

(2008) 05 DEL CK 0179

In the Delhi High Court

Case No : I.A. No's. 6052 and 7855 of 2005 in CS (OS) 1085 of 2005

TV Today Network Limited and Another

APPELLANT

Vs

Kesari Singh Gujjar and Others

RESPONDENT

Date of Decision : 19-05-2008

Acts Referred:

Citation : (2008) 38 PTC 262

Hon'ble Judges : S. Ravindra Bhat, J

Bench : Single Bench

Advocate : Siddharth Chopra, for Saikrishna Associates, for the Appellant; Y.D. Nagar and Sandeep, for the Respondent

Final Decision : Dismissed

Judgement

S. Ravindra Bhat, J.—This order shall dispose of I.A. No. 6052/2005 and I.A. No. 7855/2005 preferred under Order 39 Rule 1 and 2 and Order 39 Rule 4 of the Code of Civil Procedure, 1908, respectively.

2. The facts relevant for the present purposes are as follows. Both the Plaintiffs are duly incorporated companies having their registered office in New Delhi. It is averred that the second Plaintiff is the publisher of several reputed publications including "India Today" and "Readers Digest". It is also engaged in the production of the TV news programmes from the year 1987. It is averred that since it had sufficient expertise in mass media and due to the popularity of its ventures, it decided to commence a news programme in Hindi to be telecast in Doordarshan, in 1995 under the name "Aaj Tak". It is submitted that due to its popularity, it decided to apply for registration of trademark in respect of the term "Aaj Tak". The second Plaintiff also acquired trademark registration in respect of Subha Aaj Tak, Khel Aaj Tak and Saptahik Aaj Tak under Class 9. In 2000, it launched a 24-hour news channel under the name "Aaj Tak", which became an instant hit. The first Plaintiff promoted the second Plaintiff, to manage and administer the said channel, as a new corporate entity. The former also licensed the use of the word, logo and trademark in "Aaj Tak" with respect to the news

channel to the latter.

3. It is claimed that term "Aaj Tak" is an arbitrary, unique combination of two words in the Hindi language, thereby, making the mark a highly distinctive one. Further, since the Plaintiffs have been using the said mark continuously since 1995, members of the public associate the mark only with them and the combination has become synonymous with them. The Plaintiffs also aver that considerable sums of money were spent for promotion of the said brand and have produced figures in relation to its growing revenue, the viewership of around 19.4 million (as on April 2005), and say that the channel is highly popular. The Plaintiffs further aver that the numerous awards received by the channel over the years, has cemented its goodwill and reputation. Besides these, the Plaintiff also uses the domain name www.aajtak.com. where the said mark and logo are depicted, in order to provide news through the Internet. It is claimed that this Internet site too is highly popular and that it also owns the proprietary rights in other domain names such as www.aajtakfirm.in, www.aajtak.Co.in and www.aajtak.org.in among others. It is therefore, claimed that the said mark is a well-known mark within the meaning of Section 2(1)(zg) of the Trade Marks Act, 1999 (hereafter "the Act").

4. The Plaintiffs claim that in 2005, they discovered that the Defendants were publishing a Hindi newspaper adopting the same word mark as that of theirs.

It is alleged that the Defendants have also registered an email address, namely, aajtakindia@rediffmail.com. which further proves the malafide intention of the Defendant. They further allege that the said newspaper is a weekly publication in Hindi and is being sold free of cost in Delhi and Noda. The mark of the Defendant is phonetically identical and visually similar to that of the Plaintiffs, and the Defendants use a similar style of representing their mark in various advertisements. These practices, the Plaintiffs claim, are intentionally carried out with a view to create confusion in the minds of the public and to unlawfully benefit from the Plaintiffs reputation and goodwill. The adoption of an identical mark, the Plaintiffs allege, is neither bona fide nor innocent, as it is an arbitrary coinage, thereby distinctive of the Plaintiffs. It is therefore, submitted that the acts of the Defendants, prima facie, not only amount to infringement u/s 29 of the Act but also passing off.

5. Mr. Siddharth Chopra, learned Counsel appearing on behalf the Plaintiffs contended that since a prima facie case of infringement and passing out has been made out by the Plaintiffs and therefore, the injunction must be confirmed. Further, as the Plaintiffs coined the said arbitrary and distinctive mark, since the Plaintiffs were the first and prior users of the said mark, and since such adoption was completely malafide with the intention to deceive, the court must restrain the Defendants from further harming their goodwill. In support of these propositions, learned Counsel relied on *Century Traders v. Roshan Lal* 15 DLT (1979) 43 : PTC (Supp) (1) 720 (Del) (DB); *Bharti Enterprises v. C Lall Gopi* (1999) 19 PTC 51 and *Midas Hygiene v. Sudhir Bhatia* (2004) 28 PTC 121

respectively. He further contended that since the field of activity of the Defendants is closely related to that of the Plaintiffs, there is a high possibility of confusion in the minds of the public and therefore, it clearly amounts to infringement u/s 29 of the Act. He placed reliance on *Ellora Industries v. Banarsi Dass* (1981) PTC 46 : 1981 (1) PTC 46 (Del) in this regard. Learned Counsel also drew the attention of this Court to the decision in *Hindustan Pencils v. India Stationary* (1989) PTC 61, to argue that delay or acquiescence does not defeat an action for injunction.

6. The Defendants on the other hand aver that the Plaintiffs have suppressed material information from the Court. They aver that their newspaper has been in publication and circulation since 1996, when it was registered with the Office of Registrar of Newspapers for India, Ministry of Information and Broadcasting, bearing No. 64796/96. It is averred that since the Plaintiffs are also engaged in publishing magazines and newspapers, they would have also known that registration was a pre-requisite for obtaining the right to the title in the newspaper. Further, the Defendant also avers as to how, the Plaintiffs have been on numerous occasions, denied registration because of the prior registration of the Defendants under the Press and Registration of Books Act, 1867 (hereafter the PRB Act).

7. It is further averred by the Defendants that since they possess a valid registration since 1996, the Plaintiffs have acquiesced to the publication of the Defendant's newspaper and therefore, are now estopped from raising any plea in relation to infringement of trademark and passing off. Further, at the time of filing the suit the Plaintiffs' mark was not even registered with respect to newspapers. The Defendants aver that it has been in the market since 1996, much before the Plaintiffs started their news channel, and therefore, it cannot be said that the Defendants were attempting to take unfair advantage of the Plaintiffs' goodwill. The law of infringement and passing off, it is submitted protects a bonafide prior user of the mark.

8. Mr. Nagar, learned Counsel appearing on behalf of the Defendants contended that injunction being an equitable remedy, suppression of material facts disentitles the applicant from seeking injunction. In this regard, he chose to rely on *M/s. Seemax Construction v. State Bank of India* AIR 1992 Del 197 and *Prof. A.K. Sanyal Vs. Dr. Chitta Ranjan Basistha and Others*, He further relied on *Sakal Papers (P) Ltd. and Others Vs. The Union of India (UOI)*, and *Tata Press Ltd. Vs. Mahanagar Telephone Nigam Limited and Others*, to assert that the right to publish a newspaper was an integral part of the right to freedom of speech and expression and that the injunction if granted would restrict the said right. Learned Counsel further placed reliance on *Times Publishing House Ltd. Vs. The Financial Times Ltd.*, to argue that the PRB Act is a special law which not only provides for printing and publishing of newspapers but also safeguards the title of the newspapers. A trademark registration it is submitted does not entitle anybody to publish a newspaper. In the present case, he contended registration

under the PRB Act was obtained by the Defendants much before the Plaintiffs applied for registration of the trademark in relation to the news channel. The PRB Act being a special law, it is contended, must prevail and the Defendants must be permitted to use the said title.

9. First, the issue of delay and acquiescence. It is a fairly well settled proposition of law, that mere delay in bringing the claim, will not defeat an action for infringement and passing off, particularly the former. In order to defeat the claim, the delay must be of an inordinate nature and mere delay by itself is not recognized as a defense (*Novartis A.G. v. Wanbury Ltd.* 2005 (31) PTC 75 (Del.) *Cluett Peabody v. Hogg McIntyre* (1968) RPC 335; *Vine Products Ltd. v. Mackentze and Co.* (1969) RPC 1; *Moolji Sicca and Co. Vs. Ramjan Ali*, . In *Whitman v. Disney Productions* 263 F2d 229, the appellate court observed as follows:

Mere passage of time cannot constitute laches, but if the passage of time can be shown to have lulled the Defendant into a false sense of security and the Defendant acts in reliance thereon, laches may, in the discretion of the trial court, be found.

In *Hindustan Pencils v. India Stationary* (supra), this Court had, after referring to numerous authorities, held that delay and acquiescence are two different concepts. While delay would be mere passage of time, acquiescence occurs when the proprietor of the trademark in full knowledge of his rights and knowing the infringer is ignorant of them, does something to encourage the infringer's misapprehension, with the result that the infringer acts upon his mistaken belief and worsens his position. In the present case, the Plaintiffs have done nothing to encourage the Defendant's mistaken belief. They became aware about the Defendant's publication just before the suit was filed. The delay in this case, therefore cannot be held to constitute an inordinate delay in order to defeat the present action. Therefore, the Defendant's plea of delay and acquiescence has to be negated.

10. In cases concerning infringement of trademark and passing off, the Supreme Court has time and again held that the standard to be adopted is that of "likelihood of confusion" and not actual deception and actual damage. It has held that the courts will have to determine the likelihood of confusion and deceptive similarity, in order to arrive at a prima facie finding of infringement, keeping in mind the following considerations:

(a) the broad and essential features of the of competing marks will have to be viewed, (b) the marks will have to be considered as a whole in their respective contexts, (c) the similarities rather than dissimilarities will have to be taken note of and (d) the marks must be judged from the point of view of unwary purchaser of average intelligence and imperfect recollection *Ruston and Hornsby Ltd. Vs. The Zamindara Engineering Co.*, , *Parle Products (P) Ltd. Vs. J.P. and Co.*, *Mysore, Amritdhara Pharmacy Vs. Satyadeo Gupta*, *Heinz Italia and Another Vs.*

11. In the present case, the Defendant has adopted a mark which is phonetically and literally identical to that of the Plaintiffs, in relation to products and services, which are closely associated and similar to the ones in relation which the Plaintiff employs its trademark. Moreover, both the Plaintiffs and the Defendants exclusively use Hindi in their media products and services. The Defendant has not been able to show any proof as to the circulation figures and geographical presence, nor has he been able to show any proof relating to the volume of publication. In these circumstances, the Defendant is restrained from using the mark "Aaj Tak" or any deceptively similar term in relation to the newspaper or any similar products and services, pending trial of the suit.

12. As regards the contention of the Defendant concerning the right to freedom of press is concerned, the question of an injunction restraining it from infringing a registered trademark violating such a fundamental right does not arise. The Defendant is free to propagate its views and publish news which it chooses to, provided it does not infringe the Plaintiffs trademark. As far as applicability of the Times Publishing House Limited decision of the Karnataka High Court is concerned, this Court has explained, in *Playboy Enterprises, Inc. v. Bharat Malik* 2001 PTC 328 (Del) that the Press and Registration of Books Act, 1867 (PRB Act) only concerns registration of a concern for purpose of publication. That enactment does not deal with various aspects of trademarks, the rights of trademark owners, actions and remedies for infringement, and other remedies for which provision is made under the Trademarks Act, 1999. Therefore, merely if a person or concern secures registration under the PRB Act, he does not possess the right to infringe the trademark of another acquired on the basis of its established distinctiveness.

13. In view the above reasons, the interim injunction granted earlier in the suit has to be confirmed. I.A. No. 6052/2005 is therefore, allowed. For the same reasons, I.A. No. 7855/2005 is dismissed. No costs.