
(2018) 07 IPAB CK 0008

In the Intellectual Property Appellate Board

Case No : ORA/199/2008/TM/DEL

Delhi Public School Society

APPELLANT

Vs

Amir Education Society

RESPONDENT

Date of Decision : 16-07-2018

Acts Referred:

Trade Marks Act, 1999 — Section 8, 9, 10, 11, 12, 18, 47, 47(1)(b), 57, 134

Citation : (2018) 75 PTC 397 (IPAB)

Hon'ble Judges : Manmohan Singh, J; Sanjeev Kumar Chaswal, Technical Member

Bench : Division Bench

Advocate : S.K. Bansal, Saurabh Kapoor, Manish K. Mishra, Vipul K. Tiwari

Final Decision : Allowed

Judgement

Manmohan Singh, J

1. Respondent no. 1 has adopted the trade name MODERN DELHI PUBLIC SCHOOL and has obtained trademark registration under No. 1307389

in Class 41 as of 8th September 2004 claiming user since 1.8.2004. It is stated that the mark DELHI PUBLIC SCHOOL is forming material part of

the respondent's trade name in relation to education providing of training entertainment supporting and cultural activities. The present rectification was

filed for removal of the said trademark. By this Order, we propose to decide the above-mentioned rectification petition.

2. Both parties have made their submissions. Orders were reserved. The matter was again mentioned before us on behalf of counsel for the

respondent no. 1 to file the fresh application and additional documents, the same was disallowed as all the averments raised by the respondent no. 1

are already available on record.

3. The brief facts that the applicant is a Society established in the year 1948 who is engaged in the business of providing education and services. That

initially in the year 1948, the petitioner was registered as a society with the name ""Delhi Public School, Mathura Road"", however in the year 1962 the

name of the petitioner society was duly changed to its present name i.e. ""Delhi Public School"" of the statement of case.

4. As per pleadings, the first school of the petitioner was established in 1950 at Mathura Road, New Delhi. Thereafter many other schools were

established, both in India & abroad.

5. The applicant claiming itself the owner and proprietor of trademark DELHI PUBLIC SCHOOL and DPS in relation to school and education

services etc. falling in Classes 16, 35, 36, 41 and 42 of the Trade Marks Act, 1999. The mark DPS is an abbreviation of DELHI PUBLIC SCHOOL.

6. The applicant has got various trademarks registration and has filed various trademark applications for the trademark DELHI PUBLIC SCHOOL

Logo and DPS. The details of the same are mentioned below.

That in order to secure its proprietary rights in the said trademarks/name the petitioner has applied for registration of the same under the provision of

trade marks Act, 1999. The details of said application are as follows:

That petitioner's all the aforesaid applications for registration of said trademarks/ name are pending disposal and are likely to be allowed in due course

on completion of all formalities.

7. Few details are mentioned in paras No. 9 & 10 of the statement of case. The same are reproduced hereunder:-

That the petitioner established its first school in the year 1950 at Mathura Road, New Delhi under the said trademarks/name.

That due to the excellent quality of education imparted by the petitioner the goodwill and reputation of the petitioner grew manifold, which motivated

the petitioner to establish more and more schools (either itself or under franchise agreements with other parties) under the said trademarks/name

across the length and breath of the Country and even abroad. The schools which are established and managed by the petitioner society itself are

called ""Core Schools"" and the schools which are established by the petitioner under franchise agreements with other Societies are called ""Satellite

Schools"". The name and locations of petitioner's various schools are as under:

8. It is evident from the material placed on record that the applicant has extensive use, reputation and distinctiveness in the trademark DELHI

PUBLIC SCHOOL Logo and DPS. In support of the said use and reputation, petitioner has filed documentary evidence showing extensive use and reputation of the said trademark/trade name.

9. The applicant alleges that it came across the Respondent's advertisement in December, 2005 in the newspaper ""Hindustan Times"" regarding opening of the Modern Delhi Public School at Sector 21C, Faridabad wherein it was mentioned that Mr. U.S. Verma was the founder Principal of the Delhi Public School, Faridabad.

10. Thereafter the applicant had filed a suit being CS (OS) No. 733 of 2006 against the Respondent no. 1 as on the basis of the said advertisement,

Mr. U.S. Verma has established the Respondent's school Modern Delhi Public School. The said was withdrawn for lack of territorial jurisdiction of

Delhi High Court. It was alleged that the Respondent's adoption of ""Modern Delhi Public School"" is dishonest, malafide and aimed at to take

advantage and trade upon the reputation and goodwill of the applicant and thereby pass off their impugned services as of the applicant.

11. It is stated by the applicant that the trademark DELHI PUBLIC SCHOOL and respondent's trademark MODERN DELHI PUBLIC SCHOOL

are confusingly similar. It is also claimed that the petitioner's rights in the trademark DELHI PUBLIC SCHOOL and DPS and crest logo and the

petitioner has right in the said trademark on account of its prior adoption and continuous use and reputation. The word DELHI PUBLIC SCHOOL is

forming essential part of the respondent's MODERN DELHI PUBLIC SCHOOL.

12. It was also alleged in the petition that the Respondent has not used the impugned mark ""Modern Delhi Public School"" for a period of 5 years 3

months apart from other grounds for cancellation being section 9, 11, 12 and 18 of the Trade Marks Act, 1999.

Case of respondent no. 1

13. The case of the respondent no. 1 is that the ground of non-use of the trade mark ""Modern Delhi Public school"" under section 47 (1) (b) in the

present cancellation is not tenable that the applicant came to know about the use of the mark ""Modern Delhi Public school"" of the Respondent no. 1

when the opening of the Modern Delhi Public School was announced in the

Hindustan Times dated 12.12.2005, as the Respondent has been continuously using the said mark since 2003 and got the same registered on 26.08.2006, the applicant has tried to mislead the Board by taking the ground of non-use. Therefore, the present cancellation petition on this ground is not maintainable as the respondent no. 1 has filed the document showing use of the trade name/trade mark ""Modern Delhi Public School"".

14. It was also stated by the respondent no. 1 that the applicant has concealed the material fact that the applicant is not the registered proprietor of the trade name/trade mark ""Delhi Public School"" per se. Infact, the trade mark registrations so relied upon by the Petitioner are either for ""DPS"" or for device marks. The Petitioner has deliberately concealed the fact that in the said trade mark registration Nos. 1608946, 1608947, 1608948, 1608949 and 1608950, so mentioned by the petitioner in its statement of case, the expression ""Delhi Public School"" has been disclaimed. Therefore, the applicant is not entitled to exercise exclusive right on the trade mark ""Delhi Public School"".

15. With regard to adoption of the mark, it was stated by the respondent no. 1 that the idea to start a pre-primary school in the name of ""Modern Delhi Public School"" was conceived by Mrs. Savita Girshar, wife of Davinder Kumar in the year 2003 and a pre-primary school under the name of Modern Delhi Public School was established at 683 Raja Garden, Old Faridabad in the year 2003. The Respondent society namely Amir Education Society was created in the year 2004 and a public school under the name and style of ""Modern Delhi Public School"" was established in the year 2005 which started functioning at Tigaon Road, Sector-87, Faridabad in the year 2007. The Respondent's school was accorded with recognition as Senior Secondary School vide letter No. 13/35-07-PS (3) dated 29.11.2007.

16. It is alleged by the respondent no. 1 that Modern Delhi Public School has established itself as a premium educational institution which is not only committed towards imparting education but also believes in the holistic development of the child and with this aim, personality development classes and counseling sessions are the regular features of school curriculum. In the session 2017-2018, total 4054 students are enrolled with the Respondent's school, who are being imparted education by 209 faculty members/teachers.

17. Apart from teaching the students from syllabus and curriculum, the Respondent's school has been providing special classes to students in order to

prepare them for competitive examinations like IIT-JEE, AIIMS, AIPMT, NEET, N.T.S.E, N.S.T.S.E, N.S.O., N.C.O., I.M.O., N.M.O., Arybhata

etc. and number of students of the Respondent's school has achieved success in such competitive examinations.

18. The reputation and brand value in the Respondent's school can be ascertained from the revenue for the year 2016-2017 which was to the tune of

Rs. 38,79,41,951/- (Thirty-Eight Crores Seventy Nine Lakhs Forty One thousand Nine hundred Fifty one).

19. It is submitted that the applicant filed a civil suit against Modern Delhi Public school, the school being run by the Respondent/Applicant, before the

High Court of Delhi for permanent injunction, mandatory injunction, rendition of accounts and damages restraining the Modern Delhi Public school

from using the trade mark Delhi Public School or DPS. The said suit was registered as CS (OS) 733 of 2006 on 01.05.2006. The Respondent no. 1

entered appearance and filed their written statement on 01.08.2006 wherein it placed reliance on the trade mark registration no. 1307389, the subject

matter of the present cancellation petition as a defence. The applicant did not raise the plea of invalidity before the Court and in fact no issue including

the issue of invalidity of the Respondent's trade mark was framed in the said Suit. On 24.09.2009, the suit was returned to District Judge, Faridabad,

Haryana.

20. On 26.08.2015 when the matter was listed before Civil Judge, Junior Division, Faridabad, the Ld. counsel for the applicant got recorded his

statement to the effect that as per Section 134 of the Trade Marks Act, 1999 the present proceeding cannot be continued in the present Court and

therefore, he did not wish to pursue with the present suit and withdraws the same.

21. In view of the above submissions, the Court dismissed the suit as withdrawn with liberty to institute the fresh proceedings before the competent

court and no fresh suit proceeding has been instituted by the Petitioner till today against the Respondent on account of use of the trade mark ""Modern

Delhi Public School"".

22. The Respondent no. 1 submits that the expression ""Delhi Public School"" is public juris. It is clarified that the Respondent is not claiming any right

over the phrase Delhi Public School per se rather it is the trade mark Modern

Delhi Public School as a whole. Further, there are various schools which are using the expression Delhi Public School or its acronym DPS in the name and style of their school.

23. From the entire counter-statement and the pleadings of the respondent no. 1, the following points emerges in order to decide the present position.

- i) Similarity of the names.
- ii) Adoption of name by the respondent.
- iii) Common to the trade/public juris.
- iv) Impact of the suit filed by the applicant which was withdrawn for lack of jurisdiction.
- v) Continuance user of the mark by the respondent no. 1.

24. It is stated that the goodwill and reputation of the Respondent's school has grown exponentially with time which shows the trust the Respondent's

school has earned in the eyes of parents who always endeavor to send their children to best possible school. The subsisting trust in the Respondent's

school is result of hard work of the management, teachers, and students as well as of support staff. I further say that the subsisting reputation and

brand value in the Respondent's school can be ascertained from the revenue for the year 2016-2017 which was to the tune of Rs. 38,79,41,951/-

(Thirty Eight Crores Seventy Nine Lakhs Forty One thousand Nine hundred Fifty one). The Respondent's school has acquired tremendous goodwill

and reputation.

25. It is evident that the Respondent no. 1 was fully aware about the use and reputation of the trademark DELHI PUBLIC SCHOOL as Mr. U.S.

Verma is Director & Principal of MODERN DELHI PUBLIC SCHOOL and he was earlier associated with the petitioner (founder Principal of

DELHI PUBLIC SCHOOL, Faridabad and former Vice-Principal of DELHI PUBLIC SCHOOL, R.K. Puram, New Delhi. The documentary

evidence has been placed on record like at pages No. 38, 39, 40 and 42 of the documents and Exhibit No. 7. Accordingly, registration has been

obtained by the respondent by concealment of material facts and in bad faith.

26. It is admitted by the respondent no. 1 that Mr. U.S. Verma was appointed as Director Principal of the Respondent's school on 09.12.2005 although

the Respondent adopted the trade name/trade mark ""Modern Delhi Public

School"" way back in the year 2003 who started a pre-primary school under the name and style of Modern Delhi Public School. Few documents have been produced, however, in any case the respondent no. 1 has no justification to adopt the similar name, irrespective of fact if Mr. Verma was appointed as director of the respondents school on 9.12.2005. The respondent no. 1 could not be claimed of independent rights and the respondent no. 1 was fully aware about the rights of the applicant. The said adoption has to be considered as mala fide adoption. Actually, it is a fraud committed by Mr. Verma and respondent no. 1.

In the case of Velcro Industries v. Velcro India Ltd. : 1993 (1) Arb. LR 465, a learned Single Judge of the Bombay High Court (S.N. Variava, J.)

rejected a contention made on behalf of the defendants therein that they are entitled to continue use of Velcro as a part of their corporate name

because they have independently developed a reputation in India. It was noted that the defendants in that case were merely acting as licensees and

even if the agreement between the parties did not provide that on termination of the license, the defendants would cease to use Velcro as a part of

their trade name, that would make no difference, since the trademark Velcro is a registered trademark of the plaintiff and to allow the defendants to

use it as a part of their corporate name is to permit them to give an impression to the public that they are still connected with or have a license from

the plaintiffs.

Similarity

27. The courts have propounded the doctrine of prominent and essential feature of the trade mark for the purposes of adjudication of the disputes

relating to infringement of trade mark. While deciding the question of infringement, the court has to see the prominent or the dominant feature of the

trade mark. Even the learned single judge agrees to this proposition when the learned judge quotes McCarthy on Trade Marks that all composite

marks are to be compared as whole. However, it is dependent on case to case to basis as a matter of jury question as to what can be the possible

broad and essential feature of the trade mark in question.

28. It is settled law that where the defendant's mark contains the essential feature of the plaintiff's mark combined with other matter, the correct

approach for the court is to identify an essential feature depending particularly

on the court's own judgment and burden of the evidence that is placed before the Court. In order to come to the conclusion whether one mark is deceptively similar to another, the broad and essential features of the two are to be considered. They should not be placed side by side to find out if there are differences, rather overall similarity has to be judged. While judging the question as to whether the defendant has infringed the trade mark or not, the court has to consider the overall impression of the mark in the minds of general public and not by merely comparing the dissimilarities in the two marks.

29. The ascertainment of an essential feature is not to be by ocular test alone but if a word forming part of the mark has come in trade to be used to identify the goods of the owner of the trade mark, it is an infringement of the mark itself to use that word as the mark or part of the mark of another trader for which confusion is likely to result. The likelihood of confusion or deception in such cases is not disproved by placing the two marks side by side and demonstrating how small is the chance of error in any customer who places his order for goods with both the marks clearly before him, for orders are not placed, or are often not placed, under such conditions. It is more useful to observe that in most persons the eye is not an accurate recorder of visual detail and that marks are remembered rather by general impressions or by some significant detail than by any photographic recollection of the whole". In the decision reported as (1951) 68 RPC 103 at page 105, *De Cordova v. Vick Chemical Co.*, the plaintiffs were the proprietors of a label containing the words -Vick's Vapo Rub as the essential feature, registered in Jamaica, and the defendants used a similar label with the words -Karsote Vapour Rub as the essential feature, and it was shown that the expression -Vapo Rub had become distinctive of the plaintiff's goods in Jamaica, an action for infringement was successful. (See *De Cordova v. Vick Chemical Co.*(supra), (1941) 58 RPC 147, *Saville Perfumery Ltd. v. June Perfect Ltd.*, AIR 1972 SC 1359 at 1362, *M/s. National Chemicals and Colour Co. and Others v. Reckitt and Colman of India Limited* and AIR 1991 Bombay 76 : 1991 (11) PTC 217 (Bom), *M/s. National Chemicals and Colour Co. and others v. Reckitt and Colman of India Limited* and another)

30. Identification of essential features of the trade marks has been discussed in

details in the case of Kaviraj Pandit Durga Dutt Sharma v. Navaratna

Pharmaceutical Laboratories (supra):-

In an action for infringement, the plaintiff must, no doubt, make out that the use of the defendant's mark is likely to deceive, but where the similarity

between the plaintiffs and the defendant's mark is so close either visually, phonetically or otherwise and the court reaches the conclusion that there is

an imitation, no further evidence is required to establish that the plaintiffs rights are violated. Expressed in another way, if the essential features of the

trade mark of the plaintiff have been adopted by the defendant, the fact that the get-up, packing and other writing or marks on the goods or on the

packets in which he offers his goods for sale show marked differences, or indicate clearly a trade origin different from that of the registered proprietor

of the mark would be immaterial;...

-When once the use by the defendant of the mark which is claimed to infringe the plaintiff's mark is shown to be in the course of trade, the question

whether there has been an infringement is to be decided by comparison of the two marks. Where the two marks are identical no further questions

arise; for then the infringement is made out.

31. The Court in determining whether the Defendant's mark is deceptively similar to the mark of the Plaintiffs were enunciated in the judgment of Mr.

Justice Parker in the decision reported as 1906(23) RPC 774, Pionotist Case:

-You must take the two words. You must judge them, both by their look and by their sound. You must consider the goods to which they are to be

applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding

circumstances; and you must further consider what is likely to happen if each of those trademarks is used in a normal way as a trade mark for the

goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion - that is

to say, not necessarily that one man will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public

which will lead to confusion in the goods - then you may refuse the registration, or rather you must refuse the registration in that case.

Confusion and deception

32. It is correct that few of the trademark registrations of the petitioner are subject to disclaimer of the words DELHI PUBLIC SCHOOL. The said

disclaimers do not prevent the applicant from claiming rights in DELHI PUBLIC SCHOOL in passing off action on account of prior use and

distinctiveness especially in view of the fact that respondents have adopted the trademark MODERN DELHI PUBLIC SCHOOL in bad faith. The

public is general is not aware the disclaimer does not go to the public. Irrespective of disclaimer, it is not denied by the respondent no. 1 that the

applicant society was established in 1948 who are providing education and services for the last 70 years and the said name.

33. Respondent no. 1 cannot claim the ownership rights by stating that the trademark DELHI PUBLIC SCHOOL has geographical significance as

Respondent himself has applied for registration of the trademark MODERN DELHI PUBLIC SCHOOL and therefore Respondent is estopped from

agitating the said issue. Even the part of the mark Modern has been appropriate by the respondent no. 1 from Modern School.

34. In the decision reported as AIR 1951 Bombay 147, James Chadwick & Bros. Ltd. v. The National Sewing Thread Co. Ltd., Chagla C.J. and

Bhagwati, J.; referring to the words "'likely to deceive or cause confusion'" in section 10 of the Trade Marks Act, 1940, observed at page 152 as

follows:-

-Now in deciding whether a particular trade mark is likely to deceive or cause confusion, it is not sufficient merely to compare it with the trade mark

which is already registered and whose proprietor is offering opposition to the registration of the former trade mark. What is important is to find out

what is the distinguishing or essential feature of the trade mark already registered and what is the main feature or the main idea underlying that trade

mark, and if it is found that the trade mark whose registration is sought contains the same distinguishing or essential feature or conveys the same idea,

then ordinarily the Registrar would be right if he came to the conclusion that the trade mark should not be registered. The real question is as to how a

purchaser, who must be looked upon as an average man of ordinary intelligence, would react to a particular trade mark, what association he would

form by looking at the trade mark, and in what respect he would connect the trade mark with the goods which he would be purchasing. It is impossible

to accept that a man looking at a trade mark would take in every single feature of the trade mark. The question would be, what would he normally retain in his mind after looking at the trade mark? What would be the salient feature of the trade mark which in future would lead him to associate the particular goods with that trade mark?

The decisions referred with regard to essential features were followed by the Division Bench in the decision reported as ILR 1973 Delhi 393, M/s.

Atlas Cycle Industries Ltd. v. Hind Cycles Limited. The Division Bench has examined the similar question very thoroughly while dealing with the two rival trademarks Royal Star and Eastern Star of the parties and has come to the conclusion that the trade mark adopted and used by the defendant Royal Star is similar to plaintiffs trade mark Eastern Star.

In the decision reported as (1945) 65 RPC 62, Aristoc v. Rysta decided by the House of Lords, it was held that the comparison of trademarks was a matter of first impression, but the mark -Rysta too closely resembled mark - Aristoc phonetically and it would be liable to lead to deception and confusion. After having considered the above-mentioned decisions, it is clear to us that it is not the right test of a meticulous comparison of two marks, letter by letter and syllable by syllable. It is the person who only knows the one mark and has perhaps an impression, or imperfect recollection of it, who is likely to be deceived or confused. In fact it depends on first impression of a person. In case he is aware or familiar with both rival marks of the parties he will neither be deceived or confused. The degree of similarity between the two rival marks and which depends upon the first impression whether visual or phonetic and in case court finds that there is a risk of confusion which is the public interest should not be authorized,

Common to trade

35. Respondent has not placed any document on record to establish that DELHI PUBLIC SCHOOL or its acronym DPS is publici juris. In order to establish publici juris, extent of third party use has to be established. Respondent has not filed any documents in this regard. Accordingly, such defense is not available to the respondent.

36. Law of publici juris has been discussed in various cases and the Courts have given their respective findings to the effect that a party who has taken the defence of publici juris has to prove his case.

37. The same has been dealt with by the Supreme Court and various High Courts in the following cases:

a) In *Corn Products Refining Co. v. Shangrila Food Products Ltd.*, 1960 SC 142 : 1950-2000 (22) PTC (Suppl) (1) 13 (SC) it has been held as under:

-15. The series of marks containing the common element or elements therefore only assist the applicant when those marks are in extensive use in the

market. The onus of proving such user is of course on the applicant, who wants to rely on those marks. Now in the present case the applicant, the

respondent before us, led no evidence as to the user of marks with the common element. What had happened was that Deputy Registrar looked into

his register and found there a large number of marks which had either 'Gluko' or 'Vita' as prefix or suffix in it. Now of course the presence of a mark

in the register does not prove its user all. It is possible that the mark may have been registered but not used. It is not permissible to draw any inference

as to their user from the presence of the marks on the register. If any authority on this question is considered necessary, reference may be made of

Kerly p. 507 & Willesden Varnish Co. Ltd. v. Young & Marten Ltd., (1922) 39 RPC 285 at p. 389. It also appears that the appellant itself stated in

one of the affidavits used on its behalf that there were biscuits in the market bearing the marks 'Glucose Biscuits', 'Gluko biscuits' and 'Glucosa Lactine

biscuits'. But these marks do not help the respondent in the present case. They are ordinary dictionary words in which no one has any right. They are

really not marks with a common element or elements. We, therefore, think that the learned appellate Judges were in error in deciding in favour of the

respondent basing themselves on the series marks, having 'Gluko' or 'Vita' as a prefix or a suffix.

The Supreme Court set aside the judgment of the Division Bench of this Court and restored the order of the Learned Single Judge. The Supreme

Court dealt with the finding of the Division Bench that trademarks with the prefix or suffix 'Gluko' and 'Vita' were common features of the trade and

could not be associated only with the appellant's product, and observed thus:

The second point on which the learned appellate Judges based themselves in arriving at the conclusion that there was no reasonable apprehension of

confusion or deception was, as we have earlier stated, that there were various trademarks with a prefix or suffix 'Gluko' or 'Vita' and that made it

impossible to say that the common features 'Glu' and 'Vita' were only associated with the appellant's products. This view was founded on a passage which the learned appellate Judges quoted from Kerly on Trade Marks, 7th Edn., p. 624. That passage may be summarized thus: Where there are a series of marks, registered or unregistered, having a common feature or a common syllable, if the marks in the series are owned by different persons, this tends to assist the applicant for a mark containing the common feature. This statement of the law in Kerly's book is based on *In re: an Application by Beck, Roller and Co. (England) Ltd. (1947) 64 R.P.C. 76*. It is clear however, from that case, as we shall presently show, that before the applicant can seek to derive assistance for the success of his application from the presence of a number of marks having one or more common features which occur in his mark also, he has to prove that these marks had acquired a reputation by user in the market.

(emphasis supplied)

b) *In Express Bottlers Services Pvt. Ltd. v. Pepsi Inc. and Ors.*, 1989 (9) PTC 14 it has been held as under.

'50.. To establish the plea of common use, the use by other persons should be shown to be substantial. In the present case, there is no evidence

regarding the extent of the trade carried on by the alleged infringers or their respective position in the trade. If the proprietor of the mark is expected

to pursue each and every insignificant infringer to save his mark, the business will come to a standstill. Because there may be occasion when the

malicious persons, just to harass the proprietor may use his mark by way of pinpricks. The mere use of the name is irrelevant because a registered

proprietor is not expected to go on filing suits or proceedings against infringers who are of no consequence Mere delay in taking action against the

infringers is not sufficient to hold that the registered proprietor has lost the mark intentionally unless it is positively proved that delay was due to

intentional abandonment of the right over the registered mark. This court is inclined to accept the submissions of the respondent No. 1 on this point.

The respondent No. 1 did not lose its mark by not proceeding against insignificant infringers

c) *Rolex Sa v. Alex Jewellery Pvt. Ltd. and Ors.*, 2009 (41) PTC 284 (Del).

'22. The next aspect to be considered is the effect/impact, if any, of a large

number of other persons using the word ROLEX as claimed by the defendant. At this stage, this plea will be examined believing the same to be true. In my view, the same would be immaterial. Firstly, nothing has been shown that any of the said users has any significant presence. Secondly, it is now well settled in *Honda (supra)* in turn relying upon *Indian Shaving Products Ltd. Vs Gift Pack* that merely because the plaintiff who is otherwise found entitled to the interim injunction is shown to have not taken any step against other infringers is no ground to deny relief to the plaintiff. It cannot also be said that the plaintiff's trademark has lost its distinctiveness for the said reason. The reply affidavit of the plaintiff lists the orders of the Trade Mark Registry from 1964 to 2000, where plaintiff's mark has been protected inter alia for reason of having great reputation. It also shows that the plaintiff has been enforcing its rights. Though the list filed by defendant No. 1 in this regard is long but a perusal thereof shows a number of applicants to have abandoned or withdrawn their applications. This is a vast country. Mere long list of applicants/registrants of mark, without any extensive use of the mark, cannot dent the distinctive character or repute of the mark.

Similar view was taken by this court in various cases reported in 2009 PTC 57, *Novartis AG v. Crest Pharma Pvt. Ltd. and Anr.*, 93 (2001) DLT 406

: 2001 (21) PTC 676 (Del), *Bhagwan Dass Gupta v. Shri Shiv Shankar Tirath Yatra Company Pvt. Ltd.*, 1998 PTC 18, *Indian Shaving Products Ltd.*

& Anr. v. Gift Pack & Anr., and 2008 (38) PTC 49 (Del.) (DB) *Pankaj Goel v. Dabur India Ltd.*

38. No doubt, the respondent no. 1 has also referred the decision of Division Bench of the Hon'ble High court of Delhi in the judgment dated

10.04.2017 titled *DPS World Foundation and Ors. v. Delhi Public School Society*, 2017 (70) PTC 263, where the Petitioner was the Plaintiff, has

categorically stated that the trade mark/trade name ""Delhi Public School"" contains separate words i.e., Delhi, Public and School, in respect of which

the Plaintiff cannot seek exclusive right for the purposes of passing off and accordingly the Division Bench allowed the Defendant to adopt the trade

name/trade mark including the words ""Delhi"" ""Public"" ""School"". The said decision was reported in 2017 (70) PTC-263 in the case of *DPS World*

Foundation and Ors. v. Delhi Public School Society.

39. The reliance on the said judgment of the respondent is misplaced as respondent has not furnished complete facts involved in the said judgment.

The said judgment as relied upon by the respondent was reviewed and clarified by order dated 21st April, 2017 passed by Hon'ble Justice Ms Hima

Kohli and Justice Sangita Dhingra Sehgal in the matter of FAO (OS) (COMM) 21/2016 DPS World Foundation & Anr. v. Delhi Public School.

Apparently DPS World Foundation in the said case has undertaken not to use the words DELHI PUBLIC SCHOOL. Accordingly, the judgment

relied upon by the respondent and its review petition order is in favour of the petitioner.

40. I do not agree with the respondent no. 1 that the applicant is not a person aggrieved to maintain the present cancellation petition against the

Respondent no. 1 against the Respondent under the provisions of Section 47 and Section 57 of The Trade marks Act, 1999. The suit proceedings have

no connection with the rectification proceedings. Once the petitioner is aggrieved by the act of the registered proprietor even the suit was filed, ipso

facto, the petitioner is become person aggrieved. The suit was allowed to be withdrawn for want of jurisdiction.

41. From the above gambit of the matter, it appears to us that:-

a) The respondent no. 1 has failed to file evidence of continuous use bearing the mark in question.

b) Two marks are the parties almost same.

c) The adoption and use of the mark/name was tainted and dishonest.

d) The registration was obtained contrary to section 8, 11 and 18 of the Act.

e) The respondent no. 1 has appropriated the entire mark and name from the applicant.

Even adoption of the word MODERN which is prefix of the mark is also amount to fraud as in India Modern School is known for the same services.

42. We are of considered opinion that if a party deliberately and intentionally adopts and uses the same mark of another party knowingly that it belongs

to other party, the filing of applications for same/similar mark amount to fraud, the said party cannot claim the ownership under any circumstances as

stolen mark will remain stolen property of original/genuine party.

43. In the present case, it is clear to us that the trade mark of respondent no. 1 is wrongly remaining the Register of Trademark. Thus, in order to

maintain purity, the registered trade mark No. 1307389 in class 41 is cancelled/ removed from the Register of Trade Mark.

44. The prayer is allowed. The respondent no. 1 is burdened with the costs of Rs. 50,000/- to be deposited by the respondent no. 1 with the Prime

Minister Relief Funds within one month.

45. Copy of the order be sent to the respondent no. 2 for taking necessary steps for removal. The petition and M.P. are disposed of.