



2025:DHC:11007-DB



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

+ **FAO(OS) (COMM) 77/2025 & CM APPL. 25373/2025**

CASTROL LIMITEDAppellant

Through: Mr. Urfee Roomi, Mr. Ritesh,
Mr. Ayush, Ms. Chahat and Ms. Vanshika,
Adv.

versus

VIVEK PRATAP SINGHRespondent

Through:

CORAM:

HON'BLE MR. JUSTICE C. HARI SHANKAR

HON'BLE MR. JUSTICE OM PRAKASH SHUKLA

JUDGMENT (ORAL)

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04.12.2025

C. HARI SHANKAR, J.

1. The appellant is one of the leading manufacturers of motor oils in the country.

2. It is a matter of common knowledge that engine oils manufactured by the appellant have been duplicated by several counterfeiters who sell engine oils in cans and containers which are identical in appearance, using marks which are also deceptively similar to those of the appellant.

3. One of us, sitting singly in this Court, has dealt with similar matters in which identical infringements had come up before the Court. As these cases deal with engine oil, and duplicacy can lead



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even to loss of lives, the Court has to take an extremely serious view where counterfeiting is seen.

4. The appellant is aggrieved by the fact that the learned Single Judge has not passed any order on the appellant's application under Order XXXIX Rules 1 and 2 of CPC and merely renotified the application and also declined to pass any order appointing a local commissioner to seize the infringing products.

5. The local commissioner appointed by the learned Single Judge was only given power to inventorise the infringing products and no power of seizure.

6. When this matter had come up before us, on the very first date of hearing, given the nature of the dispute, we had passed the following order:

“*IN THE HIGH COURT OF DELHI AT NEW DELHI

+ FAO(OS) (COMM) 77/2025 and CM APPL. 25378/2025

CASTROL LIMITED

.....Appellant

Through: Mr. Urfee Roomi, Ms.
Janaki Arun, Mr. Ritesh Kumar, Ms.
Chahat Bhatia and Mr. Ayush Dixit,
Advocates

versus

VIVEK PRATAP SINGH

.....Respondent

Through:

CORAM:

HON'BLE MR. JUSTICE C. HARI SHANKAR

HON'BLE MR. JUSTICE AJAY DIGPAUL

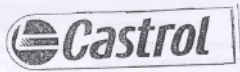


ORDER

29.04.2025

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**FAO(OS) (COMM) 77/2025**

1. This appeal assails order dated 22 April 2025 passed by a learned Single Judge of this Court in IA 10007/2025 in CS (COMM) 360/2025¹.
2. The appellant, Castrol Limited², is the proprietor of the following registered trademarks:

S. No.	Mark	Class	Date of Application	Year of 1 st use
1		4	25 January 1999	1998
2	ACTIV	4	25 January 1999	1999
3		4	31 March 2014	2012
4		4	17 October 2023	2012







3. The appellant alleged that the respondent was indulging in producing counterfeit products, with a trade dress and appearance nearly identical to the trade dress of the appellant, which stands registered as a trademark in its favour. A tabular comparison in this regard is provided in para 17 of the appeal, which may be reproduced thus :

S. No.	Respondent's Marks and Packaging	Appellant's Marks and Packaging	Changes made by the Respondent
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¹ Castrol Limited v Vivek Pratap Singh

² "Castrol", hereinafter



1.			<p>The Respondent has copied in its entirety the bullet-shaped device and the colour scheme and font from the Appellant's CASTROL Device mark. The Respondent has merely removed the Roundel Device and replaced the word CASTROL with the words OREO and SPEED-UP in the same colour and font as the word CASTROL.</p>
2.	<p>ACTIVE</p> 	<p><u>ACTIV</u></p> 	<p>The Respondent has merely added the letter E and removed the letter I from the Appellant's ACTIV mark to arrive at the Respondent's ACTIVE mark. The Respondent has also copied the exact font, colour scheme and writing style of the Respondent's ACTIV mark to arrive at the Respondent's mark ACTIVE. All in all, the rival marks are visually, structurally and phonetically nearly identical.</p>
3.			<p>The Respondent has copied the Appellant's Oil in Action with Bearing Device in its entirety.</p>



<p>4.</p>			<p>The overall colour scheme, get-up and layout of the rival packaging are nearly identical. The Respondent has only made minor alterations, such as the replacement of the CASTROL Device mark with the OREO/SPEED-UP Device marks and made other insignificant changes to arrive at its packaging. The Respondent has also imitated the placement of the Appellant's CASTROL Device mark on the right side of the bottle, engraved in grey colour. All in all, the rival packaging is nearly identical, The likelihood of confusion is apparent and unavoidable.</p>
<p>5.</p>			<p>Clearly, the overall colour scheme, get-up and layout of the rival packaging are nearly identical. The Respondent has only made minor alterations, such as the replacement of the CASTROL ACTIV Device mark with the SPEEDUP POWER Device mark and made other insignificant changes to arrive at its packaging. The Respondent has also imitated the placement of the Appellant's CASTROL Device mark on the right side of the bottle, engraved in grey colour. All in all, the rival packaging is nearly identical. The likelihood of confusion is apparent and unavoidable.</p>


4. Mr. Urfee Roomi, learned counsel for the appellant, has



also produced before us, physical copies of the containers of the appellant and the respondent. We have taken photographs thereof and the comparison thereof may be provided thus:

Appellant's Packaging	Respondent's packaging
	

5. This Court may take judicial notice of the fact that the appellant's brand is one of the most widely counterfeited brands. On the original side of this Court, we have come across any number of cases in which the appellant's brand and the container of the appellant have been counterfeited and counterfeiters have been selling motor oil and other such products in containers nearly identical in appearance to that of the appellant, and mimicking the colour scheme of the appellant's container as well as the oil in

action bearing device ().

6. Inasmuch as the goods in question are motor oil, counterfeiting cannot be tolerated at any cost. The very fact that counterfeited products have been produced, itself indicates that the quality of the product may be suspect, as the counterfeiters are seeking to capitalize on the reputation of the appellant, and confuse



consumers into believing their product to be that of the appellant. As use of substandard motor oil can endanger the lives of citizens, the court has to be additionally vigilant in such cases.

7. A bare glance at the containers of the appellant and the respondent disclose that the respondent is *prima facie* a rank counterfeiter, who is seeking to pass off his products as the product of the appellant. The respondent has copied not only the shape of the appellant's container, which is registered as a trademark in the appellant's favour, but has also copied the entire layout and design of the label on the container to the extent of using the same colour scheme, design and over all appearance. To a person of average intelligence and imperfect recollection, there is every possibility of the product of the respondent being mistaken for that of the appellant.

8. In these circumstances, it is clear that the appellant has made out a *prima facie* case for grant of interlocutory injunction against the respondent as well as for appointment of a Local Commissioner to seize the infringing products.

9. The learned Single Judge has, however, dismissed the appellant's application for interim injunction with the following observations:

“18. Vide the present plaint the plaintiff seeks injunction and damages for infringement of trademarks, passing off under The Trade Marks Act, 1999 and the Copyrights Act, 1957.

19. Though the plaintiff has averred that prior to institution of the present suit the plaintiff had conducted internet searches and found that the defendant was engaged in manufacturing, marketing and selling engine oils and lubricants bearing the infringing mark and packaging on a third-party website India Mart and social media platforms including Facebook, Instagram including WhatsApp and since the cause of action for instituting the present suit has arisen in the first week of March, 2025, however, there are no documents qua either of them. As such, no case for grant of an ex-parte injunction is made out.

20. On the plaintiff taking requisite steps, issue notice to the defendant by all permissible modes, returnable before the Court on 15.05.2025.”

10. Mr. Roomi, learned counsel for the appellant, submits that the learned Single Judge was not correct in holding that there was no material on record to indicate that the respondent was indulging in infringing of the appellant's trademark and releasing in the market products which were by passing them off as appellant's products. He has drawn our attention to documents 27 to 29, filed with the plaint. He has shown us screenshot of the representation of the respondent's products on their India Mart, Facebook and



YouTube social media webpages as well, which indicate that the respondents are rampantly advertising and selling their product.

11. Though the impugned order does not clearly indicate that all these submissions were advanced before the learned Single Judge, we are not proceeding on that issue as we are of the view that an issue of larger public interest is involved in the present case, which deals with counterfeit motor oils.

12. In that view of the matter, issue notice, returnable on 22 September 2025.

13. Both sides are at liberty to place short notes of their respective submissions not exceeding four pages each after exchanging copies with each other at least a week in advance of the next date of hearing.

14. A copy of this order be given to learned counsel for the petitioner *dasti* under the signatures of the Court Master.

CM APPL. 25375/2025 (Exemption)

15. Allowed subject to all just exceptions.

16. The application stands disposed of.

CM APPL. 25373/2025 (interim injunction)

17. The appellant has made out a clear *prima facie* case in its favour. The principles of balance of convenience and irreparable loss are also wholly in favour of grant of interlocutory injunction against the respondent and in favour of the appellant. One of us (C. Hari Shankar J), sitting singly, has already held, in *Louis Vuitton Malletier v. Capital General Store*³, thus:

“33. Counterfeiting is an extremely serious matter, the ramifications of which extend far beyond the confines of the small shop of the petty counterfeiter. It is a commercial evil, which erodes brand value, amounts to duplicity with the trusting consumer, and, in the long run, has serious repercussions on the fabric of the national economy. A counterfeiter abandons, completely, any right to equitable consideration by a Court functioning within the confines of the rule of law. He is entitled to no sympathy, as he practices, knowingly and with complete impunity, falsehood and deception. Even while remaining within the confines of the provision with which it is seized - in this case, Order 39 Rule 2A - the Court is, therefore, required to be economically and socially sensitized, and to send a deterrent message to others who indulge, or propose to indulge, in the practice of counterfeiting.”

³ AIR 2023 Del 139



The Division Bench of this Court, in writ appeal, endorsed the above view.

18. Use of counterfeit motor oil is not merely injurious to the appellant's intellectual property rights; it has the pernicious possibility of resulting in loss of life and limb. The Court has to adopt a policy of zero tolerance in such cases.

19. The considerations of balance of convenience and irreparable loss, too, therefore, justify grant of interim injunction, as sought by the appellant, till further orders.

20. In view of the aforesaid facts, till the next date of hearing, the respondent and any other individuals, officers, managers, employees, agents, dealers, licensees, companies, retailers, or any other persons / entities that are related or affiliated to the respondent and all others, acting for and on behalf of the respondent, individually or collectively, are restrained from manufacturing, offering for sale, selling, displaying, advertising, marketing, whether directly or indirectly, and whether on the Internet or otherwise, engine oils, coolants, gear oils and lubricants and/or similar/related/allied/cognate goods, bearing the

respondent's Marks, (, , ACTIVE,  and/or packaging depicted herein, i.e. ,



and all other marks or packaging which are deceptively similar to the appellant's Marks and Packaging, till the next date of hearing.

21. Renotify on 22 September 2025.

22. We make it clear that we have not restrained the proceedings before the learned Single Judge which may continue unimpeded by the pendency of this appeal.


CM APPL. 25374/2025 (for additional documents)

23. This application is disposed of with liberty to the appellant to file a separate application for placing additional documents on record, if and when the need so arises.



CM APPL. 25376/2025 (appointment of Local Commissioner)

24. A learned Local Commissioner already stands appointed by the learned Single Judge by the order under challenge. However, the Local Commissioner has not been given the power to seize any infringing goods and has only been given the power to inventorize the infringing goods.

25. In view of the *prima facie* finding hereinabove and keeping in mind the fact that the case deals with counterfeit motor oil, we extend the remit of the Local Commissioner to seize any goods found in the premises of the respondent, which bear any mark or trade dress which is identical or deceptively similar to the registered trademarks of the appellant and to inventorize the said goods. This would, in particular, include the marks (,



ACTVE,



and/or



. Any labels, packing or printing material or any other material which may be found in the premises and which may be used to manufacture the infringing goods would also be inventorized and taken into custody. The goods once inventorized shall be taken into custody and handed over to the respondent under superdari. The defendant shall stand restrained from dealing with the goods in any manner, pending orders passed by this Court.

26. The proceedings of the Local Commission shall be photographed and videographed at the expense of the appellant. The Local Commissioner shall place the said evidence on record with his report. Should the need arise, the Local Commissioner would be at liberty to effect forced ingress into any premises of the respondent in order to carry out the commission.

27. Needless to say, the respondent, or any other occupant of the premises at which the commission is to be executed, would cooperate in execution of the commission.

28. The Local Commissioner is also directed to carry out the commission in a peaceful manner and not to disturb the otherwise lawful activities of the respondent, if any.

29. Service of notice on the respondent, in the present appeal, would be effected only after the commission is executed and the report of the Local Commissioner is placed on record. However,



the learned Local Commissioner would produce a copy of the order passed to the occupants of the premises at which the commission is to be executed.

30. The Registry is also restrained from uploading this order on the website of the Court till the commission is executed and report in that regard is placed on record.

31. The application stands disposed of, accordingly.

CM APPL. 25377/2025 (exemption from pre-litigation mediation)

32. In view of the nature of the dispute, exemption is granted from the requirement of pre-litigation mediation.

33. The application is disposed of.

34. Let the order be supplied *dasti* under signatures of the Court Master.”

7. Despite issuance of notice in the matter, no one has appeared on behalf of the respondent.

8. This, again, is a common feature in the cases of counterfeiting of the appellant’s products. Invariably, the counterfeiters do not turn up and contest the matter. Significantly, before the learned Single Judge, there has been no appearance on behalf of the respondent.

9. Clearly, the case is indefensible for respondent.

10. Accordingly, we make the impugned order dated 22 April 2025 absolute pending disposal of the suit before the learned Single Judge.

11. IA 10007/2025 filed before the learned Single Judge is disposed of in the aforesaid terms.



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12. The appeal stands allowed to the aforesaid extent.

C. HARI SHANKAR, J

OM PRAKASH SHUKLA, J

DECEMBER 4, 2025/dsn