



IN THE HIGH COURT OF JUDICATURE AT BOMBAY

ORDINARY ORIGINAL CIVIL JURISDICTION

IN ITS COMMERCIAL DIVISION

INTERIM APPLICATION NO. 2143 OF 2021

IN

COMMERCIAL IP SUIT NO. 275 OF 2021

1. Petrofer Chemie H.R. Fischer GMBH & Co. KG.

A Company incorporated under the laws of
Germany having its office at Romerring
12-16, 31137, Hildesheim, Germany.

2. Hardcastle Petrofer Private Limited,

A Company incorporated under the Companies
Act, 1956, having its registered office at
Office No.802, Floor-8, Plot – 213,
Raheja Chambers, Free Press Journal Marg,
Nariman Point, Mumbai – 400 021.

...Applicants/Plaintiffs

Versus

1. United Petrofer Limited,

A Company incorporated under the
Companies Act, 2013, having its
registered office at Survey No.92,
Block -A, B, C, Illaxy Compound,
Opp. Navin Flourine, Bhestan, Surat –
395, 023, Gujarat.

...Defendant

Dr. Veerendra Tulzapurkar a/w Mr. Ashutosh Kane, Ms. Amruta Thakur, Ms.
Archita Gharat i/b W. S. Kane & Co., for the Applicants/Plaintiffs.

Mr. Amit Padwal a/w Ms. Afrin Dalal, Ms. Aafreen Bano i/b Mr. Bahraiz Irani,

for the Defendant.

CORAM : ARIF S. DOCTOR, J.
RESERVED ON : 17th OCTOBER 2025
PRONOUNCED ON : 6th NOVEMBER 2025

JUDGMENT :-

1. The Applicants/Plaintiffs have, by way of the captioned Interim Application, sought the following reliefs:

“(a) that pending hearing and final disposal of the suit, the Defendant by itself, its directors, employees, servants, agents, dealers, stockists, distributors, licensees and all persons claiming under it be restrained by an order and temporary injunction of this Hon'ble Court from infringing the Plaintiffs registered trade mark PETROFER bearing the registration numbers as more particularly stated in Exhibit "E" to the Plaint by using the impugned trade mark "UNITED PETROFER", the impugned corporate name "UNITED PETROFER LIMITED" and the impugned website/ domain name www.unitedpetrofer.com and/or any other trade mark, corporate name and website/ domain name containing the word PETROFER and/or any other word deceptively similar thereto and/or any other trade mark, corporate name and website/ domain name identical with or deceptively similar to the Plaintiffs' registered trade mark PETROFER bearing the registration numbers as more particularly stated in Exhibit "E" to the Plaint upon and in relation to the goods in respect of which the Plaintiffs have secured the aforesaid registrations and/or the like goods or in any other manner whatsoever;

(b) that pending the hearing and final disposal of the suit, the Defendant by itself, its directors, employees, servants, agents, dealers, stockists, distributors, licensees and all persons claiming under it be restrained by an order and temporary injunction of this Hon'ble Court from infringing the Plaintiffs' registered trade mark PETROFER bearing the registration numbers as more particularly stated in Exhibit "E" to the Plaint by using the word "PETROFER" as its corporate name or part of its corporate name dealing in the goods in respect of which the Plaintiffs have secured the aforesaid registrations or in any other manner whatsoever;

(c) that pending the hearing and final disposal of the suit, the Defendant by itself, its directors, employees, servants, agents, dealers, stockists, distributors, licensees and all persons claiming under it be restrained by an order and temporary injunction of this Hon'ble Court from manufacturing and/or marketing and/or supplying and/or selling and/or advertising and/ or trading in and/or exporting and/or otherwise dealing in industrial lubricants, additives, grease, industrial oils, chemicals and/or similar goods under the impugned trade mark "UNITED PETROFER", the impugned corporate name "UNITED PETROFER LIMITED", and the impugned website/ domain name www.unitedpetrofer.com and/or any other trade mark, corporate name and website/domain name containing the word "PETROFER" and/or any other word deceptively similar thereto and/or any other trade mark, corporate name and website/ domain name deceptively similar to the Plaintiffs' said well-known trade mark/ name "PETROFER" so as to pass off or enable others to pass off the Defendant's impugned goods/ business as and for the said well-known goods /business of the Plaintiffs or in any other manner whatsoever;"

However, before adverting to the rival contentions, it is useful for context to give a brief background of facts leading upto the filing of the captioned Commercial IP Suit.

A BRIEF BACKGROUND

2. The First Plaintiff is a company incorporated under the laws of Germany and established in or about the year 1948. The business of the First Plaintiff includes manufacturing, marketing, and selling industrial oils and chemicals, lubricants, greases, hydraulic fluids, and various processing compounds and chemicals used in metalworking, such as heat treatment and quenching agents, cutting coolants, rust preservatives, cleaning and corrosion-prevention preparations, drawing compounds, rolling oils, and fire-resistant hydraulic fluids (hereinafter collectively referred to as "the said goods").

3. Since its inception, the First Plaintiff is stated to have carried on its business under the name and style incorporating the word 'PETROFER', which also serves as the First Plaintiff's trade mark and trade name and is prominently displayed on all goods manufactured and supplied by the First Plaintiff.
4. On 17th March, 1997, the First Plaintiff applied for and secured registrations of the said trade mark 'PETROFER' in India in classes 1, 2, 3 and 4 ("relevant classes"), all of which are valid and subsisting. On or about 18th November, 1999, the First Plaintiff registered its domain name 'petrofer.com'. The First Plaintiff's subsidiaries, associates, and group companies are also stated to have registered other domain names containing the word 'PETROFER'. The First Plaintiff has also applied for and secured registration of said trade mark PETROFER and/or trade marks containing 'PETROFER' in various countries.
5. The Second Plaintiff was incorporated on or about 25th October, 2004, under the provisions of the Companies Act, 1956, with a view to manufacture, market and sell, *inter alia*, specialty chemical products. The name of the Second Plaintiff at the time of incorporation was HHIL Lubricants Pvt. Ltd ("HHIL").
6. On 13th January 2005, HHIL entered into an Agreement with the First Plaintiff, under which the First Plaintiff granted HHIL an exclusive and perpetual licence for use in India in respect of all its intellectual property, including trademarks, trade names, logos, patents, and know-how for the manufacture and marketing of, *inter alia*, the said goods. HHIL subsequently changed its name to Hardcastle Petrofer Private Limited, i.e., the Second Plaintiff,

pursuant to which, vide an Agreement dated 22nd June 2021, the First Plaintiff continued and reaffirmed the exclusive licence and permissions earlier granted in favour of the Second Plaintiff.

7. The Defendant, i.e., 'UNITED PETROFER', was incorporated on 29th July 2016.

8. It is the Plaintiffs' case that on or about 8th November, 2018, one of the employees of Petrofer UK PLC, a company associated with the First Plaintiff, while searching for the Second Plaintiff over the internet, came across the Defendant's website, www.unitedpetrofer.com. Thereafter, the Managing Director of Petrofer UK PLC emailed the Director of the Second Plaintiff, enquiring about the existence of the Defendant, and it was only upon enquiries that the Plaintiffs learnt that the Defendant was incorporated on 29th July, 2016, under its present name, i.e., 'UNITED PETROFER'.

9. It is also the case of the Plaintiffs (though denied by the Defendant) that a meeting was held with the Plaintiffs and the Defendant on 28th November 2018, which was attended on behalf of the Defendant by the Defendant's Director and one Mr. Hitesh P. Shah. At the said meeting the Plaintiffs are stated to have informed the Defendant of their statutory and common law rights in respect of the mark 'PETROFER' and called upon the Defendant to stop using 'PETROFER'. It is the case of the Plaintiffs that though the meeting ended inconclusively, the Plaintiffs believed that the Defendant would stop using 'PETROFER' since they were made aware of the Plaintiffs' statutory rights in respect thereof.

10. In April/May 2019, the Plaintiffs made an application to the Regional Director MCA, North-Western Region, Ahmedabad, u/s 16(1)(b)¹ of the Companies Act, 2013, seeking a direction against the Defendant to rectify/change its corporate name. The Regional Director, after hearing both the parties, vide order dated 18th September, 2019, found the Defendant's corporate name to be objectionable since the same resembled the Plaintiffs' trade mark/name. The Defendant was, therefore, vide an Order dated 18th September 2019, directed to change its name within six months.

11. The Defendant thereafter, in June 2020, filed Rectification Applications before the Trade Mark Registry by which the Defendant sought cancellation of the registration granted in respect of the First Plaintiff's registered trade marks in the relevant classes. In July 2020, the Defendant filed a Special Civil Application before the Gujarat High Court impugning the Order dated 18th September 2019 passed by the Regional Director Ahmedabad directing the Defendant to change its name within a period of six months.

12. Since the Defendant failed to comply with the Order dated 18th September 2019, the Registrar of Companies on or about 10th March 2021 filed a complaint under Section 16(3) of the Companies Act, 2013, against the Defendant and its Directors before the Chief Metropolitan Magistrate, Ahmedabad, which is pending.

1 16 (1)(b) on an application by a registered proprietor of a trade mark that the name is identical with or too nearly resembles to a registered trade mark of such proprietor under the Trade Marks Act, 1999 (47 of 1999), made to the Central Government within three years of incorporation or registration or change of name of the company, whether under this Act or any previous company law, in the opinion of the Central Government, is identical with or too nearly resembles to an existing trade mark, it may direct the company to change its name and the company shall change its name or new name, as the case may be, within a 3 [period of three months] from the issue of such direction, after adopting an ordinary resolution for the purpose.

13. On 22nd July 2021, the First Plaintiff made an application to the Registrar of Trade Marks to register the name of the Second Plaintiff as the registered user in respect of the trade mark 'PETROFER'.

14. The Plaintiffs filed the captioned Suit on 25th August 2021.

15. The application filed by the First Plaintiff to register the name of the Second Plaintiff as the registered user in respect of the trade mark 'PETROFER' was allowed vide an Order dated 18th January 2022, and the name of the Second Plaintiff was entered into the Register of Trademarks as the 'Registered User' in respect of the trade mark 'PETROFER'. Hence, the Second Plaintiff initially as an exclusive licensee of the First Plaintiff from the year 2005 and thereafter as a registered user from the year 2022, has been using the trade mark 'PETROFER' in relation to its goods and business in India.

16. The Rectification Applications filed by the Defendant were dismissed on 28th January 2025, for want of prosecution vide separate orders passed by the Registrar of Trade Marks, Mumbai.

SUBMISSIONS ON BEHALF OF THE PLAINTIFFS

17. Dr. Tulzapurkar, Learned Senior Counsel appearing on behalf of the Plaintiffs, submitted that the First Plaintiff has, since its inception, continuously carried on business under the name and style incorporating the word 'PETROFER', as its leading, prominent, and distinctive feature. He submitted that 'PETROFER' had been used both as a trade mark and a trade name in relation to

the goods manufactured and supplied by the First Plaintiff. He then pointed out that the mark 'PETROFER', being a coined and invented word, was originally adopted by the First Plaintiff and forms an integral part of the trade names of the subsidiaries, associates, group companies, and licensees of the First Plaintiff. He submitted that these entities, operate under the direct control and supervision of the First Plaintiff and/or Petrofer GmbH, and collectively conduct extensive business worldwide under the 'PETROFER' mark and trade name, generating multi-billion-dollar global sales.

18. Dr. Tulzapurkar further pointed out that the Plaintiffs had made substantial investments in developing, promoting, and popularising the 'PETROFER' brand and its products, as was evident from the magazines, brochures, and media publications annexed at Exhibits A-1 to A-9 of the Plaint which he submitted, also demonstrated the Plaintiffs' extensive, open, and continuous use of the mark across jurisdictions. He then submitted that the Plaintiffs were the registered proprietors of several trade marks, each incorporating the word 'PETROFER' as their essential and prominent feature. He then, from Exhibits E and E-1 to E-8 of the Plaint, pointed out that the Plaintiffs registrations spanned multiple classes, covering the full range of goods dealt with by the Plaintiffs. He thus submitted that any use by the Defendant of an identical or deceptively similar mark in relation to the same or similar goods was bound to cause confusion and deception among consumers. In support of his contention, that use of a deceptively similar mark in respect of cognate goods inevitably leads to confusion and constitutes infringement Dr. Tulzapurkar placed reliance upon

the decision of this Court in the case of *Neon Laboratories Ltd. v. Themis Medicare Ltd.*² and of the decision of the Hon'ble Supreme Court in the case of *Corn Products Refining Co. v. Shangrila Food Products Ltd.*³

19. Dr. Tulzapurkar, then in support of his contention that the Plaintiffs had extensive reputation and goodwill in respect of the mark 'PETROFER', placed reliance upon a chartered accountant's certificate which certified both the sales turnover of the Second Plaintiff from 2005 to 2020 and also the quantum of expenditure incurred by the Second Plaintiff on promotional activities, both of which, he pointed out, were substantial. He also placed reliance upon copies of sales invoices and promotional material to substantiate the sales and market presence of the Plaintiffs in respect of the registered trade mark 'PETROFER'. He thus submitted that the Plaintiffs had made out an overwhelmingly strong case to establish the extensive reputation and goodwill acquired in respect of the 'PETROFER' trade marks.

20. Dr. Tulzapurkar then pointed out that the Second Plaintiff, who was an exclusive licensee under strict control and supervision of the First Plaintiff, had also openly, continuously and extensively been using the said trade mark/name 'PETROFER' in relation to its goods and business in India since 2005, as more particularly set out in paragraph 12 of the Plaint. He submitted that even prior to 2005, the First Plaintiff, being the leading company dealing in the said goods worldwide, always had a transborder reputation in India through

2 2014 SCC OnLine Bom 1087

3 1959 SCC OnLine SC 11

advertisements published and circulated and also through the internet.

21. Dr. Tulzapurkar then submitted that the goods which the Defendant was manufacturing and selling were identical to or of the same description as those goods in respect of which the Plaintiffs had valid registrations of their trade marks. He submitted that this would therefore create a clear and imminent likelihood of confusion and deception among consumers and purchasers. He thus submitted that it was imperative for this Hon'ble Court to grant an injunction restraining the Defendant from using the word 'PETROFER', both on the grounds of infringement and passing off. He submitted that such an order would not only safeguard the Plaintiffs' statutory and proprietary rights but also protect consumers from any confusion and/or deception.

22. Dr. Tulzapurkar then fairly pointed out that, between April 2017 and June 2018, the purchase department of the Second Plaintiff had procured certain raw materials from the Defendant. He, however, submitted that these purchases were of an insignificant quantity, constituting only 0.06% of the total purchases made by the Second Plaintiff during that period. He also submitted that the key managerial personnel of the Second Plaintiff were unaware of the said purchases as well as the existence of the Defendant at that time, and hence the fact that the Second Plaintiff had dealt with the Defendant was entirely inconsequential to the Plaintiffs' entitlement to the reliefs sought in the present Interim Application. In support of his contention he placed reliance upon the judgment of the Delhi High Court in the case of *Make My Trip (India) Pvt. Ltd. v.*

Make My Travel (India) Pvt. Ltd.⁴

23. Dr. Tulzapurkar then submitted that the Defendant's adoption of 'PETROFER' as part of the Defendant's trade name was clearly dishonest. In support of his contention, he invited my attention to Section 2(1)(m)⁵ of the Trade Marks Act, 1999, and pointed out that the definition of 'mark' specifically includes 'name'. He thus submitted that it was therefore incumbent upon the Defendant, before adopting 'PETROFER' as part of its trade/business name, to have exercised due diligence, including undertaking a search in the Trade Mark Registry in order to ascertain whether the said mark was registered and/or belonged to anyone. He submitted that failure to do so would clearly amount to negligence on the part of the Defendant and thus render the Defendant liable for infringement. In support of his contention, he placed reliance upon the decision of this Court in the case of ***Bal Pharma Ltd. vs Centaur Laboratories Pvt. Ltd. & Anr.***⁶ from which he pointed out that this Court had held that where a defendant has used a mark without making proper enquiries with regard to the registration status of such mark, the defendant does so "*at its own risk and peril*". He thus submitted that the Defendant, having negligently adopted 'PETROFER' as part of its trade/business name, cannot be heard to contend that such adoption was honest or that the Defendant was not aware of the Plaintiffs' registered trade mark.

4 2019 SCC OnLine Del 10638

5 2(m) — 'mark' includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof;

6 2001 SCC OnLine Bom 1176

24. Dr. Tulzapurkar then pointed out that in Form INC-1 (Application for Reservation of Name) filed by the Defendant with the Registrar of Companies, the Defendant's Director at Sr. Nos. 11 and 12 of the said Form had categorically declared that the proposed corporate name of the Defendant, i.e., 'UNITED PETROFER', was not based on and was not similar to any existing registered trade mark. Dr. Tulzapurkar took pains to point out that implicit in such a declaration was the fact that the Defendant had undertaken a search in the Trade Mark Registry or was aware of such obligation and thus had made a patently false declaration, based on which the Defendant had filed for and obtained registration of its name. He thus submitted that in the present case, the Defendant's adoption of 'PETROFER' was merely negligent but patently dishonest.

25. Dr. Tulzapurkar then submitted that the Defendant has taken inconsistent and contradictory stands regarding the origin and meaning of the word 'PETROFER'. He submitted that during the meeting held on 28th November 2018 between the representatives of the Plaintiffs and the Defendant, the Defendant's representatives had stated that the word 'PETROFER' was suggested by the Defendant's consultant based in Düsseldorf, Germany. However, in the Affidavit in Reply, the Defendant had stated that 'PETROFER' was descriptive in nature, the prefix 'Petro' denoting petroleum and its by-products, and the suffix 'fer' being derived from 'ferrous', indicating its relation to iron and iron alloys, since the Defendant's products are used as metalworking fluids for ferrous and alloy materials. Dr. Tulzapurkar pointed out that in Form INC-1 filed by the

Defendant's Directors with the Registrar of Companies, it was expressly stated that the word 'PETROFER' had no dictionary meaning and was coined as a combination of the words 'Fertilizer' and 'Chemicals'.

26. Dr. Tulzapurkar submitted that since the Defendant's trade/business name 'UNITED PETROFER' was deceptively similar to the Plaintiffs' registered mark 'PETROFER', the mere addition of the word 'UNITED' did not in any manner serve to distinguish it or mitigate the likelihood of confusion or deception. In support of his contention, he placed reliance upon the decision of the Hon'ble Supreme Court in *Ruston & Hornsby Ltd. vs Zamindara Engineering Co.*⁷, from which he pointed out that the mere addition of a word before or after the mark/word that is similar or deceptively similar to a registered mark would still constitute infringement. He thus submitted that the Plaintiffs were entitled to succeed in its action for infringement of trade mark given that the Defendant had unauthorizedly used the Plaintiffs' registered trade mark as part of the Defendant's trade/business name and the Defendant was manufacturing, selling and dealing in goods in respect of which the Plaintiffs had obtained registration of the said trade mark.

27. Dr. Tulzapurkar then placed reliance upon the decision of the Hon'ble Supreme Court in the case of *Vishnudas Trading v. Vazir Sultan Tobacco Co. Ltd.*⁸ to submit that it was well settled that the registered proprietor of a trade mark was entitled to the exclusive use of such trade mark in respect of the entire

⁷ (1969) 2 SCC 727

⁸ (1997) 4 SCC 201

class of goods for which it is registered. He further submitted that, in any event, the Plaintiffs had placed ample material on record clearly demonstrating their use of the registered 'PETROFER' trade marks in relation to the very goods for which the Defendant was using the impugned name, trade mark, and domain name, as evidenced by Exhibits H-2 to H-18 of the Plaint. He pointed out that the First Plaintiff had applied for and secured registration of its 'PETROFER' trade marks as far back as 1997 in various classes and reiterated that the Second Plaintiff, as its licensee, had commenced use of the mark in 2005, by which time the First Plaintiff had already established a substantial transborder reputation in India. Crucially, he submitted that even the Rectification Applications filed by the Defendant had been dismissed.

28. Dr. Tulzapurkar submitted that it was clear that the Defendant had adopted the impugned mark 'UNITED PETROFER' in respect of similar goods and further adopted an identical or deceptively similar trade name and domain name with full knowledge and intent to come as close as possible to the Plaintiffs. He submitted that the use of the infringing mark as part of a domain name also constitutes infringement and passing off. In support of his contention, he placed reliance upon the decision of this Court in the case of *Rediff Communication Ltd. v. Cybertooth & Another*,⁹ which he pointed out held that internet domain names are of commercial significance and were entitled to the same protection as trade marks. He also placed reliance upon the decision of the Hon'ble Supreme Court in the case of *Satyam Infoway Ltd. v. Siffynet Solutions Pvt. Ltd.*¹⁰ and pointed out

⁹ 1999 SCC OnLine Bom 275

¹⁰ (2004) 6 SCC 145

that the Hon'ble Supreme Court had observed that a domain name had evolved from being merely an internet address to a vital business identifier, making exclusivity of identity critical. He therefore submitted that the Defendant had virtually lifted the Plaintiffs' corporate identity by using 'PETROFER' as part of its trade/business and 'unitedpetrofer.com' as its domain name.

29. Dr. Tulzapurkar then submitted that the conduct of the Defendant was also patently dishonest. He pointed out that the Defendant had, despite the Order dated 18th September 2019 passed by the Regional Director, not changed its name as directed. He further pointed out that the Directors of the Defendant had made a patently false declaration in Form INC-1 filed before the Registrar of Companies by stating that the proposed name 'PETROFER' was not based on any registered trade mark. He pointed out that even after the Defendant's Rectification Applications were dismissed, the Defendant continued to use the mark 'PETROFER' in respect of the goods which were in the same class covered by the Plaintiffs registration. He also reiterated that the Defendant had taken contradictory stands as to how the word 'PETROFER' came to be coined. Dr. Tulzapurkar thus submitted that the Defendant clearly intended to use the impugned mark for as long as possible and trade upon and exploit the immense reputation and goodwill built by the Plaintiffs.

30. Basis the above, Dr. Tulzapurkar submitted that the Plaintiffs had made out a strong case for the grant of the interim reliefs in terms of prayer clauses (a), (b) and (c) of the Interim Application.

SUBMISSIONS ON BEHALF OF THE DEFENDANT

31. Mr. Padwal, Learned Counsel appearing on behalf of the Defendant, opposed the Interim Application essentially contending that (i) only Section 29(5) of the Trade Marks Act would apply since what was alleged was infringement of the Plaintiffs registered trade mark by use in the Defendant's trade/business name, (ii) the Defendant's goods were distinct from the Plaintiffs' goods, and thus there was no infringement as contemplated under Section 29(5) of the Trade Marks Act; (iii) the Plaintiffs' had acquiesced to the Defendant's use of 'PETROFER' as part of the Defendant's trade name; (iv) the Defendant was not using 'UNITED PETROFER' as a trade mark, but only as a trade name; and (v) since the Defendant was using 'PETROFER' only as part of its trade/business name, the Defendant was not required to conduct a search in the Trade Mark Registry or undertake any due diligence.

32. Mr. Padwal then submitted that, since it was the Plaintiffs' case that the Defendant, by using the word 'PETROFER' as part of the Defendant's trade or business name, had infringed the Plaintiffs' registered trade mark, the present case would fall exclusively within the ambit of Section 29(5) of the Trade Marks Act. He then submitted that neither Section 29(4) nor any other sub-section of Section 29 would apply, as the Plaintiffs had not alleged infringement arising from the use of the Plaintiffs registered trade mark as a trademark, i.e., trademark vs. trademark, but only from its use as part of a trade name, i.e., trademark vs. trade name. In support of his contention that in such a scenario

only Section 29(5) would apply, Mr. Padwal placed reliance upon a Full Bench decision of this Court in *Cipla Limited v. Cipla Industries Pvt. Ltd. & Anr.*¹¹ He then submitted that the language of Section 29(5) was plain, clear, and unambiguous, and therefore must be interpreted literally, without importing conditions or elements from the other sub-sections of Section 29. In support of his contention that when the words of a statute are plain, clear and unambiguous, they must be interpreted literally, he placed reliance upon the decisions of the Hon'ble Supreme Court in the case of *Vijay Narayan Thatte & Ors. v. State of Maharashtra & Ors.*¹² and *United India Insurance Co. Ltd. v. Orient Treasures Pvt. Ltd.*¹³

33. Mr. Padwal then submitted that for infringement to be established under Section 29(5) of the Trade Marks Act, 1999, two essential conditions were required to be satisfied. First, the registered trade mark must be used as, or as part of, the trade or business name of the person alleged to be infringing it. Second, the alleged infringer must be engaged in trade or business relating to the same goods or services for which the trade mark in question is registered. He submitted that in the present case, both these conditions were not fulfilled, since the Defendant's goods were entirely distinct from those of the Plaintiffs. He pointed out that while the Plaintiffs were engaged in the manufacture and sale of finished lubricants, i.e., the final product sold in the market, the Defendant manufactures only additives and base oils, which are merely constituent

11 2017 SCC OnLine Bom 6791

12 (2009) 9 SCC 92

13 (2016) 3 SCC 49

components used in the production of lubricants. He took pains to point out that additives and base oils were by themselves not lubricants but merely components used in the formulation of lubricants. Mr. Padwal, in support of his contention that Section 29(5) required the impugned trade name to be used in relation to the very same goods or services for which the registered trade mark is registered, placed reliance upon the decision of Delhi High Court in *Chronicle Publications (P) Ltd. v. Chronicle Academy Pvt. Ltd.*¹⁴ He thus submitted that, since the goods of the Plaintiffs and the Defendant were different, no case of infringement under Section 29(5) of the Trade Marks Act was made out against the Defendant.

34. Mr. Padwal then placed reliance upon the judgement of the Hon'ble Supreme Court in *Vishnudas Trading* to submit that it was well settled that where a trade mark is registered broadly in respect of all goods within a particular class, but the proprietor has not actually used the mark in respect of all such goods, the registration is liable to be restricted or rectified and confined only to those goods for which the registered proprietor is actually using or genuinely intending to use the said trade mark. He submitted that no proprietor can claim a monopoly over an entire class of goods merely by obtaining registration and then failing to use the mark in respect of all goods within that class. He then pointed out from the e-status page of the Plaintiffs' trade mark 'PETROFER' that although the mark was registered as far back as 1997, it still reflected the status as 'proposed to be used'. He thus submitted that, as held in

14 2010 SCC OnLine Del 1497

Vishnudas Trading, continuous non-use of a mark for over twenty years in respect of other goods within the same class was sufficient ground for rectification or restriction of the registration to only those goods for which the mark was actually used. He submitted that in the present case, the Plaintiffs' admitted non-use clearly demonstrated that the rights of the Plaintiff, if any, were confined only to the products actually manufactured and sold by the Plaintiffs and would not extend to those products which were never manufactured and sold by the Plaintiffs, such as the Defendant's products, namely additives and base oils.

35. Mr. Padwal then placed reliance upon the decision of this Court in the case of *Advance Magazine Publishers & Anr. v. Just Lifestyle Pvt. Ltd.*¹⁵, to submit that the question of similarity must be determined by applying objective criteria, namely the business and practical test. He submitted that this required consideration of factors such as (i) the respective uses of the goods or services; (ii) their physical nature or the nature of the acts of service; (iii) the respective trade channels through which the goods or services reach the market; (iv) in the case of self-service consumer goods, their placement or display in retail stores; and (v) the degree to which the goods or services are competitive. He submitted that another aspect in order to ascertain similarity was how the trade and industry classified the goods in question, for example, whether they were treated as belonging to the same or different market categories. In support of his contention, he placed reliance upon the decision of this Court in the case of

15 2016 SCC OnLine Bom 8417

*Eagle Potteries Pvt. Ltd. v. Eagle Flask Industries*¹⁶.

36. Mr. Padwal then invited my attention to the Defendant's products as set out in Exhibit C to the Plaint and pointed out that each product was described along with its method of application. He submitted that every such product listed in Exhibit C functions merely as an additive to a base fluid and is therefore only a component used in the formulation of a final product and is not itself the finished final product. He further submitted that the Plaintiffs had selectively annexed details of only one of the Defendant's products, namely 'SERIX HYDRAULIC SX-1', to the Affidavit in Rejoinder (Exhibit 6) and had sought to contend that, based on the product catalogue annexed therewith, the Defendant manufactures goods similar to those manufactured by the Plaintiffs. He submitted that this contention was wholly misconceived, as the Defendant's products cannot be considered either in competition with or the same as the Plaintiffs' finished products, i.e., lubricants. Mr. Padwal clarified that the said product, 'SERIX HYDRAULIC SX-1', is in fact an additive intended to be blended with mineral oil-based hydraulic fluids and not a standalone lubricant as sought to be suggested by the Plaintiffs.

37. Mr. Padwal then also submitted that neither the Plaintiffs' goods nor the Defendant's goods were everyday consumer products sold over the counter but were specialized, industrial products meant for specific clients in defined sectors. He submitted that the Defendant's goods, in particular, were sold

16 1992 SCC OnLine Bom 490

exclusively to industrial customers and business entities, not individual consumers, and hence, given the highly specialized nature of the Defendant's business and clientele. He thus submitted that there was no possibility of confusion or deception as alleged by the Plaintiffs.

38. Mr. Padwal then placed reliance upon the decision of this Court in the case of *International Foodstuffs Co. LLC v. Parle Products Pvt. Ltd.*¹⁷, to submit that trade mark registration must be interpreted reasonably and pragmatically and not so broadly as to confer unjustified exclusivity over unrelated goods. He further submitted that the classification lists published by the Trade Marks Registry were merely administrative tools and not determinative of rights. In this regard, he also placed reliance upon *Allied Auto Accessories Ltd. v. Allied Motors Pvt. Ltd.*¹⁸, where this Court held that in the case of a dispute over the appropriate classification of goods, it is ultimately for the Court to determine the correct classification for the purposes of adjudication. He also relied upon the decision of the Delhi High Court in *Chime Financial Inc. v. Registrar of Trade Marks*¹⁹ to submit that the scope of a registered trade mark must always be determined in relation to the goods actually used and not to the entire breadth of the class under which it is registered.

39. Mr. Padwal submitted that the Plaintiffs cannot be permitted to claim a monopoly over the mark 'PETROFER' in relation to the Defendant's goods merely

17 2016 SCC OnLine Bom 2038

18 2002 SCC OnLine Bom 1138

19 2025 SCC OnLine Del 2320

because both parties' products fell within the same broad classification of the relevant class. He reiterated that the two businesses operated in entirely different spheres of the supply chain, which was clear from the fact that the Second Plaintiff had, in fact, procured raw materials from the Defendant. He further submitted that the Defendant's goods were marketed and sold under their own distinctive and registered trademarks, each prominently displayed on the products, and not under the mark 'PETROFER', and hence there could be no likelihood of confusion or deception in the minds of consumers. Mr. Padwal reiterated that the Defendant does not use 'UNITED PETROFER LTD.' as a trademark on its goods, and the reference to that name on packaging serves solely to identify the manufacturer. Such reference, he submitted, cannot by any stretch of imagination be construed as use of the Defendant's trading name in a trade mark sense.

40. Mr. Padwal then without prejudice to the above, stated that the Defendant's Rectification Applications and the Special Civil Application were dismissed merely for want of prosecution due to procedural lapses and not on merits. He pointed out that the matter before the Gujarat High Court has since been restored, and therefore, the Defendant cannot be blamed for any such procedural delay or default.

41. Mr. Padwal also submitted that the Plaintiffs were disentitled to any interim relief on the ground of acquiescence and delay. He submitted that the Plaintiffs had long been aware of, and accepted, the Defendant's use of the name 'UNITED

PETROFER LTD'. He pointed out that the Defendant was incorporated as 'UNITED PETROFER LTD.' as far back as 29th July 2016, and that the Second Plaintiff had admittedly purchased raw material from the Defendant since April 2017. In support of his contention, he placed reliance upon (i) copies of the Defendant's Business Scope Reports, (ii) the ledger account maintained in the name of the Second Plaintiff, and (iii) various invoices raised by the Defendant on the Second Plaintiff. He submitted that these invoices clearly bore out that the Defendant's trading name was 'UNITED PETROFER LTD.' and displayed the Defendant's registered trademark 'SERIX'. The invoices described the goods sold as bearing the Defendant's trade mark 'ADDIV SPG' and not the trading name 'UNITED PETROFER LTD.'. Mr. Padwal also placed reliance upon the communications exchanged between the Second Plaintiff and the Defendant, which clearly reflected not only the Defendant's trade name but also the Defendant's domain name, i.e., unitedpetrofer.com. He pointed out that the emails exchanged between the Second Plaintiff and the Defendant were sent from and addressed to email accounts using the Defendant's domain name, 'unitedpetrofer.com', which made clear that the Plaintiffs were fully aware of the Defendant's name and operations.

42. Mr. Padwal submitted that, in an attempt to overcome the plea of delay and acquiescence, the Plaintiffs had contended that the purchases made by the Second Plaintiff from the Defendant between April 2017 and June 2018 were insignificant and effected by the Second Plaintiff's procurement department without the involvement or knowledge of its senior management. He submitted

that this explanation was both an afterthought and legally untenable, as it completely disregarded the well-settled principles of the law of agency and the maxim "*Qui facit per alium facit per se*", meaning "*he who acts through another does the act himself*." He submitted that the Second Plaintiff could not disown or disclaim the knowledge and conduct of its own employees, and that any dealings made through its procurement department must, in law, be treated as acts of the Second Plaintiff itself. Accordingly, Mr. Padwal submitted that once it was admitted that the Second Plaintiff had, in 2017, dealt directly with the Defendant, the Plaintiffs could not now contend that they were unaware that the Defendant was using the name 'UNITED PETROFER'. In support of his contention that a company is bound by the acts of its employees who were acting within the scope of their authority, he placed reliance upon the decision of the Allahabad High Court in *Deo Narain Rai & Anr. v. Kukur Bind & Ors.*²⁰

43. Mr. Padwal then submitted that the Plaintiffs' assertion that a meeting had taken place between the parties on 28th November 2018 was entirely false and was only to mislead the Court. He pointed out that apart from a single email addressed to one Mr. Stuart Gregory merely stating that such a meeting had occurred, the Plaintiffs had not produced any material whatsoever to substantiate that any such meeting took place. He therefore submitted that an adverse inference ought to be drawn against the Plaintiffs, particularly since prior interactions between the representatives of the Second Plaintiff and the Defendant were always recorded and circulated by email, and no such

20 1902 SCC OnLine All 5

correspondence exists in relation to the alleged meeting of 28th November 2018.

44. On the contrary, Mr. Padwal pointed out that it was an admitted fact that in January 2018, the Second Plaintiff, through its senior manager Mr. Sujit Rao, had requested a meeting with the directors of the Defendant to discuss and finalize pricing for base oil products supplied by the Defendant, pursuant to which, on 18th January 2018, the Defendant's directors travelled to Mumbai and met with the key managerial personnel of the Second Plaintiff, including Mr. Rao. He submitted that at the said meeting, a casual reference was made by one of the representatives of the Second to communications received from the First Plaintiff concerning the Defendant's use of the word 'PETROFER'. Mr. Padwal, however, submitted that at the said meeting the representatives of the Second Plaintiff, including Mr. Rao, had expressly stated that they had no objection to, and saw no impropriety in, the Defendant's use of the mark 'PETROFER' as part of its trading name. He also noted that communications between the parties' managerial personnel continued well into January 2019, thereby confirming both the ongoing business relationship and the Plaintiffs' full knowledge of the Defendant's corporate name and business activities.

45. Mr. Padwal submitted that it was only much later, around April or May 2019, i.e., nearly fifteen months after the January 2018 meeting, that the Plaintiffs approached the Regional Director, Ahmedabad, Ministry of Corporate Affairs, by way of an application objecting to the Defendant's trade name. He

pointed out that the Defendant duly entered an appearance and filed its Reply to oppose the said Application, despite which the order dated 18th September 2019 directing the Defendant to change its name within six months came to be passed. He submitted that no adverse inference could be drawn against the Defendant for continuing to use its corporate name since the Defendant had challenged the Order dated 18th September 2019 before the Gujarat High Court by filing a Special Civil Application which was presently pending. He further pointed out that in June 2020, the Defendant filed Rectification Applications before the Trade Marks Registry, thereby putting the Plaintiffs to notice that the Defendant not only intended to contest their claims but also to challenge the validity of the registrations allegedly obtained by the First Plaintiff through misrepresentation.

46. Mr. Padwal thus submitted that the Plaintiffs had full knowledge of the Defendant's use of the trading name 'UNITED PETROFER LTD.' at every stage (i) since 2017, when the Second Plaintiff first conducted business with the Defendant (ii) during the January 2018 meeting, when the Second Plaintiff expressly indicated no objection to the Defendant's trading name; (iii) in August 2019, when the Defendant filed its reply before the Regional Director; (iv) in June 2020, when the Defendant filed Rectification Applications; and (v) in July 2020, when the Defendant challenged the order of 18th September 2019 before the Gujarat High Court. In light of this conduct, he submitted that the Plaintiffs had knowingly slept over their alleged rights and that this was not a case of mere passive acquiescence but one of active acquiescence, where the Plaintiffs

deliberately refrained from acting against the Defendant's use of the word 'PETROFER', thereby allowing the Defendant to expand its business and goodwill, only to later attempt to disrupt it. He therefore contended that the Plaintiffs, at such a belated stage, were not entitled to any interim relief. In support of this submission, he relied upon the decisions of the Delhi High Court in *Vardhman Properties Ltd. v. Vardhman Developers & Infrastructures*²¹ and of this Court in *Torrent Pharmaceuticals Ltd. v. Wockhardt Ltd. & Ors.*²², to point out that in both decisions it was held that where a plaintiff has acquiesced in a Defendant's use of a trade mark over an extended period, interim relief must be refused.

47. Finally, Mr. Padwal submitted that the balance of convenience was also entirely in favour of the Defendant and that the grant of an injunction at this stage would cause irreparable loss, harm and injury to the Defendant. In support of his contention, he submitted that since its incorporation in 2016, the Defendant's business had grown exponentially both in the national and international markets and that the Defendant had earned substantial goodwill and reputation among trade circles and industrial consumers. He pointed out that the Defendant's current turnover is approximately Rs. 215 crores, catering to over 400 domestic clients, and that the Defendant had been openly and continuously using its trading name 'UNITED PETROFER LTD.' since inception. He then submitted that granting the reliefs sought by the Plaintiffs, particularly directing the Defendant to change its trading name, would cause irreparable

21 2010 SCC OnLine Del 134

22 2017 SCC OnLine Bom 9666

and immeasurable harm to the Defendant's business, disrupting established operations and relationships built over the years. The Defendant, he pointed out, was registered and associated with leading public sector undertakings such as Hindustan Petroleum Corporation Ltd, Indian Oil Corporation Ltd, and Bharat Petroleum Corporation Ltd, as well as international entities like Lubrizol and Infineum, and held multiple industry-specific licenses that require two to five years to obtain. He submitted that any compelled change of name would require re-registration with these bodies, effectively bringing the Defendant's operations to a standstill.

SUBMISSIONS ON BEHALF OF THE PLAINTIFFS IN REJOINDER

48. Dr. Tulzapurkar submitted that the Defendant's contention that the goods manufactured and sold by the Defendant were distinct from those of the Plaintiffs' was belied by the fact that the Plaintiffs' registrations at Exhibits E1 to E8 clearly established that the registrations were in respect of "*Chemicals used in industry and science, corrosive preparations for use with metals, detergents for use in manufacturing processes, rust converting preparations, preservatives against rust, cleaning, polishing, scouring and abrasive preparations, rust removers, technical oils and greases, lubricants*". He then pointed out from the Defendant's Memorandum of Association that the same specifically states that the object of the Defendant was to deal in *all types of petrochemicals, lubricants, organic chemicals, inorganic chemicals, synthetic chemicals, resins, granules, colour chemicals, laboratory chemicals, industrial chemicals etc.* He thus

submitted that it was untenable for the Defendant to contend that the goods of the Defendant were not the same as those of the Plaintiffs.

49. Dr. Tulzapurkar additionally submitted that for the Defendant to contend that the Defendant was not manufacturing lubricants was also patently dishonest, since the Defendant had, in the Rectification Applications filed against the Plaintiffs' registered trade marks, in paragraph 4 categorically, averred that "*The Applicant, UNITED PETROFER LIMITED, today is a company with global presence, and is an independent lubricant manufacturer in India.*". He pointed out that the Defendant had also, in paragraph 3 of the Special Civil Application filed before the Gujarat High Court, stated that "*The purpose of establishing the company, UNITED PETROFER LIMITED, was to provide lubricants, as a strategic commodity.*" and in paragraph 4 of the same Application stated that "*Today, UNITED PETROFER LIMITED is a company with global presence, and is an independent lubricant manufacturer in India.*" He thus submitted that, on the Defendant's own showing, the Defendant was a manufacturer of lubricants. Dr Tulzapurkar thus submitted that the present Suit fell within the provisions of Section 29(5) of the Trade Marks Act, 1999. He thus pointed out that the Defendant's reliance upon the decision in the case of *Cipla Limited v. Cipla Industries Pvt. Ltd.* was misplaced since the Defendants had infringed the Plaintiffs' registered trade mark by using the same as part of the Defendant's trade/business name, and the Defendant was dealing in the very goods in respect of which the Plaintiffs trade marks were registered.

50. Dr. Tulzapurkar then submitted that the Defendant's reliance upon the decision in the case of *Vishnudas Trading* was also entirely misplaced. He pointed out that, firstly, the said judgement was delivered in the limited context of examining the propriety and validity of a Rectification Application and did not in any manner concern or address issues relating to infringement or passing off, as expressly noted in paragraph 50 of the judgement itself and subsequently clarified by the Hon'ble Supreme Court in *Tube Investments of India Ltd. v/s Trade Industries, Rajasthan*²³. Secondly, he submitted that the Rectification Applications filed by the Defendant had already been dismissed, and the Defendant was therefore precluded from contending that the Plaintiffs' registrations were overly broad or that they did not cover all goods in the respective classes, or from raising any plea of non-use of the registered trade marks etc. He submitted that the Plaintiffs' trade marks were all valid and subsisting, and that the Plaintiffs, being the registered proprietors, were vested with the exclusive right to use the said marks and to protect themselves against infringement as held in the case of *Vishnudas Trading*. Dr. Tulzapurkar therefore submitted that, there being no subsisting challenge to the Plaintiffs' registrations, the only question that arises for consideration is whether the Defendant's goods fall within the same class of goods covered by the Plaintiffs' registered trade marks. If they do, he submitted, there was no question of denying the Plaintiffs an injunction restraining the Defendant from committing infringement under Section 29(5) of the Trade Marks Act, 1999.

23 (1997) 6 SCC 116

51. Dr. Tulzapurkar further submitted that in an infringement action, the question of restricting the injunction only to actual goods used by the Defendant does not arise, as the injunction is to be granted when the Defendant uses the impugned name and mark in respect of the goods covered by the Plaintiffs' registrations. He reiterated that the Plaintiffs' registrations in this case were in respect of industrial chemicals and lubricants and other material falling in the relevant classes and that the Defendant was using the impugned name in respect of goods covered under these classes. He thus submitted that the Plaintiffs were entitled to an injunction restraining the Defendant from using the name 'UNITED PETROFER' in respect of any goods in the said classes in which the Plaintiffs had valid and subsisting registrations.

52. Dr. Tulzapurkar, in response to the Defendant's contention that the Defendant was using 'UNITED PETROFER' only as a trade/business name and not as a trade mark pointed out that the Defendant's use of 'UNITED PETROFER' as a trade mark was clearly established (i) from the Defendant's product catalogue, annexed as Exhibit-6 to the Plaintiffs' Affidavit in Rejoinder (ii) the printout of the Defendant's webpage on 'Indiamart', which displayed the Defendant's range of products under the name 'UNITED PETROFER', which products included automotive lubricants, industrial lubricants, and other lubricant products, (iii) the Defendant's advertisements and promotional materials annexed to the Affidavit in Reply and (iv) crucially by the Defendant using 'unitedpetrofer.com' its domain name. He submitted that all of this made clear that the Defendant was also using 'UNITED PETROFER' as a trade mark.

53. Dr Tulzapurkar also pointed out that the Defendant had not advanced any submissions as to why reliefs for passing off cannot or should not be granted. He submitted that this Court was not required to find out the differences in the use of the goods of the Defendant and the use of the goods by the Plaintiffs but was only concerned with the general category of industrial chemicals and lubricants. He submitted that a customer who is aware of the Plaintiffs' name and mark, 'PETROFER', is bound to be confused when he comes across the goods manufactured and sold by the Defendant under the name and mark 'UNITED PETROFER'.

54. Dr. Tulzapurkar then submitted that the Defendant's contention of delay and acquiescence on the part of the Plaintiffs was also entirely untenable. He reiterated that the Plaintiffs had, in the Plaint itself, explained that the quantum of purchases made by the Second Plaintiff in the year 2018 was negligible and that the senior management/key managerial personnel of the Second Plaintiff were unaware of the same. He thus submitted that the question of any acquiescence on the part of the Plaintiffs did not arise. He pointed out that Mr. Rao, who was the purchase head in the employment of the Second Plaintiff, was not in the category of 'managerial personnel'. He submitted that when it came to the notice of the Plaintiffs' managerial personnel that the Defendant was using the impugned name and mark, the Plaintiffs immediately asked the Defendant to stop its use. He reiterated that the judgement of the Delhi High Court in ***Make My Trip (India) Pvt. Ltd.*** would thus squarely apply and that the decision of the Allahabad High Court in the case of ***Deo Narain Rai*** would have no application

since the facts were materially different and the said judgement was not rendered in the context of a case of statutory breach of intellectual property rights of the plaintiff.

55. Dr. Tulzapurkar also pointed out that when it came to the knowledge of the Plaintiffs that the Defendant was using the name ‘UNITED PETROFER’, the Plaintiffs immediately called upon the Defendant to stop using ‘PETROFER’ as part of the Defendant’s name. He also pointed out that the Plaintiffs had proactively taken steps to ensure the Defendant change its name and had, in fact, succeeded in obtaining an order directing the Defendant to do so. He then submitted that even otherwise, a plea of acquiescence was available only to a person who commits a mistake as laid down in the case of *Wilmott vs Barber*²⁴. He pointed out that in the present case it was not even the case of the Defendant that the Defendant had committed any mistake. On the contrary, he pointed out that the Defendant’s adoption of ‘PETROFER’ was plainly dishonest since the Defendant had knowledge or was deemed to have had knowledge of the impugned trade mark as noted by the Division Bench of this Hon’ble Court in the case of *Bal Pharma Ltd.*

56. Dr. Tulzapurkar then also pointed out that the Defendant’s denial of the meeting held on 28th November 2018 in the Affidavit in Reply was a false and dishonest stand taken by the Defendant. In support of his contention, he pointed out that the Defendant had, in the Special Civil Application filed in the Gujarat

24 (1880) 15 Chancery Division 96

High Court, infact admitted to the meeting but denied that the issue of change of name was discussed. He thus submitted that the Defendant was clearly taking false and contradictory stands before different fora.

57. Dr. Tulzapurkar, in response to the Defendant's contention that it was not required to conduct a search in the Trade Mark Registry or undertake any due diligence since it was using 'PETROFER' only as part of its trade/business name and not as a trade mark, submitted that such an assertion was factually incorrect and legally untenable. He reiterated that firstly the definition of 'mark' in Section 2(1)(m) of the Trade Marks Act included 'name' and secondly, he pointed out that the documents produced by the Plaintiffs along with the Affidavit in Rejoinder clearly showed that the Defendant was using 'UNITED PETROFER' not only as its trade or business name but also as a trade mark. He also pointed out that the declaration made by the Director of the Defendant in Form INC - 1 made clear that the Defendant was aware of the requirement of conducting a search before adopting 'PETROFER' as part of its name. He thus submitted that it was plainly untenable for the Defendant to now contend that it was not required to undertake any search before adopting/using 'PETROFER'.

58. Dr. Tulzapurkar thus reiterated that the Defendant had no sustainable defense whatsoever. The Plaintiffs, having established a clear case of infringement and passing off, were entitled to the interim reliefs as prayed for.

REASONS AND CONCLUSIONS

59. Having heard the Learned Counsel for the parties, and upon a careful consideration of the material placed on record as well as the case law relied upon, I am of the view that the Plaintiffs have made out a strong and *prima facie* case for the grant of interim relief, for the following reasons:

- A. **First**, the Defendant's primary contention that the goods of the Defendant are different and distinct from the goods of the Plaintiffs in my *prima facie* view fails on the Defendant's own showing. It is not in dispute that the Plaintiffs hold valid registrations in respect of the said mark 'PETROFER' in the relevant Classes, which, *inter alia*, include lubricants. The Defendant has repeatedly described itself, as being engaged in *inter alia* the manufacture and supply of lubricants, as is clear from (i) paragraph 4 of the Rectification Applications filed against the Plaintiffs' registered trade marks wherein the Defendant has stated that "*The Applicant, UNITED PETROFER LIMITED, today is a company with global presence, and is an independent lubricant manufacturer in India*"; (ii) paragraph 3 of the Special Civil Application filed before the Gujarat High Court in which the Defendant has stated that "*the purpose of establishing the company, UNITED PETROFER LIMITED, was to provide lubricants, as a strategic commodity*"; and (iii) paragraph 4 of the same application, the Defendant has further stated that "*today, UNITED PETROFER LIMITED*

is a company with global presence, and is an independent lubricant manufacturer in India. In these circumstances, the Defendant's contention that it does not manufacture lubricants, or that the goods of the Defendant are different from those of the Plaintiffs, is not only untenable but plainly dishonest. The attempt to draw a distinction between 'base oils and additives' on the one hand and 'lubricants' on the other is, in light of the Defendant's own admissions, a distinction without a difference.

- B. **Second**, the Defendant's contention of acquiescence is equally untenable. The Plaintiffs have, in the Plaint itself, set out that the purchases made by the Second Plaintiff from the Defendant in 2017 were insignificant, constituting merely 0.06% of the Second Plaintiff's total purchases for that year. These purchases were made in the ordinary course of business by the purchase department of the Second Plaintiff, without the knowledge or involvement of the senior management or key managerial personnel of the Second Plaintiff. The Defendant's reliance on the decision of the Allahabad High Court in *Deo Narain Rai* to contend that the Second Plaintiff is bound by the acts of its employees, being its agents, is wholly misplaced. Apart from the fact that the facts in that case were materially different, the decision in *Deo Narain Rai* was not rendered in the context of a suit for infringement of intellectual property rights, i.e., a breach of a Plaintiffs' statutory rights. On the contrary, the decision of this Court

in the case of *MakeMyTrip (India) Pvt. Ltd.*, which is in the context of violation of intellectual property rights and considers very similar facts, would squarely apply. Also, in this case the record clearly militates against any acquiescence on the part of the Plaintiffs. The Plaintiffs have not only taken steps to ensure that the Defendant changes its name by approaching the Regional Director MCA, North-Western Region, Ahmedabad, u/s 16(1)(b) of the Companies Act, but have, infact, succeeded in obtaining an order directing the Defendant to do so.

- C. *Additionally*, and in any event, as a matter of law, a plea of acquiescence can be sustained only where the party invoking such plea has acted under a bona fide mistake and has been misled by the conduct of the other party. As held by the Court of Appeals in the case of *Wilmott v. Barber*, the doctrine of acquiescence is founded upon fraud in equity and arises only where the person asserting the right has knowingly stood by and encouraged the other party, who was acting under a mistaken belief, on the basis of which such party has altered its position to its detriment. In the present case, it is not even the Defendant's contention that the Defendant had acted under any mistaken belief. On the contrary, it is clear that the Defendant has in its Form INC – 1 made a false declaration to state that the name 'PETROFER' is not based on any registered trade mark. Hence, *prima facie*, the Defendant's adoption of 'PETROFER' being dishonest, a plea

of equity will not assist the Defendant. Also, assuming there was a delay on the part of the Plaintiffs, that by itself would not legitimise an act of infringement by the Defendant more so when the adoption is *prima facie* dishonest. I thus find that the Defendant's reliance upon the decisions in the case of **Vardhman Properties Ltd.** and **Torrent Pharmaceuticals Ltd.** to be entirely inapplicable to the facts of the present case. Hence, the contention that there has been acquiescence on the part of the Plaintiffs is wholly misconceived and stands rejected.

- D. **Third**, the Defendant's assertion that it is not using 'UNITED PETROFER' as a trade mark is *prima facie* belied by the record. The Plaintiffs have produced material including printouts of the Defendant's website, the Defendant's product catalogue, and extracts from Indiamart and use of 'unitedpetrofer.com' as a domain name, all of which show that the Defendant is prominently using 'UNITED PETROFER' on its goods in a manner which is *prima facie* clearly suggestive of use as a source identifier and thus as trade mark and not merely as a trade/business name. Further, the Plaintiffs have also set out that a web search for 'PETROFER' produces results linking both to the First Plaintiff's companies and to the Defendant's domain name, thereby creating an impression of association. I find that based on the material that has been placed before me, the Plaintiffs' reliance upon the decisions in the case of **Satyam Infoway Ltd.** and **Rediff**

Communication Ltd. is entirely apposite since the Defendant is admittedly using ‘unitedpetrofer.com’ as the Defendant's domain name, which constitutes infringement of the Plaintiffs’ mark. Thus, in my *prima facie* view, based on the material relied upon by the Plaintiff, the Defendant’s assertion that it is not using ‘PETROFER’ as a trade mark cannot be accepted.

- E. **Fourth**, the Defendant’s contention that the Defendant was not required to undertake a search in the Trade Marks Registry before adopting/using ‘PETROFER’ as part of its trade/business name is also misconceived and untenable. Section 2(1)(m) of the Trade Marks Act defines ‘mark’, which expressly includes ‘name’. Thus, it was incumbent upon the Defendant to have undertaken a search, including in the Trade Mark Registry, before adopting/using ‘PETROFER’. The Defendant's failure to undertake such a search and enquiry would result in negligent use and adoption of such mark, as held in *Bal Pharma*. Also, the very fact that the Directors of the Defendant have, in Form INC-1, declared that no registered trade mark formed part of or resembled the Defendant's proposed name, makes implicit the fact that the Defendant was well aware of such an obligation, despite which the Directors of the Defendant had made a patently false declaration.

- F. **Fifth**, the Defendant's reliance on the Full Bench decision in *Cipla Limited v. Cipla Industries Pvt. Ltd.* is wholly misplaced and inapplicable to the facts of the present case. In the present matter, the Defendant is using the Plaintiffs' registered trade mark as part of its trade or business name while simultaneously dealing in goods identical to those for which the Plaintiffs' marks are registered. The infringement therefore arises from the use of the registered trade mark both as part of a trade or business name and in the course of trade in respect of the same goods. The Plaintiffs' case thus squarely attracts Section 29(5) of the Trade Marks Act, 1999, and, in addition, also falls within the ambit of Sections 29(1) and 29(2), since the Defendant's use of an identical mark in relation to identical or similar goods is likely to cause confusion and association in the course of trade. The Full Bench decision in *Cipla Limited* was concerned with a materially different factual context.
- G. **Sixth**, the Defendant's reliance on the decision of the Hon'ble Supreme Court in the case of *Vishnudas Trading* is also entirely inapposite to the facts of the present case. The said judgement, as clearly noted in paragraph 50 thereof, was rendered only in the context of rectification proceedings and not in the context of a case of infringement and passing off. This was also subsequently clarified by the Hon'ble Supreme Court in the case of *Tube Investments*. In the present case it is not in dispute that the Plaintiffs have valid

registrations of the mark ‘PETROFER’ and that the Defendant’s Rectification Applications have been dismissed. In these facts there is no fetter on the Plaintiffs’ use of the impugned marks in respect of the entire class of goods in respect of which registrations have been granted, as infact held in the case of *Vishnudas Trading* itself.

- H. **Seventh**, the decisions in *International Foodstuffs Co. LLC, Allied Auto Accessories Ltd., Chime Financial Inc., Advance Magazine Publishers, and Eagle Potteries Pvt. Ltd.* upon which reliance has been placed by the Defendant, are, in my *prima facie* view, of no assistance to the Defendant at this interlocutory stage. First, as noted in paragraph (A) above, the Defendant has publicly represented and advertised that it manufactures and markets “lubricants and other chemicals”. These goods fall squarely within the very class under which the Plaintiffs’ trade mark stands registered. Secondly, the Rectification Applications filed by the Defendant have already been dismissed, and therefore the Defendant cannot now be heard to challenge either the classification or the validity of the Plaintiffs’ registration. Even applying the tests laid down in *Advance Magazine Publishers* namely, the nature and purpose of the goods, their physical characteristics, and the trade channels through which they are marketed, it is *prima facie* evident that the goods of both parties are similar and/or of the same description. On this footing, the decision of this Court in *Eagle Potteries Pvt. Ltd.* is clearly distinguishable and does not assist the

Defendant. Equally, while *Allied Auto Accessories Ltd.* recognizes that the issue of classification may, in certain cases, be a relevant factor, in my view, the same would not apply in the facts of the present case, since the Defendant has itself abandoned such a challenge. To enter upon this issue at this stage would effectively amount to conducting a mini-trial on classification, which is unwarranted at the interlocutory stage.

- I. **Eighth**, for infringement under Section 29(5), the Plaintiff is required to establish that the Defendant is using the Plaintiffs' registered trade mark (or a deceptively similar mark) as part of its trade or business name and that the Defendant is dealing in the goods or services in respect of which the mark is registered. In my *prima facie* view, the Plaintiffs have more than established both these criteria. The Defendant's corporate/trade name includes 'PETROFER', which is identical to the Plaintiffs' registered mark. The Plaintiffs' registrations (Exhibits E-1 to E-8) cover, *inter alia*, technical oils and greases, lubricants, industry and science chemicals, rust preservatives, cleaning and polishing preparations, and related products. The Defendant's Memorandum of Association expressly states objects including dealing in petrochemicals, lubricants, organic and inorganic chemicals and industrial chemicals. Also, the Defendant has, as already noted in (A) above, described itself as an independent lubricant manufacturer. On these facts, there can be no doubt that the

Plaintiffs have made out a strong prima facie case of infringement under Section 29(5).

- J. **Ninth**, on the question of balance of convenience, there is no dispute that the Plaintiffs are the registered proprietors of the said trade marks and as registered proprietors, the Plaintiffs have a statutory right to the exclusive use of the registered trade mark as also to establish any infringement thereof. As held in the case of *Bal Pharma Ltd*, the balance of convenience ordinarily favours the registered proprietor asserting its statutory rights. Further, the Defendant's conduct is *prima facie* dishonest, as already noted in (A) and (D) above, and hence the question of the Defendant taking the plea of balance of convenience does not arise.

60. Hence, for the aforesaid reasons, I pass the following Order:

ORDER

- i. The Interim Application is allowed in terms of prayer clauses (a), (b) and (c) as extracted above.

(ARIF S. DOCTOR, J.)

After pronouncement

Mr. Padwal sought a stay of this Order. However, for the reasons recorded above, I find that no ground for grant of stay is made out. The Defendant has,

despite the Order dated 18th September 2019 passed by the Regional Director, Ahmedabad, Ministry of Corporate Affairs which required the Defendant to change its name within six months, despite there being no stay to that order. This conduct of the Defendant, as noted above, speaks volumes. Such disregard for orders passed by a Competent Authority cannot be countenanced. Hence, the request for stay is rejected.

(ARIF S. DOCTOR, J.)