

(2011) 10 DEL CK 0197
In the Delhi High Court
Case No : CS (OS) 1451 of 2011

Disney Enterprises, Inc and Another	APPELLANT
Vs	
Gurmeet Singh and Others	RESPONDENT

Date of Decision : 20-10-2011

Acts Referred:

Court Fees Act, 1870 — Section 16
Trade Marks Act, 1999 — Section 2(1)

Citation : (2011) 10 DEL CK 0197

Hon'ble Judges : G.S. Sistani, J

Bench : Single Bench

Advocate : Tanya Varma, for the Appellant; Vibhu Tiwari, for the Respondent

Final Decision : Disposed Off

Judgement

G.S. Sistani, J.—Plaintiff has filed the present suit for permanent injunction restraining infringement of trademark, passing off, trademark dilution, and delivery up.

2. Plaintiffs are stated to be engaged in the variety of businesses including operation of theme parks and hotel services around the world, producing and distributing motion pictures and television programmes, producing and selling clothing, books, records, toys and other merchandise, and providing entertainment services. Plaintiffs' business also include merchandising and licensing of distinctive elements associated with its motion pictures and television programmes including but not limited to the world famous fanciful characters Mickey Mouse, Minni Mouse, Donald Duck, Daisy Duck, Goofy, Pluto and Winnie the Pooh and Tiger as well as the characters from "DISNEY" trademark, animated motion pictures including but not limited to "Snow White and the Seven Dwarfs", "Pinocchio", "The Lion King", "Aladdin", "Beauty and the Beast", "The Little Mermaid", and the like. According to the plaint, the character Mickey Mouse was created in the year 1928 in connection with animated motion picture "Steamboat Willie" and has over the years starred in more than 120 different

cartons. This character also starred in "The Mickey Mouse Club" television show in the 1950s. Various details of this character has been extracted in the plaint. Plaintiffs" have also extracted details of its trade mark in India in the plaint, which are reproduced below:

3. Learnedcounsel for the plaintiffs submits that defendants are carrying on the business of providing services under the trade name/style HOTEL DISNEY INN.

4. Learned counsel for the plaintiffs submits that mark of the plaintiffs is well known within the meaning of Section 2(1)(zg) of Trade Marks Act. Counsel further submits that based on its long user the plaintiffs claim that they have earned a huge goodwill and tremendous reputation through the world including in India. Counsel next submits that unauthorized use of such characters in relation to any items of merchandise would create a high degree of confusion and deception resulting in passing off.

5. While issuing summons in the suit and notice in the application on 2.6.2011, this Court had passed ex parte ad interim injunction in favour of the plaintiffs.

6. At the first call, learned counsel for the parties have submitted that parties are open for an amicable settlement. Accordingly, Mr. Hemant Singh, Advocate, who was present in the Court, was appointed as a Mediator in this matter. The matter was passed over once. At the second call, learned counsel for the parties submit that parties have arrived at an amicable settlement on the following agreed terms:

(i) Defendants admit the averments made by the plaintiff in the plaint and acknowledge that the mark of the plaintiff is well known within the meaning of Section 2(1)(zg) of the Trademark Act. Counsel for the defendants also submits that defendants have no objection if the present suit is decreed in terms of prayers i, ii, iii, iv & vi of the plaint, subject to condition that plaintiffs gives up relief in terms of prayer v of the plaint with regard to damages, to which plaintiffs have no objection;

(ii) Defendants would destroy all materials including business cards, brochures, signage, cutlery, crockery and all other items bearing the impugned name/ character DISNEY in the presence of the representative of the plaintiffs.

7. I have heard counsel for the parties. Having regard to the averments made in the plaintiff, the documents placed on record by counsel for the plaintiff, I am of the view that the settlement arrived at between the parties is lawful. The trademark WALT DISNEY and Disney Characters have acquired a tremendous reputation and goodwill throughout the world including in India so much so that the unauthorized use of such characters in relation to any items of merchandise would create a high degree of confusion and deception resulting in passing off. As a result of the plaintiff's exclusive and extensive use and protection of the characters, the said characters have achieved a secondary meaning identifying in the minds of the consuming public the goods and services of the plaintiff

exclusively.

8. Accordingly, as agreed, suit stands decreed in above terms of settlement leaving the parties to bear their own costs. Court appreciates the efforts put in by the learned Mediator, counsel for the parties and the parties to arrive at an amicable settlement.

9. In view of the settlement arrived at through Mediation, learned counsel for the plaintiffs submits that court fee be refunded to the plaintiffs in terms of Section 16 of the Court Fee Act. Let court fee be refunded to the plaintiff in terms of Section 16 of the Court Fee Act.

10. Applications stand disposed of in view of the order passed in the suit.