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

+ **CS(COMM) 313/2024, I.A. 8464/2024-Stay**

CASTROL LIMITED

.....Plaintiff

Through: Mr. Urfee Roomi, Adv.

Versus

GOVIND MOHAN SHARMA

.....Defendant

Through: Mr. Wasim Ashraf and Mr. Anand
Prakash Tiwari, Advs. alongwith
defendant in person

CORAM:

HON'BLE MR. JUSTICE SAURABH BANERJEE

ORDER

26.05.2025

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1. Learned counsel for the parties submit that the present *lis* has been settled amicably and they jointly pray that a consent decree under Order XXXIII Rule 3 of the Code of Civil Procedure, 1908 (**CPC**) may be passed in terms of prayer clauses set out in paragraph 62.(a) to (d) of the present plaint.

2. In the wake of the above, learned counsel for the plaintiff prays that liberty may be granted to press prayer 'h' of paragraph 62. of the present plaint i.e. "... ..An order declaring the Plaintiff's CASTROL Device and



ACTIV Device marks,

and



to be well-known in view of the averments and contentions put forth by the



Plaintiff... ..”. Furthermore, the plaintiff is willing to give up the remaining prayer clauses set out in paragraph 62.(e) to (g) and (i) of the present plaint, if the defendant is willing to pay nominal sum of Rs.4,00,000/- [*Four Lakhs Only*] in the form of costs/ damages.

3. Learned counsel for the defendant upon instructions from the defendant, who is present in the Court in person, submits that the defendant has already withdrawn trademark application bearing no.528032 for registration of the mark ‘**CONTROL**’ in *Class 4* of the Trade Marks Act, 1999 (***the Act***), and is willing to suffer a consent decree as also pay the nominal costs/ damages of Rs.4,00,000/- in favour of the plaintiff, payable to Sujata Chaudhari IP Attorneys [Account No.914020022909462; IFSC Code UTIB0001149], which would be paid by the defendant in three instalments within a period of three months in the following order:-

- 1) Rs.2,00,000/- be paid on or before 14.06.2025;
- 2) Rs.1,00,000/- be paid on or before 14.07.2025;
- 3) Rs.1,00,000/- be paid on or before 14.08.2025.

4. At this stage, learned counsel for the plaintiff also prays that the goods seized by the Local Commissioner in compliance of the order 16.04.2024 passed by this Court, be returned to the plaintiff or their authorised representative for destruction thereof.

5. Learned counsel for the defendant in response submits that all the infringing products seized by the Local Commissioner, during the execution of the commission on 21.04.2024, will be handed over to the



authorised representative(s) of the plaintiff/ learned counsel for the plaintiff.

6. With the consent of both the learned counsels for the parties as also of the defendant present in person, the authorised representative(s) of the plaintiff/ learned counsel for the plaintiff shall be free to collect all the infringing products seized by the Local Commissioner on 14.06.2025 @ 11:00 AM from the premises of the defendant mentioned in the memo of parties.

7. Qua prayer clause set out in paragraph 62.(h) of the plaint, the learned counsel for the plaintiff submits that the plaintiff has presence in around 160 countries with more than 5,50,000 customers and nearly 200 million end users, the plaintiff is an entity with a global reputation.

8. Learned counsel further submits that the plaintiff has adopted its **CASTROL** and **ACTIV** marks in the year 1998 for engine oils, coolant, engine lubricants and other allied and cognate goods in India and has been using the same continuously till date, furthermore, the plaintiff owns valid and subsisting registrations for '**CASTROL**' device mark and '**ACTIV**' wordmark in India under *Class 4* of the Act since and from year 2000 and 1999 respectively as also '**ACTIV**' device mark since the year 2016.

9. Learned counsel then submits that the plaintiff has also promoted its various products and prominently displayed them under the '**CASTROL**' and '**ACTIV**' marks as an official sponsor in numerous TV shows sporting events and has received extensive coverage in various renowned publications, periodicals, magazines. As such, the plaintiff has invested



substantially in advertising its marks which have also been endorsed by popular Indian celebrities.

10. Learned counsel thereafter submits that the plaintiff has indirect presence in India since the year 1910 and has been directly trading since year 1919, moreover, the plaintiff has been using various logos and color combinations of red, white and green to depict its **CASTROL** and **ACTIV** marks to achieve a distinctive character at least from the year 1998 and in fact, as of the year 2021, the plaintiff's Indian subsidiary enjoyed around 20% market share in overall Indian engine lubricant market. Furthermore, the plaintiff has also an active website www.castrol.com featuring its products under **CASTROL** and **ACTIV** marks and has significant social media presence as well.

11. Learned counsel further submits that a Co-ordinate Bench of this Court *vide* order dated 18.08.2011 in CS(OS) 1369/2006 titled **Castrol Limited & Anr. v Mahendra Automobiles and Ors.** has already declared **CASTROL** word mark as a “well-known” trademark in India. In view of the above, he prays that ‘**CASTROL**’ and ‘**ACTIV**’ device marks is also qualified to be recognized as “well-known” trademarks.

12. Learned counsel for the defendant submits that he does not wish to controvert any of the arguments advanced by learned counsel for the plaintiff with respect to the aforesaid factual matrix before this Court.

13. This Court has heard the learned counsel for the parties and perused the documents on record alongwith judgements cited as well.

14. For adjudication of prayer clause set out in paragraph 62.(h) of the



present plaintiff, this Court has to take into account the provisions of *Section 2(zg)*¹ and *Section 11(6)*² of the Act.

15. In view of the undisputed factual position, as also that the mark(s) device and word ‘**CASTROL**’ and ‘**ACTIV**’ have been advertised by the plaintiff all across India qua which the plaintiff has spent Rs.141.75 crores, Rs.130.21 crores and Rs.129.15 crores from 2021 to 2023 respectively, leaves no shadow of doubt that plaintiff and its mark(s) are recognised all across the country. Furthermore, the plaintiff has been continuously using said mark(s) ‘**CASTROL**’ and ‘**ACTIV**’ since and from 1998 and has valid and subsisting registration thereof from the year 2000 and 1999 respectively.

16. Not only the plaintiff had an annual turnover of Rs.5.07 thousand crores in the year 2023 itself but also, its wordmark ‘**CASTROL**’ has since long been recognised as a “well-known” mark under *Section 2(zg)* of the

¹ *Section 2(zg) —well known trade mark, in relation to any goods or services, means a mark which has become so to the substantial segment of the public which uses such goods or receives such services that the use of such mark in relation to other goods or services would be likely to be taken as indicating a connection in the course of trade or rendering of services between those goods or services and a person using the mark in relation to the first-mentioned goods or services.*

² *Section 11(6)-The Registrar shall, while determining whether a trade mark is a well-known trade mark, take into account any fact which he considers relevant for determining a trade mark as a well-known trade mark including—*

(i) *the knowledge or recognition of that trade mark in the relevant section of the public including knowledge in India obtained as a result of promotion of the trade mark;*
(ii) *the duration, extent and geographical area of any use of that trade mark;*
(iii) *the duration, extent and geographical area of any promotion of the trade mark, including advertising or publicity and presentation, at fairs or exhibition of the goods or services to which the trade mark applies;*
(iv) *the duration and geographical area of any registration of or any application for registration of that trade mark under this Act to the extent that they reflect the use or recognition of the trade mark;*
the record of successful enforcement of the rights in that trade mark, in particular the extent to which the trade mark has been recognised as a well-known trade mark by any court or Registrar under that record



Act by this Court in *Castrol Limited & Anr. (supra)*.

17. In view of the aforesaid, this Court observes that the device mark



as also word mark '**ACTIV**' and device mark



of the plaintiff, have become "well-known" mark(s) respectively under Section 2(zg) of the Act.

18. Qua prayer clauses set out in paragraph 62.(a) to (d) of the present plaint, in view of undertaking/ statements given on behalf of the defendant, the present suit is decreed with nominal costs/ damages of Rs.4,00,000/- to be paid in favour of the plaintiff by the defendant to Sujata Chaudhari IP Attorneys [Account No.914020022909462; IFSC Code UTIB0001149] in three instalments within the time frame as detailed in *paragraph no.4* hereinabove, i.e. Rs.2,00,000/- [Two Lakhs Only] be paid on or before 14.06.2025, Rs.1,00,000/- [One Lakh Only] be paid on or before 14.07.2025 and Rs.1,00,000/- [One Lakh Only] be paid on or before 14.08.2025.

19. Further, considering the aforesaid position, the previous costs of Rs.50,000/- imposed vide last order dated 09.05.2025 be also paid within a period of four weeks to Army Central Welfare Fund [Account No.520101236373338 and IFSC Code UBIN0530778].

20. Accordingly, the Registry is directed to draw up decree sheet in terms of prayers 'a' to 'd' of the present plaint as also in terms of *paragraph(s) 18 and 19* hereinabove.



21. In addition, it is further directed that all the infringing products seized by the Local Commissioner during the execution of the commission on 21.04.2024, be handed over to the authorised representative(s) of the plaintiff/ learned counsel for the plaintiff on 14.06.2025 at the premises of the defendant as mentioned in the memo of parties.

22. Accordingly, the suit is decreed in the aforesaid terms and is disposed of along with pending application(s).

SAURABH BANERJEE, J

MAY 26, 2025/bh