
(1993) 04 MAD CK 0037
In the Madras High Court

Dhinamalar

APPELLANT

Vs

Daily Thanthi

RESPONDENT

Date of Decision : 07-04-1993

Acts Referred:

Trade and Merchandise Marks Act, 1958 — Section 105, 106

Citation : (1993) 1 LW 533 : (1993) 2 MLJ 213

Hon'ble Judges : A.R. Lakshmanan, J

Bench : Division Bench

Judgement

A.R. Lakshmanan, J.—The applicant in O.A. No. 198 of 1993 is the plaintiff in the above suit. The suit was filed under Sections 105 and 106 of the Trade and Merchandise Marks Act for the following reliefs:

(a) For permanent injunction restraining the defendant from committing or continuing to commit any infringement of the plaintiffs name and mark "Siruvar Malar" or any imitation thereof or the name, colour combination, etc., of the expression "Siruvar Malar".

(b) Restraining the defendant from passing off their children's magazine as the magazine of the plain tiff by using the colour scheme, get up, or imitating any portion of the colour scheme get up or by using the name "Siruvar Malar" as found in the plaintiffs Document M.O.2.

(c) To render true and faithful accounts of all the profits earned by them through printing, publishing and sale of the offending mark.

(d) To surrender to the plaintiff all their impugned children's magazine containing the same name of the offending marks.

2. The plaintiffs case in short is as follows: The plaintiff is engaged in printing and publishing a Tamil Daily called "Dhinamalar", which is the second largest circulated daily of Tamil Nadu as per Audit Bureau Circulation. The paper was started in 1951. The average circulation of the daily is 2.2 lakhs. The paper has

established a reputation as a quality paper and a highly respected one. The plaintiff started a children's magazine in the name of Dhinamalar Siruvar Malar in 1984-85 for the benefit of children and supplied free with the Friday Edition of the paper. This supplement is very popular among the children of all age groups and the plaintiff has received several letters of appreciation for bringing out this supplement in their edition. The circulation of the newspaper on Friday alone has increased to 2.8 lakhs after this supplement was released, which will give an idea of the quality of the plaintiffs work and its reputation. The supplement is called "Siruvar Malar" with a Lotus, which is the symbol of the plaintiffs paper, in between the two words "Dina" and "Malar".

3. The paper is registered with Registrar of Newspapers of India. The defendant, who is a competitor in business, has also started and issued a children's magazine for the first time on 19.2.1993 captioned as "Siruvar Malar" from Daily Thanthi belonging to the defendant/respondent. The moment this issue was released, the plaintiff received a spate of letters from the public which will disclose the havoc that the defendant is attempting to make in publishing and releasing this supplement containing their name with the sole motive of creating total confusion among the Tamil reading public of Tamil Nadu, and particularly, the children who are interested in the supplement of the plaintiff. The conduct of the defendant is to pass off their goods as those of plaintiff's, which amounts to infringement of the plaintiffs, mark, which is their exclusive proprietary right, and the expression "Siruvar Malar" by long usage. Thus, it has become necessary for the plaintiff to prevent this piracy of their name and mark by the defendant any further by an order of injunction. The plaintiff has also filed O.A. No. 198 of 1993 for the following relief:

To pass an order of injunction restraining the respondent/defendant by themselves or their agents, servants, printers, publishers or distributors from committing or continuing to commit any infringement of the plaintiffs name and mark "Siruvar Malar" or any imitation thereof or the name, colour combination, etc., of the expression "Siruvar Malar" as per the artistic creation filed by the plaintiff by distributing, printing or causing the same to be printed, published or sold or from passing off their children's magazine, filed as M.O.1 along with the plaint, as the magazine of the plaintiff/ applicant filed as M.O.II, by using the same colour scheme or imitating any portion of the same or by using the name "Siruvar Malar" as found in M.O.II, pending disposal of the suit.

4. On 17.3.1993, this Court granted interim injunction for a period of two weeks. Notice was ordered to the defendant/respondent returnable by two weeks.

5. The defendant filed a detailed counter affidavit in O.A. No. 198 of 1993 and also filed a petition to vacate the interim injunction granted earlier, in Application No. 1507 of 1993.

6. The defendant/respondent raised principally the following points:

(a) The suit itself is not maintainable.

(b) The circulation of Daily Thanthi is substantially higher over 47% of the plaintiffs newspaper.

(c) The respect and reputation which a newspaper commands/and enjoys is measured by its readers and circulation.

(d) "Siruvar Malar" is a common generic term. It is untenable to state that the plaintiff has acquired exclusive right to use the same.

(e) "Siruvar Malar" -per se is not registered under the Trade and Merchandise Marks Act. The connotation "Siruvar Malar" cannot be acquired as a property right by usage by simply using the same along with the other proprietary trade name or mark "Dhinamalar".

(f) The plaintiff has suppressed the material fact of usage of the term "Siruvar Malar" combined with Dina Thanthi (logo) and Thanga-malar while pleading for the relief of injunction.

(g) Dina Thanthi has its own distinctive readers who by the Friday's issue for its news content Children's Magazine, is only an additional service offered to the readers as an extra facility.

(h) Dina Thanthi is celebrating its Golden Jubilee this year and to mark this event, they have captioned the children's supplement issued on Friday as "Dina Thanthi Thanga Malar" with the addition of the descriptive words "Siruvar Malar" printed in small letters.

(i) This supplement is supplied as free annexure to the newspaper published on Fridays. Only persons who ask for and buy Dina Thanthi on Fridays are given this free copy as annexure and hence, there is no question of passing off of defendant's goods as the goods of the plaintiff.

7. I have heard Mr. T.S. Subramaniam, learned Senior Advocate for the plaintiff/applicant and Mr. R. Krishnamurthi, learned Senior Advocate for the defendant/respondent. I have been taken through the entire pleadings and the documents filed by both sides. I have carefully considered the arguments of both sides.

8. Mr. T.S. Subramaniam, in support of his case, submits that the plaintiff has got an exclusive right for use of the name Dina Malar since it is registered, but as far as the name "Siruvar Malar" is concerned, by the long and continuous usage of the said name and mark in the Children's Magazine which was released by the plaintiff as early as in 1985-86. He further submits that the plaintiff has acquired the exclusive right to use, print, sell and exhibit this supplement every week with the name of use of the words "Siruvar Malar" and is exclusively associated with the plaintiffs paper Dina Malar and nobody else has got any right to infringe the same to pirate the same or pass off their supplement as though it is that of theirs. According to the learned Senior Advocate for the plaintiff, the right acquired by the plaintiff is a proprietary right in the use of the words "Siruvar Malar" associated with their paper Dina Malar and hence, the use of that

expression by the defendant in a manner deceptively similar to the one belonging to the plaintiff in colour combination, combination of types, etc., are clearly intended to pass off the goods of the defendant as that of the plaintiffs. Thus, the learned Senior Counsel submits that the conduct of the defendant to pass off their goods as those of the plaintiffs, amounts to infringement of the plaintiffs mark, which is their exclusive proprietary right by long usage.

9. Mr. T.S. Subramaniam has cited the following decisions in support of his contentions: John Walker and Sons v. Henry Ost and Company Limited (1970) 2 All Eng. L.R. 106, Maxim's Limited v. Dye (1978) 2 All. Eng. L.R. 55, The National Bank of India Vs. The National Bank of Indore, , B.K. Engineering Company, Delhi v. U.B.H.I. Enterprises (Regd.), Ludhiana AIR 1985 Del. 210, Ellora Industries, Delhi v. Banarasi Dass Goela AIR 1980 Del 254, Simatul Chemical Industries Pvt. Ltd. Vs. Cibatul Ltd., , Century Traders Vs. Roshan Lal Duggar Co., , Kala Niketan Vs. Kala Niketan, . 592, Com Corn Products Refining Co. Vs. Shangrila Food Products Ltd., , American Cyanamide Company v. Ethicon Limited (1975)1 All Eng. L.R. 504 and Reddaway v. Bentham Hemp-Spinning Company, (1892) 2 Q.B.D. 639.

10. Mr. R. Krishnamurthi, learned Senior Advocate for the defendant/respondent submits that the plaintiff has not made out any case for grant of injunction in their favour. According to the learned Senior Counsel, the expression "Siruvar Malar" is a common generic term denoting the description of contents i.e., feature of reading items of interest to children and it is not tenable to state that the plaintiff has acquired exclusive right to use that name and hence, there is no cause for confusion as wrongly claimed by the plaintiff among the readers of either Dina Malar or even Dina Thanthi about the Dina Thanihi's Siruvar Malar (sic.) as the title (first) page clearly mentions the words Dina Thanthi (Logo) Siruvar Malar-Thanga Malar. The learned Senior Counsel further submits that the plaintiff has suppressed the material fact of usage of the term "Siruvar Malar" combined with Dina Thanthi Logo and Thanga Malar while pleading relief of injunction in this Court. It is further urged that Dina Thanthi has its own distinctive readers who buy the Friday's issue for its news content and that the Children's Magazine is only an additional service offered to the readers as an extra facility and hence, there is no question of passing off or illegal profits as alleged by the plaintiff as the supplement is a free give-away alongwith the main issue and has no extra price of its own. The learned Senior Counsel has also reiterated the other contentions raised by the defendant/respondent in the counter-affidavit. The following decisions were cited by the learned Senior Counsel for the defendant/respondent: Office Clearing Services Limited v. Westminster Window and General Cleaners Limited, 63. R.P.C. 39, Canadian Shredded Wheat Company Limited v. Kellogg Company of Canada Limited AIR 1938 P.C. 143: 175 I.C. 178, Mothercare U.K. Limited v. Penguin Books Limited (1988) R.P.C. 113, Horlicks Malted Milk Company v. Summer Skill (1917) 34 I.O.J 63 , The Premier Motor Company (Birmingham) Limited v. Premier Driving School, (Birmingham) Limited (1962) R.P.C. 222, My Kinda Town Ltd. v. Soil,

1983 R.P.C. 407, Kaviraj Pandit Durga Dutt Sharma Vs. Navaratna Pharmaceutical Laboratories, and Teju Singh Vs. Shanta Devi, .

11. I have given my anxious consideration to the lengthy arguments of both the learned Senior Counsel. It is the admitted case of both parties that the expression "Siruvar Malar" is not registered. "Siruvar Malar" is a generic term which denotes that the contents in the magazine are meant for children. There is no dispute that the issue "Siruvar Malar-Dina Malar" is not sold separately. It is supplied alongwith Friday issue of newspaper Dina Malar free of cost. Therefore, a reader of Dina Malar Issue of Friday is supplied with Siruvar Malar free of cost.

12. Likewise, a reader of Dina Thanthi issue of Friday is supplied with "Thanga Malar-Siruvar Malar" free of cost. It is not sold separately. Only literate public will purchase the newspapers in question. There are separate set of readers for Dina Malar. Therefore, as rightly contended by Mr. R. Krishnamurthi, there is no likelihood of confusion in the minds of the readers as contended by Mr. T.S. Subramaniam, learned Senior Counsel for the plaintiff/applicant, of either Dina Malar and Dina Thanthi, about the Dina Thanthi Thanga Malar Siruvar Malar. (sic.) I have perused the documents filed by both sides. The words "Dina Thanthi-Thanga Malar" are printed in bold letters and they are of a bigger size than the "Siruvar Malar Dina Malar". Even a visual comparison of the "Dina Malar Siruvar Malar" and "Dina Thanthi-Thanga Malar-Siruvar Malar" would clearly reveal that there cannot be any confusion among the readers of either Dina Malar or Dina Thanthi. Further, the children's magazine is supplied alongwith Friday issue of newspapers of Dina Thanthi and Dina Malar to readers of the respective newspapers without any extra cost. It is not supplied, with a view to mislead the readers of either of the newspaper. As already mentioned, there is a separate distinctive class of readers who buy the Friday issue of Dina Thanthi and Dina Malar. These peculiar features impelled me to hold that the claim made by the plaintiff/applicant is untenable. Therefore, the prayer for injunction cannot be granted.

13. Both papers are leading Tamil newspapers having separate set of readers. They are in the field for the last so many decades. The words "Siruvar Malar" is a normal descriptive term. It cannot be treated as a proprietary right. There cannot be an infringement of any right of the plaintiff by passing off under Sections 105 and 106 of the Trade and Merchandise Marks Act or its Rules. Apart from that, there is another important feature. The words "Dina Thanthi" (Logo) and "Thanga Malar" are printed in very bold letters in Dina Thanthi Children's magazine, in type sizes bigger than the "Siruvar Malar" unlike the Dina Malar's issue which mentions Dina Malar (in Logo) in smaller size. I am of the opinion that since the lettering and logo of Dina Thanthi and Thanga Malar are bold and conspicuous, it cannot be held by any stretch of imagination as capable of misleading any reader into confusion that it is the Dina Malar's Children's Magazine. In my view, there is no basis for the allegation that Dina Thanthi Siruvar Malar-Thanga Malar is an attempt to pass off as the Dina Malar's Siruvar

Malar since, a perusal of the title pages of the Dina Thanthi-Siruvar Malar issue with the Logo Dina Thanthi and brand name Thanga Malar will amply demonstrate.

14. Above all, the supplement is supplied as free annexure to the newspaper published on Fridays. Only the persons who buy Dina Thanthi on Fridays are given this free copy as annexure without any extra cost. Hence, there cannot be any passing off of the defendant's goods as the goods of the plaintiff as alleged by the latter. It is equally untenable to contend that the defendant is passing off their supplement with the caption "Dina Thanthi-Thanga Malar" printed in bold letters as "Dina Malar-Siruvar Malar". The plaintiff has not made out any case for the grant of injunction in their favour till the disposal of the suit. The balance of convenience is not in favour of the plaintiff and it is only in favour of the defendant. No irreparable loss or injury will be caused to the plaintiff because of the refusal of injunction.-

15. As I am deciding the question involved in this case purely on the peculiar facts and circumstances of this case to come to a prima facie conclusion, I do not propose to refer to the various decisions cited by both the learned Senior Counsel for deciding the present controversy, as the facts of those cases bear no similarity to the peculiar facts of the present case.

16. For all the foregoing reasons, I vacate the interim injunction already granted in O.A. No. 198 of 1993 and allow Application No. 1507 of 1993. No costs.