

(2019) 02 DEL CK 0177

In the Delhi High Court

Case No : Civil Suits (COMM) 1275 Of 2018, Miscellaneous Application No.
16760 Of 2018

Aktiebolaget Volvo & Ors

APPELLANT

Vs

Volvo Holidays & Anr

RESPONDENT

Date of Decision : 13-02-2019

Acts Referred:

Trade Marks Act, 1999 — Section 2(1)(zg), 29(1), 29(4), 29(5)

Citation : (2019) 4 AD(Delhi) 406

Hon'ble Judges : Manmohan, J

Bench : Single Bench

Advocate : Raunaq Kamath, Kruttika Vijay, Aditya Gupta

Final Decision : Disposed Off

Judgement

Manmohan, J

1. Present suit has been filed for permanent injunction restraining infringement of trademarks, passing off, damages, delivery up, etc against the defendants. The prayer clause is reproduced hereinbelow:-

"(a) An order for permanent injunction restraining the Defendants, their proprietors, partners, affiliates, franchisees, officers, servants, agents, distributors, representatives and anyone acting for or on their behalf from using the mark/name VOLVO HOLIDAYS with or without the Impugned Device or any mark/name or device similar to the Plaintiffs' trade mark/name VOLVO or the Volvo Iron Mark, in any manner including without limitation on websites and as a part of the infringing domain name www.volvoholidays.co.in amounting to infringement of Plaintiff No. 2's registered trade marks.

(b) An order for permanent injunction restraining the Defendants, their proprietors, partners, affiliates, franchisees, officers, servants, agents, distributors, representatives and anyone acting for or on their behalf from using the mark/name VOLVO HOLIDAYS with or without the Impugned Device or any

mark/name or device similar to the Plaintiffs' trade mark! name VOLVO or the Volvo Iron Mark, in any manner, including without limitation on websites and as a part of the infringing domain name www.volvoholidays.co.in, or doing any other act amounting to passing off of the Defendants' business/services as those of the Plaintiffs;

(c) An order for permanent injunction restraining the Defendants, their proprietors, partners, affiliates, franchisees, officers, servants, agents, distributors, representatives and anyone acting for or on their behalf from using the mark/name VOLVO HOLIDAYS with or without the Impugned Device or any mark/name or device similar to the Plaintiffs' trade mark/name VOLVO or the Volvo Iron Mark, in any manner, including without limitation on websites and as a part of the infringing domain name www.volvoholidays.co.in. or doing any other act which may cause dilution and/ or tarnishment of the Plaintiffs' trade marks;

(d) For an order for the Defendants to furnish all the data of all transactions undertaken (including the data of the suppliers, the number of purchases, etc.) during the course of its business under the impugned mark VOLVO HOLIDAYS, to the Plaintiffs;

(e) An order for delivery up of all finished and unfinished materials including but not limited to pamphlets, signage, business cards, accessories and other material bearing the trade mark VOLVO HOLIDAYS and/or the Impugned Device or any mark or device deceptively similar to the Plaintiffs' trade mark/name VOLVO and/ or the Volvo Iron Mark, by the Defendants to the Plaintiffs for the purpose of erasure/destruction;

(f) An order for transfer of the impugned domain name www.volvoholidays.co.in to Plaintiffs No 2;

(g) A decree for damages of Rs. 2,00,00,000/- (rupees two crore only) in favour of Plaintiff No. 2 to be paid by Defendant No. 1, though its proprietors, on account of loss of sales and damage to the reputation and goodwill of the Plaintiffs' intellectual property;

(h) An order for costs of the proceedings;"

2. Vide order dated 7th December, 2018, this Court had granted an ex parte ad interim injunction in favour of the plaintiffs and against the defendants. The relevant portion of the ex-parte injunction order is reproduced hereinbelow:-

"Consequently, till further orders, the defendants, their proprietors, partners, affiliates, franchisees, officers, servants, agents, distributors, representatives and anyone acting for or on their behalf are restrained from using the mark/name VOLVO HOLIDAYS with or without the impugned device or any mark/name or device similar to the plaintiffs' trademark/name VOLVO or the Volvo Iron Mark, including without limitation on websites and as a part of the infringing domain name www.volvoholidays.co.in, in any manner whatsoever. The NIXI is directed to suspend the domain <volvoholidays.co.in> during the pendency of the suit."

3. Vide order dated 11th February 2019, it was recorded that the defendants have been served through email and SMS. The relevant portion is reproduced hereinbelow:-

"As per office report, the defendants stand served through email and SMS. None has appeared on behalf of the defendants. The matter be placed before the Hon'ble Court for further directions on the date already fixed."

4. Since despite service none has entered appearance on behalf of the defendants, they are proceeded ex parte.

5. At this stage, learned counsel for the plaintiffs states that he is confining his relief to prayer 29 (a), (b), (f) and (g) of the prayer clause to the suit. The statement made by learned counsel for plaintiffs is accepted by this Court and plaintiffs are held bound by the same.

6. This Court is also of the view that the present suit can be disposed of without any further delay. A Coordinate Bench of this Court in Satya Infrastructure Ltd. and Ors. Vs. Satya Infra & Estates Pvt. Ltd., 2013 SCC OnLine Del 508 has held as under:-

"I am of the opinion that no purpose will be served in such cases by directing the plaintiffs to lead ex parte evidence in the form of affidavit by way of examination-in-chief and which invariably is a repetition of the contents of the plaint. The plaint otherwise, as per the amended CPC, besides being verified, is also supported by affidavits of the plaintiffs. I fail to fathom any reason for according any additional sanctity to the affidavit by way of examination-in-chief than to the affidavit in support of the plaint or to any exhibit marks being put on the documents which have been filed by the plaintiffs and are already on record. I have therefore heard the counsel for the plaintiffs on merits qua the relief of injunction."

7. In the plaint, it is stated that plaintiff no.1 is an international automotive and transport vehicle group and employs approximately 1,15,000 persons worldwide. The plaintiff no. 1 was incorporated on 05th May, 1915 and commenced business of assembling cars in April 1927 and trucks in 1928. The plaintiff no.1 provides a wide spectrum of transportation related products and services, with superior quality and high standards of safety and environmental care, to customers in selected segments. Plaintiff nos. 2 and 3 are companies organized under the laws of Sweden and plaintiff no. 3 occupies a prominent position as a car producer within its segment.

8. It is stated that the plaintiff no. 1 adopted the trademark/corporate name 'Volvo' on 05th May, 1915. The plaintiff no. 1 executed a global deed of assignment in favour of plaintiff no. 2, who became the subsequent proprietor of the plaintiffs' VOLVO trademarks and subsequently licensed these to plaintiff nos. 1 and 3 to use in relation to their respective businesses. It is further stated that the word VOLVO is not found in any authoritative English dictionary and is thus a

coined and inherently distinctive trade mark which is solely associated with the plaintiffs.

9. It is averred that the plaintiff nos. 1 and 3 manufacture goods and provide related services throughout the world under the trade mark/name VOLVO. In addition to their core business in the transportation and automotive sector, the plaintiffs' use of the VOLVO mark also extends to wide range of ancillary products, services and businesses.

10. It is stated that the plaintiffs have a robust presence under the VOLVO mark in India for several decades and the plaintiff no. 1 established an Indian flagship company in India in 1996. The plaintiff no. 3 also launched two car models, under the VOLVO mark in September 2007 and has thereafter introduced various other car models and is actively carrying on its business in India through its subsidiary, i.e. Volvo Auto India Pvt. Ltd.

11. It is stated in the plaint that the plaintiffs have obtained over 30 different registrations for the trademark VOLVO and also VOLVO Iron Mark i.e. in India including under Class 39 under the Trade Marks Act, 1999. The plaintiffs' earliest registration in India dates back to 1975.

12. It is stated in the plaint that the plaintiffs have sold 571,577 cars globally in 2017. It is also stated that the plaintiff no.1 has spent Swedish Kroner 1,449 and plaintiff no. 3 has spent USD 1,089,000,000 in the year 2017 towards the promotion, publicity and advertisement of the VOLVO brand globally.

13. Learned counsel for plaintiffs states that in October, 2018, the plaintiffs received a complaint regarding the defendants' website www.volvoholidays.co.in from an individual in India on the social networking site www.twitter.com, reporting that the defendants' aforesaid website is using the Volvo Iron Device Mark. Subsequently, the plaintiffs conducted inquiries which revealed that the defendant no. 1 is operating the website www.volvoholidays.co.in and the impugned domain name was registered in the name of defendant no. 2 on 21st September, 2018.

14. Learned counsel for the plaintiffs states that the defendant no. 1 has adopted a device mark which is identical to the plaintiffs' Volvo Iron Device Mark with a mere addition of the word HOLIDAYS. A pictorial comparison of plaintiff and defendants' device mark is reproduced herein below:-

15. Learned counsel for the plaintiffs states that a similar complaint was sent to the Pune City Police explaining that the defendant no. 1 is placing calls to customers and falsely misrepresenting that it is a part of the plaintiffs' Volvo Group and that it has won a tourism award.

16. Learned counsel for the plaintiffs states that the defendants' infringing website claims "a proven name in the travel and hospitality industry today" and also claims to be "...the best architect firm & Building Consultant" and "a New Jersey private inspection facility as well as Certified Emission Repair facility..." He

states that the defendants offer tour packages and hotel bookings in India as well as other locations such as Bali, Dubai, Hong Kong, Thailand, Malaysia on its website.

17. Learned counsel for the plaintiffs further states that the defendants claim to be a winner of a Travvy Award (a travel award given by a US based entity named travAlliancemedial). He states that upon checking with travAlliancemedial, the plaintiffs' were informed that the defendants' claim is false.

18. Learned counsel for the plaintiffs states that a truecaller search revealed that there are numerous 'spam' reports lodged against the defendants' phone number.

19. Learned counsel for the plaintiffs further states that the plaintiffs through their attorneys issued a cease and desist notice on 8th November, 2018 calling upon the defendants to give up all use of the plaintiffs' trade mark/name VOLVO and the Volvo Iron Device Mark and to transfer the infringing domain name www.volvoholidays.co.in to the plaintiffs. He states that since no response was received, the plaintiffs' attorneys followed up with the defendant no. 1's proprietor Mr. Abhinav over the phone, who verbally undertook to take down the website and cease all use of the VOLVO mark and infringing logo. However, the defendants have failed to do so and despite considerable follow up, they continue to use the impugned mark and trading style VOLVO HOLIDAYS and the infringing logo.

20. Learned counsel for plaintiffs states that the plaintiffs' trade mark VOLVO has been declared as a well-known mark as defined under Section 2(1)(zg) of the Trade Marks Act, 1999 by Division Bench of the Bombay High Court in an appeal titled Aktiebolaget Volvo Vs. Volvo Steel Ltd. [1998 PTC (18) 470]. He further states that the well known status of the plaintiffs' trade mark in India was also recognized by the Trade Marks Registry and the VOLVO trade mark has been inserted in the list of the well known marks maintained by the Trade Mark Registry, as a result of which, the plaintiffs' VOLVO trade mark is entitled to the highest degree of protection conferred under law.

21. Learned counsel for plaintiffs states that the adoption and use of the mark VOLVO including as part of the impugned domain name www.volvoholidays.co.in and the impugned device mark by the defendants in relation to travel services being provided by them without any authorization from the plaintiffs amounts to infringement of plaintiff no.2's registered trade mark VOLVO under Section 29(1), (4) and (5) of the Trade Marks Act, 1999. He further states that the defendants' use of the plaintiffs' well known trade mark VOLVO amounts to passing off their products and business as those of or authorized by the plaintiffs.

22. Learned counsel for plaintiffs states that the adoption and use of the mark VOLVO including as part of the impugned domain name www.volvoholidays.co.in and the impugned iron device mark is likely to cause confusion in the mind of the public and is also likely to mislead the customers into purchasing the defendants' product and business under the mistaken impression that these originate from

the plaintiffs. He states that defendants' adoption of the impugned mark VOLVO including as part of the impugned domain name www.volvoholidays.co.in and the impugned device mark is clearly designed to ride upon the plaintiffs' common goodwill and stellar reputation in relation to the VOLVO trade mark/name.

23. He further states that the adoption and use of the impugned VOLVO mark by the defendants is patently dishonest as the defendants are bound to be aware not only of the goodwill and reputation of the plaintiffs' well known trade mark/name VOLVO but also of the plaintiffs' use of the mark both overseas as well as in India.

24. In the opinion of this Court, the defendants have no real prospect of defending the claim, as they have neither entered appearance nor have filed written statements. Further, the plaintiffs are the registered owner of the trade marks in question.

25. In view of the above, the present suit is decreed in favour of the plaintiffs and against the defendants in accordance with prayer 29 (a), and (b) of the present plaint along with actual costs. The costs shall amongst others include lawyers' fees as well as the amounts spent on purchasing the Court fees. The plaintiffs are given liberty to file on record the exact cost incurred by them in adjudication of the present suit, if not already filed. Defendants are directed to transfer the impugned domain name www.volvoholidays.co.in to plaintiff no. 2. Registry is directed to prepare a decree sheet accordingly. The plaintiffs are also granted liberty to approach the Registrar of domain name GoDaddy.com, LLC with a copy of this order for transfer of the aforesaid impugned domain name to plaintiff no.2.

26. With the aforesaid observations, present suit and pending application stand disposed of.