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O.A. No.200 of 2024 in C.S. (Comm.Div.) No.58 of 2024

IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on : 25.11.2024

Pronounced on : 02.12.2024

CORAM:

THE HON'BLE MR. JUSTICE ABDUL QUDDHOSE

O.A.No.200 of 2024 in C.S.(Comm.Div.)No.58 of 2024

Ananda Vikatan Publishers (P) Ltd.,
represented by its Authorised Signatory
Editor/Publisher Kalai Selvan Theiste .. Applicant/plaintiff

VS.

1.News Tamil 24 x 7,
owned and controlled
by S.Plus Media Ltd.,
represented by its
Director Sakilan Padmanabhan

2.S Plus Media Ltd.,
represented by its Director
Sakilan Padmanabhan

.. Respondents/defendants

For Applicant/plaintiff : Mr.Perumbulavil Radhakrishnan

For Respondents/defendants : Mr.Richardson Wilson

ORDER

This Original Application has been filed by the applicant/plaintiff
seeking for an interim injunction to restrain the respondents/defendants



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from passing off the applicant's/plaintiff's mark or the title "KAZHUGU" or any similar or identical name, mark, with prefix and/or suffix, in respect of their program on their News Tamil 24 x 7 Satellite channel or such other channels, websites like YouTube, Facebook, Instagram and/or other Social Media websites as and for the celebrated mark, name, title, artwork "KAZHUGU" (கழுகு) / "MISTER KAZHUGU" (மிஸ்டர் கழுகு), the character "MISTER KAZHUGU" (மிஸ்டர் கழுகு) pertaining to the publications in media, scoops, investigative journalism, crime and investigation and, political and socio- economic topics in any form, mode in any manner whatsoever till the disposal of the suit.

2.This application is being re-heard by this Court pursuant to the directions given by the Division Bench of this Court in its order dated 10.09.2024 passed in O.S.A. (CAD) No.103 of 2024.

3.In the aforesaid appeal, the applicant/plaintiff is the appellant and the respondents/defendants are the respondents. Originally, a commercial suit in C.S. No.58 of 2024 was filed by the applicant/plaintiff for infringement of copyright and for passing off in respect of the Trade Mark "MISTER KAZHUGU" and "KAZHUGU". The



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applicant/plaintiff is a publisher of 'Tamil Bi-weekly'. They claim that they are in the business for more than forty years and that they are also regularly publishing a bi-weekly article under the title "MISTER KAZHUGU" and "KAZHUGU" and the said marks have acquired distinctiveness by their long usage and therefore, they claim that they have the exclusive right over the Trade Marks "MISTER KAZHUGU" and "KAZHUGU". However, according to them, in the month of September 2023, the respondents/defendants, who are running a television channel, as part of one of their television programs, aired a program titled "news tamil 24x7 KAZHUGU", which is deceptively similar to that of the applicant's/plaintiff's Trade Mark.

4. According to the applicant/plaintiff, the program telecasted by the respondents/defendants also deals with investigative journalism as is the case with the applicant's/plaintiff's article under the titles "MISTER KAZHUGU" and "KAZHUGU". According to the applicant/plaintiff, the program telecasted by the respondents/defendants under the title "News Tamil 24x7 KAZHUGU" in their television channel, will amount to misrepresentation and will amount to passing off, as the public will have an impression that the telecast of the program by the respondents'/



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defendants' television channel is a program being produced by the applicant/plaintiff.

5. The suit has been filed for copyright infringement as well as for passing off. However, this interlocutory application has been filed only for injunction against the respondents/defendants from passing off. The applicant/plaintiff claims that the telecast of the aforesaid program in the respondents'/defendants' television channel has caused disrepute to the applicant's/plaintiff's reputation in the market, as both the applicant/plaintiff and the respondents/defendants are in the very same media segment of business.

6. A counter affidavit has been filed by the respondents/defendants, denying the allegations of the applicant/plaintiff. According to the respondents/defendants, the suit and the interlocutory application filed against them are not maintainable for the following reasons:

a)The applicant/plaintiff and the respondents/defendants are not in the very same line of business. The applicant/plaintiff is a publication house and in the print media, whereas the respondents/defendants are running a television channel and is in the electronic media.



b) The word "KAZHUGU" meaning "Eagle" is a generic word and

no one can claim monopoly over it;

c) The applicant/plaintiff has not obtained Trade Mark registration for its marks "MISTER KAZHUGU" or for "KAZHUGU" and therefore, they cannot seek the relief of copyright infringement as well as passing off as prayed for in the suit, since the respondents/defendants are in a different media segment.

d) The applicant/plaintiff has applied for Trade Mark registration subsequent to the filing of the suit under class 16 of the Trade Marks Act, 1999, which deals with magazines and periodicals, whereas, the respondents/defendants had applied for Trade Mark registration under class 38 of the Trade Marks Act, 1999, which deals with news agencies, electronic news and transmission, etc. Having applied for registration under different classes, no interim injunction can be granted against the respondents/defendants as prayed for in this application, since the same cannot cause confusion in the mind of any person of average intelligence with imperfect recollection. The marks of the applicant/plaintiff as disclosed in the plaint and in the application are not similar to the marks of the respondents/defendants. The font, colour scheme and get up of



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both the marks are totally different and no person of average intelligence with imperfect recollection will get confused over the same.

e) The origin of the respondents'/defendants' mark is different. In the title to the respondents'/defendants' program, it has been made clear that the origin is "News Tamil 24x7 'KAZHUGU'", which goes to show that the producer of the program is only "News Tamil 24x7" and not the applicant/plaintiff.

7. By way of reply to the submissions made by the learned counsel for the respondents/defendants, the learned counsel for the applicant/plaintiff would submit that the applicant/plaintiff has applied for Trade Mark registration not only under class 16, but also under class 41, which deals with 'entertainment'. However, the learned counsel for the respondents/defendants would submit that such a plea has not been taken in the affidavit filed in support of this application and no documentary evidence to prove the same has also been placed on record before this Court by the applicant/plaintiff.

Discussion:

8. This Court is deciding only an Interlocutory Application in a Commercial Suit. Under the Commercial Courts Act, strict timelines have



been fixed for the disposal of the main suit itself. While deciding an interlocutory application, an in-depth analysis of the subject matter of the dispute is not possible without oral evidence. Therefore, a party seeking interim injunction, pending disposal of the suit, has to necessarily satisfy the trinity tests, namely, a)prima facie case; b)balance of convenience and c)irreparable hardship.

9. A prima facie case means a party has enough evidence to support a claim. The term comes from the latin phrase 'prima facie' which amounts 'at first sight' or 'on the face of it'.

10. The balance of convenience is a legal doctrine that helps the Court to determine whether to grant a temporary injunction or not. It is used when a Court is satisfied that the plaintiff has a prima facie case and must then decide, which party would be more inconvenienced by granting or denying the injunction. The balance of convenience doctrine considers the following factors:

- a)Potential harm to the plaintiff if the injunction is denied;
- b) Inconvenience caused to the defendant if the injunction is granted;



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c) Whether the defendant gained an unfair advantage by withholding information or acting in a way that goes against fair legal proceedings.

11. The balance of convenience doctrine is a natural safeguard to prevent unjust and irreparable harm from occurring when an injunction is granted or denied in-correctly.

12. Irreparable injury/hardship is a serious harm that cannot be compensated for with money.

13. The applicant/plaintiff and the respondents/defendants will have to bear in mind that for the present, this Court is only adjudicating interim injunction application and is not deciding the main suit. This Court has taken note of the fact that this suit was filed in the year 2023 and till date, this interlocutory application is still pending and due to the same, the main commercial suit could not be proceeding with and disposed of, to comply with the time period fixed under the Commercial Courts Act.



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14. Insofar as this application is concerned, a learned Single Judge of this Court had earlier dismissed this application. Aggrieved by the same, the applicant/plaintiff preferred an Original Side Appeal. The Division Bench of this Court by its order dated 10.09.2024 in O.S.A (CAD) No.103 of 2024 has set aside the order of the learned Single Judge and has remanded this application back to this Court for fresh consideration. Pursuant to the directions issued by the Division Bench of this Court, this Court has reheard this application.

15. The issue that arises for consideration in the suit is whether the respondents/defendants have committed an act of passing off by copying the mark "KAZHUGU" of the applicant/plaintiff and has used the said mark for its Television programme under the title "News Tamil 24x7 'KAZHUGU'".

16. The following facts are undisputed:

a) The applicant/plaintiff has not obtained trade mark registration for their marks "KAZHUGU" and/or "MISTER KAZHUGU", but they claim to have acquired distinctiveness through their long usage in their bi-weekly magazine 'Junior Vikadan';



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b)The applicant/plaintiff is basically in the print media, though they claim that of late, they have also entered the social media through Youtube, Instagram, Facebook, etc., through which, they claim that "KAZHUGU" and/or "MISTER KAZHUGU" programmes are being telecasted;

c) "KAZHUGU" and/or "MISTER KAZHUGU" are not the names of the magazine published by the applicant/plaintiff, but the said titles have been given only for an article published regularly in the 'Junior Vikadan' magazine.

17. Section 2(1)(h) of the Trade Marks Act, 1999 defines the word "deceptively similar". As per the said definition, the mark shall be deemed to be deceptively similar to another mark if it so nearly resembles that other mark as to be likely to deceive or cause confusion". It implies that two marks may be labelled as deceptively similar if the company's mark is so close to an already established trademark that utilizing it will lead customers to inaccurately identify the two companies as to whom the mark belongs.



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18. During the course of arguments made by the learned counsel for the respondents/defendants, he had submitted on instructions that the respondents/defendants are prepared to put a disclaimer in their TV programme “KAZHUGU” that the said programme is the exclusive production of the first respondent’s/first defendant’s TV channel. An affidavit to that effect dated 19.11.2024 has also been filed before this Court.

19. The criteria for detecting deceptive similarity was established long ago by the Hon'ble Supreme Court in the case of **Cadila Healthcare Ltd. vs. Cadila Pharmaceutical Ltd. reported in 2001 (5) SCC 73**. The Hon’ble Supreme Court established specific guidelines for detecting deceptive similarity. It ruled that the following factors should be taken into account in determining whether a mark is deceptive: a) the nature of the products or services of the mark relates to; b) the degree of resemblance between the two marks, and c) The type of mark—whether it be a word, symbol, or phrase and d) the target audience that the company offers are also significant factors.



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20. In another decision of the Hon'ble Supreme Court in the case

of Parle Products (P) Ltd. Vs. JP Co. Mysore reported in AIR 1972

SC 1359, the Hon'ble Supreme Court established a standard to evaluate whether two trademarks are deceptively similar. It is said that a thorough examination of both marks was not required. Instead, the degree of general resemblance should be assessed based on the possibility of customer misunderstanding that it would result.

21. Passing off is a legal action that protects a company's goodwill and reputation from being mis-represented by another party. The passing off action is instituted under the Trade Marks Act when a business's goods or services are passed off as that of another business. To establish a passing off claim, the applicant must prove the following factors:

- a) It owns a reputation in the market;
- b) By the usage of the deceptively similar mark, the infringer has created confusion and has misled the customers into believing that the products sold by the infringer belongs to the applicant;
- c) The mis-representation by the infringer has damaged or is likely to damage the goodwill/reputation of the applicant.



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22. In Tamil, “KAZHUGU” means "Eagle". The applicant/plaintiff claims that the mark “KAZHUGU” used in their bi-weekly magazine ‘Junior Vikadan’ has acquired distinctiveness identified only with the applicant/plaintiff by its long usage for the past more than 40 years.

23. The first respondent/first defendant is a Television Channel. On a prima facie consideration, this Court is of the view that the target audience of the applicant’s/plaintiff’s magazine ‘Junior Vikadan’, which is primarily in the print media, and the target audience of the first respondent’s/first defendant’s TV Channel, which is in the electronic media, are different.

24. Subsequent to the filing of the suit, both the applicant/plaintiff and the first respondent/first defendant have applied for trade mark registration in respect of the trade mark “KAZHUGU”. Admittedly, they have applied under different classes. One applicable to magazines and the other applicable to electronic media. On a prima facie consideration, this will go to show that the target audience of the applicant’s/plaintiff’s magazine ‘Junior Vikadan’ and the target audience of the first respondent’s/first defendant’s TV Channel are different. While



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determining whether a mark is deceptive or not, as held by the Hon'ble

Supreme Court in **Cadila Healthcare vs. Cadila Pharmaceutical Ltd.**,

referred to supra, the nature of the products or services the mark relates to, should also be taken into account. The applicant/plaintiff has also not produced as on date any documentary evidence to prove that they had suffered loss on account of the usage of the applicant's/plaintiff's mark "KAZHUGU" by the respondents/defendants.

25. In the plaint as well as in the affidavit filed in support of this application, they have also not disclosed the approximate loss suffered by them on account of usage of the mark "KAZHUGU" by the first respondent's/first defendant's TV Channel in respect of one of their TV programmes. Differences were also pointed out by the learned counsel for the respondents/defendants between the applicant's/plaintiff's font size of the mark "KAZHUGU" and the first respondent's/first defendant's mark "KAZHUGU" as seen from its screen shot. He also drew the attention of this Court to the getup and colour scheme of the mark "KAZHUGU" as seen from the screen shot of the television programme produced by the first respondent's/first defendant's TV Channel by using the mark "KAZHUGU" and would submit that there are several differences



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between the first respondent's/first defendant's colour scheme and get up and the applicant's/plaintiff's mark. Admittedly, "MISTER KAZHUGU" is not used by the first respondent's/ first defendant's TV Channel in its Television Programme for which mark alone the suit for passing off has been filed by the applicant/plaintiff.

26.The applicant's/plaintiff's trade mark as found in the applicant's/plaintiff's article in their bi-weekly magazine 'Junior Vikadan' and the screen shot of the programme in which the mark "KAZHUGU" is used by the first respondent/first defendant is re-produced hereunder:



27. Apart from the usage of the title "news tamil 24x7 'KAZHUGU'" in one of their TV programmes, the same is accompanied by the words "கூர்மை, புலனாய்வு, தெளிவு" meaning Sharpness, Criminal Investigation, Clarity', which are not appearing in the article



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published in the bi-weekly magazine 'Junior Vikadan'. The applicant/plaintiff has been using only the mark "MISTER KAZHUGU" since its launch. The respondents/defendants are using only "KAZHUGU" along with the words "News Tamil 24x7 'KAZHUGU'" for their television programme. Though the applicant/plaintiff may claim that the word "KAZHUGU" used by them in their article for long number of years has acquired secondary meaning and has become distinctively associated only with the applicant/plaintiff, the said claim cannot be decided in an Interlocutory Application seeking for interim injunction, when there are several disputed facts. The applicant/plaintiff has also not produced any documentary evidence to prove that the usage of the mark "KAZHUGU" by the first respondent's/first defendant's TV channel amounts to misrepresentation and causes confusion in the minds of the public, who may think that the television programme is also a programme produced by the applicant/plaintiff. If at all only after trial, the relief sought for by the applicant/plaintiff in this application can be granted after the applicant/plaintiff through its oral and documentary evidence has proved that the respondent/defendant has committed the act of passing off.

28. Passing off occurs when illegal use of a trade mark or trade



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name in such a way that the public is misled into believing that the products or services supplied by one party are genuinely those of another.

This mis-representation can harm the goodwill and reputation of the legitimate owner of the trade mark. Passing off is recognized under the Trade Marks Act for protecting any registered trademark and for preventing unfair competition. Before this Court, there is no clinching evidence as of now produced by the applicant/plaintiff to prima facie establish that there has been mis-representation by the first respondent's/ first defendant's television channel by using the mark "KAZHUGU" in one of their TV programmes as if the said programme is produced by the applicant/plaintiff. The available documentary evidence produced by the applicant/plaintiff also does not prima facie establish that on account of usage of the mark "KAZHUGU" by the first respondent's/first defendant's TV channel in one of their TV programmes, the applicant's/ plaintiff's reputation and goodwill has been tarnished. Eventhough the article published in 'Junior Vikadan' under the title "MISTER KAZHUGU" and the programme "News Tamil 24x7 'KAZHUGU'" telecasted in the first respondent's/first defendant's TV Channel involves investigative journalism, the said fact would not suffice at this Interlocutory stage to prove that the first respondent/first defendant has



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committed an act of passing off.

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29. Both the applicant/plaintiff and the respondents/defendants being media houses, investigative journalism is a common area of work for any media house. The averments contained in the plaint also does not contain any undisputed facts, which will establish that the applicant/plaintiff is having the exclusive right of usage of the marks “MISTER KAZHUGU” and “KAZHUGU”. It is to be noted that “MISTER KAZHUGU” is not used by the first respondent’s/first defendant’s TV Channel, but “KAZHUGU” alone is used. Being a generic word, whether “KAZHUGU” can be associated only with the applicant/plaintiff and cannot be associated with any other media house, cannot be adjudicated in this Interlocutory Application as the same can be adjudicated only after the parties to the dispute let in oral and documentary evidence in support of their respective contentions.

30. The font, logo, colour scheme and get up of the applicant’s/plaintiff’s marks “MISTER KAZHUGU” and “KAZHUGU” and the mark “KAZHUGU” found in the screen shot of the programme of the first respondent’s/first defendant’s TV Channel are also not identical and



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several differences were also pointed out by the learned counsel for the respondents/defendants. This being the case, the question of granting an interim injunction as prayed for by the applicant/plaintiff at the Interlocutory stage does not arise.

31.To protect the interest of the applicant/plaintiff, in case they succeed in the suit after trial, as an interim protection, the respondents/defendants have filed an affidavit dated 19.11.2024 before this Court undertaking to have a disclaimer in their screen shot, which contains the mark “KAZHUGU” that their programme has been exclusively produced only by them. This Court is of the considered view that the applicant/plaintiff will be fairly protected at this interlocutory stage if the respondents/defendants while telecasting their programme “News Tamil 24x7 ‘KAZHUGU’” place a disclaimer in the screen shot that the said programme is the exclusive production of the first respondent’s/first defendant’s TV channel.

32. HALSBURY’S Laws of England, observed that in an action of passing off to establish the likelihood of deception or confusion where there has been no direct misrepresentation would generally require the



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presence of two factual elements:

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(i) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(ii) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected. While it is helpful to think of these two factual elements as two successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is ultimately a single question of fact.

33. In arriving at the conclusion of fact as to whether deception or confusion is likely, the Court will have regard to:

- (a) the nature and extent of the reputation relied upon,
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business,
- (c) the similarity of the mark, name, etc., used by the defendant to that of the plaintiff,
- (d) the manner in which the defendant makes use of the name,



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mark etc., complained of and collateral factors, and

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(e) the manner in which the particular trade is carried on, the class of persons who is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the Court attaches importance to the question as to whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.

34. This Court with the available evidence at the interlocutory stage cannot grant the interim injunction as prayed for by the applicant/plaintiff in view of the disputed facts and the primary fields of business activity of both the applicant/plaintiff and the respondents/defendants being different as one is primarily in the print media and the other is in the electronic media. The tests as laid down by Halsbury's Laws of England for passing off as referred to supra have not been established by the applicant/plaintiff at this interlocutory stage.

35. Under the Trade Marks Act, the “relevant class of persons”



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refers to the potential customers or consumers who would be likely to purchase goods or services bearing the trademark in question. When determining the relevant class, the Court considers how the average consumers in that market would perceive the trademark and its association with specific goods or services. Since on a prima-facie consideration, this Court is of the opinion that the applicant/plaintiff is primarily in the print media, whereas the respondents/defendants are primarily in the electronic media, the question of the readers/viewers getting confused as to the origin of production, does not arise.

36. For the foregoing reasons, since the applicant/plaintiff has not satisfied the trinity tests, namely, a)prima facie case; b)balance of convenience; and c)irreparable hardship, the question of granting interim injunction as prayed for by the applicant/plaintiff in this application does not arise. The balance of convenience and irreparable hardship at this interlocutory stage is in favour of the respondents/defendants. Interim injunction if granted without the applicant having not made out a prima-facie case through sufficient documents placed on record, the respondents/defendants will be put to irreparable loss as they have been telecasting the programme “News Tamil 24x7 ‘KAZHUGU’” from



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September, 2023 onwards.

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37. In the result, there is no merit in this application and this application is dismissed. However, as per the undertaking given by the respondents/defendants through their affidavit dated 19.11.2024 placed on record before this Court, the respondents/defendants shall put a disclaimer in their screen for their TV programme “News Tamil 24x7 ‘KAZHUGU’” that the said programme is their exclusive production. It is also clarified that any observation made by this Court in this order either for or against any of the party to the suit will not have any bearing in the final adjudication of the main suit, as those observations have been made only for the purpose of adjudicating this interlocutory application.

02.12.2024

Index: Yes/ No
Speaking order / Non speaking order
Neutral citation : Yes / No
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Note to Office: Registry is directed to place the entire bundle before the Advocate Commissioner - Mr.M.Nandan, District Judge (retd.) on 11.12.2024 for recording evidence.



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ABDUL QUDDHOSE, J.
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**pre-delivery order in O.A.No.200 of 2024
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