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

% **Date of Decision: 6th March, 2025**

+ C.O. (COMM.IPD-TM) 128/2021

VST INDUSTRIES LIMITED

.....Petitioner

Through: Mr. Hemant Daswani, Ms. Saumya Bajpai and Ms. Pranjal, Advocates
Mob: 9810556744
Email:
delhi@daswanianddaswani.com

versus

ASD TOBACCO PRIVATE LIMITED & ANR.Respondents

Through: Ms. Radhika Bishwajit Dubey, CGSC with Ms. Gurleen Kaur and Mr. Kritarth Upadhyay, Advocates for R-2
M: 9810982927
Email: radhika.arora21@gmail.com

CORAM:

HON'BLE MS. JUSTICE MINI PUSHKARNA

MINI PUSHKARNA, J (ORAL)

1. The present petition has been filed under Section 57 of the Trade Marks Act, 1999 (“**Trade Marks Act**”) seeking rectification of the Trade Mark Register by removal of the mark, i.e. “CHUMS” (“**impugned mark**”) registered in favour of respondent no. 1, bearing registration no. 3960579 in Class 34, with date of application being 30th September, 2018, on account of being phonetically, visually and deceptively similar to the petitioner’s mark.
2. Perusal of the order sheets clearly show that despite various efforts of service undertaken by the petitioner, no one has appeared on behalf of respondent no. 1. Accordingly, this Court has proceeded with matter.



3. Factual matrix, as captured in the petition, is as follows:
- 3.1. The petitioner in the present case was incorporated on 10th November, 1930 under the Hyderabad companies Act, number IV of 1320 Fasli, now governed under the Indian Companies Act, 2013 (“**Companies Act**”).
- 3.2. The petitioner is also a listed company in the Bombay Stock Exchange (“**BSE**”) and National Stock Exchange (“**NSE**”) of India and is engaged in manufacturing and distributing cigarettes under the brand names, TOTAL, CHARMS, GOLD, MOMENTS, EDITIONS etc. The petitioner is also involved in sale and export of unmanufactured tobacco and is the third largest cigarette manufacturing company in India.
- 3.3. The petitioner’s endeavour to manufacture and supply high quality cigarettes at affordable cost, along with the usage of premium blend of tobacco leaves and imported ingredients, has bestowed petitioner with some prestigious awards during years 2008 to 2012.
- 3.4. In the year 1982, the mark “CHARMS” was coined and adopted by the petitioner in relation to cigarettes (“**goods**”) falling under Class 34.
- 3.5. The petitioner’s mark i.e., “CHARMS” became an instant hit due to its superior quality and is very well accepted in the market, wherein, smokers have appreciated the quality products at affordable price, ultimately resulting in sale of Rs. 4,344.01 crores from financial year 2002-2003 to financial year 2018-2019.
- 3.6. One of the variants of goods sold by the petitioner under the mark i.e. “CHARMS” carry a unique artwork/getup/label which *inter alia* comprises of below mentioned intrinsic features:
- (i) The division of the side and front panel carton in two distinct colours (gold and red);



- (ii) The separation of both the colours by a stylish ‘woosh’;
- (iii) Writing of the brand “CHARMS” in a distinctive font in gold colour wherein alphabets ‘C’ and ‘S’ are slightly bigger than the rest of the alphabets;
- (iv) The background red colour has micro gold red checks.

3.7. The plaintiff came in the knowledge of the impugned mark in May, 2019, while browsing through the records of Registrar of Trade Marks and that the respondent no. 1 has obtained the impugned mark i.e., “CHUMS” under trademark number 3960579 claiming the user since 20th August, 2018.

3.8. Hence, the present petition came to be filed.

4. Learned counsel appearing for the petitioner submits that the petitioner has been using its mark, i.e., “CHARMS” since the year 1982, and has gained immense goodwill, not only till date, but the goodwill of the petitioner was established even before the respondent no. 1 had launched its goods into the market.

5. He, thus, submits that the impugned mark of respondent no. 1, i.e., “CHUMS” is phonetically similar to the mark of the petitioner, i.e., “CHARMS”.

6. The attention of this Court has also been drawn to various registrations in favour of the petitioner, with the earliest registration being for the mark “CHARMS” under Trademark application no. 396340, with date of application being 11th October, 1982, and user detail being 27th September, 1982. The said document, is reproduced herein below as:



5/22/2019

E-Register - Main Page

EXHIBIT - D (50)

(NOT FOR LEGAL USE)

(COLLY) 48

View Registration Certificate

View TM Application

As on Date : 22/05/2019

Status : Registered

TM Application No.	396340
Class	34
Date of Application	11/10/1982
Appropriate Office	CHENNAI
State	ANDHRA PRADESH
Country	India
Filing Mode	Branch Office
TM Applied For	CHARMS VIRGINIA KINGS
TM Category	TRADE MARK
Trade Mark Type	WORD
User Detail	27/09/1982
Certificate Detail	Certificate No. 216620 Dated : 15/12/1998
Valid upto/ Renewed upto	11/10/2020
Proprietor name	(1) VST INDUSTRIES LIMITED. Trading As : VST INDUSTRIES LIMITED. Body Incorporate

Email Id																													
Agent name	DEPENNING & DEPENNING.[5881]																												
Agent Address	31, WALLAJAH ROAD MADRAS - 600 002.																												
Goods & Service Details	[CLASS : 34] MANUFACTURED TOBACCO.																												
Publication Details	Published in Journal No. : 953-0 Dated : 16/02/1989																												
History/PR Details	REGISTRATION RENEWED FOR A PERIOD OF 7 YEARS FROM 11TH OCTOBER, 1989 ADVERTISED IN JOURNAL NO 1245 REGISTRATION RENEWED FOR A PERIOD OF 7 YEARS FROM 11TH OCTOBER, 1996 ADVERTISED IN JOURNAL NO 1291 REGISTRATION RENEWED FOR A PERIOD OF 7 YEARS FROM 11TH OCTOBER, 2003 ADVERTISED IN JOURNAL NO 1300 REGISTRATION RENEWED FOR A PERIOD OF 10 YEARS FROM 11/10/2010 ADVERTISED IN JOURNAL NO. 1441																												
Uploaded Documents	<table border="1"> <thead> <tr><th>Sr No.</th><th>Document description</th><th>Document Date</th><th></th></tr> </thead> <tbody> <tr><td>1</td><td>TM-1</td><td>11/10/1982</td><td>View</td></tr> <tr><td>2</td><td>Journal Copy</td><td>11/10/1982</td><td>View</td></tr> <tr><td>4</td><td>Certificate</td><td>11/10/1982</td><td>View</td></tr> <tr><td>5</td><td>TM-16</td><td>09/01/1985</td><td>View</td></tr> <tr><td>6</td><td>Power of Attorney</td><td>26/04/2010</td><td>View</td></tr> <tr><td>7</td><td>TM-12</td><td>26/04/2010</td><td>View</td></tr> </tbody> </table>	Sr No.	Document description	Document Date		1	TM-1	11/10/1982	View	2	Journal Copy	11/10/1982	View	4	Certificate	11/10/1982	View	5	TM-16	09/01/1985	View	6	Power of Attorney	26/04/2010	View	7	TM-12	26/04/2010	View
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WARNING/DISCLAIMER : THE DATA OF TRADE MARKS REGISTRY IS UNDER THE PROCESS OF DIGITISATION, IF ANY DISCREPANCY IS OBSERVED IN THE DATA PLEASE CONTACT OR SUBMIT AT APPROPRIATE TRADE MARKS REGISTRY ALONGWITH SUPPORTING DOCUMENTS. THIS WILL HELP IN UPDATION OF ELECTRONIC RECORDS.

PRINT EXIT

7. Attention of this Court is also drawn to a certificate issued by a Chartered Accountant ("CA"), reflecting the petitioner's sales turnover under the brand name/mark i.e. "CHARMS". The said certificate points out that petitioner's sales turnover was approximately Rs. 228 crores for the financial year 2018-19, with a consolidated amount of Rs. 43,440,101,000/-



from the year 2002-2003 to 2018-19.

8. The petitioner has also placed on record various invoices for year 2006 to year 2019, marked as *Exhibit-F*, demonstrating the sale of its product under the registered mark i.e. “CHARMS”.

9. At the outset, this Court notes that the registration by the respondent no. 1 for the impugned mark i.e. “CHUMS” is by way of application dated 30th September, 2018 with user detail of 20th August, 2018. The document relating to the registration in favour of the respondent no. 1 for the impugned mark “CHUMS”, is reproduced as under:

5/23/2019

ANNEXURE 17
e-Register Main Page
(NOT FOR LEGAL USE)

(27)

As on Date : 23/05/2019
Status : Registered

[View Registration Certificate](#)
[View Examination Report](#)

TM Application No.	3960579																
Class	34																
Date of Application	30/09/2018																
State	HARYANA																
Country	India																
Filing Mode	e-Filing																
TM Applied For	CHUMS																
TM Category	TRADE MARK																
Trade Mark Type	WORD																
User Detail	20/08/2018																
Certificate Detail	Certificate No. 2153205 Dated : 25/04/2019 Notified in Journal No : 1900																
Valid upto/ Renewed upto	30/09/2028																
Proprietor name	(1) M/S. ASD TOBACCO PVT. LTD Body Incorporate																
Proprietor Address	Plot no. 17, HSIIDC industrial area, Alipur, Barwala,																
Email Id	adv.vishavbharti@gmail.com																
Attorney name	VISHAV BHARTI[13601]																
Attorney Address	# 404, GH-14, MDC, Sec 5, Panchkula, Haryana																
Publication Details	Tobacco; Smokers' articles; Matches Published in Journal No. : 1878-0 Dated : 03/12/2018																
History/PR Details	M/S: ASD TOBACCO PVT. LTD, Plot no. 17, HSIIDC industrial area, Alipur, Barwala,, Company, (Body Incorporate)																
Uploaded Documents	<table border="1"><thead><tr><th>Sr No.</th><th>Document description</th><th>Document Date</th><th></th></tr></thead><tbody><tr><td>1</td><td>TM-A(TRADE MARKS APPLICATION)</td><td>30/09/2018</td><td>View</td></tr><tr><td>2</td><td>Journal Copy</td><td>02/03/2019</td><td>View</td></tr><tr><td>3</td><td>Certificate</td><td>25/04/2019</td><td>View</td></tr></tbody></table>	Sr No.	Document description	Document Date		1	TM-A(TRADE MARKS APPLICATION)	30/09/2018	View	2	Journal Copy	02/03/2019	View	3	Certificate	25/04/2019	View
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2	Journal Copy	02/03/2019	View														
3	Certificate	25/04/2019	View														

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PRINT EXIT



10. A perusal of the documents pertaining to the registrations in favour of the parties, clearly shows that while the registration in favour of the petitioner is since the year 1982 with claim of user since 27th September, 1982, the registration in favour of respondent no. 1 was much later, with user detail of 20th August, 2018.

11. Thus, it is manifest that the petitioner is the prior adopter and user of its mark “CHARMS”, having used it for approximately 36 years before respondent no. 1 adopted and used the impugned mark i.e. “CHUMS”.

12. At this stage it is pertinent to compare the marks of the petitioner with that of respondent no. 1. A comparative table for the marks of the parties is reproduced as under:

DESCRIPTION	PETITIONER	RESPONDENT NO.1
TRADEMARK (WORD)	CHARMS	CHUMS
PRODUCT		

13. Perusal of the above makes it apparent that the background colour on the products of both the parties has micro gold red checks. Further, writing of both the brand/ mark “CHUMS” and “CHARMS” are written in gold colour font and the alphabets ‘C’ and ‘S’ are slightly bigger than the rest of the alphabets written on the products of both the parties. Moreover, the background red colour in the respondent’s mark also includes similar micro



black red checks as that of the petitioner's mark. Thus, it is manifest that on account of the substantial similarity between the two marks and the products thereof, along with the established aspect of the petitioner's prior use, the respondent no. 1 has clearly come as close to the mark and product packaging as that of the petitioner.

14. This Court also notes that both the marks, i.e., "CHARMS" and "CHUMS", are visually and phonetically similar and have been used for identical goods under the same Class. Thus, this Court in the case of *Opella Healthcare Group Versus Vaibhav Vohra and Anr., 2024 SCC OnLine Del 8214*, while dealing with two marks that were phonetically similar and wherein the respondent's packaging was found to be similar to that of the petitioner, held as follows:

"xxx xxx xxx

15. The artistic work in the packaging/label, as shown above, indicates that the respondent no. 1 has attempted to bring his packaging as close as possible, to that of the petitioner's packaging. The usage of the dark blue colour, white font, blue and pink/red combination as is being used by the petitioner in their packaging, is being used by respondent no. 1 in a similar manner.

xxx xxx xxx

17. Therefore, it is manifest that the marks of the respondent no. 1 are likely to cause confusion and give the general impression that the same may be associated with the petitioner. The consumers and members of the trade, are likely to be confused, or deceived into believing, that the respondent no. 1 is associated with the petitioner, or is selling the goods originating from the petitioner.

xxx xxx xxx"

(Emphasis Supplied)

15. This Court also takes note of the order dated 18th May, 2022 passed by the Court of Additional District Judge, Panchkula, in *Case no. CS/1/2019*, titled as *VST Industries Limited Versus ASD Tobacco Private*



Limited. The aforesaid suit was filed by the plaintiff (petitioner herein) against the defendant (respondent no. 1 herein), claiming relief of permanent injunction for passing off of trademark, rendition of accounts, delivery up, etc.

16. By way of the said order dated 18th May, 2022, a decree has been passed in favour of the plaintiff and against the respondent no. 1, restraining respondent no. 1 from using the impugned trademark, i.e., “CHUMS”, and the get up associated therewith, either personally, or through its dealer, agent or, distributor.

17. Further, there is a categorical finding against the respondent no. 1 that the impugned mark i.e. “CHUMS” is identical and deceptively similar to the mark, i.e., “CHARMS” of the plaintiff company which is being used since 1982.

18. In view of the aforesaid discussion, learned counsel appearing for respondent no. 2 submits that they have no objection if the present petition is allowed.

19. After considering the submissions made before this Court, the following directions are issued herein below:

I. Registration of the impugned mark i.e. “CHUMS” in favour of respondent no. 1 bearing registration no. 3960579 dated 30th September, 2018 in Class 34, is hereby cancelled.

II. The respondent no. 2, i.e., the Registrar of Trade Marks, is directed to carry out the requisite rectification in its register.

III. The Registrar of Trade Marks shall issue an appropriate notification in regard to cancellation of the impugned mark of respondent no. 1.

IV. The Registry of this Court is directed to supply a copy of the present



2025:DHC:1562



order to the Office of the Controller General of Patents, Designs and Trade Marks of India, on E-mail Id: llc-ipo@gov.in, for compliance.

20. The present petition is accordingly allowed and disposed of, with the aforesaid directions.

MINI PUSHKARNA, J

MARCH 6, 2025

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