

(2016) 03 DEL CK 0191

DELHI HIGH COURT

Case No: CS (Comm.) No. 179/2016

Entertainment Network (India)
Ltd.

APPELLANT

Vs

HT Media Limited

RESPONDENT

Date of Decision: March 17, 2016

Acts Referred:

- Civil Procedure Code, 1908 (CPC) - Order 39 Rule 1, Order 39 Rule 2, Section 149

Citation: (2016) 4 ADDelhi 572 : (2016) 229 DLT 6 : (2016) 5 RAJ 314

Hon'ble Judges: Valmiki J. Mehta, J.

Bench: Single Bench

Advocate: Sandeep Sethi, Sr. Adv., Sudeep Chatterjee, Jaya Mandelia and Nupur Lamba, Advocates, for the Appellant; P. Chidambaram, Amit Sibal, Sr. Advocates, Meghna Mishra, Sidharth Chopra, Nakul Sachdeva, Julien George, Naman Joshi, Ankit Rajgharhia and Tahir Ashr

Final Decision: Allowed

Judgement

Valmiki J. Mehta, J.

IA No. 3317/2016

Exemption is allowed, subject to just exceptions.

The application stands disposed of.

IA No. 3318/2016 (under Section 149 CPC)

Learned Senior Counsel for the plaintiff submits that he has already paid the court fee. Registry is directed to check the same.

The application stands disposed of.

CS(COMM) 179/2016 & IA No. 3316/2016 (u/Order 39 Rule 1 & 2 CPC)

1. Plaintiff has filed this suit seeking inter alia the relief of injunction against the defendant by pleading that plaintiff is the exclusive owner of the trademark "Pehla Nasha" which is used by the plaintiff with respect to an internet radio channel, and that consequently the defendant be enjoined from using the trademark /trade name "Radio Nasha" and under which trademark/tradename the defendant is running an FM Radio Channel/Station.

2. As per the plaint, the plaintiff operates an internet Radio Channel "Radio Mirchi" besides also using this trademark radio mirchi for the plaintiff's FM Radio Station. There is a sub-channel of Radio Mirchi internet channel which provides music and songs to its listeners, and this sub-channel has as its trademark "Pehla Nasha". The case of the plaintiff is that the word "Nasha" forming part of its trademark "Pehla Nasha" is very much in the ownership of the larger trademark "Pehla Nasha" of the plaintiff, and that defendant by cannibalizing the word "Nasha" from the trademark "Pehla Nasha" cannot use the word "Nasha" in the defendant's FM Radio "Radio Nasha".

3. This suit came up for the first time on 11.03.2016 when the matter was adjourned for 14.03.2016 to enable the defendant to file an affidavit inasmuch as defendant inter alia set up a defence that the plaintiff was not the exclusive owner of the trademark "Nasha" forming part of trademark "Pehla Nasha" inasmuch as the defendant argued that there were other music and songs suppliers; whether they be through internet channels or through the normal radio channels; who use the expression "Nasha" as part of their trademark/trade name and which suppliers were in business were prior to the first use by the plaintiff of "Pehla Nasha" in the year 2014. Hence, the defendant argues that the plaintiff was not entitled to injunction in view of the ratio of a Division Bench Judgment of this Court in the case of Goenka Institute of Education & Research Vs. Anjani Kumar Goenka , ILR 2009 (vi) Delhi 415 which holds that a plaintiff cannot claim exclusive ownership of trademark where others have used the trademark prior to the plaintiff.

4. The defendant has filed an affidavit dated 14.03.2016, setting out as part of that affidavit at page Nos. 3 to 5, various music websites and channels existing on the internet using the word "Nasha", and which music channels have used the word "Nasha" even prior to the adoption and user by the plaintiff in the year 2014 of plaintiff's trademark "Pehla Nasha".

5. The plaintiff has filed its reply affidavit under an index dated 16.03.2016 to the affidavit filed on behalf of the defendant.

6. At the outset, I may note that issue with respect to the grant of interim order as prayed by the plaintiff today is at a stage when pleadings are not completed i.e the defendant has yet to file its written statement and plaintiff its replication thereto. Also, in view of the short period of time from when the suit was came up on 11.03.2016, parties have yet to file various additional documents to support its

respective pleas. In sum and substance, the issue is with respect to grant or not grant of ad interim orders till completion of pleadings by the parties and hearing and disposal of the I.A. bearing No. 3316/2016 filed by the plaintiff under Order 39 Rules 1 & 2 CPC.

7. The relevant paragraph of the judgment of the Division Bench of this Court, relied upon by the defendant, in the case of Goenka Institute of Education and Research Vs. Anjani Kumar Goenka and Anr. , (2009) ILR 6 Delhi 415 is para 24 (iv), and which para reads as under:

"24. xxxxxxxx

(iv) No doubt the field of operation of both the appellant and the respondents is the same, viz education, however, the issue of deceptive similarity will also have to be negated not only on account of "Goenka" being a common surname but also because of the fact that other educational institutions using the name "Goenka" either per se or with other words already existed prior to the respondents establishing the institutions in the year 1994. Furthermore the promoters of the appellant's institute do bear the surname "Goenka" and such user is thus bona fide. It has been found on record that the following institutions have been operating in different parts of India using the word "Goenka" in their trademark or trade name viz the name of the institution and which are as under:

(a) Goenka College of Commerce, Kolkatta since 1951 (P.388 of appeal)

(b) Goenka Vidya Mandir, Pilani, since 1983 (P.397 of appeal), and

(c) Goenka Sanskrit Mahavidyalaya, Banaras, since 1957 (P.403/405 of appeal)

We, therefore, prima facie find that there is merit in the contention of the appellant that various other institutions have been using the word "Goenka" as part of their trademark and trade name even prior to the use of the word "Goenka" by the respondents as part of their trade mark and, therefore, it cannot be said that "Goenka" has become distinctive or acquired a secondary meaning so far as the respondents are concerned. Therefore, neither the appellant nor the respondents can be said to be the first user or prior user for the purposes of becoming exclusive owners of the word "Goenka" to prevent others from using "Goenka". In fact, the number of institutions run by different parties may, after trial, lead to the word "Goenka" being publici juris. Publici Juris, Para 6(iii) "

(underlining added)

8. On behalf of the defendant, it is argued by relying upon this para that once there exists other music suppliers and websites who had adopted the word "Nasha" with respect to their music and songs channels even prior to user by the plaintiff from the year 2014, the plaintiff in such a case is not the exclusive owner and user of the word "Nasha" forming part of its trademark "Pehla Nasha" and that user by the

defendant of the word "Nasha" in view of ratio in the case of Goenka Institute of Education and Research (Supra), is relatable to and be said to be adapted from the use of word "Nasha" by those other music and song suppliers who have used that word "Nasha" even prior to the first user by the plaintiff in the year 2014.

9. As per the affidavit filed on behalf of defendant, though there are pleaded to exist various websites and music channels using "Nasha", for the purposes of the present order it will suffice if I refer to the music channels and the playlists which are found at serial nos.3, 4, 5 and 13 to 21 from the chart of the defendant at page nos.3 to 5 of its affidavit.

10.(i) Serial No. 3 pertains to a playlist which is a part of the website 8tracks.com playing songs under the name "Nepali Nasha". This play list of Nepali Nasha is a collection of Nepali hit songs available on the website 8tracks.com for being heard by any consumer or listener.

(ii) Serial No. 4 pertains to another playlist of the same site in the name of "Haroon Ka Nasha" and which is a specific playlist created by a person.

(iii) Serial No. 4 is a website nashamusic.com playing songs of two persons Ms. Sangeeta and Mr. Fazal.

(iv) Serial Nos. 13 to 21 are playlists of different creators of songs and music as found on the website of itunes.apple.com and which use the word "Nasha" in itself and with variations.

11. Learned senior counsel for the plaintiff has sought to distinguish the playlists of Nepali Nasha and Haroon Ka Nasha as regards the use of the word "Nasha" in the same as not affecting the ownership of trademark "Pehla Nasha" by arguing that the playlists of Nepali Nasha and Haroon Ka Nasha, though enables a listener of music and songs to hear the songs and music in the repertoire of Nepali Nasha and Haroon Ka Nasha (also called as play lists), however, the listeners from such play lists can control the playlist by skipping the songs by fast forwarding to a specific song or rewinding to another song, and it is thus argued that these aspects distinguish such music and songs channels from the music and songs channels and listeners of the internet radio channel of the plaintiff wherein the listener cannot choose a specific song or go to specific song, and which is similar to the position of a normal radio station at medium wave and short wave etc. or an FM radio channel for that matter. Similar are the arguments with respect to the playlists having the word "Nasha" in various playlists found in the website of itunes.apple.com and the website nashamusic.com.

12. In this strongly contested case where the defendant is already working its radio channel under the trademark RADIO NASHA 107.2 FM since 09.03.2016, grant of interim orders in the opinion of this Court would have the effect of decreeing the suit at this stage itself without opportunity to the defendant in the facts of the

present case to contest and seek dismissal of the suit on merits, including on the ground of prior user of the word "Nasha" by other websites and music channels. Whether therefore the injunction as prayed for by the plaintiff should be granted would have to be considered keeping this aspect in mind.

13. In my opinion, merely because a playlist is a playlist which can be toggled as compared to a playlist of the plaintiff which cannot be toggled, is not a valid distinction, once the issue is of the user of a trademark with respect to a supplier of music and songs and the listeners of such music and songs. The genre is playing and supplying of music and which is heard by the listeners. Prima facie, at this stage it is found that at least the playlists of Nepali Nasha and Haroon Ka Nasha in the website of 8tracks.com are existing since the years 2012 and 2013, and of nashamusic.com since 2006, and which websites have existed prior to adoption by the plaintiff in the year 2014 of the trademark "Pehla Nasha" containing the Nasha, hence, the ratio in the case of Goenka Institute of Education and Research (Supra) would apply preventing this Court from granting any interim order, more so having the effect of decreeing the suit at this stage by stopping an existing working radio station of the defendant under the trademark "Radio Nasha".

Though, Learned Senior Counsel for the plaintiff has argued that the playlists and channels having variations of the word "Nasha" in the website itunes.apple.com., so far as India is concerned, have come into operation after 2014 and for which purpose the learned Senior Counsel for the plaintiff has taken this Court through certain writings found on the site of Wikipedia, however, it is necessary that further details and evidence are available before this Court for this Court to rule on this aspect as documents of the site of Wikipedia are only in the form an article. Even if I consider the article on the site of Wikipedia yet it is seen that user by the website 8tracks.com of Nepali Nasha and Haroon Ka Nasha of the word "Nasha", and also Nasha in the website nashamusic.com prior to adoption by plaintiff in 2014, means that the defendant could have adopted the word Nasha from these music suppliers who had used the word "Nasha" in its playlists or music channels prior to the plaintiff. The issue in this regard is of adoption of word "Nasha" and not the issue of the exclusive ownership of the work mark "Nasha" by the website itunes.apple.com inasmuch as the present suit is not by apple itunes.apple.com claiming exclusive ownership to the work mark "Nasha".

14. Learned senior counsel for the plaintiff has argued on the aspect that itunes website was not available in India till 2016, and has placed reliance upon the judgment of this Court in the case of Exide Industries Limited Vs. Exide Corporation, 2012 SCC OnLine Delhi 4645 to argue that there is difference between the exclusive ownership of a trademark within India of a person such as the plaintiff because there can be exclusive ownership as regards Indian territory of a trademark "Nasha", although there are other owners who may claim exclusive ownership of the word "Nasha" in territories outside India.

In this regard it is to be however noted that the issue as of today is with respect to whether others prior to the plaintiff have been using the word Nasha and hence of adoption by the defendant not being relatable to the adoption of the word "Nasha" by the plaintiff but adoption of Nasha from other earlier music/song suppliers and channels, and who are not objecting to the user of the defendant of the word "Nasha". Also the judgment in the case of Exide Industries (supra) is distinguishable because it was passed at the final arguments stage where after leading of evidence it was found and held that the plaintiff in that case qua the territory of India had exclusive ownership of "Exide", and whereas as stated above the present suit is of the threshold stage where even pleadings are not yet complete.

15. In view of the above, the following prima facie conclusions can be arrived at and which are without prejudice to the respective rights & contentions which will be heard and decided at the stage of disposal of the injunction application No. 3316/2016 or the suit:-

(i). There are found to exist users of the word Nasha in music/song channels by music/ songs suppliers prior to the user of the plaintiff of Pehla Nasha in the year 2014 especially of 8tracks.com from the years 2012 and 2013 of the playlists Nepali Nasha and Haroon Ka Nasha and website nashamusic.com which came into operation in the year 2006. The website nashamusic.com list allows listeners to listen to songs for free or download the songs on payment of consideration. Payment of consideration, however, cannot be a ground to argue a difference being created with respect to adoption of the word Nasha so far as websites of the music/ song music channel or supplier is concerned. It bears reiteration that the payment to be made to the website nashamusic.com is not for listening to a song but for downloading of the songs and learned Senior Counsels for the defendant have argued, and prima facie rightly, that even on the website of the plaintiff while listening to the songs/music is free, however, if the song/music has to be downloaded, the same has to be paid for by the customers/listeners.

(ii) Prima facie, the ratio of Goenka Institute of Education and Research (Supra) is found to apply as it is found that there are music/song channels/ and channel/ suppliers who have used the word "Nasha" prior to the adoption of the plaintiff in the year 2014.

(iii) Considering that the suit is at an initial stage when the pleadings are not completed, it would not be appropriate in the facts of the present case to stop an existing FM radio channel of the defendant and which would have the effect of decreeing the suit at an interim stage and where the defendant prima facie seems to have defences including of the plaintiff not being the exclusive owner of Nasha inasmuch as other music/song channels and suppliers has used the word "Nasha" prior to the adoption by the plaintiff in the year 2014.

16. In view of the above, at this stage, this Court does not find that any ad interim order should be granted and it is found necessary that pleadings in the suit be completed before a decision is taken on the grant or otherwise of interim orders as prayed in I.A. No. 3316/2016.

17. Let defendant file its written statement within a period of three weeks from today. Plaintiff will file replication within two weeks thereafter, as prayed. Pleadings in the IA No. 3316/2016 be completed in the same schedule. Parties will file the documents in their power and possession alongwith their pleadings and admission/denial of such documents will be done within two weeks thereafter by filing an affidavit attaching thereto an index of the documents of the other side containing additional column of endorsement of admission/denial.

18. List on 27th May, 2016 before the Joint Registrar for marking of the exhibits to the documents.

19. List before Court on 26th July, 2016 for framing of issues and arguments on IA No. 3316/2016.