

Shephali

**IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
IN ITS COMMERCIAL DIVISION
INTERIM APPLICATION (L) NO. 3737 OF 2020
IN
COMMERCIAL IP SUIT (L) NO. 3736 OF 2020**

Plex, Inc	...Plaintiff
<i>Versus</i>	
Zee Entertainment Enterprises Limited	...Defendant

Mr Virag Tulzapurkar, Senior Advocate, with Ramesh Gajria, Gairav Mukherjee & Amol Dixit, i/b Gajaria & Co, for the Plaintiff.

Mr Janak Dwarkadas, Senior Advocate, with Sharan Jagtiani, Senior Advocate, Rashmin Khandekar, Vishal Narichania, Anushree Raut, Parul Sharma, & Pranita Saboo, for the Defendant.

**CORAM: G.S. PATEL, J
(Through Video Conference)
DATED: 1st October 2020**

PC:-

1. Heard through video conferencing.
2. The matter is listed for urgent ad interim reliefs before me as the regular Bench of the Hon'ble Mr Justice KR Shriram is unavailable.

3. This is a quia timet action in passing off. As I am considering this only at an ad-interim stage and then leaving it to the regular Bench to list the matter for a fuller hearing of the Interim Application, a shorter factual narrative will suffice.

4. The restraint sought by the Plaintiff is against the Defendant's use of the word '**PLEX**' in an online movie channel service to be launched tomorrow, 2nd October 2020. The Defendant ("Zee") is a large multi-media conglomerate. It has a number of media channels and services including internet, OTT, DTH, satellite, cable, etc. These channels are in different languages too. On 1st September 2020 it announced its proposed launch about a month later of a 'cinema-to-home' pay-per-view service. I understand this to mean that new/fresh movie releases will be made available to subscribers but in a restricted manner such that the viewer must pay for each viewing, rather like buying a ticket to a cinema hall.

5. The Plaintiff ("Plex") represented by Mr Tulzapurkar claims that it adopted this mark in May 2008 in the United States. It appears that the Plex service is essentially software or combination of software and hardware that allows a user/subscriber to share media content over what is called a media server. This means, and there is material even now to show this, that the user can 'take his content wherever he goes'.

6. Plex obtained international trade mark registrations in several jurisdictions, but not India. It however claims that it had its first registered user in India on 23rd July 2008. In the time since, it says it

has built up a user or subscriber base of 550,000 users. Mr Tulzapurkar claims that there are very high sales in India between 2015 and 2019. I have some reason to question this. The plaint itself seems to indicate—in more than one place—that the sales of the Plaintiffs in any given year were rarely more than US\$ 24,000 to 30,000. Whatever may be the sales internationally, we are concerned with the domestic sales and these are used (as is common in such actions) to provide prima facie evidence of reputation and goodwill.

7. Mr Tulzapurkar has taken me through some pages of the annexures (pages 236, 244, 255, 256 and 261 amongst others) to show the similarity between the two services. This is of limited relevance except perhaps to note that Plex is variously described as a ‘media server’ or as a ‘famous TV tuner’ which allows ‘quick and easy access to your videos or images from anywhere’. The two services appear to be fundamentally different. As I noted, on 1st September 2020, announced its forthcoming launch of the **ZEEPLEX** channel or service. Mr Tulzapurkar draws attention to some documents including article that appeared in a newspaper (The Hindu) on 1st September 2020 which describes this as a cinema-to-home pay-per-view movie service. This immediately shows the difference in the two services, and this may possibly have some bearing on the question of ‘passing off’. Plex claims to have ‘curated content’, but that seems to apply to content to which Plex affords access. In addition, a Plex user can share his or her own content — either accessing it remotely or sharing it with others. The ZEEPLEX service does not seem to be like this at all. It has a list of movies. A subscriber selects the movie of choice and then must pay to view it. I presume that there will be some timing restrictions (start and stop timing, or within how much

time the movie can be viewed before access is stopped and so on). Prima facie this may have some bearing on the question of deceit and confusion.

8. But what Mr Tulzapurkar argues is that the Zee services was described in *The Hindu* article as ‘Zee Plex’, the two words being used apparently disjunctively. There is then a tweet at page 462 by Zee, but I think I should let that pass on the basis that today perhaps the less said of tweets the better for all concerned.

9. There is then an official release in print by Zee which again speaks of the launch of ‘Zee Plex’ — two words again — and said to be ‘India’s first Cinema2Home or C2H service on television and digital platforms’.

10. Mr Tulzapurkar’s complaint is that despite these two words being used disjunctively in the actual branding Zee seems to have combined the two words into a single unit ‘**ZEEPLEX**’.

11. I do not see what possible difference this could make to Plex’s case. At least as I understood the argument, the Plaintiff has an objection to the use of ‘Plex’ by Zee for *any* service and in *any* manner, whether it is combined with Zee as one word or is used in conjunction with Zee as two words. The question, therefore, is not about the use of Plex as the second of two words. The Affidavit in Reply makes it clear that Zee is using the word ‘Plex’ not as a standalone word but tied to Zee just as it is using Zee as prefix to invariably in respect of all its other offerings and marks.

12. Mr Tulzapurkar argues that the word Plex is to be read in its ordinary and usual connotation as meaning a physically constructed space comprised of many component parts such as a duplex, triplex, cineplex, multiplex etc. If that be so, then that is not the way in which Plex itself uses the word. It has no physical constructed building. This argument, therefore, appears to me to be more than somewhat circular and will probably not take the Plaintiff the distance that it needs.

13. The question is whether the Plaintiff has been able to show any prima facie case in passing off. This is an action for damages in the tort of deceit, that is to say, deception by Zee in duping or misleading consumers as to provenance, and leading them to believe that Zee has somehow tied up with Plex. To show such a prima facie case, Plex must establish its reputation and must demonstrate that it has such a brand recognition and awareness amongst even Zee's consumers or digital consumers that such an association at least in India would readily be made.

14. Prima facie at least for the ad-interim purposes it is difficult to see this. I do not yet see sufficient material from Plex to be able to establish its reputation at least within India, whatever may be its reputation, registrations and sales in other jurisdictions. In contrast, there is the much greater reputation and standing of Zee amongst subscribers across the length and the breadth of the country with a large number of channels in various languages.

15. Mr Dwarkadas points out that the word *Plex* is being used by Zee to specifically connote the niche or specialized service now being offered, i.e. a variety of regional and other licensed films being streamed on a pay-per-view basis to the subscribers. Apart from this service being entirely different from the kind that is being offered by Plex natively (i.e. carrying one's media wherever one goes), the use of the word Plex, Mr Dwarkadas submits, is suggested by the name of the service itself, i.e. multiple movie offerings on a single channel. This is the logical reason, he argues, for using the word Plex and it provides a complete answer.

16. To show deception and especially to show deception to obtain a quia timet injunction the Plaintiff must be able to show considerably more. On the question of reputation, Mr Tulzapurkar argues that Zee can no more use Plex than it could use Sony or Disney or Hotstar. There, Plex's reach probably exceeds its grasp, and that is possibly stretching things a bit far. It puts Plex on the same brand recognition, brand equity and reputation pedestal as Sony, Disney and Hotstar. I believe Plex has to do quite a bit more to be able to sustain that argument. Merely pointing to other established and reputed players in the field is not enough, and it is hardly a credible argument to say that "if Sony provides content and has a reputation, since I, too, provide content, I must be presumed to have an equivalent reputation. So if Sony could maintain such an action and get an order, so must I." There is no one-size-fits-all approach in these matters. Every claimant in a passing off action stands or falls on his own merits and case.

17. Mr Dwarkadas argues that there is the question of delay, not one that can be easily brushed aside. Zee announced its new channel 'ZEEPLEX' on 1st September 2020. By this time Plex had applied but had not obtained trade mark registration. After this launch announcement, Plex then went to the registry to amend the date of user under its application for trade mark registration. The amendment was to change the application showing the user from '*proposed to be used*' to a date in 2008. In other words, until it moved the amendment application, its own case in the registry was that at least in India, its mark was not in use, but only had a proposed or anticipated user.

18. There is the question of the time lost between 1st September 2020 and 1st October 2020 and Mr Dwarkadas would have it that in any action that seek such urgent reliefs, given that Zee is planning to launch its product tomorrow, 2nd October 2020, this is a factor that cannot be ignored. Of course, Mr Tulzapurkar says that there is no delay and the suit has been within the shortest possible feasible time. I have only noted these arguments and I am not refusing ad-interim relief on the ground of delay simpliciter, though I do believe and maintain — and I have said this before — that parties in IPR matters cannot expect Courts to push aside all other cases. This happens repeatedly, whether it is movie releases or otherwise. It must stop. It is unfair to courts and it is unfair to other litigants waiting their turn. Where a plaintiff has had enough notice and yet chooses to move at the eleventh hour — and makes no allowance at all for any adjustment that may be required — the plaintiff must be prepared to face the consequences. If something has happened in the last few days, then moving with pressing urgency is perfectly understandable; but not

where a plaintiff indulges itself in taking time to bring suit and then seeks to impose on the court's time to the unaccounted and unaccountable cost of others. I am letting it go this once, but will not be so minded in future.

19. In the usual set of factors to be considered, therefore, I find no prima facie case (and, again, am not pronouncing on delay). But on the second-level test of balance of convenience, I must find against Plex too. It is unable to show any anticipated injury. Its amendment application is problematic. Its user base and domestic sales are not enough to show even prima facie that Zee is acting in deceit and trying to pass off its new channel as an association with, or a spin-off from, Plex. The grant of the injunction Plex seeks would, on the other, cause immense and immediate financial loss and harm to Zee — it says it has already spent more than Rs. 11 crores (rather more than Plex's combined India sales for the last five years) on this new channel. Plex is in no position to show that it can cover any part of any such potential loss.

20. Consequently, I find no reason to grant an ad interim injunction in this passing off action.

21. To my question, Mr Dwarkadas readily makes a statement on instructions that the Defendant will not claim any equities arising from its use of the word or mark PLEX between now and the final hearing of the Interim Application. The statement is noted and accepted. It goes without saying that any use that Zee's make of the

word and mark PLEX is subject to further orders in the Interim Application.

22. All observations in the foregoing order are prima facie and for the limited purposes of this ad-interim application.

23. Mr Tulzapurkar seeks leave to amend. There is a draft amendment circulated. Leave granted. Amendment is to be carried out in soft copy within one week from today and in hard copy within three weeks. Re-verification is dispensed with.

24. Mr Jagtiani states that the Defendant has filed an Affidavit in Reply in the shortest possible time. A fuller response is required. The further Affidavit in Reply will deal with the amended plaint, a copy of which is to be served in soft copy also within one week from today. The further Affidavit in Reply will be filed and served on or before 16th October 2020. Affidavit in Rejoinder, if any, is to be filed and served on or before 23rd October 2020.

25. Liberty to the Plaintiffs to apply to the assigned Bench for a listing for early hearing and final disposal.

26. This order will be digitally signed by the Private Secretary of this Court. All concerned will act on production by fax or email of a digitally signed copy of this order.

(G. S. PATEL, J)