



2025:DHC:8654-DB



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

Reserved on: 22.07.2025
Pronounced on: 26.09.2025

+ **FAO(OS) (COMM) 239/2023 & CM APPL. 56185/2023, CM APPL. 56186/2023**

THE TRUSTEES OF PRINCETON UNIVERSITY

.....Appellant

**Through: Mr.Chander M. Lall, Sr. Adv.
with Ms.Nancy Roy,
Ms.Ananya Chug and
Ms.Annanya Mehan, Advs.**

versus

THE VAGDEVI EDUCATIONAL SOCIETY & ORS.

.....Respondents

**Through: Mr.J. Sai Deepak, Sr. Adv. with
Mr.Avinash Kumar Sharma,
Mr.P. Mohith Rao and
Mr.Eugene S. Philomene, Advs.
for R-1 to R-7**

CORAM:

HON'BLE MR. JUSTICE NAVIN CHAWLA

HON'BLE MS. JUSTICE RENU BHATNAGAR

J U D G M E N T

NAVIN CHAWLA, J.

1. This appeal has been filed, challenging the Judgment dated 06.09.2023 passed by the learned Single Judge of this Court in I.A. 6494/2022 in CS(COMM) 270/2022, titled *The Trustees of Princeton University v. The Vagdevi Educational Society & Ors.*, whereby the

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learned Single Judge has dismissed the said application filed by the appellant under Order XXXIX Rules 1 and 2 of the Code of Civil Procedure, 1908 (in short, 'CPC') *inter alia* praying for an *ex parte ad interim* injunction against the respondents herein, restraining them from using the mark 'PRINCETON/PRINCETON UNIVERSITY'.

Case of the appellant:

2. It is the case of the appellant that it was founded in the year 1746 as the College of New Jersey, and is the fourth oldest institution of higher education in the United States. In the year 1896, the appellant educational institution achieved University status and was officially renamed '*Princeton University*'. It is currently a private research and educational University located in Princeton, New Jersey, and a member of the prestigious and world famous Ivy League of schools. It has close to 1300 faculty members, over 5200 undergraduate students and over 2900 graduate students. It offers various degree programs to its students ranging from subjects in the field of Arts to Science and Technology/Engineering, along with an opportunity to participate in certificate programs, often in interdisciplinary field.

3. The appellant further asserts that it offers study abroad/internship programs to its students and conducts global seminars in association with different institutions around the world, which gives its students an opportunity to expand and deepen their education by studying or working overseas, including in India, like Novogratz Bridge Year Program, based in the city of Udaipur,



4. It is further asserted that the appellant receives applications from students around the world, including India. It is asserted that in the academic year 2021-2022, over 160 students holding Indian citizenship have been enrolled in their courses.

5. It is further asserted that the appellant has been ranked No. 1 for eleven years in a row in the category of “Best National University” in the United States, by U.S. News and World Report. Its alumni consists of prominent personalities from different walks of life, like the former President of the United States of America, U.S. Supreme Court Justices, Noble Laureates, industry and media tycoons and foreign heads of State.

6. It is asserted that the appellant owns and operates its website ‘www.princeton.edu’, which was created on 03.04.1987 and is a one-stop destination that provides information about the appellant’s educational institution and degree programs, and is accessible around the world, including in India.

7. It is the case of the appellant that around January 2020, it came across the respondents website www.princetonschoolofeducation.com, and the use of the Mark for education services by the respondents herein. It is averred that after making inquiry *via* emails, and various legal notices addressed to the respondents, the appellants got to know that the respondents have obtained affiliation from a reputed public State University, that is, Osmania University.



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8. It was contended that the respondents, being in the identical type of services as the appellant, ought to have prior knowledge of the appellant and its earlier Well-Known Trade Mark PRINCETON



(hereinafter referred to as the 'Appellant's Mark').

9. It is contended that the Appellant's Mark has also been registered in India, and certificate for the same was issued on 06.12.2016 under Class 16 and Class 25, and on 23.08.2018 under Class 41. The applications for seeking registration were filed by the appellant on 28.09.2012.

10. It is the case of the appellant that the use of the Impugned Mark by the respondents is likely to confuse the consumers about the origin of the respondents' services. Consumers are also likely to mistakenly associate the services of the respondents with those of the appellant. The respondents, without due cause and without the authorization of the appellant, are unfairly trading upon the reputation and goodwill that has vested in the appellant's intellectual properties. It is averred that such misuse by the respondents is not only likely to dilute the distinctive character of the appellant's earlier Well-Known Trade Mark, but also amounts to unfair competition.

Case of the respondents:

11. The respondents filed a common written statement before the learned Single Judge, where they contended that the respondent no.1



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educational society has been constituted under the provisions of the Societies Registration Act, 1860 by various like-minded people, *vide* registration No. 380 of 1991, dated 31.01.1991. The said Society and its affiliate colleges have carved a niche reputation for itself in the sector of education, in and around Hyderabad and Ranga Reddy Districts of Telangana.

12. It is the case of the respondents that the respondent no.1 society established many colleges and societies, and named it Princeton, as an ode to the Prince of Hyderabad and his farsightedness. Furthermore, respondents wanted to educate and groom thousands (denoted by the word ton) of Princes and Princesses (denoted by the word Prince),



thereby, naming their Colleges- Princeton with logo (hereinafter referred to as the 'Respondents' Mark/ Impugned Mark').

13. It is the case of the respondents that the respondents have not infringed upon the intellectual property rights of the appellant, as the logo of respondents is entirely different.

14. It is contended by the respondents that the appellant has suppressed that it had submitted an application bearing No. 2402523 dated 28.09.2012 under Class 16, and application bearing No. 2402525 dated 28.09.2012 under Class 41, in the name of M/s. Trustees of Princeton University, for the registration of their trade mark in India, however, the same was objected by the Registrar of Trade Marks *vide* its letter dated 23.10.2013 (against the application made under Class 16) and *vide* its letter dated 13.08.2014 (against the



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application made under Class 41), on the ground that similar trade marks are already on the Register for the same or similar goods / services under Classes 16 and 41 respectively, in the name of Princeton Academy, Mumbai -II Pvt. Ltd. The appellant, however, has taken a letter of consent dated 24.09.2014 from Princeton Academy, Mumbai-II Pvt. Ltd., giving their consent to the use and registration of the appellant's Marks in Classes 16 and 41, respectively, in respect of the various goods and services covered under the said trade mark application. It is asserted that, therefore, the appellant is aware that it has no exclusive right over the word "PRINCETON". In fact, there are various other entities also which use the word "PRINCETON" as a part of their mark.

15. It is the case of the respondents that they have been in existence since the year 1991, and much before the Appellant's Mark was registered in India in the year 2012. It is further averred that 'PRINCETON', as a name of the place has no geographical indicator or significance and the said name exists for at least 30 plus places / districts across various states in United States of America, 3 places / districts in Canada, One place in Antarctica, and around 20 plus Educational Institutions across United States, Canada, India, and other countries.

16. It is the case of the respondents that neither the respondents nor the representatives or employees of the respondents have made any misrepresentation that it is in any way affiliated to or is a part of the appellant University. It is asserted that not only the marks of the appellant and the respondents different, but also because of the



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difference in their fee structure etc., there is no possibility of any person being confused.

Impugned Order:

17. As noted hereinabove, the learned Single Judge has dismissed the application filed by the appellant seeking interim injunction against the respondents from using the mark 'Princeton'/Princeton University.

18. The learned Single Judge in the Impugned Order has observed that the material placed on record by the appellant for showing the use of its mark in India, cannot be accepted as it is not showing the use of the mark by the appellant itself, but by others. The learned Single Judge held that the 'use of a mark' defined in Section 2(2)(c)(ii) of the Trade Marks Act, 1999 (hereinafter referred to as the, 'Act') read with Section 29(6) of the Act, has to be by the appellant/proprietor of the mark and not by a third party.

19. The learned Single Judge has further held that the use of the mark by the respondents in India is prior to the use of the mark by the appellant. It has held that the appellant, to deny the benefit of Section 34 of the Act to the respondents, has to show not only use, but continuous use, of the mark by itself in India, which the appellant has failed to do. The respondents, therefore, are entitled to protection under Section 34 of the Act.

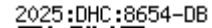
20. The learned Single Judge has further held that though the mark is being used by the appellant and the respondents in the context of providing educational services, it would be facile and plainly



21. The learned Single Judge has further held that the respondents have been using the mark since 1991, and the suit was instituted by the appellant only in 2022. No element of public interest can be said to exist in denying to the respondents a right to further use the mark as part of the names of the institutions, and no substantial case of irreparable loss being suffered by the appellant as a consequence of use of the mark by the respondents has been made out.

Submissions by the learned senior counsel for the appellant:

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24. He submits that the use of the mark does not specifically have to be in form of an educational institution being run by the appellant in India, but could be in several other forms, including but not limited to newspapers, articles, publications, information about services being



offered to Indian citizens, website of the appellant, etc. He submits that the learned Single Judge has failed to appreciate the purport of Section 2(2)(c)(ii) of the Act, which does not require availability of services within India.

25. He submits that the date of user of the mark declared by the proprietor while obtaining registration of the mark, should not be considered so sacrosanct so as to, even where the proprietor is able to show the user of the mark from the date anterior to the one declared at the time of registration, act as an estoppel against the proprietor of the mark. In support, he places reliance on the Judgment of this Court in *Intellectual Property Attorneys Association v. Union of India & Anr.*, 2014 SCC OnLine Del 1912.

26. He submits that the learned Single Judge has also erred in interpreting Section 34 of the Act while holding that for the benefit of Section 34 of the Act to be applied, it is for the appellant to show the continuous use of the mark prior to the use by the infringer. He submits that, on the contrary, it is the infringer who has to show continuous prior use of the mark to that of the first use by the proprietor. In this regard, he places reliance on the Judgment of this Court in *Century Traders v. Roshan Lal Duggar & Co.*, 1977 SCC OnLine Del 50.

27. He further submits that the learned Single Judge has further erred in holding that though the marks are identical and used for the same services, the consumers would not be confused by the use of the infringing mark by the respondents. The learned Single Judge failed to appreciate that the respondents are guilty of initial interest confusion,



and mere use of a different logo cannot justify the use of the identical mark by the respondents. In support, he places reliance on the Judgment of the Supreme Court in ***Baker Hughes Ltd. & Anr. v. Hiroo Khushlani & Anr.***, (2004) 12 SCC 628.

28. He further submits that the learned Single Judge has erred in denying the relief to the appellant only on the ground that the respondents have been using the mark for close to three decades. The learned Single Judge failed to appreciate that the appellant learnt of the use of the mark by the respondents only sometime in 2020, and thereafter, immediately sent a cease and desist notice to the respondents. He submits that thereafter the delay was because of COVID-19 pandemic. In any case, delay cannot be a ground for denial of injunction where the adoption of the mark by the respondents is with bad faith. In support, he places reliance on the Judgment of the Supreme Court in ***Midas Hygiene Industries (P) Ltd. & Anr. v. Sudhir Bhatia & Ors.***, (2004) 3 SCC 90.

Submissions by the learned senior counsel for the respondents:

29. On the other hand, the learned senior counsel for the respondents submits that this Court would not substitute its view with that of the learned Single Judge, unless the view of the learned Single Judge is found to be such that it could not have been reached in the given set of evidence.

30. He submits that the appellant had clearly and unequivocally given up its claim based on trans-boarder reputation. It cannot therefore, be allowed to agitate its claim in the appeal on the basis of



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trans-border reputation nor can such concession be allowed to be withdrawn. In this regard, he places reliance on the Judgments of Supreme Court in *State of Maharashtra v. R.S. Nayak & Anr.*, (1982) 2 SCC 463, *Registrar Osmania University & Anr. v. K. Jyoti Lakshmi*, (2000) 9 SCC 177, and *Jagvir Singh & Ors. v. State*, (2007) 5 SCC 359.

31. He further submits that the basic principle applicable to a trade mark is the principle of territoriality. In the present case, the appellant has failed to show any use of its mark in India. Mere existence of its reputation in USA is, therefore, not sufficient to grant an injunction in its favour. In support, he places reliance on the judgment of the Supreme Court in *Toyota Jidosha v. Prius Auto & Ors.*, (2018) 2 SCC 1, and of this Court in *Bolt Technology v. Ujoy & Anr.*, 2023 SCC OnLine Del 7565.

32. He further submits that the learned Single Judge has rightly interpreted Section 34 of the Act, inasmuch as, it is not denied by the appellant that the respondents have been using the Impugned Mark prior to the registration of the Appellant's Mark in India. The appellant, in its own trade mark registration application dated 29.08.2012, had claimed user of the Appellant's Mark only since 30.04.1996, that is, much after the use of the Impugned Mark by the respondents. This was reiterated by the appellant in its reply dated 02.07.2015, filed in response to the trade marks registry's objections. The appellant, therefore, cannot even be treated as a prior user of the mark in India. He submits that the respondents, therefore, are the proprietor of the mark in India. In support, he places reliance on the



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Judgments in *S Syed Mohideen v. P. Sulochana Bai*, (2016) 2 SCC 683, and *Neon Laboratories v. Medical Technologies & Ors.*, (2016) 2 SCC 672.

33. He further submits that the learned Single Judge has rightly held that the evidence produced by the appellant is not of use of the trade mark by the appellant itself, but, at best, can be considered as the use of the trade mark by others who are unconnected with the appellant. The same, therefore, cannot suffice for the purposes of Section 34 of the Act. He submits that the term 'use' in Section 34 of the Act is narrower than its definition in Section 2(2)(c) of the Act, and is confined only to the use as a trade mark by the proprietor of the mark. In any case, for purposes of 'services', the same must be available in India for satisfying the test of Section 34 of the Act.

34. He further submits that the appellant, to overcome the objections raised by the Registry, while seeking registration of its mark, *vide* a reply dated 02.07.2015, took a stand that its mark is not similar to the mark cited, as the mark of the appellant is a combination of unique logo along with the word 'Princeton'. However, in the present proceedings, it is the appellant's case that the use of word 'Princeton' by the respondents, even with the unique and distinct logo, would be deceptively similar and is likely to cause confusion. The appellant cannot be allowed to approbate and reprobate from its stand in this regard.

35. Similarly, in the trade mark application, the appellant has claimed that it has been using the mark since 03.04.1996, however, in the present proceedings, the appellant incorrectly claims that it has



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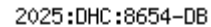


been using the mark since 1911, only to overcome the respondents prior use claim. He submits that the appellant cannot be allowed to deviate from its stand taken before the Registry. In this regard, he places reliance on the judgments of this Court in **Raman Kwatra v. KEI Industries**, 2023 SCC OnLine Del 38, **Modern Snacks v. Modern Foods**, 2023 SCC OnLine 3972, **Vasundhra Jewellers (P) Ltd. v. Kirat Vinodbhai Jadvani**, 2022 SCC OnLine Del 3370, and **PEPS Industries (P) Ltd. v. Kurlon Ltd.**, 2022 SCC OnLine Del 3275.

36. He submits that the respondents cannot be held liable for passing off inasmuch as the logo of the appellant and the respondents are different; the mode of admission and course fee are also different; and in fact, the appellant is situated only in USA and does not provide any services in any other jurisdiction.

37. He submits that the word 'Princeton' is derived by the appellant from the place Princeton, New Jersey, USA, and therefore, being a geographical name, the appellant cannot claim monopoly over the same.

38. He further submits that in India, there are multiple other users of the mark 'Princeton', and in fact, the appellant's registration in India was pursuant to a letter of consent issued by 'Princeton Academy Mumbai'. Therefore, the appellant cannot claim any exclusivity in the mark 'PRINCETON'. In support, he places reliance on the judgment of the Madras High Court in **Manipal Housing Finance v. Manipal Stock & Share Brokers**, 1996 SCC OnLine Mad 736.



39. Lastly, he submits that the respondents have been using the Impugned Mark since 1991 and are, therefore, a prior user of the mark in India. If the appellant had any actual presence or use of its mark in India since 1911, as claimed by it, it should have exercised diligence much sooner. He further submits that no arguments *qua* irreparable loss were advanced by the appellant before the learned Single Judge.

Analysis and findings:

40. We have considered the submissions made by the learned senior counsels for the parties.

41. The learned Single Judge, in its Impugned Order, has found that the appellant has been unable to make a *prima facie* case in its favour, primarily finding that it has been unable to show the use of the trade mark in India prior to 1991, the user date of the mark claimed by the respondents. The learned Single Judge has held that the various articles relied upon by the appellant cannot be treated as the use of the trade mark by the appellant. The learned Single Judge has held that these newspaper articles cannot be treated as the use of the mark by the proprietor (appellant) or the predecessor-in-interest of the proprietor of the mark. We are unable to agree with the said finding of the learned Single Judge for the reasons recorded hereinafter.

42. The learned Single Judge has, in detail, curled out the material on the basis of which the appellant was claiming use of the mark in India. We shall also do the same by merely referring to the Impugned Judgment:-

“9. The complaint has set out, in detail, instances



to indicate that the plaintiff has interactions with India. Mr. Chander Lall, learned Senior Counsel appearing for the plaintiff clarified, however, that he is not predicating his client's case on the principle of transborder reputation and its spillover into India, but on the actual use, by his client, of the Mark PRINCETON, in India, from as far back as 1911. The material on the basis of which Mr. Lall asserts actual user, by his client, of the mark "PRINCETON", in India, may be enumerated thus:

(i) The January 1911 edition of the news paper "The Indian Tiger", printed at the Allahabad Mission Press, clearly stated that it was "Published Intermittently from the Office of the Acting Secretary of the Alumni of Princeton University, N.J., USA, living in India, Burmah, Ceylon, Arabia and Persia".

(ii) The September 29, 1936 edition of the Times of India ran the following article:

**"INDIAN CHEMIST FOR U.S.
UNIVERSITY"**

Dr. Purnendu Nath Chakravarty has sailed for America from London, having been appointed to a post specially created for him in the research department of Princeton University in the United States. Dr. Chakravarty has had a brilliant academic career. After completing his education at Calcutta University, he worked for some time as Research Chemist in the Biochemical Laboratory of the Bengal Chemical and Pharmaceutical Works in Calcutta.

He afterwards went to Germany for further studies and took his Ph.D. in Chemistry from Gottingen University, the professor under whom he worked, Dr. A. Windaus, remarking on his thesis, "the chapter on the structural chemistry of sterols has been brought to



completion through the work of Mr. Chakravarty.”

(iii) The 4 February, 1949 edition of the Times of India contained the following article:

“INDIAN VISITING PROFESSOR

Prof. S.N. Roy, of the Department of Statistics, Calcutta University, and Assistant Director of the Indian Statistical Institute, who has been appointed Visiting Professor to the University of Princeton and Columbia to deliver a series of lectures on statistics, has left for U.S.A.”

(iv) The 11 November 1949 edition of the Times of India contained a photograph of Albert Einstein with Pt. Jawaharlal Nehru, the first Prime Minister of India, titled “STATESMAN AND SCIENTIST”, with the caption, below the photograph, reading “Pandit Nehru called on Prof. Albert Einstein, Father of Relativity, at Princeton University recently. Both are engaged in animated conversation.”

(v) The March 29, 1953 edition of the Times of India ran the following article:

“Frog Skeletons for Princeton

Nearly 100 well-preserved skeletons of 60,000,000-year-old frogs that were collected earlier this winter in one of the suburbs of Bombay have been added to Princeton University’s collections of fossil vertebrates by Prof. Erling Dorf of the Department of Geology.”

(vi) In the “Ten Cents” Journal printed at Princeton itself, the following article, regarding the Princeton Campus Fund Drive appeared on 1 October 1957:

“THE PRINCETON CAMPUS FUND DRIVE

The \$ 2000 to World University Service, to be matched by another \$ 2000 from the Indian Government, will finish the student medical Centre in Patna, India,



originally started by CFD money two years ago. The \$ 2000 to Recording for the Blind will be set up a recording center here in Princeton where professors and students may donate time in recording textbooks for distribution to blind college students.”

(vii) The following article appeared in the 7 July 1956 edition of the Times of India:

***“OLDEST ALUMNUS OF U.S.
‘VARSITY 93-Year- Old Indian***

An Indian nonagenarian has become Princeton University’s most senior alumnus, the Secretary of the University’s National Alumni Association announced yesterday.

This senior alumnus is the 93-year-old retired Presbyterian Minister, the Rev. Henry Goloknath, who is now the only surviving member of Princeton University’s 1882 graduating class. He became the most senior alumnus of the University on the demise of the Rev. Paul Martin a fortnight ago in this country.

The Rev. Henry Golaknath, uncle of India’s Health Minister, Rajkumari Amrit Kaur, to the theological degree from Princeton’s Theological Seminary in 1885.”

(viii) In 27 May 1956 edition of the Times of India, the following article appeared:

***“Better Indo-U.S. Understanding
Necessary***

WASHINGTON, May 26: It is important for India and the United States to understand each other better, India’s Minister of Health said on her arrival here yesterday for a busy five - day visit to the capital.

Rajkumari Amrit Kaur said that she hoped to give Americans a better understanding of India and her



problems.

"If more of us came here, it would make things much easier," she said.

The Rajkumari was met at Union Station by the Indian Ambassador, Mr. G. L. Mehta; Mr. Charles D. Withers, U.S. State Department Political Officer for India, and other Indian Embassy and American officials.

The Health Minister was here at the invitation of the Ford Foundation. She addressed a Princeton University audience on Thursday night and will give more lectures before American college and university audiences during her visit."

(ix) The 8 June 1957 edition of the Times of India contained an article reporting the result of a demographic study conducted by Mr. A. J. Coale and Mr. E.M. Hoover of the Princeton University Office of Population Research, issued a year prior thereto, predicting a big rise in population by 1986, as a serious problem which India would face.

(x) The 7 January 1957 edition of the Times of India reported that four U.S. educationists would be attending the centenary celebrations of the Indian universities of Calcutta, Madras and Bombay, as announced by the American Council of Education. With reference to the same celebrations, the 10 January 1957 edition of the Times of India reported that Dr. Robert F. Gohein, President-elect of Princeton University, and three other leading educators in the United States were scheduled to attend the centenary celebrations of the Bombay University early the next month.

(xi) The 27 December 1959 edition of the Times of India ran the following article (a welcome break from the



monotony of these references):

“TRADITION BROKEN BY INDIAN GIRL Princeton

University

ALLAHABAD, December 26: India's Defence Minister, Mr. V.K. Krishna Menon, has unwittingly helped break a 100-year-old tradition of great citadel of learning in the U.S., Princeton University, of not admitting women on its rolls.

The University authorities recently were surprised to find themselves faced with an Indian girl armed with an admission card. They made a hurried check to find if they had not committed a slip. They had not.

The Indian girl's papers were in order. She had been admitted by the authorities without realising the fact that the candidate was a woman.

She broke tradition to secure admission for post-graduate course because her name was Krishna Rao. The University authorities familiar with the name of Mr. Krishna Menon had presumed that the candidate was a boy.

Too late to say “No”, they deleted the words “I, as a gentleman ...” in her declaration form.”

(xii) The 3 October 1961 edition of the Times of India reported that Mr. Morarji Desai, then the Finance Minister of India, had been asked to deliver a sermon in a church at the Princeton University, which he carried out “admirably”.

(xiii) On 16 April 1962, the Times of India reported that Princeton University was one of the universities which had contributed towards a total contribution of US \$ 3.5 million, for development of the Indian Institute of Technology at Kanpur. Reference has also been made to some of the faculty in the IIT, who



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were to be trained at Princeton University.

(xiv) *The Times of India* edition of 3 March 1962 reported on a lecture delivered by Prof. L.V. Chandler, a “Princeton economist” on “Central Banking and Economic Development” in Bombay.

(xv) While reporting on firm commitment funds procured by the Nehru Academy, the *Times of India* dated 26 May 1964 also noted that the Nehru Academy would combine “some of the qualities, objectives and prestige of the French ‘Grandes Ecoles’ as well as of the world’s other great universities such as Oxford, Cambridge, Harvard and Princeton”.

(xvi) The Department of Public information, Princeton University issued the following Press Release on 22 September 1969:

“The centennial of the birth of the Indian leader Mahatma Gandhi will be marked at a program sponsored by the India Association of Princeton in Alexander Hall on the University campus at 8 p.m this Saturday, September 27.

President Robert F. Goheen, who was born in India and spent much of his boyhood in that country, where his parents were Presbyterian medical missionaries, will preside at the meeting. The public is cordially invited to the ceremonies.

The evening’s program will feature talks on Gandhi, the Hindu spiritual leader and champion of independence for India who was killed in 1948, by Louis Fischer, Visiting Lecturer in International Affairs at the



Woodrow Wilson School of Public and International Affairs, and C.V. Narasimhan, Under Secretary-General of the United Nations.

Also scheduled are the performance of the Indian classical dance, Bharat Natyam, and a Sitar recital.

The one man largely responsible for India's freedom, Gandhi was a deeply religious man who developed the method of non-violent agitation or passive resistance that has been used in many subsequent struggles, notably in U.S. civil rights battles. All of his life he fought nonviolently for the poor millions of India, seeking not only to remove the political evils of India, but also its social and economic ills.

The India Association of Princeton is an organisation of natives of that country and other people interested in India, living in and around Princeton. The Association has regularly celebrated India's Independence Day, Republic Day and various other festivals of the land, as well as presenting "cultural evenings" from time to time."

(xvii) The Times of India of 13 September 1970 carried an article on Dr. S.N. Agarwala, observing, among other things, that he was the first Indian to obtain a Ph.D. in demography from Princeton University.

(xviii) The Times of India of 17 May 1973, under the title "Delhi varsity honours 22 luminaries", reported that degrees were conferred in absentia on various luminaries, one of whom was



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Prof. Harish Chandra, Professor of mathematics at Princeton.

(xix) The 4 February 1975 edition of the Times of India reported the commencement of Indo-US cultural talks, noting that the leaders of the two delegations were Mr. G. Parthasarathy of India and Mr. Robert Goheen, former president of Princeton University.

(xx) An oncoming meeting of astrophysicists from India and abroad, to be held in Bombay, was reported in the Times of India of 5 January 1976, one of the speakers in which was Prof. Jeremiah P. Ostriker from Princeton University Observatory.

(xxi) The Times of India of 31 March 1977 carried a report from Washington of the plan of the White House to appoint Mr. Robert F. Goheen, former president of Princeton University, as Ambassador to India. The article highlighted the links of Mr. Goheen to India, including the fact that his parents had served as medical missionaries in Western India between 1904 and 1944, his paternal grandparents were missionaries in the Kolhapur district of the then Bombay Presidency, he himself had been educated at the American School in Kodaikanal till 1934 and that he had visited India several times on important missions and had also served as a consultant for the Ford Foundation's program at the Delhi University and was a trustee for the Rockefeller Foundation for its agricultural research programs in India.

(xxii) The conferment of an honorary doctorate on Mr. Nani Palkhivala, estimated by many to be the greatest lawyer that this country has produced, by Princeton University was reported in the 8 June 1978 edition of the Times of



India.

(xxiii) The 5 October 1981 edition of the Times of India reported that, at a function held to mark the formal opening of the United States branch of the Bharatiya Vidya Bhawan on 4 October 1981, addressed by Mr. M. Hidayatullah, then the Vice President of India, Dr. Robert Goheen performed the inaugural ceremony by lighting the oil lamp.

(xxiv) The 4 August 1982 edition of the Times of India reported that the trustees of the J. N. Tata Endowment of Indians had selected 80 new scholars for studies abroad during the academic year 1982-1983, many of whom "have secured admission to distinguished universities in the US like Harvard, MIT, Wharton School, Princeton, Yale and Cornell."

(xxv) It was reported in the Times of India of 2 February 1984 that among the functions to be held during the Festival of India, to be organised in major cities in the US in June 1985, was a seminar to be held in the Princeton University on "democracy".

(xxvi) The 26 December 1990 edition of the Times of India carried an article regarding credit recommendations by the American Council on Education for the NCC Course to over 1500 U.S. colleges and universities, which included Cornell, Princeton, University of California-Berkeley, and the State University of New York.

Thus, asserts Mr. Lall, there has been an actual user of the PRINCETON mark in India since 1911 and continuously thereafter."

43. As noted hereinabove, the learned Single Judge finds the above evidence not to be sufficient to establish the use of the mark by the



appellant in India, on the ground that it is not being used by the appellant but by others.

44. In this regard, the definition of the term ‘use of a mark’, in relation to services, as defined in Section 2(2)(c)(ii) of the Act, is reproduced hereinbelow:-

“2. Definitions and interpretation.—

(2) In this Act, unless the context otherwise requires, any reference—

(c) to the use of a mark,—

*(i) *****;*

(ii) in relation to services, shall be construed as a reference to the use of the mark as or as part of any statement about the availability, provision or performance of such services;”

45. From a reading of the above provision, what is evident is that Section 2(2)(c)(ii) of the Act does not stipulate that the use of the mark is to be by the proprietor alone. Use of a mark is defined as a use thereof to make a statement about the availability, provision or performance of such services in relation to which the mark is used. Therefore, as long as the above test is met, that is, there is a statement made about the availability, provision or performance of the service in relation to which the mark is used, it is irrelevant if such statement is being made by the proprietor itself or by a third party. Let us take an example of a manufacturer of a product, or a service provider, who because of the uniqueness of the product or service is so popular that it does not deem it necessary to advertise the product or the service. However, there are articles written in the newspapers about the



product/article using the mark in which these are being sold/provided. Applying the principle laid down by the learned Single Judge, it would have to be held that as the producer/service provider is itself not advertising the product/service, it is not entitled to any trade mark protection. In our view, the same would be defeating not only the object of the Act, but also doing violence to the plain language of Section 2(2)(c) of the Act.

46. In the present case, from the evidence produced by the appellant, at least at this stage of the proceedings, it could not be said that the evidence produced by the appellant does not refer to the availability, provision or performance of the services being rendered by the appellant under the said mark. To the contrary, the evidence referred above shows the tremendous reputation and goodwill enjoyed by the appellant for the services being rendered by it under the mark.

47. As the claim of the appellant is routed also on infringement, we quote Section 29 of the Act, as under:

“29. Infringement of registered trade marks.—

(1) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which is identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark.

(2) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a



mark which because of—

(a) its identity with the registered trade mark and the similarity of the goods or services covered by such registered trade mark; or

(b) its similarity to the registered trade mark and the identity or similarity of the goods or services covered by such registered trade mark; or

(c) its identity with the registered trade mark and the identity of the goods or services covered by such registered trade mark, is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trade mark.

(3) In any case falling under clause (c) of sub-section (2), the court shall presume that it is likely to cause confusion on the part of the public.

(4) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which—

(a) is identical with or similar to the registered trade mark; and

(b) is used in relation to goods or services which are not similar to those for which the trade mark is registered; and

(c) the registered trade mark has a reputation in India and the use of the mark without due cause takes unfair advantage of or is detrimental to, the distinctive character or repute of the registered trade mark.

(5) A registered trade mark is infringed by a person if he uses such registered trade mark, as his trade name or part of his trade name, or name of his business concern or part of the name, of his business concern dealing in goods or services in respect of



which the trade mark is registered.

(6) For the purposes of this section, a person uses a registered mark, if, in particular, he—

(a) affixes it to goods or the packaging thereof;

(b) offers or exposes goods for sale, puts them on the market, or stocks them for those purposes under the registered trade mark, or offers or supplies services under the registered trade mark;

(c) imports or exports goods under the mark; or

(d) uses the registered trade mark on business papers or in advertising.

(7) A registered trade mark is infringed by a person who applies such registered trade mark to a material intended to be used for labeling or packaging goods, as a business paper, or for advertising goods or services, provided such person, when he applied the mark, knew or had reason to believe that the application of the mark was not duly authorised by the proprietor or a licensee.

(8) A registered trade mark is infringed by any advertising of that trade mark if such advertising—

(a) takes unfair advantage of and is contrary to honest practices in industrial or commercial matters; or

(b) is detrimental to its distinctive character; or

(c) is against the reputation of the trade mark.

(9) Where the distinctive elements of a registered trade mark consist of or include words, the trade mark may be infringed by the spoken use of those words as well as by their visual representation and reference in this section to the use of a mark shall be construed accordingly.”



48. A reading of the above provision would show that Section 29(6) of the Act talks of the use of the mark by the infringer and not the proprietor of the mark. Even otherwise, Section 29(6) of the Act starts with the words “For the purposes of this section”, therefore, the scope of the term “uses a registered mark” as explained in Section 29(6) of the Act is confined only to Section 29 of the Act, and does not in any manner control the ambit and scope of the generality of the term “use of the mark” as explained in Section 2(2)(c) of the Act.

49. In addition to the above, Section 29(6) of the Act only gives the illustrative and not exhaustive list of the acts that would constitute the ‘use of the mark’.

50. A Division Bench of this Court in **Google LLC v. DRS Logistics (P) Limited**, (2023) 4 HCC (Del) 515, explained the wide nature of the above definition of the ‘use of a mark’ in Section 2(2)(c)(ii), and its distinction with Section 29(6), as under:

“86. Section 2(2)(c)(ii) of the TM Act requires the reference to the use of the mark as or as a part of any statement about availability, provision or performance of such services. The expression “or in any other relation whatsoever” is not used under Section 2(2)(c)(ii) of the TM Act. It is difficult to accept that the use of a mark in relation to services must be construed in a narrower sense than use of the mark in respect of goods. However, the same would depend on the context in which the expression “use of the mark” is used.

87. Section 2(2) of the TM Act serves as an aid to interpret the words and terms as used in the TM Act. However, the same is by no means exhaustive. The expression “use of a mark” is used in the TM Act in several sections and in



the context of various aspects including removal of the trade mark on account of abandonment or non-use, and for lack of any bona fide intention to use the mark. Thus, the question whether a reference to the expression “use of a trade mark” is to be understood as instructed by Section 2(2)(b) or Section 2(2)(c) of the TM Act would depend on the context in which the said expression is used.

88. *Section 29(6) of the TM Act expressly lists out certain actions, which would amount to use of a registered mark for the purposes of Section 29 of the TM Act. Clearly, the words of Section 2(2) of the TM Act do not control the width of Section 29(6) of the TM Act. Thus, if any action falls within the scope of Section 29(6) of the TM Act, the same would necessarily have to be construed as use of the mark, for ascertaining whether the trade mark is infringed in terms of Section 29 of the TM Act.”*

51. From the above, we are of the opinion that the learned Single Judge has erred in interpreting the ambit and scope of Section 2(2)(c)(ii) and Section 29(6) of the Act. Section 2(2)(c)(ii) of the Act, as noted herein above, is use of the trade mark as a statement about the availability, provision or performance of the service. The appellant met the said test and therefore, the mark can be said to be in use in India as referring to the availability, provision and performance of the service of the appellant since 1911.

52. The learned Single Judge, in the Impugned Order, has further held that the above articles do not evidence providing of commercial services by the appellant in India, and may, at the highest, amount to publicity for the appellant in India. The learned Single Judge has further held that the reference to Indian students studying at the



appellant's university, howsoever large the number, cannot amount to the appellant providing services in India under the mark. We are unable to agree with this finding of the learned Single Judge as well.

53. Section 2(2)(c)(ii) of the Act, as noted hereinabove, merely requires the use of the mark in relation to services about their availability, provision or performance. It does not further require that such availability, provision or performance has to be in India. We may herein itself note that much emphasis has been placed by the learned senior counsel for the respondents on the Judgment of Supreme Court in *Toyota Jidosha* (supra). We, therefore, quote the relevant paragraphs from the said judgment as under:

*“32. Prof. Cristopher Wadlow's view on the subject appears to be that the test of whether a foreign claimant may succeed in a passing-off action is whether his business has a goodwill in a particular jurisdiction, which criterion is broader than the “obsolete” test of whether a claimant has a business/place of business in that jurisdiction. **If there are customers for the claimant's products in that jurisdiction, then the claimant stands in the same position as a domestic trader.***

33. The overwhelming judicial and academic opinion all over the globe, therefore, seems to be in favour of the territoriality principle. We do not see why the same should not apply to this country.

*34. **To give effect to the territoriality principle, the courts must necessarily have to determine if there has been a spillover of the reputation and goodwill of the mark used by the claimant who has brought the passing-off action. In the course of such determination it may be necessary to seek and ascertain the existence of not necessarily a real market but the presence of the claimant through its mark***



within a particular territorial jurisdiction in a more subtle form which can best be manifested by the following illustrations, though they arise from decisions of courts which may not be final in that particular jurisdiction.

35. In *LA Societe Anonyme Des Anciens Etablissements Panhard v. Panhard Levassor Motor Co. Ltd.*, the plaintiffs were French car manufacturers who had consciously decided to not launch their cars in England (apprehending patent infringement). Nevertheless, some individuals had got them imported to England. It was seen that England was one of the plaintiff's markets and thus, in this case, permanent injunction was granted. Similarly in *Grant v. Levitt*, a Liverpool business concern trading as the *Globe Furnishing Company*, obtained an injunction against the use of the same name in Dublin as it was observed that advertisements by the plaintiff had reached Ireland and there were Irish customers.

36. *C&A Modes v. C&A (Waterford) Ltd.*, was a case where the plaintiffs operated a chain of clothes stores throughout the UK and even in Northern Ireland but not in the Republic of Ireland where the defendants were trading. The Court held that,

“a very substantial and regular custom from the Republic of Ireland was enjoyed by this store. Up to that time an excursion train travelled each Thursday from Dublin to Belfast, and so great was the influx of customers from the Republic as a result of that excursion that the store ordinarily employed extra part-time staff on Thursday on the same basis as it did on Saturday which were normally the busiest shopping days.”

The said view has since been upheld by the Irish Supreme Court.”

54. The Court, while applying the above principles on the facts of



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the said case, found that the car of the appellant therein had been introduced in the Indian market only in the year 2009-2010. The advertisements in automobile magazines, international business magazines; availability of data in information disseminating portals like Wikipedia and online Britannica Dictionary; and the information on the internet, was not found be a safe basis to hold the existence of the necessary goodwill and reputation of the product in Indian market at the relevant point of time, particularly having regard to the limited online exposure at that point of time, that is, in the year 2001. There was one singular news item of launch of the product in Japan, and even the own witnesses of the appellant therein, were suggestive of a very limited sale of the product in Indian market and virtually the absence of any advertisement of the product prior to 2001. In fact, there was lack of knowledge and information of the product even amongst the relevant section of the Indian population. It was on those facts, that the Court held that there was no warrant to reappraise the evidence of the parties.

55. In the present case, the knowledge and reputation of the services of the appellant is established from the nature of articles written about it. There is also evidence of the Indians using the services of the appellant, as a number of students travel all the way to the USA to study at the appellant's University. The above judgment, therefore, cannot come to the aid of the respondents.

56. This Court in ***Bolt Technology OU v. Ujoy Technology (P) Ltd. & Anr.***, 2023 SCC OnLine Del 7565, while analysing the law laid down in ***Toyota Jidosha*** (supra), held as under:



“102. The Supreme Court in Toyota while accepting that the territoriality principle would merit adoption by Indian courts also does not appear to have shut out the application of cross border reputation principles where reputation may be found to have transcended borders. This would be evident from the discussion which ensues. As is manifest from a reading of Toyota, the said decision spoke of those precepts being applicable even in the absence of a “real market” as conventionally understood and bid us to examine the issue from the standpoint of the claimant through its mark being present in the market. We also deem it apposite to advert to the repeated conjunctive use of the expressions reputation alongside goodwill at more than one place in the said decision.

103. Reverting then to Starbucks, we note that the UKSC essentially found itself bound by past precedents, albeit rendered in times far removed from the present, and which had held that mere spill-over of reputation would not suffice and a case of domestic rooting of goodwill had to be established. However even Starbucks sought to reconcile the legal position by accepting the fact that the presence of customers within the United Kingdom availing of services abroad may suffice. The UKSC also appears to have weighed in consideration the latent effect of such a position tipping the balance in favour of protection. While this would clearly constitute an important consideration when we evaluate claims of cross border reputation, Toyota as well as the judgments in Cadbury and MAC Personal Care have constructed adequate safeguards and gateways before such a contention may be accepted. This we do observe bearing in mind those decisions employing the metric of significant and substantial evidence of reputation and presence in the jurisdiction



as being the determinative factor. What we seek to emphasise is the need to acknowledge the imperatives of shrugging off the conventional moorings of goodwill, as traditionally understood, coupled with it being rooted in a tangible market while considering the issue of cross border reputation.

104. *We find that Toyota was dealing with a product which had virtually no physical or commercial presence in India. There was admittedly no evidence of Prius having been commercially traded in India. The Supreme Court answered the issue of transborder reputation weighing in balance the absence of significant information and knowledge of the mark in India, limited online exposure and the stray reportage of the product. It thus answered the issue based on a lack of goodwill, lack of information and knowledge of the mark amongst a sizeable number of people in the concerned segment and thus a failure to meet the evidentiary standards of recognition and knowledge of the mark. At the cost of repetition, we deem it appropriate to advert to the Supreme Court observing in para 40 of the report that if “goodwill or reputation” in the particular jurisdiction were not proven, no other issue would arise for consideration. This coalesces with the observation of absence of a real market and the principal factor being “presence of the claimant through its mark within a particular territorial jurisdiction in a more subtle form....”. 102. Thus Toyota cannot possibly be read as adopting or advocating the restricted approach taken by English courts and which had spoken of goodwill, as traditionally understood, being an inviolable condition for testing claims of passing off where the same be based upon a cross border reputation. The Supreme Court merely accepted the predominant*



view taken in most jurisdictions across the globe of the territoriality principle being the norm as opposed to the doctrine of universality. However, Toyota cannot possibly be understood as propounding a position that significant reputation can have no bearing especially in cases where it is urged that the mark had acquired a transborder reputation. In fact the concept of cross border reputation and a spill over of renown was duly recognised and affirmed.

105. *We deem it pertinent to observe that acceptance of reputation as a facet relevant to actions of passing off would not run contrary to the territoriality principle. What we seek to emphasise is that insistence upon goodwill being viewed as a necessary precondition for maintaining an action of passing off can no longer be countenanced to be the correct view. Allergan, Cadbury, MAC Personal Care and Toyota bid us to abandon the archaic and doctrinaire approach bearing in mind the transformative impact of technology that has blurred traditional boundaries allowing trademarks of global renown to surpass the conventional constraints of having localised support within tangible or real markets. We would clearly be in error if we were to ignore the imperatives of international commerce and the presence of marks which could today be recognised to have a reputation spanning jurisdictions. We thus find ourselves unable to either accord primacy to goodwill or recognise it to be an inviolable condition for asserting passing off.*

106. *We also bear in mind the exposition of the legal position by the Australian Federal Court in Conagra which had traced the “hard line” and the “softer approach” by courts in England while dealing with the subject of spillage of reputation. It was this which constrained it to observe that the line*



as advocated by the decisions rendered in the United Kingdom conflict with the needs and imperatives of contemporary business and international commerce. It is the view expressed in Conagra which also appears to be the position taken by courts in the United States as would be evident from the passages of McCarthy's seminal work on trademarks. In fact the author proceeds to suggest that perhaps the territoriality doctrine may itself have been rendered obsolete and no longer constitute a safe test to adopt for the purposes of addressing the complexities and interdependencies pervading the globally connected world that we live in. However, we do not propose to either advocate or accept that view bound as we are by Toyota. The said decision of the Supreme Court in any event only speaks of goodwill having a territorial operation as opposed to reputation which may yet be found to exist even in the absence of commercial returns or a localised rooting.

107. *We also bear in consideration the extensive review of the English position by the Federal Court of Australia which in Conagra had critically observed that the strict dissection between reputation and goodwill appeared to stem from reliance having been unjustifiably and overly placed on judgments rendered in the context of revenue laws and the inherent limitations in localising goodwill where the reputation of a business attains an omnipresent or singular stature. However, even if we proceed on the territoriality principle, and which Toyota commands us to do, the concept of reputation as explained above would warrant claims of cross border reputation being tested on lines suggested above.*

108. *Upon a due consideration of the aforementioned decisions and the authoritative texts referred to above, we find that the*



expressions “reputation” and “goodwill” have been used conjunctively or interchangeably and the distinction between the two which the English Courts continue to mandate clearly appears to have become blurred in other jurisdictions. In fact, it is the position as taken by the English courts which has constrained courts in various jurisdictions to characterise it as being overly restrictive or the limiting view. The imperatives of reputation being considered to be a stand-alone factor would also appear to be in tune with the scheme of well known marks which has come to be adopted and incorporated in statutes in various jurisdictions. In fact, the concept of well known marks was a facet which was alluded to even by the UKSC in Starbucks. This is evident from a reading of para 64 of the report.

111. *As would be evident from the above, the provision creates a statutory injunct against the registration of a trademark if it be in conflict with a well known trademark in India. The reasons for the aforesaid are underlined as being the intent of the applicant to take unfair advantage of a mark of repute or be detrimental to its distinctive character. Sub-section (6) of Section 11 then proceeds to set out the factors which the Registrar would bear in mind for determining a trademark as being well known. These are defined to be the knowledge or recognition of that mark, the duration, extent and geographical area of its use, the duration, extent and geographical area in which promotional activities including advertising, publicity and presentation may have been carried out, the duration and geographical area of registrations as also record of successful enforcement of rights by the holder of the well known trademark. Section 7(7) sets out the factors which the Registrar would bear*



in mind while determining whether a trademark is known or recognized in a relevant section of the public and those determinative factors are defined to be the number of actual or potential consumers, the number of persons involved in the channels of distribution of the goods or services, as the case may be, and the business circles dealing with those goods or services.

112. *Of significant import is Section 7(9) and which mandates that the Registrar shall not require as a condition precedent the factors set out in clauses (i) to (v) for determining whether a trademark is well known. The aforesaid conditions extend to the actual use of the trademark in India, its registration, an application for registration having been filed in India or that the trademark is well known in or has been registered in any jurisdiction other than India. In terms of Section 11(9)(v), the Registrar is also not obliged to find or come to a conclusion that the trademark is well known to the public at large in India before according recognition to a well known mark.*

113. *The aforesaid statutory provisions would thus appear to lend credence to both reputation and goodwill, constituting important and independent factors for the purposes of answering a claim of cross border reputation. As would be manifest from our reading of Section 11, while the Registrar would take into consideration the number of actual or potential consumers of goods or services provided by a well known trade mark, it is clearly not obliged to accord such recognition only in situations where the mark has been either used or registered. Ultimately, the Registrar has to bear in mind factors such as knowledge or recognition of that mark in the relevant section of the public including knowledge of the well known mark that may be derived*



from promotional activities. Section 11 thus does not purport to lay any overarching emphasis on an actual existence of goodwill alone.

114. This would also be in consonance with the observations entered by the Supreme Court in Toyota when their Lordships significantly observed that while determining and answering the question of whether there has been a spillover of reputation and goodwill, the enquiry need not be confined to ascertaining the existence of a real market but the presence of the claimant through its mark within a particular territorial jurisdiction being sufficient. The presence of a mark in the market could well be established or proven on the basis of the extent of the promotion and advertisement of a well known mark, the knowledge of the said mark amongst a sizable section of the concerned segment of the public and its reputation being found to have spilled over and be sufficiently grounded in the minds of consumers in India.

115. We further find that a mere global reputation or asserted goodwill has neither been accorded a judicial imprimatur nor accepted as being sufficient by our courts to answer a claim of transborder reputation. In order to succeed on this score, it is imperative for the claimant to prove and establish the existence of a significant and substantial reputation and goodwill in the concerned territory. Unless a sizeable imprint of the presence of the mark is established amongst the consuming public, a claimant would not be entitled to protection. In fact, knowledge amongst a sizeable and noteworthy number of the concerned segment would be a sine qua non for proving reputation itself. Ultimately the question of a significant reputation would have to be tested on principles analogous to those enumerated in Section 11 of the TM



Act. This, in our considered opinion, constitutes a sufficient, adequate and salutary safeguard which would allay and lay to rest doubts of us having adopted a too overly protective stance in favour of claimants who may otherwise have no intent of introducing goods or providing services in India. A claimant who has no presence or a customer base in India, has not established its presence by way of adequate advertisement or promotional activity or one who fails to establish a global reputation equally well known to the consuming public in India would thus be disentitled to claim protection. The adoption of the aforesaid standard would also subserve the imperatives of avoiding the stifling of local industry and enterprise. This in our considered opinion would be the correct approach and strike the right balance between brands whose reputation transcends territories and the interest of national enterprise and that of consumers on the other.”

57. From a reading of the said judgments, what appears is that once the claimant has established that there are customers for the claimant's services in a jurisdiction, though not necessarily in a real market but through use of its mark in a more subtle way, then the claimant stands in the same position as a domestic trader and it may bring an action by establishing its goodwill in the jurisdiction in which it claims that the defendants are trying to pass off their goods under the brand name of the claimant's goods.

58. In the present case, the very fact that Indian students are also being targeted by the appellant and are in fact going to the University of the appellant ‘in large numbers’, shows the availability, provision



and performance of the services being rendered by the appellant under its mark, thereby, establishing its goodwill and reputation in India.

59. The learned Single Judge has placed much emphasis on a concession made by the learned senior counsel for the appellant that he is not basing his claim on trans-border reputation. To our view, this concession must be understood in its context. As trade mark is territorial in nature, where the goods or services are not available in a particular jurisdiction, the concept of trans-border reputation is put into service to claim the overflow of reputation to such territories where the goods or services are not available. In the present case, the moment it is conceded that Indian students are availing the services of the appellant while they are still in India, it cannot be said that the services of the appellant are not available in India.

60. The learned Single Judge has further held that in terms of Section 34 of the Act, it is the plaintiff/appellant herein who has to show not merely use of the mark, but a continuous use of the mark. In our view, the said finding of the learned Single Judge cannot be sustained. Section 34 of the Act is reproduced hereinunder:-

“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 by the proprietor or a predecessor in title of his; or



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(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."

61. A reading of the above provision would show that for availing the protection under Section 34 of the Act, it is for the defendant, who is resisting a claim of a registered owner of a trade mark or of a proprietor of a mark, to show continuous user of the mark prior to the date of the first use of the mark by the proprietor or the date of registration, whichever is earlier. The reliance placed by the learned senior counsel for the respondents on the Judgments in *S Syed Mohideen* (supra), and *Neon Laboratories* (supra) is misplaced, inasmuch as, the Supreme Court in the said judgments has held that the rights flowing from the registration of the trade mark are subject to the rights of the prior user of the said mark. Once we have held that the appellant herein has established prior use of its Mark, the said judgments cannot come to the aid of the respondents.

62. The learned senior counsel for the respondents has urged that the appellant, in the application seeking registration of its mark, had claimed user of its mark in India only since 30.04.1996. The same had been reiterated by the appellant even in the reply dated 02.07.2015 issued in response to the trade marks registry's objections. He submits that, therefore, the appellant is estopped from claiming the user of the mark from any date prior thereto.



63. We may, at the outset, note that the above submissions have also been considered by the learned Single Judge by holding that merely because the appellant, while seeking registration of its mark, gives a certain date of claimed user of the mark, it would not act as an estoppel against such an applicant; the applicant can still, from cogent evidence, show that its user of the trade mark was in fact prior to the one it claimed in the application seeking registration of its mark. However, this is not to say that the declaration of the user in the application is meaningless. It will depend on the facts and circumstances of each case as to whether the applicant can be allowed to claim a user from a date prior to the one claimed in the application. We quote from the judgment of the learned Single Judge as under:-

“28.4. To that extent, therefore, Mr Lall is correct in his submission that, when examining Section 34 of the Trade Marks Act, the use of the mark, whether by the plaintiff or the defendants, has to be in terms of Section 2(2)(c). There is, therefore, substance in Mr Lall's submission that, irrespective of the declaration of user, made by the plaintiff at the time of applying for registration of the asserted mark, if use of the asserted mark, in the manner envisaged by Section 2(2)(c), is shown to exist from some prior point of time, that use would prevail, in preference to the declared user of the mark, at the time of applying for registration thereof.

28.5. That, of course, does not mean that the declaration of user, at the time of applying for registration of the mark of the plaintiff, which is alleged to be infringed by the defendant, is entirely irrelevant. Ordinarily, principles of approbate and reprobate would apply to such a case. In other words, where the plaintiff has, at the time of applying for registration of its mark, declared user of the mark from a



particular point of time, that declaration would ordinarily bind the plaintiff. If, however, the plaintiff is able to demonstrate, indisputably, that there is actual user of the asserted mark, by it, from a point of time prior to the user declared at the time of applying for registration, the court cannot shut its eyes to the material used by the plaintiff in that regard, while applying Section 34. If the material does evidence actual user, by the plaintiff, of the asserted mark, then the point of time from which such user is evidenced would have to be taken into consideration while reckoning “user” for the purposes of Section 34, irrespective of the user declared at the time of applying for registration. To take a simple example, if the user is in respect of the name of an educational institution, and the plaintiff has declared user of the mark, at the time of applying for registration, from, say, 2010, but is able to show that, since 2000, the plaintiff’s college is standing, large as life, with the mark emblazoned on its façade, then the user of the mark would be reckoned from 2000, and not from 2010. To be entitled to the benefit of actual user of the mark, in preference to the user declared at the time of applying for registration, in the context of Section 34, however, the plaintiff would have to make out a case so substantial and impenetrable that the court cannot but hold that the actual user of the plaintiff’s mark is in fact anterior, in point of time, to the user declared by the plaintiff while applying for registration of the mark.

28.6. *The evidence of anterior use has, however, under Section 34(a) “by the proprietor or a predecessor-in-title of his”. What has to be compared is, therefore, the use of the asserted mark by the proprietor i.e. by the plaintiff, vis-à-vis the use of the impugned mark by the defendant. If the defendant has used the impugned mark prior to the registration, as well as the actual use of the asserted mark by the plaintiff, then the plaintiff*



is, under Section 34, statutorily proscribed from interfering with the use of the impugned mark by the defendant. If, on the other hand, the plaintiff is able to establish actual use of the impugned mark by him, prior to the use of the impugned mark by the defendant, then Section 34 would have no application, and, if infringement exists, the plaintiff would be entitled to injunction by virtue of Section 28(1).”

64. In the present case, as has been held by us hereinabove, at least *prima facie*, the appellant has been able to show the user of its mark in India since 1911, that is, much prior to the one claimed by it in its application for registration of the mark. The above submission of the learned senior counsel for the respondents, therefore, cannot be accepted in the facts of the present case. The Judgments in ***Raman Kwatra*** (supra), ***Modern Snacks*** (supra), ***Vasundhra Jewellers (P) Ltd*** (supra), and ***PEPS Industries (P) Ltd.*** (supra), relied upon by the learned senior counsel for the respondents, are not applicable to the facts of the present case as these judgments involved the issue of estoppel *qua* the factual assertions and submissions made before the Trade Marks Registry *inter-se* between the parties.

65. Equally, as far as the submission of the learned senior counsel for the respondents on the appellant obtaining its registration on the basis of a letter of consent from ‘Princeton Academy Mumbai’ or other entities using the mark ‘Princeton’, is concerned, the respondents cannot take advantage of the same. The appellant cannot be expected to take action against all infringers of its rights as a pre-condition to taking such action against the respondents. What is the



extent of use of the impugned mark of these other entities and whether it is worth-the-while of the appellant to even proceed against them, is not disclosed by the respondents and it is even otherwise, for the appellant to decide. The respondents, as an infringer, cannot claim negative equality or immunity from legal action only on the basis that the appellant chose to settle the dispute with some party in a particular manner or chose not to proceed against the others.

66. As far as the *prima facie* case is concerned, the word mark 'Princeton' is identical for the appellant and the respondents. The appellant by its evidence, reproduced hereinabove, at least *prima facie*, has been able to establish reputation of its mark in India since the year 1911, as against the first use of the mark claimed by the respondents to be of 1991. The appellant is also a registered proprietor of the mark.

67. On the aspect of confusion, the learned Single Judge has held that it would be unrealistic to believe that any consumer would confuse the services provided by the respondents with that of the appellant. The learned Single Judge has held that no student or person interested in the services provided by the appellant or by the respondents is likely to be confused between the two merely because of the use of the mark. We are unable to agree with this finding of the learned Single Judge. The infraction of the rights of the appellant can take place in various shapes like dilution of its mark, initial interest confusion, and actual confusion.

68. The learned senior counsel for the respondents has further submitted that 'Princeton', being the name of an area from where the



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appellant operates its University, it has a descriptive and geographical significance on which it cannot claim any monopoly. We are not impressed with the said submission. It is not the case of the respondents that the respondents have adopted the mark similar to that of the appellant because of any geographical significance. The appellant's registration of the mark is also not in question. The reliance placed by the learned senior counsel for the respondents on the Judgment of the Madras High Court in ***Manipal Housing Finance Syndicate Ltd.*** (supra) is misplaced inasmuch as, while the Madras High Court held that monopoly over the use of geographical name is not the rule, however, the Court further held that in a rare case where the name has been used very extensively for a long period, is so well known in the market as to be identified in the public mind with the product or service rendered by the business enterprise, then the court may consider granting injunctive relief to a plaintiff.

69. The submission of the learned senior counsel for the appellant that as the logo used by the respondents is vastly different from the one used by the appellant, the case of passing off is not made out, does not *prima facie* impress us. It is now settled law that even in a composite mark, there can be a predominant part of the mark entitled to a standalone protection. There could also be more than one predominant part, each entitled to such protection. It shall depend on the facts and circumstances of each case as to whether any part of the mark can be held entitled to such protection or not. In the present case, *prima facie* we find that the word "PRINCETON" is a vital and important part of the mark of the appellant. It is being used by the



respondents for providing similar service. Moreover, merely because there is a difference in the fee structure of the appellant and the respondents, confusion cannot be ruled out.

70. Having said the above, we shall now consider the claim of the appellant for an injunction against the respondents from use of the mark.

71. It is trite law that for purposes of the *interim* injunction, the appellant must satisfy the trinity test of a *prima facie* case, balance of convenience, and irreparable harm and injury. The Supreme Court recently in **Ramakant Ambalal Choksi v. Harish Ambalal Choksi & Ors.**, (2024) 11 SCC 351, has explained this test as under:

“34. The burden is on the plaintiff, by evidence aliunde by affidavit or otherwise, to prove that there is “a prima facie case” in his favour which needs adjudication at the trial. The existence of the prima facie right and infraction of the enjoyment of his property or the right is a condition precedent for the grant of temporary injunction. Prima facie case is not to be confused with prima facie title which has to be established on evidence at the trial. Only prima facie case is a substantial question raised, bona fide, which needs investigation and a decision on merits. Satisfaction that there is a prima facie case by itself is not sufficient to grant injunction. The Court further has to satisfy that noninterference by the court would result in “irreparable injury” to the party seeking relief and that there is no other remedy available to the party except one to grant injunction and he needs protection from the consequences of apprehended injury or dispossession. Irreparable injury, however, does not mean that there must be no physical possibility of repairing the injury, but means only that the injury must be a material one,



namely one that cannot be adequately compensated by way of damages. The third condition also is that “the balance of convenience” must be in favour of granting injunction. The Court while granting or refusing to grant injunction should exercise sound judicial discretion to find the amount of substantial mischief or injury which is likely to be caused to the parties, if the injunction is refused and compare it with that which is likely to be caused to the other side if the injunction is granted. If on weighing competing possibilities or probabilities of likelihood of injury and if the Court considers that pending the suit, the subject matter should be maintained in status quo, an injunction would be issued. Thus, the Court has to exercise its sound judicial discretion in granting or refusing the relief of ad interim injunction pending the suit. (See : Dalpat Kumar v. Prahlad Singh, (1992) 1 SCC 719.)”

72. For the reasons we have detailed above, the appellant has been able to make out a *prima facie* case in its favour.

73. Coming to the test of irreparable harm and balance of convenience, we are of the opinion that due to the long passage of time for which the respondents have been using the impugned mark (1991) and lack of actual presence of the appellant in form of an educational institution in India, and the presence of the respondents being confined only to the State of Telengana, *prima facie*, the appellant has not been able to meet these tests. At this stage, we may only note that there are various arguable issues that would need to be determined in the Suit.

74. Given the above factors, instead of granting an *interim* injunction against the respondents, the balance of convenience would



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be met by directing that during the pendency of the Suit, the respondents would not open any new institution using the name “PRINCETON” as part of the name of such institution. The respondents must also maintain complete accounts of all its receipts, and file the same along with an affidavit every six months before the learned Single Judge.

75. We may also note that we are alive to the principle that the order of *interim* injunction, being discretionary relief, the appellate Court would not interfere with the same only because it may have exercised such discretion in a different manner, however, in the present case, as noted hereinabove, we find that the learned Single Judge has proceeded to examine exercise of such discretion on an interpretation of the provisions of the Act, which we are unable to sustain. In this regard, we may place reliance on the Judgment of the Supreme Court in **Ramdev Food Products (P) Ltd. v. Arvinbhai Rambhai Patel & Ors.**, (2006) 8 SCC 726, wherein it was held as under:

“125. We are not oblivious that normally the appellate court would be slow to interfere with the discretionary jurisdiction of the trial court.

126. The grant of an interlocutory injunction is in exercise of discretionary power and hence, the appellate courts will usually not interfere with it. However, the appellate courts will substitute their discretion if they find that discretion has been exercised arbitrarily, capriciously, perversely, or where the court has ignored the settled principles of law regulating the grant or refusal of interlocutory injunctions. This principle has been stated by this Court time and time again. [See for example Wander Ltd. v. Antox India (P) Ltd.



[1990 Supp SCC 727] , Laxmikant V. Patel v. Chetanbhai Shah [(2002) 3 SCC 65] and Seema Arshad Zaheer v. Municipal Corpn. of Greater Mumbai [(2006) 5 SCC 282 : (2006) 5 Scale 263] .]

127. The appellate court may not reassess the material and seek to reach a conclusion different from the one reached by the court below if the one reached by that court was reasonably possible on the material. The appellate court would normally not be justified in interfering with the exercise of discretion under appeal solely on the ground that if it had considered the matter at the trial stage it would have come to a contrary conclusion.

128. However, in this case the courts below proceeded on a prima facie misconstruction of documents. They adopted and applied wrong standards. We, therefore, are of the opinion that a case for interference has been made out.”

76. We must however, hasten to clarify that our above observations and findings are merely tentative in nature and shall, in no manner, influence the learned Single Judge while deciding the Suit on merits.

Conclusion:

77. In view of the above, the Impugned Order passed by the learned Single Judge cannot be sustained and is accordingly set aside.

78. The respondents are restrained from using the mark ‘Princeton’ or any other mark deceptively similar thereto for any new institution during the pendency of the above suit.

79. The respondents shall also file on affidavit, every six months during the pendency of the Suit, its receipts from the institutions being run in the name of ‘PRINCETON’.



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80. The parties shall endeavour to have the Suit decided expeditiously.

81. The appeal is allowed in the above terms. The pending applications also stand disposed of.

82. There shall be no orders as to costs.

NAVIN CHAWLA, J

RENU BHATNAGAR, J

SEPTEMBER 26, 2025/sg/rv/VS

Signature Not Verified

Digitally Signed
By: REYMON VASHIST
Signing Date: 26.09.2025
18:12:15

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