

Delhi Public School Society vs Delhi Public International School & Ors on 17 August, 2021

Author: Sanjeev Narula

Bench: Sanjeev Narula

\$~9

* IN THE HIGH COURT OF DELHI AT NEW DELHI
+ CS(COMM) 322/2021, I.A. 8153-56/2021.
DELHI PUBLIC SCHOOL SOCIETY Plaintiff
Through: Mr. Puneet Mittal, Senior Advocate
with Mr. Rupendra Pratap Singh and
Ms. Vasudha Bajaj, Advocates.
versus
DELHI PUBLIC INTERNATIONAL SCHOOL & ORS.
..... Defendants
Through: Mr. Rajat Malhotra and Mr. Vivek
Kumar, Advocates for D-1 & D-5.
Mr. Rupin Bahl and Mr. Karan Bajaj,
Advocates for D-3 & D-4.

CORAM:
HON'BLE MR. JUSTICE SANJEEV NARULA
ORDER

% 17.08.2021
[VIA VIDEO CONFERENCING]

I.A. 8152/2021 (u/S 135(2) of the Trade Marks Act, 1999 r/w Order 39 Rules 1 & 2 and Section 151 of the Code of Civil Procedure)

1. The Plaintiff- Delhi Public School Society has filed the accompanying suit inter-alia for infringement of copyright and registered trademark -

'Delhi Public School' and 'DPS' and crest logo [].

2. Counsel for the Defendants have entered appearance. They say that they have recently been served a copy of the plaint and would like to file a reply to the instant application. However, Mr. Puneet Mittal, learned Senior Counsel for the Plaintiff, presses for an injunction. Mr. Mittal submits that admissions in the Defendant School are in progress and therefore, if Defendants are not restrained by way of an injunction, parents and students are likely to be misled and deceived, causing irreparable injury to the Plaintiff.

3. The case as set out in the plaint is that the Plaintiff-Society is registered under the Societies Registration Act, 1860, with an object to establish progressive schools or other educational institutions in Delhi or outside Delhi. In the year 1948, it adopted a distinctive crest device-

[], which comprises of a hand holding a torch (mashaal) along with school motto 'Service Before Self' and words 'Delhi Public School' written inside a shield device with other distinctive artistic features comprised therein.

4. In the year 1996-97, Plaintiff-Society conceived and adopted another crest logo [] comprising of a torch (mashaal) on a book along with the school motto 'Service Before Self' written inside a shield device surrounded by creepers and the words 'Delhi Public School' written at the bottom with other distinctive artistic features comprised therein. It is claimed that both the above-said crests are original artistic works, and the Plaintiff is the first owner of the same under the provisions of the Copyright Act, 1957. The Plaintiff has established its schools at various places in India. Schools established by the Plaintiff-Society itself are described as "Core Schools" which are 12 in number. Plaintiff-Society has entered into agreements with other societies/ trusts for establishing schools at various places known as "Affiliated Schools" that are more than 200 in number. A list of "Core Schools" of the Plaintiff-Society is provided in para 6 of the plaint. On account of continuous, extensive, voluminous, and open use of the trade marks/ names- 'Delhi Public School', its acronym- 'DPS' and the crest/ logo [] since 1948 and the crest/ logo [] since 1996-97, the aforesaid trade marks have been perceived by students, parents and academicians, throughout the country as an indication of source of the Plaintiff-Society and they have become un-paralleled benchmarks of academic excellence, goodwill and reputation enjoyed by the Plaintiff.

5. The details of trade marks, registered in favour of the Plaintiff-Society are mentioned in para 8 of the plaint and the same are reproduced as under: -

S. No.	Trade Mark	Application	Class	User	Date of Application	Status
1		1608946	16	1.12.1948	08.10.2007	Registered
2		1608947	35	1.12.1948	08.10.2007	Registered
3		1608948	36	1.12.1948	08.10.2007	Registered
4		1608949	41	1.12.1948	08.10.2007	Registered
5		1608950	42	1.12.1948	08.10.2007	Registered
6	DPS	1608951	16	1.12.1948	08.10.2007	Registered
7	DPS	1608952	35	1.12.1948	08.10.2007	Registered
8	DPS	1608954	42	1.12.1948	08.10.2007	Registered

9	DPS	1608955	36	1.12.1948	08.10.2007	Registered
10	DPS	1608953	41	1.12.1948	08.10.2007	Pending
11	DELHI PUBLIC SCHOOL	211505	16	1.12.1948	08.03.2011	Pending
12	DELHI PUBLIC SCHOOL	2111506	36	1.12.1948	08.03.2011	Pending
13	DELHI PUBLIC SCHOOL	2111507	35	1.12.1948	08.03.2011	Pending
14	DELHI PUBLIC SCHOOL	2111508	41	1.12.1948	08.03.2011	Pending
15	DELHI PUBLIC SCHOOL	2111509	42	1.12.1948	08.03.2011	Registered

6. Before going into the controversy in the present suit, it would be essential to note few facts relating to another suit, which is the fountainhead of the infringement complained of in the present suit. The Plaintiff-Society had earlier filed a civil suit being- CS(COMM) 404/2016 titled- "Delhi Public School Society v. Delhi Public School Manesar & Ors.". In the said suit, this Court vide order dated 25th April, 2016 granted ex parte ad interim injunction in favour of the Plaintiff restraining the Defendants therein from dealing in any manner with the trade marks/ names 'Delhi Public School'/ 'DPS' and the crest logo of the Plaintiff-Society. One of the Defendants in the said suit was Mr. Deepak Kumar Pal. The suit ultimately was decreed in favour of the Plaintiff-Society vide judgment dated 29th November, 2016 to the following effect: -

"This suit coming on this day for final disposal before this Court in the presence of counsel for the parties while defendant Nos.2, 8, 11 and 16 were proceeded ex parte vide order dated 29.11.2016 as aforesaid; it is ordered that a decree of permanent injunction be and the same is hereby passed in favour of the plaintiff and against the defendant Nos. 1 to 9, 11, 12, 14, 15 & 16 restraining the defendants, their directors, trustees, managing committee members, office bearers, franchisees, officers, servants, agents, employees, delegates, representatives, assigns, associates and all others acting for and on their behalf from:-

a) offering for service, advertising, offering for sale, adopting, using and/or dealing in any manner with the well known trade marks/ name 'DPS' and logo of the plaintiff or any other trade mark identical or deceptively similar to the plaintiff's above mentioned trade marks amounting to infringement of the plaintiff's said trade marks and further restraining them from representing in any manner that they are connected with the plaintiff;

b) using the impugned trade mark/ name 'DPS', 'DELHI PUBLIC SCHOOL' and ;

c) directly or indirectly reproducing, using and/or dealing in any manner with the plaintiff's registered crest , or any other crest identical or deceptively similar to it amounting to infringement of the plaintiff's copyright in the said crest.

It is further ordered that the defendant Nos.3 to 5 are permitted to use the old name and the old certificates impugning which this suit was filed only for the purposes of enabling the students in Classes Xth and XIIth of the 2016-17 academic session to take the examination of any education board and not for any other purpose."

"...It is further ordered that the undertakings of the defendant Nos. 1, 4, 15, 6, 7, 9, 12, 14 and 15 are accepted and the said defendants are bound therewith (copy of order dated 29.11.2016 enclosed)."

7. Mr. Mittal contends that Plaintiff-Society in collaboration with another society is running two Delhi Public School/ DPS Schools in Nagpur. On 22nd May, 2021, Plaintiff-Society received information that Defendant No. 1- Delhi Public International School is running a school under the name and style- 'Delhi Public International School' and 'DPIS' using the logo []. The marks adopted by Defendant No. 1 are deceptively similar to Plaintiff's well-known registered trade marks. Mr. Mittal further avers that Defendant No. 1 is intentionally deceiving and misleading the parents, unwary students and public at large by making a false claim that it operates under the aegis of the Plaintiff-Society. He specifically draws the attention of this Court to the transcript of a conversation, which has been filed along with an affidavit under Section 65B of the Indian Evidence Act, 1872. This transcript is of a conversation with a representative of Defendant No. 1 who states that- "Initially, DPIS was under the DPS Society but now they have separated and there are over 200 branches of DPIS all over India." That the curriculum "is as per the DPS Society and we strictly follow all the protocols by the society. Banners are also approved by them. Teachers are trained in Delhi under the society. Even the uniform is as per the society.". "There are three branches of DPS in Nagpur. This is the first branch of DPIS in Nagpur."

8. Additionally, Mr. Mittal argues that in response to the cease-and-desist notice issued by the Plaintiff, the Defendant No. 1 replied on 15th June, 2021 to contend that 'Delhi Public International School' is a group of schools under the control and the administration of DPIS Society, New Delhi, a society registered under the Societies Registration Act, 1860 and Public Trust Act. It was further asserted in the reply that, right to use the trade marks 'Delhi Public International School' as well as 'Delhi Public Secondary Schools' has been granted by Mr. Deepak Kumar Pal, Madhubani Bihar-847211 who is registered proprietor of the said marks under trade mark Nos. 3469037 and 3469040 respectively, under Class 41 dated 30th January, 2017. Defendant No. 1 also claims to be a "permitted user" of a legally enforceable trademark granted under the Trade Marks Act, 1999.

9. Mr. Mittal contends that the aforesaid contention is ex facie untenable. Mr. Pal has already suffered a decree, pursuant to a judgment of this Court dated 29th November, 2016, relevant part of which has been quoted above. In terms thereof, Mr. Pal cannot use any mark which is deceptively similar to the Plaintiff's trade mark. The Plaintiff-Society has already initiated action against the registrations obtained by Mr. Pal. Besides an execution petition has also been filed seeking to

enforce the decree against him. Notwithstanding such action, he submits that since admittedly, the Plaintiff-Society is a prior user and has a decree in its favour, the Defendants could not have adopted the impugned marks, even if they have received permission from Mr. Pal.

10. Mr. Rajat Malhotra initially stated that he would be appearing on behalf of Defendant No. 5. However, later he added that his appearance be also recorded on behalf of Defendant No. 1-School, though he submits it is not a separate legal entity. Further he submits that the Defendant No. 5 has his own independent right to use the trade mark - 'Delhi Public International School'. An application seeking registration of the said impugned mark is pending consideration before the Trademark registry. He submits that when Defendant No. 5 learnt that Mr. Pal had an existing registration in his favour for 'Delhi Public International School', he sought permission to use the same and accordingly, he started using the mark in question as a "permitted user", which is a legally enforceable right. Mr. Malhotra further relies upon the orders passed by the Division Bench of this Court dated 10th April, 2017¹ and of the Single Judge of this Court dated 5th April, 2018² in relation to a dispute between the Plaintiff-Society and an entity by the name of the 'DPS World Foundation'. He argues that in the said case Plaintiff-Society, had agreed to the proposal of the Defendant-School therein for insertion of words between 'Delhi' and 'Public' or between 'Public' and 'School' and not sequentially. He further argues that combination of words as was used by the Defendants in the said case i.e., 'Delhi Public World School', and the acronym- 'DPWS', was not found to be deceptively similar to the Plaintiff's registered trade mark. The same test should be applied to the present Defendants. He also submits that impugned logo therein was much closer to the Plaintiff's logo in comparison to the present Defendant's logo, and yet the same was not found to be deceptively similar. Further, Mr. Malhotra as well as Mr. Rupin Bahl, learned counsel for Defendant Nos. 3 and 4 relying upon *Ultra Home Construction Pvt. Ltd. v. Purushottam Kuman Chaubey*³ also raise an objection that this Court lacks territorial jurisdiction. Lastly, In FAO (OS) (COMM) 21/2016 titled "DPS World Foundation & Anr. v. Delhi Public School Society".

In CS(COMM) 154/2016 titled "Delhi Public School Society v. DPS World Foundation & Anr.".

Mr. Malhotra contends that since Mr. Deepak Kumar Pal has not been arrayed as a party to the present suit, no injunction order can be passed.

11. The Court has considered the contentions of the parties. As of now, the written statements and replies of the Defendants are not on record. The question of jurisdiction and other aspects urged during the course of arguments would be examined at a later point of time when the pleadings are complete. However, it is evident that Defendants do not have any registration of the impugned marks. Defendant No 1 is nevertheless claiming right over the mark as a "permitted user" through Mr. Deepak Kumar Pal. As noted above, Mr. Pal has already been permanently enjoined by virtue of the decree against him. Prima facie, adoption and registration of the impugned marks by Mr. Pal does not appear to be bona fide and instead appears to be in violation of the decree passed against him. Be that as it may, the Plaintiff-Society has already taken steps for enforcement of the said decree against the said Defendants. The said execution is, however, against parties to the said decree. In the present suit, the Plaintiff-Society is seeking injunction against the purported "permitted users" who claim their right through Mr. Pal.

12. The Court thus finds a prima facie case in favour of the Plaintiff. They are a prior adopter, user and owner since 1948, and the prior registered proprietor of well-known trademarks 'Delhi Public School' and 'DPS'. The use of the impugned mark- 'Delhi Public International School'/ 'DPIS' and the impugned logo, is deceptively similar to the mark of the Plaintiff-Society FAO (OS) 494/2015 decided on 11th January, 2016.

and is in breach/ violation of the decree passed by this Court against Mr. Pal. The adoption of the impugned marks is thus prima facie invalid. Besides, considering that parties are in the field of education, deliberate adoption by the Defendants of impugned trade marks and logo that are deceptively similar and/or identical to the Plaintiff's registered trade marks/names and logos can cause confusion in the minds of the parents, prospective students and staff desirous of securing admission or availing services, seeing the advertisements, promotional material, admission forms, boards/ hoardings, etc. They are bound to be misled into availing the services of the Defendant-School, under the belief that they are those of the Plaintiff-Society. Mr. Mittal has demonstrated that the Defendant-School has intentionally misrepresented itself to be in association with the Plaintiff-Society due to the prominence of 'Delhi Public School'. Further, the registered trade mark of Plaintiff-Society- 'Delhi Public School'/ 'DPS' and the crest logo can be perceived by general public as indicative of the source of 'Delhi Public School' being the Plaintiff-Society. Therefore, the Court considers it necessary to grant an interim injunction in favour of the Plaintiff-Society.

13. The Defendants reliance upon orders passed in the suit in respect of the use of trade mark 'DPS World Foundation', is misplaced. Defendants have not noticed that, in the said suit, the Supreme Court⁴ subsequently in challenge against the order of the Division Bench of this Court, granted injunction in favour of the Plaintiff-Society, restraining the Defendants therein from using the mark- 'Delhi Public School'/ 'DPS' or the logo. The said order was only clarified later to the extent that the Defendants therein were allowed to use the logo they sought to do so after deleting certain words . The balance of convenience also lies in favour of the Plaintiff-Society and in case the Defendants are not restrained by an ex-parte injunction, it is likely to cause an irreparable loss to the Plaintiff-Society. Accordingly, till the next date of hearing, the Defendants, their trustees, directors, managing committee members, office bearers, employees, delegates, representatives, assigns, associates, agents or anybody acting on their behalf, are restrained from: -

(a) adopting, using and/ or dealing in any manner with the registered trademark of the Plaintiff- 'Delhi Public School' and 'DPS' and logo [.] or any other trademark that is identical or deceptively similar to the Plaintiff's aforementioned trademark amounting to infringement of the Plaintiff's said trade marks;

(b) offering for sale, adopting, using and/or dealing in any manner with the registered trade mark of the Plaintiff- 'Delhi Public School' and 'DPS' and logo [.] of the Plaintiff or any other trade mark identical or deceptively similar to the Plaintiff's trade mark amounting to passing off the Plaintiff's said trademark and further restraining the Defendants from representing in any manner that they Vide Order dated 25th July, 2018 in SLP (Civil) Diary No(s). 17216/2018.

Vide Order dated 29th October, 2018 in M.A. No (s). 2277-2278/2018 in SLP(C) No(s).

are connected with the Plaintiff; and

(c) using or dealing in any manner with the impugned trademark/ names
'Delhi Public International School' and 'DPIS' and logo

[.].

14. Mr. Malhotra and Mr. Bahl seek and are granted one week to file their replies. Rejoinders thereto, if any, be filed within a period of one week thereafter.

15. At this stage, Mr. Malhotra, without prejudice to his rights and contentions, seeks five days to comply with the order.

16. The injunction order is operative from today, the removal of the hoardings, advertisements etc be completed in one week.

17. Re-notify on 9th September, 2021.

SANJEEV NARULA, J AUGUST 17, 2021/ nd 20546-20547/2018.