

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED : 20.03.2018

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THE HON'BLE MR.JUSTICE M.SUNDAR

C.S.No.17 of 2018

and

O.A.No.26 of 2018

V.Rangasamy Naidu Educational Trust,
 (a Trust registered under the Indian Trust Act, 1882)
 rep by its Managing Trustee,
 Dr.S.R.K.Prasad,
 No.48, 2nd Floor, B.N.Road,
 T.Nagar,
 Chennai-600 017.

.. Plaintiff

Vs.

1.Cambridge Institute of Technology,
 rep by its Correspondent / Director /Principal,
 Cambridge Village, Tatisilwai,
 Ranchi,
 Jharkhand-835 103.

2.Cambridge Trust of India,
 rep by its Managing Trustee /Trustees,
 Cambridge Institute of Technology,
 Cambridge Village, Tatisilwai,
 Ranchi, Jharkhand-835 103.

.. Defendants

This Civil Suit is preferred, under Order IV Rule 1 of Original Side Rules read with Order VII Rule 1 of Civil Procedure Code and Sections 28, 29, 134 and 135 of the Trade Marks Act, 1999 seeking to grant (a) permanent injunction restraining defendants 1 and 2 jointly and severally, its Trustees, Correspondents, Directors, Registrar, Principal, Governing Council, Staff,

Agents, Students, Representatives, or any one associated or related with them from in any manner infringing the plaintiff's registered trade mark "CIT" under Trademark Registration No.2149954 in Class 41 and thereby restraining them from using any trademark, trade name, abbreviation or word that is identical or deceptively similar to the plaintiff's said registration trademark "CIT", or rendering or offering any services, advertisements, displaying or portraying or in any manner either directly or indirectly using or dealing with or depicting the word "CIT", especially in their precincts, premises, in their domain name www.citranchi.ac.in, in their website, web pages, or in any manner whatsoever, (b) a direction to the defendants to deliver to the plaintiff all labels, blocks, dyes stationers and all other printing materials, stickers, signage, visiting cards, letter heads, pamphlets, brochures, prospects, application forms, bill books and all other printed material and all other advertisements and promotional materials and stationery items and website codes /keys and such other materials containing the word "CIT" for destruction by the plaintiff, (c) award costs and (d) for such other and further reliefs as the nature and circumstances of the case may require and thus render justice.

For Plaintiff : Mr.GK.Muthukumaar

For Defendants : Mr.M.Purushothaman

JUDGMENT

Mr.GK.Muthukumaar, learned counsel of M/s.G.M.S. Law Associates

(Law firm) on record for the sole plaintiff is before this Commercial Division. Mr.M.Purushotaman, learned counsel along with Mr.Amit Kumar, learned counsel from Jharkhand are before this Commercial Division on behalf of both defendants.

2 On behalf of plaintiff Dr.R.Prabhakar, son of G.Ramachandra Gupta, one of the trustees of plaintiff trust is before this Commercial Division. On behalf of both defendants, Mr.Navneet Kumar Singh, Treasurer of defendant No.2 trust representing both the trust and the institution run by it being defendant No.1 is before this Commercial Division.

3 Both Dr.R.Prabhakar and Mr.Navneet Kumar Singh have produced authorisations from their respective trusts which permits them to represent their respective trusts before this Commercial Division. On behalf of plaintiff, it is a generic certificate dated 01.08.2014 and on behalf of defendants, it is minutes of meeting of trustees held on 16.03.2018 at the trust office is in Ranchi.

4 Both the aforesaid learned counsel, on instructions from their respective clients, submit that parties who were before the Mediation Centre have arrived at a compromise and have reduced the terms of compromise into a memorandum of compromise dated 20.03.2018. The memorandum of compromise dated 20.03.2018 duly signed by aforesaid parties and their respective counsel is placed before me.

5 Before proceeding further, it is necessary to place on record that parties were referred to mediation after substantial arguments on merits.

6 Both learned counsel, on instructions from their respective

clients request this Commercial Division to pass a decree in terms of the aforesaid memorandum of compromise dated 20.03.2018.

7 To be noted, the vakalatnama dated 05.02.2018 on behalf of both defendants has been signed by one Shyam Kishore Singh, Principal of defendant No.1 institution. I am informed that he has since resigned and therefore, the Treasurer of second defendant trust which runs the first defendant institution with due authorisation from the trust as mentioned supra is present before this Commercial Division.

8 The memorandum of compromise dated 20.03.2018 reads as follows :

"1.The Plaintiff is a registered trust established in the year 1956 with philanthropic objectives and in pursuance of which it had established educational institutes namely an engineering college under the name and style of Coimbatore Institute of Technology at Coimbatore in the year 1956 and also a polytechnic college in the name and style of CIT Sandwich Polytechnic College also at Coimbatore, in the year 1961, and is continuously running the same.

2.The Plaintiff had coined, adopted and used the word "CIT" as its trademark since 1956 for it's said educational Institutes and continues to use the same. It has obtained trademark registration for the said trademark "CIT", effective from 25.05.2011.

3.The 1st Defendant is an Institute run by the 2nd Defendant Trust, functioning in Ranchi, Jharkhand. The 2nd Defendant Trust has been established for philanthropic purposes duly register under Trust Act and in view of which has set up the 1st Defendant Institute. The Defendants are also one of the pioneers in higher education in the remote and newly formed Jharkhand State which is predominantly a tribal area and

even the mode of admissions of the student in Defendants Institute is guided through the policy framed by the Jharkhand Government. The Defendants never intend to infringe the plaintiff's said trademark.

4.The Plaintiff had initiated Trademark infringement action against certain persons for infringement of its said registered trademark "CIT" and for passing off. These persons had cited the 1st Defendant Institute as an entity which is also using the trademark "CIT" of the Plaintiff and that in view of which they are also entitled to use the said word and hence sought to justify their use by citing the 1st Defendant's use. In view of which the Plaintiff was constrained to file a trademark infringement suit in C.S.No.17 of 2018 before this Hon'ble High Court alleging trademark infringement by the Defendants.

5.That admittedly, at no point of time any specific case of injury caused to any person have been shown by the Plaintiff, as the Defendants are in no way connected to the state of Tamil Nadu or even South India, and the Defendants are also one of the pioneers in higher education in remote and newly formed Jharkhand State which is predominantly tribal area and even the mode of admissions of the student in Defendant's Institute is guided through the policy framed by the Jharkhand Government and which is totally distinct from the Plaintiff's. So, no where the Defendants have ever intended to use the 'CIT' trade mark of any Institute rather it is the abbreviated form of their Institute name being CAMBRIDGE INSTITUTE OF TECHNOLOGY as C.I.T.

6.In the said suit, both parties herein have mutually thereafter agreed to resolve the issue amicably so as to protect their mutual interests without affecting each other.

7.The Defendants hereby admit to the Plaintiff's said user of its trademark, "CIT" and of the Plaintiff's ownership and right to it under common law and under statute. The Defendants

also hereby undertake not to object to the Plaintiff's said usage and trademark registration of its mark, "CIT" in any manner whatsoever.

8.The Defendants hereby unconditionally undertake to henceforth desist from using the word, "CIT" per se or as "CITRANCHI" (either in small or capital letters and either with or without space in between the words, "CIT" and "RANCHI") as pleaded by the Plaintiff in the said suit in particular in their web pages, all communications, advertisements, and stationery, or in any other manner whatsoever, except as "CIT(R)".

9.The Defendants hereby further unconditionally undertake to henceforth desist from using the word, "CIT" per se or as, 'CITRANCHI" (either in small or capital letters and with or without space in between the words, "CIT" and "RANCHI") as in www.citranchi.ac.in, and the Defendants will change the existing domain name of their Institute from www.citranchi.ac.in to www.citr.ac.in, as their domain name subject to availability or any other available domain name with the combination of "CITR" in due course of time.

10.The Plaintiff hereby has 'no objection' to the use of the word, "CIT(R)" by the Defendants instead of "CIT" or "CITRANCHI" in their web pages, all communications, advertisements, and stationery and a word having combination with "CITR" as their domain name as well as they will also not have any objection in use of the abbreviated term of Cambridge Institute of Technology wherever required.

11.The Defendants also have no objection what to the Plaintiff's trademark registration of their trademark "CIT" or to its use by the Plaintiff in any manner whatsoever or the enforcement of the Plaintiff's trademark rights, statutory and under common law in case of violation of them and at the same time the Plaintiff will also provide NOC in the required

format for the registration of the word "CIT(R)" as the Defendant's trademarks under the Trademark Act 1999.

12.The Plaintiff shall be fully entitled to enforce and to protect its trademark rights (both under the common law and under statute) over its said trademark "CIT", against any infringers.

13.The Plaintiff is free to register its trademark "CIT" anywhere else in the world and is free to do so.

14.In view of the above the parties to this suit humbly pray that this suit be decreed as prayed for in para 43(a) of the plaint, against the defendants, and in terms of this Memo of Compromise, while the plaintiff gives up all other reliefs under para 43(b) to (d) of the plaint against the defendants. The defendants also give up all claims 9if any) against the Plaintiff.

15.Both parties agree to bear their own costs.

16.The parties herein pray that this Hon'ble Court may be pleased to take this Memo of Compromise on record and to pass a Judgement and Decree in terms thereof."

9 In the light of the aforesaid narrative, there will be a decree in the main suit, i.e., C.S.No.17 of 2018 in terms of the aforesaid memorandum of compromise dated 20.03.2018. The memorandum of compromise, together with annexed self attested photocopies of identity cards of the aforesaid litigants and aforesaid authorisations, shall all form part of the decree.

10 Before parting with the case, I place on record appreciation of this Commercial Division to both learned counsel for the extremely fair and reasonable approach that has been taken and the efforts put in by them in having the matter resolved amicably.

11 To be noted, this is a compromise of a suit within the meaning of Order XXIII Rule 3 of Code of Civil Procedure, 1908 ('CPC' for brevity). It has become necessary to include this in this decree to make it clear that covenants 12 and 13 in the memorandum of compromise dated 20.03.2018 will be enforceable only against the defendant. It has become necessary to make this clarification as the aforesaid two clauses are couched in a language with vast amplitude and width. Plaintiff may have a right in rem qua registered trademark, which is subject matter of the suit, but this suit is an action in personem and compromise decree in this suit is under Order XXIII Rule 3 of CPC. In other words, it is clarified that covenants 12 and 13 will mean that defendant will not object when plaintiff proceeds against other infringers and / or seeks registration of the mark in other parts of the world.

12 The suit is decreed on the above terms. No costs. Consequently connected application is closed.

20.03.2018

Index : Yes/No

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Note to Office :

Issue judgment and decree by 10.04.2018.

M.SUNDAR, J.

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