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\* **IN THE HIGH COURT OF DELHI AT NEW DELHI**  
+ CS(COMM) 270/2022, I.A. 6494/2022

*Reserved on: 31 August 2023*  
*Pronounced on: 6 September 2023*

THE TRUSTEES OF PRINCETON UNIVERSITY

..... Plaintiff

Through: Mr. Chander Lall, Senior  
Advocate with Ms. Nancy Roy, Ms. J.  
Sharanya and Ms. Ananya Chugh,  
Advocates.

versus

THE VAGDEVI EDUCATIONAL SOCIETY & ORS.

..... Defendants

Through: Mr. Rajshekhar Rao, Sr. Adv.  
with Mr. Raghav Kacker, Mr. Aareb  
Amanullah, Mr. Raval and Mr. Shukla,  
Adv.

**CORAM:**  
**HON'BLE MR. JUSTICE C.HARI SHANKAR**

**JUDGMENT**

% **06.09.2023**

**I.A. 6494/2022 [Under Order XXXIX Rules 1 and 2, CPC]**

**The *lis***

1. Princeton University, along with Brown University, Columbia University, Cornell University, Dartmouth College, Howard University, the University of Pennsylvania and Yale University constitute the prestigious Ivy League of American colleges providing premium quality collegiate education. Princeton University has



instituted the present suit through its trustees, against the Vagdevi Educational Society (Defendant 1), headquartered in Hyderabad, which runs the Princeton School of Education, Princeton School of Engineering and Technology, Princeton Degree and PG College, Princeton PG College of Information Technology, Princeton PG College of Management and Princeton College of Pharmacy. These six institutions are Defendants 2 to 7 in the present suit. They are all located in Hyderabad in the southern Indian state of Telangana. Princeton University, as the plaintiff, has sued the defendants.

2. The plaintiff alleges that, by using PRINCETON as part of the name of the educational institutions (Defendants 2 to 7) run by it, as part of its domain name [princetonschoolofeducation.com](http://princetonschoolofeducation.com), and as part of the logos/ emblems of its various institutions, Defendant 1 has infringed the registered trademarks of the plaintiff and has also sought to pass off the services provided in its institutions as services provided by the plaintiff or associated with it. The plaint, therefore, seeks a decree of permanent injunction, restraining the defendants from using any mark which includes PRINCETON for the services provided in its institutions or in any other manner as would infringe the plaintiff's registered trademarks or result in the passing off of the defendants' services as those of the plaintiff.

3. IA 6494/2022, filed with the suit under Order XXXIX Rules 1 and 2 of the Code of Civil Procedure, 1980 (CPC), seeks an interim injunction, pending disposal of the suit, restraining the defendants from using any mark which involves or includes, within it,



PRINCETON or is otherwise deceptively similar to the plaintiff's registered trademarks.

4. This judgment decides IA 6494/2022.


5. Mr. Chander Mohan Lall, learned Senior Counsel, assisted by Ms. Nancy Roy, learned counsel, argued on behalf of the plaintiff, whereas the defendants were represented by Mr. Rajshekhar Rao, learned Senior Counsel and Mr. Raghav Kacker, learned Counsel.

### Rival Contentions

6. The plaintiff is the proprietor of the following registrations in India, under the Trade Marks Act, 1999:

Trade Mark	Registration No.	Date of Application	Class
PRINCETON (Word <i>per se</i> )	2402524	September 28, 2012	25
<b>Goods:</b> Clothing, Footwear And Head Wear For Men, Women And Children, Including T-Shirts, Sweaters, Jackets, Coats, Sweatshirts, Sweatpants, Collared Shirts, Shorts, Ties, Caps, Hats, Sun Visors, Headbands, Wristbands, Shoes, Sneakers, Socks, Stockings, Rain Ponchos, Belts, Aprons, Collar Protectors, Gaiters, Fur Stoles, Shawls, Scarves, Gloves, Neckties, Neckerchiefs, Mufflers, Ear Muffs, Hoods, Night Caps, Garters, Stocking Suspenders, Suspenders.			
 <b>PRINCETON UNIVERSITY</b>	2402525	September 28, 2012	41
<b>Services:</b> Educational Services, Namely, Providing Courses, Instruction And Training At The College And University Levels, Including Undergraduate, Graduate And Post Graduate Education; Education Services, Namely, Providing Online Courses, Seminars, Interactive Classes And Peer-To-Peer Instruction And Grading At The College And University Levels; Organization Of Teaching Activities; Design Of Educational Courses; Arranging And Conducting Of Educational Events; Arranging Of Overseas Study; Arranging Of Award Ceremonies; Providing Information, Including Online, About Education, Training, Entertainment, And Sporting And Cultural Activities; Vocational			



Guidance In The Nature Of Education And Training Advice; Entertainment Services In The Nature Of Presentation Of A Variety Of Intercollegiate Sporting Events And Conducting Sports Camps; Entertainment Services, Namely, Performances Of Music Concerts And Theatre.			
 <b>PRINCETON UNIVERSITY</b>	2402523	September 28, 2012	16
<b>Goods:</b> Printed Publications, Including Journals, Reports, Text Books And Related Publications In A Variety Of Academic And Educational Fields At The College And University Level; Printed Matter And Stationery; Decals; Loose-Leaf Binders; Paper Coasters; Ballpoint Pens; Fountain Pens; Pencils, Paper Napkins; Writing Paper; File Folders; Notebooks; Postcards; Bookmarks; Playing Cards; Wrapping Paper; Yearbooks; Notebooks; Printed Directories; School Diaries; Music Books; Printed Literature; Catalogues; Educational Materials In Printed Form; Instructional And Teaching Material (Except Apparatus); Paper Weights; Wrapping Paper; Stationery.			

7. The plaintiff was founded in 1746, initially as the College of New Jersey. It is the fourth oldest institution of higher education in the United States. It was renamed “Princeton University” in 1896. As already noted, it is a member of the prestigious Ivy League of Schools of higher education in the United States. It provides undergraduate and graduate instruction in the fields of arts, humanities, natural sciences, social sciences and engineering. It operates its website at [www.princeton.edu](http://www.princeton.edu). The website was itself created on 3 April 1987.

8. The plaintiff has close to 1300 faculty members, including personages of higher renown and repute, some of whom are Nobel laureates. Albert Einstein is one of them. At any time, the plaintiff is educating over 5,200 undergraduate and over 2,900 graduate students. The plaintiff provides several courses, the details of which are provided in the plaint. It also offers study abroad programs to its students.



9. The plaintiff has set out, in detail, instances to indicate that the plaintiff has interactions with India. Mr. Chander Lall, learned Senior Counsel appearing for the plaintiff clarified, however, that he is not predicating his client's case on the principle of transborder reputation and its spillover into India, but on the actual use, by his client, of the Mark PRINCETON, in India, from as far back as 1911. The material on the basis of which Mr. Lall asserts actual user, by his client, of the mark "PRINCETON", in India, may be enumerated thus:

(i) The January 1911 edition of the news paper "The Indian Tiger", printed at the Allahabad Mission Press, clearly stated that it was "Published Intermittently from the Office of the Acting Secretary of the Alumni of Princeton University, N.J., USA, living in India, Burmah, Ceylon, Arabia and Persia".

(ii) The September 29, 1936 edition of the Times of India ran the following article:

#### **"INDIAN CHEMIST FOR U.S. UNIVERSITY**

Dr. Purnendu Nath Chakravarty has sailed for America from London, having been appointed to a post specially created for him in the research department of Princeton University in the United States. Dr. Chakravarty has had a brilliant academic career. After completing his education at Calcutta University, he worked for some time as Research Chemist in the Biochemical Laboratory of the Bengal Chemical and Pharmaceutical Works in Calcutta.

He afterwards went to Germany for further studies and took his Ph.D. in Chemistry from Gottingen University, the professor under whom he worked, Dr. A. Windaus, remarking on his thesis, "the chapter on the structural chemistry of sterols has been brought to completion through the work of Mr. Chakravarty."



(iii) The 4 February, 1949 edition of the Times of India contained the following article:

**“INDIAN VISITING PROFESSOR**

Prof. S.N. Roy, of the Department of Statistics, Calcutta University, and Assistant Director of the Indian Statistical Institute, who has been appointed Visiting Professor to the University of Princeton and Columbia to deliver a series of lectures on statistics, has left for U.S.A.”

(iv) The 11 November 1949 edition of the Times of India contained a photograph of Albert Einstein with Pt. Jawaharlal Nehru, the first Prime Minister of India, titled “STATESMAN AND SCIENTIST”, with the caption, below the photograph, reading “Pandit Nehru called on Prof. Albert Einstein, Father of Relativity, at Princeton University recently. Both are engaged in animated conversation.”

(v) The March 29, 1953 edition of the Times of India ran the following article:

**“Frog Skeletons for Princeton**

Nearly 100 well-preserved skeletons of 60,000,000-year-old frogs that were collected earlier this winter in one of the suburbs of Bombay have been added to Princeton University’s collections of fossil vertebrates by Prof. Erling Dorf of the Department of Geology.”

(vi) In the “Ten Cents” Journal printed at Princeton itself, the following article, regarding the Princeton Campus Fund Drive appeared on 1 October 1957:



“THE PRINCETON CAMPUS FUND DRIVE

The \$ 2000 to World University Service, to be matched by another \$ 2000 from the Indian Government, will finish the student medical Centre in Patna, India, originally started by CFD money two years ago. The \$ 2000 to Recording for the Blind will be set up a recording center here in Princeton where professors and students may donate time in recording textbooks for distribution to blind college students.”

(vii) The following article appeared in the 7 July 1956 edition of the Times of India:

**“OLDEST ALUMNUS OF U.S. ‘VARSITY 93-Year-Old Indian**

An Indian nonagenarian has become Princeton University’s most senior alumnus, the Secretary of the University’s National Alumni Association announced yesterday.

This senior alumnus is the 93-year-old retired Presbyterian Minister, the Rev. Henry Goloknath, who is now the only surviving member of Princeton University’s 1882 graduating class. He became the most senior alumnus of the University on the demise of the Rev. Paul Martin a fortnight ago in this country.

The Rev. Henry Golaknath, uncle of India’s Health Minister, Rajkumari Amrit Kaur, to the theological degree from Princeton’s Theological Seminary in 1885.”

(viii) In 27 May 1956 edition of the Times of India, the following article appeared:

**“Better Indo-U.S. Understanding Necessary**

WASHINGTON, May 26: It is important for India and the United States to understand each other better, India’s Minister of Health said on her arrival here yesterday for a busy five - day visit to the capital.

Rajkumari Amrit Kaur said that she hoped to give Americans a better understanding of India and her



problems.

“If more of us came here, it would make things much easier,” she said.

The Rajkumari was met at Union Station by the Indian Ambassador, Mr. G. L. Mehta; Mr. Charles D. Withers, U.S. State Department Political Officer for India, and other Indian Embassy and American officials.

The Health Minister was here at the invitation of the Ford Foundation. She addressed a Princeton University audience on Thursday night and will give more lectures before American college and university audiences during her visit.”

(ix) The 8 June 1957 edition of the Times of India contained an article reporting the result of a demographic study conducted by Mr. A. J. Coale and Mr. E.M. Hoover of the Princeton University Office of Population Research, issued a year prior thereto, predicting a big rise in population by 1986, as a serious problem which India would face.

(x) The 7 January 1957 edition of the Times of India reported that four U.S. educationists would be attending the centenary celebrations of the Indian universities of Calcutta, Madras and Bombay, as announced by the American Council of Education. With reference to the same celebrations, the 10 January 1957 edition of the Times of India reported that Dr. Robert F. Gohein, President-elect of Princeton University, and three other leading educators in the United States were scheduled to attend the centenary celebrations of the Bombay University early the next month.





(xi) The 27 December 1959 edition of the Times of India ran the following article (a welcome break from the monotony of these references):

**“TRADITION BROKEN BY INDIAN GIRL  
Princeton University**

ALLAHABAD, December 26: India’s Defence Minister, Mr. V.K. Krishna Menon, has unwittingly helped break a 100-year-old tradition of great citadel of learning in the U.S., Princeton University, of not admitting women on its rolls.

The University authorities recently were surprised to find themselves faced with an Indian girl armed with an admission card. They made a hurried check to find if they had not committed a slip. They had not.

The Indian girl’s papers were in order. She had been admitted by the authorities without realising the fact that the candidate was a woman.

She broke tradition to secure admission for post-graduate course because her name was Krishna Rao. The University authorities familiar with the name of Mr. Krishna Menon had presumed that the candidate was a boy.

Too late to say “No”, they deleted the words “I, as a gentleman ...” in her declaration form.”

(xii) The 3 October 1961 edition of the Times of India reported that Mr. Morarji Desai, then the Finance Minister of India, had been asked to deliver a sermon in a church at the Princeton University, which he carried out “admirably”.

(xiii) On 16 April 1962, the Times of India reported that Princeton University was one of the universities which had contributed towards a total contribution of US \$ 3.5 million, for



development of the Indian Institute of Technology at Kanpur. Reference has also been made to some of the faculty in the IIT, who were to be trained at Princeton University.

(xiv) The Times of India edition of 3 March 1962 reported on a lecture delivered by Prof. L.V. Chandler, a “Princeton economist” on “Central Banking and Economic Development” in Bombay.

(xv) While reporting on firm commitment funds procured by the Nehru Academy, the Times of India dated 26 May 1964 also noted that the Nehru Academy would combine “some of the qualities, objectives and prestige of the French ‘Grandes Ecoles’ as well as of the world’s other great universities such as Oxford, Cambridge, Harvard and Princeton”.

(xvi) The Department of Public information, Princeton University issued the following Press Release on 22 September 1969:

“The centennial of the birth of the Indian leader Mahatma Gandhi will be marked at a program sponsored by the India Association of Princeton in Alexander Hall on the University campus at 8 p.m this Saturday, September 27.

President Robert F. Goheen, who was born in India and spent much of his boyhood in that country, where his parents were Presbyterian medical missionaries, will preside at the meeting. The public is cordially invited to the ceremonies.

The evening’s program will feature talks on Gandhi, the Hindu spiritual leader and champion of independence for India who was killed in 1948, by Louis Fischer, Visiting Lecturer in International Affairs at the Woodrow Wilson School of Public and International Affairs, and C.V.



Narasimhan, Under Secretary-General of the United Nations.

Also scheduled are the performance of the Indian classical dance, Bharat Natyam, and a Sitar recital.

The one man largely responsible for India's freedom, Gandhi was a deeply religious man who developed the method of non-violent agitation or passive resistance that has been used in many subsequent struggles, notably in U.S. civil rights battles. All of his life he fought non-violently for the poor millions of India, seeking not only to remove the political evils of India, but also its social and economic ills.

The India Association of Princeton is an organisation of natives of that country and other people interested in India, living in and around Princeton. The Association has regularly celebrated India's Independence Day, Republic Day and various other festivals of the land, as well as presenting "cultural evenings" from time to time."

(xvii) The Times of India of 13 September 1970 carried an article on Dr. S.N. Agarwala, observing, among other things, that he was the first Indian to obtain a Ph.D. in demography from Princeton University.

(xviii) The Times of India of 17 May 1973, under the title "Delhi varsity honours 22 luminaries", reported that degrees were conferred *in absentia* on various luminaries, one of whom was Prof. Harish Chandra, Professor of mathematics at Princeton.

(xix) The 4 February 1975 edition of the Times of India reported the commencement of Indo-US cultural talks, noting that the leaders of the two delegations were Mr. G.



Parthasarathy of India and Mr. Robert Goheen, former president of Princeton University.

(xx) An oncoming meeting of astrophysicists from India and abroad, to be held in Bombay, was reported in the Times of India of 5 January 1976, one of the speakers in which was Prof. Jeremiah P. Ostriker from Princeton University Observatory.

(xxi) The Times of India of 31 March 1977 carried a report from Washington of the plan of the White House to appoint Mr. Robert F. Goheen, former president of Princeton University, as Ambassador to India. The article highlighted the links of Mr. Goheen to India, including the fact that his parents had served as medical missionaries in Western India between 1904 and 1944, his paternal grandparents were missionaries in the Kolhapur district of the then Bombay Presidency, he himself had been educated at the American School in Kodaikanal till 1934 and that he had visited India several times on important missions and had also served as a consultant for the Ford Foundation's program at the Delhi University and was a trustee for the Rockefeller Foundation for its agricultural research programs in India.

(xxii) The conferment of an honorary doctorate on Mr. Nani Palkhivala, estimated by many to be the greatest lawyer that this country has produced, by Princeton University was reported in the 8 June 1978 edition of the Times of India.



(xxiii) The 5 October 1981 edition of the Times of India reported that, at a function held to mark the formal opening of the United States branch of the Bharatiya Vidya Bhawan on 4 October 1981, addressed by Mr. M. Hidayatullah, then the Vice President of India, Dr. Robert Goheen performed the inaugural ceremony by lighting the oil lamp.

(xxiv) The 4 August 1982 edition of the Times of India reported that the trustees of the J. N. Tata Endowment of Indians had selected 80 new scholars for studies abroad during the academic year 1982-1983, many of whom “have secured admission to distinguished universities in the US like Harvard, MIT, Wharton School, Princeton, Yale and Cornell.”

(xxv) It was reported in the Times of India of 2 February 1984 that among the functions to be held during the Festival of India, to be organised in major cities in the US in June 1985, was a seminar to be held in the Princeton University on “democracy”.

(xxvi) The 26 December 1990 edition of the Times of India carried an article regarding credit recommendations by the American Council on Education for the NCC Course to over 1500 U.S. colleges and universities, which included Cornell, Princeton, University of California-Berkeley, and the State University of New York.



Thus, asserts Mr. Lall, there has been an actual user of the PRINCETON mark in India since 1911 and continuously thereafter.

**10.** Additionally, Mr. Lall emphasises the following facts:

(i) The plaintiff offered the Parvin Fellowship to citizens of less developed countries (which status our great country, thankfully, does not retain on date), including India. Reference is also made to various distinguished personalities who availed the said Fellowship.

(ii) The number of students holding Indian citizenship who matriculated in the Degree, Undergraduate and Graduate programs of the plaintiff have been tabulated from 1970 to 1999. In 1999, 1149 Indian students were conferred undergraduate, and 478 Indian students were conferred graduate degrees by the plaintiff. Reference has also been made to twelve eminent Indians who were educated at Princeton.

(iii) The plaintiff has academic associations with India. In 2018, the M.S. Chadha Centre for Global India was established at Princeton University to address key interactions between India and the world, and to bring together scholars and students from all disciplines to broadly explore contemporary India, including its economy, politics and culture. The plaintiff also offered programs on South Asian Studies including the languages of Hindi, Urdu and Sanskrit, and provided



opportunities to study in South Asia including a year in India. The plaintiff is associated with the Ashoka University, Sonipat. The plaintiff also offers a Novogratz Bridge Year Program in several countries including India. It has student groups of India just like Princeton Bhangra, Naacho and Tarana. Among its Study Abroad programs, students of the plaintiff are sent to various parts of India. The Princeton Club of India is an India specific alumni Association of the plaintiff.

**11.** Besides, Mr. Lall points out that several faculty members and students of the plaintiff received multiple prestigious awards including the Nobel Prize, that Albert Einstein occupied an office in the plaintiff's mathematics building in the 1930s and that the plaintiff was rated at the top of the charts from the U.S. News and World Report for 11 years in a row. Inasmuch as Mr. Lall has categorically stated that he is not pleading spillover of reputation of the plaintiff into India, these facts, howsoever laudatory they may be of the plaintiff, are of little significance to the case on hand.

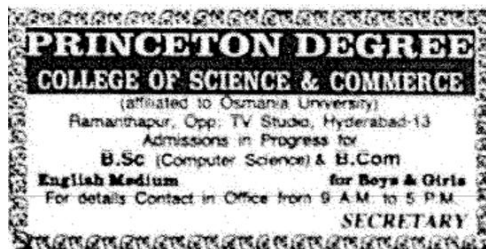
**12.** Thus, submits Mr. Lall, as the user, by the plaintiff, of PRINCETON as a mark, dates back to 1911, and the defendants are claiming earliest user since 1991 of PRINCETON as part of the name of its institutions, a clear case of infringement, by the defendants, of the plaintiff's registered trade mark, within the meaning of Section 29(2)(c)<sup>1</sup> read with Section 29(3)<sup>2</sup> of the Trade Marks Act is made out.

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<sup>1</sup> (2) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which because of—



13. Commencing arguments on behalf of the defendants, Mr. Kacker submitted that the defendants are claiming user of the mark “PRINCETON” since 1991. He has, in this context, invited my attention to letter dated 16 July 1991, addressed by the Osmania University to Defendant 1, whereby Defendant 1 was granted permission to start a Degree College at Ramanathapur in certain specified disciplines subject to fulfilment of statutory compliance is. Following this, on 14 August 1991, Defendant 1 released the following advertisement in the newspaper:



14. As against this, submits Mr. Kacker, the plaintiff has, in its affidavit of user of the PRINCETON Mark, filed with its application dated 28 September 2012, pleaded user of the mark w.e.f. 30 April 1996. He has drawn my attention to para 3 and 22 of the said affidavit, which read as under:

“3. *The Applicant has claimed the user of the subject application PRINCETON UNIVERSITY from April 30, 1996. The Applicant however has been conducting an institution of higher education since 1746 and in the name of The Trustees of Princeton*

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- (a) its identity with the registered trade mark and the similarity of the goods or services covered by such registered trade mark; or
  - (b) its similarity to the registered trade mark and the identity or similarity of the goods or services covered by such registered trade mark; or
  - (c) its identity with the registered trade mark and the identity of the goods or services covered by such registered trade mark,

is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trade mark.

<sup>2</sup> (3) In any case falling under clause (c) of sub-section (2), the court shall presume that it is likely to cause confusion on the part of the public.





University since February 13, 1896. Since then it has uninterruptedly and continuously used the same for its activities in the area of academia. The Applicant's Charter of 1963, as reprinted in the year 1998 is attached and marked as **Exhibit "A"**. The same also evidences that the Applicant had its origin in the Charter, granted under the letters patent of His Majesty, King George the Second, which passed the Great Seal of the province of New Jersey on October 22, 1746.

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22. *Due to the uninterrupted and constant use of the trademark PRINCETON is the year 1996 the Applicant has acquired such international goodwill, reputation and fame that the use of identical or deceptively similar mark by any other institution not connected to the Applicant, in respect of any goods and/or services whatsoever, is bound to cause confusion and deception in the minds of the public, leading them to falsely believe that such institute has some nexus or affiliation with the Applicant."*

Mr. Kacker relies on Section 34<sup>3</sup> of the Trade Marks Act, to contend that, for the purposes of the said provision, the plaintiff has to restrict its earliest claim of user of the PRINCETON mark to 1996. Any claim of infringement, he submits, would have to abide by the declaration of user submitted at the time of obtaining registration of the PRINCETON mark, in view of Section 34. If, on the other hand, the plaintiff is to plead passing off, then, submits Mr. Kacker, though the declaration of user, submitted at the time of obtaining registration of the PRINCETON mark by the plaintiff may not bind the plaintiff, the standard of confusion or deception, required to be established to

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<sup>3</sup> **34. Saving for vested rights.** – Nothing in this Act shall entitle the proprietor or a registered user of registered trade mark to interfere with or restrain the use by any person of a trade mark identical with or nearly resembling it in relation to goods or services in relation to which that person or a predecessor in title of his has continuously used that trade mark from a date prior –

(a) to the use of the first-mentioned trade mark in relation to those goods or services be the proprietor or a predecessor in title of his; or

(b) to the date of registration of the first-mentioned trade mark in respect of those goods or services in the name of the proprietor of a predecessor in title of his;



whichever is the earlier, and the Registrar shall not refuse (on such use being proved) to register the second mentioned trade mark by reason only of the registration of the first-mentioned trade mark.



substantiate the claim of passing off, is much higher and, in Mr. Kacker's submission, the plaintiff's case falls short of that standard.

**15.** Even apropos the user claim of 1996, Mr. Kacker submits that the only evidence placed on record by the plaintiff is its View Book for the year 1996-1997, which is stated to be used by the plaintiff admission office as a recruitment tool. This, submits Mr. Kacker, does not constitute commercial use for the purposes of the Trade Marks Act. Mr. Kacker invites my attention to the fact that, in para 15, and the paras which follow in the plaint, the plaintiff has acknowledged that its association with India started in 2018. Clearly, therefore, submits Mr. Kacker, the plaintiff cannot claim priority of user of the PRINCETON mark, *vis-à-vis* the defendants.

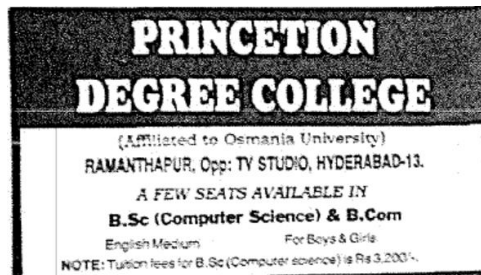
**16.** In any event, submits Mr. Kacker, the logos of the plaintiff and the defendants are completely different, and there is no chance, whatsoever, of any confusion between them. The two logos have been presented, side by side, in para-10 of the written statement filed by the defendants, thus:

Defendant's trade logo	Plaintiff's trade logo
	



17. The documents and material relied upon by the plaintiff to demonstrate user, by it, of the PRINCETON mark, submits Mr. Kacker, does not constitute commercial use of the mark in India. As against this, the defendants have placed on record the advertisement dated 14 August 1991 reproduced in para 13 *supra*, as well as the following advertisement which also figured in newspapers of 1991 and later years:

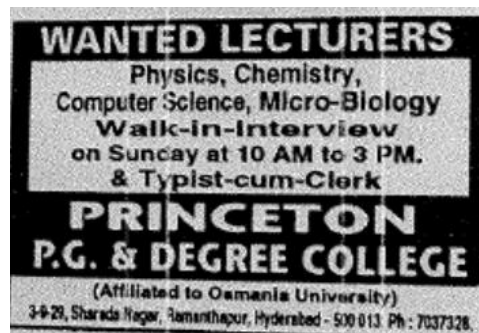
(On 29 July 1991)



(In 1993)



(In the Deccan Chronicle of 25 July 1996)





(In the Deccan Chronicle of 13 July, 1997)

**PRINCETON**  
**P.G., DEGREE & JUNIOR COLLEGE**  
Affiliated to Osmania University / Recognised by Government of A.P.  
 3-9-29, Sheradnagar, Ramanthapur, Hyderabad - 13. Ph : 7037328

**ADMISSIONS ARE IN PROGRESS**

**COURSES OFFERED IN**  
**DEGREE**

**B.Sc.** : M.P.C., M.P.Cs., M.S.Cs., M.P.E.,  
 M.Z.C., M.G.C., M.B.C.,

**B. Com & B.Com Computers** Approved by C.U.

**COURSES OFFERED IN**  
**INTERMEDIATE**

**M.P.C., B.P.C., M.E.C., C.E.C.,**

(In the Deccan Chronicle of 20 July 1997)

SCA/99471

**PRINCETON**  
**P.G., DEGREE & JUNIOR COLLEGE**  
Affiliated to Osmania University / Recognised by Government of A.P.  
 3-9-29, Sheradnagar, Ramanthapur, Hyderabad - 13. Ph : 7037328

**COURSES OFFERED**

**INTERMEDIATE**  
**M.P.C., B.P.C.,**  
**M.E.C., C.E.C.,**

**B. Com &**  
**B.Com**  
**COMPUTERS**

**B.Sc.:**  
 MATHEMATICS, PHYSICS, ELECTRONICS  
 MATHEMATICS, PHYSICS, CHEMISTRY  
 MATHEMATICS, PHYSICS, COMPUTER SCIENCE  
 MATHEMATICS, STATISTICS, COMPUTER SCIENCE  
 MICRO BIOLOGY, BOTANY, CHEMISTRY  
 MICRO BIOLOGY, ZOOLOGY, CHEMISTRY  
 MICRO BIOLOGY, GENETICS, CHEMISTRY

- College with full infrastructural facilities
- Well equipped laboratories and library.
- Experienced and highly qualified lecturers
- Sound Management

**INSTANT CANDIDATES CAN REGISTER**

**Direct Bus Routes:**  
 18R, 115, 115V, 71, 113, 71D

Given the nature of these advertisements, Mr. Kacker submits, further, that there is no chance of confusion, in the mind of an average consumer, between the plaintiff and the defendants, and the services provided by each.



**18.** Supplementing the submissions of Mr. Kacker, Mr. Raj Shekhar Rao, learned Senior Counsel, submitted that the plaint contains no averment or evidence of use, by the plaintiff, of the PRINCETON mark in India prior to 1996, as would constitute “use”, within the meaning of the Trade Marks Act. All the material relied on by the plaintiff, even if seen cumulatively, he submits, would not constitute such “use”. Besides, submits Mr. Rao, the plaintiff is, at this stage, bound by the user claim of 1996, made at the time of obtaining registration of the PRINCETON mark.

**19.** Mr. Raj Shekhar Rao echoes the submission of Mr. Kacker that there is no commonality between the consumers of the plaintiff and of the defendants, and there is, therefore, no chance of confusion.

**20.** Mr. Rao further submits that the plaintiff is estopped from seeking any injunctive relief against the defendants on the principle of acquiescence by conduct. The assertion, in para 34 of the plaint, that the plaintiff came to learn of the defendants’ activities only through an Internet investigation conducted by the plaintiff attorneys, he submits, is inherently unbelievable. Despite knowledge of the defendants’ institutions, which were functioning in broad daylight, Mr. Rao submits that the plaintiff permitted the defendants to build up their activities, to the point where the defendants have been using the impugned PRINCETON mark for 30 years. In such circumstances, he submits that the plaintiff cannot seek any injunction against the defendants at this late stage and relies, for the said purpose, on the



judgment of this Court in *Shri Gopal Engineering & Chemical Works v. POMX Laboratory*<sup>4</sup>.

**21.** As a matter of compromise, Mr. Rao submits that the defendants are willing to restrict their activities and operations to the State of Andhra Pradesh. In that event, he submits that there can be no question of any confusion or association, in the minds of a consumer, between the defendants and the plaintiff. Indeed, submits Mr. Rao, there is no evidence of even an intent, on the defendants' part, to confuse anyone.

**22.** Arguing in rejoinder, Mr. Lall submits that he is not pleading transborder reputation of his client, or its spillover into India, as a ground to seek injunction. He reiterates that the documents filed by him and noted in para 9 *supra* manifest actual use, by the plaintiff, of the mark PRINCETON in India since 1911 and, in any case, much prior to 1991, which is the earliest user of the impugned mark, pleaded by the defendants.

**23.** Mr. Lall submits that user of the mark is irrelevant as a consideration in Section 29(2)<sup>5</sup> of the Trade Marks Act, which requires likelihood of confusion to be determined on the basis of

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<sup>4</sup> 1992 (22) DRJ 504

<sup>5</sup> (2) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which because of –

- (a) its identity with the registered trade mark and the similarity of the goods or services covered by such registered trade mark; or
- (b) its similarity to the registered trade mark and the identity or similarity of the goods or services covered by such registered trade mark; or
- (c) its identity with the registered trade mark and the identity of the goods or services covered by such registered trade mark,

is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trade mark.





notional use of the mark by the registrant. In the present case, he submits that, in fact, the facts would justify invocation or even of Section 29(3)<sup>6</sup>, as the marks are identical, and used for identical services.

**24.** The only circumstance in which the defendants could escape the clutches of Section 29(2), or 29(3), submits Mr. Lall, is if the defendants can bring its case within Section 34. Mr. Lall disputes, emphatically, the submission of Mr. Kacker and Mr. Rao that the defendants are entitled to the benefit of the said Section. Mr. Lall also contests the submission of Mr. Kacker that the plaintiff is bound down by its 1996 plea of user, submitted to the Trade Marks Registry at the time of seeking registration of the PRINCETON mark. He submits that, at the time when the plaintiff applied for registration of the PRINCETON mark under Section 18 of the Trade Marks Act, the Act did not require the plaintiff to mention user of the mark. The requirement of mentioning user was to be found only in the Trade Marks Rules, specifically in Rule 25 of the Trade Marks Rules, 2017. That claim of user could not be regarded as sanctified or final, as it was rectifiable under Section 58<sup>7</sup> of the Trade Marks Act. He relies, in this context, on the judgment of the Division Bench of this Court in

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<sup>6</sup> (3) In any case falling under clause (c) of sub-section (2), the court shall presume that it is likely to cause confusion on the part of the public.

<sup>7</sup> **58. Correction of register.** –

- (1) The Registrar may, on application made in the prescribed manner by the registered proprietor, –
- (a) correct any error in the name, address or description of the registered proprietor of a trade mark, or any other entry relating to the trade mark;
  - (b) enter any change in the name, address or description of the person who is registered as proprietor of a trade mark;
  - (c) cancel the entry of a trade mark on the register;
  - (d) strike out any goods or classes of goods or services from those in respect of which a trade mark is registered,



*Intellectual Property Attorneys Association v. U.O.I.*<sup>8</sup> Mr. Lall submits that the expression “use” in Section 34 has to be interpreted in the light of Section 2(2)(c)(ii)<sup>9</sup>, which envisages actual use. If, therefore, there is evidence of actual use, by the plaintiff, of its registered mark, from a point of time prior to the user claimed while seeking registration, that actual use, submits Mr. Lall, would prevail over the erroneous claim of user submitted to the Trade Marks Registry at the time of seeking registration of the asserted mark. He also relies, while on this point, on Section 31(1)<sup>10</sup> of the Trade Marks Act, where under registration is only *prima facie* evidence of validity of the registered mark. Under Section 2(2)(c)(ii), submits Mr. Lall, “any statement about the availability, provision of performance” of services, in relation to which a mark is registered, would constitute “use of the mark”, for the purposes of the Trade Marks Act. The news articles and other documents enumerated in para 9 *supra*, submits Mr. Lall, constitute “use” of the PRINCETON mark, as they act as source identifiers of the plaintiff, and specifically refer to the educational services that the plaintiff provides. Mr. Lall also emphasises the clear mischief, as he would submit, to which the defendants have resorted,

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and may make any consequential amendment or alteration in the certificate of registration, and for that purpose, may require the certificate of registration to be produced to him.

<sup>8</sup> 2014 SCC OnLine Del 1912

<sup>9</sup> (2) In this Act, unless the context otherwise requires, any reference –  
 (a) to “trade mark” shall include reference to “collective mark” or “certification trade mark”;  
 (b) to the use of a mark shall be construed as a reference to the use of printed or other visual representation of the mark;  
 (c) to the use of a mark, -  
 (i) in relation to goods, shall be construed as a reference to the use of the mark upon, or in any physical or in any other relation whatsoever, to such goods;  
 (ii) in relation to services, shall be construed as a reference to the use of the mark as or as part of any statement about the availability, provision or performance of such services;

<sup>10</sup> 31. **Registration to be prima facie evidence of validity.** –

(1) In all legal proceedings relating to a trade mark registered under this Act (including applications under Section 57), the original registration of the trade mark and of all subsequent assignments and transmissions of the trade mark shall be *prima facie* evidence of the validity thereof.





by copying the plaintiff's PRINCETON mark for identical services. Mr. Lall concludes by placing reliance on the decisions of the learned Single Judge is of this Court in *Mayo Foundation for Medical Education & Research v. Bodhisatva Charitable Trust*<sup>11</sup> and *The British School Society v. Sanjay Gandhi Educational Society*<sup>12</sup>. He also relies on *Google LLC v. DRS Logistics (P) Ltd.*<sup>13</sup>, rendered by a Division Bench of this Court.

25. Advancing a short surrejoinder with the permission of the Court, Mr. Kacker submits that the decisions cited by Mr. Lall are clearly distinguishable. *Mayo Foundation*<sup>11</sup>, he submits, did not involve Section 34 of the Trade Marks Act and, moreover, contained the admission, in paras 17 to 18, of inspiration from the US Mayo Foundation. *The British School Society*<sup>12</sup> was offering services in India itself. *Google LLC*<sup>13</sup>, he submits, was the case of an advertisement, which is clear evidence of user.

26. Mr. Kacker submits that Section 34 requires actual user to be by the proprietor of the mark. The examples cited by Mr. Lall, he submits, do not evidence user of the PRINCETON mark by the plaintiff. If reference to the plaintiff in a newspaper could constitute "user" of the plaintiff's mark, then the plaintiff would be in a position to sue every newspaper which prints any news regarding the plaintiff for infringement.

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<sup>11</sup> 2023 SCC OnLine Del 3241

<sup>12</sup> (2022) 91 PTC 255

<sup>13</sup> 2023 SCC OnLine Del 4809



## Analysis

27. The plaintiff, in my considered opinion, is disentitled to any injunctive relief, in the present case, on three counts.

### 28. First Ground – Re. Infringement – Defendants are entitled to the benefit of Section 34

28.1 Section 29 of the Trade Marks Act delineates the circumstances in which infringement of a registered trademark can be said to have taken place. The Section does not, however, do anything more. It does not provide for any remedy against infringement. Where infringement is found to have taken place within the meaning of Section 29, and where the registration of the infringed trademark is valid, Section 28(1)<sup>14</sup> empowers the registrant of the trademark to obtain relief against infringement. The remedy against infringement, therefore, is made available by Section 28(1), and not by Section 29. By virtue of Section 28(1), the holder of a valid trademark registration becomes entitled to an injunction against infringement of the trademark, within the meaning of Section 29.

28.2 Section 34, however, operates as a complete exception to Section 28. If Section 34 applies, then, even if infringement of a registered trademark, within the meaning of Section 29, is found to have taken place, the registrant of the trademark is not entitled to

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<sup>14</sup> 28. **Rights conferred by registration.** –

(1) Subject to the other provisions of this Act, the registration of a trade mark shall, if valid, give to the registered proprietor of the trade mark the exclusive right to the use of the trade mark in relation to the goods or services in respect of which the trade mark is registered and to obtain relief in respect of infringement of the trade mark in the manner provided by this Act.



interfere with the use of the infringing trademark by the infringer. Section 34 applies, however, only where the use, by the infringer, of the infringing trademark, is prior both to registration, as well as use, of the infringed trademark.

**28.3** Section 2(2)(c), per statute, applies to all provisions in the Trade Marks Act which refer “to the use of a mark”. It is an omnibus provision. No other provision of the Act is insulated from its effect, “unless the context otherwise requires”. The reference to “use of a mark”, anywhere in the Trade Marks Act, therefore, necessarily relates back to Section 2(2)(c).

**28.4** Where the reference to the use of a mark, in the Trade Marks Act, is in relation to services, Section 2(2)(c)(ii) applies. It provides that any reference to the use of a mark, in the Trade Marks Act, in relation to services, “shall be construed as a reference to the use of the mark as or as part of any statement about the availability, provision or performance of such services”. Any reference to the use of a mark, contained in any statement regarding availability, provision of performance of the service in respect of which the mark is registered would, therefore, constitute “use of the mark” within the meaning of Section 2(2)(c)(ii) and, therefore, within the meaning of the Trade Marks Act in toto.

**28.5** To that extent, therefore, Mr. Lall is correct in his submission that, when examining Section 34 of the Trade Marks Act, the use of the mark, whether by the plaintiff or the defendants, has to be in terms



of Section 2(2)(c). There is, therefore, substance in Mr. Lall's submission that, irrespective of the declaration of user, made by the plaintiff at the time of applying for registration of the asserted mark, if use of the asserted mark, in the manner envisaged by Section 2(2)(c), is shown to exist from some prior point of time, that use would prevail, in preference to the declared user of the mark, at the time of applying for registration thereof.

**28.6** That, of course, does not mean that the declaration of user, at the time of applying for registration of the mark of the plaintiff, which is alleged to be infringed by the defendant, is entirely irrelevant. Ordinarily, principles of approbate and reprobate would apply to such a case. In other words, where the plaintiff has, at the time of applying for registration of its mark, declared user of the mark from a particular point of time, that declaration would ordinarily bind the plaintiff. If, however, the plaintiff is able to demonstrate, indisputably, that there is actual user of the asserted mark, by it, from a point of time prior to the user declared at the time of applying for registration, the Court cannot shut its eyes to the material used by the plaintiff in that regard, while applying Section 34. If the material does evidence actual user, by the plaintiff, of the asserted mark, then the point of time from which such user is evidenced would have to be taken into consideration while reckoning "user" for the purposes of Section 34, irrespective of the user declared at the time of applying for registration. To take a simple example, if the user is in respect of the name of an educational institution, and the plaintiff has declared user of the mark, at the time of applying for registration, from, say, 2010, but is able to show that,



since 2000, the plaintiff's College is standing, large as life, with the mark emblazoned on its façade, then the user of the mark would be reckoned from 2000, and not from 2010. To be entitled to the benefit of actual user of the mark, in preference to the user declared at the time of applying for registration, in the context of Section 34, however, the plaintiff would have to make out a case so substantial and impenetrable that the Court cannot but hold that the actual user of the plaintiff's mark is in fact anterior, in point of time, to the user declared by the plaintiff while applying for registration of the mark.

**28.7** The evidence of anterior use has, however, under Section 34(a) "by the proprietor or a predecessor in title of his". What has to be compared is, therefore, the use of the asserted mark by the proprietor, i.e. by the plaintiff, *vis-à-vis* the use of the impugned mark by the defendant. If the defendant has used the impugned mark prior to the registration, as well as the actual use of the asserted mark by the plaintiff, then the plaintiff is, under Section 34, statutorily proscribed from interfering with the use of the impugned mark by the defendant. If, on the other hand, the plaintiff is able to establish actual use of the impugned mark *by him*, prior to the use of the impugned mark by the defendant, then Section 34 would have no application, and, if infringement exists, the plaintiff would be entitled to injunction by virtue of Section 28(1).

**28.8** Viewed thus, I am in complete agreement with Mr. Rajshekhar Rao and Mr. Kacker that all the material, cited by Mr. Lall and referred to in para 9 *supra*, even seen cumulatively, does not make out



any case of user, by the plaintiff, of the PRINCETON mark in India prior to 1996. The material relied upon is entirely in the form of newspaper articles referring to persons who have interacted with the plaintiff, campus drives by the plaintiff in the US which could be of assistance to Indian universities and interaction of Indian dignitaries with the plaintiff in the US. The reporting, in almost every case, is by the Times of India or other newspapers, whether in the US or in India. Reference to a mark in a news article cannot, quite obviously, constitute use of the mark by the proprietor of the mark. Section 34 immunises an infringing defendant from interference, by the plaintiff, with his use of the infringing mark, if the defendant can establish that he has continuously used the infringing mark from a date prior both to the date of registration of the plaintiff's mark as well as to the use of the plaintiff's mark, in relation to those goods or services, "*by the proprietor or predecessor in title of his*" – in other words, by the plaintiff or his predecessor in title. All that the infringing defendant has to show, in order to escape an injunction, is, therefore, that the plaintiff's mark is registered on Date X, *the plaintiff has been using his mark since Date Y*, and the defendant has been using the infringing mark since a date which is prior in point of time both to X and Y. If this is shown, the defendant, despite infringement, escapes injunction.

**28.9** "Use of a mark" in relation to services is defined, in Section 2(2)(c)(ii), as "a reference to the use of the mark as, or as part of, any statement about the availability, provision or performance of such services". Additionally, Section 29(6) refers to "use of a registered mark" as, in respect of services,



(i) offering or supplying services under the said mark [*vide* clause (b)], or

(ii) using of the registered mark on business papers or in advertising [*vide* clause (d)],

though this definition is, in fact, apropos the alleged infringer, not the plaintiff.

**28.10** Dovetailing this definition into Section 34(a), if the defendant establishes that he has been using the impugned mark from a point of time prior to

(i) the date of registration of the mark in favour of the plaintiff, and

(ii) the use of the mark *by the plaintiff* as part of any statement about the availability, provision or performance of the services provided by him,

the defendant would be entitled to the benefit of Section 34.

**28.11** There is no dispute that the use, by the defendants, of the impugned PRINCETON mark is prior, in point of time, to the date of registration of the plaintiff's marks, which is 28 September 2012. Condition (i), therefore, stands satisfied.

**28.12** Condition (ii) requires the defendants to show that they have been using the impugned PRINCETON mark from a point of time prior to the use of the PRINCETON mark by the plaintiff, i.e., prior to the point of time from which the plaintiff has made a statement about



the availability, provision or performance of the services which it provides under the PRINCETON mark.

**28.13** The material relied upon by Mr. Lall to establish priority of user, by the plaintiff, of the PRINCETON mark, as enumerated in para 9(i) to (xxvi), even if seen cumulatively, does not make out a case of such user *by the plaintiff*. This material consists of

- (i) news items, published by various newspapers, periodicals and other publications by third parties, chiefly the Times of India, in which there is a reference to the plaintiff and the services provided by it, and
- (ii) a Press Release, dated 22 September 1969, issued by the Department of Public Information of the plaintiff, which announced the program scheduled to be held to celebrate the centennial of the birth of Mahatma Gandhi, but which makes no reference to the services provided by the plaintiff.

The plaintiff has not, therefore, placed on record any material indicating any statement, *by the plaintiff*, about the availability, provision or performance of the services provided by it, accessible in India, prior to 1991, which is the undisputed date of user, by the defendants, of the impugned PRINCETON mark. All references to the plaintiff, in the material placed on record by it, and cited by Mr. Lall, are to statements made by others – in fact, to articles published by the Times of India. Reference to the plaintiff, or even to the services rendered by it, in articles published in newspapers which are not printed or published by the plaintiff, cannot constitute use, by the plaintiff, of the PRINCETON mark, as envisaged by Section 34(a) of the Trade Marks Act. Mr Lall does not seek to contend that, on or





before 1991, the plaintiff was ever providing any services in India, educational or otherwise. No material to that effect is forthcoming on the record, either. The mere facts that several Indians may have been educated in the plaintiff's institution in the US, quite obviously, would not amount to "use", by the plaintiff, of its PRINCETON mark in India for providing services.

**28.14** Specifically adverting to the material cited by Mr. Lall,

- (i) the "Indian Tiger" newspaper is merely shown as having been intermittently published *by the alumni of the plaintiff*,
- (ii) all other news articles are printed and published by the Times of India, not by the plaintiff, and
- (iii) if one were to advert to the contents of the article, to examine whether they disclose use, by the plaintiff, of its PRINCETON mark in India prior to 1991, it is seen that
  - (a) the articles dated 29 September 1936 and 4 February 1949 only refers to eminent Indians being appointed to posts in the plaintiff-institution in the US,
  - (b) the article dated 11 November 1949 merely contains a photograph of Pt. Nehru and Albert Einstein meeting in the premises of the plaintiff in the US,
  - (c) the article dated 29 March 1953 refers to frog skeletons from Bombay having been added to the collection of fossil vertebrates in the plaintiff institution in the US,



- (d) the Ten Cents journal, printed by the plaintiff in the US, refers to setting up of a Reporting Centre for the Blind in the plaintiff institution itself,
- (e) the 7 July 1956 article refers to an Indian having become the plaintiff's senior-most alumnus,
- (f) the 27 May 1956 article refers to a visit by the Indian Health Minister to the plaintiff institution in the US,
- (g) the 8 June 1957 article refers to a study, regarding India, conducted in the plaintiff-Institution in the US,
- (h) the article dated 7 January 1957 reports about the visit of the President-elect of the plaintiff institution in the US to India,
- (i) the 27 December 1959 article refers to how an Indian girl was admitted to the plaintiff-institution in the US, against its policy of not admitting girls,
- (j) the 3 October 1961, 3 March 1962 and 4 February 1975 articles refer to addresses delivered by Indian personalities at the plaintiff-institution in the US,
- (k) the 16 April 1962 article reports about the plaintiff having provided financial aid to the Indian Institute of Technology, Kanpur,
- (l) the article dated 26 May 1964 noted the objectives of the Nehru Academy which included imbibing the qualities of, *inter alia*, the plaintiff-Institution,



- (m) the Press Release, dated 22 September 1969, by the plaintiff, reported celebrations of the birth centenary of Mahatma Gandhi at the plaintiff-Institution in the US,
- (n) the 13 September 1970 and 9 June 1978 articles referred to obtaining of educational qualifications by eminent Indians from the plaintiff-Institution in the US,
- (o) the 17 May 1973 article referred to the Delhi University conferring an honorary doctorate on an Indian Professor of Mathematics in the plaintiff-institution in the US,
- (p) the 5 January 1976 article refers to a speech being delivered in India by a faculty member of the plaintiff,
- (q) the 31 March 1977 and 5 October 1981 articles referred to visits by the President-elect of the plaintiff to India,
- (r) the 4 August 1982 article referred to scholarships being provided by an Indian institution for study abroad in, *inter alia*, the plaintiff-Institution in the US,
- (s) the 2 February 1984 article referred to the Festival of India held in the US in, among others, the plaintiff-Institution, and
- (t) the 26 December 1990 article referred to credit recommendations by the American Council on Education for study in over 1500 institutions in the US including the plaintiff,

*none of which* evidence providing of commercial services by the plaintiff in India, under the mark PRINCETON, and may



amount, at the highest, to publicity for the plaintiff in India. The material cited in para 10 *supra*, too, does not do so. The Parvin Fellowship is offered by the plaintiff to citizens of less developed countries. Reference to Indian students studying at Princeton, howsoever large the number, cannot amount to the plaintiff providing services, in India, under the PRINCETON mark. Opening of centres in the plaintiff-institution in the US, dealing with Indian subjects, Indian studies, or Indian cultural activities, too, does not reflect use, by the plaintiff, of the PRINCETON mark *in India* prior to 1991.

**28.15** Zero, in all its multiples, remains zero. Multiplying references of newspaper articles published in India, which make reference to the plaintiff-institution located in the US cannot, viewed any which way, constitute “use”, by the plaintiff, of the PRINCETON mark in India, within the meaning of Section 2(2)(c)(ii) and, therefore, Section 34(b) of the Trade Marks Act, 1999.

**28.16** Moreover, in order for the defendants *not to be entitled* to the benefit of Section 34, there has to be evidence, not merely of use, *but of continuous use*, by the plaintiff, of the PRINCETON mark in India prior to the date of user, by the defendants, of the impugned mark, i.e. prior to 1991. Even if it were to be assumed, *arguendo*, that any of the examples cited by Mr. Lall, in para 9 *supra*, evidence use of the PRINCETON mark by the plaintiff in India, they certainly do not make out a case of *continuous use* of the mark. At the highest, there are sporadic references, from time to time, to the plaintiff and the



services it provides – *in the US* – in Indian newspapers and publications. The requirement of “continuous use” of the plaintiff’s mark, envisaged as a counterpoint to the defendant’s right by Section 34 is also, therefore, not satisfied.

**28.17** Section 34, as already noted, acts as an exception to Section 28(1). Even if the defendants’ marks infringe the plaintiff’s mark, within the meaning of Section 29, the plaintiff is, nonetheless, disentitled from any relief against infringement, as is otherwise available to it under Section 28, once Section 34 is found to apply. Once section 34 applies, and the plaintiff is, therefore, disentitled from interfering with the use, by the defendants, of the defendants’ marks, any examination of the aspect of infringement is reduced to an exercise in futility. The necessity of examining the present case, *vis-à-vis* Section 29, therefore, stands eschewed.

**28.18** Section 34, therefore, constitutes the first ground on which the plaintiff is disentitled to interlocutory injunctive relief.

**29. Second ground – No case of passing off is made out**

**29.1** The distinction between infringement and passing off, and the differing considerations which apply in each case, are most classically explained in the following passage from *Kaviraj Pandit Durga Dutt Sharma v. Navaratna Pharmaceutical Laboratories*<sup>15</sup>:

“28. The other ground of objection that the findings are inconsistent really proceeds on an error in appreciating the basic

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<sup>15</sup> AIR 1965 SC 980



differences between the causes of action and right to relief in suits for passing off and for infringement of a registered trade mark and in equating the essentials of a passing off action with those in respect of an action complaining of an infringement of a registered trade mark. We have already pointed out that the suit by the respondent complained both of an invasion of a statutory right under Section 21 in respect of a registered trade mark and also of a passing off by the use of the same mark. *The finding in favour of the appellant to which the learned counsel drew our attention was based upon dissimilarity of the packing in which the goods of the two parties were vended, the difference in the physical appearance of the two packets by reason of the variation in the colour and other features and their general get-up together with the circumstance that the name and address of the manufactory of the appellant was prominently displayed on his packets and these features were all set out for negating the respondent's claim that the appellant had passed off his goods as those of the respondent. These matters which are of the essence of the cause of action for relief on the ground of passing off play but a limited role in an action for infringement of a registered trade mark by the registered proprietor who has a statutory right to that mark and who has a statutory remedy for the event of the use by another of that mark or a colourable imitation thereof. While an action for passing off is a Common Law remedy being in substance an action for deceit, that is, a passing off by a person of his own goods as those of another, that is not the gist of an action for infringement. The action for infringement is a statutory remedy conferred on the registered proprietor of a registered trade mark for the vindication of the exclusive right to the use of the trade mark in relation to those goods” (Vide Section 21 of the Act). The use by the defendant of the trade mark of the plaintiff is not essential in an action for passing off, but is the sine qua non in the case of an action for infringement. No doubt, where the evidence in respect of passing off consists merely of the colourable use of a registered trade mark, the essential features of both the actions might coincide in the sense that what would be a colourable imitation of a trade mark in a passing off action would also be such in an action for infringement of the same trade mark. But there the correspondence between the two ceases. 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 plaintiff's 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 plaintiff's 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; whereas in the case of passing off, the defendant may escape liability if he can show that the added matter is sufficient to distinguish his goods from those of the plaintiff.”

(Italics and underscoring supplied)

**29.2** Based on the law laid down by the Supreme Court in *Satyam Infoway Ltd. v. Siffynet Solutions (P) Ltd.*<sup>16</sup>, *Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd.*<sup>17</sup>, this Court has, in its judgment in *FDC Limited v. Faraway Foods Pvt. Ltd.*<sup>18</sup>, identified the following indicia of the tort of passing off:

“75. From the aforementioned decisions, the following clear principles emerge:

(i) Passing off, though an action based on deceit, does not require the establishment of fraud as a necessary element to sustain the action. Imitation or adoption, by the defendant, of the plaintiffs trade mark, in such manner as to cause confusion or deception in the mind of prospective customers, is sufficient.

(ii) The principles for grant of injunction, in passing off actions, are the same as those which govern the grant of injunctions in other cases, i.e. the existence of a *prima facie* case, the balance of convenience, and the likelihood of irreparable loss in issuing to the plaintiff, were injunction not to be granted.

(iii) Proof of actual damage is not necessary, to establish passing off. However, proof of misrepresentation is necessary, even if intent to misrepresent is not approved. The question of intent may, nevertheless, be relevant, when it comes to the ultimate relief to be granted to the plaintiff.

(iv) Passing off may be alleged by a claimant who owns sufficient proprietary interest in the goodwill associated with

<sup>16</sup> (2004) 6 SCC 145

<sup>17</sup> (2001) 5 SCC 73

<sup>18</sup> 2021 SCC OnLine Del 1539



the product, which is really likely to be damaged by the alleged misrepresentation.

(v) Grant of injunction, in cases where passing off is found to exist, is intended to serve two purposes, the first being preservation of the reputation of the plaintiff, and the second, safeguarding of the public against goods which are “passed off as those of the plaintiff.

(vi) The ingredients/indicia of the tort of passing off are the following:

(a) There must be sale, by the defendant, of goods/services in a manner which is likely to deceive the public into thinking that the goods/services are those of the plaintiff.

(b) The plaintiff is not required to prove long user to prove established reputation. The existence, or otherwise, of reputation, would depend upon the volume of the plaintiffs sales and the extent of its advertisement.

(c) The plaintiff is required to establish

(i) misrepresentation by the defendant to the public, though not necessarily *mala fide*,

(ii) likelihood of confusion in the minds of the public (the public being the potential customers/users of the product) that the goods of the defendant are those of the plaintiff, applying the test of a person of “imperfect recollection and ordinary memory”,

(iii) loss, or likelihood of loss, and

(iv) goodwill of the plaintiff, as a prior user.

Elsewhere, the five elements of passing off have been identified as (a) misrepresentation, (b) made by the trader in the course of trade, (c) to prospective customers or ultimate consumers of the goods or services supplied by him, (d) calculated to injure the business or goodwill of another (i.e. that such injury is reasonably foreseeable) and (e) actual damage, or the possibility of actual damage, to the business or goodwill of the plaintiff.





(vii) In cases of alleged passing off, the Court, while examining the likelihood of causing confusion, is required to consider, in conjunction, *inter alia*,

- (a) the nature of the market,
- (b) the class of customers dealing in the product,
- (c) the extent of reputation possessed by the plaintiff,
- (d) the trade channels through which the product is made available to the customer and
- (e) the existence of connection in the course of trade. The Supreme Court has also held that, in passing off action on the basis of unregistered trade marks, the Court is required to assess the likelihood of deception or confusion by examining
  - (i) the nature of the marks, i.e. whether there were demands/label marks/composite marks,
  - (ii) the degree of similarity between the competing marks,
  - (iii) the nature of the goods,
  - (iv) the similarity in nature, character and performance of the goods of the rival parties,
  - (v) the class of purchasers, and the degree of care which they would be expected to exercise while purchasing the goods, and
  - (vi) the mode of purchasing the goods and placing orders.

(viii) That the defendant is not producing the goods manufactured by the plaintiff may not be relevant, where the plaintiff's mark is found to have sufficient reputation.

(ix) Courts are required to be doubly vigilant where passing off is alleged in respect of pharmaceutical products, in view of the possibility of adverse effects resulting from administration of a wrong drug. For the said reason, the degree of proof is also lower, in the case of alleged passing of pharmaceutical products.

(x) Passing off differs from infringement. Passing off is based on the goodwill that the trader has in his name, whereas infringement is based on the trader's proprietary right in the name, registered in his favour. Passing off is an action for deceit, involving passing off the goods of one person as those of another, whereas an action for



infringement is a statutory remedy conferred on the registered proprietor of a registered trade mark for vindication of its exclusive right to use the trade mark in relation to the goods in respect of which registration has been granted. Use of the trade mark by the defendant is not necessary for infringement, but it is a *sine qua non* for passing off. Once sufficient similarity, as is likely to deceive, is shown, infringement stands established. Passing off, however, may be resisted on the ground of added material, such as packing, procurement through different trade channels, etc., which would distinguish the goods of the defendant from those of the plaintiff and belie the possibility of confusion or deception.”

**29.3** Though the PRINCETON mark of the plaintiff, and the PRINCETON mark of the defendants are both used in the context of providing educational services, it would be facile, and plainly unrealistic, to believe that any consumer would confuse the services provided by the defendants with those provided by the plaintiff. The “consumer”, whether for the purposes of infringement or of passing off, though a consumer of average intelligence and imperfect recollection, has to be a consumer of the particular goods or services in respect of which the marks are used. To that extent, the consumer differs from the “man on the Clapham omnibus”. The possibility of confusion or deception, whether for infringement or passing off has, therefore, to be examined from the point of view of a student, and not the ordinary man on the street. No student, or person interested in the services provided either by the plaintiff or by the defendants, is likely to be confused between the two, merely because of the use, by the defendants, of PRINCETON as part of the name of the defendants’ institutions. The plaintiff is, today, arguably the foremost higher educational institution in the world, and provides no services outside the US. The defendants’ institutions are situated entirely within the State of Telangana, and do not even have any branch outside the said



state. No aspirant to the portals of the plaintiff-institution is likely to mistakenly join the defendants; equally, no student, who wants to join one of the defendants' institutions, is likely to mistakenly approach the plaintiff, believing them to be inter-related. Admission to the plaintiff institution is, for that matter, a formidable exercise, nearly unattainable to all but the most extraordinary of students, whereas the defendants' institutions are far more accessible and approachable. These factors, coupled with the marked dissimilarity in the logos of the plaintiff and the defendants, render the chance of the defendants, passing off their services as those of the plaintiff, or even as associated with the plaintiff, impossible.

**29.4** So wide, indeed, is the gap between the plaintiff and the defendants, that it cannot be said, *prima facie*, that, by using the impugned mark, the defendants could even be intending to pass off their services as those of the plaintiff.

**29.5** There is, however, no educational institution which cannot, or is incapable of, striving to excellence, and the observations made hereinabove should not be regarded as undermining, in any manner, the quality of education dispensed by the defendants' institutions. They are intended only to convey the finding that there is no likelihood of the defendants passing off their services as those of the plaintiff, merely because PRINCETON happens to be common to the marks of the plaintiff and the defendants.



**29.6** It cannot, therefore, be said, *prima facie*, that the use, by the defendants, of the impugned mark would result in the defendants passing off their services as those of the plaintiff.

**29.7** This is the second ground on which the plaintiff stands disentitled to any interlocutory injunction.

**30.** Third round – Balance of convenience and irreparable loss not made out

**30.1** It has recently been felicitously observed, by a Division Bench of this Court<sup>19</sup>, that there is no “levitation principle” applicable to intellectual property matters, and that interlocutory injunctions can be granted, even in cases of alleged infringement of passing off, only where the *troika* of a *prima facie* case, balance of convenience and irreparable loss are cumulatively found to exist. I express my respectful concurrence with the said view.

**30.2** The defendants have been using their mark, admittedly, since 1991. The present suit has been instituted by the plaintiff only in 2022. The defendants provide educational services, and have been providing the said services, under the impugned marks, for close on three decades as on date. No element of public interest can be said to exist in denying, to the defendants, the further right to use PRINCETON as part of the names of their institutions. No substantial case of irreparable loss being suffered by the plaintiff, as a

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<sup>19</sup> Order dated 23 August 2022 in FAO (OS) 175/2022 [**Hi Tech Arai Pvt Ltd v. Paul Components Pvt Ltd**]



consequence of the use, by the defendants, of PRINCETON as a part of their marks, has been made out in the plaint. No argument, to the said effect, was advanced, at the Bar, by Mr. Lall.

**30.3** The plaint seeks to aver that the plaintiff came to learn of the defendants only in 2020, on an internet search. While this may be true, it is somewhat hard to digest. Either which way, the defendants institutions have expanded and the impugned mark has, by now, been in use by the defendants for 32 years as on date. The balance of convenience would, clearly, rule against injuncting the defendants from continuing the use the impugned mark at this late stage.

**30.4** It is, moreover, somewhat unrealistic to believe that the mere functioning of the defendants' institutions, within the State of Telangana, is resulting in irreparable prejudice to the plaintiff. As the defendants' institutions have been functioning since 1991, the onus would be of the plaintiff to establish that they have suffered an irreparable loss as a result, tilting the balance of convenience in their favour, insofar as grant of interlocutory injunction is concerned. No arguments, to that effect, were advanced, and no substantial reference, to that effect, finds place in the plaint, either.

**30.5** *De hors*, therefore, the merits of the dispute, the plaintiff would also be disentitled to any interlocutory injunction against the use, by the defendants, of PRINCETON as part of their mark, on considerations of the principles of balance of convenience and irreparable loss. In the event the plaintiff is able to substantiate its



claim for damages during trial, the plaintiff would stand suitably recompensed by the award thereof, as and when the suit proceeds to decree.

**30.6** This, therefore, constitutes the third ground on which the plaintiff is disentitled to any interlocutory relief from this Court at this stage.

**31.** The decisions cited by Mr. Lall are, as Mr. Kacker correctly contends, distinguishable. *Mayo Foundation*<sup>11</sup> was a case which adopted the principles enunciated by the Supreme Court in *Milmet Oftho Industries v. Allergan Inc.*<sup>20</sup> as the institution in issue in that case was imparting medical education. Moreover, there was evidence, in that case, the respondents' product *having been advertised* before the appellant commenced use of its mark. There is, in the present case, no evidence of any advertisement, by the plaintiff, of its services, in India, prior to 1991. *British School Society*<sup>12</sup> did not involve Section 124 of the Trade Marks Act at all, so that the issue of the defendant, in that case, being entitled to the benefit of the said provision if it succeeded in proving user, by it, of the impugned mark prior to registration of the plaintiff's mark and user, *by the plaintiff*, of the asserted mark, never arose. *Google LLC*<sup>13</sup>, no doubt, holds that the definition of "use" in Section 2(2)(c) is not exhaustive, but that cannot help the plaintiff as there is no evidence of *continuous use, by the plaintiff*, of the PRINCETON mark prior to 1991, which is admittedly the date of first user, by the defendants, of the impugned PRINCETON mark.



## **Conclusion**

**32.** IA 6494/2022 is, therefore, dismissed.

## **CS (Comm) 270/2022**

**33.** List before the learned Joint Registrar (Judicial) on 9 October 2023.

**C.HARI SHANKAR, J**

**SEPTEMBER 06, 2023**