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**IN THE HIGH COURT OF DELHI AT NEW DELHI**

*Reserved on: 30<sup>th</sup> March, 2022*

*Date of decision: 25<sup>th</sup> April, 2022*

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**CS (COMM) 509/2021 & I.As.13426/2021, 17285/2021, 3942/2022**

THE BRITISH SCHOOL SOCIETY

..... Plaintiff

Through: Mr. Peeyoosh Kalra, Mr. C.A. Brijesh  
& Mr. Dhruv Grover, Advocates (M-  
8447335702)

versus

SANJAY GANDHI EDUCATIONAL  
SOCIETY & ANR.

..... Defendants

Through: Mr. Ashish Upadhyay, Advocate.

**CORAM:**

**JUSTICE PRATHIBA M. SINGH**  
**JUDGMENT**

**Prathiba M. Singh, J.**

**Background**

1. The present suit has been filed by the Plaintiff- The British School Society for permanent injunction against infringement of trade mark, passing off, unfair competition, rendition of accounts, damages and delivery up etc. The Plaintiff is an international, not-for-profit society located in New Delhi, India. The Plaintiff runs '*The British School*' which is located at the Chanakyapuri, New Delhi. Defendant No.1 is a registered society with its principal place of business in Chandigarh. Defendant No.2 is stated to be a resident of Panchkula, Haryana.

2. The case of the Plaintiff is that it is aggrieved on account of Defendants' unauthorised adoption and use of the mark '*The British School*', which is identical to Plaintiff's prior, distinctive and well-known mark. The mark '*The British School*' is stated to have been adopted by the Defendants in relation to

identical services, i.e., educational services, for their four schools in Punjab & Haryana.

3. In the year 1963, a group of British parents, supported by the British High Commissioner to India, started '*The British School*' in Defence Colony, New Delhi with the aim of serving the diplomatic and expatriate community. '*The British School*' operates under the aegis of the Plaintiff society with the British High Commissioner to India as its President. The word mark '*The British School*' is registered in favour of the Plaintiff under trade mark number 2518107 claiming user since 1963 in respect of services related to education, schools, colleges, etc. However, a condition to the effect that the registration of the said mark shall give no right to the exclusive use of '*The British School*' is attached to the trade mark registration.

4. Sometime in June, 2020, the Plaintiff came across Defendants' unauthorised use of the mark '*The British School*'. It also came to the knowledge of the Plaintiff that a website- [www.thebritishschool.org](http://www.thebritishschool.org) was being run by the Defendants. Further enquiries revealed that on 29<sup>th</sup> May, 2015, an application bearing no. 2973716 for the registration of the following device mark had been filed by Defendant No.2 claiming user since 1<sup>st</sup> January, 2005-



5. The application of the Defendant No.2 has been objected under Sections 9(1)(a) and 11(1) of the Trade Marks Act, 1999 (*hereinafter "Act"*). Another application bearing no. 4423768, dated 29<sup>th</sup> January, 2020 has been

filed by Defendant No.1 for the registration of the following device mark, which has been opposed by the Plaintiff-



6. A cease-and-desist notice dated 19<sup>th</sup> June, 2020 was addressed by the Plaintiff to the Defendants. Vide the said notice, the Plaintiff asked the Defendants to give up all use of the mark '*the British School*' and transfer the domain name [www.thebritishschool.org](http://www.thebritishschool.org) in favour of the Plaintiff. A follow-up letter was sent by the Plaintiff to the Defendants dated 10<sup>th</sup> July, 2020 eliciting no reply from the Defendants. This led to filing of the present suit.

7. Vide order dated 12<sup>th</sup> October, 2021, an *ex parte ad interim* injunction was granted against the Defendants from using the mark '*The British School*' or any other mark deceptively similar to Plaintiff's mark, till further orders. Thereafter, an application for the modification of the order dated 12<sup>th</sup> October, 2021 was filed by the Defendants. Vide order dated 22<sup>nd</sup> December, 2021, concession was given to the Defendants to comply with the injunction order till the end of the academic session of 2021-22 on the condition that Defendants shall not advertise the admission for the next session under the name '*The British School*'.

### **Submissions**

8. Mr. Ashish Upadhyay, Id. Counsel appearing for the Defendants submits that the order dated 12<sup>th</sup> October, 2021 injuncting the Defendants from using the mark '*The British School*' is liable to be vacated. The submission of the Id. Counsel is three-fold. The first and foremost objection of the Defendants is that the prayer for interim relief is hopelessly barred by

delay. Ld. counsel submits that the schools of Defendants have been running since the year 2005. The British School, Panchkula was the first school opened by the Defendants. Thereafter, the Defendants have expanded to Mohali, Chandigarh and Ferozepur. They are all run by Defendant No.1- Sanjay Gandhi Educational Society. The Defendants have used the mark '*The British School*' for more than 15 years and the said use is honest and concurrent.

9. His second submission is that the term '*The British School*' is not an invented word. The mark of the Plaintiff, that it seeks to protect in the present *lis*, is a combination of three generic words- 'The', 'British', and 'School'. Further, the registrations of the Plaintiff for the mark '*The British School*' has the specific disclaimer that the registration of the trade mark shall give no right to the Plaintiff for the exclusive use of '*The British School*'. He submits that if there is no right for exclusive use, the Plaintiff cannot claim monopoly over the mark '*The British School*'. The third contention of the Defendants is that the Plaintiff is not entitled to use the term '*The British School*' as it is not recognized under the British School Overseas (BSO) Scheme of the Department of Education, Government of United Kingdom.

10. He submits that Defendants' schools are fully recognized by the Cambridge International Examinations and follow the Cambridge curriculum. It is his contention that the knowledge of Defendants' schools cannot be stated to be non-existent. Mr. Upadhyay, Id. Counsel emphasizes that the Defendant No.1 has more schools and a greater number of students than the Plaintiff. Any injunction passed by this Court would affect thousands of students who are studying in Defendants' schools. On the other hand, any loss to the Plaintiff can be suitably compensated by the Defendants. He thus

submits that the injunction is liable to be vacated.

11. On behalf of the Plaintiff, the submission of Mr. Kalra, Id. Counsel is that the Plaintiff's school was started in the year 1963. It started from a small premises in Defence Colony, Delhi. Thereafter, the Plaintiff's school has acquired a huge reputation, having been associated with the British High Commission in India. It is submitted that the President of the Plaintiff Society is the High Commissioner of the U.K. to India and it is only the Plaintiff's school which is using the said mark and name in India. He submits that insofar as third-party use is concerned, another school by the name '*The British International School*' was set up in Chennai. However, after the order of injunction dated 09<sup>th</sup> December, 2021 passed by the Id. Single judge of this Court in *CS (COMM) 408/2021* titled *The British School Society v. The British International School*, the said school has changed its name to 'PLR Academy of Excellence'.

12. The main submission by the Id. Counsel for the Plaintiff is that there is no explanation for the Defendants to use the mark '*The British School*'. The intention of Defendants in using the mark '*The British School*' is to take benefit of the reputation built by the Plaintiff over the last fifty years. There is actual confusion which has occurred. Reliance is placed upon a third-party website, wherein the said website has mentioned the name of the Defendants' school in Panchkula but was showing the location of Plaintiff's school.

13. The next submission of Mr. Kalra, Id. Counsel, is that the cease-and-desist notice was issued by the Plaintiff way back in 2020. Thereafter, an *ad interim* order was passed on 12<sup>th</sup> October, 2021. Despite this position, the Defendants have still not changed the name of their school and continue to remain in contempt. It is submitted that Defendants are guilty of gross

contempt and there cannot be any justification for adopting of the mark '*The British School*' by the Defendants.

14. In rejoinder, Mr. Upadhyay, Id. Counsel submits that the Plaintiff is accredited by the Cambridge University Examination system and so are the Defendants' schools. There is no dishonest adoption by the Defendants of the mark '*The British School*'. In any event, if the Plaintiff was aggrieved by use of the mark '*The British School*' by the Defendants, they ought to have come early and avail their legal remedies in order to seek the present injunction and not waited for four schools to be established over a span of 15 years. Mr. Kalra, Id. Counsel, on the other hand, submits that the affiliation of Defendants' schools with the University of Cambridge has also been withdrawn. The said fact, is confirmed by Mr. Upadhyay, Id. Counsel for Defendants, on getting instructions.

#### **Analysis & Discussion**

15. The colonial influence on the education system in India has taken a distinct dimension in the present case wherein the mark involved has reference to the British i.e., - '*The British School*'. The Plaintiff is the British School Society which runs The British School, New Delhi, attached to the High Commission of the United Kingdom in Chanakyapuri, New Delhi. Defendant No.1 is the Sanjay Gandhi Educational Society based in Panchkula, Haryana which runs four schools under the name '*The British School*' in Punjab and Haryana viz., Mohali, Panchkula, Chandigarh, Firozpur.

16. The British School in Delhi was started in the year 1963 when a group of British parents, with the support of the then British High Commissioner started the school with 40 students representing six nationalities in Defence

Colony, New Delhi. Various British dignitaries, of the relevant time including the then British High Commissioner to India– Sir Paul Gore-Booth, were the founding members. In the year 1969, The British School moved to its current location in Chanakyapuri, New Delhi with the aim of serving the diplomatic and expatriate communities. Over the years, the school’s remit has broadened considerably resulting with a mix of British and international education in an Indian context. Members of the British Royal family are also stated to have encouraged activities in the Plaintiff’s school. The President of the School is the British High Commissioner to India. It offers various educational programmes including EYFS Programme, the IGCSE and the IB Diploma Programme. The Plaintiff’s school has more than 1200 students from 65 nationalities. It holds accreditation and memberships from various global associations.

17. In January, 2018, the Plaintiff’s school was awarded ‘the Top British International School Award’ by BISA (British International School Awards) based in London. It has since then earned various awards and also boasts of several renowned alumni, both of Indian and international origin. The revenue figures of the Plaintiff’s school since 1976, as set out in the plaint, show that in the last few years, the revenues have been in the range of Rs.100 crores. The Plaintiff’s school adopted a logo in 2013.

18. The details of the registered trademarks of the Plaintiff are as under:

MARK	Reg. No.	Date	Class	Status	Conditions
	2518104	April 23, 2013	16, 35, 41	Registered	Registration of this trade mark shall give no right to the exclusive use of the words The British School, New Delhi, except substantially as shown in the representation on the form of application.
THE BRITISH SCHOOL	2518105	April 23, 2013	35	Registered	Registration of this trade mark shall give no right to the exclusive use of The British.
	2518106	April 23, 2013	16, 41	Registered	N.A.
THE BRITISH SCHOOL	2518107	April 23, 2013	16, 41	Registered	Registration of this trade mark shall give no right to the exclusive use of The British School.
THE BRITISH SCHOOL	5050319	July 19, 2021	16, 25, 35 and 41	Pending	N.A.

19. The domain name of the Plaintiff's school is [www.british-school.org](http://www.british-school.org), registered in 1999. The Plaintiff's school also has social media presence on Facebook, Instagram, etc. There are various documents placed on record such as Registration Forms, Admission Slips, etc. which prove user of the mark

*'The British School'* by the Plaintiff. The brochure of The British School, New Delhi issued in the year 2013, on the occasion of completing 50 years, consists of various details including user documents since 1963 when the school was located in Defence Colony, Delhi. Testimonials have given by various people including publicly renowned persons such as Mark Tully, who states in his piece as under:

*“Sadly, from our point of view, we failed. But, greatly to Elspeth’s credit, she had built The British School on such secure foundations that it survived the massive blow of her departure and went on to grow and grow. It has to be remembered that The British School started from nothing. It was not supported by the British Government, although the British High Commission was involved in its governance. Only Elspeth’s drive turned the dream of a school that would teach the British syllabus into a reality.”*

20. The brochures show various photographs and pictures of the school over the years. The brochure also depicts Prince Philip, Duke of Edinburgh inaugurating an auditorium during his visit to Plaintiff’s school in 1983 which is termed as “the Royal Seal of Approval” in the school’s brochure. Various other dignitaries such as Dalai Lama, leaders from other countries of the world have visited the Plaintiff’s school. Children from more than 100 nationalities have studied at the Plaintiff’s school. The documents on record also show various accreditations given to the Plaintiff’s school, both by the Government of India and by various educational bodies in the UK including, the International Baccalaureate Organisation (IBO), Council of International Schools (CIS), Cambridge International Examinations, and the European Council of International Schools. The registration of the Plaintiff society

under the Society Registration Act of 1860 dates back to 26<sup>th</sup> June, 1963. A perusal of the documents filed on record shows that the use of the name '*The British School*' by the Plaintiff since the year 1963 is not in dispute.

21. The Plaintiff's school has also been given exemption under the Income Tax Act, 1961 since 1970's. The order of the Commissioner of Income Tax dated 8<sup>th</sup> May, 1975 certifying registration of the Plaintiff under section 12A(a), Income Tax, 1961 is as under-

*"The British School Society, New Delhi as constituted by the Trust Deed/Memorandum of Association dated 1963-64 has filed the registration application under section 12A(a) of the I.T. Act, 1961 in the prescribed form on 13.8.73 i.e. within the stipulated time limit.*

*2. The application has been entered at No. DL.I-(C)(I-413) in the Register of applications u/s 12A(a) maintained in this office."*

22. In the trademark registration certificates of the Plaintiff, though disclaimers exist, the said registrations point to the fact that the name of the Plaintiff's school has been in use for several years and in any case prior to Defendants' use of the mark '*The British School*'.

23. The Defendants use an identical name— '*The British School*' for 4 of their schools in Punjab & Haryana, even though the name of the society which runs the said schools is Sanjay Gandhi Educational Society. The Defendants have also registered the domain name: [www.thebritishschool.org](http://www.thebritishschool.org) which is registered since the year December, 2004. The Defendants also use a '*Coat of Arms*', though it is not similar to the Plaintiff's school's logo. The Defendants

have filed various applications for the registration of the mark '*The British School*' claiming user since 2005. The first application for the registration of the mark '*The British School*' bearing no. 2973716 was filed on 29<sup>th</sup> May 2015 by Defendant No.2-Mr. Sanjay Sethi. The said application has been objected to by the Trade Mark Registry on the ground of non-distinctiveness under section 9 of the Act as well as under section 11 of the Act on the ground that similar trade mark is already on the register. Thereafter another application was filed on 29<sup>th</sup> January 2020 bearing application number 4423768 by Defendant No.1- Sanjay Gandhi Educational Society for a different device mark containing the words '*The British School*'. The said application has been opposed by the Plaintiff vide notice of opposition dated 11<sup>th</sup> September, 2020.

24. The case of the Defendants before this Court, in their application seeking vacation of injunction, is that the Plaintiff has concealed material facts. It is the contention of the Defendants that the Plaintiff is not a school accredited to the Department of Education, United Kingdom. Therefore, the Plaintiff is not entitled to use the mark '*The British School*'. It is further argued that the word 'British' derives its reputation and goodwill from the British Empire since the 16<sup>th</sup> century. Thus, no one can claim monopoly over the same as it is generic. The Defendants argue that '*The British School*' is a common, generic term and is per se *publici juris*. It is also pointed out by the Id. Counsel for Defendants that a school by the name of '*The British School*' was opened in the year 1931 in Netherlands, i.e., prior to the Plaintiff's school.

25. The justification that has been sought to be given by Defendants to argue that the adoption of the mark '*The British School*' is honest, is that the mark has been adopted on the advice of Mr. Mark Bartholomew, Regional

Manager, University of Cambridge. Reliance is placed upon the letter dated 14<sup>th</sup> January, 2005 in which, as per the Defendants, the University of Cambridge used the term '*The British School*' for the promotion of British School education system worldwide. As per the Defendants, it clearly shows that the term '*The British School*' is a generic and common term used for schools that are promoting the British School education system. Therefore, no one can have a monopoly over the same.

26. Reliance is also placed upon the 'disclaimer' imposed upon the Plaintiff's registration that there would be no exclusive rights for the mark '*The British School*' to argue that the Defendants should not be enjoined after they have been operating for more than 15 years. It has also been argued before the Court that there is no chance of confusion between the schools as the schools of the Plaintiffs and the Defendants are located more than 240-400 kms away from each other. The Defendant is also stated to have spent approximately Rs. 2 crores on promotion, branding and advertisement of the mark '*The British School*'. The Defendants have also sought to raise distinction on the basis of dissimilarity between the logos of the Plaintiff and Defendants.

27. The present suit which is filed for infringement of registered trademark and passing off relates to the mark '*The British School*' used as the name of a school. Though the Plaintiff have registrations, the same are with disclaimers on the words '*The British School*'. Thus, exclusive rights cannot be claimed by the Plaintiff on the strength of trademark registrations. The case has to be, therefore, considered on the principles of passing off. In a suit for passing off, the Court has to test the case of the Plaintiff on the 'classical trinity' of the tort of passing off- goodwill, misrepresentation and damage. **Professor**

**Christopher Wadlow** in *The Law of Passing-Off* (5<sup>th</sup> edition, at page 8) states as under-

*“Passing off is concerned with misrepresentation made by one trader which damage the goodwill of another trader. **Misrepresentation, damage and goodwill are therefore the three essential elements** of the tort and are sometimes referred to as its ‘classical trinity’. It is worth adding that liability for passing-off is not affected by the defendant’s state of mind. There is no fourth element requiring the defendant to be fraudulent, malicious or even negligent.”*

28. In the case of ***Erven Warnink v. J. Townend & Sons [1980] R.P.C.31, 93 HL***, Lord Diplock has expounded five characteristics of passing off as under:

*“My Lords, Spalding v. Gamage and the later cases make it possible to identify five characteristics which must be present in order to create a valid cause of action for passing off: (1) a misrepresentation (2) made by a trader in the course of trade, (3) to prospective customers of his or ultimate consumers of goods or services supplied by him, (4) which is calculated to injure the business or goodwill of another trader (in the sense that this is a reasonably foreseeable consequence) and (5) which causes actual damage to a business or goodwill of the trader by whom the action is brought or (in a quia timet action) will probably do so.”*

29. Thus, for the present action of passing off to sustain, the Court will have to examine (i) whether the Plaintiff has established any goodwill in the mark ‘*The British School*’ (ii) whether there is any misrepresentation on part of the

Defendants (iii) whether there is any resultant damage to the goodwill of the Plaintiff. A perusal of the documents on record leaves no doubt in the mind of the Court that the Plaintiff's School— The British School, New Delhi was established in the year 1963. It had enjoyed more than 40 years of reputation before the Defendants could adopt an identical name in the year 2005. The name of Defendant No.1 is Sanjay Gandhi Educational Society. Though various claims have been made in the pleadings of the Defendants that the Defendants' schools have been recognised by various international bodies etc, it was conceded towards the conclusion of the arguments that as on the date, the Defendants' schools are merely CBSE accredited schools. They do not enjoy any accreditation or recognition from any international body. Therefore, the Court will have to examine if Defendants can continue to use the mark '*The British School*' irrespective of any international accreditation or recognition.

30. The Plaintiff's school though not setup by any funding from the British Government is undoubtedly a school which is under the patronage of the British High Commissioner in Delhi. The High Commissioner himself is the President of the Plaintiff society. The said school, owing to the large diversity of children who study there and the various recognitions by international examination bodies including International General Certificate of Secondary Education (IGCSE), is one of the most sought-after schools in India. The Defendants have argued that the words 'British' and 'School' on standalone basis as also taken together are generic names. However, there are no documents on record to say that there is use of the mark or name '*The British School*' by any other school in India. The word 'British' on a stand-alone basis refers to anything related to Britain, but the use of the words '*The British*

*School* in the manner as is done by the Plaintiff signifies the Plaintiff and none else. The Plaintiff's school has been in existence for more than 60 years now and it continues to impart high level of education to its students. From the material placed on record, the Plaintiff has been able to show that it has goodwill in the mark *'The British School'*.

31. The Defendants are in an identical service sector, i.e., education. Though the Defendants are located in Haryana & Punjab, the possibility of parents and students carrying the impression that the Defendants' schools are affiliated or connected in some manner with the Plaintiff's school cannot be ruled out. In an action for passing off, the Court has to see the possibility or likelihood of deception and misrepresentation. Even if there is a remote chance of the possibility or likelihood of deception, the Court is bound to protect the people who avail the said services, from such confusion or misrepresentation being caused. The Court would loathe to permit the use of identical names especially in the educational field as the same may mislead parents and students to admit their wards in Defendants' institutions under a mistaken belief. The present case before the Court is a case of triple identity:

- Same name – The British School
- Same service – Education (Senior Secondary Schools)
- Same class of persons availing the service, i.e., students and their parents.

32. The words 'British' and 'School' by themselves may be common words, not invented but when used together and in conjunction with each other, in the context of schooling in India, they clearly refer to the Plaintiff. During the course of submissions, at one stage, the Id. Counsel for the

Defendants had submitted certain proposals for slightly modifying the names of their schools which are as under:

- a. **THE BRITISH SCHOOL Of CHANDIGARH**  
**THE BRITISH SCHOOL Of PANCHKULA**  
**THE BRITISH SCHOOL Of MOHALI**  
**THE BRITISH SCHOOL Of FEROREPUR**  
**Run By: SANJAY GANDHI EDUCATIONAL SOCIETY**  
**Disclaimer: Not Associated with The British School, New Delhi**
- b. **BRITISH WORLD SCHOOL**  
**Run By: SANJAY GANDHI EDUCATIONAL SOCIETY**  
**Disclaimer: Not Associated with The British School, New Delhi**
- c. **BRITISH INTERNATIONAL SCHOOL**  
**Run By: SANJAY GANDHI EDUCATIONAL SOCIETY**  
**Disclaimer: Not Associated with The British School, New Delhi**
- d. **BRITISH SR. SECONDARY SCHOOL**  
**Run By: SANJAY GANDHI EDUCATIONAL SOCIETY**  
**Disclaimer: Not Associated with The British School, New Delhi**
- e. **BRITISH SCHOOL UK**  
**Run By: SANJAY GANDHI EDUCATIONAL SOCIETY**  
**Disclaimer: Not Associated with The British School, New Delhi**
- f. **BRITISH SCHOOL**  
**Run By: SANJAY GANDHI EDUCATIONAL SOCIETY**  
**Disclaimer: Not Associated with The British School, New Delhi**

33. In the opinion of the Court, the above proposals would not obviate the chances of confusion but, in fact, would compound it further. If any of the said suggestions are accepted, the difference between the Plaintiff's mark and

Defendants' mark would be minimal as the subscript under the name of the school, in which the 'disclaimer' and 'run by' is proposed to be used, is rarely used by the proprietor in the course of business or taken note of by the public in general. It may lead to a further impression of affiliation of Defendants with the Plaintiff's school. The court had put to the Id. Counsel for the Defendants as to whether the Defendants are willing to modify the name of their schools to '**Sanjay Gandhi British School**', to which the answer was in the negative. The court is convinced, upon perusing the documents and pleadings on record, that this is a case where the Defendants are wrongfully benefiting from the reputation of the Plaintiff's mark '*The British School*'. Thus, the Defendants are reluctant to carry out any changes in the name that may have the effect of obviating confusion. The continued use of the mark '*The British School*' by the Defendants is causing damage to the goodwill of the Plaintiff. Furthermore, none of the letters which are relied upon by the Defendants show any permission given for the use of the name '*The British School*' by any international accreditation agency or international examination conducting body. Pleadings to the contrary are bereft of any merit. The existence of the Defendant's schools itself is not in dispute but the question is whether the Defendants can continue to use the name '*The British School*' causing damage to the goodwill of the Plaintiff.

34. The Plaintiff has relied upon the judgment of the Id. Single Judge of this Court in ***The British School Society v. The British International School (supra)***. In the said case, the Defendant was using the mark/name '*The British International School*' for its school located in Chennai. In the said suit, similar application for the vacation of stay under Order 39 Rule 4 was filed which was considered by the Court. The Court clearly came to the following

conclusions:

- i. Disclaimer is only for the purposes of the Act and it does not affect the rights of the proprietor that he may have acquired by long user. Relying on ***Registrar of Trade Mark v. Ashok Chand Rakhit 1955 2 SC 558***, the Court held that a suit for passing of is maintainable despite the disclaimer.
- ii. Mere delay in bringing an action would not come in the way of an injunction relying upon the judgment in ***Midas Hygiene Industries Private Limited & Another v Sudhir Bhatia, [Civil Appeal No 107/2002*** decided on 22<sup>nd</sup> January, 2004].
- iii. *'The British School'* is an essential feature of the mark of the Plaintiff. The adoption of the said mark by the Defendant shall infuse confusion in the minds of the students as also their parents who may act under the impression that the Defendant is connected to the Plaintiff. The court relied upon the judgment in ***Ritnand Baldev Educational Foundation v. Ranchhod M Shah (2018) 253 DLT 685*** relating to the mark *'Amity International School'* wherein it was categorically held that education is an area where chances of confusion should be completely avoided. Reliance has also been placed upon the judgment in ***Delhi Public School Society v. DPS World Foundation (2016) 230 DLT 5***, and ***Anjani Kumar Goenka v. Om Education Trust 2018 SCC OnLine Del 11370***. The relevant portion of the judgment reads as under:

*“17. Now if one also look at the defendant’s reply in relation to examination report of its own mark, the defendant stated it had started using the said mark since the year 2005 i.e. 40 years after the adoption*

*of the mark by the plaintiff. One may also look at the reply of the defendant it gave to the Cease and Desist notice wherein the claim of the plaintiff qua the user since 1963 etc. was simply denied and it was never alleged in reply the defendant was not aware of the plaintiff's using The British School as its trademark since the year 1963. The defendant rather admitted of using the website <http://www.britishschool.co.in> i.e., exactly with the same name of plaintiff. One may also note the area of operation is same, in this case, education, hence in this field the chances of confusion need to be completely eliminated.*

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*26. Thus, the facts of the case do show the plaintiff adopted the mark The British School in the year 1963 and hence, there has been an exemplary long use of this name i.e., for about 58 years; the plaintiff alleges of earning revenue in crores of Rupees and likewise is its expenditure in lacs on promotion. Admittedly the defendant adopted its mark in the year 2005 and never explained as to why it adopted this name or that the defendant was never aware of the mark of the plaintiff, prior to its own registration. The British School is an essential feature of the mark of the plaintiff and its adoption by the defendant shall certainly infuse confusion in the minds of the students as also their parents as they shall believe the defendant has connection with the plaintiff and thus, the defendant shall ride upon the goodwill of the plaintiff. Being a prior user and adopter, the plaintiff is entitled to get the defendant restrained to use the mark deceptively similar of plaintiff's mark irrespective of the fact the defendant got its mark registered prior in time. The mark of the defendant when compared as a whole with the mark of plaintiff it certainly shall create confusion, especially, when both are in identical field viz. educational. The similarity in the name shall certainly cause damage*

not only to the career of students but also to the reputation of the plaintiff.”

35. The Defendants on the other hand have relied upon the judgment of this court in ***Goenka Institute of Education & Research v. Anjali Kumar Goenka & Anr. AIR 2009 Delhi 139***, where the *lis* was over the mark ‘Goenka’, to argue that a disclaimer, as was directed in the said case, should also be directed in the present case. A perusal of the judgment in ***Goenka Institute of Educational Research (supra)*** shows that in the said case the Defendant’s surname itself was ‘Goenka’. The Defendants who were based out of Rajasthan had formed a trust named ‘Shree Lal Goenka Charitable Trust’ much prior, in the year 1990, to Plaintiff’s school- G D Goenka Public school, being set up. On the other hand, in the present case, the Plaintiff had adopted the mark ‘*The British School*’ in 1963, much prior to the adoption of the mark by the Defendants in the year 2005. Thus, the facts of the case in ***Goenka Institute of Educational Research (supra)*** are clearly distinguishable from the facts of the present case.

36. In ***Ritnand Balved (supra)*** the court has held that in the field of education, any chance of confusion ought to be completely avoided. The relevant portion reads as under:

***“23. It is a settled position under Trademark law that this area of law is meant to protect not just the rights of the owners, but also to avoid any confusion from being caused amongst the members of the public. There is no doubt that AMITY INTERNATIONAL SCHOOL of the Plaintiff is well known, and there are several branches of the said school. The use of an identical name by the Defendants would not merely confuse the students and parents but also those persons who wish to collaborate with the***

*Defendants. There would be no way of knowing as to whether the AMITY INTERNATIONAL SCHOOL of the Defendants is the same as that of the Plaintiff or not. The area of operation i.e., education is one such area in which any chance of confusion should be completely avoided. This is because schools, universities and colleges have very expansive activities and operations. Students studying in educational institutions participate in events, competitions, cultural festivals, and sports meets across the country. The use of identical names for two schools, completely disconnected from each other, would result in enormous confusion and could also result in having a damaging effect on careers of children. The chances of mistaken identities are very high and especially in the educational field, such confusion ought to be avoided.*

37. In the present suit, an *ex parte ad-interim* injunction was granted on 12<sup>th</sup> October, 2021 in the following terms:

*“9. The plaintiff has made out a prima facie case. The defendants are restrained by an ex parte injunction from using the plaintiff’s trade mark THE*



*BRITISH SCHOOL/TBS/ or any other mark similar to the plaintiff’s trademark in any manner whatsoever infringing and passing off the plaintiff’s registered and well-known trade mark or in violation of any other rights in any other registered trademark of the plaintiff till further orders.”*

38. The Defendants have sought vacation of the said *ex parte ad interim* injunction. The interim order has continued till now but in view of the fact that the name of the schools were to be changed, an order was passed on 22<sup>nd</sup>

December, 2021 to the following effect:

“3. This application is moved under Order 39 Rule 4 CPC on behalf of the defendants for modification of the portion of the order dated 12.10.2021 and to stay the proceedings against defendant No.1 till the decision of rectifications and oppositions filed by defendant no.1 against the plaintiff as per section 124 and other provisions of Trademark Act 1999.

4. Issue notice.

5. Learned counsel for the plaintiff accepts notice.

6. Reference is made to order dated 09.12.2021 in CS(Comm) No.408/2021 wherein the concession was given to comply with the interim order dated 03.09.2021 till the end of the academic session of 2021-22. **The learned counsel for the defendants says they shall not advertise the admissions for the next session under the brand name British School. On this submission, the concession is given to comply the order dated 03.09.2021 till the end of the academic session of 2021-22.”**

39. The above interim order is continuing till date. However, the Defendants have not complied with the said order. An application under Order XXXIX Rule 2A has also been filed by the Plaintiff in view of the continued use of the mark ‘The British School’ by the Defendants. The fact that Defendants are continuing to use the mark ‘The British School’ is not even in dispute.

40. Suggestions were called for alternative names from the Defendants but none of the names appear to show any *bona fides* on behalf of the Defendants. There is no doubt in the mind of the Court that the appropriation of the mark ‘The British School’ by the Defendants is with the intention to cause

misrepresentation and confusion to the public. Thus, this Court is of the opinion that Defendants cannot be permitted to continue with the use of the name/mark '*The British School*' for its 4 schools. The permission given to the Defendants vide order dated 22<sup>nd</sup> December, 2021 to use the mark '*the British School*' expires with the end of the academic session 2021-2022. Usually, the academic session ends around March/April every year with the final examinations being held at that time. The Defendants have had adequate notice of the injunction order to be able to carry out a name change. Moreover, a categorical undertaking has already been given to the Court by the Id. Counsel for the Defendants that the Defendants will not advertise the admission for the next academic session under the mark '*The British School*' as extracted above.

41. The conduct of the Defendants on claiming during arguments that the Defendants' schools are recognised by international examination bodies which has turned out to be false towards the conclusion of submissions shows that the Defendants do not deserve any further indulgence by this Court. There is also no document on record, as claimed by the Defendants that any international or British University had permitted the Defendants to use the name '*The British School*'.

42. This Court has no doubt in concluding that continued use of the mark '*The British School*' for schools of Defendants would constitute misrepresentation in the course of rendering educational services to the effect that Defendants' schools are in some way connected or affiliated with the Plaintiff. Further, such continuous use may cause irreparable prejudice and damage not merely to the Plaintiff's goodwill alone but to various students who may be enrolled and studying in the said school. Thus, it is not even in

the larger public interest to permit Defendants to use the mark '*The British School*'. Accordingly, the interim order granted on 12<sup>th</sup> October, 2021 as modified on 22<sup>nd</sup> December, 2021 is confirmed.

43. ***I.A. No. 13426/2021*** under Order XXXIX Rule 1 and 2 CPC is allowed. ***I.A. No. 17285/2021& I.A. No. 3942/2022*** under Order XXXIX Rule 4 CPC are dismissed.

44. The Defendants shall change the name of their schools w.e.f. 1<sup>st</sup> May, 2022 and apply to the CBSE along with copy of this order for changing the name of their schools which are currently affiliated to the CBSE. The process shall be undertaken in an expeditious manner so that no inconvenience is caused to the students studying in the schools of the Defendants. Certificates, prizes, medals, etc. to be given to the students presently studying in Defendants' schools shall be issued in the name of '*The British School*' only till the end of academic year 2021-2022 and not beyond that.

**APRIL 25, 2022/aman/sk**

**PRATHIBA M. SINGH  
JUDGE**