

O-030-05

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 81371
FOR A DECLARATION OF INVALIDITY IN RESPECT OF
TRADE MARK REGISTRATION No. 2283796
IN THE NAME OF AJIT NEWSPAPER ADVERTISING**

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for a Declaration of Invalidity in respect of
Trade Mark Registration No. 2283796
in the name of Ajit Newspaper Advertising**

BACKGROUND

1. Trade mark No. 2283796 is for the following mark which is registered in Class 16 for a specification of “Printed matter, photographs, teaching material, printed publications, newspapers”:



Mark claim / limit:

The Hindi and Punjabi characters and word in the mark mean “Invincible”.

2. The mark stands registered from a filing date of 24 October 2001.
3. On 30 July 2003 Sadhu Singh Hamdard Trust applied for the invalidation of the trade mark and provided the following background comments in their statement of grounds:
 - (i) The Applicant for the declaration of invalidity, Sadhu Singh Hamdard Trust (hereafter referred to as “the Applicant”), is the publisher of a daily newspaper in Jalandhar, Punjab, India and an example of the masthead of the newspaper is shown in Annex one to this decision.
 - (ii) The masthead comprises the Punjabi word ਅਜਿਤ in red, stylised lettering (“the AJIT logo”). The word is transliterated in English as AJIT and it means “invincible”.
 - (iii) The Applicant claims that it is and was at all relevant times the true owner of the following trade marks:

- (a) AJIT in plain Punjabi script: ਅਜੀਤ
- (b) AJIT in plain Latin script: AJIT
- (c) AJIT logo: ਅਜੀਤ
- (iv) The Applicant's newspaper has been published continuously under the trade mark AJIT since 1959. The AJIT logo has been used in its present form since at least 1984. The newspaper is predominantly in the Punjabi language and has the largest circulation of any Punjabi language newspaper in the world: approximately 300,000 copies daily with a readership of approximately 2.5 million. The name of the newspaper is a household name in Punjab and is well known among the Punjabi community worldwide. The business of the Applicant includes not only the sale of newspapers but also the sale of advertising space in its newspapers. The Sunday edition of the newspaper includes a magazine supplement.
- (v) The Applicant has for many years supplied a small number of copies of its newspaper directly to libraries and other regular subscribers in the United Kingdom. A larger number of copies of the newspaper are supplied to retail outlets in the United Kingdom by distributors who are not under the control of the Applicant.
- (vi) On 24 October 2001, Ajit Newspaper Advertising, Marketing and Communications Inc (hereafter referred to as "the Proprietor") registered as British trade mark 2283796 a sign comprising an exact copy of the AJIT logo, accompanied by the words AJIT WEEKLY, in respect of the following goods in Class 16: *Printed matter, photographs, teaching material, printed publications, newspapers*. Since April 2003, the registered proprietor of the mark in suit has been publishing a weekly Punjabi newspaper in the United Kingdom using a masthead that incorporates an exact copy of the AJIT logo, accompanied by the words either UNITED KINGDOM or AJIT WEEKLY.
- (vii) The relevant sector of the public in the United Kingdom who may wish to purchase the Applicant's or the Proprietor's newspapers is limited to those who can read the Punjabi language.

4. The applicant has set out the following grounds of invalidation:

- (i) Under Section 47(2)(a) of the Act because there is an earlier trade mark in relation to which the conditions set out in Section 5(2)(b) of the Act obtain, in that the applicant's trade marks identified in paragraph 3(iii) (above), are entitled to protection as well known trade marks within the meaning of Section 56 of the Act, Article 6 bis of the Paris Convention and under Article 16 of the TRIPS Schedule to the WTO Agreement and therefore fall within the meaning of Section 6(1)(c) of the Act in respect of newspapers and magazines;
- (ii) Under Section 47(2)(b) of the Act because there is an earlier right in which the condition set out in Section 5(4) is satisfied, in particular Section 5(4)(a), in that the mark in suit is liable to be prevented by the law of passing off as use of the mark in

suit has caused confusion amongst the relevant public in the UK, damaged the applicant's business and tarnished the reputation of the applicant;

(iii) Under Section 47(1) of the Act because the registered proprietor filed the application in bad faith knowing that the mark was not its own, contrary to Section 3(6) of the Act.

5. The registered proprietor filed a counterstatement denying the grounds of invalidity adding that:

(i) the applicant is not the true owner of the AJIT logo with reference to the UK;

(ii) while the applicant's newspaper may be well known in the Punjab it is not well known among the Punjabi community worldwide and the registered proprietor has been unable to obtain a copy of the applicant's newspaper in the UK;

(iii) The applicant's AJIT logo is different to the mark of the registered proprietor;

(iv) the registered proprietor's newspaper is free and as it contains sections in the English language, English speaking people may read it and its readership is not limited to Punjabi speakers;

(v) the registered proprietor claims earlier rights under Section 6(1)(c) of the Act as they have published a weekly newspaper using the name the AJIT in Canada and the USA for a number of years.

6. Both sides filed evidence and asked for an award of costs in their favour. The matter came to be heard on 15 December 2004 when the applicant for invalidity was represented by Mr Hamer of Counsel instructed by Serjeants and the registered proprietor was represented by Ms McBride of Withers and Rogers, the registered proprietor's professional advisors in these proceedings.

APPLICANT'S EVIDENCE

7. The applicant's evidence consists of twenty-five witness statements.

8. The first witness statement is by Prem Singh and is dated 11 November 2003. Mr Singh is Chairman of the Sadhu Singh Hamdard Trust (the Trust), the applicant.

9. Mr Singh explains that the Trust is the publisher of a daily newspaper in the Punjab known as Ajit and has used the Ajit logo. The Ajit newspaper was first published in Jalandhar on 1 November 1955 under the name "Ajit Patrika and the name was changed simply to "Ajit" meaning "unconquerable" or "invincible" on 17 January 1959 and the name has been used continuously since then. In support, Mr Singh refers to Exhibit PS1 to his statement which contains:

(i) a copy of a Certificate of Registration from the Office of the Registrar of Newspapers for India;

(ii) a copy of a confirmatory letter dated 1974 countersigned by an Information Officer of the Press Information Bureau of the Government of India;

(iii) copies of Indian legislation to illustrate that in India registration of a newspaper's name prevents any other person from registering and publishing a newspaper under the same name in India.

10. Mr Singh goes on to explain that the founder of the "Ajit" newspaper was Dr Sadhu Singh Hamdard, who was Chief Editor and full owner until his death in 1984. Mr Singh provides biographical details of Dr Hamdard who was awarded the honour of "PADAMSHREE" from the Government of India, which he later returned in protest. Mr Singh states that in 1977, Dr Sadhu Singh Hamdard decided to denote all his property to the cause of development of Punjabi people, language and culture. He created a public charitable trust and denoted all the assets of the "Ajit" newspaper to the Trust. Mr Singh took over chairmanship of the Trust in 1996.

11. Mr Singh refers to Exhibit PS2 to his statement which contains a selection of photocopies showing the evolution of the masthead of the Ajit newspaper from 1959 to 1993 and he states that the stylised presentation of the name "AJIT" in Punjabi characters reached its present form ("the AJIT logo") by 1984. Mr Singh adds that the AJIT logo is not a standard font but is especially stylised and distinctive. He goes on to compare the AJIT logo with the word Ajit in two standard Punjabi fonts, stating that the most unusual part of the AJIT logo is the "hook" above the word, which is flattened and extends further to the left across adjacent characters. Also the "hook" at lower right is cut off to form a flat lower edge.



Standard font (1)

Standard font (2)

AJIT logo

12. Next Mr Singh refers to Exhibit PS3 to his statement which contains an edition of the Ajit newspaper dated Sunday, 21 October 2001 (which is just before the trade mark in dispute was applied for). Exhibit PS3 also contains a set of the seven daily editions of Ajit from Monday, 27 October 2003 to Sunday, 02 November 2003. He states that the masthead, the format and the general contents of the newspaper are substantially the same in all these examples with the masthead dominated by the bold, red AJIT logo. He explains that the small Punjabi characters above the logo mean "Voice of Punjab" and do not form part of the name of the newspaper. In small Latin characters below the AJIT logo are the informative words "Daily Ajit, Jalandhar" followed by information such as the date and the price of the newspaper.

13. Mr Singh provides details of the contents of "Ajit" which, he says, are typical of a daily newspaper with magazine supplements accompanying the newspaper for six days every week. 90% of the newspaper is in Punjabi with a small amount of English, principally advertisements. He states that ten editions of the newspaper are published daily.

14. Mr Singh refers to Exhibit **PS4** to his statement which is a bundle of certificates for the period 1975-2002 from the Audit Bureau of Circulations, an autonomous body which certifies the circulation figures of all the newspapers and periodicals in India. He explains

that the figures certified by this Bureau are considered to be the most and only authenticated and trusted by the Government, Semi Government and big advertising agencies. (The figures in the certificates are divided by commas in the Indian style, whereby one million is written as 10,00,000.) In January 1975, the average daily circulation of Ajit was 23,467. The circulation first passed 100,000 in November 1984 and by the end of 1992 the average daily circulation had climbed to 184,032. As per the certificate for the period July 2001 to December 2001, Ajit had registered a circulation figure of 245,017 in October 2001, when the disputed trade mark application was filed.

15. Mr Singh states that the Audit Bureau of Circulations publishes a six-monthly report of all newspapers in India. Exhibit **PS4** to his statement also contains a copy of the audit reports for 1990, which show that in the period January-June 1990 the circulation of Ajit outside India was 87 and in the period July-December 1990 the circulation of Ajit outside India was 77. Exhibit **PS4** also contains a copy of a certificate from another autonomous body, ie. I.R.S. Survey Report, from July 2000 to June 2001, according to which each copy of Ajit is read on average by at least 8 persons. Mr Singh concludes that the readership of Ajit in October 2001 comes to more than 1,960,136 copies every day. Mr Singh states that the current circulation of Ajit has further increased to 300,700 copies and he refers to the Exhibit **PS8**, which contains copies of the daily print orders to support these figures. Mr Singh concludes that readership today comes close to 2.5 million which is almost 10% of the total population of Punjab.

16. Turning to the position in the UK, Mr Singh points out that many people have migrated from the Punjab, have close family ties there, and will have come across the "Ajit". He goes on to state that the "Ajit" has been sent to subscribers in the United Kingdom and other countries since before 1990. He explains that since Ajit is a daily paper, its circulation beyond India is thin due to the factor of late delivery. It cannot reach the hands of the customers on the same day beyond India so it is not a practical way for Punjabis living in the UK to receive the latest news from Punjab. The Sunday edition contains the Ajit magazine and a review of the week's news so it is of more enduring interest and some subscribers elect to receive only the Sunday edition. A few copies of the Ajit newspaper are sent directly from the publisher in India to subscribers in the United Kingdom. Mr Singh refers to the Exhibit **PS5** to his statement which includes a list of the number of direct subscribers to Ajit for each six-month period from 1990 to 2002. Subscribers in the United Kingdom are shown in the top row, labelled "England". Exhibit **PS5** also includes a list of some of the names and addresses of those subscribers in the United Kingdom. Among the subscribers are public libraries and other institutions, where daily copies of Ajit are made available to the Punjabi community in the UK. Mr Singh notes that from the Affidavit made by Gurjeet Singh Samra, the library where he is a senior librarian has subscribed to daily copies of Ajit for nine years. On 24 October 2001, Exhibit **PS5** shows a total of thirteen subscribers, one of which is a library. As on 15 October 2003, Exhibit **PS5** shows 26 subscribers, four of which are libraries.

17. Mr Singh states that in addition, most copies of Ajit are not sent directly from the publishers to customers, but are supplied via distribution companies, who are not under the control of the Trust, and many copies of the newspaper reach the United Kingdom in this way and are sold there through general news agents and other vendors. He is unable to provide precise numbers of these copies but states that it is clear from the evidence filed on behalf of the applicant by members of the UK Punjabi community that they are able to obtain and read copies of "Ajit" in the UK even if they are not subscribers.

18. Mr Singh submits that the registered proprietor's publication, the Ajit Weekly newspaper, is aimed at the same market as Ajit, namely members of the Punjabi community who can read Punjabi, and the differences in content of the two newspapers only become apparent when they are read more carefully, after they have been acquired. He says a first difference is that the political stance and policies of both papers are quite opposite and explains that the Ajit is committed to the cause of the Punjab State and supporting the general policies of Shiromani Akali Dal, the oldest and the largest Sikh political Party in Punjab, and other Sikh organisations helping the Sikh community, whereas the Ajit Weekly is pursuing the policy of the Congress government in Punjab, which is guided by their High Command at New Delhi and is generally unconcerned with the Punjab interest on various issues. Thus the readers of Ajit Weekly, Mr Singh claims, who have been confused in assuming that it is associated with Ajit, have accused the Trust of double standards by sponsoring different political views in different editions in India and UK. Furthermore, United Kingdom Punjabi Community Leaders are accusing the applicant of adopting double standards in political matters. Mr Singh goes on to state that a second difference between Ajit and Ajit Weekly is that Ajit Weekly carries many advertisements for black magic practitioners. He makes reference to pages of the Ajit Weekly newspaper in Exhibit **PS6**, to his statement adding that for example enormous advertisements cover the whole of the back page and the whole of the centre page spread. Mr Singh explains that such advertisements are generally against the Sikh religious tenets and feelings and are generally not accepted for publication in the Ajit. Because of such advertisements, Mr Singh has been informed that the Ajit Weekly has been banned from some Sikh temples in the United Kingdom.

19. Turning to the bad faith ground, Mr Singh states that on page 3 of each edition of Ajit Weekly the Editor-in-Chief is named as Dr Professor Darshan Singh. Mr Singh then refers to Exhibit **PS9** to his statement which contains a Business Information Report from the firm Dun & Bradstreet in respect of Ajit Newspaper Advertising, Marketing and Communication Inc., which is the proprietor of the trade mark in dispute. The Report states that Dr Darshan Singh has been the President of the company since its foundation in 1992. He is also a director and a 50% owner of the company. Exhibit **PS9** also contains an extract from a publication entitled "Shergill's Indians Abroad". According to the information, Dr Darshan Singh lived in Jalandhar for a very long time and for 21 years he was a professor in Jalandhar City, which is a city of about 700,000 people where Ajit is published. Mr Singh concludes that it is therefore certain that Dr Professor Darshan Singh would have been fully acquainted with Ajit and its style, contents and logo and its popularity among the Punjabi people. Mr Singh also submits that the choice of the name and the decision by Mr Singh to use the identical logo indicates that he knew of the reputation of Ajit among the worldwide Punjabi community and wished to benefit from the good name and popularity of Ajit. He contends that the trade mark in dispute was applied for in the knowledge that the name Ajit was well known among the Punjabi community in the UK as identifying the Ajit newspaper published by the Trust and in the knowledge that confusion would thereby arise. Therefore the trade mark was registered in bad faith.

20. Mr Singh concludes by stating that as the Punjabi Community has spread and settled throughout the world, the Trust has discussed whether to expand its activities abroad to meet the Punjabi Community's demand and also to promote the cause of Punjabi language, culture and people. However, due to misuse of the name of Ajit and its logo by Ajit Weekly and due to the registered trade mark, the trustees are feeling handicapped in expanding their activities by publishing an "Ajit" newspaper in the UK.

21. Mr Ajaib Singh's witness statement is dated 10 November 2003. He migrated from Punjab to the UK in 1968 and is Managing Director of Cheville Clothing Ltd and a Trustee and General Secretary of a charity called International Akaal Mission.

22. Mr Ajaib Singh explains that before migrating to the UK he was a regular reader of "Ajit" in India and that since 1996 he has been reading the "Ajit" in his local library in Leicester, which takes the paper daily. He now subscribes to the Sunday edition and when he has read the paper he takes it to the canteen of the Cheville clothing factory, where it is generally read by four other Punjabi employees.

23. Mr Ajaib Singh explains that he mistakenly acquired a free copy of the registered proprietor's Ajit Weekly from local butchers under the impression it was the "Ajit" published in the UK, as the logo looked the same. He found the policy and material to be different e.g. Ajit Weekly contained "black magic" advertisements and telephoned the Ajit Office in the Punjab to be told that he had acquired a totally different newspaper.

24. By way of background Mr Ajaib Singh explains that immigration to the UK from the Punjab began to become common in the late 1950's and that most Punjabis in the UK still have close family ties with Punjab and four airlines fly from the UK to Punjab. In his opinion anyone visiting Punjab would frequently encounter and be familiar with the "Ajit" newspaper.

25. Ajit Singh Dost's witness statement is dated 15 December 2003. He migrated to the UK in 1965 and after retirement has been an active member of the Sikh Missionary Society UK (a registered charity). He explains that he came across a freely distributed Punjabi weekly newspaper with the same name and appearance as the "Ajit" and thought the "Ajit" had commenced publication in the UK. However, on reading the newspaper, he found that some of the contents were contrary to the policy of the "Ajit" and he subsequently protested.

26. Similar witness statements going to the applicant's reputation and confusion are provided by: Ajmar Singh Basra (President of Guru Nanak Dev Ji Sikh Temple, Leicester); Amarjit Singh Dhillon (Vice President Sri Guru Singh Sabha – the largest Sikh temple outside India, Secretary General Shiromani Akali Dal UK); Bachittar Singh (Ex President of Sri Guru Singh Sabha Gurudwara, Southall); Daljit Singh Sahota (Director of Royal Graphics Ltd and Chairman of Indian Overseas Congress Party UK); Dildar Singh (who owns and runs a newsagents shop called DS News in Leicester); Gurbax Singh Virk (Chief Editor of the Punjabi Weekly 'Des Pardes' in the UK); Gurminder Singh Thind (General Secretary, Sikh Sewak Jatha, UK); Himmat Singh Sohi (President Sri Guru Singh Sabha, one of the largest Sikh temples outside India); Karam Singh (I) (President of the Lokh Bhalai Party, Walsall); Dr Karnail Singh (a Hospital Practitioner in Leicester, Director of the Institute of Punjabi Arts, Culture and Education and Editor of the Punjabi Literary Magazine called "Akhar", Chairman of the Punjabi Academy Leicester Ltd); Manjit Singh Bhambra (President MDA Entertainment Hayes (UK)); Mohinder Singh Khaira (President Gurdwara Amrit Parchar Dharmik Deewan, Birmingham); Surinder Pal Singh (elected member in Braunstone Town Council, presenter of a local community radio station, part-time teacher of Punjabi and an employee of the National Probation Service); Harjinder Singh Mander (Editor of Panjab Times International and Perdesan Monthly publications); Master Avtar Singh (President of the Shiromani Akali Dal Amristar (UK)); Ragbhir Singh (President of the Sri Guru Singh Sabha Gurdwara in Derby); Rajinder Singh (Vice President of Sri Guru Singh Sabha

Gurdwara in Derby, Chairman of Panjab Times International and Perdesan Monthly publications, Director of Kohinoor Banqueting Suite in Derby); Talwinder Singh Dhillon (President Shiv Kumar Btalvi Trust (UK)), President Punjabi Heritage Trust (UK)); Sukhvinder Singh (Director of S.G.H.T. Ltd and President of Lok Bhalai Party UK)), Minderpal Singh (General Secretary of Guru Dashmesh Sahib Sikh Temple, Leicester); and Karam Singh (II) (Vice President of Sri Guru Singh Sabha – the largest Sikh temple outside India, and Secretary General Shiromni Akali Dal (UK).

27. In his witness statement Mr Dildar Singh (mentioned above) also states that his newsagents has been selling the “Ajit” of the applicant since 1999. He stocks and sells the Sunday edition and currently sells five copies a week.

28. The applicant’s evidence also contains a witness statement by Gurjeet Singh Samra, dated 18 December 2003. He is a senior librarian at St Barnabas Library in Leicester and states that due to demand from the Punjabi community the library was asked to stock the “Ajit” newspaper of the applicant. It has been stocked in the library for the last nine years and is read by 15 to 20 people per day.

Registered Proprietor’s Evidence

29. This consists of a statutory declaration and four witness statements. The statutory declaration, dated 2 February 2004, from Dr. Darshan Bains. Dr Bains explains that he is the Chief Executive Officer, Editor in Chief and Publisher of Ajit Newspaper Advertising, Marketing and Telecommunications Inc. He provides information of his background and academic qualifications. Dr Bains has been a university teacher at Jalandhar, Punjab, an historian, an author and a lecturer in journalism. Dr Bains and his wife own one hundred per cent of the shares in the registered proprietor’s company. The following points emerge from this statutory declaration:

- (i) The name Ajit Weekly was conceived in 1992, when Dr Bains moved to Canada and began to publish a free weekly newspaper by that name;
- (ii) The registered proprietor launched a website (www.ajitweekly.com) promoting Ajit Weekly on 20 May 1998. Dr Bains points out that this site is available across the world and may be understood by all people able to speak the Punjabi language.
- (iii) Following on from success in North America, the registered proprietor launched the newspaper in the UK in April 2003. 43 editions have been published to date and Exhibit Ajit-15 shows details of printer’s invoices for the UK newspaper. The print run for the UK editions is 10,000 copies per run. Dr Bains claims that his mark was well known in the UK prior to the trade mark application as four UK businesses advertised in his New York, British Columbia and Toronto editions in October 2001.
- (iv) Dr Bains categorically denies that the name of the newspaper was chosen in bad faith. He claims it was chosen for the following reasons:
 - (a) The newspaper is a weekly publication.
 - (b) Ajit is a common forename among the Sikhs.

- (c) The newspaper is named after a warrior named Ajit Singh. The name conveys a meaning of a person who fights fearlessly against injustice and high handiness. Therefore it is an appropriate name for a newspaper title.
- (v) Dr Bains asserts that apart from Ajit Weekly, there are two weekly newspapers which are published in the UK in the Punjabi language – Des Pardes and Punjab Times. Dr Bains believes that all the supporting affidavits filed by the applicant were obtained by these two companies, which are direct competitors of the registered proprietor. Mr Harjinder Singh Mander is the editor of the Punjab Times and Mr Gurbax Singh Virk is Chief Editor of Des Pardes, both of whom have submitted affidavits for the applicant.
- (vi) Dr Bains argues that the applicant's have not shown that they have a goodwill or reputation in the UK sufficient to sustain a claim under section 5(4)(a). This is based on the assertion made in the witness statement of Prem Singh (dated 11 November 2003) on behalf of the applicant that there were 21 subscribers in the UK during the months of July-December 2001. In relation to paragraph 11 of the witness statement where Prem Singh claims that each newspaper is read by an average of eight people, Dr Bains argues that at best this means it would have been read by 168 people per day at the time the application for registration was filed by the registered proprietor. In an average UK Punjabi community of 700,000, this would amount to 0.024% of that population reading the newspaper daily.
- (vii) Dr Bains submits that the newspaper titles differ.

30. The first witness statement, dated 22 January 2004 is from Mr Iqbal Ramoowalia. Mr Ramoowalia explains that he is the Chairman of the Canadian Council of Punjabis and that he has known about Ajit Weekly since its launch in 1993. He claims it is now the largest Punjabi weekly in the world, simultaneously coming out from Ontario, Vancouver, New York, San Francisco and the UK.

31. The second witness statement, dated 21 January 2004, is from Mr Balraj Deol. Mr Deol explains that he the Chief Editor of a Punjabi newspaper "Khabarnama" which is a competitor of Ajit Weekly newspaper. He goes on to state that Ajit Weekly is the largest Punjabi weekly in the world and has surpassed all contemporary Punjabi newspapers in contents and has established a new milestone in Punjabi journalism.

32. The third witness statement, dated 9 February 2004, is from Mr Balraj Sidhu. Mr Sidhu is the Editor of the UK edition of Ajit Weekly. In January and February 2004, he assisted in carrying out a survey aimed at establishing the extent to which UK residents would perceive any connection between Ajit Weekly and **Punjab di Awaaz Ajit** (AJIT) published by the applicant.

33. Advertisements were placed in three consecutive issues of Ajit Weekly (shown at exhibits BS1-BS3). 16 people responded to the advertisements published which asked the following:

- Name, address, country of birth and country of residence;
- Details regarding language spoken;

- Details regarding newspapers read in the Punjabi language;
- Details regarding any connections known or believed to exist between any Punjabi newspapers.

34. Sixteen witness statements were made as a result of the responses to the adverts and are shown at Exhibit BS4. They are made by the following people:

- Mr Jaspal Singh Bains who is the Manager of the Sikh Times, a bilingual newspaper. The witness statement is dated 17 January 2004;
- Mr Rattan Reehal who is the convenor of the Punjabi literary society of Wolverhampton, the chairman of Ramgarhia Welfare Association of Wolverhampton and editor of a quarterly internet Punjabi magazine. The witness statement is dated 18 January 2004;
- Mr Dalvir Singh Summan who is a member of Punjabi Cultural Society, a UK member of National Union of Journalists and a radio presenter of Radio XL in Birmingham. The witness statement is dated 18 January 2004;
- Mr Kulvir Singh Brar who works for West Midland Travel. The witness statement is dated 18 January 2004;
- Mr Tralochan Singh Chanjandialvi who is an active member of Punjabi Kavi Mandal UK and Punjabi Sahit Sabha of Wolverhampton. The witness statement is dated 19 January 2004;
- Mr Amrik Singh who is the owner of a Sweet centre. The witness statement is dated 19 January 2004;
- Mr Mukhtair Singh More who is an active member Rasila Misical Group UK and Katha vachak (religious preacher). The witness statement is dated 20 January 2004;
- Mr Ranjit Singh who is a public service employee and librarian of Ramgharia Sikh Temple in Birmingham. The witness statement is dated 20 January 2004;
- Mr Gurdev Singh Manku who is a Councillor in Birmingham and an active member of Ramghria Sikh Temple in Hockley. The witness statement is dated 22 January 2004.
- Mr Surinder Jnagal who is the owner of a Punjabi restaurant. The witness statement is dated 24 January 2004;
- Mr Manmohan Singh Khalsa who has an organisation called World Muslim-Sikh Federation and is an active member of Dal Khalsa worldwide and Sikh missionary society. The witness statement is dated 24 January 2004;
- Mr Ajaib Singh Garcha who owns an off-licence shop and is trustee and treasurer of Smethwick Sikh Temple Football Club Limited. The witness statement is dated 26 January 2004;
- Mr Surinder Singh Sagar who is an active member of Punjabi Sahit in Wolverhampton and owns his own supermarket business. The witness statement is dated 26 January 2004.
- Mr Prem Avikash who is active in Asian music and is a very well-known Hindi and Punjabi singer. The witness statement is dated 26 January 2004;
- Mr Manjit Singh who is active in Punjabi literature and is President of Punjabi Sahit Sabha of Wolverhampton and the cultural secretary in the congress party in Wolverhampton. The witness statement is dated 27 January 2004;
- Mr Parveen Sharma who owns his own construction company and has his own promotion company called PS Promotion UK. The witness statement is dated 27 January 2004.

35. All the statements closely correspond with one another. Out of 16 respondents, all of them read Ajit Weekly, none knew of any connection between any Punjabi newspapers and none made a connection between the UK edition of Ajit Weekly and the applicant's publication.

36. The fourth witness statement, dated 6 February 2004 is from Mr Arashdeep Singh. Mr Singh explains that he is employed by the registered proprietor as an on-line editor and web administrator. He goes on to give details of a questionnaire placed on the website, where the following questions were asked:

1. Are you familiar with the English Language?
2. Do you speak and read Punjabi?
3. How often do you visit this website?
4. Please indicate where you heard about AJIT WEEKLY?
5. Are you aware of any other newspapers which are published in the Punjabi language?
6. If so please name those newspapers and where they are published.
7. Of the newspapers you name are you aware of any connection between the publishers?
8. If yes, please indicate which newspapers are connected and reason for their connection.
9. Please produce details relating to your country of birth and the country where you currently reside.
10. Please indicate if you have visited any of these countries, and if so the amount of times/frequency of visit.
11. Please indicate your sex and age.

37. Respondents were also asked to provide details of their name and email address.

38. Exhibit Pop-up 2 shows paper copies of all the responses received. The upshot of the survey appears to be that none of the 190 respondents had heard of the applicant's newspaper, nor perceived any connection between any two publications published in the Punjabi language. Out of the 190 respondents, only 17 were residents of the UK.

Applicant's Evidence in Reply

39. The applicant's evidence in reply consists of eight witness statements and an affidavit.

40. Prem Singh provides a second witness statement, in addition to his statement in the main evidence. It is dated 12 June 2004. Mr Singh makes a number of points which include:

- (i) Dr Bains claim to the readership figure of eight persons per newspaper in North America is not substantiated and social circumstances in North America differ to that of India;
- (ii) the circulation figure of Ajit Weekly does not support that newspaper's claims to be "The Worlds Largest Punjabi Weekly". The total print run for October 2001 was 76,000 copies, all in North America;

(iii) regarding Dr Bain's claim about the title of the applicant's newspaper, "Punjab Di Awaaz" does not form part of the name (as proved by the certificate of registration from the Registrar of Newspapers for India), but is a slogan meaning "Voice of Punjab";

(iv) Dr Bains claim to the reasons given for his choice of the Ajit name are not credible;

(v) the four businesses listed by Doctor Bains are individuals who have placed "black magic" advertisements;

(vi) the applicant's witnesses are all independent, prominent members of the Punjabi community in the UK who have nothing to gain personally or commercially in assisting the applicant in these proceedings;

(vii) the witness statements of Arashdeep Singh and Balraj Sidhu for the registered proprietor are surprising as Akeli Patrika and Desh Sewak have circulation figures of less than 5,000 a day and the respondent must have believed Ajit in the Punjab to be the same newspaper as Ajit Weekly in the UK;

(viii) the registered proprietor's witness statement made by Mr Ramoowalia has been withdrawn as he has signed a further affidavit withdrawing his earlier statement.

41. Mr Ajit Singh Dost also makes a second witness statement. It is dated 31 March 2004. He states that he agreed to give evidence in order to help "Ajit" and not for any other purpose. Since moving to England in 1965 he has had the Sunday edition of "Ajit" sent to him. He was not aware of Ajit Weekly until it was published in the UK.

42. Gurbax Singh Virk makes his second witness statement. It is dated 31 March 2004. He states that he agreed to give evidence as he believes the registered proprietor's motives were wrong. Mr Virk has no objection to Dr Bains or his company publishing a newspaper in this country, it is only the use of the name Ajit to which Mr Virk objects. He adds that his newspaper has no connection with Ajit and goes on to say that Des Pardes gets copies of the applicant's "Ajit" newspaper on a daily basis as it is essential reading for a Punjabi journalist.

43. Harjinder Singh Mander makes a second witness statement. It is dated 10 June 2004. Mr Mander makes it clear that he gave his previous witness statement freely without expecting or receiving any personal gain or benefit to himself or his business. His motive was to help in stopping Ajit Weekly making unfair use of the good name of the "Ajit". He adds that he reads daily editions of The "Ajit" at his office and when he first saw Ajit Weekly he was misled by the title of the newspaper into thinking it must be affiliated to the applicant's newspaper.

44. Himmat Singh Sohi makes a second witness statement. It is dated 31 March 2004. He states that his evidence was provided of his own volition because he knows of the good reputation of "Ajit", and not to benefit third parties Mr Sohi confirms that when he first saw Ajit Weekly he thought it must have been published by "Ajit" ie. the applicant.

45. Master Avtar Singh also makes a second witness statement. It is dated 10 June 2004. He explains that he has no links to either party and has nothing to gain by acting as a witness.

Mr Singh states that he only realised Ajit Weekly was not connected with “Ajit” when he read the names of the editors.

46. Raghbir Singh’s second witness statement is dated 10 June 2004. He states that he has no connection with the “Ajit” newspaper of the applicant or the Punjab Times. He explains that he made his statement because he knows of the reputation of “Ajit” and he believes that it is wrong for another newspaper to copy their name and undermine them. Mr Singh submits that the applicant’s “Ajit” is known to everyone in the Punjabi community because they used to live in the Punjab or because they often visit Punjab.

47. Rajinder Singh makes a second witness statement. It is dated 10 June 2004. He explains that he has nothing to gain personally or professionally by acting as a witness in this matter and that he respects both parties. Mr Singh agreed to act as a witness because he believes it not right that Ajit Weekly should use the Ajit name as it belongs to someone else. He explains that he used to buy the “Ajit” newspaper every day in the Punjab before he moved to the UK and for the past few years he has obtained daily copies for his staff to read. He now gets copies from a friend in India who sends them to his office by courier. Mr Singh submits that everyone in the UK Punjabi community will know of the applicant’s Ajit newspaper.

48. The applicant’s evidence in reply also contains an affidavit dated 17 March 2004 from Iqbal Ramoowalia. He states that when he signed his witness statement of 22 January 2004 on behalf of the registered proprietor he was not properly informed of the purpose of that statement. Mr Ramoowalia is a regular reader of what he now states is the largest circulated Punjabi daily Ajit newspaper, which is that published by the applicant. He concludes by stating that he has come to know that his earlier affidavit was incorrect and he therefore withdraws it.

Registered Proprietor’s further evidence

49. This consists of a witness statement, dated 19 March 2004, from Mr Balraj Sindhu, who has already filed a witness statement in these proceedings. He exhibits (at BS5) two further witness statements from respondents to the advertisements detailed in his earlier witness statement. These are from Mr Sarbjit Singh Bal, who works for a courier company and is associated to several political, cultural and human rights organisations and Mr Gurpreet Singh, who is an active member of Singh Sabha Sikh Temple in Southall, member of the Council of Khalistan and President of the Sikh Union in Southall. The witness statements are dated 4 and 5 February 2004 respectively. In common with the earlier witness statements, both confirm that they read Ajit Weekly and that they do not know of any connection between any Punjabi newspapers.

DECISION

Section 3(6)

50. First of all I go to the Section 3(6) ground.

Section 3(6) of the Act states:

“A trade mark shall not be registered if or to the extent that the application is made in bad faith”.

51. In essence the applicant for invalidity contends that the application to register the mark in suit was made in bad faith because, at the time of filing, the registered proprietor was aware of the applicant's reputation in the AJIT trade mark and that the application to register the mark was an attempt to trade off this reputation, which would result in confusion amongst the relevant public and detrimental to the applicant for invalidity.

52. In *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367, Lindsay J considered the meaning of "bad faith" in Section 3(6) of the Act and stated (at page 379):

"I shall not attempt to define bad faith in this context. Plainly it concludes dishonesty and, as I would hold, includes also some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined. Parliament has wisely not attempted to explain in detail what is or is not bad faith in this context; how far a dealing must so fall-short in order to amount to bad faith is a matter best left to be adjudged not by some paraphrase by the courts (which leads to the danger of the courts then construing not the Act but the paraphrase) but by reference to the words of the Act and upon a regard to all material surrounding circumstances."

53. In *Harrison v Teton Valley Trading Co* [2004] EWVA Civ 1028, the Court of Appeal confirmed that bad faith is to be judged according to the combined test set out by the House of Lords in *Twinsectra v Yardley* [2002] 2 AC 164. Paragraphs 25 and 26 of the Court of Appeal decision are of particular assistance and read as follows:

"25. Lord Hutton went on to conclude that the true test for dishonesty was the combined test. He said:

"36. Therefore I consider That your Lordships should state that dishonesty requires knowledge by the defendant that what he was doing would be regarded as dishonest by honest people, although he should not escape a finding of dishonesty because he sets his own standards of honesty and does not regard as dishonest what he knows would offend the normally accepted standards of honest conduct."

26. For my part, I would accept the reasoning of Lord Hutton as applying to considerations of bad faith. The words "bad faith" suggest a mental state. Clearly when considering the question of whether an application to register is made in bad faith all the circumstances will be relevant. However the court must decide whether the knowledge of the applicant was such that his decision to apply for registration would be regarded as in bad faith by persons adopting proper standards."

54. Thus, in considering the actions of an applicant, the test is a combination of the subjective and objective. Furthermore, it is clear that bad faith in addition to dishonesty, may include business dealings which fall short of the standards of acceptable commercial behaviour ie. unacceptable or reckless behaviour in a particular business context and on a particular set of facts.

55. The relevant facts before me are as follows –

- (i) At the relevant date ie. the date of application for the mark in suit (24 October 2001), the registered proprietor had not used the mark in the UK and there is no persuasive evidence that the registered proprietor possessed goodwill in this mark in the UK at that date;
- (ii) The applicant for invalidity had no substantial use of the “AJIT” mark in the UK at the relevant date. As at 24 October 2001 the applicant had thirteen subscribers (including one library) to its newspaper in the UK. Although some further copies were obtained by individuals through other means, the quantities involved, while unspecified, are small;
- (iii) While the applicant for invalidity had no substantial sales of its “AJIT” newspaper in the UK, the evidence demonstrates that its “AJIT” newspaper is very successful and well known in the Punjab;
- (iv) The registered proprietor is owned 100% by Dr Bains (the Chief Executive Officer, Editor in Chief and Publisher) and his wife;
- (v) Dr Bains originates from the Punjab where he has been a university teacher in Jalandhar (the headquarters of the applicant for revocation’s newspaper). He has also been an historian, an author and a lecturer in Journalism.

56. Notwithstanding, the registered proprietor’s explanation of how the mark in suit was chosen, I have no doubt that it is essentially the same as the title used on the applicant’s newspaper in that the distinctive dominant component are the Hindi and Punjabi characters – the “Ajit logo”. The additional material in the applicant’s title e.g. the transliteration of “The Voice of Punjab” consists essentially of a strapline, while the word “WEEKLY” in the mark in suit merely denotes a weekly as opposed to a daily publication. The registered mark is overall closely similar to that of the applicant’s “Ajit logo” – its newspaper title and trade mark. Furthermore, the “Ajit logo” and the word AJIT are inherently fully distinctive in relation to the relevant goods – a point agreed by the registered proprietor at the hearing.

57. Given his background, it seems to me that Dr Bains (and thus the registered proprietor) must have been aware of the longstanding use and reputation of the applicant’s trade mark – the “Ajit logo” - in the Punjab at the relevant date. While this in itself does not indicate bad faith I have also to take into account that the relevant customer for the goods in this particular case are Punjabi speakers/the Punjabi community in the UK.

58. The evidence indicates and in any event I take judicial notice that, there is a substantial Punjabi Community in the United Kingdom. A large proportion of this community (albeit an aging one) would have emigrated from the Punjab to the UK and would be aware of the existence and reputation of the applicant’s newspaper sold under the “Ajit logo” (its trade mark) in the Punjab. Continuing contact between the UK’s Punjabi Community and its Punjabi roots would reinforce this knowledge.

59. In light of the above I have no doubt that, at the relevant date, a substantial proportion of relevant customers ie. Punjabi speakers/the Punjabi Community in the UK, coming across the registered proprietor’s trade mark on a weekly newspaper would have believed it emanated from or was published in association with the applicant. I am fortified in this finding by the applicant’s evidence, which although relating to a period after the relevant date, illustrates

that such confusion did result. The registered proprietor criticises this evidence as coming from “friends” etc. of the application. However, I see no reason to discount the statements which are made by numerous individuals of high standing within the UK’s Punjabi Community.

60. In light of my findings above, it seems to me that Dr Bains (and thus the registered proprietor) must have been aware that the applicant’s “Ajit logo”, in relation to newspapers, would be widely known amongst the UK’s Punjabi Community and that the registration and use of the mark in suit would result in confusion and deception to the detriment of the applicant.

61. I go on to consider the registered proprietor’s submissions that as it had an established business under the mark in North America at the relevant date, it was a natural progression in trade to extend its business into another English speaking territory.

62. I do not find these submissions of assistance. I have no evidence on how customers in North America perceive the mark at issue and in any event these proceedings are directed at the registered proprietor’s actions in the UK in light of their likely consequences, bearing in mind the relevant customer within the UK and the repute of the applicant amongst the relevant public. Furthermore, even taking into account the “natural progression” in trade point, it seems to me not to alter the basic premise that the registered proprietor must have been aware of the applicant for revocation’s reputation in its AJIT logo/trade mark for newspapers in the Punjab would be known to a substantial proportion of the UK’s Punjabi community and that confusion and deception was likely to result from its actions.

63. I am reminded of the comments of Nicholls LJ in the Privy Council judgement *Royal Brunei Airlines Sdn Bhd v Tan* [1995] 2 AC 378, when he described dishonesty as “.. to be equated with conscious impropriety”. This was in the context of accessory liability in the misapplication of trust assets to the detriment of a beneficiary. However, I think the same general principles would apply in trade mark law and in the context of the current proceedings. He added:

“In most situations there is little difficulty in identifying how an honest person would behave. Honest people do not intentionally deceive others to their detriment. Honest people do not knowingly take others’ property .. The individual is expected to attain the standard which would be observed by an honest person in those circumstances. It is impossible to be more specific. Knox J captured the flavour of this, in a case with a commercial setting, when he referred to a person who is “guilty of commercially unacceptable conduct in the particular context involved”: see *Cowan de Groot Properties Ltd v Eagle Trust Plc* [1992] 4 A11 ER 700 at 761. Acting in reckless disregard of others’ rights or possible rights can be a tell-tale sign of dishonesty. An honest person would have regard to the circumstances known to him, including the nature and importance of the proposed transaction, the nature and importance of his role, the ordinary course of business, the degree of doubt Ultimately, in most cases, an honest person should have little difficulty in knowing whether a proposed transaction, or his participation in it, would offend the normally accepted standards of honest conduct.”

64. In my view, the actions of Dr Bains in seeking to register the mark in suit amounted to reckless disregard as to the obvious confusion, deception and detriment which would result. Certainly, his actions fell short of the standards of acceptable commercial behaviour.

65. The application for invalidation is successful under Section 47(1) of the Act because the registered proprietor filed the application in bad faith contrary to Section 3(6) of the Act.

66. Consequent to Section 47(6) of the Act the registration is deemed never to have been made provided that this shall not affect transactions past and closed.

67. As the application for invalidation has been successful under Section 47(1), I have no need to consider the other grounds raised.

COSTS

68. The applicant for invalidity having succeeded the applicant is entitled to a contribution towards costs. I therefore order the proprietor to pay the applicant the sum of £2,000. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 2nd day of February 2005

JOHN MacGILLIVRAY
For the Registrar
the Comptroller-General

