

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

**Judgment reserved on: 14.07.2017**

% **Judgment delivered on: 11.08.2017**

+ **I.A. No. 16232/2015 in CS (OS) No. 2368/2015**

TURNING POINT INSTITUE PRIVATE LIMITED .....Plaintiff

Through: Ms. Ayushi Kiran, Advocate.

Versus

M/S TURNING POINT .....Defendant

Through: Mr. H.P. Singh, Advocate with  
Mr.Navroop Singh, Advocate.

+ **I.A. No. 22081/ 2015 in CS(OS) No. 3159/2015**

M/S TURNING POINT .....Plaintiff

Through: Mr. H.P. Singh, Advocate with  
Mr. Navroop Singh, Advocate.

Versus

TURNING POINT INSTITUE PRIVATE LIMITED.....Defendant

Through: Ms. Ayushi Kiran, Advocate.

**CORAM :  
HON'BLE MR. JUSTICE VIPIN SANGHI**

**JUDGMENT**

**VIPIN SANGHI, J.**

1. As would be evident from the cause title, these are two cross suits between the parties. In each of these suits, the respective plaintiff has filed an interim application under Order 39 Rule 1 & 2 Code of Civil Procedure (*hereinafter* CPC) to seek interim injunction against the defendant in the particular suit. The parties have addressed their submissions in the said two applications – the first one being I.A. No. 16232/2015 in CS (OS) No. 2368/2015 preferred by the plaintiff - Turning Point Institute Private Limited under Order 39 Rules 1 & 2 of CPC to seek interim injunction against the defendant - M/s Turning Point, and the latter being I.A. No. 22081/2015 in CS(OS) No. 3159/2015 preferred by the plaintiff- M/s Turning Point, under O39 R1 & 2 of CPC seeking interim injunction against the defendant- Turning Point Institute Pvt. Ltd. The aforesaid applications have been heard together and are being disposed of by this common order. The I.A. No. 16232/2015 is being considered as the lead application, but both applications are being dealt with together. For ease of reference, the term 'plaintiff' is being used hereinafter to address Turning Point Institute Private Limited, and the term 'defendant' is being used to address M/s Turning Point hereinafter.

2. The plaintiff is praying for an interim order restraining the defendant from:

*".....using Plaintiff's mark **TP TURNING POINT** or any other deceptively similar trademark, trade name/company, name/trading style, by advertising, or by offering goods or services, under the said marks, either online or in any other manner, amounting to passing off of the Plaintiff's trademark;*

*dilution or tarnishment of the Plaintiff's mark **TP TURNING POINT**, by adopting the same as a part of their corporate name/ trade name/ trading style/domain name of the mark or by the use of any other deceptively similar trademark."*

3. The defendant, in its application for interim injunction, is praying for an interim order restraining the plaintiff from:

*"(i). selling and offering for sale or marketing, advertising, directly or indirectly dealing or rendering services in Educational Services including Providing of coaching and training or other related services under the Trade Mark/Trade Name **TP TURNING POINT** and/or any mark confusingly similar thereto, or any imitation or variation thereof, amounting to an infringement or passing off of the Plaintiff registered trade mark **TURNING POINT**".*

*"(ii.) Using the trade mark/trade name **TP TURNING POINT** and/or any deceptively similar name, from in any manner holding out an association of its products or business with that of the Plaintiff by use of the name **TP TURNING POINT** or any deceptively similar name and from doing any other thing as to pass-off or that maybe likely to lead to passing off of the Defendant's business as and for those of Plaintiff".*

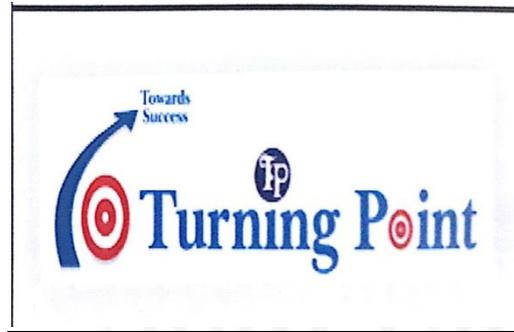
4. The case of the plaintiff, insofar as it is relevant, is as follows. The plaintiff, Turning Point Institute Private Limited - a private limited company incorporated on 15.03.2001, is engaged in providing educational and training services under the trademark "**TP TURNING POINT**". These services comprise of preparatory classes for IIT- JEE, AIEEE and PMT aspirants along with Board examination preparation for science students, and foundation courses for 9<sup>th</sup> and 10<sup>th</sup> classes. It is also maintaining a website under the address <http://www.turningpointedu.org/> wherein the details of the services provided by the plaintiff institute can be found. The

plaintiff does not hold a trademark registration for the words or label “TP TURNING POINT”.

5. The plaintiff submits that the word mark "TP Turning Point" was created during the last week of March 1994, and has been in continuous use ever since- in connection with the plaintiff's services aforementioned. The plaintiff, in relation to adoption and coining of the mark "TP Turning Point" submits in Para 6 of their plaint as follows:

*“ 6. That the word mark **TP Turning Point** was created by Ms. Bindu Saini, when Mr. Tej Narain Chowdhary was providing his services as physics teacher at her home to her nephew, Praveen Saini during the month of June, 1992 and he continued his services till his board exam of 12<sup>th</sup> standard i.e. March 1994. In the month of March 1994, one evening he was taking tea at her home, in the presence of her, her husband and her nephew, Praveen Saini (his student) and it was then that he disclosed his plan that he is soon going to start a coaching institute for Engineering and medical entrance exams and that he is looking for a name for his coaching institute. It was then that she suggested him a name that is TURNING POINT. She was very inspired with a TV program named as TURNING POINT run on national channel which was a programme based on science to remove illusion of Jadu- tona from the mind of people. Mr. Chowdhary was convinced to use TURNING POINT for his service, however, he also added the abbreviation TP to be used as a prefix to the name TURNING POINT as his name starts with letter T and his trusted friend “Prakash” who was willing to work as a Math teacher for his coaching institute, his nick name started with the letter P. That is how this name TP TURNING POINT came into existence in March 1994 and became solely associated with the coaching services offered by Mr. Chowdhary since its formal institution on 11<sup>th</sup> April 1994.”*

6. The trademark “TP TURNING POINT”- of the plaintiff is popularly represented as:



with the letters ‘TP’ encircled. It is also represented as:



7. The plaintiff submits that its venture began in 1994 under the trademark "TP Turning Point" with a group of experienced teachers joining hands and working towards a common vision to provide students with a platform from which they can spring towards success. Ever since, the plaintiff has imparted quality education to thousands of students, who, over the years, have benefitted not just in terms of academics by achieving high percentage in board/school exams and cracking medical and engineering entrances with a success percentage of 77%, but also towards building their future.

8. The plaintiff submits that their institute under the trademark "TP Turning Point", during the period 2005-2011 had expanded its centres to Jharkhand, Bihar, U.P. and Haryana and will be now having franchisees all over India.

9. The plaintiff submits that it has diversified into a range of services, namely classroom coaching; correspondence courses; online testing; test series; admission guidance; campus coaching; transport and hostel facilities, etc. These services, as per the plaintiff, are available to students of Classes IX to XII for subjects like Math, Science, English, Physics, Chemistry and Biology to prepare them for Engineering and Medical Entrances exams. It submits that the institute conducts tests which are created by ex-IITians and medicos covering all latest patterns, including unique and newly designed questions. The Online Testing facility, according to the plaintiff, aims at providing an online mode of studying for students facing constraints of distance.

10. The plaintiff submits that it has tie-ups with various schools in Delhi, Jharkhand and Haryana to assist students to gain admission into such schools, to choose their desired stream of study after class X, and to provide career counseling to students in classes IX to XII. It submits that it was also invited by NTPC Ltd., New Delhi during 2009-2010 for providing career counseling to students of classes IX to XII. Not just limited to admission guidance, the plaintiff points out that it maintains an association with various schools across the country for its campus coaching facility as well, which is conducted within the premises of such schools, during or after

school hours. It submits that under this programme it also provides scholarship to young students.

11. The plaintiff further submits that it is the first institute in India to offer coaching programmes in association with universities in relation to medical and engineering entrance examinations. It refers to its association with the Muslim Social Uplift Society (MSUS) in 2006-07, and Coaching and Guidance Center of the Aligarh Muslim University in 2007-10 in this regard.

12. The plaintiff submits that it has been granted the CSR Trophy for Excellence in Coaching for the year 2012 by the renowned publication "Competition Success Review". It has also launched an "Inter School Intelligence Contest" in Delhi, where various schools participated and got wide media coverage - in prominent newspapers including Asian Age and Deccan Chronicle regarding their model papers for class X and XII board exams as well.

13. The plaintiff submits that its institute has undertaken pro bono activities by establishing a registered society under the name TURNING POINT EDUCATIONAL SOCIETY (TPES) in 2006 for granting scholarship to under privileged children, and has also made donations to schools such as Kamal Public School, New Delhi for the welfare of students.

14. The plaintiff submits that its institute - under the trademark "TP Turning Point", has gained reputation among students all over India regarding the plaintiff's preparatory classes concerning medical and

engineering entrances since 1994, which is evident from the annual turnover and advertisement and promotional expenses for the last 5 years:

Annual Turnover for the last 5 years:

YEARS	Annual Turnover (in Rupees)
2010-11	5991057.00
2011-12	6112635.00
2012-13	6430931.00
2013-14	6816307.00
2014-15	6935275.00

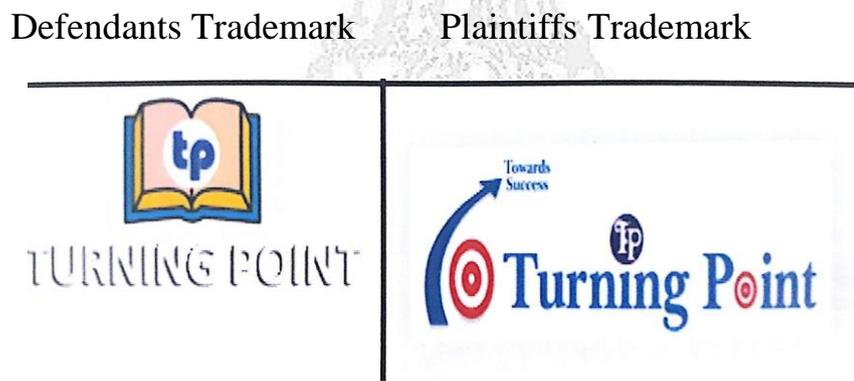
Expenditure in Advertisement and Brand promotional activities for the last 5 years:

YEARS	Expenditure in Advertisement and Brand promotion (in Rupees)
2010-11	346587.00
2011-12	441058.00
2012-13	459223.00
2013-14	672244.00
2014-15	907924.00

15. The case of the plaintiff is that on 19<sup>th</sup> April 2015, the plaintiff Institute's Managing Director came across defendant No.1's advertisement

with the identical mark as that of the plaintiff i.e. “TP Turning Point” for identical services as that of the plaintiff i.e. preparatory classes for medical and engineering entrance, and then realized that the defendants are engaged in rampant use of the identical mark as that of the plaintiff. The plaintiff realised that the defendant was passing off its services with the trademark “TP Turning Point”, as that of the plaintiff. Consequently, the plaintiff preferred this suit.

16. Ld. Counsel for the plaintiff submits that defendants have misrepresented the plaintiff’s mark as their own and passed off their services as those of the plaintiff. The defendants have copied the identical mark “TP Turning Point” and are using the same for identical services as of the plaintiff’s. The comparison of the two labels used by the respective parties are produced herein below:



17. Ld. counsel for the plaintiff submits that they are the prior adopters of the trademark “TP Turning Point” since the year 1994. Therefore, the plaintiff is entitled to appropriate the mark and claim the sole and exclusive right to use the same. She submits that the subsequent use or registration of the mark – be it identical or deceptively similar to the plaintiff’s mark,

would be contrary to the common law rights vesting in the plaintiff in respect of the said mark. Reference has been made to several documents placed on record in support of the plaintiff's claim of adoption and user of the mark "TP Turning Point" since 1994. I shall refer to these documents in detail while dealing with them a little later.

18. Ld. Counsel for the plaintiff submits that defendant no. 2 has dishonestly adopted and *mala fide* obtained trademark registration of the mark 'TP Turning Point', in the year 2004, under Class 41, vide application no. 1324835, claiming user from 07.07.1998. The application for registration, as well the user claimed therein is subsequent to the adoption of mark by the plaintiff. Ld. counsel for the plaintiff relies upon defendant's documents to state there is nothing brought on record by the defendants to show user from 1998, as claimed by them. The plaintiff further submits that the impugned registered mark of the defendants has not been renewed since 09.12.2014, and has, therefore, expired.

19. Ld. Counsel submits that the plaintiff's mark, ever since its adoption, has been used for providing services in the field of education and training, continuously and uninterruptedly, and has gained substantial reputation and goodwill among the relevant sections of public. The plaintiff's mark is, thus, enjoying the status of a well known trademark. The defendants are ridding piggy back on this reputation which the plaintiff has garnered over the years, in its trademark "T.P Turning Point", and are deliberately and in a *mala fide* manner passing off their services as that of the plaintiffs. She points out that the trademark registration applied for by the defendants, in the year 2004, i.e. after a decade of adoption and continuous use of the plaintiff's mark,

further evidences the fact that the defendants intended to ride on the reputation the plaintiff's institute.

20. Ld. Counsel for the plaintiff submits that because of the illegal adoption and use by the defendants of the plaintiff's trade mark, the consumers and members of the trade are being misled into falsely believing that the defendants' services are either being offered by the plaintiff, or endorsed by the plaintiff, or the two have some nexus or affiliation. She submits that there has been actual confusion amongst the consumer – students who are young and ignorant, and relies on the numerous inquiries received by the plaintiff in the months April-June 2015 regarding the branch offices opened by the defendants in New Delhi. She submits that the plaintiff's customers and acquaintances in trade were misled by the defendants' advertisement into believing that the said services were being offered by the plaintiff institute.

21. Ld. Counsel further submits that as a result of this misrepresentation and encashment on the goodwill of the plaintiff, defendants have caused irreparable loss and damage to the plaintiff. The damages are not just monetary, but relate to the goodwill and reputation of the plaintiff's institute as well. She submits that the young and gullible students are suffering, who are being driven to the coaching centres of the defendants, not knowing that the plaintiffs have no concern with them. Thus, their careers are at stake. By enrolling with the defendant for the purpose of training – under the misrepresentation that the institutes of the defendants are being services by the plaintiff, the aspiring students are being denied the impeccable quality of

preparatory courses offered by the plaintiff. They are being imparted substandard educational services by the defendant.

#### Defendant's submission

22. The submissions of the defendants in their respective ad interim injunction application, I.A. No. 22081/2015, and their reply to I.A. No. 16232/2015 of the plaintiffs, are taken note of together. The defendant no. 1 in its ad-interim injunction application submits that it recently came to know of the plaintiff's existence in August 2015, when the plaintiff filed its suit CS (OS) No. 2368/2015 in this Court against the defendants.

23. Defendants submit that defendant no. 1 is a sole proprietorship concern of defendant no. 2, Mr. Keshav Agarwal situated at Malviya Nagar, New Delhi engaged in providing educational, coaching and training services to students in schools and colleges since the year 1998. Defendants further submit that these services are being provided under the mark "Turning Point" - coined by the defendants. The defendants have various centres in Delhi situated at Malviya Nagar, Kalkaji, Dwarka and Rajouri Garden, all functioning under the mark "Turning Point". These services are also being provided in association with another sole proprietorship firm run by the wife of defendant no. 2 under the mark "PYRAMID CLASSES".

24. Defendants submit that the said mark has been got registered on 15.11.2005 in Class 41 for "*Educational Services, Providing of Training, Entertainment, Sporting & Cultural Activities*", claiming user since 1998. The defendants submit that the registration is valid and subsisting. Defendants refute the plaintiff's contention that the registration of the said

mark has lapsed. Reliance is placed on Form TM 12 dated 11.08.14 filed before the Registrar of Trade Marks for renewal of the mark, and the status page from the website of the Trade Marks Registry, which displays the status of the trademark as “registered”.

25. Defendants submit that they are primarily engaged in imparting coaching and training of subjects such as commerce, science, arts, etc. to students of Class VIII to XII of various schools in Delhi and around it. Defendants submit that they also provide coaching and training to students for various competitive entrance exams such as BBA, BBS, LAW, IIT, AIEEE, MEDICAL, CA, HM, CPT, etc. The defendants are maintaining a website with the IP address [www.theturningpointonline.com](http://www.theturningpointonline.com) containing all the information about its activities. Defendants also conducts online test on this website, and uploads various demo lectures on websites like [www.YouTube.com](http://www.YouTube.com), which can be accessed all across the world.

26. Defendants submit that they have taught thousands of students since the year 1998. The defendants have printed various brochures highlighting the success of its students and their achievements in the educational field. The defendants have extensively advertised their services with its mark “Turning Point” through brochures and advertisements in newspapers. The defendants are associated with various schools in Delhi, and outside, to provide education, training, and coaching services to students.

27. Defendants submit that they have achieved significant turnover since 1998. From revenues of Rs 2,90,000 for the year 1999-2000, the same has gone up to Rs 1,53,23,748 for the year 2014-2015. They further submit that

they have also incurred substantial expense in advertising and promotion of their mark “Turning Point”. Invoices of expenditure incurred towards advertising have been filed with the pleadings. The defendants, therefore, claim to have built up enormous goodwill, reputation and name in the market amongst the relevant sections of the public for its quality driven and effective coaching and training to its students. The defendants claim that by virtue of their goodwill and reputation, their mark “Turning Point” has become a distinctive and well-known trademark under Section 2(z)(g) of the Trade Marks Act, 1999 (*hereinafter* the Act). To substantiate the same, defendants place reliance on a judgment of this Court in *Keshav Kumar Aggarwal vs. NIIT* 2013 (54) PTC 178 wherein, their registered trademark “Turning Point” was declared as a “well known trademark” under Section 2(z)(g) of the Act.

28. Learned counsel for the defendants submits that the defendants are the first in trade to coin the mark “TURNING POINT” and are prior users of the said mark ‘TURNING POINT’. It is the plaintiff who has subsequently copied the defendants mark by adopting a similar trade mark/trade name in the year 2001. He submits that plaintiff’s claim of existence since 1994 is not supported by any cogent and documentary evidence, and aims to defeat the prior adoption and use of the mark by defendants’ since 1998. He submits that the plaintiff has filed false and fabricated documents of dubious nature to defeat the valuable rights acquired due to prior user of the mark by the defendants herein. He states that the rent receipt relied upon by the plaintiff does not feature their alleged mark, and the gas service receipt dated 03.09.1996 relied upon by the plaintiff - bearing the corporate name

“M/s Turning Point”, is hand written and cannot be relied upon. He submits that the plaintiff should have taken due care and conducted diligence before adopting an identical mark as that of the defendants for its educational services.

29. Learned counsel further submits that the present suit is barred by delay, laches & acquiescence, and places reliance upon Section 33 of the Act. The defendants have been engaged in providing educational services, including coaching and training to students since the year 1998, which is nearly 18 years prior to the filing of the present suit. He submits that the plaintiff must have, at all material times, been aware of the defendant institute's existence in the market, as both the defendants and the plaintiff are providing identical services in Delhi and other parts of the country. He submits that *Keshav Kumar* (supra) further probablises the fact that the plaintiff must have had specific knowledge about the defendants' prior business and existence. He relies upon *Power Control Appliances & Odrs. V. Sumeet Machines* 1995 PTC 165 in this regard.

30. Ld. Counsel submits that since the defendants have built their business with tremendous turnover and a huge customer base, an injunction, if granted against them, will cause major inconvenience and difficulty to the third parties i.e. the students of the defendants' institute, whose interest the court must protect. Reliance is placed on *Ansul Industries Vs. Shiva Tobacco Company* 2007 (34) PTC 392 (Del) in this regard.

31. Furthermore, he submits that the defendants, in any event, are honest and concurrent users of the same mark, and relies on *Alkem Laboratories*

*Ltd. Vs. Mega International (P) Ltd*, 2009(41) PTC 302 (Del.) (DB) in this regard.

32. Defendants submit that the unauthorized use of the mark in question by the plaintiff is violative of the statutory as well as common law rights vesting in the defendants. Such unwarranted adoption and unlicensed use has caused irreparable loss and damage to their well-established trade and reputation. Defendants submit that this has further led to confusion and deception in the minds of the service availing public, and in the trade. The defendants submit that the plaintiff is guilty of infringement of the defendants registered trade mark and of passing off its services as that of the defendants.

#### Submissions in Rejoinder

33. Ld. Counsel for the plaintiff submits that the defendants' have falsely obtained a trademark registration of the impugned label which consists of Plaintiff's word mark 'TP TURNING POINT' for identical services under Class 41 under trademark registration number 1324835 claiming user from 07.07.1998, which is much after the user date of the Plaintiff i.e. from March 1994.

34. Learned counsel further submits that the defendants falsely claim to have used the mark in question since 1998 and have produced no documents on record to even *prima facie* establish the same. She submits that the defendants are falsely and in a *malafide* manner trying to project that they have been using the impugned mark since 1998. In this regard, she submits the following :

- i) Photographs filed by the defendants at pages 9-16 of the documents file (volume 2) of classes held by them in the year 1999 fail to show the date or the year in which the classes were held and also the use of the mark TP TURNING POINT;
- ii) Photographs of Ryan International School at page 12 of the documents file (volume 2) have been falsely represented as of 2001 as the defendants' documents (volume 2) at page 333 show them as of 2003;
- iii) Copies of the fee receipts filed by the defendants at pages 17-52 of the documents file (volume 2) date back only to 2004, and not 1998;
- iv) Copies of advertisements filed by the defendants at pages 53 to 165 of the documents file (volume 2) date back to 2004, except for one advertisement dating back to 1999 at page 56, which fails to reflect the use of the impugned mark and is, anyway, much later to the Plaintiff's usage of TP TURNING POINT;
- v) Copies of advertisement receipts of the year 1997 filed by the defendants at pages 94 to 97 of the documents file (volume 2) are with respect to PYRAMID CLASSES and not TP TURNING POINT which is in fact the original tradename of the defendants;
- vi) Copies of advertisements published in the year 2009 filed by the defendants at pages 156 to 164 of the documents file (volume 2),

reflect the name PYRAMID CLASSES prominently and not TP TURNING POINT;

- vii) Copy of service tax registration filed by the defendants at page 194 of the documents file (volume 2) is dated 2003 and not 1998;
- viii) Copies of the income tax returns filed by the defendants at pages 195 to 297 of the documents file (volume 2) is only from the year 2000 and not 1998 and in the name of defendant no. 2, Mr. Keshave Kumar Aggarwal and some other proprietary concern called KIRAN SPORTS & STATIONERS rather than the defendant no. 1 herein;
- ix) Copies of DVB/BSES Bills filed by the defendants at pages 335-373 of the documents file (volume 2) date back to 2001 and are in the name of defendant no. 2, Mr. Keshav Kumar Aggarwal rather than the defendant no. 1 institute;
- x) Copies of the Airtel bills filed by the defendants at pages 374 to 382 of the documents file (volume 2) are of the year 2013 and issued in the name of defendant no. 2 rather than in the name of defendant no. 1;
- xi) Copies of MTNL bills filed by the defendants at pages 384 to 432 of the documents file (volume 3) are between years 2007-2013 and issued to defendant no. 2 in his individual capacity rather than in the name of defendant no. 1;

- xii) Copies of Vodafone bills filed by the defendants at pages 433 to 448 of the documents file (volume 3) are from the year 2015 and issued in the name of defendant no. 2 and not the defendant no. 1;
- xiii) Copy of the correspondence between defendant no. 1 and HDFC Bank filed by the defendants at page 493 of the documents file (volume 3) is from the year 2010;
- xiv) Copies of various bank statements filed by the defendants at pages 494 to 572, 693 to 772 and 773 to 806 of the documents file (volume 3) are from 2005 onwards and not in the name of defendant no. 1;
- xv) Copies of bank statements filed by the defendants at pages 574 to 692 of the documents file (volume 3) are not in the name of defendant no. 1, M/s Turning Point but issued in the name of defendant no. 2, Mr. Keshav Kumar Aggarwal.

35. Learned counsel of the plaintiff submits that the impugned registration is of the device mark “TP TURNING POINT” which includes the initials “TP”. She submits that the defendants have given no explanation for using the initials “TP” before the mark “Turning Point”. This unexplained conduct of the defendants establishes the conscious and intentional dishonest adoption of the impugned mark by the defendants. She submits that the suit by the defendants is just a counterblast to the suit filed by the plaintiff. She submits that the plaintiff has also initiated rectification proceedings against the impugned mark of the defendants before the concerned authorities.

36. Learned counsel submits that the defendants got registered a company with the name Turning Point Education Testing Services Pvt. Ltd. in the year 2002. The plaintiff has placed on record the Company Master Details of “Turning Point Education Testing Services Pvt. Ltd.”, which show that the address of the said company was given as B-1/130, Malviya Nagar, New Delhi – which is the address of the defendants. Moreover, the date of incorporation is 07.10.2002 and the names of the Directors include Keshav Kumar Agarwal i.e. defendant no.2. While registering the said company in the year 2002 under the Companies Act, 1956, which has now been struck off from the companies register, the defendants would have inevitably come across the name of the plaintiff company which was registered in 2001. The defendants kept quiet despite learning of the plaintiff – which shows their malafide intentions. Had the defendants genuinely believed that they were the prior users, they would have taken legal recourse to seek an injunction against the plaintiffs in the year 2002, and not filed their suit after the plaintiff has filed its suit. Counsel submits that the defendants’ suit is barred by limitation, since they clearly acquired knowledge of the plaintiff’s services at least from the year - 2002.

37. Ld. Counsel submits that the original trade name of the defendants is indeed “PYRAMID CLASSES” as reflected in the advertisements placed on record, pertaining to the year 2009. She submits that registration of the mark “PYRAMID CLASSES” is in the name of the wife of the defendant no. 2 and has the defendants address as the ‘proprietors address’. She further submits that defendants are in the habit of making fraudulent company registrations in the name of famous coaching institutes like that of the

plaintiff herein. The defendants have advertised “TP Turning Point” alongside PYRAMID CLASSES and MATRIX INSTITUTE FOR COMPETITIVE EXAMS. They have company registration in the name of Turning Point Education Services Pvt. Ltd.; Smart Gurukul Classes Pvt. Ltd.; Matrix Learning Resources Pvt. Ltd. and Matrix Institute For Competitive Exams, all of which are fraudulent, since, these trade names belong to other established entities running coaching classes, which are not even remotely associated with the defendants.

38. Counsel submits that the judgment in *Keshav Kumar* (supra) reaffirms the fact that the use of the impugned trademark by the defendants is much after that of the plaintiff. Even according to the defendants claim, it is since 1998. She submits that the said order is an interim order, and not a final judgment post trial. The same does not bind the plaintiff, since the same has been obtained behind the plaintiffs back. She submits that defendants were successful at the interim stage primarily because the usage of mark TURNING POINT by NIIT dated back only to 2013, while the defendants herein claimed usage, albeit falsely, from 1998. Furthermore, the said judgment has been obtained fraudulently and is a nullity as per recent decision of the Supreme Court in *Union of India v. Ramesh Gandhi*, (2012)1 SCC 476, wherein it was held that “*If a judgment obtained by playing fraud on the court is a nullity and is to it be treated as non est by every Court superior or inferior...*”.

39. She submits that a prior user can injunct a registered proprietor and relies on *N.R. Dongre and Ors. vs. Whirlpool Corpn. and Anr.*, 1996 PTC (16) 583 (SC), in this regard.

40. As regards delay, learned counsel submits that the plaintiff has initiated action as soon as it discovered about the activities of the defendants. However, to combat delay she relied upon *Hindustan Pencils Ltd. Vs. India Stationary Products Company & Anr.*, (1989) PTC 61, to submit that if the Court comes to the conclusion that prejudice is likely to be caused to the general public who, in this case are innocent students, then an injunction must be issued.

#### Submissions in Sur-Rejoinder

41. The defendants in their sur-rejoinder have submitted that they did not have knowledge of the plaintiff's business and alleged trademark usage. Learned counsel for the defendants submitted that delay on their part to file the suit for infringement and passing off is not fatal to the case. Reliance is placed on *Midas Hygiene Industries P. Ltd. & Anr Vs. Sudhir Bhatia & Ors*, 2004(28)PTC 121 (SC). He submits that because the defendants have a registration for the trademark in question, an injunction must follow, notwithstanding the plea of delay. He places reliance on *Power Control Appliances vs. Sumeet Machines*, 1994 SCC (2) 448, in this regard.

#### Discussion & Decision:

42. The plaintiff's case is of passing off since, evidently, they have not secured, much less applied for, registration of their trademark "TP Turning Point". To adjudicate cases of passing off, the courts in our country apply the 'classical trinity' test as laid down by Lord Oliver in *Reckitt & Colman Products Ltd. v. Borden Inc.*, (1990) 1 WLR 491 : (1990) 1 All ER 873

(HL) and explained in *S. Syed Mohideen v. P Sulochana Bai*, (2016) 2 SCC 683, the trinity comprising of - misrepresentation, goodwill and damage.

43. Before I proceed with examining these elements vis-a-vis the facts at hand, it seems appropriate to first deal with the much disputed aspect of prior user. It is also imperative to consider the effect of prior user in a case of passing off. [See *Satyam Infoway Ltd.v. Siffynet Solutions (P) Ltd.*, (2004) 6 SCC 145]. While the plaintiff submits that it was in the year of 1994 that the mark “TP TURNING POINT” came to be adopted by the founder of the plaintiff institute, Mr. Tej Narain Chowdhary, the same is disputed by the defendant on the ground of lack of cogent evidence. The defendant, on the other hand, submits that it was first in point of time in adopting the impugned mark “TURNING POINT” in the year of 1998 and is, therefore, the prior user.

44. The plaintiff has placed on record several documents to support its claim of use of the mark in question i.e. TP Turning Point since 1994-95 onwards. Firstly, the plaintiff has filed the affidavit of one Bindu Saini, wife of Mukesh Saini. She claims that she is the creator of the word mark “TP Turning Point”. The background in which she created the said word mark for the plaintiff’s institution has been set out in this affidavit. She stated that she created the said word mark when Mr. Tej Narain Chowdhary was giving his services as physics teacher at her home to her nephew Praveen Saini, during June 1992. Mr. Tej Narain Chowdhary continued to provide his services till the Board Examination for the 12<sup>th</sup> standard were held in March 1994. In the month of March 1994, one evening Mr. T.N. Chowdhary was taking tea at the deponent’s house in the presence of her husband and nephew i.e.

Praveen Saini with her, and it was then that he disclosed his plan to soon start his coaching institute for engineering and medical entrance examination. He stated that he was looking for a name for his coaching institute. She claims that she then suggested to him the name “Turning Point”, which was drawn from a TV programme of the same name on the National Channel – in respect of a science based programme to remove illusions of *jadu-tona* from the minds of the people. Mr. Chowdhary was convinced to use Turning Point for his proposed business of offering services. He also added the abbreviation ‘TP’ as a prefix to the name ‘Turning Point’, drawing the letter ‘T’ from his name, and drawing the letter ‘P’ from the nick name of his trusted friend and maths teacher, whose nickname was ‘Prakash’. That is how “TP Turning Point” came into existence in March 1994, to offer coaching services by Mr. Chowdhary, and the institute was formally launched on 11.04.1994.

45. The plaintiff has also placed on record the affidavit of Sh. Ram Prakash Gupta (Prakash), son of late Sh. B.P. Gupta, who states that he has been a teacher at Turning Point Institute Pvt. Ltd. (previously known as Turning Point; an Educational Institute) during April 1994 to July 1995. He, inter alia, states that Turning Point has been imparting educational services regarding preparation for engineering/ pre-medical entrance examinations, along with preparatory programme for classes XI, XII Boards (science stream only) and foundation classes of IX and X since 1994. He states that he took maths classes during April 1994 to February 1995 at Turning Point at GH-14/386 Paschim Vihar, New Delhi-110087. Thereafter, the plaintiff institute shifted to Shop No.4, 3<sup>rd</sup> Floor Ram House, Jwala Heri Market,

Paschim Vihar, New Delhi – 110063 in April 1995 and he took classes from April 1995 to July 1995 at that address.

46. The plaintiff has also filed the affidavit of one Rajender Chauhan, son of late Sh. Khem Chand Chauhan, who claims to be a painter by profession. He states that he had painted the sign board of “Turning Point” showing the address as GH-14/386 Paschim Vihar, New Delhi and, thereafter, once the institute shifted, as Shop No.4, 3<sup>rd</sup> Floor Ram House, Jwala Heri Market, Paschim Vihar, New Delhi–110063 in April 1995.

47. The plaintiff has filed the affidavit of Ashu Sharma, wife of Rajkumar Sharma, who claims that she was a teacher at the plaintiff institute during November 1994 to February 1997. She states that she took chemistry classes during November 1994 to February 1995 at Turning Point GH-14/386 Paschim Vihar, New Delhi-110087 and thereafter, when the plaintiff institute shifted to Shop No.4, 3<sup>rd</sup> Floor Ram House, Jwala Heri Market, Paschim Vihar, New Delhi – 110063 in April 1995, she took classes from April 1995 to July 1995, and from September 1996 to February 1997 at the said address.

48. Another affidavit filed is of one Akash Yadav, son of Shiv Taj Singh, who states that he was the caretaker of premises at Shop No.1, 2, 3 in addition to Shop No.4 located at 3<sup>rd</sup> Floor Ram House, Jwala Heri Market, Paschim Vihar, New Delhi, where Turning Point Institute Pvt. Ltd. (previously known as Turning Point; an Educational Institute) was located. He states that earlier, one Chander Prakash was the caretaker between 1995 till 2003, from whom he took over. This affidavit appears to be of no

significance, since the same is *hearsay*. It does not throw any light on the basis of firsthand knowledge of the deponent Akash Yadav during the crucial period 1995 to 1999 - when the plaintiff claims to have used the mark in question TP Turning Point, and to have run its business, firstly, at GH-14/386 Paschim Vihar, New Delhi-110087 and, thereafter, at Shop No.4, 3<sup>rd</sup> Floor Ram House, Jwala Heri Market, Paschim Vihar, New Delhi – 110063. This deponent, as per his affirmation, joined only in 2003.

49. The plaintiff has filed several affidavits of students who are claimed to have studied and taken coaching at the plaintiff institute. Along with these affidavits, the plaintiff has placed on record the mark statements issued by the Central Board of Secondary Education in the names of the respective students. In the tabulation herein below, the gist of these affidavits is being captured:

Sl. No	Name & Father's name of the Student	Period to which the Affidavit pertains	Remarks
1.	Praveen Saini s/o Late Shri Ramesh Kumar Saini	June 1992 to March 1994	<p>Deposes that the plaintiff institution has been imparting educational services under the name and style "TP TURNING POINT" since 1994.</p> <p>Deposes that he was a part of the havan ceremony of the plaintiff institution at GH-14/386 Paschim Vihar, New Delhi in 1994, and thereafter the plaintiff institution shifted to Shop No. 4, 3rd Floor Ram House, Jwala Heri Market, Paschim Vihar, New Delhi in April 1995.</p> <p>Deposes that the plaintiff institution's managing director has been critical in him passing Class XII Board exams.</p>

2.	Prashant Kumar s/o Rajendra Kumar	June 1992 to March 1994	<p>Deposes that the plaintiff institution has been imparting educational services under the name and style “TP TURNING POINT” since 1994.</p> <p>Deposes that he was a part of the havan ceremony of the plaintiff institution at GH-14/386 Paschim Vihar, New Delhi in 1994, and thereafter the plaintiff institution shifted to Shop No. 4, 3rd Floor Ram House, Jwala Heri Market, Paschim Vihar, New Delhi in April 1995.</p> <p>Deposes that the plaintiff institution has been critical in him securing excellent marks in Class XII Board exams.</p>
3.	Dr. Sudhir Kumar, s/o of Satish Kumar	April 1994 to May 1995	<p>Deposes that the plaintiff institution has been imparting educational services under the name and style “TP TURNING POINT” since 1994.</p> <p>Deposes that he took classes between April 1994 to February 1995 at GH-14/386 Paschim Vihar, New Delhi, and between April 1995 to May 1995 at Shop No.4, 3rd Floor Ram House, Jwala Heri Market, Paschim Vihar, New Delhi.</p> <p>Deposes that the plaintiff institution has been critical in him securing excellent marks in Class XII Board exams and clearing Delhi Medical Examination in 1995.</p>
4.	Rajneesh Chaudhry s/o S.K. Chaudhry	April 1994 to May 1995	<p>Deposes that the plaintiff institution has been imparting educational services under the name and style “TP TURNING POINT” since 1994.</p> <p>Deposes that he took classes between April 1994 to February 1995 at GH-14/386 Paschim Vihar, New Delhi from and between April 1995 to May 1995 at Shop No. 4, 3rd Floor Ram House, Jwala Heri Market, Paschim Vihar, New Delhi.</p> <p>Deposes that the plaintiff institution has been critical in him securing excellent marks in Class XII Board exams and clearing All India Senior School Certificate Exam in 1995.</p>

5.	Deepak Kashyap s/o Suresh Prasad	April 1994 to May 1995	<p>Deposes that the plaintiff institution has been imparting educational services under the name and style "TP TURNING POINT" since 1994.</p> <p>Deposes that he took classes between April 1994 to February 1995 at GH-14/386 Paschim Vihar, New Delhi, and between April 1995 to May 1995 at Shop No.4, 3<sup>rd</sup> Floor Ram House, Jwala Heri Market, Paschim Vihar, New Delhi.</p> <p>Deposes that the plaintiff institution has been critical in him securing excellent marks.</p>
6.	Kartik Gulati s/o Narinder Gulati	April 1994 to March 1996	<p>Deposes that the plaintiff institution has been imparting educational services under the name and style "TP TURNING POINT" since 1994.</p> <p>Deposes that he took classes between April 1994 to February 1995 at GH-14/386 Paschim Vihar, New Delhi, and between May 1995 to March 1996 at Shop No.4, 3<sup>rd</sup> Floor Ram House, Jwala Heri Market, Paschim Vihar, New Delhi.</p> <p>Deposes that the plaintiff institution has been critical in him securing excellent marks in Class XII Board exams and securing an engineering seat.</p>
7.	Manav Goel s/o Nikhil Goel	April 1994 to May 1997	<p>Deposes that the plaintiff institution has been imparting educational services under the name and style "TP TURNING POINT" since 1994.</p> <p>Deposes that he took classes in 1994 at GH-14/386 Paschim Vihar, New Delhi, and between May 1995 to May 1997 at Shop No.4, 3<sup>rd</sup> Floor Ram House, Jwala Heri Market, Paschim Vihar, New Delhi.</p> <p>Deposes that the plaintiff institution has been critical in him securing excellent marks in Class XII Board exams and securing admission in M.D. University, Rohtak for Engineering in Electronics and Communication Branch.</p>
8.	Navneet Dhand s/o	April 1995 to February	<p>Deposes that the plaintiff institution has been imparting educational services under the name</p>

	Gian Chand Dhand	1996	<p>and style “TP TURNING POINT” since 1994.</p> <p>Deposes that he was a part of April 1995-February 1996 batch and took classes from Mr. Tej Narain Chowdhary.</p> <p>Deposes that the plaintiff institution has been critical in him securing excellent marks in Class XII Board exams and preparing for entrance examinations.</p>
9.	Gagan Chawla s/o Munshi Ram Chawla	1995 to 1996	<p>Deposes that the plaintiff institution has been imparting educational services under the name and style “TP TURNING POINT” since 1994.</p> <p>Deposes that he was a part of 1995-1996 batch and took classes from Mr. Tej Narain Chowdhary.</p> <p>Deposes that the plaintiff institution has been critical in him securing excellent marks in Class XII Board exams.</p>
10.	Gaurav Mathur s/o Lt. Kamesh Mathur	1995 to 1997	<p>Deposes that the plaintiff institution has been imparting educational services under the name and style “TP TURNING POINT” since 1994.</p> <p>Deposes that he was a part of 1995-1997 batch and took classes from Mr. Tej Narain Chowdhary.</p> <p>Deposes that the plaintiff institution has been critical in him securing excellent marks.</p>
11.	Mohit Gulati s/o Naresh Kumar Gulati	April 1996 to May 1997	<p>Deposes that the plaintiff institution has been imparting educational services under the name and style “TP TURNING POINT” since 1994.</p> <p>Deposes that he was a part of the 1996-97 batch and took classes from Mr. Tej Narain Chowdhary and other teachers.</p> <p>Deposes that the plaintiff institution has been critical in him securing excellent marks in Class XII Board exams and securing admission in</p>

			DIPSAR college, New Delhi.
12.	Kuldeep Kumar s/o Sushil Kumar Sharma	April 1996 to May 1997	<p>Deposes that the plaintiff institution has been imparting educational services under the name and style “TP TURNING POINT” since 1994.</p> <p>Deposes that he was a part of the April 1996-May 1997 batch and took classes from Mr. Tej Narain Chowdhary.</p> <p>Deposes that the plaintiff institution has been critical in him securing excellent marks in Class XII Board exams and securing a placement in Delhi College of Engineering.</p>
13.	Rajnish Kumar Srivastava s/o Prof. Jawahar Lal Srivastava	April 1996 to May 1997	<p>Deposes that the plaintiff institution has been imparting educational services under the name and style “TP TURNING POINT” since 1994.</p> <p>Deposes that he was a part of April 1996- May 1997 batch and took classes from Mr. Tej Narain Chowdhary.</p> <p>Deposes that the plaintiff institution has been critical in him securing excellent marks in Class XII Board exams and securing a placement in Delhi College of Engineering.</p>
14.	Gaurav Keswani s/o Kamal Keswani	1996 to 1997	<p>Deposes that the plaintiff institution has been imparting educational services under the name and style “TP TURNING POINT” since 1994.</p> <p>Deposes that he was a part of 1996-1997 batch and took classes from Mr. Tej Narain Chowdhary.</p> <p>Deposes that the plaintiff institution has been critical in him securing excellent marks in Class XII Board exams.</p>
15.	Mridul Sharma s/o Neeraj Sharma	1997 to 1998	<p>Deposes that the plaintiff institution has been imparting educational services under the name and style “TP TURNING POINT” since 1994.</p> <p>Deposes that he was a part of 1997-1998 batch and took classes from Mr. Tej Narain</p>

			Chowdhary. Deposes that the plaintiff institution has been critical in him securing excellent marks.
16.	Raja Arora s/o K.G. Arora	1998 to 2000	Deposes that the plaintiff institution has been imparting educational services under the name and style "TP TURNING POINT" since 1994.  Deposes that he was a part of the 1998-2000 batch and took classes from Mr. Tej Narain Chowdhary and other teachers.  Deposes that the plaintiff institution has been critical in him securing excellent marks in Class XII Board exams and prepare for engineering entrance examinations.
17.	Nitin Gupta s/o Lt Naresh Gupta	1998 to 2000	Deposes that the plaintiff institution has been imparting educational services under the name and style "TP TURNING POINT" since 1994.  Deposes that he was a part of 1998-2000 batch and took classes from Mr. Tej Narain Chowdhary.  Deposes that the plaintiff institution has been critical in him securing excellent marks in Class XII Board exams and securing admission in Netaji Subhash Institute of Technology Delhi.

50. The plaintiff has also placed on record copies of rent receipts issued by the landlord in respect of Shop No.4, 3<sup>rd</sup> Floor Ram House, Jwala Heri Market, Paschim Vihar, New Delhi-110063. The first set of these receipts describe the said property as "Property of Sh. Ram Yadava". These receipts cover the period from May 1995 to March 2001. The first receipt dated 01.12.1995 is for the period May 1995 to December 1995 for Rs.4,800/-. Therefore, the rent translates to Rs.600/- per month. The receipts in respect

of four years i.e. 1996, 1997, 1998 and 1999 are single receipts for the rent for the entire calendar year i.e. from January to December and each is for Rs.7,200/- issued on 10.12.1996, 07.12.1997, 10.12.1998 and 10.12.1999. These receipts have been issued in respect of rent received from Sh. T.N. Chowdhary, the tenant. These receipts do not bear the name of “Turning Point”. Then there is one receipt dated 10.06.2000 in respect of the period January 2000 to June 2000 for Rs.3,600/- (@ Rs.600/- per month), and another receipt dated 30.03.2001 for the period September 2000 to March 2001 for Rs.8,400/- (@ Rs.1200/- per month). However, the plaintiff has also placed the printed receipts which describe the same property i.e. Shop No.4, 3<sup>rd</sup> Floor Ram House, Jwala Heri Market, Paschim Vihar, New Delhi – 110063 as the “Property of Renuka Singh”. These receipts are in respect of rent from February 1997 onwards. The first of these receipts is dated 01.06.1997 for the period February 1997 to June 1997. Though the receipts are printed for the amount of Rs.500/- only, in hand the amount the of Rs.2,500/- is mentioned. These receipts also mention the name of the tenant, in print, as –

“Tej Naraian Chawdhary  
(Turning Point) (Tenant)”

51. The period from February 1997 to June 1997 translates to five months, and the rent translates to Rs.500/- per month. Apparently, there is an overlap inasmuch, as, the rent receipt for the entire year 1997 for Rs.7,200/- describing the property as that of Ram Yadava has separately been filed showing the cumulative rent of Rs.7,200/- (i.e. Rs.600/- per month). The plaintiff has also filed monthly rent receipts in respect of August 1997, and for periods thereafter, which are similar to the receipt dated 01.06.1997

describing the property as that of Renuka Singh and mentioning the name of the tenant as “Tej Narain Chowdhary, (Turning Point), (Tenant)” @ Rs.500/- per month.

52. The rent receipts claimed to have been issued by Renuka Singh do raise some issues, and it would be for the plaintiff to explain as to how the name of the owner of the property changed from Ram Yadava to Renuka Singh; the rent which was shown as Rs.600/- per month from the beginning, and translated to Rs.1,200/- per month for the period September 2000 to March 2001, came down to Rs.500/- per month for the same premises, and; how there are overlapping receipts for the period February 1997 onwards till March 2001 from two different landlords for the same premises showing different rates of rent.

53. Consequently, for the purpose of prima facie appreciation, the said rent receipts relied upon by the plaintiff - wherein the name of the tenant has been showed as “Tej Narain Chowdhary, (Turning Point), (Tenant)” cannot be relied upon, and they would have to be ignored.

54. The plaintiff has, however, apart from filing the affidavits taken note of herein above (to establish the running of its institution with the mark “TP Turning Point” from April 1994 onwards) placed on record other documents as well. They may be taken note of at this stage. Firstly, the plaintiff has placed on record the original telephone bill in respect of Telephone No.5688081 issued in favour of Suresh Kumar Yadav showing the address as Shop No.4, 3<sup>rd</sup> Floor Ram House, Jwala Heri Market, Paschim Vihar, New Delhi for the period 21.09.1996 to 31.10.1996. Similarly, in respect of

another landline number, the plaintiff has placed on record the original bill issued in the name of Lt. Col. Maninder Singh Marwa for the period 01.01.1996 to 22.09.1996 in respect of Telephone No.5575510. The same have come from the custody of the plaintiff. It was not, and even now it is uncommon that landline telephone connection obtained in the name of some other person may be used by the tenant who may be inducted in the premises where the landline connection may be installed. The plaintiff has placed on record several test series question paper, wherein “TP Turning Point” i.e. the mark of the plaintiff has been prominently printed at the top. At the bottom, the address - 3<sup>rd</sup> Floor Ram House, Jwala Heri Market (above Kumar Sweets), Paschim Vihar, New Delhi – 110063 has been printed. All these test series papers also contain the telephone numbers of the landline number 5688081 and 5575510. However, these test series do not bear a date and, therefore, it is not clear as to for which period they pertain. These documents also do not, therefore, support the plaintiffs claim of use of the mark TP Turning Point from 1994 onwards.

55. However, two documents which, prima facie, establish the claim of the plaintiff may now be taken note of. These are, firstly, the delivery voucher issued by KWYC Gas Service dated 03.09.1996 in respect of Consumer No.16724, showing the name and address M/s. Turning Point Instt., 3<sup>rd</sup> Floor, Ram House, Jwala Heri Market, Paschim Vihar, New Delhi in respect of the issue of Indane Gas Cylinder. The same apparently bears the signature of Sh. T.N. Chawdhary. This document shows that Turning Point institute was in existence in September 1996 at the aforesaid address at Jwala Heri. This apart, the plaintiff has also placed on record the original

flyer issued by “TP Turning Point”. This flyer notifies the public at large that:

“Now  
TURNING POINT  
has shifted to  
Jwala Heri Market  
CLASSES COMMENCING FROM  
12 APRIL 1995”  
“III FLOOR RAM HOUSE, JWALA HERI MARKET  
(ABOVE KUMAR SWEETS) PASCHIM VIHAR”.

56. At the top, this flyer states that:

“Heartiest thanks to all our students & parents !!

With your cooperation & support we have completed  
our First academic session (1994-95)

Very successfully”.

57. At the bottom, it contains a note:

*“Note: Turning Point has shifted from GH-14/386, Paschim Vihar to Jwala Heri Market, P.V. All classes now will be held at Jwala Heri Market”.*

58. On the reverse side of the flyer, the flyer mentions:

“TURNING POINT  
PIONEER INSTITUTE FOR PRE-MEDICAL/ENGG. & BOARDS

ENROLMENT STARTS  
FOR  
MED – ENGG ..... 1996 & 1997  
PHY – CHEM – MATHS – BIO  
SEPARATE SUBJECT COACHING  
(XI-XII)  
FOUNDATION  
IX-X  
MATHS & SCIENCE  
CLASS TIMING:

10:30 TO 12:30 & 4:30 TO 7:30. (SUNDAY OPEN)”

59. It again mentions the fact that Turning Point has shifted as aforesaid and also mentions the address at Jwala Heri Market.

60. The name of the publisher/printer of the flyer has been mentioned as Virgin Ideas (Ph: 5581277).

61. Thus, prima facie, it appears to this Court that the plaintiff has been able to establish adoption and user of the mark TP Turning Point atleast from April 1995 onwards.

62. According to the defendants, their first use of the mark “TURNING POINT” dates back to the year 1998. Thus, even without going into the issue whether the claim of the defendants of their use of the mark “Turning Point” is of the year 1998 or later, it is *prima facie* apparent from the

documents that the plaintiff was the first to adopt and use the mark “TP TURNING POINT”.

63. I may also observe that a perusal of the defendants’ documents does not show any *prima facie* evidence of use of the impugned mark from 1998 onwards. There is, at best, a notice cum announcement regarding the batch for 1999-2000 which bears the mark “TURNING POINT” with the insignia/logo of the letters “TP” enclosed in a book. Even the sales figures offered by the defendant are from 1999 onwards. So, based on these documents, it is safe to presently proceed on the basis that plaintiff has been using the mark “TP TURNING POINT” from 1994-1995 onwards, and the defendants have been using the impugned mark from 1999 onwards.

64. Turning back to the three elements of passing off, I may now deal with the first of these i.e. misrepresentation. An act of misrepresenting one's business to be associated with another's falls within the ambit of unfair trading. The effect of misrepresentation is the causation of confusion in the mind of the consuming public with regard to the source or origin of the goods or services. It is not mandatory for an act of misrepresentation to be intentional. The Supreme Court, in catena of judgments (see *Laxmikant V. Patel vs. Chetanbhai Shah*, (2002) 3 SCC 65; *Ramdev Food Products vs. Arvindbhai Rambhai Patel & Ors.*, (2006) 8 SCC 726) has held - while placing reliance on excerpts from *Kerly on Trade Marks* - that misrepresentation may be either intentional, or not. It makes no difference. However, if it is found to be intentional, this aspect would materially assist the plaintiff in establishing probability of deception. The test that the Supreme Court has laid down is that the misrepresentation should be such

that it causes the “*likelihood of confusion in the minds of the public (the word "public" being understood to mean actual or potential customers or users) that the goods or services offered by the defendant are the goods or services of the plaintiff*” [See **Satyam Infoway** (supra)].

65. Now, in assessing the likelihood of confusion, the Courts are required to apply the test of “*imperfect recollection of a person of ordinary memory*” [See **Satyam Infoway** (supra)]. The defendant herein is a subsequent user, who is using an identical trademark “TP Turning Point”/ “Turning Point” in relation to identical services i.e. coaching classes for students in Grade IX to XII. In case of use of identical marks for identical goods or services, confusion is bound to occur. The act of the defendant is causing/ is most likely to cause confusion amongst its potential customers, who are students in this case. Owing to the identical services, the students of both the institutes also fall in the same category i.e. students in grade IX to XII studying subjects of science and math, and preparing for competitive entrance examinations for engineering/medical colleges. The customer base, as rightly pointed out by the counsel of the plaintiff, comprises of young and gullible students who are most likely to be misled into thinking that the defendants’ institute has some affiliation/association with the plaintiff’s. Thus, *prima facie*, the element of misrepresentation by the defendants – by adoption and user of the mark “TP TURNING POINT” stands established.

66. Next element for consideration is goodwill. Goodwill and reputation is ascertained, *inter alia*, from the sales figures, advertisements and promotional expenses, and also continuous use - as opposed to intermittent use of the mark since its adoption. Further, goodwill, as per *P. Narayan*,

*Law of Trade Marks and Passing off, 6<sup>th</sup> Ed.* must be seen from the date when the defendant commenced the activities complained of. As aforesaid, the defendants - as per the documents brought on record, commenced the use of the impugned mark in 1999. Thus, the existence of goodwill of the plaintiff would have to be assessed as in 1999, and prior thereto. Though the sales figures and advertisement expenses of the plaintiff institute at that point of time may not be significant, the plaintiff has *prima facie*, established continuity of adoption and use of its mark “TP TURNING POINT” since 1995. Thus, the plaintiff must have earned some goodwill and reputation in about 3 to 4 years of its existence, between 1995 to 1999 when, for the first time, the defendants adopted and started using the mark in question. I may also observe that unlike other businesses involving manufacture and sales of goods – which may take considerable time to acquire goodwill and reputation because of the feedback from the customers coming only after they have used the goods over a period of time, the nature of services offered by the parties in the present case is such that the goodwill and reputation is built rapidly – once the results of the competitive examination are declared each year. It is not uncommon to see large full page advertisements in National dailies given out by those running coaching classes, proclaiming the success of their students who are participants in the competitive examinations, on the day following the declaration of examination results. Thus, even in 1999, the plaintiff would have earned goodwill and reputation, when the defendant adopted and started using the mark in question for its identical services. The existence of goodwill and reputation can also be inferred from the flyer contemporaneously got published by the plaintiff in 1995. The said flyer conveys:

*“Hearties thanks to all our students & parents !!*

*With your cooperation & support we have completed our First academic session (1994-95) very successfully”.*

67. The plaintiffs goodwill and reputation can also be inferred from the affidavits of the students filed by the plaintiff, taken note of herein above. The reputation and goodwill earned by the plaintiff from the inception of its business has been preserved and appears to have grown, firstly, on account of continuity and, secondly, on account of the increase in its turnover and advertisement expenditure.

68. At the time of institution of the suit, owing to the continuous and uninterrupted use of the mark in question by the plaintiff, there appears to be sufficient *prima facie* material on record to establish the goodwill and reputation attained by the plaintiff.

69. It cannot be denied that the defendants have also attained goodwill and reputation, as is *prima facie* evident from their sales figures. But, this reputation and goodwill of the defendants is a result of adoption of the mark, subsequent to the plaintiff's adoption of the mark in question and, secondly, the defendants adoption of the mark, *prima facie*, seems to be dishonest. The aspect about the defendants adoption and use of the mark being dishonest is discussed a little later in this order.

70. The last of the three elements is “damage”. It is well established that at the stage of consideration of an interim injunction application, when the Court is forming a *prima facie* view, actual damages need not be established, and the likelihood of damage to the plaintiff's business by the alleged act of

passing off would suffice [See *Lakshmikant v. Patel* (supra)]. The use of an identical mark by the defendant for identical services is bound to cause confusion, which increases the likelihood of injury to the goodwill, reputation and business of the plaintiff. In fact, a comparison of the sales figures of both the institutes in the last six years, *prima facie* shows this to be an instance of actual damage. These figures are as follows:

<b>Years</b>	<b>Plaintiff</b>	<b>Defendant</b>
2010-11	59,91,057	38,96,349
2011-12	61,12,635	61,06,693
2012-13	64,30,931	97,24,700
2013-14	68,16,307	1,18,21,372
2014-15	69,35,275	1,53,23,748

71. The table above shows that the annual turnover of the plaintiff's business has become almost stagnant, while the defendant's business under the impugned trademark has zoomed past eight figures. The reason behind the upsurge in revenue figures of the defendant, *prima facie*, appears to be because of the subsequent dishonest adoption of the identical mark by the defendant for the same services. Thus, an overall assessment of these three elements, in light of the facts at hand, establishes a *prima facie* case of passing off in favour of the plaintiff.

72. Learned counsel for the defendants has submitted that the defendant no. 1 is a registered proprietor of the mark "TURNING POINT" and is

entitled to use the same in relation to the services for which it is registered under Section 28 of the Trademarks Act, 1999. Firstly, the mark for which the defendants have registration is a label mark (and not a word mark), which has within the label the words “TURNING POINT” and initials “TP”. Secondly, registration of a trademark does not bar a prior user from exercising its rights under the common law. The Act itself provides under clause (2) of Section 27 that “**Nothing in this Act shall be deemed to affect rights of action against any person for passing off goods or services as the goods of another person or as services provided by another person, or the remedies in respect thereof**” (emphasis supplied). Thus, the common law rights in respect of the Tort of “passing off”, are preserved by the Act,

73. In this regard, I may refer to the judgment of the Supreme Court in *N.R. Dongre* (supra) in *S. Syed Mohideen v. P. Sulochana Bai*, (2016) 2 SCC 683. The Court observed:

*“30.4.....The overall effect of collective reading of the provisions of the Act is that **the action for passing off which is premised on the rights of prior user generating a goodwill shall be unaffected by any registration provided under the Act.** This proposition has been discussed in extenso in *N.R. Dongre v. Whirlpool Corpn.* [*N.R. Dongre v. Whirlpool Corpn.*, 1995 SCC OnLine Del 310 : AIR 1995 Del 300] wherein the Division Bench of the Delhi High Court recognised that the **registration is not an indefeasible right and the same is subject to rights of prior user.** The said decision of Whirlpool [*N.R. Dongre v. Whirlpool Corpn.*, 1995 SCC OnLine Del 310 : AIR 1995 Del 300] was further affirmed by the Supreme Court of India in *N.R. Dongre v. Whirlpool Corpn.* [*N.R. Dongre v. Whirlpool Corpn.*, (1996) 5 SCC 714]*

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31.2. *The applicability of the said principle can be seen as to which proprietor has generated the goodwill by way of use of the mark/name in the business. The use of the mark/carrying on business under the name confers the rights in favour of the person and generates goodwill in the market. Accordingly, **the latter user of the mark/name or in the business cannot misrepresent his business as that of business of the prior right holder.** That is the reason why essentially **the prior user is considered to be superior than that of any other rights.** Consequently, the examination of rights in common law which are based on goodwill, misrepresentation and damage are independent to that of registered rights. The mere fact that both prior user and subsequent user are registered proprietors are irrelevant for the purposes of examining **who generated the goodwill first in the market** and whether the latter user is causing misrepresentation in the course of trade and damaging the goodwill and reputation of the **prior right holder/former user.** That is the additional reasoning that the statutory rights must pave the way for common law rights of passing off. (emphasis supplied)*

74. The Supreme Court has extensively referred to Kerly's law of Trade Marks and Trade Names in this decision. The Supreme Court observes:

*“32.1. The same author also recognises the principle that **the Trade Marks Act affords no bar to the passing off action.** This has been explained by the learned author as under:*

*“15-034. Subject to possibly one qualification, nothing in the Trade Marks Act, 1994 affects a trader's right against another in an action for passing off. It is, therefore, no bar to an action for passing off that the trade name, get up or any other of the badges identified with the claimant's business, which are alleged to have been copies or imitated by the defendant, might have been, but are not registered as, trade marks, even though the evidence is wholly addressed to what may be a*

*mark capable of registration. Again, it is no defence to passing off that the defendant's mark is registered. The Act offers advantages to those who register their trade marks, but imposes no penalty upon those who do not. It is equally no bar to an action for passing off that the false representation relied upon is an imitation of a trade mark that is incapable of registration. A passing off action can even lie against a registered proprietor of the mark sued upon. The fact that a claimant is using a mark registered by another party (or even the defendant) does not of itself prevent goodwill being generated by the use of the mark, or prevent such a claimant from relying on such goodwill in an action against the registered proprietor. Such unregistered marks are frequently referred to as 'common law trade marks'.*" (emphasis supplied)

75. Learned counsel for the defendants raised the plea of "Honest and Concurrent User" of the mark by the defendants. This submission may now be considered. As aforesaid, the plaintiff is the prior user of the mark in question. It is not the submission of the defendants that "TP TURNING POINT" was being simultaneously used by any third party when the plaintiff adopted the mark i.e. in 1994-1995. Defendant no. 2 claims to have himself coined the mark in the year 1998. Defendants' use of the words "TURNING POINT" within a label, which has the letters 'TP' confined in it, is similar to the mark of the plaintiff, which also has the mark "TURNING POINT" with the letters 'TP' encircled. This use is, *prima facie* subsequent to that of the plaintiff, and in respect to the same services as that of the plaintiff. The defendants' claim of honest and concurrent user has to be viewed in the light of the fact that the defendants have failed to furnish

any explanation for adopting even the initials “TP” before the words “Turning Point”. Defendant no. 2 claims to be running, with his wife, other coaching centres in the name of PYRAMID CLASSES, MATRIX CLASSES etc. It would be quite a coincidence that the defendant no. 2 innocently and *bona fide* adopted not only the mark ‘TURNING POINT’ – exclusively for students seeking coaching for engineering and medicine entrances, but even the abbreviation ‘TP’. This statement of the defendant cannot be accepted on its face value. The defendants have not explained the background which they adopted either “TURNING POINT”, or the abbreviation “TP”. Secondly, if the defendants had adopted the said mark honestly, they would have claimed protection in respect of “TP” as well, and not just “Turning Point”. As opposed to this, the plaintiff has explained the origin of the mark “TP TURNING POINT”, as noticed hereinabove.

76. The lack of bonafides on the part of the defendants is also apparent from the fact that the defendants did not take any action against the plaintiff, even though they most certainly would have learnt of the existence of the plaintiff's company, when they got Turning Point Education Testing Services Pvt. Ltd. incorporated in the year 2002. The defendants have not explained their said inaction. Pertinently, the plaintiff in its written statement filed in the suit of the defendant (C.S.(O.S.) No.3159/2015) under the heading “Preliminary Objections” has, inter alia, stated in para-9 that “*Plaintiffs have company registrations in the name of Turning Point Educational Testing Services Pvt. Ltd. (date of incorporation 07.10.2002); ... ..*” (see para 9.1.). In para 9.2, the plaintiff has stated:

*“9.2 In fact, while registering TURNING POINT EDUCATIONAL TESTING SERVICES PRIVATE LIMITED (date of incorporation 07.10.2002), as per Companies Act and Rules, the plaintiff would have inevitably come across the name of the Defendant Company registered in 2001 and thus, they chose to keep a similar name in order to enable passing off as the Defendant”.*

77. Similarly, in para 18, under the heading “Parawise Reply on Merits”, the plaintiff in its written statement stated:

*“18. The averments made in para 18 are false and denied except for the admission of the plaintiff towards acknowledgment of the incorporation of the Defendant in 2001 i.e. prior to plaintiff’s registration of TURNING POINT EDUCATIONAL TESTING SERVICES PRIVATE LIMITED (date of incorporation 07.10.2002), wherein as per the Companies Act, they must have come across the pre-existing registration of the Defendant, and chose to adopt a deceptively similar name for its services. The plaintiff has now closed its operations under the said company”.*

78. The defendant filed its replication to the said written statement. Neither in response to para 9 of the preliminary objections, nor in response to para 18 of the replication on merits, the defendant traversed the specific averment of the plaintiff, to the effect, that the defendant would have learnt of the incorporation of the plaintiff company when the defendant got the company Turning Point Educational Testing Services Pvt. Ltd. incorporated on 07.10.2002. In fact, the response of the defendant is clearly evasive inasmuch, as, the defendant has sought to reply to the said averments by bunching the same with the defendants response to several other paragraphs in the written statement of the plaintiff. Thus, I have no hesitation in, prima facie, finding that the

adoption of the mark TP Turning Point by the defendant was dishonest, and not bonafide. It, *prima facie*, appears that the defendants were aware about the plaintiff's business and trademark, and dishonestly adopted the same for their coaching institute.

79. Even if this court were to presume that the use of the impugned mark by the defendants is honest and concurrent, the same would be of no avail to the defendants. Honest and concurrent user may be a defence in cases where the goods are not identical, or the marks are not identical, i.e., in cases in which there is no scope of confusion as to the source of the goods or services of the two parties being the same. But it cannot be a defence where, as in the present case, the marks are identical and the services for which they are used are also identical. (See *Kanshiram Surinder Kumar v. M/s. Thakurdas Deomal Rohira*, (1977) 79 Bom LR 61)

80. Learned counsel of the defendants has argued that plaintiff's case must fail because of acquiescence and inordinate delay on their part in filing the suit. The defendant no. 2 claims to have started its coaching centre under the impugned mark in 1998, and the suit has been filed by the plaintiff in 2015. Thus, it is claimed that there is delay for about 17 years.

81. Acquiescence, as observed by the Supreme Court in *Sumeet Machines* (supra) is sitting by, when another is invading the rights and spending money on it. It is a course of conduct inconsistent with the claim for exclusive rights in a trade mark, trade name etc and implies positive act, and not mere silence or inaction, as is involved in laches. If the plaintiff stood by knowingly and let the defendants build up substantial trade until it

became necessary to crush it, the plaintiff would be denied an injunction by their acquiescence. Question is, has there been a “positive act/conduct” committed by the plaintiff to have encouraged the defendant to continue and grow its business under the impugned mark? Acquiescence, obviously, implies knowledge to the plaintiff of the defendants’ adoption and use of the mark in question. In the case in hand, the defendants - on whom lay the onus, have produced no material on record to establish knowledge with the plaintiff of the defendants existence; its business, and; its user of the impugned mark. In fact, it is the defendants case that they were not aware of the plaintiffs existence – thought the plaintiffs existence pre-dates their own, till the filing of the suit by the plaintiff and issuance of summons to defendants. If that be the case, the same would hold good for the plaintiff as well, since no other specific material has been placed on record by the defendants to show the knowledge with the plaintiff of the defendants existence. The defendants have claimed that when the decision in ***Keshav Kumar*** (supra) was passed in March 2013, the plaintiff would have acquired knowledge of the defendants existence. The rendering of the decision in ***Keshav Kumar*** (supra) does not imply knowledge on part of the plaintiff, as the said order was not communicated to the plaintiff. It cannot be presumed to have come into the notice of the plaintiff.

82. Reliance placed on ***Keshav Kumar Aggarwal*** (supra) by the defendant is of no avail. The plaintiff was not a party to the said decision. Thus, the claim of the plaintiff being the prior user of the mark in question did not fall for consideration by the Court. The Court proceeded on the premise that the defendant was the prior user, vis-à-vis.

NIIT Limited. Therefore, the decision in *Keshav Kumar Aggarwal* (supra) does not bind the plaintiff, and would not adversely affect the rights of the plaintiff in any way.

83. Moreover, the plea of acquiescence fails also, as it *prima facie* appears that the impugned mark has been dishonestly adopted. The Supreme Court in *Midas Hygiene Industries (P) Ltd. vs. Sudhir Bhatia*, (2004) 3 SCC 90, held that “*The law on the subject is well settled. In cases of infringement either of Trade Mark or Copyright normally an injunction must follow. Mere delay in bringing action is not sufficient to defeat grant of injunction in such cases. The grant of injunction also becomes necessary if it prima facie appears that the adoption of the mark was itself dishonest.*”. The defendants therein had failed to provide an explanation as to why their cartons had the mark “LAXMAN REKHA”, which was similar to the plaintiffs mark and contained colors of red, white and blue to look almost identical to that of the plaintiffs. This act, the Court held, *prima facie*, indicated the dishonest intention to pass off his goods as that of the appellants. (emphasis supplied)

84. In *Ansul Industries* (supra), this Court while dealing with *Hindustan Pencils Ltd.*(supra), observed:

*31. ... .. A person who had deliberately infringed upon another's mark, it was held, cannot complain and hide behind defence of delay, laches or acquiescence, as the infringement at the very initial stage itself was fraudulent. Delay and laches by itself would not bestow, fraud with character of legality. Reference was also made to Mc CARTHY on Trade Marks wherein it was observed that the Court must also take into consideration necessity to protect third party interest i.e. the*

***general public or the buyer of the goods. It was the right of the public not to be deceived and confused. After examining various aspects this Court held as under:***

***“30. It would appear to be difficult to accept that relief of temporary injunction should not be granted, because of the delay on the part of the plaintiff, even though the Court feels, at that point of time, that ultimately permanent injunction will have to be granted.***

*Even though there may be some doubt as to whether laches or acquiescence can deny the relief of a permanent injunction, judicial opinion has been consistent in holding that if the defendant acts fraudulently with the knowledge that he is violating the plaintiff's rights then in that case, even if there is an inordinate delay on the part of the plaintiff in taking action against the defendant, the relief of injunction is not denied. The defence of laches or inordinate delay is a defence in equity. In equity both the parties must come to the Court with clean hands. An equitable defence can be put up by a party who has acted fairly and honestly. A person who is guilty of violating the law or infringing or usurping somebody else's right cannot claim the continued misuse of the usurped right. It was observed by Romer, J. in the matter of an application brought by J.R. Parkington and Company Ltd., 63 RPC 171 at page 181 that “in my judgment, the circumstances which attend the adoption of a trade mark in the first instance are of considerable importance when one comes to consider whether the use of that mark has or has not been a honest user. If the user in its inception was tainted it would be difficult in most cases to purify it subsequently”. It was further noted by the learned Judge in that case that he could not regard the*

*discreditable origin of the user as cleansed by the subsequent history. In other words, the equitable relief will be afforded only to that party who is not guilty of a fraud and whose conduct shows that there had been, on his part, an honest concurrent user of the mark in question. If a party, for no apparent or a valid reason, adopts, with or without modifications, a mark belonging to another, whether registered or not, it will be difficult for that party to avoid an order of injunction because the Court may rightly assume that such adoption of the mark by the party was not an honest one. The Court would be justified in concluding that the defendant, in such an action, wanted to cash in on the plaintiff's name and reputation and that was the sole, primary or the real motive of the defendant adopting such a mark. Even if, in such a case, there may be an inordinate delay on the part of the plaintiff in bringing a suit for injunction, the application of the plaintiff for an interim injunction cannot be dismissed on the ground that the defendant has been using the mark for a number of years.*  
(emphasis supplied)

85. The Court further held in *Ansul Industries* (supra) that:

*“32. It would appear to me that where there is an honest concurrent user by the defendant then inordinate delay or laches may defeat the claim of damages or rendition of accounts but the relief of injunction should not be refused. This is so because it is the, interest of the general public, which is the third party in such cases, which has to be kept in mind. In the case of inordinate delay of laches, as distinguished from the case of an acquiescence, the main prejudice which may be caused to the defendant is that by reason of the plaintiff not acting at an earlier point of time the defendant has been able to establish his business by using the infringing mark. **Inordinate delay or laches may be there because the plaintiff may not be***

*aware of the infringement by the defendant or the plaintiff may consider such infringement by the defendant as not being serious enough to hurt the plaintiff's business. Nevertheless, if the Court comes to the conclusion that prejudice is likely to be caused to the general public who may be misled into buying the goods manufactured by the defendant thinking them to be the goods of the plaintiff then an injunction must be issued. The Court may, in appropriate cases, allow some time to the defendants to sell off their existing stock but an injunction should not be denied.”* (emphasis supplied)

86. Thus, acquiescence or delay can be invoked as a defence, where the defendants' adoption and use of the mark appears to be honest and *bonafide*. I have already taken a *prima facie* view that the defendants do not appear to be honest adopters of the impugned mark. Their use of the same is also likely to cause prejudice among the relevant sections of the public as well, who are young students looking to make their career, and they could be misled into opting for the defendants' institute, thinking it to be associated with the plaintiffs. In such circumstances, the plea of acquiescence or delay does not stand.

87. No doubt, that the plaintiff's inaction has led to the growth of defendants' business and goodwill under the impugned mark, to an extent, where the defendants' sales have exceeded the plaintiff's. Also there is possibility of reverse confusion as well i.e. the defendants' business may have got diverted to the plaintiff. But where the defendant has attained such goodwill and growth under a mark which it has, *prima facie*, dishonestly and fraudulently adopted, injunction must follow. In such cases, the Courts may, at best, deny or reduces the damages to the plaintiff at the final stage of determination, but not the relief of injunction.

88. The defendants have also placed reliance on Section 33 of the Trade Marks Act, 1999. Section 33 of the Act provides:

***“33. Effect of acquiescence.- (1) Where the proprietor of an earlier trade mark has acquiesced for a continuous period of five years in the use of a registered trade mark, being aware of that use, he shall no longer be entitled on the basis of that earlier trademark-***

*(a) to apply for a declaration that the registration of the later trade mark is invalid, or*

*(b) to oppose the use of the later trade mark in relation to the goods or services in relation to which it has been so used,*

***unless the registration of the later trademark was not applied in good faith.***

*(2) Where sub-section (1) applied, the proprietor of the later trade mark is not entitled to oppose the use of the earlier trade mark, or as the case may be, the exploitation of the earlier right, notwithstanding that the earlier trade mark may no longer be invoked against his later trade mark.” (emphasis supplied)*

89. Section 33 of the Act is available to a registered proprietor who has been continuously using the registered trademark for more than 5 years. It prohibits a proprietor of an earlier trademark, from either: (i) applying for a declaration that the registration of the later registered trademark is invalid, or; (ii) opposing the use of the later registered trademark in relation to the goods or services for which the earlier trademark is used.

90. Section 33, in terms, does not support the defendants. Firstly, Section 33 stipulates that the proprietor of the earlier trade mark should be

aware of the use of the later registered trade mark. In the present case, there is nothing to show that. Secondly, this section also brings in the aspect of honest, *bonafide* and good faith adoption and use by the later mark registrant. Thus, if the later registrant of the mark did not apply in good faith, the bar against the proprietor of the earlier trademark created by this section shall not apply. Since the adoption and use of the mark in question by the defendant does not appear to be in good faith, the bar under Section 33 would not apply against the plaintiff. I have already found, *prima facie*, that the adoption and use of the mark in question by the defendant is not in good faith. Thus, this argument fails.

91. I now come to the submissions raised by the defendants in their cross suit in CS (OS) No. 3159/2015. The defendants' case is of infringement of their registered label mark "TP-TURNING POINT" and passing off. Section 28 of the Act provides the rights conferred by registration. Clause (1) of the said section reads-

*"(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."* (emphasis supplied)

92. The statute protects the rights of a prior user. Section 34 of the Act reads:

*"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.” (emphasis supplied)*

93. This is precisely the position that has been dealt with by the Supreme Court in *S. Syed Mohideen* (supra). The Court observed:

*“30.4. Section 34 of the Trade Marks Act, 1999 provides that nothing in this Act shall entitle the registered proprietor or registered user to interfere with the rights of prior user. Conjoint reading of Sections 34, 27 and 28 would show that the rights of registration are subject to Section 34 which can be seen from the opening words of Section 28 of the Act which states “Subject to the other provisions of this Act, the registration of a trade mark shall, if valid, give to the registered proprietor....” and also the opening words of Section 34 which states “Nothing in this Act shall entitle the proprietor or a registered user of registered trade mark to interfere....” **Thus, the scheme of the Act is such where rights of prior user are recognised superior than that of the registration and even the registered proprietor cannot disturb/interfere with the rights of prior user.**”(emphasis supplied)*

94. Learned counsel for the defendants has placed reliance on the following decisions in support of his submissions:

- i) *ACL Education Centre Pvt. Ltd. & Anr. v. American's Centre for Languages & Anr.*, 2008 (36), PTC 113 (Del);
- ii) *Alkem Laboratories* (supra)
- iii) *Pearl Retail Solutions Pvt. Ltd. v. Pearl Education Society*, 2014 (58) PTC 26 (Del).

95. In my view, neither of these decisions are of any relevance and they do not advance the case of the defendants. *ACL Education Centre Pvt. Ltd.* (supra) was a case where the plaintiff was running its centre for imparting teaching and training in various languages under the trading style “American Centre for Languages”. Defendant no.2 established its businesses under the name M/s. American Centre for Languages, carrying on the same business activity as the plaintiff within the same area of operation. Defendant no.2, prior to start of the business of the defendants, was associated with the plaintiffs as a Director and teacher and after leaving the plaintiffs, he started the business. The defendant - while opposing grant of interim injunction, inter alia, contended that the word/mark ‘American’ was generic. There were several other educational institutes in existence using the word ‘American’. The learned Single Judge held the adoption of the mark by the defendant to be dishonest, since the defendant had no explanation as to why he had adopted the same name i.e. “American Centre for Languages”. The Court held that even though the word “American” is generic, and there are many other institutes being run wherein the word “American” is used in the house mark/ trading style, however, the word “American” along with the words “Centre for Languages” had been adopted by the plaintiff for a

number of years, and had come to be associated with the plaintiff. The use of the word “American” *per se* with some other prefix or suffix may not be objectionable, however, when the defendant adopts the identical name, which is the trade name/ house mark of the plaintiff, that becomes objectionable - particularly when the same has been dishonestly adopted by the defendant. Consequently, the learned Single Judge confirmed the ex-parte injunction granted in favour of the plaintiff. The aforesaid decision, in my view, supports the case of the plaintiff in the facts and circumstances discussed herein above, rather than that of the defendants.

96. *Alkem Laboratories Ltd.* (supra) was a case concerning the trade mark “GEMCAL” in respect of medicinal and pharmaceutical preparations. The learned Single Judge while dismissing the suit, *inter alia*, returned the finding that both the parties were honest and concurrent users of the said mark. The learned Single Judge also returned a finding that the defendant was the prior adopter of the mark. Neither party had obtained registration of the mark. Consequently, the learned Single Judge had dismissed the suit of the plaintiff/ appellant. The Division Bench dismissed the Regular First Appeal of the plaintiff/ appellant. In this decision, the Division Bench, *inter alia*, held that in an action for passing off, the date of the prior use - and not the date of registration, is the relevant test. The Division Bench also relied upon *Century Traders v. Roshan Lal Duggar & Co. & Ors.*, AIR 1978 Del 250, in this regard.

97. I have found that the plaintiff is the prior user of the mark in question. Consequently, the decision in *Alkem Laboratories Ltd.* (supra) supports the case of the plaintiff, rather than that of the defendant. The defendants have

sought to rely on this decision in support of their plea of honest and concurrent user. However, as already discussed, prima facie, the adoption of the mark in question by the defendants does not appear to be honest. Thus, this decision does not come to the aid of the defendant.

98. In *Pearl Retail Solutions Pvt. Ltd.* (supra), the learned Single Judge confirmed the ad-interim injunction in favour of the plaintiff. The plaintiff was running its business under the mark “Pearl Academy of Fashions”. The defendant claimed that “PEARL” was a generic word. In this regard, the defendant placed reliance on *Skyline Education Institute (Pvt.) Ltd. v. S.L. Vaswani & Anr.*, AIR 2010 SC 3221, wherein the Supreme Court held that the word “SKYLINE” was being used by 117 companies including computer and software companies and institutions and, thus, “SKYLINE” was held to be a generic word. The defendant also claimed that the plaintiff did not have the exclusive right to use the words “Academy of Fashion” in respect of educational institutions. The plaintiff had disclaimed the said words in the registrations obtained by the plaintiff. The learned Single Judge rejected the submission of the defendant that the word “PEARL” was a generic word in respect of education and training institutions. The learned Single Judge observed:

*“15. Having heard learned counsel for the parties, this Court is of the view that the word PEARL cannot be said to be a generic word in respect of education and training institute. In the opinion of this Court, a word may be generic qua a specific business or trade or industry but not across the board for all businesses or trades or industries. For instance, word "Arrow" is a generic word qua archery business but is an arbitrary word qua shoes.*

16. Similarly, PEARL is a generic word qua gems and jewellery business but not with regard to educational business as the said expression has no connection or correlation with education or training services.

17. In *Kirorimal Kashiram Mktg. & Agencies Pvt. Ltd. Vs. Shree Sita Chawal Udyog Mill Tolly Vill*, 2010 (44) PTC 293 (Del.) (DB) the Court after considering the judgment of *Goenka Institute of Education and Research* (supra) has observed as under:-

"5. In our opinion, the learned Single Judge has fallen into an error in declining the grant of interim injunction to the appellant. The overriding aspect in a case such as the present is that deer is a prominent part of the trademark of the appellant. Copying of a prominent part of a trademark leads to deceptive similarity especially when the product of both the parties is the same. The expression "Deer" was arbitrarily adopted by the appellant with respect to its product being rice. A deer has no connection or co- relation with the product namely rice. Such arbitrary adoption of a word mark with respect to a product with which it has no co- relation, is entitled to a very high degree of protection, more so, as the appellant's trademark is a registered trademark. The use by the respondent of its trademark is admittedly subsequent to that of the appellant. The first registration of the appellant is of the year 1985 and then of 1990. The respondent claims the first user only from the year 1999, and, as the later discussion will show, that is also not a correct fact because the user of the respondent is prima facie only from around the year 2003."

18. Consequently, the arbitrary adoption of the word mark PEARL with respect to services with which it has no

*correlation, is entitled to very high degree of protection, especially when the trade mark is a registered trade mark”.*

99. Reliance placed by the defendant on *Skyline Education Institute Pvt. Ltd.* (supra) was rejected, as the admitted position was that a number of other institutes were using the “SKYLINE” mark. The learned Single Judge held:

*“22. In fact, in view of the judgment of this Court in Om Prakash Gupta (supra), plaintiff's trade mark will be limited to the parts of the composite mark which have not been disclaimed.*

*23. This Court is of the opinion that in view of Section 17(2)(a)(i) of the Act in the present case the trade mark PEARL ACADEMY OF FASHION would be read as PEARL alone as ACADEMY OF FASHION has been disclaimed and the word PEARL is a subject matter of separate registration application.*

24. Section 17 of the Act reads as under:-

*"17. Effect of registration of parts of a mark.-(1) When a trade mark consists of several matters, its registration shall confer on the proprietor exclusive right to the use of the trade mark taken as a whole.*

*(2) Notwithstanding anything contained in sub-section (1), when a trade mark--*

*(a) contains any part--*

*(i) which is not the subject of a separate application by the proprietor for registration as a trade mark; or*

*(ii) which is not separately registered by the proprietor as a trade mark; or*

*(b) contains any matter which is common to the trade or is otherwise of a non-distinctive character, the registration*

*thereof shall not confer any exclusive right in the matter forming only a part of the whole of the trade mark so registered.”*

100. The decision in *Pearl Retail Solutions Pvt. Ltd.* (supra), therefore, is of no relevance to the defence of the defendants.

101. In the light of the law stated above, the case of infringement made out by the defendants in their suit may not survive, since the rights conferred upon them by the registration of the said mark, are subject to rights of a prior user which, *prima facie*, the plaintiff is.

102. The defendants' case on passing off also appears to lack merit on account of the plaintiff appearing to be the prior user. The Supreme Court in *Satyam Infoway* (supra) while dealing with a case on passing off held that *“The action is normally available to the owner of a distinctive trademark and the person who, if the word or name is an invented one, invents and uses it. If two trade rivals claim to have individually invented the same mark, then the trader who is able to establish prior user will succeed. The question is, as has been aptly put, who gets these first?”* (emphasis supplied).

103. Though the term “TURNING POINT” exists in the English language to signify a point in time when a decisive change occurs in a person's life - particularly to bring beneficial/positive results, but use of the same for coaching classes by the plaintiff can be considered as distinctive qua such services. Moreover use of the abbreviation ‘TP’ with the words ‘TURNING POINT’ was also the brain child of the plaintiff. This use of the said

distinctive mark by the plaintiff deserves to be protected on account of it being prior in point of time.

104. An application for injunction is decided upon examination of three aspects, viz.: (i) *prima facie* case, (ii) balance of convenience, and (iii) irreparable loss and injury. I have no hesitation in holding, on the basis of the observations made hereinabove, that a *prima facie* case of passing off has been made out in favour of the plaintiff. As regards balance of convenience, this Court in ***Ansul Industries*** (supra) observed that

*“42. While examining the question of balance of convenience, the Courts have also held that where initial adoption itself is fraudulent, subsequent use or even prejudice does not tilt the balance of convenience in favour of a third party. If the initial adoption itself is dishonest, injunction must follow. Fraud or illegal adoption does not become valid and legal. Honesty in adoption must, therefore, be established and proved by the Defendant.*

*43. While examining the question of balance of convenience, Court is required to take into consideration public interest i.e. interest of the buyers and the consumers. If public interest is affected, delay is of no consequence.”*

105. Here, the dishonest adoption of the mark by the defendants; public interest involved in stemming confusion amongst the innocent and gullible public – particularly young students looking to get trained for competitive examinations, and; the rights of the prior user tilt the balance of convenience in favour of the plaintiff. Even though the defendants appear to have encashed the mark in question more than the plaintiff, the comparison of the yearly turnover of the parties does not show that the plaintiff's turnover is miniscule, or insignificant, compared to that of the defendants. The plaintiff,

*prima facie*, is suffering damage in its business due to the use of the impugned mark by the defendants. If injunction is not granted, the plaintiff would suffer irreparable loss and injury. The defendants are running their business also under different names, including, under the mark “PYRAMID CLASSE”. Thus, the defendants are not likely to be very seriously prejudiced by the grant of injunction in favour of the plaintiff forthwith.

106. In view of the aforesaid findings the I.A. No. 16232/2015 is allowed and I.A. No. 22081/2015 is dismissed. The defendants stand enjoined from using the mark “TP Turning Point”, or any part thereof either as a word mark, or the label mark got registered by the defendants in respect of their services of providing coaching/ training classes to students or as a part of their corporate name. The plaintiff shall also be entitled to costs in these applications, which are quantified at Rs.50,000/-. The costs be paid within four weeks.

107. It is clarified that the observations made in this order are based on a *prima facie* view taken by this Court, and the same shall have no bearing on the final decision in the suits, to be decided by the court after a trial on the basis of the evidence adduced.

**(VIPIN SANGHI)**  
**JUDGE**

**AUGUST 11, 2017**