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

+ **CS(COMM) 100/2023 & I.A. 12910/2023**

AKTIEBOLAGET VOLVO & ORS. Plaintiffs

Through: Ms. Vaishali Mittal and Mr. K. Kamra, Advs.

versus

M K ENTERPRISES Defendant

Through: Mr. Sridharan Ramkumar, Adv.

CORAM:

HON'BLE MR. JUSTICE C.HARI SHANKAR

ORDER (O R A L)

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18.07.2023

I.A. 12910/2023 (Order XXIII Rule 3 of the CPC)

1. The disputes between the parties stand settled and a joint application under Order XXIII Rule 3 of the Code of Civil Procedure, 1908 (CPC) has been filed.

2. The terms of settlement reads thus:

“i. The Defendant herein acknowledges and recognizes the exclusive statutory and common law rights of the Plaintiffs in the following trademarks (hereinafter referred to as the 'VOLVO' trademarks), in India as are directly relevant to the present proceedings, including all other trademark registrations comprising of the 'VOLVO' word, device and logo marks, not specifically mentioned herein which the Defendant does not and shall not contest:

Sl. No.	Trademark	Regis No.	Date of Application	Class	Status
1.	VOLVO	763291	20.06.1997	4	Registered



2.	 VOLVO (device)	1404133	06.12.2005	4, 7, 12, 35	Registered
3.	VOLVO PENTA	1384891	14.09.2005	4, 7, 12, 35	Registered
4.		3249588	12.02.2005	4, 12, 35	Protection granted
5.		3251273	12.02.2005	12, 35	Protection granted
6.	VOLVO	361886	15.05.1980	12	Registered
7.	VOLVO	763280	20.06.1997	12	Registered
8.		1930763	4/03/2010	7, 12	Registered
9.	VOLVO FL	1759086	02/12/2008	12	Registered
10.	VOLVO FE	1759088	02/12/2008	12	Registered
11.	VOLVO FD	1466300	30/06/2006	12	Registered
12.	VOLVO FM	1759085	02/12/2008	12	Registered
13.	VOLVO FH16	1759087	02/12/2008	12	Registered
14.	VOLVO FH	1759089	02/12/2008	12	Registered
15.	VOLVO SELEKT	2119694	22.03.2011	12	Registered

ii. The Defendant hereby acknowledges and recognizes that the Plaintiffs' trademark 'VOLVO' is a well-known trademark as defined under the provisions of section 2 (1) (zg) of the Trade Marks Act, 1999.

iii. The Defendant agrees to a decree of permanent injunction in terms of prayer clause 75 (i) of the Plaint, that it will not by itself or through its subsidiaries, affiliates, franchisees, proprietors, officers, servants, agents, distributors, stockists, representatives, and anyone acting for or on its behalf, use the name/mark



'VOLVOSTAR/' and/or any other name/mark, identical or deceptively similar thereto to the Plaintiffs' name / registered and well-known mark 'VOLVO' in relation to their business activities of manufacturing, marketing, supplying and repackaging of turbo engine oil products or as regards any other goods or services, in any manner, including on products and product packaging; in email ids; in domain names; on social media posts; in third party listings and/or as regards any online and offline representation amounting to:

- a) Infringement of Plaintiff No.2's registered trademarks bearing registration numbers 763291, 1384891, 3249588, 1404133;
- b) *Passing off* the Defendant's products and services as those of the Plaintiffs;
- c) Dilution and tarnishment of the Plaintiffs' registered and well-known trademark 'VOLVO';
- d) Unfair competition vis. a. vis. Plaintiffs' business under its registered and well-known trademark 'VOLVO'.

iv. The Defendant agrees to a decree in terms of prayer clause 75 (ii) of the Plaint and undertakes to destroy all the finished and unfinished materials, including all product containers, packaging, brochures, promotional material, labels, stickers, cartons, dyes, articles, locks, signage, business cards, stationary material, accessories, and any other material bearing the name/mark



'VOLVOSTAR/' and/or any other name/mark, identical or deceptively similar thereto to the Plaintiffs' name / registered and well-known mark 'VOLVO' at their own cost within seven (7) days of the execution present Settlement Agreement.

v. The Defendant agrees to a decree in terms of prayer clause 75 (iv) of the Plaint and undertakes to withdraw its Trademark, Application bearing no. 5088418 for the name/mark "VOLVOSTAR" in Class 4 (lubricants oil, industrial oil, and industrial grease) as is filed before the Trademark Registry. The Defendant shall write a letter withdrawal letter to the Trademark Registry and furnish proof of the same to the counsel of the





Plaintiffs within seven (7) days of the present execution present Settlement Agreement. The Defendant is to make their best efforts and take all necessary steps to ensure that the process of withdrawal is completed within a period, *not exceeding six (6) months* from the execution Settlement Agreement. Only in exigent or unavoidable circumstances, for reasons to be shared by the Defendant in writing and with documentary proof, a further extension of six (6 months) is possible. The Defendant undertakes that it will become liable for breach of the present Settlement Agreement and the Plaintiffs will be entitled to all remedies as are envisaged under laws (including costs and damages) in case the process has not been completed within the prescribed one (1) year timeline unless objective reasons can be demonstrated that lie outside of the control of the Defendant.

vi. The Defendant hereby undertakes before this Hon'ble Court that it shall pay a sum of Rs. INR 1,28,584 /- (Rupees One Lakh, twenty thousand five hundred and eighty-four only) to the Plaintiffs on signing of the instant application as token damages. The Defendant undertakes that the said amount will be paid by it within a period not exceeding one (1) month from the execution of the present Settlement Agreement.

vii. The Defendant undertakes to cease and desist either by itself, or through any of its agents, in the future from adopting, using, filing any application for registration of, or obtaining a registration as a trademark, company name, trade name, domain name and/or email id comprising of the word, name and mark 'VOLVO' and/or any name/designation deceptively similar hereto."

3. Learned Counsel for the parties are present and they undertake on behalf of their respective clients to remain bound by the aforesaid terms of settlement.

4. The Court has perused the terms of settlement and find them to be lawful and in order.

5. As such, nothing survives for adjudication in the present suit.

6. The suit stand decreed in terms of the aforesaid terms of



settlement, by which the parties shall remain bound.

7. Let a decree sheet be drawn up accordingly by the Registry.
8. The plaintiff shall be entitled to refund of 50% of the Court fees, if any, deposited by it.
9. Next date of hearing, i.e. 27 July 2023 stands cancelled.

C.HARI SHANKAR, J

JULY 18, 2023/ar

