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IN THE HIGH COURT OF DELHI AT NEW DELHI

Pronounced on : 13.04.2010

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CS(OS) 1114/2006

CHRONICLE PUBLICATIONS (P) LTD.

..... Plaintiff

Through : Mr. Ashish Aggarwal, Advocate.

versus

CHRONICLE ACADEMY PVT. LTD. F+

..... Defendant

Through : Nemo.

CORAM:

MR. JUSTICE S. RAVINDRA BHAT

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| 1. | Whether the Reporters of local papers may be allowed to see the judgment? | YES |
| 2. | To be referred to Reporter or not? | YES |
| 3. | Whether the judgment should be reported in the Digest? | YES |

MR. JUSTICE S.RAVINDRA BHAT

*1. This is a suit for permanent injunction seeking to restrain the defendant from infringing the plaintiff's trademark in the word "CHRONICLE", the plaintiff further seeks an order for Rendition of Accounts, Permanent Injunction and Passing off.

2. The plaintiff is a reputed publisher and carries on his business under the name of "Civil Services Chronicle". According to the plaintiff there are various competitive magazines published by it requisite for various coaching/information/ knowledge for various competitive examinations across India under this trademark since 1992. The plaintiff is well renowned in this field for the last almost 15 years.

3. The plaintiff is the proprietor of the trade-name "CHRONICLE" and the same is being used by the plaintiff company and all its publication since 1992. It is contended in the suit that the trade name 'CIVIL SERVICES CHRONICLE' was registered by the plaintiff with the office of Register of Newspaper for India. The plaintiff also mentions about having applied for various trade-names. The trade-name CHRONICLE YEAR BOOK 2001 has already been registered.

4. The plaintiff mentions about starting a coaching academy under the name of CHRONICLE IAS ACADEMY, which is also registered. The trade name “CHRONICLE” through its continuous use since 1992, advertisement and the quality of information contained in the magazine has earned distinctiveness in the field of imparting knowledge. It is one of the leading mark and synonymous to the vehicle of success in civil service examination. The plaintiff ran the academy for 2-3 years, however the plaintiff, due to some inadvertent circumstances, decided to close down its activity relating to the coaching academy.

5. The plaintiff claims that the use of the trademark “CHRONICLE” by the defendant as a trade- name and issued in the brochures/ information bulletin issued had effected its reputation in the market and that the customers had come to associate the mark as the plaintiff’s academy.

6. On the allegation that the defendant, had deceptively and with *mala fide* intentions blatantly attempted to cheat the public in connection with the use of the trademark with the same and identical style of writing for the purpose of publishing and providing coaching under the name of “CHRONICLE ACADEMY PVT. LTD.”, the plaintiff has filed suit proceedings before this Court alleging passing off of its trademark “CHRONICLE” by the defendant and praying for an injunction to restrain the defendant from doing so and for other consequential relief.

7. The plaintiff says that a descriptive trademark may be entitled to protection if it has assumed a secondary meaning, which identifies it with a particular product or as to being from a particular source. The plaintiff is also publishing magazines and providing the coaching under the same trademark. The advertisement by the defendant reveals that the style of writing the trademark is completely identical to the style of the plaintiff. The same gives an impression that the said academy is being run by the plaintiff. The use of the trademark/ name CHRONICLE by the defendant is in the violation of the plaintiff’s exclusive and sole right to use the said trade name. The words CHRONICLE/ CIVIL SERVICES CHRONICLE are so associated with the plaintiff that its use by any other person associated with the relevant field, i.e. imparting knowledge etc. is capable of amounting to a representation that his goods/ services are those of the plaintiff.

8. The plaintiff mentions about having earned reputation and goodwill by spending considerable and substantial amounts of money to make its trade name famous and that the said trade name due to prior and consistent user denotes the plaintiff as its source and origin. It is also alleged that action and appropriation of the trade-name by the defendants amounts to the commercial invasion and piracy of the plaintiff’s trade-name. The intention of the defendant is fraudulent and they want to usurp the trade-name for their ulterior motives and with a view to pass off their product/services as the services provided by the plaintiff by creating confusion and deception.

9. In support of the suit allegations, the plaintiff has produced copies of invoices and also advertisements. These disclose that the plaintiff had been using the CHRONICLE mark in

respect of its tutorials and printed materials to assist candidates aspiring to write the civil service examinations. Reliance is placed upon the affidavit of Mr. Amarendra Kumar (PW-1); he has filed an affidavit dated 07.08.2008 (PW-1/A). He has endorsed the pleadings in the suit and produced copies of the Registration Certificates in respect of the plaintiff's publications, issued by the Registrar of Newspapers for India, as Ex. PW-1/2 to PW-1/A. PW-1 further states that the plaintiff also publishes other magazines and Year Books, which include the name "CHRONICLE". The details of these are mentioned in para 5 of the affidavit, and copies of Registration Certificates issued by the Registrar of Newspapers have been marked as Ex. PW-1/5 to PW-1/11. The witness also deposes that trademark registrations for class-16 and 41 are pending; copies of the application and representations are marked as Ex. PW-1/12 and 1/13. It is submitted that the Trademark Registrar has granted exclusivity for the word "CHRONICLE" in respect of the Year Book 2001 but the plaintiff stated that exclusivity for "Year Books" has been denied. The Registration Certificate is produced as PW-1/14. It is stated that the plaintiff has applied for registration of the tradename "CIVIL SERVICES CHRONICLE" on 02.02.2000 and 21.03.2001 and that they are pending. Similarly, applications for registration of the mark "CHRONICLE IAS ACADEMY" with Trademark Registry are said to be pending since 03.03.1994.

10. The plaintiff states that the word "CHRONICLE" is well-known nationwide and is associated with its services, particularly, the tutorials and support given to those aspiring to become civil servants, by writing Civil Services Examinations. The plaintiff relies upon copies of advertisements, and in support of having spent money, has also produced bills; all of which are marked as Ex. PW-1/24 to PW-1/108.

11. It is stated that the plaintiff started a Coaching Academy called "CHRONICLE IAS ACADEMY" in the year 1992-93, which continued for 2-3 years, but had to be closed-down. It is further alleged that the plaintiff decided to revive the activity in 2002 and asked for franchisees to carry-out the activity on its behalf; copies of applications made in that regard have been produced as Ex. PW-1/45 to PW-1/157.

12. The witness PW-1 deposes that on 13.04.2006, the plaintiff became aware about a brochure or Information Bulletin, by the defendant, which, for the first time claimed that the latter was engaged in managing the academy known as "CHRONICLE CIVIL SERVICES ACADEMY". The copy of the brochure issued by the defendant has been produced as Ex. PW-1/218.

13. In the light of all these facts, the plaintiff seeks injunction, submitting that the wordmark "CHRONICLE" in relation to tutorials, as well as allied services has attained distinctiveness and denotes it and the various services that are offered. The plaintiff contends that the trademark is a well-known trademark under Section 2(1)(zg) of the Trademarks Act, 1999 and that the defendant's use of the same in respect of cognate or allied services, i.e. coaching academy amounts to passing-off, against which it is entitled to seek the restraint of through a permanent

injunction. The plaintiff relies upon the decisions *Infoedge (India) Pvt. Ltd. v. Shailesh Gupta and Anr.*, 98 (2002) DLT 499. It is submitted that even though the plaintiff has not established or is not engaged in rendering services or offering course through coaching academy, there is a real likelihood of confusion between the plaintiff's mark and that of the defendant. It is submitted specifically that the class of users, both in respect of tutorial services offered by Year Books, magazines and publications, by the plaintiff – as well as those who enroll in coaching, is the same, as in either case, the students and candidates wish to avail of such services to successfully appear in various kinds of civil services examinations held by the Central Government and different states. It is stated that the defendant has, despite service, after entering appearance chosen to absent himself and did not explain why the word "CHRONICLE" has been singled-out to denote the services it offers. In these circumstances, having regard to the close resemblance of the two marks and the class of users as well as services, the plaintiff argues that it is entitled to decree for permanent injunction and all the consequential reliefs sought in the suit.

14. The above discussion reveals that the plaintiff's claim against the defendant is founded on the latter's use of the word CHRONICLE in respect of the services offered by it, to coach students and candidate, wishing to appear in civil services examinations held by the Union Public Service Commission, and agencies of various states, for recruitment in public service. The plaintiff is not registered owner of the word CHRONICLE, except in relation to a year book; it concededly is claiming to use of the said mark, and tradename, in respect of publications, to aid such candidates, for appearing in the civil service examinations. The defendant, on the other hand, is not publishing any periodical or magazine, but has established coaching classes which aid candidates in preparing for such public examinations. Concededly the plaintiff had started coaching centres or classes, but later shut them down, for undisclosed reasons. As at the time of filing the suit, the plaintiff had not established or engaged itself in running such coaching classes.

15. The plaintiff has, undoubtedly placed on record materials to disclose that it has been using CHRONICLE in respect of the various publications it is engaged in. However, the Court has to be mindful about the fact that the said word is a common one. According to the Shorter Oxford Dictionary "Chronicle" means "...A record, a register, a narrative, an account. *Freq. in titles of newspapers...*". CHRONICLE, therefore denotes a narrative, or an account, as in a journal or periodical, which is recorded or issued periodically. In the context used by the plaintiff (in respect of its publications) it means exactly what the word is; i.e. a periodical brought out from time to time. The word is a common, dictionary one, and is also descriptive or generic, as it conjures up the image of the goods or services the word mark caters to.

16. In *SBL Limited v. Himalaya Drug Company*, 67 (1997) DLT 803 (DB), a Division Bench of this court said that:

"Nobody can claim exclusive right to use any generic word, abbreviation, or acronym which has become publici juris. In the trade of drugs it is common practice to name a drug by the name of the organ or ailment which it treats or the main ingredient of the

drug. Such an organ ailment or ingredient being public jurisdiction or generic cannot be owned by anyone for use as a trademark”.

A similar view was taken by another Division Bench in *Schering Corporation v. Alkem Laboratories*, 2009 (165) DLT 474. Very recently, in *Rhizome Distilleries P. Ltd. & Ors. v. Pernod Ricard S.A. France & Ors.*, 165 (2009) DLT 474 too, another Division Bench underlined that common words, generic or descriptive names, do not automatically evoke protection of the Court unless a plaintiff establishes that such marks have acquired secondary meaning.

17. There is no evidence on record, to establish that the plaintiff's CHRONICLE has acquired distinctiveness and association with its product of such kind that the consumer or user only thinks of the plaintiff's tutorial. At this stage, the Court is evaluating the evidence, on the basis of material on record, it is necessary that the suit should rely on materials which are not matters of conjecture, but based on hard reality. The plaintiffs not led any evidence to show that there was grave likelihood of consumer confusion, or that the defendants, knowing the plaintiff's mark, deliberately chose to use it. For these reasons, the plaintiff was under an obligation to prove confusion, (and not rely merely on the averments in the suit, and the documents filed), which it has failed to discharge.

18. As far as the plaintiff's claim for injunction based on the defendant's use of CHRONICLE is concerned, the Court is mindful of the fact that the injunction sought for restraining the use of a mark, in a corporate name, is a species of infringement, under the Trademarks Act, 1999, under Section 29 (5), in respect of goods and services of the same or identical kind. However, in this case, the defendant is not publishing periodicals, and is seeking injunction stating that though the defendant uses CHRONICLE for coaching classes, the plaintiff is not in the same business. The plaintiff has also not shown that the word mark has acquired such distinctiveness as to compel the Court to conclude that use by the defendant in respect of tutorial classes, is likely to dilute its reputation. As said earlier, the word is a common enough English term, and also descriptive of the products or services offered. In these circumstances, it is concluded that the plaintiff is not entitled to the decree of permanent injunction; the other reliefs claimed are consequential and incidental to the main reliefs sought for.

19. In view of the above reasoning, the suit cannot succeed; it is accordingly dismissed, with no order on costs.

April 13, 2010

(S.RAVINDRA BHAT)

JUDGE