

AFR

HIGH COURT OF CHHATTISGARH, BILASPUR

MA No. 79 of 2019

1. Brilliant Public School Society Seepat Road, Bhatarai, Bilaspur Chhattisgarh Through Its Chairman, Mr. Praveen Kumar Agrawal, S/o Bajrang Prasad Agrawal, Aged About 50 Years, R/o Uslapur, Bilaspur Chhattisgarh, District : Bilaspur, Chhattisgarh
2. Brilliant Public School Through Its Principal Seepat Road, Bhatarai, Bilaspur Chhattisgarh

---- Appellants

Versus

Brilliant Public School Sitamarhi Through Its Principal/ Chairman, School Address Riga Road, Islampur, Bhavdepur, Sitamarhi, Bihar, Office Address Dewangan, Rajopatti, Dumra Road, Sitamarhi, Bihar 843301, District : Sitamarhi, Bihar

---- Respondent

For Appellants : Mr. S.K. Bansal, Advocate with Mr, Vaibhav Shukla, Mr. Suyash Dhar and Ms. Astha Shukla, Advocates

For Respondent : Mr. Vikram Sharma, Advocate

D.B. :Hon'ble Mr. Justice Manindra Mohan Shrivastava & Hon'ble Mrs. Justice Vimla Singh Kapoor

C A V Judgment

23/03/2020

Per Manindra Mohan Shrivastava, J.

1. This appeal arises out of order dated 17.7.2019 passed by learned Court below by which appellant- plaintiff application for grant of temporary injunction under Order 39 Rule 1 & 2 read with Section 151 IPC has been rejected.
2. The appellant-plaintiff No.1- Brilliant Public School Society is a Society registered under M.P. Society Registration Act, 1973 and runs

school/plaintiff No.2 at Bilaspur, Chhattisgarh. Defendant also runs a school under a Trust namely B.D. Sah Foundation Trust which is situated at Sitamarhi, Bihar. The plaintiffs and defendant both are engaged in the field of education by establishing school, imparting teaching and carrying out various other extra curricular activities normally carried out by an educational institution. Both the institutions are imparting school education, though, at two different places. While plaintiff has three schools at Bilaspur and one school at Korba, all situated in Chhattisgarh, defendant has one educational institution at Sitamarhi, Bihar. The plaintiff-society is running aforesaid four schools under the name and style as **"BRILLIANT PUBLIC SCHOOL"**.

3. Plaintiff filed suit seeking injunction against the defendant, based on infringement of its registered trademark **"BRILLIANT PUBLIC SCHOOL"** as also passing off action on the pleading, inter alia, that the plaintiff in the trade name **"BRILLIANT PUBLIC SCHOOL"** opened first school in the year 2000 and thereafter opened three schools and since then, it has been using the aforesaid mark **"BRILLIANT PUBLIC SCHOOL"** in relation to educational services which have been provided by it in the area where the schools are situated. According to plaintiff, three schools situated at 'Mission Hospital Road', 'Bahatarai' and 'Vyapar Vihar' in the city of Bilaspur were started in the year 2000, 2006-07 and 2015 respectively. Its school at Bahatarai, Bilaspur is recognized and affiliated to Central Board of Secondary Education (CBSE), Delhi. Further case of the plaintiff was that **"BRILLIANT PUBLIC SCHOOL"** name and formative labels/logos were duly registered in the name of plaintiff No.1 under the Trade Marks Act, 1999 in Class-41 in the year 2015. The plaintiff has established and running school since 2000 and acquired prestige, name and fame in the field of education and has earned appreciation, award both at national and international level and carries an enviable reputation. The defendant has adopted the aforesaid trademark **"BRILLIANT PUBLIC SCHOOL"** in relation to its educational services and also on all goods and paraphernalia related thereto including its stationery, uniforms, literature etc. The said act of the

defendant, as pleaded by the plaintiff, has infringed the plaintiff's registered trademark as also passing off its goods and business by unfair and unethical trade practice. According to the plaintiff, the trade name which is being used by the defendant is identical and in any case deceptively similar to that of the plaintiff's trademark which is causing deception and confusion in the market and trade, amongst parents, students, public, as they are being deceived into believing that defendant's impugned school to be that of the plaintiff or of plaintiff source or affiliation or association which is adversely affecting the goodwill of plaintiff- school which is being diluted and tarnished. According to plaintiff, due to defendant's activity of using the same trademark as that of the plaintiff, which has been duly registered in the name of the plaintiff, plaintiff's trademark registration is being nullified and plaintiff is suffering huge losses both in its school services as well as reputation and goodwill and which are all incapable of being assessed in monetary terms.

4. The plaintiff also moved application for grant of temporary injunction on the aforesaid pleading, supported with various documents of its registration, trade name, logos, seeking to restrain the defendant from using the said trademark for its activity of imparting education through its educational institution situated at Sitamarhi, Bihar. The plaintiff, in its application, pleaded that as the plaintiff's trademark is duly registered under the Trade Marks Act, whereas defendant does not have any such trademark nor the trademark registered in favour of the plaintiff has been challenged by the defendant in any proceedings drawn under the Trade Marks Act before the competent authority, the defendant be restrained by temporary injunction during the pendency of the suit otherwise the plaintiff is likely to suffer irreparable loss which cannot be compensated in monetary terms.
5. The defendant in its written statement and reply to injunction application came out with the plea that their school styled and marked as "Brilliant Public School, Sitamarhi" is not situated in the State of Chhattisgarh but in the State of Bihar and is running that school for a

long time since 1995, firstly in the name of 'Brilliant Coaching Institute' and then as "Brilliant Public School Sitamarhi" till now. Their institution is not only established institution since more than a decade but it has also its own established goodwill and reputation over a long time. It is duly affiliated in the name of "Brilliant Public School, Rajopatti, Dumra Road, Sitamarhi, Bihar" from CBSE Delhi in the year 2012. It entered in internet domain as "www.brilliantpublicschool.com" in the year 2011 prior to plaintiff's entry in the Internet domain and they have also applied for registration of their trademark in the name as "Brilliant Public School, Dumra Road, Rajopatti, Nahar Chowk, Sitamarhi, Bihar" under the Trade Marks Act which is still pending consideration. According to defendant, the similarity as claimed by the plaintiff is based only on use of words of "**BRILLIANT PUBLIC SCHOOL**", whereas in order to make out a prima facie case of infringement, the plaintiff is required to make out a strong case that the trademark used by defendant is either identical or deceptively similar. The trademark of the plaintiff and the defendant cannot be said to be either identical or even deceptively similar once both the trademarks are compared along with setting of words "Brilliant Public School Logo" and the shape of appearance of the two trademarks. According to defendant, if the defendant is restrained from operation of school from using the words "**BRILLIANT PUBLIC SCHOOL**", they will suffer irreparable injury and the balance of convenience does not lie in favour of plaintiff.

6. Learned trial Court vide impugned order rejected plaintiffs' application for grant of temporary injunction. Though learned trial Court recorded a finding that it will have jurisdiction under the law to try the suit filed by the plaintiff, prayer for injunction has been rejected holding that the plaintiff has failed to make out a prima facie case and other two considerations in its favour namely balance of convenience and irreparable injury. One of the main consideration for learned trial Court to reject the application is that word "**Brilliant**" is a generic word which is commonly used in the field of education and qualification and is neither invented by the plaintiff nor a specific word, relying upon the

decision in the case of **Skyline Education Institute (India)(P) Ltd. Vs. S.L. Vaswani** (2010) 2 SCC 142, wherein the Supreme Court observed that word "Skyline" has acquired the status of a generic word. Learned trial Court was also of the view that the plaintiff's claim that use of name "**BRILLIANT PUBLIC SCHOOL**" by the defendant will create confusion in the mind of the students and parents who came to pursue their studies in the plaintiff's school is not made out because the students and parents who would like to go an educational institution for their admission and study are not lay customers but they are expected to make their informed choice. Learned trial Court also held that the logos of the plaintiff-school and that of the defendant, on a comparison, are quite different from each other. On such consideration that word "**Brilliant**" being in the nature of *publici juris*, logo as registered in the name of plaintiff being different from that used by defendant and that word "**Brilliant**" had not acquired such distinctiveness for the plaintiff to make out a strong prima facie case for interim injunction and further that grant of temporary injunction in favour of plaintiff will be against the principle of equity and natural justice and would cause damage to the future of students who are already studying in the school of defendant, rejected the application.

7. In this appeal, learned counsel for the appellant- plaintiff argued in extenso, challenging validity and correctness of order refusing to grant temporary injunction by raising manifold contentions. It was contended before us that principle in the matter of grant of interim injunction in so far as cases of infringement and trademark and passing off action are concerned are that in such cases injunction is ordinarily granted in view of the nature of relief sought. Learned counsel for the appellant-plaintiff argued that the judgment in the case of **Skyline** (supra) is not at all applicable because in that case, the main operative reason for the Supreme Court to deal with the word "Skyline" was that it had acquired status of a generic word, based on material that large number of institutions are using that word "Skyline" whereas in the present case, on facts, no material could be placed by the defendant to show that word

“Brilliant” is being used by large number of educational institutions imparting school education in the country. It was also contended that the statutory protection under Section 28 of the Trade Marks Act becomes operative the movement party gets a particular trademark registered under the Trade Marks Act. This protective right against infringement could not be defeated nor could grant of temporary injunction refused on the ground that other party who is using similar trade name has been using the same for long time because the protection is limited only to those cases which are statutorily prescribed under other provision of the Act namely Sections 34 & 35 of the Act. The defendant is neither prior user nor they have any trademark registered in their name nor their logo, though, they have applied for before the registering authority under the Trade Marks Act. Defendant having applied for registration cannot raise defence that word/mark **“BRILLIANT PUBLIC SCHOOL”** is a generic word which could not be registered. In any case, it is argued, if the defendant had any grievance that word **“Brilliant”** being *publici juris* could not be claimed as trademark and its infringement could not be made basis for injunction, the only remedy that the defendant could seek is cancellation by taking recourse to statutory remedy available under the Trade Marks Act. Learned counsel for the appellant-plaintiff further argued that no plea of acquiescence could be raised as the plaintiff has clearly stated in their plaint that they came to know about running of defendant's school only in the year 2018. Further submission is that in case of action based on infringement of registered trademark, which is statutorily protected under Section 28 of the Trade Marks Act, it is not necessary to establish reputation. He further submits that in order to make out a prima facie case, it is not at all necessary for the plaintiff to establish complete identity or exact similarity of the two trademarks. The trademark which is being used by the defendant has the character of being deceptively similar because of the use of word **“BRILLIANT PUBLIC SCHOOL”** which is also being used by the plaintiff and duly registered in his name and as the plaintiff as well as defendant are in the same activity of imparting

school education and merely because they are operating at two different places, one in Chhattisgarh and other in the State of Bihar, could not be made a basis to deny the relief of temporary injunction. In the absence of a prima facie case made out under any of the clause under Section 30 of the Trade Marks Act nor present being a case covered by Section 28 (3) of the Act, the plaintiff has made out a strong prima facie case. He would further submit that apart from and in addition to claim based on registered trademark, under the protective umbrella of Section 28 of the Act, the plaintiff has also made out a prima facie case of passing off action because the pleadings and documents of the plaintiff clearly make out that the plaintiff having established school since 2000 and having more than one schools at different places at Bilaspur and one at Korba in the State of Chhattisgarh, has earned reputation, goodwill which is entitled to be protected under common law right as against any other user who, by use of such trademark, have been creating confusion and passing off goodwill of the plaintiff by dishonest use of its trademark. In support of his submissions, learned counsel for the appellant-plaintiff has relied upon several authorities¹.

8. On the other hand, learned counsel for the respondent-defendant argued that the learned trial Court has meticulously examined the plaintiff's claim and after careful examination of the pleadings and documents led by both the parties in the affidavit, has rejected the application. He would submit that at present only temporary injunction application has been decided and the parties are yet to lead their respective evidence, therefore, in appeal against the order granting or refusing to grant temporary injunction, scope of interference is very limited. Learned trial Court having exercised its discretion not to grant

1. **Laxmikant V. Patel Vs. Chetanbhat Shah & Anr.** 2002 (24) PTC 1 (SC), **Midas Hygiene Industries P. Ltd. & Anr. Vs. Sudhir Bhatia & Ors.** 2004 (28) PTC 121 (SC), **Enterprise Holdings, Inc. Vs. Enterprise Auto Rentals**, 2014 (58) PTC 111 (Del), **Montari Overseas Limited Vs. Montari Industries Limited** 1996 (16) PTC 142 (Del), **K.R. Chinna Krishna Chettiar Vs. Sri Ambal And Co. and Anr.** AIR 1970 SC 146, **Cadila Heath Care Ltd. Vs. Cadila Pharmaceuticals Ltd.** 2001 PTC 541 (SC), **Kaviraj Pandit Durga Dutt Sharma Vs. Navaratna Pharmaceutical Laboratories** (AIR 1965 SC 980), **Corn Products Refining Co. Shangrila Food Products Ltd.** (AIR 1960 SC 142), **American Home Products Corporation Vs. Mac Laboratories Pvt. Ltd. And Anr.** (AIR 1986 SC 137), **Hem Corporation Pvt. Ltd. and Ors. Vs. ITC Limited** 2012(52) PTC 600 (Bom.), **Power Control Appliances and Ors. Vs. Sumeet Machines Pvt. Ltd. And Ors.** (1994) 2 SCC 448, **Rolex SA Vs. Alex Jewellery Pvt. Ltd. & Ors.** 2014 (60) PTC 131 (Del), **Skyline Education Institute (India)(P) Ltd. Vs. S.L. Vaswani** (2010) 2 SCC 142, **Metal Goods MFG. Co. (P) Ltd. Vs. Gupta Industrial Corp.** (AIR 1971 SC 898) , **Teleecare Network India Pvt. Ltd. Vs. Asus Technology Pvt. Ltd & Ors.** 2019 (79) PTC 99 (Del.)

injunction in favour of plaintiff at interim stage, no case is made out warranting interference due to limited scope of interference. The defendant have been using the name "**Brilliant**" not only from recent but since 1995 in the name of **Brilliant Coaching Institute** and when defendant earned reputation and goodwill amongst the students and their parents in the matter of imparting school education in their area of operation at Sitamarhi, after due affiliation from the CBSE, the name of "**BRILLIANT PUBLIC SCHOOL**" used by the defendant cannot be seen in isolation but the entire style of the logo has to be appreciated, in which these words are imprinted. When the logo of the plaintiff and defendant are compared side by side, there is no identity much less any deceptive similarity. Mere use of word "**BRILLIANT PUBLIC SCHOOL**", when word "**Brilliant**" is essentially a *publici juris* and not a distinctive name earned by any person much less plaintiff, claim based on infringement of trademark is not at all made out. According to defendant, the plaintiff has not come out with clear hands and has not given complete details with regard to his application and subsequent registration of trademark with specific logo of "**BRILLIANT PUBLIC SCHOOL**". The defendant is not only honest user but they are prior user of the word "**Brilliant**" since 1995 and as **Brilliant Public School** since 2007. The plaintiff got trademark registration only in the year 2017 and, therefore, the defendant who has been using the trademark of Brilliant Public Coaching since much prior to that of the plaintiff, could not be restrained by temporary injunction. Referring to Section 30 (2) (a) of the Trade Marks Act, learned counsel for the respondent-defendant further argued that the plaintiff trade name clearly indicates different geological origin by use of words "**Sitamarhi**" and, therefore, the plaintiff's action based on infringement of trademark is not prima facie made out. Plaintiff and defendant both are operating in area which are mutually exclusive, plaintiff educational activity are only confined in the State of Chhattisgarh whereas that of the defendant is confined only at Sitamarhi in the State of Bihar and present is not a case where the plaintiff has already established school at Sitamarhi or at any other place in the State

of Bihar. Similarly, defendant has also not established any school in the State of Chhattisgarh much less at places where the plaintiff is running school under trademark **"BRILLIANT PUBLIC SCHOOL"**. His next submission is that while examining the case of the plaintiff, it has to be decided on the principle of comparative strength, **"Brilliant"** being *publici juris*, no monopoly could be claimed. The defendant by long use of mark/word is not only prior but superior user. In support of his submissions, learned counsel for the respondent has referred the meaning of word **"Brilliant"** under dictionary and also several authorities.²

9. We have heard learned counsel for the parties and perused the records of the case.

10. In suits based on passing off action, as observed by the Supreme Court in the case of **Laxmikant V. Patel Vs. Chetanbhat Shah & Anr.** 2002 (24) PTC 1 (SC), it is usual, rather essential, to seek injunction temporarily or aid-interim and the principles for grant of such injunction are the same as in case of any other action against injury complained of. In such cases, fraud is not a necessary element of the right of action and even the absence of intention to deceive could not be pressed in service as defence though proof of fraudulent intention may materially assist a plaintiff in establishing probability of deception. Actual damage is not required to be established and likelihood of damage is sufficient. Holding that the same principle which applied to the trademark is applicable to trade name, Their Lordship observed as below:-

"12. In **Oertli Vs. Bowman** (1957) RPC 388, (at page 397) the gist of passing off action was defined by stating that it was essential to the success of any claim to passing off based on the use of given mark or get-up that the plaintiff should be able to show that the disputed mark or get-up has become by user in the country distinctive

2. **J.R. Kapoor Vs. Micronix India** 1994 Supp (3) SCC 215, **Goenka Institute of Education and Research Vs. Anjani Kumar Goenka and Anr.** (AIR 2009 Delhi 139), **M/s. S.M. Dyechem Ltd Vs. M/s Cadbury (India) Ltd.** (AIR 2000 SC 2114), **Wander Ltd. And Another Vs. Antox India P. Ltd.** (1990 Supp Supreme Court cases 727), **Seema Arshad Zaheer & Ors. Vs. Municipal Corpn. of Greater Mumbai & Ors.**(2006) 5 SCC 282

of the plaintiffs goods so that the use in relation to any goods of the kind dealt in by the plaintiff of that mark or get up will be understood by the trade and the public in that country as meaning that the goods are the plaintiffs goods. It is in the nature of acquisition of a quasi-proprietary right to the exclusive use of the mark or get-up in relation to goods of that kind because of the plaintiff having used or made it known that the mark or get-up has relation to his goods. Such right is invaded by anyone using the same or some deceptively similar mark, get-up or name in relation to goods not of plaintiff. The three elements of passing off action are the reputation of goods, possibility of deception and likelihood of damages to the plaintiff. In our opinion, the same principle, which applies to trade mark, is applicable to trade name.

13. In an action for passing off it is usual, rather essential, to seek an injunction temporary or ad-interim. The principles for the grant of such injunction are the same as in the case of any other action against injury complained of. The plaintiff must prove a prima facie case, availability of balance of convenience in his favour and his suffering an irreparable injury in the absence of grant of injunction. According to Kerly (ibid, para 16.16) passing off cases are often cases of deliberate and intentional misrepresentation, but it is well-settled that fraud is not a necessary element of the right of action, and the absence of an intention to deceive is not a defence though proof of fraudulent intention may materially assist a plaintiff in establishing probability of deception. Christopher Wadlow in Law of Passing Off (1995 Edition, 0.3.03) states that the plaintiff does not have to prove actual damage in order

to succeed in an action for passing off. Likelihood of damage is sufficient. The same learned author states that the defendants state of mind is wholly irrelevant to the existence of the cause of action for passing off (ibid, paras 4.20 and 7.15). As to how the injunction granted by the Court would shape depends on the facts and circumstances of each case. Where a defendant has imitated or adopted the plaintiffs distinctive trade mark or business name, the order may be an absolute injunction that he would not use or carry on business under that name. (Kerly, ibid, para 16.97)."

11. In **Midas Hygiene Industries P. Ltd. & Anr. Vs. Sudhir Bhatia & Ors.** 2004 (28) PTC 121 (SC), it has been held that in cases of infringement of trademark, normally an injunction must follow. It was observed thus:-

"5. The law on the subject is well settled. In cases of infringement either of Trade Mark or of Copyright normally an injunction must follow. Mere delay in bringing action is not sufficient to defeat grant of injunction in such cases. The grant of injunction also becomes necessary if it prima facie appears that the adoption of the Mark was itself dishonest. "

12. The Trade Marks Act, 1999 defines trademark as below:-

"2 (zb) "trade mark" means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours; and—

(i) in relation to Chapter XII (other than section 107), a registered trade mark or a mark used in relation to goods or services for the purpose of indicating or so as to indicate a connection in the course of trade between the goods or services, as

the case may be, and some person having the right as proprietor to use the mark; and

(ii) in relation to other provisions of this Act, a mark used or proposed to be used in relation to goods or services for the purpose of indicating or so to indicate a connection in the course of trade between the goods or services, as the case may be, and some person having the right, either as proprietor or by way of permitted user, to use the mark whether with or without any indication of the identity of that person, and includes a certification trade mark or collective mark;”

Registered trademark has been defined under clause (w) of Section 2 of the Act, to mean a trademark which is actually on the register and remaining in force.

Word “registered” has also been contextually defined under clause (u) of Section 2 to mean registered under the provision of the Trade Marks Act.

Any person claiming to be proprietor of a trademark used or proposed to be used by him, may apply for registration of his trademark under Section 18 to the registering authority and the registering authority may, after making necessary inquiry and following the procedure prescribed under Chapter-III, provide registration of trademark under Section 23 thereof.

Section 25 of the Act talks of duration, renewal, removal and restoration of registration.

13. Chapter-IV of the Trade Marks Act makes provision regarding effect of registration. Section 28 thereof creates an important right to the registered proprietor of the trademark, the exclusive right to the use of the trademark in relation to the goods or services in respect of which the trademark is registered and to obtain relief in respect of infringement of the trademark in the manner provided by the Act. Such right, however, is subject to other provision of the Act as mentioned in sub- section (1) of

Section 28 of the Act. Further, as provided under sub-Section (2) thereof, the exclusive right to the use of a trade mark given under sub-section (1) is subject to any conditions and limitations to which the registration is subject. Sub-section (3) deals with a situation where two or more persons are registered proprietor of trademark, which are identical with or nearly resemble each other, by providing that in such cases, the exclusive right of any of those trademark shall not be deemed to have been acquired by any one of those persons as against any other of those persons merely by registration of trademarks but each of those persons shall have otherwise the same rights as against other person (not being registered users using by way of permitted use) as he would have if he were the sole registered proprietor. Infringement of registered trademark has been dealt with under Section 29 of the Act. Various clauses therein deals with cases leading to infringement of registered trademark.

Section 30 of the Act, however, specifies limits on effect of registered trademark. Under Section 31 of the Act, it has been provided that registration shall be prima facie evidence of validity. Section 32 provides for protection of registration on the ground of distinctiveness. Section 33 provides for effect of acquiescence. Section 32 contains saving for vested rights acquired by prior user and Section 35 also limit the rights of proprietor or registered user of registered trademark in the matter of interference with bona fide use in certain cases.

Section 135 provides for relief in suits for infringement or for passing off.

14. The right conferred by statute under Section 28 of the Act is the exclusive right to the use of trademark in relation to the goods or services in respect of which the trademark is registered. The provision under Section 28 (1) not only creates right but also further provides right to obtain relief in respect of infringement of the trademark in the manner provided under scheme of the Act. In the present case, the appellant- plaintiff has, in its hands, a registered trademark of which the

most prominent is **“BRILLIANT PUBLIC SCHOOL”**. This also happens to be the most prominent trademark of the defendant as the defendant admittedly is using this very trademark **“BRILLIANT PUBLIC SCHOOL”**. While the registration in favour of appellant-plaintiff is apparent on the face of the records, it is equally borne out from defendant's own pleading that they have also applied for registration of trademark but till date that has not been granted in their favour so as to say that their trademark with certain variation in description and details only incidentally carries the name **“BRILLIANT PUBLIC SCHOOL”**.

15.As has already been particularly referred to herein above, Section 29 of the Trade Marks Act provides for the situation and circumstances which would lead to infringement of registered trademark. Sub-Section (1) thereof being relevant is extracted herein-below.

“29. Infringement of registered trade marks-

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

x x x
x x x

Under the Law, a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which is identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trademark, registered trademark is infringed. It is important to note that in order to make out a prima facie case of infringement, it is necessary for the plaintiff to make out a prima

facie case that two trademarks are absolutely identical in every aspect, though in such a case, on the face of it, infringement would be made out. The other important circumstance which may prima facie make out a case of infringement is 'deceptive similarity'. Further more, where such use of mark is likely to be taken as being used as trademark, it only reinforce allegation of infringement of trademark.

Wide and comprehensive meaning and import of 'infringement' encompassing variety of situations has been delineated not only under sub-section (1) of Section 29 but in other situation and circumstance as specified in sub-section (2), (4), (5) (7) and (8) of Section 29. The legislative intention is clear that infringement of trademark is not to be confined to certain generic word only but also in cases where there is no absolute identity between two trademarks one being registered and other not registered but also where the application of the identity with the trademark; similarity of the goods or services covered by such registered trademark; or similarity to the registered trademark and the identity or similarity of the goods or services covered by such registered trademark; or identity with the registered trademark and the identity of goods or services covered by such registered trademark is likely to cause confusion on the part of public, or it is likely to have an association with the registered trademark, as has been provided under sub-section (2) of the Act.

Importantly, sub-section (3) of Section 29 of the Act further provides that in the cases of the nature as provided under clause (c) sub-section (2) of Section 29, the Court shall presume that it is likely to cause confusion on the part of the public. Thus, a wide range of situation and circumstance has been brought within the mischief of Section 29 of the Act where infringement can be said to be made out and for this, 'deceptive similarity', likelihood of causing confusion by itself, without anything more, may make out a strong prima facie case of infringement of trademark.

In the present case, attempt has been made by the respondent-

defendant to dislodge plaintiff claim of it being a strong prima facie case of infringement of trademark, by putting forth that though, word **"BRILLIANT PUBLIC SCHOOL"** is common in both the cases, logos used by them, if kept side by side, are not identical but give a different pictorial impression. Such contention, on prima facie consideration, does not hold water. For this purpose, it is relevant to refer to decisions, only with a view to broadly state, settled legal position applicable to deal with such cases.

16. In **Enterprise Holdings, Inc. Vs. Enterprise Auto Rentals**, 2014 (58) PTC 111 (Del), following observations were made :

"13. It is settled law that in order to prove the case for infringement of trade mark, the plaintiff has to show that the essential features of the registered trade mark which has been adopted by the defendant has been taken out from the plaintiff's registration. Only the marks are to be compared by the Court and in case the registration is granted in favour of the plaintiff, he acquires valuable right by reason of the said registration.

14. The test of comparison of the marks side by side is not a sound one since a purchaser will seldom have the two marks actually before him when he makes his purchase. The eye is not an accurate recorder of visual detail and that marks are remembered rather by general impression or by some significant detail than by any photographic recollection of the whole. While judging the question as to whether the defendant has infringed the trade mark by colourable imitation of the mark or not, the Court has to consider the overall impression of the mark in the minds of general public and not by merely comparing the dissimilarities in the two marks.

15. In **K.R. Chinna Krishna Chettiar v. Sri Ambal & Co.**, AIR 1970 SC 146, the Supreme Court held that ocular comparison is not always the decisive test. Resemblance between the two marks must be considered with reference to the ear as well as to the eye. In this case, the Registrar held that the sound of "AMBAL" does not so nearly resemble the sound of "ANDAL" in spite of certain letters being common to both the marks, as to be likely to cause confusion or deception. The Registrar thus found that the marks were not deceptively similar. But on appeal both the Single Judge and Division Bench found deceptive similarity. The Supreme Court, dismissed the appeal, and held that there was a striking similarity and affinity of sound between the word "Andal" and "Ambal" and held that there was a real danger of confusion between the two marks."

17. In **Montari Overseas Limited Vs. Montari Industries Limited** 1996 (16) PTC 142 (Del), aspect of deceptive similarity was dealt with as below:-

"14.....When a defendant does business under a name which is sufficiently close to the name under which the plaintiff is trading and that name has acquired reputation and the public at large is likely to be misled that the defendant's business is the business of the plaintiff, or is a branch or department of the plaintiff the defendant is liable for an action in passing off. Even if the word "MONTARI" as part of the corporate name of the appellant was derived from the names of the father and father-in-law of the M.D. of the appellant company it would still be liable for an action in passing off as the use of the word

"MONTARI" in its corporate name is likely to cause confusion and injure the goodwill and reputation of the respondent, in the sense that this is a reasonable and foreseeable consequence of the appellant's action. We find from the record of the trial court, which contains the Memorandum of Association of six Montari group of companies and annual reports of Montari Industries Ltd, that Montari group of industries have large operations and some of them have been in business for a long time. The members of the public are likely to mistakenly infer from the appellant's use of the name which is sufficiently close to the respondent's name that the business of the appellant's company is from the same source, or the two companies are connected together."

(15) The question to consider in a case of similarity in trade names is whether ordinary person or public at large will mistake one company for the other. Relying on the observation of Sir George Jessel in *Guardian Fire and Life Assurance Co. Vs. Guardian and General Insurance Co. Ltd.* (8) (1880) 50 L.J. Ch. 253 to (3) to Bombay High Court in *National Bank of India Vs. National Bank of Indore* Air 1923 Bombay 119 (4) observed as follows:

".....BUT the question in this class of cases is not whether the intelligent section of the public is likely to be deceived but whether the public at large is likely to be deceived. Further as observed by Sir George Jessele in *Guardian Fire and Life Assurance Co. vs. Gurdian and General Insurance Co. Ltd* (8), "the public are careless, and it is no use

supposing that if they paid a very moderate attention to names they would see they were not the same but only similar".

18. In **K.R. Chinna Krishna Chettiar Vs. Sri Ambal And Co. and Anr.** AIR 1970 SC 146, pertinent observation with regard to the requirement of Law were considered in following manner:-

"10. There is no evidence of actual confusion, but that might be due to the fact that the appellant's trade is not of long standing. There is no visual resemblance between the two marks, but ocular comparison is not always the decisive test. The resemblance between the two marks must be considered with reference to the ear as well as the eye. There is a close affinity of sound between Ambal and Andal.

11. In the case of *Coca-Cola Co. of Canada v. Pepsi Cola Co. of Canada Ltd.*, it was found that cola was in common use in Canada for naming the beverages. The distinguishing feature of the mark Coca Cola was coca and not cola. For the same reason the distinguishing feature of the mark Pepsi Cola was Pepsi and not cola. It was not likely that any one would confuse the word Pepsi with coca. In the present case the word "Sri" may be regarded as in common use. The distinguishing feature of the respondent's mark is Ambal while that of the appellant's mark is Andal. The two words are deceptively similar in sound.

12. The name Andal does not cease to be deceptively similar because it is used the conjunction with a pictorial device. The case of *De Cordova & Ors. v. Vick Chemical Coy.* is instructive. From the Appendix printed at page 270 of the

same volume it appears that Vick Chemical Coy were the proprietors of the registered trade mark consisting of the word "Vaporub" and another registered trade mark consisting of a design of which the words "Vicks Vaporub Salve" formed a part. The appendix at page 226 -shows that the defendants advertised their ointment as 'Karsote vapour Rub". It was held that the defendants had infringed the registered mark. Lord Radcliffe said , ". . . a mark is infringed by another trader if, even without using the whole of it upon or in connection with his goods, he uses one or more of its essential features."

19.In **Cadila Heath Care Ltd. Vs. Cadila Pharmaceuticals Ltd.** 2001 PTC 541 (SC), it was held as below:-

"8. The appeal filed by the appellant before the High Court met with no success. After discussing various cases which were cited before it and after verifying the cartons and packings of the respective products, the High Court came to the conclusion that it could not be said that there was a likelihood of confusion being caused to an unwary consumer in respect of the disputed marks. It observed that there was little chance of any passing off of one product for the other product."

20.In yet another decision in **Kaviraj Pandit Durga Dutt Sharma Vs. Navaratna Pharmaceutical Laboratories** (AIR 1965 SC 980), approach required to be adopted was highlighted as below :-

"28.....but where the similarity between the plaintiff's and the defendants mark is so close either visually, phonetically or otherwise and the court reaches the .conclusion that there is an imitation, no further evidence is required to

establish that the plaintiff's rights are violated. Expressed in another way, if the essential features of the trade mark of the plaintiff have been adopted by the defendant, the fact that the get-up, packing and other writing or marks on the goods or on the packets in which he offers his goods for sale show marked differences, or indicate clearly a trade origin different from that of the registered proprietor of the mark would be immaterial;".....

21. In **Corn Products Refining Co. Shangrila Food Products Ltd.** (AIR 1960 SC 142), similar observation as in aforesaid decision were made, as under:

"14. We may also refer to *In re : Harrods'* application, mentioned in the quotation from Beck, Kollar & Co's case(supra), set out in the preceding paragraph. It was there said at p. 70;

"Now it is a well recognised principle, that has to be taken into account in considering the possibility of confusion arising between any two trademarks, that, where those two marks contain a common element which is also contained in a number of other marks in use in the same market such a common occurrence in the market tends to cause purchasers to pay more attention to the other features of the respective marks and to distinguish between them by those features. This principle clearly requires that the marks comprising the common element shall be in fairly extensive use and, as I have mentioned, in use in the market in which the marks under consideration are being or will be used."

22. The aforesaid decisions succinctly laid down the judicial approach on the

aspect of deceptive similarity and likelihood of confusion. Tested on the aforesaid well settled principles, it is apparent that the defendant is using word/mark **"BRILLIANT PUBLIC SCHOOL"** which is most prominent of all other part of its trademark which incidentally happens to be the most important and prominent expression of plaintiff's trademark **"BRILLIANT PUBLIC SCHOOL"**.

23. Prima facie, the plaintiff is possessed of a registered trademark and defendant is having none in his hand. Defendant's submission to dilute registered trademark on the premise which were more in nature of objection as contained in Section 9 of the Act relating to absolute ground and under Section 11 as relative grounds for refusal of registration cannot dilute plaintiff's strength in view of provision contained in Section 31 which is reproduced as below-

"31. Registration to be prima facie evidence of validity.—(1) In all legal proceedings relating to a trade mark registered under this Act (including applications under section 57), the original registration of the trade mark and of all subsequent assignments and transmissions of the trade mark shall be prima facie evidence of the validity thereof.
(2) In all legal proceedings as aforesaid a registered trade mark shall not be held to be invalid on the ground that it was not a registrable trade mark under section 9 except upon evidence of distinctiveness and that such evidence was not submitted to the Registrar before registration, if it is proved that the trade mark had been so used by the registered proprietor or his predecessor in title as to have become distinctive at the date of registration."

The respondent remedy would only be to take such remedy as may be available to it under the law seeking cancellation of the registered trademark of the plaintiff and not to raise it as a ground to oppose plaintiff's case.

24. In **American Home Products Corporation Vs. Mac Laboratories Pvt. Ltd.** And Anr. AIR 1986 SC 137, it was held as below:-

"36.When a person gets his trade mark registered, he acquires valuable rights by reason of such registration. Registration of his trade mark gives him the exclusive right to the use of the trade mark in connection with the goods in respect of which it is registered and if there is any invasion of this right by any other person using a mark which is the same or deceptively similar to his trade mark, he can protect his trade mark by an action for infringement in which he can obtain injunction, damages or an account of profits made by other person. In such an action, the registration of a trade mark is prima facie evidence on its validity.".....

25. In the case of **Metro Playing Card Co. Vs. Wazir Chand Kapoor**, PTC (Suppl) (1) 76 (Del) (DB), the aspect of prima facie evidence of validity was highlighted as below:-

"7. No doubt registration may be granted for concurrent user as provided by the law but till registration is granted there can be no doubt that the respondent's trade mark is infringed by the appellant and the statutory right which the respondent has under Section 28 of the Act is violated. Inasmuch as registration of the trade mark is prima facie evidence of its validity and the appellant has not challenged the validity of the registration of the respondent's trade mark it is not open to the appellant at this stage, to plead Section 12(3) of the Act."

Further, in the case of **Hem Corporation Pvt. Ltd. and Ors. Vs. ITC Limited** 2012(52) PTC 600 (Bom.) also legal position was highlighted as below :-

"42. Dr. Tulzapurkar relied upon the judgment of this

Court in Hindustan Embroidery Mills Pt. Ltd. v. K. Ravindra & Co. 1976 BLR 146 and Biochem Pharmaceutical Industries v. Biochem Synergy Ltd., 1998 (18) PTC 267. In fact, in the latter judgment, the learned Judge held that once a mark is a registered, an interim injunction to prevent infringement can be granted howsoever wrongly the mark remains on the register. It was contended on behalf of the defendant that the mark was inherently unregistrable, that the registration thereof was invalid and that no injunction should, therefore, be granted till the rectification application filed by the defendant was finally decided. The contention was rejected, inter-alia, on the ground that whatever be the worth of the defendant's application, it cannot prevent the registered proprietor from asserting his rights under section 28 of the 1958 Act so long as the trademark continued on the register."

26. The arguments of learned counsel for the respondent-defendant to weaken the strength of plaintiff's case based on plea of acquiescence do not come to his aid as, at this stage, in view of settled judicial pronouncement in this regard, some of which may be useful to refer to at this stage.

In **Midas Hygiene Industries** (supra), Their Lordships in the Supreme Court held:

"7. In our view on the facts extracted by the learned Single Judge this was a fit case where an interim injunction should have been granted and should have been continued. In our view the Division Bench was entirely wrong in vacating that injunction merely on the ground of delay and laches. Under the circumstances, the impugned order is set

aside and that of the trial court is restored. It is clarified that all observations made by the High Court and by this Court are prima facie and shall not be taken into consideration at the time of the trial of the suit."

27. In **Power Control Appliances and Ors. Vs. Sumeet Machines Pvt. Ltd. And Ors.** (1994) 2 SCC 448, the settled legal principle was explained by the Supreme Court as below :

"29. Acquiescence is sitting by, when another is invading the rights and spending money on it. It is a course of conduct inconsistent with the claim for exclusive rights in a trade mark, trade name etc. It implies positive acts; not merely silence or inaction such as is involved in laches.

In *Harcourt v. White*²⁸ Beav 303 Sr. John Romilly said: "It is important to distinguish mere negligence and acquiescence." Therefore, acquiescence is one facet of delay. If the plaintiff stood by knowingly and let the defendants build up an important trade until it had become necessary to crush it, then the plaintiffs would be stopped by their acquiescence. If the acquiescence in the infringement amounts to consent, it will be a complete defence as was laid down in *Mouson & Co. v. Boehm*" (1884) 26 Ch D 406. The acquiescence must be such as to lead to the inference of a licence sufficient to create a new right in the defendant as was laid down in *Rodgers v. Nowill*.

30. The law of acquiescence is stated by

Cotton, L.J. in *Proctor v. Bannis* (1887) 36 Ch D 740 as under:

"It is necessary that the person who alleges this lying by should have been acting in ignorance of the title of the other man, and that the other man should have known that ignorance and not mentioned his own title."

In the same case Bowen, L.J. said:

In order to make out such acquiescence it is necessary to establish that the plaintiff stood by and knowingly allowed the defendants to proceed and to expend money in ignorance of the fact that he had rights and means to assert such rights."

In *Messrs. Devidoss and Co.* (supra) at pages 33 and 34 the law is stated thus:

To support a plea of acquiescence in a trade mark case it must be shown that the plaintiff has stood by for a substantial period and thus encouraged the defendant to expend money in building up a business associated with the mark. In (1896) 13 RPC 464 *Rowland v. Mitchell*¹⁴ Romer J. observed:

'If the plaintiff really does stand by and allow a man to carry on business in the manner complained of to acquire a

reputation and to expend money he cannot then after a long lapse of time, turn round and say that the business ought to be stopped."

In the same case, but on appeal Lord Russel, C.J. said' (1897) 14 RPC 37:

Is the plaintiff disentitled to relief under that head by injunction because of acquiescence? Of course it is involved in the consideration of that that the plaintiff has a right against the defendant and that the defendant has done him a wrong and the question is whether the plaintiff has so acted as to disentitle him from asserting his right and from seeking redress from the wrong which has been done to him. Cases may occasionally lay down principles and so forth which are a guide to the court, but each case depends upon its own circumstances."

Aforesaid settled legal position has been reiterated in **Rolex SA Vs. Alex Jewellery Pvt. Ltd. & Ors.** 2014 (60) PTC 131 (Del) as below :

"43. One of the defences taken by the defendants in the present matter was that of delay. It was averred in the written statement that plaintiff has knowledge about the defendants since year 2003 but they

chose not to take any action and acquiesced and allowed defendants to develop their business. It has been averred that the present suit is time barred and without any cause of action. The aspect of delay has been discussed in various following cases. However, the said defence therefore has no force.

a) In the case of **Midas Hygiene Industries Pvt. Ltd. vs. Sudhir Bhatia and Others, 2004 (Vol.28) PTC 121**, relevant para-5 of the said judgment is as under:

"5. The law on the subject is well settled. In cases of infringement either of Trade Mark or of Copyright normally an injunction must follow. Mere delay in bringing action is not sufficient to defeat grant of injunction in such cases. The grant of injunction also becomes necessary if it prima facie appears that the adoption of the Mark was itself dishonest."

b) In the case of **Swarn Singh vs. Usha Industries (India) and Anr., AIR 1986 Delhi Page No.343 (DB)** it was held as under :

"There is then the question of delay. Learned counsel for the respondents had urged that the delay is fatal to the grant of an injunction. We are not so satisfied. A delay in the matter of seeking an injunction may be aground for refusing an injunction in certain circumstances. In the present case, we are dealing with a statutory right based on the provisions of the trade and Merchandise Marks Act, 1958. An exclusive right is granted by the registration to the holder of a registered trade mark. We do not think statutory rights can be lost by delay. The effect of a registered mark is so clearly defined in the statute as to be not capable of being misunderstood. Even if there is some delay, the exclusive right

cannot be lost. The registered mark cannot be reduced to a nullity....."

c) In the case of **Hindustan Pencils Pvt. Ltd. Vs. M/s India Stationery Products Co., AIR 1990 Delhi 19** it was held as under :

"It was observed by Romer, J. in the matter of an application brought by J.R. Parkinson and Co. Ltd., (1946) 63 RPC 171 at page 181 that "in my judgment, the circumstances which attend the adoption of a trade mark in the first instance are of considerable importance when one comes to consider whether the use of that mark has or has not been a honest user. If the user in its inception was tainted it would be difficult in most cases to purify it subsequently". It was further noted by the learned Judge in that case that he could not regard the discreditable origin of the user as cleansed by the subsequent history."

d) In the case of **M/s. Bengal Waterproof Lim. Vs. M/s. Bombay Waterproof Manufacturing Co., AIR 1997 SC 1398** it was held as under :

"20. It is now well settled that an action for passing off is a common law remedy being an action in substance of deceit under the Law of Torts. Wherever and whenever fresh deceitful act is committed the person deceived would naturally have a fresh cause of action in his favour. Thus every time when a person passes off his goods as those of another he commits the act of such deceit. Similarly whenever and wherever a person commits breach of a registered trade mark of another he commits a recurring act of breach or infringement of such trade mark giving a recurring and fresh cause of action at each time of such infringement to the party aggrieved. It is difficult to agree how in such a case when in historical

past earlier suit was disposed of as technically not maintainable in absence of proper relief, for all times to come in future defendant of such a suit should be armed with a license to go on committing fresh acts of infringement and passing off with impunity without being subjected to any legal action against such future acts."

28. Defendant opposition to plaintiff's case and which found favour with the learned Court below is based mainly on the decision in the case of **Skyline Education Institute (India) (P) Ltd. Vs. S.L. Vaswani & Ors.** (AIR 2010 SC 3221), that the word "**Brilliant**" being generic word used by large number of person and institutions non-suits the plaintiff. Learned trial Court has also heavily relied upon this judgment to hold that the plaintiff has failed to establish a prima facie case.

29. Reliance upon the aforesaid decision is prima facie misplaced because in that case, on the basis of undisputed position of use of a particular trademark by large number of companies, more than hundred in numbers, it was held to be a generic word. In para-18 of the said judgment (Skyline), the distinctive feature was noted as below :-

"18..... It has not been disputed on behalf of the appellant that the word 'Skyline' is being used as trade name by various companies/ organizations / business concerns and also for describing different types of institute/institutions. The voluminous record produced by the respondents before this Court shows that in India as many as 117 companies including computer and software companies and institutions are operating by using word 'Skyline' as part of their name/nomenclature. In United States of America, at least 10 educational/training institutions are operating with different names using 'Skyline' as the first word. In United Kingdom also two such institutions are

operating. In view of this, it is not possible to agree with the learned counsel for the appellant that the Skyline is not a generic word but is a specific word and his client has right to use that word to the exclusion of others.”

In the present case, there is hardly any prima facie material to place before the Court below by defendant to make out a case of user of “Brilliant” or “BRILLIANT PUBLIC SCHOOL” by large number of institutions in the country or abroad. Learned trial Court clearly overlooked that the application of principle of *publici juris* in the aforesaid decision was based on undisputed fact which is not the case here.

The other decision in the case of **J.R. Kapoor Vs. Micronix India** 1994 Supp (3) SCC 215 is related to claim of monopoly over the use of word “Micro”. It was found that there being no phonetic or visual resemblance between the words 'tel' and 'nix' users of such products not likely to be misguided or confused, interim injunction was not granted.

In judgment **Goenka Institute of Education and Research Vs. Anjani Kumar Goenka and Anr.** (AIR 2009 Delhi 139) use of trademark “Goenka” was not held infringement consideration of doctrine of honest concurrent use, there being no cases made out of deceptive similarity as “Goenka” is a common surname. One of the important consideration was that running of institution for about one year does not make it possible that institute became so famous that its name and fame spread well beyond Delhi into the district where the alleged infringement by opening another institution of the same name had taken place.

Learned counsel for the respondent also relied upon **M/s. S.M. Dyechem Ltd Vs. M/s Cadbury (India) Ltd.** (AIR 2000 SC 2114) to buttress his submission that the plaintiff's case for grant of temporary injunction is not made out if principles of comparative strength is applied.

Even if the principle laid down in para-19 of the aforesaid decision are

kept, in view of consideration which has been made by this Court in foregoing paragraph, on application of the principle of comparative strength also, the plaintiff case stands on a higher pedestal.

30. During the course of argument, learned counsel for the respondent-defendant drew attention of this Court to several decisions to put-forth his point of view that once the learned trial Court has exercised its discretion not to grant temporary injunction, the scope of judicial review in appeal against the order of refusing to grant temporary injunction is extremely limited and merely because discretion could well be exercised other way, interference would not be warranted.

In the case of **The Printers (Mysore) Private Ltd. Vs. Pothan Joseph** (AIR 1960 SC 1156), it was held:

“9. Where the discretion vested in the court under s. 34 has been exercised by the trial court the appellate court should be slow to interfere with the exercise of the said discretion. In dealing with the matter raised before it at the appellate stage the appellate court would normally not be justified in interfering with the exercise of discretion under appeal solely on the ground that if it had considered the matter at the trial stage it would have come to a contrary conclusion. If the discretion has been exercised by the trial court reasonably and in a judicial manner the fact that the appellate court would have taken a different view may not justify interference with the trial court's exercise of discretion. As is often said, it is ordinarily not open to the appellate court to substitute its own exercise of discretion for that of the trial judge; but if it appears to the appellate court that in exercising its discretion the trial court has

acted unreasonably or capriciously or has ignored relevant facts and has adopted an unjudicial approach then it would certainly be open to the appellate court-and in many cases it may be its duty-to interfere with the trial court's exercise of discretion. In cases falling under this class the exercise of discretion by the trial court is in law wrongful and improper and that would certainly justify and call for interference from the appellate court. These principles are well established; but, as has been observed by Viscount Simon, L. C., in *Charles Oseinton & Co. v. Johnston* (1942) AC 130 at p. 138 " the law as to the reversal by a court of appeal of an order made by a judge below in the exercise of his discretion is well established, and any difficulty that arises is due only to the application of well settled principles in an individual case".

31. In another decision in **Wander Ltd. And Another Vs. Antox India P. Ltd.** (1990 Supp Supreme Court cases 727), the principle was explained as below :

"14. The appeals before the Division Bench were against the exercise of discretion by the Single Judge. In such appeals, the Appellate Court will not interfere with the exercise of discretion of the court of first instance and substitute its own discretion except where the discretion has been shown to have been exercised arbitrarily, or capriciously or perversely or where the court had ignored the settled principles of law regulating grant or refusal of interlocutory injunctions.".....

32. In a subsequent decision in the case of **Seema Arshad Zaheer & Ors. Vs. Municipal Corpn. Of Greater Mumbai & Ors.** (2006) 5 SCC 282, the circumstances in which interference may be made was explained as below:-

“32. Where the lower court acts arbitrarily, capriciously or perversely in the exercise of its discretion, the appellate court will interfere. Exercise of discretion by granting a temporary injunction when there is 'no material', or refusing to grant a temporary injunction by ignoring the relevant documents produced, are instances of action which are termed as arbitrary, capricious or perverse.”.....

33. In the present case, consideration of material on record, makes out a case of interference in the light of principles laid down in aforesaid decisions.

34. A strong prima facie case is made out in favour of plaintiff in view of judicial trend in the matter of granting temporary injunction particularly dealing with cases of infringement of trademark by educational institution.

35. In **VIT University Vs. Bagaria Education Trust and Ors.** 2016 (67) PTC 120 (MAD), mark “VIT” was registered in favour of plaintiff- University and the same mark was used by the defendant and the defence was that defendant -University is situated at different place. Long and continuous use of mark “VIT” by the plaintiff was found to be of importance to grant interim injunction. It was held as below :

“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.”

In **Delhi Public School Society Vs. DPS Trust** 2016 (53) PTC 449 (Del.), plaintiff Delhi Public Society felt aggrieved by use of trademark “DPS” by the defendant, approached the Court. Having noted that the defendant is running a school, using the highly reputed brand name of “Delhi Public School” , a case was made out to pass an order in favour of the plaintiff.

In the case of **Ram Krishan & Sons Charitable Trust Vs. ILM Consulting Pvt. Ltd.** 2017 (70) PTC 529 (Del.), plaintiff educational institution having trade name of “Institute for Integrated Learning in Management , having registered trademark “IILM” was held entitled to relief against use of trademark “IILM” by the defendant who was running the placement and recruitment programme as it was found to be deceptively similar to that of the plaintiff mark and website.

In the case of **Rockfurd Education Pvt. Ltd. And Ors. Vs. Luv Kush Infrastructure Pvt. Ltd.** [CS (OS) No.234 of 2014, decided on 28.11.2017] plaintiff, educational institution alleged infringement of its registered trademark of “SHEMROCK” and “SHEMFORD”. The defendant was found running and operating a school under the name “SHEMROCK” and “SHEMFORD” school. Plaintiff allegation of infringement was found proved.

In another case **Delhi Public School Society Vs. DPS World Foundation & Anr.** [SLP (Civil) No.17216 of 2018], application for grant of injunction by the plaintiff having mark/name/words “DPS” and “Delhi Public School” registered trademark in his favour, temporary injunction was

issued against the defendant-DPS World Foundation that such logo shall not be used.

36. In the case of **Ms. Rupali Sharma Vs. Mathuram Swasthya Evam Shikshan Sansthan & Ors.** [CS (OS) No.3903 of 2014 decided on 17.12.2014], plaintiff having found to be possessed of registered trademark "Lawrence". Plaintiff had a longstanding use name and fame. The defendant was also found having started school with the name "Lawrence School Jaganpura Road, Near By Pass Kankarbagh, Patna". An ex-parte aid interim injunction was granted against use of word /mark Lawrence".

37. On prima facie consideration, the plaintiff has established that they have been running and operating their school under the trademark "**BRILLIANT PUBLIC SCHOOL**" since 2000 whereas the defendant could not prima facie established use of word "**BRILLIANT PUBLIC SCHOOL**" or word "**BRILLIANT**" prior to 2000. Though in defence pleading it has been stated that they had started a coaching institution in the name of **Brilliant Coaching Institute** way back in the year 1995, no prima facie material to support this pleading has been brought on record and material on records placed by the defendant only show that they started school in the name of "**BRILLIANT PUBLIC SCHOOL**" only in the year 2007 and not before that.

38. In view of aforesaid consideration, we are of the view that the appellant-plaintiff on the basis of material placed before the Court below and on the basis of provision contained in Sections 28 & 29 of the Trade Marks Act, 1999 examined in the light of settled legal position, made out a strong prima facie case, balance of convenience as also irreparable injury to grant temporary injunction and the learned trial Court arbitrarily and capriciously rejected the application by misdirecting itself in applying the ratio of decision in the case **Skyline** (supra), judgment of the Supreme Court, which was clearly distinguishable on facts and ignoring settled principles that deceptive similarity and likelihood of confusion, at this stage, prima facie make out a case of infringement and

further that plaintiff is having registered trademark whereas defendant is having no such trademark though applied for the same name.

39. In the result, this appeal is allowed. Order passed by learned Court below is set aside and the plaintiff application for grant of temporary injunction against defendant is allowed. The defendant is restrained from using plaintiff trademark "**BRILLIANT PUBLIC SCHOOL**" in the matter of running and operating their educational institution, till final disposal of the suit.

40. Before parting with the case, we must hasten to observe that all observations made by us herein-above, on the material placed by the parties in the form of pleading and documentary, are prima facie in nature and not conclusive and have been made for the limited purpose of consideration whether case for grant of temporary injunction is made out.

Sd/-
(Manindra Mohan Shrivastava)
Judge

Sd/-
(Vimla Singh Kapoor)
Judge