

Atul

**IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
SUIT NO. 2854 OF 2010**

1. THE INDIAN EXPRESS LIMITED,
a company incorporated under the
provisions of the Companies Act, 1956
having its registered office at 2nd Floor,
Express Towers, Nariman Point,
Mumbai – 400 021

**2. INDIAN EXPRESS NEWSPAPERS
(MUMBAI) LTD.,**
a company incorporated under the
provisions of the Companies Act, 1956
having its registered office at Express
Towers, Nariman Point,
Mumbai – 400 021

...Plaintiffs*Versus*

CHANDRA PRAKASH SHIVHARE,
Son of Shri Bhanwarlal Shivhare,
R/o: T.I.T. Complex, Old Bus Stand, Behind
Collector Nivas, Ganeshpura, Morena,
Madhya Pradesh 476 001
And at Dhoolkot Road, Dhaulpur, Rajasthan

...Defendant**APPEARANCES**

FOR THE PLAINTIFFS

**Dr. A. D. Chandrachud, with Mr. A.
Joshi, i/b Ms. P. Kamani**

FOR THE DEFENDANT

Mr. R.D. Soni, i/b Mr. R.S. Champawat

CORAM: G.S. PATEL, J
DATED: 16th October 2015 &
23rd October 2015

JUDGMENT:-

1. The Plaintiffs, the owners and proprietors of the popular and well known “Indian Express” group of newspapers and publications seek an injunction against the Defendant restraining him from infringing their registered trade mark “Indian Express”. The Plaintiffs have set out the *inter se* devolution of title between them. This is not immediately germane, not being disputed. The 2nd Plaintiff is the registered proprietor of various trade marks and it has assigned these to the 1st Plaintiff, today the subsequent proprietor.

2. The Defendant says that he is a publisher as much by occupation as inclination. He is a resident of Ganeshpura, Morena, Madhya Pradesh. There, he claims to have begun and carried on for a short time the publication and limited distribution of a journal or a newspaper with the name “Indian Express”, written, however, in Devnagari. It is this action that prompted the present suit.

3. The Plaintiffs are two of several companies and corporate entities in the Indian Express group. The phrase “Indian Express” features prominently in the corporate names of most, if not all, of these corporate entities. The Plaintiffs publish newspapers and magazines in English and many other regional languages. There are about 20 such publications with 68 editions. These emanate from

50 centres across India. Till recently there was also a publication in the United States. The Indian Express newspaper itself has been in publication since 1932. It is published from various cities. It has a popular and busy online edition. It enjoys a circulation even in the areas where it is not actually published.

4. The Plaintiffs also claim to have registrations to the mark “Indian Express” in Class 16. I will turn to the evidentiary material in this regard shortly. It is, however, sufficient to note that this claim to the ownership of the trade mark registration is not disputed by the Defendant.

5. In addition to these trade mark registrations, and this is of some consequence, the Plaintiffs have also registered the title “The Indian Express” with the Registrar of Newspapers for India (“RNI”). This is a statutory body under the Press and Registrations of Books Act, 1867 (“**the Press Act**”). The Plaintiffs have some title registration dating back half a century or more in various parts of India. Particulars are set out in the Plaint, which also contains particulars of various awards won by the Plaintiffs and their publications, the work that they are known for, their Internet presence and so on.

6. The Plaintiffs claim that in May 2009 they learnt that the Defendant approached the RNI and attempted to register “Indian Express” under the Press Act. The Defendant claimed to be using the word “Indian Express” in “another language”. It is true that what the Defendant registered was in Devnagari but, as Dr. Chandrachud for the Plaintiffs points out, whether this can be said

to constitute use “in another language” is more than somewhat debatable. The Plaintiffs wrote to the RNI on 5th May 2009 asserting their rights. I will revert to the relevant documentary evidence in this regard later. The Plaintiffs also applied for trade mark registration of “Indian Express” in Devnagari.

7. The Defendant has filed a Written Statement. He says in this that he obtained title registration to “Indian Express” in Devnagari under the Press Act long before the Plaintiffs obtained trade mark registration in Devnagari. Having obtained title registration, he *bona fide* used it till he received a notice from the Plaintiffs. The sum and substance of the Written Statement, as I see it, is not a dispute or contest on facts at all. What the Defendant says is that he is entitled to use and exploit his Press Act registration and that this does not constitute an infringing use of the Plaintiffs’ mark. In short, the Defendant says that he used the words “Indian Express” written in Devnagari only as a title of his publication and not in any other way. His use in that fashion is legitimate and permissible under the provisions of the Press Act. He does not suggest that the provisions of the Press Act must override the provisions of the Trade Marks Act, 1999 but only suggests what is, apparently, a policy of peaceful co-existence, presumably meaning that while the Plaintiffs’ use of the word “Indian Express” in English and perhaps elsewhere in Devnagari may continue, at least so far as Morena, Madhya Pradesh is concerned, the Defendant is well within his rights to use “Indian Express” as a title to his newspaper without being accused of infringement.

8. Issues were struck on 6th March 2013. Documents on both sides were assessed for marking in evidence. The Plaintiffs led the evidence of one Ms. Vaidehi Thakar who filed three Affidavits of Evidence and was cross-examined. The Defendant examined himself. The entire record has been recompiled and sequentially paged. References to documents in the following discussion are to page numbers in this recompiled record.

9. To complete the factual narrative, there was an ad-interim order passed on 11th January 2011. That order was confirmed on 7th February 2011. The Plaintiffs filed a Contempt Petition (L) No. 67 of 2015 alleging the Defendant to be in violation of these orders. Notice was issued. That Contempt Petition was finally disposed of on 1st October 2015. The terms of that order are of some consequence. By that time, the Defendant had applied for rectification of the register and also sought registration in his own name of the mark “Indian Express”. He undertook to the Court, and this undertaking I accepted, that he would withdraw both. He also expressed apology and this too was accepted. The Contempt Petition was disposed of on that basis.

10. The result of this is that there is today no pending application by the Defendant either for rectification of the register in respect of the Plaintiffs’ marks or for registration of a mark in his own name. The Register of Trade Marks continues to show the Plaintiffs’ marks. The Defendant continues to have a registration under the Press Act of the word “Indian Express” written in Devnagari. The question, therefore, will be whether the Defendant

is entitled to continue using that word as a title to his publication in Madhya Pradesh.

11. The issues framed are set out below:

<u>Sr. No.</u>	<u>Issues</u>	<u>Findings</u>
1.	Whether the Plaintiffs prove that this Court has jurisdiction to entertain and try the present Suit?	Yes*
2.	Whether the Plaintiffs prove that they are owners of the registered trademark "Indian Express"?	Yes*
3.	Whether the Plaintiffs prove that the various applications to Registrar of Newspapers of India (RNI) and proposed use of the Plaintiffs' registered trademark by the Defendant in various cities as indicated by the said applications constitutes infringement or intention to infringe the Plaintiffs' registered trademark?	Yes
4.	Whether the Defendant proves that the Plaintiffs' registered trademark "Indian Express" is restricted to any particular font, script and/or territory? If yes, to which font, script and/or territory?	No*
5.	What order? What relief?	Suit decreed

12. Mr. Soni for the Defendant, on instructions, did not, in fairness, contest or pursue the defence on Issues Nos. 1 and 2, or attempt to press Issue No. 4. He restricted himself to Issue No.3, and that is, therefore, the only issue for consideration. Shortly

stated, Mr. Soni's case is that the provisions of the Press Act and the Trade Marks Act, 1999 must be construed 'harmoniously'; and that, therefore, where there is valid and subsisting registration with the RNI under the Press Act for a publication title, the use of that title can never constitute infringement of a mark registered under the Trade Marks Act, 1999. In any case, and this is the second limb to his submission, the Plaintiffs' newspaper is not published in Morena, and therefore there is neither a question of infringement nor of passing off. Thirdly, he submits that the Defendant is using the expression in another language, one in which the Plaintiffs did not, at the time of the suit, have a subsisting RNI title registration.

13. The Indian Express newspaper was first published in 1930s. Exhibit P16 in evidence is a copy of the front page of the Indian Express edition of 2nd January 1933.¹ Exhibit P-17 is a copy of the front page of the 9th August 1942 edition.² Part of the same exhibit is a reproduction of the 28th June 1975 edition with a blank editorial in protest against the declaration of the Emergency.³ Exhibit P-15 is a letter dated 20th March 2013 from the RNI setting out the cities from which the Indian Express is published.⁴ The cities listed are Mumbai, Pune, Nagpur, Ahmedabad, Vadodara, New Delhi, Chandigarh, Lucknow, Kolkata and Jammu. These details are amplified in paragraph 9 of the Plaint, where the dates of first registration with the RNI in these cities are also set out.⁵ The

¹ Compilation *p.* 340.

² Compilation *p.* 341.

³ Compilation *p.* 342.

⁴ Compilation *p.* 328.

⁵ Compilation *p.* 9, paragraph 9.

Indian Express was registered with the RNI under the Press Act for Mumbai and Delhi in 1957. Other cities followed.

14. The mark “Indian Express” was registered under the Trade Marks Act, 1999 as a word mark in Class 16 for newspapers of the Fourth Schedule to the Trade Marks Rules, 2002 on 23rd June 2004 with a registration date of 23rd June 1994 under No.631652. The legal proceedings certificate is in evidence.⁶ A label mark was also registered in the same class for other paper products with a registration date of 7th October 2004.⁷ The word mark’s user is shown to be from 1st January 1953, and the label mark’s since 31st December 1932. On 21st May 2009, the Plaintiffs applied for registration of “The Indian Express” in Devnagari in Classes 16, 35 and 42.⁸ The Plaintiffs also use a device of nibs on their masthead, and the special font, lettering and this device are registered. These are not disputed. There is in evidence a list of the various registrations obtained by the Plaintiffs, including of “Indian Express”, in various classes.⁹ On 7th July 2014, the Plaintiffs obtained registration in Class 16 of the word mark “The Indian Express” written in Devnagari (disclaiming only the use of the word “Indian” used separately), with a registration date of 26th May 2009 under number 1822066.¹⁰ There are identical registrations obtained in Class 35 on 23rd June 2014¹¹ and in Class 42 on 7th July 2014.¹²

⁶ Exhibit P-10, Compilation *pp.* 298-299.

⁷ Exhibit P-9, Compilation *pp.* 300-301.

⁸ Exhibit P-11, Compilation *pp.* 302-304.

⁹ Exhibit P-12, Compilation *pp.* 305-322.

¹⁰ Exhibit P-31, Compilation *pp.* 385-386.

¹¹ Exhibit P-32, Compilation *pp.* 389-390.

¹² Exhibit P-33, Compilation *pp.* 387-388.

15. The first of these, the registration in Class 16 with a registration dated of 26th May 2009, is of some importance because it precedes the first publication by the Defendant of a newspaper. That, admittedly, was on 21st June 2010.¹³

16. There is no dispute about any of this, and indeed there is no cross-examination on these registrations, or the facts about the Plaintiffs' publications in India (and, for a time, overseas). Dr. Chandrachud points that in cross-examination, the Defendant admitted that he had published about 2000 copies of his newspaper and did so for between two and four months, ceasing when he received a notice from the Plaintiffs. Exhibit P-26 is a listing of the various title registrations with the RNI for "Indian Express".¹⁴ This shows the Defendant as having obtained as many as four registrations in Dhaulpur, Raipur, Faridabad and Morena. The earliest of these is the one for Morena on 9th June 2010. That is the only place, admittedly, from which the Defendant published his newspaper. The present suit was filed in August 2010.

17. Dr. Chandrachud took me through the Affidavit in lieu of Examination-in-Chief of Ms. Vaidehi Thakar, PW1.¹⁵ In paragraph 15 of her first Witness Affidavit, Ms. Thakar said in terms:

"I say that this multi edition newspaper is published from Ahmedabad, Chandigarh, Delhi, Jammu (until recently), Kolkata, Lucknow, Mumbai, Nagpur, Pune, New York

¹³ Exhibit D-8, Compilations *p.* 418.

¹⁴ Exhibit P-26, Compilation *pp.* 372-373.

¹⁵ Compilation *pp.* 114-147; second affidavit *pp.* 148-152; third affidavit *pp.* 153-156.

(until recently) and Vadodara and also has an online edition and e-paper. I say that apart from the centres of publication, the newspaper is also widely circulated in several other States all over India, including Madhya Pradesh. I say that "THE INDIAN EXPRESS" enjoys immense prestige and goodwill among its readers, the public in general and also abroad."

18. Given Mr. Soni's formulation, as set out earlier, I imagine that this was central to at least the second leg of his case. Yet I find absolutely no cross-examination of Ms. Thakar on this.

19. Dr. Chandrachud says that the entire case of the Defendant is misconceived. He is not, contrary to Mr. Soni's suggestion, using "Indian Express" in another *language* even in his RNI registrations. Had that been so, he would have used an equivalent in Hindi (or some other Indian language) for the word "Indian" and another for "Express". The first might not present much difficulty: *Bharat* or *Bharatiya* might do. The second, however, is another matter altogether, and its 'translation' depends on how one sees the word 'Express': as a noun, a verb, an adjective or an adverb. Does the word, in translation, mean certain, clear, quick, expression, statement, disclosure, announcement, transportation, articulation, or something else entirely? "In another language" implies a translation, and Dr. Chandrachud asks what that might conceivably be: *Bharatiya Teevragati*? *Bharatiya Anusaran*? *Bharatiya Abhinyakti*? *Bharatiya Uccharan*? Those might, he says, be "Indian Express" in "another language", albeit of more than dubious felicity. But the Defendant claims no such thing. What he claims, Dr. Chandrachud

says, and I think quite correctly, is the right to use the term “The Indian Express” in *transliteration*, not in translation. By definition, a transliteration is a conversion of a text from one *script* or *alphabet* to another, not a translation from one language to another. The Shorter Oxford Dictionary, 5th Edition, defines ‘transliterate’, the verb as being to:

Replace (letters or characters of one language) by those of another used to represent the same sounds; write (a word, etc.) in the closest corresponding characters of another alphabet or language.

The noun ‘transliteration’ in the same reference work is:

The action or process of transliterating; the rendering of the letters or characters of one alphabet in those of another; the result of this.

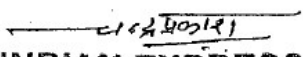
The Merriam-Webster Dictionary says transliteration is

to represent or spell in the characters of another alphabet.

20. There is therefore, no question of the Defendant’s use being ‘in another language’. In any case, even this is untrue. Dr. Chandrachud points to Exhibit D-4, a document produced by the Defendant himself,¹⁶ his declaration in Form I under the Press Act. That declaration bears a stamp used by the Defendant, and the

¹⁶ Compilation *pp.* 405-406.

stamp uses “Indian Express” in what is clearly both the English language and its alphabet, thus:


INDIAN EXPRESS
 Signature : T.I.T. Complex, M.S. Road
 Morena (M.P.)
 Name **CHANDRA PRAKASH SHIVHARE**
 Designation : **PUBLISHER & PRINTER**

21. In relation to the registrations under the Press Act, a few further facts are necessary. On 5th May 2009, the Plaintiffs wrote to the RNI saying that they had learned of an application made for registration of “The Indian Express” in Madhya Pradesh and, since the Plaintiffs had valid registrations under the Trade Marks Act, 1999 and the Copyright Act, 1957, and were publishers of a reputed and well known newspaper, that application ought not to be granted.¹⁷ On 13th May 2009, the Plaintiffs filed a query under the Right to Information Act, 2005 about the application made in Madhya Pradesh.¹⁸ The RNI replied on 10th June 2009,¹⁹ and that response included a copy of the RNI’s letter dated 11th February 2009²⁰ to the Defendant refusing his application for title registration. On 15th June 2009, the Plaintiffs wrote to the RNI again. They set out their trade mark registrations once more, and requested, first, that no title clearance be given to the Defendant;

¹⁷ Exhibit P-18, Compilation *pp.* 343-346.

¹⁸ Exhibit P-19, Compilation *pp.* 347-349.

¹⁹ Exhibit P-20, Compilation *pp.* 350-351.

²⁰ Exhibit P-20, Compilation *pp.* 350-351, *at* 351.

and that the Plaintiffs' application for title clearance be considered.²¹ There then followed a letter dated 13th July 2009 from the RNI to the authorities in Bhopal with a copy to the Plaintiffs rejecting the Plaintiffs' application.²² The Plaintiffs took up the matter and on 25th August 2009,²³ the RNI wrote to the Plaintiffs in Mumbai referencing its letter of 13th July 2009 and saying that the Defendant had applied for title clearance and registration; that this was refused; that the Defendant then filed Writ Petition No. 2190 of 2009 before the Gwalior Bench of the Madhya Pradesh High Court. Since that Writ Petition was pending and the matter was *sub judice*, no action could be taken on the Plaintiffs' application. However, the RNI's rejection dated 13th July 2009 of the Plaintiffs' application for title clearance was expressly withdrawn. As matters stand today, therefore, that application is pending. The Defendant's application for title registration was granted on 1st October 2010.²⁴ It seems that this registration was granted since the Madhya Pradesh High Court disposed of the Defendant's Writ Petition on 30th March 2010 by giving him liberty to move after a final order was passed under Section 6 of the Press Act.²⁵ It is not disputed that the Defendant's publication first appeared on 21st June 2010,²⁶ some months before the actual title registration.

²¹ Exhibit P-21, Compilation *pp.* 352-354.

²² Exhibit P-22, Compilation *pp.* 355-356.

²³ Exhibit P-23, Compilation *pp.* 357-359.

²⁴ Exhibit D-5, Compilation *p.* 407.

²⁵ Exhibit D-6, Compilation *pp.* 408-413, read with clarification dated 28th June 2010 Exhibit D-7, Compilation *pp.* 414-416.

²⁶ Exhibit D-8, Compilation *p.* 418.

22. Mr. Soni has no quarrel with Dr. Chandrachud's assertion that even under cross-examination, the Defendant has no dispute with the Plaintiffs' registrations under the Trade Marks Act, 1999.²⁷ Mr. Soni however points out that at the same time, PW1, Ms. Thakkar, has admitted in cross-examination that the Plaintiffs do not publish a Hindi edition of the Indian Express in Madhya Pradesh,²⁸ and, further, that to publish a newspaper, RNI registration is required.²⁹ Ms. Thakkar was also questioned on the Plaintiffs' application for trade mark registration of "The Indian Express" in Hindi. These questions, and Ms. Thakar's responses, need to be set out:

3. Q. Do the Plaintiffs publish a Hindi edition of the Indian Express in Madhya Pradesh?

Ans. No, they do not.

4. It is true that to publish a newspaper one needs a title clearance, a no objection and a registration of the proposed name of the publication from the Registrar of Newspapers (RNI), New Delhi.

5. Q. Is it correct that on the date of the suit the Plaintiffs are not the registered proprietors of the trademark The Indian

²⁷ Cross-examination of Defendant, Q.8, Compilation *pp.* 170-171.

²⁸ Cross-examination of PW1, Q.3, Compilation *p.* 158.

²⁹ Cross-examination of PW1, Q.4, Compilation *p.* 158.

Express in Hindi (Devnagari Script)?

Ans. Yes. That is correct. But we had already, before the suit was filed, applied for registration of the trade mark "The Indian Express" in Hindi (Devnagari Script). This was by way of abundant caution. We are the registered owners of the trade mark "The Indian Express".

23. To my mind, the questions here are more telling than the answers, and the result is, unfortunately, not quite Mr. Soni probably intended. Question 3 seems to me to be clear: that the focus was on whether there was a *Hindi edition* of the Plaintiffs' newspaper in Madhya Pradesh. Read with Question 5, this puts the matter of 'translation' versus 'transliteration' beyond the pale; and it also raises the question of honesty in adoption. Put simply: why Indian Express in particular? Why not the name of some other newspaper? One circulating in the North-East perhaps, or the South? One with a far more localized distribution? What Mr. Soni points out from the record provides no answer.

24. Mr. Soni's entire case is founded on the decision of learned single Judge of the Karnataka High Court in *Times Publishing House Ltd. v The Financial Times Ltd.*³⁰ The respondent in that appeal claimed to hold trade mark registrations, and complained that the appellant's use of the trade mark as a title registered under the Press Act was impermissible. The learned single Judge was of the

³⁰ ILR 1994 Karnataka 2068 : 1995 (1) Kar LJ 219

view that the Press Act was a special act and prevailed over the Trade & Merchandise Marks Act, 1958 (the precursor to the present Trade Marks Act, 1999); and that the two had to be read harmoniously. Since no one with a mere trade mark registration could publish a newspaper without a valid registration under the Press Act, that use of a title with Press Act registration could not be said to be an infringement of a registered trade mark. The only ‘harmonious construction’ possible, the Court held, is:

that a registration under the Trade Marks Act cannot be made with regard to the newspaper title if there is no registration under the Press Act. The principle of harmonious construction requires that the Special Act shall get primary importance and not to be eclipsed the act that the condition precedent for publishing a newspaper in India is the filing of a declaration under the Press Act.

25. This is, indeed, the entirety of Mr. Soni’s case. A working title under the Press Act is, he submits, a complete defence to an infringement action based on registration of the identical title as a trade mark under the Trade Marks Act, 1999. This is especially true, Mr. Soni says, where the Press Act registration is prior to the trade mark registration; and the Plaintiffs obtained their Devnagari mark registrations only in 2014. This misses completely the fact that those registrations, though granted in 2014, carry a registration date of 26th May 2009, well before the Defendant’s Press Act title registration on 1st October 2010; but I will for the moment let that

pass, though in my judgment that is in itself a sufficient answer to Mr. Soni's formulation.

26. I have the gravest misgivings about the applicability of this decision. Its starting point, that the Press Act is a special act and that the Trade Marks Act, 1999 (or its precursor) is not seems to me to be plainly incorrect. The Trade Marks Act, 1999 can hardly be called a 'general' law as we understand that term. Quite unlike the Contracts Act, the Specific Relief Act or the Transfer of Property Act, the Trade Marks Act, 1999 deals with a narrow and specialized subject, and with that alone. It is, as Dr. Chandrachud says, as special, if not more special, than the Press Act, and its fundamental contours are different. The process of registration of a trade mark is wholly different. It is not merely a licensing procedure, as is a title registration. The Press Act is a mere permission and Dr. Chandrachud says it is possibly an accident of history, perhaps a relic of the British Raj carried forward today. In any case, if both are special laws, then it is settled law that the later must prevail.³¹ Apart from this, it seems to me illogical that the Trade Marks Act, 1999 should permit the registration of marks in respect of books, newspapers and periodicals in Class 16 if those were to be solely governed by the Press Act. The inclusion of these in Class 16 of the Fourth Schedule to the Rules is *a fortiori* a complete answer. Moreover, the preambles to the two statutes differ markedly and show that they operate in different spheres. The Press Act is

for the regulation of printing presses and
of newspapers, for the preservation of

³¹ *Ashoka Marketing Ltd. & Anr. v Punjab National Bank & Ors.*, (1990) 4 SCC 406

copies of every book and newspaper printed in India and for the registration of such books and newspapers.

The Trade Marks Act, 1999 on the other hand is meant to

amend and consolidate the law relating to trade marks, to provide for registration and better protection of trade marks for goods and services and for the prevention of the use of fraudulent marks.

Finally, it cannot be insignificant that the *Financial Times* decision was under the Trade & Merchandise Marks Act, 1958, not the present Trade Marks Act, 1999. This is not irrelevant. Section 7 of the Trade Marks Act, 1999 says that the Registrar shall classify goods and services, as far as may be, in accordance with the international classification of goods and services for the purposes of registration of trade marks, and this must, of course, be read with Rule 22 of the Trade Marks Rules, 2002 and the Fourth Schedule. This makes it clear that the sweep and ambit of the Trade Marks Act, 1999 is far wider than the Press Act. The Trade Marks Act, 1999 is also wider than its 1958 precursor, for it introduces a concept unknown to the previous statute, and that is to be found in Section 29(4). This grants express protection to well-known marks that have a domestic reputation (in India), even where those marks relate to goods and services that differ from those of the infringer. This was not the state of the law at the time of the *Financial Times* decision. In any case, that decision was at an interim stage, not at the final hearing of the suit, and with which I am concerned today.

27. Dr. Chandrachud also points out that the Karnataka decision has been doubted or not followed in later decisions. It was cited before a learned single Judge of the Delhi High Court in *TV Today Network Limited and Anr. v Kesari Singh Gujjar and Ors.*,³² (“*Aaj Tak - I*”) a tussle between the proprietors of the registered trade mark “aaj tak” in relation to television news channels and the publisher of a newspaper who claimed to have obtained Press Act registration to the same term. The Karnataka decision, though not discussed, was not followed, and the interim application for an injunction in trade mark infringement succeeded.

28. The Karnataka decision seems to have been cited by reference to its facts though not by name in the Delhi High Court decision in *Playboy Enterprises, Inc. v Bharat Malik and Anr.*³³ That was also a trade mark infringement action where the defendant claimed to be entitled to use “Playway” for a magazine, having obtained Press Act registration, and argued that there was, in that use, no infringement of the plaintiff’s registration of the trade mark “Playboy”. Though he did not cite *Financial Times* explicitly, the learned single Judge of the Delhi High Court expressly considered the rival acts. I need only reproduce the relevant paragraphs,³⁴ adding my own emphasis:

“28. Let us first deal with the distinctive features of PRB and TMM Act.

³² 2008 (38) PTC 262 (Del); per Ravindra Bhat J.

³³ 91 (2001) DLT 321 : 2001 (21) PTC 328 (Del); under the Trade & Merchandise Marks Act, 1958.

³⁴ Paragraph numbers from the Manupatra report: MANU/DE/0313/2001

29. The registration of name of magazine, calendar or any printed publication under the provisions of PRB Act is an independent action and has no relevance or effect either over-riding or over-stepping the provisions of TMM Act. The preamble of the PRB Act itself demonstrates that this Act was not made for the purpose of governing disputes relating to names, titles and trade marks. Trade mark or mark registered under the TMM Act or its prior, long and known existence particularly the mark of arbitrary nature makes it so strong, the infringement of which entitles the user to obtain injunction against the infringer.

30. 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.

31. 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. The Fourth Schedule of the TMM Act has adopted the international classification of goods including the kinds of the goods in question. Magazines, periodicals are included in Class 16. Had the PRB Act, which too is a special Act, a precedence over the TMM Act, the inclusion of magazines, periodicals and other literature in Class 16 would have been omitted as the registration of the name of the periodicals and printed publication is compulsorily registrable under the PRB Act. Thus the two Legislations should not be confounded and confused. So far as the valuation or infringement of the trademark or mark is concerned this is to be regulated by the provisions of TMM Act and provisions of the PRB Act are of no relevance."

29. The suit itself in the *Aaj Tak* case was decided a few years later in 2013 by S. Muralidhar J of the Delhi High Court: *TV Today Network Limited and Anr. v Kesari Singh Gujjar and Ors.*,³⁵ ("*Aaj Tak - II*"). Here, the Karnataka decision in *Financial Times* was specifically cited and considered, and I believe I must follow that reasoning:

28. Since considerable reliance has been placed by learned counsel for the

³⁵ 2013 (56) PTC 359 (Del)

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*: (1994) DLT 751 where it was observed that the PRB Act being a special enactment prevailed when it comes

to registration of news papers 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.

28.1 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 mala fides could be attributed to TPHL.

28.2 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/contributories. 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.

29. 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.

30. 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.

30. I am in most respectful agreement with the entire line of authority of the Delhi High Court. I cannot bring myself to accept Mr. Soni's submission that the Karnataka view should be preferred. The reasons for not doing so are plain. This entire line of authority also renders otiose any argument that the Defendant before me has not used "The Indian Express" in a 'trade marky' sense.

31. There is yet another vital point of distinction between the *Financial Times* case and this one; and, indeed, between the *Aaj Tak - II* case and this one. In the *Financial Times* case, the mark was registered to the respondent, the Financial Times, while it was Times Publishing that had Press Act registration and wide circulation. In the *Aaj Tak - II* case, the plaintiff TV network had the trade mark registration but no Press Act registration. In the present case, the Defendant has no trade mark registration at all, and does not dispute the Plaintiffs' entitlement to such registrations. But the Plaintiffs *also* have Press Act registrations, and have immense circulation (unlike the Financial Times), and this, too, is not disputed. They even have trade mark registration, though of relatively recent vintage, in Devnagari. All that they lack, and their application for this is clearly pending, is Press Act registration in Hindi in Madhya Pradesh. The Defendant has no circulation to speak of: a few months at best, and no more than 2000 copies by his own admission.

32. Dr. Chandrachud is justified in his reliance on the decision of the Supreme Court in *Cadila Health Care Ltd v Cadila Pharmaceuticals Ltd*.³⁶ The tests are well established: if the defendant's use of a mark is so structurally, phonetically, visually and aurally similar to that of the plaintiff, an injunction will usually follow, except in certain limited circumstances. Given the longevity of the Plaintiffs' mark, its widespread use, daily production in very many centres across India, multiple editions, online presence, and large circulation the conclusion that theirs is a well-known mark must necessarily follow. Once this is done, the Plaintiffs are

³⁶ (2001) 5 SCC 73.

automatically entitled to protection under Section 29(4) of the Trade Marks Act, 1999. But they are also entitled to protection at closer quarters: none may lay claim to title registration under the Press Act of “The Indian Express” in any script. Doing so would *ipso facto* result in a trade mark infringement, and no use of a Press Act registration can be permitted as would result in such an infringement. Registration under the Press Act is not a defence to an infringement action under the Trade Marks Act, 1999.

33. The final nail in the coffin, as it were, is the Defendant’s acceptance, by reason of a complete lack of cross-examination, of PW1’s categorical assertion that the Plaintiffs’ publication, though not printed in Morena, is in wide circulation in Madhya Pradesh. Mr. Soni’s argument in this context seems to me to hark back to a distinctly antediluvian era, a time when broadsheets were hand-printed, were sold by street-corner vendors calling out headlines, and enjoyed no more than a restricted circulation. Those days are long gone. The Plaintiffs’ newspaper has an active epaper that is accessible in its myriad editions from anywhere in the country. I do not think that it is Mr. Soni’s intention to suggest that Morena is so far fallen off the national grid that it remains insulated from the Internet or modern technology. Ms. Thakar has, in her first evidence affidavit,³⁷ specifically attested to the Plaintiffs’ publications’ widespread and popular Internet presence and the reputation and goodwill the Plaintiffs’ publications and mark enjoy. She also says that the mark is uniquely identified with the Plaintiffs and their publications. She was questioned on none of this.

³⁷ Paragraphs 23 and 24, Compilation *pp.* 133-134.

34. There is also no law that says that reputation and goodwill in a trade mark are geographically constrained to the place of their registration or, in the case of a newspaper, to the place where it is printed. Goodwill and reputation follow use, and the ‘use’ of a newspaper is wherever it is circulated, not only where it is printed. *The Hindu*, for instance, is not published in Mumbai, but is available here; so are many magazines published in the South. Kolkata-based newspapers are accessible here in their online editions. International newspapers from the *New York Times* to *The Economist* are also all available and in circulation in India, though not one of them is locally published. The place of publication is clearly irrelevant. The Plaintiffs have shown wide circulation and longevity of use. Therefore, as a matter of law, once the Plaintiffs’ witness attested to all this and, in addition, specifically to circulation in Madhya Pradesh, and there was no cross-examination of her on this, she could safely be said to have discharged the burden of proof; and the onus then shifted to the Defendant to show through cogent evidence that the Indian Express newspaper, in any language, was not circulated in Madhya Pradesh and Morena; that no one in Morena knew of it; and that, therefore, the Plaintiffs had neither reputation nor goodwill in their trade mark in Madhya Pradesh.

35. I cannot but help question the Defendant’s choice of this title for his Press Act registration? Why particularly “The Indian Express”? He does not explain, and does not suggest that this was the result of some unbidden epiphany. There are very many publications and newspapers in this country; he elected for one.

36. The third (and only) issue for determination must therefore be answered in the affirmative for the Plaintiffs and against the Defendant. His use of “The Indian Express” in the Devnagari script is an infringement of the Plaintiffs’ registered marks. The suit is decreed in the following terms: The Defendant, his heirs, assigns and all who claim by or under him are all permanently restrained from in any manner using the words “Indian Express” in any form, either by themselves, or with any other words or symbols, and whether in English or in any other language or script so as to infringe the Plaintiffs’ registered trade marks including but not limited to those referred to in the Plaint, its annexures, and in the documents marked as exhibits in evidence.

37. There will be no order as to costs.

38. Decree to be drawn accordingly.

39. The original documents tendered in evidence are to be returned to the respective parties on these being substituted with the authenticated copies.

(G. S. PATEL, J.)