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

+ **CS(COMM) 57/2023**

PUNJAB KESARI PUBLISHING

HOUSE PVT LTD & ANR.

..... Plaintiffs

Through: Mr Arun Kathpalia, Sr.
Advocate with Mr. Swapnil Gupta, Ms.
Sabhya Jain, Mr. Abhinav Mishra, Ms.
Diksha Gupta, Mr. Aditya Dhupar and Mr.
Kshitij Wadhwa, Advs.

versus

AJIT SINGH BULAND & ORS.

..... Defendants

Through:

CORAM:

HON'BLE MR. JUSTICE C.HARI SHANKAR

ORDER

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03.02.2023

CS(COMM) 57/2023

1. Plaintiffs 1 and 2 are associate concerns and shall, therefore, be referred to hereinafter collectively as “the plaintiffs”.




2. The plaintiffs started a newspaper under the name of “Punjab Kesari” in 1949, which was registered with the Registrar of Newspapers in 1965. Since then, the plaintiffs assert that they have been uninterruptedly and continuously using the said mark. The plaint also draws attention to the readership and reputation that the newspaper of the plaintiffs has garnered over a course of time. The mark “Punjab Kesari”, it is asserted, has become indelibly identified with the newspaper of the plaintiffs.


3. The plaintiffs are the proprietors of the word mark “PUNJAB KESARI” registered under Classes 9 and 35 on 31st December 2018. The plaintiffs claim user of the mark under Class 9 with effect from

12th May 2008 and user under Class 35 with effect from 13th June 1965. Under Class 35, the “PUNJAB KESARI” mark stands registered in the plaintiff’s favour for “advertising; business management; business administration; office functions outdoor advertising services, distribution services relating to electronic media, print media, internet media, electronic media providing information about products via telecommunication networks for advertising and sales purposes for the States Jammu Kashmir, Punjab, UT of Chandigarh, Himachal Pradesh, Bihar, West Bengal, Madhya Pradesh, Maharashtra, Andhra Pradesh, Karnataka, Haryana (Except Bhiwani, Faridabad, Gurgaon, Mahendragarh & Rewari districts), Uttar Pradesh (in the District of Etawah, Kanpur Rural, Kanpur Urban, Unnao, Barabanki, Gorakhpur, Deoria, Faizabad, Azamgarh, Jaunpur, Ballia, Ghazipur, Sultanpur, Mirzapur, Varanasi, Allahabad, Partapgarh, Rae Bareilly, Fatehpur, Banda, Hamirpur, Jalaun, Jhansi, Lalitpur only)”.

4. The plaintiffs have also placed on record its gross turnover for the years 2016 to 2022, in order to emphasize the reputation and goodwill that it has earned over a period of time. The gross turnover of the plaintiffs, in the year 2022 is ₹ 6,15,99,35,000/-. The plaintiffs also claim to be the registrants of the domain names www.punjabkesari.in and www.kesari.tv. The plaintiffs claim to have been using the word mark “KESARI TV” as well as “PUNJAB KESARI TV” uninterruptedly since 2014, *inter alia*, through the registered domain name www.kesari.tv and word mark “KESARI TV”. The domain name registration of www.kesari.tv in favour of the plaintiffs has been annexed at page 187 of the documents, accompanying the plaint. The plaintiffs have also placed on record the screenshots from the internet evidencing use, by the plaintiffs, of the “KESARI TV” appellation.

5. The registration of the “PUNJAB KESARI” word mark in favour of the plaintiffs, therefore, is of December 2018, whereas the www.kesari.tv domain name is registered in favour of the plaintiffs with effect from 3rd August 2014.

6. Defendant 1 is stated to have been the freelance reporter of the plaintiffs. Even during the time Defendant 1 was working in the said capacity, the plaintiff alleges that he surreptitiously obtained registration of the domain name www.kesarivt.com through Defendant 3-Domains By Proxy LLC, an entity located in the United States, which provides domain name registration in such a manner that the identity of the registrant would remain masked. As such, the plaintiffs submit that they remained unaware of the fact that such a domain name has been registered. It was only in 2022 that the plaintiffs came to realise that Defendant 1 had, in fact, got the aforesaid domain name registered in its favour and had concretised an internet presence under the name “Kesari TV” employing a logo , which is deceptively similar to the unregistered mark , being employed by the plaintiffs as well as the registered mark . The domain name www.kesarivt.com is also deceptively similar to the domain name www.kesari.tv which are both registered in favour of the plaintiffs.

7. It is in these circumstances that the plaintiffs have filed the present suit, seeking an injunction against the defendants or any person claiming under them from using in any manner mark/logo “KESARI TV” and , as well as for a direction to the defendants to transfer the domain name www.kesarivt.com to the plaintiffs, apart from the perpetual injunction against the defendants

using any similar domain name or mark.

8. In the circumstances, let the plaint be registered as a suit. Issue summons in the suit.

9. Written statement, accompanied by affidavit of admission and denial of the documents filed by the plaintiffs be filed within 30 days with advance copy to learned Counsel for the plaintiffs who may file replication thereto, accompanied by affidavit of admission and denial of the documents filed by the defendants within 30 days thereof.

10. List before the learned Joint Registrar (Judicial) for completion of the pleadings, admission and denial of documents and marking of exhibits on 21st March 2023 whereafter the matter would be placed before the Court for case management hearing and further proceedings.

I.A. 2032/2023 (Order XXXIX Rules 1 and 2 of the CPC)

11. Issue notice, returnable on 13th April 2023 before the Court.

12. Reply, if any, be filed within four weeks, with advance copy to learned Counsel for the plaintiffs who may file rejoinder thereto, within four weeks thereof.

13. By this application, the plaintiffs seek interlocutory injunctive relief.

14. The facts recited hereinabove make out a *prima facie* case of infringement on the part of the plaintiffs against the defendants. It is,

prima facie, clear that Defendant 1 has, even while he was working as a freelance reporter of the plaintiffs, sought to capitalize on the goodwill earned by the plaintiffs and had the domain name www.kesariv.com registered in their favour. The employment, by Defendant 1 of the services of Defendant 3 for the said purpose also *prima facie* indicates that there was intent to mask the identity of Defendant 1.

15. The registered mark of the plaintiffs as well as unregistered mark of the plaintiffs, in which they enjoy priority of user, are being used by the defendants for the very same purpose. The nature of services provided by the plaintiffs under their marks are the same as that provided by the defendants.


16. To a viewer of average intelligence and imperfect recollection, therefore, there is every likelihood of the viewer mistaking the services provided by the defendants under the impugned marks to be the services provided by the plaintiffs or associating the said services with the plaintiffs. This would tantamount to infringement within the meaning of sub-sections (1) and (2) of Section 29 of the Trademarks Act, 1999 and would also make out a *prima facie* case of Defendant 1 passing off of its services as those provided by the plaintiffs.

17. As such, a clear *prima facie* case exists in favour of the plaintiffs. In such an event, following the judgments of the Supreme Court in *Midas Hygiene Industries (P) Ltd v. Sudhir Bhatia*¹ and *Laxmikant V. Patel v. Chetanbhai Shah*², an injunction has to follow. Failure to grant an injunction at this point would result in perpetuation

¹ (2004) 3 SCC 90

² (2002) 3 SCC 65

of the infringing activities of the defendants. The balance of convenience is also, therefore, in favour of the plaintiffs. In the event injunction is not granted, perpetuation of the infringing activities of the defendant would result in irreparable prejudice to the plaintiffs.

18. In view thereof, till the next date of hearing, Defendants 1 and 2, as well as all others acting on their behalf, shall stand restrained from directly or indirectly dealing their services under the infringing “KESARI TV” marks and the  logo, either for providing news services in print or in electronic mode or for any other services which are allied or associated therewith. The defendants are also directed to suspend the use of the domain name www.kesariv.com till the next date of hearing.

19. As this order has been passed *ex parte*, the plaintiffs are directed to comply with the provisions of Order XXXIX Rule 3 of the Code of Civil Procedure, 1908 (CPC) within a period of one week from today.

I.A. 2033/2023 (Section 12A of the Commercial Courts Act, 2015)

20. This application seeks exemption from pre institution mediation under Section 12A of the Commercial Courts Act, 2015. In view of the judgment of the Division Bench of this Court in *Chandra Kishore Chaurasia v. R.A. Perfumery Works Pvt Ltd*³, exemption as sought is granted.

21. The application stands allowed accordingly.

³ 2022 SCC OnLine Del 3529

I.A. 2034/2023 (exemption)

22. Subject to the plaintiffs filing legible copies of any dim or illegible documents within 30 days, exemption is granted for the present.

23. The application is disposed of.

I.A. 2035/2023 (exemption advance service to defendants)

24. In view of the facts of the present case, the plaintiffs are granted exemption from the requirement of advance service on the defendants.

25. The application is disposed of.

I.A. 2036/2023 (Order XXVI Rule 9 of the CPC)

26. This application shall be taken up for consideration along with I.A. 2032/2023 on the next date of hearing.

C.HARI SHANKAR, J

FEBRUARY 3, 2023

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