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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**
+ **CS(COMM) 450/2023, I.A. 12157/2023, I.A. 18743/2023, I.A. 20012/2023 & I.A. 6532/2024**

CASTROL LIMITED

..... Plaintiff

Through: Mr. Urfee Roomi, Ms. Janaki Arun,
Mr. Ritesh Kumar, Mr. Ayush Dixit,
Ms. Anuja Chaudhary and Ms.
Soumya Jain, Advocates.

versus

**PAPPU KUMAR, PARTNER OF SHRI SHYAM LUBRICANTS
OIL & CHEMICALS & ANR.**

..... Defendants

Through: Mr. Vipin Wason and Ms. Stuti
Wason, Advocates alongwith D-1 & 2
(through VC).

CORAM:

HON'BLE MR. JUSTICE ANISH DAYAL

ORDER

22.03.2024

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I.A. 6532/2024 (joint application under Order XXIII Rule 3 CPC)

1. This application has been filed jointly by plaintiff and defendants, placing on record their terms of settlement.
2. The said application has been signed by authorised signatory of plaintiff and countersigned by counsel for the plaintiff. The application has been supported by the affidavits of defendants.
3. Court has perused the terms of agreements and finds the following terms to be lawful and acceptable:



“a. This settlement agreement binds the Defendants, in their individual and personal capacities, as well as in their capacities as the proprietors/owners/partners of Shri Shyam Lubricants Oil & Chemicals, as the case may be, the individual Defendants’ successors and/or subsequent assigns, or any entity or concern in which the Defendants hold a majority of shares or that is otherwise under the control of the Defendants.

b. This settlement agreement shall come into effect on the date on which it is being signed (hereinafter referred to as “Effective Date”).

c. The Defendants acknowledge the Plaintiff’s right, title and interest in the Plaintiff’s intellectual property around world, including in India as given below:

*(i) **The Plaintiff’s CASTROL Trade Marks:** The Defendants acknowledge the Plaintiff’s right, title and interest in the CASTROL mark and marks that incorporate the CASTROL mark, including, but not limited to the CASTROL Device mark shown below:*



*(ii) **The Plaintiff’s Other Trade Marks:** The Defendants acknowledge the Plaintiff’s right, title and interest in (i) ACTIV mark (ii) ACTIBOND mark (i ii) ACTIV Device mark (shown below) (iv) ACTIBOND Device mark (shown below) and (v) Oil Device mark (shown below).*





The marks in paragraphs c(i) and c(ii) above are hereinafter collectively referred to as the "Plaintiffs Marks".

*(iii) **The Plaintiff's Trade Dress in Containers and Labels Affixed to Containers:** The Defendants acknowledge the Plaintiffs right, title and interest in the trade dress of the containers shown below, consisting of the distinctive shape of the containers and the labels affixed to the containers.*



The containers shown above are hereinafter collectively referred to as the "Plaintiff's Containers" and the labels affixed to the containers are hereinafter collectively referred to as the "Plaintiff's Labels". The Plaintiff's Containers and the Plaintiff's Labels are hereinafter collectively referred to as the "Plaintiff's Packaging".

*(iv) **The Plaintiff's Copyrights in the Plaintiff's Marks and the Plaintiff's Labels:** The Defendants acknowledge the Plaintiff's copyrights in one or more of the Plaintiff's Marks and the Plaintiff's Labels. The Plaintiff's Marks (as defined in paragraph c(i) and c(ii) above) and the Plaintiff's Packaging (as defined in paragraph c(iii)) are, unless otherwise specified, hereinafter collectively referred to as the "Plaintiffs Marks and Packaging".*



d. The Defendants state that they are engaged in manufacturing, marketing, and sale of engine oils and lubricants, using, unauthorizedly, the intellectual property listed below. The term 'use' includes, but is not limited, to use on and in relation to engine oils and lubricants and/or any allied/cognate/related goods and/or services, on promotional and advertising material, on listings on third-party business listing websites and e-commerce websites.

(i) **The MAXALL Device mark:** The Defendants are using MAXALL Device mark (shown below) on and in relation to engine oils and lubricants:



(ii) **The Other Marks Used by the Defendants:** The Defendants are also using the (i) ACTIVE mark (ii) ACTIVATE mark, (ij) ACTIBOND mark, (iv) ACTIBOND Device mark (shown below) and (v) an Oil Device mark (also shown below) on and in relation to engine oil and lubricants. The MAXALL Device mark (as shown in paragraph d(i) above), marks that incorporate the MAXALL Device mark, the marks ACTIVE, ACTIVATE, ACTIBOND, ACTI BOND Device and Oil Device mark (both shown below) are hereinafter collectively referred to as the "Defendants' Marks".



(iii) **The Defendants' Trade Dress in Containers and Labels Affixed to Containers:** The Defendants' engine oil



and lubricants bearing the Defendants' Marks (as defined in paragraph d(ii) above) are sold in containers shown below to which are affixed with the labels also shown below:



The containers and labels shown above are hereinafter collectively referred to as the "Defendants' Packaging". The Defendants' Marks (as defined in paragraph d(ii) above) and the Defendants' Packaging (as defined in this paragraph) are, unless otherwise specified, hereinafter collectively referred to as the "Defendants' Marks and Packaging".

*(iv) **Shape of Defendants' container:** The Defendants are also selling engine oil bearing the Defendants' Marks in a container as shown below:*



The containers and labels shown above are hereinafter collectively referred to as the “Defendants’ Packaging”. The Defendants’ Marks (as defined in paragraph d(ii) above) and the Defendants’ Packaging (as defined in paragraph d(iii)) and Defendants’ shape of container are, unless otherwise specified, hereinafter collectively referred to as the “Defendants’ Marks, Packaging and Bottle Shape”.

- e. The Defendants undertake that they will never, directly or indirectly, in the future, use*
- i. the Defendants’ Marks;*
 - ii. the Defendants’ Packaging;*
 - iii. the Defendants’ Bottle Shape;*
 - iv. any mark that incorporate the Defendants’ Marks;*



- v. *the Plaintiff's Marks;*
- vi. *any mark similar to the Plaintiffs Marks, whether alone or in conjunction with other word(s) and/or device(s);*
- vii *the Plaintiff's Packaging;*
- viii *any packaging similar to the Plaintiffs Packaging.*

f. The Defendants, have not, whether jointly or severally and/or whether directly or indirectly, filed or caused to be filed, any trade mark, copyright, design application(s), as the case may be, to register, and do not, jointly or severally and/or directly or indirectly, own any trademark copyright, design registration(s), as the case may be, for:

- i. the Defendants' Marks and Packaging;*
- ii. the Defendants' Bottle Shape;*
- iii. any mark/ packaging/ label/ design that incorporates the Defendants' Marks, Packaging and Bottle Shape;*
- iv. any mark/ packaging/ label/ design that is identical/ deceptively similar to the Plaintiff's Marks and Packaging covering any goods, including, but not limited to, oil, such as textile oil, lubricating oil, industrial grease, automotive engine oils, and/or goods/services relating to oil.*

g. The Defendants, jointly and severally, undertake to destroy, within a period of ten (10) working days from the Effective Date, at their own cost, all goods, advertising and promotional materials, containers, unfinished products, etc. bearing (i) the Defendants' Marks and Packaging; (ii) the Defendants' Bottle Shape; (iii) any mark/packaging/label/design that incorporates the Defendants' Marks, Packaging and the Defendants' Bottle Shape (iv) any



mark/packaging/label/design that is identical/ deceptively similar to the Plaintiff's Marks and Packaging; and on completion of ten (10) working days from the Effective Date furnish a written confirmation to Castrol's Indian counsel, Sujata Chaudhri IP Attorneys that all such goods/materials have been destroyed along with pictures evidencing such destruction. It is clarified here that the provisions of this paragraph will apply to all goods/materials lying at any premises that are under the control of one or more of the Defendants.

h. The Defendants will never, now, or in the future, challenge, or take any action against, the Plaintiff's rights in the Plaintiff's Marks and Packaging.

i. The Defendants will not hold themselves as being related to the Plaintiff in any way.

j. The Defendants will not, whether, directly or indirectly, cause, enable or assist another party to do any of the acts that it is undertaking not to do.

k. The Defendants will pay the Plaintiff a sum of INR 3,00,000 (three lakhs rupees) in three (3) installments, each installment to be paid on/before 10th day of every month as reimbursement of the costs incurred in acting against the Defendants and its infringing use via bank transfer into the bank account of the Plaintiff's counsel. The bank details of the Plaintiff's counsel are provided below:

Name: Sujata Chaudhri IP Attorneys

Bank Name: Axis Bank Ltd.

Current Account No: 914020022909462

IFSC Code: UTB0001149

l. The Plaintiff and the Defendants agree to be bound by the terms and conditions of this present settlement agreement and further undertake that they shall neither challenge nor violate the terms and conditions of this settlement agreement.



m. The Plaintiff and the Defendants agree that a decree may be passed by the Hon'ble Court in terms of this present settlement agreement. The parties understand that in case the decree so passed by the Hon'ble Court is not complied with or any default is committed by either of the parties, the other party shall be at liberty to execute the said decree against such defaulting party in the court of law.”

4. Parties shall remain bound by the terms of settlement provided above.
5. Nothing survives for adjudication.
6. Accordingly, decree sheet be drawn up by the Registry in terms of the settlement. Suit is disposed of.
7. In view of out of Court settlement between the parties, plaintiff is entitled to refund of 50% of court fees, in terms of section 16A of the Court Fees Act, 1870.
8. Registry may refund the court fees to counsel for the plaintiff, who undertakes to accept the same on behalf of the plaintiff.
9. Pending applications, if any, are disposed of as infructuous.
10. Order be uploaded on the website of this Court.

ANISH DAYAL, J

MARCH 22, 2024/kct/rj