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Delhi HC pulls up **Prasar Bharti** for infringing Dish TV trademark

Aditi Singh July 17 2019



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The Delhi High Court has restrained Prasar Bharti from infringing the trademark of Dish TV by adopting the mark "DD FREE DISH" or any other mark incorporating the word "DISH" for its Direct-To-Home Service.

Expressing its disappointment at finding a public sector undertaking using another's trademark and contesting the litigation at the cost of the exchequer, the Court remarked,

".. I am dismayed that the defendant, a public sector enterprise, indulged in using another's trademark 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 the 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."

The interim order was passed by a Single Judge Bench of Justice **Rajiv Sahai Endlaw** in trademark infringement suit by Dish TV India Limited (plaintiff) against Prasar Bharti (defendant).

The plaintiff is engaged in the business of providing Direct To Home (DTH) services and has a subscriber base of more than 16 million, with a capacity of more than 400 channels and movies on demand.

The plaintiff claimed that it is the original coiner, first adopter, prior user and the registered proprietor of the trademark/corporate name "DISHTV" since 2003.

It was further submitted that "DISH" was an integral and distinctive element of plaintiff's trademark and trade name and was used in combinations like dish+, Dish TruDH+, dishonline, dishflix, dish active, dish dvr etc.

The Court was informed that the plaintiff's applications for registration of other marks with the word "DISH" are pending consideration and the corporate name along with the logo "DISHTV" was also protected under the Copyright Act, 1957.

The plaintiff was also running a website in the name of www.dishtv.in and had 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.

The plaintiff's grievance was that the defendant, in May 2014 renamed its Free to Air DTH service "DD Direct+" to "FREE DISH".

It claimed that the defendant even adopted a logo which was deceptively similar to that of the plaintiff with the motive to benefit from the reputation and goodwill of the plaintiff and to create confusion.

Disputing the claims, the defendant argued that there was no similarity between "DD Free Dish" and "DISHTV" and hence there was no possibility of anyone being misled.

Distinguishing its product from the plaintiff's on the ground that "DD Free Dish" was the only free to air DTH platform in the country, the defendant argued that the possibility of deception or confusion between "DD Free Dish" and "DISH TV" was nil.

The defendant stated that "DISH" was a generic word used to describe equipment which receives the satellite signals and thus could not be the subject matter of an exclusive right. It also stated that that the term "DISH" was not distinctive in nature and none could claim exclusive right to use it.

After hearing the parties, the Court noted that the mark "DISHTV" stood registered for the last 16 years as none raised any objection against its registration and sought the removal of the registration in terms of **Section 9** of the *Trade Marks Act, 1999* on the ground that mark lacked distinctiveness.

Even the defendant did not bother to seek the removal of registration of the plaintiff's mark even though the main thrust of its argument is that the word "DISH" was *publici juris* and/or generic or common to the trade.

Under the situation, the Court remarked that the question for consideration was,

"whether the defendant, having chosen not to do so, when sued for infringement, is entitled to defend the claim for infringement on such grounds."

The Court stated that the power to remove a mark from the register vested exclusively in the Registrar of Trade Marks or in the Intellectual Property Appellate Board (IPAB), under **Section 47** of the Trade Marks Act. Section 31 nonetheless provides for registration of the mark as a prima facie evidence of the validity, it said.

It further recorded that under **Section 124**, proceedings in a suit for infringement of trademarks could be stayed where the validity of registration was questioned. It is while so staying any proceedings that a Court is required to form a prima facie view on the plea of validity, it said.

Since the defendant had not applied under this section, the Court opined that it could not take a prima facie view on the validity of the mark.

"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."

The Court also examined if the use by the defendant of "DISH" was intended to indicate the kind and/or purpose of the service being provided by the defendant under **Section 30(1)** and answered in negative.

"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..

..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". the Court answered.

The Court further concluded that the word "Dish" was not generic to DTH service. Thus, its adoption by the plaintiff for its DTH services would not allow the others providing the same service to use 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."

The defendant's contention that "DISH TV" and "DD FREE DISH" were distinguishable was also rejected by the Court.

"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."

The Court also rejected the defendant's request to not pass an interim order at a stage when evidence was being recorded and remarked,

"..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."

The defendant had also pleaded "public interest" as a ground for not passing any injunction order. The same was, however, rejected.

"..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."

In view of the above, the Court allowed the plaintiff's application for an interim injunction. The order shall remain operative during the pendency of the suit.

It nonetheless granted the defendant three months' time to inform its consumers/subscribers of its new name, so as to not cause any of them to suffer.

Dish TV was represented by Senior Advocate **Sandeep Sethi** with advocates from Singh & Singh - **Sudeep Chatterjee**, **Nupur Lamba**, and **Sonal Chhablani**.

Prasar Bharti was represented by advocates **Rajeev Sharma**, **Radhalakshmi R**, **T Rajat Krishna** and **Saket Chandra**.

Read the Order:

Dish TV vs DD Delhi HC_watermark

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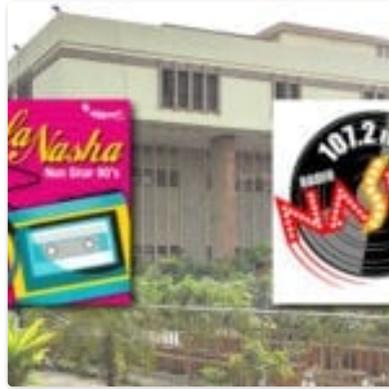
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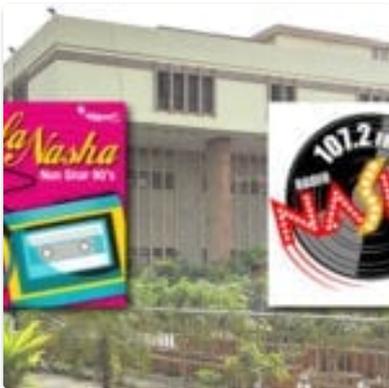
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