

THE HIGH COURT OF DELHI AT NEW DELHI

% Judgment Reserved on: 26.09.2011
Judgment Pronounced on: 28.09.2011

+ CS(OS) 2364/2011

ST. STEPHEN'S COLLEGE, DELHI **Plaintiff**

Through : Mr. Suhail Dutt, Sr. Adv.
with Mr.K.Sultan Singh, Mr.
V.Hari Pillai, Mr. Manish
Kumar Saryal and Ms.Susha
Unni, Advs.

versus

ST. STEPHEN'S COLLEGE ALUMNI ASSOCIATION & ORS

..... **Defendants**

Through : Mr. Upamanyu Hazarika, Sr.
Adv. with Mr.Sachin Datta,
Ms.Dharitry Phookon, Ms.
Gayatri Verma and Mr.Paul
Roy Panski, Advs.for D-1.
Mr. Pinki Mishra, Sr. Adv.
with Mr.Sachin Datta, Adv.
for D-6 & 7.

CORAM:-

HON'BLE MR JUSTICE V.K. JAIN

1. Whether Reporters of local papers may be allowed to see the judgment? Yes.
2. To be referred to the Reporter or not? Yes.
3. Whether the judgment should be reported in Digest? Yes.

V.K. JAIN, J

IA 15304/2011(O.39 R.1 & 2 CPC)

1. The plaintiff college is a society registered under Societies Registration Act and is a constituent college of

University of Delhi. The plaintiff is a leading educational institution, offering degrees to both undergraduate as well as postgraduate students. The plaintiff college came to be founded on 1st February, 1881. The plaintiff has sponsored a number of societies/clubs, including St. Stephens College Alumni Association, which has been in existence for last 50 years and is an integral part of the plaintiff society. It is alleged that St. Stephen's College Alumni Association on account of their continuous extensive and uninterrupted use have come to be associated with plaintiff and is alumni association. Defendant No. 1 has been formed recently and registered under Societies Registration Act. While obtaining registration, defendant No. 3 filed an affidavit stating therein that there is no society with an identical or resembling name. This affidavit was false to the knowledge of defendant No. 3. Defendant No. 1-society had been founded without any permission from the plaintiff and it is alleged that this is a mala fide act on account of the invitation which the previous principal of the plaintiff had extended to defendant No. 6 to represent the alumni in the Governing Body, having been withdrawn in May, 2011. A cease and desist notice dated 5th September, 2011 was sent

by the plaintiff to the defendants, requiring them to stop using the names “St. Stephens College and/or its derivatives/logo, College Crest and motto. There has however been no response from the defendants who have also created a website <http://ststephensalumni.co.in> Defendant No. 1 has also provided a hyperlink from its website to the website of the plaintiff www.ststephens.edu and it has also been using the College Crest, copyright in which vests solely in the plaintiff since the year 1926. It is alleged that by using the name St. Stephens Alumni College, defendant No. 1 is passing off its activities as those of the alumni association of the plaintiff and is misleading the ex-students of the plaintiff into joining it, believing it to be the recognized and authorized alumni association of the plaintiffs. Defendant No. 1 is also collecting subscription, gifts, donations, etc using the name adopted by it. The plaintiff has sought injunction restraining the defendants from using the name St. Stephens College Alumni Association as also the college crest, motto and logo and from representing themselves as an alumni association of the plaintiff. They have also sought injunction, restraining the defendants from receiving any subscription or collecting

any donations or grant for the membership of defendant No. 1-society. They have sought a further injunction against defendant No. 1 interfering in the association, management and affairs of the plaintiff college.

2. It can hardly be disputed that if a company or a society adopts a name, which is so similar to the name of the plaintiff as is likely to deceive or to cause confusion, a Civil Court has jurisdiction, under common law, to grant an injunction against use of such a name by the defendant, so as to ensure that the defendant is not able to pass off its business and activities as those of the plaintiff and is not able to encash upon the goodwill and reputation which the plaintiff-company/society enjoys. In such a case, it would also be in public interest to grant injunction against use of a name which is likely to deceive or cause confusion so as to protect the interest of the persons who are likely to be confused on account of similarity of the two names. It is true that no person has an exclusive right in a particular name or title except to the extent such a right is conferred by Statutes such as Trademarks Act and Companies Act, but, a person carrying business or other activity under a particular name is entitled to seek protection against

adoption and use of such or similar name by another person where he is able to satisfy the Court that a damage has been caused or is likely to be caused to him or his reputation on account of the confusion which is likely to be caused in the mind of the public due to of the same or similar name by another person.

3. When this matter came up for hearing for the first time on 23rd September, 2011, there was representation on behalf of the defendants. Arguments on the application were heard on that day as well as on 26th September, 2011. During the course of arguments, the learned counsel for the defendants very fairly stated that the defendants are agreeable not to use the name St. Stephens College Alumni Association and are ready to use any of the following four alternative names, suggested by them; (a) Old Stephanian's Association; (b) Stephanians; (c) Association of Stephanians's (d) Association of Old Stephanians. He also stated that defendant No.1 is ready to put a disclaimer on its website stating therein that it is not the recognized/authorized alumni association of the St. Stephens College, Delhi, it has no connection with St. Stephens College, Delhi or its official/authorized alumni

association. This, however, was not acceptable to the plaintiff, who maintained that the defendants despite being former students of St. Stephens College, Delhi cannot use the words “St. Stephens College” “St. Stephens” or “Stephanians”.

4. Prima facie, it appears to me that use of the name Association of Old Stephanians by defendant No. 1, coupled with the disclaimer or the lines proposed by the learned counsel for the defendants would ensure that no ex-Stephanian is confused as to which is the officially recognized/approved alumni association of St. Stephens College, Delhi and there would be no reasonable possibility of any ex- Stephanians mistaking defendant No.1-society as the official/recognized alumni association of St. Stephens College, Delhi.

It is not in dispute that defendants 2 to 8 are former students of St. Stephens College, Delhi. This is a fundamental right, guaranteed by Article 19 (1)(c) of the Constitution to every citizen, including those who have studied in St. Stephens College, to form an association. Hence, defendants 2 to 8 were well within their constitutional right in forming an association even if that

association is to consist wholly of ex- Stephanians. If they have a right to form an association, they also have to necessarily give a name to it. During the course of arguments, I was informed that the membership of defendant No. 1 is open only to those who have been the students of St. Stephens College, Delhi. Hence, there should be no valid objection to their using the word stephanian as a part of the name of the society since being an old stephanian is the only common link amongst the members of the society. It is their having been students of St. Stephens College, Delhi which has brought them together and prompted them to form defendant No.1 society. Everyone, who has studied at St. Stephens College, Delhi can claim, as a matter of right, to describe himself as a stephanian and this right comes to him on account of having been a student of the college. Therefore, use of the word stephanian as a part of the name of the society cannot be objected at all.

In a matter of passing off what is relevant is whether there is any likelihood of the defendant being able to pass off its goods/services as those of the plaintiff. The name being used by the plaintiff for its alumni i.e. St.

Stephens College Alumni Association and the name 'Association of Old Stephanians', cannot be said to be similar, nearly similar or even resembling each other. There is no use of the expression St. Stephens College in the name "Association of Old Stephanians". The name does not convey an impression that it is the official/approved by College alumni association of St. Stephens College. The impression it conveys is that this is an association formed by those who have, in the past, been students of St. Stephens College.

5. The Court has to keep in mind that the membership of defendant No. 1-Association is open only to those who have been students of St. Stephens College, Delhi. Considering the background, education, level of awareness and credentials of those who have studied at St. Stephens College, Delhi, it is most unlikely that they can be misled into believing that Association of Old Stephanians is the officially sponsored/recognized/affiliated alumni Association of St. Stephens College, Delhi. Added to this would be the disclaimer on the website of defendant No. 1 which would convey in no uncertain terms that this association has no link or connection of any nature

whatsoever either with St. Stephens College or with its official alumni association. Also, nothing prevents the plaintiff-society from putting an appropriate notice on its website with respect to defendant No. 1-society and addressing individual communications to all the ex-students informing them that defendant No. 1-association has neither been recognized by it nor is this, in any manner, affiliated with the college or its official alumni association.

6. Of course, if defendant No. 1 has to change its name, it has necessarily to change the domain name being used by it and it cannot continue to use the name saintstephens.co.in. The name St. Stephens College Alumni Association cannot be used by the defendants for any purpose at all, including for the promotional promotion and expansion of defendant No. 1-society. Also, the defendants have no right to use the official crest/logo and motto of St. Stephens College on their website, stationery or in any other manner.

7. The learned counsel for the plaintiff has relied upon **International Association of Lions Clubs vs. National Association of Indian Lions & Ors, 2006 (33) PTC 79 (Bom).**, **U. Srinivas Malliah and another v. Krishna**

Kumar Chatterjee and Ors. AIR 1952 Calcutta 804, Ruston & Hornsby Ltd. vs. The Zamindara Engineering Co. AIR 1970 SC 1649, interim order dated 06th June, 2002 passed by this Court in Suit No. 1061/2002 **President & Fellows of Harvard College vs. Mr Harbans S. Bawa.**

8. In **International Association of Lions Clubs** (supra), the plaintiff Association of Lions Clubs was set up for organizing, chartering and supervising various service clubs known as "Lions Clubs", to co-ordinate the activities and to standardize the administration of these clubs. The plaintiff was using the mark Lion, Lions and Leo in relation to their services and their club along with the emblem mark which had picture of lion on it. Defendants adopted the words lions and were also found using an emblem similar to that of plaintiffs. They were also using the domain name www.indianlions.org.bizli.com. Defendant No. 1-society was describing itself as a national society of Indian Lions. It was contended on behalf of the defendant that it was a registered society and its Memorandum and Articles permitted it to use the word Lion, Lioness and Leo and it was not open to the plaintiff to seek injunction restraining them from using the said words as a name of a society

which was permitted by Rajasthan Cooperative Societies Act. The contention, however, was rejected holding that mere registration under Companies Act or under the Cooperative Societies Act does not confer any right to use the name of such a nature which is also a trade name or organization name of some other person. Since the defendants are no more insisting on the use of the name under which defendant No.1-society has been registered and consequently there is no use of the expression “St. Stephens College”, or even “St. Stephens” in the new names proposed by them and also considering the fact that the membership of defendant No. 1 is only open to those who are ex- Stephanians, this judgment can be of no help to the plaintiff before this Court.

In **President & Fellows of Harvard College** (supra), the defendant who was an alumni of Harvard Business School had without permission of the plaintiff established an institution by the name of Harvard Business Research and Education Foundation. The defendant was using the letter head which showed the crest of Harvard Business School with a logo/seal in which one of the several registered shields of the plaintiff had been used. This Court

passed an ex parte interim order restraining the defendant from using or passing off the trade name Harvard or from acting or dealing under the trade mark/name of the plaintiff or any other mark/name which could be similar or deceptively similar to the trade mark of the plaintiff as also from offering any educational material/publication under the name Harvard/Harvard Business School. It would thus be seen that the defendant in that case was using the word Harvard which is a name that had come to be identified with Harvard College, as a part of the name of an institution set up by him for imparting education. The defendant was attracting prospective students by use of the slogan “If you can’t go to Harvard—we bring Harvard Education to you”. He had obtained Harvard teaching material and intended to use that material as a part of its course. The Court felt that if the defendant was not restrained from doing so, the public at large was likely to be drawn in by the apparent misrepresentation of the defendant. The facts of the case before this Court are clearly distinguishable since neither the defendants are now insisting on using the name St. Stephens College or even St. Stephens as a part of the name of defendant No. 1 nor are they seeking to exploit the name

of the plaintiff college for a commercial purpose. They being the former students of St. Stephens College, Delhi, they need to use some such word as would indicate that they are a society formed by the persons who have been the students of St. Stephens College, Delhi. This becomes more necessary considering the fact that the membership of defendant No. 1-society is open only to those who have been the students of St. Stephens College, Delhi.

In **Ruston & Hornsby Ltd.** (supra), which was a case of infringement, the defendant was found using the word "RUSTAN" of the plaintiff and the "RUSTAM" of the defendant and, therefore, it was held that the use of the word RUSTAM by the respondent constituted infringement of the appellant's trade mark "RUSTON" being deceptively similar. The Court was of the view that mere addition of word India to the trademark of the respondent was of no consequence in such a use.

During the course of the judgment, the Court observed that the gist of passing off action is that A is not entitled to represent his goods as goods of B and it is enough if there is probability of confusion and no case of actual deception or actual damage needs to be proved. As

noted earlier, this is not a case of the infringement. Moreover, use of the name Association of Old Stephanians, to my mind, ensures that there is no probability of ex-stephenians getting confused and mistaking defendant No. 1-society as the official alumni of St. Stephens College.

In **U. Srinivas Malliah** (supra), it was found that the defendants had applied for registration for a society under the name of Indian National Congress. It was noted by the Court that Indian National Congress was an old organization which is an institution having worldwide reputation and had one crore members with branches in various parts of the country. It was also noticed that substantial portion of funds of Indian National Congress came by way of donations and subscriptions. In these circumstances, the Court felt that there was every possibility of a confusion in the mind of the public to the effect that the society of the defendants was a branch of and was sponsored by Indian National Congress. The Court felt that if the society proposed to be set up by the defendants became involved in pecuniary difficulties or was guilty of any misdeeds the same was likely to reflect discredit upon Indian National Congress. It was also felt that many

persons may get enrolled as member of the proposed society with a feeling that they will get all the benefits and advantages of congress membership, without having to pay any subscription for the membership of the Society and this, in turn, was likely to deprive Indian National Congress of the subscriptions which these persons would have paid had they become its members. In that case, the defendants, when asked as to how they had taken a fancy for this name for their Society, had no explanation to offer and the Court, therefore, felt that their intention was to injure and cause damage to the plaintiffs which by itself sufficient to grant injunction. Again, the facts of the case before this Court being altogether different and there being no reasonable likelihood of the persons, who can become members of defendant No. 1-society becoming its members under a mistaken belief that they are becoming member of the official alumni association of St. Stephens College, Delhi, there is no reasonable likelihood of defendant No. 1 passing off its services as those of the official alumni association of the plaintiff.

9. The learned counsel for the plaintiff has also submitted copies of the decision of this Court in **M/s**

Helpage India, vs. M/s Helpage Garhwal, AIR 2001 Delhi 499, **Dr. Reddy's Laboratories Ltd. vs. Reddy Pharmaceuticals Limited** 2004 (76) DRJ 616, **British Diabetic Association v. Diabetic Society Ltd and Others** (1995) 4 All England Law Reports and **Burge v. Haycock** (2002) RPC 28. However, since these judgments were not referred during arguments and are otherwise distinguishable on facts, I need not analyze them. Suffice it to note that in the case of **M/s Helpage India** (supra), the name of the defendant was almost identical to that of the plaintiff, being Helpage Garhwal as against the name Helpage India of the plaintiff, whereas in the case of **Dr. Reddy's Laboratories Ltd.** (supra), the plaintiff was marketing its drugs under the trade name Dr. Reddy's whereas the defendant was using the trademark Reddy claiming that it was entitled to use the trademark Reddy since its Managing Director was one Mr Reddy.

10. During the course of arguments, it was contended by the learned counsel for the defendants that the name St. Stephens College is being used by a number of institutions, including St. Stephen's Collge, Uzhavoor, Kottayam, Kerala, St. Stephen's College Pathanapuram, Kerala, St. Stephens

College of Education for Women, Madurai Address: Hosanna Mount, Kadavur, Chatrapatti Post, New Natham Road, Madurai, St. Stephen College of Teacher Education, Kanyakumari Address: Velayudha, nagar, Kollemcode, P.O. Kanyakumari, St. Stephens School, Pitampura, Delhi, St. Stephen's Higher Secondary School, Dahod, Gujarat, St. Stephen's School, North Kolkata, Kolkata, St. Stephen's School, Sector 45 B, Chandigarh, as an essential part of their name and no action has been taken by the plaintiff to stop user of such name by those institutions, which amounts to the plaintiff waiving its right to exclusive use of the name St. Stephens College and also indicates that the defendants are being targeted for using the name adopted by them, only because they have criticized the functioning of the present principal of the college. This, however, was refuted by the learned counsel for the plaintiff, who stated that all these institutions are using the expression St. Stephens College as a part of their name with the consent of the plaintiff since they are being managed/run by the same persons who are managing St. Stephens College, Delhi. It would be pertinent to note that St. Stephens College is a society registered under Societies Registration Act. When

asked as to whether the plaintiff-society had passed a resolution authorizing these institutions to use the name St. Stephens College as a part of their name or had otherwise issued any written authorization to them in this regard, no such resolution/authorization was claimed by him. I, however, need not delve further into this aspect of the matter since the defendants have agreed to change the name of defendant No. 1-society.

For the reasons given in the preceding paragraphs, defendant No. 1 is restrained from using the name St. Stephens College Alumni Association. It is also restrained from using the official crest, logo or motto of St. Stephens College, Delhi as also the domain name <http://ststephensalumni.co.in>. Defendant No. 1, however, will be entitled to use the name 'Association of Old Stephanians', subject to the condition that it will display an appropriate disclaimer on its website, as and when it is started under a new domain name, that it is not the official/approved/recognized alumni association of St. Stephens College and it has no connection or affiliation either with St. Stephens College, Delhi or St. Stephens College Alumni Association.

The application stands disposed of in terms of this order.

CS(OS) 2364/2011

Written statement be filed within the prescribed period. Replication can be filed within four weeks.

List before Joint Registrar on 18th November, 2011 for admission/denial of documents and before Court for framing of issues on 04th April, 2012.

**(V.K. JAIN)
JUDGE**

SEPTEMBER 28, 2011/bg