

* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

Reserved on: 12.10.2015
Pronounced on: 29.01.2016

+ **FAO (OS) 110/2014, C.M. APPL.3742/2014**

LIVING MEDIA INDIA LTD. & ANR.Appellants

Through: Sh. C.M. Lall with Sh. Sajad Sultan and Ms.
Nancy Roy, Advocates.

Versus

ALPHA DEALCOM PVT. LTD. AND ORS.Respondents

Through: Ms. Kanika Sinha with Sh. Ankit Bhatnagar,
Advocates.

CORAM:

HON'BLE MR. JUSTICE S. RAVINDRA BHAT

HON'BLE MS. JUSTICE DEEPA SHARMA

MR. JUSTICE S. RAVINDRA BHAT

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1. In this appeal, the dissatisfied appellants (hereafter "plaintiffs") complain against the denial of temporary injunction in their suit, which claims trademark infringement and passing off, by the respondents (hereafter "defendants") and seek injunctive relief.

2. The plaintiffs in their suit allege that they and their affiliates are major media corporations in India with significant commercial presence in the print and electronic media. They are engaged in varied business activities, such as printing and publishing magazines, journals, periodicals, newspapers, operating news broadcasting channels, infotainment programs, FM radio channels, organizing conferences, seminars, music shows, production of music albums etc. The first plaintiff is owner and publisher of the weekly news magazine "INDIA TODAY" which has a significant

holding in its sphere of activity, since 1975. It is published in various regional languages in India while its international editions are published in USA, Canada, UK, Doha etc. The first plaintiff also owns and publishes a business magazine under the trade mark "*Business Today*", a travel magazine "*India Today Travel Plus*", an architecture and design magazine "*Design Today*", and other magazines under the trade mark "*Spice Today*" and "*Money Today*" etc. Each of these is a trademark. The said plaintiff also publishes a daily newspaper "MAIL TODAY" through its associate in collaboration with the prestigious Daily Mail of the United Kingdom. It used to publish and circulate a daily afternoon newspaper under the trade mark "TODAY". The first plaintiff manufactures and markets music cassettes, CDs, VCDs and DVDs under the trade mark "MUSIC TODAY" and conducts music shows, concerts, live shows etc. under the said trade mark. The suit contends that the first plaintiff conducts an "*incredibly famous yearly conference/ colloquiums/seminar under the mark "INDIA TODAY CONCLAVE", wherein world leaders and eminent personalities converge and debate important and pressing issues on varied subjects.*"

3. The suit avers that the first Plaintiff, under a license through the second Plaintiff broadcasts popular news channels namely, "AAJ TAK" (Till Today) in Hindi and "HEADLINES TODAY" in English besides few other media channels like "AAJ TAK TEZ" and "DILLI AAJ TAK". It is alleged that the first plaintiff is the registered proprietor of the trade mark "TODAY" and its variations not only in India but also in various foreign countries. The plaint lists out growing sales figures arising from sale of goods and services under the trade mark "TODAY" and its variations: 2005-06 (₹ 268.647crores); 2006-07 (₹ 301.527 crores); 2007-08 (₹ 346.205

crores); 2008-09 (₹ 375.234 crores); 2009-10 (₹ 348.341 crores); 2010-11 (₹ 375.791 crores) and 2011-12 (₹ 369.383 crores). Likewise, the sales figures of the second plaintiff for services under the trademarks "Aaj Tak" and "Headlines Today" are shown to be: 2004-05- ₹ 138.94 crores; 2005-06, ₹ 157.81 crores; 2006-07- ₹ 184.51 crores; 2007-08, ₹ 226.52 crores; 2008-09- ₹ 238.79 crores; and 2009-10- ₹ 260.16 crores.

4. It is claimed that the plaintiffs are using said mark "TODAY" and its variants continuously since 1975 and have spent sufficient resources i.e money, time and creativity to promote and publicize these brands. The Plaintiffs' brand has earned the status of a "Well Known Trademark" and commands the highest level of protection irrespective of the class that they have been applied for or used in. It is also urged that the goodwill accrued to the said mark extends beyond the actual use of the mark; it is so widely used that the brand has become a household name. It is claimed that the trademark "TODAY" has assumed and acquired a secondary meaning owing to the Plaintiff and their affiliate's long, continuous and honest use; it is associated with the Plaintiffs and its affiliates only.

5. The suit claims that in late October 2012, during a routine search of the official website of the Registrar of Trademarks conducted on behalf of the Plaintiff(s), it was found that the first Defendant had applied for registration of the trademark 'Nation Today' in Class 38 allegedly claiming to be user of the trademark in respect of broadcasting and telecommunication services since June 23, 2010. The said defendant had filed 3 applications for registration of the said trademark i.e 2243158, 2286420 and 2322140 in Class 38. The second defendant, was a senior

employee of the second Plaintiff till 21.12.2011 and thereafter he apparently joined the first defendant as CEO. The applications for trademark registration of 'Nation Today' were filed after his appointment as CEO. The plaintiffs allege that he "*apparently influenced Defendants in applying and adopting the impugned trademark 'Nation Today' as the Defendant No.2 is aware of the tremendous brand value, reputation, popularity and goodwill associated with 'TODAY' and its variants for Plaintiffs.*" Thus, adoption by the defendants of the impugned trademark has been done dishonestly, with clear knowledge and *mala fide* intention so as to reap benefits of the plaintiffs' established reputation and goodwill. The adoption of the trademark TODAY by the defendants is questioned by the plaintiff as it not only infringes their rights in and to the said trade mark and its variations but also amounts to passing off its services as and for services of the Plaintiffs and/or their affiliates/subsidiaries.

6. The plaintiffs argued in the suit that the trade mark used by the Defendant is deceptively/confusingly/phonetically/structurally similar to trademark of the Plaintiffs and is also used for absolutely similar goods/services and clearly would convey to those in trade and the general public that there is some connection between the business of the Plaintiffs and the Defendants, when in reality no such connection exists.

7. The defendant filed a reply to the temporary injunction application, refuting the plaint allegations. It was also urged that the two marks were dissimilar and that the plaintiff could not claim exclusivity over the word TODAY. It was submitted that the plaintiff does not have a news channel using the mark INDIA TODAY. Other pleas such as the composite nature of

the plaintiff's mark and how the viewers would not be confused or deceived by mere use of the word TODAY were taken.

8. The learned Single Judge considered the suit averments as well as the submissions on behalf of the defendant. The learned Single Judge noticed that the defendants through their written statement had disputed that the plaintiff possessed rights over the expression TODAY. It was pointed out in the written statement that the defendants intended to launch a TV news channel NATION TODAY. Since the Court had, in another proceeding, restrained the launching of that channel, contentions as to whether the plaintiffs could obtain an interim injunction against the defendants for the use of the expression TODAY as part of the name of the proposed Channel was gone into. The learned Single Judge firstly noticed that the plaintiff had used TODAY in conjunction with several other words in respect of various services and marks used by it.

9. In the impugned order the learned Single Judge held that the plaintiff's trademark INDIA TODAY is a registered one. However, he was of the opinion that intended use of the mark NATION TODAY for a News TV Channel by the defendants would not amount to infringement of the plaintiffs' mark under Section 29 of the Trade Marks Act, 1999. The learned Single Judge took note of the fact that when registration of the mark TODAY in Class 38, which is *Telecommunications and Broadcasting* was sought by the plaintiffs, there was already an application pending for registration of a trademark "Punjab TODAY" for a TV news Channel. The applicant claiming use of that trademark was from the early 1990s. It was in these circumstances that the Trademark Registry objected that since the mark PUNJAB TODAY was used for a news Channel, and an application

for its registration was pending, the plaintiff's mark was descriptive and not distinctive. The plaintiffs contended that even though they had not entered the news channel business, with the mark TODAY, nevertheless the existing business under which the mark TODAY was being used, was in a related or allied field i.e. news media and publication. Therefore, there was every likelihood of confusion.

10. The learned Single Judge noted that the plaintiff's INDIA TODAY depicted India in a very small font as compared to the word TODAY, which was prominent, whereas the TODAY in the defendant's mark TODAY had a much smaller font than the expression NATION. Therefore, the learned Single Judge was *prima facie* of the opinion that there was no likelihood of any TV news Channel viewer being misled into believing that the news channel NATION TODAY was part of the plaintiffs' INDIA TODAY group. He then went on to hold that the plaintiff's claim that the stand-alone word mark TODAY had acquired secondary meaning and distinctiveness was a matter that had to be established during the trial by adducing necessary evidence and that a mere claim in this regard could not be accepted. In so holding the learned Single Judge relied upon and discussed several judgments of the Supreme Court.

11. In sum, the learned Single Judge was of the opinion that the defendants impugned mark NATION TODAY could not be said to be identical or deceptively similar to the plaintiff's mark INDIA TODAY and that even the mark NATION TODAY would not be deceptively similar to HEADLINES TODAY owned by the plaintiffs and would not lead to any confusion. It was also held that the expression TODAY which was a mark registered in Classes 16 and 35, were stand alone and that the plaintiff had

never used them for Telecommunications and Broadcasting. After taking all this into consideration, the learned Single Judge, while refusing injunction was of the opinion that the balance of convenience heavily weighed in favor of the defendant and accordingly dismissed the application under Order XXXIX CPC.

12. The appellant argues that the learned Single Judge was considerably influenced by the fact that the registration application for PUNJAB TODAY was pending adjudication. It was contended that in fact that issue stood concluded by another suit - CS(OS) 924/2002 where the plaintiff's registered proprietorship of the trademark TODAY was held to have been established and the defendant i.e. STV Enterprises Ltd. was permanently enjoined from using the trademark PUNJAB TODAY and from broadcasting its Channel or services by using the mark PUNJAB TODAY or any other similar name. It was contended by the plaintiff that the learned Single Judge did not take note of the fact that the viewership of the plaintiffs was likely to be lured into believing that the mark NATION TODAY, had an association with the plaintiff.

13. Mr. Lall, learned counsel urged that the dominant presence of the mark INDIA TODAY and its variants in different services in the media and news industry, led to the undeniable fact that any use of the expression TODAY was likely to impinge upon the plaintiff's rights. It was emphasized that there is no denial of the fact that the mark TODAY is in use. It has been registered in class 35 which is advertising and class 16 which is print. In these circumstances since there was no challenge to this aspect, the likelihood of confusion was greatest.

14. Mr. Lall, learned counsel for the plaintiff, argued that the learned Single Judge fell into error in holding that there was no deceptive similarity. Here it was emphasized that the word TODAY is not just similar but identical and occurs in both the marks i.e. the plaintiff's mark as well as the defendant's mark NATION TODAY. As between the two the plaintiff was in the market and was well known for the last four decades. Opposed to this the defendant had not even started its services and had merely applied for a license. In these circumstances, urged counsel, the learned Single Judge should have granted temporary injunction. Counsel relied on the judgments of the Supreme Court reported as *Ramdev Food Products Pvt. Ltd v Arvindbhai Rambhai Patel & Ors*¹ and *Laxmikant V. Patel v. Chetanbhai Shah & Anr*². He also relied on the judgment of this Court in *Anchor Beauty and Health care (P) Ltd v Procter & Gamble Manufacturing (Tiajin) Co. Ltd & Ors*. (a judgment of a learned learned Single Judge dated 09.07.2014, which was upheld by the Division Bench in *Procter & Gamble Manufacturing (Tianjin) Co. Ltd. & Ors v. Anchor Health & Beauty Care Pvt. Ltd*³).

15. Counsel for the defendant argued that the impugned judgment requires no interference. She contended that the word TODAY is close to the trade, i.e news channel broadcasting, and descriptive. Concededly the plaintiff did not use the expression TODAY or INDIA TODAY for any news channel. That it used the word Aaj Tak ("Till Today") did not imply that the expression TODAY was of such a distinctive character as to acquire

¹ AIR 2006 SC 3304

² 2002 (3) SCC 65

³ 2014 (59) PTC 421 (Del) (DB)

secondary meaning. Counsel argued that according to the list of permitted channels allowed to operate in India - both uplinking and downlinking services, a number of entities were using the word TODAY (i.e RUSSIA TODAY, LIVE TODAY, MANAGEMENT TODAY, etc.). She also submitted that in Class 9 there were marks such as ECOTTON TODAY, *Buy today Sell tomorrow*, *SPM Touching Tomorrow Today*, and in Class 25 there were at least a dozen marks registered as TODAY. Furthermore, in Class 35 itself, 8 out of 40 marks had been registered, with TODAY. The others were awaiting processing, or some other formalities and not many were objected.

16. It was submitted that the word TODAY in the context of current events coverage in the media is generic, and without a strong proof of secondary use, no plaintiff should be given injunction, not the least the present one. Highlighting that in other classes such as Class 36 and 42, several registrants of the word TODAY exist, it was submitted that given the relevance to the nature of services offered and also that the plaintiff's use of the TODAY mark is not in respect of existing TV services, there is no cause to grant injunction. Counsel argued that if the injunction to use the expression TODAY, which describes its services, were to be granted, other words too can be prevented from use, despite their denoting the nature of the services. In such eventuality, the plaintiff has to show that in the particular trade or service, how strongly is the word mark TODAY perceived by the general public and cannot fall back on the distinctiveness acquired in the magazine publishing field or in the Hindi news channel Aaj Tak.

Analysis and Conclusions

17. The discussion of the facts discloses that the plaintiffs are owners of several registered trademarks. Prominent amongst these is INDIA TODAY which has been used for a weekly magazine since 1975; others are MUSIC TODAY, BUSINESS TODAY, a travel magazine "INDIA TODAY TRAVEL PLUS", an architecture and design magazine "DESIGN TODAY", and other magazines under the trade-marks SPICE TODAY and MONEY TODAY etc. The plaintiff also publishes daily newspaper MAIL TODAY. It has apparently acquired two trademarks TODAY in classes 16 and 35. The argument for temporary injunction is that the plaintiffs have acquired distinctiveness to the extent that TODAY has gained a secondary meaning in the news, publishing and media segment; it is also a well known trademark. In support, they contend that the advertising and growing sales figures testify to the mark's gaining strength. The bedrock of their reputation is the word mark TODAY, with which the users and members of the public invariably associate the plaintiffs. Quite naturally, the defendant resists the argument and points out that TODAY is a descriptive term: descriptive of the services rendered by the plaintiff; it also has a strong descriptive or service associative meaning to the defendant's business, i.e news channel. Additionally, the defendant points out that TODAY has been used by several other channels and products and that *per se* absence of use of that word by the plaintiff in the English news channel segment cannot entitle it to *ad interim* injunctive relief.

18. There is no dispute about the fact that the plaintiff has been in the news magazine publication business for over four decades; if it asserts that it has acquired a strong reputation for the title INDIA TODAY, which is its registered trademark, the Court would be correct in assuming it to be so.

However, does that *per se* - along with sales figures and other financial details testifying to various brands and trademarks owned by the plaintiff, crystallize into a right to prevent others from using a common word, "TODAY" in respect of television news channel services. It is here that the matter requires a slightly closer scrutiny. The word TODAY is a common term and a dictionary one. Used in a non-contemporary sense, i.e without reference to time and as a mark, it could well be urged that it constitutes an arbitrary mark. However, its link with news is unmistakable. In this context, what acquires distinctiveness is the combination *India Today*.

19. The law demands closer scrutiny, when it comes to the use of common words (such as TODAY), that are descriptive (or semi-descriptive) of the services or goods offered by the service provider or trader. This reluctance was best described in *Re J Crosfield & Sons Ltd*⁴ "*Wealthy traders are habitually eager to enclose part of the great common of the English language and to exclude the general public of the present day and of the future from access to the inclosure.*" Again, in *Mars GB Ltd v Cadbury Ltd*⁵ it was held that:

"Where the trade mark allegedly used by the defendant comprises ordinary English words (such as "Page Three", considered by Slade J in News Group Newspapers Ltd v Rocket Record Co Ltd [1981] FSR 89 at 102) then, as this decision illustrates, that circumstance may be taken into account by the court in the process of reasoning."

The burden of establishing that what are descriptive of the commercial activity and can be protected - particularly when the plaintiff is not directly

⁴ [1910] 1 Ch 130

⁵ [1987] RPC 387

using it in the same field, but using it in combination with another or other words- is heavy, as expressed in *My Kinda Town Ltd v Soll* ⁶(the Chicago Pizza case):

'It has to be borne in mind always that the burden of proving the case that he has elected to make is on the plaintiff and it is therefore important to consider the quality of the evidence which he calls, what it actually establishes, and whether it discharges that burden. In the ordinary case, this does not call for any very profound analysis for the question normally is simply whether damaging confusion has arisen or is likely to arise from similarity of get-up or description. But where it is inherent in the factual situation in which the parties are operating that there is some risk of confusion in any event from the mere fact that the parties are conducting the same trade and using in it descriptive titles of which neither can claim any legitimate monopoly -- as, for instance, in the Office Cleaning case -- a closer analysis is essential, for the simple fact of confusion does not, by itself, prove the plaintiff's case for him : it becomes an extraordinarily difficult question to answer where there is already a substantial potentiality for confusion of the two businesses simply by reason of their being engaged in the same trade. That does not mean, of course, that a defendant is legitimately entitled to build on and increase that potentiality in such a way that confusion becomes worse confounded, but it does mean that where evidence of actual confusion is tendered it has to be approached -- as indeed it was here by the learned judge -- with the caveat that there may well be reasons why it occurs which involve no question of legal liability at all.'

⁶ [1983] RPC 407. A similar reasoning was adopted in *British Diabetic Association v Diabetic Society Ltd and others* 1995 (4) All ER 812. Earlier, in *Office Cleaning Services Ltd v Westminster Window and General Cleaners Ltd* (1946) 63 RPC 39 it was held that:

'... the Courts will not readily assume that the use by a trader as part of his trade name of descriptive words already used by another trader as part of his trade name is likely to cause confusion and will easily accept small differences as adequate to avoid it. It is otherwise where a fancy word has been chosen as part of the name.'

Holding that the words LEISURE NEWS were incapable of protection given the fact that the activity was newly launched, it was held in *Marcus Publishing plc v Hutton-Wild Communications Ltd*⁷ that:

"But there is the further difficulty that the words Leisure News are merely descriptive words in the English language, descriptive of the nature of the publication. Of course descriptive words can come by use to acquire a special meaning as referable, in a particular field, like the field of magazines, to the product of one particular publisher. The name Country Life would seem to be a fairly simple example of that. But it is well established that it is not at all easy to establish goodwill in a name which merely consists of descriptive words: see Office Cleaning Services Ltd v Westminster Window & General Cleaners (1946) 63 RPC 39. The law is reluctant to allow ordinary descriptive words in the English language to be fenced off so as to become the private preserve of one particular publisher or tradesman."

20. In India too, it has been recognized that trademark use of generic or descriptive words have to be closely scrutinized before claims of injury are allowed.⁸ The Supreme Court ruling in *Skyline Education Institute (India) Ltd v S.L. Vaswani* declined to grant injunction to the plaintiff, who carried on business under the trademark "Skyline". The Court noted that a large

⁷ [1990] RPC 576. Also in *Baywatch Production Co Inc v The Home Video Channel* [1997] FSR 22 injunction was refused to the plaintiff, producer of the series Baywatch, even though the defendant was using the title "Babewatch" for its serial, having regard to all the surrounding circumstances.

⁸ *SBL Limited v. Himalaya Drug Company* 1997 (17) PTC 540 where it was held that "Nobody can claim exclusive right to use any generic word, abbreviation, or acronym which has become publici juris..." in *Bhagwan Dass Gupta Vs. Shri Shiv Shankar Tirath Yatra Company Pvt. Ltd.* 93 (2001) DLT 406 this court noted that the basic test to find out whether a trademark is publici juris is whether the mark has come to be so public because of its universal use that it does not confuse or deceive, by the use of it, the purchasers of the goods of the original trader.

number of other businesses had used the term "Skyline" for the same business activity, i.e educational services:

"the word `Skyline' is being used as trade name by various companies / organizations / business concerns and also for describing different types of institute/institutions. The voluminous record produced by the respondents before this Court shows that in India as many as 117 companies including computer and software companies and institutions are operating by using word `Skyline' as part of their name/nomenclature. In United States of America, at least 10 educational/training institutions are operating with different names using `Skyline' as the first word. In United Kingdom also two such institutions are operating. In view of this, it is not possible to agree with the learned counsel for the appellant that the Skyline is not a generic word but is a specific word and his client has right to use that word to the exclusion of others."

21. A sound principle articulated in *Wander Limited v. Antox India (Pvt.) Limited*,⁹ was that the exercise of discretion by a Court of first instance, which takes into account all relevant materials and pleadings, should not lightly and ordinarily be disturbed in appeal:

"... In such appeals, the appellate court will not interfere with the exercise of discretion of the court of first instance and substitute its own discretion except where the discretion has been shown to have been exercised arbitrarily, or capriciously or perversely or where the court had ignored the settled principles of law regulating grant or refusal of interlocutory injunctions. An appeal against exercise of discretion is said to be an appeal on principle. Appellate court will not reassess the material and seek to reach a conclusion different from the one reached by the court below if the one reached by that court was reasonably possible on the material. The appellate court would normally not be justified in interfering with the exercise of discretion under

⁹ (1990) Suppl. SCC 727.

appeal solely on the ground that if it had considered the matter at the trial stage it would have come to a contrary conclusion. If the discretion has been exercised by the trial court reasonably and in a judicial manner the fact that the appellate court would have taken a different view may not justify interference with the trial court's exercise of discretion."

22. On an overview of the circumstances, this Court is of opinion that the learned Single Judge was not in error in holding that the word TODAY had not acquired such distinctiveness for the plaintiff (which was not using it as a stand alone mark), to make out a *prima facie* strong case for grant of ad-interim injunction. The observations made in the course of this order shall not be construed as an expression of the merits of the rival claims; the relative strengths would be gone into during the trial. For these reasons, the appeal has to fail. It is accordingly dismissed, without order on costs.

S. RAVINDRA BHAT
(JUDGE)

DEEPA SHARMA
(JUDGE)

JANUARY 29, 2016