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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

+ C.O. (COMM.IPD-TM) 86/2022

**BENNETT COLEMAN AND
COMPANY LIMITED**

.... Petitioner

Through: Mr. Hemant Singh, Ms. Mamta
Rani Jha, Ms. Akansha Singh, Ms. Soumya
Khandelwal and Ms. Pragya Jain, Advs.

Versus

**E ENTERTAINMENT TELEVISION
LLC AND ANR**

.... Respondents

Through: Ms. Priya Adlakha and Ms.
Devyani Nath, Advs. for R-1
Mr. Harish Vaidyanathan Shankar, CGSC
with Mr. Srish Kumar Mishra, Mr.
Alexander Mathai Paikaday and Mr.
Krishnan V., Advs. for R-2

+ C.O. (COMM.IPD-TM) 243/2022

**BENNETT, COLEMAN AND
COMPANY LIMITED**

.... Petitioner

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**CORAM:
HON'BLE MR. JUSTICE C. HARI SHANKAR**


JUDGMENT (ORAL)

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16.11.2023

I.A. 19852/2023 (Order XI Rule 1(10) of the CPC) in C.O. (COMM.IPD-TM) 86/2022

I.A. 19851/2023 (Order XI Rule 1(10) of the CPC) in C.O. (COMM.IPD-TM) 243/2022

1. These are applications by Respondent 1 in petitions filed by the petitioner Bennett, Coleman and Company Ltd under Section 57¹ of the Trade Marks Act, 1999. The petitioner has, in its petitions, sought rectification of the register of trade mark by removal, therefrom, of the mark , which stands registered in favour of Respondent 1 *vide* Registration Nos. 2340887 in Class 38 and 1252812 in Class 38 and 41.


2. Respondent 1 E! Entertainment Television, LLC has, in its counter-statement filed by way of response to the petitioner's

¹ 57. **Power to cancel or vary registration and to rectify the register. –**

(1) On application made in the prescribed manner to the High Court or to the Registrar by any person aggrieved, the Registrar or the High Court, as the case may be, may make such order as it may think fit for cancelling or varying the registration of a trade mark on the ground of any contravention, or failure to observe a condition entered on the register in relation thereto.

(2) Any person aggrieved by the absence or omission from the register of any entry, or by any entry made in the register without sufficient cause, or by any entry wrongly remaining on the register, or by any error or defect in any entry in the register, may apply in the prescribed manner to



rectification petitions, pleaded, *inter alia*, that it has been using the  mark as part of its trading style since the early 1990s. In support of its submission, Respondent 1 relied upon a YouTube video titled “E Entertainment TV 1993 year in Review”, available at the URL link <https://www.youtube.com/watch?v=uMI3pSL2GA>. On the fact that Respondent 1 has indeed so pleaded in its response to the petitioner’s rectification petitions, there is no dispute.

3. The petitioner has, consequent to the filing of the counter-statement by Respondent 1, filed its rejoinder. Both sides have also filed documents as well as a list of their respective witnesses.

4. Respondent 1 has, at this stage, moved these applications under Order XI Rule 1(10)² of the Code of Civil Procedure, 1908 (CPC) as amended by the Commercial Courts Act, 2015. These applications essentially seek to place on record the YouTube video clip which, as per the application, corresponds to the URL link <https://www.youtube.com/watch?v=uMI3pSL2GA>, referred to in the written statement. The justification for seeking to place the said clip on record, at this stage, is found to be in paras 3 to 5 of each of these applications which, therefore, may be reproduced thus:

“3. That Respondent No. 1 has averred in its counter-statement that it has been extensively, continuously, and uninterruptedly


the High Court or to the Registrar, and the Registrar or the High Court, as the case may be, may make such order for making, expunging or varying the entry as it may think fit.

² (10) Save and except for sub-rule (7)(c)(iii), defendant shall not be allowed to rely on documents, which were in the defendant's power, possession, control or custody and not disclosed along with the written statement or counter-claim, save and except by leave of court and such leave shall be granted only upon the defendant establishing reasonable cause for non-disclosure along with the written statement or counter-claim;



providing its services under the name/mark E! as part of its trading style since the early 1990s. Respondent No. 1 has relied upon and filed various documents in support of its use and brand reputation, including a YouTube video titled 'E Entertainment TV 1993 Year in Review' available at the link <https://www.youtube.com/watch?v=uMI3pSL2GA>. It is a matter of fact that when the extracts of a YouTube video are saved in the form of a document, the media content is not displayed in the resultant file. Therefore, the screenshot filed by Respondent No. 1 showing the URL and date of download at pages 15-17 in the list of documents dated December 26, 2022, is in fact blank.

4. Consequently, the current version of the screengrab of the aforesaid YouTube video which is on the court file does not display

the  trademark of Respondent No. 1. *The screengrab displaying the trademark, which is generated from the same video link is reproduced herein below for the ready reference of this Hon'ble Court:*



5. It is submitted that filing the aforesaid document along with the corresponding video file in support of the authenticity of the screen grab is essential to prove the case of Respondent No. 1 and for the proper adjudication of the present dispute. Therefore, Respondent No. 1 seeks leave of this Hon'ble Court to place on record fresh screenshots of the 1993 YouTube Video available at the link <https://www.youtube.com/watch?v=uMI3pSL2GA>, as well as file the downloaded copy of the video file itself in a CD.”


(Emphasis supplied)

6. The prayer clause in these applications, which is identical read as under:

“In view of the facts and circumstances, the Respondent No. 1 most respectfully prays that this Hon'ble Court may be pleased to:



- (a) allow the present application and take the fresh extracts of the 1993 YouTube video on record;
- (b) grant leave to the Respondent No. 1 to file the downloaded copy of the 1993 YouTube video in a CD;
- (c) pass such other order as this Hon'ble Court may deem fit and proper in the facts and circumstances of the present case and to render justice to Respondent No. 1.”

7. Ms. Priya Adlakha, learned Counsel for Respondent 1, submits that grant of the prayers in these applications is necessary for complete justice to be done in these cases. She points out that the plea of the user, by Respondent 1, of the  mark w.e.f. the early 1990s is one of the main grounds on which Respondent 1 has sought to oppose the present rectification petitions. In order to establish this, proof of such user has to be placed on record. She submits that, in fact, she is not introducing any additional document by the present applications, as the link, the screenshot of which is sought to be placed on record, corresponds to the URL which is already filed by Respondent 1 with the written statement, and to which the written statement makes specific reference. The URL, without the corresponding YouTube video would, however, be of no use and would not assist the court in adjudicating the matter. It is, therefore, essential that the actual YouTube video is also on record. It is for this reason, she submits, that the present applications seek to place the screenshot of the YouTube video on record as well as permission to file the downloaded copy of the YouTube video in a CD.



8. Mr. Hemant Singh, learned Counsel for the petitioner vehemently opposes the applications. He submits that, in the first place, such an application is not maintainable in a rectification petition filed under Section 57 of the Trade Marks Act. He has drawn my attention, in this context, to Rule 7 of the IPD Rules 2022, applicable to this Court. He submits that Rule 7(ii)³ specifically requires the parties to file all documents along with their respective pleadings. To the same effect, points out Mr. Hemant Singh, is Rule 2(i)⁴ in Chapter VII of the Delhi High Court (Original Side) Rules, 2018 (“the Original Side Rules”). The IPD Rules contain no provision analogous to Order XI Rule 1(10) of the CPC, enabling the defendant to file additional documents after the written statement has been filed. He further submits that Rule 7(xiii)⁵ of the IPD Rules cannot come to the aid of Respondent 1, as it does not envisage incorporation, by reference, into the IPD Rules, of any provisions of the CPC or the Commercial Courts Act, which are inconsistent with the IPD Rules. Where, therefore, the IPD Rules specifically require the documents to be filed with the pleadings, there is no provision permitting documents to be filed at a later stage, Mr. Hemant Singh’s contention is that the Court

³ (ii) The parties shall also file all other relevant documents in support of the relief sought in the original petition. If interim orders are sought by the Petitioner, an application under Order XXXIX Rule 1 and Rule 2, Code of Civil Procedure, 1908 shall be filed setting out the grounds for such interim order. Averments shall be made in the original petition specifying as to which of the documents filed form part of the record of the IPO.

⁴ 2. **Procedure when defendant appears.** – If the defendant appears personally or through an Advocate before or on the day fixed for his appearance in the writ of summons: —

(i) where the summons is for appearance and for filing written statement, the written statement shall not be taken on record, unless filed within 30 days of the date of such service or within the time provided by these Rules, the Code or the Commercial Courts Act, as Page 23 of 71 applicable. An advance copy of the written statement, together with legible copies of all documents in possession and power of defendant, shall be served on plaintiff, and the written statement together with said documents shall not be accepted by the Registry, unless it contains an endorsement of service signed by such party or his Advocate.

⁵ (xiii) **Procedures applicable to original petitions:** The provisions of the Commercial Courts Act, 2015, Delhi High Court (Original Side) Rules, 2018 and orders as also the practice directions issued from time to time, to the extent there is no inconsistency with these Rules, shall be applicable to original petitions



cannot seek recourse to Order XI Rule 1(10) of the CPC to allow such documents to be taken on record. He relies on the decision of a Division Bench of this Court on *Ram Sarup Lugani v. Nirmal Lugani*⁶, in order to submit that the Delhi High Court Original Side Rules and the IPD Rules would prevail over the provisions of the CPC, where there is inconsistency between them.

9. Without prejudice, Mr. Hemant Singh submits, further, that, even on merit, the prayer in these applications ought not to be allowed. Order XI Rule 1(10) of the CPC, he points out, permits additional documents to be taken on record only if they were not originally in the power and possession of the defendant and, if they were, on the defendant showing sufficient cause for not filing the said documents with the written statement. In the present case, the YouTube video which Respondent 1 seeks to place on record by means of these applications, he points out, was certainly within Respondent 1's control, if the averments in the applications are to be believed, as Respondent 1's own case is that the video corresponds to the URL which has been filed with the written statement. If that is so, Mr. Hemant Singh submits that, in the absence of any cogent reason as to why the said video link was not filed with the written statement, the Court ought not to permit it to be taken on record at this stage, when the petitioner has already filed its replication and both sides have also placed their evidence on record. He submits that there is no way in which, at this stage, he can test the veracity of the submission of Respondent 1 that the video clip that these applications seek to



place on record corresponds to the URL link <https://www.youtube.com/watch?v=uMI3pSL2GA>, referred to in the written statement.

10. I have heard learned Counsel for both sides and have examined the matter in light of the applicable rules.

11. I address, first, the preliminary objection of Mr. Hemant Singh that the present applications are not maintainable at all, as this proceeding is not a suit, but a rectification petition under Section 57 of the Trade Marks Act. Following the law laid down by the Division Bench of this Court in *Ram Sarup Lugani*, there can be no doubt that the procedure to be followed, in respect of all matters in the Intellectual Property Division (IPD) of this Court, has to be governed, pre-eminently, by the IPD Rules. The provisions of the CPC, the Commercial Courts Act, and the Original Side Rules, would apply only to the extent the IPD Rules so provide.

12. The procedure to deal with rectification petitions is, as Mr. Hemant Singh correctly points out, contained in Rule 7 of the IPD Rules. However, Rule 7(xiii) makes the provisions of the Commercial Courts Act, 2015 to the extent they are not inconsistent with the IPD Rules, applicable to original petitions, such as these.

13. The amendments to the CPC, as effected by the Commercial Courts Act, constitute the Schedule thereto and are, therefore, an integral part of the Commercial Courts Act itself. The reference to the



“Commercial Courts Act” in Rule 7(xiii) of the IPD Rules would, therefore, include, within its sweep, the amendments to the CPC as made by the Commercial Courts Act, which includes Order XI Rule 1(10). To the extent they are not inconsistent with the IPD Rules, therefore, the amendments to the CPC by the Commercial Courts Act would also apply to rectification petitions filed under Section 57 of the Trade Marks Act.

14. Order XI Rule 1(10) of the CPC, as amended by the Commercial Courts Act, allows additional documents to be placed on record by the defendant, in addition to the documents filed with the written statement, subject to satisfaction of the pre-requisites envisaged in the said Rule.

15. The question that is to be addressed is, therefore, whether Order XI Rule 1(10) of the CPC would apply in the case of rectification petitions filed under Section 57 of the Trade Marks Act.

16. Certainly not, Mr. Hemant Singh would contend. Rule 7(xiii) of the IPD Rules incorporates, by reference, only those provisions of the Commercial Courts Act which are not inconsistent with the IPD Rules. Inasmuch as Rule 7(ii) of the IPD Rules requires the documents to be filed with the pleadings, and there is no provision permitting documents to be filed thereafter, Order XI Rule 1(10) of the CPC, inasmuch as it does permit such later filing, conflicts with the IPD Rules and cannot, therefore, apply.

Can Order XI Rule 1(10) of the CPC be invoked in the case of



rectification petitions under Section 57 of the Trade Marks Act?

17. I confess my inability to agree with Mr. Hemant Singh submission that allowing the defendant to place additional documents on record, after the written statement is filed would conflict with the IPD Rules. Rule 7(xiii) of the IPD Rules specifically makes the Commercial Courts Act, 2015 – and, therefore, the amendments to the CPC as contained in the Commercial Courts Act, 2015 – *ipso facto* applicable to original petitions i.e., rectification petitions preferred under Section 57 of the Trade Marks Act. In my opinion, allowing such documents to be taken on record does not militate against any of the provisions of the IPD Rules. *The IPD Rules do not contain any provision which proscribes taking of additional documents on record, unlike the Original Side Rules, which does contain such a provision, in Rule 14⁷ in Chapter VII.*

18. *In fact, there is no provision in the IPD Rules requiring the documents, in Civil Original Petitions (which include petitions under Section 57 of the Trade Marks Act), to be filed with the respective pleadings, corresponding to Order XI Rule 1(7)⁸ of the CPC as*

⁷ 14. **No documents to be filed after completion of pleadings.** – Except as provided in Order XIII of the Code and these Rules, neither party shall be entitled to file any documents after completion of pleadings in the suit. Upon failure of parties to file their respective documents and/ or file the respective documents on completion of filing of pleadings, in accordance with these Rules, the Registrar shall forthwith place the matter before Court.

⁸ (7) The defendant shall file a list of all documents and photocopies of all documents, in its power, possession, control or custody, pertaining to the suit, along with the written statement or with its counter-claim if any, including –

- (a) the documents referred to and relied on by the defendant in the written statement;
- (b) the documents relating to any matter in question in the proceeding in the power, possession, control or custody of the defendant, irrespective of whether the same is in support of or adverse to the defendant's defense;
- (c) nothing in this rule shall apply to documents produced by the defendants and relevant

only –

- (i) for the cross-examination of the plaintiff's witnesses,



amended by the Commercial Courts Act. Carefully read, it would be seen that Rule 7(ii) only requires “the *parties* (to) also file all other relevant documents ...” without specifying that the documents have to accompany the corresponding pleadings. In fact, Rule 7(ix)⁹ of the IPD Rules envisages filing of a reply to the Civil Original Petition if so, directed by the Court, with no stipulation regarding the stage at which documents, in support of the reply, can be filed by the respondent. Needless to say, however, the respondent cannot be denied its right to file documents supporting its reply to the rectification petition. The stage at which the documents can be filed has, however, been left open-ended in Rule 7 of the IPD Rules. Allowing the defendant, the benefit of Order XI Rule 1(10) of the CPC, in the matter of filing additional documents in support of the reply to the rectification petition would not, therefore, *stricto sensu* infract any of the provisions of Rule 7 of the IPD Rules.

19. Even if it were to be assumed, *arguendo*, that Rule 7 of the IPD Rules requires, by implication, documents in support of the counter-statement/reply to the rectification petition to be filed with the counter-statement/reply, such a requirement would only correspond to Order I Rule 1(7) of the CPC as amended by the Commercial Courts Act. Order XI Rule 1(10) of the CPC provides for an *additional opportunity to file documents*, in addition to the right to file documents with a written statement. It does not, therefore, conflict

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- (ii) in answer to any case setup by the plaintiff subsequent to the filing of the plaint,
or
(iii) handed over to a witness merely to refresh his memory.

⁹ (ix) Reply, if so directed, shall be filed within the period prescribed by the Court or shall be filed within 60 days from the date on which the Court directs the filing of such Reply.



with Order I Rule 1(7). Neither, per corollary, could such a right be said to conflict with the requirement of filing documents with the counter-statement/reply to the rectification petition, assuming any such requirement can be read into Rule 7 of the IPD Rules. There is no provision in the IPD Rules which *proscribes* taking of additional documents on record, after the reply/counter-statement has been filed by the respondent.

20. In that view of the matter, I am of the opinion that Order XI Rule 1(10) of the CPC as amended by the Commercial Courts Act would be applicable, *mutatis mutandis*, to rectification petitions, in view of Rule 7(xiii) of the IPD Rules.

21. Though I have examined the matter with respect to the right of the respondent to file additional documents under Order XI Rule 1(10), as that is what the present application concerns itself with, this principle would equally apply to the right of the petitioner to file additional documents in terms of Order XI Rule 1(4) or (5) of the CPC, as amended by the Commercial Courts Act.

22. The preliminary objection of Mr. Hemant Singh regarding the maintainability of the present applications, therefore, in my view, is bereft of substance and accordingly rejected.

On merits

23. On merits, Ms. Adlakha has pointed out that the clip, as sought to be placed on record, is merely the clip which corresponds to the



URL link <https://www.youtube.com/watch?v=uMI3pSL2GA> to which reference is already contained in a written statement, and which forms part of the documents filed with the written statement. Her submission is that, unfortunately, by merely clicking the said URL link, the video clip would not be thrown up. It is only to place on record the video clip which corresponds to the URL which is already one of the documents filed with the written statement, therefore, that the present application has been filed.

24. Whether the YouTube video clip which Respondent 1 seeks to place on record with the present applications does, or does not, correspond to the URL filed with the written statement is not something which this Court is required to examine while adjudicating the present applications. Ms. Adlakha says that it does. It shall always be open to the petitioner to contest the correctness of this submission at the appropriate stage. The onus would undoubtedly be on Respondent 1 to prove that the video clip filed with this application actually corresponds to the URL link <https://www.youtube.com/watch?v=uMI3pSL2GA>. Any misgivings that the plaintiff may have on that score are, therefore, unfounded.

25. This Court is also not concerned with the relevance of the video clip which is being sought to be placed on record with these applications or whether it substantiates the case that Respondent 1 has set up in the counter-statement by way of response to the rectification petitions. The validity, correctness and relevance of the video clip are all matters which the petitioner could contest during the hearing of the



rectification petitions and this Court leaves all defences in that regard open to the petitioner to be urged at the appropriate stage.

26. Insofar as taking the video clip on record is concerned, I am of the concerned opinion that the Court has to view the matter *ex debito justitiae*. Times without number, the Supreme Court has stressed and re-stressed that the provisions of the CPC and other procedural provisions cannot prevail over considerations of substantial justice. It is also obvious that, in order for a Court to effectively adjudicate on a *lis*, all relevant material has to be before the Court.

27. Had Respondent 1 been seeking to introduce, by way of the present applications, a document which was foreign to the written statement and which constitutes an entirely new document then, perhaps the situation would have been more arguable. The avowed stand of Respondent 1, in these applications, is that the YouTube video link, the screenshot of which has been provided in the applications, and which Respondent 1 seeks to place on record by way of CD/pen drive is in fact the video which corresponds to the URL link <https://www.youtube.com/watch?v=uMI3pSL2GA>, to which reference is contained in the written statement and which forms one of the documents filed with the written statement. For the purposes of deciding whether to grant, or refuse, the prayers in this application, that stand has to be treated as correct. As already noted, Mr. Hemant Singh does not specifically contest the correctness of the contention; his only submission is that he may not be able to verify its correctness at this stage. As already observed, it would be for the defendant to substantiate its assertion that the clip in fact corresponds to the URL



<https://www.youtube.com/watch?v=uMI3pSL2GA>, and the right of the plaintiff to assert to the contrary remains reserved.

28. Assuming the video clip that these applications seek to place on record does correspond to the URL <https://www.youtube.com/watch?v=uMI3pSL2GA>, it would be a travesty of justice if this Court were to deny Respondent 1 the right to place it on record, especially as reference to the URL link <https://www.youtube.com/watch?v=uMI3pSL2GA> finds place in the written statement and has been filed as one of the documents accompanying the written statement.

29. To that extent, in fact, Ms. Adlakha is correct in her submission that the video clip that these applications seek to place on record is not, in fact, an additional document at all, as it corresponds to the URL link <https://www.youtube.com/watch?v=uMI3pSL2GA> which is already one of the documents filed with the written statement. Even *de hors* the issue of the right of the respondent to place additional documents on record after the reply/counter-statement to the rectification petition has been filed by it, therefore, Respondent 1 would be entitled to place the video clip on record.

30. Accordingly, reserving liberty with the petitioner to contest the claim of Respondent 1 that the video clip that Respondent 1 seeks to place on record by means of these applications actually corresponds to the URL link <https://www.youtube.com/watch?v=uMI3pSL2GA>, filed with the written statement and further reserving liberty with the petitioner to contest the validity and relevance of the said video link as



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well as all other defences in that regard, this Court is of the opinion that Respondent 1's applications to place on record the said video clip deserve to be allowed.

31. Accordingly, both the applications are allowed. Respondent 1 is permitted to place on record what it claims to be the downloaded copy of the YouTube video corresponding to the URL link <https://www.youtube.com/watch?v=uMI3pSL2GA>, by means of a pen drive and provide an advance copy thereof to learned counsel for the petitioner.

32. Inasmuch as the present document is being permitted to be taken on record at this stage, the petitioner would be at liberty to admit or deny the document and also file an additional affidavit contesting the validity and relevance of the YouTube video link and raise of other defences in that regard, as noted hereinabove, within a period of four weeks from today.

33. These applications stand allowed accordingly.

C.HARI SHANKAR, J

NOVEMBER 16, 2023

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Click here to check corrigendum, if any