
(2019) 07 DEL CK 0104

In the Delhi High Court

Case No : Civil Suits (COMM) No. 347 Of 2016

Dish TV India Ltd

APPELLANT

Vs

Prasar Bharti

RESPONDENT

Date of Decision : 16-07-2019

Acts Referred:

Trade Marks Act, 1999 — Section 9, 17, 30, 30(2), 31, 47, 124

Citation : (2019) 262 DLT 345 : (2020) 1 AD(Delhi) 504 : (2019) 79 PTC 325

Hon'ble Judges : Rajiv Sahai Endlaw, J

Bench : Single Bench

Advocate : Sandeep Sethi, Nupur Lamba, Sonal Chhablani, Rajeev Sharma, Radhalakshmi R., T. Rajat Krishna, Saket Chandra

Judgement

Rajiv Sahai Endlaw, J

IA No.20187/2014 (of plaintiff u/O XXXIX R-1&2 CPC)

1. The plaintiff has instituted this suit for permanent injunction restraining the defendant from infringing the trade mark "DISHTV" of the plaintiff

and from passing off the defendant's services as that of the plaintiff by adoption of the name / mark "FREE DISH" and for ancillary reliefs.

2. The suit came up first before this Court on 15th October, 2014, when the counsel for the defendant appeared on advance notice. Summons of the

suit and notice of the application for interim relief were issued and the counsel for the defendant directed to take instructions, whether the defendant

was agreeable to an amicable settlement. Pleadings were completed and no mention is found in any of the subsequent orders of any attempts at

amicable settlement being made. On completion of pleadings, issues in the suit were also struck on 26th August, 2016 but the application of the

plaintiff for interim relief remained to be heard, on most dates owing to non-

availability of the counsel for the defendant. In spite of issues having been framed nearly three years back, recording of evidence is still at an initial stage, with PW-1 having been only partly examined-in-chief as yet.

3. The counsels were heard on 13th November, 2018. After I made my mind clear to the counsel for the defendant, the counsel for the defendant stated that he needed to cite case law and sought adjournment. The hearing was again adjourned from time to time and the counsel for the defendant was further heard only on 16th November, 2018 and the hearing concluded on 22nd November, 2018 and orders reserved.

4. It is the case of the plaintiff Dish TV India Limited, (i) that the plaintiff is engaged in the business of providing Direct To Home (DTH) services

within the purview of the Interconnection (Broadcasting & Cable Services) Regulations framed by the Telecom Regulatory Authority of India

(TRAI); (ii) that the plaintiff was earlier known as ASC Enterprises Ltd. and which was changed to the present name Dish TV India Limited with

effect from 7th March, 2007; (iii) that the plaintiff has a subscriber base of more than 16 million, with capacity of more than 400 channels and movies

on demand; (iv) that the plaintiff, since 2003, has been providing DTH services under the brand name 'DISHTV'; (v) that the plaintiff is the

original coiner, first adopter and prior user of the trade mark / corporate name 'DISHTV'; (vi) that the word/mark 'DISH' is an integral and

distinctive element / feature of plaintiff's trade mark / trade name; (vii) that plaintiff has used the word 'DISH' as its leading and main mark

and offered services such as dish+, Dish TruDH+, dishonline, dishflix, dish active, dish dvr etc.; (viii) that the plaintiff is the registered proprietor of the

corporate name / trade mark / logo 'DISHTV' in numerous variants in Classes 9, 38, 16, 35, 42 and 41 with the first registration dating back to

15th July, 2003; (ix) that a large number of applications for registration of other marks / logos also with the word 'DISH' are pending

consideration; (x) that the corporate name / trade mark / logo 'DISHTV' is also protected under the Copyright Act, 1957; (xi) that the plaintiff

also has a website in the name of www.dishtv.in and 'DISH' is also an integral part of as many as 24 domain names registered in the name of

plaintiff viz. dish.co.in, dish.net.in, dishtv-india.gen.in, dish.firm.in, dish.ind.in etc.; (xii) that the defendant Prasar Bharti is a public broadcaster and is

also known as 'Doordarshan'; (xiii) that the defendant, in May, 2014 renamed its Free to Air DTH service 'DD Direct+' to 'FREE

DISH'; (xiv) that the defendant is bound to know about the plaintiff's well-known and registered mark, corporate name as well as its activities,

being engaged in identical service; (xv) that the defendant has also adopted a logo which is deceptively similar to that of the plaintiff's inasmuch as

the defendant's stylized logo contains the device of a dish which is also an integral and prominent part of the plaintiff's 'DISHTV' logo; (xvi)

that the defendant failed to desist in spite of cease and desist notice got issued in May, 2014; (xvii) that the defendant had also filed a trade mark

application in Class 41 for the mark 'FREE DISH'; (xviii) that the defendant is also misrepresenting 'FREE DISH' to be a registered trade

mark on its website www.ddindia.gov.in; (xix) that 'FREE DISH' adopted by the defendant infringes the plaintiff's mark 'DISHTV' as

well as copyright therein; and, (xx) that the defendant, by adopting 'FREE DISH', is passing off its services as that of the plaintiff.

5. The defendant has contested the suit pleading, (a) that there is no similarity between 'DD Free Dish' and 'DISHTV' and there is no

possibility of anyone being misled; (b) that 'DISH' is a generic word used to describe equipment which receives the satellite signals; (c) that

every DTH platform requires a Dish Antenna for receiving its signals; (d) that 'DISH' is publici juris and no one can claim exclusive right

thereto; (e) that the term 'DISH' is not distinctive in nature and none can claim exclusive right to use thereof; (f) that 'DD Free Dish' is the

only free to air DTH platform in the country; (g) that while a subscriber to the DTH platform of the plaintiff is required to make a periodical payment

to the plaintiff, no such payment is required to be made to the defendant and all that is required is the installation of a Dish Antenna and set top box for

receiving the signals; (h) that the plaintiff does not have any right in law to the exclusive use of the word 'DISH'; (i) that the possibility of

deception or confusion is nil, since there is no similarity whatsoever, whether phonetic or visual between the marks 'DISHTV' and 'DD Free

Dish'; (j) that while a customer wishing to subscribe to the DTH platform of the plaintiff would have to enter into an agreement, pay the price for the

Dish Antenna to be installed and make periodic payments; a customer tuning into the DTH platform of the defendant would only have to purchase an

appropriate set top box and a Dish Antenna from the market and would not have to enter into any agreement with the defendant or anyone else and would not have to make any periodic payments to the defendant or anyone else; (k) that a customer who wishes to subscribe to the DTH platform of the plaintiff, would never settle for the product of the defendant; (l) that the plaintiff itself claims its DTH service is superior to that of the defendant; (m) that when two rival marks contain features that are not only descriptive but also publici juris, the consumer will tend to ignore the common features and will pay more attention to the uncommon features; (n) that under Section 17 of the Trade Marks Act, 1999, registration of a trade mark confers rights in the mark as a whole and not in part or fragments of the mark; the plaintiff having chosen to brand its product with a generic word, "DISH", any other person entering the market would have the right to use the said term to identify the product in question and the plaintiff if had not desired so, ought to have branded its product with a unique name; (o) that the defendant, in line with its statutory obligation, is providing a DTH platform which can be availed of without any payment and for this reason named it "DD Free Dish"; (p) that the said mark / logo is not even remotely similar to the plaintiff's mark / logo "DISHTV"; and, (q) that a Dish Antenna is an equipment, which is in use by every person in the broadcasting industry and each of such persons has the right to use the image of a dish.

6. The plaintiff, in its replication has inter alia pleaded, (I) that from the factum of the defendant operating its DTH platform since the year 2004 under the mark "DD Direct+" and in January, 2014 changing its mark "DD Direct+" to "DD Free Dish", the motive to benefit from the reputation and goodwill of the plaintiff and to create confusion, is writ large; (II) the adoption by the defendant of the impugned mark, for identical services, establishes the mala fide intention of the defendant; (III) the defendant has also adopted the stylization of the mark of the plaintiff; (IV) due to a close proximity of the satellites carrying "DD Direct+" with the satellite carrying "DISHTV", it results in a situation wherein the recipients unavoidably receive the free to air signal of "DD Direct+" by the Dish Antenna of Dish TV; the same also leads to the broadcast of the Dish TV containing the "DD Direct+" logo alongside the "DISHTV" logo, resulting in confusion; (V) resultantly, the broadcast of

DISHTV also contains the logo of FREE DISH, thereby leading to immense confusion amongst customers as well as general public vis-

a-vis trade association between the plaintiff and defendant; (VI) in spite of the said confusion persisting, the defendant chose to adopt a trade mark

deceptively and confusingly similar to the plaintiff's trade mark; (VII) the defendant having itself applied for registration of the mark FREE

DISH vide Trade Mark Application No.2592320 in Class 41, is estopped from contending DISH to be generic, non-distinctive or publici juris;

and, (VIII) the plaintiff was the first in India to adopt and use the word DISH as part of its trade mark / name in relation to DTH services and

the said mark is exclusively associated with the plaintiff.

7. After part hearing on 12th April, 2017 on this application of interim relief, the defendant filed an additional affidavit dated 14th September, 2017

explaining the position with respect to proximity of satellite of the defendant with the satellite of the plaintiff. In the said affidavit, it has been explained

that today it is not possible for the Dish of DISHTV to receive signals of DD Direct+ (now known as DD Free Dish) because all

contents provided to subscribers of private Dish TV platforms, irrespective of source, has to pass through encryption and conditional access system,

resulting in the signals of every channel carried on the private DTH platform being available to subscribers of that private Dish TV platform only and

private Dish TV platforms are mandatorily required to carry specified Doordarshan channels. The signals and logo of DD Free Dish appear

because DISHTV allows them to appear for its commercial consideration.

8. The senior counsel for the plaintiff has argued:

(A) that the defendant has adopted the most prominent part of the plaintiff's mark for identical services; reliance in this regard is place on United

Biotech Pvt. Ltd. Vs. Orchid Chemicals & Pharmaceuticals Ltd. 2012 (50) PTC 433 (Del) (DBL), axmikant V. Patel Vs. Chetanbhat Shah 2002 (24)

PTC 1 (SC) and Himalaya Drug Company Vs. S.B.L. Limited 2013 (53) PTC 1 (Del) (DB);

(B) that though the defendant was earlier claiming FREE DISH to be a registered trade mark, but after the institution of the present suit has

stopped claiming so;

(C) reliance is placed on Automatic Electric Limited Vs. R.K. Dhawan (1999) 19

PTC 81 (Del) and Procter & Gamble Manufacturing (Tianjin) Co.

Ltd. Vs. Anchor Health & Beauty Care Pvt. Ltd. (2014) 211 DLT 466 (DB) to contend that the plea, of "DISH" being generic or publici juris, is

not available to the defendant, which itself has sought registration thereof;

(D) reliance is placed on Midas Hygiene Industries P. Ltd. Vs. Sudhir Bhatia 2004 (28) PTC 121 (SC)to contend that in the absence of any

explanation by the defendant for the reason for change from "DD Direct" to "DD Free Dish", mala fides of the defendant are evident;

(E) that the Registrar of Trade Marks, by granting registration to the trade marks of the plaintiff, has considered them capable of distinguishing the goods / services of the plaintiff;

(F) that the test applied in Ramdev Food Products (P) Ltd. Vs. Arvindbhai Rambhai Patel (2006) 8 SCC 72 6and United Biotech Pvt. Ltd. supra is of the essential features of the mark;

(G) that on the aspect of generic / publici juris, attention is invited to Time Warner Entertainment Company, L.P. Vs. A.K. Das 1997 (17) PTC 453

(Del), qua Home Box Office and on Info Edge (India) Pvt. Ltd. Vs. Shailesh Gupta 2002 (24) PTC 355 (Del), qua Naukri.com;

(H) reliance is placed on Baker Hughes Limited Vs. Hiroo Khushalani (1998) 74 DLT 715, laying down that the mere fact that the customers are

sophisticated, knowledgeable and discriminating, does not rule out the element of confusion and to contend that the test of confusion is of initial

confusion; and,

(I) reliance is placed on Bhole Baba Milk Food Industries Ltd. Vs. Parul Food Specialities Pvt. Ltd. (2012) 186 DLT 234 (DB) to contend that

whether a common word such as "DISH" has acquired secondary distinctiveness is primarily a question of fact.

9. Per contra, the counsel for the defendant has argued:

(i) that the difference of paid and free and the difference in subscriber base, distinguishes the services of the plaintiff and the services of the defendant;

(ii) that there is another registration with "DISH", relating to telecast services (however, it is admitted that the same is not telecasting in India);

(iii) that the judgments holding that a person who has himself applied for

registration of the same mark is estopped from contending the mark to be generic, have not considered that there can be no estoppel against the statute; reliance is placed on Hi-Tech Pipes Ltd. Vs. Asian Mills Pvt. Ltd.

(2006) 32 PTC 192;

(iv) that the test of similarity / deceptive similarity, to be adopted, is as laid down in Gufic Ltd. Vs. Clinique Laboratories, LLC 2010 (43) PTC 788

(Del);

(v) that 'DD' refers to 'Doordarshan'; free indicates that the service is available free of charge; 'DISH' indicates that the Direct to

Home service is free;

(vi) that the mark 'DD Free Dish' is not similar or deceptively similar to 'DISHTV';

(vii) reliance is placed on Rhizome Distilleries Pvt. Ltd. Vs. Pernod Ricard S.A. France 2009 SCC OnLine Del 3346 to contend that if words of

common parlance are used, exclusivity cannot be claimed and that the use of a prefix would invariably result in distinguishing the rival products;

(viii) that no commercial gain accrues to the defendant from use of the word 'DISH';

(ix) that the mode and manner of use of the two DTH platforms shows that there can be no possibility of confusion;

(x) that difference in pricing and the class of people using the services is also the test to be applied; reliance is again placed on Gufic Ltd. supra;

(xi) that the plaintiff has no separate registration of the word 'DISH' and has registration of the mark 'DISHTV' and cannot claim exclusive

right to 'DISH'; reliance is placed on Carlsberg India Pvt. Ltd. vs. Radico Khaitan Ltd. 2012 (49) PTC 54 (Del);

(xii) that without establishing by evidence, it cannot be claimed that the mark 'DISHTV' has achieved distinctiveness or secondary meaning;

reliance is placed on Rich Products Corporation Vs. Indo Nippon Food Ltd. 2010 SCC OnLine Del 734 (DB) and Bhole Baba Milk Food Industries

Ltd. Vs. Parul Food Specialities (P) Ltd. 2011 SCC OnLine Del 288;

(xiii) that recording of evidence has already commenced and there is no need for any interim order; and,

(xiv) that 'DD Free Dish' service provides 80 channels to subscribers, without any payment or charge whatsoever and it is targeted towards

rural households and has about 30 million subscribers and any change in the name of the defendant's DTH service would create confusion in the minds of the rural masses.

10. I have considered the rival contentions.

11. The main thrust of the defendant is, on the word "DISH" being generic and/or publici juris and/or common to the trade and the plaintiff,

therefore, notwithstanding holding a registered mark, being not entitled to prevent the defendant from use thereof. The said defence is based on

Section 9 of the Trade Marks Act titled "Absolute Grounds for Refusal of Registration", which prescribes that trade marks which are devoid of

any distinctive character and incapable of distinguishing the good or services of one person from those of another person and which consist exclusively

of marks or indications which serve in trade to designate the kind, quality of the service or which have become customary in the language practiced in

the trade, shall not be registered.

12. However, the fact remains that the mark "DISHTV", notwithstanding the said provision, stands registered, as of today, for the last 16 years

and none objected to registration thereof or has till date sought removal of the registration. The defendant also, though has chosen to use the word

"DISH" as a part of its mark and though having commenced such use since the year 2004 has in the last 5 years, not bothered to seek removal of

registration of the plaintiff's mark. The question which arises is, whether the defendant, having chosen not to do so, when sued for infringement, is

entitled to defend the claim for infringement on such grounds.

13. This Court is not empowered to remove the mark from the register and the power to do the same vests exclusively in the Registrar of Trade

Marks or in the Intellectual Property Appellate Board (IPAB), under Section 47 of the Trade Marks Act.

14. On the contrary, vide Section 31 of the Trade Marks Act, in this proceeding, registration of the mark is prima facie evidence of the validity

thereof.

15. Though Section 31 uses the word "prima facie", but owing to Section 47 of the Trade Marks Act vesting jurisdiction to determine validity, only

in the Registrar or IPAB, the occasion for this Court to render a final view in this regard never arises.

16. Section 124 of the Trade Marks Act provides for stay of proceedings in the suit for infringement where the validity of registration is questioned.

While so staying the proceedings, the Court is required to take a prima facie view on the plea of validity. The defendant however has not applied

thereunder also, for this Court to take a prima facie view on the validity of the mark.

17. The conclusion therefore at this stage is that the plea raised by the defendant, of the word 'DISH' being publici juris and/or generic or common to the trade, is of no avail.

18. Section 30(2) of the Trade Marks Act however provides that a registered trade mark is not infringed where use thereof in relation to services

indicates the kind or intended purpose of the service or other characteristics of service. The only question to be considered thus is whether use by the

defendant of 'DISH' as part of its mark is intended to indicate the kind and/or purpose of the service being provided by the defendant.

19. The defendant has not even pleaded so. Rather, the defendant has admitted that from the year 2004 till the year 2014, it was marketing the same

service under the name DD Direct+. It is also not the case of the defendant that only the plaintiff and the defendant and none other is providing the

said service. The defendant also does not state that owing to the word 'DISH' being generic or publici juris, others providing the said service are

also using the said word or are necessarily required to use the said word.

20. When the defendant itself was able to provide the said service without using the word 'DISH' from 2004 to 2014 and when others also are

providing the same services as the plaintiff and the defendant, without using the word 'DISH', it is not open to the defendant to say that the use

of the word 'DISH' by the defendant is indicative of the kind or characteristic of services being rendered by the defendant. Thus, none of the

defences under Section 30 of the Trade Marks Act are available to the defendant.

21. 'Dish' is a word in the English language, classified as a noun and meaning, 'a shallow, flat bottomed container for cooking or serving

food' or 'a shallow, conclave receptacle, especially one intended to hold a particular substance'. A 'satellite dish' is a dish shaped type of

parabolic antenna designed to receive or transmit information by radio waves to or from a communication satellite. A 'Dish Antenna' is

described as "common in microwave systems used for satellite communication and broadcast reception, space communications, radio astronomy

and radar". Direct to Home (DTH) technology enables a broadcasting company to directly beam the signal to the television set through a

receiver that is installed in the house, without any need for a cable connection. DTH broadcasting service refers to the distribution of multichannel TV

programme in Ku Band, by using a satellite system by providing TV signals direct to subscribers premises; for DTH connection, the broadcasting

company provides a set that comprises a "dish and a receiving set"; the company beams an encrypted signal that only the set installed in a

subscribers house can receive and enable viewing. My readings on the subject show that the dish shape is pretty much irrelevant inasmuch as it is

merely a reflector and lens to focus on the signal. The vital part is the Low Noise Block downconverter (LNB) i.e. the equipment mounted on the

front of the dish, which transmits the signal to the set top box or the receiver. What thus emerges is that (a) it is not as if "Dish" or "Dish

Antenna" is confined to DTH service; as aforesaid, it is common to all satellite communications and broadcasts; and, (b) "Dish" or "Dish

Antenna" is not essential to DTH service; what is essential is the LNB and the set top box; "dish" only serves the purpose of focusing the signal

on LNB and which can be achieved by other means also, without the "Dish". This explains why the defendant, as aforesaid, has not pleaded so.

What follows is, that "Dish" is not generic to DTH service or publici juris and/or common to the trade of DTH service for it to be said that

adoption thereof by plaintiff for its DTH services cannot prevent the others providing same service from using the same for the reason of its being

essential for them for describing their service. "Dish" may be generic to the business of cooked food or utensils, but certainly not to providing

television service.

22. The only other ground of challenge is that the comparison has to be between the marks "DISHTV" and "DD FREE DISH" and that the

said comparison does not pass the test of infringement.

23. However, the said contention is contrary to United Biotech Pvt. Ltd., Laxmikant V. Patel and Himalaya Drug Company supra cited by the senior

counsel for the plaintiff, in all of which the test applied was of use by the

defendant of a prominent part of the plaintiff's registered trade mark and applying which test, a clear case of infringement is made out. However, considering the stage of the suit, I must add prima facie.

24. The only other part of the plaintiff's mark, besides 'DISH', is 'TV' and which is indeed incapable of distinguishing. Even though the

defendant's mark has the word 'DD' and which indeed is associated by all concerned with Doordarshan, but considering the complex public

private partnerships / ventures and different business modules prevalent today, it cannot be said that the same is incapable of breaking the connection

or identity which is bound to be formed in the minds of a consumers / subscribers or public at large, finding the word 'DISH' being used by the

defendant for the service which was earlier called 'DD Direct+' by the defendant. It is well-nigh possible for the consumers / subscribers to

form an opinion that the plaintiff, in association with Doordarshan, is providing certain free channels also and may result in the consumers / subscribers

wanting the paid channels of the plaintiff also to be telecast free. There can be similar other myriad opinions which can be formed because of such

association. The entire law of trade marks is to prevent the same from happening and once the possibility of such opinions / impressions being formed

is found to exist, the law has to intervene and stop infringement.

25. The elements of irreparable injury and balance of convenience are implicit.

26. Though the counsel for the defendant has also contended that the recording of evidence having begun, interim order should not be passed at this

stage, I am constrained to observe that the pace at which the defendant is participating in the suit, causing delay at each and every step, does not give

credence to the said argument. As aforesaid, in spite of issues being framed nearly three years ago, the recording of evidence is at a nascent stage.

At this pace, the final decision of the case is still several years away.

26. As far as the contention of the counsel for the defendant regarding public interest is concerned, it cannot be lost sight of that the defendant, after

ten years changed the name of its service from DD Direct+ to DD Free Dish. It is not the case of the defendant that in doing so, any such

consequence followed. The defendant has also not disclosed the need for such change. There is no reason for the defendant to now, upon being asked

to make the change instead of affecting the same voluntarily, suspect any such

harm to the public. Moreover, the said aspect can be taken care of by providing sufficient time to the defendant to make its customers / subscribers aware of the change including on its own telecast.

27. Rather, I am dismayed that the defendant, a public sector enterprise, indulged in using another's trade mark and in spite of the plaintiff objecting thereto, refused to act reasonably. The same is not expected of a public sector enterprise which according to the proclaimed litigation policy of the Government is not to be indulged in. It is at least now expected that the officials responsible for conduct of the business of the defendant will bestow attention thereto and take a call, whether it is worthwhile to contest this litigation, obviously at the cost of the exchequer.

28. The aforesaid being the characteristic of the controversy, it is not deemed necessary to burden this judgment by a discussion on plethora of other judgments which have been cited, when the two crucial issues have been dealt with hereinabove.

29. The application is thus allowed. The defendant, during the pendency of the suit is restrained from infringing the trade mark of the plaintiff by adopting the mark "DD FREE DISH" or any other mark incorporating the word "DISH" in it.

30. However, the defendant is granted three months time to inform its consumers / subscribers of the new name, so as to not cause any of the consumers / subscribers to suffer as has been canvassed.

31. The application is disposed of.

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32. List before the Joint Registrar on 24th July, 2019 for scheduling the date/s of trial.