

(2020) 10 DEL CK 0019

In the Delhi High Court

Case No : Civil Suit (COMM) No. 619 Of 2018, Miscellaneous Application No. 2460 Of 2018, 14173 Of 2018

CFA Institute

APPELLANT

Vs

Brickwork Finance Academy

RESPONDENT

Date of Decision : 06-10-2020

Acts Referred:

Code Of Civil Procedure, 1908 — Section 151, Order 13A, Order 39 Rule 1, Order 39 Rule 2

Trade Marks Act, 1999 — Section 2(d), 2(1)(d), 2(1)(zg), 11(6), 12, 29, 29(1), 29(2), 29(2)(a), 29(2)(b), 29(2)(c), 29(4), 30, 31, 101, 102, 103, 104, 124

Income Tax Act, 1961 — Section 80G(5)(vi)

Citation : (2020) 10 DEL CK 0019

Hon'ble Judges : V. Kameswar Rao, J

Bench : Single Bench

Advocate : Sanjeev Sindhwani, Prashant Gupta, Jithin M. George, J. Sai Deepak, G. Nataraj, Avinash Sharma, Rishesh Sikarwar

Judgement

V. Kameswar Rao, J

I.As. 2460/2018 and 14173/2018

1. By this order I shall decide two applications bearing I.A. 2460/2018 filed by the plaintiff under Order XXXIX Rule 1 and

2 read with Section 151 of CPC as well as I.A. 14173/2018 filed by the defendant under order XIII A read with Section 151 of CPC seeking a summary judgment against the plaintiff.

2. The suit has been filed by the plaintiff for permanent injunction against the defendant and its agents from infringing its trade marks, passing off, unfair trade practice, delivery-up of materials/products, damages as well as to declare the plaintiff's

mark as a well-known trade mark.

3. It is averred that the plaintiff is a non-stock corporation incorporated under the laws of the Commonwealth of Virginia, USA having its registered office at 915 East High Street, Charlottesville, VA 22902 United States of America. It was established to serve as a global membership organization of financial analysts, portfolio and investment manager and other similar investment professionals, educators and supervisors thereof (hereinafter, "the Investment Professionals").

4. It is the case of the plaintiff, it first conducted in India the CFA examination in 1981. It is also stated that the plaintiff is the successor-in-title and interest to the Institute of Chartered Financial Analysts (ICFA) that was founded in 1959 by the Financial Analysts Federation (FAF) that was incorporated in 1962 in Charlottesville, Virginia, USA with the objective of developing and administering a certification program for investment professionals, where under qualified candidates who pass three levels of examinations and meet other experience and professional standards requirements are awarded the right to use the Chartered Financial Analyst or CFA designation. Established in 1986 under the name Financial Analysts Programs, the plaintiff changed its name to Association for Investment Management and Research (AIMR) in 1990. In 1990, ICFA and FAF combined and became subsidiaries of the plaintiff. The plaintiff then entered into a co-operative operating agreement with ICFA and FAF, where under the plaintiff was granted the exclusive license to administer the CFA certification program worldwide, including in India. With effect from June 1, 1999, ICFA merged with and into the plaintiff and, by virtue of the said merger, all properties owned by ICFA or any proceedings pending by or against ICFA were deemed to have been transferred to, vested in, and to be continued by the plaintiff. With effect from May 2004, the plaintiff underwent a further change of name to 'CFA Institute' which is the current name under which it is known today.

5. It is the case of the plaintiff that the marks 'Chartered Financial Analyst' and 'CFA' were first coined and used internationally in 1963. The 'CFA' and 'Chartered Financial Analyst' designations are recognized worldwide as symbols of high integrity and professional excellence by investment professionals, employers, educators, regulators, government bodies and agencies, and the public.

6. It is averred that candidates who seek the CFA charter from the plaintiff must pass a series of three six-hour examinations, covering, inter alia the fields of accounting, economics, securities analysis and asset portfolio management, and must have at least four years of acceptable work experience as a financial analyst. Finally, candidates must demonstrate their good character and integrity by submitting three character references, and must comply at all times with the Code of Ethics and Standards of Professional Conduct of the plaintiff. Upon successful completion of the plaintiffs' rigorous application and examination program, candidates are awarded the right to use the professional designation 'Chartered Financial Analyst' or 'CFA'. The 'CFA' and 'Chartered Financial Analyst' designations are recognized worldwide as symbols of high integrity and professional excellence by investment professionals, employers, educators,

regulators, government bodies and agencies, and the public. Individuals who have been granted the CFA charter and the right to use the CFA Marks are recognized as having achieved an unparalleled level of education and knowledge in the fundamental principles of financial analysis.

7. It is the case of the plaintiff that it currently has a membership of over 146,700 investment professionals in 140 countries (all of which periodically receive materials branded with the CFA trademarks), including more than 110,000 CFA charter-holders. Specifically in India, the Plaintiff conducted the first CFA examination in 1981 in Mumbai. In India the exam is offered at test centres located in various cities. It is also stated that the plaintiff has a fast-growing membership and candidate base outside North America, especially in Asia including India. Indeed, a June 2017 press clipping indicated that 188,915 candidates worldwide registered for Level I, II and III June 2017 CFA exams in 91 countries. This represents a 9 percent increase in registrations compared to June 2016. Regionally, the Asia Pacific region continues to be the largest source of candidates with 48 percent of the total registered for the June 2017 exam coming from the Asia Pacific region. In India around 1.87 lacs students enrolled for the CFA program examination in India for the period 2006 to 2017. However, due to the rigor of the exams, only a small percentage of candidate worldwide complete all the requirement to obtain the CFA designation. Currently, there are 2204 charter-holders residing in India. Additionally, plaintiff has 20 societies across Asia, including Indian Association of Investment Professionals doing business as CFA Society India with approx. 1,938 members established in April 2005.

8. It is averred that plaintiff today holds all rights, benefits and interests in connection with an arising out of the CFA certification program including all intellectual property rights therein.

9. It is the stand of the plaintiff that it is the exclusive proprietor of numerous CFA-formative marks, including CFA, C.F.A., CFA Digest, CFA Institute, CFA Society and Chartered Financial Analyst. It is also stated that CFA Marks are registered in the United States and dozens of other countries and most of these marks have been successfully used in over 200 countries for a number of years.

10. The plaintiff has also set out details of its trademark registration for the mark 'CFA' and / or pending applications in respect of various CFA Marks, including the marks 'CFA Institute' and 'Chartered Financial Analyst', 'CFA logo' in various classes of goods and services relevant to its CFA certification program, in India, as follows:

(a) Trademark

CFA

Application No

791235

Valid up to

February 12, 1998

Date

Class

9

Goods

Videotapes, audio tapes, sound recording and sound reproducing equipment and apparatus, compact discs, records (sound) and other goods falling in class 9

(b) Trademark

CFA

Registration No.

791236

Date

February 12, 1998

Valid up to

February 12, 2028

Class

16

Goods

Printed publications, printed matter, books, magazines, periodicals. Brochures, pamphlets, catalogues, booklets, bulletins, photographs, stationery, instructional and teaching material (other than apparatus); articles made of papers and cardboard, printed matter relating to computer hardware and computer software and other goods falling in class 16

(c) Trademark

CFA

Registration No.

1237947

Date

September 18, 2003

Valid up to

September 18, 2023

Classes

41 & 42

Services

Class 41: Educational services, arranging, conducting and providing courses of instruction, workshops, seminars and conferences in the field of financial analysis and distributing course materials in connection therewith. Class 42: Association services, promoting the interests of and professional standards in the field of financial analysis.

(d) Cert. Trademark

CFA Logo

Application No.

1321715

Date

November 23, 2004

Classes

36

Services

Financial services, namely, financial analysis, investment management security management and corporate finance.

(e) Trademark

Application No.

2301021

Date

March 16, 2012

Classes

16, 35 & 41

Goods & Services

Class-16:

Printed publications, namely, newsletters, brochures, books, digest books, and monographs in the fields of investment management and financial analysis and in support of the interests of investment professionals and financial analysts.

Class -35:

Association services, namely, the promotion of professional standards and practices and providing career information in the fields of investment management and financial analysis; promoting the interests of investment professionals and financial analysts

Class : 41

Educational services, namely, arranging, conducting, and providing courses of instruction, examinations, workshops, seminars and conferences in the fields of investment management and financial analysis and distributing course materials in connection therewith

(f) Trademark

CFA INSTITUTE

Application No.

235146 4

Date

June 21, 2012

Classes

09

Goods

Downloadable publications, in the nature of newsletters, magazines, books, digest books, and monographs and downloadable video and audio content, all in the fields of investment management and financial analysis

(g) Trademark

CFA

Registration No.

2680697

Date

February 17, 2014

Valid up to

February 17, 2024

Class

16

Goods

Printed publications, printed matters, books, magazines, periodicals, brochures, pamphlets, catalogues, booklets, bulletins, photographs, stationery, instructional and teaching material (other than apparatus); articles made of papers and cardboard, printing matter relating to computer hardware and computer software and other goods falling in class -16.

(h) Trademark

CFA

Registration No.

2680700

Date

February 17, 2014

Valid up to

February 17, 2024

Classes

41 & 42

Services

Class: 41

Educational services, arranging, conducting and providing courses of instruction, workshops, seminars and conferences in the field of financial analysis and distributing course materials in connection therewith.

Class: 42

Association services, promoting the interests of and professional standards in the field of financial analysis.

(i) Cert. Trademark

CFA

Application No.

3058414

Date

September 18, 2015

Class

36

Services

Financial and investment analysis services.

11. Thus, it is averred by the plaintiff that it is the exclusive proprietor of numerous CFA formative marks, including CFA, C.F.A., CFA Digest, CFA Institute, CFA Society and Chartered Financial Analyst in Classes 9 (videotapes, audiotapes, CDs, etc.), 16 (publication, printed material, etc.), 35 (association services), 41 (educational services), 42 (association services). It is also stated that the earliest registration in India dates back to February 12, 1998 and the earliest claim of use dates to August 31, 1981. Besides, CFA Marks are registered in several countries world wide including in UK, USA and EU.

12. To ascertain that it had presence on internet, it is stated that the plaintiff obtained registration of domain name <cfainstitute.org> <cfasociety.org> on November 30, 2006 and has been hosting corresponding websites at www.cfainstitute.org and www.cfasociety.org carrying updated information on the history and heritage of the plaintiff as well as requisite information pertaining to various programs provided by it to enable users across the world to access the same.

13. It is further averred that it had invested substantial sums of money in advertisements and sales promotions of its various products and services under the CFA marks around the world including India. Its expenses on print media as well as on digital media internationally for the period 2008 to 2016 was around

CS (COMM) 619/2018 Page 10 of 63

USD 215 Million (INR 1,525 Crores approx.). It is also stated that CFA designation is recognized by over 40 governmental bodies and regulatory agencies throughout the world. In India the CFA society has organized and continues to organize several educational sessions, conferences and events involving industry experts from all across India.

14. It is the case of the plaintiff that the reputation and goodwill of the CFA Marks worldwide is reflected in the annual revenues generated by the plaintiff. A tabulated statement for the period 2012 to 2016 is as follows:

Year

USD (in Million)

2016

283.0

2015

260.2

2014

240.9

2013

224.9

2012

220.1

15. It is also the case that the plaintiff has been proactively enforcing its exclusive rights in CFA Marks against any misuse of its statutory or common law rights since 1963 (through legal, actions, cease and desist letters, notices of oppositions before the Trade Marks Registry etc.). It is also stated that the plaintiff has been successful in protecting the plaintiff's rights and reputation in its marks before various Courts and Tribunals in jurisdictions throughout the world, including in India. It is pointed out in the plaint that this Court vide its order dated August 04, 2006 noted that "the marks CFA or CHARTERED FINANCIAL ANALYST are distinctive marks and even though the words CHARTERED, FINANCIAL and ANALYST are three generic and descriptive terms, their use in the given sequence and on account of their use for a long term, have acquired a secondary meaning and have become a trade mark entitled to protection."

16. It is therefore, the case of the plaintiff that (a) the plaintiff has exclusive rights in the CFA Marks by virtue of prior adoption and use thereof; (b) pursuant to the long, continuous and extensive use of the CFA Marks as aforesaid, high revenues and the substantial expenditure incurred in the promotion and advertisement worldwide, the CFA Marks are exclusively associated with the plaintiff's certification program, apart from being recognized as 'well-known trade mark' within the meaning of Section 2(l)(zg) and 11(6) of the Trade Marks Act, 1999 ('Trade Marks Act', for short). Therefore, no third party may be allowed to operate use a mark that is confusingly similar so as to ride upon the goodwill of the plaintiff's CFA Marks.

17. It is the case of the plaintiff that in May 2015, the plaintiff came across to trademark applications filed by the defendant that had been advertised in Trade Mark Journals. Details of these marks as appeared in the Trade Mark Journals are as follows:

App. No.

Trade Mark

App. Date

User Details

Services covered

Publication Details

2657928

Jan. 10, 2014

Dec. 23, 2009

[Class:41] educational institution, business school, providing education and training mainly in finance and other financial affairs including areas of credits, investment and risk management

Published in Journal No.: 1686-0 Dated: 30/03/2015

2657929

BFA

Jan. 10, 2014

Dec. 23, 2009

(Class:41) educational institution, business school, providing education and training mainly in finance and other financial affairs including areas of credits, investment and risk management

Published in Journal No.: 1685-0 dated 23/03/2015

18. It is the case that based on aforesaid details the plaintiff immediately proceeded to conduct some searches / investigations into the defendant which led the plaintiff to the defendant's website www.bfa-india.org. As per its website, the defendant offers a nine-month, weekend program in Finance for Graduates, Post Graduates and Working Professionals looking for an enriching career in Finance that is recognised by Brickwork Ratings, a SEBI registered Credit Rating Agency, accredited by RBI and empaneled by NSIC. The course covers areas in Finance namely, Credit Management, Investment Management and Risk Management. This course has been termed as 'Banking and Financial Analyst' by the defendant and is also referred to as the BFA program. While perusing the defendant's website, the plaintiff noted that the website bears reference to the plaintiff's CFA program at several places. In fact, the defendant offers a dual program, and in the description of the same the defendant explicitly stated that candidates with CFA are preferred. In addition, some of the faculty teaching the BFA course claimed to hold the CFA certification. Even a number of students enrolled in the defendant's BFA program were appearing for CFA examinations, as reflected on the student profiles uploaded on the defendant's website. The multiple references to the plaintiff's 'CFA' mark and the stark similarities in the programs offered attested to the fact that the defendant recognizes the reputation of the plaintiff's CFA program. A bare perusal of the website, thus, made it evident that the adoption of the mark 'BFA' by the defendant was a calculated attempt at taking advantage of the reputation gathered by the plaintiff and the 'CFA' mark over the years. Further, on the official Facebook page of the defendant, the defendant claims that its BFA Program is "similar to the American

CFA program". It is also relevant to state that the defendant's consumer base is the same as that of the plaintiff's. The defendant also markets its goods and services in the same trade channels. As such, consumers are likely to mistakenly believe that the defendant is affiliated or connected with, or otherwise authorized or sponsored by the plaintiff, thereby misleading the consumers. It is also stated that the investigation done by the plaintiff reveals that the defendant is using the mark 'BFA' as its tradename, as well as, as the name of a program offered by it, including the award of 'BFA' mark as a professional designation in the field of financial analysis and investment management to be used in the identical manner as the CFA designation. It is further stated that the defendant's brochure also bears reference to the plaintiff's CFA program while citing the additional subjects covered in the BFA program as compared to CFA. Therefore, it is the case of the plaintiff that the defendant is attempting to portray itself as an equivalent of the plaintiff's CFA program in India and attempting to ride upon the good will and reputation of the CFA program and the CFA Marks by confusing the public through the adoption and use of a confusingly similar designation.

19. The plaintiff thereafter, issued a cease and desist letter to the defendant on June 02, 2015 and as part of the requisitions in the notice, the plaintiff cautioned the defendant of the plaintiff's legal rights and calling upon them to refrain from using the mark 'BFA' and to withdraw the afore mentioned pending trademark applications.

20. It is averred that the plaintiff received a response dated June 22, 2015 from the defendant refusing to comply with the requisition in the cease and desist notice and further putting the plaintiff to proof of the reputation of the CFA Marks. Owing to the refusal of the defendant to resolve the matter amicably, the plaintiff filed notices of opposition on July 20, 2015 to the trade mark application no. 2657928 for the mark FINANCE FOR LIFE., and and trade mark application No.2657929 for the mark 'BFA' filed by the defendant. The plaintiff further addressed a letter dated July 24, 2015 offering the defendant to continue the use of the mark 'BFA' as part of its logo FINANCE FOR LIFE provided that the word 'BFA' is not used as a standalone mark, in order to avoid potential confusion when the 'BFA' mark is used as a designation in the identical manner to the CFA designation. The defendant vide letter dated September 03, 2015 refused to agree with the proposal and claimed that the marks 'CFA' and 'BFA' are phonetically different. Proceedings before the concerned Trade Mark Registrar are still ongoing.

21. It is alleged by the plaintiff in the suit as well as in this application that the adoption and use of the mark BFA by the defendant is deliberate and is calculated to give effect to its mala fide motive to ride upon the enviable reputation and goodwill of the plaintiff's well-known CFA Marks. Thus, it is the case of the plaintiff that these acts are actionable in law as they constitute infringement, passing off and unfair trade practice apart from being an offence under Sections 101 to 104 of the Trade Marks Act.

22. To establish trademark infringement, it is the case of the plaintiff that the mark 'BFA' is confusingly similar to the plaintiff's CFA Marks, the only difference being the replacement of the letter 'c' with 'b' (which letter immediately precedes 'c' in the English language alphabet) in relation to financial education services that are identical to the services offered by the plaintiff. It is further stated that the use of the mark 'BFA' is confusingly similar to the plaintiff's CFA Marks and appearance, sound, meaning and commercial impression and the use of this mark by the defendant in relation to services that are identical to those of the plaintiff is bound to cause confusing or an association amongst the purchasing public as well as members of trade as to the origin of the said services, which amounts to intentional and willful violation of the statutory rights of the plaintiff within the meaning of Section 29 of the Trade Marks Act.

23. To establish passing off by defendant, it is stated that; (a) plaintiff has along with its affiliate companies spent substantial money in the marketing of the well known CFA Marks, resulting in unparalleled goodwill and reputation so that anyone who sees the CFA Marks, would associate the same with the plaintiff's CFA program alone; (b) the defendant's use of the mark 'BFA' is confusingly similar to the plaintiff's well known CFA Marks in relation to identical services, has inherent in it a misrepresentation to the consuming public that defendant under the mark 'BFA' has an association or nexus with the plaintiff, when it is not the case; and (c) such misrepresentation is not only calculated to give unfair advantage to the defendant, and is likely to cause damage to the plaintiff's exclusive proprietary rights and goodwill in the CFA Marks, but is also likely to cause monetary loss to the plaintiff and plaintiff's business.

24. It is therefore, pleaded by the plaintiff that based on the facts and circumstances encapsulated in the plaint as well as in the application under Order XXXIX Rule 1 and 2, prima facie case in favour of the plaintiff exists as there is no plausible justification for adoption of the mark 'BFA' by the defendant except to ride upon the inviolable and worldwide reputation of the well known mark 'CFA' and plaintiff being the registered proprietor of the CFA Marks, balance of convenience also lies in favour of the plaintiff. It is also stated that plaintiff is likely to suffer irreparable harm, injury and monetary compensation alone would not be sufficient to redress the continuing harm resulting from the acts of infringement being committed by the defendant. Thus, the plaintiff is entitled to an order of ad-interim ex-parte injunction to protect goodwill and reputation of the plaintiff as well as its common law and statutory rights in the well-known CFA Marks and to restrain defendant from deceiving and causing grave loss and irreparable injury to the public at large.

25. Reply was duly filed by the defendant to I.A. 2460/2018. It is stated that the defendant is a society-(Non-Profit Organization) duly registered under the provisions of the Karnataka Societies Registration Act, 1960, founded by Mr. Vivek Kulkarni, IAS (Retd.) a former IT Secretary, Government of Karnataka. The defendant has also been granted approval under Section 80G (5) (vi) of the

Income Tax Act, 1961, making donations made to the defendant deductible from the tax liability. It is stated that the defendant society was established as a not for profit organization and for providing financial literacy services through all sections of the society.

26. It is the case of the defendant that the plaintiff's claim that the mark 'CFA' and the examination was first conducted in the year 1981 in Mumbai and has been held annually ever since is false as it is an admitted position that in 2007, the AICTE ('All India Council For Technical Education', for short), the statutory body for technical education in the Country, had debarred the plaintiff from carrying out any such examination as according to AICTE, the plaintiff had failed to abide by its guidelines.

27. It is averred by the defendant that the mala fide intent of the plaintiff is demonstrated by the mere fact that the plaintiff has failed to annex with the plaint or the application, the Counter statement (TM-6) filed by the defendant dated November 26, 2015 and the reply dated February 09, 2016 to the Examination Report dated January 19, 2015, with regard to the proceedings pending before Registrar of Trade Marks.

28. It is further averred that the reference made by the defendant in its brochure about plaintiff's program is a clear and bona fide attempt on the part of the defendant to highlight the differences between the two programs as well as the fact that there is no association of any kind between the programs offered by the plaintiff and the defendant. It is also stated that the use of the term 'CFA' to identify the other program is not in the course of trade but in a descriptive sense, which does not amount to infringement or passing off.

29. It is the case of the defendant that owing to the unexplained delay and laches in approaching this Court when admittedly, the plaintiff has been aware of the defendant's mark since 2015, the plaintiff is not entitled to any relief.

30. It is the case of the defendant that being the proprietor and the owner of a number of trade marks for its products and services, including 'BFA', 'BFA' is an acronym used by the defendant in relation to its nine months program / course, titled 'Banking Financial Analyst'. The acronym was adopted by the defendant in the year 2009 for its business and has been continuously used since adoption. The services rendered by the defendant under the trademark 'BFA' relate to educational institutions, Business Schools, providing education and training mainly in finance and other financial affairs including area of credit, investment and risk management. The defendant tabulated the difference between the courses offered by it and the plaintiff as under:

Particulars

BFA

CFA

Name of the Institute

Brickwork Finance Academy

CFA Institute

Domain Name

www.bfa-india.org

www.cfainstitute.org

Type of Institute

Non-Profit Organization

Non-Profit Organization

Name of Course

Banking & Analyst Brickwork

Program

Financial Program, Analyst

CFA Program, CIPM Program

Coursework

BFA Program focused on Investment Management, Credit Management and Risk Management

CFA Charter demonstrate your mastery of the investment analysis and decision-making skills most needed for a competitive career in global investment management profession.

Who is it for?

Candidates who are seeking analyst jobs in BFSI sector:

Indian/International Commercial and

Investment Banks, research and

information service providers, hedge funds. Mutual Funds, Insurance Companies, NBFC's BFSI wings of

IT firms, KPO, etc

Portfolios and wealth managers, investment and research analysts, professionals involved in the investment decision making process, and finance students who want to work in the investment management profession.

<http://www.cfainstitute.org/programs/comparison/Pages/index.asp> X.

Eligibility

Graduates in any discipline with a good academic record are eligible to apply for BFA Program.

Any of one: Undergraduate education/ 4 years of professional work experience/
a Combination of experience & education.

Validity

Lifetime

Needs continuing education (20

continuing education (CE) credits each Calendar Year)

Designation

None (only certification can be mentioned in the resume)

CFA (After completion of 3 levels)

Time to Complete the Course

9 months.

No restriction.

Number of Levels

2

3

Exam

3 hours X 2 exams on the same day

6 hours X 3 exams at a different point in time.

Pre requisite to take the next level exam

Both levels of exam need to be attempted once.

Unlimited attempts in each level

Exam Retake option

No.

Yes.

Fees

structure

One time exam fee

One time exam structure fee + Annual membership fee.

Fee Amount

Rs. 1.5 lakh (Inclusive of exam fee, training fee & materials)

Enrollment fee \$ 450 + \$ 650 (Early registration per level) Standard fee \$ 950/level/US\$ 1380 with late registration fee per level + \$ 75 Shipping fee + Membership fee

\$275/Annum

Mode of teaching

Classroom sessions, Harvard case studies.

Distance Education

Reading Material

List of recommended books

Proprietary Material printed materials/ebooks/CDs

Maximum intake

Limited

Unlimited

Membership to the Institute

No option

Mandatory

Candidate Screening

Yes.

No, anybody eligible can take the exam by paying the fee

On the job training

Yes

No

Job Guarantee

Yes (for those who pass DS Grade)

Claims that the course could help to get a job.

Recognition by the

Govt. in India

No.

No.

Recognition by the Universities in

India

No.

No.

31. It is the case of the defendant that the plaintiff has filed the suit only to harass the defendant and that there is no similarity or likelihood of confusion between the marks 'CFA' and 'BFA' as alleged by the plaintiff. When the marks, compared as a whole there is similarity neither visually nor phonetically. It is also the case of the defendant that it is important to take into consideration the class of the consumers / public towards whom the relevant goods / services are aimed at. In the present case, the services of the defendant being aimed at people who are highly educated, there is no scope for confusion as alleged, neither has the defendant received till date a single report / complaint or even a query from any prospective applicant or members of public in this regard.

32. It is the case of the defendant that owing to the quality of services offered, the mark 'BFA' and its accompanying logo have acquired significant amount of goodwill and reputation and that the trade partners and the competitors have associated the mark 'BFA' along with its accompanying logo with the defendant alone. Moreover, the defendant states that it has spent substantial amount of money towards advertisement, promotion and publicity of its mark 'BFA' and the accompanying logo. It is also stated that clients of defendant have repeatedly acknowledged the high-quality training and educational services provided by the defendant.

33. It is the case of the defendant that there is a significant difference in the courses / programs offered by the plaintiff and the defendant as defendant's program is focused on Investment Management, Credit Management and Risk Management whereas, the program of the plaintiff is aimed at mastery towards investment analysis and decision making skills which are needed for a competitive career in global investment management profession.

34. It is the case of the defendant that the fact that several customers / students of defendant's BFA program had prior to enrolling in the BFA program has also completed various levels of plaintiff's CFA course, is further demonstrative of the fact that there is no likelihood of confusion. Even some of the faculty members are 'CFA' holders.

35. It is denied by the defendant that the terms 'CHARTERED FINANCIAL ANALYST' and 'CFA' were first coined by the plaintiff's predecessor-in-interest and that the same have become well-known marks within the meaning of Section 2(1)(zg) of Trade Marks Act. Moreover, it is stated that 'CFA' is akin to a title or a

professional qualification, such as a CA, LL.B., M.B.A etc, over which there can be no monopoly. It is also stated by the defendant that the course or conduct of examinations in India by the plaintiff is a very recent phenomenon perhaps not prior to 2006 and that it is the admitted case of the plaintiff that number of people actually holding / carrying the plaintiff's qualification as on date is only 2204 and in 2006, this number was only 10.

36. It is the case of the defendant that the plaintiff is not the exclusive proprietor of numerous CFA formative marks including CFA, C.F.A., CFA Digest, CFA Institute, CFA Society and Chartered Financial Analyst and that even the accreditation offered by the plaintiff is aimed at misleading the general public of an association of some kind between the plaintiff and the Institute of Chartered Accountants of India, a statutory authority which is incorrect and cannot be permitted. It is also the case that the mention of plaintiff's course in defendant's website as 'candidates with CFA are preferred' is only aimed at drawing a clear distinction between the plaintiff's 'CFA' mark and the defendant's 'BFA' program. It is further stated that even the official Facebook page of the defendant claims that its BFA program is 'similar to the American CFA program' which clears any kind of confusion. Even the allegation of the plaintiff that the defendant uses in its brochure, plaintiff's mark 'CFA' to ride upon plaintiff's reputation is completely misconceived as the bare perusal of the entire statement and the context thereof demonstrates that it is bona fide on the part of the defendant to highlight the differences between the two programs and the fact that there is no association of any kind between the two.

37. It is the case of the defendant that there is no likelihood of monetary loss of any kind to the plaintiff or plaintiff's business, any damage to the plaintiff's rights and goodwill in the CFA marks owing to the defendant's use of the mark 'BFA'. Moreover, there is no infringement of the plaintiff's mark within the meaning of Section 29 of the Trade Marks Act and no valid cause of action in its claim for trade mark infringement or passing off. According to the defendant, since there is no prima facie case in favour of the plaintiff, balance of convenience is also not in its favour and no irreparable / grave loss or injury would be caused to the plaintiff or the public at large, plaintiff is not entitled to an order of injunction restraining the defendant from using the mark 'BFA' in any manner whatsoever.

38. Rejoinder was also filed on behalf of the plaintiff to the reply of the defendant, wherein it is stated that even though, the AICTE vide its order dated May 18, 2007 had directed the plaintiff to cease all operations in India, this Court vide order dated May 18, 2007 in W.P. (C) 4037/2007 was pleased to stay the said order issued by AICTE. Even an appeal was preferred by the plaintiff, being LPA No. 53/2008 against the order by the learned Single Judge dismissing the writ petition. However, during the pendency of the appeal, the Division Bench vide interim orders dated May 2008, April 2009, March 2010 and August 2011 permitted and allowed the plaintiff to conduct examinations in India. Subsequently, an Executive Committee formed by AICTE by its decision taken on

March 20, 2012 held that CFA program need not be regulated by AICTE and based on this report, the Division Bench of this Court vide order dated April 17, 2012 made an observation that order dated May 18, 2007 issued by the AICTE would not stand.

39. It is the case of the plaintiff that claim of the defendant that 'CFA' marks of the plaintiff were not sighted in the examination report issued by the Trade Mark Office while examining the 'BFA' applications cannot be the test for the comparison of marks.

40. It is the case of the plaintiff that defendant's claim of honest adopter and concurrent user of the mark under Section 12 of the Trade Marks Act is not applicable as there has been blatant dishonest adoption of the mark. It is the admitted case of the defendant that it has been using the mark 'BFA' since 2009 subsequent to plaintiff's use of mark 'CFA' from 1963 internationally and 1981 in India and moreover, Section 12 of the Trade Marks Act is only a provision enabling the Registrar of the trade marks to permit registration of two or more similar marks on certain conditions and limitations and cannot be construed as a valid defence against a claim of trade mark infringement.

41. The defendant in its application being IA 14173/2018 filed under Order XIII A of the CPC seeking summary judgment has stated out that the expression 'CFA' forming the basis of plaintiff's claim is not entitled to any trade mark status, notwithstanding any registration by the Trade Mark registry, being admittedly intended by the plaintiff to be a 'profession designation' similar to FRCS, FRCP, MBA, MBBS, CA etc. and hence, not indicative of any product or services. Defendant relies upon the orders of this Court from earlier litigations to submit that 'CFA' is not a trade mark or service mark but a designation of a qualification that is achieved after partaking in exams conducted by the plaintiff. In effect, any person who pays the plaintiff fees and writes their test is entitled to call himself / herself a CFA or Chartered Financial Analyst describing the alleged profession qualification they have obtained. It is also stated that the plaintiff apparently changed their name to CFA Institute only in May 2004 and prior to this based on its own admission, were operating under different identities.

42. It is further the case of the defendant that the plaintiff's use of the expression 'CFA' was not continuous in India as stated in paragraph 29. It is the case of the defendant that based on plaintiff's own admission before Judicial authorities, it is not providing any services mentioned under Class 41. Defendant relies on the excerpts of submissions made on behalf of the plaintiff in judgment in W.P.(C) 4037/2007, wherein it was stated that the plaintiff is 'not conducting any program or education, research and training in India' and claims that the plaintiff made contrary submissions before the Trade Mark registry to secure registration under Class 41.

43. It is further the case of the defendant that the trade mark 'BFA' is a recognized and permitted use of an acronym of the name of the defendant

Brickwork Finance Academy and has been in continuous use since the year 2009 along with its logo FINANCE FOR LIFE. It is also stated that there is no identity or visual or phonetic similarity between the trade marks of the defendant and the expression 'CFA' which is purportedly used as an accreditation or logo by the plaintiff and relies upon a comparative table as provided below.

DEFENEDANT

PLAINTIFF

BFA

CFA

44. Based on the above table, it is contended that there is no scope or chance for any confusion as the target audience of the plaintiff's courses are highly skilled professionals with prior qualifications of graduate degrees in finance or Business Administration or work experience in finance sector of at least four years. Hence, there is no likelihood of such persons who seem to have high level of intelligence and technical knowledge specific to the trade ever being confused between plaintiff's expression 'CFA' and defendant's mark. It is also stated that even though both the programs fall under the same class of services, both the programs differ drastically from each other as plaintiff provides a certification / qualification, whereas the defendant does not provide any such certification / qualification, mode of instruction for defendant's program is class room based whereas plaintiff's CFA program is conducted online / online materials, and if a person fails in the 'BFA' exams, the individual cannot partake in the exam again, which is not the case for plaintiff's 'CFA' accreditation program.

45. It is also the case of the defendant that the plaintiff has not made out a case to support its claim of passing off or actual confusion by the use of defendant's mark apart from averments regarding 'potential confusion'.

46. Reply to the defendant's application under Order XIII A CPC was duly filed by the plaintiff, wherein plaintiff reiterated its case as laid down in the plaint, application under Order XXXIX Rule 1 & 2 CPC as well as in the rejoinder and vehemently objected to the defendant's prayer for a summary judgment under Order XIII A of the CPC.

SUBMISSIONS:-

47. Mr. Sanjeev Sindhvani, Ld. Sr. Counsel appearing for the plaintiff, at the outset submits that plaintiff would be willing to allow the defendant to use logo FINANCE FOR LIFE. provided the defendant agrees not to use the standalone word mark 'BFA', which proposal was declined by the learned counsel appearing for the defendant. Mr. Sindhvani also agreed not to rely upon certification trade mark registration under Class 36 as listed at serial numbers (d) and (i) at paragraph 10.

48. It was submitted by Mr. Sindhvani that the mark 'CFA' is infringed by the use

of the mark 'BFA' by the defendant under Section 29(2)(b) of the Trade Marks Act, as the mark BFA was similar to the registered trademark 'CFA' of the plaintiff and was being used in relation to identical services, being educational services (which services are specifically covered under the trademark registrations of the Plaintiff). It was contended by Mr. Sindhwani that the marks were visually, structurally and phonetically similar. It was also stated that the plaintiff has established that the CFA marks are exclusively associated with plaintiff and have come to be known as well-known marks and in fact, this Court, upholding the plaintiff's rights in the CFA Marks, had held that the mark CFA has acquired a secondary meaning and has become a trade mark entitled to protection.

49. Mr. Sindhwani also stated that defendant on its website and its brochure clearly makes references to plaintiff and the CFA program, stating that 'BFA' is similar to 'CFA' and that candidates with CFA qualification are preferred. It was claimed by him that by making such references, the defendant acknowledges and admits the reputation of the plaintiff in its CFA Marks as well as by such references, the defendant advertises and entices the public into believing that an association exists between plaintiff and the defendant and their respective CFA & BFA programs, when none exists. Conduct of the defendant is thus clearly to trade off on the reputation of plaintiff's well-known CFA Marks and this form of association is known as injurious association and has been held to be violative of plaintiff's right. In support of his submission, he has relied upon a Division Bench judgment of this Court in B.K. Engineering Company, Delhi vs. U.B.H.I. Enterprises (Regd.) Ludhiana and another, AIR 1985 Delhi 210.

50. He further went on to rely upon a Supreme Court judgment in the case of Toyota Jidosha Kabushiki Kaisha vs. Prius Auto Industries 2018 (73) PTC 1 (SC) and Laxmikant V. Patel vs. Chetanbhat Shah 2002 (24) PTC 1 (SC), to contend that actual confusion is not required to establish for infringement or passing off. He has also relied upon the following judgments to contend that Courts have been consistent in protecting abbreviated / alphabetical marks from being infringed / passed off / diluted.

1. DPS World Foundation vs. Delhi Public School Society 2017 (70) PTC 263 (Del);
2. Aktiebolaget SKF vs. Rajesh Engineering Corporation 1996 PTC (16) Delhi;
3. Larsen and Toubro Ltd. vs. Lachmi Narain Trades 2008 (36) TC 223 (Del);
4. H&M Hennes & Mauritz AB vs. HM Megabrands Pvt. Ltd. 2018 (74) PTC 229 (Del);
5. The General Electric Company vs. Pyara Singh & Ors.;AIR 1974 PH 14 (DB)
6. Inter IKEA Systems BV vs. Annanya Gautam 2018 IXAD (Delhi) 237;
7. S. Mehar Singh vs. M.L. Gupta & Co. 1997 (17) PTC 660 (Del);
8. Hind Cutlery House vs. Malik Bartan Bhandar 2003 (26) PTC 344 (Del);

9. NIIT Ltd. vs. NIT 1996 (16) PTC 217 (Del);

10. Ram Kishan & Sons Charitable Trust vs. ILM Consulting Pvt. Ltd. 2017 (70) PTC 529 (Del);

11. Inter IKEA Systems BV vs. AKEA Furniture Soln., CS (COMM) 500/2017, order dated July 31, 2017.

51. He also submitted that the plaintiff has been conducting the CFA examinations in India continuously and uninterruptedly, denying the allegation made by the defendant that AICTE vide order dated May 18, 2017 directed plaintiff to cease the operation. In support of his contention, he has drawn the attention of this Court to orders passed by the Coordinate Bench in W.P.(C) 4037/2007 as well as orders of the Division Bench in LPA 53/2008 in particular order dated April 17, 2012, wherein observation was made by the Division Bench that order dated May 08, 2007 issued by AICTE would not stand in terms of the AICTE, Executive Committee order dated March 20, 2012.

52. It was also averred that the stand of the defendant that the marks were not cited/reported in the examination report of the defendant's mark by the Registrar, was not a test of comparison between the both the marks. He further stated that the approval of defendant's course/program by various other statutory authorities (eg. SEBI, RBI, authorities under Income Tax Act etc.) for using the mark 'BFA', were only for the limited purposes as completed within their ambit, and that the right to use a name or mark was solely governed by the specialized statute i.e., Trade Marks Act. In support of his submission he has relied on a Coordinate bench judgment of this Court in Living Media India Limited v. Jitender V Jain & Anr., 2002 (25) PTC 61 (Del).

53. Further Mr. Sindhwani, while contesting the argument of the defendant the stand of its honest adoption of the mark BFA, stated that the defendant's admitted use of its mark 'BFA' since 2009 is subsequent to the plaintiff adoption / use of its mark 'CFA' since 1963 internationally and since 1981 in India and that even honest adoption is not a defense to a claim of infringement or passing off. In support, he has relied upon the Apex Court judgment in Laxmikant V. Patel v. Chetanbhat Shah & Anr., 2002 (supra).

54. He submitted that the present case falls under the ambit of Section 29(2) of the Trade Marks Act, which stipulates that a mark which is similar to the registered mark and is used in respect of identical similar services as that covered under the registration would amount to infringement if such use is likely to cause confusion or is likely to create an association with the registered mark, and the test as per Section 29(2) is that of 'confusion' and 'association' and not that of 'deceptive similarity'. The test of 'confusion' stands at a much lower pedestal as compared to test of 'deception', as 'deception' requires misrepresentation or making a false statement whereas 'confusion' could occur even when a person makes a true statement. Insofar as term 'association' is concerned, Mr. Sindhwani submitted that the term being not defined in the Trade

Marks Act, one has to go by the dictionary meaning of the word 'association' which means 'any group of people who have joined together for a particular purpose', and it is his contention that people/public may make association between CFA and BFA even if they believe that the two courses are not the same. Placing reliance on B.K. Engineering Company (supra) and Laxmikant V. Patel (supra), he stated that such injurious association has been held as unfair by the Courts much prior to the same receiving statutory recognition under the Trade Marks Act. Thus, it was his submission that because of the close proximity with the mark 'CFA', the consumers are likely to be confused or at-least link an association between the marks 'CFA' and 'BFA', amounting to infringement under Section 29 (2) of the Trade Marks Act. To cement his stand, he refers to a Coordinate Bench judgment of this Court in *The Royal Bank of Scotland Group Plc. v. Sharekhan Ltd.*, 2015 (61) PTC (Del). He further submitted that defendant is silent on the test as laid down in Section 29(2) and therefore it amounts to conceding to the plaintiff's case of infringement under the said Section.

55. It was submitted by Mr. Sindhvani that the defendant's stand/argument that owing to the educational/professional qualifications of target audience for the 'CFA' and BFA programs, they would be able to distinguish between the respective courses of the parties is concerned, it would not hold good as the Courts have repeatedly held that the mere fact that the customers are sophisticated, knowledgeable does not rule out the element of confusion. He also submitted, because of the similarity between the two marks, there exists a likelihood of initial confusion amongst the customers to mislead them into an initial interest even though they discover at a later stage that the two entities/marks are different and that this initial interest caused by the initial confusion owing to the similarity of the marks amounts to infringement and passing off. Moreover, it may entice the public/target audience to think that defendant's BFA program is a customized version for Indian students of the plaintiff's well-known CFA program. He has relied upon of the Supreme Court judgment in *Baker Hughes v. Hiroo Khushlani*, 2004 12 SCC 628, to support his submission.

56. It was contended by Mr. Sindhvani that the defendant's claim of usage of plaintiff's 'CFA' mark in its website/ brochures is not in trademark sense but in a descriptive manner to draw a distinction between the marks as envisaged in Section 30 of the Trade Marks Act, was never contested in the written statement and the same is a new plea /stand taken at the stage of arguments.

57. Against the stand taken by the defendant that the plaintiff's mark came into existence only in 2004 and that its has not filed any document to evidence its goodwill, it was argued by Mr. Sindhvani that the same was never disputed by the defendant in its Written Statement nor were any averments made against the stand taken by the plaintiff that its mark 'CFA' was a well known mark within the ambit of Section 2(1)(zg) of the Trade Marks Act and in fact defendant acknowledged the goodwill of the plaintiff's well-known mark 'CFA' by stating that candidates with CFA qualifications are preferred in brochures/website.

Moreover, defendant has also admitted that its revenue was merely a fraction of plaintiff's revenue as well it was argued on behalf of the defendant that relevant consumers know about CFA and BFA and would not be confused. In other words, Mr. Sindhvani argued that the defendant should be estopped from arguing that the mark 'CFA' does not have any goodwill in India.

58. It was further submitted by Mr. Sindhvani that the defendant has also applied for registration of the mark 'BFA' in relation to a program which is similar to the CFA program, having course content similar to the CFA program and having attempted to monopolize the mark in relation to a program similar to that of the plaintiff, the defendant cannot argue or take a stand to claim that the mark 'CFA' cannot be monopolized. He has relied on *Automatic Electric Limited v. R.K. Dhawan*, 77 (1999) DLT 292, and *Procter & Gamble Manufacturing (Tianjin) Co. Ltd. v. Anchor Health & Beauty Care Pvt. Ltd.*, 2014 (59) PTC 421 (DLI) (DB); to contend that defendant cannot be allowed to approbate and reprobate.

59. Mr. Sindhvani further submitted that plaintiff's Trademark & Certification registrations for the CFA Marks are valid and defendant has not challenged the same and that the defendant's counsel did not even argue that the registrations for the CFA Marks are invalid. He submitted that Section 31 of the Trade Marks Act, creates a presumption as to the prima-facie validity of the registered trademarks. Under Section 124 of the Trade Marks Act, the validity of a registered trademark is rebuttable only if the defendant satisfies to the court that the registration in favour of the plaintiff is prima-facie invalid. If the Court is satisfied that the plea of invalidity of the plaintiff's registered mark is tenable, then the Court will frame an issue in that regard and allow the defendant to approach the IPAB to seek cancellation of the Plaintiff's registration. It is settled that a civil court cannot determine the validity of the trademark and that IPAB's decision regarding the same is binding on the parties before the civil court. If the defendant does not take steps as envisaged under Section 124 of the Trade Marks Act, then its plea regarding invalidity of the plaintiff's registered trademark is deemed to be abandoned. He anchors his submission on the Supreme Court judgment in *Patel Field Marshal Agencies v. P.M.Diesels Ltd.*, (2018) 2 SCC 112. Thus, he submits that the defendant has abandoned its plea of invalidity, as the defendant in the present case has sought for a summary judgment, prior to framing of issues.

60. It was submitted by Mr. Sindhvani, there was no question of any delay or laches in the present case as the plaintiff has taken necessary action as soon as it came to the knowledge of existence of defendant's BFA mark and the proceedings are pending before the Registrar. Moreover, it was submitted that the Apex Court has held, in the case of *Midas Hygiene Industries Pvt. Ltd, v. Sudhir Bhatia*, (2004) 3 SCC 90; that delay is inconsequential in a case of infringement/passing off, especially where the adoption is in bad faith. Further, it was submitted by Mr. Sindhvani that case laws/precedents relied upon by defendants were not applicable in the present set of facts, as it was well settled

by Supreme Court in *Deepak Bajaj v. State of Maharashtra*, (2008) 16 SCC 14; that a little difference in facts or additional facts may make a lot of difference in the precedential value of a decision.

61. On the other hand Mr. J Sai Deepak, learned counsel appearing on behalf of the defendant at the outset submitted that the plaintiff's oral request for an 'oral application' under Order XIII A for a summary judgment against the defendant is not permissible under the CPC as modified by the Commercial Courts Act or under the CPC as modified by the Commercial Courts Act or under the Delhi High Court Rules for a party to move an 'oral application' for summary judgment in Commercial Suits. He submitted that the Court may suo moto take up the matter for summary judgment, however a party may invoke Order XIII A only through an application by complying the procedure laid down in Order XIII A. In other words, it was his submission that the plaintiff cannot on one hand raise procedural objections to defendant's application under Order XIII A and at the same time make an 'oral application' for summary judgment against the defendant. He also went on to submit that if the defendant's application under Order XIII A is allowed, it would automatically render the plaintiff's application under Order XXXIX Rule 1 & 2 for interim injunction infructuous.

62. Mr. Sai Deepak, submitted that in the light of plaintiff relinquishing its claim against infringement of its certification marks as well as its claim of dilution alleged against the defendant, the only issue which arises for adjudication in respect of both the applications is whether the defendant's use of 'BFA' as a trade mark constitutes infringement of plaintiff's registered non-certification marks within the meaning of any limb of Section 29 of the Trade Marks Act and whether such use amounts to passing off as well.

63. To demonstrate its case for summary judgment for dismissal of the suit in so far as the claim of passing off was concerned, Mr. Sai Deepak contended that:

(i) An action for passing off is based on demonstration of goodwill in the jurisdiction where passing off is alleged. Importantly, there is a recognized distinction in law between 'goodwill' and 'reputation'. It is establishment of goodwill at the relevant point in time within the jurisdiction where passing off is alleged which sustains a claim of passing off. The existence of such goodwill in favour of the plaintiff prior to the adoption of the mark by the defendant must be demonstrated through the extent of sales and advertising expenses incurred. This is the law laid down by a Division Bench of this Court in Paragraphs 17-20 of *Intex Technologies (India) Ltd & Anr. v. M/s AZ Tech (India) & Anr.*, 2017 (70) PTC 118 (Del). Applying this to the facts of the instant case, upon a perusal of every document filed by the plaintiff in the suit, it becomes evident that the plaintiff has not filed a single document relating to either sales or advertising expenses which relates to a period prior to the adoption of "BFA" by the Defendant i.e. before December 2009.

(ii) In *Intex Technologies (India) Ltd.*(supra), it was also held that if there is

"added matter" which removes the scope for confusion between the marks, a case for passing off is not made out. Further, the Apex Court in *M/s Nandhini Deluxe v. M/s Karnataka Cooperative Milk Federation*, AIR 2018 SC 3516, held that in the determination of phonetic and/or visual similarity, added factors must be given due regard. Drawing inference from these judgments it was submitted by Mr. Sai Deepak that there is sufficient 'added matter' in the defendant's mark which clearly precludes any 'likelihood of confusion' wherein likelihood refers to a real probability and not theoretical possibility. He also relied on the law laid down by the Apex Court on comparative referencing in the case of *Tata Press Limited v. MTNL* AIR 1995 SC 2438. In support of his contention he has drawn the attention of this Court to the table as reproduced below:

DEFENDANT

PLAINTIFF

BFA

CFA

(iii) The Apex Court in *Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd.*, AIR 2001 SC 1952, held that in an action for passing off, to decide the question of deceptive similarity, the following factors must be considered:

- a. The nature of the marks i.e. whether the marks are word marks or label marks or composite marks;
- b. The degree of resemblance between the marks;
- c. The nature of the goods or services in respect of which the marks are used as trademarks;
- d. The similarity in the nature, character and performance of the goods of the rival traders;
- e. The class of purchasers who are likely to buy the goods or avail the services bearing the marks-their education and intelligence and a degree of care they are likely to exercise in purchasing and or using the goods or availing the services;

It was submitted by Mr. Sai Deepak that by placing reliance on plaintiff's documents on record, it becomes abundantly clear that the plaintiff has failed to prove the satisfaction of any of the aforesaid factors as (a) the competing marks are composite in nature and do not resemble each other, (b) the nature of services provided by both parties are sophisticated and cater to an extremely educated and presumably intelligent group of graduates, and (c) the brochure of the Defendant clearly speaks of 'CFA' as a program or a qualification, and not in a trademark sense. He further submitted that use of a mark in its nominative sense is protected by this Court in terms of the judgment of Co-ordinate bench in the case of *Tata Sons Limited v. Greenpeace International & Anr.*, 178 (2011) DLT 705.

(iv) It was contended by Mr. Sai Deepak that the plaintiff changed its name to 'CFA Institute' only in May 2004, and prior to this the 'CFA' was admittedly referred only as a designation, therefore any use of 'CFA' prior to 2004 was not in the trade mark sense and cannot inure to plaintiff's benefit for its trade mark claim. Moreover, it is his claim that in paragraph 8 of the plaint, the plaintiff states that Brickwork Finance Academy or BFA is a flagship of Brickwork, "a prominent group of companies in the field of business research and finance", which negates the plaintiff's claim that 'BFA' was coined to ride on the coattails of goodwill and reputation of the plaintiff and its mark 'CFA'. It was also stated that the defendant had used 'Brickwork' in the context of its own ratings agency, namely Brickwork Ratings India Pvt. Ltd., since 2007 and was therefore justified in using Brickwork in the context of BFA.

(v) It was submitted by him that the plaintiff's only grievance is that alphabet 'B' is close to alphabet 'C' and therefore 'BFA' is deceptively similar to 'CFA'. Going by this logic of the plaintiff, every other alphabet in the English language other than 'C' cannot be used along with 'FA' in order to protect the plaintiff's rights. Mr. Sai Deepak submitted this to be a patently absurd position since Finance Academy being a generic combination and there may be any number of institutions with the appellation Finance Academy. It was also submitted that the services offered by both parties being extremely advanced programs and caters to a highly educated group who understand the distinction between CFA and BFA and their respective programs.

(vi) While stating that in a broad sense both plaintiff and defendant are in said to be in the 'financial services sector', he drew the attention of the Court to paragraph 15 of the Written Statement (as reproduced at paragraph 30) where the key differences between both the programs are stated as (a) plaintiff does not offer classroom courses, defendant does; (b) plaintiff admittedly uses 'CFA' as a designation, defendant does not offer a 'BFA' certification, (c) plaintiff's program can be taken at any point of time and repeatedly by payment of fees, whereas defendant's program was a one-time program with no re-take option. Thus, it was his submission that the two programs are evidently different with different target audience.

(vii) Mr. Sai Deepak submitted that since defendant's existence since 2009 and also since the institution of the suit, the plaintiff has failed to place before the Court even a single instance of confusion as alleged in the suit/application. He further submitted that even though notices against defendant's mark were issued by the plaintiff in 2015, the present suit is filed only in 2018 and failed to demonstrate even a single instance of confusion in the said period. Moreover, the plaintiff is precluded by delay from seeking interim injunction.

(viii) He also vehemently contested the plaintiff's submission that 'Brick' and 'Work' are two separate words and the suggestion that the defendant should have chosen 'BWFA' as acronym, by stating that 'Brickwork' is single word and he has placed reliance on authoritative dictionaries such as oxford, Merriam-Webster

etc. That apart he also submitted that the plaintiff's stand of letting defendant use the logo with 'BFA' was befuddling as if the plaintiff believed 'BFA' is confusingly similar to 'CFA', then plaintiff shouldn't be permitting defendant to even use it in its logo.

64. Further, Mr. Sai Deepak submitted that, a reading of Section 29(1) makes it abundantly clear that for the provision to be attracted, the defendant must use an identical or deceptively similar mark in the course of trade in relation to goods or services in respect of which the plaintiff's mark is registered and the manner of use by the defendant must constitute use in a Trade Mark sense. In the facts of this case, it was his claim that the competing marks were neither identical or similar as explained by him in the context of passing off, nor was the use of CFA program in the defendant's brochure is in a trade mark sense and therefore, the conjunctive requirements of Section 29(1) have not been satisfied by the Plaintiff. He also stated that in terms of judgment of the Supreme Court in the case of Kaviraj Pandit Durga Dutt Sharma v. Navaratna Pharmaceutical Laboratories, (1965) 1 SCR 737, the test of deceptive similarity, in particular the class of customers, remains the same for infringement and passing off. Reliance is also placed on a Co-ordinate Bench judgment of this Court, in the case of Godfrey Phillips India Ltd. v. P.T.I. Ltd. & Ors., 2018 (73) PTC 178 (Del), wherein the Court while allowing an application for summary judgment against the plaintiff under Order XIII A, held in the context of cigarettes that the class of consumers was a relevant factor in determining deceptive similarity, to contend that defendant's position with respect to class of customers for the purpose of deceptive similarity in the context of an action for passing off is equally valid and applicable to the plaintiff's claim of trade mark infringement.

65. He also contended that Section 29 (2) of the Trade Marks Act does not apply since the trade marks are not identical in terms of Section 29(2)(a); trade marks are not similar in terms of Section 29 (2)(b) and Section 29(2)(c) does not apply since the trade marks are not identical and there is no likelihood of confusion or association as contended above. Further, it was contended that Section 29(2) clearly envisages use of a mark in its trade mark sense, which does not apply to the facts of the present case.

66. Having heard the learned counsel for the parties, the issue which arises for consideration in these applications is whether the plaintiff is entitled to injunction in its favour against the defendant for the usage of defendant's device mark (logo) with BFA and the word mark 'BFA' or the suit of the plaintiff is liable to be dismissed by granting the prayer as sought for by the defendant in its application under Order XIII A CPC.

67. To answer these questions, it has to be seen whether the defendant's use of BFA mark is infringing the plaintiff's registered mark CFA. The submissions of Mr. Sindhwani in support of the application under Order XXXIX Rules 1 and 2 can be summarized as under:

(i) The use of mark 'BFA' by the defendant constitutes infringement under Section 29(2)(b) of the Trade Marks Act as the mark is similar to registered mark 'CFA' of the plaintiff, which is a prior adoption; (ii) The defendant is using the mark 'BFA' in relation to identical services being educational services; (iii) The marks are visually, structure and phonetically similar; (iv) The 'CFA' mark of the plaintiff is exclusively associated with plaintiff and is a well-known mark, in other words, the mark 'CFA' has acquired a secondary meaning; (v) The defendant on its website and brochure clearly makes references to plaintiff and CFA program stating BFA is similar to CFA and candidates with CFA qualification are preferred; (vi) By representing so, the defendant acknowledges and admits the reputation of the plaintiff in its CFA marks; (vii) It also entices the public into believing that an association exists between the plaintiff and defendant and their respective CFA and BFA programs; (viii) The conduct of the defendant is clearly to trade off on the reputation of plaintiff's well-known CFA marks; (ix) The actual confusion is not required to be established for infringement or passing off; (x) The plaintiff has been conducting the CFA examination and denied the plea of the defendant that AICTE had directed the plaintiff to cease the operation; (xi) the plaintiff adoption / use of the mark is since 1963 while that of the defendant is from 2009.

68. On the other hand, the submissions of Mr. Sai Deepak for the defendant are the following:

(i) The action for passing off is based on demonstration of goodwill through the extent of sales and advertising expenses incurred; (ii) Not a single document has been filed relating to sales and advertising expenses for the period prior to December 2009; (iii) There is a sufficient added matter in the defendants' mark which clearly precludes any likelihood of confusion; wherein likelihood refers to real probability and not theoretical possibility; (iv) The nature of services provided by both parties are sophisticated and they cater to extremely educated and presumably intelligent group of Graduates; (v) The competing marks are composite in nature and do not resemble each other; (vi) The brochure of the defendant clearly speaks of CFA as a program or a qualification and not in a trademark sense; (vii) Not even a single case of confusion has been placed by the plaintiff.

69. Having noted the broad submissions of the counsel for the parties, it is noted that the suit filed by the plaintiff is both for infringement and passing off of the trade mark 'CFA'. For establishing the case of infringement, the plaintiff's mark being registered as 'CFA', it has to be proved that the defendant's mark is identical with or deceptively similar to the plaintiff's registered mark; the defendant's use of the mark is in the course of trade in respect of goods and services covered by the registered trademark; the use of the mark by the defendant is in such a manner so as to render the use of mark likely to be taken as being used as a trademark; the defendant use of the mark is not by way of "permitted use" and accordingly unauthorized, infringing use.

70. Having said that in an action for infringement where the defendant's trade

mark is identical with plaintiff's mark, it is not necessary to enquire whether infringement as such is likely to cause confusion, but where the alleged infringement consists of using not the exact mark on the register but something similar to it, the test of infringement is same as in an action of passing off. In other words, the test as to likelihood of confusion or deception arising from similarity of marks is the same both in infringement and passing off actions. (Reference: Ruston and Hornsby Ltd. v. Zamindara Engineering Company, (1969) 2 SCC 727, Biofarma & Anr. v. Sanjay Medical Store & Ors., (1997) 66 DLT 705, Saville Perfumery Limited v. June Perfect Limited, 1941 (58) RPC 147)

71. In the present case the mark 'CFA' is an abbreviation of the word 'Chartered Financial Analyst'. Similarly, 'BFA' is an abbreviation of 'Brickwork Finance Academy', the institution and 'Banking Financial Analyst', a course conducted by the defendant.

72. It is trite law, as held by the Apex Court in *Amritdhara Pharmacy v. Satyadeo Gupta*, AIR 1963 SC 449, inter-alia that it should be the overall structural and phonetic similarity that needs to be considered in coming to a conclusion whether the marks are deceptively similar or not. Having noted the position of law and as to what constitutes infringement / passing off, it is seen in the case in hand, the mark of the plaintiff is 'CFA' whereas the impugned mark is 'BFA'. Apparently, I am of the view that the marks are not identical. So, it is not a case of infringement of the mark 'CFA'. The marks not being identical, the question that arises then would be whether there is likelihood of confusion or deception arising from similarity of marks. Section 2(1)(d) of the Trademark Act defines deceptive similarity to mean, 'a mark shall be deceptively similar to another mark if it is so nearly resemblance that other mark as to be likely deceive or cause confusion'.

73. The division Bench of Bombay High Court in *Hiralal Prabhudas v. Ganesh Trading Co.*, AIR 1984 Bom 218, by relying upon the Judgments of the Supreme Court in *Corn Products Refining Co. v. Shangrila Food Products Ltd.*, AIR 1960 SC 142 and *Amritdhara Pharmacy* (supra), has summarized the principles for deceptive similarity as, (a) what is the main idea or salient features, (b) marks are remembered by general impressions or by some significant detail rather than by a photographic recollection of the whole, (c) overall similarity is the touchstone, (d) marks must be looked at from the view and first impression of a person of average intelligence and imperfect recollection, (e) overall structure, phonetic similarity and similarity of idea are important and both visual and phonetic tests must be applied, (f) the purchaser must not be put in a state of wonderment, (g) marks must be compared as a whole, microscopic examination being impermissible, (h) the broad and salient features must be considered for which the marks must not be placed side by side to find out differences in design and (I) overall similarity is sufficient. In addition, the nature of the commodity, the class of purchasers, the mode of purchase and other surrounding circumstances must also be taken into consideration. In fact, similar is the test laid down by the Apex Court in *Cadila Health Care Ltd.* (supra) and the same has

been relied upon by Mr. Sai Deepak in his submissions.

74. Undisputedly, the essential function of a trademark is to guarantee the identity of origin of the mark goods or services to the customer or enabling him without any possibility of confusion to distinguish the goods or services from others which have another origin as inter-alia held by the Court of Justice of the European Economic Community in the case of Hoffmann-La Roche, (1978) ECR 1139.

75. The Supreme Court in the case of F. Hoffmann-La Roche & Co. Ltd. v. Geoffrey Manners & Co. Pvt. Ltd., AIR 1970 SC 2062, wherein the marks 'PROTOVIT' and 'DROPOVIT' of the respective parties therein were held to be not deceptively similar even though the last three letters were common as there existed sufficient difference in the uncommon part of the two marks, 'PROTO' and 'DROPO', both visually and phonetically.

76. Similarly, in Ciba Geigy Ltd. v. Sun Pharmaceutical Industries, (1992) 2 GLR 1053, the Gujarat High Court has held that the marks 'CLOFRANIL' and 'ANAFRANIL' are not deceptively similar as the three letters in the beginning of the said marks being 'CLO' and 'ANA' are pronounced differently. Likewise is the line of reasoning given by a division bench of the Madras High Court in Mount Mettur Pharmaceuticals Ltd. vs. Ortha Pharmaceuticals Corporation, AIR 1975 Mad 74, while holding the marks 'Ortho-Gynol' and 'Utogynol' to be not deceptively similar as the first two syllables of the word are most important in the normal enunciation of words and the accentuation would be upon the first word 'Ortho' or 'Uto' and not on the second word 'Gynol'. Even it is stated in Kerly's Law of Trade Marks and Trade-names; Eleventh Edition, para 17-20 page 416, that 'the first syllable of word mark is generally the most important' as there is a 'tendency of person using the English language to slur the termination of words'.

77. In fact, this Court in Biofarma and Anr. v. Sanjay Medical Store and Ors., 1997 SCC Online Delhi 359, while dealing with deceptive similarity of the marks 'flavedon' and 'trivedon', has held the marks to be dissimilar, as the opening syllable of the two marks are completely different and distinct in appearance as well. The Court has also noted that there are several drugs which apparently end with the suffix 'vedon' / 'vidon'.

78. Moreover, the Supreme Court in Amridhara Pharmacy (supra) as well as in other judgments has also observed that every case must depend on its own particular facts, and the value of authorities lies not so much in the actual decision as in the tests applied for determining what is likely to deceive or cause confusion.

79. Applying the above discussed principles to the case in hand, I find that the marks 'CFA' and 'BFA' have common second and third alphabets but the first alphabet/syllable being 'C' and 'B', are not similar/common and the marks 'CFA' and 'BFA' start with distinct dissimilarity. Owing to this dissimilarity, I am of the

view that the first syllable/alphabet is different/dissimilar, making it visually and phonetically dissimilar. Although phonetic and visual similarities are disjunctive and not conjunctive tests, I am of the view that the both the tests are not satisfied by the impugned mark.

80. That apart the visual similarity of the device mark of the defendant is concerned, the mark in its trade mark sense describes what BFA stands for i.e. 'Brickwork Finance Academy', so as to enable any person of average intelligence and imperfect recollection coming across the device mark to clearly understand what the defendant means by the abbreviation, 'BFA'. Moreover, the remaining part of the defendant's logo in the mark is also substantially different from the plaintiff's mark. In fact, Mr. Sindhwani, during the course of arguments had stated that the plaintiff is willing to allow the defendant to use the logo/device mark provided the defendant agrees not to use the standalone word mark 'BFA'.

81. Having said that, there is other important aspect that cannot be overlooked i.e. the mark 'BFA' is used by the defendant along with device mark on its brochure (Reference: page 118 of defendant documents) which depicts descriptive words 'Brickwork Finance Academy' (the Institution) and also 'Banking Financial Analyst' the program conducted by the defendant.

82. He is also right in submitting to counter arguments of Mr. Sindhwani that the defendant is referring to the mark 'CFA' to contend that it is being used as a separate program which qualification is given preference for doing 'BFA'. In other words, according to him, at no place defendant is attempting to convey that BFA program is same/similar as CFA program. In fact, he highlights the fact that in the brochure itself, it is mentioned that candidates with CFA qualification are preferred. This according to Mr. Sai Deepak brings out the distinction between the CFA and BFA programs.

83. That apart, Mr. Sai Deepak is also justified in contending that the nature of service provided by both the parties are to the people having at least a graduate qualification and persons having that qualification shall be easily in a position to differentiate the programs, being conducted by the plaintiff and the defendant and also decide that the CFA course is not the BFA course as being conducted by the defendant.

84. In fact, a division bench of this Court in *Fritco-Lay India and Ors. v. Uncle Chipps Private Limited* AIR 2000 Delhi 366, by relying upon *M/s. Hiralal Parbhudas (supra)*, *Amridhara Pharmacy (supra)*, while deciding whether act of the respondent therein, distributing a free collectible which goes by the name 'AMAZO' as compared to the free patented collectible 'TAZO' distributed by the appellant with their products respectively amounts to passing off of the appellant's products, inter-alia held that the promotional campaign being aimed at a certain class of customers (middle class and upper middle class children) who are capable of distinguishing between the 'TAZO' and 'AMAZO', there was no likelihood of confusion. The relevant portion of the judgment reads as under:

"28. We have considered the rival contentions.

Section 2(d) of the Trade and Merchandise Marks Act, 1958 defines the word deceptively similar. A mark shall be deemed to be deceptively similar to another being it so nearly resembling the other mark as is likely to deceive or cause confusion. For deciding the question of deceptive similarity, the courts have laid down broad factors to be considered. Reference can be made to *M/s. Hiralal Parbhudas Vs . Ganesh Trading Company & Others* MANU/MH/0275/1984 : AIR1984Bom218 , wherein it has been held that :

(a) Marks are remembered by general impressions or by some significant detail rather than by a photographic recollection of the whole.

(b) Overall similarity is the touchstone.

(c) marks must be looked at from the first impression of a person of average intelligence and imperfect recollection.

(d) overall structure, phonetic similarity and similarity of idea are important and both visual and phonetic tests must be applied.

(e) marks must be compared as a whole, microscopic examination being impermissible and.

(g) the broad and salient features must be considered for which the marks must not be placed side by side to find out difference in design.

It was further held that:

In addition, the nature of the commodity, the class of purchasers, the mode of purchase and other surrounding circumstances must also be taken into consideration.

29. Therefore, reference to every case cited by the parties would not be of any real assistance. Questions which arise for consideration in each case are questions of fact. Reference in this regard can be made to the following observation of the Supreme Court in *Amritdhara Pharmacy's case* (supra), MANU/SC/0256/1962 : [1963]2SCR484 :

"The Act does not lay down any criteria for determining what is likely to deceive or cause confusion. Therefore, every case must depend on its own particular facts, and the value of authorities lies not so much in the actual decision as in the tests applied for determining what is likely to deceive or cause confusion."

30. Applying the above principles it is clear that one of the important factors to be considered, is the class of purchasers. Mere look at the promotional campaign reveals that both names i.e., TAZO or AMAZZO are written in English. Thus, the promotional campaign is meant to attract urban elite children of middle class or upper middle class families. The children who are well versed in English and can certainly distinguish between TAZO and AMAZZO and as such there is no likelihood of confusion. In this regard we are also fortified by the observations

made by a division bench of this Court reported as Kellogs and company Vs. Praveen Kumar 1996 2 AD 465. The court after considering several cases, rejected the plea of similarity or likelihood of confusion or plea of fraud based on imperfect memory and declined to interfere with the order of the learned Single Judge. In fact, in Amritdhara's cases (supra) relied upon by the appellants. Supreme Court considered the persons who were likely to purchase that Ayurvedic Medicine would be both villagers town folk, literate as well as illiterate and observed as under :-

"where the trade relates to the goods largely solo to illiterate or badly educated persons it is no answer to say that a person educated in Hindi language would go by the etymological of ideological meaning".

31. In the present case, persons who would go to purchase the snacks are not likely to be illiterate or badly educated persons. They would be those who belong to a class, who are fairly educated in English and would be able to distinguish between TAZO and AMAZZO, there are several other dissimilarities. As noticed above the characters printed on each of the discs are different. Discs are contained inside the product packets which are admittedly different."

(Emphasis supplied)

85. It is also pertinent to note that a division bench of the Madras High Court in A.V. Rajadurai Nadar v. P. Ayya Nadar and Ors., AIR 1977 Mad 237, while reversing the stand of the Single Judge holding the marks to be deceptively similar, held inter-alia that the marks should be looked at especially from the standpoint of a person who is most likely to use a particular brand (brand of matches therein) and if it appears that the difference is prominent and it cannot lead to any similarity or a deceptive similarity or confusion then there could be no objection to the two different trade marks.

86. Similarly, the Apex Court in Khoday Distilleries Limited v. The Scotch Whiskey Association and Ors., AIR 2008 SC 2737, has inter-alia held that the test of deceptive similarity to be applied would be different in each case and should depend upon nature and kind of customers who would likely to buy the goods. The relevant portion of the judgment reads as under:

"96. Yet again in Diageo North America, Inc. and Anr. v. Shiva Distilleries Ltd. MANU/DE/1578/2007 a learned Single Judge of the Delhi High Court held as under:

14. So much for the second syllable. As regards the first syllable, I find that there is no similarity between SMIR and BRIS. Although the learned Counsel for the plaintiffs had submitted that all the letters are common except the letter and M in SMIR and the letter B in BRIS, this, to my mind, is of no consequence because the arrangement of the letters is entirely different, as is the phonetic and visual result. I also agree with the submission made by the learned Counsel for the defendant that the intending purchasers of the competing products are

literate persons belonging to the affluent class of society and who would be in a position to easily distinguish SMIRNOFF from BRISNOFF particularly when the eyebrow device and the colour combination is sought to be given up by the defendant. The average person with imperfect recollection would have to be from amongst the sub-set of such persons i.e., discerning consumers of vodka. My prima facie view is that the trade mark BRISNOFF is not deceptively similar to, nor can it be confused with the Plaintiffs' trade mark SMIRNOFF.

97. This Court in *Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd.* MANU/SC/0199/2001: [2001]2SCR743 inter alia laid down the law in the following terms:

35. Broadly stated, in an action for passing-off on the basis of unregistered trade mark generally for deciding the question of deceptive similarity the following factors are to be considered:

(e) The class of purchasers who are likely to buy the goods bearing the marks they require, on their education and intelligence and a degree of care they are likely to exercise in purchasing and/or using the goods.

98. The tests which are, therefore, required to be applied in each case would be different. Each word must be taken separately. They should be judged by their look and by their sound. Must consider the goods to which they are to be applied. Nature and kind of customers who would likely to buy goods must also be considered. Surrounding circumstances play an important factor. What would likely to happen if each of those trade marks is used in a normal way as a trade mark of the goods of the respective owners of the marks would also be a relevant factor. [See *Pianotist Co.' Application, Re*, (1906) 23 RPC 774].

99. Thus, when and how a person would likely to be confused is a very relevant consideration."

(Emphasis supplied)

87. Drawing inference from the above-mentioned judgments, as well as table reproduced at paragraph 30 above, courses offered by the plaintiff and the defendant as CFA and BFA program are certification courses, aimed at candidates interested in financial/investment services, who have at least completed their under-graduation, both with a different course structure. Insofar as the CFA program is concerned, it is the conceded case of the plaintiff that after completion of the course/program, successful candidates can even use the 'CFA' as part of their professional designation. The plaintiff has also pointed out in the plaint that numerous industries and scholarly publications describe the rigorous pre-requisites to earn the CFA designation and urge potential investors to look for and rely upon the CFA designation in choosing an investment advisor and that the CFA designation is recognized by over 40 governmental bodies and regulatory agencies throughout the world. If that be so, any prospective candidate who seeks to pursue CFA program, owing to the difference in

curriculum/course structure, professional designation, acceptance at various organizations etc., in normal course will not confuse the same with the course offered as 'BFA' by the defendant. Moreover, the defendant's program BFA is not a substitute for the course offered by the plaintiff. Even though in similar/identical areas, the curriculum as admitted by the parties are not the same. Similarly, the assessment pattern/examination patterns of both the programs are also different. The defendant has, in that regard has differentiated/pointed out in its brochure that the courses provided by the parties are different. Therefore, prima-facie I am of the view that the class of customers who are likely to avail/pursue the courses of the either the plaintiff or the defendant will be capable of differentiating between the two programs before enrolling for their preferred course.

88. That apart, I agree with the submission made by Mr. Sai Deepak that 'Finance Academy' being a generic combination and there may be number of institutions with the appellation Finance Academy or containing its abbreviation 'FA', any injunction granted shall have a bearing on those usages/institutions. In this regard I may state that during the preparation of this Judgment, I did an organic online search in Google, being a popular search engine, with the keywords 'Finance Academies', to find out finance academies, if any, conducting educational/certification programs/exams. The organic search returned the names of two academies specifically containing the combination 'Finance Academy' namely IFA-Indian Finance Academy and Pioneer House Finance Academy along with various other institutions. The abbreviation of the former being IFA, surely any finding that 'BFA' is deceptively similar to 'CFA' shall have a bearing on 'IFA' as well. In fact, it shall have a bearing on every mark with suffix 'FA'. Similarly, I also note that there are other courses such as Bachelor of Fine Arts which goes by the abbreviation 'BFA' in common parlance.

89. Mr. Sindhwani has relied upon a division bench judgment of this Court in B.K. Engineering (supra) in support of his contention that the use of mark BFA by the defendant is a deliberate attempt to entice the public into believing that an association exists between the plaintiff and defendant. However, the said judgment is clearly distinguishable in facts as 'B.K' and 'B.K. 81' were the house mark and trade mark respectively of the plaintiff and defendant therein, who were engaged in the manufacture of cycle bells, the Court held the defendant's mark to be deceptively similar as the product being the same (cycle bell) and there was a likelihood of the purchasing public to believe the product to be of plaintiff company. The Court also held that the owing to 'common field of activity' public could be deceived of that there could be some association with the two parties. In the present case, the marks are not deceptively similar and more over the class of customers as against the class in B.K. Engineering(supra) is capable of differentiating between the programmes offered by the parties herein.

90. He has relied upon the Apex Court judgments in Toyota Jidosha Kabushiki Kasiha (supra) and Laxmikant V. Patel (supra) to contend that actual confusion is

not required to establish infringement or passing off. Reliance was also placed on a Coordinate Bench judgment of this Court in The Royal Bank of Scotland Group PLC (supra) wherein it was inter-alia held that what needs to be looked into by Court under Section 29(2) is whether confusion is likely to be caused or not. These judgments are also clearly not applicable in the facts of the present case, in view of my conclusion above that there is no scope for confusion between the two marks owing to the dissimilarity and class of customers who would be enrolling for the respective programmes.

91. In so far as the judgments relied upon by Mr. Sindhvani viz. Aktiebolaget SKF (supra), Larsen and Toubro Ltd. (supra), H&M Hennes & Mauritz AB & Anr. (supra), DPS World Foundation (supra), The General Electric Company (supra), Inter IKEA Systems BV (supra), S. Mehar Singh (supra), Hind Cutlery (supra), NIIT (supra), Ram Kishan & Sons Charitable Trust (supra) and Inter Ikea System B.V v. Akea Systems (supra) ; I have considered them and find that all these judgments are on the line of the impugned marks, abbreviations, therein being deceptively similar, which is not the case in the present matter in view of my above conclusion and hence misplaced.

92. Further, reliance has been placed on Living Media India Ltd (supra) by Mr. Sindhvani, wherein a coordinate Bench of this Court has held that any kind of prefix or suffix would not make any difference so far as the trade name is concerned. I find the reliance is misplaced as the trade name or registered mark of the plaintiff is 'CFA' and the mark of the defendant is altogether different as 'BFA' and defendant is not using any pre-fix or suffix to the trade name/ trade mark of the plaintiff.

93. Anchorage made by Mr. Sindhvani on Baker Hughes (supra) of this Court and Baker Hughes (supra) (Supreme Court) is clearly weak in the facts of the present case, as in those matters there was a question involved of revocation of an agreement between the parties whereby consent was given for the use of the name 'Baker', subject to certain conditions (such as share holding pattern of the plaintiff/appellant to not go down below 40%). It was on the continued use of the said name/mark (foreign registered) after the alleged violation of the agreement that the plaintiff approached of this Court which granted interim injunction on a prima facie view and same was upheld by the Apex Court facie, without prejudice to the trial in the matter.

94. Insofar so a coordinate Bench judgment of this Court in Association for Investment Management and Research and Ors. v. The Institute of Chartered Financial Analysts of India and Ors., 2006 (33) PTC352, is concerned I have carefully perused this judgment as well, only to find, the issue involved therein was whether using of the mark CFA and ICFA by the defendants even after revocation of the agreement by which plaintiff granted them license amounted to passing off or not and the Court granted injunction in said context.

95. I also note that a plea of dilution under Section 29(4) of the Trade Mark Act

taken by the plaintiff in the Suit/application was not pressed by Mr. Sindhwani during the course of the arguments. Even otherwise, the said plea will not hold good in view of my conclusion above.

96. Since the plaintiff has pleaded distinctiveness and secondary meaning to its mark 'CFA' which is a disputed fact and mandates adducing of evidence and also to find out what is the effect thereof on the impugned mark, I dismiss the application under Order XIII A read with Section 151 of the CPC, being I.A. No. 14173/2018, seeking summary judgment. I may also state, in fact an 'oral prayer' was made by Mr. Sindhwani under Order XIII A of the CPC for summary judgment in the facts and pleadings put forth by him. Suffice it to say that in view of the judgment of a Division Bench of this Court in *Bright Enterprises Private Ltd. v. MJ Bizcraft LLP*, 2017 (69) PTC 596 (Del)., an oral prayer being not maintainable under Order XIII A, I reject the same.

97. In view of my above conclusion, I dismiss the application under Order XXXIX Rule 1 & 2, bearing I.A. No. 2460/2018.

CS (COMM) 619/2018

List before the Joint Registrar for marking of exhibits on November 12, 2020.