



IN THE HIGH COURT OF JUDICATURE AT BOMBAY  
ORDINARY ORIGINAL CIVIL JURISDICTION

COMMERCIAL APPEAL (L) NO.41053 of 2025  
WITH  
INTERIM APPLICATION (L) NO.41851 OF 2025

**Express Publications (Madurai) Pvt. Ltd.** )  
a company incorporated under the )  
provisions of the Companies Act, 1956 and )  
having its registered office at No.29, Second )  
Main Road, Ambattur Industrial Estate )  
Chennai ) ..Appellant

**Versus**

**The Indian Express (P) Ltd.** )  
A company incorporated under the provisions )  
of The Companies Act, 1956 and having its )  
Registered office at 7<sup>th</sup> Floor, Mafatlal Centre, )  
Ramnath Goenka Marg, Nariman Point, )  
Mumbai - 400 021 ) .. Respondent

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Mr. Zal Andhyarujina, Senior Advocate with Ms.Revati Desai,  
Mr.Pratyush Gupta and Mr.Deepak Y. Chitnis i/b Deepak  
Chitnis-Chiparikar & Co. for the Appellant.

Mr. Darius Khambata, Senior Advocate with Mr.Arun Mohan,  
Dr.Abhinav Chandrachud, Mr.Pranit Kulkarni, Ms.Nishita  
Gupta and Ms.Tejasvi Ghag i/b Ms.Poorvi Kamani for the  
Respondent.

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**CORAM : BHARATI DANGRE &  
MANJUSHA DESHPANDE, JJ.**

**RESERVED ON : 17<sup>th</sup> APRIL, 2026  
PRONOUNCED ON : 15<sup>th</sup> JUNE, 2026**

**JUDGMENT (Per Bharati Dangre, J.)**

1. This commercial appeal is filed by the appellant, Express Publications (Madurai) Private Limited, being aggrieved by

the order passed by the learned Single Judge (Justice R. I. Chagla) dated 13.11.2025, thereby allowing the interim application filed by the plaintiff, Indian Express (P) Limited, seeking injunction against the defendant for acting in breach of the terms and conditions of the Memorandum of Settlement (MOS) dated 05.02.1995, recorded in the form of decree dated 16.04.1997 in Civil Suit Nos. 1246 and 1247 of 1992 by the Madras High Court as well as supplemental agreement executed between the parties.

The discord between the parties stem out of the MOS dated 05.02.1995 as well as the supplemental agreement dated 12.08.2005, entered between the plaintiff and the defendant, which received approval from the Madras High Court.

As per the plaintiff, the MOS conferred permitted user on the defendant, being a derivative of Indian Express; whereas, the defendant claimed its proprietary right over the mark and has adopted a stand that the settlement between the parties nowhere restrained it from promoting its publication outside the Five States referred to in the MOS.

Thus, the bone of contentions between the parties is the interpretation of MOS and the supplemental agreement and in the civil suit instituted by the plaintiff, it claimed right based upon the MOS and the defense adopted by the defendant also arose on account of the interpretation of the MOS. Ultimately the learned Single Judge in the impugned order, has agreed with the plaintiff in construing the permitted user of the defendant, by accepting that it was so conferred in the form of derivative of the Indian Express.

2. We have heard the learned Senior Counsel Mr. Zal Andhyarujina for the appellant (original defendant in the suit); whereas, the respondent before us (the original plaintiff in the suit), is represented by the learned Senior Counsel Mr. Darius Khambata.

In order to appreciate the findings rendered by the learned Single Judge in the impugned order dated 13.11.2025, we must briefly refer to the background facts in which the said finding is rendered.

3. Indian Express (P) Ltd. instituted a suit for infringement of trade mark and passing off claiming that it is a Company incorporated under the provision of the Companies Act, 1956 (now Companies Act, 2013) and was formerly known as Indian Express Ltd.. Indian Express Newspaper (Bombay) Ltd and now 'Indian Express Newspaper (Mumbai) Private Ltd, claimed to be the proprietors, publishers of multi-editions of newspapers including its flagship newspaper "The Indian Express". In the year 2008 a scheme of arrangement was filed under the Companies Act, 1956 before the High Court which was sanctioned by order dated 25.07.2008, by which the "Print Media Undertaking" of Indian Express Newspaper (Mumbai) Ltd. was demerged and transferred to and vested in the Indian Express Ltd. i.e. the plaintiff, the effective date of transfer being 05.01.2009.

On 05.01.2009 the Indian Express Newspapers (Mumbai) Ltd. entered into a Deed of Assignment of Trade Marks and its goodwill with the plaintiff, as a consequence all trademarks, patents and domain names, copyrights, trade secrets, industrial designs, product registrations and other

intellectual property along with the goodwill stood transferred to and vested in the plaintiff and this covered 62 trademarks.

Apart from this, in the year 2009 the plaintiff filed an application under the Trade Marks Act, 1999, claiming prestige and goodwill amongst its readers and the public in general in India and abroad. As per the plaintiff, "The Indian Express" has been on the forefront of press freedom in the country and under the able leadership of Shri Ramnath Goenka, and series of eminent editors, outstanding journalists, it furthered the cause of freedom.

4. After the death of Shri Ramnath Goenka on 05.10.1991 in the wake of the discord between his heirs including his grandson, Shri Manojkumar Sonthalia, and the adopted son of Shri Ramnath Goenka, Shri Vivek Goenka, various proceedings were instituted. Amidst its pendency, *quietus* was brought out through a settlement drawn in the civil suit which was pending before the Madras High Court, the suit being instituted by Manojkumar Sonthalia in the capacity as plaintiff with the impleadment of Indian Express Newspapers (Bombay) Ltd. as well as "Indian Express (Madurai) Ltd." and Shri Vivek Goenka as defendants along with other individuals being impleaded in their individual capacity. The settlement was arrived between the two main contenders, viz. Shri Vivek Goenka, who was subsequently adopted as a son, by Late Shri Ramnath Goenka and the other contender being Shri Manojkumar Sonthalia. The settlement reached also involved the equity shares and preference shares as it was agreed by way of settlement that Manojkumar Sonthalia shall pay to the estate of Late Shri Ramnath Goenka the balance consideration

owned by him originally for the purchase of shares from Shri Ramnath Goenka as reduced by any amount owing from his estate on the demise of Shri Ramnath Goenka. As an understanding reached, 9280 equity shares and 4000 preference shares were agreed to be transferred to Vivek Goenka from Manojkumar Sonthalia and on Vivek Goenka paying to Manojkumar Sonthalia the latter's cost of the shares, equivalent to the consideration paid to the original transfers of the shares from Shri Ramnath Goenka. Some other understanding was also reached between the contenders about the issuance of share certificates, but since we are not concerned with the same, we need not delve deep in this regard.

5. The present dispute, as unfurled before us, revolve around Clause 17 onwards, in the MOS, as regards the rights conferred on the respective parties and claimed by them. The plaintiff staked its claim in the suit that it is absolute owner of the registered title and the Indian Express (Madurai), APL, NSL shall not at any time directly or indirectly use or adopt any of the said titles, in any way whatsoever or any title similar to or resembling thereto, save and except that was permitted in Clause 19.

The plaintiff also claimed that such rights of ownership is unlimited in point of time and Clause 18 permitted "The Indian Express (Madurai) Limited" to restrict its activity in five States and the specified Union Territories, as set out in Clause 18. But, in addition, it also included various other restrictions stipulated therein.

6. Based on the consensus expressed in the settlement terms which were accepted by the Madras High Court, the plaintiffs claimed its ownership over the “Indian Express” and adopted a specific stand that it permitted the defendant to have restricted user by permitting it to publish any newspaper or periodical in any Indian language in the five southern States and Union Territories and it also granted permission to publish an English language daily by using the name “New Indian Express”.

The aforesaid agreement was followed by execution of supplementary agreement entered between the parties and even it received approval from the Madras High Court, by accepting the terms therein.

However, the Indian Express (Pvt.) Limited was aggrieved by the action of the defendant, allegedly in contravention of the MOS and the supplemental agreement, as it accused that though the parties had perfectly understood the terms of settlement but when the defendant attempted to promote its newspaper “The New Indian Express” by conducting an event in Mumbai, styled as “The New Indian Express - Mumbai Dialogue” on 20.09.2024 in the presence of the Hon’ble the Deputy Chief Minister of the State along with other dignitaries, the plaintiff perceived it as breach of the MOS and supplemental agreement as, according to it, the defendant was permitted to use the title “New Indian Express” in a restrictive manner i.e. only in specified five States, viz. Karnataka, Kerala, Andhra Pradesh, Tamil Nadu and Orissa and specified Union Territories, Pondicherry, Andaman and Nicobar Islands and Lakshadweep and the defendant had clearly acknowledged its usage. According to the plaintiff it

violated the MOS and this violation was specifically urged in the wake of geographical limitation imposed upon the defendant as per the terms of the MOS and supplemental agreement and it was alleged to be in breach of Clauses 17, 18, 19 and 20 of the MOS and the essence of both, the MOS and the supplemental agreement. According to the plaintiff, the defendant was not permitted to conduct “services” such as “Events” and in fact, it was subjected to omnibus restriction that it shall not use the terms “The New Indian Express for no other purpose or any other area or any use whatsoever”

This constrained the plaintiff to approach the Court by filing a Civil Suit, since the posters released by the defendant on social media to promote the event, ‘Mumbai Dialogues’ by the use of title “New Indian Express”, were displayed in such a manner that the expression “new” is not legible to the naked eyes and the average consumer or reader who would peruse the same, would be confused and there is a likelihood of being deceived to believe that it is the plaintiff, who is hosting the event “Mumbai Dialogue”.

Pleading that the plaintiff had already parted a hefty sum as consideration for the forbearance to restrain an obligation accepted by the defendant in respect of most parts of India except the specified Five States and Union Territories and on accepting the consideration, it was bound by the restrictions imposed on it in the proceedings and therefore, the defendant was sought to be restrained from promoting any such event, which would have an impact on the plaintiff’s interest and the plaintiff sought permanent order of injunction restraining the defendant from violating or acting contrary to the terms and conditions of the MOS dated 05.02.1995

converted into a decree on 16.04.1997 by the Madras High Court and the supplemental agreement dated 12.08.2005 executed between the plaintiff and the defendant.

7. In the pending suit an interim application is filed, which has been adjudicated by the learned Single Judge and the said application prayed for the following reliefs:

*a. Pending the hearing and final disposal of the suit, the Defendant, its agents, employees, representatives, or any other persons acting on its behalf, be restrained by an order and injunction of this Hon'ble Court from breaching, violating, or acting contrary to the terms and conditions of the Memorandum of Settlement dated 05.02.1995 recorded as a decree on 16.04.1997 in C.S.No.1246 and 1247 of 1992 by the Hon'ble Madras High Court and the Supplemental Agreement dated 12.08.2005 executed between the Plaintiff and the Defendant;*

*b. Pending the hearing and final disposal of the suit, the Defendant, its agents, employees, representatives, or any other persons acting on its behalf to be directed by an order of this Hon'ble Court to comply with its obligations under the Memorandum of Settlement dated 05.02.1995 recorded as a decree on 16.04.1997 in C.S.No.1246 and 1247 of 1992 by the Hon'ble Madras High Court and the Supplemental Agreement dated 12.08.2005 executed between the Plaintiff and the Defendant;*

*c. Pending the hearing and final disposal of the suit, the Defendant by themselves, their directors, legal representatives, successors in business, assigns, servants, agents, transporters, distributors, printers, stockists, wholesalers, dealers, retailers, advertisers or any one claiming through or under them be restrained by an order and injunction of this Hon'ble Court from infringing upon the Plaintiffs registered trademarks by operating, advertising, or conducting any event, program or business using the Plaintiff's registered trademarks or the permitted title "The New Indian Express" outside the specified states of Kamataka, Kerala, Tamil Nadu, Andhra Pradesh, and Orissa and the Union territories of Pondicherry, Enam, Andaman Nicobar Islands and Lakshadweep islands as specified under the Memorandum of Settlement dated 05.02.1995 recorded as a decree on 16.04.1997 in C.S.No.1246 and 1247 of 1992 by the Hon'ble Madras High Court and the Supplemental Agreement dated 12.08.2005 executed between the Plaintiff and the Defendant;*

8. The learned Senior Counsel, Mr. Andhyarujina, by tracing the history of the dispute, resulting into execution of the MOS and the order of the Madras High Court dated 16.04.1997 would submit that on 18.04.1997, a Joint Advertisement Agreement (hereinafter referred to as 'JAA') was executed between the parties for the purpose of sharing all the revenue generated from All India Advertisements. Based on the said agreement, he would submit that the Indian Express (Pvt.) Limited continued to publish advertisements in the appellant's publication i.e. Express Publications (Madurai) Private Limited by clear use of the words, "Indian Express" with the heading "New Indian Express" in circulation in southern States and Union Territories and vice versa. It is his specific contention that this continued to be an ongoing arrangement between the parties as both issued advertisements in each other's newspapers/publications.

Mr. Andhyarujina has placed on record the Minutes of Meeting, held on 18.04.1997 which resulted into execution of JAA with the specific understanding arrived between the parties and this arrangement between the parties, according to him, proceeded on barter, with publication media sponsored ads of publications other than Indian Express which, being referred to as home ads and the rate was fixed as 25% card rate; whereas ads on barter other than the media, fetched rate of 50%. In addition, the arrangement also comprised of factors like bulk incentives.

The understanding involved an all India billing and also set out the manner of sharing of the all India billing by clearly stipulating that two companies shall raise consolidated credit note in favour of each other for share of revenue due to other

company and the amount will be settled by payment not later than 15<sup>th</sup> day of the following month with a specific clause of levy of service charge of 12% by each company on the gross of India billing, which would cover the credit period, bad debts and administrative expenses. The understanding reached between the parties, according to Mr. Andhyarjuna clearly recorded that All India Ads rates will be revised by mutual consultation and deviation to the arrangement shall also be mutual and in the event of any difficulty in implementing the terms, the same was to be referred to Shri Vivek Goenka and Shri Manojkumar Sonthalia and their joint decision was agreed to be final.

This agreement of 18.04.1997, received a further extension on 20.03.2000 by clearly stipulating that there shall be no change in existing system of sharing between all India revenue between the two companies and this was signed by Vivek Goenka on behalf of Indian Express Newspaper (Bombay) Limited and Manojkumar Sonthalia, on behalf of Express Publications (Madurai) Limited. A further deed of agreement was entered into between the parties on 12.08.2005 with reference to the agreement of 18.04.1997, as partially modified in the year 2000 and 2003 but a fresh agreement was necessitated considering the changes in the market, banking norms, etc. as well as the future trends. This agreement having taken effect from 01.04.2005 was agreed to remain in force until modified.

9. An assertive submission of the appellant is that on 24.09.2005 it obtained a trademark registration for the label "New India Express", though it is conceded that, pursuant to

the rectification proceedings filed by the respondent before the Intellectual Property Appellate Board (“IPAB”) the use of the said trademark was limited to the specified southern States and Union Territories.

Mr. Andhyarujina has placed on record documents in the form of instances to establish that his client had published its advertisement by use of expression “New India Express” in the respondent newspaper (Indian Express having nation wide circulation). Since this advertisement was published along with its logo, it is contended by the learned Senior Counsel by permitting publication of such advertisement the respondent has acted in furtherance of the MOS by rightly interpreting its terms.

Without prejudice to the aforesaid submissions, the learned Senior Counsel would submit that since this arrangement continued for considerable length of time, the respondent has acquiesced to the use of the expression “New India Express” outside the specified southern States and the Union Territories. According to him, this acquiescence was also taken note by the Delhi High Court in the suit filed by the respondent, but it is his specific contention that for the first time in the suit filed before the Bombay High Court, an objection is being raised about the advertisements for promoting the publications outside the five States.

10. The moot question which falls for consideration according to Mr. Andhyarujina is whether or not the appellant is entitled to hold events of ‘Promotion’ in the Territories outside the five States and the Union Territories demarcating its area of operation. According to him, Clause 20 of the MOS

clearly contemplate a non-compete arrangement as the Indian Express (Madurai) Limited agreed that it shall not start any English language newspaper in any State of India other than the specified five States and specified Union Territories in Clause 18 for a period of 36 months from the date of the agreement and that after expiry of this period, if the Indian Express (Madurai) Limited, start an English language newspaper in any State of India other than the excluded Territories, it was subjected to further condition that it shall not bear the name of “New Indian Express” or “Indian Express” or any name including the word “Indian” or “Express” or its derivatives and in no way it shall start any Indian language newspaper which is in conflict or competition with the language newspaper owned by Vivek Goenka, and Indian Express Newspaper (Bombay) Limited in their territories, but this prohibition was not made applicable to periodicals, (magazines, weeklies, etc.).

According to Mr.Andhyarujina, in consideration of the said restraint against competition, Clause 22 of the MOS, Indian Express (Madurai) Limited was paid non-competing and forbearance capital fee amounting to Rs.Fifty Six Crores, with the bifurcation set out therein. According to Mr.Andhyarujina, this Clause has been interpreted by the learned Single Judge as ‘License’ and he would submit that if it was license granted in favour of his client, the license fee would have been due and payable by the licensee, and not to the contrary.

11. Apart from this, according to the learned counsel, a reciprocal obligation is imposed in Clause 21 upon Vivek

Goenka, Indian Express Newspaper (Bombay) Limited, i.e. the plaintiff that, they shall not start any English language newspaper in any of the five States and the specified Union Territories as contemplated in Clause 18 for a period of 36 months and if they start any English language newspaper thereafter, it shall not bear the name of “Indian Express” or any name including ‘Indian’ or ‘Express’ or its derivatives, but this limitation was not applicable to the Daily. Another reciprocal obligation included in the same Clause, imposed a restriction that they shall not start any Indian language newspaper which in any way is in conflict with the newspaper owned by Manojkumar Sonthalia, Indian Express (Madurai) Limited /Andhra Prabha Limited in five States, though this prohibition was not made applicable to the periodical, (magazines, weekly). According to Mr. Andhyarujina, none of the clauses has used the word ‘license’, but reading of Clauses 17 to 22, concertedly would only indicate that it amount to a “non-compete” arrangement without there being any reference to a license fee being payable.

In the supplementary agreement executed between the plaintiff- Indian Express Group (“**IEG**”) and the defendant-New Indian Express Group (“**NIEG**”), he would submit that there is a relaxation in the non-compete clause as it is agreed that notwithstanding anything to the contrary contained in Clause 19(v) of the MOS dated 05.02.1995, NIEG shall be at liberty to take such action as it deem necessary against any infringement by any one of its title (New Indian Express) in the five southern States and specified Territories without calling upon the Indian Express Group to take action. In paragraph 7, the dilution is further made to the effect

notwithstanding any prohibition contained in Clauses 18(iv) and 19 (iv) of the MOS, the NIEG shall be at liberty to publish any newspaper or periodical in any Indian language in five southern States and specified Union Territories using the word 'Express' without association with the word 'Indian' or any derivative of the word 'Indian' in the title of the publication, provided however that NIEG shall only use the word 'Express' to publish a newspaper or periodical in any Indian language which is not in any manner whatsoever in competition with the existing publication of Indian Express.

Not only this, as regards the right to use the title 'New Indian Express' for Television or Radio, the supplemental agreement recorded a consensus that notwithstanding a prohibition contained in Clause 18(iv) of the MOS, NIEG shall be at liberty to use its title "New Indian Express" or any of its derivatives/abbreviations on the internet for dissemination of news. Clause 9 contained a further dilution of the MOS, when it was agreed that the restrictions imposed under the MOS, on the condition that the expression 'new' shall be in the same line and of the same size as the word "Indian Express" wherever the title appeared shall be dropped and NIEG shall be entitled to use the expression 'New' along with the expression "Indian Express" in the manner they deem fit subject to the condition that the word 'New' shall be legible to the naked eyes.

Thus, according to Mr.Andhyarujina, the supplemental agreement diluted the restrictions imposed but neither the MOS nor the supplemental agreement are indicative that NIEG shall act as permissible user or licensee. According to him, the appellant registered its mark as a label and it published

advertisements by use of the label mark “New Indian Express” in the respondent’s newspaper “Indian Express” for a considerable length of time and along with the appeal memo, the appellant has annexed the copies of the relevant pages of Indian Express, Loksatta, Financial Express dated 15.07.2005 all reflecting the advertisement of the defendant newspaper and invoices dated 15.07.2005 raised by the plaintiff in respect thereof.

This being permitted to be done, according to Mr. Andhyarujina would amount to acquiescence by the Indian Express Group. He would submit in the wake of JAA entered in the year 1997 and subsequently being renewed and even a fresh agreement being executed, this arrangement continued till 21.07.2010 when this agreement was terminated but there is no challenge to the same.

12. Mr.Andhyarujina, has placed before us a compilation of documents to establish his plea of acquiescence by the plaintiff and this includes advertisement in regards to the events held in various cities like, Mumbai, Delhi, Lucknow, Kolkata and it being published in various publications of the respondent including Delhi (Sunday Standard), Bangalore N.I., Chennai N. I., Delhi (Morning Standard), Delhi (Sunday Standard) etc.. The events include the ‘Devi Awards’ held in different Cities like Delhi, Lucknow, Indore right from 2014 upto 2020. Thus, permitting such publications according to Mr. Andhyarujina, is clear cut proof of acquiescence by the plaintiff. Apart from above, he would submit that at PAN India level it was also advertised on YouTube and it is his specific contention that whenever such an advertisement appeared in the newspaper

complimentary copies were forwarded to the plaintiff and this he has specifically contended in the affidavit placed on record.

13. In addition to the aforesaid, Mr. Andhyarujina has invited our attention to the order passed by the learned Single Judge, on the notice of motion filed in Suit No.2502 of 2010 instituted by “Indian Express Limited”, seeking restraint against the defendants, Express Publications (Madurai) Limited from using in relation to any newspaper, magazines, printed matter, publications, media publication and journals of all goods covered by the registered trademark “i.e.” either by itself or as a part of any word or exhibiting or displaying or its used in any website or any other deceptively similar mark so as to infringe its registered trademark.

By inviting our attention to a detailed order passed by the learned Single Judge, he would submit that the relief is refused in favour of the plaintiff by recording that the plaintiff ought to have brought on record cogent and reliable material to establish the infringement and the plaintiff has not disclosed the usage by the defendant for considerable length of time. Recording that the plaintiff who has asserted his right in a registered trademark has gone beyond silence and his conduct is consistent with the claim of exclusive right in a trademark and by applying the said principle, it is concluded by the learned Single Judge that it is not a case where the plaintiffs have discovered that rival newspaper in the industry have come forward and suddenly started using the words, mark or logo allegedly, but it is a case where the plaintiffs themselves described the publications from southern India as publication by group within business house of Goenka’s and

therefore, are held to be not entitled for injunction. According to Mr.Andhyarujina the learned Single Judge has also pronounced upon the aspect of acquiescence. He would categorically submit that the order makes a reference to the Joint Advertisement Agreement (“**JAA**”) executed before the parties and even the learned Single Judge also had before him the decree of 16.04.1997 passed on the compromise/settlement arrived at and by considering the whole background, the injunction was refused.

14. In addition to the above, Mr.Andhyarujina also make a reference to the order passed by the Delhi High Court when the plaintiff, Indian Express Limited had approached the Court by filing a suit seeking injunction restraining the defendant from using the word “Indian Express”, “New Indian Express”, ‘Indian’ , ‘Express’ or any associated aglet or cognate or abbreviated terms or any logos covered by the plaintiff registered trademark “Indian Express” or “Express News Service” or “New Indian Express Group”.

The suit having been contested by the defendant before the High Court by raising preliminary objection about its maintainability by contending that it was an attempt to execute the compromise decree passed by the Madras High Court and no injunction would be granted as the defendant was registered owner of the trademark “New India Express”. A specific plea was also adopted to the effect that the plaintiff has acquiesced in the use of the logo as well as expression “New India Express” and failed to disclose the words “New India Express” has been used only as a logo in the advertisement published in the “Sunday Standard”. A specific

stand was adopted that in the advertisement along with the logo of “New India Express” were regularly published in the newspaper of the plaintiff and the plaintiff also published the supplemental title “Express International Aro India”, “New India Express” Bangalore and “Financial Express” on the front page and this clearly amounted to acquiescence.

By relying upon the said order, it is contended by Mr. Andhyarujina that the Court considered the case of the plaintiff based on the infringement of its trademark and passing off and the breach the contractual obligations including compromise decree passed by the Madras High Court. Noting that no infringement of the trademark of Indian Express is made out on account of the use of the trademark “New Indian Express”, it was specifically noted by the Delhi High Court that the expression “New India Express Group” is not altogether prohibited to be used by the defendant under the arrangement between the parties. Rather, the supplemental agreement dated 12.08.2005 permitted the use of the expression of “New Indian Express” or any of its derivatives/abbreviations on the internet. It also specifically recorded that the defendants were also permitted under the first agreement itself to publish an English daily newspaper in five southern States and the Union Territories specified in the agreement and they were permitted to use the expression “New Indian Express” for that purpose but with an embargo that the words ‘Indian’ or ‘Express’ or the derivatives outside the Southern Territories and the Union Territories was prohibited.

Recording that there was no case is made out for grant of any relief, the same is refused and Mr. Andhyarujina would

rely upon the observations of the Delhi High Court but submit that the suit came to be abandoned by the plaintiff and was dismissed for want of prosecution on 06.05.2015. He would submit that suit sought almost identical reliefs as are sought in the suit filed in Bombay. Since it is held by the Delhi High Court that no case for infringement or passing off is made out, he would submit that the plaintiff is not entitled for any relief but the learned Single Judge has indulged it for non-existent reasons and therefore at the appellate stage this Court shall interfere.

15. Mr. Andhyarujina would also invite our attention to the order passed by the Intellectual Property Appellate Board (IPAB) and he would concede to the fact that the said order restricted the impugned mark “New Indian Express” only to the five States and the Union Territories. But, this order according to Mr. Andhyarujina is not determinative of the question that falls for consideration before this Court being whether the appellant is entitled to advertise its business outside the said Territories.

16. Focusing his attention on the impugned order dated 13.11.2025, it is the contention advanced that the learned Single Judge has failed to take into consideration the most important aspect being of the registration in favour of the appellant for its mark. Inviting our attention to paragraph 86 of the impugned judgment, he would submit that the learned Single Judge by referring to the IPAB order dated 18.06.2015 has construed that the order has also imposed restriction upon promotion and advertisement and, according to him, the order

has been construed as blanket ban from usage of its mark but according to him this finding is erroneous as IPAB itself had granted liberty to approach the Delhi High Court by instituting a suit. In addition, Mr. Andhyarujina is also extremely and critical of the observation of the learned Single Judge in para 92 when it is held that the expression “New Indian Express”/”The New Indian Express” is only derivative of the mark “Indian Express” by adding “New” as the plaintiff is the absolute proprietor of the mark “Indian Express”. According to him, there is no concept of Territory in trademark and as long as the appellant’s registration is intact, there is no question of it being accused of using the mark as derivative. According to him, the learned Single Judge has not at all considered the gist of the submissions advanced in opposing the interim relief.

In short, it is the contention advanced by Mr. Andhyarujina that the impugned order suffers from gross perversity as the learned Single Judge has failed to take into consideration that the respondent had never taken any step to register the trademark “New Indian Express” as an associate trademark under Section 16 of the Trade Marks Act, 1999. Apart from this, he would submit that there is no concept of derivative trademark under the Trade Marks Act, 1999 and as the appellant has been registered as registered proprietor of the trademark “New Indian Express” since 17.01.2005 under Section 28 of the Trade Marks Act, the case of the respondent that the appellant is not the proprietor ought to have been rejected. He would specifically submit that he is not the permitted user as is held by the learned Single Judge, as on account of registration, the appellant has acquired certain

rights and though IPAB order has restricted its operation to five States and specified Union Territories that do not wipe away its case that it is a registered proprietor of the mark “New Indian Express”. He would submit that if the appellant was permitted user or licensee of the respondent then it would have been registered as a registered user in respect of the trademark “Indian Express” and/or “New Indian Express” instead of registered proprietor of the trademark “New Indian Express”.

According to the learned Senior Counsel, if the usage by the appellant was to be construed as a ‘License’, then there would have to be a connection maintained between the appellant’s newspaper and the trademark Indian Express, which was rather contrary to the result of separation which was sought to be achieved by the MOS.

17. By inviting our attention to the salient features of the MOS, it is also contended by the learned Senior Counsel that the fact that the MOS/consent decree makes no statement with regard to respondent’s ownership of the expression “The New Indian Express” makes it clear that the appellant’s proprietary trademark was recognized under the MOS as well as the supplemental MOS. He would submit that in fact the word “Indian Express and its derivatives” have been used in contradistinction to “New Indian Express” and this term has not been used, so as to be included in the sweep of the expression “its derivative”. In any case it is the submission advanced that MOS and consent decree are to be understood to be overall of settlement of the dispute in the suit that was filed before the Madras High Court by dividing the business on

terms as set out therein and the consent decree refers to a 'corporate cum family settlement' between the parties and it is unconceivable that the appellant would agree for deviation of the business of publication of newspaper based on a mere permissive license. Apart from this, he would submit that parties conduct bear relevance and as per their understanding that New Indian Express belongs to the appellant, the appellant has gained reputation associated with it having secured registration of the trademark under Section 28 of the Trade Marks Act, 1999.

18. Mr.Andhyarujina has placed reliance upon the decision of the Apex Court in the case of *S. Sayed Mohideen vs. P. Sulochana Bai*<sup>1</sup> to submit that the registration only recognizes the proprietary rights that are pre-existing in common law, but does not create any specific right.

It is also his contention that the effect of the IPAB order is limited to the benefits of Section 28 to the five southern States and the Union Territories and it cannot otherwise reflect the appellant's rights accruing on account of registration of the mark.

In support of his submission about acquiescence, Mr. Andhyarujina would place reliance upon the decision in the case of *Union of India vs Murugesan*<sup>2</sup> to submit that the acquiescence does not always require positive act and it can also be implied passive acceptance of a particular act. Reliance is also placed upon the decision in the case of *Kanchan Udyog Limited vs. United Spirits Limited*<sup>3</sup> to submit

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1 (2016) 2 SCC 683

2 (2022) 2 SCC 25

3 (2017) 8 SCC 237

that waiver and acquiescence may be expressed or implied and has to be found in the facts of each individual case.

Thus, according to the learned Senior Counsel, the order passed by the learned Single Judge deserves to be set aside as it has failed to consider the crucial aspect of the matter and the learned Single Judge has committed patent error in holding that Clause 22 of the MOS read with Clause 12 of the supplemental MOS records sufficiency of consideration paid to the appellant in exchange of permitting it to use its title “New Indian Express”.

Further it is specifically contended that the learned Single Judge has failed to interpret the MOS and in specifically Clause 18(iv) where the appellant is entitled to use the expression “New Indian Express” only for publication of an English language daily newspaper in five southern States and that Clause impose negative covenant on the appellant whereby the appellant would not use the expression “New Indian Express” for any other purpose or for any other area or territory for any use whatsoever, but definitely by conduct of the parties, it was evidently clear that there was no prohibition on promotion of the appellant’s publication outside the five southern States and the specified Union Territories.

Reliance has been placed upon the decision of the Apex Court in the case of *Godhara Electricity Company Limited & Anr. vs. State of Gujrat & Anr.*<sup>4</sup> wherein it is held that the intrinsic evidence of act of the parties done under the instrument is a guide to the intention of the parties and it is permissible to rely upon the same, where there remains a doubt as to its true meaning. It is thus urged that the findings of the learned Single Judge, which are perverse, deserve to be

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4 (1975) 1 SCC 199

set aside and the injunction granted in favour of the plaintiff be vacated by setting aside the impugned order.

19. Opposing the submissions advanced on behalf of the appellant, Mr. Khambata, the learned Senior Counsel, has taken us through the impugned order in the wake of the pleadings in the plaint filed by the plaintiff Indian Express (Pvt.) Limited and the interim application. The thrust of the argument of Mr. Khambata is on the Clauses of the MOS, in specific Clauses 17, 18 and 19 and Clause 6 of the supplemental MOS executed between the parties. It is his submission that Indian Express (Pvt.) Limited granted permission in favour of the Express Publications (Madurai) i.e. the appellant and Clause by Clause he has elaborated the permissive user conferred upon it. According to Mr. Khambata, reading of the Clauses of the MOS, disclose that it was consensually agreed between the parties that his client continued to be the absolute owner of the registered titles and what was conferred on the Express Publications is the permitted use. According to him, whatever is given is only to be used with express permission and by no stretch of imagination it conferred any independent right on the appellant. Apart from this, negative covenant imposed is absolute in time, in use and in manner, as the Clauses clearly stipulate that the appellant cannot at any point of time whatsoever use or adopt any of the titles in any manner whatsoever, clearly indicating that it cannot be done directly or indirectly. Since the title "Indian Express" belonged to Indian Express Newspaper (Bombay) Limited, this was specifically recognized and Clause 18(ii) clarified that the title included not only all rights in respect all the publications

of an English language newspaper under the name of “Indian Express” but also in relation “to any use whatsoever” whether in relation to “print media, electronic media or any other medium whatsoever”. Thus, according to him the title was not intended to be limited to the publication of an English language newspaper but it extended to any use in all media and this was clearly indicative on account of the omnibus language used in the relevant Clause. Further its ownership is also perpetual with no geographical or temporary limit is the specific contention of Mr. Khambata.

Further Clause 19(v), has expressed the intention of the parties clearly as Mr. Khambata would argue that the appellant was required to act ‘on behalf of and in the name of the respondent’, which would reaffirm the undisputed ownership of Indian Express (Pvt.) Limited over “Indian Express” including the “New Indian Express” as the ultimate right vested in Indian Express (Pvt.) Limited to institute action to protect the same. Thus, in short, the gist of the submissions of Mr. Khambata is that Indian Express (Pvt.) Limited continued to be the sole source of all rights and in contrast, Express Publication is only granted permitted use.

20. Mr. Khambata has exhaustively taken us through the clauses, which clearly reflected the limited and restricted use of “New Indian Express” and according to him the permissions which are implicit in the MOS, can be enumerated as below:

- (i) No right, title or interest in “Indian Express” and “New Indian Express” is only permitted to operate in five southern States and the specified Union Territories to the print media only.

(ii) Permitted use for the Indian Express was only for publication of an English language daily in five States and specified Union Territories and for no other purpose or area whatsoever.

(iii) On account of the aforesaid permission, Indian Express Publication was entitled to publish an English language daily with the use of the name “New Indian Express”, subject to the word ‘new’ being in the same line and size as “Indian Express”.

(iv) Liberty is conferred on the appellant to publish only a newspaper or periodical in any Indian language in the five States and specified Union Territories using ‘express’(without ‘Indian’)-provided in no manner whatsoever it can compete with the existing ‘IEG’ Publication.

(v) Liberty to use “The New Indian Express” or its derivatives or abbreviations on the internet for dissemination of the news only but no right granted for its use on the Television or Radio since liberty to use the expression ‘new’ alongside ‘Indian Express’ in any manner and subject to ‘new’ being legible to the naked eyes.

21. Simultaneously Mr. Khambata also read the Clauses so as to enlist the negative covenant on the appellant/Express Publications and he has enlisted the same as under:

(i) The appellant cannot use or adopt its title or derivative or any similar title except as specifically permitted under Clause 19 (ii).

(ii) The appellant shall not any right, title or interest in respect of the title “Indian Express”.

(iii) Even within five southern States and specified Union Territories the appellant is merely “permitted user” of the mark “The New Indian Express” and that too strictly confine to

publications of an English language in daily; prohibited for any other purpose or territory.

(iv) The appellant's corporate name must not include the word 'Indian'.

(v) The appellant shall not be permitted to use respondent's title without any temporal or territorial limit.

(vi) "New" has to be in the same line and the same size as Indian Express which Clause was subsequently diluted.

(vii) Derivatives / look alike titles are barred - circumvention by variation is foreclosed even in appellant's own section of supplement "INDIAN" cannot be used alongside "Express".

(viii) The appellant has no right to use New Indian Express on Television or Radio.

According to Mr.Khambata the supplemental MOS has reaffirmed the rights and restrictions enumerated in Clause 18 as well as Clause 19 of the MOS and has specifically declared that they shall remain in force in all time except the modification in Clauses 18(iv), 19(iii), 19(iv) and 19(v).

22. In the light of MOS and supplemental agreement, the senior counsel has asseverated that, together, the MOS and the supplementary MOS constitute a consent decree of the Madras High Court passed in Civil Suit Nos. 1246 and 1247 of 1992. By relying on the decision in the case of *Rama Narang vs. Ramesh Narang*<sup>5</sup> he would submit that a compromise is as much as a decree passed on adjudication and is composed of both command and contract and the decree bind the parties to it and must be construed strictly in accordance with its plain

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5 (2006) 11 SCC 114

terms. He has specifically urged that “Indian Express” always vested in “Indian Express Newspaper (Bombay) and was in use since 1932 and registered as a trademark in its favour since 23.06.1994 much prior to the execution of the MOS. That is the specific reason why the MOS has a foundational statement namely “Indian Express” meant to be owned and vested in Indian Express Group and he would strongly contest the statement of Mr. Andhyarujina that the MOS has granted two separate titles. On the other hand, he would submit that the MOS granted appellant a limited permitted user of a derivative of the mark “Indian Express” in the form of “New Indian Express” for a limited purpose, to be operated within limited territory. Thus, according to Mr. Khambata when the MOS, which was inked, the contesting parties agreed for a settlement for which a total of Rs.Sixty One Crores was paid by the Indian Express Group to the appellant for the forbearance, sufficiency of which is mutually acknowledged.

He would strongly refute the contention of Mr.Andhyarujina that the consideration under Clause 22 was a “non-competing” and forbearance capital fee and according to him the contention is wholly irrelevant as the nomenclature of the payment would not alter its substance, when the fact remains that the money was paid to the appellant to accept the territorial restrictions on the use of its mark in most parts of India and internationally. According to Mr. Khambata the MOS is comprehensive family settlement in which money, assets and rights moved in multiple direction and payment of Rs. Sixty One Crores was only one component and it is the specific contention of Mr. Khambata that various obligations under the MOS are not severable from one another.

Apart from this, it is also urged by him that the Bombay High Court in several orders has recognised “Indian Express” as a Well-Known Mark of “Indian Express” and its significance is unfolded before us by Mr. Khambata by stating that under Section 11(2) read with Section Section 2(a)(z)(g) of the Trade Marks Act, 1999 a well known mark is entitled to protection across all classes of goods and services and across the whole of India. In addition, under Section 29(4) of the Trade Marks Act, 1999, use of a mark identical or similar to a well-known registered mark, even in relation to dissimilar goods or services, constitutes infringement if such use without due cause takes unfair advantage of or is detrimental to, the distinctive character or repute of a well-known mark.

By applying this principle it is the contention advanced by Mr. Khambata that the appellant’s use of “New Indian Express” to conduct sponsored commercial events in Mumbai directly trends upon and is detrimental to the well-known mark of “Indian Express”. Another consequence of a well-known mark according to Mr. Khambata is, any goodwill generated by permitted user using a mark under a limited license from the proprietor of a well-known mark vests exclusively to the proprietor and therefore, it is his submission that the appellant being a limited permitted user within restricted territory, cannot acquire any independent goodwill or proprietary interest in the “New Indian Express”.

23. Taking his argument ahead Mr. Khambata has urged that since the appellant was only permitted to use “The New Indian Express” only for publication of English language daily newspaper in five southern States and Union Territories and

“for no other purpose or any other territory for any use whatsoever” every mode of commercial deployment of the mark is prohibited. He would invite our attention to the statutory definition of the term “use” in Trade Marks Act, 1999 under Section 2(2)(b) and Section 2(2)(c)(i) as the use of a mark is to be construed as a reference to the use of printed or other visual representation of the mark and in relation to the goods it is construed as a reference to the use of the mark upon, or in physical or any other relation whatsoever to such goods.

He would invoke principles of law laid down by the Apex Court in the case of *Hardie Trading Limited vs. Addisons Paints and Chemicals Limited*<sup>6</sup>, and in particular paragraphs 41 to 45 to buttress his submission that the statutory definition of ‘use’, make it evidently clear that ‘use’ in relation to a mark shall be broadly construed and the words ‘in any relation whatsoever’ indicate that use may be other than physical and bring within its sweep use in advertisements, invoices, orders, etc. Thus, according to him, the restrictions in Clause 18(iv) of the MOS encompass the promotion and advertisement and this particular condition being read in the light of the other clauses, it is the contention of Mr. Khambata that the appellant’s permitted use was for a single defined activity i.e. publication of an English daily within a defined geography of five States and specified Union Territories which expressly excluded all other modes, purposes and territories.

24. Mr. Khambata has also urged that on 16.04.2025 the counsel for the appellant had clarified his submission to the

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6 (2003) 11 SCC 92

effect that it independently has a right to promote its publication outside five southern States and specified Union Territories but he would submit that for that purpose the appellant must establish an independent right but there is none as neither of the words/phraseology “promotion”, “business”, “events” find any place in Clause 18(iv) and therefore, according to him, the appellant’s independent promotional right which is sought to be pressed into service is without any foundation.

Further dealing with the argument that the Mumbai event was stand-alone activity for separate revenue stream, as the event “The New Indian Express-Mumbai Dialogues” was conducted on 20.09.2024 in Mumbai with the independent sponsors like United Bank of India, MAHAGENCO, New India Assurance Company Limited, and it is sought to be projected as a stand-alone commercial event aimed at generating sponsor revenue, Mr. Khambata would question as to under what right this event is organized as this would fall entirely outside any permitted use of MOS or supplementary MOS. Though an attempt is made to conduct it as a promotional event for newspaper, this according to Mr. Khambata is outside the scope of the “permissive user” and amounts to gross overreach of the explicit restrictions set forth in MOS.

25. Mr. Khambata has laid much emphasis on the IPAB order dated 18.06.2015 which, according to him is definitive determination of the enquiry into the appellant’s right. Pointing out to us the provision in the Trade Marks Act in the form of Section 124 which mandates a stay of civil proceedings where a defense is raised by the defendant that the registered

trademark is liable to be rectified, he submit that the Delhi High Court stayed CS (OS) No.1134 of 2011 on 03.02.2015 by invoking Section 124, and it deferred the questions of registrations, geographic, scope to IPAB. The IPAB passed an order on 18.06.2015 restricting the appellant's registration and use to five southern States. In the interregnum, the Delhi High Court suit which was adjourned awaiting the decision of IPAB and was dismissed for want of prosecution on 06.05.2015 and no appeal is filed against the IPAB order.

According to Mr. Khambata, the said order holds the field and is binding on all civil determination of issue thereunder. According to him, the Delhi High Court order with the interim arrangements which at the relevant time bear some relevance, since the IPAB proceedings were pending but reliance upon the said orders to pitch it against the IPAB order, according to Mr. Khambata is wholly unjustified in the backdrop of the scheme of Section 124. In any case, he would submit that under sub-section (4) of Section 124, the IPAB orders circumscribing the scope of trademark registration shall bind on all civil Courts and the Delhi High Court and, therefore, if the suit at all was to proceed on merits, the Delhi High Court would have been bound by the IPAB order. According to him, IPAB order restricted all modes of use and not mere publication but it would include the promotion, advertisement, sponsorship and even stand-alone events and no residual right can be carved out therefrom for events or promotion by characterizing such activity as something other than "use".

26. With reference to the order dated 10.10.2011 passed by the learned Single Judge of the Delhi High Court, according to the learned Senior Counsel, since the suit was stayed on

03.02.2015 which was subsequently dismissed for non prosecution, the interim order has merged into final disposal. The argument of *res judicata* is wholly inapplicable as according to Mr. Khambata the interim order which does not finally and conclusively decided an issue cannot be a precedent as the reasons assigned in such orders are only tentative, being temporary arrangements to preserve the status quo before final hearing. Mr. Khambata would rely on the decision in the case of *State of Assam vs. Barak Upatyaka D. U. Karmachari Sanstha*<sup>7</sup>. According to him, the order of the Delhi High Court cannot constitute *res judicata* it being an interlocutory order and not finally determining the rights of the parties.

It is also his contention that at that stage, the learned Single Judge of the Delhi High Court do not have the benefit of the JAA dated 18.04.1997 or its termination as all invoices filed in support of advertisement fell between 1997 to 2009 - entirely within subsistence of the JAA and constitute only a limited permission under that irrevocable agreement. According to Mr. Khambata, the learned Single Judge of Delhi High Court did not consider the admitted position that the “New Indian Express” is not available outside five southern States and Union Territories for the very same reason, the Division Bench which upheld the Single Judge decision do not bind today, as the opinion expressed is based upon *prima facie* observation.

27. As regards the order of the learned Single Judge of this Court (Justice S.C.Dharmadhikari) dated 18.10.2010 when the ad-interim injunction was declined in favour of his client also

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7 (2009) 5 SCC 694

do not create any binding effect as on today, as according to him the suit was not taken for trial on the issue of title and infringement but it was resolved by final consent order recorded on 29.04.2012 before another Single Judge (Justice G.S.Patel) and the suit was disposed of on those terms. Therefore, the order has no independent legal existence.

It is the specific contention of Mr. Khambata that there is no question of any *res judicata* as the orders relied upon, both by the Delhi High Court and Bombay High Court has not determined the rights of the parties finally.

28. Focusing his attention on the allegations of acquiescence, Mr.Khambata has urged that consent decree can be varied or extinguished by the private conduct of parties to it and the only remedy available to a party to a consent decree to avoid it, is to approach the Court which recorded the consent. He would submit that if the consent decree cannot be varied even by deliberate express act of the party definitely it cannot be varied by the parties inaction, as the Court cannot go beyond the decree and has no jurisdiction to modify it and it is imperative for the Court to execute the decree as it is.

According to Mr. Khambata, JAA never varied consent decree and even if assuming for a moment it did, the variation was temporary and revocable and in fact the JAA itself stood terminated in the year 2011. It is also urged that the appellant being aware of the IPAB order subjecting its registration and use to the territory jurisdiction as per MOS is not estopped from arguing that its usage in some manner modified the terms of MOS. Since there is no challenge to the IPAB order, it

has attained finality, the appellant has no right to advance such a statement is the contention of Mr. Khambata.

29. Dealing with the contention of Mr. Andhyarujina that the statutory right can be waived and therefore consent rights also can be waived and the reliance in the case of *ARCE Polymers vs. Alpine Phamaceuticals Pvt. Ltd. & Ors.*<sup>8</sup> and in the case of *Jaswant Singh vs. Ahmedabad Municipal Corporation*<sup>9</sup>, as according to Mr. Khambata, is not having relevance to their case, as neither of it holds that the decretal obligation can be waived by inaction. It is urged that the appellant accepted the consent decree, never appealed against the IPAB order that restricted its registration to five southern States and Union Territories and has conducted itself on footing that these instructions are binding but at the same time now it is an attempt to claim broader right rather than what instrument permits and this is what are the inconsistencies contemplated under the *ARCE Polymers* (supra.) and this is prohibited according to Mr. Khambata.

30. Another submission on behalf of the “Indian Express Group” assertively stated is that acquiescence, waiver and laches prevent a party from asserting its “right”, if it has led another to believe that it will not assert, but in no way it create rights, which were non existent and it is contended that no amount of inaction on part of Indian Express can result into a decree or permission which the parties deliberately excluded, the governing principle being that, what cannot be done

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8 (2022) 2 SCC 221

9 1992 (Suppl)(1) SCC 1992

directly cannot be done indirectly. In addition, it is also submitted that acquiescence implies positive acts and not merely silence or inaction such as is involved in laches. A mere failure to sue, without an affirmative act of encouragement that cause infringer to change its position is not acquiescence and for this proposition a reliance is placed upon the decision in *Encure Pharmaceuticals Limited vs. Corona Remedies Pvt. Ltd.*<sup>10</sup> and also on the decision in the case of *Union of India vs. Divyangana Kumar*<sup>11</sup>.

It is urged that when a party continuously asserts its rights, the very foundation of acquiescence and laches collapses and this is so urged in the background that the Indian Express contested the appellant's registration before various forums, including the IPAB and therefore, according to Mr. Khambata there was never any stoic silence on its behalf and rather at every stage and at an every opportunity available it contested the assertion of rights by the appellant. According to Mr. Khambata, the appellant has resorted to dishonest use of the restricted/limited right conferred upon it under the MOS and by relying upon the decision in the case of *Colgate Palmolive Company & Anr. vs. Anchor Health and Beauty Care*<sup>12</sup> it is submitted if the use is found to be dishonest, delay or acquiescence has no relevance and when an infringer's knowledge of proprietors right is pervasive, acquiescence is not even remotely applicable. It is thus submitted that the appellant which was a party to the MOS and supplementary MOS and the consent decree cannot claim ignorance of the respondent's rights. In fact, the order of IPAB

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10 2014 SCC Online(Bom) 1064

11 2005 SCC Online (Bom) 179

12 2003 SCC Online (Delhi) 1005

calling upon the appellant to scrupulously follow its order without any slightest violation of the terms of the MOS having been accepted as final and determinative, would lead to an irresistible conclusion that the appellant has waived all its claims to argue in any manner about waiver/modification of MOS, as the said directions are wholly binding without any exception.

31. As regards a contention to the effect that mutual advertisements were published in each other's newspapers in the wake of the JAA and this being pressed into service as evidence of PAN India acquiescence, it is contended that they were "Home ads" and did not relate to the promotion or sale of the newspaper of "The New Indian Express". Every incident relied upon dating from 1997 to 2009 precisely covering the period of JAA, it is submitted that the JAA was terminated by notice dated 21.07.2010 with effective from 20.01.2011 and upon termination the limited permission under the JAA stood revoked. It is also submitted by Mr. Khambata that if a submission that every time whenever the publication of the advertisements took place, a copy of newspaper was also delivered is also a hallow submission as he would submit that it is pleaded that from 1995 upto 15 years the newspapers were supplied but the JAA itself came to be end in 2010 and it also conveyed that it was not supplied after 15 years i.e. from 1995. Therefore. an issue is raised by Mr. Khambata as to if accepting the submission that the newspapers were delivered but it was delivered till when and definitely not beyond the 15 years. Ultimately in June 2015 when IPAB directed the

appellant to restrict its operation then there is no question of any acquiescence as the IPAB order also makes a reference to the consent decree order and that binds the parties equally.

32. In conclusion, Mr. Khambata has assertively submitted that the learned Single Judge has committed no error in granting interim injunction by precisely construing the counter stand and by rightly interpreting the terms of the MOS and supplementary MOS which translated into consent decree passed by the Madras High Court which is binding and has to be strictly construed and has rightly concluded that the appellant enjoy no proprietary right in “New Indian Express” and its use in Mumbai to conduct and sponsor commercial event is violation of the consent decree.

For the sake of the argument it is submitted by the learned Senior Counsel that even if any promotional right existed, ‘Mumbai Dialogues’ is not a promotion of newspaper but it is exploitation of the grant, to host an event as an independent assets generating corporate sponsorship in a contractually and legally forbidden territory. In any case, according to Mr. Khambata the order passed by the learned Single Judge will have to be tested in the light of the principles laid down in the case of *Wander Limited & Anr. vs. Antox India P. Limited*<sup>13</sup> and the appellate Court shall interfere only if the impugned order is vitiated by an error of law apparent on the face of the record or if it is so arbitrary, capricious or perverse that no reasonable person could have reached such a conclusion.

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13 1990 Supple (1) SCC 727

Submitting that the appellant has assailed the order passed by the learned Single Judge on 18 grounds and categorizing them as “patent errors” and “perverse” but none of the grounds, according to Mr. Khambata, identify a wrong legal test or ignorance of a binding authority or make out that the conclusion reached is not a conclusion which could be reached by a reasonable man and therefore, according to him, the scope for interference is very little and in his opinion none as the learned Single Judge has rightly appreciated a *prima facie* case, balance convenience and the irreparable harm if the injunction is not granted, he would request the Court to uphold the impugned order.

33. The contest between the two parties, Indian Express Group (IEG) and New Indian Express Group (NIEG) arises in the wake of consent terms executed in a dispute that finds its way before the Madras High Court in the form of two Civil Suits.

The historical background of the Indian Express Group and its existence would establish that Indian Express Newspaper (Private) Limited Nariman Point Buildings and Holdings Private Limited (NPBHPL) was incorporated in 1959 to acquire, take over and carry on business as proprietors, publishers of any newspapers, journals, magazines, books and other literary work. In an about 1972 it took on long lease the land and buildings know as “Express Towers” . The name of the Company was changed to “Indian Express Newspapers (Bombay) Limited and it continued over the years as it involved itself in publication of multi editions of newspapers.

“Indian Express Limited” was incorporated on 05.11.2003 and through a scheme of arrangement by way of demerger entire print media undertaking, the Indian Express Newspaper(Bombay) Limited stood transferred to “Indian Express Newspaper(Mumbai) Limited with effect from 05.01.2009. The Indian Express Group comprise of several group of companies, shares of which were held by Nariman Point Buildings Services and Trading Private Limited as the ultimate holding company (NPBS).

The shares of NPBS were held by late Shri Ramnath Goenka and his grandsons Shri Vivek Goenka and Shri Manoj Kumar Sonthalia. Manojkumar had an elder brother Amit Kumar Sonthalia, who was mentally challenged and in the year 1989 it was proposed that the shares held by Shri Ramnath Goenka for the benefit of Shri Amitkumar Sonthalia to the extent of 24.32% of the shareholding of NPBS would be divided equally and kept in the joint name of Manojkumar Sonthalia and Vivek Goenka.

Mr.Manojkumar contended that in the year 1990, 24.94% shareholding as owned and held by him and 12.16% shareholding held in Trust for his brother, had been transferred fraudulently in favour of Ramnath Goenka as a part of larger conspiracy by Vivek Goenka to take over the entire management and ownership of NPBS and effectively the entire Indian Express Group of Companies. He also alleged that the management of Indian Express Group was sought to be taken over by Vivek Goenka by manipulating Board Resolutions and in the year 1992 he instituted two suits impugning the transfer of shares that were held by him as well

as transfer of shares held for the benefit of elder brother, as transfer of 49.28% of entire shareholding of NPBS resulted into depriving him of the control of the Group and amounted to handing over the entire control to Vivek Goenka and the suit sought relief of cancelling the meeting in which the shares were transferred and for the several other ancillary reliefs.

34. A civil suit filed by Manojkumar Sonthalia impleaded NPBS along with Indian Express Newspaper (Bombay) Limited, Indian Express (Madurai) Limited as well as Vivek Goenka along with several other individuals as the defendants. The suit claimed the relief of declaring the Board Meeting of NPBS held on 05.01.1991 to be illegal, null and void and sought injunction restraining some of the defendants from acting as Director in the said Company.

During the pendency of the said proceedings, an application was moved before the Court to record Memorandum of Settlement arrived between the plaintiff Shri Manojkumar Sonthalia and sixth defendant Shri Vivek Goenka and defendant no.14 Radhadevi Sonthalia and consequently for passing a decree in its terms and disposal of the civil suit. This resulted in disposal of the civil suit and it was ordered and decreed in terms of the settlement arrived between the parties.

The settlement terms included a settlement in the form of transfer of the shares equity and preference shares with an understanding that the plaintiff shall withdraw all allegations and indemnify Shri Vivek Goenka against all over any claims which may be made by Anilkumar Sonthalia. With

regard to the aforesaid allegations and he along with Radhadevi Sonthalia shall jointly and severally indemnify and keep Shri Vivek Goenka against all claims of whatsoever nature that may arise from any member of Sonthalia family.

35. The clauses, which are relevant for our consideration in the MOS, are Clause Nos. 17 to 21 which read thus:

*"17) That Indian Express News papers (Bombay) Limited and Traders Limited shall be the absolute owners of their registered titles of the Newspapers and Magazines (including supplements) whether current published by them or not in respect of the whole of India and that Manoj kumar Sonthalia, Indian Express (Madurai) Limited Andhra Prabha Limited and Sterling Newspapers Limited shall have no claim of any kind in relation thereto and that Manoj Kumar Sonthalia, Express (Madurai) Limited, Andhra Prabha Limited, Sterling Newspapers Limited shall not at any time the or adopt any way whatsoever directly or indirectly use or adopt any of the said titles in any way whatsoever or any title similar or resembling thereto save and except what is specifically permitted in clause 19 infra.*

*18) That the title "Indian Express" shall vests absolutely in Indian Express Newspapers (Bombay) Limited as clarified in Sub Clauses (i) to (iv), infra and that Indian Express (Madurai) Limited shall not have any right, title or interest in respect thereof, subject to the condition only that in the states, of Tamil Nadu, Kerala, Karnataka, Andhra Pradesh and Orissa (hereinafter referred to as the five states) and the Union territories of Pondicherry, Inam, Andaman and Nicobar Islands and Lakshadweep islands (hereinafter referred to as the said Union Territories), Vivek Goenka, Nariman Point Building Services & Trading Private Limited Indian Express Newspapers (Bombay) Limited and Traders Limited or any corporation owned or controlled by them shall not directly or indirectly use the title (in relation to the print media) "Indian Express" or any name which includes the words "Indian" or "Express" or any derivative thereof save the Financial Express, the Weeklies, Supplements or other periodicals,*

*i) That the title "Indian Express" belongs to Indian Express. Newspapers (Bombay) Limited absolutely.*

*ii) That this title includes not only all rights in respect of all publications of an English language Newspaper under the name "Indian Express"; but, also, in relation to any use whatsoever whether in relation.) That this title includes not only all right in respect of all publications of an English language Newspaper under the name "Indian Express"; but, also. in relation to any use*

*whatsoever whether in relation to print media, electronic media or any other medium whatsoever:*

*iii) That such rights and ownership is unlimited in point of territory or time.*

*iv) That Indian Express (Madurai) Limited is permitted use of the expression "New Indian Express" only for the publication of an English language daily Newspapers in the specified five states and Union Territories and for no other purpose or any other area or territory for any use whatsoever.*

*19) That Indian Express (Madurai) Limited, Andhra Prabha Limited Sterling Newspapers Limited shall be the absolute owners of all the titles of the News papers and magazines including the Supplements) Indian Express News papers (Bombay) limited published by them and that Vivek Goenka/Traders Limited, Nariman Point Building Services & Trading Private Limited shall have no claim of any kind in relation thereto and that Vivek Goenka, Indian Express Newspapers (Bombay) Limited Traders Limited, Nariman Point Building Services & Trading Private Limited shall not at any time whatsoever directly or indirectly use or adopt any of the said titles in any way whatsoever or any title similar of resembling thereto and that Vivek Goenka, Indian Express Newspapers (Bombay) Limited, Traders. Limited, Nariman Point Building Services & Trading Private Limited have no claim of any kind in relation thereto. In relation to the English language publication "Indian Express" and that having regard to clause 18 supra the following further provisions be and are hereby made:-*

*i) "The name of Indian Express (Madurai) Limited. shall be changed to any name which does not include the word "INDIAN", it being clarified that the name can be 'IEM OF NIEM' or any other abbreviation or name to the intent and purpose that, the new name may contain the word 'Express' but shall not contain the word "INDIAN".*

*ii) Manoj Kumar Sonthalia, Indian Express (Madurai) Limited, Andhra Prabha Limited & Sterling Newspapers Limited shall not use the title Indian Express(IE) at any time, anywhere.*

*iii) Subject to Clause 20 infra Indian Express Madurai) Limited /NIEM shall be entitled to publish an English language Daily by the name of "New Indian Express" on the condition that the expression "NEW" shall be in the same line and of the same size as the words Indian Express wherever this title appears.*

*iv) Save and except what is, stated in clause 19(iii) hereinabove, neither Indian Express(Madurai) Limited/New Indian Express (Madurai) Limited or Manoj Kumar Sonthalia or Andhra Prabha Limited or Sterling Newspapers Limited or any corporation owned or controlled by them shall directly or indirectly use the title Indian Express or any of its derivatives or any title similar on resembling thereto at any time whatsoever, provided that the restrictions against use of the word "Express*

*(without association with the word "Indian") shall not apply to the sections or supplements of New Indian Express, and in these sections or supplements the word "Indian" shall not be used alongside or otherwise with the word "Express".*

v) *Manoj Kumar Sonthalia, Indian Express(Madurai) Limited & New Indian Express(Madurai) Limited shall be entitled to object to and prevent any other person from using the title Indian Express or its derivatives in the said five states and the said union territories and for this purpose shall be entitled to require Indian Express News papers (Bombay) Limited to take steps to prevent such publication, and if for a period of 15 days after, receipt of notice from Manoj Kumar Sonthalia, Indian Express(Madurai)limited (or New Indian Express Madurai Limited) Indian Express News papers (Bombay) Limited fails to institute appropriate proceedings, then Manoj Kumar Sonthalia and/or Indian Express Madurai limited New Indian Express Madurai Limited) are hereby irrevocably authorized to adopt such proceedings on behalf and in the name of Indian Express New papers (Bombay) Limited to restrain and stop such publication or publications.*

20) *That Indian Express Madurai Limited, New Indian Express (Madurai) Limited, Andhra Prabha Limited Sterling Newspapers Limited' or Manoj Kumar Sonthalia or any corporation, firm or concern, directly or indirectly owned or controlled by them or associated with them shall not start any English language. Newspapers in any state of India other than specified five states and the specified union territories in clause 18 supra for a period of 36 months from this date and that after the expiry of the said period of 36 months, if Indian Express (Madurai) Limited, New Indian Express (Madurai) Limited, Andhra Prabha Limited, Sterling Newspapers Limited or Manoj Kumar Sonthalia, start an English Language newspaper in any State of India other than the said five States and the said Union Territories, it shall be subject to the further condition that it shall not bear the name of "New Indian Express" or "Indian Express" or any name including the word Indian or Express or its derivatives, and that Squally, none of them shall start any Indian Language Newspaper which is in any way in conflict or competition with the language newspapers presently owned by Vivek Goenka, Indian Express Newspaper (Bombay) Limited, Traders Limited, Nariman Point Building Services & Trading Limited, Bharat Katha Publication Private Limited Bharat Katha Offset (Private) Limited in their shall not apply to periodicals (magazines, weeklies etc).*

21) *That Vivak Goenka, Indian Express News Papers (Bombay) Limited, Traders Limited, Nariman Point Building Services & Trading Private Limited or Bharat Katha offset Private Limited/Bharat katha Publication Private Limited or any corporation, firm or concern owned 'or controlled by them or associated with them shall not start any English language Newspaper in any of the said five states and the said union territories in clause 18 Supra for a period of 36 months from the date and that, if they start any English language Newspaper*

*thereafter, it shall not bear the name of Indian Express or any name including the word Indian or Express or its derivatives but this limitation shall not apply to the daily. The Financial Express and the periodicals and again none of them shall start any Indian Language Newspaper which is in any way in conflict with the language newspapers presently owned by Manoj Kumar Sonthalia, Indian Express (Madurai) Limited/Andhra Prabha Limited or Sterling Newspapers Limited or any Kalayalam Newspaper in the said five states and the said union Territories mentioned in Clause 18 supra and that this prohibition shall not apply to periodicals (magazines, weeklies etc).*

36. One more Clause which is relevant is Clause No.22 which pertained to the payment of non-competing forbearance capital fee of Rs.Fifty Six Crores in favour of Indian Express (Madurai) Limited, and the relevant portion of the said Clause reads thus:

*22) That in consideration of the restraint against competition and obligations accepted herein-above in clause 21 supra particularly in respect of most parts of India save the specified five states and the specified Union Territories which are over and above the counter obligations provided for hereinabove and that Indian Express Newspaper(Bombay) Limited shall pay Indian Express (Madurai) Limited a non-competing and forbearance capital fee of Rs.55 Crores as under :*

*a) For the forbearance accepted by Indian Express (Madurai) Limited not to start an English Newspaper within 36 months, Rs.6(six) crores.*

*b) For the balance forbearances accepted Rs.50 (fifty)crores and as determined by Mr.R.V.Pandit by valuing the restraints and forbearances) on the dispute regarding payable and the the amount of non-competitive free terms of such payment and the security therefore being referred to him by Vivek Goenka and Manoj kumar Sonthalia on behalf Indian Express Newspapers (Bombay) Limited and Indian Express (Madurai) Limited Which reference has been ratified by the Board of Directors of the respective companies and This fees shall be paid as..”*

37. Various other clauses in the MOS record understanding between the parties but since the subject matter of the appeal before us do not involve any of them, we refrain ourselves from reproducing the same. The consent terms were accepted by the Madras High Court and resulted into passing of a decree.

38. A slight modification of the said consent terms on 30.03.1997 in the form of supplemental agreement modified Clause 19 (i) of the MOS (limited to the company name) and it reads thus "the name of Indian Express (Madurai) Limited shall be changed any name which does not include the word 'INDIAN', it being clarified that the name can be 'IEM or NIEM' or any other abbreviation or name to the intent and purpose that, the new name may contain the word 'Express' but shall not contain the word "INDIAN'."

There was also substitution of Clause 22(ii) and some other clauses relating to payment which are not relevant for our purpose. This was followed by a supplemental agreement entered between the IEG and NIEG in the backdrop of the settlement dated 05.02.1995 creating reciprocal preemptive rights with respect to publication and companies control by IEG and NIEG.

The supplemental agreement clearly recorded that IEG had concluded all payment obligations under the MOS and the memorandum of satisfaction of the decree was duly recorded by the High Court of Madras on 20.03.2003.

39. IEG and NIEG agreed to certain clauses in the MOS which contain restrictions which were unlimited in point of time and precluded both the groups from pursuing restructuring option or effective strategies for growth and expansion. In the mutual interest of both the groups it was agreed to effect certain amendments to the MOS and the decree in terms of MOS was passed by the Madras High Court on 16.04.1997. The relevant clauses with which we are concerned in the supplemental agreement which relaxed the restrictions imposed in the MOS, reads thus :

*“6. IEG and NIEG also agree that notwithstanding anything to the contrary contained in Clause 19(v) of the Memorandum of Settlement dated 05.02.1995, NIEG shall be at liberty to take such action as NIEG might deem necessary against any infringement by anyone of its title "The New Indian Express" in the five Southern states and specified Union territories without first calling upon IEG to take action. It is clarified however that this is not in derogation of the right of IEG to take action against any infringement of any of its rights under the Memorandum of Settlement dated 05.02.1995 or any of its titles anywhere.*

*7) IEG and NIEG agree that notwithstanding the prohibition contained in Clause 18 (iv) and 19(iv) of the Memorandum of Settlement dated 05.02.1995, NIEG shall be at liberty to publish any newspaper or periodical in any Indian language in the five southern states and union territories mentioned in the Memorandum of Settlement dated 05.02.1995 using the word "Express" (without association with the word "Indian" or any derivative of the word "Indian") in the title of the publication provided, however that NIEG shall only use the word "Express" to publish a newspaper or periodical in an Indian Language which is not in any manner whatsoever in competition with an existing publication of IEG.*

*8) IEG and NIEG agree that notwithstanding the prohibition contained in Clause-18 (iv) of the Memorandum of Settlement dated 05.02.1995, NIEG shall be at liberty to use its title "The New Indian Express" or any of its derivatives/abbreviations on the Internet for dissemination of news. For the removal of doubts, it is clarified that NIEG shall not have the right to use the title "The New Indian Express" for Television or Radio.”*

40. The supplemental agreement presented before the Madras High Court in execution petition filed in Civil Suit No.1246 of 1992 received its approval as the Court recorded the consensus that the execution petition may be closed by recording supplementary agreement. Accordingly, the execution petition was closed and it was recorded that the supplementary agreement dated 12.08.2005 signed by the parties shall form a part of the record.

41. After the agreement is executed, two groups being represented by Manojkumar Sonthalia and Vivek Goenka respectively entered into an arrangement for joint advertising termed as "All India Advertisement Revenue Arrangement" and it was a mutual understanding, that bills will be raised by the two groups for the ads at discounted card rates of the publication in which they are carried and debit notes will be exchanged on monthly basis. The arrangement also contemplated certain incentives and it was agreed that any deviation to the terms therein shall be with the mutual consent. The terms in the agreement were extended from time to time and a new agreement was entered into on 12.08.2005. However, on 21.07.2010, the said agreement was terminated with effect from 20.01.2011 in the wake Clause 10 of the Deed of Agreement permitting termination by giving six months notice.

The notice of termination issued by Indian Express categorically stated in the wake of demerger order dated 25.07.2008, the publication business of Indian Express Newspaper (Mumbai) Limited was transferred to it. In any case after 21.07.2010, there is no arrangement between the two groups in the form of Joint Advertisement Agreement (JAA).

42. In the year 2010, "Indian Express Limited" instituted a suit to restrict Express Publication (Madurai) from using its registered trademark 'i.e.' or any other deceptively similar mark so as to infringe the plaintiff's registered trademark. It also brought an action of passing off and prayed for award of damages.

A Notice of Motion take out in the said suit was decided by the learned Single Judge on 15/18.10.2018 and the injunction was refused.

The order passed by the learned Single Judge exhaustively referred to the arrangement between the two groups surfacing through memorandum of settlement(MOS) and supplemental MOS when the plaintiff brought a case of infringement of its registered trademark. It rendered a finding that there was complete silence by the plaintiff about the usage by the defendants of the said mark and it was held that both the parties were in the same business and functioning as the same group for decades together and the name and their publication is identical, but subsequently there was division or separation in the group, to avoid the conflict and clashes. Thus the relief was refused to the plaintiff for the reason that it had failed to produce cogent and reliable material to establish infringement of its mark.

However, this discord is resolved on 18.07.2014 in the wake of understanding where the counsel for the defendants made a statement that they have discontinued to use of the mark "i.e" on the masthead and as a logo w.e.f. 18.04.2011 and removed the same from the website. The defendants also clarified that they had no intention of using the mark in future and their application filed before the Registrar of Trademark for registration of masthead, which was the subject matter of the suit as an associate trademark will be withdrawn.

In the wake of the aforesaid understanding when the defendants conceded that it will not use the mark/logo of Indian Express group the proceedings are closed.

The insistence on behalf of the appellant to reply upon the observations of the learned Single Judge in refusing the interim relief, which was a *prima facie* view expressed, therefore, loses its efficacy as the defendants willingly agreed that it shall not use the logo 'I.e.'. In any case the suit was filed for action on infringement and passing off and that action has come to an end.

43. The Indian Express Limited also instituted a suit before the Delhi High Court in the form of CS (OS) No.1124 of 2011, seeking injunction against the defendants for use of the words "The Indian Express", "New Indian Express" 'Indian' and 'Express' or any associated or cognate or abbreviated terms or any logos covered by the plaintiff's trademark, thereby violating the rights under a decree dated 16.04.1997 and supplementary agreement dated 12.08.2005.

By judgment dated 10.10.2011, the learned Single Judge of the Delhi High Court with reference to the compromise decree and by specifically reproducing its distinct clauses, expressed that the plaintiff had based its case upon (i) infringement of trademark (ii) passing off and (iii) breach of contractual obligations including the compromise decree passed by the Madras High Court.

Admitting that "Indian Express" is the registered trademark of the plaintiff; whereas, "New Indian Express" is the registered trademark of the defendant no.1, with reference to Section 28 of the Trade Marks Act, 1999 it was held that there is no infringement of the trademark Indian Express by the defendants on account of use of the trademark "New

Indian Express” as Section 28 clearly provided, that where two or more persons are registered proprietors of trademark which are identical or nearly resemble each other, exclusive right to use any of those trademarks shall not deemed to have been acquired by anyone of them as against any other of those persons merely by its registration.

As far as action of passing off is concerned, the Court considered likelihood of the defendants being able to pass off its goods and services as those of the plaintiff and the Single Judge of the Delhi High Court concluded that the plaintiff has no right to object to the advertisement published in the defendants own newspaper when they themselves had published similar advertisement in their newspapers outside the southern States / Union Territories specified in the agreement between the parties.

It is further held that the plaintiff has been carrying out advertisement of “Indian Express” in the inhouse newspaper published from southern States/Union Territories though they were precluded from doing so in the wake of the agreement and, therefore, it is inferred that if the advertisement of New Indian Express Group in the Sunday Standard is to be taken as passing off of the newspaper, “Sunday Standard” as the newspaper belongs to “Indian Express Group”, it was difficult to dispute that publication of advertisement of Indian Express would amount to passing off the newspaper “Indian Express” as a newspaper belonging to New Indian Express in southern States. It is also held that the plaintiff by its acts and deeds has waived its right by permitting the use of the expression “New Indian Express” by defendants and therefore are now

estopped from objecting to the publication in Sunday Standard.

The said order being challenged in appeal is upheld by the Division Bench on 22.11.2011 by recording that there was no reason to interfere with the discretion exercised by the Court of first instance, since the finding rendered was neither arbitrary, capricious or perverse nor had the Court ignored the principle of law regulating grant or refusing interlocutory injunction.

44. Both the orders in our view carry very little relevance as the order dated 10.10.2011 was passed while adjudicating the interim application in a Civil Suit and it pronounced upon the application for exemption against the use of 'NIE' logo in the masthead of its newspaper 'Sunday Standard' in Delhi and for certain advertising agency correspondence. The adjudication resulted into a finding that the advertising NIE in third party media in outside five States was permissible as it is ancillary to publication and the learned Single Judge did not take into consideration the effect of the consent decree of the Madras High Court and rather refused to deal with the contention of the defendants that the remedy against the contravention of the consent decree passed by the Madras High Court lies before that Court.

As on date it is worth to note that this suit was stayed on 03.02.2015 under Section 124 of the Trade Marks Act and was ultimately dismissed for non-prosecution on 06.05.2015. Thus, the interim order passed by the learned Single Judge which is in turn upheld by the Division Bench of the Delhi High

Court has merged into final order, when the suit itself is dismissed.

Since there was no propriety in restoring the suit at subsequent point of time, we do not find that it defeats the contention and the grounds raised by the Indian Express Group in the suit filed before the Bombay High Court and the interim application seeking an injunction on which the impugned order is passed. It is well settled principle that once the final order is passed, all the earlier interim orders merge into the final order and the interim order ceased to exist.

45. The contention advanced that the above findings rendered by the learned Single Judge would operate as *res judicata* and that Justice R.I.Chagla, while granting injunction in favour of the plaintiff, has failed to consider its effect is without any merit. Mr. Khambata has invoked the observations of the Apex Court in the case of *Hope Plantations Ltd. vs Taluk Land Board, Peermade & Anr.*<sup>14</sup> and on its perusal, it is noted that the principle of *res judicata*, prevent the parties to a judicial determination from litigating the same question and it is a doctrine based on public policy and justice. The embargo exists in the parties continuing in litigating when the proceedings had attained finality and the parties are bound by the judgment and estopped from questioning it. The doctrine prohibits a party to litigate again on the same cause of action nor does it allow them to litigate on any issue which was necessary for decision in the earlier litigation.

This distinguishing line is, however, drawn by the Hon'ble Apex Court while pronouncing upon the law on the

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14 (1999) 5 SCC 590

issue of *res judicata*, by holding that if an issue has been decided in an earlier litigation again arises for determination between the same parties in a suit based on a fresh cause of action or where there is continuing cause of action, the principle of *res judicata* may not be strictly applicable. However, there can be no dispute about the fact that the interim application is decided, the findings recorded are merely *prima facie* and do not conclusively determine the lis between the parties.

In *State of Assam vs. Barak Upatyaka D.U. Karmachari Sanstha* (supra), the Apex Court has clearly rule thus :-

“21. A precedent is judicial decision containing a principle, which forms an authoritative element termed as ratio decidendi. An interim order which does not finally and conclusively decide an issue cannot be a precedent. For reasons assigned in support of such non-final interim order containing *prima facie* findings, are only tentative. Any interim directions issued on the basis of such *prima facie* findings are temporary arrangements to preserve the status-quo till the matter is finally decided, to ensure that the matter does not become either infructuous or a fait accompli before the final hearing.”

Thus, in order to constitute *res judicata* there must be final determination of the rights of the parties and this benefit is not available to an interlocutory order and in the present case the same applies to the order passed by the Delhi High Court, which was an order passed on the interlocutory application, which did not final determine the rights between the parties.

46. In *EPUB Singapore* (supra) the contours of the principle of the *res judicata* as ingredient in Section 11 of the Civil

Procedure Code, 1908 received attention of the Apex Court in the light of the existing precedents on the said point.

Recording that principle of *res judicata* is based on the need of giving finality to the judicial decisions and principle specifically stated being; once *res judicata*, it shall not be adjudged again.

In simple terms it is a principle laying down that where question of fact or question of law has been decided between two parties in one suit or proceeding and the decision is final, either because no appeal is taken up to higher Court or appeal was dismissed or no appeal lies, neither party will be allowed in future to file a suit or proceedings between the same party to canvass the matter again.

This principle further elaborated in *Sheodhan Singh vs Daryao Kunwar*<sup>15</sup> to the effect that the condition which must be satisfied before doctrine of *res judicata* can apply in a given case and this necessitated the five conditions laid down, prominent among it was highlighted as “the matter directly and substantially in issue in a subsequent suit must have been heard and finally decided” by the Court in the first suit.

The term “heard and finally decided” clearly indicate the finality and conclusiveness on the issue between the parties i.e. it involves conscious adjudication of the issue on merits and it is well settled that a plea of *res judicata* cannot be taken aid of unless there is expression and opinion on the merits.

*Res judicata* cannot apply solely because the issue previously come up before the Court as the doctrine will only

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15 AIR 1966 SC 1332

apply where the issue is “heard and finally decided” on merits through a conscious adjudication by the Court.

Thus, the perusal of the order of the learned Single Judge passed as early as in 2011, when the suit was instituted by Indian Express and an application for interim injunction is filed, did not take into consideration the conspectus of the dispute, which is placed before the learned Single Judge of the Bombay High Court in the present suit. In any case, it is to be noted that the Delhi High Court had no benefit of the consideration of JAA or its termination and invoices filed in support of advertising which are relied in fact covered the period of between 1997 and 2009 and the same invoices are relied upon to establish the permissible advertisements which were issued in each other’s newspapers. Apart from this, even that order has lost its efficacy in the light of the IPAB order which has glossed over the finding of the learned Single Judge that Express Publications Madurai was having PAN India registration as IPAB order has restricted the registration only to five States. Therefore, in our view the order passed by the Delhi High Court in the suit instituted by the plaintiff do not in any way restrict the scope of determination in the present suit instituted by the Indian Express Group in the year 2025.

47. Today, the IPAB order forms the cornerstone of the reliefs sought by Indian Express Group in the suit as well as the interim application. It is noted that the Delhi High Court had stayed the proceedings in the suit, in the wake of the provisions of Section 124 of the Trade Marks Act, which mandate stay of civil proceedings pending IPAB determination of validity of registration and as per sub-section (4) of Section 124, the findings rendered to bind the Civil Court.

The IPAB order dated 18.06.2015, passed on an application filed by the 'Indian Express Limited' for rectification of the impugned trademark of 'New Indian Express' in respect of the trademark application in Class 16.

The order passed make a reference to the civil proceedings between the parties, which culminated into passing of a Decree and Judgment dated 16.04.1997 by the Madras High Court on the basis of the terms of compromise dated 05.02.1995 and 30.03.1997. The understanding between the parties as referred in the order of IPAB record as below :-

"It would be suffice for us to state clearly and categorically that it is incumbent on both the parties i.e. the applicant and respondent nos. 1 and 2 to follow the terms and conditions of MOU/MOS dated 05.02.1995, 30.03.1997 and supplemental agreement dated 12.08.2005 incorporated in the judgment and decree of the Hon'ble High Court of Madras in Civil Suit Nos. 1146 and 1147 of 1992 dated 16.04.1997 and Execution Petition No. 153 as stated earlier and to scrupulously follow without any slightest violation."

In the wake of the aforesaid IPAB directed as below:

*"5. We are also constrained to state and direct the Registrar of Trade Mark, Chennai to restrict the use of the impugned trade mark The New Indian Express" under No. 856018 only to the above said States namely Tamlinadu, Kerala, Karnataka, Andhra Pradesh, Telungana and Orissa and the Union Territories of Pondicherry, Andaman Nicobar, Lakshadweep and Enam. In respect of other points that are agitated before us, it is open to the parties to agitate the same either in suit filled by the applicant and pending on the file of the Hon'ble Delhi High Court or by initiating any proceedings before the appropriate forum. The OPA is disposed of with the above directions" ..*

48. In light of Section 124 of the Trade Marks Act, 1999 , a provision intended to prevent conflicting decisions when the matter is pending before the Registrar, it is deemed appropriate to stay the Civil Suit till those proceedings are concluded. In terms of sub-section (4) of Section 124, the final order made in any rectification proceedings referred to in sub-

section (1) and (2) shall be binding upon the parties and the Court shall dispose of the suit in conformity to such order, insofar as it relates to the issue as to the validity of the registration of the trademark.

49. The fate of the suit before the Delhi High Court even if it was not dismissed for want of prosecution, would have been sealed by the IPAB order as the declaration issued by it on 18.06.2015 would be binding on the parties and also on the Court itself, particularly when the IPAB order is also based upon the Memorandum of Understanding reached between the parties and it would have bound the Court also.

Thus, we find merit in the submission of Mr. Khambata that the IPAB order being passed, the scope of the arguments advanced on behalf of the appellant is definitely constricted as the order declared, that the appellant shall restrict its operations only to five States and Union Territories.

50. The learned Single Judge, in impugned order, has rightly positioned his emphasis on the IPAB order, by observing that this order has clearly restricted the use of the impugned trademark “The New Indian Express” to five southern States and specified Union Territories and also restricted the use of the trademark for ‘any purpose, including advertising, promotion and events’ as this order is, according to the learned Single Judge, was in consonance with the terms of the MOS/ the consent decree.

51. The learned Single Judge has also applied the analogy “use of the mark” by placing reliance upon Section 2(2)(b) and 2(2)(c) of the Trade Marks Act, 1999 to render a finding that

the wide expansive understanding of use of a mark as defined by the statute would include usage for promotion and advertisement, which stands restricted to the five southern States and specified Union Territories by the IPAB order.

At this juncture we would refer to the statutory definition of “use” under the Trade Marks Act under Sections 2(2)(b) and 2(2)(c)(i), which read thus:

*“Section 2 (2): In this Act unless the context otherwise requires, any reference -(...)*

*(b) to the use of a mark shall be construed as a reference to the use of printed or other visual representation of the mark;*

*(c) to the use of a mark, -*

*(i) In relation to goods, shall be construed as a reference to the use of the mark upon, or in any physical or in any relation whatsoever, to such goods;”*

52. In *Hardie Tradings* (supra), what is the scope of the word “use” in Section 46(1) was posed in the background that an application for removal of a registered trademark is permitted to be allowed under Section 46(1)(b), only if a continuous period of five years or longer has elapsed upto the date of one month prior to the date of application during which there was no bona fide use by proprietor of the trademark. It was contended by the appellant *Hardie*, that there was no non-use of registered trade mark during said period and *Addisons* had failed to plead or establish this.

It was urged on behalf of the respondent that the word “use” means “actually putting the mark in the business and utilizing the same for selling of the goods” and since there was no use of trademark by *Hardie* and no efforts were taken to manufacture the goods using the trademark since 1971, it

must be therefore accepted that Hardie had abandoned the trademark.

With reference to Section 2(2)(b), it is held by the Apex Court that the use “may be other than physical; it may be in any other relation to the goods” and observed, “*We see no reason to limit the user to use of the goods or to sell of goods bearing trademark*”.

The following observations of the Apex Court deserve reproduction, being aptly applicable here :-

*“43. In Hermes Trade Mark 1872 RPC 425, the registered proprietor had inserted advertisements in which the trademark appeared in relation to the watches it manufactured in the annual trade publication. It was also in evidence that the registered proprietor placed an order for parts of the watches during the period of alleged non-use although the actual sale of the watches took place subsequently. In this factual background, the words, 'other relation' in an identical statutory provision in the United Kingdom were construed to mean "something other than actually being upon the goods or in physical relation to them - that would cover the use of the mark, ....., for example, in advertisements, in invoices, in orders and so on".*

*“It was also said, the phrase 'in the course of trade' must be wide enough to embrace the steps necessary for the production of the goods as well as the actual placing of them on the market. It was held that even though there was no use of the mark upon or in physical relation to the "goods, but it was used in "other relation", i.e. to say in non physical use.”*

53. With the aforesaid precedent before us throwing light on the ambit of word “use” and same phraseology being found in the form of restrictions in Clause 18(iv) of the MOS “by any use whatsoever” therefore deserve a broadest possible meaning to be assigned and we have no hesitancy in holding that it encompassed ‘Promotion and Advertising’. The rights

granted to the appellant were restricted to the territory, as against the rights retained with “Indian Express” was clearly set out in Clause 18(ii) by use of the following words:-

*“In relation to any use whatsoever... unlimited in point of territory or time”.*

54. A comparison of the rights conferred on the two parties, as per their own understanding being placed before the Madras High Court, make the distinction very clear.

When the terms of MOS and supplemental MOS are unambiguous and the parties understood it to be so, it is not open for the Court to assign a meaning contrary to their intention and understanding as we find that it is not permissible to be done in a contract executed between the parties and here we have a decree passed by the Competent Court based on an understanding arrived at between the parties, which according to us, bind them.

On clear reading of the Clauses of the MOS and the supplemental MOS, one thing which emerges with prominence, is the right retained by the “Express Group” when Clause 17 categorically provided “that Indian Express Newspaper (Bombay) Limited and Traders Limited” shall be absolute owners of their titles of newspapers and magazines (including supplement) currently published or not i.e. even for its future publications, with the emphasis on this right being available for “whole of India”. In contrast the very said clause clearly stipulating that the rivals, Manojkumar Sonthalia, Indian Express (Madurai) shall have no claim in relation to what is granted in favour of Indian Express Newspapers (Bombay) Limited and Trading Limited with negative covenant being imposed that they shall not any time “use” or “adopt” any of

the said titles in any way or any titles similar or resembling thereto” save and accept what is permitted to them in Clause 19. The understanding recorded in para 17, with the clear choice of words, being unambiguous, conferring the permission on Express Publication as set out in Clause 19 but at the same time recognizing the ownership of Express Group is clearly indicative of the restrictive user of the Madurai Group.

Clause 18 has again reinforced the intention of the parties that the title “Indian Express” absolutely vests in ‘Indian Express Newspaper (Bombay) Limited’, however, in respect of the five States and the Union Territories, Vivek Goenka, NPBS, Indian Express Newspaper (Bombay) Limited and Trading Limited or any corporation owned or controlled by them was also restricted from using the title, directly or indirectly (in relation to the print media) except the Financial Express, the weekly supplements, or other periodicals. With lot of clarity, Clause 18 conferred the title “Indian Express” on Indian Express Newspapers (Bombay) Limited absolutely.

It is also clarified that the title included not only rights in respect of publications of English language newspaper under the name “Indian Express” but also in relation to any ‘use’ whatsoever, in relation to print media, electronic media or any other medium whatsoever. The right conferred on “Indian Express” was specifically made unlimited in point of territory or time.

On the contrary, the right granted to Indian Express Madurai, on account of the permission granted was restricted only for publication of an English language daily newspaper in the specified five States and Union Territories and “for no

other purpose or any other area or territory in any use whatsoever”.

Further Clause 19 of the MOS imposed additional embargo by stating that Manojkumar Sonthalia, Indian Express Madurai, Andhra Prabha Limited and Sterling Newspaper shall not use the title Indian Express (i.e), at any time anywhere but subject to Clause 20 Indian Express Madurai Limited/NIEM was held entitled to publish an English language daily by the name “New Indian Express”, but again with condition attached with the expression “new” shall be in the same line and same size as the words “Indian Express” wherever the title appeared.

Another embargo is imposed by sub-clause (iv) of Clause 19, by providing that they shall not directly or indirectly used the title “Indian Express” or any of its derivatives or any title similar or resembling thereto at any time whatsoever provided the restrictions against the use of the word ‘Express’ shall not apply to the sections or supplements of “New Indian Express”, and in this section or supplements the word ‘Indian’ shall not be used alongside or otherwise with the word ‘Express’.

55. Reading of the MOS with the supplemental MOS make it evidently clear that the rights and ownership of the title conferred in Indian Express Group is unlimited both, on the point of territory and time and the title included not only the rights in respect of all publications of English Newspaper, but also in relation to any use whatsoever, whether it is in relation to print media or electronic media or any other medium whatsoever.

56. One striking feature is the incorporation of the condition in sub-clause (v) of Clause 19 when New Indian Express Madurai was permitted to request the Indian Express Newspaper to take steps to restrain any publication or publications which would infringe the title 'Indian Express or its derivatives' but if within period of 15 days no cognizance thereof is taken by the Indian Express Newspaper (Bombay) Limited then it is authorized to adopt such proceedings, 'on behalf and in the name of Indian Express Newspaper (Bombay) Limited' to restrain and stop such publication.

The condition that the appellant shall to act in the name of Express Group affirmed the ownership of Indian Express Group on all variants of "Indian Express" including "New Indian Express" as the right is conferred on it to institute any proceedings to protect its title.

Even after the execution of the supplemental agreement, this right is restricted in five southern States and specified Union Territories if there is any infringement of the title "New India Express" in the area of its operations but this right is also concurrently retained by the Indian Express Group and if any infringement occur outside the five southern States and the Union Territories i.e. anywhere in India, the right vests only in "Indian Express Group".

The above is a clear indication of the absolute right and ownership of "Indian Express" being subsisting in "Indian Express (P) Limited".

Thus, it can be seen that the source of right conferred on the appellant flows from the MOS and supplemental MOS and definitely it can not permitted to travel beyond its source.

57. With the wide phrased terminology being applied in the MOS as well as the supplemental MOS and in the background that the Indian Express is accepted as a well-known mark of the Indian Express Group, and with indication that at any point of time the Indian Express Group traded with its well-known mark but rather reading of the MOS and supplemental MOS, based upon the understanding between the parties make it adequately clear that it always intended to protect its “well-known mark” across of classes of goods and services and across the whole of India.

The use of the word “New Indian Express” by the appellant to conduct some sponsored commercial events though claimed to be stand-alone events in Mumbai from which it definitely generated revenue, thus runs contrary to the understanding arrived between the parties and with the Indian Express Group continuing to exercise its hold over the well-known mark. The appellant is permitted to use the “The New Indian Express” only for publication of English language daily newspaper in five southern States and Union Territories and for no other purpose or for any other area or territory for any other use whatsoever.

The wide use of the terms “any use whatsoever” is intended to cover every mode of exploitation of the mark and therefore, the event “New Indian Express Mumbai Dialogue” conducted by the appellant with independent sponsors is revenue generation event and offer sufficient justification for being objected by the owner of the title ‘Indian Express’ who has permitted to use of the mark “New Indian Express” by the appellant on specific understanding being reached and purely as business arrangement.

Though it is the stand of Mr. Andhyarujina that even his client has understood the terms of the MOS and supplemental MOS and has lived upto it and that there is no embargo in promoting/advertising its publications outside the five States and Union Territories, this argument failed to appeal to us.

The terminology used in the MOS clearly restricting the “use” of the title “New Indian Express” which was restricted only for publications, in our view do not admit ‘advertisement or promotion’ outside the five southern States and the Union Territories. Even the IPAB order dated 18.06.2015 had made it evidently clear that the appellant shall restrict itself only to five southern States for its area of operation including the use of the mark “New India Express”.

58. The registration of the mark by the Registrar of Trade Marks do not confer any right on the appellant as while obtaining the registration, the restriction imposed upon its use by the MOS and the supplemental MOS which received an imprimatur from the Madras High Court was not brought to the notice of Registrar. Now, when IPAB order has attained finality, as it is not challenged by appeal, it binds the appellant and though it is attempted to canvas before us that this order is only limited to Section 128, the statutory benefit and the common law rights accruing from the registration survives PAN India, we do not find merit in this submission. The Apex Court in *S. Syed Mohideen* (supra) in para 33 has held thus:

*“33. Fourthly, it is also a well-settled principle of law in the field of the trade marks that the registration merely recognises the rights which are already pre-existing in common law and does not create any rights. This has been explained by the*

*Division Bench of the Delhi High Court in Century Traders v. Roshan Val Duggar & Co. in the following words:*

*"10. 16.... First is the question of use of the trade mark. Use plays an all - important part. A trader acquires a right of property in a distinctive mark merely by using it upon or in connection with his goods irrespective of the length of such user and the extent of his trade. The trader who adopts such a mark is entitled to protection directly the article having assumed a vendible character is launched upon the market. Registration under the statute does not confer any new right to the mark claimed or any greater rights than what already existed at common law and at equity without registration. It does, however, facilitate a remedy which may be enforced and obtained throughout 'the State and it established the record of facts affecting the right to the mark. Registration itself does not create a trade mark. The trade mark exists independently of the registration which merely affords further protection under the statute. Common law rights are left wholly unaffected. (emphasis supplied)*

*33.1. The same view is expressed by the Bombay High Court in Sunder Parmanand Lalwani v. Caltex (India) Ltd. in which it has been held vide AIR para 32 as follows:*

*"1. A proprietary right in a mark can be ['Iruttukadai Halwa'] obtained in a number of ways. The mark can be originated by a person, or it can be subsequently acquired by him from somebody else. Our Trade Marks law is based on the English Trade Marks law and the English Acts. The first Trade Marks Act in England was passed in 1875. Even prior thereto, it was firmly established in England that a trader acquired a right of property in a distinctive mark merely by using it upon or in connection with goods irrespective of the length of such user and the extent of his trade, and that he was entitled to protect such right of property by appropriate proceedings by way of injunction in a court of law. Then came the English Trade Marks Act of 1875, which was substituted later by later Acts. The English Acts enabled registration of a new mark not till then used with the like consequences which a distinctive mark had prior to the passing of the Acts. The effect of the relevant provision of the English Acts was that registration of a trade mark would be deemed to be equivalent to public user of such mark. Prior to the Acts, one could become a proprietor of a trade mark only by user, but after the passing of the Act of 1875, one could become a proprietor either by user or by registering the mark even prior to its user. He could do the latter after complying with the other requirements of the Act,*

*including the filing of a declaration of his intention to use such mark. See observations of Llyod Jacob, J. in Vitamins Ltd.'s Application, In re at RPC p. 12, and particularly the following:*

*...A proprietary right in a mark sought to be registered can be obtained in a number of ways. The mark can be originated by a person or can be acquired, but in all cases it is necessary that the person putting forward the application should be in possession of some proprietary right which, if questioned, can be substantiated.*

*2. Law in India under our present Act is similar."*

*(emphasis supplied)*

*33.2. We uphold the said view which has been followed and relied upon by the courts in India over a long time. The said views emanating from the courts in India clearly speak in one voice, which is, that the rights in common law can be acquired by way of use and the registration rights were introduced later which made the rights granted under the law equivalent to the public user of such mark. Thus, we hold that registration is merely a recognition of the rights pre-existing in common law and in case of conflict between the two registered proprietors, the evaluation of the better rights in common law is essential as the common law rights would enable the court to determine whose rights between the two registered proprietors are better and superior in common law which have been recognised in the form of the registration by the Act."*

59. The registration is thus merely a recognition of the pre-existing rights in common law. In the facts of the case it was held that in case of conflict between the two registered proprietors, the evaluation of better rights in common law is essential as common law rights would enable the Court to determine whose rights between two registered proprietor is better and superior in common law which have been recognised in the form of registration by the Act.

The registration only recognizes pre-existing common law use and it do not confer the right. Appellant had never used the mark independently and its use flow from MOS and

therefore, its rights cannot control beyond nor operate in derogation of its terms.

60. The submissions of Mr. Andhyarujina that all the while Indian Express Group had maintained a stoic silence, when advertisements were issued by each of the party in each other's publications and therefore it amounts to acquiescence, we must note that the right of the appellant flow from a consent decree and if it desired to have any variation or modification of the said decree, it ought to have approached the Court which recorded the compromise. A consent decree cannot be varied by conduct of the parties and acquiescence definitely implies a positive act and mere inaction would not amount to acquiescence.

In *Power Control Appliances vs. Sumeet Machines Pvt. Limited*<sup>16</sup>, acquiescence is described thus:

*"26. Acquiescence is sitting by, when another is invading the rights and spending money on it. It is a course of conduct inconsistent with the claim for exclusive rights in a trade mark, trade name etc. It implies positive acts; not merely silence or inaction such as is involved in laches. In Harcourt v. White Sr. John Romilly said: "It is important to distinguish mere negligence and acquiescence." Therefore, acquiescence is one facet of delay. If the plaintiff stood by knowingly and let the defendants build up an important trade until it had become necessary to crush it, then the plaintiffs would be stopped by their acquiescence. If the acquiescence in the infringement amounts to consent, it will be a complete defence as was laid down in Mouson (J.G.) & Co. v. Boehm. The acquiescence must be such as to lead to the inference of a licence sufficient to create a new right in the defendant as was laid down in Rodgers v. Nowill."*

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16 (1994) 2 SCC 448

61. In the facts before us, we do find that the above observations fit into the facts at all, as the while the Indian Express Group contested the appellant's registration as it approached the IPAB; it filed the proceedings before the Bombay High Court and Delhi High Court and we can safely infer that it continue to assert its rights and for this reason the foundation of acquiescence and latches definitely collapses. There is no voluntary relinquishment on the part of the Indian Express Group and in fact what we find is if the use is found to be dishonest, then delay or acquiescence is of no relevance. The appellant being party to the MOS and supplemental MOS and the same being based on consent, definitely cannot claim ignorance of the rights that are conveyed on it and the rights that are continued by the Indian Express Group. We therefore, do not find a plea of acquiescence or delay to be sustainable and rather we have noted that when IPAB called the appellant to scrupulously follow the restrictions without slightest violation, it still continued with its ventures, on an assumption that it was entitled to do so.

Indian Express Group never acknowledged the conduct of the events for promotion though as far as advertisements are concerned, since there was a JAA which was executed by the parties recording consensual terms but even it was terminated with effect from 20.01.2011 and therefore, it cannot be definitely construed as open ended or permanent consent conferred on the appellant for PAN India use. After 2011, since no such arrangement continued and particularly with the IPAB order, it is imperative for the appellant to restrict itself to the territories assigned to it and strictly abide by the MOS and supplemental MOS.

62. Applying the test of *Wander Ltd. & Anr. vs Antox India P. Ltd. (supra)* we do not find any perversity or patent error or in the order passed by the learned Single Judge and therefore, by upholding the order we dismiss the present appeal.

The Interim Application stands disposed of.

(MANJUSHA DESHPANDE, J)

(BHARATI DANGRE, J.)

Andurkar