

Castrol Ltd. Vs. Shri Subhash Kapoor

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Court : Delhi

Decided On : Jan-03-1995

Reported in : 1995IAD(Delhi)619; 1995(1)ARBLR274(Delhi); 58(1995)DLT147

Judge : R.C. Lahoti, J.

Appeal No. : IA No. 4458 & 9827 OF 1994 - Suit No. 1049 of 1994

Appellant : Castrol Ltd.

Respondent : Shri Subhash Kapoor

Judgement :

R.C. Lahoti, J.

1. The plaintiffs M/s. Castrol Ltd., U.K. and Castrol India Ltd., Bombay and New Delhi have filed this suit for permanent injunction restraining infringement of trade mark, passing-off, rendition of accounts etc.
2. On 10.5.1994, the court has issued an ad interim injunction restraining the defendants from using the words 'INDOL' in connection with wheel bearing grease and multi purpose grease, and 'INDEROIL' in connection with brake fluids. The defendants have sought for vacating the injunction order.
3. According to the plaintiffs, the plaintiff No. 1 is the registered proprietor in India of several trade marks including the trade mark 'CASTROL'. The plaintiff No. 2 is

the registered proprietor of several trade marks bearing the name 'INDROL'. The relevant registered trade marks are :

(a) Trade mark Indrol registered under No. 400575 as of 27.1.1983 in respondent of Hydraulic fluids (not being oils) antifreeze preparations in fluid form, Chemical products, catalysts, anti-oxidants, damp resisting and water proofing compounds, adhesives, solvents, degreasing preparations, emulsifying preparations, detergents, descaling and desludging preparations all for use in industrial and manufacturing processes, fire extinguishing compositions.

(b) Trade mark 'INDROL' registered under No. 400578 as of 27th January, 1983 in class 4 respect of Industrial oils and grease (other than edible oils, fats and essential oils) Hydraulic fluids being oils, lubricants, fuels and illuminants.

(c) The trade mark 'INDROL MONOGRAM' registered under No. 419423 as of 21st March, 1984 in class 1 in respect of Hydraulic fluids (not being oils) anti-freeze preparations in fluid (not being oils) anti-freeze preparations in fluid form, Chemical products, catalysts, antioxidants, damp resisting and water proofing compounds, adhesives, solvents, degreasing preparations, emulsifying preparations, detergents, descaling and desludging preparations, all for use in industrial and manufacturing processes, fire extinguishing compositions.

(d) Trade mark 'INDROL MONOGRAM' registered under No. 4194-6 as of 21st March, 1984 in class 4 in respect of Industrial oils and greases (other than edible oils, fats and essential oils), Hydraulic fluids being oils, lubricants, fuels and illuminants.

4. These trade marks have been renewed from time to time and are still subsisting in the Register of Trade Marks. Vide paragraph 10 of the plaint, the plaintiffs have stated figures of their turnover between June, 1983 and December, 1992 running into crores. Vide paragraph 12 of the plaint, the plaintiffs have stated the figures of annual expenditure on advertisement incurred by them between June, 1984 and December, 1992 which again run into crores.

5. The Indrol logo of the plaintiffs consists of the white device of one dome shape portion in vertical, position and another in an inverted position, both in green colour, and in between the word INDROL (in capital) in red colour is shown and the whole of this is encased in a white square. This is called INDROL device of which the plaintiff has a copyright bearing registration No. A-47185/85.

6. The plaintiffs further allege that the defendant No. 1, who is the proprietor of the firm of defendant No. 2 is committing breach of the plaintiffs' proprietary rights of trade mark and copyright. They have adopted trade mark INDOL in respect of multi purpose wheel bearing grease and gear oil. The containers used by the defendants bearing the trade mark INDOL has similar colour combination, get up, lay-out as that of the plaintiffs. The defendants have also adopted the trade mark INDEROIL for Girdling Brake Clutch Fluid Crimson. The cap of the container is having the mark INDOL. Test purchases were made by the plaintiffs and then action has been initiated.

7. Without entering into the details, suffice it to state that the documents filed by the plaintiffs with their plaint amply borne out truthfulness of the several averments made in the plaint and noticed hereinabove.

8. The defense of the defendants is based mainly on Section 33 of the Trade and Merchandise Marks Act, 1958. It is stated by the defendants that they are the prior users of the said trade marks since 1981 and so the plaintiffs cannot use them. Admittedly, the trade mark is not registered with the defendants. Section 33 of the Trade and Merchandise Marks Act, 1958 provides as under :

Section 33

SAVING FOR VESTED RIGHTS : Nothing in this Act shall entitle the proprietor or a registered user of a registered trade mark to interfere with or restrain the use by any person of a trade mark identical with or nearly resembling it in relation to which that person or a predecessor in title of his has continuously used that trade mark from a date prior :

(a) to the use of the first-mentioned trade mark in relation to those goods by the proprietor or a predecessor in title of his; or

(b) to the date of registration of the first-mentioned trade mark in respect to those goods in the name of the proprietor or a predecessor in title of his;

which is the earlier, and the Registrar shall not refuse (on such use being proved) to register the second mentioned trade mark by reason only of registration of the first-mentioned trade mark.

9. In support of their plea that they have been using, allegedly infringing, trade mark since 1981, the defendants have filed a few invoices. These invoices 14 in number, are respectively dated 30.3.1981, 30.12.1982, 20.3.1984, 23.10.1986, 6.10.1989, 25.10.1989, 18.11.1989, 25.1.1990, 29.1.1990, 24.2.1990, 23.4.1991, 24.4.1991, 28.10.1988 and 27.4.1989. Each of the invoice is for a petty amount i.e., in hundreds only. Apart from the fact that the plaintiffs have challenged the genuineness of the invoices, it is worth being noticed that none of the invoices is for an amount exceeding a few hundreds and then the invoices are spread over a period of more than 10 years. up to the year 1988 not more than one invoice for one year has been filed. The defendants have not filed any account books. They have not given any figures of sales and any figures of expenditure incurred by them on advertising their products.

10. There are few other prominent features of the case to be noticed. The plaintiffs have filed a good number of documents Along with their replication dated 12.12.1994. These documents reveal that :

(i) the plaintiffs had sought for registration of INDROL LUBRICANTS AND SPECIALITIES PVT. LTD. with the Registrar of companies on 27.4.1979. Incorporation of company by this name was permitted. In 1982, the name of the company was permitted to be changed to INDROL LUBRICANTS AND SPECIALITIES LTD;

(ii) the plaintiffs had also sued (a) Five Star Chemicals Ltd. and (ii) M/s. Deluxe Oil and Chemicals in the year 1991 for protection of their trade marks INDROL,

CASTROL AND CASTROL CRIMSON. The plaintiffs had succeeded in securing injunction orders protecting their trade marks.

11. In the year 1991 M/s. Five Star had filed a Civil Suit against this very defendant in the court of Mr. L. D. Mual, Additional Distt. and Sessions Judge, Delhi registered as S. No. 319/91. The plaintiff therein had claimed 'Indol' to be its own trade mark and had complained of passing off the same by this very defendant by using the trade marks 'Indol' and 'Indrol'. The plea taken by the defendant herein in that suit, as disclosed by the affidavit dated 1st July, 1991 of Mr. Subhash Chander Partner of the defendant, was that M/s. Indrol Lubricants and Specialities Ltd., were the registered owners of the trade mark Indrol and the plaintiff there at namely M/s. Five Star was pirater of the trade mark and hence not entitled to succeed.

12. The two plaintiffs herein had filed Civil Suit No. 1724/91 in the High Court of Delhi against the same M/s. Five Star Chemicals. This suit was decreed and M/s. Five Star Chemicals Industries were restrained from using or passing off the trade marks 'Indol' or 'Indrol' belonging to the plaintiffs herein vie decree dated 3rd April, 1992.

13. In view of the above said set of documents, it does not lie with the defendant herein to contest the plaintiffs' prayer. It appears that the defendant who is committing the infringement of the plaintiffs registered trade mark and also passing off his goods as the plaintiffs' is trying to shield his action by taking different pleas in different litigations.

14. For the foregoing reasons, the is 4458/94 is allowed. The interim injunction order dated 10th May, 1994 is confirmed. Further it is directed that the defendants, their partners servants, agents, shop keepers or any other person under them or on their behalf shall remain restrained from :

(i) dealing in multipurpose grease, gear oil and wheel bearing grease or any other cognate or related goods under the trade mark INDOL or any other mark which is deceptively similar with the registered trade mark INDROL;

(ii) using the mark INDEROIL in respect of break and clutch fluid crimson;

(iii) from manufacturing and selling multipurpose wheel bearing grease and gear oils and break clutch fluid crimson or any other cognate or allied goods packed in tin containers annex ture X, Y, Z and Z-1 bearing the trade marks INDOL and INDROL and general get up and lay out and colour scheme which are substantial reproduction in the matter of get-up, lay out and other features of the plaintiffs' products and also from passing off their goods as of the plaintiffs'.

15. is 9897/94 filed by defendant under Order 39, Rule 4 is rejected.

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