

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

% Decided on: 28th July, 2017

+ **CS(COMM) 1144/2016**

THE BRITISH BROADCASTING CORPORATION (BBC)

..... Plaintiff

Represented by: Mr. Himanshu Deora, Adv.

versus

MR KULDIP SINGH KALRA & ANR

..... Defendant

Represented by: Ms. Priyanka Anand, Adv.

CORAM:

HON'BLE MS. JUSTICE MUKTA GUPTA

MUKTA GUPTA, J. (ORAL)

IA Nos. 10189/2016 (O.39 R.1 & 2 CPC) & 10191/2016 (O.11 R.4 Comm. Court Act)

In view of the settlement arrived at between the parties, the applications are disposed of as not pressed.

CS(COMM.) 1144/2016

1. By the present suit, the plaintiff had prayed for the following reliefs-
 - a) *a decree of permanent injunction restraining the Defendants, their directors/proprietor/partners, their principals, employees, agents, distributors, franchisees, representatives and assigns from using the impugned marks and any other trade marks or trade name which are deceptively or confusingly similar to the Plaintiff's registered mark BBC in any manner whatsoever without the permission, consent, license of the Plaintiff thereby infringing the rights of the Plaintiff in its registered trade marks amounting to infringement thereof;*

- b) *A decree of permanent injunction restraining the Defendants, their directors/proprietor/partners, their principals, employees, agents, distributors, franchisees, representatives and assigns from using the impugned marks or any other trade mark or trade marks which are deceptively or confusingly similar to the Plaintiff's well-known and world renowned mark BBC, amounting to passing off their goods and businesses as and for the goods and business of the Plaintiff, or in any manner whatsoever, using or incorporating the Plaintiff's well-known mark BBC or any other trade mark which is deceptively or confusingly similar to the Plaintiff's mark BBC and from taking benefit of the reputation and goodwill of the Plaintiff in any manner whatsoever;*
- c) *An order of delivery up be passed thereby directing the Defendants, its directors/proprietor/partners, as the case may be, its principles, employees, agents, distributors, franchisees, representatives and assigns to hand over to the Plaintiff or their nominated representative all goods, packaging and promotional material, catalogues, stationery and any other material whatsoever including labels, signs, prints, packages, moulds, plates, dies, wrappers, receptacles and advertisements in its possession or under its control bearing the impugned marks or any other mark as may be confusingly or deceptively similar to the Plaintiff's mark BBC;*
- d) *A decree in favour of the Plaintiff for recovery of damages to the tune of Rs.1,00,01,000/- (Rupees one crore and one thousand only) as punitive/compensatory damages for committing the illegal activities of infringement of trade mark, passing off & falsification against the Defendants, their directors/proprietor/partners, as the case may be;*
- e) *For an order for rendition of account of profits earned by the Defendants by its impugned illegal trade activities and a decree for the amount so found in favour of the Plaintiff on such rendition of accounts;*
- f) *For an order of costs of the present proceedings including the Court fee affixed and the counsel fee; and*
- g) *Such other further orders as this Hon'ble Court may deem and proper in the facts and circumstances of the present case may also be passed in favour of the Plaintiff and against the defendants.*

2. During the pendency of the suit before the issues could be settled, the parties entered into a settlement before the Delhi High Court Mediation and Conciliation Centre on the following terms and conditions-

“1. The Defendant No. 1 (which term shall hereinafter include their partners, principles, employees, agents, distributors, franchisees, representatives, legal heirs, assigns and successors in business as the case may be, jointly as well as severally) undertakes not to use the Plaintiff’s well-known mark BBC in standalone manner in any manner whatsoever including but not limited to its publications, books, stationary, pamphlets, visiting cards etc. The parties hereby agree that manner of use of the mark BBC by the Defendant No. 1 shall be strictly in accordance with the below terms-

(a) The Defendant No.1 is the registered proprietor of Trade Mark No. 532501 in Class 16. The Plaintiff has no objection to use the label



by the Defendant in the manner as it is registered.

- (b) The following terms are for use of the trade mark **bbc** other than as set out in paragraph 1(a) above:*
- a. The term ‘bbc’ shall always be used in small characters; and*
 - b. The term ‘bbc’ shall always be used and reflected in close conjunction with the terms “BRAJINDRA BOOK COMPANY” i.e. as “bbc BRAJINDRA BOOK COMPANY”; and*
 - c. The font size ratio of the terms ‘bbc’ and ‘BRAJINDRA BOOK COMPANY’ for all purposes shall be of 100:50, subject to condition that the font size of the term ‘BRAJINDRA BOOK COMPANY’ shall never be less than font size 6.*
 - d. Further, it has been agreed between the parties that, for use of the term ‘bbc’ on CD labels, etc., the ratio of ‘bbc’ : ‘BRAJINDRA BOOK COMPANY’ shall be of 100:100, irrespective of the font size; and*
 - e. The terms ‘bbc’ and ‘BRAJINDRA BOOK COMPANY’ shall always be in same font style. For eg. - If ‘bbc’ is bold then ‘BRAJINDRA BOOK COMPANY’ shall also be in bold.*

2. *It is understood by the parties that the letters “bbc” will never be used in isolation and the aforesaid condition so applicable to bbc/Brajindra Book Company would equally be applicable to bbc when used in conjunction with an altogether different trade mark COMPACTA or any other suffix which may be or may not be used by the Defendant No. 1. In other words, both the parties understand that the concern of the Plaintiff is qua the word bbc and the same has been addressed by the Defendant No. 1 by agreeing to not to use bbc in isolation but always in conjunction with Brajindra Book Company. For clarity’s sake, the following conditions are relevant:*
- a. The term ‘bbc’ shall always be used in small characters; and*
 - b. The term ‘bbc’ shall always be used and reflected in close conjunction with Brajindra Book Company; and*
 - c. The font size ratio of the terms ‘bbc’ and Brajindra Book Company for all purposes shall be such that bbc is not more than half the size of the word Brajindra Book Company.*

- d. It is further agreed that the Defendant No. 1 after complying with the aforesaid conditions may seek any registration of the trade mark **bbc Brajindra Book Company** and/or **bbc Brajindra Book Company COMPACTA** or **bbc Brajindra Book Company** with any other suffix.*
- 3. For clarification, it is added that the Defendant No. 1 is fully entitled to use the word COMPACTA in any manner as it deems fit but when used with the **bbc** brand the aforesaid conditions will apply.*
- 4. The Defendant No. 1 hereby undertakes to voluntarily amend its trade mark application bearing no. 2639325 in class 16 for the mark **bbc compacta (stylized)***



within a period of six weeks from the date of signing of this agreement to bring it in conformity with the aforesaid terms. In case, the said amendment is not allowed by the Registrar of Trade Marks, the Defendant No. 1 shall withdraw the said Application No. 2639325 immediately. However, the Defendant No. 1 will be at liberty to file a fresh application as per the terms and condition agreed upon by this AGREEMENT.

5. *The Defendant No. 1 shall immediately cease further publication of the marks impugned in CS (COMM) 1144/ 2016 and agrees not to adopt any identical or similar mark in the future, other than the allowed manner of use as defined herein above. The Defendant No. 1 shall act in good faith. Further, the Defendant No. 1 shall dispose of or sell out the existing stock bearing the impugned marks till 30th June, 2017.*
6. *The Plaintiff hereby agrees that in view of the undertakings by the Defendant No.1 recorded in the present AGREEMENT, it shall not oppose the application(s) if any filed by the Defendant No. 1 hereinafter for the registration of the mark “bbc” in conjunction with ‘BRAJINDRA BOOK COMPANY’, and/or with COMPACTA in conformity with the terms of the present settlement deed. Similarly, the Defendant No. 1 agrees that based on his registration for the mark(s) secured as per the terms of this AGREEMENT, the Defendant No. 1 shall never challenge and/or pose any obstruction for registration and/or use of the well-known trade mark ‘BBC’ and/or any BBC formative marks by the Plaintiff in any jurisdiction and in case, the Defendant No. 1’s such application(s)*

and/or registration(s) are cited as an objection to the Plaintiff's application(s) for its trade mark 'BBC' and its variants, the Plaintiff shall be entitled to rely upon the present settlement before the Registrar of Trade Marks to allow the no objection of the Defendant No. 1 to such registration of the Plaintiff.

GENERAL TERMS

- a) It is both parties' endeavor that the obligations under this Agreement be discharged as expeditiously as possible.*
- b) Each party's obligations hereunder shall terminate forthwith if, when and the extent to which the other party shall have abandoned rights in its marks.*
- c) Non compliance by one party with respect to one or more of its obligations hereunder shall not constitute a breach or violation of this Agreement unless the other party notifies such one party of any such noncompliance in writing and the one party does not cure the non compliance within thirty (30) days of such notice.*
- d) This Agreement may be modified only in writing, signed by the duly authorized representatives of all the parties.*

- e) *All terms and provisions of this Agreement shall be binding upon, shall inure to the benefit of and shall be enforceable by the respective officers, employees, affiliates, heirs, beneficiaries, personal and legal representatives, successors and assigns of the parties.*
- f) *Each party shall, without further consideration, execute any and all additional documents and take such further action as may be requested to effect the terms of this Agreement.*
- g) *Each party shall bear its own cost in regard to the present suit. Further, in the event that the parties engage in a dispute regarding this Agreement in future, each party shall bear its own costs in connection with such dispute.*
- h) *This AGREEMENT is for India only.*
- i) *Neither the failure nor any delay to exercise a right, remedy or privilege under this Agreement shall operate as a waiver thereof, nor shall any single or partial exercise of a right, remedy or privilege preclude any further exercise of the same.*
- j) *In the event of any breach of any of the terms hereof, either actual or threatened, by either party, the other party's remedies at law shall be*

inadequate. In such event, the injured party shall have the right to specific performance and/or injunctive relief in addition to all other remedies at law and/or in equity, and such remedies shall be cumulative.

- k) Subject to compliance with the terms of this Agreement, each party does hereby fully release and discharge the other party from any and all claims, counterclaims, debts and other causes of action relating to the subject matter and arising prior to the Effective Date of this Agreement as well as subsequently which may arise.*
- l) Whenever possible, each provision of this Agreement shall be interpreted in a manner as to be valid under existing law. A finding of invalidity as to any provision of this Agreement or any portion thereof shall void only that provision or portion and no other, and this Agreement shall be interpreted as if it did not contain such invalid provision or portion.*
- m) The individuals signing below on behalf of their respective parties represent that they are fully authorized to execute this Agreement on behalf of the parties on whose behalf they are signing.*

- n) Parties hereby agree that a decree sheet may be drawn up in terms of the above Settlement in CS(COMM) NO.1144/2016.*
- o) The Plaintiff hereby withdrawn the prayer nos.(c), (d) and (3) in the suit in terms of the present full and final settlement.”*

3. The settlement agreement has been signed on behalf of the plaintiff by Shri Naveen Jhunjhunwala, the authorized representative of the plaintiff, authorization in whose favour has been annexed with the proceedings of the Delhi High Court Mediation and Conciliation Centre dated 1st May, 2017 as Annexure ‘A’ at pages 135 to 137 of the paper book and on behalf of defendant No.1 which is the contesting party the settlement agreement has been signed by Mr. Harminder Singh Kalra, special power of attorney in whose favour has been annexed as Annexure ‘B’ at pages 138 to 143 of the paper book. The settlement proceedings were also signed by respective counsel of the parties.

4. As per clause (4) of the terms of settlement, defendant No.1 had undertaken to amend its trademark application bearing No.2639325 in class 16 within a period of six weeks from the date of signing of the agreement. Learned counsel for defendant No.1 submits that defendant No.1 was under the impression that after the agreement is taken on record by this Court, the application was to be amended. Learned counsel on instructions states on behalf of defendant No.1 that an application seeking amendment of the trademark application bearing No.2639325 in class 16 for the mark bbc compacta (stylized) will be filed within two weeks from today. Copy of the

application seeking amendment will be supplied to learned counsel for the plaintiff within two weeks thereafter.

5. In view of the settlement arrived at between the parties, the suit is decreed as per the settlement. The decree sheet will incorporate the terms of settlement arrived at between the parties. Since the parties have entered into a settlement before Delhi High Court Mediation and Conciliation Centre, the court fees be returned to the plaintiff under Section 16 of the Court Fees Act.

JULY 28, 2017
‘v mittal’

(MUKTA GUPTA)
JUDGE