
(2014) 04 DEL CK 0226
In the Delhi High Court
Case No : C.S. (OS) 1710/2005

Ford Motor Company

APPELLANT

Vs

C.R. Borman

RESPONDENT

Date of Decision : 22-04-2014

Acts Referred:

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

Citation : AIR 2014 Delhi 165 : (2014) 59 PTC 132

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

Bench : Single Bench

Advocate : Pravin Anand, Shrawan Chopra and Vibhav Mittal, Advocate for the Appellant; Ajay Sahni, Kanika Bajaj, Vasudha Bajaj, Pallav Palit and Gautam Banerjee, Advocate for the Respondent

Final Decision : Allowed

Judgement

G.S. Sistani, J.—Plaintiffs have filed the present suit for permanent injunction, restraining infringement of trademarks, passing off, rendition of accounts of profits, damages, delivery up, etc. As per the plaint, which is duly supported by an affidavit of Mr. Mark S. Sparschu, plaintiff No. 1, Ford Motor Company, is a corporation organized and existing under the laws of Delaware, United States of America and having its principal place of business at Michigan, United States of America. In the plaint, the plaintiffs have given in detail the background of the plaintiffs' business and how the trade mark, trade name and house mark of the plaintiffs "FORD" was derived from its founder, Mr. Henry T. Ford, who started the Ford Motor Company in the year 1903. The plaintiffs have also detailed how over the past more than 100 years FORD has grown and continuously expanded its business and has become one of the biggest industrial conglomerates in the world.

2. Section 2(1)(zg) of the Trade Marks Act, 1999 defines "well-known trade mark", in relation to any goods or services as a mark which has become so to the substantial segment of the public which uses such goods or receives such

services that the use of such mark in relation to other goods or services would be likely to be taken as indicating a connection in the course of trade or rendering of services between those goods or services and a person using the mark in relation to the first-mentioned goods or services.

3. By way of the documents placed on record, the plaintiffs have been able to prove that the plaintiffs have been using the mark "FORD" as a part of their trade/corporate name and as a trade mark on its products and services continuously and extensively since the year 1903 and have been selling cars in India since the year 1908. Plaintiffs have also established the numerous trade mark registrations of the mark "FORD" obtained by them under various classes in India. Copies of trade mark registration certificates have been filed along with the plaint. Further, plaintiffs have established the widespread business activities carried out by them all over the world including in India. Extensive goodwill and reputation enjoyed by the plaintiff across the globe is not only evident from the hefty sales figures generated by them on annual basis that run into billions of dollars but plaintiffs have also proved the wide scale advertising and publicity undertaken by them over decades which is evident from the vast expenses incurred by them in their promotional and advertising campaigns. The wide spread goodwill and reputation earned by the plaintiffs is also evident from the fact that their trade mark "FORD" has been identified by Guinness Book of Business Records as the 7th most powerful brand name in the world and "Interbrand's Compilation of World's Top 100 Brands" has consistently listed "FORD" in the top 100 brands of the world. Copies of extracts of the Guinness Book of Business Records and extracts of Interbrand's Compilation of Worlds 100 Top Brands have also been placed on record. It has also been proved by the plaintiffs that ever since its establishment in India, in the year 1952, the FORD FOUNDATION has been carrying out various businesses/activities in India, primarily related to manufacture and sale of vehicles and because of the superior quality of products and services provided by the plaintiffs under the trade mark "FORD", public in general associates the said trade mark solely and exclusively with the plaintiffs. Popularity and trust that "FORD" has built up for its products and services among Indian public is also reflected in the immense number of vehicles successfully sold by "FORD" in India over the years.

4. In the case of Tata Sons Ltd. Vs. Manoj Dodia and Others, , following observations were made by another bench of this court with respect to the factors that ought to be looked into while considering what constitutes a "well-known mark":

"13. Trademarks Act, 1999 does not specify the factors which the Court needs to consider while determining whether a mark is a well known mark or not, though it does contain factors which the Registrar has to consider while determining whether a trademark is a well known mark or not. In determining whether a trademark is a well known mark or not, the Court needs to consider a number of factors including (i) the extent of knowledge of the mark to, and its recognition

by the relevant public; (ii) the duration of the use of the mark; (iii) the extent of the products and services in relation to which the mark is being used; (iv) the method, frequency, extent and duration of advertising and promotion of the mark; (v) the geographical extent of the trading area in which the mark is used; (vi) the state of registration of the mark; (vii) the volume of business of the goods or services sold under that mark; (viii) the nature and extent of the use of same or similar mark by other parties; (ix) the extent to which the rights claimed in the mark have been successfully enforced, particularly before the Courts of law and trademark registry and (x) actual or potential number of persons consuming goods or availing services being sold under that brand."

[Also See Rolex Sa Vs. Alex Jewellery Pvt. Ltd. and Others, .]

5. Having regard to the various factors detailed in the paragraphs foregoing, I am of the view that the plaintiffs have established beyond reasonable doubt that the plaintiffs' trade mark "FORD" is an extremely "well known" mark amongst members of the trade and the public at large. The long duration for which the said mark has been put in use by the plaintiff, the wide extent of the geographical area of use, the knowledge of the trademark "FORD" to the general public and its goodwill and reputation due to extensive promotion, publicity and advertisement, use of the mark as well as extensive sales made by the plaintiffs under the mark in India as well as other countries and the numerous registrations obtained of the mark, all establish the fact that the mark "FORD" used by the plaintiffs has undoubtedly acquired the status of a "well known mark".

6. During the pendency of this matter, the parties have entered into an amicable settlement. Authorised representative of defendants is present in Court. His statement on oath has been recorded separately. In his statement, he deposed that the defendants have no objection if the present suit is decreed in terms of para 40(a) and (b) of the plaint, provided all other reliefs are given up by the plaintiffs. He has undertaken to the Court that the defendants will not carry out any fresh production with the impugned trade mark and the logo of the plaintiffs "FORD". He has further undertaken to the Court that all the stock of shoes, which is approximately 60,000, shall be sold within eighteen months from today and thereafter all the remaining stock will be destroyed. He has also undertaken that within the same period all the finished and unfinished materials, accessories, packaging, labels, dies, blocks, stationery, etc., bearing the plaintiffs' trade mark/ name and logo "FORD" shall also be destroyed. It is also deposed that the defendants have no objection if the representative of the plaintiffs, after giving one week's notice to the defendants, inspect the premises of the defendants after eighteen months.

7. Statement of Mr. Pravin Anand, learned counsel for the plaintiffs, has also been recorded separately without oath. In his statement, Mr. Anand has stated that he has instructions to accept the terms of the settlement arrived at between the parties. Accordingly, as prayed, present suit is decreed in favour of the

plaintiff and against defendants in terms of para 40(a) and (b) of the plaint.