



# HOIST BY ITS OWN PETARD

Can an applicant be stopped from taking a contrary stand to the submissions made by him at the time of prosecution of a trademark? Lucy Rana reports.

**A** decision from the Delhi High Court in February 2014 highlights the importance of submissions in response to an examination report before the trademarks registry.

The publisher of weekly magazine *India Today* filed an application for an interim injunction at the Delhi High Court to restrain Alpha Dealcom from launching a news channel with the name 'Nation Today'. *India Today's* publisher argued that the use of the word 'today' infringed its trademark incorporating the same name. The Delhi High Court held that, *prima facie*, there was no infringement because the use of the word 'today' by the two parties was not likely to cause confusion in the minds of consumers.

Alpha Dealcom had applied for the trademark 'Nation Today' in June 2012. In October of the same year, *India Today's* publisher sued for trademark infringement under Section 29 of the Trade Marks Act.

## The plaintiff's arguments

India Today argued that since it owns trademarks for several publications and news channels using variants containing the word 'today', the term has acquired the status of a well-known trademark.

Further, it argued that the term 'today' has become synonymous with the plaintiff's goods and services, thereby acquiring a secondary meaning. It added that the trademark registered by Alpha Dealcom is deceptively similar to its own.

## The defendant's arguments

Alpha Dealcom said that India Today had, at the time of its reply to the examination report for the 'India Today' trademark, argued that 'India Today' was dissimilar to the pre-existing trademark for 'Punjab Today'. By

"THE PLAINTIFF HAD, WHILE REPLYING TO THE EXAMINATION REPORT ISSUED BY THE TRADEMARK REGISTRY IN RESPECT OF THE MARK 'INDIA TODAY'."

this, the defendants argued, India Today had conceded that merely using the term 'today' will not cause confusion or cause the competing mark to be similar to its own.

Additionally, Alpha Dealcom said 'today' is a common English word that can be freely used by third parties and that the plaintiffs can't monopolise such a common word merely by registering a large number of trademarks. The defendant emphasised that such a monopoly would be detrimental to the news business, as 'today' was descriptive to the news business itself.

Finally, Alpha Dealcom argued that India Today's trademarks were combination marks, thereby not conferring exclusive rights over the term 'today'.

### Observations

In the present case, the plaintiff had, while replying to the examination report issued by the trademark registry in respect of the mark 'India Today', stated that the conflicting mark 'Punjab Today' is visually, structurally and phonetically dissimilar to the mark 'India Today'. The question that arises is: does the explanation given by the plaintiff at the time of prosecution of its trademark amount to an admission that the mere use of the word 'today' does not make the competing mark similar to its mark?

Further, during the prosecution of the mark, the plaintiff had made voluntary submissions before the deputy registrar stating that it may be granted Part B registration and agreed to

disclaim 'India' and 'today' separately. However the final registration for the mark disclaimed only 'India'. The pertinent issue is whether this amounts to an admission of the generic and descriptive nature of the words 'India' and 'today' by the plaintiff.

The court held that the plaintiff is stopped by its own submissions and that, even if the mark 'Punjab Today' has no similarity with the mark 'India Today', at this interlocutory stage it cannot be permitted to contend that there is a similarity between 'India Today' and 'Nation Today'.

### Abandonment of the trademark?

Does non-prosecution or ignorance of repeated infringement amount to abandonment of the trademark?

It was submitted by the defendant that there are numerous third parties, apart from themselves, who have adopted and are using the word 'today' in relation to TV news channels, and that the plaintiff did not raise objection to those users.

The plaintiff submitted that since there is no evidence brought on record by the defendant regarding the extent of the use of the word 'today' by those third parties and the plaintiff having not felt seriously affected by those users, it cannot be said that the failure of the plaintiff to take action against every one of those infringers entitles the defendant to infringe the plaintiff's well known and household name for news. The plaintiff relied upon a division bench judgment of this court in Pankaj Goel v Dabur India Ltd, in support of the submission that non-initiation of legal proceedings against third-party users is of no consequence in the present case.

However the court took a contrary view and held that the plaintiff's above submission has no merit since in the replication the plaintiff did not claim that it had not initiated any action against infringements by third parties. This was because the use of the word 'today' was not substantial enough to have any impact on the plaintiff's business.

The court went on also to cite the Supreme Court decision in National Bell Co v Gupta Goods Mfg Co (P) Ltd & Anr, to opine that the fact that there were several other trademarks held by third parties containing

the word 'today' which the plaintiff has chosen to ignore could amount to abandonment of trademark.

### Court decision

The court decided in favour of the defendant, noting that the plaintiff's admission earlier that 'Punjab Today' was dissimilar to 'India Today' worked against it. It was held that there was no prima facie likelihood of confusion. The application for temporary injunction was dismissed.

This is a welcome decision, as conferring monopoly over generic terms such as 'today', which is so intricately tied to the news industry, would grant the trademark holder an unfair competitive advantage and the same would be antithetical to the objectives of trademark law.

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Lucy Rana advises Fortune 500 companies and some of the world's most esteemed corporations in multifarious fields and has actively contributed to growth in every sphere of the firm, from prosecution to successful litigation. Rana, who majored in Japanese language and business management, has channelled her innovative and pioneering strategies for delivering efficient, high quality and cost effective results to clients.