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

+ **CS(COMM) 157/2018, IA 8074/2020**

DIAGEO BRANDS B.V & ORS

..... Plaintiffs

Through: Mr. Peeyoosh Kalra, Adv. with
Mr. V. Mohini & Ms. Aarti
Aggarwal, Advs.

Versus

KHODAY BREWERIES LTD & ORS

..... Defendants

Through: Ms. Swathi Sukumar, Adv. with
Mr. Subhoshree Sil & Mr. Naveen
Nagarjuna, Advs.

CORAM:

HON'BLE MR. JUSTICE V. KAMESWAR RAO

ORDER

% **14.09.2020**

This matter is being heard through Video Conferencing.

IA 8074/2020 in CS(COMM) 157/2018

1. This is a joint application under Order 23 Rule 3 read with Section 151 CPC by the parties.
2. The application is signed by the constituted attorney on behalf of plaintiffs and authorized signatory on behalf of the defendants and their counsels. The application is accompanied by the affidavit on behalf of the plaintiffs and the defendants. The prayers made in the application read as under:-

“It is, therefore, most humbly prayed before this Hon'ble Comi that may be pleased to:

- a. accept the settlement reproduced hereinbefore;*
- b. decree and dispose off the Suit vis-a-vis the marks mentioned in paragraphs 19, 20, 21 and 23 of the Amended Complaint, in terms of prayers A, B, C and G of paragraph 41 of the Complaint except the Defendants ' trade mark KHODAY'S BLACK LABEL, and;*
- c. decree and dispose off the Suit vis-a-vis the KHODAY'S BLACK LABEL mark in terms of the statement of the Plaintiffs giving up all their claims in relation to the said mark;*
- d. give this Application an exhibit mark and allow it to form part of the decree;*
- e. pass such other/further orders as this Hon'ble Court may deem appropriate in the facts and circumstances of the case.”*

3. It is stated in the application that the parties have settled their inter-se disputes in terms of paras 3(I) to 3(XII) of this application. The parties have in paras 3, 4 and 5 stated as under:-

“3. The Plaintiffs and Defendants have arrived at a settlement on the terms and conditions set out hereinbelow.

I. Defendants acknowledge the Intellectual Property rights of the Plaintiffs in the registered and well known trade marks JOHNNIE WALKER, CAPTAIN MORGAN, VAT 69, SMIRNOFF, CAPTAIN, GREEN LABEL, GILBEY'S and GUINNESS and undertake jointly and/or severally, to not use or attempt to use or assert any right to use or apply to the Register or to maintain the applications, or to register

any of the trade marks mentioned above or any other trade mark deceptively similar to any trade marks of any of the Plaintiffs as mentioned hereinabove or in any manner whatsoever infringing the registered trade marks of the Plaintiffs or passing off at any point in time in India or any other part of the world.

<i>S. No.</i>	<i>TRADE MARK</i>
<i>i.</i>	<i>JOHNNIE WALKER</i>
<i>ii.</i>	<i>CAPTAIN MORGAN</i>
<i>iii.</i>	<i>VAT 69</i>
<i>iv.</i>	<i>SMIRNOFF</i>
<i>v.</i>	<i>CAPTAIN</i>
<i>vi.</i>	<i>BLACK LABEL</i>
<i>vii.</i>	<i>GREEN LABEL</i>
<i>viii.</i>	<i>GILBEY'S</i>
<i>ix.</i>	<i>GUINNESS</i>

II. Defendants undertake not to use the trade marks mentioned in Paragraph Nos. 19, 20, 21, and 23 of the Amended Plaint filed by Plaintiffs on February 17, 2014 either individually or in conjunction with any other words as a trade mark/label/trade name/company name/trading style/website/domain name/e-mail address/other web pages or in any manner whatsoever throughout the world as well as in India. The list of trade marks that are mentioned in Paragraph Nos. 19, 20, 21 and 23 are filed alongwith the extant Application.

III. Defendants undertake not to file any new applications or secure registrations for the marks listed in the enclosed document or any other marks identical or deceptively similar thereto.

IV. Defendants agree to withdraw all applications pending with the Registrar of Trade Marks for the marks included in the enclosed document and furnish a copy of letters of withdrawal to the Plaintiffs' Counsel within four weeks from the date of execution of this Application.

V. Defendants undertake to voluntarily cancel all registered trade marks included in the enclosed document within four weeks from execution of this Application and furnish documents filed with the Registry of Trade Marks to Counsel for Plaintiffs.

VI. Defendants undertake to remove all reference to the marks mentioned in the enclosed document from their official website and all other social networking pages such as Facebook, LinkedIn, Instagram and other pages within its control, and agree not to apply for or obtain registration of marks identical or deceptively similar to Plaintiffs' trade marks before any competent body or government authority, singularly or in conjunction with any other mark(s)/word(s)/label(s) or as trade names, trading style, corporate name, website, domain name, e-mail address or other in any manner whatsoever in relation to its business/products/services.

VII. Defendants declare that they do not have any stocks, products, labels, packaging material or any other material for manufacturing, advertising, selling or marketing any product/service under the marks included in the enclosed document.

VIII. Notwithstanding anything contained herein, the Plaintiffs give up their claim against the mark KHODAY'S BLACK LABEL vis-a-vis use of the said trade mark in terms of the judgment of the Hon'ble Karanataka High Court in United Breweries Limited v. Khoday Breweries Limited, in Regular First Appeal No. 66/2018, reported at 2013 (55) PTC 513 (Karn.).

IX. The Plaintiffs agree to give up their prayer for damages and costs sought in the extant Suit. The Plaintiffs also agree to give up damages and costs awarded in the case of Diageo Brands B. V v. Mr. MS. Mayya & Anr., including under judgments and orders dated November 03, 2014 and October 06, 2018.

X. The parties shall file appropriate requests with the Hon'ble Intellectual Property Appellate Board for withdrawal of the following pending proceedings inter se the parties:

a. Cancellation filed by Diageo Brands B.V. against registration No. 831762 in the name of Khoday Brewing & Distilling Industries Limited & Ors. (ORA/64/2011/TM/CH). As Defendants will seek voluntary cancellation of the mark PETEW ALKER, Plaintiffs will file request for disposal of the matter.

b. Cancellation filed by Diageo Brands B.V. and Diageo Scotland Limited against registration No. 804671 in the name of Khoday Breweries Limited & Ors. (ORA/125/20 11 /TM/CH). As Defendants will seek voluntary cancellation of the mark CAPTAIN WALKER, the said proceedings will be disposed off accordingly. Plaintiffs will file request for disposal of the matter.

c. *Appeal filed by Diageo Brands B.V. against registration No. 518496 in the name of Khoday Breweries Limited (OA/51/2010/TM/CH). As Plaintiffs have agreed to allow use of the mark KHODAY'S BLACK LABEL, the said Appeal will be withdrawn by the Plaintiffs.*

XI. *The parties shall honour the terms of settlement and undertake to be bound by it. The terms of the settlement shall remain confidential between the Parties.*

XII. *The statements made by the Defendants in this application shall further be without prejudice to the rights and contentions of the Defendants in any trade marks not covered by this compromise application or any trade mark that is the subject matter of any other litigation pending before any other Court or forum, including before the Bombay High Court in Suit No. 1729/1987, and the same are expressly kept open.*

4. *It is agreed between the Plaintiffs and Defendants that nothing in the instant Application shall affect the parties' rights to use, or institute or press any remedies for:*

- (i) Intellectual property rights which are not the subject matter of the instant suit, or*
- (ii) Violation of any of the terms of the present settlement.*

5. *In view of the aforesaid, Defendants agree to suffer a decree in terms of prayers A, B, C and G of paragraph 41 of the Plaint in respect of the trade marks mentioned in the enclosed document. The Plaintiffs give up their prayers for damages and costs mentioned in D and E of paragraph 41.”*

4. Learned counsel for the parties states that the terms of the settlement, as reflected in para 3,4 and 5 be taken on record and the suit be decreed vis-a-vis the marks mentioned in paragraphs 19, 20, 21 and 23 of the amended plaint and in terms of prayers A, B, C and G of paragraph 41 of the plaint except the defendants ' trade mark KHODAY'S BLACK LABEL. Learned counsel for the parties also states that the parties shall abide by the terms of the settlement.

5. By taking the submissions made by the counsel on record and the fact that the parties have settled their inter-se disputes, as reflected above in paras 3, 4 and 5 of this application, which are taken on record and the same being lawful, the suit is decreed vis-a-vis the marks mentioned in paragraphs 19, 20, 21 and 23 of the amended plaint and in terms of prayers A, B, C and G of paragraph 41 of the plaint except the defendants ' trade mark KHODAY'S BLACK LABEL. Application is disposed of.

V. KAMESWAR RAO, J

SEPTEMBER 14, 2020/ak