(2022) 09 DEL CK 0063

Delhi High Court

Case No: Civil Suit (COMM) No. 359 Of 2020, I.As. No. 7682, 11913 Of 2020, 16049 Of 2021

Star Television Productions Limited & Anr.		APPELLANT
	Vs	
Eurosport & Ors.		RESPONDENT

Date of Decision: Sept. 9, 2022

Acts Referred:
Code Of Civil Procedure, 1908 â€" Order 11 Rule 1, Order 39 Rule 1, Order 39 Rule 2#Trade Marks Act, 1999 â€" Section 2(1)(zg), 28(3), 29, 30, 31, 57, 95, 124, 124(5)

Citation: (2022) 09 DEL CK 0063

Hon'ble Judges: Asha Menon, J

Bench: Single Bench

Advocate: Amit Sibal, Sneha Jain, Disha Sharma, Saksham Dhingra, Aishvary Vikram, Kanishk Kumar, Kashika Agrawal, Sandeep Sethi, Arjun Khurana, Lalltaksh Joshi

Judgement

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Ã¢â‚¬Å“EUROSPORTÃ¢â‚¬ was deceptively similar to the various registered STAR Marks in India, including , , ,",

, , , .",

11. The defendant No.1 is EUROSPORT, defendant No.2 is Discovery Communications, LLC and defendant No.3 is Discovery Communications",

India. The defendants have filed a common written statement. It is submitted that the suit was a malicious attempt to wrongly obtain a commercial,

advantage over the defendants. It has been further stated in the written statement that the defendant No.1 is the registered proprietor of the impugned,

trademarks and their variations, not only in India but over 100 jurisdictions around the world such as in Hong Kong, South Korea and Taiwan. It is",

further stated that the impugned marks have been used globally by the defendants since 2015 without objections including from the plaintiffs.,

12. The further case set out is that the marks were dissimilar, and the suit also suffered from delay, laches, waiver, acquiescence, constructive assent,",

deemed consent and estoppel.,

13. It is further stated in the written statement that the Ring of Stars that was used by the defendant No.1 when its brand EUROSPORT was,

launched in 1989 was in reminiscence of the stars used in the logo of the European Union, in turn signifying the jurisdiction of the origin by defendant",

No.1. However, over the years, the defendant No.1 has used multiple variations of its trademark which comprise an unchanged reiteration of a star or",

stars, and/or the underline brand and wordmark EUROSPORT. These variations include .",

14. According to the defendants, a bare perusal of these marks reveals their difference from the marks of the plaintiffs.",

15. It is further stated that in the year 2012, 20% stake in EUROSPORT was acquired by DISCOVERY which then grew into full ownership in 2015",

and was a brand to reckon with in its own right. However, the brand EUROSPORT was given a facelift and the impugned mark was resultantly",

adopted in 2015 in order to enhance and modernize EUROSPORTÃ¢â‚¬â„¢s visual appeal.,

16. It is further stated that on the basis of registration of the impugned trademark in WIPO Madrid in 2015, the final registration vide the Statement of",

Grant of Protection under Rule 18ter (1) of Common Regulations was given in India in 2017 (placed at page 85 of the defendantsÃ¢â‚¬â„¢ documents).,

The defendants claim to have adopted the impugned mark more than 2 years before the plaintiffs and that the plaintiffs were now seeking to misuse,

the Settlement Agreement dated 26th February, 2018. The defendants have expounded on the reach and reputation of the defendants in detail which",

need not be reproduced here.,

17. In short, by way of the written statement, it has been submitted that the adoption of the impugned marks was bonafide and the defendants had a",

right to use the said marks and the impugned Star marks and device in EUROSPORT marks in general were essential and exclusive to,

defendantsÃ¢â‚¬â„¢ brand identity and business and have been explicitly adjudicated as Ã¢â‚¬Å“well-knownÃ¢â‚¬Â in multiple jurisdictions. Hence, the defendants",

have sought the dismissal of the plaint.,

18. The contents of the reply to the application being on similar terms need not be specifically and separately referred to for the sake of brevity.,

19. In the replication filed by the plaintiffs, its case was reiterated with a complete denial of the claims made in the written statement.",

ARGUMENTS,

PLAINTIFFSÃ¢â‚¬â„¢ ARGUMENTS,

20. Mr. Amit Sibal, learned senior counsel for the plaintiffs, has submitted that the plaintiffs were pioneers in cable T.V. and satellite broadcasting in",

India and had commenced operating its T.V. channels under the name of Ã¢â‚¬Å“STARÃ¢â‚¬Â with the Star Device and its variants since 1991. The plaintiffs,

had more than 500 trademark registrations and applications with this device. The plaintiffs were well-established in India in broadcasting under the,

said style, name and logo, and also had reputed presence in several other countries.",

21. It was pointed out that the defendants had used a star device in the shape of a Ring of Stars but never as a stand-alone star till 2015. By that time,

the plaintiffs had developed their marks as well-known marks all over the world, particularly in India. The entry of the defendants as DSPORT in",

India was in 2017 by which time viewers in India identified the stand-alone star device with the plaintiffs. It therefore, did not matter if the defendants",

had used a Single Star with EUROSTAR in Europe. That the mark and the star device belonging to the plaintiffs did in fact have a well-known,

character was conceded by the defendants when they entered into an Agreement dated 26th February, 2018 and changed the star device in the logo",

into a globe with the word Ã¢â‚¬Å“DSPORTÃ¢â‚¬. They could not be now permitted to re-enter India with a Single Star Device and the word EUROSPORT,

on the plea that they used a similar mark in other jurisdictions.,

22. With regard to the claim of the defendants that they had obtained the registration of EUROSPORT with a Single Star Device in India, the learned",

senior counsel submitted that the plaintiffs had filed objections which were pending and the application for rectification had also been filed, as the",

registration ought not to have been granted to them. However, since the Intellectual Property Appellate Board (Ã¢â‚¬ËœIPABÃ¢â‚¬â„¢) did not have powers to",

issue injunction, the instant suit has been filed for the said relief. Presently, the IPAB has also been disbanded and the application is pending before the",

IP Division of this Court. Thus, no right could be claimed by the defendants on the basis of a registration which was not valid.",

23. Reliance has been placed on a number of decisions including Rajkumar Prasad Vs Abbott Healthcare, 2014 SCC OnLine Del 7708, Clinique Labs",

v. Gufic Ltd., 2009 SCC OnLine Del 751, South India Beverage v. General Mills Marketing Inc. 2014 SCC OnLine Del 1953, in support of the",

contention that the defendants had to be injucted from using the deceptively similar trademark and that too in the sphere of sports broadcasting.,

24. The further contention of the learned senior counsel was that the defendants cannot take the dominant and essential features of the plaintiffsÃ¢â‚¬â„¢,

mark or device to make their own mark. Thus, since the Single Star Device in the minds of the common person connected it to the plaintiffs as the",

originator of the services, the same star could not be taken by the defendants and made a part of their mark and device. Thus, in addition to",

infringement, the defendants were guilty of passing off in an attempt to ride on the goodwill and reputation of the plaintiffsÃ¢â‚¬â„¢, built step-by-step",

since 1991/1992. By the use of the Single Star in EUROSPORT, unsuspecting viewers would connect it to the services rendered by the plaintiffs and",

that would deceive the public and act to the prejudice of the plaintiffs affecting its reputation and also causing dilution of their marks.,

25. It is further submitted that there was no delay in approaching the court and there was no occasion to claim acquiescence. The cause to approach,

the court arose when the infringing trademarks were adopted by the defendants with intention to appropriate the plaintiffÃ¢â‚¬â„¢s goodwill. It was only in,

February 2020, that the defendants had commenced their sports channel with the impugned trademarks/device. Immediately notice to desist was",

issued and the instant suit was filed alongwith an application for rectification. There was no time lag to allow the defendants to raise the defence of,

acquiescence.,

26. As regards the use of the star device, it was pointed out that the right to use the trademark must be also considered territorially and whatever be",

the scenario outside India since the plaintiffsÃ¢â‚¬â„¢ greatest target audience was in India and the target audience of EUROSPORT was in Europe,",

there was no immediate need for the plaintiffs to take steps in other jurisdictions against the use of the star device and logo. It was their entry into,

India that had a major impact on the plaintiffs and without delay the plaintiffs had taken all necessary steps to oppose such use. At no point of time, did",

the plaintiffs hold out or give an impression that they were okay with the use of a Single Star Device by the defendants. Reliance has been placed on,

Hindustan Pencils Pvt. Ltd. v. India Stationery Products Co. 1989 SCC Online Del 34, Dr. Reddy Laboratories Vs Reddy Pharmaceuticals 2004 SCC",

OnLine Del 668, Toyota Jidosha Kabushiki Kaisha Vs. Prius Auto Industries Ltd. & ors. (2018) 2 SCC 1, Patel Field Marshal Agencies v. P.M.",

Diesels Ltd., (2018) 2 SCC 112.",

27. It was submitted that the plaintiffs had thus disclosed a prima facie case in its favour. Since it was the first user of a Single Star Device globally,

and has registered the said mark and logo device in India and had used it in India much before the defendants, the balance of convenience lay in",

favour of the plaintiffs. When the defendants launched DSPORT initially with the Single Star Device, after objections were raised by the plaintiffs, the",

logo and device were changed into a globe which was used by the defendants for their sports channel for over 18 months whereafter, they suddenly",

changed into EUROSPORT with a Single Star in 2017. Thus, prior to 2017, they were not in India with the Single Star logo and mere pendency of the",

suit would not give them any vested right to continue to use the impugned trademarks, logo and device. It is further submitted that the loss to the",

reputation of the plaintiffs would be irreparable, if the defendants continued to use the impugned trademarks and device. Thus, it was prayed that the",

defendants be restrained from using the impugned trademarks whereafter the proceedings be stayed under Section 124(5) of T.M. Act till disposal of,

the rectification petition.,

DEFENDANTS ARGUMENTS,

28. Mr. Sandeep Sethi, learned senior counsel for the defendants, submitted that the suit was completely misconceived, and the plaintiffs were not",

entitled to any injunction against the defendants. It was pointed out that the two trademarks have been in co-existence in over 100 jurisdictions since,

2015 and yet the plaintiffs had never raised any objections till 2020 by way of the present suit. The defendants had commenced the broadcast of,

sports under the name of EUROSPORT since 1989 whereas Star Sports came into existence only in 1996 and, therefore, it was the defendant No.1",

which was in prior use of Star logo/device. Initially, it was a Ring of Stars with five on the top and five at the bottom. Since 2003, globally and since",

2004, in India, the Single Star logo/device which was solid, italicized with five points had been in use, which also establishes that it was the defendant",

No.1 which was the prior user.,

29. The learned senior counsel submitted that the defendants had a far greater reach when compared to the plaintiffs and, therefore, the defendants",

had no need to encash on the reputation of the plaintiffs. For instance, while 3000 hours of programming across 75 countries was the performance of",

the defendants, the plaintiffs had only 1500 hours and that too only in India and Asia. The defendants were EuropeÃ¢â‚¬â„¢s No.1 sports destination",

channel. The defendantsÃ¢â‚¬â„¢ marks were themselves well-known and the use by the defendants of EUROSPORT with a Single Star has,

commenced in 2004 world-wide and the defendants had built up immense reputation with their reach in 135 millions homes in 54 countries in 20,

languages covering 120 sports, having 15 websites in 11 languages across jurisdictions and in 2020 the cumulative subscribers of the defendants were",

246 million across 75 countries. In contrast, as per the averments in the plaint itself, the plaintiffs had only 169 million subscribers for their STAR",

Sports channel, thus, showing that the defendants were much bigger with wider reach and greater repute than the plaintiffs.",

30. The trademark of the defendants was also registered in 21 territories where the plaintiffs also claim to have trademark registration, but in none of",

these territories, objections have been raised by the plaintiffs on any ground whatsoever. The Settlement Agreement also reflected acquiescence and",

acceptance that the defendantsÃ¢â‚¬â„¢ trademark was well-known, and the defendants had a large following of subscribers and reputation. Since the",

defendants were well-established, world-wide in the field and being the prior user, there was no question of taking any advantage of the reputation that",

the plaintiffs may have in India or overseas.,

31. It was submitted that under Section 29 of the T.M. Act, the basis for infringement would be whether the defendantsÃ¢â‚¬â„¢ marks are deceptively",

similar to those of the plaintiffs as a whole and whether the deceptive similarity was likely to cause confusion or likely to make people believe an,

association between the two products or services with regard to their origin. It was submitted that these tests were not met in the instant case. The,

two marks had to be compared as a whole and when the composite star device and words were compared in accordance with the anti-dissection,

rules, it was more than apparent that there was no confusion to the consumers by the use of the trademark by the defendants.",

32. It was also submitted that Star was a celestial object and no one can claim exclusive use of the word Ã¢â‚¬Ëœ Starà¢â‚¬â„¢ or for that matter stake an,

exclusive claim to the device of the Star. The only exclusivity that could be claimed was in the manner of portraying the Star which was dissimilar in,

the present case. Though the objections/rectification had been filed by the plaintiffs to the registration of the defendantsÃ¢â‚¬â„¢ trademarks, it was",

pointed out that in respect of the trademarks of the plaintiffs themselves, there were objections filed and the plaintiffs had also issued disclaimers that",

the registrations in their favour would not give them exclusive right to the word Ã¢â‚¬Ëœ Starà¢â‚¬â„¢ or the Ã¢â‚¬Ëœ Device of Starà¢â‚¬â„¢. In other words, they were",

fully aware of the factual position that they had no exclusive rights to the word Star or the device of a Star and could not now stake a claim by means,

of the present suit.,

33. The learned senior counsel referred to various documents placed on the record to establish that the defendants were co-existing with the plaintiffs,

in several jurisdictions. It was the further contention of the learned senior counsel that under Section 28 (3) of T.M. Act, no injunction can be issued",

against the registered proprietor and, therefore, the plaintiffs have no prima facie case in their favour so long as the registration was not rectified, and",

the registered trademarks of the defendants removed. Reliance has been placed on Jindal Industries Ltd. vs Nirmal Steel Tubes Pvt. Ltd., 1994 SCC",

OnLine Del 347 and P.M. Diesels Pvt. Ltd. vs Thukral Mechanical Works, 1988 SCC OnLine Del 34, to contend that in these circumstances the very",

suit was not maintainable.,

34. Importantly, according to the learned senior counsel, when the plaintiffs sought suspension of the trademark when the matter was pending before",

the erstwhile IPAB, vide its order dated 7th August, 2020 and the clarificatory order dated 17th December 2020, the relief was declined. The only",

restraint on the defendants was against transferring these registered trademarks and logos to any third-party. It was only thereafter that the present,

suit was filed and so it was in effect a second bite at the cherry, a practice to be deprecated. According to the learned senior counsel, this also",

tantamounts to forum shopping which was again impermissible. Since these facts were not disclosed in the plaint, there was suppression of material",

facts on which ground also, the plaintiffs were not entitled to discretionary relief. Reliance was placed in Kamini Jaiswal vs. Union of India, (2018) 1",

SCC 156 (3JJ.) and Allied Blenders and Distillers Pvt. Ltd. vs. Amit Dahanukar 2019 SCC OnLine Del 8898.,

35. Another fact that was suppressed by the plaintiffs was their own disclaimer before the Registrar of Trademarks in respect of the same device of,

Star, documents in respect of which have been filed by the defendants on this record. So too, the discretionary relief could not be granted to the",

plaintiffs. Once such disclaimer had been made by the plaintiffs, in effect it was an acknowledgment of the absence of exclusive rights to the Star",

Device, despite the registration of the said trademarks and no such rights in the present suit against the defendants could be claimed by the plaintiffs.",

36. Reliance has been placed on Parakh Vanijya Pvt. Ltd. Vs. Baroma Agro Product, 2018 (16) SCC 632, Bawa Masala Company Vs. Gulzari Lal",

Lajpat Rai, 1974 SCC OnLine Del 121, Surya Agro Oils Ltd. Vs. Surya Coconut Oil Industries 1994 SCC Online Del 266 and Mercy Bigi Vs Sunil",

Kumar, 2015 SCC OnLine Ker 16947.",

37. Relying on (i) Gufic Ltd. Vs Clinique Laboratories, LLC 2010 SCC Online Del 2322, (ii) Nandini Deluxe Vs Karnataka Cooperative Milk",

Producers Federation Ltd., (2018) 9 SCC 183, (iii) Rajesh Jain Vs Amit Jain, 2014 SCC OnlineDel 1984 and (iv) PP Jewellers Pvt. Ltd. Vs PP",

Buildwell Pvt. Ltd. 2010 SCC OnLine Del 932, it was submitted that when two marks were to be compared, the trademark could not be split into",

constituent elements and must be seen as a whole.,

38. When the Device and Trademarks of the plaintiffs and the defendants were juxtaposed, there was absolutely no confusion that could arise on",

similarity between the two trademarks as the two were distinct. There was no visual or structural similarity in the manner in which the Star itself has,

been depicted. This was the stand taken by the plaintiffs when their registered trademarks were objected to by others. Thus, the plaintiffs cannot be",

permitted to blow hot and cold at the same time.,

39. Coming to the Settlement, it was submitted that in the various paragraphs in the Settlement itself, the plaintiffs have acknowledged that",

EUROSPORT has a registered trademark of a Star or of several Stars and that they had been using the same from a date prior to the plaintiffs in,

over 54 countries and that there was a group of EUROSPORT marks, thus, also acknowledging that there is more than one registered trademark and",

depiction of Ã¢â‚¬ËœStarÃ¢â‚¬â„¢ that belonged to the defendants. Moreover, the Agreement was limited only to sports which was evident from the recitals in",

the Agreement itself. The plaintiffs also undertook not to object to the EUROSPORT marks, particularly such marks which include not only the use of",

a Ring of Stars but also a Single Star depicted in a stylized manner. In short, the plaintiffs had conceded the right of the defendants to use the said",

marks and having waived their rights, cannot now seek injunctions against the plaintiffs and the suit deserved to be dismissed as a sheer abuse of",

process.,

40. The next argument was that the suit was barred by acquiescence. Since the plaintiffs had not raised any objection when EUROSPORT was,

launched in India with the Single Star Device and the defendants had benefitted therefrom, the defendants could not now be restrained from using it.",

The learned counsel, however, referred to several documents which included promotional material, media coverage, publicity material for sports,",

screenshots of the programs and recording broadcast by the defendants to show that the Single Star Mark was a well-known trademark globally.,

Reliance has also been placed on the decisions by the WIPO Arbitration & Mediation Centre holding that EUROSPORT was a well-known mark and,

has a strong reputation in Europe and world-wide.,

41. Reliance has been placed on Milmet Oftho Industries v. Allergan Inc. (2004) 12 SCC 624, Cadbury UK Ltd. Vs Lotte India Corporation 2014",

SCC OnLine Del 367 and Choice Hotels International Inc Vs M. Sanjay Kumar, 2015 SCC OnLine Del 7407, to submit that the defendants were the",

first to use the logo of a Ã¢â‚¬ËœStarÃ¢â‚¬â„¢ world-wide. Therefore, even if reputation had not been built on account of absence of local sales, the defendants",

would be entitled to consideration of spill over reputation from other jurisdictions as trans-border reputation was a significant factor to be considered,

and reputation was something that was dynamic. Reliance has been placed on NR Dongre Vs Whirlpool Corpn. 1996 5 SCC 714, Rolex Sa Vs Alex",

Jewellery Pvt. Ltd., 2009 SCC OnLine Del 753, Lowenbrau AG Vs Jagpin Breweries Ltd., 2009 SCC OnLine Del 45, Star Bazaar Pvt. Ltd. Vs Trent",

Ltd., 2009 SCC Online Del 3337, South India Beverage (supra). Thus, the defendants could not be restrained from using their registered trademarks.",

42. With regard to the judgments relied upon by the plaintiffs, it was submitted that South India Beverage (supra) would work in favour of the",

defendants as Ã¢â‚¬Å“StarÃ¢â‚¬â€‹ being generic would be less significant in the trademark.,

43. The issue in A. Ayyasamy v. A Paramasivam (2016) 10 3 SCC 386, was one under arbitration law and did not have any applicability save for the",

principle that the refusal of the IPAB to injuct the defendants would be binding on this Court being a civil court. The decision in Hindustan Pencils Pvt.,

Ltd. (supra) was in public interest in order to protect the general public from spurious goods, which fact situation did not exist in the present case. In",

Wockhardt Ltd. Vs. Torrent Pharmaceuticals Ltd., (2018) 18 SCC 346, the decision upheld the rights flowing from prior use by the plaintiff, holding",

that such prior use was the determining factor. Again, this judgment would help the defendants inasmuch as the defendants are the prior users of the",

Star Device.,

44. As regards the decision in Toyota Jidosha Kabushiki Kaisha (supra), it was urged that it could be distinguished on facts. In the present case where",

there was a spill over reputation the use of the trademark could not be limited on the basis of territoriality and there was prior use by the defendants,

and a complete absence of deceptive similarity.,

45. Learned senior counsel for the defendants contended that several of the submissions made on behalf of the plaintiffs were without pleadings,

especially in respect of the type of sports events that were broadcast by both of the parties and the reach of the plaintiffs in different jurisdictions.,

46. It was nowhere pleaded that the reputation of the plaintiffsÃ¢â‚¬â„¢ mark was territorial and, therefore, infringement must be seen qua India and",

nowhere else. Whereas, admittedly, in the plaint it is stated that it was the principal marks of the plaintiffs in both Europe and India, where the two",

trademarks were co-existing. Rather, the pleadings admitted the extent and operation and reach of the defendants which was much more than that of",

the plaintiffs and some self-serving averments in the replication would not justify a restraint on the defendants. At the same time, it was pointed out",

that the defendantsÃ¢â‚¬â„¢ website/channel on social media was available even in India using the same impugning mark which fact has also not been,

denied, again, establishing that there has been no confusion resulting from such common use.",

47. Finally, it was submitted that the balance of convenience lies in favor of the defendants as it would suffer immensely if not allowed to use the",

registered trademark in India and since the trademark of the plaintiffs and the defendants were co-existing in 23 other countries and no confusion had,

admittedly occurred, the absence of interim relief would cause no harm to the plaintiffs. Thus, it was prayed that the application under Order XXXIX",

Rules 1 & 2 CPC be dismissed.,

REJOINDER ARGUMENTS,

48. In rejoinder, Mr. Amit Sibal, learned senior counsel for the plaintiffs, contesting all the submissions of Mr. Sandeep Sethi, learned senior counsel",

for the defendants, asserted that on the basis of documents, that the plaintiffs were the first user of the Single Star Device in electronic media, the",

world over. The plaintiffÃ¢â‚¬â„¢s registration is in India and so the rights of the plaintiffs were to be determined under the trademark law and common,

law, as applicable in India. Global use of the trademarks were, therefore, not relevant. The status of the trademark being well-known would therefore",

be seen with reference to the public in India and causing of confusion and preservation of distinctiveness of the plaintiffsÃ¢â‚¬â„¢ trademarks were also to,

be considered territorially in India. Moreover, the use of the Single Star by EUROSPORT was never in respect of broadcast of sports events but was",

first used for EUROSPORT NEWS which had no distribution or access in India in 2004. Also, EUROSPORT NEWS used both the Single Star as",

also Multiple Stars and there was no exclusive use of the Single Star even then. There is nothing brought on record to show that the defendants were,

in India since 1989. Rather, the documents only reflected that they were in Europe and not in India, as the publications relied upon by the defendants",

were British.,

49. The defendants had not disclosed the number of their subscribers or viewers in India and so the extent of viewership or number of subscribers in,

other countries was not relevant for determination of the present matter. There is no dispute that the defendants had entered in Indian market only in,

2017, initially as DSPORT after the defendant No.2/DISCOVERY had taken over EUROSPORT. Relying on the judgment in Banyan Tree Holdings",

vs. A Murali Krishna Reddy 2009 SCC OnLine Del 3780, it was urged that a passive website even if it was accessible in India would not be relevant",

to determine the presence of the defendants in India to constitute a defense of prior use. As regards the App of the defendants, it is nowhere",

mentioned that it was available in India since 2017.,

50. In contrast, the plaintiffs have placed several documents to establish the presence of the plaintiffs in India since 1991 continuously and",

uninterruptedly. It was submitted that Ã¢â‚¬Å“STARÃ¢â‚¬ in the trademark of the plaintiffs was not the celestial object, but was an acronym for Satellite",

Television in Asia Region (for short, Ã¢â‚¬ËœSTARÃ¢â‚¬â„¢). Therefore, the use of the word STAR is unique. Moreover, it does not of its own, depict the",

nature of the services provided, again making the use of the word STAR a creative use by the plaintiffs. Reliance has been placed on the annual",

reports and other documents to show that since 1991, the plaintiffs have been increasing their width of services by introducing Star Movies in 1994,",

acquiring Prime Sports to commence Star Sports channels in 1996 and Star Plus, for its entertainment channels. In all of these channels, the plaintiffs",

have always used the Single Star depicted in a particular fashion and thus, that Star Device had become synonymous to the services provided by the",

plaintiffs.,

51. With regard to reputation built by the plaintiffs over a period of time, the learned counsel highlighted the number of awards that the various",

channels of the plaintiffs including the Star Sports channel, have won. When the plaintiffs moved on to the OTT platform, the Star Device was used in",

Hotstar including for sports from 2014 onwards.,

52. The learned senior counsel for the plaintiffs argued that the documents of the defendants themselves show that the original logo was a circle of,

stars and not a Single Star Device. The documents relating to the brand history of the defendantsÃ¢â‚¬â„¢ channels EUROSPORT establish that from,

1989 till May, 2011, the defendants had used only a Circle of Stars. During the same period, the plaintiffs had established its use of the Single Star",

Device. Further, it is evident from the documents of the defendants that the colors of the stars were changed in 2010 and 2014 but the Circle of Stars",

continued to be the logo of the defendants.,

53. EUROSPORT NEWS, which used a Single Star was only in United Kingdom and the stray instance could not suffice to establish the use of the",

mark as a brand. In the news report (at page 156) connected to the acquisition of EUROSPORT by DISCOVERY LLC, in 2015, it was",

acknowledged that the logo used had always been a Ring of Stars since inception, even according to the defendants. It was revealed in the interview",

by Peter Hutton at page 651, of the documents filed by the defendants on 2nd December, 2015 that EUROSPORT was a Ã¢â‚¬Å“nice sleepy second- tier",

channelÃ¢â‚¬ and was not a Ã¢â‚¬Å“strong brandÃ¢â‚¬ as written at page 652, thus, conceding that EUROSPORT had no reputation till DISCOVERY LLC",

acquired it in November, 2015.",

54. It is only then that the logo was changed from the Ring of Stars to a Single Star. The defendants were till then relaying events that had already,

taken place, whereas the plaintiffs aired marquee events such as the World-Cup and other sports which appeal to Indian audiences whereas",

EUROSPORT had programs relating to cycling, soccer etc. of recorded events taking place in Europe. Even then the defendants had not entered",

India in November 2015.,

55. Thus, territoriality had relevance and was an important factor in favour of the plaintiffs for an injunction against the defendants.",

56. Thus, when the plaintiffs had a family of Single Star marks for their different channels, the use of a Single Star by the defendants would lead the",

viewers to believe that this was just another variant belonging to the plaintiffs and thus, confusion regarding the source of the service would occur.",

Dilution as a result of association also is the consequence. Cases referred to are Kaviraj Pandit Durga Dutt Sharma Vs Navaratna Pharmaceuticals,

Lab (1965) 1 SCR 737, Renaissance Hotels Holdings Inc. Vs B. Vijaya Sai, 2022 SCC OnLine SC 61, HTC Corporation Vs LV Degao, 2022 SCC",

OnLine Del 253, South India Beverage v. General Mills Marketing Inc. 2014 SCC OnLine Del 1953.",

57. It was submitted that the decision in South India Beverage (supra) would not stand in the way of protection to the plaintiffsÃ¢â‚¬â„¢ trademark,

inasmuch as the logo/device of star is the dominant one compared to the word Ã¢â‚¬Å“sportsÃ¢â‚¬ and it is also a matter of impression on the viewers.,

Moreover, when for 18 months DSPORT used the Globe and not the Star, they continued to use the Single Star with EUROSPORT in other",

countries. This again would show that use of the trademark was territorial and as far as India is concerned, the trademark of the plaintiffs ought to be",

protected.,

58. Another argument set forth by the learned senior counsel for the plaintiffs is that it was through DISCOVERY that DSPORT had goodwill in,

India and not EUROSPORT. When DSPORT entered India and used the Single Star, the matter was resolved and an Agreement entered into",

whereby the defendants agreed not to use a Ã¢â‚¬ËœSTARÃ¢â‚¬â„¢ in whatsoever form. Once they had agreed to never use the Single Star logo in India, to",

now insist on doing so was in violation of their-own undertaking and could not be allowed. The assurance had been in respect of future reiterations,

also and thus, the defendants had completely given up any claim to use the Single Star Device/logo in India in whatsoever manner. The use of the Star",

logo referred to in the Agreement was in respect of other products and therefore, it would be incorrect to say that the plaintiffs had given up any right",

by entering into the Settlement. Thus, the use of the Ã¢â‚¬ËœStarÃ¢â‚¬â„¢ by the defendants was not bonafide and could not be protected.",

59. With regard to the arguments of acquiescence, learned senior counsel for the plaintiffs submitted that it was only in February, 2020 that the",

defendants had launched the EUROSPORT with the Single Star logo/device and a legal notice had been issued, a rectification application was also",

duly filed before the IPAB and thereafter, the present suit had been filed and therefore, there was no time lag to reflect acquiescence by the plaintiffs.",

60. With regard to registration of similar trademarks in other jurisdictions, the learned senior counsel pointed out from the record that these were not",

all in use in the different jurisdictions, particularly, in respect of sports events. Viewership in six foreign countries evident from the documents placed",

on the record by the defendants (IndexÃ¢â‚¬"4, documents No.3) would show that India is not included in the list and moreover, if the operation of the",

plaintiffs was not very significant or that of the defendant was insignificant, the plaintiffs would be quite justified in not initiating any legal action",

against the defendants and the mere absence of such a litigation in other jurisdictions would not be fatal to the present suit. Reliance has been placed,

on the cases of Pankaj Goel vs. Dabur India Ltd. 2008 SCC OnLine Del 1744 and Telecare Network India Pvt. Ltd. Vs Asus Technology Pvt. Ltd.,

2019 SCC Online Del 8739. The decisions relied upon by the defendants to establish that their mark was a well-known mark, were not relevant since",

they did not relate to the reputation in India. Thus, merely to say that trademark of both parties existed in other jurisdiction would not be sufficient for",

the plaintiffs to be denied relief.,

61. With respect to the alleged concealment of facts, the learned senior counsel pointed out that the disclaimers were in respect of registration in",

classes that were other than broadcasting and therefore were not mentioned in the plaint. Such disclaimers would have no effect on the relief claimed,

in the suit and non-disclosure was not of a material fact nor was there concealment with suppression.,

62. As regards broadcasting, the plaintiffs had never issued any disclaimer and that alone would be relevant for a decision in the present case.",

Reliance has been placed on the decision in Cadbury UK Ltd. (supra) and Parakh Vanijya Pvt. Ltd. Vs Baroma Agro Product 2018 (16) SCC 632, to",

submit that even if some disclaimer had been made, the disclaimer being not of the same class would not deprive the plaintiffs of the protection against",

infringement and passing off for which the present suit has been filed (see : KEI Industries Ltd. Vs Raman Kwatra 2022 SCC OnLine Del 1459,",

Telecare Network India Pvt. Ltd. Vs Asus Technology Pvt. Ltd. 2019 SCC Online Del 8739).,

63. Thus, it was submitted that the plaintiffs were entitled to injunction against the defendants, as they had created the word Ã¢â‚¬Å“STARÃ¢â‚¬ and even if",

it was a common word, it had been arbitrarily used and was thus to be protected. The defendants had never come to India till 2017 and when it did in",

the shape of DSPORTS, it had agreed to not use the Single Star and had commenced to use the Globe and whereas the plaintiffs had been in India",

since 1991 and had developed a huge viewership based in India and that plaintiffs were entitled to temporary protection against the defendants. Thus,",

it was prayed that the injunction be issued.,

DISCUSSION,

PRELIMINARY OBJECTION,

64. The first contention raised by the learned senior counsel for the defendants was that this was a case of forum shopping since the IPAB had,

declined to grant interim relief to the plaintiffs, but that argument would presume that the powers exercised by the IPAB, and the civil court are the",

same and approaching one would oust the jurisdiction of the other. The decision of the Full Bench of the IPAB in Shreedhar Milk Food Pvt. Ltd v.,

Vikas Tyagi 2013 SCC OnLine IPAB 109 only affirms that the powers existed in the IPAB to grant interim stay under Section 95 of the T.M. Act,",

particularly where the registration had been obtained by fraud. The issue considered in that case was whether the IPAB had powers to grant interim,

orders pending final disposal of the application for rectification. Depending on the facts of each case, it was held that the IPAB had such powers. In",

fact, it is to be noted that certain guidelines for exercise of that discretion were prescribed in that case. Nowhere in the judgment has it been held that",

the exercise of such powers by the IPAB would result in the extinguishment of the right to file a suit for infringement. Had it been that the exercise of,

those powers would preclude the civil court from exercising similar powers including in a suit filed after the initiation of rectification proceedings, there",

would have been no need for Section 124 of the T.M. Act.,

65. Section 57 of the T.M. Act provides that whenever the validity of the registration of the trademark is questioned, proceedings for rectification of",

registration can be filed. These could be filed before the filing of a suit or even thereafter. Where a suit is filed without a rectification application,

pending, and a dispute is raised regarding the validity of the registration, the court is to frame the issue in order to enable the party concerned to apply",

to the Appellate Board (now IP Division of the High Court) for rectification of the Register. The suit will be then stayed. Where such rectification,

application is pending, then the civil court will stay the suit, without the need to frame an issue.",

66. Had the suit been not maintainable at all, the provisions would have been couched differently to convey in precise terms that a suit itself could not",

be filed or entertained when rectification proceedings are pending or that the suit proceedings would end once the issue is referred to the IPAB for,

rectification of the register. More significantly, Section 124(5) of the T.M. Act allows the civil court to pass interlocutory orders before staying the suit",

for infringement of a trademark pending rectification of the register. It is trite that an interpretation that gives primacy to the legislative intent is to be,

preferred over one that would render the provisions otiose.,

67. Turning to the facts of the present case, the records do reveal that the plaintiff had sought interim relief and the IPAB had passed the following",

order on 7th August 2020:,

Ã¢â‚¬Å“The respondent No.1 has filed the application of trademark which contain the device of Star. Without making any comments at this,

stage, we direct that till the next date, the respondent no.1 shall not claim any exclusive right to the device of Star in any manner and shall",

also not transfer the registration with the device of Star.Ã¢â‚¬â€‹,

A clarificatory order was passed on 17th December, 2020 as under :",

Ã¢â‚¬Å“3. After small hearing, we may clarify that IPAB has not stayed the operation of the registration by virtue of the interim orders passed",

by IPAB on 07/08/2020. However by the said orders IPAB has directed that the Respondent shall not claim any exclusive right to the device,

of Star and shall also not transfer the registration with the device of Star.Ã¢â‚¬â€œ,

68. It is clear that the orders were only intended to be till the next date of hearing. They do not refer to a separate prayer for interim injunction as is,

available before a civil court under Order XXXIX Rules 1 & 2 CPC. It appears clearly that merits had not been considered by the IPAB when it,

passed the said orders. Therefore, this Court would not be precluded from considering the question of grant of interim relief under Order XXXIX",

Rules 1 & 2 CPC.,

69. Thus, if proceedings before the IPAB for rectification is pending, the filing of the suit cannot tantamount to forum shopping even if the IPAB had",

declined to exercise its discretion to grant interim relief following the guidelines provided in M/s Sridhar Milk Food Products Ltd. (supra). It is also,

moot that a civil suit would not only be filed against trademark infringement but also for the use of the mark to pass off goods/services. An order of,

injunction may be necessitated if passing off is made out. There is, thus, no doubt that the powers of the civil court are wider than the powers of the",

IPAB in issuing interim/interlocutory orders. If a party has approached the IPAB for interim relief and the same has been declined, it would no doubt",

be a relevant fact that could be kept in mind by the civil court while determining the question of grant of interim injunction by it, provided the interim",

injunction was declined for reasons given. In the light of the discussion herein-above, this Court concludes that the present application under",

consideration will have to be considered on merits and the plea taken of forum shopping is rejected.,

70. Since the IPAB has been abolished and rectification matters have now to be considered by the Commercial Division/IP Division of the High,

Court, the exercise of powers by the High Court Commercial Division/IP Division under Section 95 of the T.M Act and the powers to be exercised by",

a Civil Court/Commercial Court under Section 124 of the T.M. Act may require a more detailed consideration. That aspect is left open as it is not,

required in the present case where the interim order has been passed by the IPAB.,

INTERIM INJUNCTION - WHETHER TO BE GRANTED,

71. It is trite that the grant of interim injunction would depend on the existence of a prima-facie case, the balance of convenience being in favour of",

the plaintiffs and the irreparable loss and injury that a party to the suit could suffer in the event the interim relief was or was not granted. The three,

conditions have to be simultaneously satisfied. It would not be enough were the plaintiff to establish the existence of a prima-facie case where,

irreparable loss and injury is not suffered or the balance of convenience tilts in the favour of the defendant. It is quite possible for the court to refuse,

the interim relief. The facts of the present case would therefore, be required to be assessed in this backdrop.",

72. The admitted position is that the two trademarks are registered trademarks. While the mere fact that the two marks are registered would not be,

the clinching factor in dealing with injunction against passing off, as regards trademark infringement, Section 30 provides for use of a registered",

trademark by another in certain circumstances viz. to identify goods and services as those of the proprietor provided such use is in accordance with,

honest practices and is not such as to take unfair advantage or being detrimental to the distinctive character or repute of the trademark. Section 31,

declares registration to be prima-facie evidence of its validity. Section 28 vests rights of exclusive use of a trademark to the register proprietor,

provided the registration is valid.,

73. Admittedly, the registration of the defendantsÃ¢â‚¬â„¢ marks is under challenge and a rectification application is pending. This Court in HTC Corpn v.",

LV Degao 2022 SCC OnLine Del 953 has held that where there are two registered trademarks, while both proprietors could use their respective",

trademarks exclusively against third party, but not against each other, but the registration of the later Trade Mark may be refused or cancelled: (i)",

when deception or confusion results, (ii) there is dishonest user, (iii) subsequent use is without due cause, (iv) there is bad faith, or (v) dilution of the",

distinctiveness of a prior registered Trade Mark may occur. Therefore, these factors would be relevant to decide whether the subsequent",

user/registered proprietor should be restrained from using its Trade Mark, even if it was registered.",

74. The plaintiffs have claimed prior use of the Single Star logo and the word STAR. Star India Pvt. Ltd. had commenced its broadcasting in India,

way-back in 1991 and launched its first television channel Star TV in India in the year 1992. The defendants claim that they had adopted a star logo in,

1989 when it had come into being and when EUROSPORT had commenced its business of broadcasting in sports. The question of territoriality, as",

considered in Toyota Jidosha Kabushiki Kaisha (supra) would be relevant while determining the conflicting rights claimed by both sides. Both, prior",

use and territoriality are factors that would be crucial in the action for passing off. Deception and confusion would determine equities being in whose,

favour, not only in a passing off action, but also in action against trademark infringement. So also would be the question of dilution of the",

distinctiveness of the registered trademark. But bad faith and a dishonest adoption of a registered trademark would justify an injunction to restrain a,

proprietor of a registered trademark from using it. If the plaintiffs were to establish a prior entry into India and a prior user of the registered trademark,

of the word Ã¢â‚¬ËœSTARÃ¢â‚¬â„¢ and the Single Star Device in India and it appears that the defendants, though may be in use of a Ring of Stars or a Single",

Star Device in European countries, had come much later, the plaintiffs would still be entitled for an injunction for it is the reputation of each one in",

India that would matter, being competitors in the same field of broadcasting of sports events. Both would be vying for the same space and viewership.",

Use of similar trademarks could lead to the possibility or likelihood of confusion. The presence or absence of the defendants in the same market,

where the plaintiffs were operating their channels would also determine the entitlement to an injunction.,

75. Therefore, even if EUROSPORT had commenced business in 1989 in Europe, it would also be relevant to determine as to when they had entered",

the Indian market. It is apparent from the record that they seem to have done so only in 2017. The various documents filed by the plaintiffs would,

indicate that since 1992 till 2017, the company Star India Pvt. Ltd. and Star TV Production Ltd. had expanded their broadcasting activities by",

introducing several channels which included entertainment and sports. The name of these channels included the word Ã¢â‚¬ËœStarÃ¢â‚¬â„¢ as also a Single,

Star logo placed in a particular manner and its variations in color and shading. The reputation that these channels and the popularity of these channels,

with the viewing public has resulted in the Single Star logo being identified with the plaintiffs as the originator of the content on these channels and the,

provider of entertainment and sports programs on television in India.,

76. It is to be noted further that the Star logo that was adopted by the defendants was a Ring of Stars. That Ring of Stars is distinctive when,

compared to the Single Star logo of the plaintiffs. Had the defendants introduced that logo in India when it entered the Indian sports broadcasting,

arena, it is clear that there would have been no similarity in the two marks. But the comparison is between the Single Star used in EUROSPORT and",

the Single Star Device used by the plaintiffs, and whether such use by EUROSPORT adversely impacts the rights of the plaintiffs. No doubt when",

two marks are to be compared, there cannot be a surgical separation of the word and it would be an overall impression of the mark that would be",

considered. The argument was therefore that EUROSPORT was not at all similar and obviously not identical to Star Sports. That may be so, but",

when the Single Star Device is used by EUROSPORT, in the light of the fact that the plaintiffs had several channels, the possibility of confusion",

cannot be ignored. The distinctiveness of the mark of the plaintiffs would be affected adversely by multiple usages by others.,

77. It is no doubt true that Ã¢â‚¬ËœStarÃ¢â‚¬â„¢ is a celestial object but it would be incorrect to accept the contention of the learned senior counsel for the,

defendants that the adoption of the word Ã¢â‚¬Ëœ STARÃ¢â‚¬â„¢ and the use of the Ã¢â‚¬Ëœ StarÃ¢â‚¬â„¢ device would therefore be commonly available and the,

plaintiffs could claim no monopoly over the name Ã¢â‚¬Å“StarÃ¢â‚¬ or the common shape of a star. The plaintiffs can claim exclusivity in their own specific,

representation of the star, as has been held in Skyline Education Institute (India) Pvt. Ltd. Vs. SL Vaswan (2010) 2 SCC 142, Surya Agro Oils Ltd",

(supra) and Mercy Bigi (supra). A word that is descriptive and in common use for a particular object, by its use should immediately bring to the mind",

that object alone. A star to a common person would not connect to an entertainment and sports broadcasting channel. The use of a completely,

unconnected word and device to represent the broadcasting channels of the plaintiffs is a creative usage of the common word which requires to be,

protected. It is the plaintiffsÃ¢â‚¬â„¢ case that they had coined the word Ã¢â‚¬Ëœ STARÃ¢â‚¬â„¢ as an acronym for Satellite Television in Asia Region. The device,

was created depicting a Ã¢â‚¬Ëœ StarÃ¢â‚¬â„¢ in a stylized manner. The defendants have no explanation for choosing the Single Star logo, though they have one",

for the Ring of Stars, that is to reflect the European Union. Thus, the plaintiffs have a right to protect the use of a common word in a novel manner.",

78. The contention that the plaintiffs have themselves acknowledged the common nature of the word Ã¢â‚¬Ëœ StarÃ¢â‚¬â„¢ and the device by issuing,

disclaimers must be also seen in the backdrop of the products for which such disclaimers have been issued. The extracts of the disclaimers which,

have been filed by the defendants, as having been made by the plaintiffs themselves, are in respect of products and goods and are to the effect that",

registration of their marks shall give no right to the Ã¢â‚¬Å“exclusive use of the device of Ã¢â‚¬Å“STARÃ¢â‚¬â€‹ except as representedÃ¢â‚¬â€‹. There does not appear to,

be any disclaimer in classes 9/38/41 i.e. broadcasting. Also they reserve the plaintiffsÃ¢â‚¬â„¢ right to use the particular representation. That the plaintiffs,

did not file these disclaimers alongwith the plaint, will not be a suppression of material facts as such disclaimers do not have any relevance to the",

matter at hand. In contrast, the claim of the defendants that they had been using the Single Star even if it was to be accepted, was only in an",

extremely limited manner, in respect of Sports news on a webpage. It was not consistently used while telecasting the sports events on television. It",

was only in 2015 that EUROSPORT after being taken over by DISCOVERY i.e. defendants No.2 & 3 that they adopted the Single Star logo placed,

in a distinctive manner within the alphabet Ã¢â‚¬Ëœ EÃ¢â‚¬â„¢.,

79. The co-existence of both the trademarks in various jurisdictions would not act as an estoppel against the plaintiffs from seeking to protect their,

trademarks in India. If the impact on the business in other jurisdiction was negligible, the plaintiffs would be justified in taking a call as to initiate legal",

action or to ignore the use.,

80. The scale of operation of the plaintiffs in India being huge as reflected in their annual reports, where millions of households watch the channels of",

the plaintiffs including their sports channel, the use of a Single Star logo by the defendants would prima-facie be on account of that popularity and",

reputation that the plaintiffs had built in India. That the EUROSPORT was itself not a very popular channel in Europe is also evident from their own,

public statement made by Peter Huton on 2nd December 2015 (placed at page Nos.651-654 of the DefendantÃ¢â‚¬â„¢s documents) that the channel had,

not been doing well as having focused on recorded events and that a complete overhaul was being done by DISCOVERY to rebrand itself as also to,

add more premium events in the broadcast. This admission in 2015 though relevant for EUROSPORT would also concededly establish that they had,

no presence in India up to 2015 when they came in with DSPORT. By that time the plaintiffs were well entrenched in the sports and entertainment,

arena of the electronic media under the trademark Ã¢â‚¬Ëœ STARÃ¢â‚¬â„¢ and the distinctive Star logo.,

81. That the adoption of the Single Star by the defendants did not reflect honest practice is evident from the chain of events that had taken place,

between the parties. In 2017, the defendants had entered into the sports broadcasting arena in India under the name DSPORT after DISCOVERY",

had taken over EUROSPORT. They adopted a Single Star Device embedding it in the alphabet Ã¢â‚¬Ëœ Ã¢â‚¬â„¢. Immediately, the plaintiffs protested by",

issuing a legal notice dated 30th March, 2017. The matter was resolved by the parties entering into a Settlement dated 26th February, 2018 which was",

also amended on 22nd October, 2018. This Agreement is an important document and its contents worth noting in detail. Reference in the Agreement",

has been made to EUROSPORT network of television channels in para (ii) recording it having offered premium sports content in several markets for,

nearly 30 years and enjoying a cumulative viewership of 231 million viewers across 54 countries. Reference was also made to the fact that there were,

several EUROSPORT formative trademarks.,

82. With regard to the plaintiffs Ã¢â‚¬â„¢ trademarks, it is stated in the Agreement that it had launched the earliest of the Star Channels in the year 1992",

and was at the time of the Agreement, broadcasting more than 50 channels in 8 different languages reaching approximately 726 million viewers a",

month across India and more than 100 other countries. Specifically it was noted that the plaintiffs had a network of 12 sports channels in India,",

broadcasting premium sports events, apart from several other channels. The word Ã¢â‚¬Ëœ Star Ã¢â‚¬â„¢ in a particular representation with various star",

formative trademarks was recorded as being used by the plaintiffs.,

83. After each one proclaimed their respective status and reputation, the parties, vide the Settlement resolved the trademark conflict which had arisen",

in India on account of DSPORT adopting a Single Star and the plaintiffs opposing the same. As a means of resolving the trademark dispute, the",

present defendants No.2 & 3 agreed to alter the Ã¢â‚¬Å“DSPORT Ã¢â‚¬ logo with the star marks, by removing the Star Device Ã¢â‚¬Å“entirely Ã¢â‚¬ and replacing",

it with a device of a sphere/globe . Since the defendants had sought to register the DSPORT with a Star and,

the same was pending, the defendants had agreed to withdraw the same. However, DSPORT with Globe stood registered on 15th April, 2015. It is",

worthy of note at this juncture that the defendants have subsequently, also instituted suits against entities which used the Device of a Globe in their",

mark, thus asserting exclusive rights to their registered trademark of DSPORT with a Globe.",

84. It is clear from the Settlement that both sides acknowledged the reputation of one another and in a spirit of resolution, the defendants had agreed",

to not use the Single Star mark in India in respect of sports broadcasting. Clause 1 of the Settlement Agreement dated 26th February, 2018 reads as",

under :,

Ã¢â‚¬Å“1. Discovery agrees to alter the DSPORT & Star Marks by removing the star device entirely and replacing it with the device of a,

sphere/globe. Consequently, the DSPORT-formative trademarks may be represented as (Ã¢â‚¬ËœDSPORT &",

Globe LogoÃ¢â‚¬â„¢), among other possible iterations and without any limitation as to colour. For clarity, it is agreed and understood that",

DSPORT & Globe Logo, including any future iterations of the same shall not use / incorporate the word STAR and/or a representation of",

star in any form whatsoever.Ã¢â‚¬â€‹,

(emphasis added),

85. Despite the above assurance, the defendants have introduced EUROSPORT with the star mark. It is not possible for them to say that the",

undertaking is not applicable to EUROSPORT because that was in connection to Ã¢â‚¬Å“DSPORTÃ¢â‚¬. The defendants had themselves referred to its,

EUROSPORT marks in clause 6 and had agreed not to use a Ã¢â‚¬Ëœ StarÃ¢â‚¬â„¢ in India. An argument had been advanced that the plaintiffs had agreed not,

to raise any objection to the use of the EUROSPORT marks. However, as rightly pointed out by the learned senior counsel for the plaintiffs, that was",

subject to the EUROSPORT mark not being identical with or deceptively similar to the Star mark of the plaintiffs in India. The defendants, by going",

against the terms of the Agreement which had once and for all settled the trademark disputes between them, have chosen to rake it up again. The",

adoption of the Single Star by no stretch can be considered to be a bonafide adoption.,

86. The facts unequivocally establish that the plaintiffs have disclosed a prima-facie case in their favour. The continued dishonest use of the Single,

Star by the defendants would cause irreparable loss and injury to the plaintiffs particularly, by diluting the unique use of the word Ã¢â‚¬ËœSTARÃ¢â‚¬â„¢ which",

is a created word and the Ã¢â‚¬ËœStarÃ¢â‚¬â„¢ logo, by common usage.",

87. The balance of convenience lies in favour of the plaintiff as they have built up a strong reputation in India over a long period of time, whereas the",

defendants have just entered the market in 2017 as EUROSPORT. The defendants had in fact run their sports channel as DSPORT with the Globe,

logo for about 18 months and had protected it, before they had adopted the Single Star EUROSPORT name and device.",

88. There is not a shred of evidence to support the claim of the defendants that the plaintiffs had acquiesced to the use of the Single Star logo by the,

defendants in India. They have acted promptly both when the DSPORT channel was introduced in India with a star which led to the Settlement dated,

26th February, 2018 and when the Star logo was changed into a Globe. They have acted promptly when EUROSPORT with a Single Star logo was",

introduced by the defendants in February, 2020. The desist notices were sent to the defendants on 14th February, 2020 objecting to the use of the",

Single Star logo and the suit was filed on 2nd September, 2020.",

89. The plaintiffs are thus entitled to interim injunction as prayed for. Accordingly, the application is allowed and the defendants are restrained from",

using the impugned marks , , , and , or any other mark which is",

identical or deceptively similar to the Plaintiff No. 1Ã¢â‚¬â„¢s registered STAR Marks including the STAR Device , thereby amounting to",

infringement of trademark as also passing off till the disposal of the suit.,

90. Nothing contained in this order shall be an expression on the merits of the case.,

91. The application [I.A.7682/2020] stands disposed of.,

CS(COMM) 359/2020,

92. Since the rectification proceedings are pending before the IP Division, further proceedings in this suit are stayed to be revived by either party after",

the decision in the rectification proceedings, to be listed before the Roster Bench.",

93. The judgment be uploaded on the website forthwith.,