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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**
+ CS(COMM) 1196/2024, I.A. 49748/2024, I.A. 49749/2024, I.A.
49750/2024, I.A. 49751/2024, I.A. 49752/2024 & I.A. 49753/2024
HERO MOTOCORP LTD. AND ANR.Plaintiffs

Through: Mr. Krtin Bhasin, Adv.
M: 9810060831
Email: krtin.bhasin29@gmail.com

versus

ASHOK KUMAR (JOHN DOE)Defendant
Through: None

CORAM:
HON'BLE MS. JUSTICE MINI PUSHKARNA

ORDER

% **24.12.2024**

I.A. 49751/2024 (Exemption from filing original, certified, translated and clearer copies of dim/ dark documents with left side margins)

1. The present is an application under Section 151 of the Code of Civil Procedure, 1908 ("CPC"), on behalf of the plaintiffs, seeking exemption from filing original, certified, translated and clearer copies of dim/ dark documents with left side margins, electronic documents, etc.
2. Exemption is granted, subject to all just exceptions.
3. Plaintiffs shall file original, certified, translated and clearer copies of dim/ dark documents with left side margins, electronic document, on which the plaintiffs may seek to place reliance, before the next date of hearing.
4. Accordingly, the present application is disposed of.



I.A. 49750/2024 (Exemption from undergoing Pre-Institution Mediation)

5. The present is an application under Section 12A of the Commercial Courts Act, 2015, read with Section 151 of CPC, seeking exemption from undergoing Pre-Institution Mediation.

6. Having regard to the facts of the present case and in the light of the judgment of Supreme Court in the case of *Yamini Manohar Versus T.K.D. Keerthi*, 2023 SCC OnLine SC 1382, and Division Bench of this Court in *Chandra Kishore Chaurasia Versus RA Perfumery Works Private Ltd.*, 2022 SCC OnLine Del 3529, exemption from attempting Pre-Institution Mediation, is granted.

7. Accordingly, the application stands disposed of.

I.A. 49752/2024 (Exemption from advance service to the defendant)

8. The present is an application under Rule 22 of Delhi High Court Intellectual Property Rights Division Rules, 2022 read with Section 151 CPC, seeking exemption from advance service to the defendant.

9. The plaintiffs seek urgent interim relief, and have also sought appointment of a Local Commissioner. Therefore, in the peculiar facts and circumstances of this case, exemption from effecting advance service upon the defendant, is granted.

10. For the reasons stated in the application, the same is allowed and disposed of.

I.A. 49753/2024 (Application seeking extension of time for filing Court Fees)

11. The present application has been filed under Section 149 read with Section 151 of the CPC, seeking extension of time to file the Court Fees.



12. Learned counsel appearing for the plaintiffs submits that the Court fees shall be deposited within a period of two weeks, from today.

13. Liberty is so granted.

14. With the aforesaid directions, the present application is disposed of.

CS(COMM) 1196/2024

15. Let the plaint be registered as suit.

16. Upon filing of the process fee, issue summons to the defendant by all permissible modes. Summons shall state that the written statement be filed by the defendant within thirty days from the date of receipt of summons. Along with the written statement, the defendant shall also file affidavit of admission/denial of the plaintiffs' documents, without which, the written statement shall not be taken on record.

17. Liberty is given to the plaintiffs to file replication within thirty days from the date of receipt of the written statement. Further, along with the replication, if any, filed by the plaintiffs, an affidavit of admission/denial of documents of the defendant, be filed by the plaintiffs, without which, the replication shall not be taken on record. If any of the parties wish to seek inspection of the documents, the same shall be sought and given within the timelines.

18. List before the Joint Registrar (Judicial) for marking of exhibits, on 21st February, 2025.

19. List before the Court on 21st May, 2025.

I.A. 49748/2024 (Application under Order XXXIX Rules 1 and 2 read with Section 151 CPC)

20. The present suit has been filed for permanent/ perpetual injunction, infringement, of design, trademark, copyright, passing off, delivery up,



rendition of accounts, damages, etc.

21. It is submitted that the present suit has been instituted by the plaintiffs to *inter-alia* restrain the defendant from manufacturing, packaging and offering for sale bottles disguised as the plaintiffs' genuine products, which are identical, fraudulent and an obvious imitation of the plaintiffs' unique and novel registered design nos. 311300 and 311301 dated 25th October,



2018 / sold under the trademark "HERO", specifically under the brand name HERO GENUINE OIL with its unique label. The present suit has also been filed so as to prevent the defendant from making use of the trade mark "HERO", "HERO GENUINE OIL" as well as the unique packaging which is on the aforesaid bottle of oil of the plaintiff that infringes the plaintiffs' trade mark HERO and the copyright subsisting in the original artistic work of the packaging and further leads to passing off of the defendant's products as that of plaintiffs.

22. It is submitted that the plaintiffs are group companies and plaintiff no. 1 is engaged in the business of manufacturing and selling motorcycles, scooters and their parts and accessories under the trademark 'HERO' since April 9, 1985. Since the dissolution of the joint venture and consequently company name change, plaintiff no. 1 continued its business under its new trade name Hero MotoCorp and the well-known trademark 'HERO'. Plaintiffs also use label and device marks



for its diverse range of its products which include auto parts of motorcycles and scooters as well as lubricant oil and engine oil under its much renowned sub-brand name **HERO GENUINE ENGINE OIL**. The said trademark '**HERO**' is well known, and reputed in the automotive industry and associated exclusively with plaintiffs and their products.

23. It is submitted that the plaintiff no. 2 has continuously, uninterruptedly and extensively using the HERO TRADEMARKS, devices and label attached to it for more than 60 years in India and globally and therefore, the consumers now exclusively identify and associate the said marks, devices and label as originating solely from the plaintiff. The said mark HERO has been protected by plaintiff no. 2 through a plethora of registrations in several countries across the globe. The trademark HERO, both as a word and its various artistic representations, has been registered by plaintiff no.2 in India. Plaintiff no.2 currently owns over 2,000 registrations/applications for registrations of mark HERO in 121 countries across the world. The details of the registrations of the HERO trade marks in favour of the plaintiffs, are given as under:



Trademark	Class	TM Application no.	Date of Registration	Valid upto
HERO (word mark)	4	2205777	15.09.2011	15.09.2031
HERO (word mark)	12	235780	13.06.1966	13.06.2028
 (H device)	9, 12, 16, 25, 35, 36, 37, 4, 42	2191293	16.08.2011	16.08.2031
 (Device Mark)	9, 12, 16, 25, 35, 36, 37, 41, 42 and 99	2191294	16.08.2011	16.08.2031

 (Device Mark)	4	2314273	12.04.2012	12.04.2012
 (H device)	4	2314274	12.04.2012	12.04.2032

24. It is submitted that plaintiffs are the registered owners of the artwork



of the unique device and label. Further, plaintiffs own the exclusive



rights in the artwork of the device, and by virtue of Copyright Act, 1957, holds all the exclusive rights to its use on all its products, as a result of



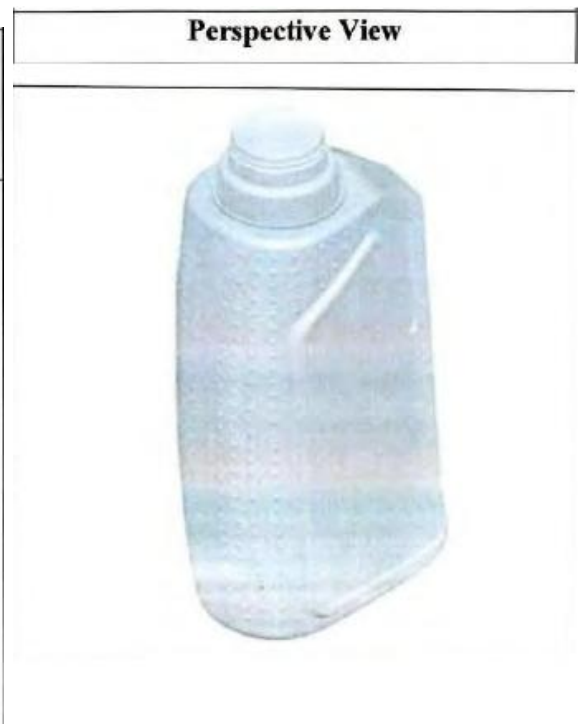
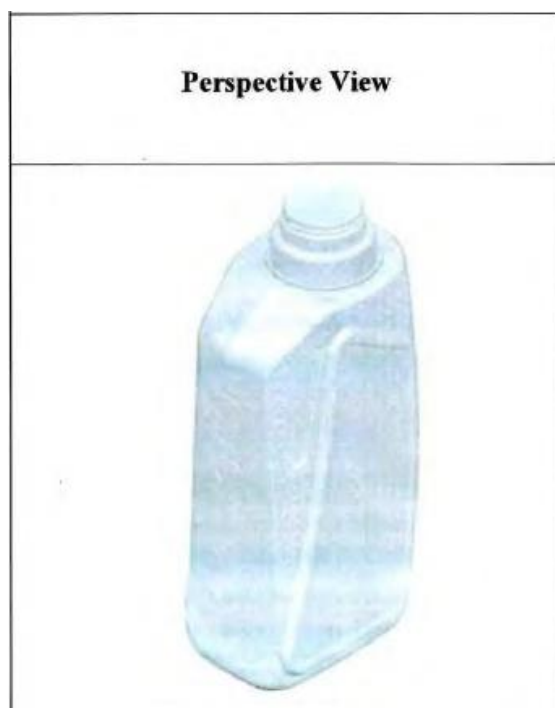
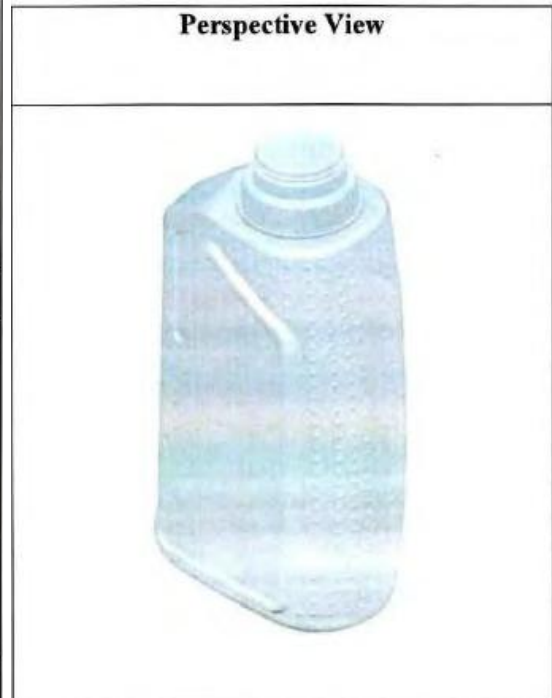
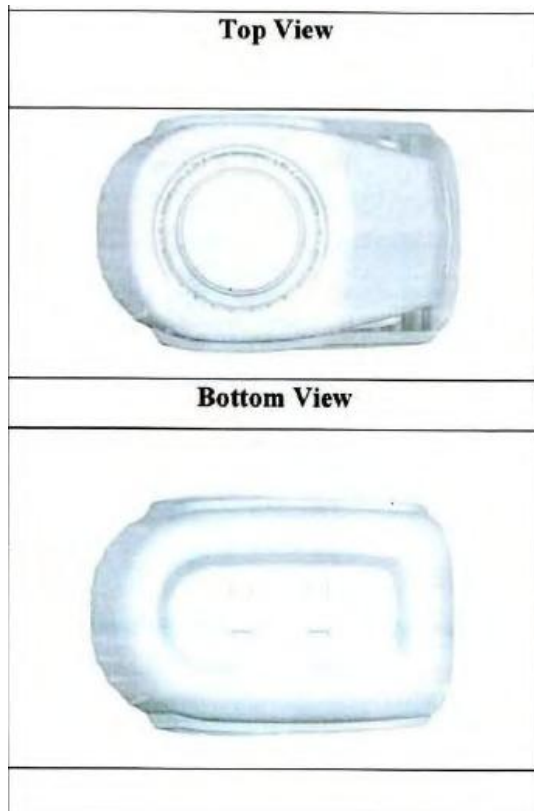
which, its wide customer base exclusively associates the original artwork with plaintiffs' high-quality products including spare parts of two-wheelers, lubricant oils and engine oils.

25. It is submitted that the plaintiff no. 1 for the manufacture and sale of its premium quality products of engine lubricant oil under its sub-brand HERO GENUINE OIL created its novel bottle designs with an eye-catching configuration and features that make it easy for its customers to associate its products with the plaintiff and in the year 2018 got the same registered in order to secure its intellectual property rights of the same.

26. It is submitted that the suit designs are inherently crucial to the plaintiffs' flagship product, i.e., engine oil / automotive lubricant. For the very reason the plaintiffs' HERO GENUINE ENGINE OIL is sold in distinctive, unique bottles /containers with its trademarks prominently displayed on its distinguishing label. The bottles consist of a unique shape with a variety of novel features which distinguish it from other products of similar category. In order to protect its intellectual property rights in the suit designs, plaintiff filed two design applications bearing nos. 311300 and 311301 on 25th October, 2018. Accordingly, the plaintiff owns valid and subsisting design registrations in its products, the details of which are as follows:



DESIGN REGISTRATION NO. 311300	Rear View
Front View 	
Left View 	Right View 





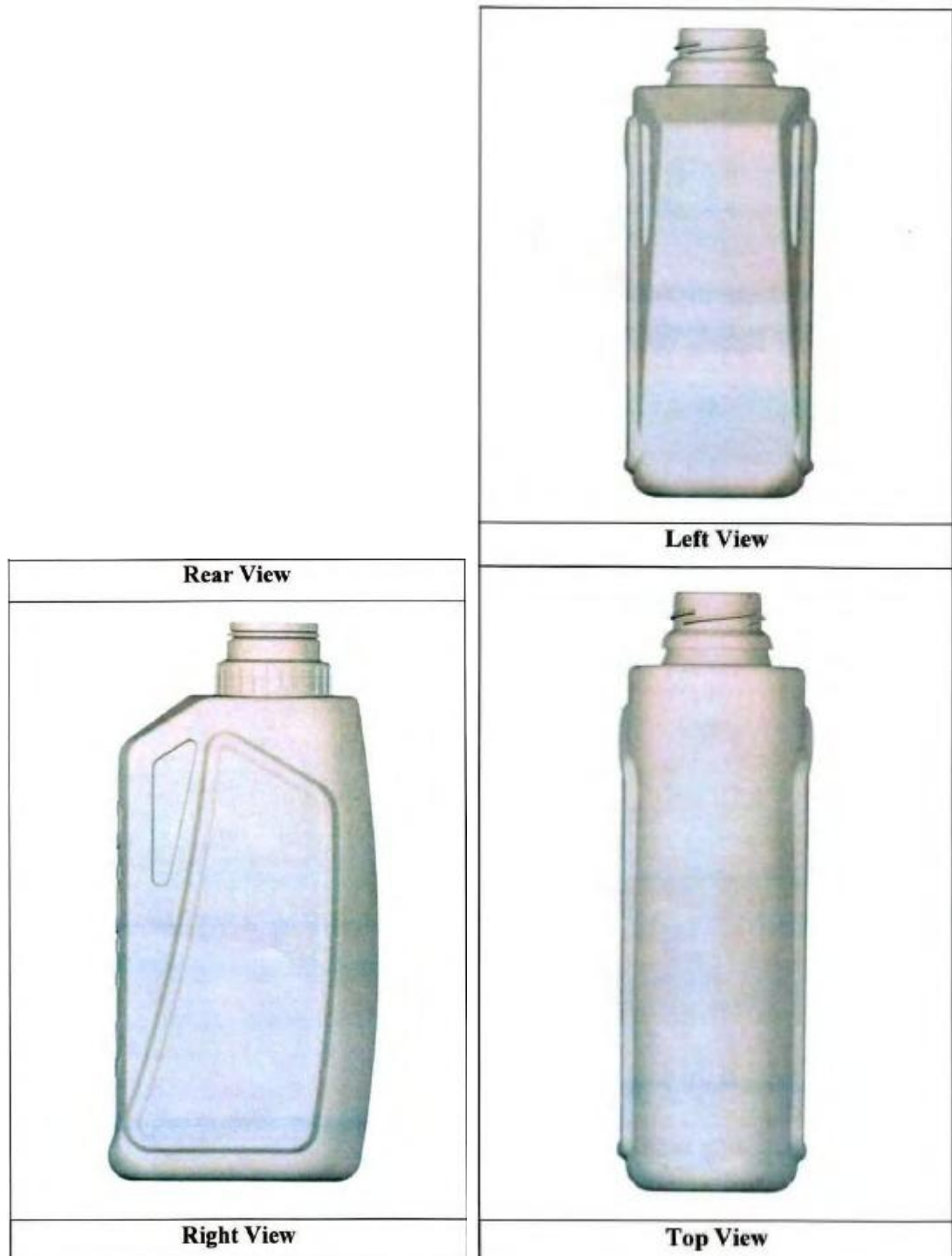
Perspective View

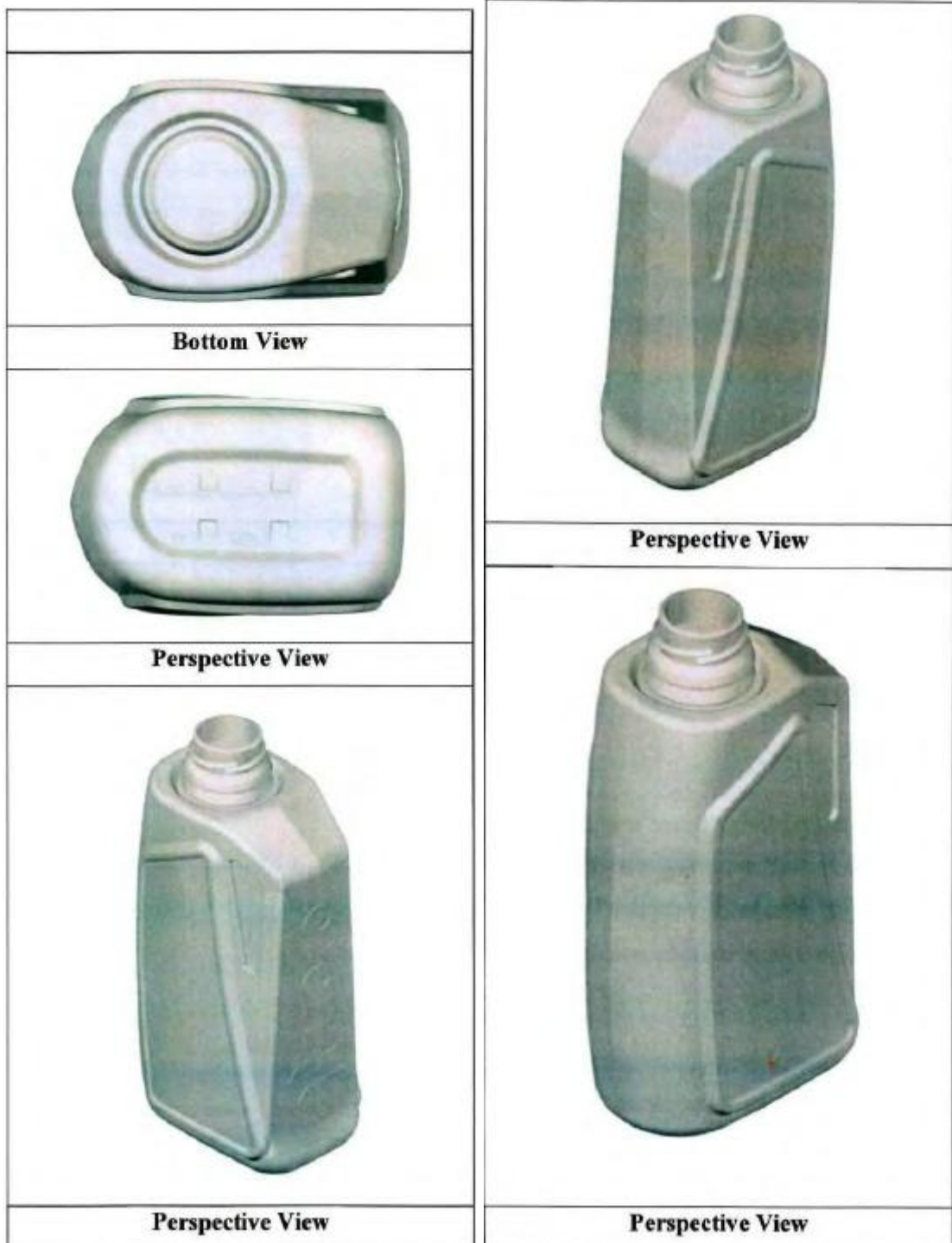


DESIGN REGISTRATION NO. 311301

Front View









27. It is submitted that the plaintiffs have been continuously and exclusively using the suit designs and being the registered owner of these designs, the plaintiffs hold the sole and exclusive right to their use, unless specifically permitted, assigned, or authorized by the plaintiffs. Therefore, any unauthorized use or clear imitation of the registered designs by any third party, other than the plaintiffs, constitutes an infringement of the plaintiffs registered designs and the copyright associated with the label attached to the designs.

28. It is submitted that the plaintiffs' 'HERO GENUINE OIL', is sold in its distinctively designed bottles and holds a significant position in the plaintiffs' premium product line-up and enjoys great popularity among consumers, contributing substantially to the plaintiffs' overall revenue which has crossed the mark of Rs.29,802.30 in the financial year 2021-2022.



Consumers widely associate the product with its unique bottle design and attached label, with its success further linked to the strong reputation and goodwill the plaintiff enjoys under the 'HERO' brand. The plaintiffs' esteemed position in the industry stems from its commitment to excellence and leadership, setting it apart through its experience, expertise, innovation, and drive for excellence.

29. It is submitted that the distinctive bottle design used by the plaintiffs for its 'HERO GENUINE OIL' has become a focal point of premium products associated with the plaintiffs in its market segment. The design is so unique that it has gained a secondary meaning, with the general public widely associating the bottle design exclusively with the plaintiffs, its products, and its business, and not with any other entity.

30. It is submitted that the HERO lubricant oil bottles are especially designed by the plaintiffs after extensive efforts in terms of research and development, and substantial amounts have been invested by the plaintiffs in developing the same. The plaintiffs' products and its design not only meet all safety standards but also look aesthetically pleasing to the eyes and are a rage amongst its customer base due to its unique design and novel features. As a result of the promotional activities undertaken by the plaintiffs and the superior quality of its products, plaintiffs' original designs relating to its products enjoy an unmatched reputation and goodwill throughout India.

31. It is submitted that the defendant in the present suit is unidentified entity/entities and is carrying out the business of manufacturing and packaging plastic bottles of various kinds as well as bottle caps for usage in different industries like engine oil. From the investigation carried out by the plaintiffs, it has become evident that the defendant has a place of business at



112/A, M.G. Road, Kolkata - 700007 India.

32. It is submitted that the plaintiffs in the second week of December 2024 came across the defendant's products being sold in Kolkata bearing identical design to the plaintiffs' registered suit designs for its lubricant oil bottles under its sub-brand HERO GENUINE OIL.

33. It is submitted that the plaintiffs were disturbed to discover that the products being sold by the defendant were identical imitations of plaintiffs' rightfully owned suit designs bearing no. 311300 and 311301, which the plaintiffs exclusively uses to sell its lubricant engine oils under the sub-brand HERO GENUINE OIL. In addition, the said impugned bottles bear the identical HERO GEUINE OIL labels of the plaintiffs as well as the



plaintiffs' registered HERO trademark and device.

34. In order to reach the very depth of defendant's infringing activities, the plaintiffs hired an investigating team who determined that the defendant is running their business from its manufacturing unit and is manufacturing and selling plastic bottles and lubricant oil products in an unauthorized and illegal manner and is brazenly indulging in design, copyright and trademark infringement activities all over Kolkata on a large scale and there is credible and imminent threat that the defendant is supplying the said impugned products all across India, including within the jurisdiction of this Court.

35. It is submitted that the plaintiffs' investigator requested to provide a few bottles to him as samples, including that of the design of HERO GENUINE OIL on which he was provided with the same. Photograph of the



sample bottle is as under:



36. It is submitted that no invoice for the purchase of the above samples was issued to the investigator, which indicates that the defendant is operating in a clandestine manner in order to avoid attracting legal action for its infringing and counterfeiting activities.

37. It is submitted that a comparison of the plaintiff's HERO GENUINE OIL bottle with the defendant's impugned product, will show that the look and feel of the products is such that an unwary customer with an imperfect memory and average intelligence is bound to get confused as to the source of the products. The plastic mould identical to plaintiffs' suit design is being sold by the defendant in the lubricants oil market, a sizable portion of which



39. It is submitted that the defendant is not an authorised dealer of the plaintiffs and has never been in any such capacity vis-a-vis the plaintiffs. The plaintiffs diligently maintains an extensive record of all its authorized dealers, vendors, stockiest and representatives in the due course of business and therefore, when the plaintiffs came across the defendant's infringing activities, they were shocked to discover the depth of defendant's malicious acts given that the defendant has never been associated with the plaintiffs in any capacity.

40. It is submitted that the defendant is neither the registered owner nor has obtained any license or written permission to use the plaintiffs' registered designs for its 'HERO GENUINE OIL' bottles. The defendant's bottle design is a clear imitation of the plaintiffs' registered designs. This is evident when the designs are viewed from any angle-front, back, or side as they appear identical. The defendant has replicated not only the surface pattern but also the shape and configuration of the plaintiffs' registered designs. Consequently, this unauthorized use of the bottle shape, design, and surface pattern constitutes infringement of the plaintiffs' registered designs under section 22 of the Designs Act, 2000.

41. It is submitted that the plaintiffs' rightfully owned HERO trademarks with a history of more than 60 years are exclusively associated with plaintiff's products and services and that defendant's applying of the mark identical to the infringing bottles bearing suit designs, are part of defendant's *malafide* efforts to dilute the plaintiffs' mark.

42. It is submitted that the defendant is in no way associated with the plaintiffs' companies and is neither the authorized manufacturer of HERO GENUINE OIL bottles, nor associated with the plaintiffs through any other



trade channels and that the first time plaintiffs came across the defendant was in first week of November, 2024, when plaintiffs' sale representatives came across the defendant's infringing activities.

43. It is submitted that the plaintiffs are under the credible and imminent threat of the Delhi markets being flooded with the impugned products of the defendant bearing the plaintiffs' suit registered designs and under the



plaintiffs' HERO trademark and device which has a direct and brazen reference to plaintiffs' distinctive renowned products under its sub-brand HERO GENUINE OIL, as the same have been associated with the plaintiffs by all segments of the society not only in India but across the globe due to the sheer superiority of the plaintiffs' lubricant oil product in the market.

44. It is submitted that the defendant is also engaged in printing label / artworks similar to that of the plaintiffs, which is affixed on the suit design bottle. The representation of the said label of the plaintiffs is as given under:

Front Side of artwork	Back side of artwork





45. It is submitted that the said labels are the original artistic work of the plaintiffs within the meaning of Section 2 (c) of the Copyright Act, 1957.

46. It is submitted that the bare glance at the defendant's impugned product is enough to establish that defendant has deliberately adopted an identical shape, configuration, surface pattern, appearance, trade dress and even the identical trademark in relation to the identical goods, with the dishonest intention of earning illicit profits by way of misleading other traders, customers and public at large into believing that there exists some business association or nexus between plaintiffs and defendant, when none exists.

47. It is submitted that the defendant's use of an identical bottle design for its engine oil products cannot be a mere coincidence and clearly demonstrates bad faith. Moreover, since the defendant operates in the same industry, it is evident that they are fully aware of the plaintiffs, its lubricant oil product, and the unique and distinctive bottle designs and labels associated with it.

48. It is submitted that the defendant is applying the plaintiffs' artistic work of its HERO label upon their impugned products in order to pass off the impugned products even more convincingly and with a higher degree of deception. This increases the degree of damages to the plaintiffs monumentally, as the public of average intelligence is bound to confuse the defendant's inferior quality goods as that of plaintiffs' superior quality goods.

49. It is submitted that the defendant is, therefore, besides indulging in design, trademark and copyright infringement employing unfair trade practices and causing unfair competition in the market by selling bottles of



lubricant oil identical to that of plaintiffs' HERO GENUINE OIL bottles, which is rightfully owned and registered in the name of the plaintiffs.

50. In view of the above circumstances, the plaintiffs have demonstrated a *prima facie* case for grant of injunction and in case no *ex-parte ad-interim* injunction is granted, the plaintiffs will suffer an irreparable loss. Further, the balance of convenience also lies in favour of the plaintiffs and against the defendant.

51. Accordingly, till the next date of hearing the defendant, its proprietor or partners, its associates and agents, officers, employees, distributors, franchisees, representatives and assigns are restrained from manufacturing, trading, supplying, selling, marketing, in any manner, including, online sale or dealing in any other way, any goods and/or any other product which is identical and/or obvious fraudulent imitation of the suit designs, namely design no. 311300 and 311301 dated 25th October, 2018, thereby, infringing plaintiff no.1's registered suit design.

52. Further, the defendant is also restrained from dealing in any goods and/or any other product, including, accessories under the plaintiffs' HERO trademarks, including the device marks or any other mark/ logo which is identical and similar to the plaintiffs' HERO trademarks and or device marks, which may amount to infringement of the plaintiff no.2's registered trademarks.

53. Further, the defendant is also restrained from trading in any similar/ identical packaging, including the device marks or any other mark/ logo/ labels/ artistic work, which are identical and similar to the plaintiffs' HERO logo, labels, packaging and/or artistic work, which may amount to infringement of the plaintiffs' trademark rights and copyright, passing off.



54. Issue notice to the defendant by all permissible modes upon filing of process fee, returnable on the next date of hearing.
55. Let reply be filed within a period of four weeks.
56. Rejoinder thereto, if any, be filed within two weeks, thereafter.
57. Compliance of Order XXXIX Rule 3 CPC, be done within a period of three weeks, from today.
58. Re-notify on 21st May, 2025.

I.A. 49749/2024 (Application for appointment of Local Commissioner)

59. The present application has been filed on behalf of the plaintiffs under Order XXVI Rules 9 and 10 read with Order XXXIX Rule 7 read with Section 151 CPC, seeking appointment of a Local Commissioner.
60. It is submitted that in order to preserve evidence of infringement, it is necessary that a Local Commissioner be appointed to visit the premises of the defendant.
61. Accordingly, the following directions are issued:
 - i. Mr. R.K. Baudh, Advocate (Mob. No. 8744006497), is appointed as a Local Commissioner, with a direction to visit the following premises of the defendant:-
**112/A, M.G. Road,
Kolkata-700007
West Bengal, India**
 - ii. The learned Local Commissioner, along with a representative of the plaintiffs and its counsel, shall be permitted to enter upon the premises of the defendant mentioned hereinabove, or any other location/premises, that may be identified, during the course of commission, in order to conduct the search, and seize the products, packaging, labels, printing materials, etc.,



bearing the infringing trademark and its labels.

iii. After seizing the infringing material, the same shall be inventoried, sealed, and signed by the learned Local Commissioner, in the presence of the parties, and released on *superdari* to the defendant, on its undertaking to produce the same, as and when further directions are issued, in this regard.

iv. The learned Local Commissioner shall also be permitted to make copies of the books of accounts, including ledgers, cash books, stock registers, invoices, books, etc., in so far as they pertain to the infringing products.

v. Further, the learned Local Commissioner shall be permitted to undertake/arrange for photography/videography of the execution of the commission.

vi. Both the parties shall provide assistance to the learned Local Commissioner, for carrying out the aforesaid directions.

vii. In case, any of the premises are found locked, the learned Local Commissioner shall be permitted to break open the lock(s). To ensure an unhindered and effective execution of this order, the Station House Officer (“SHO”) of the local Police Station, is directed to render all assistance and protection to the Local Commissioner, as and when, sought.

viii. The fee of the learned Local Commissioner, to be borne out by the plaintiffs, is fixed at ₹2 Lacs (Rupees Two Lacs). The plaintiffs shall also bear all the expenses for travel/lodging of the Local Commissioner, and other miscellaneous out-of-pocket expenses, for the execution of the commission. The fee of the Local Commissioner shall be paid in advance by the plaintiffs.

ix. The local commission shall be executed within a period of two weeks



from today. The Local Commissioner shall file the report within a period of two weeks from the date, on which the commission is executed.

62. The order passed today, shall not be uploaded for a period of two weeks.

63. The present application is accordingly disposed of in the aforesaid terms.

64. *Dasti* under signatures of the Court Master.

MINI PUSHKARNA, J

DECEMBER 24, 2024/kr