

IN THE HIGH COURT OF JUDICATURE AT MADRAS

Date : 01.06.2015

CORAM

THE HONOURABLE MR. **JUSTICE R.SUBBIAH**

Original Application No.640 of 2012
and
Original Application Nos.576 & 577 of 2012
in
C.S.No.476 of 2012

As per O.A.No.576 of 2012

VIT University,
(Vellore Institute of Technology),
Vellore-632014,
Tamil Nadu,
India.
Having Chennai Office at
New No.6 (old No.W-73), Second Street,
(Opp: Towers Club),
Anna Nagar, Chennai-600 040.
rep. by its Registrar.

... Applicant/Plaintiff

Vs.

1.Bagaria Education Trust,
rep. by its Chairman and Managing Trustee K.R.Bagaria,
110, Arvind Nagar,
Jagatpura,
Jaipur-302 025.

2.Vivekananda Institute of Technology

3.Vivekananda Institute of Technology (East),
[formerly known as Vivekananda College of Engineering].

both the 2nd and 3rd respondents are at VIT Campus,
Sisyawas, NRI Road, Jagatpura, Jaipur-302 012,
Rajasthan-India.

4.VIT University

Rep. by its Registrar,
VIT Campus,
Sector-36, NRI Road, Dantali,
Jagatpura, Jaipur-303 012.
Rajasthan-India.

5.University Grants Commissioner (UGC),

Bahadur Shah Zafar Marg,
New Delhi-110 002.

6.The State of Rajasthan,

rep. by its Chief Secretary,
Secretariat, Jaipur-302 005.

.... Respondents/Defendants

Original Application No.576 of 2012 has been filed under Order XIV Rules 8 of Original Side Rules r/w Order XXXIX Rules 1 & 2 of CPC praying for grant of interim injunction restraining the respondents 1 to 4/defendants 1 to 4, by themselves, their trust, associates, sister concerns, or any of them claiming under them, from starting, establishing, assigning, creating, running education institutions, colleges, universities, study centres, training centres, entertainment, websites, sporting and cultural activities or any similar or identical activities, in any manner infringing the applicant/plaintiff's registered service/trademark 'VIT' by use of the trademark 'VIT university' or 'VIT Campus' or 'VIT' or 'VIT EAST' or by hosting deceptively websites such as VIT Jaipur, VIT J etc., or by use of any deceptively similar service/trademark or in any other manner, whatsoever, pending disposal of the suit.

For applicant/plaintiff

: Mr.P.S.Raman, Senior Counsel
for Mr.A.Saravanan

For Respondents/Defendants 1 to 4

: M/s.M.S.Bharath & K.Premchandrar
for M/s.Anand & Anand

ORDER

Original Application No.640 of 2012 has been filed under Order XIV Rule 8 of Original Side Rules r/w Order XXXIX Rules 1 & 2 of CPC, praying to grant interim injunction restraining the respondents/defendants 1 & 4, by themselves, their trust, associates, sister concerns, or any of them claiming under them, from issuing any advertisements in newspapers, periodicals or any other mode or hosting deceptive websites such as VIT Jaipur, VIT J etc. of the applicant/plaintiff's registered service/trademark 'VIT' by use of the trademark 'VIT university' or by use of any deceptively similar service/trademark or in any other manner whatsoever, pending disposal of the suit.

2.Original Application No.576 of 2012 has been filed under Order XIV Rule 8 of Original Side Rules r/w Order XXXIX Rules 1 & 2 of CPC, praying to grant interim injunction restraining the respondents 1 to 4/defendants 1 to 4, by themselves, their trust, associates, sister concerns, or any of them claiming under them, from starting, establishing, assigning, creating, running education institutions, colleges, universities, study centres, training centres, entertainment, websites, sporting and cultural activities or any similar or identical activities, in any manner infringing the applicant/plaintiff's registered service/trademark 'VIT' by use of the trademark 'VIT university' or 'VIT Campus' or 'VIT' or 'VIT EAST' or by hosting deceptively websites such as VIT

Jaipur, VIT J etc., or by use of any deceptively similar service/trademark or in any other manner, whatsoever, pending disposal of the suit.

3.Original Application No.577 of 2012 has been filed under Order XIV Rule 8 of Original Side Rules r/w Order XXXIX Rules 1 & 2 of CPC, praying to grant interim injunction restraining the respondents 1 to 4/defendants 1 to 4, by themselves, their trust, associates, sister concerns, or any of them, from in any manner passing off or enabling passing off of the name of the respondents 1 to 4 under the Trademark VIT university or ViT Campus or 'VIT' or 'VIT EAST' or by hosting deceptive websites such as VIT Jaipur, VIT J etc., as and for that of the applicant VIT university or by use of any deceptively similar service/trademark for starting, establishing, assigning, creating, running education institutions, colleges, universities, study centres, training centres, entertainment, websites sporting and cultural activities or any similar or identical activities or in any other manner whatsoever, pending disposal of the suit.

4.The applicant herein is the plaintiff and the respondents herein are the defendants in the suit. For the sake of convenience, the parties are referred to as per their rankings in the suit.

5.The brief facts of the case of the plaintiffs are as follows:-

5(1) The Trust namely 'North Arcot Educational and Charitable

Trust' was established by one Dr.G.Viswanathan, by the Trust Deed dated 07.05.1984, with an object to spread knowledge and education by publishing books, classics and other literature and/or by establishment of specific endowments and memorials for public charitable purposes, to hold and promote education and learning including primary, higher and college education, etc.,

5(2)The Department of Education, Government of Tamil Nadu, by G.O.Ms.No.1279, dated 27.09.1984, permitted the above Trust to start a private Engineering College in the name and style of *Vellore Engineering College at Vellore, North Arcot District* with effect from 1984-85. As the institution was to attain Deemed Universities status, the Trust Deed was amended on 09.04.2001 and the name of the Trust was changed as 'Vellore Institute of Technology". By the said amended trust deed, further objects, powers, functions, interpretation of objects, objects etc., which are included in the Trust deed dated 07.05.1984 and due to the hard work and continuous efforts of the Founder, the Engineering College has grown as a Deemed University. The Department of Secondary and Higher Education, the Ministry of Human Resource Development issued a Notification No.F.9-2/99-U.3 dated 19.06.2001 declaring the Vellore Institute of Technology, Vellore [formerly known as Vellore Engineering College, Vellore], Tamil Nadu as Deemed to be University for the purpose of the aforesaid Act with immediate effect. The University Grants Commission, New Delhi, issued a Notification No.F.6-3/2001(CPP-I), dated 25.09.2001 and declared the Vellore Institute of

Technology, Vellore [formerly known as Vellore Engineering College, Vellore] Tamil Nadu as Deemed to be a University for the purpose of the aforesaid Act with effect from 19th June, 2001. By virtue of University Grants Commission's communication and consequent Board Resolution dated 10th October 2006, Vellore Institute of Technology was renamed as 'VIT UNIVERSITY'.

5(3)The reputation and quality of the Education imparted by the plaintiff-institution is equal to that of the Indian Institute of Technology, Indian Institute of Management. The said institutes are called shortly as IIT, IIM, likewise, the plaintiff-institution is also called as VIT. The general public and the students and others identify the plaintiff-institution as VIT university and the plaintiff is having the popular slogan ***VIT – A place to learn; a chance to grow.***

5(4)The plaintiff-university is having two campuses, the main campus at Vellore and another at Chennai and their Administrative Office is at Anna Nagar, Chennai. The object of the plaintiff-university is to create a dynamic environment that facilitates interaction and dialogue. The Vellore campus is housed in 355 acres, eco-friendly campus, with 50.8 lakhs sq.ft built up area and eco-friendly campus at Chennai is housed in 160 acres. The teaching-learning process at plaintiff-university is structured around its 9 schools of excellence. The student is registered in one of the schools, depending on the degree or programme, he/she is interested in pursuing. Research Centres, part of each school, encourage interdisciplinary collaboration and provide opportunities to students to participate in exciting

projects. The university offers 18 under graduate and 35 post graduate programmes. The 9 schools of excellence are as follows_

S.No.	<i>Names of schools</i>
1	School of Information Technology and Engineering (SITE)
2	School of Mechanical and Building Sciences (SMBS)
3	School of Bio Sciences and Technology (SBST)
4	School of Electronics Engineering (SENSE)
5	School of Computing Sciences and Engineering (SCSE)
6	School of Electrical Engineering (SELECT)
7	School of Electrical Engineering (SAS)
8	VIT Business School (VIT BS)
9	School of Social Sciences and Languages (SSL)

The plaintiff is following a transparent mechanism for admission and having their own Entrance Examination called 'VITEEE' (VIT Engineering Entrance Examination) conducted at 243 Examination Centres in 105 cities across India in particular 20 centres including 6 cities in the State of Rajasthan, in which State the defendants are running their educational institutions, and also in Dubai, Riyadh and Singapore for admission to B-Tech Programmes and also conducting VITMEE (VIT Master Entrance Examination) for MCA and M-Tech Programmes. In the plaintiff University about 20,000 students from 48 countries and from all the States in India are studying and nearly one third of them are women. The plaintiff University is having over 1100 faculty members of whom 412 are Ph.d., degree holders with 1350 supporting Administrative staff. Foreign nationals and NRI students had joined the University because of interaction/cross border reputation.

5(5)The plaintiff has made a mark in global arena of education through strong integration linkage by developing innovative programmes, promoting faculty and students exchanges and admitting the students from all over the world. With the vision of providing education of international quality, the plaintiff had developed academic partnerships with reputed universities around the world. The plaintiff signed more than 120 Memorandum of Understandings with Universities abroad for Masters and Doctoral studies at partner Universities, students and faculties exchange, faculty development, collaborative research and joint/twinning degree programmes. The said Memorandum of Understandings were all entered in the name 'VIT UNIVERSITY'. People from abroad as well as from India identify the plaintiff University with the above name only. Further, the plaintiff University is the first University in India to get accreditation from various International Agencies like ABET (USA), IET, Energy Institute (U.K). This again shows the cross border reputation of the plaintiff. The accreditation and the certificates were issued to the plaintiff-University in the name of 'VIT University'. Thus, the name, that is the mark, has become a well known mark because of enormous reputation it had acquired in India as well as overseas all these years.

5(6)The 5th defendant, the University Grants Commission identifies the plaintiff-University as 'VIT University'. Further, they send their communications to the plaintiff as 'VIT University'. The national Assessment and Accreditation Council, which is an autonomous Institution of University

Grants Commission granted accreditation to the plaintiff-University in the name of VIT University with 'A' Grade. In the same manner All India Council for Technical Education and National Board of Accreditation had also granted accreditation to the plaintiff-University in the name of 'VIT University'. Further, the Ministry of Human Resource Development also addresses that plaintiff-University as 'VIT University'.

5(7)The plaintiff is motivating the talents by giving scholarship worth over Rs.3 Crores by way of Merit scholarship to class toppers. Free education is provided to rural students who secure ranks at District Level. The said scheme is called STARS Scheme (Support the advancement of Rural Students) which offers 100% free education, hostel accommodation and mess facilities to one boy and one girl who secure the highest marks among students of Government Schools in rural areas of each District in Tamil Nadu. As of now 234 of such students (115 boys + 119 girls) are pursuing their higher studies. Financial assistance is provided to students who wish to do their project work as partner with Universities and Institutions Abroad.

5(8)The reputation of the educational institute depends on the number of its students securing jobs in the campus interviews and the plaintiff University is a preferred destination for campus recruitment among private institutions in India. Their students are highly rated in private and public sector industries and receive the excellent job offers from reputed top companies with high packages. The plaintiff University was entered in Limca books for Records twice in 2009 and 2011 for the highest number of campus

placements by a single company in a single campus. More than 130 companies visited the plaintiff-University for campus recruitments in 2011. The top most companies like TCS, WIPRO INFOSYS, COGNIZANT etc., have accorded most favoured status and are giving preference to recruit the students from the plaintiff-University. The plaintiff also entered into various Memorandum of Understanding with top companies for placement and training centres. The plaintiff has acquired popularity among the students and their parents both at National and International level for the mark referred to as VIT as could be seen from the number of students appeared and admitted for various branches from 2001 onwards.

5(9)Therefore, it is evident that the plaintiff has acquired phenomenal reputation and goodwill of a high order as also attained the status of “**well known trademark**” within the meaning of Trade Marks Act, ever since 2001. The plaintiff had applied for registration of their name 'VIT' vide Trade Mark Application No.1130066, dated 30.08.2002, in class 16 in respect of paper and paper articles, cardboard and cardboard articles, printed matter, newspapers and periodicals, books, photographs, stationery adhesive materials (stationary), instructional and teaching materials (other than apparatus), pamphlets, visiting cards, letter heads, bill books, invoices. Further, the plaintiff has also filed another Trade Mark Application No.1130065 dated 30.08.2002 in Class 16 for registration of marks 'VIT – A PLACE TO LEARN, A CHANCE TO GROW'. So also the plaintiff filed Trade Mark Application No.1324167, dated 06.12.2004, in class 41 for registration

of Mark 'VIT' in respect of Education, providing of training, entertainment, sporting and cultural activities. All the above trade marks are registered, valid and subsisting till date.

5(10)While so, during June-2011, the plaintiff came across through Internet that one Vivekananda Institute of Technology and Vivekananda Institute of Technology (East) (Part of SKIT Groups of Colleges) are using the mark 'VIT CAMPUS' on their buildings and in their other printed materials. The plaintiff immediately issued cease and desist notice to the said institutions not to use the plaintiff's registered Trademark VIT in any manner. Despite the receipt of the notice, the said institutes have not withdrawn the use of the trademark VIT nor complied with the other demands. Hence, the plaintiff issued another legal notice through their Advocate on 04.05.2012.

5(11)During May-2012, the plaintiff has received queries from prospective students and parents from North India as to whether the plaintiff has started any campus at Jaipur like in Chennai. The plaintiff made a search and it has come to light that one Bagaria Education Trust, Jaipur has started an University in the name of 'VIT University' and on browsing they came to know that they have also started the similar Website as *www.vitjaipur.ac.in*. On going through the Website, the plaintiff has come to know that one Sri.K.R.Bagaria a Chartered Accountant had established Swami Keshvanand Institute of Technology Management & Gramothan, Jaipur in the year 2000. In the year 2002, he has promoted another society

Marudhar Education Society for establishing Engineering College in Bikaner. In the year 2005, K.R.Bagaria started Swami Keshvanand Institute of Pharmacy. These educational institutes were started by Bagaria Education Trust, the 1st defendant herein, which came into being in the year 2002. In the year 2008, two Engineering Colleges namely Vivekananda Institute of Technology (2nd defendant) and Vivekananda Institute of Technology (East) at Jaipur (3rd defendant) were also started with these educational institutes.

5(12)The defendants 1 to 4, knowing the reputation of the plaintiff and with the object of illegally appropriating the reputation, by abbreviating the name and imitate the same as that of the plaintiff, had intentionally started the engineering colleges in the name of Vivekananda Institute of Technology only during 2008. Further, the defendants 1 to 4, to show their institute as if it is the campus of the plaintiff, had mentioned their name boards as 'VIT CAMPUS', only to show their institute is an associate institution of the plaintiff, who is highly reputed. The 1st defendant having knowledge of all the reputation and the demand for the admission in the plaintiff Institution, intentionally started the University in the name of 'VIT'. The name of 'VIT University' is a slavish imitation of the plaintiff's name. The adoption of the above mark VIT by the defendants 1 to 4, knowing the reputation and mark of the plaintiff viz., VIT is only to deceive the students to join with them as they are made to believe that they are joining in the plaintiff-University. Hence, the plaintiff has filed the present suit.

6. Pending the suit, the plaintiff has filed the above applications for the interim reliefs as stated supra.

7. When the above applications came up on 27.07.2012, this Court ordered notice to the defendants.

8. On appearance, the defendants 1 to 4 have filed common counter affidavit, denying all the allegations made by the plaintiff, and *inter alia*, contenting as follows_

The 1st defendant is a Trust, providing education services in the State of Rajasthan by establishing various educational institutes. It is engaged in operating a number of educational institutions including the defendants 2 to 4 herein viz., ***Vivekanand Institute of Technology, Vivekanand Institute of Technology (East), and VIT University, Jaipur***, which was established by Rajasthan State Legislature vide Act No.11/2012, Notification FIL2(17) Vidhi/2/2012, dated 02.05.2012. The 1st defendant was constituted by a group of professionals from Rajasthan, including Mr.K.R.Bagaria (Managing Trustee of 1st defendant), who felt that special efforts were needed for promoting education in the rural areas particularly amongst rural women. On 20.06.2008, the 1st defendant got approval from All India Council for Technical Education (AICTE) to establish *Vivekananda Institute of Technology, Jaipur* (2nd defendant herein), to impart education in the field of technology and offer B.E/B.Tech Degree courses.

Further, on 30.06.2008, AICTE approved one more college of the 1st defendant under the name *Vivekanand College of Engineering (VCE)*. In the year 2010, AICTE approved the change of name of VCE into *Vivekananda Institute of Technology (East)* (3rd defendant herein). The defendants 2 & 3 find their names as one of the premier institute providing quality education in the northern part of India. The contributions of the great people, who devoted their life for the cause of education and youth, have always inspired the 1st defendant and therefore, the defendants 2 & 3 have been named after the great Swami Vivekananda. As the name suggests, the institutes have been built on the eternal guidelines and thoughts as advocated by Swami Vivekananda. Besides being approved by AICTE, the defendants 2 & 3 are affiliated to Rajasthan Technical University (RTU), Kota. The 1st defendant and its institutions (defendants 2 & 3) right from inception, have gained intense goodwill and reputation in the market. They have earned a distinct place in the field of technical education and is a well known name, not only in the State of Rajasthan, but in other parts of India as well, for offering top quality education services, world class infrastructure and other related facilities. The distinct place of the defendants 1 to 3 in the market prompted them to apply for setting up a university in the year 2010, which was duly accepted by the Government of Rajasthan and by virtue of the VIT University, Jaipur Act, 2012 (Act No.11 of 2012), published in the Gazette of Rajasthan dated 2nd May, 2012, VIT University, Jaipur, has come into existence. The 1st defendant is a *bonafide* adopter and user of VIT

University, Jaipur, as it has become an essential feature of its trade names and is an integral to its persona and is identified and associated with the 1st defendant. Moreover, the 1st defendant does not use only 'VIT' *per se*, but in a composite form and as an acronym of its trade names namely, 'Vivekanand Institute of Technology', '*Vivekanand Institute of Technology (East)*', '*VIT University, Jaipur*', is always used as a whole, which has been assigned to it by Rajasthan State Legislature vide Act No.11/2012, Notification FIL2(17) Vidhi/2/2012, dated 02/05/2012. The 4th defendant has entered into various memorandum of understanding with other institutions including two foreign universities. These Memorandum of Understandings have been entered into in the name of VIT University, Jaipur. Though the plaintiff has filed the suit based on the registrations of the mark VIT in Classes 41 & 16, the said registrations are not valid in the eye of law. The 1st defendant has already filed a Rectification Application against the plaintiff's Trademark Registration No.1324167 in class 41 and the online status of the said application has already been updated as 'Rectification Filed'. Further, VIT is a three letter acronym and it lacks basic requirements of a valid trademark as it is inherently not distinctive as per provisions of Indian Trademarks Act, 1999. The plaintiff is not the first entity to have adopted the acronym VIT, as there were many institutions in India which had used the acronym VIT even before the alleged usage of VIT by the plaintiff. It is customary and *bonafide* practice in the educational field that educational institutes use acronym of their names because their names are usually lengthy; so for the sake of

convenience, acronym forms of names are adopted. The acronym VIT is being used by various institutions including the defendants. There are about 26 institutes using the acronym VIT. The 1st defendant and its institutions have started using the acronym VIT right from the inception of the defendants 2 & 3 in the year 2008. However, the plaintiff has filed the present suit only in the year 2012. Hence, there is an unexplained delay of three years in filing the suit. The plaintiff has come to this Court with unclean hands by suppressing the fact that the trademark VIT in class 41 under application No.1324167 was challenged under a rectification petition filed by the defendants before the Registrar of Trademarks. The acronym VIT is non-distinctive and it is common to trade; hence, the plaintiff cannot claim monopoly over the same. Thus, the defendants 1 to 4 sought for dismissal of the applications.

9.It is the submission of the learned senior counsel appearing for the plaintiff that in the year 1984, the private Engineering College was started by the North Arcot Educational and Charitable Trust, in the name of Vellore Engineering College at Vellore, North Arcot District. Subsequently, the name of the College was changed as Vellore Institute of Technology and the same was declared as a deemed university with effect from 19.06.2001 and approved by the University Grants Commission. By virtue of University Grants Commission's communication and consequent Board Resolution dated 10th October 2006, Vellore Institute of Technology was renamed as "VIT

UNIVERSITY". The plaintiff has acquired popularity among the students and their parents both at National and international level for the mark 'VIT'. The plaintiff has applied for registration of its name VIT vide Trade Mark Application No.1130066, dated 30.08.2002, in Class 16 in respect of paper and paper articles, cardboard and cardboard articles and etc. The plaintiff has also filed Application No.1324167, dated 06.12.2004, in Class 41 for registration of Mark "VIT" in respect of Education, providing of training, entertainment, sporting and cultural activities. The said mark was registered on 19.11.2005 in favour of the plaintiff. While so, during June-2011, the plaintiff came across that one Vivekananda Institute of Technology and Vivekananda Institute of Technology (East) (Part of SKIT Group of Colleges) are using the word 'VIT CAMPUS' on their buildings and in their other printed materials. Though the plaintiff issued cease and desist notice on 27.07.2012 to the said institutions not to use the plaintiff's registered Trade Mark VIT in any manner, the said institutions have not withdrawn the use of the Trade Mark 'VIT'. The name of 'VIT University' is a slavish imitation of the applicant's name. The defendants, with the *mala fide* intention of securing the students, who would have only joined the applicant's Deemed University, is attempting to cause confusion as if they are a part of the plaintiff university and get the students admitted and thereby unjustly enriched. Further, the learned counsel for the plaintiff, by inviting the attention of this Court to Section 2(1)(zg) of the Trade Mark Act, submitted that the by long and continuous usage of the mark VIT, the plaintiff has built the mark VIT as a

"*well known mark*" of the plaintiff, as defined under Section 2(1)(zg) of the Act. The defendants have adopted the mark only from the year 2012, whereas the plaintiff has adopted the mark from the year 2001 itself. The act of the defendants 1 to 4 in naming their institutions as VIT University is an act of infringement of the registered trade mark of the plaintiff. The plaintiff University is one of the India's top University and conducting their exclusive entrance examination all over India in the name 'VITEE'. Further, the plaintiff issued huge number of advertisements and their articles, rankings were published in the newspapers, periodicals and other journals. Various Institutions granted accreditations and certificates. The plaintiff entered into more than hundreds of Memorandum of Understandings with foreign Universities. Whereas, the 4th defendant is only a recent entrant and entered only in May-2012 and they cannot be compared with that of the plaintiff. The plaintiff's mark is "*well know mark*" by virtue of its reputation and long usage. The learned senior counsel for the plaintiff further submitted that the mark VIT was also registered in the Office of Registrar of Trademarks. Hence, as on date, there is a valid registration made 'VIT' in favour of the plaintiff. Therefore, the plaintiff is entitled for statutory protection for the mark 'VIT'.

10. Further, the learned senior counsel for the plaintiff submitted that after filing the suit, the Board of Management of the VIT University, Jaipur, after seeking approval of the sponsoring body i.e., Bagaria Educational Trust

has requested the State Government to change the name of the University from VIT University, Jaipur to Vivekananda Global University, Jaipur, so as to avoid any litigation. In fact, a Bill has also been passed changing the name from *VIT University* to *Vivekananda Global University*. However, the defendants 1 to 4, during the academic year 2013-2014, had circulated a brochure under the caption/title VIT CAMPUS, JAIPUR, and the name of the institution was mentioned as Vivekananda Global University, Jaipur (Formerly VIT University, Jaipur). This once again created confusion among the student community, leading to huge distortion in changing the name of the University of the defendants. The change of the name effected by the defendants is not followed by them and it remains only on paper.

11.It is further submitted by the learned senior counsel for the plaintiff that continuous use of the name VIT by the defendants 1 to 4, despite passing an amendment to the VIT University Jaipur Act, 2012 (Bill No.30 of 2013 dated 07.06.2013) only proves their *malafide* intention to divert the plaintiff from proceeding with the pending litigation. The defendants had applied for a trademark registration in TM Application No.2167415 dated 12.08.2013 in Class 41 for the mark VIT before the Trade Mark Registry, Ahmedabad and the same has been abandoned by the Registry by operation of Section 21(2) of the Trade Mark Act, 1999, vide order dated 17.04.2014.

12.The learned senior counsel for the plaintiff submitted that now the

defendants 1 to 4 have taken a defence in their counter affidavit stating that VIT is not a distinctive word and it is common to trade and the same cannot be restricted to one person. In this regard, the learned counsel for the plaintiff submitted that once the defendant has chosen to apply for the registration of a trademark, he cannot challenge the same stating that the word is not distinctive and common to the trade. In support of his contention, the learned senior counsel for the plaintiff relied upon the decision reported in **2011(4) CTC 417 [Blue Hill Logistics Pvt Ltd., Vs. Ashok Leyland Limited]**.

13. Further, the learned counsel for the plaintiff, by relying upon the judgment reported in **1998 PTC (18) 698 [Indian Shaving Products Ltd and others Vs. Gift Pack & another]**, submitted that even a descriptive mark can become distinctive and capable of registration, if it can be established that through extensive usage and goodwill, the descriptive word itself has become distinctive of the user. In the instant case, the name VIT was registered in the year 2005 in favour of the plaintiff and by continuous and long usage of the word VIT, it has become distinctive.

14. The learned counsel for the plaintiff submitted that the plaintiff registered the trademark VIT for providing educational service. The defendants 1 to 4 are also involved in the educational service and adopted the identical mark VIT, as that of the plaintiff. Hence, the act of the

defendants 1 to 4 squarely falls under Section 29(2)(c) of the Trade Mark Act; therefore, the plaintiff is entitled for interim order of injunction.

15. Per contra, the learned counsel for the defendants 1 to 4 submitted that the 1st defendant is a Trust established on 13th December 2002. The 1st defendant got approval from All India Council for Technical Education (AICTE) on 20th June-2008, to establish 'Vivekananda Institute of Technology, Jaipur (2nd respondent herein). Further, on 30th June-2008, All India Council for Technical Education (AICTE) has approved one more college of the 1st defendant under the name *Vivekanand College of Engineering (VCE)*. In the year 2010, All India Council for Technical Education (AICTE) approved the change of name of *Vivekandand College of Engineering (VCE)* into *Vivekanand Institute of Technology (East)* (3rd defendant herein). After filing the suit, the Board of Management of the VIT University, Jaipur, after seeking approval of the sponsoring body i.e., Bagaria Educational Trust has requested the State Government to change the name of the University from VIT University, Jaipur to Vivekananda Global University, so as to avoid any litigation and subsequently, a Bill has also been passed changing the name from VIT University to Vivekananda Global University. After changing the name as Vivekananda Global University, the defendants 1 to 4 are not using the name "VIT University". Since the defendants 1 & 2 are using the acronym VIT, they are claiming their campus as VIT Campus, since VIT is a short abbreviation of Vivekananda Institute of Technology and Vivekananda

Institute of Technology (East) [defendants 2 & 3 herein]. The plaintiff never used VIT *per se*. The acronym VIT is common to trade. In fact, acronym VIT is used by several parties in the trade including educational institutes, without any confusion or deception. In this regard, the learned counsel for the defendants 1 to 4 invited the attention of this Court to the list of institutions, which are using the acronym VIT.

16.The learned counsel for the defendants 1 to 4 further submitted that the students, who are seeking higher education, who are required to make investment of a substantial amount for their higher studies, are bound to make enquiry about the credentials of the institutes concerned. Therefore, the use of *VIT Campus* by the defendants would no way amount to creating any confusion in the minds of the students. In support of this contention, the learned counsel for the defendants 1 to 4 relied upon the judgments reported in **MANU/MH/1077/2012 [ITM Trust, Mr.Putcha Venkata Ramana and Mrs.Putcha Lalitha Ramana Vs. Educate India Society]** and **2008(37) PTC 413 (SC) [Khoday Distilleries Ltd Vs. Scotch Whisky Association & Ors]**.

17.The learned counsel for the defendants 1 to 4 would further submit that monopoly of a generic word is not allowed under law and in the instant case, the acronym VIT is only a descriptive and generic word; hence, the plaintiff cannot claim monopoly over VIT. In this regard, the learned counsel

for the defendants 1 to 4 relied upon the judgment reported in **2010(42) PTC 217(SC) [Skyline Education Institute (I) Private Ltd Vs. S.L.Vaswani and another]**.

18.The learned counsel for the defendants 1 to 4 further submitted that any symbol, word or get-up commonly used by the traders in connection with their trade and in respect of which no particular trader can claim an exclusive right to use, may be considered common to that particular trade or *publici juris*. Further, the words, expressions or devices, which are descriptive of particular goods, are open to use by all persons engaged in the trade. In this regard, the learned counsel for the defendants 1 to 4 relied upon the decision reported in **MIPR 2009(1)356 [Lowenbrau AG and anr Vs. Jagpin Breweries)]**.

19.It is further submission of the learned counsel for the defendants 1 to 4 that since the plaintiff has applied for registration of the mark 'VIT', it does not mean that the defendants are not entitled to use the word 'VIT Campus'. Since name of the 2nd defendant has been changed to Vivekananda Global University, they have abandoned their application for registration of the Mark VIT University. Though the application for registration of the mark VIT University was abandoned, there cannot be any legal bar in referring their campus as VIT campus, since the word VIT is only a descriptive and generic word. Further, the learned counsel for the defendants 1 to 4

submitted that the defendants 1 to 4 is imparting education only in the State of Rajasthan; whereas the plaintiff is having its university at Vellore; therefore, absolutely, there is no likelihood of confusion. Thus, he sought for dismissal of the application.

20.By way of reply, the learned senior counsel for the plaintiff submitted that though several institutions are using the plaintiff's mark VIT, in all the cases, whenever the same came to the knowledge of the plaintiff, the plaintiff has initiated action against them; therefore, the usage of the mark VIT by the third parties cannot be a defence for the defendants. In this regard, the learned counsel for the plaintiff also relied upon the decision reported in **2007(4) MLJ 1022 [B.Kishore Jain Vs. Navaratna Khazana Jewellers]**.

21.Further, the learned senior counsel for the plaintiff submitted that the mark VIT, by continuous and long usage, has attained distinctiveness relating to the plaintiff. Therefore, the defendants 1 to 4 cannot use the mark "VIT Campus'. In this regard, the learned counsel for the plaintiff **MANU/DE/1822/2009 [Larsen and Toubro Ltd., Vs. Lakshmi Industries and another]**.

22.Heard the submissions made on either side and perused the materials available on record. In view of the submissions made on either

side, the following question falls for consideration_

Since the plaintiff is the prior and registered user of the mark VIT in respect of education, providing of training, entertainment, sporting and cultural activities, whether the defendants are entitled to use the same mark VIT for their University campus as 'VIT Campus'?

23.Originally the plaintiff had established a Trust by name 'North Arcot Educational and Charitable Trust' in the year 1984 and during the same year, they started a private college in the name and style of *Vellore Engineering College* at Vellore. Later, the name of the Trust was changed to 'Vellore Institute of Technology'. Subsequently, the Department of Secondary and Higher Education, Ministry of Human Resource Development issued a Notification No.F.9-2/99-U.3 dated 19.06.2001 declaring the Vellore Institute of Technology as Deemed University. The institutions of the plaintiff are called shortly as VIT. Thereafter, the plaintiff had applied for registration of the name VIT vide their Trademark Application No.1130066, dated 30.08.2002 in Class 16 and Trademark Application No.1324167, dated 06.12.2004 in Class 41. The plaintiff's trademark VIT has attained the status of "*well known trademark*" within the meaning of Trade Marks Act since 2001. While so, during June-2011, the plaintiff came to know through internet that the 1st defendant-Trust at Jaipur has started the institutions in the name of VIT University. The 1st defendant-Trust has started two engineering colleges in the name of *Vivekananda Institute of Technology* and

Vivekananda Institute of Technology (East) (defendants 2 & 3 herein) and mentioned their name boards as *VIT Campus*. It is the case of the plaintiff that the 1st defendant had intentionally started the University in the name of VIT to deceive the students to join with them as they are made to believe that they are joining the plaintiff's institution. Hence, the plaintiff has filed the suit for the reliefs as stated supra.

24. After filing the present suit, the 1st defendant has changed the name of their institution from VIT University, Jaipur to Vivekananda Global University. In fact, Her Excellency the Governor of Rajasthan promulgated the ordinance "The VIT University, Jaipur (Change of Name) Ordinance, 2013 (Ordinance No.8 of 2013), on 7th June, 2013, which was published in Rajasthan Gazette, Part IV(B), Extraordinary, dated 10th June, 2013. To replace the said ordinance, the 6th defendant, State of Rajasthan, introduced a Bill No.30 of 2013 'The VIT University, Jaipur (Change of Name) Bill, 2013" in the Rajasthan Legislative Assembly and the same was discussed and passed on 27.08.2013. The relevant portions in the said Bill passed on 27.08.2013 are extracted hereunder_

"Be it enacted by the Rajasthan State Legislature in the Sixty-fourth Year of the Republic of India, as follows:-

1. Shot title and commencement:-

(1) This Act may be called the VIT University, Jaipur (Change of Name) Act, 2013.

(2)It shall be deemed to have come into force on and from 7th June, 2013.

2.Change of Name of the VIT University, Jaipur:- (1)The name of the VIT University, Jaipur incorporated under the VIT University, Jaipur Act, 2012 (Act No.11 of 2012), hereinafter referred to as the principal Act, shall, as from the date of commencement of this Act, be "The Vivekananda Global University, Jaipur".

(2)Any reference to the VIT University, Jaipur in any law for the time being in force or in any indenture, instrument, or other documents shall be read and construed as a reference to that University under its name as altered by this Act.

(3)Nothing in this Act shall affect the continuity of the corporate status of the said University.

3.Amendment:- (1)As from the date of commencement of this Act, the principal Act shall stand amended to the extent and in the manner specified in the schedule.

(2)The provisions of sub-section(1) shall be without prejudice to the generality of the provisions of Section 2.

4.Citation of the principal Act:-The principal Act may be cited as the Vivekananda Global University, Jaipur Act, 2012.

5.Repeal and savings:-(1)The VIT University, Jaipur (Change of Name) Ordinance, 2013 (Ordinance No.8 of 2013) is hereby repealed.

(2)Notwithstanding such repeal, all things done, actions taken or orders made under the principal Act as amended by the said Ordinance shall be deemed to have been done, taken or made under the principal Act as amended by this Act.”

The learned senior counsel for the plaintiff has also invited the attention of this Court to the *STATEMENT OF OBJECTS AND REASONS* for passing the aforesaid Bill, which read as follows:-

STATEMENT OF OBJECTS AND REASONS

With a view to keep pace with the rapid development of the State and to provide higher education by allowing the private institutions engaged in higher education having sufficient resources and experience, the VIT University, Jaipur was established by the State Government in the year 2012.

After the establishment of the VIT University, Jaipur, a writ petition was filed by the VIT University, Vellore (Tamilnadu) before the Hon'ble High Court of Judicature at Chennai wherein it was requested to the Hon'ble Court to issue an interim injunction restraining from infringement in any form of the Trade Mark 'VIT'. Keeping in view the aforesaid writ petition, the Board of Management of the VIT University, Jaipur after seeking the approval of the sponsoring body ie., Bagaria Education Trust, Jaipur has requested the State Government to change the name of the University from the VIT University, Jaipur to the Vivekananda Global University, Jaipur so as to avoid any litigation.

The State Government had considered the above request to change the name of the VIT University, Jaipur to The

Vivekananda Global University, Jaipur'.

Since the Rajasthan Legislative Assembly was not in session and circumstances existed which rendered it necessary for the Governor of Rajasthan to take immediate action, she, therefore, promulgated the VIT University, Jaipur (Change of Name) Ordinance, 2013 (Ordinance No.8 of 2013), on 7th June, 2013, which was published in Rajasthan Gazette, Part IV (B), Extraordinary, dated 10th June, 2013.

This Bill seeks to replace the aforesaid Ordinance.

Hence the Bill.

Minister Incharge."

Now, after filing the suit, by way of the above said Bill the name of the 1st defendant university viz., VIT University, Jaipur was changed into Vivekananda Global University. In spite of the change of the name, still the defendants 1 to 4 are claiming their campus as 'VIT Campus' stating that VIT is a short abbreviation of Vivekananda Institute of Technology, Jaipur and Vivekananda Institute of Technology (East) (defendants 2 & 3). In spite of the change of name of the University, since the defendants 1 to 4 are claiming their campus as 'VIT Campus', the plaintiff is insisting for injunction against the defendants.

25. But, it is the reply of the learned counsel for the defendants 1 to 4 that the defendants 1 to 4 are using the acronym VIT, since VIT is a short abbreviation of 'Vivekananda Institute of Technology, Jaipur' and 'Vivekananda Institute of Technology (East)', (defendants 2 & 3). The

acronym VIT is common to trade and infact, the acronym VIT is being used by several parties in the trade including educational institutes. It is further submission of the learned counsel for the defendants 1 to 4 that the students, who are seeking higher education, are making investment of substantial amount for their higher studies and they are bound to make enquiry about the credentials of the institutes concerned. The students being the educated persons cannot be deceived on VIT, Jaipur as 'Vellore Institute of Technology' because admission to a college is not buying products in the market to get confused easily. In this regard, the learned counsel for the defendants relied upon the decision reported in **2008(37) PTC 413 (SC) [Khoday Distilleries Ltd., Vs. Scotch Whisky Association]**, wherein it has been held that where the class of buyers is quite educated and rich, the test to be applied is different from the one where the product would be purchased by the villagers, illiterate and poor.

26.Though it is the defence of the defendants 1 to 4 that the educated persons cannot be confused or deceived even if the abbreviation of the names of the two educational institutions resembles the same and as such, there cannot be a bar for the defendants for using the mark VIT for this campus, I find that the plaintiff has registered the trademark VIT before the Registrar of Trademarks, for providing educational service. The defendants 1 to 4 are also engaged in the same profession of providing education and they also adopted the identical mark VIT Campus. When there is an earlier

registration of the mark VIT in favour of the plaintiff, definitely the plaintiff is entitled for statutory protection. The registration of the mark VIT in favour of the plaintiff is valid and subsisting as on date. The rectification application filed by the 1st defendant against the plaintiff's registration for the mark VIT under Registration No.13241678 in Class 41 is pending before the Trademark Registry. Therefore, I am not inclined to accept the submissions made by the learned counsel for the defendants 1 to 4 that since the class of customers are educated persons, there would not be any confusion about the mark of the defendants and the plaintiff and as such, they are entitled to use the Trademark 'VIT'.

27.It is another defence of the learned counsel for the defendants that the acronym VIT is only a descriptive and generic word; hence, the plaintiff cannot claim monopoly over the acronym VIT. In support of his contention, the learned counsel for the defendants 1 to 4 relied upon the judgment reported in **2010(42) PTC 217(SC) [Skyline Education Institute (I) Private Ltd Vs. S.L.Vaswani and another]**.

28.But, even assuming for a moment, the acronym VIT is a common and generic word, the plaintiff has been using the said word VIT right from the year 2001 and the said mark VIT was also registered in the year 2005 in favour of the plaintiff. Furthermore, by long and continuous usage, the plaintiff has built the mark VIT as a “**well know mark**” as defined under

Section 2(1)(zg) of the Trademarks Act. Now, the said mark VIT has become distinctive and associated with the plaintiff. Since the 1st defendant started to use the same mark VIT for the identical service, definitely it will create confusion in the mind of the general public. Moreover, the defence of the learned counsel for the defendants that the mark VIT is a descriptive and generic word and as such, the plaintiff can not claim monopoly over the same, is not available to the defendants, since the 1st defendant itself had filed application for registration of the mark VIT, which was subsequently abandoned by them in view of the change of the name of VIT University, Jaipur into Vivekananda Global University. In this regard, a reference could be placed in the judgment reported in **2011(4) CTC 417 [Blue Hill Logistics Pvt. Ltd., vs. Ashok Leyland Limited]** wherein it has been held as follows__

“37.The words 'Luxura' and 'Luxuria' are only variants of the descriptive term 'Luxury' and as a consequence, the protection available is not so strong. But, the 1st defendant cannot take advantage of the same. As pointed out by the learned Single Judge, 1st defendant himself had applied for registration of trade mark 'Luxuria' under Classes 39 and 35 despite the fact that there is a prohibition under Section 9(1)(b) of the Act. The person claiming exclusive right over the expression cannot challenge the same expression as generic.”

From the dictum laid down in the above said judgment, I find that when the

1st defendant itself had applied for registration of the mark VIT, now they cannot say that the mark VIT is descriptive and generic word. Moreover, as observed earlier, by continuous usage of the mark VIT since 2001, the plaintiff has built the said mark as '*well known mark*'. Hence, the defence put forth by the defendants that since the mark VIT is a descriptive and generic word, the plaintiff cannot claim monopoly over the said mark, cannot be accepted in the factual background of the case on hand.

29. It is another contention of the learned counsel for the defendants 1 to 4 submitted that since the three letter mark VIT is only an acronym of 'Vivekananda Institute of Technology' and 'Vivekananda Institute of Technology (East)', (defendants 2 & 3 herein), which are located in the campus of the 1st defendant, the campus is called as VIT campus. Only for the sake of convenience, the acronym form of the names is adopted. In this regard, the learned counsel for the defendants has also submitted that the more than twenty institutions are using the acronym VIT.

30. But, it is the reply of the learned senior counsel for the plaintiff that whenever it comes to the knowledge of the plaintiff that an educational institute was using the mark VIT and on all such occasions, the plaintiff has been regularly taking the legal action against them. Therefore, the use of the mark VIT by the third parties cannot be a defence for the defendants. In this regard, the learned senior counsel for the plaintiff has also relied upon

the judgment reported in **2007(4) MLJ 1022 [B.Kishore Jain Vs. Navaratna Khazana Jewellers]** wherein it has been held that the mere use of trademark by third parties will not be a defence unless it is established that by such rampant use, there is no exclusivity for the plaintiff.

31.In the instant case, I find that the defendants 1 to 4 are also using the same mark VIT for the identical service as that of the plaintiff; when the plaintiff has already registered the mark VIT, the defendants 1 to 4 cannot use the mark VIT to refer their campus, that too particularly when the name of the 1st defendant's institution has been changed from VIT University, Jaipur into Vivekananda Global University. Since the plaintiff is a registered owner of the mark VIT, the plaintiff is entitled for the statutory protection for the mark VIT.

32.It is yet another submission of the learned counsel for the defendants 1 to 4 that the plaintiff is having their University at Vellore; whereas the defendants are having their University at Jaipur; therefore, there is no likelihood for confusion.

33.But, it is the reply of the learned senior counsel appearing for the plaintiff, by relying upon the decision in the case of **Gangotree Sweets & Snacks Vs. Shree Gangotree Sweets MANU/TN/2389/2005**, that since the registration certificate did not contain any geographical limitation, the plaintiff is entitled to sue an infringer anywhere in India.

34. In the instant case, since the mark VIT has been registered in favour of the plaintiff, the defence put forth by the learned counsel for the defendants that the defendant University is situated at Jaipur; whereas the plaintiff University is situated at Vellore, has no significance. Further, by long and continuous use of the mark VIT by the plaintiff, the mark VIT has become well known and associated with the plaintiff. If the defendants 1 to 4 are allowed to use the same mark for the identical service, certainly it would cause great confusion in the minds of the general public.

For the foregoing reasons, I am of the opinion that a *prima facie* case has been made out by the plaintiff and the plaintiff is entitled for the grant of interim injunctions as sought for. Hence, there shall be an order of interim injunctions as prayed for in the present applications.

01.06.2015

Internet : Yes / No

Index : Yes / No
ssv

R.SUBBIAH, J.,

SSV

Pre-delivery order
in
O.A.No.640 of 2012
and
O.A.Nos.576 to 578 of 2012
in
C.S.No.476 of 2012

01.06.2015