

The British School Society vs Sanjay Gandhi Educational Society & Anr on 12 October, 2021

Author: Jayant Nath

Bench: Jayant Nath

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* IN THE HIGH COURT OF DELHI AT NEW DELHI

+ CS(COMM) 509/2021

THE BRITISH SCHOOL SOCIETY Plaintiff

Through Mr.Sandeep Sethi, Sr. Adv. with
Mr.Peeyoosh Kalra, Mr.C.A. Brijesh, Mr.Dhruv
Grover, Ms.Ishita Aora and Mr.Gavnil Singh,
Advs.

versus

SANJAY GANDHI EDUCATIONAL
SOCIETY & ANR.

..... Defendants

Through

CORAM:

HON'BLE MR. JUSTICE JAYANT NATH
ORDER

% 12.10.2021 IA Nos. 13427-29/2021 (exemption) Allowed subject to all just exceptions.

IA No. 13430/2021 For the reasons stated in the application, the same is allowed. CS(COMM) 509/2021 Let the plaint be registered as a suit.

Issue summons to the defendants through speed post and email, returnable for 15.12.2021.

IA No. 13426/2021

1. Issue notice to the defendants through speed post, courier and email, returnable for 15.12.2021.

2. This application is filed under Order 39 Rules 1 & 2 CPC seeking an ad interim injunction in favour of the plaintiff and against the defendants restraining the defendants by themselves, their servants, partners and agents from using or attempting to use or asserting any right to use or importing or exporting or applying to register or to maintain the applications or to register any of the trademarks similar to the plaintiff's trade mark THE BRITISH SCHOOL/TBS/ / or in any other manner whatsoever infringing and passing off the plaintiff's registered and well- known trade mark or in violation of any other rights in any other registered trademark of the plaintiff.

3. It is the case of the plaintiff that in 1963, a group of British parents, supported by the British High Commissioner to India, started the plaintiff School. In 1969, the School moved to the current location in Chanakya Puri, New Delhi. The school was started with the aim of serving the diplomatic

and expatriate community, the plaintiff operates under the aegis of 'The British School Society' with the British High Commissioner to India as its President. It offers the National Curriculum of England adapted to an international context, the EYFS Programme, the IGCSE and the IB Diploma Programme. With over 1200 students from 65 nationalities, plaintiff provides student-centred education. It is stated that the plaintiff has a 8:1 Student Teacher Ratio.

4. The plaintiff is the registered proprietor of a host of trade/service marks consisting of and/or containing THE BRITISH SCHOOL/ / . The details of registration are as follows:-

MARK Reg. Date Class Status Conditions No. 2518104 April 16, Registered
Registration of 23, 35, this trade mark 2013 41 shall give no right to the exclusive use
of the words The British School, New Delhi except substantially as shown in the
representation on the form of application.

THE BRITISH SCHOOL	2518105	April 23, 2013	35	Registered	Registration of this trade mark shall give no right to the exclusive use of The British
	2518106	April 23,	16, 41	Registered	N.A.

THE BRITISH SCHOOL	2518107	April 23, 2013	16, 41	Registered	Registration of this trade mark shall give no right to the exclusive use of The British SCHOOL.
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THE BRITISH SCHOOL	5050319	July 19, 2021	16, 25, 35	Pending	N.A.
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and

TBS	5050320	July 19, 2021	16, 25, 35	Pending	N.A.
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and

THRIVE BELIEVE SUCCEED	5050321	July 19, 2021	16, 25, 35	Pending	N.A.
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and

5. It is the case of the plaintiff that on 19.06.2020, the plaintiff came across the defendants' unauthorised use of the mark 'THE BRITISH SCHOOL'. The plaintiff addressed a 'cease and desist' notice to the defendants. It is stated that on 11.09.2020, the plaintiff also filed an opposition application to the defendants' application for registration of their mark. The said proceedings are said to be pending.

6. It is the case of the plaintiff that the use of the plaintiff's name 'THE BRITISH SCHOOL' by the defendants is inexplicable and leads to deception or confusion in the minds of the consumers and members of the trade. It is stated that the plaintiff's trade mark being a registered mark and having priority in adoption, long and continuous usage and extensive popularity, reputation and goodwill, the use of the said trade mark by the defendants would cause deception and confusion.

7. Reference is also placed on the judgement of a Co-ordinate Bench of this court in Ritnand Balved Education Foundation vs. Ranchhod M.Shah & Ors., (2018) 76 PTC 439. In the said matter the Co-ordinate Bench held as follows:-

"25. It is a settled position under Trademark law that this area of law is meant to protect not just the rights of the owners, but also to avoid any confusion from being caused amongst the members of the public. There is no doubt that AMITY INTERNATIONAL SCHOOL of the Plaintiff is well known, and there are several branches of the said school. The use of an identical name by the Defendants would not merely confuse the students and parents but also those persons who wish to collaborate with the Defendants. There would be no way of knowing as to whether the AMITY INTERNATIONAL SCHOOL of the Defendants is the same as that of the Plaintiff or not. The area of operation i.e. education is one such area in which any chance of confusion should be completely avoided. This is because schools, universities and colleges have very expansive activities and operations. Students studying in educational institutions participate in events, competitions, cultural festivals, and sports meets across the country. The use of identical names for two schools, completely disconnected from each other, would result in enormous confusion and could also result in having a damaging effect on careers of children. The chances of mistaken identities are very high and especially in the educational field, such confusion ought to be avoided."

8. My attention has been drawn to an earlier order passed in CS(COMM) 408/2021 titled as "The British School Society vs. The British International School" on 03.09.2021 whereby this court passed the following order:-

"9. Keeping in view the user of the plaintiff of the mark since 1963 and the reputation of the plaintiff, plaintiff has made out a prima facie case. The defendant is restrained by an ex parte injunction from using or asserting any right on the trademark 'THE BRITISH INTERNATIONAL SCHOOL' or any other trademark similar to the plaintiff's trademark THE BRITISH SCHOOL/ .

The defendant will take steps within three months from the date of receipt of the injunction order."

9. The plaintiff has made out a prima facie case. The defendants are restrained by an ex parte injunction from using the plaintiff's trade mark THE BRITISH SCHOOL/TBS/ / or any other mark similar to the plaintiff's trademark in any manner whatsoever infringing and passing off the plaintiff's registered and well-known trade mark or in violation of any other rights in any other registered trademark of the plaintiff till further orders.

10. The plaintiff to comply with Order 39 Rule 3 CPC within 5 days from today.

JAYANT NATH, J OCTOBER 12, 2021 rb