

**DPS World Foundation barred from piggybacking on Delhi Public School's reputation
India - Nishith Desai Associates**

**Examination/opposition
Infringement
Passing off**

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The Delhi Public School Society has run schools and educational institutions in Delhi and throughout India under the name Delhi Public School since 1948. It has successfully established 11 core schools in India and is affiliated with 170 schools in India and 15 schools worldwide, which comprise approximately 300,000 students. The Delhi Public School Society is the registered proprietor of the trademark DPS, which covers several relevant classes except Class 41, for which registration is still pending. It also applied for registration of the trademark DELHI PUBLIC SCHOOL (in Classes 16, 35, 36, 41 and 42) on March 8 2011. The Delhi Public School Society also uses two crest logos. One – a registered trademark, which it has claimed to use since 1948 – comprising of a hand holding a torch, the school motto “Service before Self” and the words “Delhi Public School” written inside a shield. The other – a logo adopted in 1996 – comprising of a torch on a book along with the school motto written inside a shield surrounded by a creeper and the words “Delhi Public School” written below.

DPS World Foundation is a trust whose founder was a life member of the Delhi Public School Society until October 17 2015 and its president from 1994 to 2004. The Delhi Public School Society alleged that DPS World Foundation was operating in the same market under the trademark DPS WORLD FOUNDATION, which conflicted with its mark. Further, the Delhi Public School Society alleged that DPS World Foundation had used a crest deceptively similar to one of Delhi Public School's crests. The plaintiff became aware of the defendant's conflicting mark in July 2015. A show cause notice was immediately served by the Delhi Public School Society calling on DPS World Foundation's founder to illustrate why an action should not be taken against him for having clandestine association with the creation of the defendant trust and the adoption of the disputed trademarks. Subsequently, the Delhi Public School Society filed a suit against DPS World Foundation and its founder for infringement and passing off.

At the interim stage, the Delhi High Court observed that the trademark DPS was the Delhi Public School Society's registered trademark under the Trademark Act 1999 and that the use of the word DPS in the trade name DPS World Foundation and DPS World School infringed the plaintiff's rights under Section 29 of the act. However, the court rejected the contention that DPS World Foundation's crest was identical to that of the plaintiff. The defendants filed an appeal against the interim order.

During the appeal, DPS World Foundation and its founder contended that:

- the trust had been set up by Delhi Public School alumni and its members had *bona fide* intentions in using DPS as part of the school name. Further, the materials published and circulated by them were accompanied by a prominent disclaimer stating that they were “A Dipsites Knowledge Initiative and an independent effort of DPS Alumni (Dipsites). Not a part of Delhi Public School Society, New Delhi”;
- more than 200 schools were operating under the name Delhi Public School/DPS and using the plaintiff's crest without authority. Thus, it should be held that the trademark DPS had been diluted and was *publici juris* (ie, of public right); and
- the Delhi Public School Society had registered DELHI PUBLIC SCHOOL under Classes 16, 35, 36 and 42, but had no registration for the acronym DPS in Class 41 (ie, the class relevant for educational services). Thus trademark protection under Section 29(4) of the Trademark Act did not apply.

The Delhi Public School Society contended that:

- DPS World Foundation's adoption of the trademark DPS was clearly dishonest and the injunction had thus been rightly granted by the single judge in its favour;
- apart from the infringement, DPS World Foundation was also liable for passing off, as the adoption of the trademark DPS was done to piggyback on the Delhi Public School Society's reputation and goodwill and wrongly convince the public at large that there was a connection between the two entities; and
- DPS World Foundation had not complied with the impugned order dated April 18 2016 and had continued to violate the order by using the disputed trademark. It was thus in contempt and could not be heard in appeal.

The Delhi High Court Division Bench rejected the appeal, but held that even though the trademark DPS was

not registered in Class 41, the Delhi Public School Society could not be barred from claiming common law protection of its trademark, especially in view of the fact that it was registered in Classes 16, 35, 36 and 42. Thus, DPS World Foundation and its use of DPS in its trade name was an infringement under Section 29 of the Trademarks Act. Further, the court held that while no Delhi Public School Society school had ever been called DPS, the term DPS is an acronym of Delhi Public School used for the purpose of convenience and no evidence was found that any harm to its reputation or goodwill had been caused by the adoption of the infringing trademark. DPS was found to be the Delhi Public School Society's registered trademark and was therefore entitled to statutory protection. Lastly, it was found that the trademark DELHI PUBLIC SCHOOL was not registered and contained separate words 'Delhi' 'Public' and 'School', in respect of which the plaintiff could not seek exclusive rights for passing-off purposes. As a result, it was found that DPS World Foundation could adopt a trade name including the words 'Delhi' 'Public' and 'School', but could not use the registered trademark DPS in any manner whatsoever.

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