

MANU/DE/0607/2002

**Equivalent Citation:** 2002VAD(Delhi)161, 98(2002)DLT430

**IN THE HIGH COURT OF DELHI**

IAs 10383 and 12189/99 in Suit No. 2282 of 1999

Decided On: 21.05.2002

Appellants: **Living Media India Limited**  
**Vs.**

Respondent: **Jitender V. Jain and Anr.**

**Hon'ble Judges/Coram:**

J.D. Kapoor, J.

**Counsels:**

For Appellant/Petitioner/plaintiff: Rajiv Nayar, Sr. Adv. and Manmohan Singh, Adv

For Respondents/Defendant: Pratibha M. Singh, Adv.

**Subject: Intellectual Property Rights**

**Acts/Rules/Orders:**

Press and Registration of Books Act, 1867 ;Trade Marks and Merchandise Act, 1958 ;Code of Civil Procedure (CPC) - Order 39 Rules 1, Code of Civil Procedure (CPC) - Order 39 Rules 2, Code of Civil Procedure (CPC) - Order 39 Rules 4

**Cases Referred:**

Globe Super Parts v. Blue Super Flame, AIR 1986 Delhi 245; Reddaway v. Banham, (13) 1896 RPC 218; J.L. Mehta v. Registrar of Trade Marks, AIR 1962 Bombay 82; Laxmikant V. Patel v. Chetanbhat Shah and Anr., AIR 2002 SC 275; Competition Review Private Limited v. N.N. Ojha (Competition Success Review v. Competition Review), 1996 PTC (16) 124 (Del); Rupee Gains Tele-Times Private Limited v. Rupee Times (Rupee Gain v. Rupee Times), 1995 PTC (15) 384; J.R. Kapoor v. Micronics India (Microtel v. Micronix), 1994 PTC 260 (SC); Girnar Food & Beverages Pvt. Limited v. Godfrey Phillips India Limited, 2001 PTC 360 Delhi; SBL Ltd. v. Himalaya Drug Co., 1997 PTC (17); Office Cleaning Services Ltd. v. Westminster Office Cleaning Association, 1944 All England Reporter 269; George Outram & Co. Ltd. v. London Evening Newspapers Company Ltd., 1911 RPC 28 308; Lok Nath Prasad Gupta v. Vijay Kumar Gupta, 57 (1995) DLT 502; S.S. Products Ltd. v. Star Plast, 2001 PTC 835 (Delhi); British Vacuum Cleaner Co. Ltd. v. New Vacuum Cleaner Co. Ltd., (1907) 2 Ch. 312

**Case Note:**

**The case dealt with the grant of injunction for passing off the trade mark 'Aaj Tak' under Sections 27(2), 2 and 106 of the Trade and Merchandise Marks Act, 1958 –A new programme in Hindi was telecasted by the plaintiff under name 'Aaj Tak' – The defendant adopted the same trade mark for his news paper, which was exactly similar to that of plaintiff – It was ruled that, prefixing 'Khabrein' to the name of news paper, did not made it distinct from plaintiffs mark – Thus, it was ruled that prima facie case was made out in favor of plaintiff –He was likely to suffer irreparable loss due to the infringement, thus injunction was granted in his favor**

**JUDGMENT**

**J.D. Kapoor, J.**

1. The short controversy for the limited purpose of an interlocutory injunction is whether the name and style of "AAJ TAK" and its logo having distinctive features in relation to the News Channel is a generic term and as such is not the monopoly of any particular person either in relation to the news programme or otherwise. Put briefly the relevant facts are as under:-

2. The plaintiff is carrying on its business of the production of the programme which is telecast on the Doordarshan Channel and transmitted all over India and is the producer of the news programme in Hindi under the name and style of "AAJ TAK". It has been using the said trade name since 1.6.95 though had applied for its registration before the trade mark authorities on 13.9.95. It is also the case of the plaintiff that the layout and the script of words "AAJ TAK" is an artistic, exclusive and distinctive style and as a consequence the readers have identified the plaintiff's production not only by the trade mark "AAJ TAK" but also by its peculiar descriptive style. It is claimed that the plaintiff's name of the production "AAJ TAK" has

3. Some time in the last week of July, 1999 the plaintiff discovered from the reception office of the Maharashtra Sadan, New Delhi where the copies of the newspapers are circulated that the defendants have adopted the name of its news programme by printing and publishing the name and style of Khabrein "AAJ TAK". The adoption and use of the mark "AAJ TAK" was found to be an exact reproduction of the mark of the plaintiff in respect of their publication. The defendants are using this name without prior permission of the plaintiff. It is averred that the confusion or deception is inevitable. On account of this the plaintiff has suffered damages as to its name, reputation and goodwill and business and is likely to suffer further damages unless the defendants are enjoined from using the trade mark/name of the magazine "AAJ TAK" in respect of their magazine or newspaper or periodicals as it amounts to "passing off".

4. As against this the defendant has questioned the right to a proprietorship of the plaintiff as to the mark aaj tak mainly on the following grounds:-

(i) that the words "AAJ TAK" are completely descriptive in nature and have dictionary meaning and, Therefore cannot be monopolised by any particular party or person;

(ii) that the plaintiff has come with unclean hands as it has concealed the material fact as it has represented that it has also a magazine which is sold from the same counter as that of the defendants whereas no magazine by the name of "AAJ TAK" has ever been printed or published by the plaintiff;

(iii) that the defendant has a registration under the Press and Registration of Books Act, 1867 granted by the Registrar of Newspaper in 1998 for printing a Daily Newspaper in Bombay under the tile "Khabrein Aaj Tak";

(iv) that the plaintiff had initially represented that there was a registered trade mark in its favor but it has now admitted that this is only an action for passing off and, Therefore confusion has to be established in an action for passing off;

(v) that this Court has no territorial jurisdiction as the newspaper of the defendants is meant for circulation only in Bombay and adjoining areas and it has no sale in Delhi.

5. Admittedly the trademark "AAJ TAK" has still not been registered under the TMM Act and the plaintiff has sought injunction only by way of an action for passing off.

6. The objection that the title "AAJ TAK" or "Khabrein AAJ TAK" was found available when defendant approached the authorities for registration under the provisions of the Press & Registration Books Act, 1867 and that the registration under this Act gives it the protection is flimsy and feeble attempt to resist the application of the plaintiff and is a sort of peripheral objection. Registration under the aforesaid Act is of no relevance and consequence. Registrar is neither an expert nor an authority under the law to make inquiries into and decide the similarity of the titles.

7. The nature of enquiry under the PRB Act is for the purpose of approval of the name of a magazine or publication and as such it cannot have precedence over the provisions of the TMM Act which is a special enactment and was made for the purpose of governing disputes relating to names, titles or trade marks. This conclusion emanates from the comparison of the object of the aforesaid two Acts. The preamble of PRB Act shows that it was made for regulating printing presses and newspapers, for preservation of copies of every book and registration of such books and newspapers. Thus the main concern of the Legislature was to enact a law which would help in preservation of the copies of the books and newspapers.

8. The TMM Act was enacted to provide for the registration and better protection of trade marks and for the prevention of the use of fraudulent marks on merchandise.

9. On merits it is contended by Mr. Rajiv Nayar, senior counsel appearing for the applicant/plaintiff that even if word "AAJ TAK" is descriptive in nature and even if it has a dictionary meaning still it is a coined word by the plaintiff and has acquired a secondary meaning by virtue of prior, continuous, regular and extensive user as every citizen in India or abroad recognises the mark "AAJ TAK" in relation to Hindi news with the plaintiff only and no one else. It is the conduct of the defendant on the date of the filing of the suit which is the relevant date for the determination of the real controversy between the parties.

10. In support of the contention that if the coined word even if it has dictionary meaning provides distinctive mark or trade mark and the person who has coined it or has been in continuous prior user has a right to protect it, Mr. Nayar has placed reliance upon the following judgments:-

(i) In Globe Super Parts v. Blue Super Flame, AIR 1986 Del 245 in which two words super and flame which are dictionary words were joined together were declared as coined words and protection was granted.

(ii) Reddaway v. Banham 1896 (13) RPC 218 - here the trade mark was the 'Camel Hair' used in

relation to belts prepared from the Camel hairs. Though both the words have the dictionary meaning still it was held that when the words which are descriptive of an article have come to denote the goods of a particular manufacturer he is entitled to restrain others from using them as to deceive purchasers.

(iii) J.L. Mehta v. Registrar of Trade Marks MANU/MH/0144/1962 : AIR1962Bom82 . The trade mark in question was 'Sulekha' having the meaning a woman having "good writing" was though descriptive but since it was being used in connection with fountain pens, nibs etc. the Court came to the conclusion that it is a valid trade mark and enjoined the infringer.

(iv) Laxmikant v. Patel v. Chetanbhat Shah and Anr. MANU/SC/0763/2001 : AIR2002SC275 the trade mark of the plaintiff was Mukta Jeevan Colour Lab whereas the defendant adopted the mark QSS Mukta Jeevan. Apart from the plea that it has dictionary meaning the other plea taken was that QSS is an abbreviation and accordingly an adjective pre fixed to the name. Though the defendant was carrying on business in the name of QSS Mukta Jeevan Studio but at the time of filing of the suit he was having the business in the name and style of Mukta Jeevan Colour Lab which was identical with the business of the plaintiff. The plea of the counsel for the plaintiff that QSS is an abbreviation and was merely an adjective pre-fixed to the name was accepted and it was held that it is the word Mukta Jeevan which makes distinctive the business name of the plaintiff and it is the continuous user of the plaintiff which has created a property therein linked with the plaintiff. The defendant was enjoined from using the said trade name in pursuance to the action for passing off.

11. On the contrary Ms. Pratibha Singh learned counsel for the defendant has contended with all vehemence that it is not the plaintiff's case in the plaint that the words "AAJ TAK" has acquired a secondary meaning and pleaded the word "AAJ TAK" is not a coined word. According to Ms. Singh the word "AAJ TAK" is dictionary word and appears in Oxford Hindi Dictionary and since this word clearly descriptive of news and being an ordinary dictionary word cannot be monopolised by any party.

12. In support of this contention, Ms. Singh has tried to draw support from the following cases:-

(i) In Competition Review Private Limited v. N.N. Ojha (Competition Success Review v. Competition Review) 1996 (16) PTC 124 where both the parties had used the word 'competition' while publishing their journals it was held that the word 'competition' is a generic term and that the absence of similarity in the colour scheme, the plaintiff could not claim exclusive use of the word 'competition'.

(ii) In Rupee Gains Tele-Times Private Limited v Rupee Times (Rupee Gain v. Rupee Times) 1995 (15) PTC 384 it was held that the word RUPEE is synonymous with money. It has been noticed that almost all the financial journals and publications have been using either the word business or financial or money for their journals and newspapers. Merely because one of the company has used the word RUPEE to name its financial journal will not mean that the said word cannot be used by any other journal nor it can mean that the journal first using the said word RUPEE has acquired trademark in the said word. RUPEE is a descriptive word not a distinctive word. Everything connected with trade and business is described by money, finances and rupee and it is for this reason that these words are repeatedly used by all the financial journals.

(iii) In J.R. Kapoor v. Micronics India (Microtel v. Micronix) 1994 PTC 260 the word 'micro' was held to be a common or general name and descriptive of the products which are sold or of the technology by which the products are manufactured, and the users of such products are Therefore not likely to be misguided or confused by the said word.

(iv) In Girnar Food & Beverages Pvt. Limited v. Godfrey Phillips India Limited 2001 PTC 360, the plaintiff's case was that it has been selling 'Super Cup' tea since 1982 with considerable expenses and the trademark 'Supercup' identifies the plaintiff's goods and has the effect of misleading the public as to its source. The finding of the learned Single Judge that there are basic features of similarities between the two marks and has the effect of misleading the public as to its source, did not find favor with the Division Bench as in view of the Division Bench there were differences between the plaintiff's and defendant's marks and trade dresses and Therefore there was no legally relevant confusion in the market place. It was held that plaintiff's own case is that 'Super' is a laudatory word but is only laudatory of the Cup and not of tea and if the 'Cup' in the present context is held to mean a, cup of tea, then on the plaintiff's own showing the word 'Super' is laudatory of the word 'CUP of tea' and Therefore incapable of acquiring a secondary meaning.

(v) In SBL Ltd. v. Himalaya Drug Co. 1997 PTC (17) controversy was between trade mark Liv 52 and LIV-T. It was held that 'Liv' is an abbreviation of Liver, a human organ and both the aforesaid drugs pertain to the treatment of liver functioning. It was held that any symbol, word or get up commonly used by traders in connection with their trade and in respect of which no particular trader can claim an exclusive right it cannot be considered to common to that particular trade or publici juris. Further words, expressions, or devices which are descriptive of particular goods are

open to use by all persons engaged in the trade. Such matters which are generally of a non-distinctive character may or may not be in actual use at any particular time. What is important is that the trading public has a right to use them in connection with their business.

(vi) In Office Cleaning Services Ltd. v. Westminster Office Cleaning Association 1944 All 269 it was held that "in the absence of any fraudulent intention the differentiation between the words "Services" and "Association" was sufficient to distinguish the defendants' business from that of the plaintiffs and the plaintiffs' claim should be dismissed.

There was an Editorial note which reads as under:-

"In the case of descriptive names, the court is reluctant to interfere even where the resemblance is very close. Here there has been a difference of opinion between the court of first instance and the Court of Appeal and the latter court has thought the matter of sufficient importance to give their reasons in a written judgment."

13. Main plank of the contention of Ms. Singh is that initial onus is upon the plaintiff to show that the trade mark adopted by it is exclusively appropriable and in case plaintiff succeeds only then plausibility of the Explanation of the defendant is taken into consideration and since it is the plaintiff's own case that the word "AAJ TAK" is coined word and there is no averment or plea that this word has acquired secondary meaning the plaintiff is not entitled to injunction because of the word "AAJ TAK" being descriptive in nature.

14. Last out not the least, Ms. Pratibha Singh while canvassing the proposition that there is no scope for confusion or misleading the public as to the source and origin of infringing newspaper as its circulation is only confined to Bombay whereas plaintiff trade mark AAJ TAK at the time of filing of suit was confined to only one hour news bulletin on Doordarshan placed reliance on George Outram & Co. Ltd. v. London Evening Newspapers Company Ltd. 1911 RPC 28. In this case the proprietors of a Newspaper called the "Evening Times" printed and published in Glasgow, brought an action against the proprietors of a Newspaper called by the same name but printed and published in London, to restrain their use of the name. The plaintiff's Newspaper was established in the year 1876 and had a large circulation in Glasgow and the south-west of Scotland, but practically no circulation in London, where the earliest edition did not arrive until late at night. The plaintiffs had an office in London for the collection of advertisements and news for their Newspaper. The advertisements inserted in the plaintiff's newspaper were substantially Glasgow advertisements. The Defendants' Newspaper did not circulate beyond 150 miles from London.

15. It was held that the Newspapers were not competing papers, and that there was no resemblance between them, and that a person intending to buy the Glasgow paper would not be induced by the name of the Defendant's Newspaper calculated to lead people to believe that the Defendants were the plaintiffs or connected with them nor was there any likelihood of pecuniary loss to the plaintiffs by reason of any confusion.

16. Ms. Singh has also challenged the jurisdiction of this court to entertain the suit on the premise that neither does the defendant publish its newspaper in Delhi nor does it sell the same in Delhi nor has it any circulation whatsoever in Delhi nor has it any office in Delhi and the mere circumstance that plaintiff happened to lay hands on the defendants' newspaper at Maharashtra Sadan, Delhi cannot provide cause of action at Delhi. In support of this plea, Ms. Singh has placed reliance upon Lok Nath Prasad Gupta v. Vijay Kumar Gupta 57 (1995) DLT 502 wherein the plaintiff did not allege having any shop, branch or office of his own in Delhi. The plaintiff also did not allege any instance of the defendant having sold the infringing goods in Delhi or having any office, branch or shop of his own in Delhi and for want of particulars, it was held that plaintiff cannot confer territorial jurisdiction upon Delhi courts.

17. In S.S. Products Ltd. v. Star Plast 2001 PTC 835 it was found that there was no registered office of the plaintiff in Delhi. plaintiff also did not prima facie establish that he has been carrying business in Delhi and Therefore in the absence of any such fact, it was held that civil court has no jurisdiction to entertain the suit.

18. Admittedly at the time of filing of the suit, the title of the defendant newspaper was "AAJ TAK" but during the pendency of these proceedings, word 'Khabrein' was added as a prefix and in the opinion of Ms. Singh now there is no scope of confusion whatsoever as both the trademarks are different in nature and are descriptive.

19. It is further contended by Ms. Singh that balance of convenience is also not in favor of the plaintiff as plaintiff is a news channel on electronic media and defendant will suffer immensely if it is restrained from using the title AAJ TAK in respect of newspaper.

20. It appears that whole gamut of the case of the defendant is on the presumption that the word "AAJ TAK" is not only descriptive in nature but also is a dictionary word and have even otherwise not acquired secondary meaning and as such plaintiff has no exclusive proprietorship or monopoly over it.

21. The broad principle on which the foundation of the right to restrain the user of a similar name was enunciated in British Vacuum Cleaner Co. Ltd. v. New Vacuum Cleaner Co. Ltd. (1907) 2 Ch. 312 referred to

"The foundation of the right to restrain the user of a similar name is the principle that no one is entitled to represent his business or goods as being the business or goods of another by whatever means that result may be achieved, and it makes no difference whether the representation be intention or otherwise; but a distinction has been and must always be drawn between cases in which the trade name or the part of it in question consists of word or words of ordinary use descriptive of the business carried on or the article dealt in and cases in which the word or words complained of is or are of the character of a fancy word or words and primarily have no relation to such business or article but only to the person carrying on the business or dealing in the article."

22. It was in view of this principle that their Lordships held that "if it can be established that the descriptive word or words has or have acquired among the public, or that class of the public likely to deal with the business or goods in question, a subsidiary or secondary meaning denoting or connoting the business or the origin of the article, the person claiming to restrain the user of that word or those words can obtain the relief he seeks.

23. Let us assume for the sake of argument that mark "AAJ TAK" is descriptive in nature, has a dictionary meaning and has not acquired a secondary meaning. Can the plaintiff still seek interlocutory injunction against the use of this word on account of its having prior, long, continuous and regular user in relation to news at Doordarshan?

24. The word 'mark' has been defined in the Trade Marks and Merchandise Act of 1958 as under:-

"2. Definitions and interpretation - (1) In this Act, unless the context otherwise requires -

(j) "mark" includes a device, brand, heading, label, ticket, name, signature, word, letter or numeral or any combination thereof;"

25. The word trade mark has been defined as a registered trade mark or a mark used in relation to goods for the purpose of indicating so as to indicate a connection in the course of trade between the goods and some person having the right as proprietor to use the mark. If any mark is used in relation to goods for the purpose of indicating or so as to indicate and some person having the right as proprietor it is a trade mark which becomes the property of its prior user even if it happens to be descriptive in nature but has been coined by it.

26. The mark is always used for the purpose of indicating either a connection in the course of trade between the goods and it is the prior user which provides the right of protection. Thus even if the adjective "Khabrein" is pre-fixed it does not make the trade mark "Khabrein Aaj Tak" distinct or different from the mark "AAJ TAK".

27. The word "AAJ TAK" itself is no distinctive that it has acquired such a meaning that any pre-fix or suffix would be of no relevance so far as the action of passing of is concerned. The only object and design of the defendant to adopt the word "AAJ TAK" was to trade and encash upon the goodwill of the plaintiff earned over the years through the advertisements and because of its extensive popularity. The mark "AAJ TAK" has become synonymous with the plaintiff so far as the news channel is concerned.

28. The word "AAJ" and "TAK" may be individually descriptive and dictionary word and may not be monopolised by any person but their combination does provide a protection as a trademark if it has been in long, prior and continuous user in relation to particular goods manufactured, sold by a particular person and by virtue of such user the mark gets identified with that person. It is so irrespective of the fact whether such a combination is descriptive in nature and has even a dictionary meaning. In such a case any other person may choose any of the two words viz. either "AAJ" or "TAK" as its trade name or mark but it has to be prohibited from using the combination of these words as such a user not only creates confusion as to its source or origin but also bares the design or motive of its subsequent adopter.

29. Any kind of prefix or suffix would not make any difference so far as the trade name or for that purpose the domain name "AAJ TAK" is concerned. It is immaterial whether the defendant has no clientele or publication in Delhi. Channel "AAJ TAK" is a National Channel. It has widespread reputation and goodwill. Adoption of similar or deceptively similar mark amounts to passing off even if it has no local physical market, goodwill or reputation of a product or person is all pervasive. It is not confined in the four walls or to a particular territory. It has to be protected wherever it is threatened or is sought to be eroded or exploited. Merely because the product or mark adopted by a rival has no circulation or sale in the territory of the plaintiff's mark or product is no defense against protection of the mark. Protection of mark is in actuality protection of reputation and goodwill. At every cost the reputation has to be protected and preserved.

30. Not only the plaintiff has made out a prima facie case for interlocutory injunction but balance of convenience also lies in its favor and it is likely to suffer irreparable loss and injury as the defendants' goods are the same that is the dissemination of news may be through print media whereas the plaintiff provides such service through electronic media and it is likely to generate confusion and further there was no other object to choose mark "AAJ TAK" than to trade upon the reputation and goodwill of the plaintiff earned over the

31. In the result the application under Order 39 Rule 1 & 2 CPC is allowed and the ex parte injunction is hereby confirmed and made absolute. The application under Order 39 Rule 4 CPC moved by the defendant for vacation of ex parte stay is hereby dismissed.

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