

* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

Pronounced on: April 10, 2017

+ **FAO(OS)(COMM) 21/2016**

DPS WORLD FOUNDATION & ANR Appellants
Through: Mr.Salman Khurshid, Appellant
No.2-in-person.
Mr.Anil Airi, Sr.Adv., Mr.Sumeet Pushkarna,
Ms.Girija Krishan Verma, Mr.Abhishek Saket,
Mr.P.K.B. Dubey, Mr.Aadil Singh, Ms.Vijaya
Singh, Ms.Sakshi Kotiyal and Mr.Vikramditya
Singh, Advs. for Appellant No.1

Versus

DELHI PUBLIC SCHOOL SOCIETY Respondents
Through: Mr.Sandeep Sethi, Sr.Adv. with
Mr.Sudhanshu Batra, Sr.Adv., Mr.Puneet Mittal,
Mr.Bhuvan Gugnani, Mr.Rupender Pratap Singh,
Ms.Vasudha Bajaj, Mr.Amitej Nagar, Mr.Sagar
Mittal and Ms.Arushi Tangri, Advs.

CORAM:

HON'BLE THE CHIEF JUSTICE

HON'BLE MS.JUSTICE SANGITA DHINGRA SEHGAL

J U D G M E N T

: **Ms.G.ROHINI, CHIEF JUSTICE**

1. This appeal under Order 43 Rule 1 of CPC read with Section 13 of Commercial Courts, Commercial Division and Commercial Appellate Division of High Courts Act, 2015 is directed against the order of the learned Single Judge dated 18.4.2016 in IA No. 2920/2016 in CS(COMM) 154/2016.

2. The said IA No.2920/2016 was filed by the plaintiff / respondent herein under Order 39 Rules 1 and 2 CPC, 1908, to restrain the defendants / appellants herein from dealing in any manner *inter alia*:

"a) from offering their services, advertising, offering franchisees, selling goods and stationary, adopting, using and/or dealing in any manner with the registered trade mark/name 'DPS' and logo



of the plaintiff or any other trade mark identical or deceptively similar to the registered trade marks of the plaintiff amounting to infringement and passing off the plaintiffs registered trade marks.

b) from offering services, advertising, offering franchisees, selling goods, adopting, using and/or dealing in any manner with the trade mark/name 'DELHI PUBLIC SCHOOL' and the crest logo



of the plaintiff or any other trade mark identical or deceptively similar to it amounting to passing off the plaintiffs trade mark/name.

c) from using the impugned trade mark/name 'DPS', 'Delhi



Public School' and logo

d) from directly or indirectly reproducing, using and/or dealing



in any manner with the plaintiff's crest and or any other crest identical or deceptively similar amounting to infringement of the plaintiff's copyright in the said crests."

3. By the order under appeal dated 18.04.2016, the learned Single Judge allowed the application on the following terms:

"1. The defendants, their life trustees, terms trustees, members, franchisees, officers, employees, agents, delegates, representative, associates and all other acting for and on their behalf, are restrained from offering their services, advertising, offering franchisees, selling goods, and stationery, adopting, using and/or dealing in any manner with the registered mark/name 'DPS' or any other mark identical or deceptively similar to the registered mark of the plaintiff, amounting to infringement and passing off the plaintiff's registered trademark till the disposal of this suit;

2. The defendants, their life trustees, terms trustees, members, franchisees, officers, employees, agents, delegates, representatives, associates and all other acting for an on their behalf are restrained from using the impugned trademark/name 'DPS', or any other trademark identical or deceptively similar to it, amounting to passing off the plaintiff's trademark/name, till the disposal of the suit."

4. As could be seen, the relief was granted to the plaintiff to the extent of its registered trade mark/name 'DPS' by restraining the defendants from using, till the disposal of the suit, the registered mark/name 'DPS' or any other mark identical or deceptively similar to the registered mark of the plaintiff amounting to infringement and passing off the plaintiff's registered trademark. The defendants have also been restrained from using the impugned trademark/name 'DPS' or any other trademark identical or deceptively similar to it amounting to passing off the plaintiff's trademark/name.

5. Aggrieved by the same, the present appeal has been filed by the defendants.

6. Before going into the merits of the case, the relevant facts to appreciate the controversy between the parties may be noticed.

7. The plaintiff/Delhi Public School Society is a society registered under the Societies Registration Act, 1860. It is pleaded that it was registered in the year 1948-49 with an object to establish progressive schools or other educational institutions in Delhi or outside Delhi. The plaintiff established its schools at various places in India which are 11 in number and are known as Core Schools. The plaintiff has also entered into agreements with other societies/trusts for establishing schools at various places known as affiliated schools and there are more than such 170 affiliated schools. The plaintiff has also established 15 schools outside India and approximately 3 lakhs students are studying in the schools run under the aegis of the plaintiff.

8. It is also pleaded that in the year 1948, the plaintiff conceived and adopted the crest which comprises of a hand holding a torch along with the school motto "Service Before Self" and the words "Delhi Public School" written inside a shield. It is claimed that the unique crest of the plaintiff is widely recognised in India as well as across borders and has been considered synonymous with the plaintiff and the various schools established by it. During 1996-97, plaintiff conceived and adopted another crest which comprises of a torch (mashaal) on a book along with school motto "Service Before Self" written inside a shield device surrounded by creeper and the words "Delhi Public School" written at the bottom with other distinctive artistic features comprised therein. It is claimed that both the above-said crests are of original artistic work and the plaintiff is the first owner of the same under the provisions of the Copyright Act, 1957.

9. It is claimed that due to continuous and extensive use of its trademark/name "Delhi Public School", its acronym "DPS" as well as two

logos conceived and adopted by it are being perceived by the students, parents and academicians throughout the country and also abroad as an indication of the source of the plaintiff and they have become the un-paralleled benchmark of the academic excellence, goodwill and reputation enjoyed by the plaintiff.

10. In order to secure the statutory rights in respect of the crest conceived in the year 1948 and the trade-names DPS & Delhi Public School, the plaintiff filed applications for registration under the provisions of the Trademarks Act, 1999. So far the crest conceived in the year 1948, the Trademark was registered under Class 16, 35, 36, 41 and 42. Similarly, registration was granted for the trade mark/name 'DPS' under Class 16, 35, 42 and 36. However, the application dated 08.10.2007 under Class 41 for trade mark 'DPS' is still pending. The applications dated 08.03.2011 for trade mark 'Delhi Public School' under Class 16, 36, 35, 41 and 42 are also pending.

11. It is pleaded that the plaintiff has been extremely vigilant about its intellectual property rights and whenever any attempt was made to infringe and/or pass off their services and business by any third parties, the plaintiff filed suits and all such suits were decreed injuncting the defendants therein from using the trademarks/names DPS and Delhi Public School. The suits which were decreed in favour of the plaintiff included ***Delhi Public School Society vs. DPS Trust*** [CS(OS) No.1519/2008; CS(OS) No.1518/2008; CS(OS) No.1520/2008; CS(OS) No.1521/2008; CS(OS) No.114/2011 and CS(OS) No.1092/2012].

12. It is pleaded that the defendant No.1 is a Trust whereas the defendant No.2, who was the life member of the plaintiff Society till 17.10.2015 and was also the President of the plaintiff society from 1994-2004, is stated to be one of the founder trustees of the defendant No.1. It is alleged that the defendant No.1 Trust is functioning under the trade-name 'DPS World Foundation' by adopting the identical trademark/name 'DPS' and a deceptively similar logo/crest. It is pleaded that for the first time the plaintiff came to know about the same in the month of July 2015 when it came across a letter dated 12.06.2015 addressed by the founding trustees of the Defendant No.1 to the Alumni of the schools running under the aegis of the plaintiff. It is alleged that Defendant No.1 is the brainchild of Defendant No.2 who while holding the life membership in the plaintiff deceived the plaintiff by secretly forming the Defendant No.1 Trust and adopting the trademarks of the plaintiff which were extensively used by the plaintiff during the tenure of the Defendant No.2 as the President of the plaintiff. It was found that the defendants are also maintaining a website wherein the impugned trademark "DPS" as well as the crest/logo have been prominently displayed. It was also found from the website that the Defendant No.1 Trust was inaugurated on 16.08.2015 for the purpose of establishing schools and other educational institutions similar to that of the plaintiff and has been using the impugned trademarks in relation to the said services.

13. It is alleged that the logo/crest of the defendant No.1 is identical and deceptively similar to the plaintiff's registered trademark and has been deliberately copied by the defendants in order to gain unlawful advantage and illegal profits by confusing and deceiving the intending parents,

students, staff as well as the general public by misrepresenting that they have connections with the plaintiff. The plaintiff therefore served a show-cause notice dated 24.07.2015 calling upon the Defendant No.2 as to why an action should not be taken against him for having clandestine association in creation of Defendant No.1 and adoption of the impugned trademarks. The Defendant No.2 vide his reply dated 21.08.2015 admitted that he is associated with the Defendant No.1. In the circumstances, the plaintiff vide notice dated 17.09.2015 declared that the Defendant No.2 has ceased to be a life member of the plaintiff society from 17.10.2015. Having received the same Defendant No.2 filed CS (OS) No.3094/2015 with a prayer to declare the notice dated 17.09.2015 as null and void. The said suit is pending on the file of this Court.

14. The plaintiff came to know that the defendants got published advertisements in newspapers for recruiting staff, teachers, employees etc for the schools proposed to be established by them in Greater Noida, Patna, Alwar and other places. It is alleged that on account of unlawful adoption of the registered trademark/name and logo of the plaintiff by the defendants the following consequences are inevitable:

- a) The potential students, staff and parents would believe that the defendants are endorsed by and franchisee of the plaintiff in regard to their services and the defendants command and provide the same quality and reliability i.e. synonymous with the services of the plaintiff which as a matter of facts the plaintiff has build up over last more than 65 years of dedicated hard work.

- b) The general public would also believe that the defendants are licensed or authorized by the plaintiff to use the plaintiff's trade mark/name and logo.
- c) Irreparable loss, injury and damage to the plaintiff in its business, goodwill and reputation and by use of the impugned trade marks by the defendants, value of the plaintiff's trade marks is getting diminished.

15. It is thus pleaded that the plaintiff is likely to suffer unquantifiable loss and irreparable damage unless the defendants are restrained from carrying on their illegal acts of deliberately infringing the plaintiff's trademarks "DPS" and logos and copyrights in the crests.

16. The defendants/appellants herein filed a reply denying the allegations and stating that the defendant No.1/'DPS World Foundation' is a DIPSITES Knowledge initiative and an independent effort of DPS alumni (DIPSITES) and that it is not a part of Delhi Public School Society. It is also pleaded that in fact, "DIPSITES Association" was registered by the DIPSITES under the Societies Registration Act, 1860 as an association of the alumni and staff members of the Delhi Public School in the year 1982 itself. The defendant No.2 was the founding president of the said association. The DIPSITES Association has an active participation in the DPS World Foundation/defendant No.1. While claiming that the goodwill of the plaintiff is actually the goodwill generated by DIPSITES, be it students, staff or teachers, it is contended that the defendant No.1 has no intention to mislead anyone and that the said Trust has been envisaged with the noble objective to give the character of excellence in education, social service and

advancement of human values. While claiming that the values and ethos for which the plaintiff society was created, has over the years degraded in view of the number of franchise schools and the simultaneous lack of attention towards educational standards, it is pleaded that the DIPSITES (alumni of the Delhi Public School) who are the original torch-bearers of the ideals of the Delhi Public School are beholden to further propagate and cherish the true ideals of education and human values and thus several illustrious DIPSITES and former teachers are part of DPS World Foundation/defendant No.1 in the capacity of life members, trustees, etc. It is contended that the members of the DPS World Foundation/defendant No.1 have a strong link with Delhi Public School value system and share the common heritage and legacy that all DIPSITES are entitled to.

17. While categorically denying the allegations in the plaint that the defendant No.1 has adopted the identical trademark/name 'DPS' and deceptively similar logo/crest and thus infringing plaintiff's trademark 'DPS' and logos, it is pleaded that the goodwill that the plaintiff is seeking to appropriate to itself is actually a goodwill generated by the DIPSITES, be its students, staff or teachers without which the plaintiff society has no goodwill. It is also claimed that the *bona fide* altruistic motives of the members of the defendant No.1 are clearly brought forth by the fact that in all the material published and circulated by the defendant No.1, a categorical and prominent advisory which states "***A Dipsites Knowledge Initiative and an independent effort of DPS Alumni (Dipsites). Not a part of Delhi Public School Society, New Delhi***" has been put up. It is thus claimed that the clear intention of the defendant No.1 is to ensure that the public can

clearly discern that the defendant No.1 has no connection or relation whatsoever with the plaintiff society and is an independent initiative of the DIPSITES. It is claimed that the logo of the defendant No.1 also gives a *bona fide* description that the DPS World Foundation is a DIPSITES Knowledge Initiative. The allegation that the defendant No.1 is making fraudulent gain by misrepresentation thus causing unquantifiable loss and irreparable damage to the plaintiff has also been categorically denied.

Findings of the learned Single Judge:

18.1 The learned Single Judge had taken note of the fact that the plaintiff has registration of trademark/name 'DPS' in Class 16 (Paper, Cardboard, Photographs, Stationery), Class 35 (Advertising, Business Management, Business Administration, Office Functions), Class 36 (Insurance, Financial Affairs, Monetary Affairs, Real Estate Affairs) and Class 42 (Food and Drink, Medical, Industrial Research and Computer Programming). Having regard to the admitted fact that the defendant No.1 Trust has been operating under the trade name 'DPS World Foundation' which itself includes 'DPS' in respect of which the plaintiff has the registration of trademark in Classes 16, 35, 36 & 42, the learned Single Judge held that the mark/name of defendant No.1 'DPS World Foundation' or 'DPS World School' would surely cause 'infringement' under the provisions of Section 29 of the Trademarks Act, 1999 of the registered trademark 'DPS' of the plaintiff.

18.2 The learned Single Judge also opined that from the documents placed on record it is clear (at least at this stage) that the mark/name 'DPS' owe its origin to Delhi Public School and not to 'DIPSITES' and to connect defendant No.1 with DIPSITES Association is not appealing. The learned

Single Judge had also taken note of the fact that this Court in various judgments/orders passed with regard to the mark/name 'DPS' held that schools established by the plaintiff society are known as Delhi Public Schools and are popular by the branch names and at the public at large and students, staff refers to the same as 'DPS'. Thus, the learned Single Judge recorded a *prima facie* view that the plaintiff has made out a case for interim relief with regard to the usage of trademark 'DPS' and further the balance of convenience is also in favour of the plaintiff. It was further held that the reliance placed by the plaintiff on several orders of this Court wherein this Court had held 'DPS' enjoyed goodwill and reputation in the field of school education is a relevant factor for determining the *prima facie* case in favour of the plaintiff.

18.3 With regard to the advisory "a Dipsites knowledge initiative and an independent effort of DPS alumni (Depsites). Not a part of Delhi Public School Society, New Delhi," claimed to have been put up by the defendant No.1 right from its inception showing their disassociation with the plaintiff society, the learned Single Judge opined that it is a matter of evidence whether such an advisory would not create confusion or is sufficient notice to the public at large that the defendant No.1 is not associated with the plaintiff in any manner or would not pass off its institution/schools as the plaintiff's schools.

18.4 With regard to the contention on behalf of the defendants that the delay would disentitle the plaintiff the relief inasmuch as the plaintiff became cognizant of the defendant No.1 in the month of July, 2015 and despite such knowledge, the plaintiff has not taken any steps to protect the

trademark till February, 2016 also, the learned Single Judge was of the view that the issue of delay being a mixed question of fact and law needs to be decided in trial upon furnishing evidence.

18.5 The allegation of the plaintiff that the crest/logo of the defendant No.1 when compared to the plaintiff's trademark and logo clearly establishes that the same is identical to the plaintiff's crest/logo conceived and adopted during 1996-97 and deceptively similar to the plaintiff's registered trademark which was conceived in the year 1948 was not accepted by the learned Single Judge observing:

"Apparently, it does not appear to be identical or deceptively similar for the plaintiff to contend infringement of its registered crest logo at 1 of Annexure-A. The only common feature, is the Torch (Mashaal). The crest logo of the defendant No.1 does not feature the hand. Additionally, it has a book in the background. That apart, the crest logo of the defendant has creepers on both sides, which are not there with the crest logo of the plaintiff. The crest logo of the defendant No.1 is not identical or deceptively similar so as to infringe the registered crest logo of the plaintiff. I may note, here, that the defendant No.1 has stated in its reply that it is neither using the registered crest logo of the plaintiff at 1 of Annexure 'A', or it intends to use the same in future."

18.6 With regard to the crest/logo of the plaintiff which was stated to be conceived and adopted by it in the year 1996-97, the learned Single Judge was of the view that the issues involved therein need to be ascertained by way of an evidence to be adduced during the trial. It was also observed that in the absence of any evidence to controvert the plea of the defendants that the plaintiff has used the said crest logo only in the year 2008 and not thereafter, the discretion cannot be exercised in favour of the plaintiff on the

aspect of the said crest/logo while considering the application under Order 39 Rules 1 and 2 of CPC.

19. Thus, the learned Single Judge disposed of the application by the order under appeal restraining the defendants, their life trustees, terms trustees, members, franchisees, officers, employees, agents, delegates, representative, associates and all other acting for and on their behalf from offering their services, advertising, offering franchisees, selling goods, and stationery, adopting, using and/or dealing in any manner with the registered mark/name 'DPS' or any other mark identical or deceptively similar to the registered mark of the plaintiff, amounting to infringement and passing off the plaintiff's registered trademark till the disposal of this suit. The defendants their life trustees, terms trustees, members, franchisees, officers, employees, agents, delegates, representatives, associates and all other acting for an on their behalf are also restrained from using the impugned trademark/name 'DPS', or any other trademark identical or deceptively similar to it, amounting to passing off the plaintiff's trademark/name, till the disposal of the suit.

20. The said order is assailed in the present appeal preferred by the defendants.

21. It may at the outset be mentioned that though the learned Single Judge declined to grant the injunction sought by the plaintiff in respect of the two crests/logos stated to be conceived and adopted by the plaintiff, the plaintiff had not chosen to challenge that part of the order of the learned Single Judge. Therefore, the challenge to the impugned order is limited only to the

extent of the injunction granted restraining the defendants (i) from using and/or dealing in any manner with the registered trade mark/name 'DPS' or any other mark identical or deceptively similar to the registered trade mark of the plaintiff till the disposal of the suit; and (ii) from using the impugned trade mark/name 'DPS' in the trade name and/or logo of the defendant No.1.

22. We have heard Sh.Salman Khurshid, the appellant No.2/defendant No.2 who appeared in person as well as Sh.Sandeep Sethi, the learned Senior Counsel appearing for the respondent/plaintiff.

23. The contentions advanced by Sh.Salman Khurshid may be summarized as under:

(i) The order under appeal suffered from factual infirmities, namely, that the appellant No.1/defendant No.1 Trust has been set up by the DIPSITES Association and that the respondent/plaintiff has registration over the words 'Delhi Public School' under Classes 16, 35, 36 & 42.

(ii) The learned Single Judge failed to properly appreciate the intent and effect of the Advisory and erred in concluding that it is a matter of evidence whether such an Advisory would not create confusion or is sufficient notice to the public at large that the defendant No.1 is not associated with the plaintiff in any manner.

(iii) The learned Single Judge has also failed to appreciate the fact that no school of the plaintiff society has ever been called 'DPS' by the society or the school management across the country and that the word 'DPS' has never been used as a trademark by the plaintiff not

even in Classes 16, 35 and 42 in which the said mark is registered. It is contended that the acronym/abbreviation 'DPS' which is used only for the purpose of convenience cannot be extended the statutory protection.

(iv) Placing reliance upon *Khoday Distilleries Ltd. vs. Scotch Whiskey Association* (2008) 10 SCC 723, *Skyline Education Institute vs. SL Vaswani and Anr.* (2010) 2 SCC 142 and *Cadila Health Care Ltd. vs. Cadila Pharmaceuticals Ltd.* (2001) 5 SCC 73, it is also contended that there is no reason as to why the alumni of DPS, who are part of its legacy cannot use DPS with a suitable disclaimer. It is also contended that as more than 200 schools have been operating as Delhi Public Schools/DPS with same logo as that of the plaintiff society without authority and further several other societies and public sector sponsored societies having been registered as the franchisees of the plaintiff society, the learned Single Judge ought to have held that the trademark 'DPS' has been diluted and has become *publici juris*.

(v) Having regard to the fact that the appellant has been running 14 schools where admissions have also done, the finding recorded by the learned Single Judge that the balance of convenience is in favour of the plaintiff is erroneous. In support of the said submission, reliance has been placed upon *Wander vs. Antox* 1990 (SUPP) SCC 727 wherein it is held that the need for protection must be weighed against the corresponding need of the defendant to be protected against injury. Reliance has also been placed upon *Nestle India vs. Mood*

Hospitality Private Limited (2010) ILR 3 Delhi 560, wherein this Court held that the test of *prima facie* case has been replaced in trademark matters by the test of comparative strengths of the rival cases.

(vi) It is also contended that the plaintiff has no registration of acronym 'DPS' in Class 41. Therefore, to extend the benefit of trademark protection is not in conformity with the provisions of Section 29(4) of the Act. It is sought to be pointed out that no finding was recorded by the learned Single Judge with regard to satisfaction of the ingredients of Section 29(4).

24. On the other hand, it is submitted by Sh.Sandeep Sethi, the learned Senior Counsel appearing for the respondent/plaintiff that the discretionary order of injunction passed by the learned Single Judge comprehensively dealing with the respective factual and legal contentions and returning a *prima facie* finding that the defendant is *prima facie* guilty of infringement and passing off of the plaintiff's trademark is neither arbitrary nor capricious nor perverse. It is also submitted that the said order being judicious and in terms of settled principles of law regulating grant of injunction warrants no interference by the Appellate Court in terms of the dictum of the Supreme Court in *Wander vs. Antox* (*supra*).

25. Placing reliance upon *Ramdev Food Products vs. Arvindbhai Rambhai Patel*; (2006) 8 SCC 726, *Laxmikant V. Patel vs. Laxmi Bhat Shah*; AIR 2002 SC 275, *T.V. Venugopal vs. Ushodaya Enterprises*; (2011) 4 SCC 85 and *Midas Hygiene vs. Sudhir Bhatia*; 2004 (28) PTC 121 (SC), it is further contended that the adoption of the trademark by the

defendants being clearly dishonest, the learned Single Judge has rightly injuncted the defendant.

26. The further contention is that apart from the infringement of registered trademark of plaintiff, the defendants are also guilty of passing off. It is a clear case where the defendants adopted the trademark of the plaintiff to encash upon its reputation and goodwill and wrongly impress upon the people at large that there is some connection between the plaintiff and the defendant No.1. The defendant No.1 is therefore, guilty of passing off and is liable to be injuncted. In support of the said submission, the learned Senior Counsel relied upon *Reckitt & Coleman Limited vs. Borden Inc.* [1990] 1 All ER 873 and *Honda Motors Company Limited vs. Charanjit Singh & Others*, (2002) 101 DLT 359 (Del).

27. It is finally submitted by the learned Senior Counsel that the appellant has not complied with the impugned order dated 18.04.2016 and has continued to violate the said order by continuing to use the trademark of the plaintiff. Therefore, according to the learned Senior Counsel, the appellant who is in contempt cannot be heard in this appeal until the appellant purges itself.

Consideration:

28. This is a case where the plaintiff claims to be entitled to the exclusive use of trademarks 'DPS', 'Delhi Public School' and two logos i.e.



(i) conceived and adopted in the year 1948 and (ii)



conceived and adopted in 1996-97. The allegation is that the defendants

have malafidely adopted and have been using the trade mark/name 'DPS



World Foundation' and the crest logo which are identical and deceptively similar to the trademarks of the plaintiff.

29. Though the defendants denied the said allegations, in the light of the material available on record, the learned Single Judge opined that the documents placed on record at least at this stage make it clear that the mark/name 'DPS' owes its origin to the plaintiff. Accordingly, it was held that the mark/name of the defendant No.1 'DPS World Foundation' or 'DPS World School' would cause infringement of the registered trade mark 'DPS' of the plaintiff. The learned Single Judge was therefore of the view that the plaintiff has made out a case for interim relief with regard to the usage of the trade mark 'DPS' and that the balance of convenience is also in favour of the plaintiff.

30. Section 28 of the Trade Marks Act, 1999 provides that the registration of a trade mark shall give to the registered proprietor of the trade mark the exclusive right to the use of the trade mark in relation to the goods or services in respect of which the trade mark is registered and to obtain relief in respect of infringement of the trade mark in the manner provided by the Act. Section 29 of the Trade Marks Act, 1999 further provides that 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. It may also be added that Section 27 expressly provides that no person shall be entitled to institute any proceeding to prevent the infringement of an unregistered trademark.

31. Admittedly, the plaintiff got the trade mark 'DPS' registered in accordance with the provisions of the Trade Marks Act, 1999 and the Rules made thereunder. It is not disputed before us that the said registration for the trade mark 'DPS' is under Class 16, Class 35, Class 42 and Class 36. The application of the plaintiff for registration of the trade mark 'DPS' under Class 41 is still pending.

32. So far as the trade mark/name 'Delhi Public School' is concerned, the plaintiff made application dated 08.03.2011 for its registration under Class 16, Class 36, Class 35, Class 41 and Class 42 and all the said applications are admittedly pending.



33. With regard to logo  conceived and adopted by the plaintiff in the year 1947, it is not in dispute that it is a registered trade mark and that the same has been registered under Class 16, Class 35, Class 36, Class 41 and Class 42.



34. However, the logo  stated to be conceived and adopted by the plaintiff in the year 1996-97 is not a registered trade mark and it appears that the plaintiff has not even made an application for registration.

35. Coming to the trade name of the defendant No.1 and the logo adopted by it, the trade name of the defendant No.1 'DPS World Foundation' itself includes the registered trade mark 'DPS' of the plaintiff. So far as the logo adopted by it is concerned, we found that though it cannot be held to be identical or deceptively similar to the registered logo conceived and adopted by the plaintiff in the year 1947, the logo of the defendant No.1 admittedly contains the words 'DPS World Foundation' which again includes the registered trade mark 'DPS' of the plaintiff. That being the case, we are of the view that the learned Single Judge is justified in holding that a prima facie case has been made by the plaintiff that the trade name/mark of the defendant No.1 and the logo would cause infringement under the provisions of Section 29 of the Trade Marks Act.

36. The contentions on behalf of the appellants that no school of the plaintiff society has ever been called 'DPS' across the country and that the same is nothing but acronym/abbreviation of Delhi Public School being used for the purpose of convenience and that the plaintiff enjoys no goodwill or reputation in the word 'DPS' and that no evidence could be placed by the plaintiff to show that any damage has been caused to its reputation by the trade mark/name adopted by the defendant No.1 which included the word 'DPS' are all untenable in view of the admitted fact that 'DPS' is a registered trade mark of the plaintiff and thus entitling the plaintiff to the statutory protection under the provisions of the Trade Marks Act, 1999.

37. The mere fact that the plaintiff has no registration of the trade mark 'DPS' in Class 41 (education, providing of training, entertainment, sporting and cultural activities) cannot be a bar to the plaintiff's claim for statutory

protection of its trade name/mark 'DPS' in view of the admitted fact that the said trade mark has been registered in Class 16 (Paper, Cardboard, Photographs, Stationery), Class 35 (Advertising, Business Management, Business Administration, Office Functions), Class 36 (Insurance, Financial Affairs, Monetary Affairs, Real Estate Affairs) and Class 42 (Food and Drink, Medical, Industrial Research and Computer Programming). We also agree with the view of the learned Single Judge that the effect of the Advisory stated to be used by the defendant needs consideration in the main suit.

38. We, therefore, do not find any justifiable reason to interfere with the finding of the learned Single Judge that the name of defendant No.1 'DPS World Foundation' and its logo which included the plaintiff's registered trade mark 'DPS' resulted in infringement under Section 29 of the Trade Marks Act, 1999.

39. However, it may be added that for the trade mark/name 'Delhi Public School', no registration has been granted to the plaintiff till date. Moreover, as rightly contended by the appellants, it contains separate words 'Delhi' 'Public' 'School' in respect of which the plaintiff cannot seek exclusive rights for passing off purposes.

40. It is also relevant to note that though there was a specific prayer in the application to grant injunction in respect of the trade mark/name 'Delhi Public School', the same has not been granted by the learned Single Judge.

41. Therefore, may be it is open to the defendant No.1 to adopt the trade name/mark including the words 'Delhi' 'Public' 'School', however, the

registered trade mark/name 'DPS' of the plaintiff cannot be used in any manner whatsoever.

The appeal is accordingly disposed of.

CHIEF JUSTICE

SANGITA DHINGRA SEHGAL, J

APRIL 10, 2017/pmc

