

**IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
APPEAL (L) NO. 704 OF 2014
IN
NOTICE OF MOTION NO.310 OF 2012
IN
SUIT NO.284 OF 2012**

Educate India Society

..... Appellant
(Original Defendant)

V/s

ITM Trust & Others

..... Respondents.
(Original Plaintiffs)

**ALONGWITH
NOTICE OF MOTION (L) NO.2568 OF 2014
IN
APPEAL (L) NO. 704 OF 2014
IN
NOTICE OF MOTION NO.310 OF 2012
IN
SUIT NO.284 OF 2012**

Educate India Society

.... Applicant.

In the matter between :

Educate India Society

.... Appellant.

V/s

ITM Trust & Ors.

..... Respondents.

Dr. Virendra V. Tulzapurkar, Senior Counsel alongwith
Mr. Virag V. Tulzapurkar, Senior Counsel, Mr. Ricab Chand i/b
Mr. R.B. Sawant for the Appellant/Applicant.

Mr. Aspi Chinoy, Senior Counsel alongwith Mr. Chetan
Kapadia i/b Vigil Juris for the Respondents.

**CORAM: V. M. KANADE &
REVATI MOHITE DERE, JJ.**

**Order reserved on : 13/01/2015
Order pronounced on : 02/03/2015
(In chamber at 2.35 PM)**

P.C.:- (Per V.M. Kanade, J.)

1. Appellant who is the original Defendant is aggrieved by the judgment and order passed by the learned Single Judge dated 15/09/2014 allowing the Notice of Motion taken out by the Plaintiffs restraining the Appellant/Defendant from using the mark "ITM" or any other deceptively similar mark in respect of technical and educational services so as to infringe the Plaintiffs' registered trade mark "ITM".

2. Respondents/Plaintiffs filed a suit against the Defendant inter alia claiming an order of injunction restraining the Defendant by perpetual order of injunction from using the impugned marks "ITM" and/or "ITM University". Notice of Motion was taken out by the Plaintiffs, seeking ad-interim and interim relief. The said Notice of Motion was dismissed by the learned Single Judge by judgment and order dated 20/07/2012. Against this order, an appeal was filed challenging the said order. On 08/05/2013, Division Bench set aside the order of the learned Single Judge and the matter was remanded back. Division Bench, while

remanding the matter, has observed in its order in para 5 and 6(iii) as under:-

“(5) The learned Single Judge has not dealt with the defence of honest and concurrent user that has been set up by the Respondent. The Respondent has also filed a written statement raising that defence. The written statement was filed after the impugned order was passed. **In this background, both the learned counsel state that the impugned order of the learned Single Judge may be quashed and set aside and the proceedings may be remitted back for considering the defence of honest and concurrent user that has been set up by the Respondent. However, it is agreed that since the marks 'ITM' of the Appellants and of the Respondent are identical, the impugned finding of the Single Judge would have to be set aside. Other aspects of the defence can be kept open.**”

6(iii) The learned Single Judge shall consider the Notice of Motion afresh. **It is, however, clarified that the finding on which the learned Single Judge has dismissed the Notice of Motion namely that there is a dissimilarity between the marks of the Appellants and of the Respondent is set aside and shall stand concluded in view of the admitted position that the essential features of both the marks are letters 'ITM'.**

The learned Single Judge, therefore, was directed to consider the defence of honest and concurrent user by the Defendant.

3. After the Notice of Motion was heard and the order was reserved, Appellant filed another Notice of Motion No.2040 of 2014 seeking to rely on additional documents in support of the plea of honest and concurrent user and a request was made to consider the same before the judgment was pronounced. The learned Single Judge, however, adjourned the motion and pronounced the impugned order on 15/09/2014, restraining the Appellant from using the mark "ITM". Appellant filed Review Petition before the learned Single Judge. However, the Review Petition was dismissed by the order dated 31/10/2014.

4. Dr. Virendra Tulzapurkar, the learned Senior Counsel appearing on behalf of the Appellant, submitted that the Appellant was challenging the impugned order on the ground that the learned Single Judge had erred in rejecting the Appellant's contention of prior user only on the ground that the use of the mark "ITM" by the Appellant was merely an abbreviation of Institute of Technology & Management or an acronym and therefore it was not used as a mark. The learned Senior Counsel invited our attention to the finding

given by the learned Single Judge in paragraph 4 of the impugned order. The said finding recorded by the learned Single Judge in para 4 of the impugned order, reads as under:-

“4. I am not persuaded that the Defendants have been able to establish a case of honest and concurrent user. What they claim is use of the mark is nothing but use as a common abbreviation; there is no use of the mark as a mark *per se*. I have therefore granted the injunctions sought.”

It was submitted that all the reasoning in subsequent paragraphs viz from paragraphs 17 onwards was directed to show that “ITM” cannot be a mark and that it was only an abbreviation or an acronym. It was submitted that the said finding was erroneous because the dictionary meaning of the word “acronym” is, word formed from the initial letters of other words. The learned Senior Counsel invited our attention to Section 2(1)(m) which defines mark to include, inter alia, name. He then invited our attention to Section 2(1)(o) which defines name to include any abbreviation of a name. He submitted that the acronym is an abbreviation of the name. He submitted that the decision of the learned Single Judge was contrary to the definition of a mark. He then submitted that the Courts have held that abbreviation

as a mark and that such abbreviation, if it satisfies the requirements of Section 9 of the Trade Marks Act, is registerable. He relied upon the judgment in *United Iron & Steel Works vs. Government of India*¹. He also invited our attention to American Cases noted by the learned Author J. Thomas McCarthy in his Book McCarthy on Trade Marks and Unfair Competition, 4th Edition. He submitted that the said cases clearly showed that abbreviations are just as entitled to legal protection as the original full trade marks. He submitted that the Author noted the abbreviations which are protectable as trade marks such as COKE for Coca Cola, but BUD for Budweiser, HOG for large Harley-Davidson Motor Cycles, MET for Metropolitan Opera, PAN-M for Pan American Airways. He submitted that the learned Author has also noted that “VW” is a recognized abbreviation for Volks Wagen car and is protectable as a trade mark. He submitted that therefore the learned Single Judge had failed to appreciate that the logo containing “ITM” was registered in Class 16 in the name of the Appellant. He contended that the Registrar therefore accepted the position that “ITM” was a mark.

5. Mr. Aspi Chinoy, the learned Senior Counsel appearing on behalf of the Respondents, submitted that the entire defence of the original Defendant was of honest and

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concurrent user. He submitted that the case of prior user was never argued before the learned Single Judge. He submitted that the Review Petition which was filed by the Appellant was also rejected by the learned Single Judge.

6. The learned Senior Counsel appearing on behalf of the Respondents further submitted that the learned Single Judge had in para 4 of the impugned order clearly observed that the Defendant had not been able to establish the case of honest and concurrent user and in that context had examined the entire material on record and had given further reasons on the contentions of the Appellant. He submitted that from the material which was brought on record, the learned Single Judge had arrived at a conclusion that there was no material brought on record to show that there was honest and concurrent user by the Appellant or that there was use of mark as a mark *per se*.

7. We have heard both the learned Senior Counsels for the Appellant and Respondents. Both have taken us through the voluminous documentary evidence on record in support of their case.

8. Brief facts which are germane for deciding this appeal are as under:-

9. Plaintiff No.1 is a Trust registered under the Bombay Public Trusts Act, 1950 for charitable purposes and is known as ITM Trust. Plaintiff Nos. 2 and 3 are trustees of the said Trust. Plaintiff Nos. 2 and 3 decided to start an educational institute which would render educational training in the field of technology and management.

In February 1991, Plaintiff Nos. 2 and 3 approached Southern New Hampshire College, Manchester, New Hampshire, USA and they entered into an Articulation Agreement. According to the Plaintiffs, a brochure issued by Southern New Hampshire College specifically refers to the academic association with the Plaintiffs and it also emphasizes the reputation and goodwill that the Plaintiffs enjoy in respect of the educational services which are offered by them.

On 08/07/1993, a trust deed was executed between Mr. Kishore Gopal Desai as the Settler and Plaintiff Nos. 2 and 3 to formalize the control and management of the Institute for Technology and Management. It is the case of Plaintiffs that the Trust is to be called by the name Institute for Technology and Management Trust and/or ITM Trust. According to the Plaintiffs, therefore, Plaintiff Nos. 2 and 3 have been using the name / trade mark "Institute for Technology and Management" and/or "ITM" since the year 1991.

According to the Plaintiffs, Trust Deed was registered with the Charity Commissioner on 08/10/1993. Plaintiff No.1 set up another Center in Chennai and in 1995 new Centers were opened at Warangal and Raipur. Plaintiff No.1 also set-up and established a private University called "ITM University" in 2004. On 26/07/2004 Plaintiffs had a specific registration bearing registration certificate No.619410 in respect of services being "educational services" as specified in Class 41 of the Fourth Schedule of the Trade Marks Rules, 2002 under the Trade Marks Act, 1999. It is the case of the Plaintiffs that the said mark was registered as on 26/07/2004 and that there is continuous use as a user since the year 1993 and it was so claimed at the time of filing of the said mark.

According to the Plaintiffs, sometime on 18/03/2010, they came across a blog which referred to the closure of an ITM Gurgaon. They, therefore, published public notices in various newspapers and it was mentioned in the notice that ITM University and Institute of Technology and Management, Gurgaon was using the name ITM illegally. When the Plaintiffs learnt that some other Institute was using identical and/or deceptively similar trade mark to its well-known registered trade marks "Institute for Technology and Management", "ITM" and/or "ITM University", Plaintiffs filed

this suit. It is a specific case of the Plaintiffs that they were initially using the mark “Institute for Technology and Management” and “ITM” alongwith a device of a shield below which there was a ribbon like device and the words “Institute for Technology and Management” were written within a circular border encompassing the device of the shield. On the ribbon device below the shield was the latin phrase “SUMMA OPTIMAQUE” and below it were the numerals 1991. According to the Plaintiffs, after the establishment of the Trust, the said logo was amended to its present day registered trade mark which consisted of and retained the essential and prominent features thereof being the words “Institute for Technology and Management” and “ITM”. According to the Plaintiffs, amended trade mark was adopted in 1993.

Plaintiffs' case is that they have been openly, continuously and uninterruptedly using the said trade mark amended since 08/10/1993. According to the Plaintiffs, several other Institutions which are being run and/or managed under the trade marks such as ITM Institute of Hotel Management, ITM Institute of Health Sciences, ITM Institute of Fashion Design and Technology and ITM School of Culinary Art. Plaintiffs applied for and obtained registration of the trade mark “Institute for Technology and Management” and/or “ITM” and/or “ITM University”.

10. On the other hand, Defendants in their reply to the Notice of Motion, claimed that in 1996, they obtained registration of a mark with a shield device inset with a cross set in a chequered background, with a lamp at the cross's centre, and the words "INSTITUTE OF TECHNOLOGY & MANAGEMENT" beside the device. The word "ITM" does not appear on this trade mark. It is contended that in 2007, they obtained registration of a trade mark in Class 16 and this was a device of a shield with a cross embedded on a chequered background, a scroll beneath the shield device, the words "INSTITUTE OF TECHNOLOGY AND MANAGEMENT" beside it and, above the shield, the letters "ITM". Defendants then applied for registration of a trade mark "ITM University" with the logo in Class 41, saying that the user was 'proposed'. Defendants in their reply have stated that they are using the mark "Institute of Technology and Management" since 1996 and the mark "ITM" since 1999 and they claimed to be the honest and concurrent user of the said mark.

11. We have gone through the impugned order passed by the learned Single Judge. Though at the first blush the submission made by Dr. Tulzapurkar, the learned Senior Counsel appearing on behalf of the Appellant, appears to be attractive, on a closer scrutiny of the judgment and order

passed by the learned Single Judge, in our view, the said submission is without any substance.

12. We are unable to accept the submissions made by Dr. Virendra Tulzapurkar, the learned Senior Counsel appearing on behalf of the Appellant. Though in the reply there is a solitary averment regarding the prior user, the entire case of the Appellant is essentially based on the honest and concurrent user. It is evident that after the order of remand was passed by the Appellate Court, the learned Single Judge has, after taking into consideration the pleadings between the parties and after examining the documents brought on record by the Appellant and by the Respondents, recorded a finding that there was no material to show that the Appellant was using the word "ITM" as a mark.

13. In our view, the learned Single Judge, after having gone through the averments made by the Defendants in their reply and after examining the documents on which reliance was placed by the Defendants, came to the conclusion that the word "ITM" was not used as a trade mark, though the words "Institute of Technology and Management" appear to be used by the Defendants as a trade mark. The learned Single Judge has then examined 186 pages of annexures to the Affidavit which were mandatory disclosures made by the Defendants to various authorities at different times and from

this material the learned Single Judge has observed that there was nothing to show that the word “ITM” was used as a trade mark. The learned Single Judge, therefore, came to the conclusion that since the word “ITM”, from the material which was brought on record by the Defendants, did not show that it was used as a trade mark, the plea of honest and concurrent user was not made out. Once the learned Single Judge has come to the conclusion that the word “ITM” was not used as a trade mark, it would not fall within the definition under section 2(1)(o) which defines name to include any abbreviation of a name. If the word “ITM” was not used as a trade mark, Defendants cannot claim benefit of the provisions of section 2(1)(o). The observation made by the learned Single Judge that the word “ITM” is being used as acronym or abbreviation, therefore, has to be viewed from that angle. The learned Single Judge has practically examined all the documents on which reliance has been placed by the Defendants and has prima facie observed that they do not show that the word “ITM” was used as a trade mark at any point of time by the Defendants from 1993.

14. We concur with the prima facie view taken by the learned Single Judge. The learned Single Judge obviously has examined the entire material on the basis of the defence which was taken by the Appellant viz of honest and concurrent user. Though it is true that acronym is an

abbreviation of the name and the letters ITM are abbreviation of Institute of Technology & Management, the learned Single Judge has examined the material which was brought on record and came to the conclusion that the Appellant had never used the mark as a mark *per se*. The learned Single Judge has given cogent reasons in arriving at the said conclusion.

15. We are of the view that the said reasons given by the learned Single Judge cannot be said to be perverse or it cannot be said that the learned Single Judge has considered material which is not the part of the record. We are therefore not inclined to interfere with the impugned order passed by the learned Single Judge. Appeal is therefore dismissed. Since, the appeal itself is dismissed, Notice of Motion (L) No.2568 of 2014 taken out therein does not survive and the same is accordingly disposed of.

16. At this stage, Mr. Sawant, learned Counsel appearing on behalf of the Appellant, seeks continuation of the stay of the impugned order. We are not inclined to continue the stay. However, time to comply with the order is extended by six weeks.

(REVATI MOHITE DERE, J.)

(V.M. KANADE, J.)