



2023:DHC:9330



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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**
+ **CS(COMM) 568/2021 & I.A. 14686/2021, I.A. 16119/2021**

KHANDELWAL EDIBLE OILS LIMITED Plaintiff
Through: Mr. Gagan Gupta and Mr.
M.K.Arora, Advs.

versus

LANDSMILL AGRO PRIVATE LIMITED Defendant
Through: Mr. Sudhir Makkar, Sr. Adv.
with Ms. Roopa Dayal, Mr. Birender Bhatt,
Mr. Karan Khaitan and Ms. Yogita Rathore,
Advs

CORAM:
HON'BLE MR. JUSTICE C. HARI SHANKAR

J U D G M E N T

% **22.12.2023**

I.A. 14686/2021 (under Order XXXIX Rules 1 and 2 of the CPC)
& I.A. 16119/2021 (under Order XXXIX Rule 4 of the CPC)

1. The plaintiff is the proprietor of the trademark CHAKRA, registered as a word mark in Class 29¹ in respect of “edible oils for sale in the States of Uttar Pradesh, Uttaranchal and Uttarakhand²” w.e.f. 28 June 2013. It is also the proprietor of the following three copyright registrations for artistic works, in each case titled CHAKRA:

¹ of the NICE classification applicable for registration of trade marks

² Why the certificate mentions both Uttaranchal and Uttarakhand remains a mystery



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| S.No. | Regn No. | Dt of Registration | Work |
|-------|---------------|--------------------|---|
| 1 | A-69555/2005 | 28 November 2003 |  |
| 2 | A-140279/2021 | 19 August 2021 |  |
| 3 | A-140277/2021 | 19 August 2021 |  |

2. The plaintiff claims that its predecessor-in-interest, B.L. Agro Oils Ltd, had adopted the trademark CHAKRA on 1 April 1997. The unique label, and the manner in which the mark was depicted thereon, were also adopted on the same day. Since then, it is asserted that B.L. Agro Oils and, thereafter, the plaintiff, have been continuously using the mark CHAKRA and the labels, in respect of which the plaintiff has registered copyright, for packing and selling edible oils of different kinds, such as mustard oil, Kohlu mustard oil, agmark mustard oil, soya refined oil, refined oil, vegetable refined oil, and the like. In



each case, the sale was under the mark CHAKRA. The mark CHAKRA was assigned to the plaintiff by B.L. Agro Oil Co. on 2 December 2008.

3. To vouchsafe its reach and reputation in the market, the plaintiff provides the figures or sales returns of the plaintiff by use of the mark CHAKRA, and the labels in respect of which it has copyright registration. During the years 2019-20 and 2020-21, the sales of the plaintiff, of the said products, exceed ₹ 1266 crores and ₹ 1609 crores respectively. The plaintiff also claims to have expended considerable amounts towards advertising and promotion of its marks, with the amount spent in 2020-2021 alone being in excess of ₹ 24 lakhs.

4. Mr. Gagan Gupta, learned Counsel for the plaintiff, submits that, as the proprietor of the registered trademark CHAKRA, the plaintiff has, by virtue of Section 28(1)³ of the Trade Marks Act, 1999, the right to exclusivity in respect of the said trademark, and to protect it against infringement. By virtue of Section 27(2)⁴ of the Trade Marks Act, the continuous use of the trademark CHAKRA and of the labels in respect of which the plaintiff has copyright registration also confers, on the plaintiff, the right to protect itself against any attempt, by others, to pass off their products as those of the plaintiff. Mr.

³ 28. **Rights conferred by registration.** –

(1) Subject to the other provisions of this Act, the registration of a trade mark shall, if valid, give to the registered proprietor of the trade mark the exclusive right to the use of the trade mark in relation to the goods or services in respect of which the trade mark is registered and to obtain relief in respect of infringement of the trade mark in the manner provided by this Act.

⁴ (2) Nothing in this Act shall be deemed to affect rights of action against any person for passing off goods or services as the goods of another person or as services provided by another person, or the remedies in respect thereof.



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Gupta submits that, by dint of continuous use, the mark CHAKRA, especially when represented in the unique manner in which it figures on the plaintiff's label, is indelibly associated with the plaintiff's edible oils, of which it has emerged as a source identifier.

5. On 27 May 2021, the defendant applied for registration of the word mark CHAKRA KOLHU in Class 29 for "mustard oil, refined rice bran oil, refined soybean oil; processed oils for food". The plaintiff filed a Notice of Opposition dated 12 July 2021. The defendant's application is currently "opposed".

6. Despite the above opposition, the defendant was found to be selling vegetable oil and other edible oils under the mark "CHAKRA KOLHU", advertised both in English and Hindi but figuring, on the label of the bottle containing the oil, in Hindi (Devanagari). A comparison of the plaintiff's and defendant's bottles is thus provided in the documents filed with the plaint:

| Plaintiff's CHAKRA | Defendant's CHAKRA KOHLU |
|---|---|
|  |  |



7. Mr. Gupta contends that, by using the marks CHAKRA and CHAKRA KOLHU, albeit in Devanagari, and a label which is deceptively similar to the label used by the plaintiff and by adopting a style of writing and font, for the Devanagari “CHAKRA” which is identical to the style of writing and font used by the plaintiff, the defendant has not only infringed the plaintiff’s trademark and copyright, but has also sought to pass off its product as the product of the plaintiff, especially as both are dealing in edible oils.

8. The defendant is the proprietor of the registered device



mark (“CHAKRESH”), w.e.f. 19 March 2017, in Class 29 for “edible oils, blended oils, palm oil, sunflower oil, cotton seed oils, soya refined oil, rice blend oil, vegetable oils, mustard oil, ghee, meat, fish, poultry and game, meat extract, preserved and dried and cooked fruits, vegetables, jellies, jams, fruits, milk and milk products, dairy products, fats and ghee”, claiming user from 1 April



2012. The mark is also used for edible oils, as is apparent from the representation of the bottle in an advertisement contained on the website of the defendant:



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9. According to Mr. Gupta all the defendant's marks, CHAKRA KOLHU, CHAKRIKA, and CHAKRESH, infringe the trademark CHAKRA, registered in the plaintiff's favour prior in point of time. The fact that the defendant has adopted a printing style and font which is identical to that used by the plaintiff, and has also adopted labels which are nearly identical to the plaintiff's labels, it is submitted, that the defendant was deliberately seeking to pass off its products as those of the plaintiff by creating confusion in the market.

10. Accordingly, by the present suit, the plaintiff has sought a decree of permanent injunction, restraining the defendant from using the marks CHAKRA KOLHU, CHAKRIKA, and CHAKRESH, for any kind of products, apart from rendition of accounts, damages and costs.

11. Summons in the present suit were issued by this Court on 12 November 2021. Notice was also issued in IA 14686/2021 (preferred by the plaintiff under Order XXXIX Rule 1 & 2 of the CPC), and an *ad interim* injunction was granted against the defendant to the extent of using the mark CHAKRA KOLHU.






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12. The defendant has, thereafter, filed a reply to IA 14696/2021 and has also filed IA 16119/2021, under Order XXXIX Rule 4 of the CPC, for vacation of the *ad interim* injunction granted by this Court on 12 November 2021.

13. I have heard learned counsel at length on both applications. Mr. Gagan Gupta appeared on behalf of the plaintiff and Mr. Sudhir Makkar, learned senior counsel appeared on behalf of the defendant.

Rival Contentions

14. Mr. Gupta submits that the word “CHAKRA” has, in Devanagari, been written by the defendant, both for its CHAKRA KOLHU () as well as for its CHAKRESH () marks, in a manner identical to the manner in which the plaintiff writes CHAKRA () . This, he submits, is copying, plain and simple. Mr. Gupta further submits that, in CS (Comm) 528/2021 (*Landsmill Agro Pvt. Ltd v. Khandelwal Edible Oils Ltd*), the defendant, as the plaintiff in that suit, admitted that it had launched its CHAKRA KOLHU brand only in October 2021.

15. Mr. Gupta relies on the rectification petition filed by the defendant under Section 57 of the Trade Marks Act, seeking removal, from the register of trade Marks, of the trademark “CHAKRA”,



registered in the plaintiff's favour *vide* Registration 2556260, in which the defendant has averred thus:

“The impugned mark is textually, phonetically, and visually similar to the Applicant's well-known CHAKRA KOHLU Mark. The impugned mark has been filed and registered in respect of goods which are identical/similar to the goods in respect of which the Applicant's CHAKRA KOHLU Mark. An entry in the Register of Trade Marks or use of the impugned mark (which is deceptively to the Applicant's CHAKRA KOHLU Mark) in respect of identical/similar goods by the Registrant is bound to cause confusion among the public and traders.”

Thus, submits Mr. Gupta, the defendant is estopped from contesting the allegation of deceptive similarity between the defendant and the plaintiff marks. As a senior user of the similar mark, Mr. Gupta submits that his client is entitled to an injunction.

16. Mr. Gagan Gupta draws my attention to para 2 of the plaint in CS (Comm) 528/2021, in which the defendant has averred that it was “amongst the leading manufactures and sellers/distributors of edible oils including Mustered oil, Refined Rice Bran oil and refined Soyabean Oil in the territory of Uttar Pradesh, Bihar.... under the brand CHAKRA KOLHU”. This, submits Mr. Gupta, is contrary to the stand adopted by the defendant in IA 16119/2021, in which the defendant has averred that, while the plaintiff uses its mark for mustard oil, the defendant uses its mark only for multigrain edible oil. Mr. Gupta submits that, till May 2021, the defendant was using the marks DADAJI, DHAN KOSH and NATURE FIT, and had applied for the mark “CHAKRA KOLHU” in May 2021. Mr. Gupta also relies on para 19 of the plaint in CS(Comm) 528/2021, in which the defendant has acknowledged that a substantial class of consumers



who purchase the goods of the plaintiff and defendant is illiterate, who rely upon their visual power of recall for the overall idea and impression of the packaging used by them.

17. Mr. Gupta submits that, while the defendant has admittedly applied for registration of the word mark CHAKRA KOLHU only on 27 May 2021, the plaintiff has been using the mark “CHAKRA” since 1997 and has placed, on record, invoices evidencing such use at least since 2002. The plaintiff applied for registration of the word mark “CHAKRA” in 2013. Registration was granted in 2016, and the defendant never objected to the use of the said mark by the plaintiff till the rectification application filed by the defendant in 2021.

18. Mr. Gupta submits that the likelihood of confusion is enhanced by the fact that the plaintiff and defendant both operate in UP. The plaintiff’s sales in the year 2021 alone is to the tune of ₹ 1609 crores.

19. Insofar as the mark CHAKRIKA is concerned, Mr. Gupta acknowledges that no product bearing the said mark is yet to be seen in the market. He points out that the defendant applied for registration of the mark CHAKRIKA on 8 September 2021 on “proposed to be used” basis.

20. The mark CHAKRESH, as used by the defendant on its bottle is, however, according to Mr. Gupta, both infringing of the plaintiff’s mark CHAKRA and also amounts to an attempt to pass off the



defendant's goods as those of the plaintiff, especially as the defendant uses an identical lettering for the "CHAKRA" part of the mark "CHAKRESH" and a label which is deceptively similar to the plaintiff's label.

21. Mr. Gupta also disputes Mr. Makkar's contention that the mark CHAKRESH is registered in favour of the defendant. He submits that it is registered in favour of Gagan Agarwal, as is acknowledged in the rejoinder filed by the defendant in IA 16119/2021. According to the said rejoinder, Gagan Agarwal is the licensor who has executed the license deed in favour of the defendant, which is not traceable and is not in the defendant's possession. As such, Mr. Gupta submits that the defendant cannot be heard to argue that he is the proprietor of the registered trade mark CHAKRESH. Nor is the defendant in possession of any document to indicate that he is a licensee of Gagan Agarwal, in whose name the mark is registered, so as to claim permissive user.


22. In response, Mr. Makkar submits that there is no chance of confusion as a consequence of use of the rival marks, as the plaintiff's product is mustard oil, whereas the defendant's product is multigrain edible oil. Insofar as the mark "CHAKRESH" is concerned, Mr. Makkar submits that his client is the holder of a valid and subsisting registration in respect of the mark since 2017, and is using the mark in exercise of the right conferred by him as the registrant thereof.




23. The plaintiff's mark "CHAKRA", submits Mr. Makar, was not entitled to registration in the first place. The word "Chakra", he submits, is descriptive of the nature of the product in respect of which it is used, as "Chakra" is the method of extraction of the oil. Besides, he submits that there are several other users who used similar marks, the oldest of which is registered since 1990. For the proposition that no exclusivity can be claimed in respect of a descriptive mark, Mr. Makar relies on paras 2, 6, 9 and 11 to 13 of the judgment of a learned Single Judge of this Court in *Three N Products v. Kairali Exports*⁵.

24. Further responding to the submissions of Mr. Gupta, Mr. Makkar submits that "चक्र" is *publici juris*, and that no exclusivity can be claimed over "चक्र" either as a whole mark or as a part of the mark. He draws my attention to the documents filed with the written statement, particularly emphasizing

(i) the registration granted to the word mark "CHAKRADHARI" as a word mark w.e.f. 8 January 1999 in Class 29 for edible oil, in favour of Bajrang Lal,


(ii) the registration of the device mark  (which is the word "Chakra" written in Tamil) in favour of G. Krishnan w.e.f. 11 July 1996 under Class 29 for "edible oils",


(iii) the registration of the device mark , in favour of Tata Global Beverages Ltd. w.e.f. 2 September

⁵ 246 (2018) DLT 691



2011 in Class 29 for “eggs, milk and milk products, preserved, dried and cooked fruits and vegetables, jellies, jams”,

(iv) the registration for the device mark  in favour of M/s Good Health Agrotech Ltd. w.e.f. 11 September 2006 in Class 29 for “edible oil and vanaspati” and

(v) the registration of the device mark  in favour of Vutukuri Sundar Ramanujam w.e.f. 2 January 2017 under Class 29 for “edible oils”.

Mr. Makkar submits, therefore, that the plaintiff cannot claim exclusivity over the “चक्र”/“CHAKRA” part of its mark, as it is common to the trade and relies, for the said purpose, on Section 17(2)(b)⁶ of the Trade Marks Act.

25. Mr. Makkar further submits that the words “CHAKRA” and “KOLHU” denote the conventional method of extracting oil from seeds and cannot, therefore, be entitled to exclusivity or even registered as marks. He has drawn my attention to the following literature which he has placed on record, in this regard, with respect to the word “CHAKRA”:

⁶ 17. Effect of registration of parts of a mark. –

(2) Notwithstanding anything contained in sub-section (1), when a trade mark—

(b) contains any matter which is common to the trade or is otherwise of a non-distinctive character,

the registration thereof shall not confer any exclusive right in the matter forming only a part of the whole of the trade mark so registered.



“LITERATURE ON THE WORD CHAKRA

Definition of Chakra

In Sanskrit, the word "chakra" means "disk" or "wheel".

Definition of Kolhu

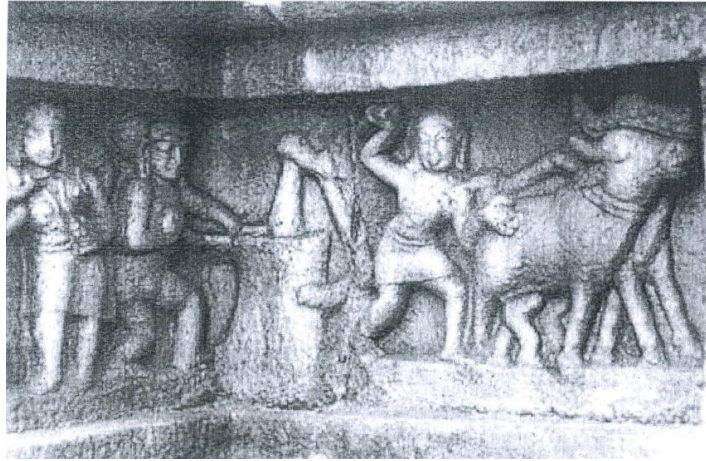
1. The system of crushing seeds to extract oil is commonly called the ghani, or the kolhu or chekku (Achaya, 1993). Kolhu operation has been noted in Afghanistan, Sri Lanka and Myanmar, which had cultural ties with India. The device is widely used in the Sudan to crush sesame seeds.

2. In hindi Kolhu means

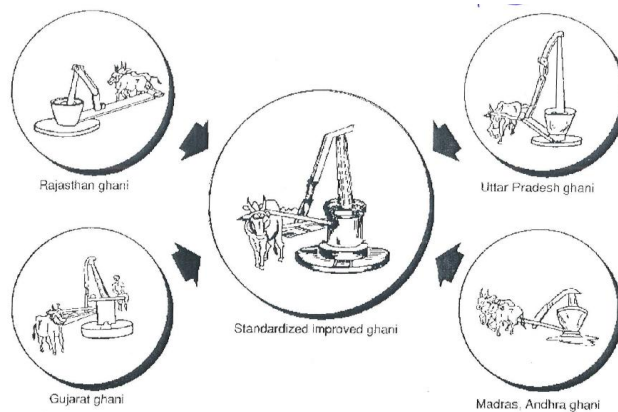
सरसोंऔरअन्यतिलहनोंकीपिराईकरकेतेलनिकालनेकायंत्र।

History

1. In Sanskrit literature of about 500 BC there is a specific reference to an oil-press, although it was never described (Monier-Williams, 1899). Juices were extracted from vegetable materials as early as 1500 BC using either a mortar and pestle or a grinding stone working on a flat stone.



Linguistic evidence suggests that it is from these two crushing systems that presses for both oilseeds and sugar cane developed in the form of a mortar-and-pestle arrangement powered by animals.

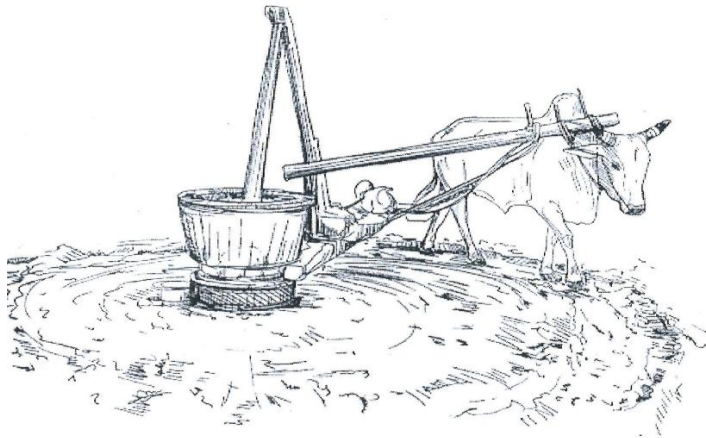


This system is commonly called the ghani, or the kolhu or chekku (Achaya, 1993). (Where the animals make rounds being attached to the stone i.e. Chakkar in order to Extract Oil)



Articles Explaining Traditional Use of Kolhu

1. The oil seeds and subsequently the expressed oil are held in a scooped circular pit in the exact centre of a circular mortar made of stone or wood. In it works a stout, upright pestle which descends from a top curved or angled piece, in which the pestle rests in a scooped-out hollow that permits the pestle to rotate, eased by some soapy or oily lubricant. Today the single angled piece takes the form of two shorter pieces pinioned or chained together. The bottom of the lower angled piece is attached to a load-beam; one end of the load-beam rides around the outside of the barrel, while the other is yoked to the animal. The load-beam is weighted down with either heavy stones or even the seated operator. As the animal moves in a circular ambit, the pestle rotates, exerting lateral pressure on the upper chest of the pit, first pulverizing the oilseed and then crushing out its oil.



2. Ghani technology is the traditional method of extraction of oil from oil seeds like sesame, mustard , rapeseed etc. by use of simple technology. In this technology, oilseeds are held in scooped circular pit in the center of mortar made of stone or wood. In it works a stout upright pestle which descends from tip curved or angled piece. The pestle rests in a scooped out hollow that also permits pestle to rotate. Today the single angled piece takes the form of two shorter pieces chained together. The bottom of lower angled piece is attached to a load beam. One end of load beam rides around the outside of barrel while other is yoked to animal. The load beam is weighted down either with heavy stones or even seated operator. As the animal moves in circular ambit, the pestle rotates exerting lateral pressure on the upper chest of the pit, first pulverizing the oilseed and then crushing out its oil.

3. Being crushed in Ghani, operated by a blindfold bullock. The seed in the "Mortar" is crushed by the large log "Pestle" which is pulled down against the side of the "Mortar" by weights of the shaft, as the animal moves in circular ambits.

4. Kachchighani refers to coldpress extraction process for taking out oil from seeds. Traditionally, oil from seeds were extracted in kohlus (a wooden cold press used with the help of a cow). In this process, seeds are crushed at low temperature so natural properties, antioxidants and essential oils are retained in the oil.

5. The oilseeds and subsequently the expressed oil are held in a scooped circular pit in the exact centre of a circular mortar made of stone or wood. In it works a stout, upright pestle which descends from a top curved or angled piece, in which the pestle rests in a scooped out hollow that permits the pestle to rotate, eased by some



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soapy or oily lubricant. Semi-Automatic Ghani Machine Ghani Oil Processing 16 single angled piece takes the form of two shorter pieces pinioned or chained together. The bottom of the lower angled piece is attached to a load-beam; one end of the load-beam rides around the outside of the barrel, while the other is yoked to the animal. The load-beam is weighted down with either heavy stones or even the seated operator. As the animal moves in a circular ambit, the pestle rotates, exerting lateral pressure on the upper chest of the pit, first pulverizing the oil seed and then crushing out its oil.

The Oil is extracted with the tradition method called Kolhu/Ghani. In which it involves One/Two Bullocks to move in Circular ambits i.e. Chakra, attached to the grinding machine, extracting the Oil."

26. Without prejudice, Mr. Makkar submits that his client is willing to change its label to any one of the following labels, none of which, in his submissions, infringe either the plaintiff's trade mark or its copyright:





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Mr. Makkar submits that, in these labels, his client has entirely removed the wheel “Chakra” symbol and has also changed the colour and the font of the words “CHAKRA” and “KOLHU”, so that they do not resemble the manner in which the plaintiff uses “CHAKRA” in its mark.

27. With this, he submits that the grievance of copyright infringement would stand assuaged.

28. Mr. Makkar, continuing his arguments, cites, in support of his contention that the plaintiff is not entitled to claim exclusivity over the mark “CHAKRA” as it is common to the trade, paras 1 and 34 of the judgment of a learned Single Judge of this Court in *Prem Singh v. CEEAM Auto Industries*⁷. He also relies on para 2 of the decision in *Girnar Food & Beverages Pvt. Ltd.* and paras 6 and 10 of the judgment, again, of a learned Single Judge of this Court in *Panacea Biotec Ltd. v. Recon Ltd*⁸.

29. The moment the word CHAKRA is used in conjunction with oil, Mr. Makkar submits that the connect between the use of the mark and the process of oil extraction is immediate and inevitable. As

⁷ AIR 1990 Delhi 233

⁸ 1996 PTC 16



such, he submits that it is not open to the plaintiff to contend that the mark is generic, inventive, or distinctive. Apropos Mr. Gupta's reliance on the provision to Section 9(i), Mr. Makkar submits that there is no evidence, produced by the plaintiff, of the mark "CHAKRA" having attained secondary meaning. Mr. Makkar also relies on paras 5.1, 5.2, 20, 21, 27.5 and 28 of the judgment of a judgment of this Court in *SBL Ltd. v. Himalaya Drug Company*⁹, to support his contention that no exclusivity can be claimed in respect of words which have become common to the trade. He further cites paras 1 to 9 of the judgment of a learned Single Judge of this Court in *Jagdish Prasad Sharma v. Mastermind Publishing House*¹⁰, para 6 of the judgment of the Supreme Court in *J.R. Kapoor v. Micronix India*¹¹, paras 1 and 9 of the judgment of the Division Bench of this Court in *Rhizome Distilleries P. Ltd. v. Pernod Ricard SA France*¹² and para 20 of my decision in *Phonepe P. Ltd. v. Ezy Services*¹³.

30. Mr. Makkar invokes the anti-dissection rule to contend that it is not permissible to dissect his mark into "Chakra" and "Kolhu". He submits that the defendant's mark is CHAKRA KOLHU.

31. Mr. Makkar finally summarizes his submissions. Firstly, the plaintiff was not the originator of the mark "CHAKRA", but was merely an adopter and user. Secondly, the mark "CHAKRA" is

⁹ 1997 PTC (17) (DB)

¹⁰ 2005 (310) PTC 243 (DEL)

¹¹ 1994 PTC 260

¹² 166 (2010) DLT 12 (DB)

¹³ 2021 (86) PTC 436 (Del)



common to the trade and represents the conventional method of oil extraction. Thirdly, there is no evidence that the plaintiff's mark "CHAKRA" has acquired secondary meaning so as to entitle the plaintiff to the benefit of the proviso to Section 9(1) of the Trade Marks Act. Fourthly, in the absence of any evidence of secondary significance having been acquired, the plaintiff cannot monopolize the generic word "CHAKRA" as it is not inherently distinctive.

32. Finally, apropos, the alleged admission, in the rectification petition filed by the defendant against the plaintiff's "CHAKRA" mark, in para 8 of the rectification petition on which Mr. Gagan Gupta places reliance, Mr. Makkar contends that the application was on account of a cut and paste error and cannot be read out of context. He submits that, in the very same rectification petition, the defendant has clearly contended that the word "CHAKRA" is an ordinary Hindi word over which no one can claim monopoly.

33. Responding to the submissions of Mr. Makkar in rejoinder, Mr. Gagan Gupta submits, apropos the entitlement of the mark "CHAKRA" to registration that, even if it were to be assumed that the mark "CHAKRA" was descriptive, the proviso to Section 9(1)¹⁴ of the

¹⁴ **9. Absolute grounds for refusal of registration. –**

- (1) The trade marks –
- (a) which are devoid of any distinctive character, that is to say, not capable of distinguishing the goods or services of one person from those of another person;
 - (b) which consist exclusively of marks or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, values, geographical origin or the time of production of the goods or rendering of the service or other characteristics of the goods or service;



Trade Marks Act entitles descriptive marks to registration provided they have acquired a secondary significance with passage of time. His clients, he submits, has a turnover of over ₹ 1600 crores, by use of the mark “CHAKRA”. As such, his client, in any way would be entitled to the benefit of the proviso to Section 9(1).

34. That apart, Mr. Gupta submits that the mark “CHAKRA” cannot be regarded as descriptive but is, at best, suggestive of edible oils in respect of which it is used. Suggestive marks, he submits, are entitled to registration as well as exclusivity. He cites para 17 of the judgment of the Division Bench of this Court in *Girnar Food & Beverages Pvt. Ltd. v. Godfrey Philips India Ltd*¹⁵.

35. Arguing in rejoinder, Mr. Gagan Gupta points out that the registration of the mark “CHAKRA” in favour of the plaintiff is specifically for use of the mark in the States of Uttar Pradesh and Uttarakhand. The plaintiff and the defendant are, therefore, using the rival marks in the same geographical area. The triple identity test is, therefore, clearly applicable.

36. Mr. Gagan Gupta submits that his reliance on the proviso to Section 9(1) of the Trade Marks Act was not intended to satisfy Mr.

(c) which consist exclusively of marks or indications which have become customary in the current language or in the bona fide and established practices of the trade,
shall not be registered:

Provided that a trade mark shall not be refused registration if before the date of application for registration it has acquired a distinctive character as a result of the use made of it or is a well-known trade mark.

¹⁵ 2001 PTC 360 (DEL) (DB)



Makkar that the mark “CHAKRA” was entitled to registration. He submits that the reference was only by way of response to Mr. Makkar’s contention that the word mark “CHAKRA” could not be registered. Mr. Gagan Gupta’s attempt was, therefore, only to point out that, there was no inherent bar to registration of the mark of the “CHAKRA”, in view of the proviso to Section 9(1) of the Trade Marks Act. It was obviously after being satisfied that the said proviso applied that the Trade Mark Registry registered the trade mark “CHAKRA” in favour of the plaintiff.

37. Mr. Gagan Gupta resists Mr. Makkar’s contention that the word “CHAKRA” refers to a method for extraction of oil or was descriptive thereof. That apart, he submits that, having applied for registration of the mark “CHAKRA KOHLU” the defendant cannot seek to contend that the mark “CHAKRA” was not registrable.

38. Mr. Gagan Gupta took me through paragraphs 3 to 8 of the defendant’s rectification petition filed before the Registrar of Trade Marks, opposing against the plaintiff’s “CHAKRA” mark, thus:

“3. The Applicant is the first adopter, sole and exclusive owner, renowned trademark CHAKRA KOHLU, including its



formative marks such as etc. (all of which are hereinafter collectively, individually as well as jointly, referred to as the 'CHAKRA KOHLU Mark') in respect of its goods. The Applicant owns the exclusive rights to the CHAKRA KOHLU Mark in relation to its offerings. Intellectual property rights, including trademarks and copyrights in the CHAKRA KOHLU Mark vest exclusively in the Applicant.



4. The Applicant's CHAKRA KOHLU Mark edible oils under the CHAKRA KOHLU Mark has become synonymous with high quality of oils across India. The popularity and repute of the Applicant's products under the CHAKRA KOHLU Mark is also evident and well received by customers in the relevant industry.

5. In India, the Applicant's CHAKRA KOHLU Mark has acquired significant goodwill and reputation owing to the extensive use. Several advertisements have listed also listed the CHAKRA KOHLU oils in India.

6. The Applicant owns an application for the mark CHAKRA KOHLU in class 29 bearing Application No. 4985026.

7. Through consistent and extensive marketing and actual use, the Applicant's CHAKRA KOHLU Mark has acquired enviable goodwill and significant degree of fame and reputation. The Applicant's CHAKRA KOHLU Mark enjoys immense reputation and goodwill amongst customers and public at large, which is evident from the Applicant's presence on public domain.

8. Owing to extensive use, and extensive marketing, the Applicant's CHAKRA KOHLU Mark qualifies to be declared as a "well-known trademark" in India as per the definition under Section 2(1)(zg) read with Section 11(6) of the Trade Marks Act, 1999. The statute mandates that such "well-known" trademarks are entitled to protection across classes. The outstanding reputation, goodwill and brand value associated with the CHAKRA KOHLU Mark is of inestimable value to the Applicant. Any unauthorized use or adoption of the CHAKRA KOHLU Mark or any mark deceptively and confusingly similar thereto in respect of any goods/services by anyone, including the Registrant, would take unfair advantage of and be detrimental to the distinctive character and repute of the Applicant's mark."

Mr. Gagan Gupta submits that, the recital, in paras 5, 6 and 7 of the rectification petition that the defendant's "CHAKRA KOHLU" mark had acquired significant goodwill and reputation by extensive use was obviously false, as the rectification petition was filed on 13 October,



2021 and it was the defendant's admitted case that it had commenced use of the mark "CHAKRA KOHLU" only in October 2021.

39. In support of his submissions, Mr. Gupta relies on paras 20, 24, 86 and 92 of the judgment of the Supreme Court in *T.V. Venugopal v. Ushodaya Enterprises Ltd*¹⁶, paras 2, 40 and 41 of the judgment of the learned Single Judge of this Court in *Hi-Tech Pipes Ltd. v. Asian Mills Pvt Ltd*¹⁷ and paras 22 to 25, 30 to 32 and 39 of the judgment of a learned Single Judge in *Teleecare Network India Pvt. Ltd. v. Technology Pvt Ltd*¹⁸. On the basis of these decisions, primarily *Teleecare Network*, Mr. Gupta submits that the word "CHAKRA" cannot be treated as descriptive and at worse, could only be regarded as suggestive.

40. With respect to Mr. Makkar's contention that the mark "CHAKRA" was *publici juris*, Mr. Gupta places reliance on Section 28(3)¹⁹ of the Trade Marks Act as well as paras 21 to 26 of the judgment of the learned Single Judge of this Court in *Millennium and Copthorne International v. Aryansh Plaza Service Pvt. Ltd*²⁰. He further relies on the principle that the plaintiff cannot be expected to sue every infringer. He submits that his client has already filed seven

¹⁶ (2011) 4 SCC 85

¹⁷ 2006 SCC Online Del 21

¹⁸ (2019) 262 DLT 101

¹⁹ (3) Where two or more persons are registered proprietors of trade marks, which are identical with or nearly resemble each other, the exclusive right to the use of any of those trade marks shall not (except so far as their respective rights are subject to any conditions or limitations entered on the register) be deemed to have been acquired by any one of those persons as against any other of those persons merely by registration of the trade marks but each of those persons has otherwise the same rights as against other persons (not being registered users using by way of permitted use) as he would have if he were the sole registered proprietor.

²⁰ (2019) 77 PTC 115



rectification petitions against persons who have been infringing its mark. Moreover, he submits that the evidences cited by Mr. Makkar do not make out a case of the mark “CHAKRA” being *publici juris*, as the plaintiff’s mark is valid only in UP and Uttarakhand and, of all the mark shown by Mr. Makkar of the 25 marks annexed to the written statement, only three are from UP. Of this three, the mark “CHAKRAVYOOH” is used in respect of potato chips, in respect of the mark “CHAKRADHARA”, a rectification has been filed and the third mark is “CHAKRADHAR”.

41. Mr. Makkar submits in surrejoinder that no plea of estoppel can be raised against him and he has not applied for registration of “CHAKRA”, but of “CHAKRA KOHLU”. In this context, he cites paras 11 and 54 of the judgment of the in *Nestle India v. Mood Hospitality*²¹.

Analysis

42. I would deal with the defendant’s marks CHAKRA KOLHU, CHAKRESH and CHAKRIKA individually, *seriatim*.

Re. CHAKRA KOLHU

43. Trade mark infringement

²¹ (2010) 4 PTC 514 (DB)



43.1 The plaintiff is the proprietor of the registered trade mark “CHAKRA”, registered as a work mark in Class 29 for “edible oils for sale in the States of Uttar Pradesh, Uttaranchal and Uttarakhand” w.e.f. 28 June 2013.

43.2 Section 29(2)(b)²² of the Trade Marks Act envisages infringement as taking place where the defendant uses a mark which is similar to the plaintiff’s, for goods or services which are identical or similar to the goods or services of the plaintiff, and, as a result of these factors, there is a likelihood of confusion or of association between the two marks in the mind of the public. The plaintiff has a registration for the word mark “CHAKRA”. The defendant uses the mark “CHAKRA KOLHU”. The marks are, *ex facie*, similar. The marks are used for the same product, viz. edible oils. Mr. Makkar sought to submit that the plaintiff’s mark is used for mustard oil and the defendant’s for multigrain edible oil, while Mr. Gupta disputed the assertion. It hardly matters. Both are edible oils. They are, therefore, similar. A manufacturer who manufactures one variety of edible oil today may well manufacture another tomorrow. A likelihood of confusion, therefore, exists.

²² (2) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which because of—

- (a) its identity with the registered trade mark and the similarity of the goods or services covered by such registered trade mark; or
- (b) its similarity to the registered trade mark and the identity or similarity of the goods or services covered by such registered trade mark; or
- (c) its identity with the registered trade mark and the identity of the goods or services covered by such registered trade mark,

is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trade mark.





43.3 The likelihood is enhanced by the fact the defendant has, whether by intent or otherwise, chosen to print “चक्र” exactly in the manner and style in which the plaintiff prints it. The fact that the defendant’s label uses a colour scheme, and arrangement of features, which is also similar to the plaintiff’s, exacerbates the chance of confusion.

43.4 The matter has to be viewed from the perspective of a consumer of average intelligence and imperfect recollection.²³ The rival marks are not to be placed side by side. The Court has to examine whether, if such a consumer were to see the plaintiff’s mark at one point of time, and the defendant’s mark at another, there is a likelihood of his being confused. If he is inclined to ask himself – assuming he has a predisposition to soliloquy – whether he had seen the mark, or something like it, before, the test of infringement is satisfied. Actual confusion is not necessary. Likelihood of confusion is sufficient. A “state of wonderment” is all that is needed. Even if the average consumer were to believe an association between the two marks, it suffices, for infringement to be found to exist. These principles stand settled in numerous judicial authorities, and the decision of the Division Bench of this Court in *Shree Nath Heritage Liquor Pvt. Ltd. v. Allied Blender Distillers Pvt. Ltd.*²⁴, admirably elucidates the entire legal position in this regard.

²³ *Khoday Distilleries Limited v. The Scotch Whiskey Association* : (2008) 10 SCC 723; *Amritdhara Pharmacy v. Satyadeo Gupta* : AIR 1963 SC 449

²⁴ 221 (2015) DLT 359 (DB)



43.5 There are no mathematical standards to be met. The matter has ultimately to depend on the perception of the Court, which has to place itself in the place of the mythical consumer of average intelligence and imperfect recollection. Viewed thus, it is obvious that there is every likelihood of confusion between the marks  and . The defendant has used the entire “चक्र” mark of the plaintiff and has separately used “कोल्हू” below it in a smaller font. The prominence accorded to “चक्र” in the defendant’s mark is likely to result in an immediate possibility of an average consumer recollecting that he has seen the same product earlier. The “कोल्हू”, written in a smaller and much less prominent manner below “चक्र”, is unlikely to mitigate the possibility of confusion. At the very least, such a consumer, who sees the latter mark first, and, some time later, chances on the former, is likely to believe an association between them. The fact that the marks are used on bottles which are also identical in appearance only makes matters worse:





43.6 The marks are similar. Both are used for edible oils. They are sold through the same outlets, as both marks are used in the state of UP. They cater to the same consumer segment. These factors also satisfy the “triple identity test”²⁵ which is a judicially accepted indicator of the chance of likelihood of confusion and consequent infringement.

43.7 The defendant’s “CHAKRA KOLHU” mark, therefore, *prima facie* infringes the plaintiff’s “CHAKRA” mark.

44. Copyright infringement

44.1 The plaintiff possesses copyright registrations for the labels



and

44.2 Section 51 of the Copyright Act sets out the circumstances in which copyright is infringed. We need be concerned only with clauses (a)(i) and (b)²⁶ of Section 51. Section 51(a)(i) deems infringement to

²⁵ Refer *Toyota Jidosha Kabushiki Kaisha vs. Prius Auto Industries Ltd. and Ors.* (2018) 2 SCC 1, *Reckitt & Colman Products Ltd. v. Borden Inc.* MANU/UKHL/0012/1990 : (1990) 1 WLR 491 : (1990) 1 All ER 873 (HL)

²⁶ **51. When copyright infringed.** – Copyright in a work shall be deemed to be infringed –
(a) when any person, without a licence granted by the owner of the Copyright or the Registrar of Copyrights under this Act or in contravention of the conditions of a licence so granted or of any condition imposed by a competent authority under this Act—



occur when any person, without a licence from the copyright owner, or in contravention of a licence so granted, does anything, the exclusive right to do which vests, under the Copyright Act, in the copyright owner. Section 51(b) treats, as infringement, making for sale or displaying, for sale or hire, infringing copies of the work. The rights that vest in owner of a copyright are elucidated in Section 14. In the case of artistic works, Section 14(c)²⁷ applies. Though the principle of confusing or deceptive similarity, which forms the backbone of the Trade Marks Act, does not find specific statutory place in the Copyright Act, Section 14(c)(v) confers, on the owner of copyright in an artistic work, the exclusive right to make an adaptation of the work. “Adaptation”, in the case of an artistic work, is defined, in clause (a)(v) of Section 2 of the Copyright Act, as meaning “any

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- (i) does anything, the exclusive right to do which is by this Act conferred upon the owner of the copyright, or
 - (ii) permits for profit, any place to be used for the communication of the work to the public where such communication constitutes an infringement of the copyright in the work, unless he was not aware and had no reasonable ground for believing that such communication to the public would be an infringement of copyright; or
 - (b) when any person—
 - (i) makes for sale or hire, or sells or lets for hire, or by way of trade displays or offers for sale or hire, or
 - (ii) distributes either for the purpose of trade or to such an extent as to affect prejudicially the owner of the copyright, or
 - (iii) by way of trade exhibits in public, or
 - (iv) imports into India,

any infringing copies of the work:

²⁷ **14. Meaning of copyright.** – For the purposes of this Act, “copyright” means the exclusive right subject to the provisions of this Act, to do or authorise the doing of any of the following acts in respect of a work or any substantial part thereof, namely:—

- (c) in the case of an artistic work,—
 - (i) to reproduce the work in any material form including—
 - (A) the storing of it in any medium by electronic or other means; or
 - (B) depiction in three-dimensions of a two-dimensional work; or
 - (C) depiction in two-dimensions of a three-dimensional work;
 - (ii) to communicate the work to the public;
 - (iii) to issue copies of the work to the public not being copies already in circulation;
 - (iv) to include the work in any cinematograph film;
 - (v) to make any adaptation of the work;
 - (vi) to do in relation to an adaptation of the work any of the acts specified in relation to the work in sub-clauses (i) to (iv);



use of such work involving its re-arrangement or alteration”. The right to alter an artistic work, too, therefore, vests only in its copyright owner.

44.3 The judgment of the Supreme Court in *R.G Anand v. Delux Films*²⁸ elucidates definitive principles in respect of copyright infringement. Though the case dealt with copyright infringement in the case of a cinematographic film, these principles have been followed even in cases of other species of copyright infringement. Para 46 of the report sets out the propositions in this regard:

“46. Thus, on a careful consideration and elucidation of the various authorities and the case law on the subject discussed above, the following propositions emerge:

1. There can be no copyright in an idea, subject-matter, themes, plots or historical or legendary facts and violation of the copyright in such cases is confined to the form, manner and arrangement and expression of the idea by the author of the copyrighted work.
2. Where the same idea is being developed in a different manner, it is manifest that the source being common, similarities are bound to occur. In such a case the courts should determine whether or not the similarities are on fundamental or substantial aspects of the mode of expression adopted in the copyrighted work. If the defendant's work is nothing but a literal imitation of the copyrighted work with some variations here and there it would amount to violation of the copyright. In other words, in order to be actionable the copy must be a substantial and material one which at once leads to the conclusion that the defendant is guilty of an act of piracy.
3. One of the surest and the safest test to determine whether or not there has been a violation of copyright is to

²⁸ (1978) 4 SCC 118



see if the reader, spectator or the viewer after having read or seen both the works is clearly of the opinion and gets an unmistakable impression that the subsequent work appears to be a copy of the original.

4. Where the theme is the same but is presented and treated differently so that the subsequent work becomes a completely new work, no question of violation of copyright arises.

5. Where however apart from the similarities appearing in the two works there are also material and broad dissimilarities which negative the intention to copy the original and the coincidences appearing in the two works are clearly incidental no infringement of the copyright comes into existence.

6. As a violation of copyright amounts to an act of piracy it must be proved by clear and cogent evidence after applying the various tests laid down by the case-law discussed above.


7. Where however the question is of the violation of the copyright of stage play by a film producer or a director the task of the plaintiff becomes more difficult to prove piracy. It is manifest that unlike a stage play a film has a much broader prospective, wider field and a bigger background where the defendants can by introducing a variety of incidents give a colour and complexion different from the manner in which the copyrighted work has expressed the idea. Even so, if the viewer after seeing the film gets a totality of impression that the film is by and large a copy of the original play, violation of the copyright may be said to be proved.”



44.4 When one compares the  label of the plaintiff with the



of the defendant, it does appear that an attempt at imitation has taken place. The defendant has not only replicated the manner in



which the plaintiff has printed “चक्र” in  but also replicated the colour scheme of the label and the device of a wheel. Substantial similarity between the two labels, as envisaged in paras 46(2) and (3) of the decision in **R.G. Anand**, therefore, exists between the two labels.

44.5 The defendant , therefore, *prima facie*, infringes the copyright held by the plaintiff in its label .

45. Re: Validity of the registration of plaintiff’s “CHAKRA” trade mark:

45.1 Mr. Makkar sought to submit that “CHAKRA” is a descriptive mark and is not, therefore, entitled to registration. He has also questioned the plaintiff’s right to claim exclusivity in respect of “CHAKRA”, as it is descriptive. He submits that “CHAKRA” describes the manner of extraction of the oil.

45.2 Mr. Gupta raised a preliminary objection to this argument. He submits that, having thus applied for registration of the mark “CHAKRA KOHLU” as a trade mark, the defendant cannot be heard to contend that the mark “CHAKRA” is descriptive. Mr. Makkar’s response is that, the defendant has applied not for registration of the



registration of the mark “CHAKRA” and of the mark “CHAKRA KOHLU”.

45.3 Mr. Makkar’s response is, with respect, far from satisfactory. If “CHAKRA” is descriptive of the oil, “CHAKRA KOLHU” would be even more so, as is apparent from the literature that Mr. Makkar has himself placed before the Court. Having, thus, applied for registration of the mark “CHAKRA KOLHU”, it is not open to the defendant to submit that “CHAKRA” is a descriptive mark. There are several authorities to support this proposition, including *Automatic Electric Limited v. R.K. Dhawan*²⁹, which has been followed by me in *Pernod Ricard India Pvt. Ltd. v. A.B. Sugars Ltd.*³⁰

45.4 On merits, however, I am of the opinion that the mark “CHAKRA” cannot be regarded as “descriptive”.

45.5 The Trade Marks Act does not make any reference to “descriptive” marks. Section 9(1)(b)³¹ proscribes registration of trade marks which consist exclusively all marks or indications which may

²⁹ 1999 SCC OnLine Del 27

³⁰ 2023 SCC OnLine Del 6966

³¹ 9. Absolute grounds for refusal of registration. –

(1) The trade marks –

(b) which consist exclusively of marks or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, values, geographical origin or the time of production of the goods or rendering of the service or other characteristics of the goods or service;

shall not be registered:

Provided that a trade mark shall not be refused registration if before the date of application for registration it has acquired a distinctive character as a result of the use made of it or is a well-known trade mark.



serve in the trade to designate the kind, quality, quantity, intended purpose, values, geographical origin or the time of production of the goods or rendering of the services or other characteristics of the goods or the services. It is this parenthesis of marks which is often referred to “descriptive”. (Perhaps a more apt epithet would be “indicative”.) What is apparent from Section 9(1)(b) is that the proscription is against the registration of the trade marks which may serve in trade to designate the kind, quality, quantity, etc. of the goods or services. The word “CHAKRA” does not designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production or any other characteristic of the edible oil. *The representation must be of the characteristic of the goods or services, and not of the manner in which the goods are produced.* A mark which merely indicates the manner in which the goods are produced is not hit by Section 9(1)(b). No occasion, therefore, arises to refer to the proviso to the said sub section.

45.6 Even if it were to be assumed, for the sake of arguments, that the word “CHAKRA” may suggest, to a consumer, edible oil – which is a very far suggestion – that, at the highest, would make the mark suggestive and not descriptive. The proscription against the registration is of descriptive marks and not of suggestive marks. Suggestive mark can be registered³². As such, it cannot be said, the submission of Mr. Makkar that the mark “CHAKRA” could not be registered for edible oil, cannot *prima facie* be accepted.

³² Refer **T.V. Venugopal v. Ushodaya Enterprises Ltd**, (2011) 4 SCC 85 , **Teleecare Network India Pvt. v. Asus Technology Pvt. Ltd.** (2019) 262 DLT 101



46. Re: Section 17(2)(b) of the Trade Marks Act

46.1 For the same reason, the reliance by Mr. Makkar on Section 17(2)(b) of the Trade Marks Act fails to impress. Mr. Makkar has sought to contend that “CHAKRA” as a mark is common to the trade of edible oils. It is important to note that Section 17(2)(b) uses the words “common to *the* trade” and not “common to trade”. A defendant who chooses to contest the prayer for injunction against infringement on the ground that the plaintiff’s mark is common to the trade has, therefore, to establish a mark is common to the trade in respect of which the plaintiff uses the mark in accordance with its registration. In other words, it is only if the defendant can produce evidence to satisfy the Court, *prima facie*, that the mark “CHAKRA” is common to the trade of edible oils, that it can seek to rely on Section 17(2)(b).


46.2 Mere profusion of marks, on the register of trade marks, is no evidence of trade in the said marks. What has to be shown for Section 17(2)(b) to be legitimately invoked is that there is a large volume of trade in the mark associated by the plaintiff, by others. All that Mr. Makkar has sought to contend is that there are several registrations for marks which, if seen, would make it appear that “CHAKRA” is common to the trade. To employ a somewhat clumsy expression which is, however, often used, such an assertion can only show that the mark is “common to the register” and not “common to the trade”.



46.3 In order to succeed in a defence based on Section 17(2)(b), therefore, it is not enough for the defendant to show that there are several registrations, under the Trade Marks Act, of the said mark. What has to be shown is that there is a large volume of trade in the said mark. This position has been settled by the judgment of the Division Bench of this Court in *Pankaj Goel v. Dabur India Ltd.*³³.

46.4 Citing a number of registrations of marks which include “CHAKRA”, therefore, does not farther the defendant’s case or justify invocation, by the defendant of Section 17(2)(b).


46.5 That apart, even if one were to refer to the marks cited by Mr. Makkar, they are all marks for which “CHAKRA” is only a part. Section 17(2)(b) applies only where the asserted mark contains matter which is common to the trade. In other words, Mr. Makkar would have had to show that “CHAKRA” was common to the trade of edible oils in UP/ Uttarakhand, as the plaintiff’s CHAKRA word mark was specifically registered for use in the said states and the plaintiff does not claim any goodwill or reputation outside the states of UP and Uttarakhand.

46.6 Of all the marks cited by Mr. Makkar, the only “CHAKRA” mark is the device mark , which is registered in favour of

³³ 2008 (38) PTC 49 (Del)



Vutukuri Sundar Ramanujam. This solitary mark can hardly make out a case of “CHAKRA”, being common to the trade. Besides, there is

no evidence of use of the mark  cited by Mr. Makkar. The reliance on Section 17(2)(b) can also, therefore, not come to the aid of the defendant.

47. Re: Admission contained in rectification petition filed by the defendant against the plaintiff’s “CHAKRA”

47.1 The defendant has, in its rectification petition, clearly averred that the plaintiff’s “CHAKRA” mark is “textually, phonetically and visually similar” to the defendant’s “CHAKRA KOHLU” mark and that the simultaneous “existence of the two marks is bound to cause confusion among the public and traders”. I do not see, at least at this *prima facie* stage, how the defendant can escape this admission. Mr. Makkar sought to underplay its effect by contending that it was a cut and paste error, which could not be read out of context. The submission is obviously unacceptable. The defendant had raised the contention of deceptive similarity as between the mark “CHAKRA KOHLU” and “CHAKRA”, as an independent ground to seek invalidation of the plaintiff’s “CHAKRA” mark, obviously based on Section 11(1)(b)³⁴ of the Trade Marks Act. The subsequent assertion

³⁴ 11. **Relative grounds for refusal of registration.** –

(1) Save as provided in Section 12, a trade mark shall not be registered if, because of—

(b) its similarity to an earlier trade mark and the identity or similarity of the goods or services covered by the trade mark,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.



that the mark “CHAKRA” was descriptive has nothing to do with the aspect of deceptive similarity. Clearly, the defendant had advanced two alternative submissions to question the validity of the plaintiff’s “CHAKRA” mark; firstly, that the mark was deceptively similar to the defendant’s “CHAKRA KOHLU” mark and secondly, that “CHAKRA” was a descriptive mark. Being faced with the admission of deceptive similarity contained in the rectification petition filed by his client, Mr. Makkar cannot seek sanctuary on the second ground of challenge urged in that regard viz that the mark “CHAKRA” was descriptive.

48. Re: “CHAKRESH” AND “CHAKRIKA”

48.1 Unlike “CHAKRA KOLHU”, which replicates the entire “CHAKRA” mark of the plaintiff and merely adds a “KOLHU” thereafter, the marks “CHAKRESH” and “CHAKRIKA” do not even replicate the “CHAKRA” mark of the plaintiff. “CHAKR” merely happens to be a part of both marks. Both “CHAKRESH” and “CHAKRIKA” are compound words, and it would *prima facie* be impermissible to return a finding of infringement by isolating, from both words, the “CHAKR” portion. Equally, it might not be possible to hold, even *prima facie*, that a person of average intelligence would be confused between the marks “चक्र” and “चक्रेश” or “चक्रिका”. They cannot be regarded as phonetically similar either.



48.2 The registration of the mark “CHAKRA” cannot entitle the plaintiff to a monopoly over all words in Hindi which start with “चक्र”, even if used for edible oils. The defendant’s mark has to be seen as a whole. It cannot be vivisected into parts, especially where the mark is one single word, written and printed as such. The mark as a whole must infringe.

48.3 It is not possible, therefore, to hold, *prima facie*, that the marks “CHAKRIKA” or “CHAKRESH” infringe the plaintiff’s registered word mark “CHAKRA”.

48.4 Besides, so far as the mark “CHAKRIKA” is concerned, the plaintiff acknowledges that the plaintiff has no knowledge of use, by the defendant, of the mark “CHAKRIKA”. It cannot, therefore, be said that the mark “CHAKRIKA” was being used, in any manner, as would result in likelihood of confusion. Mere registration of a mark does not amount to infringement within the meaning of Section 29. A mark per se does not infringe. It is only where the use of the mark satisfies the ingredients of one or more of the sub sections of Section 29, resulting of any likelihood of confusion or association, that infringement can be said to have taken place.

48.5 Absent of any evidence of use of the mark “CHAKRIKA”, no interlocutory injunction can be passed in respect of the said mark.

The sequitur



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49. As a result, the plaintiff would be entitled to an injunction against the use, by the defendant, of the mark “CHAKRA KOHLU” in respect of any products. However, there can be no injunction in respect of the mark “CHAKRIKA” or “CHAKRESH”.

Conclusion

50. Resultantly, the interim order dated 12 November 2021 is made absolute pending disposal of the suit.

51. I.A. 14686/2021, under Order XXXIX Rules 1 and 2 of the CPC, stands partly allowed to the aforesaid extent. IA 16119/2021 by the defendant, under Order XXXIX Rule 4 of the CPC, is dismissed.

C. HARI SHANKAR, J.

DECEMBER 22, 2023

dsn/rb