



2024:DHC:9348



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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**+ **CS(COMM) 587/2023 & I.A. 8999/2024**% **Date of Decision: 28th November, 2024**

BP P.L.C. & ANR.

.....Plaintiffs

Through: Mr. Urfee Roomi, Mr. Jaskarn Singh,
Mr. Arpit Singhal and Mr. Ayush
Dixit, Advs.
M: 9811600017

versus

SUBHASH CHANDRA, TRADING AS SHIVAY ENTERPRISES

.....Defendant

Through: Mr. Visakha, Advocate
M: 9668099896

CORAM:**HON'BLE MS. JUSTICE MINI PUSHKARNA****MINI PUSHKARNA, J (ORAL)****I.A. 8999/2024**

1. The present application has been filed under Order XIII-A Rules 3 & 6(1)(a) read with Section 151 of the Civil Procedure Code, 1908 ("CPC").
2. Present suit has been filed by the plaintiffs seeking permanent injunction restraining the defendant from dealing in engine oil, coolants and lubricants and/or similar goods, bearing the defendant's Marks and

Packaging,

BPL,

BPL

GOLD,





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,  ,  , ACTIVE,  , and the Oil in Action



Device Mark (), and/or the piratical container(s) , and marks or packaging or designs that are nearly identical/similar to the plaintiffs' Marks and Packaging.

3. The plaintiffs seek a summary judgment against the defendant, on the ground that the defendant has no prospect of defending the plaintiffs' claims and in view of the various admissions by the defendant with respect to his use of the defendant's Marks and Packaging, which are nearly identical/deceptively similar to the plaintiffs' Marks and Packaging and plaintiffs' Container Design.

4. Learned counsel appearing for the plaintiffs submits that, the defendant has made various admissions, including, his written statement and his reply to Order XXXIX Rules 1 and 2, with respect to his use of the defendant's marks and packaging, which are nearly identical/deceptively similar to the plaintiff's marks and Packaging, as well as plaintiff no.2's Container Design.

5. The case, as canvassed by the plaintiffs, is as follows:

5.1 The plaintiff no. 1, i.e., BP P.L.C., and plaintiff no. 2, i.e., Castrol Ltd. ("plaintiffs"), are companies organised and existing under the laws of England and are both group companies in the BP group of companies. The plaintiff no. 1 is the ultimate parent company of the BP group of companies and is a direct parent company of the plaintiff no. 2.



5.2 The plaintiffs are the proprietors of various valid and subsisting registrations for the plaintiffs' marks in India. The plaintiff no. 2 is also the owner of Registration no. 219180 for the plaintiff no. 2's Container Design in Locarno Class 09-03. The said Registration no. 219180 dated 16th October, 2008, claims novelty in the shape and configuration of the container and is valid and subsisting.

5.3 The details of some of the applications/registrations filed by/owned by the plaintiffs, are as follows:

S. No.	Reg/ App No.	Mark	Class	Reg/App Date	Status
1.	128292		4	08/03/1947	Registered (valid upto 08/03/2014)
2.	568720		5	03/03/1992	Registered
3.	569726		4	03/03/1992	Registered
4.	1248852	BP	1, 4, 9, 25	01/01/1996	Registered
5.	1219443		4	01/08/2003	Registered



6.	1418318	BP	6, 35, 36, 37, 38, 39, 40, 41, 42	01/06/2001	Registered
7.	4057828	BP	1, 4, 9, 36, 37, 39, 40, 42	09/08/2018	Protection Granted
8.	3355419		4	08/04/2016	Protection Granted
9.	838183	ACTIV	4	25/01/1999	Registered
10.	2709612		4	31/03/2014	Pending
11.	3440526	BPMe	9	23/12/2016	Registered
12.	3423256	BP PLUS	9, 16, 35, 36	29/11/2016	Registered

5.4 A table showing the years, in which the plaintiffs first used each of the plaintiffs' marks in India, is reproduced as under:

S No.	Mark	Year of First Use
1.	BP	1947
2.		2019
3.	ACTIV	1999
4.		2012

5.5 Plaintiffs have sold engine oils and lubricants, on a worldwide basis, in containers, each of which have a distinctive shape. The labels affixed to the plaintiffs' containers feature a distinctive layout and get-up. The plaintiffs' Marks and Packaging used by the plaintiffs on and in relation to their products, are all original artistic works and are entitled to copyright protection across world, including India.



5.6 The defendant is the sole proprietor of and trades as M/s Shivay Enterprises, with address at 133/430, Block-O, Sabji Mandi, Kidvai Nagar, Kanpur, Uttar Pradesh – 208011, and is engaged in the business of manufacturing, marketing, and sale of engine oils, transmission oils, machine oils, greases, and other forms of lubricants. The defendant uses the defendant's Marks, the defendant's Packaging and/or the defendant's piratical Container Design, as depicted in Para 12A, 12B and 12C of the plaint, on and in relation to the said goods.

5.7 The defendant filed Trademark Application no. 5891422 for “BPL GOLD” on 13th April, 2023, covering “packing of 2T oil used for 2 and 3-wheeler motor engines” in Class 4, on a proposed-to-be-used basis. However, after the filing of the present suit, the defendant submitted a Letter of Withdrawal dated 07th October, 2023 to the Trade Marks Registry but, the Registry has not yet acted on it, and the application status remains “Objected”.

5.8 The plaintiffs became aware in June 2023 of the defendant's business of selling engine oil in containers resembling the plaintiffs' Marks, Packaging, and Container Design. A subsequent investigation in July 2023 revealed the defendant was manufacturing and distributing infringing products nationwide, including in Delhi.

5.9 On 24th July, 2023, the plaintiffs issued a legal notice demanding the defendant to cease using the infringing marks, packaging, and withdraw the BPL GOLD trademark application. Despite receiving the notice, the defendant continued the infringing activities. Hence, the present suit came to be filed.

6. This Court vide order dated 23rd August, 2024, granted an *ex-parte ad*



interim injunction restraining the defendant from dealing in engine oil, coolants and lubricants and/or similar goods, bearing the defendant's Marks and Packaging, BPL, BPL GOLD,  ,  ,  , ACTIVE,  and the Oil in Action Device Mark (), and/or the piratical



container(s) and marks or packaging or designs, that are nearly identical/similar to the plaintiffs' Marks and Packaging.

7. This Court also appointed a Local Commissioner to visit the defendant's premises, to seize the infringing products and prepare an inventory. Upon the execution of the commission on 28th August, 2023, the Local Commissioner seized a substantial amount of infringing goods from the defendant's premises. The relevant portion of the Report of Local Commissioner, is reproduced as under:

S. NO.	PARTICULARS OF THE INFRINGING GOODS	QUANTITY
1.	Grey Bottles with impugned design.	54 pcs x 18 packs = 972 bottles
2.	BPL sachets 2T-oil (boxes)	56boxes x 720 sachets + 2boxes 240 sachets =40,800 sachets
3.	BPL sachets 2T oil (loose bundles)	13 bundles x 60 sachets = 780 sachets
4.	Gold containers with impugned design.	5 labeled with impugned marks and 5 not labeled.
5.	White bottles containing impugned mark (filled with oil)	9 boxes x 30 bottles = 270 bottles
6.	Gold bottles with impugned mark 'BPL GOLD' 4T OIL (filled with oil)	4 boxes x 20 bottles = 80 bottles



7.	Gold bottles with impugned mark 'BPL GOLD' 4T OIL (empty)	55 + 111 (2 sacks) = 166.
8.	BPL GOLD AP-3 Grease container	10 containers filled with grease + 120 empty.
9.	BPL GOLD 2T Oil packaging roll	1 used packaging roll, about 8kg
10.	BPL GOLD sewing machine oil packaging roll	3 rolls about 9.5kg each

8. Further, vide order dated 04th March, 2024, written statement of the defendant along with reply to I.A. 15977/2023 under Order XXXIX Rules 1 and 2, was taken on record.

9. Pursuant thereto, vide order dated 19th March, 2024, this Court confirmed the *ex-parte ad interim* order and also recorded the submission made on behalf of the counsel for the defendant that the defendant is not using the impugned trademarks anymore and had complied with the injunction order dated 23rd August, 2023. Relevant portion of the aforesaid order, is reproduced, as under:

“xxx xxx xxx

2. Counsel for defendant, who appears through VC, confirms that the defendant is not using the impugned trademarks anymore and had complied with the injunction order passed by this Court on 23rd August, 2023.

xxx xxx xxx”

10. Attention of this Court has been drawn to the written statement of the defendant, wherein, the defendant has admitted to the averments made in the plaint with regard to the infringing activity. The statements of the defendant in his written statement, are reproduced as under:

“xxx xxx xxx

3. That it is further mentioned that the present suit is not maintainable since the cause of action for filing the present application is not existing as on date. **It is submitted that the Defendant has curtailed**



the use of the trademark of the plaintiffs once the same came to the knowledge of the Defendant when the legal notice dated July 24, 2023 was sent by the Plaintiff.

xxx xxx xxx

3. That the contents of para 9 of the suit are denied save and except the matters of record. It is pertinent to mention that the Defendant as on date is not using any of the trademarks, copyrights or design registration as mentioned in the present paragraph.

4. That the contents of para 10 to 12 are wrong and hence denied. In this regard it is pertinent to mention that the Defendant has not used the names of the trademark of the Plaintiffs intentionally. It is also brought in the kind attention of this Hon'ble Court that the Defendant have stopped selling the goods having the alleged infringing trademark and trade dress and have stopped using the name of the Plaintiffs' trademark once the Defendant became aware of the same i.e. from the date of receipt of notice of the Plaintiff on July 24, 2023.

5. That the contents of para 13 are baseless. It is humbly submitted that the Defendant has stopped selling engine oil, lubricants and related services which have the alleged infringing trademark and trade dress (hereinafter 'Defendant's Mark and Packaging and alleged piratical container') since the date of receipt of legal notice on behalf of the Plaintiffs. Further, the Plaintiffs have not suffered any monetary loss due to the inadvertent use of the trademark by the Defendant. The Defendant have made no profits through the sale of the allegedly infringing goods and the said name has also not been used by the Defendant once they became aware about the actual situation of trademark.

.....

15. That in response to the contents of para 68, it is humbly submitted that the use of the Defendant's Marks and Packaging and alleged piratical containers was an inadvertent use on the part of the Defendant which was immediately stopped upon the receipt of the Plaintiffs' objection. The allegation of the Plaintiffs that the Defendant's intention is dishonest and mala fide is baseless and false. There is no reason to approach this Hon'ble Court as the use of the Defendant's Marks, Packaging and alleged piratical containers has been terminated before the institution of the present suit.

.....

18. That, in response to the contents of para 72, it is being denied that the Defendant's use of the Defendant's Marks and Packaging and alleged piratical container is in bad faith with a mala fide intention. It



was an inadvertent use on the part of the Defendant and there was no dishonest intention to claim any goodwill or reputation of the Plaintiffs as evident from the fact that the Defendants have immediately stopped using the Defendant's marks upon receipt of the Plaintiffs objection, have promptly and duly withdrawn the trademark application filed in relation to the Defendant's marks and have not made any profits in relation to the goods. Therefore, there is no reason to approach this Hon'ble Court as any alleged unauthorized use have been curtailed.

xxx xxx xxx”

(Emphasis Supplied)

11. Further, attention has been drawn to the reply of the defendant to I.A. 15977/2023 under Order XXXIX Rules 1 and 2, wherein, the defendant in Para 2 of the Para-wise Reply has admitted to the plaintiffs’ submission pertaining to the goodwill and reputation in the plaintiffs’ Marks, Packaging and Registered Container Design, for being “matters of record.”

12. Attention has also been drawn to the reply of the defendant to I.A. 8999/2024 under Order XIII-A Rules 3 & 6(1)(a), wherein, the defendant has categorically stated that he has stopped the use of the infringing marks and packaging, in the following manner:

“xxx xxx xxx

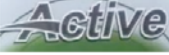
8.The Defendant acknowledges that he has ceased the use of the Defendant's Marks and Packaging but denies any admission of liability or infringement of the Plaintiffs' Marks, Packaging, or the elapsed design registration of Plaintiff No. 2's Container Design....

xxx xxx xxx”

(Emphasis Supplied)

13. A side-by-side comparison of the rival marks and packaging, are reproduced as under:



S. No.	The Defendant's Marks and/or the Defendant's Packaging	The Plaintiffs' Marks and/or the Plaintiffs' Packaging
1.	<u>BPL</u>	<u>BP</u>
2.		BP, BP PLUS,  
3.	<u>ACTIVE</u> 	ACTIV  ACTIVE 
4.		
5.		

14. It is apparent from a bare viewing of the above comparison table, that the defendant's marks and packaging are nearly identical/deceptively similar to the plaintiff's mark, packaging, and container design. No defence can possibly be put forth for adopting such blatantly infringing similar mark and packaging by the defendant.

15. It is not in dispute that the defendant and plaintiffs are involved in the



same business and are using the rival marks and rival packaging in respect of identical goods, having identical trade channels, and having identical target consumers. It is settled law that in cases where the rival marks are identical/deceptively similar, and the goods/services and the trade channels/target consumers, are also identical or similar, an injunction must necessarily follow. The defendant has not raised any substantial defence, which would repudiate the plaintiffs' assertions as to the defendant's infringing activities.

16. In regard to passing a summary judgment, this Court in the case of ***DS Confectionery Products Ltd. v. Nirmal Gupta & Anr., 2022 SCC OnLine Del 4013***, has held as follows:

“xxx xxx xxx

26. This Court, in *Su-Kam Power Systems Ltd. v. Kunwer Sachdev*, 2019 SCC OnLine Del 10764, has held as under:

“90. To reiterate, the intent behind incorporating the summary judgment procedure in the Commercial Court Act, 2015 is to ensure disposal of commercial disputes in a time-bound manner. In fact, the applicability of Order XIII A, CPC to commercial disputes, demonstrates that the trial is no longer the default procedure/norm.

91. Rule 3 of Order XIII A, CPC, as applicable to commercial disputes, empowers the Court to grant a summary judgement against the defendant where the Court considers that the defendant has no real prospects of successfully defending the claim and there is no other compelling reason why the claim should not be disposed of before recording of oral evidence. The expression “real” directs the Court to examine whether there is a “realistic” as opposed to “fanciful” prospects of success. This Court is of the view that the expression “no genuine issue requiring a trial” in Ontario Rules of Civil Procedure and “no other compelling reason....for trial” in Commercial Courts Act can be read mutatis mutandis. Consequently, Order XIII A, CPC would be attracted if the Court, while hearing such an application, can make the necessary finding of fact, apply the law to the facts and the same is a proportionate, more expeditious and less expensive means of achieving a fair and just result.



92. Accordingly, unlike ordinary suits, Courts need not hold trial in commercial suits, even if there are disputed questions of fact as held by the Canadian Supreme Court in Robert Hryniakv. Fred Mauldin, 2014 SCC OnLine Can SC 53, in the event, the Court comes to the conclusion that the defendant lacks a real prospect of successfully defending the claim.”

xxx xxx xxx”

(Emphasis Supplied)

17. Accordingly, this Court is of the view that the plaintiffs are entitled to a decree under Order XIII-A of the Commercial Courts, Commercial Division and Commercial Appellate Division of the High Courts Act, 2015, as the said provision empowers this Court to pass a summary judgment, without recording evidence, if it appears that the defendant has no real prospect of defending the claim.

18. Considering the aforesaid discussion and the admission on behalf of the defendant, the plaintiffs are entitled to decree of permanent injunction in their favour, and against the defendant.

19. On the issue of Costs and Damages, this Court notes that the defendant’s adoption of the infringing Marks and Packaging, cannot be considered to be *bonafide* or honest. The defendant knowingly infringed the plaintiffs’ Marks and Packaging and cannot plead ignorance of prior existence, as well as the reputation of the plaintiffs’ registered Marks and Packaging. The defendant has no plausible justification for adopting the plaintiffs’ Marks and Packaging, other than to ride upon the plaintiffs’ immense reputation and goodwill. Further, this Court also notes that significant amounts of infringing goods were recovered from the defendant’s premises by the learned Local Commissioner.

20. Considering the aforesaid facts and circumstances of the present case,



and taking into account the significant amount of infringing goods confiscated by the learned Local Commissioner, this Court holds that the plaintiffs are entitled to Costs and Damages.

21. Accordingly, the following directions are issued:

I. A decree of permanent injunction is passed in favour of the plaintiffs and against the defendant in terms of Para 87 (a), (b), (c) and (e) of the plaint.

II. ₹ 5,00,000/- shall be paid by the defendant to the plaintiffs, towards costs and damages, which shall be paid within a period of six months, from today.

III. The goods that were seized by the Local Commissioner and returned on *superdari*, shall be destroyed by the defendant, in the presence of the plaintiffs' representative.

IV. For this purpose, the plaintiffs' counsel/representative shall contact the defendant's counsel, and fix a convenient date and time.

V. The Costs/damages payable to the plaintiffs shall be paid through the plaintiffs' counsel, whose appearance is recorded, in today's order.

22. With the aforesaid directions, the present suit, along with the pending application, is disposed of.

MINI PUSHKARNA, J

NOVEMBER 28, 2024

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