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Educare Limited and anr Vs. S.K. Sachdev and anr

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Court : Delhi

Decided On : Nov-14-2014

Judge : G. S. Sistani

Appellant : Educare Limited and anr

Respondent : S.K. Sachdev and anr

Advocate for Pet/Ap. : Shri. Ram Schools

Judgement :

$~43. * IN THE HIGH COURT OF DELHI AT NEW DELHI + CS(OS) 1151/2014 % Judgment reserved on 4.9.2014 % Judgment pronounced on 14.11.2014 EDUCARE LIMITED & ANR ..... Plaintiffs Through : Ms.Anuradha Salhotra, Mr.Sumit Wadhwa, Mr.Zeeshan Khan and Mr.Tushar John, Advocates versus S.K. SACHDEV & ANR ..... Defendants Through: Mr.M.K. Miglani, Mr.Aayushmaan Gauba and Mr.Kapil Kumar Giri, Advocates CORAM: HON'BLE MR. JUSTICE G.S.SISTANI G.S.SISTANI, J IA.No.7512/2014 & IA.No.10541/2014 1. This is an application filed by the plaintiffs under Order 39 Rules 1 and 2 of the Code of Civil Procedure. While issuing summons to the defendants this court had restrained the defendants from using the trademark/ trade name, ShreeRam World School and the domain name www.shreeram.in, as it was deceptively and phonetically similar to the plaintiffs trade-mark SHRI RAM / SHRIRAM in relation to its services.

2. IA.No.10541/2014 has been filed by the defendants under Order 39 Rule 4 CPC for vacation of the interim order.

3. Both the applications have been heard together and are being disposed of by a common order.

4. The facts of the case as set out in the plaint are that the plaintiff no.1 is engaged in setting up schools in India and abroad. The plaintiff no.2 is a registered non-profit society engaged in several social and community development initiatives including running schools under the name of the Sri Ram School and is the first adopter and user of the trade-name SHRI RAM in respect of the schools. Defendant no.1 is the Chairman of defendant no.2, which is running a school under the name ShreeRam World School at Dwarka.

5. The plaintiff established the SHRI RAM SCHOOL in the year 1988 in Vasant Vihar, New Delhi in an area of 1.5 acres near the ridge forest. It is the case of the plaintiff that the school has been designed to provide each student a diverse education in a safe and supportive environment that promotes sound values, self-discipline, motivation and excellence in learning. From a modest beginning in five tents with sixty four eager children, the school has grown to a strength in excess of seven hundred children and a hundred and eight staff. THE SHRI RAM SCHOOLMoulsari, Gurgaon is the senior school of THE SHRI RAM SCHOOL, Vasant Vihar. THE SHRI RAM SCHOOL-Aravali, Gurgaon was established in the year 2000 in DLF City Phase IV.

6. In order to fulfil its objective to meet the shortage of good schools in India, the first Plaintiff entered into an agreement with Educomp Infrastructure and School Management (EISML), a subsidiary of Educomp Solutions to set up five schools over the next 2-3 years under the name THE SHRIRAM MILLENIUM SCHOOL which would imbibe the core ideals enshrined in the pedagogical philosophy of second plaintiffs THE SHRI RAM SCHOOLS. The overall guidelines and framework of the curriculum, courses, contents, teaching, methodology, academic policies and pedagogic strategies of these schools were to be the same as the second Plaintiffs schools under the name THE SHRI RAM SCHOOLS.

7. Under the Agreement with EISML, the first Plaintiff opened THE SHRIRAM MILLENIUM SCHOOL, Noida in April, 2000 and THE SHRIRAM MILLENIUM SCHOOL, Faridabad in April, 2012.

8. In the year 2011 the second Plaintiff jointly with the Haryana Police Department set up THE SHRI RAM POLICE SCHOOL in Bhondsi, Haryana for the children of Police Personal and the General Public. The Plaintiffs are therefore today associated with schools at six different locations with the word SHRI RAM as a prominent part thereof.

9. It is the case of the plaintiffs that the Plaintiffs schools under the name SHRI RAM/SHRIRAM have carved out a unique space as institutions of excellence and are well known for their value based innovative caring and child-centered approach to educating young children and the institutions are popularly known as THE SHRI RAM SCHOOLS. In the year 2002, THE SHRI RAM SCHOOL, Vasant Vihar was ranked number 04 amongst all schools of Delhi by Outlook India. The said school was rated the best day school in the country by an independent 15 city survey carried out by Education World Magazine in the years 2008, 2009 and 2011. In 2010 THE SHRI RAM SCHOOLS in Delhi and Gurgaon were recognized as the Number One schools in Gurgaon and Southwest Delhi by The Hindustan Times. In 2011 THE SHRI RAM SCHOOL, Aravali was ranked as the Number One school in India by the Delhi based Center for Forecasting and Research Private Limited and the Education World Magazine. Further THE SHRI RAM SCHOOL, Vasant Vihar was ranked 6th in the list of Top Schools in India for the year 2013 in the ranking released by IndiaRanker.com.

10. Relying on the aforestated achievements, it is the case of the plaintiff that for almost 25 years of use the word SHRI RAM in relation to schools has become exclusively identified with the schools of the plaintiffs and/or the core values and educational philosophy of the plaintiffs said schools. It is also pointed out that an application for registration of the trade mark THE SHRI RAM SCHOOL was filed by the plaintiff on 6.6.2008 under No.1696277 in Class 41 and the application is pending with the Registrar, Trade Marks.

11. It is also the case of the plaintiff that very recently they became aware of the defendant no.2 when they came across some advertisements of The ShreeRam World School. The second defendant also commenced the domain name www.shreeram.in. Plaintiff has also learnt that the Chairman of the said school is also the Chairman of Sachdeva Public School, Pitam Pura, established in the year 1986, Sachdeva Public School, Rohini established in the year 1999 and Sachdeva Global School, Dwarka established in the year 2007. All the schools are running under the aegis of Shri Laxman Dass Sachdeva Memorial Educational Society. Defendant no.1 is also the Chairman of the Queens Valley School established in the year 2009, which is running under the aegis of Durga Parvati Khaitan Memorial Centre. According to the plaint, the above information is available on the school websites.

12. Attention of the court is drawn to the fact that in the website of ShreeRam World School, there is silence on the management of this school. It is the case of the plaintiff that this silence is intentional. Counsel for the plaintiff submits that the adoption of the word ShreeRam which is phonetically and conceptually identical to the word SHRI RAM in respect of a school by the defendants, is with the clear intention to trade upon and benefit from the immense reputation attached to the plaintiffs school under the name / mark THE SHRI RAM SCHOOL.

13. Ms.Salhotra, counsel for the plaintiffs contends that the use of the ShreeRam word in respect of a school by the defendants is bound to create an impression that the school of the defendants is in some manner connected and/or associated with the plaintiffs well known school under the SHRI RAM name.

14. It is also argued before this court that the adoption of the name ShreeRam by the defendants is not only dishonest, but it violates the rights of the plaintiffs and its well known name SHRI RAM in relation to schools. Similar argument is in relation to adoption of the domain name www.shreeram.in in respect of their website.

15. Ms.Salhotra further contends that the aim and purpose of the defendants in adopting the name, according to the plaintiffs, is to reap wrongful gains and profits by the immense reputation of the plaintiffs. It is also the case of the plaintiffs that

the defendants are no stranger to the world of education for they have been running schools in Delhi since the year 1986 i.e. Sachdeva Public School, Pitam Pura, established in the year 1986, Sachdeva Public School, Rohini established in the year 1999, Sachdeva Global School, Dwarka established in the year 2007 and Queens Valley School established in the year 2009. Thus the defendants would be aware of the plaintiffs extremely popular schools, which are in existence since the year 1988.

16. It is contended that by the use of the word ShreeRam, the defendants are creating a false and misleading impression in the minds of the public including interested prospective students that the defendants school is directly and/or indirectly connected with the plaintiffs or the plaintiffs schools. The adaption being identical and for similar services is totally dishonest and intended to trade upon and benefit from the immense reputation and goodwill attached to plaintiffs trade mark SHRI RAM / SHRIRAM.

17. Counsel also submits that the dishonesty can also be ascertained from the fact that although the words Shree Ram have been used as one word ShreeRam, the manner of writing clearly shows it to be two words. Counsel also contends that the dishonesty of the defendants is also evident from the fact that the schools website is pertinently silent on the particulars of the management of the school in comparison to other schools / coaching institutions, educational outfits of the defendant no.1 where details are prominently displayed on their websites.

18. Another argument which has been advanced before this court is that other schools, coaching institutions / educational outfits of the defendants are running for sufficiently long period of time, yet the defendants instead of choosing their existing and known trade mark have attempted to use the words ShreeRam, a well established and associated with education and schools of the plaintiffs.

19. Elaborating her arguments further Ms.Salhotra submits that the defendants trademark SHREERAM WORLD SCHOOL is deceptively similar to Plaintiffs trademark THE SHRI RAM SCHOOL as they are phonetically, structurally and visually nearly identical to each other. The only difference between the two marks is the deletion of the word THE and addition of the word WORLD. The Plaintiffs

adopted and used the trademark THE SHRI RAM SCHOOL in the year 1988 which is 25 years prior to the claimed adoption of the trademark SHREERAM WORLD SCHOOL by the Defendants in the year 2011 and claimed use in the year 2014.

20. In support of her arguments that the use of trade mark SHRI RAM by the plaintiffs is much prior in time other than the defendants and in fact from the year 2000, reliance is placed on a copy of School Book of the year 2000 showing the first page of students passed out in the said school book, who joined the school in the year 1988. Reliance is also placed on the computer print out of the trade mark application for the mark SHREERAM WORLD SCHOOL under application no.02101083 in Class 41 dated 17.2.2011 filed on a proposed to be used basis.

21. Learned counsel for the plaintiff submits that on account of uninterrupted use for over 25 years and on account of top ranking conferred by independent service the word SHRI RAM has become an intrinsic part of the goodwill of the plaintiff. It is, thus, become the plaintiffs property and any misuse whereof is protected under the law of passing off. The public associates the word SHRI RAM with the school of the plaintiffs.

22. It is further argued that in the year 2011, when the mark SHREERAM WORLD SCHOOL was allegedly adopted by the Defendants, the Plaintiffs mark THE SHRI RAM SCHOOL was ranked as the best school in India. The adoption of the SHREERAM WORLD SCHOOL by the Defendants is therefore dishonest. The Defendants have also failed to give a plausible explanation for adoption of the impugned mark and therefore for this reason also the adoption of the impugned trade mark by the Defendants is prima facie dishonest. It is also submitted that, the defendants are already running schools in Delhi and, thus, it is not possible that they were not unaware of the Plaintiffs schools in NCR region which were consistently in the top 10 rankings since the year 2008. To show that the adopting of the defendants is not bonafide, it is contended that the Defendants have conspicuously refrained from giving its details in the official website of SHREE RAM WORLD SCHOOL even though such details have been given on the official websites of its other schools namely, SACHDEVA and QUEENS VALLEY. In

these circumstances, the dishonesty on part of the Defendants in adopting the trademark SHREE RAM for its schools is apparent.

23. Attention of the Court is drawn to a large number of documents in support of the submissions that the plaintiffs have earned a high reputation, and goodwill in relation to the mark SHRI RAM. The documents include:

1. Interview of Mrs. ManjuBharatram to Times of India dated 2nd July, 2005 giving reason for starting of THE SHRI RAM SCHOOL2Print out from the web-site www.hindustantimes.com showing the result of the 2010 HT-C FORE SURVEY of South West Delhis top Schools in which SHRI RAM, VasantVihar was ranked number 1. Print out from the web-site www.rediff.com showing the result of a Pan India Survey in the year 2011 conducted by the Centre for Forecasting & Research Pvt. Ltd. and Education World Magazine in which THE SHRI RAM SCHOOL, Delhi was ranked first in the country. 3 4 Print out from the web-site www.indiaranker.com giving the updated list as of June 01, 2013 of the Top Schools in Delhi. THE SHRI RAM SCHOOL, VasantVihar is at No.6 and THE SHRI RAM SCHOOL, Aravali is at No.12. 5 Copy of the Patent Application filed in 2011 by the Plaintiffs school for an invention by its student Anshul Gupta 6 Newspaper cutting of Hindustan Times (Sunday); May 20, 2012 showing that The Shri Ram School was referred as one of the two prominent schools in Delhi, NCR Region. 7 Newspaper cutting of Times of India showing that ShivaliMalhotra and BhavyaKulshreshta both students of The Shri Ram School, Aravali topped ICSR scoring 98.75%. 8 Newspaper cutting of Times of India showing that NehalGarg, a student of The Shri Ram School, Aravali topped the District Gurgaon in commerce scoring 97.25%. 9 Newspaper cutting of Times of India showing that Abishek Gupta, a student of The Shri Ram School, (DLF III) topped in commerce with 97.25%. 10 Newspaper cutting of Times of India showing that SrayanaSanyal, a student of The Shri Ram School, Aravali topped Science stream with 96.75%. 11 Newspaper article showing that Anshul Gupta, a student of The Shri Ram School, Aravali topped class X ICSE exams scoring 97% followed by Sara Rajagopal. 12 Newspaper cutting of Hindustan Times showing that RishibhaKwatra a student of The Shri Ram School, (DLF III) topped humanities scoring 97.50%. 13 Article from magazine B on Vivant dated 2-8 November, 2012 showing that Madhulika Mohan

of The Shri Ram School, Aravali won first prize in Joy of Going photography competition held by Photosynthesis and was the winner of INTACH Times of India Inter-School photography competition. 14 Article from the Magazine Achievers Club showing that IshitaMatharu of The Shri Ram School, Aravali was amongst one of the six Ball Kids from India at the Open Tennis Tournament held in 2006 in Australia. 15 Newspaper article showing that SukhmaniBakshi a student of class VII of The Shri Ram School, Aravali emerged as second best swimmer in Haryana. 16 Newspaper article showing that Anshul Gupta of The Shri Ram School, Aravali bagged top grade in a summer programme of Harvard University, USA. 17 Newspaper article showing that RaghavKhurana was selected amongst the 56 probables for the Junior National Football Competition.

24. 18 Article from the Newspaper Sunday Hindustan Times dated February 14, 2010 showing that PrannayKohli of The Shri Ram School, Aravali started the Signature Campaign on Tiger crisis in 2001. 19 Print out from the website www.sachdevaglobal.in evidencing that the Defendants have been running schools under the name SACHDEVA PUBLIC SCHOOL and SACHDEVA GLOBAL SCHOOL since the year 1992 wherein the 1st Defendant is shown as the Chairman. 20 Print outs from the web-site www.shreeram.in which does not show the details of the management of Defendants school. Further, there exists no plausible reason for adopting the name SHREE RAM when the Defendants have been running schools under the names SACHDEVA and QUEENS VALLEY for many years. 21 Computer printout of trademark application for the mark SHREE RAM WORLD SCHOOL showing that the Defendants dishonestly adopted and filed for the registration of the aforesaid trademark in the year 2011 i.e. the year when the Plaintiffs school was ranked No.1 in the country. In support of her argument that any violation of the plaintiffs rights in use of the word SHRI RAM by the defendants is actionable and even though a person may be innocent, although the plaintiff has alleged in this case that the adoption of the mark by the defendant is not innocent and even though no damage has been proved, counsel for the plaintiff has relied upon Century Traders v. Roshan Lal Duggar & Co., reported at AIR1978 Del 250 (DB), where the Court was concerned with the trade marks RAJARANI. Paras 14 & 19 read as under:

14. Thus, the law is pretty well-settled that in order to succeed at this stage the appellant had to establish user of the aforesaid mark prior in point of time than the impugned user by the respondents. The registration of the said mark or similar mark prior in point of time to user by the appellant is irrelevant in an action passing off and the merepresence of the mark in the register maintaned by the trade mark registry did not prove its user by the persons in whose names the mark was registered and was irrelevant for the purposes of deciding the application for interim injunction unless evidence had been led or was available of user of the registered trade marks. In our opinion, these clear rules of law were not kept in view by the learned Single Judge and led him to commit an error.

19. Even the Supreme Court in Kaviraj Pandit Durga Dutt Sharma's case, referred to earlier, observed that the use by the defendant of a trade mark of the plaintiff is not essential in an action for passing off, but is the sine qua non in an action for infringement. Salmond in his Law of torts (Twelfth Edition) described the basis of passing off action in the following words :"THE courts have wavered between two conceptions of a passing off action-as a remedy for the invasion of a quasi proprietary right in a trade name or trade mark, and as a remedy analogous to the action on the case for deceit. for invasion of the personal right not to be injured by fraudulent competition. It has recently been said that 'the true basis of the action is that the passing off.... injures the right of property in the plaintiff, that right of property being his right to the goodwill of his business'. In general the violation of a right to property is actionable, even though it is innocent and though no damage has been proved. At common law it was necessary to prove an 'actual fraudulent intention' but a different view was taken in equity, and since the Judicature Acts it has been generally accepted that it is not necessary in an action for passing off to prove fraud that is to say, an intent to deceive. It is sufficient in all cases to prove that the practice complained of is calculated (that is to say, likely) to deceive."

In our view the proof of actual damage or fraud is unnecessary in a passing off action whether the relief asked for is injunction alone or injunction, accounts and damages. If there is a likelihood of the offending trade mark invading the proprietary right, a case for injunction is made out. We are fortified in coming to this conclusion by the observations in a bench decision of this court in Prina

Chemical Works and others v. Sukndayal and others, I.L.R. 1974 (1) Delhi 545. (Emphasis supplied)

25. Reliance is also placed on the same judgment i.e. Century Traders (supra) by Ms.Salhotra in support of her argument that in order to succeed in a case for passing off, the plaintiffs have to establish prior user in point of time at the stage of seeking interlocutory injunction.

26. Counsel for the plaintiffs has also relied upon B.K. Engineering and Company v. Ubhi Enterprises, reported at 1985 PTC (DB) 1, in support of her arguments that the defendants cannot make use of the plaintiffs labour, effort and cannot deliberately reap what he has not sown in this case, the Court was concerned with the marks B.K. Para 47, 50, 52 and 55 read as under:

47. Lord Parker in A.C. Spalding (supra) showed that in a passing off action the right in question is a right of property. A plaintiff complains of the invasion of this right to property. The property is in business or goodwill likely to be injured by misrepresentation. If the mark is distinctive of the plaintiff's goods in the eyes of the public or a class of the public any misrepresentation is likely to deceive the ultimate customer. Property is not in the mark, name or get up improperly used by the defendant. But the property is in business or goodwill likely to be injured by misrepresentation. The foundation of the modern tort of passing off is the infringement of right to, property. A plaintiff can say that the defendant is infringing his name which is distinctive of his goods. A misuse of that name is hardly consistent with fair or honest trading, as Lord Parker said. The same emphasis was laid by Lord Diplock when he spoke of "commercial honesty" [Wamick v. Townend (supra) at p. 933]. and Lord Fraser of "business morality" (at p. 944).

50. A fair and honest trader will not give misleading name to his product to the continuing detriment of a plaintiff who has built up his goodwill in the business after years of hard work, for example, 13 or 14 years, as in this case. It is this intangible right to property which the law seeks io protect. The plaintiffs attach capital importance to the password "B.K."

which represents their house mark and is the indicium of their products. The defendants have not sufficiently distinguished their bells by merely putting the manufacturer's name as Ubhi along with "B.K.-81". The risk of confusion in the minds of the public cannot be ruled out.

52. The modernisation of the tort of passing off lies in this that what was previously a misrepresentation of goods has now become a misappropriation of another man's property in the business or goodwill, or misappropriation of another's personality. You cannot make use of the plaintiff's expensive labour and effort. You cannot deliberately reap where you have not sown. You cannot filch a rival's trade. Passing off is thus a remedy for injury to goodwill.

55. The mainstay of the defendants' case is that they are using their mother's name "B.K."

to which they are entitled. I cannot accept this contention. Firstly it is not the defendants name. The name of the partner who appeared before the learned judge and made a statement is Man Mohan Singh. Even if a man uses his own name as to be likely to deceive and so to divert business from the plaintiffs to the defendants he will be restrained. Pears' soap is the stock example of this. A man name William Joban Pears cannot set up a soap business and call his soap "Pears Soap" He is not entitled to abbreviate his own name so as to lead to deception. [Parker Knoll (supra) at p. 276 per Loard Denning].. Another example I gave in the course of arguments was of Haman soap. On the cake it is stamped "A Tata Product". Is it open to a rival trader to call his soap. "Tata Soap" simply because Tatas do not make "Tata Soap" as such by name ?. The fundamental question is whether there is a likelihood of deception of the public by the use of a particular name. If there is likelihood the complainant can bring an action against the deceiver, the maker of the representation. As Lord Parker said that the case of action is complete with the representation. It is no longer true that the cause of action is complete only upon sale. It was true to say this in 1896 when Lord Halsbury decided the leading case of Reddaway v. Banham. It is true after 1915 when the leading cases of Parker-Knoll and Warnink were decided. The roots of passing off tort lay in deceit, yet the fraud was practiced not upon the plaintiff but

upon the customers of the defendant who purchased the goods believing them to be of the plaintiff's manufacture.

27. Reliance is also placed by counsel for the plaintiffs on Laxmikant V. Patel v. ChetanBhat Shah and Anr., reported at (SC) 2002 (24) PTC1 a case concerning the trade mark MUKTAJIVAN, wherein the Supreme Court held the principal issue determining grant of temporary injunction. Paras 7, 8, 10 and 13 of the judgment read as under:

7. Though there is overwhelming documentary evidence filed by the plaintiff in support of his plea that he has been carrying on his business in the name and style of Muktajivan Colour Lab since long we would, for the purpose of this appeal, proceed on the finding of fact arrived at by the Trial Court and not dislodged by the High Court, also not seriously disputed before this Court that the plaintiff has been doing so at least since 1995. Without entering into controversy whether the defendants had already started using the word Muktajivan as a part of their trade name on the date of the institution of the suit we would assume that such business of the defendants had come into existence on or a little before the institution of the suit as contended by the defendants. The principal issue determinative of the grant of temporary injunction would be whether the business of the plaintiff run in a trade name of which Muktajivan is a part had come into existence prior to commencement of its user by the defendants and whether it had acquired a goodwill creating a property in the plaintiff so as to restrain the use of word Muktajivan in the business name of a similar trade by a competitor, i.e., the defendants.

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 companys name, or

its intended name, is calculated to deceive, and so to divert business from the plaintiff, or to occasion a 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.

10. 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 adopt 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.

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

Passing Off (1995 Edition, at p.3.06) states that the plaintiff does not have to prove actual damage in order to succeed in an action for passing off. Likelihood of damage is sufficient. The same learned author states that the defendants state of mind is wholly irrelevant to the existence of the cause of action for passing off (ibid, paras 4.20 and 7.15). As to how the injunction granted by the Court would shape depends on the facts and circumstances of each case. Where a defendant has imitated or adopted the plaintiffs distinctive trade mark or business name, the order may be an absolute injunction that he would not use or carry on business under that name. (Kerly, ibid, para 16.97).

28. Besides, the application under order 39 Rule 4 of the CPC, a detailed written statement has been filed by the defendants.

29. The first argument raised by Mr.Miglani, learned counsel for the defendants, is that the present application for grant of injunction is liable to be dismissed on account of concealments and misrepresentations made by the plaintiffs. It is contended by Mr.Miglani that the gross concealments and deliberate misrepresentations have been made in the plaint with the sole purpose of misleading this Court and obtaining an ex parte ad interim injunction against the defendants.

30. Mr.Miglani submits that the plaintiffs have concealed the examiners reports issued by the Registrar of Trade Marks whereby the Registrar of Trade Marks had in response to plaintiffs application seeking registration of trademarks comprising expression SHRI RAM conveyed to the Plaintiffs that trademarks comprising the expression SHRI RAM are already registered or pending in the name of various other parties.

31. Plaintiffs have also withheld from the Court plaintiffs own response submitted to the Registrar vide letter dated 8 th June, 2012, categorically and clearly admitting that the expression SHRI RAM stands for a famous Hindu Deity and is common to the trade and the same cannot be monopolized by one person and that its trademark SHRI RAM EDUCARE is different and distinct from trademarks SHRIRAM, USHA SHRIRAM, RAMSHREE EDUCATION OF TECHNOLOGY SAMITI, SHRI RAM CHANDRA MISSION, SHRI RAM, SHRI RAM SCHOOL OF

BUSINESS.

32. Mr.Miglani contends that the plaintiffs deliberately did not file copy of the search report of mark SHREE RAM/SHRI RAM in Class 41 as the same would have revealed third-party registrations and prior rights of mark SHREE RAM/SHRI RAM vis--vis Plaintiffs.

33. Counsel further contends that plaintiffs have also deliberately concealed various third party prior registrations and use of the mark SHRI RAM/SHREE RAM/SRI RAM in India in Class 41 even prior to the alleged adoption by the Plaintiffs and have rather wrongly claimed to have been the first adopters and first users of the trademark SHRI RAM. Plaintiff ought to have been aware of presence of large number of schools with the name SHRI RAM and in any case were put to such notice by Registrar as back as January, 2009.

34. It is next contended that such an intentional non-disclosure and not filing of search reports has been held by this Honble Court to be a material concealment disentitling the Plaintiff to an equitable relief of injunction.

35. Learned counsel for the defendants relies on S.P Chengalvaraya Naidu vs Jagannath, reported at 1994 SCC (1) 1, wherein the Apex Court held that a litigant is required to produce on record every relevant document and cannot take inconsistent stands in two proceedings. Paras 1, 7 and 8 read as under:

1. "Fraud-avoids all judicial acts, ecclesiastical or temporal" observed Chief Justice Edward Coke of England about three centuries ago. It is the settled proposition of law that a judgment or decree obtained by playing fraud on the court is a nullity and honest in the eyes of law. Such a judgment/decree - by the first court or by the highest court - has to be treated as a nullity by every court, whether superior or inferior. It can be challenged in any court even in collateral proceedings.

7. The High Court, in our view, fell into patent error. The short question before the High Court was whether in the facts and circumstances of this case, Jagannath obtained the preliminary decree by playing fraud on the court. The High Court, however, went haywire and made observations which are wholly perverse. We do

not agree with the High Court that "there is no legal duty cast upon the plaintiff to come to court with a true case and prove it by true evidence". The principle of "finality of litigation" cannot be pressed to the extent of such an absurdity that it becomes an engine of fraud in the hands of dishonest litigants. The courts of law are meant for imparting justice between the parties. One who comes to the court, must come with clean-hands. We are constrained to say that more often than not, process of the court is being abused. Property-grabbers, tax- evaders, bank-loan-dodgers and other unscrupulous persons from all walks of life find the court - process a convenient lever to retain the illegal-gains indefinitely. We have no hesitation to say that a person, who's case is based on falsehood, has no right to approach the court. He can be summarily thrown out at any stage of the litigation.

8. The facts of the present case leave no manner of doubt that Jagannath obtained the preliminary decree by playing fraud on the court. A fraud is an act of deliberate deception with the design of securing something by taking unfair advantage of another. It is a deception in order to gain by another's loss. It is a cheating intended to get an advantage. Jagannath was working as a clerk with Chunilal Sowcar. He purchased the property in the court auction on behalf of Chunilal Sowcar. He had, on his own volition, executed the registered release deed (Exhibit B-1S) in favour of Chunilal Sowcar regarding the property in dispute. He knew that the appellants had paid the total decretal amount to his master Chunilal Sowcar. Without disclosing all these facts, he filed the suit for the partition of the property on the ground that he had purchased the property on his own behalf and not on behalf of Chunilal Sowcar. Non-production and even non-mentioning of the release deed at the trial tantamounts to playing fraud on the court. We do not agree with the observations of the High Court that the appellantsdefendants could have easily produced the certified registered copy of Exhibit B-15 and non-suited the plaintiff. A litigant, who approaches the court, is bound to produce all the documents executed by him which are relevant to the litigation. If he withholds a vital document in order to gain advantage on the other side then he would be guilty of playing fraud on the court as well as on the opposite party.

36. Reliance is also placed on Living Media India Ltd. & Anr. Vs. Alpha Dealcom Pvt. Ltd. & Ors., reported at 2014 (28) DLT145wherein plaintiff concealed its stand before the Registrar that INDIA TODAY was different from PUNJAB TODAY and raised an inconsistent stand in Court that NATION TODAY was deceptively similar to INDIA TODAY. Injunctive relief was declined by the Court.

37. Reliance is also placed on Unichem Laboratories Ltd. Vs. Ipca Laboratories Ltd. & Anr., reported at 2011 (45) PTC488 where the Mumbai High Court dealt with a similar circumstance and denied relief of injunction as plaintiffs stand before Registrar and Court was at variance and plaintiff concealed the same.

38. Counsel for the defendants has further placed reliance on, Astrazeneca UK LTd. & Ors. V. Orchid Chemicals & Pharmaceuticals Ltd., reported at :

2012. (50) PTC380wherein it was held that a Party is not permitted to approbate and reprobate and take inconsistent stands.

39. Mr.Miglani also contended that the letter of 8.6.2012, addressed by the plaintiff to the Registrar, is an admission, which cannot be permitted to be withdrawn by simply writing another letter to the Registrar. Registrar has not allowed the letter to be withdrawn and plaintiff has not shown to the court any permission by Registrar for withdrawal of said admission (letter). Counsel for the defendant has relied upon Heeralal v. Kalyan Mal & Others, reported at AIR 1998 SC618and Pfizer Inc. V. Pifer Pharmaceuticals Pvt. Ltd., reported at 2007(34) PTC660(Del) in support of his submission that admissions cannot be withdrawn even by amending pleadings.

40. The second argument raised by Mr.Miglani, learned counsel for the defendants is that the expression SHRI RAM is common to the field of schools and education and is apt to be adopted by others. It is further submitted that as early as in 1923 a school by the name of SHRI RAM ASHRAM was established and is still in existence. Further schools came to be established with the expression SHRI RAM or SHREE RAM in 1932, 1951, 1960, 1968, 1972, 1977, 1978, 1986 and about 100 schools existed on the date of filing of the suit.

41. Reliance is also placed by Mr.Miglani on various documents to show running of schools from websites of the schools, official website of CBSE and other Boards. Photographs, admission forms, brochures and advertisements have also been placed on record in support of the submissions made.

42. It is further contended by Mr.Miglani that SHRI RAM formative marks are co-existing peacefully. The presence of SHRI RAM in ones name is incapable of distinguishing the goods/services of one trader from the other and is equally incapable of being associated exclusively with the plaintiffs. Distinctiveness, if any, has been blurred by presence of large number of schools bearing the name SHRI RAM and yet co-existing with others. The ultimate test of relative strength is the distinctiveness of a mark in the perception and mind of the relevant customer group. A mark that is hemmed in on all sides by similar marks on similar goods or services cannot be distinctive.

It is merely one of a crowd of similar marks. In such a crowd, customers are not likely be confused between any two of the crowd and may learn to carefully pick out one from the other.

43. Mr.Miglani has relied upon Macarthy on Trade Marks and Unfair Comp. 11:85 (4th Ed). Relevant portion has been reproduced hereunder:

Just Another Mark in the Crowd of Look-Alikes. The ultimate test of relative strength is the distinctiveness of a mark in the perception and mind of the relevant customer group. A mark that is hemmed in on all sides by similar marks on similar goods or services cannot be very distinctive. It is merely one of a crowd of similar marks. In such a crowd, customers will not likely be confused between any two of the crowd and may have learned to carefully pick out one from the other.[1]. When numerous sellers in a product or service line use similar marks, there may be little if any individual distinctiveness and consumers may have difficulty telling one seller from another.[2]. [I].f consumers dont have a clear sense of what plaintiffs mark represents, they are unlikely to purchase defendants product or service thinking it is plaintiffs.

[3]. Each one in the Crowd is a Weak Mark. In a crowded field of look-alike marks, each member of the crowd is relatively weak in its ability to prevent use by others in the crowd. For example, the Trademark Board has said that the field of trademarks in stripe designs on sports shoes is a crowded field. That is, widespread use by different firms of plethora of similar stripe designs has narrowed the breadth of protection afforded each mark such that any one such design on sports shoes is limited to substantially that identical design.[4]. As the Trademark Board observed: [T].his complete saturation of the market with somewhat similar stripe and bar designs leave[s]....manufacturers of athletic shoes engaging in such practice with marks that are extremely weak and certainly entitled to only a very narrow and limited scope of protection...This means that competitors in this field may come closer to such weak marks without violating the owners rights therein than would be the case with a stronger mark.[5]. The Trademark Board reversed an ex parte refusal to register GRAND HOTELS NYC based on a likelihood of confusion with a registration for GRAND HOTEL. Applicant submitted evidence of five registrations of variations on GRAND HOTEL (such as ANCORAGE GRAND HOTEL), five additional uses of variations GRAND HOTEL (such as KYOTO GRAND HOTEL AND GARDENS in Los Angeles), and website advertising of ten other GRAND hotels (such as MGM GRAND HOTEL & CASINO in Las Vegas). The Board concluded that because grand was a highly suggestive term for a hotel and the proliferation of variations on GRAND for hotels, the mark GRAND HOTEL was entitled to only a very narrow scope of protection:

[W].e conclude that consumers are able to distinguish between different GRAND HOTEL marks based on small differences in the marks , including the addition of a geographic term.

[5.50]. Examples of Crowded Markets. Applying the crowded market test, the Ninth Circuit found that marks used to identify beauty pageants are a crowded field of similar marks consisting if marital prefix and a geographic term, such as Miss U.S.A., Miss America, Mrs. America, Miss World etc. In such a crowded field, defendants MRS. OF THE WORLD was not so close to plaintiffs MISS WORLD as to be likely to cause confusion.[6]. The Seventh Circuit affirmed a Rule 12(b)(6) dismissal where a rap duo sued for infringement of its name (PHIFTY-50) by use

of 50/50 as the title of a motion picture about a character who has a 50% chance of surviving cancer . Noting that the phrases 50/50 and fifty-fifty have been used as the title of a number of films and songs, the court said plaintiff was a very junior user and in no position to complain about the 2011 film. [Plaintiff]. Phifty-50 entered a crowded field, and its rights are correspondingly weak and narrow.

[6.50]. Many local cafes and restaurants have similar names. For example, where evidence showed hundreds of restaurants and eating establishments with a name containing the word Broadway, the Trademark Board held that in this context, Broadway was so weak that the applied-for BROADWAY CHICKEN for restaurant services was not confusingly similar to a prior registration of BROADWAY PIZZA for restaurant services.[7]. Similarly, in a battle between two Joe: Restaurants the San Francisco Bay Area, the court noted that there were several Joes in that area, such as Joes Coffee Shop, Joes Cafe Little Joes Pizzeria, Big Joes Broiler, Joe Joes BBQ Cafe, Joes 24th Street Cafe Joes Cable Car, Marin Joes, San Rafael Joes and an Original Joes in San Jose. The court denied a preliminary injunction in a suit brought by Original Joes in San Francisco against Uptown Joes also in San Francisco, noting that the mark is not very strong in the marketplace.

[8]. Other examples where courts have found a crowded field of marks are: ADVANTAGE used on health care programs [9]. BONGO used in restaurant names [10]. FLEX on exercise machines[11]. Grand hotels[11.50]. JUPITER in the Internet technology field[12]. MOOSE (and its image) on clothing[13]. PEOPLES bank[13.25]. PLUS on vitamins[13.50]. Bold colors and graphics for energy drinks[14].

44. Mr.Miglani has further relied upon Rajinder Kumar Aggarwal v. Union of India and Anr., reported at 2007 (35) PTC616 and also relied upon Ashok Kumar Aggarwal and Ors. v. Rajinder Kumar Aggarwal & Ors., reported at 2009 (40) PTC67Del. (DB) to show that user per se does not establish distinctiveness. In both the aforesaid cases, the Court has held that though the mark Aggarwal sweets has been used for a long time but the same is not distinctive considering the nature of the mark and its common use.

45. Learned counsel for the defendants has also relied upon P.P. Jeweller Private Limited v. P.P. Buildwell Private Limited, reported at 2009 (41) PTC217 wherein the Court has held that at that stage reference to search reports etc. was sufficient to say that the mark is not distinctive and hence there is no passing off. Appeal and Special leave petition filed against the aforestated judgment were also dismissed.

46. Another argument raised by learned counsel for the defendants is that the Court must consider the nature of the mark and whether such a mark is likely to cause confusion. A mark may be invented, coined, fancy, suggestive, descriptive, laudatory, ordinary word apt to be adopted in commerce, a common name, a common surname, a geographical place etc. While protecting a given mark in passing off action it is to be considered so as to judge the distinctiveness or distinctive character of the mark. In the present case the mark is SHRI RAM which is a name of a Hindu Deity known for learning and teaching and adopted and used by Hindus as their name, part of trading activities, business ventures and there is wide spread use thereof. The defendants have filed on record search reports in all classes to show such wide spread adoption and use. It is also submitted that in case a telephone directory is referred to lakhs of entries would be found with the name SHRI RAM of living persons and business entities. This name is common and generic and apt to be adopted by others and has been so adopted by others in the relevant field as well prior to and after the plaintiffs alleged adoption and thus it is not distinctive. There is a crowd of educational institutions and schools with the name SHRI RAM.

47. Even otherwise, it is contended that no person much less the plaintiff can have a monopoly over the names of deities. The Courts have leaned against monopoly of the use of the name of a deity. Mr.Miglani, counsel for the defendant submits that Lord Krishna is known for his love of Milk products. In the case of Bhole Baba Milk Food Industries Ltd. v Parul Food Specialities (P) Ltd., reported at 2011 (45) PTC217 and Bhole Baba Milk Food Industries Ltd. v Parul Food Specialities (P) Ltd., reported at 2011 (48) PTC235 DB) interim relief was declined although the sale was over 300 crores, as the trademark was used by many others. Similarly in the case of Kamdhenu Ispat Limited v. Kamdhenu Pickles & Spices Ind. Pvt. Ltd.

& Anr., reported at 2011 (46) PTC152DEL, protection was declined, despite registration of the mark KAMDHENU. In the case of Goenka Institute of Education and Research v. Anjani Kumar Goenka and Anr. reported at AIR2009 Delhi 139 surname Goenka was used for Schools, and in the said case protection was declined, as it was considered to be an ordinary surname and not considered distinctive for protection.

48. Mr.Miglani has also submitted that an ordinary word used by others become generic and not entitled to protection despite plaintiff being prior user and defendant being a subsequent user. Mr.Miglani submits that in the case of Skyline Education Institute (India) Pvt. Ltd. v. Mr. S.L. Vaswani and Anr., reported at 2003 (27) PTC37 a Single Judge of this Court granted partial injunction and restrained defendant not to start further courses though agreeing that SKYLINE was in common use by many others and directed the defendants to put a disclaimer that they are not related to plaintiff. An appeal was taken by both the parties, which was reported at 2005 (30) PTC561 The Honble Division Bench partially modified the injunction and permitted the defendants to use the name for additional courses as well. On an SLP filed by both the parties [Skyline Education Institute (Pvt.) Ltd. v. S.L. Vaswani and Anr., reported at 2010 (42) PTC217, Honble Supreme Court ordered that the word SKYLINE was generic and common in use and hence there ought not to have been any injunction.

49. Another ground raised by learned counsel for the defendants for rejecting the application for grant of injunction is a deliberate act of the plaintiffs by taking a contrary stand before the Registrar and before this Court.

50. Mr.Miglani submits that plaintiffs stand before the Registrar was that SHRI RAM is common to the trade; name of deity, not entitled to monopoly and schools with such names were co-existing and hence plaintiff was entitled to registration. Plaintiffs stand before this Court is at variance and inconsistent. Plaintiffs claimed that they had withdrawn their letter of 8th June, 2012 on 15th April, 2014, however, the withdrawal letter was not produced with documents in reply to I.A.10541/2014 filed under Order XXXIX Rule 4 CPC and the same was filed subsequently as a single document, not scanned by the Registrar on its electronic records though

subsequent letters of plaintiff for June and July 2014 have been scanned. Defendants have seriously doubted the said document to have been manipulated and the same does not inspire confidence. It does not even say that earlier letter was by mistake or unauthorized.

51. Application of injunction is opposed also on the ground that plaintiff has failed to prove use, goodwill, reputation or distinctiveness of the mark. Mr.Miglani contends that plaintiffs have even failed to furnish details of its annual fee collections or advertisement expenditure in the plaint. There are no documents pertaining to running of the school and only few pages from the website of the plaintiff and few downloads from website of two publications have been filed. There is nothing on record to prove the long established use, goodwill and reputation so as to establish distinctive character by the common name SHRI RAM in use by others much prior to and even subsequent to the plaintiff.

52. It is also the case of the defendants that having regard to the class of customers there can be no confusion and/or deception because the case at hand deals with educational services. Parents are very cautious about Admission of their wards to a school. Such parents who seek to their wards admission to private schools are well educated and informed and exercise due diligence and care for the purpose would be undertaken. Further factors like that the Plaintiffs school is an ICSE board school and that the Defendants School is a CBSE board school, the factor that the Plaintiffs and Defendants operate in different cities as schools have a maximum range of geographical radius in which they can admit students as per guidelines, are all other relevant factors in determining the scope for confusion or deception besides there being large number of SHRI RAM SCHOOLS.

53. To show that the adoption of the mark by the defendants is honest, it is submitted that the adoption and use of the mark SHREE RAM WORLD SCHOOL by the Defendants is completely honest, bona fide and is without any reference to the Plaintiffs alleged mark. It is submitted that mother of the Defendant No.1who herself was a very holy Hindu lady, full of virtues worshipped Lord Shri Ram during her life time. It was her desire that a school be established after the name of Lord

Shri Ram for providing quality education to children and thus in terms of her last wish the Defendants adopted the said trademark SHREERAM WORLD SCHOOL way back in the year 2011. The defendants have different patterns, representations, way of writing and even the spellings of the name is different. It is submitted that the Defendants do not need the alleged goodwill and reputation of the Plaintiffs to ride upon and that the goodwill of the Defendants themselves is many fold vis-a-vis. the Plaintiffs.

54. It is also argued by counsel for the defendants that Plaintiffs themselves have concealed from this Court that there is a dispute inter-se the family/brothers qua the use of the trademark SHRI RAM. It is submitted that there are various SHRI RAM formative schools being operated by the same family since the year 2011. Schools by the name SHRI RAM GLOBAL SCHOOL AND SHRI RAM CENTENNIAL SCHOOLS have been in operation by family members and yet unconnected with each other and independent of each other. Plaintiffs have recently filed a suit and have been denied ex parte interim injunction by the court. Plaintiff had concealed its awareness of such schools since the year 2011.

55. Mr.Miglani has, thus, submitted that defendants have proved prima facie that SHRI RAM being name of a deity is apt to be used; has been used by many a persons as part of name of a educational institution; it has been registered by others as part of name of school or other educational institutions prior to the plaintiff and also subsequent to the plaintiff and there being large number of such institutions and schools in operation for a long period; SHRI RAM is not distinctive of the services of the plaintiffs and the name is not associated and identified with the plaintiff by the public and is common in the field and adoption and use by the defendant of the name SHREE RAM as part of name of school is not likely to cause confusion or deception among the public and trade; that the plaintiff is guilty of suppression of material facts and documents; plaintiff is guilty of raising inconsistent stands in relation to the word SHRI RAM itself and is bound by its own admission. Therefore, plaintiff does not have a prima facie case and has failed to prove distinctiveness and identification with itself by the public and there is no imminent injury to the plaintiff. However, defendants would be willing to put a caveat alongside use of name of school that it is run by the trust Mata Phoolan

Wanti Educational Society so as to convey to the public a different source, if so required by this Honble Court.

56. In response to the arguments of the counsel for the defendants, Ms.Salhotra has submitted that the defendants cannot be allowed to take the stand that the word SHRI RAM is publici juris as the Defendants themselves have filed a trademark application for the mark SHREE RAM WORLD SCHOOL under application number 2101083 in class 41 in the year 2011.

57. Reliance is also placed on the case of India Hotels Company Ltd. And Anr. v. Jiva Institute of Vedic Science and Culture, reported at 2008 (37) PTC468(Del.) (DB), a case relating to the trade mark JIVA vs. JIVA wherein it has been held that a party having itself applied for registration of a trade mark cannot turn around and argue that the mark is descriptive.

58. Reliance is also placed on Automatic Electric Limited v. R.K. Dhawan and Anr., reported at 1999 (19) PTC81(Del) pertaining to the trade mark DIMMERSTAT vs. DIMMERDOT, wherein the Court has held that the fact that the defendant itself had sought to claim trade proprietary right and monopoly in DIMMER DOT it would not lie in their mouth to say that the word dimmer is a generic expression.

59. Ms.Salhotra has also contended that no harm would be caused to the Defendants if they are injuncted from using the trademark SHREE RAM for its schools as such use of the mark began only in the year 2014 whereas the Plaintiffs have been using the mark SHRI RAM for its schools since 1988.

60. In response to the argument of Mr.Miglani, counsel for the defendants, that Lord Ram is a deity, associated with learning, therefore, there are number of Shri Ram Schools, learned counsel for the plaintiffs submits that neither there is any evidence that Ram is a deity associated with teaching and schools and moreover there are large number of schools having the word Krishna as part thereof in existence. Reliance is placed on a list of such schools, which has been placed on record.

61. In response to the argument of Mr.Miglani that a large number of schools exists with the name Shri Ram, it is submitted that even as per the list provided there are only a small number of schools, which existed prior to the establishment of plaintiffs school, being only 12 in number, but between the year 1988 to 2000, 23 schools were established with the name Shri Ram and between 2001-2014, 42 schools with the name Shri Ram or part thereof were established, all for the reason of success of the plaintiffs school.

62. The faint argument raised by counsel for the defendants with regard to the letter dated 15.4.2014 not being on the website of the trade mark Registry is denied by Ms.Salhotra and it is submitted that the Trade Mark Registry is under the process of digitalisation and the letter of 15.4.2014 is very much on the record of the Registry. Ms.Salhotra also contends that the defendants are unnecessarily highlighting that a contrary view has been taken by the plaintiffs before the Trade Mark Registry and in the present proceedings.

63. It is submitted by Ms.Salhotra that the application no.1696276 in relation to which this letter was written has not been mentioned in the Plaint. The trade marks involved in the application No.1696276 were SHRI RAM EDUCARE V. USHA SHRIRAM. The mark THE SHRI RAM SCHOOL was not in issue. It is further submitted that the letter dated June 8, 2012 was withdrawn on April 15, 2014 prior to the filing of the suit on May 25, 2014. The Plaintiffs have derived no advantage from the argument put forth in the letter dated June 08, 2012. It is also contended that there is no misrepresentation, no concealment much less deliberate concealment on the part of the plaintiff.

64. I have heard learned counsel for the parties and considered their rival submissions. Before the submissions of counsel for the parties are examined in detail it may be noticed that the plaintiffs trade mark THE SHRI RAM SCHOOL and the defendants trade mark SHREE RAM WORLD SCHOOL are phonetically, structurally and visually identical to each other. There is no element of doubt that the SHRI RAM SCHOOL was established in the year 1988. A copy of the year 2000 school book has been placed on record. It may also be noticed that the use of the mark SHREERAM by the defendants is only from the year 2014.

65. The first argument of Mr.Miglani seeking vacation of the order of injunction is that the plaintiffs have deliberately concealed material facts and made gross representations in the plaint. There is no quarrel to the proposition sought to be urged by Mr.Miglani as it is well settled that a litigant is required to produce on record every relevant document and a litigant must not suppress and withhold material facts and documents.

66. He, who seeks equity, must do equity. According to the defendants the plaintiffs did not bring to the notice of the Court the examiners report issued by the Registrar of Trade Marks, which was conveyed to the plaintiffs that the trade mark comprising the expression SHRI RAM are already registered or pending registration in the name of other parties.

67. The defendants claims that the plaintiffs response to the Registrar vide letter dated 8.6.2012 clearly admitting that the expression SHRI RAM stands for a famous Hindu deity is common to trade and cannot be monopolised by one person and its trade mark SHRI RAM EDUCARE is different and distinct from other Shri Ram trade marks. The law is equally well-settled that a petition cannot be thrown out merely on the ground of concealment unless it is established that the concealment was material in nature. It must also be prima facie established that the concealment is of such a nature that the Court would not grant an injunction in favour of such a person, in case all the facts were disclosed. The Court must also consider that such concealment is deliberate, intentional and has been made with an intention to steal an order.

68. In this case, the application no.1696276 was made by the plaintiff and in relation to which a letter was written between SHRI RAM EDUCARE and Usha Shri Ram. The mark Shri Ram School was not in issue. It has also been clarified by Ms.Salhotra that the letter dated 8.6.2012 was withdrawn on 15.4.2014 prior to the filing of the suit on 25.5.2014 and the plaintiff in fact derives no advantage of the stand taken in the letter dated 8.6.2012.

69. In my view there are no material concealments or misrepresentations made by the plaintiffs. On meaningful reading of the plaint and also the main thrust of the arguments of learned counsel for the plaintiffs was that the word SHRI RAM has

become intrinsic part of the goodwill of the plaintiff school through 25 years of uninterrupted use and for this argument the so concealment would be of no material relevance. In my view the defendants cannot derive any advantage with respect to the said arguments and the explanation of Ms.Salhotra is accepted.

70. It has been strenuously argued by Mr.Miglani that the expression SHRI RAM is common to the field of school and education, and has been adopted by many others. The first school having been established was as early as in the year 1923. The said school is still in existence. Mr.Migalni has rightly pointed out the schools established in the year 1932, 1951, 1960, seventies and eighties. This submission is duly supported from the point of view of the websites of CBSE, random photographs, admission forms and brochures. The argument of Mr.Miglani that Shri Ram formulative words are co-existing peacefully, Shri Ram is a name incapable CS(OS)1151/2014 of being exclusively associated with the distinctiveness, if any, has been blurred by the persons of a large number of schools bearing the name Shri Ram. Closely connected to this argument is the argument raised by Mr.Miglani that a mark, which is invented and coined would require protection of the highest order.

71. Before the judgments sought to be relied upon by Mr.Miglani, in support of his submission can be considered, it may be noticed that the court cannot loose track of the fact that the defendants have themselves filed an application with the trademark Registry for the mark ShreeRam World School under the application No.2101083 in clause 41 in the year 2011 and thus the defendants cannot be allowed to take a stand that the word ShreeRam is publici juris. In the case of India Hotels Company Ltd. & Anr. v. Jiva Institute of Vedic Science & Culture, reported at 2008 (37) PTC468(Del.) (DB), the Court has held as under:

40. It was next argued by Mr. Rohtagi that the word 'JIVA' is a descriptive word which cannot be protected as a trade mark by a Civil Court. We do not think so, the appellant has itself applied for registration of the Jiva as a trade mark and cannot, Therefore, argue that the mark is descriptive.

72. In the case of Automatic Electric Limited vs R.K. Dhawan and Anr. Reported at 1999 (19) PTC81(Del). In para 16 the court observed as under:

The defendants got their trade mark DIMMER DOT registered in Australia. The fact that the defendant itself has sought to claim trade proprietary right and monopoly in DIMMER DOT, it does not lie in their mouth to say that the word DIMMER is a generic expression.....

73. Mr.Miglani has placed on record a list showing large number of schools in existence with the word Shree Ram. It is also the case of the defendants that the deity Ram is associated with the learning. Counsel for the defendant has also placed on record a large list of schools having the word Krishna as part thereof in existence.

74. To rebut the argument of counsel for the defendant Lord Ram alone is a deity associated with learning, it is the argument of counsel for the plaintiff that on account of huge success, goodwill and reputation earned by the plaintiff over a span of 25 years, various other schools also mushrooming to gain advantage over their goodwill and the defendant is yet one such example of the same.

75. Mr.Miglani has placed reliance on Bhole Baba Milk Food Industries Ltd. Vs. Parul Food Specialities (P) Ltd. 2011 (45) PTC217(Del) to show that the Krishna is associated with ghee and dairy products, while Ram is associated with teaching and schools.

76. The basic issue arises for consideration is whether the plaintiffs have been able to prima facie establish before this court that over a passage of time they have acquired goodwill and the mark has become distinctive to the plaintiff.

77. Mr.Miglani, has strongly urged before this court that mere use of the word SHRI RAM by the plaintiff even for the past 25 years is not sufficient to show reputation. While relying in the case of Bhole Baba (Supra), Mr.Miglani has contended that even sales worth Rs.300 crores were not considered sufficient for an action of passing off and in this case the financial details have not been provided by the plaintiff, nor have been pleaded, thus the plaintiff cannot gain advantage either of use for the past 25 years, neither they have been able to establish goodwill, nor anything is on record, to show that the mark has become distinctive to the plaintiffs school. The submissions of counsel for the defendant, in

my view are without any force. The court in the case of Bhole Baba (Supra), relied upon by the defendant would show that despite sales worth Rs.300 crores the court did not consider it sufficient to grant an injunction in the case of passing off, accordingly, the sales and financial figures are not the sole criteria for a court to arrive at a finding as to whether the plaintiff has acquired goodwill and the mark has become distinctive to the plaintiffs schools.

78. Being a school, it cannot be expected that the financial statements would run into hundreds or thousands of crores, nor can a financial statement in the case of a school be the sole criteria for arriving at a decision with regard to the mark becoming distinctive of the school. What has been placed on record are various documents to show the ranking of the school by independent bodies. Details of documents have been extracted in para 23 aforegoing. The result of 2010 HT-C FORE SURVEY of South West Delhis top Schools has been filed, wherein SHRI RAM, Vasant Vihar has been ranked as No.1. A copy of Pan India Survey held in the year 2011 conducted by the Centre for Forecasting & Research Pvt. Ltd. and Education World Magazine in which THE SHRI RAM SCHOOL, Delhi was ranked as No.1 in the country. The up-dated list as of 1.6.2013 of www.Indiaranker.com rated SHRI RAM SCHOOL, Vasant Vihar at No.6 and SHRI RAM SCHOOL, Aravali at No.12. Newspaper cuttings of The Hindustan Times dated 20.5.2012 referred to the plaintiffs school as one of the two prominent schools in Delhi. Copy of the newspaper cuttings wherein student of this school had topped with 98.75%, with respect to the school at Aravali 97.25% and another 97.25% of the school at DLF Phase-3. Other newspaper cuttings have also been filed showing excellent results of the plaintiffs schools. Achievements of students appearing in newspapers in sports including Swimming, table-tennis, photography; and achievements in summer programme, probables of junior National Football competition and various other details have been placed on record.

79. In the case of a school, the financial statement would take a back seat. Even a government aided schools, Kendriya Vidyalaya or any other school run by a charitable institution can acquire goodwill, reputation and distinctiveness, based on their result, manner of teaching, achievements in sports, debates and other extra-curricular activities. In fact while dealing with educational institutions money should

not play a vital role. Buying degrees are fast gaining pace in this materialistic world while knowledge is taking a back seat. In the present case what would constitute distinctiveness would depend on the reputation earned by the school and a school earns reputation based on the achievements of the students, its teachers and even the support staff. The achievement of the students is directly related to the quality of education provided by the school and its staff and teachers. If independent bodies have rated the plaintiff school(s) as No.1 or if the students have secured 98.75%, 97.25%, 96.75% marks, it would show the quality of education provided, it would talk highly of the teachers and it would talk highly of the management. If the students have achieved and excelled in the field of sports as well, the credit is to be shared by the students, teachers and the management. The test is when reference is made to SHRI RAM SCHOOL the public at large would associate the school of the plaintiff with the name SHRI RAM. The public at large would not associate the school, which was either established in the year 1932 or any other school. The plaintiff has passed this test of distinctiveness.

80. The plaintiff has prima facie been able to establish that the plaintiff over a passage of time has earned enormous goodwill. The name has acquired distinctiveness and in fact documents placed on record show that after the plaintiffs school had achieved distinctiveness, reputation and goodwill, based on which many more schools have been established with the same name.

81. The court cannot lose track of the fact that the defendants are not new to the field of education. The defendants have been running school under the name of SACHDEVA PUBLIC SCHOOL and SACHDEVA GLOBAL SCHOOL since the year 1992. The website www.sachdevaglobal.in shows defendant no.1 as the Chairman. Defendant no.1 is also running the school by the name of QUEENS VALLEY by many years. The explanation given for starting a school by the name SHREERAM WORLD SCHOOL is unacceptable.

82. Mr.Miglani is that adoption and use of the mark ShreeRam World School by the defendant is completely honest and bona fide and is without any reference to the plaintiffs mark. The mother of defendant no.1 was a very holy Hindu lady; she worshiped lord Rama during her lifetime and it was her desire that a school be

established after the name of Lord Shri Ram for providing quality education to children and thus in terms of her last wish the defendants adopted the said mark and they are not dependent on the goodwill and reputation of the plaintiffs.

83. Counsel for the plaintiffs has submitted that the adoption of the defendants of the mark ShreeRam is not honest and bona fide. It is submitted that the defendants were well aware of the existence of the plaintiffs school and in fact the defendants wished to ride over the goodwill and reputation of the plaintiffs and it is only after the hard-work put in by the plaintiffs and after the school of the plaintiffs has been ranked as amongst the best schools in India the defendant has chosen to establish ShreeRam World school.

84. There is force in the submission made by counsel for the plaintiff. The defendants have been in the line of education since 80s. The defendants are running schools under the name of Sachdeva Public School, which is in existence at Pitampura, Rohini and Dwarka. All the schools are running under the aegis of Shri Laxman Dass Sachdeva Memorial Educational Society. The defendant no.1 as the chairman also established QUEENS VALLEY school in the year 2009 a school run under the aegis of Durga Parvati Khaitan Memorial Centre. Details of the management of these schools are available on the website according to the plaintiffs, but the website of ShreeRam World School is silent on the management of the school. This silence on the website with regard to the details of the management of the defendant is unusual, creates suspicion and it seems intentional. This is the first factor, which shows that the use of the name SHREERAM WORLD SCHOOL by the defendants is not bona fide and honest.

85. The argument of the defendants is also not convincing that the mother of the defendants desired that a school to be established with the name Shri Ram and seems far-fetched. While the written statement discloses that the defendant no.1, who is the chairman of the school is 72 years of age and he is extremely pious and devoted Hindu, the written statement does not disclose when the mother of the defendant no.1 died and at what point of time did she desire that the school should be established under the name Shri Ram.

86. Admittedly, the defendants claimed themselves to be the renowned educationist, who have been in the education sector since the year 198586. In the absence of disclosing the date of death of the mother of the defendant or any timeframe when she made such a wish and desire, and also conspicuous absence on the website of the defendant school the name and details the management, especially when the website of the other schools of the defendants give full details of the management, in my view the adoption of the defendants of the mark ShreeRam is neither honest nor bona fide. Defendants cannot be permitted to ride over the plaintiffs extensive labour, effort and allow to reap what has not been sown by the defendants.

87. In my view, prima facie, the plaintiff has been able to establish immense goodwill and reputation in the name of SHRI RAM, attached to the school of the plaintiff. The achievement of the plaintiffs school show that their school stand out in the crowd and not that they are yet another in the crowd. Accordingly, interim order dated 25.4.2014 stands confirmed.

88. I.A.7512/2014 filed by plaintiff under Order XXXIX Rules 1 and 2 CPC stands allowed and I.A.10541/2014 filed by defendants under Order XXXIX Rule 4 CPC stands dismissed. CS(OS)No.1151/2014 89. List this matter before Joint Registrar for admission/denial of documents on 11.2.2015.

90. List this matter before Court for framing of issues on 3.3.2015, when parties shall bring suggested issues to Court. G.S.SISTANI, J NOVEMBER14 2014 msr

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