

MANU/DE/0825/2009

Equivalent Citation: AIR2008Delhi1992, 2008(2)ALD(Cri)547, (2009)ILR 3Delhi758, 2009(39)PTC720(Del)**IN THE HIGH COURT OF DELHI**

IA Nos. 15242/2008 and 307/2009 in CS (OS) No. 2579/2008

Decided On: 24.02.2009

Appellants: **Anjani Kumar Goenka and Anr.****Vs.**Respondent: **Goenka Institute of Education and Research****Hon'ble Judges/Coram:**

Manmohan Singh, J.

Counsels:

For Appellant/Petitioner/plaintiff: Pratibha M. Singh, Alok Kumar and Nidhi Bisht, Advs

For Respondents/Defendant: N.K. Kaul, Sr. Adv., Neel Mason and Balachandran, Advs.

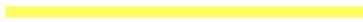
Subject: Intellectual Property Rights**Acts/Rules/Orders:**

Companies Act, 1956; Indian Trade Marks Act, 1999 - Section 28, Indian Trade Marks Act, 1999 - Section 29, Indian Trade Marks Act, 1999 - Section 31, Indian Trade Marks Act, 1999 - Section 34, Indian Trade Marks Act, 1999 - Section 35, Indian Trade Marks Act, 1999 - Section 35(1), Indian Trade Marks Act, 1999 - Section 35(3); U.K. Trade Marks Act, 1938 - Section 8; Trade and Merchandise Marks Act, 1958; Code of Civil Procedure (CPC) - Section 151, Code of Civil Procedure (CPC) - Order 39 Rule 1, Code of Civil Procedure (CPC) - Order 39 Rule 2, Code of Civil Procedure (CPC) - Order 39 Rule 4

Cases Referred:

Rajinder Kumar Agarwal v. Union of India and Anr. 2007 (35) PTC 616; Ashok Kumar Aggarwal v. Rajinder Kumar Aggarwal 2009 (1) AD Delhi 392; S. Chivers & Sons v. S. Chivers & Co. 17 RPC (15) 420; Rodgers v. Rodgers (1924) 41 R.P.C. 277; Bajaj Electrical Limited, Bombay v. Metals & Allied Products, Bombay AIR 1988 Bom 167; Dr. Reddy's Laboratories Ltd. v. Reddy Pharmaceuticals Ltd. 2004 (29) PTC 435 (Del); Mahendra & Mahendra Paper Mills Ltd. v. Mahindra & Mahindra Ltd. 2002 (24) PTC 121 (SC); K.G. Khosla Compressors Ltd. v. Khosla Extraktions Ltd. 1986 (6) PTC 211 (Del); Kewal Krishan v. Rudi Roller Flour Ltd. and Anr. 2008 (1) AD Delhi 178; B.D.A. Private Limited v. Paul P. John and Anr. 2008 (37) PTC 569; James Chadwick & Bros. Ltd. v. The National Sewin Thread Co. Ltd. MANU/MH/0063/1951; Parle Products (f) Ltd. v. J.P. & Co. Mysore. MANU/SC/0412/1972; Ruston and Hornby Ltd. v. Zamindara Engineering Co. MANU/SC/0304/1969; Kaviraj Pandit Durga Dutt Sharma v. Navaratna Pharmaceutical Laboratories AIR 1965 SC 980; Taw Manufacturing Co. Ltd. v. Notek Engineering Co. Ltd. and Anr. (1951) 68 Reports of Patent Cases 271 (2); De Cordova and Ors. v. Vick Chemical Co. 68 R.P.C. 103; American Home Products v. Mac Laboratories AIR 1986 SC 137; National Bell Co. v. Metal Goods Mfg. Co. AIR 1971 SC 898; Avis International v. Avi Footwear AIR 1991 Delhi 22; Allianz Aktiengesellschaft Holding v. Allianz Capital & Management Services Ltd. 2002 (24) PTC 177; Hindustan Pencils Ltd. v. Universal Trading Co. 2000 (7) AD Delhi 925; Ric Products Corporation v. India Nippon Food Ltd. 2007 (35) PTC 15; Johnson & Johnson and Anr. v. Christine Hoden India Pvt. Ltd. and Anr. AIR 1998 Delhi 249; Britannia Industries Ltd. v. Cremica Agro Foods Ltd. 2008 (38) PTC 89; Vijay Kumar Ahuja v. Lalita Ahuja 2002 (2) AD Delhi 223; Warnik v. Townend & Sons (HULL) Ltd. 1979 AC 731; Laxmikant V. Patel v. Chetanbhai Shah AIR 2002 SC 275 : 2002 (24) PTC 1; Century Traders v. Roshan Lal Dagar AIR 1978 Delhi 250; Corn Products refining Co. v. Shangrila Food Products Ltd. AIR 1960 Supreme Court 142 (47); Coolways India v. Princo Air Conditioning and Refrigeration PTC (Suppl) (1) 470 (Del); P.M. Diesels Ltd. v. S.M. Diesels 1993 PTC 75; Info Edge (India) Pvt. Ltd. and Anr. v. Shailesh Gupta and Anr. 2002 (24) PTC 355 (Del); Indian Shaving Products Ltd. and Anr. v. Gift Pack and Anr. 1998 PTC (18); Pankaj Goel v. Dabur India Ltd. 2008 (38) PTC 49 (Del); Express Bottlers Services Pvt. Ltd. v. Pepsi Inc. and Ors. 1989 (7) PTC 14; Midas Hygiene Industries Pvt. Ltd. v. Sudhir Bhatia and Ors. 2004 (28) PTC 121; Swarn Singh v. Usha Industries (India) and Anr. AIR 1986 Delhi 343; Hindustan Pencils Pvt. Ltd. v. India Stationery Products Co. AIR 1990 Delhi 19; Bengal Waterproof Lim. v. Bombay Waterproof Manufacturing Co. AIR 1997 SC 1398; Syncom Formulations v. SAS Pharmaceuticals 2004 (28) PTC 632 (Del); Sun Pharmaceuticals v. Cipla Ltd. IA No. 6872/2008 in CS (OS) No. 1073/2008; In re: Beck, Kollar and Co. (England) Limited 64 R.P.C. 76

Citing Reference:

Discussed		27
Distinguished		4
Mentioned		11

Case Note:

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Intellectual Property Rights - Passing of Trademark - Vacation of Injunction - Order XXXIX Rule 1, 2 and 4 and Section 151 of Code of Civil Procedure, 1908 (CPC) - Plaintiffs filed present application under Order XXXIX Rule 1 and 2 and Section 151 of CPC for grant of injunction restraining defendant from using trademark of plaintiffs whereas defendant filed this application under Order XXXIX Rule 4 and Section 151 of CPC for vacation of injunction granted to plaintiffs restraining defendant, its agents, representatives, assignors from offering its service in field of education, under trade mark, 'Goenka' or its school, 'goenka Public School', 'goenka Girls College' and 'Goenka Girls College' - Held, plaintiff No. 1 is registered proprietor of trademark/service mark 'G.D. Goenka', 'Goenkas', Goenka School, 'Goenka Medical University' and 'G.D. Goenka Medical University' - Use of name Goenka Public School, Goenka Girls College and Goenka College of Pharmacy in which mark Goenka forms an essential feature for its service in field of education, two names are prima facie deceptively similar with name of plaintiffs G.D. Goenka Public School - Use of name Goenka Public School and Goenka College of Pharmacy would lead to passing off services as that of plaintiffs - Defendant has named few institutions which are using word 'Goenka' in their name - A perusal of same list itself establishes that all these institutions are using their own/full name as name of their institutes - Apart from one M/s Goenka College of Commerce whose present actual status could not be traced till date by plaintiffs there is no other institute on record showing use of mark/word 'Goenka' per se, prior to that of plaintiffs or even otherwise - Regarding Goenka Girls School there is no evidence or pleading by defendant about use of said name except that said name is shown in defendant's website, therefore, ex parte ad interim injunction would continue against use of said name during pendency of suit - Ex parte ad interim injunction shall also continue against defendant for use of name Goenka Public School and Goenka College of Pharmacy as it leads to infringement of registered trade mark of plaintiffs and passing of their goods as that of plaintiffs - Defendant is granted time to discontinue use of name Goenka Public School and Goenka College of Pharmacy and ex parte ad interim order would continue against defendant after expiry of said period - Applications are disposed of in above terms

JUDGMENT

Manmohan Singh, J.

1. By this order I shall dispose of the application filed by the plaintiffs (IA No. 15242/2008) under Order XXXIX Rule 1 and 2 read with Section 151 CPC as well as application filed by defendant (IA No. 307/2009) under Order XXXIX Rule 4 read with Section 151 CPC for vacation of injunction granted to the plaintiffs restraining the defendant, its agents, representatives, assignors from offering its service in the field of education, under the trade mark, 'Goenka' or its school, 'goenka Public School', 'goenka Girls College' and 'Goenka Girls College'.

2. Brief facts are that the plaintiffs have filed the suit for infringement of trade marks and passing off and damages etc. against the defendant.

3. It is averred in the plaint that the plaintiff No. 1 is a noted businessman with experience of over two decades in the field of imparting education, real estate, travel, tourism and plaintiff No. 2 is a company incorporated under the Companies Act, 1956 and is engaged in the field of imparting education under the license from first plaintiff. In 1994, plaintiffs opened 'G.D. Goenka Public School' at Delhi through G.D. Goenka Educational Society.

4. It is alleged that by virtue of long, extensive and continuous use of marks 'Goenka/G.D. Goenka' in the field of education the plaintiffs have acquired distinctiveness. The word Goenka has become an essential and integral part of plaintiffs' services and its name has acquired distinctiveness and exclusivity.

5. The plaintiff No. 1 is the registered proprietor of the trademark/service mark "G.D. Goenka, Goenkas, Goenka School, Goenka Medical University, & G.D. Goenka Medical University" in class 41 and is also the registered proprietor of the trademark G.D. Goenka, Goenkas, GOENKA and G in various other classes, details of which are given below:

S. No.	Trade Marks	Class	Status	App.No.	J/No.
1	GDGOENKA	41	REGD.	1281086	1325 S-1
2	G	41	REGD.	1238908	1325 S-1
3	GOENKAS	41	PUB.	1238911	1338 S-1
4	GOENKA	41	REGD.	1257627	1327 S-2
INTERNATIONAL SCHOOL					
5	GOENKA	41	REGD.	1257630	1327 S-2
MEDICAL UNIVERSITY					
6	GDGOENKA	41	REGD.	1257629	1328 S-1

MEDICAL UNIVERSITY					
7	GOENKA	41	REGD.	1257628	1327 S-2
	SCHOOL				
8	GOENKA	3	REGD.	1232682	1327 S-5
9	GOENKAS	3	REGD.	1232688	1327 S-5
10	GOENKAS	12	REGD.	1232689	1328 S-1
11	GOENKA	12	REGD.	1232683	1327 S-5
12	GW (DEVICE)	16	REGD.	1213729	1324 S-1
13	G.D. GOENKA	16	REGD.	1281083	1327 S-4
14	GOENKAS	18	REGD.	1232690	1328 S-1
15	GOENKA	18	REGD.	1232684	1327 S-5
16	GW (LABLE)	25	REGD.	1213731	1327 S-1
17	GOENKAS	25	REGD.	1232691	1356
18	GOENKA	25	REGD.	1232685	1327 S-5
19	GOENKAS	32	REGD.	1232692	1327 S-5
20	GOENKA	32	REGD.	1232686	1327 S-5
21	GOENKAS	33	REGD.	1232693	1328 S-1
22	GOENKA	33	REGD.	1232687	1327 S-5
23	GOENKA	35	REGD.	1238913	1357
24	GOENKAS	35	REGD.	1238910	1335
25	GDGOENKA	35	REGD.	1281084	1325 S-1
26	G	35	REGD.	1238907	13268-1
27	GDGOENKA	36	REGD.	1281085	13258-1
28	GDGOENKA	42	REGD.	1281087	13268-1
29	G	42	REGD.	1238909	13258-1
30	GOENKA	42	REGD.	1238915	1335

6. It is submitted in the plaint that the plaintiffs have schools at following places:

Self owned

1. G.D. Goenka Public School, Vasant Kunj, New Delhi (CBSE curriculum)

2.2. G.D. Goenka World School, Sohna (IB curriculum) Franchisee:

1. Ludhiana
2. Rohini, Delhi
3. Faridabad
4. Jammu

7. It is stated in the plaint that apart from enjoying huge turnovers, the plaintiff's trade mark GOENKA/G.D. GOENKA have been widely advertised in the periodicals, journals and newspapers. This tremendous publicity has lead it in public identifying services bearing trademark/service mark GD GOENKA and GOENKA exclusively as originating from the plaintiffs'. The said trademark/ service mark has been continuously extensively, voluminously and uninterruptedly used by the plaintiffs in respect of the services provide by them since 1994. The aforesaid services provided by the plaintiff symbolize in itself a mark of quality and has become synonymous with the high degree of excellence. The aforesaid services of the plaintiff with the trademark/service mark G.D. Goenka, Goenka, Goenkas have acquired distinctiveness, substantial goodwill

8. It is alleged in the plaint that defendant is also in the services/business of providing education, training, entertainment, sporting and cultural activities falling under Class-41. The use of word 'GOENKA' for its school, college as a Goenka Public School, Goenka Girls College and goenka Girls College as a trade mark and service mark by the defendant is bound to cause deception and confusion amongst the public and trade, who, will undoubtedly be misled into thinking that services of the aforesaid defendant also originate from the plaintiff's in one or the other manner.

9. It is submitted in the plaint that the plaintiffs came to know about the defendant trade activities of providing education and training, as that of plaintiffs, with the trade mark 'GOENKA' for its school as a Goenka Public School from the publication of their advertisement in Hindustan Times News Paper dated 11.11.2008.

10. By order dated 12th December, 2008 this Court has passed an ex parte ad interim injunction restraining the defendant Society from offering its service in the field of education, under the trademarks 'GOENKA' for its school, college as 'goenka Public School', 'goenka Girls College' and 'Goenka Girls College'.

11. Upon service, the defendant filed an application under Order 39 Rule 4 read with Section 151 CPC being IA No. 307/2009 for vacation of ad interim injunction.

12. It is claimed by the defendant that the four Schools and Colleges are running under this society using the word Goenka as part of the name of the Schools/Colleges-

- a. Mohini Devi Goenka Mahila Mahavidyalaya commencing in the year 1995.
- b. Goenka Public School commencing in the year 2000.
- c. Goenka College of Pharmacy commencing in the year 2004.
- d. Mohini Devi Goenka Girls B.Ed College commencing in the year 2006.

13. The defendant has averred that the name/mark Goenka is a very common surname and cannot be monopolized by anyone unless it is shown to have acquired distinctiveness. The plaintiffs have not placed any evidence on record to show that the surname "Goenka" has become distinctive of the plaintiffs'. There are only two schools of the plaintiffs by the said name in Delhi and Sohna Road.

14. It is alleged that the name/mark Goenka is commonly used in the filed of education by third parties for educational institutions. The details of the some of the institutions have been given in the application filed under Order 39 Rule 4. The Defendant has shown that one institution, the 'Goenka College of Commerce in Kolkata', adopted Goenka well before the plaintiffs. The name used by the plaintiffs is G.D. Goenka and not Goenka in isolation as a mark by the plaintiffs.

15. The plaintiffs have, inter alia, filed large number of documents to show their use of the mark/name in question:

- a] Photostat copies of the registrations of the mark GOENKA [label], Gonenka School, Goenka International School, Goenka Medical University in Class 41 in relation to education, providing of training, entertainment, sporting and cultural activities.
- b] Various registration certificates have been filed in order to show that the mark Goenka is registered in various classifications of goods other than the education.
- c] The search report of the trademark Goenka in Class 41 as a service mark, which shows that the plaintiffs are having most of the trademarks registered in their favour.
- d] The statement of receipts/turnover of G.D. Goenka Private Limited from the year 1994-95 to 2006-07.
- e] The list of the places where the schools with the name of Goenka are being run by the plaintiffs, its franchisees as well as list of countries where the students are studying at G.D. Goenka World School etc.
- f] Copies of the balance sheet from the year 1995 onwards.
- g] Advertisement and publicity expenses from the year 1996 to 2008.
- h] Photostat copy of the advertisement published in various well known newspapers from the year 1994 and invoices etc.

From the documents, prima facie, it appears that the plaintiffs have been using the name/mark Goenka and/or part of the G.D. Goenka Public School from the year 1994.

16. The defendant has also filed number of documents by way of balance sheet, income tax returns, advertisement expenses, copies of Trust Deeds, Brochures, advertisement materials, prospectus, copies of the newspaper articles. After having gone through the said documents filed by the defendant, prima facie, it appears that the defendant has been using the following names in which the mark GOENKA forms part of it:

(i) Goenka Shiksha Avam Shodh Sansthan in the year 2000.

(ii) Mohini Devi Goenka Mahila Mahavidyalaya in the year 1995.

(iii) Mohini Devi Goenka Girls Mahavidhyalya in the year 1997.

(iv) Mohini Devi Goenka Girls B.Ed. College in the year 2006.

(v) Goenka College of pharmacy in the year 2004-05.

(vi) Goenka Public School - The defendant has claimed that this name is being used since 2000 for the course of CBSE affiliation upto Class XII. The defendant has also filed some of the documents in support of the user claim of Goenka Public School. The details of the said documents are as under:

(a) Copies of the ledger accounts showing the advertisement and publicity expenses for the year 1.4.2007 -31.3.2008;

(b) Students' strength of Goenka Public School for the year 2006-07; 2007-08 and 2008-09;

(c) Certificate issued by the CBSE under the name 'Goenka Public School' dated 13th July, 2005 for the period with effect from 1st April, 2005 to 31st March, 2008;

(d) Certificate of upgradation issued on 26th February, 2007 and

(e) Prospectus, brochure, admission notice and some of the references made in the news article published in the year 2008.

(vii) Goenka Girls College

17. After having examined the documents filed by the defendant, prima facie it appears that the defendant has filed the material on record to show that the said name is being used by the defendant from the year 2004-05. There is no evidence on record to show that 'Goenka Girls College' has ever been used by the defendant, although in their Website they have made publicity regarding the said name.

18. The main contentions of the defendant for vacation of the ad interim order during the course of argument are:

a] The word 'Goenka' per se is a very common surname/caste in India, therefore, no monopoly can be claimed by the plaintiffs. In fact, it is a weak mark/name and is also non-distinctive and its distinctiveness can only be assessed by the court at the time of trial and not at this stage for considering the interim application.

b] The use of the name Goenka being a part of trust, school, college, pharmacy and girl colleges is to be considered as bona fide use being common surname of the defendant proprietor/partners/directors and, therefore, under Section 35 of the Trade Marks Act, 1999, the defendant is entitled to use the same as a bona fide user. Section 35 of the Act is an exception to Sections 28 and 29 of the Trade Mark Act and therefore, no case of infringement of trade mark has been made out as two names used by the plaintiffs and defendant is dis-similar.

c] The defendant Shree Lal Goenka Chairtable Trust was set up in the year 1990 for the purpose of education and school etc., which is prior to the adoption of the plaintiffs' trademark G D GOENKA. Hence, the defendant's claim is protected under Section 34 of the Trade Mark Act, 1999 being the prior user.

d] There is a delay on the part of the plaintiffs for bringing the action, hence, the balance of convenience lies in favour of the defendant and, thus, the injunction is liable to be vacated.

e) There are other parties who are using the mark/name Goenka in relation to the same services and some of them are using the name/mark GOENKA as part of their name prior to the plaintiffs.

Bona fide Use of Name

19. The first contention of Mr. Neeraj Kishan Kaul, learned Senior Counsel is that prima facie suit is not maintainable. He referred to the provisions of Section 35 of the Trade Mark Act, 1999. Section 35 of the Trade Mark Act, 1999 reads as under:

35. Saving for use of name, address or description of goods or services.- Nothing in this Act shall entitle the proprietor or a registered user of a registered trade mark to interfere with any bona fide use by a person of his own name or that of his place of business, or of the name, or of the name of the place of business, of any of his predecessors in business, or the use by any person of any bona fide description of the character or quality of his goods or services.

Relying upon the above said provision, learned Senior Counsel submitted that the defendant cannot be

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restrained from using their own name. Various decisions in support of his submission are relied upon at the bar on this question Rajinder Kumar Agarwal v. Union of India and Anr. 2007 (35) PTC 616; Ashok Kumar Aggarwal v. Rajinder Kumar Aggarwal 2009 (1) AD Delhi 392 Para 10 and S. Chivers & Sons v. S. Chivers & Co. 17 RPC (15) page No. 420. Para 10 of the decision cited by the learned Counsel for the defendant in 2009 (1) AD Delhi 392 reads as under:

10. Every trader has a right to trade in his own name and ought not to be hampered in its use. One has, therefore, to consider the interests of other persons having the same surname who might at any time carry on trade in the goods. A surname, therefore, is considered prima facie not adapted to distinguish for the purpose of registration in part A. For the same reason, a personal name is considered not registrable in part A. A surname, therefore, is considered not registrable in part A without evidence of distinctiveness. Common abbreviation of surname, or personal name is to be considered on the same footing as a surname or a personal name. (See P. Narayanan's Law of Trade Marks and Passing Off (6th edition), para 8. 20).

20. There is no dispute that surname cannot become distinctive without the evidence of distinctiveness. No protection or registration can be granted without the evidence. However, the situation in the present case is different as the plaintiffs have been using the surname since the year 1994. Therefore, the findings and law laid down in the case of 2007 (35) PTC 616 and 2009 (1) AD Delhi 392 do not help case of the defendant. Similarly, the ratio of the decision reported in 17 RPC Page 420 is also not applicable as in that case, it is held that the plaintiff had not proved that 'Chivers' Table Jelly meant their Table Jelly and nothing else. Further by virtue of long user established by the plaintiffs from the year 1994, the mark Goenka is become distinctive and has acquired secondary meaning.

21. The learned Counsel for the plaintiffs, Ms. Pratibha M. Singh has made her submissions on the question of bonafide use of his own surname to the following effect that the defence under Section 35 relied upon by the Defendant permits only "bonafide use by a person of his own name". The emphasis in this Section is on the two terms "bonafide" and "his own name". Her submissions are that "his own name" has to be mean the full name of a person as a person cannot be known just by his first name or last name.

22. She relied upon the case of Rodgers v. Rodgers (1924) 41 R.P.C. 277 to contend that there are five elements to the supposed defence of a desire of defendant to use his own name:

- a. The Defendant must be using his own full name,
- b. He must do nothing more that causes confusion with the claimant,
- c. he must act honestly,
- d. he must in general be a natural person;
- e. and he must not be using the name so as to describe his goods.

The supposed defense may be lost if the defendant does not use his own name in full without abbreviations or embellishments. In particular, an individual may not in general claim any right to trade under his surname alone, or as part of a trading style, where it would involve passing-off. Failure to use one's full name may itself indicate a lack of bona fides.

23. Section 35 is based on the U.K. Trade Marks Act 1938. The respective statutory provisions relating to use of one's own name under English and Indian Trade Marks Acts are set out hereunder:

Trade Marks Act 1938 (The U.K. Act)

Saving for use of name, address or description of goods-

Section 8

No registration of a trade mark shall interfere with-

The Trade Marks Act, 1999

Saving for use of name, address or description of goods or services

Section 35

Nothing in this Act shall entitle the proprietor or a registered user of a registered trade mark to

(a) any bon fide use by a person of his own name or that of his place of business, or of the name, or of the name, or of the name of the place of business, of any of his predecessors in business; or

(b) the use by any person of any bona fide description of the character or quality of his goods, not being a description that would be likely to be

interfere with-

Any bona fide use by a person of his own name or that of his place of business, or of the name, or of the name of the place of business, of any of his predecessors in business, or The use by any person of any bona fide description of character or quality of his goods or services.

From the above table it is clear that the statutory position in respect of bonafide use.

24. In the case of Bajaj Electrical Limited, Bombay v. Metals & Allied Products, Bombay MANU/MH/0333/1988 : AIR1988Bom167 , the Bombay High Court discussed the case of Rodgers v. Rodgers as also Parker Knoll in para 7 which reads as under:

Para 7: ...It is the law of this land that no man is entitled to carry on his business in such a way as to represent that it is the business of another, or is in any way connected with the business of another; that is the first proposition. The second proposition is that no man is entitled so to describe or mark his goods as to represent that the goods are the goods of another. To the first proposition there is, I myself think an exception: a man, in my opinion, is entitled to carry on his business in his own name so long as he does not do anything more than to cause confusion with the business of another, and so long as he does it honestly. To the second rule, to which I have referred, I think there is no exception at all; that is that a man is not entitled so to describe his goods as to lead to the belief that they are the goods of somebody else.

25. In the case of Dr. Reddy's Laboratories Ltd. v. Reddy Pharmaceuticals Ltd. MANU/DE/0658/2004 : 2004(76)DRJ616 , it was held as under:

Para 15: ...No other "Reddy" has a right to start a rival business by using the same trade name on the plea that it is his surname. This would encourage deception. If such a plea is allowed, rivals in trade would be encouraged to associate in their business ventures persons having similar surnames which was held to be an act of passing off the goods and it was observed that the use of such family name as a trade mark was not permissible. The plea of the defendant that the surname of the partners of its firm could be used to carry on trade in their own name was rejected. It was held that prima facie the defendant was intentionally and dishonestly trying to pass off their goods by use of name "Bajaj" and as such the plaintiff had made out a case for grant of injunction.

This Single Bench judgment was confirmed by the Division Bench who dismissed the appeal by the defendant and is reported in MANU/DE/2672/2007.

26. In the case of Mahendra & Mahendra Paper Mills Ltd. v. Mahindra & Mahindra Ltd. 2002 (24) PTC 121 (SC) [Para 23] where defendant's name was 'Mahendrabhai', no protection was given and injunction was granted by the Apex Court.

27. In the case of K.G. Khosla Compressors Ltd. v. Khosla Extraktions Ltd. 1986 (6) PTC 211 (Del) similar position arose, the court held that, prima facie, when the reference is made to 'Khosla' in the business trade, it is referred to the plaintiffs and there being no reason why the name of the defendant should be as it is except that the name was deliberately used to cash on the goodwill and reputation of the plaintiffs. In view of the settled law, it is clear that the surname which is rare in use is protectable. The present case can not be compared with the mark/name 'Aggarwal' which is very common surname and very common sect in India.

28. 'Bonafide use' normally means the honest use by a person of his own name without any intention to deceive anybody or without any intention to make use of the goodwill which has been acquired by another trader. The mere fact that a party is using his own name which too closely resembles the registered trade mark of which he is aware does not prevent the user from being bonafide provided that the party honestly thought that no confusion would arise if he had no intention to wrongfully divert the business to himself by using the name. By use of the name Goenka Public School and Goenka College of Pharmacy in which the dominant and essential part of the word is 'Goenka' and in case the said names are used in the manner of essential and prominent features, then defendant's case is not protected under Section 35 of the Act as it would create confusion and deception. Infringement of Trademark.

29. The next submission of Mr. Kaul is that the two names used i.e. G.D. Goenka Public School and Goenka Public School, Goenka Girls College, Goekna College of Pharmacy are totally dis-similar, and in view thereof the question of infringement of trade mark does not arise. Learned Senior Counsel has referred to 2008 (1) AD Delhi 178 Kewal Krishan v. Rudi Roller Flour Ltd. and Anr. (DB) and B.D.A. Private Limited v. Paul P. John and Anr. 2008 (37) PTC 569.

30. As regards the judgment cited by the learned Counsel for the defendant reported in 2008 AD Delhi 178 and 2008 (37) PTC 569 are concerned, the same are not applicable to the facts and circumstances of this

manupatra case. In the first judgment of a case of registration of trademark where the court held that the mark used by the defendant Shiv Shakti along with the device of Trishul and Damru, was used in the descriptive form and when it is read as a whole, there is no similarity, therefore, the said decision does not help the case of the defendant. Similarity in the second case where the two names Officers Choice and Original Choice are in dispute were held to be different. The facts of the said case were totally different as there was a suppression of facts in that case. The mark Choice was disclaimed by the plaintiff at the time of obtaining registration. The said fact was not disclosed in the plaint amongst other concealments.

31. In an infringement action it is well established law that when the plaintiffs complains of infringement of trademark by taking the mark in its entirety or by taking substantial portion of it, or by colourable imitation or he relies on his title to the exclusive use of the mark in question for goods of the specified kind. Under Section 28 of the Trade Mark Act, 1999 the registration confers exclusive right in favour of the plaintiffs and under Section 29 of the Act when the defendant is using identical or deceptively similar trade mark then a clear case of infringement of trademark is made out. Section 31 of the Act says that the registration granted in favour of the plaintiffs is a prima facie case of evidence of validity.

32. In the present case, it is an undisputed fact that the plaintiff No. 1 is the registered proprietor of the trademark/service mark 'G.D. Goenka', 'Goenkas', Goenka School, 'Goenka Medical University' and 'G.D. Goenka Medical University' in class 41. The question before this Court is whether the use of the name Goenka Public School, Goenka Girl's College and Goenka College of Pharmacy and other names are deceptively similar or not.

33. The question of resemblance and deception are to be considered by referring not only to the whole mark, but also to its distinguishing or essential/substantial feature of the mark. Essential features.

34. A trade mark is infringed if a person other than the registered proprietor or authorised user uses, in relation to goods covered by the registration, one or more of the trade mark's essential particulars. The identification of an essential feature depends partly upon the Court's own judgment and partly upon the burden of the evidence that is placed before the Court.

35. In James Chadwick & Bros. Ltd. v. The National Sewin Thread Co. Ltd. MANU/MH/0063/1951 the Court ruled as under:

in an action for infringement what is important is to find out what was the distinguishing or essential feature of the trade mark already registered and what is the main feature or the main idea underlying the trade mark. In Parle Products (f) Ltd. v. J.P. & Co. Mysore. MANU/SC/0412/1972 the Supreme Court took the same view.

36. In the judgment of the Supreme Court in Ruston and Hornby Ltd. v. Zamindara Engineering Co. MANU/SC/0304/1969. The High Court, in appeal, held that the offending trade mark infringed the appellant's trade mark "Ruston", and restrained the respondent from using the trade mark "Rustam", but further held that the use of the words "Rustam India" was not an infringement of the registered trade mark, as the appellant's goods were manufactured in England and not in India and the suffix of the word "India" constituted a sufficient distinguishing factor. The Supreme Court, while upholding the first part of the High Court Judgment and reversing the second part, held that an infringement of a registered trade mark takes place not merely by exact imitation but by the use of a mark so nearly resembling the registered mark as to be likely to deceive.

37. In the case of Kaviraj Pandit Durga Dutt Sharma v. Navaratna Pharmaceutical Laboratories MANU/SC/0197/1964 : [1965]1SCR737 it was held as under:

30. The mark of the respondent which he claims has been infringed by the appellant is the mark 'Navaratna Pharmaceutical Laboratories', and the mark of the appellant which the respondent claimed was a colourable imitation of that mark is 'Navaratna Pharmacy'.

Where common marks are included in the trade marks to be compared or in one or in one of them, the proper course is to look at the marks as wholes and not to disregard the parts which are common.

38. In the case of Taw Manufacturing Co. Ltd. v. Notek Engineering Co. Ltd. and Anr. (1951) 68 RPC 271 (2), where the two pictures of the respective parties which are scanned and shown as under were in dispute:

It is held that the monopoly right claimed under the registered trade mark related to Motor Lamps and consisted of a pictorial device and the word "Taw". The device comprised of a representation of the full-faced view of a cat's head, wherein the eyes were drawn in the form of a motor ear headlamps and the whole was superimposed upon an open body motor ear viewed from the front in a manner as to substitute the cat's head for the bonnet and radiator as normally seen. The device that was the subject matter of challenge consisted of a square panel with informative particulars printed below. The panel depicted a full-faced view of a cat's head with the eyes drawn as motor car headlamps, beneath which was the caption "Let Notek be your eyes in fog and darkness". The disposition and lettering was such as to lead the reader to take particular notice of the device with the word "Notek" beneath it. The question for decision was whether there was infringement by the latter device of the former registered trade mark.

manupatrr 39. As observed by the Privy Council in *De Cordova and Ors. v. Vick Chemical Co.* 68 R.P.C. 103, 106 it was held as under:

it has long been accepted that, if a word forming part of a mark has come in trade to be used to identify the goods of the owner of the mark, it is an infringement of the mark itself to use that word as the mark on part of the mark of another trader, for confusion is likely to result.

Test of Infringement

40. In the case of *Kaviraj Pandit Durga Dutt v. Navaratna Pharmaceutical* MANU/SC/0197/1964 : [1965]1SCR737 , it was held as under:

In an action for infringement the plaintiff must, no doubt, make out that the use of the defendant's mark is likely to deceive but where the similarity between the plaintiff's and the defendant's 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.

41. In the case of *American Home Products v. Mac Laboratories* MANU/SC/0204/1985 : AIR1986SC137 it was held:

When a person gets his trade mark registered, he acquires valuable rights by reason of such registration. Registration of his trade mark give 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....

42. In the case of *National Bell Co. v. Metal Goods Mfg. Co.* AIR 1971 SC 898 at Page No. 903 it was held as under :

On registration of a trade mark the registered proprietor gets under Section 28 the exclusive right to the use of such trade marks in relation to the goods in respect of which the trade mark is registered and to obtain relief in respect of any infringement of such trade mark.

43. In the case of *Avis International v. Avi Footwear* AIR 1991 Delhi 22 at Page 25 Para 21 it was observed:

In my view violation of the exclusive statutory rights is illegal activity, to hold otherwise will negate the statutory provisions of the Trade and Merchandise Marks Act.

44. Validity of the trade mark cannot be challenged in an action of infringement In the case of 1999 PTC 81 it was held as under:

The validity of the registration of 'DIMMERSTAT' cannot be challenged by the defendants in a proceeding like this for the defendants have a remedy to file cancellation of the registration in an appropriate forum.

45. From the above, it is clear that the use of the name Goenka Public School, Goenka Girls College and Goenka College of Pharmacy in which the mark Goenka forms an essential feature for its service in the field of education, the two names are prima facie deceptively similar with the name of plaintiffs G.D. Goenka Public School. Passing Off

46. In order to establish the case of passing off the learned Counsel for the plaintiffs has referred to the advertisement which appeared in the Hindustan Times on 11.11.2008 from where the plaintiffs have got the knowledge about the use of the names. Scan copy of the said publication is scanned and reproduced:

47. Learned Counsel has argued that in view of the abovesaid advertisement which appeared in the Hindustan Times on 11.11.2008, it is a classic example of passing off.

48. It appears that the advertisement of both the parties appeared simultaneously. The learned Counsel for the plaintiffs states that after the said advertisement, it has received various queries from the public verifying as to whether Goenka Public School is also belonging to the plaintiffs or not.

49. Learned Counsel for the defendant has argued at great length on the point of passing off action. The first contention of the learned Counsel for the defendant is that the defendant has established the Trust in the year 1990 under the name Shree Goenka Charitable Trust from the surname which is prior in time to the plaintiffs mark and in view thereof the defendant's case is protected under Section 34 of the Act. The name of the Trustees were Shyam Sunder Goenka and Aushutosh Goenka and the name of the Trust was Sri Lal Goenka Charitable Trust which was derived from the name of the father Sh. shyam Sunder Goenka. The second submission of the learned Counsel for the defendant is that there is no similarity between the service

manupatra mark/names of the parties, therefore, the question of passing of does not arise. In support of his submission the learned Counsel for the defendant has referred to the following decisions:

- i) Allianz Aktiengesellschaft Holding v. Allianz Capital & Management Services Ltd. 2002 (24) PTC 177.
- ii) Hindustan Pencils Ltd. v. Universal Trading Co. 2000 VII AD Delhi 925.
- iii) Ric Products Corporation v. India Nippon Food Ltd. 2007 (35) PTC 15.
- iv) Johnson & Johnson and Anr. v. Christine Hoden India Pvt. Ltd. and Anr. MANU/DE/0471/1998 : AIR1998Delhi249 .
- v) Britannia Industries Ltd. v. Cremica Agro Foods Ltd. 2008 (38) PTC 89.
- vi) Vijay Kumar Ahuja v. Lalita Ahuja 2002 II AD Delhi 223.

50. In passing off action, one has to see as to whether the defendant is selling goods/service so marked as to be designed or calculated to lead purchasers to believe that they are plaintiffs' goods. The law of passing off prevents commercial dishonesty representing one's goods as the goods of somebody else. It is well settled law that an action for passing is a common law remedy being an action in substance of deceit under the law of Tort. In Warnik v. Townend & Sons (HULL) Ltd. 1979 AC 731 Lord Diplock identified the following five characteristics which must be represented in order to create a valid cause of action for passing off:

- A misrepresentation.
- Made by a trader in course of trade,
- To prospective customers of his or ultimate customers of goods or services supplied by him,
- Which is calculated to injure the business or goodwill of another trader (in the sense that there is a reasonable forceably consequence) and
- Which causes actual damage to a business or goodwill of the trader by whom the action is brought or (in quia timet action) will probably do so.

51. In the case of Laxmikant V. Patel v. Chetanbhai Shah MANU/SC/0763/2001 : AIR2002SC275 it was held as under:

A person may sell his goods or deliver his services such as in case of a profession under a trading name or style. With the lapse of time such business or services associated with a person acquire a reputation or goodwill which becomes a property which is protected by courts. A competitor initiating sale of goods or services in the same name or by imitating that name results in injury to the business of one who has the property in that name. The law does not permit any one to carry on his business in such a way as would persuade the customers or clients in believing that the goods or services belonging to someone else are his or are associated therewith. It does not matter whether the latter person does so fraudulently or otherwise. The reasons are two. Firstly, honesty and fair play are, and ought to be, the basic policies in the world of business. Secondly, when a person adopts or intends to adopts a name in connection with his business or services which already belongs to someone else it results in confusion and has propensity of diverting the customers and clients of someone else to himself and thereby resulting in injury.

52. In Salmond & Heuston In Law of Torts (Twentieth Edition, at P. 395) this form of injury is called as 'injurious falsehood' and observed the same having been 'awkwardly termed' as 'passing off' and state:

The legal and economic basis of this tort is to provide protection for the right of property which exists not in a particular name, mark or style but in an established business, commercial or professional reputation or goodwill. So to sell merchandise or carry on business under such a name, mark, description, or otherwise in such a manner as to mislead the public into believing that the merchandise of business is that of another person is a wrong actionable at the suit of that other person. This form of injury is commonly, though awkwardly, termed that of passing off one's goods or business as the goods or business of another and is that most important example of the wrong of injurious falsehood. The gist of the conception of passing off is that the goods are in effect telling a falsehood about themselves, are saying something about themselves which is calculated to mislead. The law on the this matter is designed to protect traders against that form of unfair competition which consists in acquiring for oneself, by means of false or misleading devices, the benefit of the reputation already achieved by rival traders.

53. In Allianz Aktiengesellschaft Holding's case relied upon by the defendant, the business activities of the parties were totally different nor the plaintiffs had obtained registration in India. This was one of the main factor

manupatra for not granting injunction and the court held that there is no confusion and deception. It was the case of rectification of the registered trademark where the main contention of the respondent was that the two sets of goods are totally different, the Division Bench of this Court has confirmed the registration of the respondent on the basis of special circumstances.

54. Vijay Kumar Ahuja's case (supra) also does not help the case of the defendant as in this case it is held by the court that the two names adopted by the plaintiff are common language words and have not acquired secondary significance and the injunction was obtained by suppression of facts. The decision in Hindustan Pencils Ltd's case (supra) is entirely on different facts. In fact, it was a case of removal of the trade mark and the court has given the benefit of user under special circumstances. The defendant on the date of decision of the appeal was the registered proprietor of the trade mark which was being used on the date of decision of the appeal for more than 26 years. In view of above, the decisions referred by the defendant has no direct application in the facts and circumstances of the present case. Learned senior Counsel for the defendant has argued that registrations obtained by the plaintiffs contain various contradictory statements about the user of the mark, therefore, in view of the statements made by the plaintiffs in the Trade Marks Office, the user from the year 1994 should not be considered. Since the plaintiffs have filed their evidence, which clearly indicates that the name of the plaintiffs is being used from the year 1994, no one can deny the said advertisement published in the well known newspaper like Hindustan Times, New Delhi Edition dated 15.09.1994, which is available at Page-132 of the documents filed by the plaintiffs. Similar advertisements have been published from time to time under the name G.D. Goenka Public School and their activities from time to time.

55. In the case of Ric Products Corporation's case (supra), the injunction was not granted in the case of passing off because of the reason that the court felt that the two names Rich's with topping and Bells with topping are totally different. As the distinctive features are Rich's and the word Bells, they are totally different and rest of the portions were totally descriptive. In the case of Johnson & Johnson and Anr. (supra) the injunction was refused on the reason that the defendant main trade mark was COMFITALWAYS and the word STAYFREE was used by the defendant in order to describe their goods. In Britannia Industries Ltd.'s case the injunction has been refused on the reason that the plaintiff has been using the sub brands Good Day, Little Hearts, 50-50, Tiger and the word Greetings as a range of biscuits and in a festival pack. The main trademark was Britannia and the court held that the plaintiff is not able to prima facie establish its claim that the sub brand 'Greeting' has acquired the secondary meaning, therefore, the injunction was not granted by the court.

56. Learned Counsel for the plaintiffs on the other hand has argued that there is no dispute that the defendant might have formed the Trust for educational purposes but the fact remains, which is admitted by the defendant, that they have commenced using the name Mohini Devi Goenka Mahila Mahavidayala in the year 1995 which is subsequent to the use of the name by the plaintiffs. Learned Counsel for the plaintiffs has referred to the decision of the Division Bench of this Court in the case of Century Traders v. Roshan Lal Dagar MANU/DE/0153/1977 : AIR1978Delhi250 .

57. The general principle of passing off has been discussed in the case of Lakshmi V. Patel v. Chetan Bhai 2002 (24) PTC 1 which stated as follows:

Para 8. It is common in the trade and business for a trader or a businessman to adopt a name and/or mark under which he would carry on his trade or business. According to Kerly (Law of Trade Marks and Trade Names/Twelfth Edition/para 16.49) the name under which a business trades will almost always be a trade mark (or if the business provides services/a service mark/ or both). Independently of questions of trade or service mark, however, the name of a business (a trading business or any other) will normally have attached to it a goodwill that the courts will protect. An action for passing-off will then lie wherever the defendant company's name, or its intended name, is calculated to deceive, and so to divert business from the plaintiff, or to occasion confusion between the two businesses. If this is not made out there is no case. The ground is not to be limited to the date of the proceedings; the court will have regard to the way in which the business may be carried on in the future, and to its not being carried on precisely as carried on at the date of the proceedings. Where there is probability of confusion in business, an injunction will be granted even though the defendants adopted the name innocently.

58. During the course of the arguments, learned Counsel for the defendant has confirmed that no clear evidence has been placed by the plaintiffs on record in order to show that the plaintiffs have the knowledge about the use of the said names by the defendant. However, the fact of the matter is that the said names i.e. Goenka Public School and Goenka College of Pharmacy and other names have been used since very long and there are advertisements in the local newspapers and other evidence by way of prospectus, brochures as well as domain name used by the defendant. In view of the said evidence and documents placed on record, one can easily draw the inference that the plaintiffs are supposed to have the knowledge of the names of the defendant. Under these circumstances, it appears that the use of the name Goenka Public School and Goenka College of Pharmacy would lead to passing off the services as that of the plaintiffs.

Common to the trade/third party use

59. The next contention of the learned Counsel for the defendant is that the word Goenka is common to the trade and no monopoly can be given to any person being a very common surname. It has also been alleged that there are various Schools and Colleges in India who are using their name in which the mark Goenka forms part of it. The defendant has given the details of various such Schools and Colleges in the application

manupatra under Order 39 Rule 4 as well as in the written submissions. It is alleged that since there are various parties who are using the said name and even one of the party has used the said name prior to the plaintiffs, therefore, the injunction under these circumstances is liable to be vacated.

60. In the case of Corn Products refining Co. v. Shangrila Food Products Ltd. MANU/SC/0115/1959 : [1960]1SCR968 it was held as under :

12. ...Where there are a "series" of marks, registered or unregistered, having a common feature or a common syllable, if the marks in the series are owned by different persons, this tends to assist the applicant for mark containing the common feature. This statement of the law in Kerly's book is based on *In re: an application by Beck, Kollar and Co. (England) Limited* 64 R.P.C. 76. It is clear however from that case, as we shall presently show, that before the applicant can seek to derive assistance for the success of his application from the presence of a number of marks having one or more common features which occur in his mark also, he has to prove that those marks had acquired a reputation by user in the market.

61. In the case of Coolways India v. Princo Air Conditioning and Refrigeration (1) PTC Supp 470 it was held as under:

...What has to be seen is whether the plaintiff has acquired a reputation, goodwill in a mark which he is using in trading his goods uninterruptedly for quite some time and somebody else is attempting to pass off his goods under that mark. The contention that a plaintiff himself using usurping or infringing a third party's registered trade mark is debarred from claiming the relief of injunction, in my view, is a meritless plea. This a matter between the plaintiff and the party in whose favour trade mark is registered. Only he can object to it. It is not for a third person to take up issue for him and claim protection on that score. It is not disputed by the defendant that no action for infringement of trade mark has been initiated against the plaintiff by any of the parties, in whose name the said trade mark is claimed as registered. There is no reason why a person, competing in trade, is allowed to make use the reputation and goodwill of another person by attaching to his product a name or description with which he has no natural association....

62. In the case of P.M. Diesels Ltd. v. S.M. Diesels 1993 PTC 75, it was held as under:

Next contention raised by learned Counsel for the defendant is that the word Marshal has become common to the trade of diesel engines in Rajkot and various other persons are using the trade mark in one form or other as inasmuch as some are using Airmarshal, Perfect Marshal, Powermarshal etc. and the defendant is not the only person who is using the trade mark Sonamarshal only. The plaintiff, Therefore, cannot claim its trade mark to be distinctive of its goods or business and no customer is likely to be confused or deceived on account of this trade mark. This contention of the learned Counsel for the defendant is also without force. In this connection it is sufficient to say that under the law it is the right of two parties before the court which has to be determined and the court has not to examine the right of other parties. If some other manufacturers are using or suffixing the word Marshal on their diesel engines, it is of no consequence. Furthermore, if the plaintiff has not taken any action against several other infringements, this does not mean that the plaintiff has abandoned its trade mark and cannot challenge the action of the defendant.

63. The plaintiffs place reliance on the following cases to support his contention that the third party use is not a defence:

Essel Packaging Ltd. Sridhar Narra and Anr. 2002 (25) PTC 233 (Del) Para 22. Merely because some other parties or persons are using the name ESSEL does not provide a justification to the defendants for using the said name as the plaintiff has been using this name much prior to the adoption of this name by the defendants and its widespread use of this name shows that this word has become synonymous with the business of the plaintiff and its group companies.

Info Edge (India) Pvt. Ltd. and Anr. v. Shailesh Gupta and Anr. 2002 (24) PTC 355 (Del). Para 26

Indian Shaving Products Ltd. and Anr. v. Gift Pack and Anr. 1998 PTC (18)

64. In the case of Pankaj Goel v. Dabur India Ltd. MANU/DE/2271/2008 : 2008 (38) PTC 49 (Del) the Division Bench of this Court has recently held as under in para 21 and 22:

22. As far as the Appellant's argument that the word MOLA is common to the trade and that variants of MOLA are available in the market, we find that the appellant has not been able to prima facie prove that the said 'infringers' had significant business turnover or they posed a threat to plaintiff's distinctiveness. In fact, we are of the view that the respondent/plaintiff is not expected to sue all small type infringers who may not be affecting respondent/plaintiff's business. The

Supreme Court in National Bell v. Metal Goods AIR 1971 SC 898 has held that a proprietor of a trademark need not take action against infringement which do not cause prejudice to its distinctiveness. In Express Bottlers Services Pvt. Ltd. v. Pepsi Inc. and Ors. 1989 (7) PTC 14 it has been held as under:

...To establish the plea of common use, the use by other persons should be shown to be substantial. In the present case, there is no evidence regarding the extent of the trade carried on by the alleged infringers or their respective position in the trade. If the proprietor of the mark is expected to pursue each and every insignificant infringer to save his mark, the business will come to a standstill. Because there may be occasion when the malicious persons, just to harass the proprietor may use his mark by way of pinpricks.... The mere use of the name is irrelevant because a registered proprietor is not expected to go on filing suits or proceedings against infringers who are of no consequence.... Mere delay in taking action against the infringers is not sufficient to hold that the registered proprietor has lost the mark intentionally unless it is positively proved that delay was due to intentional abandonment of the right over the registered mark. This court is inclined to accept the submissions of the respondent No. 1 on this point... The respondent No. 1 did not lose its mark by not proceeding against insignificant infringers....

65. As a settled principle of law, unauthorized or unconsented use by other party is no defense.

Delay

66. Lastly the learned Counsel for the defendant has argued that there is a delay on the part of the plaintiffs in bringing the action before this Court. In the case of Midas Hygiene Industries Pvt. Ltd. v. Sudhir Bhatia and Ors. 2004 28 PTC 121 relevant paras 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.

67. In the case of Swarn Singh v. Usha Industries (India) and Anr. MANU/DE/0366/1985 : AIR1986Delhi343 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 a ground 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....

68. In the case of Hindustan Pencils Pvt. Ltd. v. India Stationery Products Co. MANU/DE/0383/1989 : AIR1990Delhi19 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.

69. In the case of Bengal Waterproof Lim. v. Bombay Waterproof Manufacturing Co. MANU/SC/0327/1997: AIR1997SC1398 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.

70. The Defendant in para 9 at page 7 of I.A. 307/2009, has named a few institutions which are using the word 'Goenka' in their name. A perusal of the same list itself establishes that all these institutions are using their own/full name as the name of their institutes. Apart from one M/s Goenka College of Commerce whose present actual status could not be traced till date by the plaintiffs there is no other institute on record showing use of the mark/word 'Goenka' per se, prior to that of the plaintiffs or even otherwise.

71. In the case of Syncom Formulations v. SAS Pharmaceuticals MANU/DE/0406/2004 : 111(2004)DLT616 , it was held as under : .Frankly, I do not see the need to multiply citations and authorities on this subject. Suffice it to say that the accepted position in law is that delay or laches in approaching a Court for an injunction in a case of passing off is not fatal – at best, the plaintiff may not be entitled to a relief of damages or rendition of accounts, but he may still be entitled to the grant of an injunction, even in a case of an honest concurrent user. A defence of estoppel by acquiescence is to be distinguished from a defence that by delay the mark has become publici juris. (Kerly's Law of Trade Marks and Trade Names', thirteenth edition, page 391 paragraph 13.157). One of the factors that may tilt the scales in favour of a grant of a temporary injunction in such cases would be, as pointed out by McCarthy in 'Trade-marks and Unfair Competition', the protection required to be given to the general public who have a right not to be deceived or confused. This is only a factor to be considered by a Court and is not an absolute proposition; otherwise, in cases of acquiescence, it may be interpreted to mean that the contesting parties have acquiesced in deceiving or confusing the general public, which obviously cannot be accepted. Consequently, the contention of learned Counsel for the Appellant based on delay is rejected.

72. The delay, if any, for the name used by the defendant of Goenka Public School, Goenka College of Pharmacy is between 4 to 5 years although the plaintiffs have alleged that there was no knowledge of the plaintiffs about the use of the said names and the plaintiffs for the first time came to know about the said names from the advertisement in the newspaper Hindustan Times dated 11th November 2008. The learned Counsel for the defendant has not denied that no cogent evidence has been placed by the defendant in order to establish that the plaintiffs were having knowledge about the activities of the defendant from the very beginning. However, the learned Counsel for the defendant has submitted that inference can be drawn about the use of the said names since the plaintiffs are also in the same activities. The plaintiffs must be aware about the same. Learned Counsel for the plaintiffs during the course of arguments has argued that even in case of user of the defendant of the names Goenka Public School and Goenka Girls College for the last about 4 to 5 years, it is not fatal to this case as the present suit is also for infringement of trade mark wherein the delay is immaterial. Learned Counsel for the plaintiffs have also argued that since the activities of both the plaintiffs and defendant have to be extended in future, therefore, in case the injunction is not granted particularly against the Goenka Public School and Goenka College of Pharmacy, there would be total confusion and deception amongst the public at large.

73. As regard the other names used by the defendant i.e. Mohii Devi Goenka Mahila Vidayala, Mohini Devi Goenka Girls Mahavidyala and Goenka Shiksha Avam Shodh Sansthan are concerned, it is an undisputed fact that the said names are being used from 1995, 1997 and 2000 respectively and admittedly there is a long delay on the part of the plaintiffs to bring the action against the said names, therefore, the defendant is entitled to use the same. The other reason for allowing the use of the said name is that being use of full names, it would not create any deception.

Balance of convenience

74. Learned Counsel for the defendant has also contended that since the defendant has been extensively using the name for very long, the balance of convenience does not lie in favour of the plaintiffs and, therefore, the damages are the appropriate remedy if ultimately the plaintiffs succeed and the plaintiffs can be sufficiently compensated if the defendant is permitted to use the same.

75. On the other hand, the learned Counsel for the plaintiffs urged on the point of balance of convenience that:

The plaintiffs' sole intention is to protect their rights in respect of their registered trademark 'Goenka/G.D. Goenka'. The balance of convenience in the present case lies in favour of the plaintiffs. Further, the class of customer here is a school/college going student, who in every possibility can confuse the Defendant's Institute/School to be associated with the plaintiffs. In such a situation, where the very future of naive and innocent students is at stake, no relief is liable to be granted to the Defendant. It is pertinent to state herein that on 11.11.2008 an ad was taken out by the Defendant in a national daily, wherein the plaintiffs' advertisement was published on the same page.

In Sun Pharmaceuticals v. Cipla Ltd. IA No. 6872/2008 in CS (OS) No. 1073/2008 decided on 3.10.2008 a recent judgment of Delhi High Court, the Ld. Single was of the view that "if a registered proprietor is entitled to maintain an action for injunction and found entitled to injunction, the injunction ought not to be denied for the reason of the alternate relief of directing accounts to be kept.

76. a) As observed in Para 73 of my judgment, in order to maintain the balance between the parties and

manupatra considering the overall situation of this matter, I am of the considered view that the defendant is entitled to use the names Mohini Devi Goenka Mahila Mahavidyala, Mohini Devi Goenka Girls B.Ed College, Mohini Devi Goenka Girls Mahavidayala and Goenka Shiksha Avam Sodh Sansthan.

b) Regarding Goenka Girls School there is no evidence or pleading by the defendant about the use of the said name except that the said name is shown in the defendant's website, therefore, the ex parte ad interim injunction would continue against the use of the said name during the pendency of the suit.

c) The ex parte ad interim injunction shall also continue against the defendant for use of the name Goenka Public School and Goenka College of Pharmacy as it leads to infringement of the registered trade mark of the plaintiffs and passing of their goods as that of the plaintiffs. However, the defendant is permitted to use both the names in relation to their services in case the defendant shall use the full name Mohini Devi Goenka Public School/Mohini Devi Goenka College of Pharmacy.

d) The defendant is granted four months time to discontinue the use of the name Goenka Public School and Goenka College of Pharmacy and the ex parte ad interim order would continue against the defendant after the expiry of the said period.

77. The applications are disposed of in the above terms. Any expression of opinion made in the above said order is prima facie and will not affect the merits of the case of the parties.

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