is vitiated by fraudulent misrepresentation to the Trade Marks Registry, and that fraud invalidates and vitiates all acts. The fraudulent misrepresentation stems from Grupo Bimbo's claim of international registrations and worldwide reputation prior to the adoption and use of the mark by Bristol Bakery.

60. The Trade Marks Act, 1999 is a territorial Act and recognises registrations secured under the enactment. Section 9 of the Trade Marks Act, 1999 deals with the absolute grounds for refusal and Section 11 deals with relative grounds of refusal of registration. The statutory provisions provide that a mark which by reason of

identity/similarity to earlier registered trade mark and similarity/ identity of goods is likely to cause confusion on the part of the public which includes likely association with the earlier registered trade mark should not be registered. It is thus the identity/similarity to the earlier registered trade mark which may be refused registration.

61. Section 11 of the Trade Marks Act deals with the relative grounds for refusal of registration and sub-section (3) provides that the trade mark shall not be registered, if or to the extent, that its use in India is liable to be prevented by virtue of law of passing off. The embargo on registration in cases falling under sub-section (3) of Section 11 is subject to a caveat under sub section (5) of Section 11 that objection should be raised by proprietor of earlier trade mark. Admittedly, Bristol Bakery's trade mark registration of the year 1979 was not opposed by Grupo Bimbo. As such Bristol Bakery's registration could not have been refused by the trade mark registry under the law of passing off.

62. Section 31 of the Trade Marks Act, 1999 provides that the registration of a trade mark is *prima facie* evidence of its validity. The registration protects the registered proprietor against an action for infringement and at the interlocutory stage, the inquiry which can be conducted by a Court into the validity of registration is set out in the Full Bench decision of this Court in ***Lupin Ltd. vs. Johnson & Johnson***

(supra). The issue was as to the powers of the Court to venture into the question of validity of registration of the trade mark at an interlocutory stage upon defence of invalidity of registration being taken. The relevant conclusion in paragraph 59(3), (5), (6) and (8) reads as under:

> **"59.** (3) A challenge to the validity of the registration of the trade mark can finally succeed only in rectification proceedings before the Intellectual Property Appellate Board. However, there is no express or implied bar taking away the jurisdiction and power of the Civil Court to consider the challenge to the validity of the trade mark at the interlocutory stage by way of prima facie finding. (Paras 34 and 53)
>
> (5) However, a very heavy burden lies on the defendants to rebut the strong presumption in favour of the plaintiff on the basis of the registration at the interlocutory stage. The plaintiff is not required to prove that the registration of a trade mark is not invalid, but only in the cases where the factum of registration is ex facie totally illegal or fraudulent or shocks the conscience of the Court that the Court may decline to grant relief in favour of the plaintiff. (Paras 25, 27 and 55)
>
> (6) It is not sufficient for the defendant to show that the defendant has an arguable case for showing invalidity. The prima facie satisfaction of the Court to stay the trial under section 124 of the Act is not enough to refuse grant of interim injunction. It is only in exceptional circumstances, such as, the registration being ex facie illegal or fraudulent or which shocks the conscience of the Court that Court will refuse the interim injunction in favour of the registered proprietor of the trade mark. (Para 57)
>
> (8) Though it is considered as a practice of this Court in granting injunction in favour of the plaintiff having a

> registered trade mark, the same cannot be treated as a total embargo on the power of the Court to refuse grant of interim injunction. In exceptional cases, that is in cases of registration of trade mark being ex facie illegal, fraudulent or such as to shock the conscience of the Court, the Court would be justified in refusing to grant interim injunction. (Para 33)"

63. The Hon'ble Full Bench upheld the power of the Court to travel beyond the registration but with the caveat that the same can be done only in exceptional cases where the registration is *ex facie* illegal or fraudulent or which shocks the conscience of the Court. The threshold to be met is not that of *prima facie* arguable case of invalidity but a higher threshold of *ex facie* illegality or fraud or which shocks the conscience of the Court. The fraud/illegality claimed by Grupo Bimbo is adoption of identical mark despite Grupo Bimbo's alleged international registrations and worldwide reputation, which is referable to the relative ground for refusal of registration under Section 11(3) and requires satisfaction of Section 11(5), which is missing. As to the worldwide reputation, Grupo Bimbo claims that in the year 1970, "Bimbo" was leading mark in America and Latin America, not even a case of worldwide reputation. The criteria of fraud by reason of Grupo Bimbo's alleged reputation confined to America and Latin America in the year 1970 is not sufficient to stamp the registration of Bristol Bakery as invalid. The registration of Bristol Bakery's trade mark in the year 1979 does not shock the conscience of

the Court as being vitiated by fraud on the ground of Grupo Bimbo's alleged reputation in America and Latin America. Grupo Bimbo's case of invalidity does not fit in the small window left open by **Lupin** decision for the Court at this stage to answer the issue of invalidity of Bristol Bakery's mark in favour of Grupo Bimbo.

64. Even if the plea of invalidity of Bristol Bakery's trade mark is raised by Grupo Bimbo under Section 124 of Trade Marks Act, the Hon'ble Full Bench has held that the prima facie satisfaction of the Court to stay the trial under Section 124 of the Trade Marks Act, 1999 is not enough to refuse grant of interim injunction. For a plea of invalidity to fit in the small window left open in ***Lupin's*** case, the burden to be discharged is heavy and rightly so as the registration of the trade mark confers statutory rights on the proprietor which should not be interfered with lightly.

65. As both the parties have secured registrations of their trade marks, which is not shown to be *ex facie* illegal, fraudulent or such, which shocks the conscience of the Court, Grupo Bimbo's claim for infringement of trade mark at this stage fails.

66. Whilst on the subject of registrations secured by Bristol Bakery, I deem it fit to deal with the challenge raised by Mr. Lall to the right of Bristol Bakery to maintain the action for infringement or passing off on the ground that it is not the registered proprietor of the trade

mark Bimbo. The argument canvassed is that the (a) registration stands in the name of apparently dissolved partnership firm of Jamshed Irani, Aspi Irani and Cyrus Irani, which dissolution took place upon death of Jamshed Irani on 16th December, 1994 (b) in the partnership deed of 23rd March, 1995 between Aspi Jamshed Irani and Cyrus Jamshed Irani, there is no mention of "Bimbo" and (c) that the firm name is Bristol Bakery and not Bimbo Bristol Bakery, a name now adopted.

67. In Commercial IP Suit No. 189 of 2025, Grupo Bimbo has impleaded Bristol Bakery through its partners Aspi Jamshed Irani and Cyrus Jamshed Irani and the plaint proceeds on the basis of the Bristol Bakery presently comprising of Aspi and Cyrus as partners is the registered proprietor of the trade mark "Bimbo" and seeks relief against Bristol Bakery. Neither in the suit filed by Grupo Bimbo nor in the reply affidavits filed by Grupo Bimbo to the suit of Bristol Bakery have the proprietary rights of Bristol Bakery in respect of the registered device mark "Bimbo" have not been questioned and only validity of the registration has been assailed. The stand that Bristol Bakery is not the registered proprietor of trade mark is not the pleaded case of Grupo Bimbo in its suit and finds place in the written statement filed by Grupo Bimbo. In ***Grasim Industries Ltd. & Anr. vs. Saboo Tor Pvt. Ltd.*** (supra), I have taken a view that principles of

fairness and equity demand that documents should have been part of reply affidavits so that the Plaintiffs could have had an opportunity to deal with the same. The doctrine of fairness and equity demands that all contentions to oppose the grant of interim relief should be pleaded in the affidavits filed by the parties.

68. A pleading tucked in a paragraph in the written statement denying that Bristol Bakery is the actual proprietor of Bimbo without enumerating the specific particulars of the claim, cannot thereafter be mounted as a substantial challenge to the interim injunction sought by Bristol Bakery or to support Grupo Bimbo's case of infringement. The nuanced argument canvassed by Mr. Lall in support of its challenge to Bristol Bakery's proprietary right does not find place in the affidavits filed in response to the interim application giving no opportunity to Bristol Bakery to deal with the same. It is no answer to say that replication could have been filed to deal with the contention. There is no specific traverse of the specific pleading about Aspi Irani and Cyrus Irani continuing with the same old business under the terms and conditions of earlier partnership.

69. Apart from the above, what is placed on record by Bristol Bakery is online status of Bristol Bakery's registration, copy of trade mark application and copy of registration certificate indicating that the device mark of "Bimbo" was applied for registration on 6th March,

1979 with a user claim of 1st January, 1979. The online status shows proprietor's name is shown as Jamshed Ardeshir Irani trading as Bristol Bakery with the partners Aspi Jamshed Irani and Cyrus Jamshed Irani, the registration certificate shows registration in the name of Jamshed Irani, Cyrus Irani, and Aspi Irani. The online status shows that the registration is subsisting, which is *prima facie* evidence of its validity under Section 31 of the Trade Marks Act.

70. As no challenge was raised to Bristol Bakery's proprietary right on the ground of Section 42 of the Partnership Act, no documents were produced by Bristol Bakery to demonstrate whether the earlier partnership provided for the firm to survive upon death of a partner or there was dissolution or whether the assets were transferred to the firm of existing partners. *Prima facie* at this stage, considering the subsisting registration in favour of Bristol Bakery, when read with Section 2(v) of the Trade Marks Act, 1999, the proprietor's name, as per the online status, is Bristol Bakery, which has filed the present suit.

71. Coming to the core issue of passing off, the essence of the tort of passing off is that no trader shall be permitted to trade its goods as that of another and be unjustly enriched from the other party's goodwill and reputation. Passing off requires priority of use, actionable goodwill and reputation on the date when the Defendants

commenced use of the impugned mark, misrepresentation and damage. In present facts, the first question to be answered is "who is the first". Bristol Bakery claims to be the prior user by reason of adoption, use and registration of its trade mark in the year 1979, whereas Grupo Bimbo claims to be prior user having adopted and used the trade mark in Mexico since 1940 with spill over of its worldwide reputation in India even prior to its registration in India in 1993 and affixing of its mark on the product for the first time in 2019.

72. Grupo Bimbo is a Mexican entity incorporated in the year 1945 claiming to have adopted the trade mark in 1943 with the first registration secured in Mexico on 15th January, 1944. Both claim to have invented the mark independently.

73. In ***Brihan Karan Sugar Syndicate Pvt. Ltd. vs. Yashwantrao Mohite*** (supra), the Hon'ble Apex Court noted the decision of ***Satyam Infoway Ltd. v. Sifynet Solutions (P) Ltd.***[51]**,** which held that, if two trade rivals claim to have individually invented the same mark, then the trader who is able to establish prior user will succeed. The question is, as has been aptly put, who gets there first?

74. The pleading in the Bristol Bakery's plaint is that Bristol Bakery is manufacturing and marketing its product under the trade mark "Bimbo" since the year 1979. The online status of registration

51 AIR 1966 Bombay 149

produced by Bristol Bakery shows that the registration application was filed on 6th March, 1979 with user claim of 1st January, 1979. Bristol Bakery has annexed at Exhibit "C" various communications to substantiate its claim of use since the year 1979. The documents from pages 93 to 104 are request communications by Bristol Bakery to third party for supply of bread. At pages 104 and 105 are communications dated 24th April, 1981 and 29th September, 1980 exchanged with Premier Automobile about prices of bread and mentions the mark Bimbo. The communication at page 106 is dated 10th March, 1982 with Godrej Soaps Ltd., mentioning the mark Bimbo. From page 107 onwards there are further communications to third-parties by Bristol Bakery mentioning their product with the mark Bimbo. At page 120 is the communication by Godrej to Bristol Bakery, dated 11th December, 1987 regarding revision of price of bread mentioning the mark Bimbo. There are similar subsequent communications by Bristol Bakery to clients for supply of bread with few communications from third parties to Bristol Bakery. There is a price list of Bristol Bakery dated 24th January, 1992 mentioning the trade mark Bimbo. These communications have been assailed as self-serving documents. In the case of ***Lacoste and Another vs. Crocodile International Pte. Ltd.*** (supra), the Delhi High Court had termed the expression "self-serving" in respect of documents prepared unilaterally by a party to the

litigation and without cross-verification or external validation. The Delhi High Court was considering the probative value of the documentary evidence produced after the trial. At the interlocutory stage, the documents can be looked into as supporting Bristol Bakery's claim of use of the mark since the year 1979. There is also no reason as to why after obtaining registration of the trade mark in Class 30 in the year 1979 and continuing in the business of bakery, Bristol Bakery would not market its product using the trade mark Bimbo.

75. The majority of documents being communications addressed by Bristol Bakery to third parties cannot be a reason to discard the claim of Bristol Bakery of use of its mark after securing registration. Mr. Lall would contend that there is no independent advertisements or invoices prior to the year 1994 or even thereafter to show use of the mark. The product in respect of which the trade mark is used is average-priced bread. It cannot be expected that in the era of 1980/1990, in respect of daily-use commodity in India, there would be extensive advertisements and promotional material. In the absence of fierce brand competition in the earlier decades, the absence of widespread advertisement and promotional material is justified and cannot take away the fact of use of the mark by Bristol Bakery on that ground. Bristol Bakery has also placed on record the purchase order

dated 30th September, 1996 by Bharat Petroleum Corporation Ltd for supply of "Bimbo" bread. For establishing the use of the mark in the year 1979/1980, the material placed on record by Bristol Bakery is sufficient.

76. Grupo Bimbo asserts its claim of prior user by reason of prior international registrations and worldwide reputation pre-dating Bristol Bakery's registration, which reputation is claimed to have percolated in India. Before scrutinising the documents placed on record by Grupo Bimbo in support of its claim of trans-border reputation, it would be apposite to refer to the judicial pronouncements on the issue.

77. In case of ***Ahmed Perfumes LLC & Ors. vs. Mohammed Faisal Rehman Sulant Ahmed Shamsi***[52]**,** this Court had the occasion to consider the issue of passing off and trans-border reputation. This Court summarised the law enunciated in various decisions as under:

> "The judicial pronouncements have settled the tests for passing off and trans-border reputation, which can be summarised as under:
>
> (a) In ***N.R.Dongre And Ors. vs Whirlpool Corporation And Anr.*** (supra), the Plaintiff did not make out a case of actual sales in India, however, had advertised its products in international

52***IA/1405/2026 in COMIP/711/2025 decided on 07/05/2026***

magazines having circulation in India. The Hon'ble Apex Court approved the findings of the Hon'ble Division Bench that even advertisement of the trade mark without existence of goods in the market is also to be considered as use of the trade mark.

(b) In ***Milmet Oftho Industries And Ors. vs Allergan Inc*** (supra), the Hon'ble Apex Court, in context of medicinal preparations, noted its agreement with the view in ***N.R.Dongre And Ors. vs Whirlpool Corporation And Anr.*** (supra), observing that medical literature is freely available in India, goods are widely advertised in newspapers, periodicals, magazines and other media available in India which results in products acquiring worldwide reputation.

(c) The decision of ***Toyota Jidosha Kabushiki Kaisha vs Prius Auto Industries Ltd. And Ors.*** (supra) is an authoritative pronouncement on the subject and the Hon'ble Apex Court favoured the territoriality principle over the universality principle. It held that the Courts have to determine if there has been a spill over of the reputation and goodwill of the mark used by the Claimant who has brought the passing off actions and to ascertain the existence of not necessarily a real market but the presence of the claimant through its mark within a

particular territorial jurisdiction. The Hon'ble Apex Court further held in paragraph 32 as under:

> "32. Prof Christopher Wadlow's view on the subject appears to be that the test of whether a foreign claimant may succeed in passing off action is whether his business has a goodwill in a particular jurisdiction, which criterion is broader than the "obsolete" test of whether a claimant has a business/place of business in that jurisdiction. If there are customers for a claimant's products in that jurisdiction, then the claimant stands in the same position as a domestic trader."

The Hon'ble Apex Court noted the decision in ***Starbucks (HK) Ltd. And Anr. vs British Sky Broadcasting Group And Ors.***[53], where the UK Supreme Court observed as under:

> "52. As to what amounts to a sufficient business to amount to goodwill, it seems clear that mere reputation is not enough…. The claimant must show that it has a significant goodwill, in the form of customers, in the jurisdiction, but it is not necessary that the claimant actually has an establishment or office in this country. In order to establish goodwill, the claimant must have customers within the jurisdiction, as opposed to people in the jurisdiction who happen to be customers elsewhere. Thus, where the claimant's business is carried on abroad, it is not enough for a claimant to show that there are people in this jurisdiction who happens to be its customers when they are abroad. However, it could be enough if the claimant could show that there were people in this jurisdiction who, by booking with, or purchasing from, an entity in this country, obtained the right to receive the claimant's services abroad. And, in such a case, the entity need not be part or branch of the claimant; it can be someone acting for or on behalf of the claimant."
>
> (Emphasis supplied)

53 (2015) 1 WLR 2628

The Hon'ble Apex Court noted the decision in ***Athlete's Foot Marketing Associates Inc v Cobra Sports Ltd.***[54] as under:

> "...no trader can complain of passing off as against him in any territory ..in which he has no customers, nobody who is in trade relations with him. This will normally shortly be expressed by stating that he does not carry on any trade in that particular country….but the inwardness of it will be that he has no customers in that country…"

In ***Starbucks (HK) Ltd. And Anr. vs British Sky Broadcasting Group And Ors.*** (supra), the UK Supreme Court considered the issue as to whether a claimant who is seeking to maintain an action for passing off need only establish a reputation among a significant section of the public within the jurisdiction, or whether such a claimant must also establish a business with customers within the jurisdiction. It noted that Goodwill as subject of proprietary rights is incapable of subsisting by itself having no independent existence apart from the business to which it is attached. It held in paragraph 47 as under:

> "47. ….In other words, I consider that we should reaffirm that the law is that a claimant in passing off claim must establish that it has actual goodwill in this jurisdiction, and that such goodwill involves the presence of clients or customers in the jurisdiction for the products or services in question. And, where the claimant's business is abroad, people who are in the jurisdiction, but who are not customers of the claimant in the jurisdiction, will not do, even if they are customers of the claimant when they go abroad."

54 [1980] RPC 343

In ***Bolt Technology OU vs Ujoy Technology Pvt. Ltd. And Anr.*** (supra), the Delhi High Court summarised the principles of ***Toyota Jidosha Kabushiki Kaisha vs Prius Auto Industries Ltd. And Ors.*** (supra) in passing off and trans-border reputation as under:

> "72. Several important principles emerge from these passages, which may be enumerated as under:
> (I) The territoriality principle applies: not the universality doctrine. Existence of goodwill and reputation has, therefore, to be shown to exist in India. Universal or worldwide goodwill and reputation sans any evidence of territorial goodwill and reputation, is not sufficient.
> (ii) Mere reputation is not enough. The claimant/plaintiff must show that it has significant goodwill.
> (iii) The actual existence of an office of the plaintiff in the country of the defendant is not necessary.
> (iv) However, the claimant must have customers within the country of the defendant, as opposed to persons in the defendant's country who are customers elsewhere. Thus where the claimant's business is carried on abroad, it is not enough for the claimant to show that there are people in the defendant's country who happen to be his customers when they are abroad.
> (v) However, it would be enough if the claimant could show that there were people in the defendant's country who, by booking with, or purchasing from an entity in the defendant's country obtained the right to receive the claimant's service abroad. The person from whom such booking or purchase took place could be the claimant or its branch office or someone acting for or on behalf of the claimant.
> (vi) The claimant must be "present through its mark in the territorial jurisdiction" of the country of the defendant' though the existence of "real market" was not necessary.
> (vii) Such presence could, for instance, be shown by extensive advertisement which had been circulated

> and seen, or read, in the country of the defendant.
> (viii) Once the existence of trans-border reputation and goodwill was thus established, the claimant was not required, further, to prove the existence of actual confusion. The likelihood of the customer of average intelligence and imperfect recollection being confused, by the use of the impugned mark of the defendant, that the goods or services by the defendant were those of the claimant-plaintiff was sufficient."

In ***Daiwa Pharmaceuticals Co. Ltd. vs Daiwa Pharmaceuticals Pvt. Ltd. And Ors.*** (supra), this Court held in paragraph 86 as under:

> "86. A relevant factor to be borne in mind is that the Plaintiff's mark is in respect of pharmaceutical products. It has been held by the Supreme Court in Milmet (Supra) which has been followed by the Delhi High Court in Mayo Foundation (Supra), decisions relied upon by the Plaintiff, that in the event the material relied upon by the Plaintiff prima facie shows that the Plaintiff's product was advertised before the Defendant entered the field, the Plaintiff being the first to adopt the mark, is then able to maintain an action for passing off.The mere fact that the Plaintiff has not been using the mark in India would be irrelevant if they were first in the world market. Thus, there does appear to be special segment carved out for pharmaceutical products and the test of trans-border reputation would in my view have to be liberal and such reputation may be derived from advertisement and publicity of the Plaintiff's mark and cited in Indian newspapers, magazines and online publications..."

78. Applying the above enunciation of law to the facts of present case, to sustain its case of prior user, Grupo Bimbo is required to establish its presence through its mark in India even prior to Bristol Bakery's registration of the year 1979. The claim of physical presence is of the year 2017 by entering into joint venture with Ready Roti and

use of its trade mark is in the year 2019. Whether, 38 years prior to Grupo Bimbo entering into the Indian market, its worldwide reputation had percolated in India is the question.

79. Grupo Bimbo substantiates its claim of trans-border reputation by placing reliance on the extracts from the Plaintiff's website, social media pages featuring Grupo Bimbo, advertisements and press releases issued worldwide. It relies upon its numerous websites across the world in different countries, which are dedicated to the trade mark "Bimbo", and are also accessible to its users globally. The claim of trans-border reputation is based on the social media handles, website extracts, advertisements and promotion. In ***Toyota Jidosha Kabushiki Kaisha vs. Prius Auto Industries Ltd.*** (supra), the Hon'ble Apex Court considered whether Toyota's mark had disseminated through media and advertisements, and it noted that there must be adequate evidence to show that the Plaintiff therein had acquired a substantial goodwill, as the car itself was introduced in the Indian market in the year 2009-2010 and that information on the internet, even if accepted, will not be a safe basis to hold the existence of the necessary reputation and goodwill of the product in the Indian market at the relevant point of time, particularly having regard to the limited online exposure at that point of time, i.e. the year 2001.

80. Grupo Bimbo seeks to rely on its online presence in the year 1979 and considering that the Hon'ble Apex Court has termed internet exposure limited in the year 2001, it is safe to accept that online exposure must be definitely negligible in the year 1979. The mere existence of Grupo Bimbo's websites in developed countries is not sufficient to hold that its reputation had spilled over in India as its websites were accessible to its users globally.

81. The relevant extracts from Grupo Bimbo's websites feature the historical conception, adoption and evolution of the mark "Bimbo" and "OSITO Bimbo". A perusal of Annexure-1 does not indicate any India-dedicated website and the references to the evolution of "Bimbo" in the year 1970–1980 is in respect of Latin America. The reference to India in Annexure-1 is for the period from 2010–2020, where it is mentioned that India is now part of the team. Annexure-2 are the select screenshots of the website of Defendant No. 1, which shows evolution of Grupo Bimbo and makes a reference to acquisition of 65% shares of Ready Roti India Private Limited, which was founded in the year 1993. The acquisition is admittedly of the year 2017 and does not show any presence in India prior to 2017. Annexure-3 is the select printouts of Grupo Bimbo's websites stated to be accessible globally. Considering the limited internet exposure and availability in India in the year 1979, the material produced by Group Bimbo is insufficient to

come to a *prima facie* finding that in the year 1979, when Bristol Bakery adopted and registered its trade mark "Bimbo", Grupo Bimbo's global reputation and goodwill had permeated into India. Insofar as the Facebook pages are concerned, the same appear to have been created on 20th February 2014, as disclosed from page 208 forming part of Annexure-3. The presence on social media platforms appears to be post 2010. The association of Grupo Bimbo with well-known brands, the list of international registrations or the list of various group entities do not demonstrate spill over of its reputation in India. The website extracts of Grupo Bimbo sets out the evolution of Grupo Bimbo since the year 1955 and unless it is shown that the trans-border reputation has permeated into India, the documents are irrelevant for consideration.

82. Insofar as the specimen advertisements and press releases issued by Grupo Bimbo are concerned, at Annexure-11, Grupo Bimbo has listed the press releases and advertisements. However, there is no advertisement which is shown to have been targeted for Indian customers or released in India. Mr. Lall has not demonstrated that any of these advertisements were available in India or had circulation within India. The awareness of a foreign brand amongst Indian customers is an essential aspect to demonstrate goodwill and reputation. It also needs to be noted that Grupo Bimbo's product is

bread, which is a daily perishable product and cannot be said to be a product with which Indian consumers would keep themselves updated by accessing websites or social media handles, even if the same are accessible globally. The advertisements and promotional material are *prima facie* not demonstrated to have any circulation in India and, without the awareness of the Indian customers about Grupo Bimbo's brand, the existence/presence of Grupo Bimbo in the local market cannot be accepted. The acquisition of goodwill in other jurisdictions, much prior to the use and registration of the "Bimbo" trade mark by Bristol Bakery does not assist the case of Grupo Bimbo, as there is virtually an absence of any sales of Grupo Bimbo's products in the Indian market at the time when Bristol Bakery secured registration of its mark and a virtual absence of any advertisement of the products in India at the relevant time.

83. In ***Daiwa Pharmaceuticals Co. Ltd. vs Daiwa Pharmaceuticals Pvt. Ltd. And Ors.*** (supra), the learned Single Judge of this Court had, in the facts of that case, held that the Plaintiff's reputation had spilled over into India and had taken note of the explanation which has been tendered by Defendant No. 1 therein to hold that the same indicated a dishonest intention behind the adoption of the trade mark Daiwa. In present facts, Bristol Bakery has secured registration of the mark in the year 1979, when Grupo Bimbo had not even entered into the

Indian market. Being the first in India to adopt the said trade mark, it is not necessary for Bristol Bakery to justify the adoption of the trade mark. It also needs to be noted that the case of Daiwa Pharmaceutical Company Limited was in the context of pharmaceutical products, and the relevant market segment lays emphasis on medical journals and the conferences which update doctors about pharmaceutical products that may be launched abroad. It is in that view that the learned Single Judge held that there was a spill-over of reputation into India. The learned Single Judge has specifically noted that there thus appears to be a special segment carved out for pharmaceutical products and that the test of trans-border reputation would have to be liberal.

84. In ***The Trustees of Princeton University vs The Vagdevi Educational Society & Ors*** (supra), the Plaintiff therein had predicated its case on actual use of the mark in India and not on the principle of trans-border reputation. The newspaper articles on which reliance was placed were Indian newspapers. The Delhi High Court held that use of mark is defined as a use thereof to make a statement about the availability, provision or performance of such services in relation to which the mark is used. It accepted the news articles as proof of actual use of mark . It noted that the Indian students were being targeted by the Plaintiff and were going to the University of the Plaintiff in large numbers, shows availability, provision and

performance of services being rendered by the Plaintiff under its mark, thereby establishing its goodwill and reputation in India. The factual scenario in the present case is completely different as there is no actual use of the mark in India till the year 2019 and no spill-over of reputation and goodwill.

85. In ***Kores (India) Ltd vs Whale Stationery Products Ltd*** (supra), this Court enunciated the territoriality principle and the saving provisions of Section 34 of Trade Marks Act, 1999 in paragraph 10 and 11 as under:

> **"10.** The savings provision embodied in Section 34 inter alia to a situation where a person has continuously used a trade mark from a date prior to the use of the registered trade mark in relation to those goods or services by the proprietor of the mark prior to the date of registration of the mark. Prima facie, at the present stage, it emerges from the record before the Court that the Plaintiff is the registered proprietor in India of the trade mark KORES. The initial registration of the mark dates back to 1943. At this stage, the record before the Court would indicate that after the lapsing of the initial registration the Plaintiff applied for and obtained registration of the word mark KORES and of the associated device of a lady typist which continues to subsist on the register of trade marks. The Defendant claims to be in the process of moving an application for rectification but it is an admitted position that as of the date of these proceedings, the mark and the device continue to be registered in the name of the Plaintiff. That being the position, the Defendant would within the territory of India be entitled to the benefit of the saving contained in Section 34 the Act provided, that it establishes before the Court a continuous user of the trade mark from a date prior to the use of the registered trade mark by the Plaintiff. There is prima facie a complete absence in the record of material that would show a prior, continuous or

concurrent user of the trade mark by the Defendants in the territory of India.

11. The Trade Marks Act, 1999, has territorial operation within the territory of India. While considering the provisions of the Trade and Merchandise Marks Act, 1958, Mr. Justice P.B. Mukharji observed in *Aktiebolaget Jonkoping Vulcan v. V.S.V. Palancichamy Nadar (AIR 1969 Calcutta 43)* the provisions of the Act must be understood to refer to use within the territory of India and not use abroad. The Learned Judge held that the registration of a mark and its continuance on the register were exclusively within the scope and ambit of domestic law. That was a case involving rectification. The learned Single Judge held thus:

> "The Trade Mark law is not extraterritorial; that use abroad in foreign countries under foreign registration can be use within the meaning of the Indian Trade and Merchandise Marks Act of 1958. This statute is an Act which provides for registration and better protection of trade marks and for the prevention of the use of fraudulent marks on merchandise. That is its preamble. That preamble I read as confined to the territorial limits of India. Section 1(2) of the statute extends it to the whole of India. The statute establishes trade marks register for India. The definition of a trade mark in Section 2(v) speaking of use in relation to goods must in my opinion be understood as use within the territory of India and not use abroad. On the authorities quoted above and on the principles that I have just mentioned I am of the opinion that under Section 46 the Trade and Merchandise Marks Act, 1958 the word "use" employed therein is use within India. Naturally if it is not used in India that would be a ground for removal from the Indian register. I cannot imagine that a foreign use or use abroad or outside India could be pleaded as a sufficient ground for retaining a registered Trade Mark on the Indian Trade Mark register. I cannot import any extraterritorial notion to construe the Indian Trade and Merchandise Marks Act, 1958 to cover foreign use. I am of the opinion that registration of a Trade Mark and its continuance on the register are exclusively within the scope and ambit of domestic and national law."

86. In the case of ***Sumit Vijay and Another vs Major League Baseball Properties Inc.*** (supra), the learned Single Judge of the Delhi High Court had struck off the registered `Blue-J' trade mark of the Appellants under Section 57(2) of the Trade Marks Act, which came to be reversed by the Division Bench. The Hon'ble Division Bench has held that the existence of goodwill in the mark which has been imitated is therefore the *sine qua non* of any passing off action. Apart from goodwill, the other two requisites for any passing off action to succeed are misrepresentation by the tortfeasor and resulting damage to the other. It further held that the mere fact that the `Blue-J' mark figured on websites which are accessible in India or figured on merchandise which could be purchased in India cannot amount to use of the mark in India. The Hon'ble Division Bench considered the decisions on trans-border goodwill and reputation, which decisions have also been relied upon in the present case, and held that the availability of a mark on a website can again be no indicator of trans-border goodwill or reputation percolating into a particular country such as India, as such an indicator would amount to every mark of every entity having trans-border reputation in every country in the world. It further held that positive assertions regarding the number of times the website has been accessed in India would also have to be pleaded. Mere availability of products on an e-commerce website or

on the website of the owner of the mark would not suffice as proof of trans-border goodwill or reputation, as it has to be shown that orders were actually placed or purchases effected, to a considerable extent, of the goods bearing the mark from within India. It held that if the other has no goodwill or reputation, the very *raison d'être* of alleging passing off fails. The existence of sufficient goodwill and reputation has to be established prior to the adoption of the mark by the Defendant.

87. In ***Reed Elsevier Properties Inc. & Ors. vs. Best Media Associates (India) Pvt. Ltd.*** (supra), this Court considered Section 34 of Trade Marks Act, 1999 in the context of prior user claimed by foreign entity. It held that Section 34(a) pertains to the use of the mark in India and not anywhere in the world.

88. In ***Austin Nichols & Co. vs. Arvind Behl*** (supra), the Delhi High Court followed the decision of the Hon'ble Apex Court in ***Milmet Oftho Industries & Ors. vs Allergan Inc.*** (supra). The Delhi High Court did not accept that the Plaintiffs were prior users of the trade mark in India. The Court held that the Plaintiff's product was known in India, that the Plaintiff's predecessor in interest had intention of directly exploiting the Indian market and had applied for permission to manufacture in India since 1993. The Defendant therein was manufacturing the Blender's Pride whisky only for a few months

during 1993–1994 and thereafter stopped its manufacture for as long as 11 years, till sometime in 2005. In such facts the Delhi High Court held that the merely being first past the post in India is not enough and the Plaintiffs were first past the post worldwide, which is important. The decision turned on the facts of that case.

89. The judicial pronouncements underscore that the "use" as contemplated under Section 2(v) of Trade Marks Act, 1999 is to be understood as "use" within the territory of India and not use abroad. The documents of Grupo Bimbo may well establish its prior use abroad but in so far as India is concerned, there is no prior user or spill-over of its reputation and goodwill in the year 1979. The issue of prior user is answered in favour of Bristol Bakery.

90. The discussion above and the finding that there was no prior user and spill over of Grupo Bimbo's reputation and goodwill in India will answer the case of passing off claimed by Grupo Bimbo. Grupo Bimbo claims that for purpose of passing off, apart from trans-border reputation, it has reputation and goodwill by virtue of direct use and sales in India since the year 2017. The relevant date for assessing goodwill in an action for passing off is the date on which the Defendant commences use of the mark. Grupo Bimbo must demonstrate actionable goodwill and reputation in India when Bristol Bakery commenced the use of its mark in the year 1979/1980, at

which time, Grupo Bimbo had no actionable goodwill and reputation in India. [(See ***Sun Pharmaceutical Industries Ltd. vs Emcure Pharmaceuticals Ltd.*** (supra), ***Ramnish Verma & Anr vs The Haddad Apparel Group Ltd & Ors*** (supra)]. The global sales turnover of Grupo Bimbo for the years from 1978 onwards does not result in actionable goodwill and reputation in India in the absence of its percolation in India in the year 1979. Goodwill, as held, is the subject of a proprietary right, incapable of subsisting by itself, having no independent existence apart from the business to which it is attached. Admittedly the actual sales in India by affixing the trade mark "Bimbo" by Grupo Bimbo commenced in the year 2019.

91. The essence of passing off is that no trader should be allowed to unjustly enrich itself at the cost of another's goodwill and reputation and, if there is no trans-border goodwill and reputation, which is shown to have permeated into India, the foundation of passing off is eroded. In the absence of such spill-over of the Grupo Bimbo's goodwill and reputation in India, there is no *prima facie* case of passing off made out by Grupo Bimbo. An action for passing off requires actionable goodwill and reputation at the relevant date, misrepresentation and damage to be established conjunctively. In the absence of actionable goodwill and reputation on the date on which

Bristol Bakery commenced using the mark, there is no occasion to consider misrepresentation and damage.

92. Grupo Bimbo alleges dishonesty in adoption by the trade mark "Bimbo" claiming that the explanation for adoption is an afterthought and did not find place in the opposition proceedings. In the case of ***Jolen Inc. v. Doctor Company*** (supra), the Delhi High Court considered the justification given by the Defendants therein for the adoption of the trade mark Jolen as unbelievable. It further held that to expect a foreign trading company of repute to copy a trade mark from a small-time trader is mind-boggling and hard to ram down the throat. Bristol Bakery has adopted the mark in the year 1979 and, being a prior adopter at a time when Grupo Bimbo had no presence in the Indian market, Bristol Bakery is not required to explain the adoption.

93. I am also not inclined to accept that in view of the contents of the communication dated 4th January, 2010, that Aspi Irani in his stint in Australia has been bestowed an award indicates that he was well-travelled and aware of Grupo Bimbo's reputation and goodwill. The contention is too far-stretched to be accepted. The communication of 4th January, 2010 solicits purchase orders and exemplifies the skill of Aspi Irani without any mention as to the period of his travel to Australia. The trade mark has been adopted and registered in the year 1979. It is difficult to digest that in the year 1979, with an intent to

ride upon Grupo Bimbo's international reputation and goodwill, Bristol Bakery adopted the mark or that it anticipated that in future, Grupo Bimbo would enter the Indian market.

94. Grupo Bimbo also alleges misuse of the Grupo Bimbo's cartoon device, as some of the documents describe Bristol Bakery's mark as "Bimboo Bunny", and "bunny" according to Mr. Lall is closer to Grupo Bimbo's cartoon device. The documents carrying the description of Bimboo Bunny are tax invoices raised by printers of plastic bags for Bristol Bakery. The manner of description by third parties of Bristol Bakery's trade mark cannot support a claim of dishonest adoption by Bristol Bakery. The adoption of Super Bread as copying of Grupo Bimbo's Super Pan cannot be held against Bristol Bakery as the words are descriptive and the reason for the disclaimer issued by trade mark registry while granting registration of Bristol Bakery's trade mark. The use of the word "BIMBO" by Bristol Bakery, when compared with Grupo Bimbo's word mark of "BIMBO" does not show copying of the stylisation as alleged. Both marks being identical when depicted in capital letters would be depicted in the same manner. Similarly, the misrepresentation alleged on the ground of use of the words "under licence from Bimbo" is unacceptable as Grupo Bimbo and Bristol Bakery's trade mark is "Bimbo". The words are not "under licence from Grupo Bimbo", which could have been viewed as misrepresentation to

the consumer by Bristol Bakery, that its product is marketed as that of Grupo Bimbo. This discussion is despite the fact that, in the absence of any goodwill or reputation being shown by Grupo Bimbo at the relevant time when Bristol Bakery adopted the mark in the year 1979, there is no further need to examine the aspect of misrepresentation.

95. Dealing now with Bristol Bakery's claim of passing off against Grupo Bimbo, Bristol Bakery claims that Grupo Bimbo commenced the use of the trade mark in the year 2019. In its plaint, Grupo Bimbo has pleaded that in or around mid-2017, Grupo Bimbo entered into a joint venture with Ready Roti India Ltd and in the year 2019, Grupo Bimbo's trade mark was affixed on the packaging of products sold under the trade mark "Harvest Gold". By its own admission, Grupo Bimbo entered the Indian market using the trade mark Bimbo in the year 2019, which would be the relevant date for purpose of passing off.

96. In paragraph 9 of its plaint, Bristol Bakery has set out its sales turnover from the year 1994–1995 till 2021–2022 and, insofar as the period 2019–2020 is concerned, the sales are claimed to be of Rs. 16,40,68,046/-. Apart from the bare pleading in the plaint, there is no document on record to substantiate the sales turnover.

97. In ***Brihman Karan Sugar Syndicate Pvt. Ltd. vs. Yashwantrao Mohite*** (supra), the Hon'ble Apex Court has held that, for establishing goodwill of a product, it was necessary for the Appellant to prove not

only the figures of sales of the product but also the expenditure incurred on promotional and advertisement of the product. While deciding an application for temporary injunction in a suit for a passing off action, in a given case, the statement of accounts signed by the Chartered Accountant of the Plaintiff indicating the expenses incurred on advertisement and promotion and the figures of sales may constitute material which can be considered for examining whether a *prima facie* case was made out by the Appellant/Plaintiff.

98. The Hon'ble Apex Court has held that it is not essential for the Plaintiff to prove long user to establish reputation in a passing off action. It would depend upon the volume of sales and extent of advertisement. The decision lays emphasis on the volume of sale and the extent of advertisement as a relevant consideration and Bristol Bakery was, therefore, required to *prima facie* prove the sales turnover and also the expenditure incurred on promotion and advertisement of the product for establishing goodwill.

99. This decision is sought to be distinguished by Mr. Kadam by pointing out that the issue before the Hon'ble Apex Court as regards the proof of volume of sales and extent of advertisement was after trial and, in that case, at the time of final hearing of the Suit, the figures were not proved. The observations of the Hon'ble Apex Court assume significance, as it is specifically held that a statement of

accounts signed by a Chartered Accountant may constitute material for establishing a *prima facie* case of goodwill of the product.

100. It cannot be disputed that goodwill is associated with a business and the sales turnover is an indicator of the goodwill achieved by the party. It may not be necessary to have a comparative assessment of the sales turnover of the rival products, however, the sales turnover cannot be accepted merely on bald assertion in the plaint unsupported by a Chartered Accountant's certificate. Bristol Bakery claims a sales turnover of about Rs. 16 crores for the relevant period and its accounts would have been audited. There are no audit reports, promotional material, or advertisement expenses produced on record to demonstrate goodwill and reputation.

101. The market situation which prevailed in 1980/1990 changed considerably with the advent of foreign brands in Indian markets leading to greater emphasis on advertisement and promotions to sustain a foothold in the relevant segment. The goodwill and reputation came to be intrinsically linked with the volume of sales and advertisement and promotional material. The goodwill and reputation must be shown to exist as such that the relevant consumer base associates the mark Bimbo with Bristol Bakery and no other. It is only when such association is formed in the minds of end users that a case for passing off would be made out by use of identical trade mark by

other party. The material produced by Bristol Bakery is insufficient to come to such a *prima facie* finding of association of trade mark BIMBO with Bristol Bakery. Pertinently, in ***Toyota Jidosha Kabushiki Kaisha vs. Prius Auto Industries Ltd.*** (supra), the Hon'ble Apex Court has considered that a limited sale of the product and the absence of advertisement would show lack of goodwill.

102. The unsubstantiated sales figure, the negligible advertisement and promotional material damages Bristol Bakery's claim of goodwill and reputation at the relevant date to sustain an action for passing off. As there is no goodwill and reputation demonstrated, the other consideration of misrepresentation and damage does not arise for consideration.

103. There is yet another reason for declining the interim relief to both the parties. Bristol Bakery, in its Suit, has referred to the notice of opposition dated 11th February 2010 filed by Grupo Bimbo against the registration of Bristol Bakery's second label mark. Bristol Bakery's claim is that in the fourth week of March 2023, Bristol Bakery learnt that Grupo Bimbo was likely to launch the impugned goods bearing the impugned trade mark in India. The notice of opposition, which was filed in the year 2010, repeats and reiterates about the registration of the trade mark "Bimbo" by Grupo Bimbo in India and its reputation and goodwill which had percolated in India. The notice of opposition

also claims that Bristol Bakery's trade mark is confusingly and deceptively similar to Grupo Bimbo's registered trade mark “Bimbo”. In the counter by Bristol Bakery, it is claimed that Bristol Bakery has been using the trade mark “Bimbo” since the year 1979 and that it was not aware of the existence of Grupo Bimbo’s products, as Bristol Bakery has not come across any of Grupo Bimbo's products in India and they have not come across any advertisement in print/electronic media relating to Grupo Bimbo's products. In the evidence in support of the opposition, Grupo Bimbo as well as Bristol Bakery have reiterated the stands taken in the notice of opposition and counter-opposition.

104. It is *prima facie* evident that both parties were aware of each other's registrations. No steps were, however, taken by either of the parties to initiate any proceedings till the present Suit came to be instituted by Bristol Bakery on 17th May 2023 and thereafter by Grupo Bimbo on 1st September 2023. There is also a reference to negotiations between the parties during the period 2020-2022, which subsequently failed in the year 2022. Even accepting that the 2017 acquisition of Ready Roti by Grupo Bimbo was not to the knowledge of Bristol Bakery, considering that the notice of opposition reiterates Grupo Bimbo’s registration and presence in India, it cannot be accepted that Bristol Bakery was unaware of the Grupo Bimbo’s

existence *per se*. The negotiations in the year 2020 indicate awareness about launch of the product in the year 2019 as there can be no other reason to commence negotiations.

105. No steps were taken by Bristol Bakery for filing a rectification application after learning about Grupo Bimbo's registration in the year 2010 by way of opposition proceedings. It was not awareness of the registrations but the fact that Grupo Bimbo opposed Bristol Bakery's registration of the second label mark, which should have set the alarm bells ringing for Bristol Bakery as the opposition indicated an obvious intent to enter the Indian market. Bristol Bakery waited not only for Grupo Bimbo to enter the Indian market but also waited for four years thereafter, which is nothing but acquiescence.

106. Grupo Bimbo, on the other hand, in view of the opposition proceedings was well aware of Bristol Bakery's registration and with little efforts could have learnt about the use of the mark in the market. Grupo Bimbo does not say that till the filing of its suit, they were not aware of Bristol Bakery's use of the mark and their case is that before 1993, there was no use of the mark by Bristol Bakery.

107. In the case of ***Power Control Appliances and Others vs. Sumeet Machines Private Limited*** (supra), the Hon'ble Apex Court has held as under:

> **"26.** Acquiescence is sitting by, when another is invading the rights and spending money on it. It is a course of conduct inconsistent with a claim for exclusive rights in a trade mark, trade name, etc. It implies positive acts: not merely silence or inaction such as is involved in laches. In *Harcourt v. White*, Sir John Romilly said: 'It is important to distinguish mere negligence and acquiescence.' Therefore, acquiescence is one facet of delay. If the Plaintiff stood by knowingly and let the Defendants build up an important trade until it had become necessary to crush it, then the Plaintiffs would be stopped by their acquiescence. If the acquiescence in infringement amounts to consent, it will be a complete defence, as was laid down in *Mouson (J.G.) & Co. v. Boehmann*. The acquiescence must be such as to lead to the inference of a licence sufficient to create a new right in the Defendant, as was laid down in *Rodgers v. Novwill*."
>
> **"28.** ……. Delay simpliciter may be no defence to a suit for infringement of a trade mark, but the decisions to which I have referred to clearly indicate that where a trader allows a rival trader to expend money over a considerable period in the building up a business with the aid of a mark similar to his own, he will not be allowed to stop his rival's business. …….".

108. Delay simpliciter may not be a defence in a suit for infringement of trade mark. However, in the present case, it is very clear from the material placed on record that both parties were aware of the registration of each other's marks. Grupo Bimbo and Bristol Bakery have allowed each other to build up their businesses with the assistance of a trade mark, which both parties agree are identical/deceptively similar to each other's trade marks.

109. Even if accepting that, in the year 2010, when the notice of opposition was filed, Bristol Bakery was under the impression that the

mark had merely been registered without any intention of Grupo Bimbo to enter into the market, it cannot be denied that, in the year 2017, there was an acquisition of MODERN BREAD by Grupo Bimbo. The acquisition is a strong indicator of Grupo Bimbo entering into Indian market and, despite thereof, Bristol Bakery chose to sit back for almost six years before filing of the present suit. Being in the same market segment, Bristol Bakery cannot claim that it was unaware of the acquisitions of Grupo Bimbo since the year 2017. The case of both the parties would, therefore, be impacted by acquiescence on each other's part, denying them the relief of an interim injunction.

110. Mr. Lall would seek decree of its suit, as no written statement has been filed by Bristol Bakery till date. In ***M/s. SCG Contracts India Pvt. Ltd. vs. K.S. Chamankar Infrastructure Pvt. Ltd. & Ors.*** (supra), the consequence of non-filing of a written statement or forfeiture of right to file written statement has been reiterated. In the present case, Bristol Bakery has disputed the valid service of writ of summons to contend that the timeline of 120 days has not yet commenced. Apart from the fact that Grupo Bimbo will still have to prove its case, at this stage, it is not possible to conduct a mini-trial in order to ascertain whether the writ of summons has been duly served in order to decree the suit filed by Grupo Bimbo.

111. In the case of ***Wockhardt Limited vs. Eden Healthcare Private Limited*** (supra), the learned Single Judge of this Court was considering an issue of infringement, where the rival marks were identical, i.e., SPASGAN. In that case, the Plaintiffs had applied for registration of the mark on 22nd April 1996, claiming user since 1st January 1991, and the Defendant claimed user since 1998. This Court considered the provisions of Section 23 of the Trade Marks Act, to hold that the statutory rights of the registered proprietor relate back to the date of application for registration, then the adverse common law claim to the statutory right of the registered proprietor, by alleging use of a mark prior to the registered proprietor but subsequent to the date of application for registration by the registered proprietor, would render the provisions of Section 23 meaningless. This decision would assist the case of Bristol Bakery, which has secured registration of its trade mark Bimbo in the year 1979 and, therefore, would be entitled to statutory protection of its trade mark against infringement. Mr. Kadam has, in view of the subsequent registration, confined his relief only in respect of passing off. Grupo Bimbo's registration in India is of the year 1993, which is subsequent to the registration secured by Bristol Bakery.

112. The decision in the case of ***Commissioner of Income Tax v. E. Kathawala and Company*** (supra) was pressed into service in support

of the submission that the death of a partner dissolves the partnership firm, in order to substantiate the arguments about the proprietary right of Bristol Bakery to the trade mark Bimbo. In light of the discussion above, as regards the *prima facie* validity of the registration, the decision does not assist the case of Grupo Bimbo.

113. In the case of ***The Trustees of Princeton University v. The Vagdevi Educational Society and Others*** (supra), the Delhi High Court held that the provisions of Section 2(2)(c)(ii) of the Trade Marks Act do not stipulate that the use of the mark is to be by the proprietor alone, and that the use of the mark is defined as use thereof to make a statement about the availability, provision, or performance of such services in relation to which the mark is used. As Grupo Bimbo has failed to *prima facie* prove the spill-over of its reputation in India, the decision has no application.

114. In the case of ***Grasim Industries Limited and Another v. Saboo Tor Private Limited and Others*** (supra), this Court held that the relevant date for deciding the reputation and goodwill that existed, is the date of use by Defendant No. 1 therein of its trade mark. This Court followed the well-settled principles and, in the facts of that case, held that no *prima facie* case for infringement or passing off was made out, as Defendant No. 1 therein was the registered proprietor of the trade mark since the year 2008 and there was sufficient

promotional material placed on record to demonstrate the active advertising carried out since the year 2016. In those facts, this Court held that it was difficult to accept that the Plaintiffs were unaware of the use of the registered trade mark by the Defendant No. 1. The decision turned on the facts of the said case. In the present case, based on the material placed on record, this Court has held that Grupo Bimbo's reputation had not percolated into India at the relevant time of adoption of the trade mark by Bristol Bakery.

115. In ***The Supreme Industries Limited v. Moorthi Rabeha*** (supra), there was material produced on record to demonstrate the goodwill and reputation and there was no justification by the Defendant as to how it adopted a mark which was deceptively similar to the Plaintiff's registered trade mark, which had been filed on 24th November 2021 on a proposed-to-be-used basis. The findings in that case were based on the material that had been produced on record. In the present case, the relevant date is the year 1979, and Grupo Bimbo had no presence in India whatsoever.

116. In the case of ***Laxmikant V. Patel v. Chetanbhai Shah and Anr.*** (supra), the Hon'ble Apex Court held that fraud is not a necessary element in an action for passing off and the absence of intention to deceive is no defence. It was further held that as to how the injunction granted by the Court would be shaped depends on the facts and

circumstances of each case. There is no quarrel with the said proposition.

117. The decisions which have been cited, reiterate the well-settled principles which are required to be applied and the decision would differ depending on the facts of each case. In the present case, Bristol Bakery has *prima facie* established prior adoption and use of its mark in the year 1979/1980. For purpose of sustaining an action for passing off, Bristol Bakery has failed to make out a *prima facie* case of goodwill and reputation, as on the relevant date when Grupo Bimbo commenced the use of the mark in the year 2019. There are no certified sales figures, no promotional material or advertisements to sustain the claim of goodwill and reputation of such nature that consumers identified BIMBO with Bristol Bakery.

118. Grupo Bimbo, though adopted and commenced use of its mark in the year 1943 in Mexico, its registration in India in 1993 was subsequent to Bristol Bakery's registration. Grupo Bimbo has *prima facie* failed to prove spill-over of its worldwide reputation and goodwill in India on the date of use of the mark by Bristol Bakery and is not entitled to interim injunction for passing off.

119. Insofar as the infringement action is concerned, Bristol Bakery, at this stage, had confined its relief in respect of passing off, however, Grupo Bimbo insisted on infringement action, which *prima facie* case,

it has failed to make out, in view of the prior registration secured by Bristol Bakery and failing the test of *Lupin* principles. Section 34 of Trade Marks Act, 1999 would protect the use of the trade mark by Bristol Bakery.

120. Grupo Bimbo and Bristol Bakery have acquiesced in the use of the mark "BIMBO" by each other by letting each other's business grow and after failure of negotiations have preferred the suit, which is hit by the principle of acquiescence. The ingredient of balance of convenience demands that neither should be restricted in use of its trade mark and the co-existence, which has continued since such long standing should not be disturbed at the interlocutory stage.

121. In light of the discussion above, Interim Application (L) No. 13958 of 2023 in Commercial IP Suit No. 117 of 2025 and Interim Application No. 5609 of 2025 in Commercial IP Suit No. 189 of 2025 stand dismissed.

[SHARMILA DESHMUKH, J.]