

IN THE HIGH COURT OF DELHI AT NEW DELHI

CS (OS) No. 1085 of 2005

Reserved on: September 12, 2013

Decision on: October 7, 2013

T.V. TODAY NETWORK LTD. & ANR. Plaintiffs

Through: Mr. Saurabh Srivastava with
Ms. Shilpa Gupta, Advocates.

versus

KESARI SINGH GUJJAR & ORS. Defendants

Through: Mr. Y.D. Nagar, Advocate.

CORAM: JUSTICE S. MURALIDHAR

JUDGMENT

7.10.2013

1. This is a suit filed by TV Today Network Ltd. (Plaintiff No.1) and Living Media India Ltd. (Plaintiff No.2) against the Chief Editor and Editor (Defendants 1 and 2 respectively) of United Group of Media (Defendant No.3), Mr. Uttam Prakash (Defendant No.4), and M/s. Roshan Offset (Defendant No.5) for permanent injunction restraining the Defendants from passing off of their publications and for delivery up of all products of the Defendants and for rendition of accounts and damages.

2. After the filing of the suit in August 2005, the Plaintiff No.2 obtained registration for the trade mark 'Aaj Tak'. Accordingly, by an order dated 17th May 2006, the Plaintiffs were permitted to amend

the plaint to seek the relief of permanent injunction restraining the Defendants from infringing the Plaintiffs' registered trade mark 'Aaj Tak'.

3. The Plaintiffs are companies having registered office in New Delhi. They state that Plaintiff No.2 is the publisher of several reputed news publications including 'India Today', 'Business Today', 'Computers Today' and 'Readers Digest'. From the year 1987, it has also been engaged in producing TV news programmes. In 1995, it decided to commence a news programme in Hindi under the name of 'Aaj Tak' and was granted registration for the said trade mark in classes 38 and 41. It also applied for registration of the trade mark in Classes 9 and 16 of the Schedule to the Trade Marks Rules. Plaintiff No.2 also acquired trademark registration in respect of the marks 'Subha Aaj Tak', 'Khel Aaj Tak' and 'Saptahik Aaj Tak' in Class 9. Copies of the trade marks registration certificates have been filed along with the plaint.

4. In 2000, Plaintiff No.2 launched a 24-hour news channel under the name 'Aaj Tak'. Plaintiff No.1 was established by Plaintiff No.2 as a new corporate entity for managing and administering the 'Aaj Tak' news channel. Plaintiff No.2 also licensed the use of the word, logo and trade mark/trade name 'Aaj Tak' to Plaintiff No.1. The Plaintiffs state that 'Aaj Tak' is a household name in India and several other countries where the TV signals of the 'Aaj Tak' channel are beamed. The trade mark/service mark 'Aaj Tak' has therefore been

continuously and uninterruptedly used by the Plaintiffs since 1995. The Plaintiffs states that the news channel has won several awards and citations. It is stated that the trader mark/service mark 'Aaj Tak' is an arbitrary, unique combination/collection of two words in Hindi language thereby making the mark a highly distinctive one. Members of the public associate the mark only with the Plaintiffs. It is stated that Plaintiff No.1 has become the exclusive perpetual licensee of trade mark/logo 'Aaj Tak'. It is stated that 'Aaj Tak' is a well known trade mark within the meaning of Section 2(1) (zg) of the Trade Marks Act, 1999 ('TM Act'). The Plaintiffs state that trade mark/service mark 'Aaj Tak' enjoys tremendous goodwill and reputation on account of the high quality of programming. It is stated that as on the week commencing 30th April 2005, 'Aaj Tak' had a total viewership of 19.4 million at an all-India level pointing to a market share of 25.5%. The expenses incurred by the Plaintiff No.1 in promoting the mark for the years 2000-01 to 2004-05 have been set out in para 6. The turnover figures for the same period have been set out in Para 7. For the year 2004-05 the turnover was Rs.1390.68 lakhs.

5. In addition to the above the Plaintiff has also domain name 'www.aajtak.com' to provide news through the internet and on which website the said mark and logo are depicted. The Plaintiffs own other domain names: www.aajtak.in, www.aajtak.co.in, www.aajtak.firm.in, www.aajtak.gen.in, www.aajtak.org.in, www.aajtak.net.in, and www.aajtak.ind.in.

6. It is stated that in 2005, the Plaintiffs discovered that the Defendants were publishing a Hindi newspaper depicting under the same word mark 'Aaj Tak'. The Defendants had also registered an email address aajtakindia@rediffmail.com. The newspaper was a weekly being sold free in Delhi and Noida. The mark of the Defendants was phonetically, identically and visually similar to that of the Plaintiffs. It is stated that the Defendants used a style similar to that of the Plaintiffs in representing their mark in various advertisements. It is stated that the Defendants were misleading the public into believing that the Defendants were connected/affiliated to or licensed by the Plaintiffs to publish the impugned publications. Thus, the Defendants were illegally encashing on the reputation and goodwill of the Plaintiffs.

7. The Plaintiffs deputed an investigator to visit premises of the Defendants. A correspondent of the Defendants' newspaper informed the investigator that the newspaper 'Aaj Tak' is a weekly publication and also gave the investigator a rate list for booking advertisements in the newspaper. The visiting card of the correspondent and the rate list has been included in the documents filed with the plaint. It is stated by the Plaintiffs that the Defendants are deceiving the public into thinking that the Plaintiffs have started another newspaper under the name 'Aaj Tak'. The Defendants are also exploiting the goodwill and reputation of the mark by inviting advertisements to be placed in the newspaper. Further the Defendants are inviting applications from persons desirous of becoming 'Aaj Tak' models.

8. While directing summons to issue in the suit on 9th August 2005, the Court restrained the Defendants from making use of the mark 'Aaj Tak' or any deceptive variant thereof in respect of the Defendants' publications or in any manner till the order was modified, varied or vacated. That order has continued during the pendency of the suit.

9. In their written statement filed on behalf of all the Defendants, it is stated that the Defendants have been publishing the newspaper for ten years. The newspaper bears Registration No. 64796/96 having been registered in the office of the Registrar of Newspapers, under the Ministry of Information and Broadcasting. The copy of the certificate has been included in the documents filed with the written statement. It is next contended that the Plaintiffs were aware of the existence of newspaper since 1996 and, therefore, the suit was liable to be rejected both on the ground of laches and acquiescence. A reference is made to Section 33 of the TM Act. It is stated that newspapers fall in a different and distinct class of goods and service different from that in respect of which the trade mark registration is held by the Plaintiffs. The Defendants claim that it has an increasing number of members/subscribers since 1996. As on the date of filing the written statement, i.e. on 9th September 2005, there were around 5000 members/subscribers for the Defendants' newspaper. It is further stated that Defendant No.3 is a society registered under the Societies Registration Act, 1860 in accordance with its aims and objects and brought out the newspaper 'Aaj Tak' published in Hindi. The financial statement of Defendant No.3 for the years 2002 and 2004

has been enclosed. It is stated that newspaper is sold at a nominal rate of Rs.2 to cover the cost of publication and, therefore, is a social venture. It is denied that the Defendants are copying the trade mark of the Plaintiffs in any manner. It is denied that any investigator of the Plaintiffs visited the premises of the Defendants and met a correspondent of the Defendants' newspaper Mr. Manish Kumar or that he gave his visiting card or the rate list for advertisements. It is denied that 'Aaj Tak' is an arbitrary and unique mark. It is further submitted that the Defendants' newspaper is governed by the Press and Registration of Books Act ('PRB Act') whereas the Plaintiffs are running a TV channel. Therefore, the Defendants were exercising their legal rights to publish the newspaper. It is submitted that in common parlance, in respect of news, it is generally said: '*Kya Hai Aaj Tak Ki Kabhar*' and from those words the words 'Aaj Tak' was appropriately used for the Defendants' newspaper in Hindi. The Defendants claim to have eminent subscribers and, therefore, no cause of action for a suit for infringement or passing off has arisen.

10. A replication was filed by the Plaintiffs on 9th November 2005 wherein, apart from reiterating the averments in the plaint, it is pointed out that PRB Act was for regulating newspapers and cannot override the TM Act, 1999 which is special enactment. As long as the Plaintiffs hold registration for the trade mark/service mark 'Aaj Tak' there was no provision in the PRB Act permitting the Defendants to infringe or pass off the Plaintiffs' registered trade mark.

11. By an order dated 8th February 2006, the Plaintiff was directed to file an affidavit to explain whether it had approached the Registrar of Newspapers for deregistration of the Defendants' publication. An affidavit was filed by the Plaintiffs on 17th February 2006 answering the said question in the negative. The Defendants were directed by the same order to disclose on affidavit as to what the circulation of the news paper was when it started and what its present circulation was. An affidavit dated 20th February 2006 was filed stating that the Registrar of Newspapers granted registration of Defendants' newspaper under the PRB Act after verification on 15th December 1995. It was stated in Para 4 of the said affidavit that the circulation of the Defendants publication had gone down. At the time of inception in 1996-97 the circulation of the Defendants' newspaper was 17,000 and in terms of the Annual Report of the Registrar of Newspapers for 2005 it had gone down to 2000. It is further claimed that immediately before the filing of the suit the circulation was 5,000 on account of "improvement in the newspaper such as size, colour, printing, and increase in number of pages, printing quality".

12. IA No. 7855 of 2005 was filed by the Defendants under Order XXXIX Rule 4 CPC for vacating the interim order of stay. Both IA No. 6052 of 2005 under Order XXXIX Rules 1 and 2 CPC and the aforementioned IA No. 7855 of 2005 were heard together. A detailed order was passed by the Court on 19th May 2008 affirming the injunction granted by the Court on 9th August 2005.

13. On 21st August 2008, the following issues were framed by the Court:

“(1) Does the Plaintiff prove entitlement to injunctive relief, as claimed, based on ownership of the registered trade mark ‘Aaj Tak’? OPP

(2) Does the Plaintiff prove the Defendant’s use of the mark or words ‘Aaj Tak’ amounts to infringement and/or passing off? OPP

(3) Does the Defendant prove its entitlement to use the word ‘Aaj Tak’ on the basis of registration under the registered Press and Registration of Books Act, 1867? OPD

(4) Is the Plaintiff entitled to damages and/or rendition of accounts, as claimed? OPP

(5) Relief.”

14. On behalf of the Plaintiffs Mr. Ashok Kumar Vermani, their duly authorised signatory filed an affidavit dated 13th January 2009 of examination-in-chief. The board resolution authorizing him to act on behalf of the Plaintiffs was marked as Exhibit P-1. The trade mark registration certificates were marked as Exhibit P-2. The advertisements of the Plaintiffs’ mark published in various newspapers in 1995 were marked Exhibit P-3. Documents pertaining to the goodwill and reputation of the Plaintiffs news channel ‘Aaj Tak’ were marked as Exhibit P-4. The visiting card of Mr. Manish Kumar, the correspondent of the Defendants whom the Plaintiffs’ investigator met was marked as Exhibit P-5. The affidavit reiterated the averments in the plaint.

15. Further, for the Plaintiffs, an affidavit dated 8th December 2011 of Ms. Divisha Bopana, the authorised signatory of Plaintiff No.2, was filed. The statement of Ms. Divisha Bopana as PW-1 was recorded on 21st May 2012. She was cross-examined on 23rd November 2012.

16. On 29th September 2008, the Defendants had filed a list of 15 witnesses. However, on 11th February 2013, a statement was made by learned counsel for the Defendants that the Defendants had no evidence to lead in the case. On the same date, Ms. Divisha Bopana was recalled for further cross-examination. She confirmed that the resolutions dated 17th March and 27th July 2005 do not show her name as the authorised representative of the Plaintiff No.2.

17. Mr. Saurabh Srivastava, learned counsel appearing for the Plaintiffs submitted that this was a case of infringement of the registered trade mark of the Plaintiffs and the Defendants contention that the PRB Act permitted the Defendants to publish their newspaper using an identical mark was no answer to the infringement in terms of the TM Act. He submitted that 'Aaj Tak' was an arbitrary and distinct mark and the Plaintiffs are the prior users thereof. He contended that the field and activity of Defendants viz., publishing newspapers was closely related to the principal activity of the Plaintiffs viz., news broadcasting, and that was causing a high degree of confusion in the minds of the public. According to him, there was a clear infringement of the registered mark of the plaintiffs in terms of Section 29 of the TM Act. Reliance was placed on the decisions in *Playboy Enterprises*

v. Bharat Malik 2001 PTC 328 (Del), Century Traders v. Roshan Lal Duggar 15 DLT (1979) 269, Ziff-Davis Inc. v. Dr. D.K. Jain 1998 PTC (18), Novartis AG v. Wanbury Ltd. 2005 (31) PTC 75 (Del) and Bengal Waterproof Ltd. v. Bombay Waterproof Mfg. Co. 1997 PTC (17). He further pointed out that as the Defendants failed to avail of the opportunity of leading evidence the Plaintiffs' case was virtually uncontested. He relied upon the decisions in *Swaran Singh v. State of Punjab (2003) 1 SCC 240* and *Mohd. Naved v. Hindustan Petroleum Corporation 2004 (1) MPHT 16*.

18. Mr. Srivasatava referred to Rule 22(2) of the Trade Marks Rules, 2002 ('TM Rules') which stated that the goods and services specified in the Fourth Schedule only provided a means by which the general content of the numbered international classes could be quickly identified and that reference had to be made to the alphabetical index of goods and services for determining the classification of particular goods and services. According to him, therefore, news report services were in Class 41 and television broadcasting and news agency under Class 38 as per the international classification of goods and services. According to him, by this classification, the Plaintiffs could be said to be holding registration for the above goods and services as well.

19. Appearing for the Defendants Mr. Y.D. Nagar, learned counsel, submitted that the Defendants had a right to publish their newspaper as part of their right to freedom of speech and expression. He placed reliance on the decision of the Karnataka High Court in *Times*

Publishing House Limited v. Financial Times Limited 1995 (1) Kar LJ 219 and submitted that the PRB Act is a special law which not only provided for publishing and printing of newspapers but safeguarded the title of the newspaper. According to him, the registration of the Defendants' newspaper under the PRB Act was obtained much prior to the application made by the Plaintiffs for registration of the trade mark in relation to the news channel. He also placed reliance on the decision in *Competition Review (P) Ltd. v. N.N. Ojha 1996 PTC (16)* to submit that 'Aaj Tak' was a generic term and the Plaintiffs could not claim exclusive use to the said words. According to Mr. Nagar, it was unlikely that the subscriber to the Defendants' newspaper would be confused into thinking that it emanated from Plaintiffs. Reliance was placed on the decisions in *Ram Kumar Jalan v. R.J. Wood & Co. Ltd. (28) AIR 1941 Lahore 262*, *J.K. Kapoor v. Micronix India 1994 Supp (3) SCC 215*, *Parry and Co. Ltd. v. Perry & Co. AIR 1963 Madras 460*, *SBL Ltd. v. Himalaya Drug Co. 1997 PTC (17) (DB)*, *Rupee Gains Tele-Times Private Ltd. v. Rupee Times 1995 PTC (15)* and *Johnson and Johnson v. Christine Hoden India (P) Ltd. AIR 1988 Delhi 249*. The thrust of the submissions of Mr. Nagar was that since the Plaintiffs held registration for their trade mark in a different class of goods and services and since in any event the Defendants hold valid registration for their newspaper under the PRB Act, no case for infringement could lie against the Defendants. He further submitted that the suit was barred by delay and acquiescence.

20. The Plaintiffs admittedly hold registration for the mark 'Aaj Tak'. Placed on record are the relevant trade mark registration certificates as Exhibit P-2 (collectively). Registration No. 1242921 has been granted in favour of Living Media India Limited for the word mark 'Aaj Tak' in Class 41. The registration has been issued on 7th October 2005. It has been indicated that the mark has been used since 1st June 1995. The Class 41 certificate describes the goods and services as "Education, Providing of Training, Entertainment, Sporting and Cultural Activities". Registration No. 1242922 has been issued on 23rd November 2005 in favour of Plaintiff No.2 for the word mark 'Aaj Tak' in Class 38 with use claimed since 30th June 1995. The Class 38 certificate describes the goods and services as "Telecommunication included in class 38".

21. Section 28(1) of the TM Act, 1999 states that the valid registration of a trade mark shall give to the registered proprietor "the exclusive right to the use of the trade mark in relation to the goods and services in respect of which the trade mark is registered and to obtain relief in respect of infringement of the trade mark in the manner provided by the Act". There is no doubt, therefore, that in the present case the Plaintiffs hold the valid registration of the trade mark 'Aaj Tak' in Classes 38 and 41. The certificates relate back to the date of making of the application. They also constitute prima facie evidence of the date from which the use is claimed. Significantly, in both these certificates the use has been claimed from 1st June and 30th June 1995 respectively which are prior to the dates on which the Defendants

applied for registration of the newspaper using the same word mark 'Aaj Tak'.

22. Section 7(1) of the TM Act, 1995 states that the Registrar shall classify goods and services "as far as may be in accordance with International Classification of Goods and Services for the purposes of the registration of the trade marks". This has to be read with Rule 22 of the TM Rules which reads as under:

"22(1) For the purposes of the registration of trademarks, goods and services shall be classified in the manner specified in the Fourth Schedule.

(2) The goods and services specified in the Fourth Schedule only provide a means by which the general content of numbered international classes can be quickly identified. It corresponds to the major content of each class and are not intended to be exhaustive in accordance with the international classification of goods and services. For determining the classification of particular goods and services and for full disclosure of the content of international classification, the applicant may refer to the alphabetical index of goods and services, if any, published by the Registrar under Section 8 or the current edition of the international classification of goods and services for the purpose of registration of trade mark published by the World International Property Organisation or subsequent edition as may be published.

(3) The Registrar shall identify and include in the alphabetical index of classification of goods and services, as far as practicable, goods or services of Indian origin".

23. The Fourth Schedule to Rule 22 gives a detailed description of each of the classes of goods. For the purposes of the present case both
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Classes 38 and 41 fall under the sub-heading ‘Services’ in the Fourth Schedule to the TM Rules. Class 38 is “Telecommunications” and Class 41 is “Education; providing of training; entertainment; sporting and cultural activities”. The International Classification of Goods and Services (Nice Classification) (9th Edition) issued in Geneva in 2006 gives the further sub-classifications of the broad classification of the goods. Under Class 38, **sub-classification ‘380012’ concerns “news agencies/wire services”**. **Sub-classification ‘380005’ concerns “television broadcasting”**. Under Class 41, the relevant sub-classifications are **‘4110103’ “news reporters services”, ‘410026’ “production of radio and television programmes” and ‘410016’ “publication of texts, other than publicity texts”**. It is, therefore, seen that the dissemination of news and news reporting would be covered under Classes 38 and 41. It cannot, therefore, be said that the publishing of a newspaper by the Defendants is in a class of goods and services different from that for which Plaintiffs hold the trade mark registration.

24. Turning to Section 29 (1) of the TM Act it is seen that infringement can result when a person not being a registered proprietor uses in the course of its trade a mark “which is identical with or deceptively similar to the trade mark in relation to goods or services in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark.” In the present case it is seen that the Defendants are using an identical trade mark i.e. ‘Aaj Tak’. A perusal

of the sample newspaper of the Defendants depicting the infringing mark shows that the word mark 'Aaj Tak' is identical to the registered word mark of the Plaintiffs. Further, the visiting card of Mr. Manish Kumar, correspondent of the Defendants' newspaper shows the words 'Aaj Tak' with the word 'Aaj' above the word 'Tak'. This is identical to the Plaintiffs' depiction of their mark. Even the depiction of the name of their newspaper in an advertisement in the newspaper inviting enquiries for placing advertisement depicts the mark in a manner identical to the depiction of the Plaintiffs' mark i.e. the word 'Aaj' shown above the word 'Tak'. It also shows the address of the Defendants.

25. Even if Classes 38 and 41 are held not to cover newspapers, the publishing of newspapers is an allied and cognate activity similar to the goods and services for which the word mark 'Aaj Tak' has been registered in favour of the Plaintiffs. The adoption and use of such mark by the Defendants would undoubtedly cause confusion in the minds of the public and it is likely that the public will associate the activity of the Defendants with the Plaintiffs. Therefore, the ingredients of Section 29 (2) (b) of the TM act are also satisfied.

26. Under Section 29 (4) of the TM Act, where the registered mark is shown to have a reputation in India and the use of the impugned mark by the Defendant results in taking unfair advantage of the registered mark or is detrimental to, the distinctive character or repute of such registered mark there is no need for the owner of the registered trade

mark to demonstrate the likelihood of confusion in the mind of the public. As far as the present case is concerned, the uncontroverted evidence of the Plaintiffs clearly establishes that the Plaintiff No.2 is assignee and Plaintiff No.1 is the registered proprietor of the word mark 'Aaj Tak'. Secondly, the registrations are in respect of services under Classes 38 and 41 of the Fourth Schedule to the TM Rules. By virtue of Rule 22(2) of the TM Rules read with the Fourth Schedule these classes cover news reporting and dissemination of news as well. Thirdly, the Defendants are not the registered proprietor of the trade mark 'Aaj Tak'. The impugned mark 'Aaj Tak' adopted by the Defendants is identical to the registered mark 'Aaj Tak' phonetically, structurally and visually. The statements made on affidavits by the Plaintiffs regarding the reputation enjoyed by the registered mark in India and worldwide and the demonstrable exploitation of that mark by the Defendants by inviting applications for 'Aaj Tak Models' and for advertisements by issuing tariff rates remains uncontroverted. It has been satisfactorily proved by the Plaintiffs that the adoption and use of the impugned mark by the Defendants will cause detriment to the distinctive character and repute of the registered mark of the Plaintiffs. It is also been shown that the Defendants have by such use taken unfair advantage of the goodwill and reputation of the Plaintiffs' mark. There is nothing in the cross-examination of Plaintiffs' witnesses which disproves their case.

27. Significantly, the Defendants have not led any evidence whatsoever to counter the evidence of the Plaintiffs. As explained in

A.Raghavamma v. A. Chenchamma AIR 1964 SC 136 and *Mohd. Naved v. Hindustan Petroleum Corporation*, the failure by the Defendants to examine themselves and to submit themselves to cross-examination as witnesses would result in discrediting the truth of their case.

28. To summarise, the Court is of the view that the Plaintiffs have been able to demonstrate that there has been an infringement of the Plaintiffs' registered trade mark in terms of Section 29(1) and 29 (2) (b) of the TM Act. Further by the material brought on record, the Plaintiffs have been able to demonstrate that the trade mark 'Aaj Tak' has a distinctive character and reputation in India and that the Defendants have sought to take unfair advantage of the reputation and goodwill of the Plaintiffs' mark and that such use is detrimental to the distinctive character and reputation of the registered trade mark thus attracting infringement in terms of Section 29(4) of the TM Act.

29.1 Since considerable reliance has been placed by learned counsel for the Defendants on the decision of the Division Bench of the Karnataka High Court in *Times Publishing House Ltd.*, the Court proposes to discuss the said decision at some length. The facts in the said case were that the Plaintiff Financial Times Limited ('FTL') filed a suit in the civil court in Bangalore against Times Publishing House Ltd. ('TPHL') alleging infringement of its trade mark 'Financial Times' by TPHL. Admittedly, FTL held registration for the mark 'Financial Times'. An interim injunction was granted by the civil

court restraining TPHL from printing and publishing 'The Financial Times'. TPHL was publishing 'The Economic Times' and offering 'The Financial Times' on a complementary basis along with 'The Economic Times' by printing it on a light pink paper which was similar to the colour of 'The Financial Times' as published by FTL. TPHL contended that it was registered under the PRB Act and that printing of newspaper was exclusively governed by PRB Act and, therefore, the Trade & Merchandise Marks Act, 1958 ('TMM Act') was not applicable. TPHL further contended that it was legitimately publishing 'The Financial Times' as a weekly newspaper after getting the necessary declaration from the RNI. The Division Bench of the Karnataka High Court relied upon the decision of this Court in *M.K.Agarwal v. Union of India 53 (1994) DLT 751* where it was observed that the PRB Act being a special enactment prevailed when it comes to registration of newspapers and that when a conflict arose between the two enactments it could be resolved on the basis of well settled principles of interpretation of statutes.

29.2 The Karnataka High Court, which was considering the above question at the interlocutory stage, concluded that the PRB Act not only provided for printing and publishing newspapers but safeguarded the title of newspapers. Since TPHL had applied for, obtained registration of the title and thereafter used it, no malafides could be attributed to TPHL.

29.3 The second factor that weighed with the High Court was that there was a variation in the number of pages, news items, articles and the price of 'The Financial Times' published by FTL. Its circulation was only 231 copies and was available to selected members/contributors. It was held that without a PRB Act registration, there was no right to publish a newspaper in India. In those circumstances it was held that there was no possibility of deception since the readers were literate and could recognise the differences between two newspapers. More importantly, the PRB Act at the relevant time restricted publication of a newspaper by non-residents. In the circumstances, the hardship that would be caused to TPHL would be greater if the injunction was granted in favour of FTL. It was held that the trial court committed an error in holding that the TMM Act alone would govern the publication of newspapers.

30. The above decision is distinguishable on facts for more than one reason. In the first place it was a decision at the interlocutory stage of the matter and the fact that weighed to the Division Bench was that the newspaper published by FTL hardly had any circulation in India. Secondly, being a foreign entity it could not seek registration under the PRB Act. Thirdly, TPHL had a large circulation and was holding registration under the PRB Act and was in the business of publication of newspapers for long. Fourthly, as far as the present case is concerned, the Plaintiffs have been able to show that they have been in the business of disseminating news since 1995. The use claimed in both trade mark registration certificates is from June 1995.

Admittedly, this is prior to the date on which the Defendants applied for and obtained registration of its title under the PRB Act. No parallel can therefore be drawn between the facts in the *Times Publishing House Limited* case and the instant case.

31. As explained in the decision of this Court in *Playboy Enterprises*, the PRB Act is concerned with registration for the purposes of publication. The PRB Act does not deal with various aspects of trade marks, the rights of a trade mark owner and remedies for infringement. The *Times Publishing House Limited* decision was rendered at a time when the TM Act had not been enacted. Under Section 7 of the TM Act read with Rule 22 and the Fourth Schedule of TM Act, it is clear that the classification of goods and services under the TM Act read with the TM Rules is of a wider nature. Further under Section 29 (4) of the TM Act there is an express protection afforded to well-known marks, and marks that are shown to have a reputation in India, even where they are in respect of goods and services different from those in respect of which the infringer has adopted and used an identical or similar mark. Therefore, even in law it is possible that the decision in the *Times Publishing House Limited* case may have been different had the above provisions existed at the time it was rendered. This Court is therefore of the view that the decision in the *Times Publishing House Limited* does not help the case of the Defendants.

32. Turning to the question of damages, the Court is of the view that

in the circumstances of the case, the Plaintiffs are entitled to a decree for punitive damages against the Defendants. In ***Time Incorporated v. Lokesh Srivastava 2005 (30) PTC 3 (Del)*** the Court awarded the Plaintiff Rs. 5 lakhs as punitive damages after holding that “a large number of readers of the defendants' Magazine 'TIME ASIA SANSKARAN' also have suffered by purchasing the defendants' Magazines under an impression that the same are from the reputed publishing house of the plaintiff company.”

The Court explained:

“the award of compensatory damages to a plaintiff is aimed at compensating him for the loss suffered by him whereas punitive damages are aimed at deterring a wrong doer and the like minded from indulging in such unlawful activities.... The punitive damages are founded on the philosophy of corrective justice and as such, in appropriate cases these must be awarded to give a signal to the wrong doers that law does not take a breach merely as a matter between rival parties but feels concerned about those also who are not party to the *lis* but suffer on account of the breach.”

33. Consequently, the Court is of the view that in the instant case, the Defendants should be asked to pay the Plaintiffs punitive damages in the sum of Rs. 5 lakhs to act as a deterrent against the Defendants infringing the registered mark of the Plaintiffs.

34. The Court answers the issues framed as under:

Issue No.1: Does the Plaintiff prove entitlement to injunctive relief,

as claimed, based on ownership of the registered trade mark ‘Aaj Tak’?

The above issue is answered in the affirmative by holding that the Plaintiffs are entitled to a permanent injunction, as claimed, against the Defendants and their agents, employees and servants, jointly and severally, based on the Plaintiffs’ ownership of the registered trade mark ‘Aaj Tak’.

Issue No.2: Does the Plaintiff prove the Defendant’s use of the mark or words ‘Aaj Tak’ amounts to infringement and/or passing off?

The above issue is answered in favour of the Plaintiffs and against the Defendants holding that the Defendants’ use of the impugned mark and word mark ‘Aaj Tak’ amounts to infringement and/or passing off of the Plaintiffs’ registered trade mark.

Issue No.3: Does the Defendant prove its entitlement to use the word ‘Aaj Tak’ on the basis of registration under the Press and Registration of Books Act, 1867?

The above issue is answered in the negative against the Defendants by holding that the Defendants have failed to prove their entitlement to the use of word mark ‘Aaj Tak’ on the basis of the registration under the PRB Act.

Issue No.4: Is the Plaintiff entitled to damages and/or rendition of accounts, as claimed?

The Plaintiff is entitled to punitive damages in the sum of Rs. 5 lakhs from the Defendants, jointly and severally. The Plaintiffs are also awarded costs of Rs.25,000 against the Defendants.

35. The suit is decreed in the above terms. Decree sheet be drawn up accordingly.

OCTOBER 7, 2013
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S. MURALIDHAR, J.

