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

+ CS(COMM) 352/2018, I.A. 16685/2014, I.A. 1659/2016

FERRERO SPA & ORS

..... Plaintiffs

Through: Ms.Prachi Agarwal, Mr.Rohin
Koolwal & Ms.Mrinali Menon,
Advocates.

versus

SUNNY CHOWRANI & ANR

..... Defendants

Through: Mr. H.P. Singh, Advocate.

CORAM:

HON'BLE MR. JUSTICE PRATEEK JALAN

ORDER

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04.03.2020

CS(COMM) 352/2018 & I.A. 2572/2020 (Joint Compromise application under Order XXIII Rule 3 of the CPC)

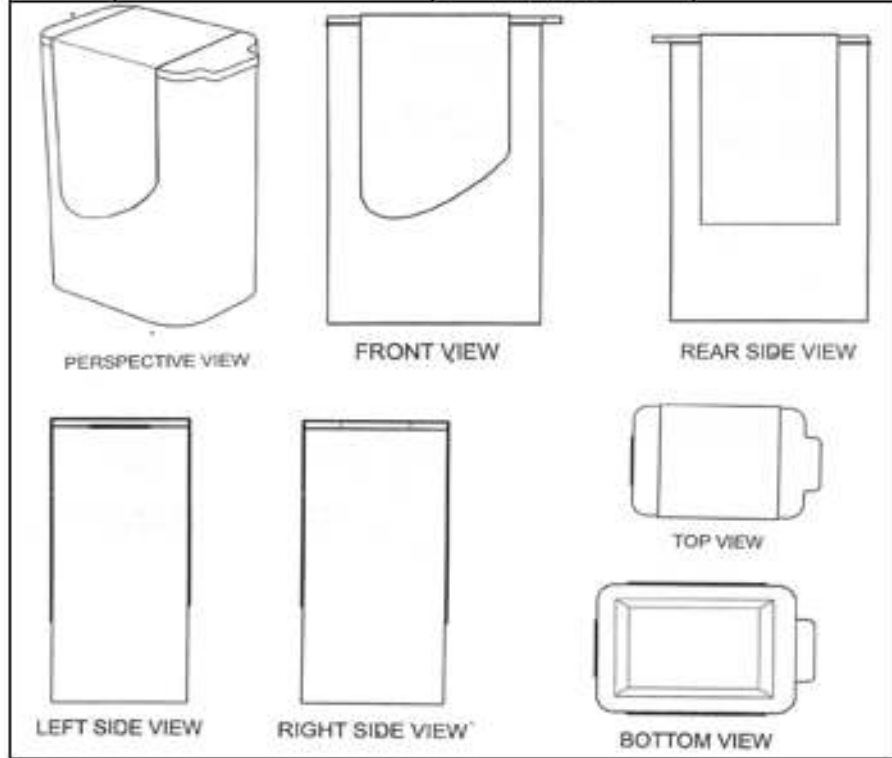
1. Pursuant to the order dated 24.02.2020, the authorisation in favour of the signatories to the settlement have been filed.
2. Learned counsel for the parties state that the suit has been settled upon the terms contained in paragraph 2(a) to 2(1) of the application. The application is signed by defendant no.1 in person, by the authorised representative of plaintiff nos. 1 to 3, and defendant nos. 2 and 3 as well as by their counsel. It is also supported by affidavits of all the signatories.
3. The terms of settlement provide as follows:-

“(2) During the course of the present proceedings, the Plaintiff No. 1, Plaintiff No.2, and Plaintiff No. 3 (hereinafter referred to as Plaintiffs) with the Defendant No. 1 and Defendant No. 2 (hereinafter referred to as Defendants) have entered into a settlement along the following terms:

(a) The Defendants herein hereby acknowledges and recognizes the Plaintiffs’ sole and exclusive proprietary rights in the Plaintiffs’ following trademarks, which rights the Defendants do not and shall not contest. An illustrative list of some of the Plaintiffs’ registrations and applications for the said trademarks in India, wherein the Plaintiffs’ sole and exclusive proprietary rights are recognized by the Defendants herein, is given below:

S.NO.	APPLICATION NO.	TRADEMARK	WORD/LABEL
1.	290487	TIC TAC	Word
2.	802128	TIC TAC	
3.	1570829	The box device	
4.	IRDI-2789445	TIC TAC LEAF	

(b) The Defendants herein hereby acknowledges and recognizes the Plaintiffs’ sole and exclusive proprietary rights in the Plaintiffs’ following design registration, which rights the Defendants do not and shall not contest, as follows:

S.NO.	APPLICATION NO.	NATURE	DESIGN
1.	213492	Transparent White Lid Box	TIC TAC
 PERSPECTIVE VIEW FRONT VIEW REAR SIDE VIEW LEFT SIDE VIEW RIGHT SIDE VIEW TOP VIEW BOTTOM VIEW			

(c) The Defendants hereby acknowledge that the Plaintiffs are the proprietor of the TIC TAC trademarks, design of the transparent white lid box and trade dress and that the Plaintiffs have worldwide reputation and goodwill in its TIC TAC trademarks.

(d) The Defendants herein acknowledge and recognize the Plaintiffs' sole and exclusive rights contained in the get-up, color combination, overall layout of the TIC TAC trademarks and its associated trade dress specifically the small rectangular transparent plastic boxes with a re-sealable flip top opening on one end to dispense the TIC



TAC pills

and including but not limited to the



unique leaf logo with the words 'TIC TAC' appearing in it which constitutes a significant part of the trade-dress pertaining to its confectionery range of products under the well-known TIC TAC trademarks.

(e) The Defendants further shall not contest for (i.e. shall not raise opposition against, shall not file an application for rectification and/or invalidation and/or cancellation of, etc.) any trademark applications or trademark registrations filed or secured by the Plaintiffs. The Defendants, undertake to withdraw any and every pending proceeding and not initiate any proceeding in relation to the Plaintiffs' trademark registrations and for any mark similar to that of the Plaintiff's TIC TAC marks. The Defendants further agree and undertake not to contest the Plaintiffs' above mentioned sole and exclusive rights at any point of time in the future.

(f) The Defendant undertakes that it shall make use of the trademark "TIP TOP" in such a manner that the two expressions, namely "TIP" and "TOP" are always and in perpetuity separated by a hyphen (-). The Plaintiffs' agree that the Defendants can continue to make use of the trade dress bearing only the "Mint Leaves in the label" as depicted and as shown below:



(g) *The Defendants, shall immediately cease from making*



use of the trade dress in any manner whatsoever. The Defendants undertake to refrain from making use, manufacture, sale, advertising, distribution, import, export of products with the combinations of colors green and white in relation to the mark TIP TOP or any deceptively similar color combination or in a vice-versa combination with respect to confectionery and/or allied products in future.

(h) *The Defendants shall cease and desist from making use of, manufacture, sale, advertising, distribution,*



commercialize, import, export any pellets of the size and shape which is nearly identical and/or deceptively similar to the shape of the Plaintiffs' TIC TAC



pellets . Without prejudice to the rights of the Plaintiffs, the Plaintiffs acknowledge that the pellets of the "TIP-TOP" trademarks are manufactured by "hand-operated" machines and thus the sizes of these pellets might vary. However, the Defendants undertake their pellet sizes could be of any size save as except the nearly identical and / or deceptively similar dimensions of the Plaintiff's TIC TAC pellets.

(i) *The Defendants shall immediately cease from making use, manufacture, sale, advertising, distribution, import, export in relation to confectionary product or allied goods in the containers/boxes as depicted in Annexure A and/or containers/boxes identical and/or deceptively similar to the*



shape of the Plaintiff's containers for the TIC TAC confectionery products.

(j) *Without prejudice to the Plaintiffs' statutory rights vested in the TIC TAC confectionery products, the Plaintiffs undertake not to restrain the Defendants from making use of, manufacture, sale, advertising, distribution, commercialize, import, export in relation to confectionary product or allied goods in the container/box*



provided that the Defendants undertake and ensure not manufacture any pellets whose size is deceptively similar and/or nearly identical to the shape of the Plaintiff's TIC TAC pellets as mentioned under sub-clause (h) of this settlement agreement.

(k) *The Defendants herein undertake and assure the Plaintiffs that they do not have any pending trademark applications and/or registration before the Trade Marks Office in relation to the impugned trademarks and any other trademark making use of the Plaintiffs' TIC TAC trademarks and constituent trade dress, in relation to any goods or services. The Defendants undertake that at no point of time*

in future they shall claim proprietorship of and file applications seeking registration of the trademarks TIP TOP and/or TIP-TOP and any other trademark making use of the Plaintiffs' TIC TAC trademark and constituent trade, in relation to any goods or services.

(l) The Defendants hereby undertake that they have informed all their associates, retailers and other commercial outlets that they shall continue operations only under the amended "TIP-TOP" trademarks and trade-dress subsequent to the amendments to their trademark, trade dress in furtherance of the settlement entered between the parties. "

4. In these circumstances, there is no impediment to the suit being decreed in terms of the settlement agreement.
5. Having regard to the material on record, and submissions of counsel, a decree is passed in terms of paragraph 2(a) to 2(l) of the application. Decree sheet be prepared accordingly.
6. The suit and all pending applications stand disposed of.

PRATEEK JALAN, J

MARCH 04, 2020

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