

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

% **Date of Decision: May 11, 2023**

+ **RFA(OS)(IPD) 3/2023 & CM APPL. 23932-23933/2023**

SAVITA OIL TECHNOLOGIES LIMITED **Appellant**

Through: Mr. Ramesh Singh, Sr. Adv. with Mr. Pratap Venugopal and Ms. Surekha Raman, Advs.

Versus

VALVOLINE LICENSING AND INTELLECTUAL PROPERTY LLC **Respondent**

Through: Mr. Peeyosh Kalra, Mr. Krishna Gambhir and Ms. Simrantjot Kaur, Advocates.

CORAM:

HON'BLE MR. JUSTICE MANMOHAN

HON'BLE MR. JUSTICE SAURABH BANERJEE

J U D G M E N T

SAURABH BANERJEE, J: (ORAL)

1. Ashland Inc. obtained registration of the trademark 'VALVOLINE ALL-FLEET' bearing no. 1373335 in Class 04 dated 18th September, 1984 before the United States Patent and Trademark Office, *however*, with the disclaimer '*No claim is made to the exclusive right to use "All-Fleet" apart from the mark as shown*'. Thereafter, Ashland Licensing and Intellectual Property LLC obtained registration of the trademark 'ALL FLEET' bearing no.639705 in Class 04¹ before the Trade Marks Registry pursuant to a Deed

¹ Hereinafter "*subject mark*"

of Assignment executed in its favour by Ashland Inc. Thereafter, Valvoline Licensing and Intellectual Property LLC-respondent was recorded as the registered proprietor of the said mark pursuant to an Assignment Agreement dated 2nd September, 2016 executed in its favour by the previous registered proprietor, Ashland Licensing and Intellectual Property LLC.

2. Savita Oil Technologies Limited-appellant thence filed a petition under *Section 57* of The Trade Marks Act, 1999² for cancellation of the subject mark 'ALL FLEET' before the learned Single Judge largely contending that the same being descriptive was not registrable under *Section 9(1)(b)* of the Act and being used in a customary manner on account of being common to trade it was in contravention of *Section 9(1)(c)* of the Act also and was thus not registrable.

3. The learned Single Judge, after hearing the parties, vide order dated 27th January, 2023³ dismissed the said rectification petition of appellant. Hence, the present appeal impugning the said order.

4. Of the various grounds raised by the learned senior counsel for appellant before this Court, it was principally contended that the learned Single Judge overlooked the fact that the mark 'ALL FLEET' being highly descriptive was devoid of distinctive character and as such was not registrable under *Section 9(1)(b)* of the Act and that the trademark 'ALL FLEET' was registered as 'VALVOLINE ALL-FLEET' before the United States Patent and Trademark Office in the name of Ashland Inc. with a disclaimer that "*No claim is made to the exclusive right to use "ALL FLEET" apart from the mark as shown*" and further that the trademark

² Hereinafter "*rectification petition*"

³ Hereinafter "*impugned order*"

‘ALL FLEET’ was in contravention of *Section 9(1)(c)* of the Act as it was common to the trade of automobiles and if allowed to remain in the Register, traders like the appellant would be unable to use it. It was also contended that the learned Single Judge erred in giving undue weightage to the order dated 22nd July, 2010 passed by a learned Single Judge of this Court in CS(COMM) 79/2018, wherein, while granting an order of injunction against the appellant herein, the learned Single Judge had expressed his opinion on the validity of registration of the subject mark, and lastly relying upon *Valvoline Cummins Limited v. Apar Industries Limited*⁴ vide which a learned Single Judge of this Court denied injunction with respect to marks of the same appellant, contended that the subject mark was liable to be rectified.

5. Having heard the learned senior counsel for appellant, this Court finds that the subject mark, being a combination of two words ‘ALL’ and ‘FLEET’ independently adopted by the respondent used for lubricating oils in automobiles, does not designate the kind, quality, quantity or like of automobiles. The subject mark is nowhere directly relatable or connected with automobiles. To say that because lubricating oils are used in automobiles, the subject mark is relatable/connected with it will, in the opinion of this Court, be far-fetched. The subject mark cannot be said to be common to the trade or that it indicates of being remotely connected with automobiles. Moreover, in view of this Court, the subject mark is not descriptive as it does not describe the product explicitly.

6. Further, the fact that Ashland Inc. was granted registration of the trademark ‘VALVOLINE ALL-FLEET’ before the United States Patent and

⁴ 2013 SCC OnLine Del 6414

Trademark Office with a disclaimer is of no consequence and cannot come to the aid of the appellant as, *admittedly*, the respondent was thereafter granted registration for the subject mark by the Trade Mark Registry without any disclaimer.

7. A reading of the impugned order reveals that the learned Single Judge, in the opinion of this Court, has thoughtfully and rightly relied upon nothing but the view expressed by the learned Single Judge in the order dated 22nd July, 2010 after duly noting that “... ..*the Court was not examining the question of validity of registration... ..*”. Also, as both proceedings are involving the same parties and are qua the same subject mark, the view expressed in the order dated 22nd July, 2010, *prima facie*, in the opinion of this Court, certainly had a material bearing to those involved before the learned Single Judge. As such, the learned Single Judge cannot be faulted for relying on the view expressed in order dated 22nd July, 2010. Even otherwise, the impugned order reveals that the rectification petition has been dismissed on various other grounds.

8. Lastly, reliance by the learned senior counsel upon *Valvoline Cummins Limited (supra)* is misplaced as the same is pertaining to a case involving a suit for infringement faced by the appellant whereas this Court is dealing with a rectification petition wherein the appellant is the one seeking rectification. Thus, the parameters, legal position and the factual consideration qua both are not same.

9. Hence, the subject mark is not devoid of distinctive character and thus what is mandated in the provisions of either *Section 9(1)(b)* or *Section 9(1)(c)* of the Act cannot come in the way of the registration of the subject mark. This Court, being unable to agree with the contentions raised by the

learned senior counsel, is in agreement with the reasonings given and findings of dismissal of the rectification petition of the appellant returned by the learned Single Judge.

10. Finding no reason to interfere with the impugned order, this Court is of the opinion that the present appeal is bereft of merit. Consequently, the present appeal, along with pending applications, *if any*, is dismissed *in limine*, leaving the parties to bear their respective costs.

SAURABH BANERJEE, J.

MANMOHAN, J.

MAY 11, 2023

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