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## No justification for adoption leads to injunction against Indian Express clone

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The Bombay High Court has by its judgment dated 23<sup>rd</sup> October, 2015 upheld the right of Indian Express Newspaper Limited in the name/mark INDIAN EXPRESS and permanently restrained the Defendant, Chandra Prakash Shivhare (CPS) from using the mark Indian Express in relation to publishing newspaper in Devanagiri (local language). India Express Limited (IEL) had filed the suit against CPS alleging that it's use of the mark INDIAN EXPRESS amounts to trademark infringement and passing off. An interim injunction was granted in favour of IEL and the case has matured for final decision.

### **Indian Express in support of its case contends:**

- i. The Plaintiffs belong to the well known Indian Express group of companies. IEL publish newspapers and magazines in English and many other regional languages and the Indian Express newspaper has been in publication since 1932.
- ii. They are the registered proprietor of the mark INDIAN EXPRESS in Class 16 and have also registered the title "The Indian Express" with the Registrar of Newspapers for India ("RNI"), a statutory body under the Press and Registrations of Books Act, 1867 ("the PRB Act"). RNI registration is necessary for publication of a newspaper.
- iii. In May 2009, IEL came to know that CPS had approached the RNI and attempted to register "Indian Express" under the PRB Act claiming to be using the word "Indian Express" in "Devanagari" (local Indian language) to which IEL objected and wrote to the RNI, asserting its rights in the mark INDIAN EXPRESS.
- iv. CPS filed application for rectification of IEL's mark INDIAN EXPRESS and also filed application for registration of the same before the Trademark Registry. IEL filed contempt action against CPS for violation of the court's interim injunction order and the contempt petition was disposed of by the court on the basis of the undertaking given by CPS. CPS also withdrew its cancellation petition against INDIA EXPRESS mark.

### **CPS in the reply/written statement put forth the following contentions:**

- a) He obtained title registration for "Indian Express" in Devnagari under the Press Act long before IEL obtained trade mark registration in Devnagari.
- b) He uses the words "Indian Express" written in Devnagari only as a title of his publication and the said use is legitimate and permissible under the provisions of the PRB Act.
- c) CPS is well within his rights to use the mark Indian Express in Monera (a small town) in Madhya Pradesh where he carries on his business and the same will not amount to infringement of IEL's rights.

### **IEL filed documents to substantiate:**

- The mark "Indian Express" is registered as a word mark in Class 16 since June 23, 1994, with a user date of January 1, 1953, and as a label mark since October 7, 2004, with a user date of December 31, 1932, respectively.
- Indian Express is registered in Devnagari in classes 16, 35 and 42 since May 26, 2009, which is prior of CPS's first use of the mark, i.e., June 21, 2010.
- At the time of hearing CPS relied on case laws and focused his arguments on the following:
  - The provisions of the Press Act and the Trade Marks Act, 1999 must be construed 'harmoniously' and where there is valid and subsisting registration with the RNI under the PRB Act for a publication title, such use can never constitute infringement of a mark registered under the Trade Marks Act, 1999.
- IEL's newspaper is not published in the area where CPS is operating and they are using the expression INDIAN EXPRESS in Devanagari in which IEL did not have a subsisting RNI title registration.

### **Court Decision**

After considering the submissions, pleadings and case laws relied on by the parties the court made the following observations:

The preamble of the PRB Act and Trademarks Act, 1999, differ and operate differently. Moreover, to assess whether there is infringement of a trademark, one has to rely on the provisions of the Trademarks Act and not PRB Act. The instant case is also factually different from the case laws relied on by CPS. In the present case IEL has prior trademark registrations in the relevant class and it is not disputed that CPS is using an identical mark in relation to newspapers. CPS has also not provided any justification for adoption of an identical mark. IEL's long and widespread use, online presence, multiple editions, large circulation, etc, entitles it to seek protection as a well known mark.

In light of the above the court passed a final decree in favour of IEL, permanently retrained CPS from using the mark/title INDIAN EXPRESS in relation to its business.

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