

World Trademark Review Daily

**Former students may not use college name for non-official alumni association
India - Nishith Desai Associates**

Passing off

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In *St Stephens College, Delhi v St Stephens College Alumni Association* (CS(OS) 2364/2011), the Delhi High Court has issued an injunction restraining the defendants - members of the St Stephens College Alumni Association - from using a name for their organisation that might create an association with plaintiff *St Stephens College*, and from using the official crest, logo, motto and domain name of the plaintiff.

The plaintiff is a leading and renowned educational institution in Delhi. The defendants, former students of the plaintiff, formed the defendant association and subsequently registered it as a society. At the time of registration, they submitted an affidavit stating that there were no other societies with identical or similar names.

The plaintiff, alleging that this was a bad-faith act on the part of the defendants, filed an action for passing off, seeking an injunction restraining the defendants from:

- using their current name, as well as the plaintiff's crest, motto and logo;
- representing themselves as the alumni association of the plaintiff; and
- operating their website at 'ststephensalumni.co.in'.

Notably, the plaintiff had not registered its name as a trademark.

In support of its claims, the plaintiff set forth the following arguments, among others:

- The defendants had not replied to a cease and desist notice requiring that they stop using the name St Stephens and/or derivatives thereof, as well as the plaintiff's crest and motto, and had not stopped their activities following receipt of the notice.
- The defendants were passing off their activities as those of the plaintiff's official alumni association and were misleading former students into joining them under the belief that the defendant society was the official alumni association.
- The defendants had bad-faith intentions, as their website used the crest of the plaintiff (in which the plaintiff claimed to have copyright). Further, the defendants' website provided a hyperlink to the plaintiff's website.

In response, the defendants contended as follows:

- Several other institutions were using the name St Stephen's and, therefore, the plaintiff had effectively waived its "right to the exclusive use of the name St Stephens College".
- They were not using the plaintiff's name for commercial purposes.
- They were willing to stop using their current name and suggested four alternatives: Old Stephanians Association, Stephanians, Association of Stephanians and Association of Old Stephanians. They were also willing to add a disclaimer to their website stating that they were not the registered/authorised alumni association of the plaintiff and had no connection with the plaintiff or its official alumni association.

Based on the arguments of the parties, and relying on well-established case law, the court accepted that use of the name Association of Old Stephanians by the defendants, together with a disclaimer, was sufficient to ensure that former students of the plaintiff would not be confused as to the identity of the official alumni association. The court made the following observations in support of this conclusion:

- The defendants had a fundamental right, under the [Constitution of India](#), to form an association consisting of former students of the plaintiff.
- Since membership to the association was restricted, the defendants had a right to describe themselves as 'Stephanians' and could use the word 'Stephanian' as part of the name of their society.
- The name Association of Stephanians was not similar to the name of the plaintiff, since the words 'St Stephens College' were absent. Accordingly, it did not convey the impression that it was the official alumni association of the plaintiff; rather, it gave the impression that it was an association formed by former students of the plaintiff.
- Considering the educational background, level of awareness and credentials of the plaintiff's students, it was highly unlikely that they could be misled into believing that the Association of Stephanians

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was the official alumni association of the plaintiff. Moreover, the absence of connection between the defendant association and the plaintiff or its official alumni association could be highlighted in the proposed disclaimer and actions could be taken by the plaintiff to make it clear that there was no connection (eg, by putting a notice on its website and by communicating with former students individually).

- The defendants had a just and valid association with the plaintiff. They were not using the name of the plaintiff (assuming that the name Association of Old Stephanians was adopted) and did not seek to exploit it for commercial purposes. Because they were former students of the plaintiff, it was essential for them to use a name which would indicate that membership to the association was open only to former students.

Consequently, the court issued an injunction restraining the defendants from using the current name of their association, as well as the plaintiff's official crest, logo and motto, and the domain name containing the name of the plaintiff. However, it allowed the defendants to use the name Association of Old Stephanians, provided that they include an appropriately worded disclaimer on their website.

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