



2024 : DHC : 2868



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

% Reserved on : 21st March 2024

Pronounced on : 8th April 2024

+ **C.O. (COMM.IPD-TM) 165/2023 & I.A. 11129/2023**

KAIRA DISTRICT COOPERATIVE MILK PRODUCERS UNION
LTD & ANR. Petitioners

Through: Mr. Vishal Nagpal, Advocate.

versus

D N BAHRI TRADING AS THE VELDON CHEMICAL AND
FOOD PRODUCT & ANR. Respondents

Through: Mr. Ajayinder Sangwan, Mr.
Devendra Singh, Mr. Siddharth Gill
and Mr. Smit Singh Kuru, Advocates
for Respondent no.1.

Mr. Harish Vaidyanathan Shankar,
CGSC, Mr. Srish Kumar Mishra,
Mr. Alexander Mathai Paikaday,
Mr. Lakshay Gunawat and Mr.
Krishnan V. Advocates for
Respondent no.2

CORAM:
HON'BLE MR. JUSTICE ANISH DAYAL
JUDGMENT

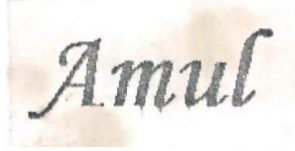
1. This rectification petition has been filed *inter alia* under Sections 47 and 57 of the Trade Marks Act, 1999 (hereinafter referred to as “**the Act**”) by the petitioner/society against respondent no.1 seeking rectification of the



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Register of Trade Marks by removal of respondent no.1's trademark



registered under no. 1182469 in Class 32 (hereinafter referred to as “**impugned mark**”). Petitioner claims rights in the trademark ‘AMUL’, in the word mark, as well as, various other device marks and formative marks. Petitioner further claims that it is a well-known trademark, as has been declared so in 2011.

Submissions on behalf of Petitioner

2. Petitioner no.1 is a Co-operative Society originally registered under Bombay Co-operative Societies Act, 1925, having its registered office at Amul Dairy Road, Anand 388 001, Gujarat. The former name of petitioner no.1 was Anand Milk Union Limited and therefore, ‘AMUL’ was adopted as the trademark, being an acronym thereof. The trademark ‘AMUL’ has since then found a distinctive place in Indian history, tracing its roots back to 1946 when petitioner was registered; 1955 when the first milk processing plant was inaugurated by the first Prime Minister of India, Late Pandit Jawaharlal Nehru; 1964 when AMUL’s Cattle Feed Plant was inaugurated in Anand, Gujarat; and subsequently when the Co-operative became the centre-piece of ‘Operation Flood’ or the ‘White Revolution’ making India one of the leaders in milk production on global stage.

3. Petitioner no.1 avers that it had initially consented and allowed other Co-operative unions in Gujarat to use the brand name ‘AMUL’, in the spirit



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of cooperation and goodwill, and to symbolize the Co-operative dairy movement amongst farmers. Later it was realised that with the growing business, it was commercially unwise to market their products with individual brands, and an all-India entity was needed to market the Co-operative's products. This led to the formation of Gujarat Co-operative Milk Marketing Federation Limited (*Petitioner no. 2*) in 1973 under the Gujarat Co-operative Societies Act, 1969.

4. Petitioner no.1 and petitioner no. 2 entered into a license agreement on 12th January, 2001 to record their understanding, where petitioner no.2 was allowed uninterrupted use and management of petitioner's trade mark 'AMUL' and its variants.

5. The word AMUL has since become a part of Indian household use and is claimed to be a much-loved icon of modern India particularly with its depiction of a girl in a polka dot dress (*known informally as the AMUL girl*). The promotional and advertising campaign has also involved very visible public messaging, often 'tongue-in-cheek', on print ads and billboards.

6. In this background, counsel for the petitioners states that 'AMUL' is not an ordinary trademark but a very important identifier of goods. The first registration obtained by the petitioners was in class 5, the date of application being 16th July, 1966 with user claim from 15th February, 1956 in the device

Amul

mark .

7. As regards class 32 in which the impugned mark is registered, registration was obtained by petitioner on 9th August, 2005; date of



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application being 20th July, 1998 on a 'proposed to be used' basis. This



device mark as registered under class 32 was as under:

8. A more comprehensive list of registrations that the petitioners claim in their favour, is provided in a table filed with the petition, which is reproduced as under:

| Sr. No. | Regd. Trade Mark No. | Date | Class | Trade Mark |
|---------|----------------------|------------|-------|--|
| 1. | 185698 | 01-07-1958 | 29 | Amul |
| 2. | 225905 | 11-12-1964 | 31 |  अमूल |
| 3. | 236457 | 16-07-1966 | 05 | Amul |
| 4. | 238403 | 24-10-1966 | 05 | अमूल |
| 5. | 238404 | 24-10-1966 | 29 | अमूल |
| 6. | 240391 | 06-02-1967 | 05 | Amulspray |
| 7. | 240392 B | 06-02-1967 | 05 | अमूलस्प्रै |
| 8. | 240393 B | 06-02-1967 | 29 | Amulspray |
| 9. | 240394 B | 06-12-1967 | 29 | अमूलस्प्रै |
| 10. | 262239 | 30-01-1970 | 05 | बाल-अमूल |
| 11. | 262240 | 30-01-1970 | 05 | Bal-amul |
| 12. | 266844 | 10-09-1970 | 29 |  |
| 13. | 270604 | 11-03-1971 | 05 | AMUL (Device) |



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| | | | | |
|-----|--------|------------|----|-----------------|
| 14. | 270605 | 11-03-1971 | 05 | |
| 15. | 270606 | 11-03-1971 | 05 | |
| 16. | 270607 | 11-03-1971 | 05 | |
| 17. | 286348 | 19-09-1972 | 29 | Amul |
| 18. | 286538 | 01-03-1973 | 30 | VITAMUL |
| 19. | 286607 | 12-03-1973 | 30 | Amulick |
| 20. | 287566 | 23-04-1974 | 29 | |
| 21. | 291038 | 22-09-1973 | 29 | |
| 22. | 298678 | 26-08-1974 | 30 | बाल-अमूल |
| 23. | 298679 | 26-08-1974 | 30 | Bal-amul |
| 24. | 298680 | 26-08-1974 | 30 | |



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| | | | | |
|-----|--------|------------|----|---|
| 25. | 299895 | 10-10-1974 | 30 |  |
| 26. | 299896 | 10-10-1974 | 30 |  |
| 27. | 309001 | 06-10-1975 | 30 |  |
| 28. | 309002 | 06-10-1975 | 29 |  |
| 29. | 325172 | 10-05-1977 | 30 |  |
| 30. | 367073 | 04-10-1980 | 29 | FERAMUL [word] |
| 31. | 462367 | 29-10-1986 | 30 |  |
| 32. | 462368 | 29-10-1986 | 30 |  |
| 33. | 462369 | 29-10-1986 | 30 |  |



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| | | | | |
|-----|--------|------------|----|----------------|
| 34. | 462370 | 29-10-1986 | 30 | |
| 35. | 462371 | 29-10-1986 | 30 | |
| 36. | 464144 | 05-12-1986 | 29 | |
| 37. | 464897 | 22-12-1986 | 29 | Amul |
| 38. | 469667 | 24-03-1987 | 29 | SoyAmul |
| 39. | 517961 | 06-10-1989 | 30 | Amul |
| 40. | 521816 | 27-12-1989 | 29 | |
| 41. | 521818 | 27-12-1989 | 29 | |
| 42. | 525992 | 12-3-1990 | 29 | |
| 43. | 525994 | 12-3-1990 | 29 | |
| 44. | 525993 | 12-3-1990 | 29 | |



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| | | | | |
|-----|---------|------------|----|--|
| 45. | 667883 | 01-06-1995 | 29 | |
| 46. | 1223349 | 18-08-2003 | 29 | |
| 47. | 1169364 | 27-1-2003 | 29 | |
| 48. | 772625 | 6-10-1997 | 29 | |
| 49. | 845740 | 16-3-1999 | 29 | |
| 50. | 833299 | 21-12-1998 | 29 | |
| 51. | 1221284 | 8-8-2003 | 29 | |



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| | | | | |
|-----|---------|-----------|----|--|
| 52. | 1169357 | 27-1-2003 | 29 |  |
| 53. | 794508 | 10-3-1998 | 29 |  |

9. Trademark ‘AMUL’ was also declared as a well-known trademark by the Intellectual Property Appellate Board (hereinafter referred to as “IPAB”) in 2011. Counsel for the petitioners stated that they have numerous court decisions in favour of petitioners granting protection from infringement /passing off of their registered marks. In particular, attention is drawn to Order of a Single Judge of this Court in *Gujarat Cooperative Milk Marketing Federation Limited & Ors. v. Maruti Metals*, CS (COMM) 343/2021 dated decision 13th August, 2021; *Kaira District Cooperative Milk Producers Union Ltd. v. Bharat Confectionery Works*, 1993 SCC OnLine Del 227 to endorse the submission that ‘AMUL’ has become a household word.

10. Aside from this statutory right flows from registrations, counsel for the petitioners drew attention to the turnover achieved by the petitioner in trademark ‘AMUL’ (as certified by the Chartered Accountant and filed along with the petition). According to the certificate, for the annual financial year-end reports, while the sales were Rs.46,480/- crores in 2021-22, the marketing / promotional expenses were in the range of Rs.1,187/- crores.

11. Grievance was against the impugned mark being registered in favour of the respondent for their application which was filed on 12th March, 2003



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for the category “*MINERAL AND AERATED WATER AND OTHER NON-ALCOHOLIC DRINKS FRUITS DRINKS AND FRUIT JUICES, SYRUPS AND OTHER PREPARATIONS FOR MAKING BEVERAGES*”. The user was however claimed since December, 1957.

12. This, the petitioner’s counsel submits, was dishonest since respondent no.1 had not filed any document at all to show that they had been using the said mark since 1957. Quite to the contrary, the only document which had been filed, in support of respondent no.1’s use, was the trademark certificates and one singular label as represented hereunder which had no detail whatsoever.



13. On this basis, the petitioner's counsel claims that the impugned mark ought to be removed as per Section 47 of the Act for non-use.

14. Reliance was placed on Rule 33 of the Trademark Rules, 2017 which mandated that the Registrar, during examination of a trademark application, shall conduct a search amongst earlier trademarks, either registered or applied for registration. The mandatory nature of this Rule, according to the petitioner’s counsel, ought to have obligated the Registrar to have searched the Register when respondent no.1 had applied for the mark in 2003, and it would have led to discovery of an earlier application filed in 1998 by the





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petitioner.

15. Reliance was placed on a decision of IPAB in *M/S. F K Bearing Machinery Co. Ltd. v. M/s. Modern Machinery Stores*, decision dated 16th December, 2020. Paragraph 28 of the said decision endorses that the Registrar is obligated to cause a search to be made amongst registers / pending marks for ascertaining whether they exist on record identical /similar trademarks to the mark sought to be registered, in respect of identical/similar goods. The relevant paragraph is extracted hereunder for ease of reference.

“28. The grant of registrations of the trade marks by Respondent No. 2 to Respondent No. 1 Applications is against the settled principle of law that under the provisions of Rule 33 of the Trade Marks Rules, 2017 read with Section 11 of the Trade Marks Act, 1999 the Office of the Respondent No. 2 is obliged to cause a search to be made amongst the registered/pending trademarks for the purpose of ascertaining whether there exist on record any earlier identical/similar trademarks to the mark sought to be registered in respect of identical/similar goods and that where the subsequent mark is registered in contravention to the said provisions then the effect of such registrations are liable to be

Cancelled. As stated above, the trade mark FK/  /  is being used by the Applicant in India since the year 1997 and due to such long, continuous and extensive use, the mark is associated solely with the Applicant and none else. No other trader can therefore register the mark in their name. The registration of the marks in the name of Respondent No. 1 should therefore have been refused by the Respondent No. 2 as the same is against the law of passing-off.”

(emphasis supplied)



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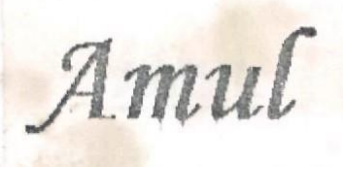
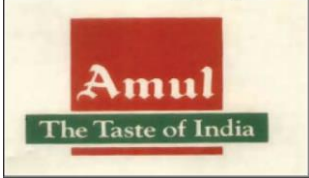


16. For the purposes of rectification, other grounds were pleaded *inter alia* under Sections 9 (1) (a), 9 (2) (a), 11(1) (a), 11 (3) (a), 18 (1) of the Act.

17. As regards respondent no.1’s assertion that the petitioner had failed to oppose the said mark, reliance was placed on a decision of Single Judge of this Court in *Fybro Electric Pvt. Ltd. v. Mukesh Singh & Anr.*, 2023 SCC OnLine Del 2948, (2023:DHC:3484) where it has been held that “*inaction in opposing the application filed by the applicant for registration of the impugned mark cannot divest the petitioner of its right to seek rectification of the Register and removal of the impugned mark.*”.

Submissions on behalf of Respondent No.1

18. In response, counsel for respondent no.1 contended that the device mark registered by the petitioner in class 32 was very different, structurally and visually, from the impugned mark AMUL registered by the respondent no.1. The dissimilarity, according to him, was apparent from a comparative representation of both the marks.

| Impugned mark of Respondent no.1 | Petitioner’s Mark |
|---|--|
|  |  |

19. Further it was stated that the category of goods in which petitioner and respondent no.1 operate are different, in that the petitioner’s main products are milk and milk products and not mineral aerated water, as was the category in which respondent no.1’s mark was registered. Further, the



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user was claimed since 1957 which precedes the proposed to-be-used claim made by the petitioner in their application filed in 1988. It was further contended that the petitioner had not shown that they had any product in the market relatable to registration in class 32 and therefore, Section 47 would apply to the petitioner as well, making the mark invalid.

20. Attention was drawn to two other formative marks applied for by



petitioner under class 32 on May 30, 2017 being:



which were also on a ‘*proposed to be used*’ basis.

It would show that even in 2017 the petitioner’s class 32 usage was not existing. The Chartered Accountant Certificate relied upon by petitioner was of sales of product of the Co-operative which was still in the milk business predominantly in class 29. As regards the well-known mark declaration under Section 2 (z) (g) it was only made in 2011 and respondent no.1’s impugned mark was already registered much prior and could not therefore be struck off the Register merely on that basis. Reliance was placed on Section 11(5) stating that no objection had been raised by the petitioner to the registration process. Further reliance was placed on a decision of the Hon’ble Supreme Court in *Nandini Deluxe v. Karnataka Cooperative Milk Producers Federation Limited*, (2018) 9 SCC 183 (decided on July 26, 2018), in particular paragraph no. 26.7 to assert that “*there was a contrast between the device mark and word mark of the*



respondent and the marks were altogether different.” as also on paragraph no. 32 to assert that “if a manufacturer has no bona fide intention to trade in goods and articles falling under the same classification, it should not be allowed to enjoy the monopoly in respect of all the articles in the said classification.”

Submissions in Rejoinder on behalf of the Petitioner

21. Counsel for the petitioner stated that not only is the registration in class 32 subsisting but also there has been no application by respondent no.1 seeking invalidity of the petitioner’s mark and therefore an argument based on Section 47 non-use cannot apply to the petitioner. As regards the category of goods, petitioner’s counsel drew attention to the fact that AMUL was in all kinds of edible products including non-alcoholic drinks, illustrations of which are as under:





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22. Attention was drawn to a fruit drink under the trademark ‘**AMUL tru**’ (*picture reproduced above*) which belongs to the same category of goods in which the impugned mark was registered. Moreover, it was contended that such goods of petitioner and respondent no.1 would be stocked on similar shelves and shops and therefore, the likelihood of confusion is extremely high. Section 11 (5) of the Act applies more to the Registrar while examining the marks and that there was no limitation of time to seek rectification by petitioner. Reference was also made to a decision of the High Court of Calcutta in CS/107/2020 dated 22nd March, 2021, being ***Kaira District Cooperative Milk Producers Union Ltd & Anr. V. Maa Tara Trading Co. And Ors.*** wherein the defendant’s mark was injuncted, where the defendant was using the ‘AMUL’ mark for candles being sold at cake shops and confectioneries.

Analysis

23. To seek rectification of a mark, the petitioner must be able to show that any of the grounds under Sections 9, 11, 47 or 57 of the Act are made out. Without having to draw a comparison with an earlier registered mark, grounds under Sections 9 and 47 of the Act are available to a petitioner to claim that the impugned mark ought not to have been registered on absolute grounds, and if registered, can be removed for reason of non-use. What is striking, in this case, is that respondent no.1 has produced no document whatsoever which would prove their use since 1957, as claimed. There is not a sliver of any documentation, photograph, advertisement, invoice or any other visual or documentary proof to support their assertion that they



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were indeed using the said mark on some goods. The singular picture provided by respondent no.1, as noted in paragraph no.11 above, only shows an ‘**AMUL Leechi fruit drink**’ manufactured by Weldon Chemical and Food Products, which was being operated by respondent no.1. However, there is no detail whatsoever which supports that the said label has been used on products since 1957, or even later. Even assuming that said label would show that such a drink existed in 1957, it would have been an obvious expectation that respondent no.1 places on record any documentation whatsoever in support of the claim that it has continued thereafter, till date. Counsel for respondent no.1, on being confronted with this issue, had nothing to state in response. On this basis alone, the ground of non-use would, in the opinion of this Court, be made out for removal under Section 47 of the Act.

24. Notwithstanding the above, the rectification petition must be assessed on the basis of other grounds as well. It would be difficult to not acknowledge, countenance and recognise the huge, significant, unique reputation, goodwill and continuous use that petitioner has in trademark ‘AMUL’. Not only is the coined word ‘AMUL’ distinctive for the acronym for Anand Milk Union Ltd., but also has been recognized as a well-known trademark in 2011, therefore getting protection across all classes.

25. Respondent no.1’s contention that ‘AMUL’ is a generic word being a short form of the Hindi word ‘*Amulya*’ (“*अमूल्य*”) and therefore, petitioner cannot have dominance over said mark, is untenable, particularly since ‘AMUL’ as a mark has now gained compelling distinctiveness in favour of



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petitioner. Notice is taken of observations of Single Judge of this Court in *Maruti Metals* (*supra*) where an injunction was passed against AMUL Cookware noting that Section 29 (4) of the Act permitted an action for infringement even in respect of dissimilar goods which are deceptively similar to that of petitioner. In this context the Single Judge in *Maruti Metals* (*supra*) stated as under:

7. “The word “AMUL” is distinctive, and has no etymological meaning. It is indelibly associated, in the minds of the consuming public, with the products of the plaintiff. Prima facie, any use of the word “AMUL” as a trademark by any other entity may tantamount to infringement.”

26. Order of the Single Judge in *Bharat Confectionary Works* (*supra*) is also instructive, particularly what is observed in paragraph 12:

“12. Over the years the word ‘AMUL’ has become a house hold word and it has come to denote to the public at large that the food products sold in the market under the said trade mark are manufactured and come from the house of ‘AMUL’ Butter. The plaintiff’s and defendants’ goods are ordinarily purchased by the ladies, which include literate and semi-literate and domestic servants, who in most of the cases are illiterate. Under these circumstances the test of phonetic resemblance assumes even greater importance. Needless to say that there is complete phonetic similarity between the plaintiff’s mark and the mark used by the defendants. For the buyers of the two goods, the phonetic sound of the word ‘AMUL’ is sufficient enough to identify the goods to be those of the ‘AMUL BUTTER PEOPLE’, i.e., the plaintiff. Normally they may not even bother to know or look for the name of the manufacturer on the container. They may ‘AMUL’ Butter. Keeping in view the facts of the present case, particularly the nature of the goods and the trade-mark involved, as also the phonetic similarity in the



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marks used by the plaintiff and the defendants, I feel, the user of the mark 'AMUL' by the defendants would vitally confuse an ordinary purchaser of average intelligence."

(emphasis supplied)

27. There is little doubt that the trademark 'AMUL' has gained a wide, expansive, comprehensive and nation-wide reputation and products of 'AMUL', which have gone far beyond milk and milk products are available not only in shops and retail stores, but also in shops which are operated or franchised by AMUL, selling 'AMUL' products exclusively. The mark 'AMUL' has therefore acquired huge, undiluted, enduring significance and is relatable to source of goods of petitioners. Also its protection would transcend all classes having been declared a well-known mark.

28. In particular as regards class 32, it is an admitted position that the application by the petitioner was made in 1998 in the device mark though it was granted in 2005. Respondent no.1's application made in 2003 was therefore preceded by more than 5 odd years by a prior application of the petitioner. This, as rightly contended by counsel for petitioner, would have been thrown up in a search by the Registrar, as mandated under Rule 33 of the Trademark Rules. Rule 33 is prefaced by 'shall' and is therefore mandatory and also directs the Registrar to search not only the registered marks but also those that have been applied for. Not only that, the mark 'AMUL' had a reputation since much before 1998 and it was incumbent upon the Registrar to have taken notice of the many registered marks in various classes as is evident from the tabulation, reproduced in paragraph no.8 above.



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29. For respondent no.1 to contend that the registration of petitioner in class 32 was a device mark and different from a simple word registration of impugned mark, is quite specious, infirm, and untenable. For the simple reason that, ‘AMUL’ was a predominant aspect of the petitioner’s registered mark with only a by-line stating “*The Taste of India*”. Further the word mark ‘AMUL’ had been registered since 1956 in other classes, as also various families of marks, both word and device, in relation to ‘AMUL’.

30. Regards respondent no.1’s contention of different goods, this Court does not find any merit in the said submission for the reason that the category of goods in which impugned mark has been registered includes mineral and aerated water and other non-alcoholic drinks along with fruit drinks and fruit juices. The AMUL range of products is large and expansive, and as shown by petitioner’s counsel, includes the ‘AMUL tru’ drinks as well, aside from other drinks.

31. On these grounds alone Section 11 (1) and (2) of the Act would be made out, triggering removal of the impugned mark from the Register. Aside from that, the possibility of application of law of passing off is also protected under Section 11 (3) (a) of the Act. Even on this account, applying the triple test enunciated in various decisions, for assessing passing off, the ‘AMUL’ mark of the petitioner would pass muster in relation to the defendant’s impugned mark.

32. Additionally, as per *Hardie Trading Ltd. v. Addisons Paint & Chemicals Ltd.*, (2003) 11 SCC 92 the triple test to be satisfied for removal of a mark was laid down as under:



“26. Thus before the High Court or the Registrar directs the removal of the registered trade marks they must be satisfied in respect of the following:

- (1) that the application is by a “person aggrieved”;*
- (2) that the trade mark has not been used by the proprietor for a continuous period of at least five years and one month prior to the date of the application;*
- (3) there were no special circumstances which affected the use of the trade mark during this period by the proprietor.*

27. The onus to establish the first two conditions obviously lies with the applicant, whereas the burden of proving the existence of special circumstances is on the proprietor of the trade marks. These conditions are not to be cumulatively proved but established seriatim. There is no question of the third condition being established unless the second one has already been proved and there is no question of the second one even being considered unless the High Court or the Registrar is satisfied as to the locus standi of the applicant.”

33. Accordingly, in view of the above analysis and discussion, this rectification petition is allowed. The impugned mark bearing no. 1182469 under Class 32 be removed from the Register. The Register may accordingly be rectified and the website of the Registrar of Trademarks be updated.

34. Registry to supply a copy of the present order to Trade Mark Registry at llc-ipo@gov.in for compliance.

35. These directions be carried out within 4 weeks after this judgment is pronounced.

36. Petition stands disposed of with these directions.

37. Pending applications, if any, also stand disposed of as infructuous.



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38. Judgment be uploaded forthwith on the website of this Court.

ANISH DAYAL, J.

APRIL 8, 2024/sm