



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

% *Judgment Reserved on: 29th May, 2023*
Judgment Delivered on: 4th July, 2023

+ **CS(COMM) 279/2022**

TV 18 BROADCAST LIMITED Plaintiff

Through: Mr. Chander M. Lall, Senior Advocate with Mr. Mayank Mikhail Mukherjee and Mr. Ujjwal Singh, Advocates.

versus

BENNETT, COLEMAN AND COMPANY LIMITED Defendant

Through: Mr. Hemant Singh, Ms. Soumya Khandelwal and Ms. Pragya Jain, Advocates.

CORAM:
HON'BLE MR. JUSTICE AMIT BANSAL

JUDGMENT

AMIT BANSAL, J.

I.A. 6589/2022 (O.XXXIX R.1 and 2 of the CPC)

1. By way of the present judgment, I shall decide the application filed on behalf of the plaintiff for grant of interim relief.
2. Notice in the present application was issued on 29th April, 2022 and accepted by the counsel appearing on behalf of the defendant. Reply to the application and rejoinder thereto have duly been filed on behalf of the parties. Arguments were heard on 27th April, 2023, 23rd May, 2023 and 29th May, 2023, when judgment was reserved in the captioned application.

CASE SET UP IN THE PLAINT


3. The case set up in the plaint is as under:



3.1. The plaintiff is a part of the Network18 group, which is India's largest media and entertainment conglomerate.


3.2. The business operations of the plaintiff involve running various television channels in India such as CNBC-TV18, CNN News18 and News18, and which news channels run across twenty-six states in the country and in fifteen different languages. The plaintiff is also in the business of running entertainment and infotainment media channels such as Colors, Nickelodeon, MTV and History TV18.

3.3. In addition to operating television channels, the plaintiff is engaged in the business of creating television shows that are broadcast under their well-

known trademarks such as "NEWS18", "BOTTOMLINE", and 



/ "BHAIYAJI KAHIN" [hereinafter "Bhaiyaji Kahin" marks].

3.4. The plaintiff adopted the device mark  with effect from 29th December, 2016 under classes 38 and 41. The details of the registrations granted in favour of the plaintiff for the said mark are provided in paragraph 7 of the plaint.

3.5. On 26th December, 2016, the plaintiff first aired its Hindi television



show under the mark  /  on News18 India and has broadcasted over 1,200 episodes ever since.



3.6. Since the show has been running in a successful and uninterrupted manner, the “Bhaiyaji Kahin” marks have attained immense goodwill and reputation amongst the show’s viewers/audience. This is further evidenced from the viewership of the show with some of the episodes having garnered over 11 million views. The show has also won various awards, details of which are given in paragraph 12 of the plaint.

3.7. The show titled “Bhaiyaji Kahin” has also generated a revenue of Rs.73,89,40,000/- from the year 2017–2018 to 2021–2022. Details of the sales revenue generated by the plaintiff are given in paragraph 15 of the plaint. In the year 2021–2022 alone, the plaintiff’s revenue was Rs.16,26,42,000/-.

3.8. In January, 2022, it came to the knowledge of the plaintiff that the defendant was launching a show titled “Bhaiya Ji Superhit” using the



trademark , wherein newsworthy issues were to be brought to light through humour and satire.

3.9. The show of the defendant is also available to watch online on YouTube on the Times Now Navbharat YouTube channel.

3.10. Owing to the similarity in the trademarks as well as the nature of the show of the plaintiff and the defendant, the plaintiff served a cease and desist notice dated 10th January, 2022, calling upon the defendant to, *inter alia*, stop



using the impugned mark “Bhaiya Ji Superhit”/ .



3.11. In response to the aforesaid cease and desist notice, the defendant vide communication dated 19th January, 2022 requested the plaintiff to withdraw the cease and desist notice, noting that neither was the show format of the defendant similar to that of the plaintiff, nor was there any likelihood of confusion between the impugned mark and the trademark of the plaintiff.

3.12. On 24th February, 2022, the plaintiff once again sent a legal notice to the defendant, reiterating the contentions raised in its first cease and desist notice. However, the defendant refuted the claims made in the notices sent by the plaintiff.

3.13. Accordingly, the plaintiff has filed the present suit seeking to restrain the defendant from infringing the trademarks of the plaintiff, passing off and other ancillary reliefs.

WRITTEN STATEMENT FILED ON BEHALF OF THE DEFENDANT

4. The following submissions have been made in the written statement filed on behalf of the defendant:

4.1. The defendant is the media conglomerate “Times Group” that is engaged in the business of print, digital and television media, which includes various news channels such as Times Now, ET Now and Times Now Navbharat.



4.2. The trademark “TIMES NOW” and logo of the defendant have acquired goodwill and reputation in the market due to the defendant’s extensive promotion efforts and media coverage. The Hindi news channel of



the defendant, “TIMES NOW NAVBHARAT”/ has various



shows under its belt such as “News Ki Paathshala”, “Opinion India Ka” and “Bhaiya Ji Superhit”.

4.3. The show “Bhaiya Ji Superhit” of the defendant is an interactive thirty-minute infotainment programme that has become immensely popular since its first episode aired on 8th January, 2022.

4.4. There is no likelihood of confusion between the competing marks of the parties as even the mark “Bhaiyaji Kahin” was registered with the rider/condition that “*Registration of this trade mark shall give no right to exclusive use of the word separately,*” thereby meaning that the plaintiff has no right to claim exclusive use of the word “Bhaiyaji”.

4.5. The word/term “Bhaiya”/ “Bhaiyaji” is a generic Hindi word that literally translates to “brother” and therefore, the plaintiff cannot claim exclusive use of the said word/term.

4.6. There is no likelihood of confusion between the two competing marks/shows of the parties as the viewers of the shows identify the same with two different news channels, being “TIMES NOW NAVBHARAT” and “NEWS18”.

4.7. The format of the shows of both the parties are completely different. The show of the defendant is an infotainment programme that is hosted by a comedian, whereas the show of the plaintiff is in the form of a news debate show. Further, the show of the defendant is scripted and non-interactive, which is not the case with the show run by the plaintiff.

SUBMISSIONS ADVANCED ON BEHALF OF THE PLAINTIFF

5. Senior counsel appearing on behalf of the plaintiff made the following submissions:



5.1. There is no disclaimer on the word “Bhaiyaji” in respect of the registration granted in favour of the plaintiff under class 38. Therefore, the plaintiff is entitled to complete protection of the mark “Bhaiyaji Kahin” in class 38.

5.2. Although the plaintiff is not claiming exclusive rights over the term “Bhaiyaji”, the said term is the most dominant part of the plaintiff’s registered trademark.

5.3. It is a settled position of law that marks have to be compared as a whole to see if there is a similarity between the competing marks. Reliance in this regard is placed on the judgments in *Corn Products Refining Co. v. Shangrila Food Products Ltd.*, AIR 1960 SC 142; *Cadbury India Ltd. v. Neeraj Food Products*, 2007 SCC OnLine Del 841; and, *Pankaj Goel v. Dabur India Ltd.*, 2008 SCC OnLine Del 1744.

5.4. The show, “Bhaiyaji Kahin” has been running for over a decade. Therefore, the mark of the plaintiff has acquired distinctive character on account of its long user by the plaintiff.

5.5. The adoption of the mark “Bhaiya Ji Superhit” by the defendant is dishonest inasmuch as the defendant is using a similar mark for a similar programme that is based on current affairs.

SUBMISSIONS ADVANCED ON BEHALF OF THE DEFENDANT

6. Counsel for the defendant made the following submissions:

6.1. The format of the shows of the plaintiff and the defendant are totally different. The show of the plaintiff is set in an outdoor setting in which the anchor moves around on the streets, speaking to members of the public about matters of public importance. On the other hand, the defendant’s show is a



show shot indoors and one where the anchor uses humour and satire to make social commentary on newsworthy issues from the past week.

6.2. In the relevant class, class 41, which deals with television programmes, the registration has been granted in favour of the plaintiff with a clear limitation that the plaintiff will not have any right to the exclusive use of the term “Bhaiyaji”.

6.3. Once the plaintiff agreed on conditional registration, it cannot claim exclusivity on the term “Bhaiyaji”.

6.4. No exclusive rights vest in the plaintiff in respect of the term “Bhaiyaji” in view of Section 17 of the Trade Marks Act, 1999 as the said term is of a non-distinctive character.

6.5. Whether the mark of the plaintiff has acquired distinctiveness on account of long user is subject matter of trial and cannot be decided at this *prima facie* stage.

6.6. The essential component of the mark of the plaintiff is the term “Bhaiyaji”, as is evident from a reading of the plaint. Reference in this regard may be made to paragraph 28 of the plaint.

6.7. The term “Bhaiyaji” is common to trade and is used in various television as well as radio programmes. Reliance in this regard is placed on pages 22 to 167 of the defendant’s documents. Therefore, it is wrong to state that the adoption of the term “Bhaiyaji” by the defendant was malafide.

6.8. When the plaintiff applied for registration of its mark, the Registry raised an objection citing an earlier mark, “Bhaiyaji Aisa Kyun”, in its examination report. In its reply to the examination report, the plaintiff stated that the two marks have to be taken as a whole and cannot be dissected. When taken as a whole, there is no similarity between the two marks. Hence, the



plaintiff is now estopped from taking a different stand when it comes to the comparison between the marks of the plaintiff and the defendant. Reliance in this regard is placed on the judgments in *Raman Kwatra v. KEI Industries Limited*, 2023 SCC OnLine Del 38 and *Living Media India Ltd. v. Alpha Dealcom Pvt. Ltd.*, 2016 SCC OnLine Del 815.

7. I have heard the rival submissions.

ANALYSIS AND FINDINGS

8. The plaintiff's mark "Bhaiyaji Kahin" is registered under both classes 38 and 41. The registration under class 41 has a disclaimer with regard to the term "Bhaiyaji", whereas the registration under class 38 does not have any such disclaimer. At the outset, reference may be made to the Nice Classification¹ in respect of classes 38 and 41. Class 38 is set out below:

"Class 38

Telecommunications services.

Explanatory Note

Class 38 includes mainly services that allow at least one party to communicate with another, as well as services for the broadcasting and transmission of data.

This Class includes, in particular:

- transmission of digital files and electronic mail;*
- providing user access to global computer networks;*
- radio and television broadcasting;*
- video-on-demand transmission;*
- providing internet chatrooms and online forums;*
- telephone and voice mail services;*
- teleconferencing and videoconferencing services.*

This Class does not include, in particular:

- radio advertising (Cl. 35);*

¹ 12th Edition, Version 2023.



- telemarketing services (Cl. 35);
- **content or subject matter that may be contained in the communication activity, for example, downloadable image files (Cl. 9), providing business information via a website (Cl. 35), providing films and television programmes, not downloadable, via video-on-demand services (Cl. 41);**
- services conducted using telecommunication connections, for example, online retail services for downloadable digital music (Cl. 35), online banking (Cl. 36);
- **production of radio and television programmes (Cl. 41);**
- telecommunications technology consultancy (Cl. 42);
- online social networking services (Cl. 45).”

9. Class 41 is as under:

“Class 41

Education; providing of training; entertainment; sporting and cultural activities.

Explanatory Note

Class 41 includes mainly services consisting of all forms of education or training, services having the basic aim of the entertainment, amusement or recreation of people, as well as the presentation of works of visual art or literature to the public for cultural or educational purposes.

This Class includes, in particular:

- organization of exhibitions for cultural or educational purposes, arranging and conducting of conferences, congresses and symposiums;
- translation and language interpretation services;
- publication of books and texts, other than publicity texts;
- **news reporters services, photographic reporting;**
- photography;
- film direction and production services, other than for advertising films;
- cultural, educational or entertainment services provided by amusement parks, circuses, zoos, art galleries and museums;



- *sports and fitness training services;*
- *training of animals;*
- *online gaming services;*
- *gambling services, organization of lotteries;*
- *ticket reservation and booking services for entertainment, educational and sporting events;*
- *certain writing services, for example, screenplay writing, songwriting.*

This Class does not include, in particular:

- *organization of exhibitions for commercial or advertising purposes (Cl. 35);*
- *writing and publication of publicity texts (Cl. 35);*
- *news agency services (Cl. 38);*
- *radio and television broadcasting (Cl. 38);*
- *videoconferencing services (Cl. 38);*
- *technical writing (Cl. 42);*
- *day nursery and crèche services (Cl. 43);*
- *health spa services (Cl. 44);*
- *planning and arranging wedding ceremonies (Cl. 45).”*

10. It cannot be disputed that the names used by the plaintiff and the defendant are in respect of television programmes, particularly news programmes. A perusal of the aforesaid classification leaves no doubt in my mind that television programmes, including news-related programmes, fall under class 41 and not class 38. In fact, in class 38, there is a clear exclusion in respect of television programmes. Further, class 38 includes telecommunication services, which include television broadcasting. Therefore, what would be included in class 38 would be names of television channels, such as Times Now, CNN News18, News18 and the like. The names of programmes that are telecast on these channels would be subject matter of class 41. Therefore, for the purposes of determining infringement, the relevant class would be class 41, where the plaintiff has been granted



registration with a clear disclaimer with regard to the use of the term “Bhaiyaji”. Hence, the reliance placed by the plaintiff on registration under class 38 is not relevant in the present context, more particularly when the plaintiff has obtained registration under class 41.

11. The only similarity between the marks of the plaintiff and the defendant is the use of the term “Bhaiyaji”. There is no similarity between the term “Kahin”, used by the plaintiff and the term “Superhit” used by the defendant. In view of the disclaimer with regard to the term “Bhaiyaji” under class 41, the plaintiff cannot restrict the defendant from using the said term. This is also made clear by Section 28(2) of the Trade Marks Act, which provides that the exclusive right to use of a trademark shall be subject to any condition and limitation that is part of the registration granted.

12. Even otherwise, the term “Bhaiyaji” is a word of common use in certain states of India, including Uttar Pradesh and Bihar, and which literally translates into the word “brother” and is therefore, of a non-distinctive character. Further, the defendant has also placed on record sufficient material to show that the term “Bhaiyaji” is a part of various television and radio programmes in India and is therefore, common to trade. Reference in this regard may be made to pages 22 to 167 of the documents filed on behalf of the defendant. Therefore in my *prima facie* view, the term “Bhaiyaji” is a generic term of widespread use and nobody can claim exclusive right to use such generic words. Having regard to the aforesaid, the plaintiff is not entitled to exclusive rights over the mark “Bhaiyaji” in terms of Section 17 of the Trade Marks Act, 1999.

13. Counsel for the defendant has also drawn attention of the Court to the stand taken by the plaintiff in its reply to the examination report of the



Registry, when the plaintiff had applied for registration of the mark “Bhaiyaji Kahin” under class 41. In its reply dated 3rd April, 2017, while distinguishing the plaintiff’s mark with the earlier mark, “Bhaiyaji Aisa Kyun”, the plaintiff has clearly taken a stand that the plaintiff’s mark is not similar to the said mark as the marks have to be compared as a whole and cannot be dissected. Having obtained registration on the basis of the aforesaid assertion, now the plaintiff cannot be permitted to take a contrary stand that the defendant’s mark is infringing the plaintiff’s mark on account of both marks using the term “Bhaiyaji”. The plaintiff cannot be permitted to approbate and reprobate. In this regard, counsel for the defendant has correctly placed reliance on the judgment of the Division Bench in *Raman Kwatra* (supra), the relevant extract of which are set out below:

“43. We also find merit in the appellant's contention that a party, that has obtained the registration of a trademark on the basis of certain representation and assertions made before the Trade Marks Registry, would be disentitled for any equitable relief by pleading to the contrary. The learned Single Judge had referred to the decision in the case of Telecare Networks India Pvt. Ltd. v. Asus Technology Pvt. Ltd. (supra) holding that after grant of registration neither the Examination Report nor the plaintiff's reply would be relevant. We are unable to agree with the said view. In that case, the Court had also reasoned that that there is no estoppel against statute. Clearly, there is no cavil with the said proposition; however, the said principle has no application in the facts of the present case. A party that has made an assertion that its mark is dissimilar to a cited mark and obtains a registration on the basis of that assertion, is not to be entitled to obtain an interim injunction against the proprietor of the cited mark, on the ground that the mark is deceptively similar. It is settled law that a person is not permitted to approbate and reprobate. A party making contrary assertions is not entitled to any equitable relief.”



14. Reliance has been placed on behalf of the plaintiff on the judgment of the Division Bench in *Shree Nath Heritage Liquor Pvt. Ltd. v. M/s. Allied Blender & Distillers Pvt. Ltd.*, 2015 OnLine Del 10164, wherein the interim injunction was upheld by the Division Bench in respect of the defendant using the mark “Collector’s Choice” as against the plaintiff’s registered mark of “Officer’s Choice” in respect of alcoholic beverages. Senior counsel appearing on behalf of the plaintiff emphasized that even in this case, the word “Choice” had been disclaimed by the plaintiff therein. However, in the said case, the plaintiff had several other trademark registrations for alcoholic beverages and other goods without any disclaimer. In the present case, there is only one registration in favour of the plaintiff in the relevant class 41, which has a disclaimer attached to it. Further, in *Shree Nath* (supra), the dominant part of the composite mark of the plaintiff was not the word “Choice” but the term “Officer’s” and for which word there was no disclaimer. In the present case, the dominant part of the plaintiff’s mark is “Bhaiyaji” in respect of which there is a disclaimer. Resultantly, the aforesaid judgment does not advance the case of the plaintiff.

15. Even in the case of *Under Armour, Inc v. Aditya Birla Fashion & Retail Ltd.*, 2023 SCC OnLine Del 2269, the registration granted in favour of the plaintiff did not contain any disclaimer as is there in the present case. Therefore, the said judgment does not advance the case of the plaintiff.

16. As regards the case of the passing off, at this interlocutory stage, I am of the view that the formats of the respective shows of the plaintiff and the defendant are quite different. The show of the plaintiff is an interactive show that is not scripted, whereas the show of the defendant is scripted and non-interactive. The defendant’s show is hosted and anchored by a standup



comedian, whereas the show of the plaintiff is hosted and anchored by a news anchor/journalist. Further, the two shows are shown on different television channels. Therefore, in my *prima facie* view there is no likelihood of confusion between the two television shows.

17. As regards the contention of the plaintiff that the mark “Bhaiyaji Kahin” has acquired distinctiveness on account of long user, in my view, this aspect can only be examined in trial and cannot be the basis for grant of an interim injunction.

18. In view of the discussion above, the plaintiff has failed to make out a *prima facie* case for grant of interim injunction. Accordingly, the application is dismissed.

19. Needless to state, any observations made herein are for the purposes of adjudication of the present application and shall not have a bearing on the final outcome of the suit.

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20. List before the Joint Registrar on 16th August, 2023.

JULY 04, 2023

at

AMIT BANSAL, J.