



\$~2

* **IN THE HIGH COURT OF DELHI AT NEW DELHI**
Date of Decision: 6th October, 2022
+ **CS(COMM) 253/2022**
MALOOK CHAND COTTON AND OIL MILLS Plaintiff
Through: Mr. Chitra Ahluwalia, Mr. S.K. Bansal and Mr. Virender Sinha, Advocates. (M:9873185628)

versus

ABHISHEK GUPTA TRADING AS HARIOM ENTERPRISES Defendant
Through: Mr. S.S. Dhir and Mr. Manmohan Singh, Advocates. (M:9711409889)

CORAM:
JUSTICE PRATHIBA M. SINGH
Prathiba M. Singh, J.(oral)

1. This hearing has been done through hybrid mode.
2. The present suit has been filed by the Plaintiff- M/s Malook Chand Cotton and Oil Mills against the Defendant- Mr. Abhishek Gupta, *trading as* M/s Hariom Enterprises. The Plaintiff seeks permanent injunction in respect of its mark 'DOUBLE HIRAN' as also the accompanying label which is used in respect of mustard oil and other edible oils. The case of the Plaintiff is that its predecessor- M/s Tilak Ram & Sons (P) Ltd., adopted the mark 'DOUBLE HIRAN' in 1942 and over the course of time, the label changed and evolved. The right to use the said mark was given to the Plaintiff by its predecessor vide sale deed dated 18th August, 1982.
3. The first registration of the device mark bearing no.2774 was granted in the name of the predecessor of the Plaintiff on 29th July, 1942. As per ld.



Counsel for the Plaintiff, the said mark may not be valid and standing on the Register as on date. However, the current status of the trade mark erroneously shows that the same is renewed till 29th July 2049. Apart from the said registration, the Plaintiff also has trademark registration for the word mark 'DOUBLE HIRAN' written in English bearing trademark number 1476828 from 7th August, 2008 with user from 1st January 1977. Two label marks of 'DOUBLE HIRAN' are also registered in favour of the Plaintiff as of 2008 and 2014 under classes 29 and 35 in respect of edible oil including mustard oil. The user claimed in both the trademark registrations is of 1960.

4. The label of the Plaintiff is also registered under the Copyright Act, 1957 bearing registration no. A44332/84, a copy of which has been placed on record. The Plaintiff also promotes its business and the products through the website www.doublehiranoil.com. The mark 'DOUBLE HIRAN' with the device of two deer standing one behind the other forms the essential and prominent feature of the Plaintiff's brand. It is claimed that the Plaintiff's mark 'DOUBLE HIRAN' and the accompanying device/label has acquired enormous goodwill and reputation in the market. The sales figure of mustard oil and mustard cake in the last year 2021-2022 is claimed to be to the tune of Rs.135 crores and Rs.5 crores respectively. The yearwise turnover has also been placed on record.

5. The grievance of the Plaintiff, is that the Defendant has adopted a phonetically similar mark 'DOUBLE HORN' along with a label consisting of two deer in the same colour combination in respect of identical products. The Plaintiff came to know of the Defendant when it searched the trademark database and realized that the Defendant had filed two applications which



were initially registered but they have since been opposed and the status of the marks stands changed to 'OPPOSED'.

6. In the said applications bearing no. 5025293 and 4830123, the Defendant has stated that the marks are 'proposed to be used'. The Plaintiff has since opposed these marks. The Defendant is also stated to have wrongfully obtained a 'Search Certificate', under Section 45 of the Copyright Act, from the Trademark Office for copyright registration of the label. The Defendant's products have been purchased by the Plaintiff and the photographs of the products have also been placed on record. Mr. Bansal, Id. Counsel for the Plaintiff submits that the Plaintiff's products bearing the mark 'DOUBLE HIRAN' are promoted and sold extensively in Delhi including by its website www.doublehiranoil.com.

7. The Plaintiff's grievance was, thus, against use of the mark 'DOUBLE HIRAN' with the device having two deer in an identical colour combination, label, layout and trade dress. The Court had considered the matter on 21st April, 2022 and had passed an *ad interim* injunction order in the following terms:

"20. A perusal of the competing marks and labels leaves no doubt whatsoever that the Defendant has virtually imitated Plaintiff's mark, device, logo, label, packaging and has copied all the essential characteristics of the Plaintiff's mark. The difference between 'DOUBLE HIRAN' and 'DOUBLE HORN' is hardly decipherable by looking at the product -mustard oil which is sold in tins. The overall look and feel and get up of Plaintiff's and Defendant's product are almost identical. The competing labels of the parties are set out below:



21. *In the opinion of this Court, the Plaintiff has made out a prima facie case for grant of an ex parte ad interim injunction. The balance of convenience lies in favour of the Plaintiff. If the said relief is not granted in favour of the Plaintiff, irreparable injury would be caused to the Plaintiff. The Plaintiff has a very old business of selling mustard oil under the mark 'DOUBLE HIRAN'. Since, the products in question are for human consumption, the quality standard is also a concern for the Court. The Plaintiff's goodwill could also be severely impacted by misuse of the mark and label.*

22. *Considering the fact that the Defendant's adoption is very recent, as stated in its own trademark applications, till the next date of hearing the Defendant and all others acting for or on its behalf including its stockists, distributors or retailers are restrained from manufacturing, selling, offering for sale mustard oil or any edible oil under the trademark 'DOUBLE HORN' including the accompanying device/label, and packaging which is either identically/deceptively similar to the Plaintiff's mark/label and packaging 'DOUBLE HIRAN' as extracted above. "*

8. On the said date, a Local Commissioner was also appointed to visit



the premises of the Defendant and make an inventory of the infringing products. The local commission was executed on 04th May, 2022 and the Local Commissioner's Report reveals that no infringing products bearing the mark 'DOUBLE HORN' were found at the Defendant's premises.

9. Ld. counsel appearing for the Defendant today submits that the Defendant is willing to change the mark, name as also the layout of the label but would only wishes to continue with the same colour combination, i.e., yellow and red, inasmuch as this colour combination is common to the trade. He also submits that the word 'DOUBLE' is used by a large number of manufacturers.

10. Mr. Bansal, Id. Counsel submits that as long as the Defendant is willing to suffer a decree, in terms of the prayer in the suit, the Plaintiff has no objection. Ld. counsel for the Defendant, has proposed three different marks 'DOUBLE HEN', 'DOUBLE COCK' and 'DOUBLE KOLHU'. His client is willing to give an undertaking that he would not use the name/mark 'DOUBLE HORN', the two deer device/label in the same layout and colour combination as has been impugned in the present suit. He submits that his client Mr. Abhishek Gupta who is the proprietor of the Defendant firm has given him instructions to this effect. On the other hand, Id. Counsel for the Plaintiff submits that the Court ought not to approve any of the marks which have been suggested by the Defendant.

11. Heard. In the present suit, the Court is concerned with the *lis* between the parties relating to the mark 'DOUBLE HORN', and the accompanying device / label thereof which is identical, and confusingly similar to the Plaintiff's mark 'DOUBLE HIRAN' and the accompanying device / label thereof. Insofar as the proposed marks of the Defendant is concerned, the



Court cannot look into these marks today inasmuch as the information relating to the availability of these marks or any grievances of third parties would be in the realm of speculation. Insofar as the *lis* before this Court is concerned, since the Defendant is willing to suffer a decree in terms of the prayer clause in the suit, no further cause of action would survive.

12. Insofar as damages are concerned, it is the stand of the Defendant that the Defendant obtained the 'No Objection Certificate' from the Trade Mark Registry in accordance with law and only, thereafter, adopted the mark 'DOUBLE HORN' and the accompanying label. He, further, submits that since no seizure was made by the Local Commissioner, it is clear that the Defendant has not used the mark. At this stage, *Id.* Counsel for the Plaintiff does not press the relief of damages and costs.

13. In these facts and circumstances, since the dispute has been amicably resolved between parties, a decree of permanent injunction is granted restraining the Defendant, trading in his own name or in the name of the firm 'M/s HARIOM ENTERPRISES', and all other acting for or on his behalf including family members, dealers, distributors, *etc.*, from manufacturing, selling, offering for sale, exporting, distributing or advertising mustard oil or any other form of edible oil, vanaspati ghee or any other cognate or allied products under the mark 'DOUBLE HORN' and the accompanying device or label impugned in the present suit as extracted above or any other mark, device or label which is identical/confusingly similar to the Plaintiff's mark, name, label 'DOUBLE HIRAN' device or label of two deer.

14. The Defendant shall withdraw its trademark applications 5025293, 4830123 for the impugned mark/label and the copyright application within a



period of two weeks upon which the office of the CGPDTM shall pass orders in accordance with law within four weeks thereafter.

15. The suit is decreed in the above terms. All pending applications are disposed of. The decree sheet be drawn up accordingly.

16. It is made clear that the Court has not expressed any opinion on any of the proposed marks which the Defendant wishes to adopt.

17. Let the present order be intimated by the Registry for compliance to the Office of CGPDTM through email llc-ipo@gov.in.

18. In view of the fact that the parties have resolved their disputes at the initial stage full court fee is directed to be refunded through counsel in view of the judgment of the Id. Division Bench in *Nutan Batra v. M/s Buniyaad Associates, 2018 (255) DLT 696*.

PRATHIBA M. SINGH
JUDGE

OCTOBER 6, 2022
dj/sk