



O.A. Nos.790 and 791 of 2023 in C.S. (COMM.DIV.) No.219 of 2023

WEB **ABDUL QUDDHOSE,J.**

C.B.Paul Chellakumar

.. Applicant/plaintiff

VS

M/s.Campus Abroad Educational Services

.. Respondent/defendant

The suit has been filed for infringement and passing off.

2.The applicant/plaintiff is having registration of its trade mark 'CAMPUS ABROAD' under Class 41 of the Trade Marks Act. The applicant/plaintiff has obtained registration of its trade mark 'CAMPUS ABROAD' on 11.04.2014. The applicant/plaintiff came to know that the respondent/defendant is using the same trade mark 'CAMPUS ABROAD' in the year 2015. The applicant/plaintiff issued a cease and desist notice to the respondent/defendant calling upon the respondent/defendant not to use the trade mark 'CAMPUS ABROAD'. According to the applicant/plaintiff, despite receipt of the cease and desist notice, the respondent/defendant has been continuously using the trade mark 'CAMPUS ABROAD'. In such circumstances, they have filed the Suit for infringement and passing off against the respondent/defendant in respect of the alleged infringed trade mark 'CAMPUS ABROAD' used by the respondent/defendant.



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3. Pending the suit, they have filed these Original Applications in O.A. Nos.790 and 791 of 2023 seeking for interim injunction restraining the respondent/defendant from infringing the applicant's/plaintiff's registered trade mark 'CAMPUS ABROAD' and restraining the respondent/defendant from passing off the applicant's/plaintiff's trade mark 'CAMPUS ABROAD'.

4. A counter affidavit has been filed by the respondent/defendant in these applications. Their contentions are as follows:

a) The respondent/defendant has obtained registration of its trade mark 'CAMPUS ABROAD' under Class 35 of the Trade Marks Act, which is different from Class 41 of the Trade Marks Act for which the applicant/plaintiff has obtained registration;

b) The applicant/plaintiff has acquiesced to the usage of the trade mark 'CAMPUS ABROAD' by the respondent/defendant as they were aware that the respondent/defendant has been using the trade mark 'CAMPUS ABROAD' ever since 2015 when the applicant/plaintiff has issued cease and desist notice on the respondent/defendant;

c) Being a registered trade mark, the respondent's/defendant's right to usage of the trade mark 'CAMPUS ABROAD' is protected as per the provisions of Section 29 of the Trade Marks Act;



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d)The suit filed by the applicant/plaintiff has to be dismissed in limine on account of the delay and laches since as per the provisions of Section 33 of the Trade Marks Act, any infringement action will have to be filed within a period of five years. Since the suit has been filed only in the year 2023 even though the cease and desist notice was sent by the applicant/plaintiff to the respondent/defendant in the year 2015 itself, the suit has to be dismissed in limine on account of delay and laches.

e)CAMPUS and ABROAD are two generic words and therefore, nobody can claim exclusive usage of the same.

5.Heard Ms.S.Rajeni Ramadass, learned counsel for the applicant/plaintiff and Mr.M.L.Joseph, representing for M/s.Chennai Law Associates, learned counsel for the respondent/defendant.

6.Learned counsel for the applicant/plaintiff reiterated the contents of the affidavit filed in support of these applications and similarly, learned counsel for the respondent/defendant reiterated the contents of the counter affidavit filed by the respondent/defendant in these applications. Both the counsels drew the attention of this Court to various documents filed along with the typed set of documents filed by the respective parties.



7.Learned counsel for the applicant/plaintiff drew the attention of this Court to the following authorities in support of her contentions:

a)A decision of the Hon'ble Supreme Court dated 22.01.2004 in the case of **Midas Hygiene Industries P. Ltd. vs Sudhir Bhatia and others** reported in **2004 (28) PTC 121 SC**;

b)A decision of the Hon'ble Supreme Court dated 17.03.2015 in the case of **S.Syed Mohideen vs. P.Sulochana Bai** rendered in **Civil Appeal 2758 of 2015**;

c)A decision of the Division Bench of the Delhi High Court dated 04.07.2008 in the case of **Shri Pankaj Goel vs. M/s.Dabur India Limited** rendered in **FAO (OS) 82 of 2008**;

d)A Division Bench judgment of this Court dated 23.02.2011 in the case of **Vinod Kumar Agarwal vs. Needle Industries (India) Private Limited** rendered in **O.S.A. No.353 of 2006 and M.P. No.1 of 2010**.

8.Relying upon the aforesaid decisions, learned counsel for the applicant/plaintiff would submit as follows:

a)Even though cease and desist notice was issued by the applicant/plaintiff to the respondent/defendant on 19.05.2015, the respondent/defendant has been using the trade mark 'CAMPUS ABROAD', belonging to the applicant/plaintiff. Therefore, it would amount to dishonest intention on the part of the respondent/



defendant and therefore, the decision of the Hon'ble Supreme Court in the case of “Midas”, referred to supra is applicable to the facts of the instant case;

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b) Since the trade mark 'CAMPUS ABROAD' used by the respondent/defendant is identical to that of the applicant/plaintiff as was held in the Division Bench judgment of this Court in the case of “Vinod Kumar Agarwal vs. Needle Industries (India) Private Limited”, referred to supra, this Court will have to grant an order of interim injunction as prayed for in these applications;

c) The decision rendered by the Hon'ble Supreme Court in the case of “S.Syed Mohideen vs. P.Sulochana Bai”, referred to supra, clearly applies to the facts of the instant case. Despite the registration obtained by the respondent/defendant under Class 35 of the Trade Marks Act, the suit for passing off is maintainable;

d) The decision rendered by the Delhi High Court in the case of "Shri Pankaj Goel vs. M/s.Dabur India Limited", referred to supra, also clearly applies to the facts of the instant case as the applicant/plaintiff is a prior user of the trade mark 'CAMPUS ABROAD', which has also not been disputed by the respondent/defendant;

e) Mere delay in taking action against the infringer is not sufficient to hold that the registered proprietor has lost the mark intentionally as held in the decision rendered by the Delhi High Court, referred to supra.



9. On the contrary, learned counsel for the respondent/defendant would submit as follows:

a) Any acquiescence of the infringement amounts to giving consent. Even in the cease and desist notice sent by the applicant/plaintiff to the respondent/defendant, the trade mark 'CAMPUS ABROAD' used by the respondent/defendant disclosed in the said notice clearly discloses that the respondent/defendant has been using the trade mark ever since 2000. Therefore, having come to know about the respondent's/defendant's usage ever since 2000 and that too when the applicant/ plaintiff has not sought for any rectification of the respondent's/defendant's trade mark 'CAMPUS ABROAD' as per the provisions of the Trade Marks Act, the question of granting interim injunction will not arise;

b) As per the provisions of Section 33 of the Trade Marks Act, any action for infringement will have to be initiated within a period of five years from the date of knowledge of the infringement/passing off;

c) The registration of the whole mark cannot confer any exclusive rights on the holder thereof to any part of such registered mark;

d) No exclusivity can be claimed over a descriptive mark or a descriptive part of the mark even by misspelling it;



e)The acquisition of secondary meaning is essentially a matter of trial and extensive usage of trade mark is insufficient.

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Discussion:

10.While deciding whether the applicant/plaintiff is entitled for the grant of interim injunction or not, it is settled law that the applicant/plaintiff will have to satisfy the three cardinal principles, namely, a)prima facie case; b)balance of convenience and c)irreparable hardship. Before deciding whether the applicant/plaintiff has satisfied the aforementioned tests, it is to be noted from the pleadings of the respective parties, the undisputed facts which are as follows:

a)The applicant/plaintiff has obtained registration of its trade mark 'CAMPUS ABROAD' used by the respondent/defendant on 11.04.2014 under Class 41 of the Trade Marks Act, which pertains to "providing training and counselling for students";

b)The respondent/defendant has obtained registration of its trade mark 'CAMPUS ABROAD' on 16.12.2014 under Class 35 of the Trade Marks Act, which is detailed hereunder:

'Consultancy services, Advertisement, Business Management, Administration and Function and Import and Export, Office function of all kinds of services including Education and other Consulting Services, Dealership, Show Room of Educational or Instructional



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Items and Teaching Materials, Franchisee, Super Market, Super Store, Mall, Website, Information in Computer or by Telephone and Mail, Distributing, Dealing, Stocking, Marketing, Servicing, Supplying'

c)Cease and Desist notice has been issued by the applicant/plaintiff to the respondent/defendant on 19.05.2015 requesting the respondent/defendant not to use the registered trade mark 'CAMPUS ABROAD';

d) In the plaint, the following averments are made by the applicant/plaintiff with regard to the cause of action for filing the suit:

'The defendant, despite the notice dated 19.05.2015, is continuing to use the plaintiff's mark and hence continuously infringing the plaintiff's registered trade mark and hence no part of the suit claim is time barred.'

e)The other relevant portion in the plaint with regard to the cause of action reads as follows:

'The plaintiff therefore caused a notice dated 19.05.2015 to be issued to the defendant to cease and desist from using the plaintiff's registered trade mark 'CAMPUS ABROAD'. After the issuance of the notice, the defendant stopped using the trade mark for a while and started to use the trade mark again.'

f)No specific date as to when the respondent/defendant stopped using the trade mark 'CAMPUS ABROAD' and the date on which they restarted to use the trade mark 'CAMPUS ABROAD', has been disclosed in the plaint.



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g)The suit has been filed only on 04.07.2023. The applicant/plaintiff claims that the trade mark 'CAMPUS ABROAD' is a well known trade mark and that the applicant/plaintiff is involved in the business of Educational Consultancy Services for students, who are going abroad for admission to International Universities.

h)On the other hand, the respondent/defendant contends that they have been in the field of Educational Consulting Services ever since 2000.

11.Section 29(1) of the Trade Marks Act 1999 enables a party to bring an infringement action, provided the respondent/defendant is not a registered proprietor of trade mark. Section 29(1) of the Trade Marks Act 1999, which is relevant for the case on hand, reads as follows:

'29. Infringement of registered trade marks

(1) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which is identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark.'

12.In the case on hand, both the applicant/plaintiff and the respondent/defendant are using the very same trade mark 'CAMPUS ABROAD' though the



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applicant's/plaintiff's trade mark has been registered under Class 41 of the Trade Marks Act, whereas the respondent's/defendant's trade mark has been registered under Class 35 of the Trade Marks Act. As seen from Section 29(1) of the Trade Marks Act 1999, there is a protection given to the registered proprietors of trade marks from being sued for an infringement action. Admittedly, the applicant/plaintiff has obtained its trade mark 'CAMPUS ABROAD' on 11.04.2014. The respondent/defendant obtained registration of its trade mark 'CAMPUS ABROAD' on 16.12.2014. Admittedly, till date, the applicant/plaintiff has not filed any application as per the provisions of the Trade Marks Act seeking for rectification of the respondent's/defendant's trade mark 'CAMPUS ABROAD', which has been registered under Class 35 of the Trade Marks Act. Infact, the applicant/plaintiff having been aware that the respondent/defendant has been using the trade mark 'CAMPUS ABROAD' in the year 2015 itself as seen from the cease and desist notice dated 19.05.2015 issued by them to the respondent/defendant, could have filed an application seeking for rectification of the respondent's/defendant's trade mark as per the provisions of the Trade Marks Act. But, till date, they have chosen not to do so for the reasons best known to them.

13.The respondent/defendant also claims in their counter affidavit filed in these applications that they have been using the trade mark 'CAMPUS ABROAD'



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ever since 2000 though the learned counsel for the applicant/plaintiff would submit that in the additional representation, submitted before the Trade Marks Registry by the respondent/defendant, they had disclosed that they have been using the trade mark 'CAMPUS ABROAD' only since 2014. Admittedly, the pleadings in the plaint, has also not disclosed the specific dates on which the respondent/defendant had stopped using the trade mark 'CAMPUS ABROAD' subsequent to the issuance of the cease and desist notice on 19.05.2015 and no specific dates have also been given as to when the respondent/defendant restarted using the trade mark 'CAMPUS ABROAD'. The foundation of any legal case is made up of pleadings. The pleading lays out the case. It directs the parties to develop their arguments and understand the other party's claim in order to frame claims or defences for either party, as appropriate. It serves as a direction for the entire suit journey. Oral arguments of the counsel cannot substitute pleadings which are the foundation of any suit.

14.The only averment made by the applicant/plaintiff in paragraph 9 of the plaint is that ever since the issuance of cease and desist notice in the year 2015, the respondent/defendant has been continuously using the trade mark 'CAMPUS ABROAD' though in another paragraph, namely, in paragraph 4, they have disclosed that the respondent/defendant after issuance of the cease and desist



notice had stopped using the trade mark 'CAMPUS ABROAD' and restarted using the same thereafter continuously. There are several disputed questions of fact involved as seen from the pleadings of both the parties to the dispute, which cannot be adjudicated in these Interlocutory Applications. The question of laches pleaded by the respondent/defendant on the part of the applicant/plaintiff to file the suit cannot also be adjudicated in these Interlocutory Applications as they are disputed questions of fact, which can be adjudicated only after trial.

15.Learned counsel for the respondent/defendant also relied upon Section 33 of the Trade Marks Act, which reads as follows:

'33. Effect of acquiescence

(1) Where the proprietor of an earlier trade mark has acquiesced for a continuous period of five years in the use of a registered trade mark, being aware of that use, he shall no longer be entitled on the basis of that earlier trade mark-

(a) to apply for a declaration that the registration of the later trade mark is invalid, or

(b) to oppose the use of the later trade mark in relation to the goods or services in relation to which it has been so used, unless the registration of the later trade mark was not applied in good faith.

(2) Where sub-section (1) applies, the proprietor of the later trade mark is not entitled to oppose the use of the earlier trade mark, or as the case may be, the exploitation of the earlier right,



notwithstanding that the earlier trade mark may no longer be invoked against his later trade mark.'

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16.As seen from Section 33(1) of the Trade Marks Act, it is clear that where the proprietor of an earlier trade mark has acquiesced for a continuous period of five years in the use of a registered trade mark, being aware of that use, he shall no longer be entitled on the basis of that earlier trade mark.

17.In the case on hand, the cease and desist notice was issued by the applicant/plaintiff on the respondent/defendant in the year 2015, whereas the suit has been filed only in the year 2023. Learned counsel for the applicant/plaintiff, during the course of her submissions, contends that only in the year 2022, the respondent/defendant has restarted its business in a fullfledged manner and therefore, the suit filed in the year 2023 is not hit by delay or laches, which is disputed by the learned counsel for the respondent/defendant, who would contend that the respondent/defendant has been using the trade mark 'CAMPUS ABROAD' continuously ever since 2000. When there are no pleadings in the plaint with regard to the specific dates of usage of the trade mark 'CAMPUS ABROAD' by the respondent/defendant, learned counsel for the applicant/plaintiff cannot improve the pleadings through her oral submissions as the pleadings are the foundation for any suit.

18.There are several triable issues involved, which cannot be adjudicated in



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these Interlocutory Applications. As observed earlier, the applicant/plaintiff will have to satisfy the three cardinal principles for obtaining an order of injunction i.e., a)prima facie case b)balance of convenience and c)irreparable hardship. The respondent/defendant has produced documents in its typed set of papers to show that they are not using the same trade mark 'CAMPUS ABROAD' ever since 2009 though the learned counsel for the applicant/plaintiff would dispute those documents. Even according to the learned counsel for the applicant/plaintiff as seen from the cease and desist notice, the respondent/defendant was using the trade mark 'CAMPUS ABROAD' in the year 2015 itself though they may contend that thereafter they had stopped using it and restarted only in the year 2022. The balance of convenience is also in favour of the respondent/defendant since they have produced documents to show that they have been using the trade mark 'CAMPUS ABROAD' ever since 2009. Further the registration obtained by the respondent/defendant is under Class 35, whereas the registration obtained by the applicant/plaintiff is under Class 41. They are two different classes and therefore whether the respondent/defendant has committed infringement or not cannot be decided in these Interlocutory Applications.

19.The decisions relied upon by the learned counsel for the applicant/plaintiff, referred to supra, are not applicable to the facts of the instant case for the



following reasons:

a)Whether the adoption of the trade mark 'CAMPUS ABROAD' by the respondent/defendant amounts to dishonest intention or not cannot be adjudicated in these Interlocutory Applications, that too, when there is no prima facie evidence to establish that the respondent/defendant has dishonestly adopted the trade mark 'CAMPUS ABROAD'. Therefore, the decision rendered by the Hon'ble Supreme Court in the case of **Midas Hygiene Industries Private Limited vs. Sudhir Bhatia and others**, referred to supra, has no applicability to the facts of the instant case.

b)In the decision rendered by the Division Bench of this Court dated 23.02.2011 in the case of **Vinod Kumar Agarwal vs Needle Industries (India) Private Ltd.**, relied upon by the learned counsel for the applicant/plaintiff, though the usage of identical names was under consideration, the question of delay and laches on the part of the applicant/plaintiff to institute the suit as in the case on hand was not under consideration. Therefore, the facts of the decision rendered in **Vinod Kumar Agarwal vs Needle Industries (India) Private Ltd.'s** case, referred to supra, will not have any bearing on the facts of the instant case.

c)Similarly, the judgment of the Hon'ble Supreme Court in the case of **S.Syed Mohideen vs. P.Sulochana Bai**, relied upon by the learned counsel for the



applicant/plaintiff has no applicability to the facts of the instant case since the registration obtained by the respondent/defendant for the trade mark 'CAMPUS ABROAD' is under a different class i.e. under class 35, whereas the applicant's/plaintiff's registration has been obtained under Class 41 and further the question of delay and laches was also not under consideration by the Hon'ble Supreme Court in the aforesaid decision. Though the learned counsel for the applicant/plaintiff may contend that in view of the aforesaid decision, the suit for passing off is maintainable despite the respondent/defendant having obtained registration, the facts in S.Syed Mohideen, referred to supra, is different from the facts of the instant case.

d)The facts of the decision of the Delhi High Court, relied upon by the learned counsel for the applicant/plaintiff in the case of **Shri Pankaj Goel vs. M/s.Dabur India Ltd.**, referred to supra is also different and that was not a case where a cease and desist notice was issued and there was a delay on the part of the applicant/plaintiff to file a suit for infringement and passing off. In the instant case, cease and desist notice was issued by the applicant/plaintiff in the year 2015, but the applicant/plaintiff chose to file a suit only in the year 2023. Even though mere delay in taking action against the infringer is not sufficient to hold that the registered proprietor has lost the mark intentionally unless it is positively proved that the delay was due to intentional abandonment of the right over the registered



mark. In the instant case, cease and desist notice was issued by the applicant/plaintiff as early as in the year 2015 itself. But the applicant/plaintiff chose to file a suit only in the year 2023. Therefore, the said decision has also got no applicability for the facts of the instant case.

20. There are several triable issues involved, which cannot be adjudicated by this Court in these Interlocutory Applications. Necessarily, the parties will have to be directed to go for trial and wait for the outcome of the suit. The decisions relied upon by the learned counsel for the respondent/defendant, lays down the following propositions:

a) The conduct of the parties has been considered to be a ground attracting doctrine of estoppel by acquiescence. Inaction involving laches and sitting by when another is invading the rights and spending money on it, acquiescence has been explained. The acquiescence in infringement amounts to giving consent. The course of conduct inconsistent with the claim of exclusive right for trade mark/trade name amounts to acquiescence;

b) In order to invoke Section 33(1) of the Trade Marks Act, the respondent/defendant must be a registered proprietor of the mark. Insofar as passing off is concerned, in the light of the fact that there was acquiescence by the respondent/defendant and the trade mark “Technova” was common to the trade, it



is not even the case of the respondent/defendant that it coined the said word first and adopted it;

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c)The registration of the whole mark cannot confer any exclusive rights on the holder thereof to any part of such registered mark. No exclusivity can be claimed over a descriptive mark or a descriptive part of the mark even by misspelling it. The acquisition of secondary meaning is essentially a matter of trial and evidence and the evidence of extensive use is insufficient. The proprietor, claiming that his mark has acquired secondary meaning, must show that the secondary meaning has entirely displaced the primary descriptive meaning of the mark.

21.As observed earlier, since there are triable issues involved, the question of granting interim injunction in favour of the applicant/plaintiff will not arise as the applicant/plaintiff has not made out a prima facie case and they have not established the balance of convenience/irreparable hardship in their favour. On the other hand, if interim injunction is granted, the respondent/defendant, who claims to be using the trade mark 'CAMPUS ABROAD' ever since 2000, will be put to

irreparable hardship and therefore, the balance of convenience is certainly in favour of the respondent/defendant.



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22. For the foregoing reasons, there is no merit in these applications as the applicant/plaintiff has not satisfied the mandatory triple tests, namely, prima facie case, balance of convenience and irreparable hardship. Accordingly, these applications are dismissed. Post the suit for filing written statement by the defendant on 16.11.2023.

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