



IN THE HIGH COURT OF DELHI AT NEW DELHI

% Judgment delivered on: 06.03.2024

+ **FAO(OS)(COMM) 267/2019**

PRASAR BHARTI

..... Appellant

versus

DISH TV INDIA LTD.

..... Respondent

Advocates who appeared in this case:

For the Appellant : Mr Rajeev Sharma, Senior Advocate with Mr Uddyam Mukherjee, Mr Saket Chandra Roy, Mr Pranav Giri and Mr Swapnil Pattanayak, Advocates.

For the Respondent : Mr Sandeep Sethi, Senior Advocate with Mr Rohan Swarup and Ms Anjalika Arora, Advocates.

CORAM

HON'BLE MR JUSTICE VIBHU BAKHRU

HON'BLE MR JUSTICE AMIT MAHAJAN

JUDGMENT

AMIT MAHAJAN, J

1. The appellant has filed the present intra- court appeal under Section 13 of the Commercial Courts Act, 2015 impugning an order



dated 16.07.2019 (hereafter ‘**the impugned order**’) passed by the learned Single Judge in I.A. No. 20187 of 2014 in CS (Comm.) No. 347 of 2016, whereby the respondent’s application under Order XXXIX Rules 1 and 2 of the Code of Civil Procedure, 1908 was allowed and the appellant was restrained from adopting the trademark ‘DD Free Dish’ or any other mark incorporating the mark ‘Dish’, pending disposal of the suit.

FACTUAL CONTEXT

2. Appellant, a statutory corporation created by the Prasar Bharti (Broadcasting Corporation of India) Act, also known as Doordarshan, is the public broadcaster of the country, providing free Radio and Television services to all subscribers including Direct to Home (hereafter ‘**DTH**’) services since the year 2004. It was engaged in providing DTH services under the trademark and trade name ‘DD Direct Plus’. However, in the year 2014, the appellant renamed it as ‘DD Free Dish’.

3. The respondent is a company incorporated under the Companies Act, 1956, engaged in the business of providing DTH services within the purview of the Interconnection (Broadcasting & Cable Services) Regulations framed by the Telecom Regulatory Authority of India (TRAI). The respondent has been providing its services under the brand name ‘Dish TV’ since the year 2003 after obtaining the DTH license



from the Ministry of Information and Broadcasting Government of India. The respondent claims that it was the first to introduce DTH entertainment services in India, and there were approximately 16 million registered subscribers in the year 2014. The respondent's trademark, 'Dish TV' has acquired distinctive character by virtue of its extensive and exclusive use.

4. On 15.07.2003, the respondent became the registered proprietor of the word mark 'Dish TV' (Application No. 1214373) under Class 9. Thereafter, on 29.03.2004, it secured the registration of the label 'Dish TV' by Trademark Application No. 1275348. The respondent claims that it is the adopter, prior user and proprietor of the aforesaid registered trademarks, and the status of the aforementioned trademark registration is valid and subsisting as of date. The respondent has also obtained registration for its device of Dish Antenna and has got several registrations of the variants containing the word 'Dish', in its name.

5. In May, 2014, the respondent came to know about the use of the impugned mark 'Free Dish' by the appellant in respect of the identical service being provided by the respondent, and tried to resolve the issue by sending a notice to the appellant dated 17.05.2014, *inter alia*, calling upon the appellants to cease and desist from providing services under the impugned mark 'Free Dish'.



6. On 16.06.2014, the appellant replied to the notice of the respondent but continued to provide its services under the trade name 'Free Dish'. The respondent contends that after the said notice the appellant claimed statutory right and filed an application for registration of the impugned trademark (Application No. 2592320) under Class 41. While the application for the registration of the trademark was still pending, the appellant represented its mark as a registered trademark under the Trade Marks Act, 1999 (hereafter 'TM Act').

7. The respondent filed a suit for permanent injunction along with an interim application under Order XXXIX Rules 1 & 2 of the Code of Civil Procedure, 1908 against the appellant on 15.10.2014 for the infringement of trademark, copyright, passing-off combination, misrepresentation, rendition of accounts and damages.

IMPUGNED ORDER

8. The learned Single Judge, by impugned order, allowed the application for interim injunction filed by the respondent and directed the appellant to refrain from infringing the trademark of the respondent by adopting the mark 'DD Free Dish' or any other mark incorporating the word 'Dish' during the pendency of the suit. The Court also granted three months to the appellant to inform its consumers of the new name as well.



9. The learned Single Judge considered the rival submissions of the parties. The Court concluded that the plea raised by the appellant, based on Section 9 of the TM Act, that the word 'Dish' is *publici juris* and/or common to trade was unmerited. The Court noted that, notwithstanding Section 9 of the TM Act, the respondent's mark stood registered for 16 years (as on the date of judgment) and no one, including the appellant was using the word 'Dish' as part of its mark since 2004 and had never objected to respondent's registration till then. The learned Single Judge further interpreted Sections 31 and 47 of the TM Act, and held that since the jurisdiction to determine validity of a mark vested only in the Registrar or the Intellectual Property Appellate Board (IPAB), the Court could not render a final view in this regard.

10. The Court also noted that none of the defences under Section 30 of the TM Act were available to the appellant as it had not pleaded or even indicated that the use of the word 'Dish' was indicative of the kind or characteristic of DTH service, particularly as the appellant was providing the said service without using the word 'Dish' from 2004 to 2014. Moreover, the Court examined in detail, the meaning of 'Dish' and 'Dish Antenna' and observed that the same were common to all satellite communication, and not essential to DTH Service.

11. The Court finally compared the marks 'Dish TV' and 'DD Free Dish' applying the test of use of a prominent part of the registered mark, as prescribed in the cases of *United Biotech Pvt. Ltd. v. Orchid Chemicals & Pharmaceuticals Ltd. & Ors. : 2012 SCC OnLine Del*



2942, *Laxmikant V. Patel v. Chetanbhai Shah and Another: (2002) 3 SCC 65* and *Himalaya Drug Company v. S.B.L. Limited: 2010 SCC OnLine Del 2206*. The Court found that, *prima facie*, a clear case of infringement was made out in light of the complex public private ventures prevalent today. The Court further noted that even though the appellant's mark had the word 'DD' in it, it was possible for consumers to form an opinion that it was the respondent, in association with the appellant, who was providing certain free channels, which may result in them wanting paid channels of the respondent to be telecasted for free.

12. The Court disagreed with the contention of the appellant that the interim order should not be passed as recording of evidence had already begun. The Court observed that the conduct of the appellant was causing delay at every step of the suit and at the material time the recording of evidence was still at a nascent stage, despite the issues being framed three years prior.

13. The Single Judge found that there was no reason for the appellant to suspect any harm to the public as the appellant had itself changed the name of its service from DD Direct+ to DD Free Dish after ten years. The Single Judge addressed the said aspect by providing sufficient time to the appellant to inform its customers.



SUBMISSIONS

14. Mr. Rajeev Sharma, learned Senior Counsel for the appellant submitted that their DTH Platform is named as 'DD Free Dish', for the reason that the word 'DD' stands for Doordarshan, the word 'Free' indicates that the services of the appellant are free of cost and 'Dish' refers to the nature of the services i.e. satellite broadcasting service and the reception of broadcast and reception of satellite signals.

15. Learned counsel stated that the word 'Dish' being a generic word refers to a Dish Antenna without which DTH services cannot be availed. Therefore, the respondent cannot claim the exclusive right to use the same as such marks are not entitled to be protected under section 30(2) of the TM Act. Learned counsel also averred that the respondent only has a registration in so far as DTH is concerned for the mark 'Dish TV', and the word 'Dish' does not constitute an essential feature of respondent's mark.

16. Learned counsel further submitted that there can be no possibility of deception having regard to the mode and manner of availing the services of the appellant and the respondent. A customer wishing to subscribe to the DTH Platform of the respondent would have to enter into an agreement with the respondent to pay the price for the Dish Antenna to be installed at his place and to make periodic payment. On



the other hand, a customer wishing to tune into the DTH service of the appellant would only have to purchase an appropriate Set Top Box and a Dish Antenna from the market and get it installed.

17. Learned counsel submitted that the respondent's registered trademark 'Dish TV' is a composite mark, which must be looked at as a whole and the respondent has not sought a separate registration for the word 'Dish', thus the respondent cannot claim exclusivity over a part of the registered trademark. He further stated that it is also well settled that the mere use of a mark does not automatically translate into distinctiveness.

18. Mr. Sandeep Sethi, learned senior counsel for the respondent countered the aforesaid submissions by contending that the appellant, by using the impugned mark 'DD Free Dish' is infringing its registered trademark 'Dish TV'. Further, the trade name and the impugned mark used by the appellant is deceptively similar/identical to its registered trademark.

19. Learned counsel further contended that the appellant's sudden and unexplained change of the name from 'DD Direct+' to 'DD Free Dish' is clearly an attempt to illegally encash upon the reputation and goodwill of the respondent.

20. Learned counsel averred that the contention of the appellant that the word 'Dish' is common to the trade, is incorrect, since, there are



five DTH Operators in the country, namely- the respondent Dish TV, Tata Play, SUN Direct, Airtel Digital TV and the appellant, DD Free Dish and none of the other DTH operators use the respondent's registered mark 'Dish TV', or even the most prominent part of the respondent's mark 'Dish' in their marks.

ANALYSIS

21. The suit for injunction was filed by the respondent under Section 29(1) of the TM Act. In terms thereof, the plaintiff is entitled for an order of injunction in case it is established that the trademark used by the defendant is identical or similar to the registered trademark of the plaintiff and is being used to market the goods or services, which are also identical or similar. It is not in dispute that the services provided by the appellant / defendant are similar to the services provided by the respondent / plaintiff, that is, DTH services by installation of Set Top Box and a Dish Antenna. In such a case, if it is found that the marks are identical or similar, the same would be sufficient to presume the existence of likelihood of confusion.

22. Therefore, the principal question to be addressed in the present appeal, is whether the two competing marks 'Dish TV' and 'DD Free Dish' are, *prima facie*, similar / identical.

23. It is significant to note that the trademark registered in favour of the respondent consists of not one but two words, that are, 'Dish' and



‘TV’. Similarly, the mark used by the appellant also consists of three words, that are, ‘DD’, ‘Free’ and ‘Dish’. A comparison of the two marks shows that other than the word ‘Dish’ occurring in both the marks, there is no other similarity. The mark being used by the appellant includes its well-known trade name, that is, DD.

24. In terms of Section 17 of the TM Act, where the trademark consists of several words, its registration confers on the proprietor an exclusive right over the trademark when taken as a whole; its registration does not confer any exclusive right in the matter forming only a part of the whole of the trademark so registered. Section 17 of the Act reads as under:

“17. Effect of registration of parts of a mark.— (1) When a trade mark consists of several matters, its registration shall confer on the proprietor exclusive right to the use of the trade mark taken as a whole.

(2) Notwithstanding anything contained in sub-section (1), when a trade mark—

(a) contains any part—

(i) which is not the subject of a separate application by the proprietor for registration as a trade mark; or

(ii) which is not separately registered by the proprietor as a trade mark; or

(b) contains any matter which is common to the trade or is otherwise of a non-distinctive character,



the registration thereof shall not confer any exclusive right in the matter forming only a part of the whole of the trade mark so registered.”

25. It has been held in several decisions that it is not correct to take a portion of the mark and compare it with the corresponding portion of the competing mark. The true test is whether the mark when seen as a whole is likely to cause deception or confusion in the mind of a person of average intelligence and imperfect recollection. The conflicting marks are to be compared by looking at them in its entirety rather than breaking the marks into parts for comparison. It is, however, true that it is permissible to consider the dominant feature of the composite mark for determining if the competing mark is similar. However, it is not permissible to hold a mark as deceptively similar by examining a portion of the mark and comparing it with the portion of another mark when the marks if compared as a whole are not similar.

26. It is pertinent to note that the matters contained in the competing marks are common generic words. It is not in dispute that the word ‘Dish’ being used in both the marks relates to the ‘Dish Antenna’. The word ‘TV’ denotes the device which is used for viewing the signals, that is a television. The words are common and on standalone basis may not be eligible for registration. The same are, to some extent, suggestive of the services being offered by the parties. The same denotes the Dish Antenna which is an essential component of the services provided by both the parties.



27. A bare visual comparison of the two marks shows that apart from the word ‘Dish’, there is no other similarity. The word DD has been associated with the appellant’s trade name and reputation over the decades. The existence of the word ‘DD’ as part of the appellant’s mark, in our opinion, is *prima facie*, sufficient to indicate to the general public, the distinctive origin of the appellant’s service. There is no likelihood of confusion in the minds of the purchasing public as to the origin of the services.

28. We agree with the contentions advanced by the learned Senior Counsel for the appellant that the word ‘Dish’ is a generic word and refers to a Dish Antenna, which is an essential component of DTH services and the respondent cannot claim any exclusive right to the use of the same. The same on standalone basis was not entitled to be protected in terms of Section 30(2) of the TM Act.

29. Section 30(2) of the TM Act reads as under:

“(2)A registered trade mark is not infringed where—

(a)the use in relation to goods or services indicates the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services or other characteristics of goods or services;

(b)a trade mark is registered subject to any conditions or limitations, the use of the trade mark in any manner in relation to goods to be sold or otherwise traded in, in any place, or in relation to goods to be exported to any market or in relation to services for use or available or acceptance in any place or country outside



India or in any other circumstances, to which, having regard to those conditions or limitations, the registration does not extend;

(c) the use by a person of a trade mark—(i) in relation to goods connected in the course of trade with the proprietor or a registered user of the trade mark if, as to those goods or a bulk or which they form part, the registered proprietor or the registered user conforming to the permitted use has applied the trade mark and has not subsequently removed or obliterated it, or has at any time expressly or impliedly consented to the use of the trade mark; or (ii) in relation to services to which the proprietor of such mark or of a registered user conforming to the permitted use has applied the mark, where the purpose and effect of the use of the mark is to indicate, in accordance with the fact, that those services have been performed by the proprietor or a registered user of the mark;

(d) the use of a trade mark by a person in relation to goods adapted to form part of, or to be accessory to, other goods or services in relation to which the trade mark has been used without infringement of the right given by registration under this Act or might for the time being be so used, if the use of the trade mark is reasonably necessary in order to indicate that the goods or services are so adapted, and neither the purpose nor the effect of the use of the trade mark is to indicate, otherwise than in accordance with the fact, a connection in the course of trade between any person and the goods or services, as the case may be;

(e) the use of a registered trade mark, being one of two or more trade marks registered under this Act which are identical or nearly resemble each other, in exercise of the right to the use of that trade mark given by registration under this Act.

30. The learned Single Judge has given a *prima facie* finding that the dish shape is irrelevant for the purpose of DTH services and the vital part is the Low Noise Block Downconverter (LNB), that is the equipment mounted on the front of the Dish, which transmits the signal



of the Set Top Box or the receiver. The learned Single Judge held that “*Dish is not generic to DTH service or publici juris and/or common to the trade of DTH service*”. The learned Single Judge further held that the word ‘Dish’ may be generic to the business of cooked food or utensils, but is certainly not to providing television service.

31. We disagree with the findings given by the learned Single Judge for more than one reason. Firstly, the findings are not based on the pleadings, but on a personal reading by the learned Single Judge on the subject. It is recorded that “*My readings on the subject show that the dish shape is pretty much irrelevant inasmuch as it is merely a reflector and lens to focus on the signal*”. No such proposition was put to the parties, and thus the impugned order is vitiated for having violated the well settled principles of natural justice. It is settled law that the findings which are returned on the basis of the material in respect of which no opportunity of rebuttal, is given to the party, are vulnerable and are liable to be set aside [*Ref: Bright Enterprises Pvt. Ltd. & Anr. v. MJ Bizcraft LLP & Anr.:2017:DHC:67-DB. In Ssangyong Engineering and Construction Company Limited v. National Highways Authority of India (NHAI) : (2019) 15 SCC 131*], reliance placed on the government guidelines was faulted as the same was not put to a party. It was held that the same cannot be relied upon since party against whom the material is relied upon could have argued that such material is not correct or was open to some other interpretation.



32. Secondly, the learned Single Judge himself notes that for the purpose of DTH service, the broadcasting company provides the set that comprises a Dish and a receiving set. Therefore, it is not in dispute that for the purpose of DTH services, 'Dish' is a commonly used word for the Dish Antenna, which is an essential component for the purpose of receiving the services. Thus, it can be held to be descriptive of the DTH service. It is also not the respondent's case that the word 'Dish' forming part of the respondent's mark is not reflective of the Dish Antenna. In fact, the case as pleaded by the respondent is that it has a registration in its favour of the mark 'Dish TV', and as 'Dish' is the essential and dominant part of its mark, it is entitled to injunction restraining the appellant from using the word 'Dish' as part of its mark. The respondent has not pleaded that the word 'Dish' is not generic or common for the purposes of DTH services.

33. We also do not agree with the argument advanced by the learned counsel for the respondent that since the appellant has itself applied for the trademark registration for the mark 'DD Free Dish', it cannot be heard to say that the said mark is generic / *publici juris*. The judgments passed by this Court in the case of ***Procter & Gamble Manufacturing (Tianjin) Co. Ltd. & Ors. v. Anchor Health & Beauty Care Pvt. Ltd.***:2014:DHC:2936-DB, and ***Automatic Electric Limited v. R.K. Dhawan & Anr.***:1999 SCC OnLine Del 27, are of little assistance to the respondent.



34. It is pertinent to note that the appellant had not applied for the registration of the trademark 'Dish', and had instead applied for the registration of the mark 'DD Free Dish'. It is no one's case that common and generic words cannot be put together and applied for registration. The case of the appellant is that the respondent has a registration of the trademark 'Dish TV' and not on the standalone mark 'Dish'. The appellant has also pleaded that the respondent is entitled to protection of the mark taken as a whole, and not for the separate words forming the trademark. The appellant, in our opinion, is entitled to take the said objection that the word 'Dish' is generic since the claim in the suit is in relation to use of one part of the trademark and not the entire mark as a whole.

35. Similarly, the reliance of the respondent on the judgments in the case of *United Biotech Pvt. Ltd. v. Orchid Chemicals & Pharmaceuticals Ltd.*: 2012 SCC OnLine Del 2942, *Laxmikant V Patel v. Chetanbhai Shah & Anr.*: 2002 (3) SCC 65 and *Himalaya Drug Co. v. S.B.L. Limited* : 2010 SCC OnLine Del 2206 is of no help in the facts of the present case. There is no cavil to the principles laid down by the Hon'ble Courts in the said judgments. However, the Courts in those cases had concluded that the competing marks were deceptively similar, whereas in the present case, as discussed above, the marks in our opinion, are not similar.



36. We agree with the contention that the appellant has not disputed that the mark 'Dish TV' is a well-known mark. However, the dispute relates to not the adoption of the trademark owned by the appellant but the alleged use of one part of the trademark which, as discussed above, is a generic word and, *prima facie*, associated with the DTH services.

37. Even though the word 'Dish' appearing in the respondent's trademark is a prominent / essential feature of its trademark, but for the reasons mentioned above, the same is not entitled to any protection. The mark has to be looked at as a whole. If the argument advanced by the respondent is accepted, then it would also be entitled to an injunction when any party uses the word 'TV' in its trademark for the reason that the word 'TV' in the respondent's mark is also a prominent and essential feature of the mark. Obviously, this contention cannot be accepted.

38. It is not the respondent's case that the word DISH is a fanciful or a coined word, which evokes an impression that the services covered under the mark are associated with the respondent. It is a common English word which denotes Dish Antenna, as also noted by the learned Judge. The same in our opinion cannot be described as a prominent or an essential feature of such nature so as to allow the plaintiff a monopoly over its use.

39. The learned Single Judge also noted that the appellant had admitted that from the year 2004 till the year 2014 it was marketing the



same services under the name of 'DD Direct Plus'. It also noted that other services providers are also not using the word Dish for their DTH services and thus, the defence under Section 30 of the TM Act is not available to the appellant. We do not agree with the said view. Merely because the appellant was not using the word, which according to the respondent infringes its trademark, on an earlier occasion does not preclude the appellant from using the mark at a subsequent stage. The issue to be considered is whether the respondent is entitled for an order of injunction when one part of the respondent's trademark used by the appellant, as a part of its trademark for similar services. This question is to be decided within the parameters as discussed above.

40. The respondent has also not been able to point out any material, which would *prima facie* show that the use of the word 'Dish' by the appellant has led to any confusion in the mind of the consumers. As noted above, the existence of the word DD as part of the appellant's mark, which has been associated with the appellant for last many decades, is, *prima facie*, sufficient to put the consumers to notice of the distinctive origin of the appellant's services. *Prima facie*, we are unable to accept that there is any likelihood of any one being deceived or confused from the use of word 'Dish' by the appellant in its composite mark 'DD Free Dish'.

41. We are also conscious that the Appellate Court ought not to interfere with the *prima facie* view of the Trial Court unless it finds that



the Trial Court has exercised its jurisdiction arbitrarily, capriciously or in ignorance of the settled principles of law. (*Ref: Wander Ltd. And Anr. v Antox India P. Ltd: 1990 Supp. SCC 727*). However, we find that in the present case, the learned Single Judge has erred in holding that the competing marks are similar. First of all, the decision disregards the anti-dissection rule. The words 'DISH TV' form part of the registered mark and are used in conjunction. Their appearance in the label is to be considered together. The services provided by the respondent are associated with the label 'DISH TV'; not with the word DISH. The words 'DISH TV' may have acquired distinctiveness because of long use and can be said to have acquired the secondary meaning when used together. However, this does not entitle the respondent to any exclusive right in respect of the word 'DISH'. The said word is suggestive of the DTH services as it requires a Dish Antenna to receive the signals. Secondly, the learned Single Judge also disregards the principles of natural justice. The findings were based on the material in respect of which no opportunity of rebuttal was afforded to the appellant. The said findings are not based on the pleaded case of the parties.

42. In view of the above, impugned judgment is set aside.

43. We make it clear that the observations made in the present order are only *prima facie* for the purpose of deciding whether an interim injunction restraining the appellant ought to have been issued. Nothing



stated in this order shall preclude the parties from advancing their respective contentions. We clarify that the Trial Court shall adjudicate the suit uninfluenced by any observations made in this order.

AMIT MAHAJAN, J

VIBHU BAKHRU, J

MARCH 06, 2024
'SK'/UG