

MANU/DE/1378/2004

Equivalent Citation: 116(2005)DLT88, 2005(30)PTC44(Del)

IN THE HIGH COURT OF DELHI

IA No. 1382/2004 in CS(OS) No. 208/2004

Decided On: 20.11.2004

Appellants: **Twentieth Century Fox Film Corporation**
Vs.
Respondent: **ASC Enterprises Ltd.**

FX Channel Case

Hon'ble Judges/Coram:

Mukul Mudgal, J.

Counsels:

For Appellant/Petitioner/plaintiff: C.M. Lall and Shikha Sachdev, Advs

For Respondents/Defendant: Rajiv Nayyar, Sr. Adv. and Pratibha M. Singh, Adv.

Subject: Intellectual Property Rights

Case Note:

Intellectual Property Rights - Interim injunction - Application filed for interim relief in a suit for passing off and unfair competition - Held, Defendants' adoption of the mark at annexure Z which has Zee letters in white Along with word Z in brown and word M and staggered X were sufficient to distinguish the Defendant's mark from that of Plaintiff - Once such a mark was used and the channel Zee identified clearly to demonstrate that the channel 'MX' belong to Zee Network and is being marked as 'MX', there was no reasonable possibility of confusion or deception of a possible viewer - Suit was mainly about a mark seen on the visual media such a change offered to be made is sufficient to redress the grievance averred by the Plaintiff - Defendant's altered mark labelled (Z) with that of the Plaintiff's, no possibility of deception or confusion of any kind whatsoever exists and thus the Plaintiff had not made out any prima facie case for grant of interim injunction in its favor - Interim measure during the pendency of the suit and without prejudice to their rights the Defendant was permitted to use the logo as marked Z having Zee letters in white imposed upon the letter Z in brown and letters M with a staggered X and no other and further relief claimed in the application for interim relief was warranted and/or justified - Directions disposed of.

JUDGMENT

Mukul Mudgal, J.

1. This is an application for interim relief in a suit for passing off and unfair competition. This suit has been instituted by the plaintiff, Twentieth Century Fox Film Corporation, and relates to the 'FX' channel launched by it in June 1994 which has diverse programmes including motion picture films which include action films from the plaintiff as well as other major studios. Various other popular programmes also aired on the said channel and the channel is available in UK, US. The plaintiff has thus proprietary rights in the mark 'FX' used by it extensively since 1994. In India the plaintiff is the registered proprietor of the mark 'FX'. The 'FX' channel has been extensively advertised and has had extensive media coverage in several well circulated magazines and journals. Thus the 'FX' channel and its programmes have become synonymous with the plaintiffs. The defendant had launched Direct to Home (DTH) services in October 2003 and was intending to launch 'FX' channel. The plaintiff has filed the present application in the pending suit to restrain the use of 'FX' channel by the defendant so as to seek injunction against the defendant from using the mark 'FX' so as not to violate the rights of the plaintiff.

2. In reply the defendant has contended that it has a group of companies including Zee TV, Zee News, Zee, Cinema, Zee Music, Zee MGM, Zee English, Alpha Channels, Alpha Bengali, Alpha Gujrat, Alpha Marathi, Alpha Punjabi, Niche Channels, Smile TV, Trendz TV and 'FX'. It also include several originally launched bouquets. The defendant originally was reaching its viewers through cable but recently has got a license to run the DTH platform television service. The 'FX' channel only runs on DTH platform.

3. It is, inter alia, contended by the defendant that :

- a) 'FX' is a highly descriptive word and nobody has a monopoly over its use.
- b) 'FX' has not acquired the secondary meaning of distinctiveness in favor of the plaintiff.
- c) No goodwill or reputation in India was established in respect of the mark 'FX' and the mere fact of advertisements in foreign magazine does not confer any rights on the plaintiff.
- d) No likelihood of confusion exist between the plaintiff and the defendant's established mark.

4. During the course of arguments the defendant agreed to alter its channel to another mark 'MX'. Thus it is the defendants' submission that without admitting the correctness of the averments of the plaintiff, the altered mark will leave no manner of doubt or confusion between the two competing marks. The defendants has thus suggested that it will alter its mark to 'MX' instead of 'FX'. The defendants also agreed to put the mark Zee ato MX. It has also indicated that the word Z on Zee will be seen in the reasonably prominent manner so that there will no doubt or confusion about the mark belonging to the Zee network. Learned counsel for the defendant had filed three suggested and altered logos which are marked as X Y and Z. The counsel for the plaintiff however did not agree to the logos proposed by the defendant and wanted a decision on merits.

5. A bare perusal of the Mark 'MX' (marked Z) suggested by the defendant which I have compared with the plaintiff's mark 'FX', demonstrates the following comparative features of the two marks:-

plaintiff'S MARK

DEFENDANT'S MARK

- (a) plaintiff's mark 'FX' is preceded with another caption showing two search light beam in the skies which could also be construed as the letter 'X'
- (a) There is no such preceding caption in the Defendant's mark.
- (b) The letter F and X are of the same size.
- (b) The letter X is larger than M and the crossing of the X is angled.
- (c) The mark 'FX' has no other notation besides above or below it.
- (c) The defendant's logo is overridden by a brown colour letter Z which is inscribed by the logo Zee.

6. On careful perusal of all the three logos submitted, I am of the view that the defendants' adoption of the mark at annexure Z which has Zee letters in white Along with word Z in brown and word M and staggered X are sufficient to distinguish the defendant's mark from that of the plaintiff. Once such a mark is used and the channel Zee identified clearly to demonstrate that the channel 'MX' belong to Zee Network and is being marked as 'MX', there is no reasonable possibility of confusion or deception of a possible viewer. Taking into account the fact that this suit is mainly about a mark seen on the visual media such a change offered to be made is sufficient to redress the grievance averred by the plaintiff.

7. I am, Therefore, of the view that upon a visual comparison as tabulated above, of the defendant's altered mark labelled (Z) with that of the plaintiff's, no possibility of deception or confusion of any kind whatsoever exists and thus the plaintiff has not made out any prima facie case for grant of interim injunction in its favor.

8. Accordingly it is ordered that as an interim measure during the pendency of the suit and without prejudice to their rights the defendant is permitted to use the logo as marked Z having Zee letters in white imposed upon the letter Z in brown and letters M with a staggered X and no other and further relief claimed in the application for interim relief is warranted and/or justified.

9. With the above directions the is stands disposed of.

CS (OS) 204/04

The suit be listed before the Joint Registrar on 19th January 2005 for completion of pleadings.