

SK Sachdeva and Another Vs. Shri Educare Limited and Another

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SooperKanoon Citation : sooperkanoon.com/1177997

Court : Delhi

Decided On : Jan-25-2016

Judge : Badar Durrez Ahmed & Sanjeev Sachdeva

Appeal No. : FAO(OS) No. 531 of 2014 & CM Nos. 20873 of 2014, 4500 & 14112 of 2015

Appellant : SK Sachdeva and Another

Respondent : Shri Educare Limited and Another

Judgement :

Sanjeev Sachdeva, J.

1. The appellants in this appeal impugn the judgment dated 14.11.2014 whereby the interim order dated 25.04.2014 has been confirmed. The appellant has been restrained from using the trademark/trade-name ShreeRam World School and the domain name www.shreeram.in on the ground that it is deceptively and phonetically similar to the respondent's trademark SHRI RAM / SHRIRAM in relation to its services.

2. The respondents are the plaintiffs and have filed the suit for permanent injunction, passing off, damages contending that they had established the school THE SHRI RAM SCHOOL in the year 1988 in Vasant Vihar, New Delhi. It is contended that the respondents thereafter added further schools under the same trade-name i.e. The SHRI RAM SCHOOL in Gurgaon. It is contended that the

schools under the name THE SHRI RAM SCHOOL have carved out a unique space as institutions of excellence and are well known for their value based education. The schools of the respondents have been ranked very high in order of merit and in certain surveys ranked as the number one school in India.

3. It is contended in the plaint that the appellants/defendants have been running schools under the name and style of SACHDEVA PUBLIC SCHOOL', SACHDEVA GLOBAL SCHOOL'. It is contended that as per the information of the respondents, the appellants recently opened a school by the name of SHREERAM WORLD SCHOOL and adopted a domain name www.shreeram.in recently. It is contended that the adoption of the mark by the appellants was dishonest and was for taking benefit of the immense reputation attached to the respondents schools under the mark THE SHRI RAM SCHOOL'.

4. Per contra, the appellants have contended that the word SHRI RAM represents the name of a Hindu deity and, as such, no person could be allowed to adopt or use the word SHRI RAM in a manner to oust the usage of the same by others. It is contended that the word SHRI RAM has been associated with educational institutions as far back as in the year 1923.

There are several schools in Delhi and in other parts of India that use the name and word SHRI RAM as part of the name of the school.

5. It is further contended that the respondents are guilty of misrepresentation and concealment inasmuch when the respondents had applied for the mark THE SHRI RAM EDUCARE, the Trademark Registry had raised objections that there were several trademarks already registered with the word SHRI RAM'. The respondents in response thereto by their letter dated 08.06.2012 had categorically taken a stand that the word SHRI RAM was the name of a Hindu deity and no one could claim proprietorship to such a name and further that the word SHRI RAM was common to trade. It is contended that having taken such a stand the respondents could not have then filed the present suit claiming proprietorship of the mark SHRI RAM'. It is contended that the respondents after replying to the objections raised by the Trademark Registry by letter dated 08.06.2012 just before filing of the suit claim to have issued a letter dated 15.04.2014 to the Trademark Registry

withdrawing the letter dated 08.06.2012. The letter dated 15.04.2014 is not available on the electronic record available on the website of the Trademark Registry. However, the respondents by their letter dated 20.08.2014 sought to place a copy of the said letter on record.

6. It is contended that the timing of the withdrawal of the letter dated 08.06.2012 by the respondents was such that it was just prior to the filing of the suit and the respondents being aware that such a response would be fatal to their case, sought to withdraw the letter and filed the suit. The objections raised by the Trademark Registry, response by the respondents and the alleged withdrawal of the response were not disclosed in the plaint and, as such, the same amounted to the concealment and misrepresentation and, as such, the respondents were disentitled to the grant of discretionary relief of an injunction. It is further submitted that the respondents by their letter dated 08.06.2012 have made positive statements of facts and they are now estopped from now taking a completely contrary stand. The respondents in response have contended that the letter dated 08.06.2012 had been withdrawn by the respondents by their letter dated 15.04.2014.

7. It is alternatively contended that the layout, getup, trade dress and the style and use of the mark by the respondents and the appellants are completely different and there is no likelihood of any confusion.

8. The learned Single Judge rejected the contentions raised by the appellants and confirmed the interim injunction granted on 25.04.2014 thereby restraining the appellants from using the mark SHRI RAM GLOBAL SCHOOL and the domain name www.shreeram.in.

9. Aggrieved by the interim injunction, the appellants in the appeal have reiterated the contentions raised before the learned Single Judge and strenuously argued with regard to the concealment and misrepresentation by the respondents.

10. To appreciate the arguments of concealment and misrepresentation and the shifting stand taken by the respondents, it would be relevant to refer to the objections raised by the Trademark Registry and the response thereto originally

given by the respondents. The Trademark Registry by its letter dated 13.01.2009 had raised the following objections:-

The above mentioned application has been examined under the provisions of Trade Mark Act, 1999 and Trade Mark Rules, 2002 and the trade mark applied for is open to objection under the following sections:

1. The trade marks which are devoid of any distinctive character, that is to say, not capable of distinguishing the goods or services of one person from those of another person;

2. The Trade Mark application is open to objection on relative grounds of refusal under Section 11 of the Act because the same/similar trade mark(s) is/are already on record of the register for same or similar goods/services. The detail of same/similar trade marks is enclosed herewith.

is identity with an earlier trade mark and similarity of goods or services covered by; the trade mark; or its similarity to an earlier trade mark and the identity or similarity of the goods or services covered by the trade mark, A trade mark which is identical with or similar to an earlier trade mark;

Hence, the above application is liable to be refused. Accordingly, you are requested to submit your response/submissions, if any, along with supporting documents, within in One Month from the date of receipt of this Examination Report or you may apply for a hearing.

Please Note that if no reply is received or a request for a hearing is applied for within the above mentioned stipulated time, the said application shall be treated to have been abandoned for lack of prosecution under Section 132 of the Trade Marks Act, 1999 and thereafter the status of application in the computer database shall reflect the factual position. ?

11. The trademark in issue in the said application was SHRI RAM EDUCARE'. Perusal of the objections raised by the Trademark Registry shows that the Trademark Registry was, prima facie, of the view that the trademark sought to be registered was devoid of any distinctive character and similar trademarks were

already on record of the register for same or similar goods or services. The Class in issue was Class 41 dealing with education.

12. In response to the objections raised by the Trademark Registry, the respondents by their letter dated 08.06.2012 replied as under:-

Our Ref:VPL:SCE:sf:1696276

The Registrar of Trade Marks June 8, 2012

Office of the Trade Marks Registry By Hand

Baudhik Sampadha Bhawan, Agent Code: 244(2)

Plot No. -32, Sector-14,

Dwarka,

New Delhi -110 075

UNIT SECTION

Dear Sirs,

Re Shri Educare Limited

Trade Mark: Shri Ram Educare

Indian Application No. 1696276

Dated June 6, 2008 in Class 41

We write with respect to the captioned application. We write with reference to the Official Examination Report No.TMR/MUMBAI/EXM/2011 dated January 13, 2009. (dispatched on May 5, 2012, received by us on May 9, 2012).

We deal with the objections raised in the official letter as under:

Paragraph 1

We respectfully submit that Shri Ram is one of the popular figures and deities in Hinduism. As such, no one proprietor can claim exclusive rights on the mark 'Shri Ram'. As evident from the search report attached with the examination report, several Shri Ram-formulative marks are peacefully co-existing on the Register of Trade Marks. The subject mark is a fancy juxtaposition of the words 'Shri Ram and Educare'. As a whole the subject mark does not in any manner directly convey the meaning of the services for which registration is sought and the reference if any, is at best suggestive and a multi-process reasoning is required to ascertain the descriptive element. We also wish to aver that it should be borne in mind that the average consumer normally perceives a mark as a whole and does not analyze its various details.

We also wish to submit that the subject mark is unique and distinctive and has been specifically adopted to distinguish the applicant's services from those of the others.

The marks, when taken as a whole, is distinctive of and capable of distinguishing the applicant's goods and, therefore, does not fall under the provisions of Section 9(1)(a) of the Trade Marks Act, 1999.

Paragraph 2

Insofar as the objection re the cited marks is concerned, we submit as follows:

Re the cited mark SHRIRAM (LABEL) (Application No.1238980), we submit that from a perusal of the online records of the Registry, we note that the status of the cited mark is being reflected as removed. Enclosed herewith is a copy of the online extract for the learned Registrar's reference. We aver that since the cited mark is removed from the Register of Trade Marks, the same should not be allowed to bar the registration of the subject application.

Re all the cited marks, we wish to invite the learned Registrar's attention to the fact that according to the provision of Trade Marks Act, 1999 only an earlier trademark can bar the registration of the mark. Since the cited marks USHA SHRIRAM (Application No 1242875), RAMSHREE EDUCATION OF TECHNOLOGY SAMITI

(DEVICE) (Application No. 1252507) are neither registered trade marks nor convention applications the same do not fall under the definition of earlier trade marks and therefore cannot bar the registration of the subject mark.

Re the remaining cited marks i.e. SHRIRAM (Registration Nos. 1238981 and 1515318), SHRI RAM SCHOOL OF BUSINESS WITH LABEL (Registration No. 1642131), SHRI RAM CHANDRA MISSION (Registration Nos. 1288968 and 1288972), we wish to invite the learned Registrar's attention to the well established judicial principle of entirety. According to the said judicial principle, conflicting marks should not be broken into separate components and read for the sake of comparison; they should be dealt with as a whole. Accordingly, we aver that 'Shri Ram' is one of the popular figures and deities in Hinduism. As such, no one proprietor can claim exclusive rights on the mark 'Shri Ram'. We submit that 'Shri Ram' is common to the trade. It is the combining elements' that make the conflicting marks distinguishable from each another. The marks taken as whole are different each other such that there is no likelihood of confusion and deception between them by their co-existence.

Moreover, as evident from the search report several 'Shri Ram' formulative marks are peacefully co-existing on the Register of Trade Marks. Therefore, the subject mark should not be barred registration as well.

In view of the above submissions, we submit that none of the relative grounds for refusal of the mark apply to the subject mark and, hence, the conflict objection re the cited marks ought to be waived.

We request the learned Registrar to waive objections and accept the application for registration under intimation to us. If the objections are maintained the applicant requests for a hearing before the final orders are passed.

Yours faithfully

of Lall Lahiri and Salhotra

Encl: online extract for Application No.1238980 ?

13. The categorical stand taken by the respondents by their letter dated 08.06.2012 is that SHRI RAM is one of the popular figures and deities in Hinduism and, as such, no one proprietor can claim exclusive rights in respect of the mark SHRI RAM. It is further contended that from the search reports attached with the examination report of the Trademark Registry it was evident that several SHRI RAM formulative marks were peacefully co-existing on the register of trademarks and the said mark was a fancy juxtaposition of the words SHRI RAM and EDUCARE and as a whole the subject mark did not, in any manner, directly convey the meaning of the services for which the registration was sought and the reference, if any, is at best suggestive and a multi-process reasoning is required to ascertain the descriptive element and that the average consumers normally perceive the mark as a whole and do not analyze its various details.

14. It was reiterated that SHRI RAM is one of the popular figures and deities in Hinduism and no one proprietor can claim exclusive rights on the mark SHRI RAM and that SHRI RAM was common to trade. The respondents in response have contended that the letter dated 08.06.2012 has been withdrawn by the respondents by their letter dated 15.04.2014. The letter of 15.04.2014 reads as under:-

Our Ref: VPL:RCA/MKI:sf:1696276

The Registrar of Trade Marks April 15, 2014

Trade Marks Registry

Bhauhdik Sampada Bhawan

Plot No.32, Sector 14

Dwarka

New Delhi-110075 By Hand

Agent Code No.244(2)

Re: Shri Educare Limited

Trade Mark: Shri Ram Educare

Indian Application No.1696276

Date June 06, 2008, Class 41

Dear Sir,

We write with reference to the captioned matter.

We request the Learned Registrar to treat our letter dated June 08, 2012 filed in reply to the examination report as cancelled/withdrawn.

It is submitted that the subject mark Shri Ram Educare is distinctive of the applicant and its services by virtue of the well-known mark Shri Ram under which the applicant successfully runs its schools since the year 1988.

The applicant's mark Shri Ram is so reputed and popular that the said mark including any other trade mark incorporating the words The Shri Ram/ Shri Ram in relation to schools is instantly identified with the appellant and its services.

The words Shri Ram forms the foremost and prominent part of the subject mark Shri Ram Educare and therefore, the relevant members of the trade and public will exclusively associate the subject mark with the applicant and none other.

In view of the aforesaid, the Learned Registrar is requested to accept the subject mark for registration.

Yours faithfully,

Of Lall Lahiri and Salhotra ?

15. The subject suit had been filed on 24.04.2014 i.e. a few days after the letter dated 15.04.2014. The timing of the letter submitted to the Trademark Registry is very crucial. The response to the examination report was given on 08.06.2012. From 08.06.2012 till 15.04.2014, the respondents did not realize or contend that there was any error in the response of 08.06.2012. It is only when the respondents were allegedly contemplating to file the present suit that the respondents realized

that the response of 2012 to the Trademark Registry could be damaging and fatal to the very case of the respondents. Firstly, we may note that there is no reasoning given in the letter dated 15.04.2014 to the Trademark Registry as to on what basis the respondents came to the conclusion that the earlier stand taken by the respondents was incorrect.

16. The stand taken by the respondents by its letter dated 08.06.2012 was that the word SHRI RAM represented a popular figure and deity in Hinduism and no one proprietor could claim exclusive rights on the mark SHRI RAM'. It was further categorically admitted that several SHRI RAM formulative marks were co-existing on the register of trademarks in respect of the same services i.e. of schools. This fact was conveniently omitted by the respondents from the plaint. It is not possible to believe that the respondents were not aware of the stand taken on 08.06.2012 inasmuch as the respondents only a few days prior to the filing of the suit on 24.04.2014 had written the letter dated 15.04.2014 to the Trademark Registry withdrawing the earlier stand taken by letter dated 08.06.2012. There is no basis/rationale given by the respondents for withdrawal of the said admissions made by the said letter dated 08.06.2012. The admissions made by letter dated 08.06.2012 have a material bearing on the stand of the appellants in the subject suit. The fact that the respondents did not mention about the letter dated 08.06.2012 in the plaint, in our view, amounts to a clear case of misrepresentation and concealment of material facts that have a bearing on the very case set up by the respondents in the plaint.

17. The learned Single Judge while considering the withdrawal letter dated 15.04.2014 has erred in not appreciating that the same was concealment of a material fact having bearing on the case of the respondent/plaintiff. The mere fact that the appellants themselves have applied for registration of its trademark does not, in any manner, help the case of the respondents. What is material is the stand taken by the respondents in the plaint and in other proceedings and not the conduct of the appellants/defendants. A party who approaches the Court for grant of a discretionary relief has to approach the Court with clean hands. The respondents clearly did not do so.

18. We are of the view that the interim injunction is liable to be vacated in view of various factors. First of all, the respondents themselves have taken a categorical stand that the word SHRI RAM is the name of a popular figure and deity in Hinduism and no one proprietor can claim exclusive rights on the mark SHRI RAM'. Secondly, their stand that the mark SHRI RAM is common to trade and several SHRI RAM formulative marks are peacefully co-existing on the register of trademark. Thirdly, the appellants have prima facie shown that there were several schools in existence using the name SHRI RAM in existence even prior to the adoption of the mark by the respondents. Fourthly, the respondents are guilty of concealment and misrepresentation and, lastly, discretion should not be exercised in favour of a person who approaches the court with unclean hands.

19. Prima facie, we are of the view that the respondents are not entitled to the grant of an injunction at this stage. The respondents would have to establish that the word SHRI RAM by extensive use in respect of schools is only associated with the respondents and none else. This can only be done at trial.

20. The injunction granted in respect of domain name www.shreeram.in, also cannot be sustained on the above grounds. Further, the domain name www.shreeram.in does not indicate that the same is being used in respect of same or similar class of services. The name SHRI RAM is the name of a Hindu deity and even as per the admission of the respondents it is the name of a popular deity in Hinduism. Use of the said domain name by the appellants cannot prima facie amount to infringement of the rights of the respondents.

21. In view of the above, the impugned order is set aside. The injunction restraining the appellant from using the trade mark/trade name "ShreeRam World School" and the domain name www.shreeram.in in relation to its services is vacated. However, the appellants shall clearly, at all places, where they use the trademark ShreeRam World School also state prominently that the school is managed and run by the appellant No. 2 Mata Phoolan Wanti Educational Society.

22. The appeal is, accordingly, disposed of in the above terms leaving the parties to bear their own costs.