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

+ CS(COMM) 182/2021

THE GOODYEAR TIRE AND RUBBER

COMPANY AND ANR.

..... Plaintiffs

Through Mr.Peeyoosh Kalra, Ms.V.Mohini,
Mr.Udayvir Rana and Ms.Aarti
Aggarwal, Advs.

versus

DEVA NAND SUKHIA

..... Defendant

Through Mr.Sanjeev Singh and
Mr.D.K.Yadav, Advs.

CORAM:

HON'BLE MR. JUSTICE JAYANT NATH

ORDER

% **03.05.2021**

This hearing is conducted through video conferencing.

IA No.5579/2021

1. On 19.04.2021, this court passed the following orders:

“IA No. 5579/2021

1. This application is filed under Order 39 Rules 1 and 2 CPC seeking an ex parte injunction in favour of the plaintiff to prevent infringement of the plaintiff's registered trade mark

GOODYEAR/ **GOOD YEAR** and to restrain the defendant, its promoters, etc. from using the mark 'GOOD YEAR' or any such mark which is identical or deceptively similar to the plaintiff's registered trade mark GOODYEAR/

GOOD YEAR

2. The case of the plaintiff is that the oldest registration of the mark of 'GOODYEAR' in the USA was in 1906. The said mark was adopted in India in 1920. The earliest registration of the mark 'GOODYEAR' in India in Class 12 for tyres for

vehicle wheels and inner tubes is of 1943. Plaintiff No. 1 has also started selling lubricants under the mark/name 'GOODYEAR'. The mark 'AUTOMOBILI GOOD YEAR' was registered on 05.01.2019 in respect of industrial oil and grease, lubricants, lubricating oils etc.

3. It is stated that in February 2020, representatives of plaintiff No. 1 came across the impugned mark GOOD YEAR in respect of break oil, grease, gear oil, etc. in the name of the defendant. The plaintiff filed a cancellation application on 16.03.2020. Plaintiff No. 1 has also applied for the registration

of the mark GOODYEAR/**GOOD YEAR** in Classes 1 and 4 on 'proposed to be basis' on 27.03.2020. The defendant has also filed an application for rectification on 29.10.2020.

4. Issue notice.

5. Learned counsel for the defendant accepts notice.

6. Learned counsel for the defendant states that he would like to take instructions as he has not received a copy of the plaint.

7. A copy of the paper book be supplied to the learned counsel for the defendant.

8. List in court on 26.04.2021."

2. When the matter came up for hearing on 19.04.2021, it was suggested by the court that the defendant may try and settle the matter. Learned counsel for the defendant has taken two adjournments to take instructions.

3. Today, learned counsel for the defendant has vehemently urged that no interim order can be passed in favour of the plaintiff. He has sought to state that the defendant has been using the impugned trademark 'GOOD YEAR' in respect of break oil, grease, gear oil, etc. since 1997. He also states that the mark was registered in 2002.

4. Learned counsel for the defendant also relies upon a judgment of this court in the case of *Mittal Electronics vs Sujata Home Appliances (P) Ltd.*

&Ors., MANU/DE/1695/2020.

5. I may only note that the mark 'GOODYEAR/**GOODYEAR**' has been registered in India in class 12 since 1943. It has been used in India, as per plaint, since 1920.

6. A perusal of the plaint shows that plaintiff No.1 is one of the world's largest tyre company. It presently employs about 64,000 people in its 47 facilities in 21 countries around the world.

7. It is also stated that for the year 2014-18, the turnover was to the extent of \$50 billion evidencing the extensive reputation and goodwill accruing to the trademark/name 'GOODYEAR/**GOODYEAR**'. In India, the said trademark is available across the country and the net sales for the year 2014-2018 under the said mark were in excess of \$1 billion. The net income for 2020 was Rs.1,78,074 Lakhs.


8. It is manifest that the registered mark/name of the plaintiff 'GOODYEAR/**GOODYEAR**' is *prima facie* a well-known mark. The act of the defendant using the same mark tantamounts to infringement of the said mark/name of the plaintiffs.

9. In this context reference may be had to the judgment of a Co-ordinate Bench of this court in the case of *United Distillers PLC v. Jagdish Joshi & Ors., (2000) 88 DLT 142* where the Co-ordinate Bench held as follows:

"9. The learned Counsel has also relied upon several judgments to contend that in respect of well-known trade marks a restraint order can be issued even in respect to different goods. It is only necessary to consider the illustrative case of *Daimler Benz Aktiengesellschaft and Another v. Hybo Hindustan*, AIR 1994 Delhi 239, where an automobile manufacturer was granted a restraint order in respect of undergarments in respect of a

known trade mark. Thus it is well settled law that the known trade marks do enjoy protection in respect of its unauthorised user on goods other than those goods for which the trade mark is registered. This principle of availability of protection for other goods has been laid down in number of judgments reported as Alfred Dunhil Limited v. Kartar Singh, 1999 PTC 294; AB Volvo v. Volvo Steels, 1998 PTC 48; Bata India Limited v. M/s. Pyare Lal and Co. , AIR 1985 All. 242; M/s. Binatone International Ltd. v. M/s. Sujan Kitchenware Appliances, 1991 PTC 8; M/s. Jugmug Electric and Radio Co. v. M/s. Telerad Pvt. Ltd. , ILR 1977 (1) 295; Banga Watch Co. v. M/s. NV Philips, AIR 1983 Pandh 418; Caterpillar Inc. v. Jorangel, 1998 PTC 31 (DB).”

10. Reliance of learned counsel for the defendant on the judgment of another Co-ordinate Bench of this court in the case of *Mittal Electronics vs Sujata Home Appliances (P) Ltd. &Ors.*(supra) is misplaced. That was a case in which the plaintiff was seeking to protect its trademark SUJATA. It was the contention of the defendant therein that the plaintiff had never actually used the mark SUJATA in the context of water purifiers, water filter and RO systems despite having applied for the mark in 2014. On the other hand, the defendant had applied for registration of the trademark SUJATA and was granted the same in 2014. The court held that the proprietor of a trademark cannot enjoy monopoly over entire class of goods particularly when he is not using the said trademark in respect of certain goods falling under the same class of goods. Clearly, the issue was different. That was not a case of a well-known trademark.

11. The plaintiffs have made out a *prima facie* case. The defendant, its promoters, directors etc. are restrained from using the mark/name ‘GOODYEAR/ or any other mark which is identical or

deceptively similar to the plaintiffs' trademark/name 'GOODYEAR/**GOODYEAR** in any manner whatsoever, till further orders.

12. Issue notice. Learned counsel for the defendant accepts notice. Reply be filed within four weeks from today. Rejoinder, if any, be filed within four weeks thereafter.

13. List for arguments on 06.09.2021.

JAYANT NATH, J.

MAY 3, 2021/v