

IN THE COURT OF X ADDL. DISTRICT AND SESSIONS JUDGE,
(DEDICATED COMMERCIAL COURT)
BENGALURU RURAL DISTRICT, BENGALURU

Present: Sri. Basavaraj Chengti
B.Com., LL.B.(Spl.)
X Addl. District & Sessions Judge,
Bengaluru Rural District, Bengaluru.

DATED THIS THE 22ND DAY OF APRIL 2022

COMMERCIAL O.S. NO.960/2021

Plaintiffs : 1) M/s Manipal Academy of Higher
Education,
A Public Trust,
Having its registered office at
Madhav Nagar,
Manipal – 576 104,
Karnataka
Represented by its Trustee
Dr. H.S. Ballal.

2) Manipal Academy of Higher
Education (Deemed University),
Madhav Nagar,
Manipal,
Karnataka-576104,
Represented by its authorized
signatory Dr. Narayana Sabhahit.

(By : Sri. S.S.Poovaiah Advocate)

- Defendants : V/s
- 1) Manipal International School,
Chandapura, Bengaluru,
Chandapura – Anekal Rd.,
Suryanagar Phase I,
Electronic City,
Bengaluru,
Karnataka – 560 099.
Represented by its Director.
 - 2) Manipal E Commerce Limited,
Having its registered office at
N-701, North Block,
Manipal Centre – 47,
Dickenson Road,
Bengaluru.
Karnataka – 560 042.
Through its Director
Mr. T. Sudhakar Pai.
 - 3) T. Sudhakar Pai,
N-701, North Block,
Manipal Centre – 47,
Dickenson Road,
Bengaluru.
Karnataka – 560 042.
 - 4) Manipal Academy of Health &
Education Automatic House,
10/19, Ground Floor,
East Patel Nagar,
New Delhi – 110 008.
Through its Director
T. Sudhakar Pai.

- 5) Kurlon Limited,
No.301, III Floor, North Block,
Front Wing, Manipal Centre,
47, Dickenson Road,
Bengaluru – 560 042.

(By : Sri. Ashok G.V.,Advocate for D-3
to D-5)
(D-1 and 2: Ex parte)

PARTIES TO I.A.No. I to VI

Applicants : M/s Manipal Academy of Higher
Education and another

V/s

Respondents : Manipal International School and
others.

PARTIES TO I.A.No. VII

Applicant : T. Sudhakar Pai

V/s

Respondents : M/s Manipal Academy of Higher
Education and another

ORDER ON I.A No. I to VII

These I.As. are interlinked and hence, I have taken them together for disposal by a common order. The parties to the I.A. are referred to as per their ranking in the suit.

2. The plaintiffs have filed I.A.No.I under Order XXXIX Rules 1 and 2 read with Section 151 of Code of Civil Procedure for an order of temporary injunction against the defendants, their partners, directors, promoters, shareholders, managers, assigns, successors-in-interest, licensees, franchisees, companies, representatives, servants, distributors, agents, etc., restraining them from using the trade mark Manipal International School and/or MAHE and/or Manipal Academy of Health and Education and/or other word(s) identical or deceptively similar to the plaintiffs' registered trade mark MAHE (Deemed University)/ Manipal Academy of Higher Education (Deemed University)/ Manipal University singularly or in conjunction with any other words or monogram/logo as a trade mark, service mark, trade name, trading style/ corporate name/ domain name, or in any other manner whatsoever; on or in relation to or any

goods and/or services whatsoever, advertising, business papers, etc., until disposal of the suit.

3. The plaintiffs have filed I.A.No.II under Order XXXIX Rules 1 and 2 read with Section 151 of Code of Civil Procedure for an order of temporary injunction against the defendants, their partners, directors, promoters, shareholders, managers, assigns, successors-in-interest, licensees, franchisees, companies, representatives, servants, distributors, agents, etc., restraining them from jointly and severally, passing off their goods/ services/ business as and for the goods/ services/ business of the plaintiffs by restraining them from using Manipal International School and/ or MIS and/or MAHE and/or Manipal Academy of Health and Education and/or other marks comprising of Manipal or any other mark/ name/ words identical or deceptively similar to the plaintiffs' trade mark(s) name MIS/ MAHE (Deemed University)/ Manipal Academy of Higher Education (Deemed University)/ Manipal University/ Manipal, singularly or in conjunction with any other words or monogram/logo as a trade mark, service mark, trade name, trading style, corporate name, domain name or in any other manner whatsoever; on or in relation to or any goods and/or

services whatsoever, advertising, business papers, etc., until disposal of the suit.

4. The plaintiffs have filed I.A.No.III under Order XXXIX Rules 1 and 2 read with Section 151 of Code of Civil Procedure for an order of temporary injunction against the defendants, their partners, directors, promoters, shareholders, managers, assigns, successors-in-interest, licensees, franchisees, companies, representatives, servants, distributors, agents, etc., restraining them jointly and severally, from using plaintiffs' trade mark(s)/ name MAHE (Deemed University)/ Manipal Academy of Higher Education (Deemed University)/ Manipal University and/ or other marks comprising of Manipal or any other mark/ name/ words identical or deceptively similar thereto, singularly or in conjunction with any other words or monogram/logo as a trade mark, service mark, trade name, trading style, advertising, business papers, etc., on or in relation to or any goods and / or services whatsoever; leading to acts of unfair competition by the defendants with the plaintiffs' goods and /or services, until disposal of the suit.

5. The plaintiffs have filed I.A.No.IV under Order XXXIX Rules 1 and 2 read with Section 151 of Code of Civil Procedure for an order of temporary injunction restraining the defendants from using, either directly or indirectly, the impugned word/ name/ trade name/ trading style “Manipal Group”, singularly or in conjunction with any other words, in relation to any goods or services or business or in any manner whatsoever until disposal of the suit.

6. The plaintiffs have filed I.A.No.V under Order XXXIX Rules 1 and 2 read with Section 151 of Code of Civil Procedure for an order of temporary injunction restraining the defendants from using, either directly or indirectly, the impugned trade mark “Manipal Group”, in relation to any goods or services or business or in any manner whatsoever other than lottery tickets, until disposal of the suit.

7. The plaintiffs have filed I.A.No.VI under Order XXXIX Rules 1 and 2 read with Section 151 of Code of Civil Procedure for an order of temporary injunction restraining the defendants from using the domain name “manipalschool-city.com” and pass an order/ direction to the defendant No.2

to transfer the domain name “manipalschool-ecity.com” in favour of the plaintiff No.1, until disposal of the suit.

8. The defendant No.3 has filed I.A.No.VII under Order XXXIX Rule 4 read with Section 151 of Code of Civil Procedure seeking for an order to vacate the exparte ad-interim relief dated 21-02-2019.

9. The facts narrated in the plaint and affidavit are that the plaintiffs belong to the group head by Dr. Ramdas Pai and his direct descendant Dr. Ranjan Pai. As per the information available, the defendant No.3 who is the director of the defendant No.2 intends to start a school called “Manipal International School” of which Manipal is the essential feature. The defendants are also using the mark “MIS” which is identical/deceptively similar trade mark to the plaintiffs. The defendants have made all attempts to sail as close as possible with the plaintiffs. The defendants’ use of the said impugned marks for identical services as that of the plaintiffs in the field of education is an illegal attempt to piggy back on the plaintiffs’ reputation. Such adoption/use of the defendants constitutes infringement of inter alia plaintiffs’

exclusive statutory and proprietary rights in its registered and reputed trade mark and tantamount to passing off.

10. It is further asserted that the plaintiff No.1 is a public trust primarily engaged in inter alia the establishment, management, development and conduct of educational institutes in all its branches and stages, including but not limited to kinder-garten, primary and high schools, colleges, post graduate and doctorate courses in arts, science, commerce, engineering, medicine, pharmacy, dental, nursing, management, music, fine arts, architecture etc., and in the establishment, management, development and conduct of hospitals for providing medical, surgical and nursing care or treatment for indoor and/or outdoor patients. The plaintiff No.1 manages and operates the plaintiff No.2.

11. It is further stated that the defendant No.1 is a school that the defendant No.2 to 5 intend to start. The defendant No.2 is a company incorporated on 02-04-1996 under the Companies Act, 1956. As per the domain name records available on the internet, the defendant No.2 is the registrant of the impugned website www.manipalschool-city.com which is being used by the defendant No.1. The

domain name has been registered only on 24-11-2018. As per the information available, the defendant No.2 has amalgamated into the defendant No.5 as per order dated 11-02-2011 passed by Hon'ble High Court of Karnataka in Company Petition No.223 and 224 of 2010. The defendant No.5 is a company incorporated on 09-02-1962 under the Companies Act, 1956. The defendant No.3 is the director of the defendant No.2 and 5 companies. The defendant No.5 is the registrant of the domain name 'mahe.org.in'. The defendant No.5 has registered the domain name by using the mark MAHE which is identical/ deceptively similar with the plaintiffs' registered trademark. The defendants are in violation of the plaintiffs' statutory and common law rights inter alia using marks- Manipal Academy of Health & Education, MAHE and MANIPAL GROUP on the impugned website www.mahe.org.in. The defendant No.4 was incorporated as a private limited company on 09-05-2007 under the Companies Act, 1956. The status of the defendant No.4 on the website of MCA is a non governmental company limited by shares. The defendant No.3 is shown as the director of the defendant No.4 company. The defendant No.4 has applied for the registration of the trademark 'Manipal International School' vide application No.3092002 which is

pending registration as has been objected to by the Trade Mark Registry. The defendant No.3 has executed the said application in the capacity of director of the defendant No.4 and the company is also being represented by the defendant No.3 in the application.

12. It is further stated that the defendant No.3 is the son of late T. Ramesh Pai and grand son of T. Upendra Pai, who is the brother of Dr. T.M.A. Pai. Dr. Ramdas Pai (the sole trustee of plaintiff Trust) is the son/direct descendant of Dr. T.M.A. Pai. The defendant No.3 is the director of the defendant No.2, 4 and 5. The defendants have wrongly represented on the impugned website www.manipalschool-ecity.com that “Manipal International Schools (MIS) are the premier schools from Manipal Group, which has been imparting world class education for over last eight decades and is rated as No.1 in education. Continuing the traditions and legacy with the same values and global education standards, Manipal group is opening a new campus in the name of Manipal International School – Electronic City, Bangalore.”

13. It is further stated that the plaintiff No.1 is branded and known as MAHE and/or Manipal Academy of

Higher Education Deemed University and/or Manipal University, was founded and established solely by Dr. Ramdas M. Pai with the primary objective of supporting and promoting of educational activities in all its branches. The plaintiff Trust has been established by way of a Deed of Trust dated 19-05-1993 executed by Dr. Ramdas M. Pai and registered on 22-05-1993. Dr. Ramdas M. Pai is the son of Dr. T.M.A. Pai, who was an eminent doctor, educationist, banker and philanthropist, and who had pioneered and established the university town of Manipal, Karnataka, India. Pursuant to registration of the plaintiff Trust on 22-05-1993, a Notification dated 01-06-1993 was published by the Central Government (Ministry of Human Resources Development) declaring Manipal Academy of Higher Education as deemed to be university. By virtue of the aforesaid notification, Manipal Academy of Higher Education consisted of:

- (a) Kasturba Medical College, Manipal and Associated teaching hospitals, Manipal.
- (b) Colleges of Dental Surgery, Manipal (now known as Manipal College of Dental Sciences)
- (c) College of Nursing, Manipal (now known as Manipal College of Nursing)

- (d) Kasturba Medical College and Associated teaching institutions Mangalore; and
- (e) College of Dental Surgery, Mangalore.

14. Notification dated 24-04-2000 by Ministry of Human Resource Development, Manipal Institute of Technology and College of Pharmaceutical Science were included under the ambit of Manipal Academy of Higher Education (MAHE), a deemed to be university for the purposes of University Grants Commission Act, 1956. As on the date, functioning under the chancellorship of Dr. Ramdas M. Pai, the plaintiff Trust operates inter alia 29 departments and colleges in Karnataka, most of them located in the town of Manipal. Since the grant of Deemed University status by University Grants Commission, the plaintiff Trust has been managing and running the Manipal Academy of Higher Education Deemed University, also popularly known as MAHE Deemed University and/or Manipal University. The institutions that fall under the plaintiff Trust and the activities that are connected therewith are now popularly known as 'MANIPAL UNIVRSITY' amongst the consuming public. Manipal University has become synonymous with quality education and it has at least 14 establishments and

sister concerns under its aegis and management. In recognition of quality education provided, administered and controlled by Dr. Ramdas Pai, the Government of Sikkim collaborated with the group working under Dr. Ramdas Pai and established 'SIKKIM MANIPAL UNIVERSITY' by an act of state legislature notified on 15-01-1995. Even the state recognizes the education being imparted by Dr. Ramdas Pai in the mark 'MANIPAL' being quality services. The plaintiff Trust, referred to and known as the Manipal Academy of Higher Education/ MAHE, ever since its inception has come to garner a reputation all over India and the world as one of the most prestigious institutes of learning. The plaintiff Trust has become synonymous with excellence in higher education. Since the year 2000, over 84,728 students from 57 different nations have studied and continue to study in the University township of Manipal and outside Manipal. Additionally, the University has nearly 2500 faculty and almost 10000 other support and service staff, who cater to the various professional institutions that operate under the plaintiff trust's supervision and management. In addition to the University township in Manipal, the university managed and run by the plaintiff Trust – Manipal Academy of Higher Education/MAHE has off-campus in Mangalore and

Bangalore, and off-shore campuses in Dubai (UAE), Nepal Manipal College of Medical Sciences and the Manipal Teaching Hospital) and Melaka (Melaka Manipal Medical College, Malaysia). The Mangalore campus offers medical, dental and nursing programs. The Bangalore campus offers programs in Regenerative Medicine. The Dubai campus offers programs in engineering, management and architecture and that the Melaka campus offers programs in medicine and dentistry. The University run by the plaintiffs Trust is known for its high quality educational facilities like the Simulation Lab with computer driven Manikins, an Innovation Centre, one of Asia's largest health sciences libraries, one of the world's best anatomy museums, a business incubation centre and various other centres of excellence. The University boasts of a plethora of international collaborations with the likes of the GlobalNxt University, Malaysia, and the American University of Antigua and other academic collaborations and twinning programs with several universities in the US, UK, Australia and other countries. Given its singular and unwavering dedication towards academic excellence, the University has established a unique brand value that is representative of the quality of the education institutes owned, managed and controlled by the plaintiff Trust. The

Manipal University has produced alumni that includes amongst other Mr. Satya Nadella, CEO of Microsoft Corporation, Mr. Rajeev Suri, CEO of Nokia and Mr. Sampat Shivangi, Chairman of the Mississippi Board of Mental Health. The said academic distinctions, international collaborations and facilities and the plaintiff Trust's commitment to its mission of encouraging and promoting education, have resulted in the Manipal University being recognized as a symbol of excellence and perseverance all across the world. Therefore, due to its commitment to quality, its focus on research and wide variety of courses that the Manipal Academy of Higher Education/MAHE Deemed University offers, the plaintiffs Trust has acquired an enviable reputation in a short span of time. The plaintiffs have met with appreciation world-wide and have often been ranked as amongst the premier private universities in India. The plaintiffs Trust has achieved several national and international awards, each of which reflects the reputation that it has garnered and the brand value that it has come to establish. The said awards and distinctions are reflective of the goodwill that the plaintiffs Trust has acquired on account of use of "Manipal" as an essential feature of the trademark/ service mark/ trade name/ logo/ label. This goodwill lends

itself to the registered and unregistered trademarks of the plaintiffs Trust. Besides being a trademark and its trade/corporate name, MAHE/Manipal Academy of Higher Education also forms an essential and integral part of plaintiff Trust's trading style. The said trade mark was adopted in the year 1993 and has been used continuously, openly and extensively since then. The said mark of the plaintiff Trust has amassed a colossal reputation not only in the field of education but among the people at large due to its numerous world-wide provision of high quality services and extensive promotional activities. The plaintiff Trust has executed numerous educational projects under the name MAHE/ Manipal Academy of Higher Education and / or Manipal University. The mark MAHE/ Manipal Academy of Higher Education is an integral mark for the plaintiff Trust and has acquired a secondary meaning qua the activities/ goods/ business/ services of the plaintiff Trust. A brand assessment survey report in respect of assessment of degree and awareness of brands in education and health space in India and association of the name Manipal in India was conducted by Ernst and Young along. The said survey report itself speaks volumes of the goodwill and reputation earned by the plaintiff Trust in respect of the services offered under

the mark Manipal. In addition to the mark/ acronym MAHE/ Manipal Academy of Higher Education, the plaintiffs coined and has been using trademarks/ trade name/ corporate name/ logo/ label of which “Manipal” is an essential feature with regard to education services. The marks of which “Manipal” is an essential feature has been continuously, openly and extensively used and promoted in relation to inter alia educational activities since its adoption. The plaintiff Trust has been the pioneer of advertising in its field and aggressively promoted its diverse educational activities, goods/services relating thereto, hospital sector and other products/activities under the mark(s) inter alia MAHE/Manipal Academy of Higher Education since the very beginning, with consistent and innovative advertising promotional campaigns through every possible media. The plaintiffs have obtained registration of the domain name “manipal.edu” and its mark(s) MAHE/Manipal Academy of Higher Education is prominently displayed on its website. Enormous effort and resources have been continually expanded to reach out to the members of trade and public, create awareness for the ever-expanding and diversified range of educational projects/products/services/activities of the Deemed University managed by the plaintiff Trust which are

offered under inter alia the trade mark(s)/name MAHE/ Manipal Academy of Higher Education/Manipal University, Manipal Inspired By Life (Label) and various other trade marks of which MANIPAL is the essential feature. Various Manipal formative trademarks have been used by the plaintiff Trust/its universities/sister concerns/constituents in all the advertisement and promotional materials, sign boards, office stationery, web site, print and electronic media advertisements including telecasted advertisements in national dailies. On account of such extensive advertising/ publicity along with long, uninterrupted, extensive, widespread, unique and exclusive use and display of the mark/name use of MAHE/Manipal Academy of Higher Education and/or other marks of which MANIPAL is an essential feature by the plaintiff Trust/its universities/ institutes/sister concerns for its activities/products/services under the said trade marks/name, the same have gained exceptional visibility, huge popularity and instant recognition globally and in India. The degrees awarded by the numerous institutions under the plaintiff Trust to its students also prominently bear the marks of which MANIPAL is an essential feature. The mark MAHE/ Manipal Academy of Higher Education/ Manipal University, Manipal Inspired by Life

(label) and / or Manipal alone or in conjunction with any other words/ name, has become absolutely, distinctive of and associated exclusively with the plaintiff Trust. Over the years the plaintiff Trust has spent huge amounts towards marketing of the trade mark MAHE/ Manipal Academy of Higher The annual promotional expenses incurred by the plaintiff trust for the period ranging from 1993-2018 for its numerous projects, goods and services under the trade mark(s)/name(s) mark/name of which MANIPAL is an essential feature, went on increasing and stood at Rs.2,334.99 lakhs for the year 2017-18.

15. It is further stated that the plaintiff's services are extensively promoted outside India under the marks of which MANIPAL is an essential feature. The plaintiff trust and/or its universities/entities associated with it and/or other entities forming part of the group under Dr. Ramdas Pai have registered numerous domain names with the mark/name "MANIPAL". It promotes its services under marks of which MANIPAL is an essential feature on the websites and the same are accessible by students across borders. The plaintiff Trust has obtained registration of the domain name "manipal.edu" on 27-09-1999. Manipal Universal Learning Pvt. Ltd., an

entity under Dr. Ramdas Pai and his direct descendant, obtained registration of the domain name “manipalgroup.com” on 22-12-1997 and has been offering services in the field of inter alia education on the said websites under inter alia the mark “Manipal inspired by Life (label)” openly and without any objection since the year 1997. The word/ name Manipal and the trademarks/ mark(s) MAHE/ Manipal Academy of higher education and/ or marks of which Manipal is the essential feature is the most valued intellectual property of the plaintiffs Trust. The said marks and the goodwill there therein lends itself to the registered and unregistered trademarks of the plaintiffs. In order to secure the statutory protection of the trademark MAHE/MANIPAL ACADEMY OF HIGHER EDUCATION, the MANIPAL ACADEMY OF HIGHER EDUCATION Deemed University managed and run by the plaintiff Trust registered and/or applied for registration of the Manipal Academy of Higher Education/MAHE trademarks in different classes under the Trade Marks Act, 1999 (hereinafter referred to as the Act) in India. The plaintiffs’ proprietary right in the mark(s) of which Manipal is the essential feature have been unequivocally acknowledged and accorded statutory protection by way of trade mark registrations in India, in

respect of diversity of goods and services. Manipal Academy of Higher Education Deemed University managed and run by the plaintiff Trust is the registered proprietor of inter alia MAHE/ Manipal Academy of Higher Education trade mark(s) and / or other marks of which Manipal is the essential feature in numerous classes. The plaintiff Trust has taken all the necessary steps to secure the mark MAHE/Manipal Academy of Higher Education in broad array of goods/services being used by it. The plaintiff No.2 is the proprietor of the following trade mark registration in Classes 16, 35, 41 and 42:

Sl.No.	Registration No.	Trade Mark	Class
1.	1319603	MAHE (Deemed University)(Device)	41
2.	1319604	MAHE (Deemed University)	42
3.	1319605	MANIPAL ACADEMY OF HIGHER EDUCATION DEEMED UNIVERSITY	41
4.	1319606	MAHE (Deemed University)	16
5.	1319608	MANIPAL ACADEMY OF HIGHER EDUCATION (DEEMED UNIVERSITY)	42
6.	1319609	MANIPAL INSPIRED BY LIFE (LABEL)	41
7.	1319610	MANIPAL INSPIRED BY LIFE (LABEL)	42
8.	1522820	MANIPAL UNIVERSITY	41
9.	1522822	MANIPAL UNIVERSITY	35

16. The above registrations for MAHE/Manipal Academy of Higher Education trademarks are duly renewed and/or are valid and subsisting on the Register of Trade Marks. In addition to the aforesaid registrations, the plaintiff Trust/its constituents/ universities/ associate/ sister concern has numerous other registration and applications, for registration of MANIPAL formative trademarks in various classes. To protect its proprietary rights in the trademark of which MANIPAL is an essential feature, it has taken action against violation of its common law and statutory rights in the said trademark. The plaintiff had caution notice published in the newspaper and had also filed an opposition numbered 930373 to the trade mark MANIPAL PRO applied for vide number 3681783 which was abandoned.

17. It is further stated that the plaintiff No.1 has conceptualised and used the trade mark Manipal Academy of Higher Education and the acronym MAHE and has been its prior user, lawful proprietor and legal owner since 19-05-1993. Since the incorporation and establishment, the plaintiff Trust and its constituents/institutes/sister concerns have been using the trade mark Manipal Academy of Higher Education/ MAHE and/or other marks of which MANIPAL is

an essential feature as a part of its corporate name/trade mark/trading style continuously, extensively and without any hindrance whatsoever. The plaintiff Trust has conducted all of its activities, including establishing and managing educational institutions and hospitals under the trade marks of which MANIPAL is essential feature.

18. It is further stated that the trade mark Manipal Academy of Higher Education and its abbreviation/acronym MAHE and/or other marks of which MANIPAL is the essential feature is distinctive of the activities and business of the plaintiff Trust its constituents/sister concerns alone and any reasonable members of trade and public are bound to associate the mark MANIPAL with the activities of the plaintiff Trust only. The annual admissions figures of the plaintiff/its constituents/institutes have been increasing every year from the year 2000 to 2018. The said figures speak volumes of the reputation gained by the plaintiff Trust in the mark Manipal Academy Of Higher Education and its abbreviation/acronym MAHE and/or Manipal Inspired By Life (Label) and/or other marks of which MANIPAL is the essential feature. The annual revenue of the plaintiff Trust in respect of services offered by it under its said marks of which MANIPAL is an essential

feature itself speaks volume of the brand value that the said marks have gathered by way of extensive and widespread use and is also indicative of the trade mark's popularity, goodwill and reputation. The MANIPAL has achieved secondary meaning in respect of educational services and denotes a particular level of quality only being provided by the plaintiff Trust. The word "MANIPAL", earlier a village in Mangalore District and now a block under Municipality Corporation limits of Udupi District, has on account of extensive and continuous use, transcended the location meaning and is associated with plaintiffs' educational services provided to the general public. In fact, as early as in the year 2004, Economic Times has published an article "Thinking beyond IIMS" which itself evidences the word MANIPAL having become synonymous of the plaintiff's services.

19. It is further stated that on account of the longstanding and continuous use of the trade marks the MAHE/Manipal Academy of Higher Education and/or Manipal Inspired by Life (Label) and/or other marks of which MANIPAL is the essential feature, the said trade marks symbolize the goodwill and reputation that is attached to the plaintiff Trust, the values it stands for and its activities in the

field of education and healthcare. Dr. Ramdas Pai Group has also for many years been running a school styled as “Manipal School”. Manipal School is affiliated to the Central Board of Secondary Education, India. Over the years, the school has achieved distinction in scholastic and co-scholastic areas and set new benchmarks for education in Mangalore. It is Dr. Ramdas Pai Group which is behind Manipal Hospitals, one of the India’s foremost multi-speciality healthcare providers catering to both Indian and International patients. It is part of the Manipal Education and Medication Group (under Dr. Ramdas Pai Group), a leader in the areas of education and healthcare. Dr. Ramdas Pai Group has established the Manipal Hospital in the year 1991 and since then has been running and managing the famous Manipal Hospital, situated in Bengaluru. Manipal Hospital is one of the largest healthcare brands in India. It is present in 7 Indian cities and has an international presence through two locations in Klang, Malaysia and Lagos, Nigeria. As one of the leading hospitals in India, it offers treatments and facilities across a wide range of specialities. Due to its emphasis on clinical excellence and a patient-centric approach, Manipal Hospitals has emerged as one of the top hospitals in the country, known for its quality and affordable health care. From many years, the plaintiff

Trust has been running and managing Manipal Hospital in Manipal. Under Dr. Ramdas Pai Group i.e., Manipal Global Education Services Private Limited (known and branded as Manipal Education) entered into a Memorandum of Understanding in the year 2007 with ICICI Bank Limited. ICICI Manipal Academy for Banking and Insurance (IMA), was established by the said entity under Dr. Ramdas Pai Group in the year 2008. More than 12,000 professionals had graduated out of the ICICI Manipal Academy Program in the year 2016. Over the years, the success of ICICI Manipal Academy led to many such joint initiatives between leading banks & financial institutions and Manipal Global, resulting in setting up of Manipal Academy of Banking with world-class residential campuses at Jaipur and Bengaluru. Manipal Academy of Banking, today partner with 25 leading banks, insurance and financial institutions – like ICICI Bank, Bank of Baroda, Punjab National Bank, Andhra Bank, Axis Bank and Kotak Mahindra Bank, HDFC Life, Janalakshmi Financial Services amongst others – and have trained over 25,000 professionals for leading banks, insurance and financial services organisations. Manipal Academy of Banking has established exceptional bench marks in enhancing the productivity by transforming the human capital of the banks, insurance and

financial institutions. The mark “MANIPAL” is employed by all the entities under Dr. Ramdas Pai Group in their field of activities, thereby, effectively treating the mark “MANIPAL”, as an integral mark for all the entities that fall under Dr. Ramdas Pai Group. The mark MANIPAL is also the house mark for all institutes/constituents under the plaintiffs. The said marks have achieved the status of a “well-known mark” in accordance with the section 2(zg) of the Act. Therefore, the said marks are entitled to absolute protection against any misuse/misappropriation across all categories of goods/services. Manipal Global Education Services Private Limited (under Dr. Ramdas Pai Group) is also the registered proprietor of trademarks as under used in education sector:

Sl.No.	Registration No.	Trade Mark	Class
1.	1860436	Manipal Education	35
2.	1860437	Manipal Education	41
3.	1860438	Manipal Education	42
4.	1860439	<u>MANIPAL</u> EDUCATION	35
5.	1860440	<u>MANIPAL</u> EDUCATION	41
6.	1860441	<u>MANIPAL</u> EDUCATION	42

20. The reputation established in an institution having a “geographical area” as part of its name gets associated with

the name of such university/institution and the two elements merge. In case a university is successful and and remains operative for a long period, the university's name gets attached to the geographical place. The students/alumni from such universities are immediately associated by members of public and trade with a particular standard. The name of the geographical place thereupon transcends the geographical meaning due to inter alia the continued performance of its alumni outside the said geographical area. The word MANIPAL has stopped being publici juris and has acquired a secondary meaning qua the plaintiffs. In particular having regard to the public interest involved in the field of education and healthcare sector, there can be no departure from the principle of there being only one mark, one source and one proprietor. Even as per the online databases of Intellectual property office UK and European Union Intellectual Property office, universities across the globe such as Cambridge, Standford, Harvard, Oxford, University of Barkley, Georgetown University, London School of Economics etc., which have a geographical name as its trade mark or as part of its trade mark, have been accorded statutory protection on acquiring secondary meaning.

21. It is further stated that the defendant No.3 had applied for registration of trade mark "MANIPAL GROUP" (Logo) vide No.659807. The plaintiff had filed an opposition being MAS – 58810 against defendant No.3's application. The said opposition as erroneously dismissed by the Registrar vide Order dated 27-02-2008 and defendant No.3's application for the logo "MANIPAL GROUP" was erroneously directed to be registered subject to amending the specification of goods in respect of 'Lottery Tickets included in Class-16" only. Against the erroneous dismissal of its Opposition No.MAS-58810, the plaintiff Trust filed an appeal numbered OA/71/2011/TM/CH before the Intellectual Property Appellate Board, which is pending final hearing.

22. It is further stated that the plaintiff No.2 has filed a suit bearing O.S. No.8204/2014, before the City Civil Court, Bengaluru, seeking inter alia a permanent injunction restraining Manipal Academy of Health & Education Private Limited from infringing and passing-off the plaintiff No.2's marks by using offending trademark and/or trading style Manipal Academy of Health & Education Pvt. Ltd., or any other deceptively similar trade name/trade mark. The plaintiff No.2 was constrained to file an interlocutory application

under Order VII Rule 10 of the Code of Civil Procedure, praying for return of plaint. The court was pleased to allow the application but directed the plaintiff No.2 to approach a particular forum. The plaintiff No.2 filed M.F.A. No.917 of 2017 before the Hon'ble High Court of Karnataka. The Hon'ble High Court by its order dated 28-05-2018 remitted the matter back to the trial court for fresh consideration. The Hon'ble High Court directed that the trial court while deciding the application shall first conclude as to whether the court has no jurisdiction to try the suit. Aggrieved by the order dated 28-05-2018, the plaintiff No.2 has filed Special Leave Petition before the Hon'ble Supreme Court of India. O.S. No.8204/2014 is still pending before the trial court.

23. It is further stated that on 29-01-2019, the plaintiff came across a newspaper advertisement in The Times of India, Bengaluru Edition in respect of admissions opening for the year 2019-20 Nursery to Grade VII for a new school "MANIPAL INTERNATIONAL SCHOOL"/ the defendant No.1. The article inter alia stated as follows:

*"Manipal International School (CBSE AND IGCSE)
Continuing the traditions and legacy of MANIPAL*

GROUP, Manipal International School Chandapur, Near Electronic City Now opens doors for young innovators. Registration forms can be downloaded from Website- www.manipalschool-ecity.com, www.manipal.school..”

24. The plaintiffs did a preliminary search in respect of the defendant No.1 / Manipal International School on the website www.manipalschool-ecity.com which revealed the following:

a) As per the domain name records, it is the defendant No.2 which is the registrant of the impugned website www.manipalschool-ecity.com. The domain name has been registered only on 24-11-2018. The defendant No.2 has amalgamated into the defendant No.5.

b) The said website makes the following claims:

“The legend in Education Now in Electronic City – Bangalore. Manipal International Schools (MIS) are the premier Schools from Manipal Group, which has been imparting world class education for over last eight decades and is rated as No.1 in Education, Continuing the traditions

and legacy with the same values and global education standards, Manipal group is opening a new campus in the name of Manipal International School – Electronic City, Bangalore.”

c) The plaintiffs learnt that not only have the defendants illegally adopted the mark MANIPAL in the field of education but also misrepresented being associated with the plaintiffs.

d) The defendant No.3 is admittedly not been engaged in the field of education. However, the defendants have falsely claimed that Manipal International Schools (MIS) are the premier Schools from Manipal Group, which has been imparting world class education for over last eight decades. In doing so, the defendants have sought to misrepresent that its nexus and/or association with the plaintiffs.

e) The website further claimed as follows:
“MIS advantage is our dedicated, qualified and trained expert faculty who are well equipped to inspire the students to strive for academic excellence, enable their holistic development

and opens myriads of opportunities for the development different facets of a Child's personality.

MIS is a center of world class education with a spectacular piece of architecture, placed in the arms of nature to ensure that learning is a joyous experience. MIS shapes young learners into global citizens by providing comprehensive education system keeping in view the country's rich heritage, cultural background and be resilient to the demands of 21st century.”

f) Despite having been erroneously granted registration in respect of the “MANIPAL GROUP (logo)” only in respect of lottery tickets in Class 16, the defendants are illegally and blatantly using the mark/name “MANIPAL GROUP (logo) on the website www.manipalschool-ecity.com for all its alleged business / activities in the field of education. Its appeal is pending before the Intellectual IPAB – OA.71/2011/TM/CH that the registration of mark Manipal Group (Logo) is erroneous, the aforesaid is a complete misuse of the rights accruing to a registered proprietor on account of registration which relates only to the goods in respect of which registration has been obtained.

g) The plaintiffs also came across an advertisement wherein, the defendant No.3 projected as Chairman, Manipal Group and Manipal Academy of Health & Education (MAHE) is stated to be inaugurating Manipal International School/ the defendant No.1 on 17-02-2019.

25. It is further stated that the plaintiff Trust came across a letter dated 15-07-2004 written by the defendant No.3 to the Principal Secretary, Prime Minister's office wherein he has chosen an acronym – MAHE and a trade mark – MANIPAL ACADEMY OF HEALTH AND EDUCATION – identical with that of the plaintiff Trust. The Kasturba Medical College is a constituent of the plaintiff Trust and managed by the plaintiff Trust. Despite having no association with the plaintiffs, the defendant No.3 with a malafide intention to ride upon the goodwill and reputation earned by the plaintiffs and its constituents / associates / entities, tried to sail as close as possible to the plaintiffs by falsely seeking to rely upon the experience and reputation of Kasturba Medical College, Manipal (of the plaintiff Trust) and Manipal Hospital, Bengaluru (an entity of Dr. Ramdas Pai Group). The defendant No.3 made an effort to create confusion at the highest office of the country. In fact, based on the aforesaid

correspondence, it has emerged that further directions were given by the Prime Minister's office to Ministry of Health and Family Welfare.

26. It is further stated that the defendant No.3 was at all times completely aware of the activities of the plaintiff Trust under the plaintiff's mark MAHE/MANIPAL ACADEMY OF HIGHER EDUCATION. In fact, while dealing with the similarity and prior adoption of the mark – MAHE/MANIPAL ACADEMY OF HIGHER EDUCATION vis-a-vis the trade mark “MANIPAL GROUP (logo)” applied for by the defendant No.3. Despite having complete knowledge of the activities of the plaintiff Trust in the field of education, the defendant No.3 has with a malafide intention made all possible efforts to use a mark identical and/or deceptively similar to the plaintiffs' marks in order to associate itself with the plaintiffs amongst the members of public, trade and consumers. In Opposition – MAS No.58810, it was set up that the services and business of plaintiff Trust and that of the defendant No.3 herein having nothing to do with each other.

27. It is further contended that it is evident that it is not a mere co-incidence that the defendants intend to start a

school under the impugned marks/names/acronym MANIPAL INTERNATIONAL SCHOOL and MIS. It is clear that the defendant No.3 had complete knowledge that the plaintiffs are the prior user as well as the adopter of the mark "MANIPAL" in the field of inter alia education. The defendants intentionally adopted the marks which are visually, structurally and phonetically identical and/or deceptively similar to the plaintiffs' trade marks/ name, but is claiming to use the same in respect of a field identical to those of the plaintiffs. The defendant No.3 has illegally, with a view to ride upon the goodwill earned by the plaintiffs, also used the name/mark MANIPAL GROUP in respect of inter alia education. The malafide intention, fraudulent and deliberate adoption despite complete knowledge and the conduct of the defendants of having slavishly copied the plaintiffs' mark in respect of an identical field clearly establishes the defendants' malafide intent to encash upon the plaintiffs' name and goodwill and brand identity vesting in plaintiffs' mark / name of which MANIPAL is the essential feature. The field of services of the defendants is identical to those of the plaintiffs as both are related to inter alia education; consequently, there exists a clear trade connection. The said acts of the defendants lead to an irrefutable legal presumption of

existence of confusion in the members of trade and public. The enormous reputation of the plaintiffs in its business/ products/ services under the MAHE/MANIPAL ACADEMY OF HIGHER EDUCATION/MIS trademarks and/or other marks of which MANIPAL is the essential feature internationally as well as in India, coupled with the fact that the said marks of which MANIPAL is the essential feature was registered and well-known at the time of defendants' alleged adoption. The defendants are deemed to have been aware of the plaintiffs' registered and famous trade mark/name in and the goodwill and trust enjoyed by the plaintiffs in marks of which MANIPAL is the essential feature same. The defendants apparently have no justifiable or plausible reason for adopting the mark MANIPAL INTERNATIONAL SCHOOL and/or the acronym MIS and/or MANIPAL GROUP and/or any other mark of which MANIPAL is the essential feature except having copied plaintiffs' well-known trade mark/name. The dishonest, intentional and illegal adoption/use of the impugned marks/name by the defendants are driven purely by its malafide intention to encash upon and exploit the goodwill and reputation of plaintiffs' prior and well-known trade mark/ name, project to the members of trade and public that its products and/or services emanate or enjoy the

backing/approval of the plaintiffs and derive unjust enrichment /gains therefrom.

28. It is further stated that The defendants have no locus to adopt under/or use MAHE/Manipal Academy Of Health and Education and/or MANIPAL GROUP which is identical and/or deceptively similar to the plaintiffs' registered and reputed trade mark/name MAHE/ MANIPAL ACADEMY OF HIGHER EDUCATION and other marks of which MANIPAL is the essential feature in any manner whatsoever and that it deserves to be restrained forthwith from using the same to represent its business/services. The use of the plaintiffs' trademark by the defendants is a clear case of infringement and passing off. The defendants are trying to associate themselves to the general public as if they are promoted by the plaintiffs and the use of the impugned trademarks "MANIPAL INTERNATIONAL SCHOOL" and/or MIS and/or MANIPAL GROUP and/or MAHE and/or MANIPAL ACADEMY OF HEALTH AND EDUCATION and/or other marks of which MANIPAL is the essential feature or any other similar mark thereto, creates confusion in the general market. The acts of the defendants are in violation of the plaintiffs' exclusive statutory and proprietary rights in the registered and reputed

trade mark name MIS/ MAHE / MANIPAL ACADEMY OF HIGHER EDUCATION and/or other marks of which MANIPAL is the essential feature and render it liable for inter alias Infringement of trade mark; Infringement by dilution; Passing off: Acts of unfair competition and Payment of Damages.

29. It is further stated that the plaintiffs have no other equally efficacious remedy but to approach this court and both equity and balance of convenience are in their favour and the relief sought is reasonable and necessary to protect their intellectual property rights. If the I.As. are not allowed, the plaintiffs will suffer irreparable loss and their reputation is likely to suffer tremendous damage. No prejudice will be caused to the defendants if the I.As. are allowed. Hence, the plaintiffs have sought for allowing the applications.

30. Upon the motion of the plaintiffs, the court vide order dated 21-02-2019 has granted ex parte T.I. restraining the defendants from infringing the plaintiffs' registered trademark like 'MAHE' or 'Manipal Groups' in conjunction with any other words or monogram or logo as their trademark, service mark and advertisement for their services or business papers. The said interim order was granted till

the defendants appear and file written statement. The said order was extended from time to time till this day.

31. The defendant No.3 has filed written statement and adopted it as objections to I.A.No.I to VI. It is his defence that the Manipal Group was founded by Sri. T.M.A. Pai and his brothers in the year 1953. The defendant No.3 is the grandson of T. Upendra Pai, who was the brother of Sri. T.M.A. Pai. Not only was T. Upendra Pai himself an administrator of the original Manipal Group of Companies, but his son and the defendant No.3's father, Ramesh Pai and the defendant No.3 herein, went on to promote and manage some of the premiere business in the country including the world famous mattress company "Kurlon Ltd.," which manufactures and sells the Kurlon brand of mattresses, furniture and upholstery.

32. It is further contended that Dr. Ramdas Pai, the Chancellor of the plaintiff Institution and the defendant No.3, both belong to the famous Pai family hailing from Manipal. The origin of the Pai family to whom both Dr. Ramdas Pai and the defendant No.3 belong to can be traced to Tonse Anant Pai. The said Tonse Anant Pai had 4 sons namely P. Pai,

Upendra Pai, Madhava Pai and T.R.A. Pai (hereinafter collectively referred to as “the Pais of Manipal”). The 3rd son of Tonse Anant Pai i.e., Madhava Pai was a graduate of medicine and established a prosperous practice at Udupi, Karnataka. The said Madhava Pai along with his brothers, P. Pai, Upendra Pai and T.R.A. Pai went on to establish numerous successful finance companies, insurance companies, educational institutions, medical colleges and hospitals in and around a locality now known as Manipal, close to Udupi. As a result of the enterprise, hard work and ingenuity of the ancestors of the defendant No.3 and the said Dr. Ramdas Pai, the place Manipal which was until then a small locality near Udupi, became an economic hub housing industries, financial institutions, educational institutions and medical establishments. The contribution of the ancestors of both Dr. Ramdas Pai and the defendant No.3 are well documented in the acclaimed book ‘Pais of Manipal’ by Selden Manefee. Out of the 15 businesses set up by the Pais of Manipal, 9 businesses had adopted the word “Manipal” as part of their corporate name. In addition to the said businesses, the Pais of Manipal also set up educational institutions including medical colleges through the public charitable trusts including the Manipal High School Trust in

which, the father of the defendant No.3 was a trustee. Though the plaintiffs admit that the said Dr. Ramdas Pai and the defendant No.3 are related, they have deliberately suppressed the fact that the term “Manipal” achieved the reputation due to the collective efforts of all of the Pais of Manipal and not just the father of Dr. Ramdas Pai i.e., the Late T.M.A. Pai. Therefore, assuming that the name “Manipal” is no longer the name of a place alone and has in fact acquired a secondary meaning as a trade mark, such secondary meaning has become synonymous with all the Pais of Manipal as a whole and not to any single member of the Pais of Manipal. Such being the case, the trade mark “Manipal” cannot be singularly appropriated by the plaintiffs but in fact remains the property of all the descendants of the Pais of Manipal, who inherited the said trade mark without limitations or restrictions. On account of certain disputes that arose between the defendant No.3’s father and the said Dr. Ramdas Pai and his family, the businesses comprising of the “Manipal” group of companies came to be split under “Ambani Accord”. As a result of this split, the defendant No.3 and his father were allotted control over the following among other companies, constituting the Manipal Group:

- a. Maharashtra Apex Corporation Limited.
- b. Canara Steel Limited.
- c. General Investment and Commercial Corporation of India Limited.
- d. Manipal Springs Ltd.
- e. Manipal Home Finance Limited.
- f. Rajamahal Hotels Limited.

33. The said accord which was arrived at on 04.11.1993 due to the intervention of the family friends of the Pais of Manipal including Mr. Dhirubai Ambani, Mr. Virendra Heggade, Dharmadikari of Dharmasthala and Mr. C.Subramaniam, Former Union Minister of Union of India and Former Governor of Maharashtra, neither allotted the name Manipal exclusively to the plaintiffs or Dr. Ramdas Pai or to his ancestors nor did the plaintiffs or Dr. Ramdas Pai claim any exclusive rights to the mark Manipal during the discussions preceding the said Accord. Certain companies that had fallen onto the children of the Late Dr. T.M.A. Pai i.e., Dr. T.V. Mohandas Pai and the said Dr. Ramdas Pai, filed 3 law suits before the Hon'ble Madras High Court in CS No. 19, 20 and 21 of 1996 against companies promoted by the defendant No.3 and his father, including Manipal Stock and

Share Brokers Ltd., seeking inter alia, a permanent injunction against inter alia the defendant No.3, restraining him and anyone claiming under him from using the word “Manipal”. Along with the said suits, the plaintiffs therein sought for the relief of temporary injunction against inter alia the defendant No.3 restraining him and persons claiming under him, from using the term “Manipal”. The Hon’ble Madras High Court has dismissed the applications for temporary injunction. The said judgment of the Hon’ble Madras High Court was not assailed in appeal by the Chancellor of the plaintiffs or any of his companies or family members and therefore, has reached finality.

34. It is further contended that the plaintiff Trust admittedly was constituted by the said Dr. Ramdas Pai by way of a Deed Trust dated 19.05.1993 and thus, preceded the Ambani Accord which was arrived at on 04.11.1993. Therefore, the plaintiffs having failed to either claim an exclusive right to the term “Manipal” during the discussions preceding the Ambani Accord or having been awarded any such right in the Ambani Accord, cannot now, under the guise of the above suit, seek to restrain the defendants from using the word “Manipal”. Consequently, the claim of the

plaintiffs is untenable and is an effort to illegally and surreptitiously defy the findings of the Hon'ble Madras High Court in the judgment cited supra. On the other hand, the defendants' use of the term "Manipal" is squarely supported by the fact that the defendant No.3, his father and his grand father, being members of the family of the Pais of Manipal have acquired indisputable and unqualified rights, interest and title in the mark "Manipal". The defendant No.3's right to compete with the business and institutions set up by the said Dr. Ramdas Pai has been specifically upheld by the Hon'ble Madras High Court.

35. It is further contended that the plaintiffs have not approached the Court with clean hands. The plaintiffs have disclosed 2 legal proceedings namely O.A. No.71/2011/YM/CH and O.S. No.8204/2014 as matters connected to the use of the term "Manipal", but they have deliberately suppressed the judgment of Hon'ble Madras High Court with the sole intention of misleading this Court. They had instituted suits in O.S. No.8203 and 8204 of 2014 which, in turn culminated into appeal proceedings in MFA 916 and 917/2017 and MFA 2271 and 2272/2017 against 2 companies promoted by the defendant No.3, in which the defendants

therein had, in their pleadings, set out the factum of the said judgment of the Hon'ble Madras High Court. Further, the issue of the plaintiffs' challenge to the Charitable Company using the word "Manipal" for its service is also pending adjudication before the City Civil Court in O.S. No.8204/2014.

36. It is further contended that the trade mark "Manipal Public School" has been registered by Manipal Academy of Health and Education (a society) in the year 1995 itself. Subsequently, the defendant No.3 got incorporated another company, Manipal Academy of Health and Education Pvt. Ltd., on 09.05.2007 (hereinafter referred to as "The Charitable Company) which has been converted into a company for charitable purpose under Section 8 of the Companies Act, 2013 from March 2018. The Charitable Company is arraigned as a defendant in O.S. No.8204/2014 by the plaintiff No.2. Though the plaintiff had knowledge of the said trade mark "Manipal Public School", they did not claim any remedy in respect thereof in O.S. No.8204/2014. The trade mark "Manipal International School" is an extension of the defendant's right to use the term "Manipal" to compete with the plaintiffs as held in the judgment of the

Hon'ble Madras High Court. Having acquiesced with the use of "Manipal Public School" by Manipal Academy of Health and Education, a company incorporated by the defendant No.3, the plaintiffs cannot now challenge the use of the trade mark "Manipal International School" by any of the defendants or by any entity incorporated by them. The predecessor to the Charitable Company, Manipal Academy of Health and Education Society was constituted as early as 1995. Therefore, the plaintiffs have committed an inordinate and inexplicable delay in bringing the present suit and the suit in O.S.No.8204/ 2014 challenging the use of the word "Manipal" by the defendant No.3 or a company incorporated by him.

37. It is further contended that the grandfather of the defendant No.3, the late Tonse Upendra Anant Pai co-founded the Manipal Group of businesses and educational institutions along with late Dr. T.M.A. Pai. The late Tonse Upendra Anant Pai was not only a spirited and able entrepreneur but closely followed the nationalist movement in the country led by none other than Mahatma Gandhi. As a founder of Syndicate Bank, he spearheaded the banking revolution in India and contributed immensely to the sustenance and growth of the cottage and hand loom industry. As a member of the Manipal

High School Trust, he leveraged his entrepreneurial skills and financial acumen to drive the educational initiatives of the Pais of Manipal. In recognition of his contribution to social initiatives, the Upendra Pai Memorial college in Manipal is named after the late Tonse Upendra Anant Pai. The late Tonse Upendra Anant Pai had 8 children including the late Ramesh Pai and the late T.A. Pai, who not only went on to play integral roles in the success of the businesses of the Pais of Manipal, but actively contributed to the cause of dissemination of education. Not only was the late Ramesh Pai instrumental in the setting up of Kasturba Medical College, but he was also responsible for setting up Academy of General Education which housed 25 different educational institutions including the acclaimed school of Music and Fine Arts, College of Dental Surgery, College of Pharmaceutical Sciences, Manipal Institute of Technology, Vaikunta Baliga Law College and Sharada Residential School. In recognition of his contribution to the world of education, the late Ramesh Pai was also a member court of Goa University, member syndicate of Mysore University, member of senate of Madras University, member senate of Mangalore University and Chairman of Vidhyadhiraj Theerth Charitable Trust. In addition to his contribution to the world of education, the late Ramesh Pai

also co-founded numerous health care enterprises including the Karturba Medical College and Hospital, Manipal, College of Dental Surgery, Manipal and Mangalore, Dr. T.M.A. Pai Health Complex Udupi, Dr. T.M.A. Pai Rotary Hospital Mangalore, Manipal Hospital Bangalore, Rural Maternity and Child Welfare Centre (7 Centres), Karkala Health Project and Maternity Hospital, Manipal Artificial Limb Centre, OEU Institute of Ophthalmology. The defendant No.3 himself, who holds a degree in Engineering and Management, not only actively worked with the late Ramesh Pai on the aforesaid initiatives, but started his own independent journey as an entrepreneur in the year 1990 by setting up the business of stockist and distribution of government lotteries under the name and style of Manipal Group. Having inherited, enhanced and carried forward the legacy of the late Tonse Upendra Ananth Pai and the late Ramesh Pai in the field of education and health care, the defendant No.3 is entitled, both by virtue of the use of the trade mark "Manipal" by him and his predecessors in title and by virtue of the judgment of the Madras High Court cited supra, to adopt, use and commercially leverage the name "Manipal" for any activity or business, whether, in the field of education and/or healthcare or otherwise. Such being the case, in the wake of the internal

disputes among the families of Pais of Manipal, with the intention of carrying forward the legacy in education and healthcare set up by the defendant No.3, his father and his grand father, the Manipal Academy of Health and Education, was registered as a society in the year 1995. Subsequently, a private limited company was incorporated in the year 2007 under the name and style of Manipal Academy of Health and Education Pvt. Ltd., which has, with effect from the month of March, 2018, become a company for Charitable purpose under Section 8 of the Companies Act, 2013. The said Charitable Company has honestly adopted and registered the trademarks “Manipal Group” and “Manipal Public School” as seen from the certificate of registration bearing numbers 659807 and 1335585 issued by the Registrar of Trademarks under the provisions of the Trade and Merchandise Marks Act, 1958 and Trade Marks Act, 1999. The said Charitable Company has, with the intention of setting up premier institutions for providing excellence in school education, also honestly conceived and adopted the trademark “Manipal International School” and has also filed an application seeking registration of the same vide application No.3092002. The Charitable Company has in turn set up Manipal International School branches in Anantpur (Andhra Pradesh)

and Electronic City (Bangalore). In both locations, the schools of the Charitable Company boast of a sprawling campus spread across several acres of land in which students get access to world-class infrastructure, education consistent with international best practices and safety and security. The Charitable Company has now embarked on the journey of leveraging the long legacy and history of the defendant No.3 and his family with education to manage and run world class primary, secondary and high schools under the name of style of Manipal International school. Though the defendant No.3 is not actively involved in the day to day management and operations of the Manipal International Schools, they have not only become well-known, but given the legacy of the defendant No.3 and his family in the field of education, the launch of the Electronic City Campus was even covered by the Times of India on 29-01-2019 as admitted in the plaint. In addition, the website of Manipal International School adequately clarifies the history of family of the defendant No.3 in the field of education. This clearly demonstrates that not only does the said Manipal International Schools have an independent reputation of its own, but the use of the said trade mark or the representations contained in the said website do not qualify as either infringement of the plaintiffs'

trade marks or as passing off the plaintiffs trade mark as that of the defendants herein.

38. It is further contended that the entire purpose of setting up the Manipal International Schools is to provide education of international quality at an affordable price to the students. It is also the defendant No.3's vision to subsidize the cost of education for worthy students who are otherwise unable to afford such education on account of their socio-economic context and circumstances. From the time of the defendant No.3, his father and his grand father, that the defendant No.3's family has firmly believed that ensuring availability of quality education at primary, secondary and high school levels is critical for the growth of the country and the upliftment of India's underprivileged communities. Therefore, not only is the defendant No.3 and the other defendants entitled to use the mark "Manipal" to advance the cause of providing education, but the defendant No.3's efforts will do justice to his family's contribution to the world of education and thus greatly enrich the brand of "Manipal" and ensure it is remembered for having contribution to the lives of many children from all socio-economic backgrounds, in a positive manner. The plaintiffs have not made out a prima

facie case and they are not entitled for the reliefs sought for. Hence, he has sought for dismissal of the I.As. with costs. On the similar grounds, the defendant No.3 has filed I.A.No.VII and sought for vacating the order granting exparte ad-interim relief dated 21.02.2019.

39. The defendant No.4 and 5 have also filed written statement and adopted it as objection to the I.A. No.I to VI contending that the I.As. are false, frivolous and untenable in law and on facts. The plaintiffs have not approached this Court with clean hands. The plaintiffs have arraigned them in the suit with the sole intention of harassing them. The plaintiffs have suppressed material facts.

40. It is contended that the defendant No.4 is a company incorporated on 09.05.2007 as private limited company under the provisions of the Companies Act of 1956 and subsequently has been converted into a company incorporated for Charitable purpose under section 8 of the Companies Act, 2013. The name "Manipal" is the name of a locality in the town of Udupi and is commonly used as the name of a number of businesses in a variety of industries and sectors. The defendant No.4 is promoted by the defendant

No.3. The defendant No.3 and author of the plaintiffs Trust, Dr. Ramdas Pai belong to the illustrious families of the late Tonse Upendra Ananth Pai and his brother, the late T.M.A. Pai, who jointly founded a number of businesses and institutions under the name and style of "Manipal". Therefore, the plaintiffs' assertion to the use of the word "Manipal" is no different or better than the defendant No.4's right to use the said word. Consequently, the plaintiffs have no right to claim exclusive rights to use the word "Manipal" and it also does not have any registration for the word "Manipal" per se under the provisions of the Act. Accordingly, the plaintiffs also do not have the right to challenge the defendant No.3 or 4 or any person from using the word "Manipal". The defendant No.4 is one of 80 odd companies (as borne by the records of the Registrar of Companies) that have adopted the name "Manipal" as part of the company name. The defendant No.4 is primarily engaged in advancing the Charitable Objective of disseminating health care services and education at highly subsidized cost to all members of the society irrespective of cast, class, religion and creed and is also an affiliate of the defendant No.3. It is has honestly conceived and adopted the term "Manipal" as part of its name since the date of its incorporation in the year 2007 and has been using the same

continuously for a period of close to 13 years without any let or hindrance from any person. The conception and adoption of the term “Manipal” for its own name as well as for its various trademarks is lawful, bonafide, honest and beyond question by any person including the plaintiffs. The record and documents pertaining to the said educational initiatives are not in the possession of the defendant No.4, but in the possession of the respective affiliate entities that are running the same.

41. It is further contended that the defendant No.3 and the said Manipal Group has been continuously engaged in the field of education since the time of late Tonse Upendra Ananth Pai. The defendant No.3 and his father together with the authors of the plaintiffs’ Trust i.e., Dr. Ramdas Pai all belong to the families of the Original Pais of Manipal. The Original Pais of Manipal neither intended to nor allocated exclusively the mark “Manipal” or the connected various educational and business initiatives to any of the family members. The same is borne by the fact that the family members of the late Tonse Upendra Ananth Pai i.e., the late T. Ramesh U. Pai and Sri. T. Sudhakar Pai established and

managed several educational and health initiatives of the Original Pais of Manipal including the following:-

- a. Academy of General Education
- b. Hindu Orphanage
- c. College of Dental Surgery, Manipal
- d. College of Dental Surgery, Mangalore
- e. Manipal College of Education
- f. Vaikunta Baliga Law College
- g. Manipal Hospital
- h. Dr. TMA Pai Health Complex
- g. Manipal Artificial Limb Centre

42. It is further contended that the plaintiffs cannot claim monopolistic right to use the mark "Manipal". However, due to irreconcilable differences between the descendants of Dr. TMA Pai and descendants of late Tonse Upendra Ananth Pai, the businesses and educational institutions of the Original Pais of Manipal came to be split among the said descendants with involvement and assistance of Mr. Dhirubai Ambani, Mr. Virendra Heggade, Dharmadikari of Dharmasthala and Mr. C Subramaniam, Former Union Minister of Union of India Former Governor of Maharashtra. In the course of the split neither the authors of the plaintiffs

Trust nor any other descendants of the Original Pais of Manipal were allotted the exclusive use of the mark 'Manipal' nor did any of the said descendants successfully assert exclusive rights to the use of the said name. Therefore, the plaintiffs who claim to derive its rights to use the word 'Manipal' from the descendants of the Original Pais of Manipal does not have either exclusive rights or better rights to the said name as against the defendant No.4 or any other members of the Manipal Group. In this connection, the author of the plaintiff Trust, the said Dr. Ramdas Pai along with several of his companies instituted the suit in CS No.19, 20 and 21 of 1996 before the Hon'ble Madras High Court against the defendant No.3 and his companies. Though the said suit remains pending even as on date, the efforts of the plaintiffs in the said suit to secure ad interim injunction restraining the defendant No.3 from using the mark 'Manipal' failed. The judgment of the Hon'ble Madras High Court has attained finality.

43. It is further contended that the word 'Manipal' is commonly used and cannot be exclusively appropriated by the plaintiffs. Being an initiative of the defendant No.3, who along with his father and grandfather has been using the word

'Manipal' continuously for educational services, the defendant No.4 has a legitimate right to use the said name for its education institutions and as a part of its corporate name. The plaintiffs having acquiesced the said usage of the word and mark 'Manipal' cannot now challenge the defendants' right to use the same. Schools are established by the defendant No.4 and is in continuous usage of the mark 'Manipal'. Accordingly, the defendant No.4 is not only entitled to, but has actually entered into franchise agreements with various persons across the country to set up and run a number of schools under the name and style of 'Manipal Global School', and 'Manipal International School'. The defendant No.4 affiliate company has honestly adopted and registered the trademark "Manipal Group". The defendant No.4 itself has applied for registration of the trademarks "Manipal International School" and "Manipal Global School". In fact, the Manipal International School set up by the defendant No.4 has even become well-known for its standard of education and infrastructure and the same is borne by the fact that the launch of the Manipal International School at Electronic City, Bangalore was widely covered by the Times of India on 29-01-2019 as admitted in the plaint. The said Manipal International School has also won numerous awards

and has received extensive press coverage. Owing to the Charitable motives and intent of the defendant No.3 and his father, the late T. Ramesh U Pai, all the educational initiatives of the defendant No.3 and 4 have focused exclusively on disseminating education as a form of social service and not as a business initiative. As a result, the defendant No.4 and 5 initiatives in the field of education have built strong relationships in the local communities they operate in. The intended beneficiaries of their educational initiatives are those who seek access to quality education at subsidized costs as opposed to the plaintiffs whose sole focus has been to build profitable enterprises in the name of education and health.

44. It is further contended that far from appreciating the modest and humble approach of the defendant No.3 and 4 and their educational initiatives, the plaintiff has sought to compare the defendants' charity based approach to its educational initiatives with its own business savvy approach focused heavily on extensive marketing and promotion of its educational institutions and unaffordable fee structures, to belittle not only the defendant No.4 and 5 right to use the mark "Manipal", but also to undermine their efforts to

disseminate education at subsidized price. As the defendant No.3 and 4's approach to the field of education is more in line with the vision of the original Pais of Manipal who saw health and education as key to India's freedom colonial rule and success, the defendant No.3 and 4's use of the mark "Manipal" for their educational initiatives is more in line with the vision of the Original Pais of Manipal and the plaintiffs have no right to prevent the defendant No.3 or 4 from using the said mark. This also goes to show that the markets in which the defendant No.3 and 4's educational initiatives operate in is different from the plaintiffs intended market. There is no confusion caused by the usage of the mark "Manipal" by the defendant No.3 and 4.

45. It is further contended that the defendant No.4 has also continuously used the mark "Manipal" since the date of its incorporation. The defendant No.4 has been in the field of education and pursued its own objectives is also borne by the Auditor's report dated 26.06.2019, director's report providing financial summary for the years 2017-18 and 2018-19 and extracts of annual return for the year 2018-19. The defendant No.4's trademark including but not limited to 'Manipal International School', 'Manipal Academy of Health and

Education', 'Manipal Group' and 'MAHE' and have also been in active and continuous usage as evidenced by the fee receipts for the "Manipal International School" it operates in the Ananthpur for the year 2019-20. The plaintiff Trust initially instituted suit in OS No.8204/2014 against the defendant No.4 alleging infringement of the mark 'Manipal'. However, the plaintiffs not only failed to secure ad interim injunction against the defendant No.4 herein but filed an application under Order 7 Rule 10 of Code of Civil Procedure, on the ground that courts at Bangalore did not have jurisdiction to entertain the same. Subsequently, the plaintiffs and the defendant No.4 preferred M.F.A. 916 & 917/2017 and MFA 2271 and 2272/2017 against the order of the City Civil and Sessions Judge Bengaluru, allowing the application filed by the plaintiffs. The Hon'ble High Court of Karnataka vide judgment dated 08.05.2019 allowed the appeal filed by the defendant No.4 herein, against which the plaintiffs filed a special leave petition before the Hon'ble Supreme Court which is pending even as on date. Having failed to secure any relief against the defendant No.4 in the said suit, the plaintiffs have engaged in forum shopping by instituting the present suit against the defendant No.4, that too, by suppressing the information that it is the defendant No.4 and not defendant

Nos. 1 to 3 who is the proprietor and the user of the trade mark "Manipal International School". The plaintiffs have also deliberately suppressed the aforesaid judgment of the Hon'ble Madras High Court in CS. Nos.19 to 21 of 1996 with the sole intention of misleading this court into granting the reliefs of permanent and temporary injunction. Therefore, not only does the defendant No.3 have a legitimate right to use the mark impugned in the above suit, but the plaintiffs by virtue of its inequitable, unfair and unethical conduct and having not approached this Court with clean hands are disentitled to any relief let alone the reliefs of permanent injunction, damages and accounts of profits sought for in the above suit.

46. It is further contended that the defendant No.4 was incorporated in the year 2007. Its predecessor, Manipal Academy of Health and Education Society was constituted as early as 1995. The defendant No.4 who is a family member of the late Tonse Upendra Anath Pai, is entitled to use the mark and the plaintiffs do not have any right to restrain him or the other defendants from using the same. Therefore, filing the suit in the year 2014 vide O.S. No.8204/2014, the plaintiffs have committed an inordinate and inexplicable in bringing, both the present suit as well as the suit in O.S.

No.8204/2014. Furthermore, despite being aware of registration of the trademark “Manipal Public School” in the year 2005 itself, the plaintiffs did not claim any remedy in respect thereof in O.S. No.8204/2014. The trade mark “Manipal International School”, is an extension of the defendant No.4’s right to use the term “Manipal” to compete with the plaintiffs as held in the judgment of the Hon’ble Madras High Court cited supra. Having acquiesced with the use of “Manipal Public School”, the plaintiffs cannot challenge the right of the defendants to use the mark “Manipal International School” by any of the defendants. Furthermore, the trademark registered by the plaintiffs is not just the term “Manipal” but ‘Manipal Academy of Higher Education’. It is settled law that when a trade mark consists of several parts, registration if any, is conferred for the trade mark as a whole and not to its individual parts. Especially where the trade mark consists of a part which is generic or descriptive or the name of a place, the registration of the whole of the mark does not confer any exclusive rights to its components. In the instant case also, the plaintiff has not secured any registration of the mark “Manipal” per se. Therefore, when the mark of the plaintiffs is compared with the marks of the defendant No.4 in a proper perspective, the defendants’ marks

are distinctive and neither cause any actual confusion nor can the plaintiffs justify the allegation of the likelihood of such confusion.

47. It is further contended that the defendant No.2 that was incorporated under the provisions of the Companies Act, 1956 in the year 1996 ("1996 Company"), got amalgamated with the defendant No.5, a company primarily engaged in the manufacture and sale of mattresses, in the year 2011 pursuant to the order dated 11.02.2011 passed by the Hon'ble High Court of Karnataka. The defendant No.5 is a well known brand for its fleet of upholstery and furniture products and has achieved critical acclaim for its quality of goods. In addition, the defendant No.5 supports a number of charitable initiatives including the educational initiatives of the defendant No.3 and 4, their affiliates as part of its corporate social responsibility programs. A company by the name of Manipal E Commerce Limited appears to be incorporated on 08.01.2018 ("2018 Company"), which is not a party to the above suit. The domain name manipalschool-city.com as admitted by the plaintiffs appears to have been registered in the name of one Manipal E-Commerce Limited on 24.11.2018. Whereas the 1996 company, by virtue of

amalgamation with the defendant No.5 in the year 2011 ceased to be in existence as on the date of registration of the domain name being 24.11.2018. The plaintiffs have not produced any material whatsoever to clarify whether the domain name registered on 24.11.2018 is registered in the name of the 1996 company so as to involve the defendant No.5 herein and that the domain does not reflect the name of the defendant No.5 as its proprietor. The defendant No.5 is neither a necessary party nor a proper party to the suit. The domain name <http://www.mahe.org.in> is being used by the defendant No.4. The defendant no.5 is an affiliate of the defendant No.4 and its registration of the said domain name is bonafide and lawful and is intended to aid the educational initiatives of the defendant No.4 and its various affiliate entities. The domain name and website has been in existence since the year 2011 and the plaintiffs have taken no steps to challenge the same until after the expiry of almost a decade. Therefore, the registration and use of the said domain name is not only bonafide but is unassailable in law and on facts. The plaintiffs have not made out any case against the defendants, let alone a prima facie case. On the contrary, the judgment of the Hon'ble Madras High Cour reveals that all the defendants have an undeniable right to use the mark

“Manipal” for running schools and educational institutions. Hence, they have sought for dismissal of the I.A.No.I to VI with costs.

48. The plaintiffs have filed objections to I.A.VII filed by the defendant No.3 in which it is stated that the applicant has disentitled himself from invoking the equitable jurisdiction of the court on account of his deliberate and willful disobedience of the order of this court, that the plaintiffs have already initiated proceedings U/o 39 Rule 2A of CPC, that the applicant has not made out sufficient grounds to vacate the ex parte order, that the applicant has no relationship or nexus with the plaintiffs, but the applicant is seeking to create a connection between himself and the plaintiffs on the basis of he belongs to Pai family, that the applicant owns industries and businesses under the trademark “Kurlon” and instead of utilizing his own companies’ goodwill and reputation, he chooses to use the plaintiffs’ marks in the market for making commercial gain and to destroy the reputation of the plaintiffs, that the business permitted under trademark “Manipal Group” by the applicant is lottery business, that there is no proof of use of the name ‘Manipal’ by the applicant after partition of 1990’s,

that the applicant has not used the said mark in the field of education, that the applicant is seeking to mislead the court by falsely stating that the word Manipal is a family name, but it is Pai and not Manipal which is the family name, that there is no suppression by the plaintiffs regarding Madras proceedings, that the plaintiffs were not parties to the said proceedings and the outcome of those proceedings is neither determinative of the plaintiffs' rights nor relevant to the present proceedings, that the applicant has falsely stated that interim order dated 06.12.1996 passed by Hon'ble Madras High Court was not challenged and wrongly relied upon the said order in para No.11 of the application. It is further stated that the plaintiffs in CS No.19-21 of 1996 had filed an appeal No.OSA 116 to 121 of 1997 challenging the interim order dated 06.12.1996 and said appeal was disposed of vide order dated 25.11.2002, that the applicant has suppressed the passing of said order, that the observations recorded in the interim order do not operate as res judicata and cannot be treated as a precedent, much less binding precedent, that the said interim order does not permit the applicant to violate the rights of the plaintiffs, that the present suit is not based on the cause of action on which the earlier suits were filed before Hon'ble Madras High Court, that recurring act of breach of

infringement of trademark gives arise a recurring and fresh cause of action, that there is no delay, latches or acquiescence by the plaintiffs as the suit is filed prior to the date of inauguration of Manipal International School, that the plaintiffs have filed opposition numbered as MAS No.58810 against the application of the applicant in the year 2001 itself which was erroneously dismissed on 27.02.2008 against which the plaintiff Trust filed an appeal before Intellectual Property Appellate Board (IPAB), that the applicant cannot claim right to use the mark/ name Manipal by virtue of alleged use of the mark/ name Manipal by Manipal High School Trust. Hence, the plaintiffs have sought for dismissal of the I.A.No.VII.

49. Initially, the suit was filed before Prl. City Civil and Sessions Judge, Bengaluru which was registered in O.S.No1244/ 2019 and was made over to CCH-83. Since the suit involves commercial dispute, it was renumbered as Com.O.S.No.15/ 2019. In the meantime, Commerce Court for Bengaluru Rural district is constituted and the suit came to be transferred to this court on the ground of jurisdiction. Then the suit is renumbered as Com.O.S.No.960/ 2021. The

plaintiffs and the defendant No.3 to 5 are represented by their respective counsels. The defendant No.1 and 2 are ex parte.

50. Heard the learned Senior counsels Sri. K.G. Raghavan, Advocate and Sri. Dhyan Chinnappa Advocate for the plaintiffs and the learned Senior counsel Sri. Rajesh Ramanathan, Advocate for the defendants No.3 to 5. Both the counsels have filed written submissions. The parties have relied upon the following rulings:

For the plaintiffs

- 1) (1993) SCC Online Kar 132
(Mangalore R.K. Beedies V/s Mohammed Hanif)
- 2) 1975 SCC Online Kar 22
(Nilgiri Dairy Farm Vs. S.A. Rathnasabapathy)
- 3) 2005 SCC Online Del 103
(M/s Bikanerwala Vs. M/s New Bikanerwala)
- 4) MANU/TN/4856/2011
(Murugan IDLI Shop vs. Murugan IDLI Shop)
- 5) (2004)3 SCC 90
(Midas Hygiene Industries P.Ltd., and Anr. Vs. Sudhir Bhatia and Ors.)
- 6) AIR 1965 SC 980
(Kaviraj Pandit Durga Dutt Sharma vs. Navaratna Pharmaceutical Laboratories)
- 7) (2002)3 SCC 65
(Laxmikant V. Patel vs. Chetanbhai Shah & another)

- 8) (1990) Supp SCC 727
(Wander Ltd. & Another Vs. Antox India Pvt.Ltd.,)
- 9) AIR 2012 Kant 68
(Madhu Product, Bengaluru vs. Sundaram Files & Ors.)
- 10) (2004)6 SCC 145
(Satyam Infoway Ltd., Vs. Sifynet Net Solutons (P) Ltd.
- 11) (1963)2 SCR 484
(Amritdhara Pharmacy Vs. Satya Deo Gupta.)
- 12) 2001 SCC Online Kar 676
(Betco Enterprises & Another Vs. Pradhan Perfumers & Another)
- 13) (2016)2 SCC 683
(S. Syed Mohideen Vs. P. Sulochana Bai).
- 14) MANU/DE/0892/2008
(Indian Hotels Company Ltd., Vs. Jiva Institute)
- 15) 1962 SCC Online Mad 89
(M/s Parry and Co.Ltd., Vs. Perry & Co.)
- 16) AIR 1960 SC 142
(Corn Products V. Shangrila Food Products)
- 17) 1989 ILR (1989) I Delhi 115
(Hindusthan Pencils Vs. India Stationary Products.
- 18) (1997)1 SCC 99
(Bengal Waterproof Limited Vs. Bombay Waterproof)
- 19) (1979)2 SCC 65
(M.V. Ramasubbiar Vs. Manicka Narasimhachari)
- 20) 2010 SCC Online Mad 3175
(P.R. Pandurangan Chettiar and Another Vs. M. Balakrishnan and others)

- 21) (2008)10 SCC 723
(Khoday Distilleries Ltd., Vs. Scotch Whisky Association and others)
- 22) 1991 SCC Online Bom 271
(The Scotch Whisky Association and Another Vs. Pravara Sahakar Shakar Karkhana Ltd.,
- 23) ILR 1979 II Delhi 481
(Ellora Industries Vs. Banarsi Das Goela and Ors.)
- 24) (2004) SCC Online Mad 883
(Jolen Inc Vs. Shobanlal Jain and Others)
- 25) 1957 SCC Online Bom 45
(Ciba Ltd., Basle Switzerland Vs. M. Ramalingam and S. Subramaniam Trading in the name of South Indian Manufacturing Co., Madhura and Another)
- 26) 2008(38) PTC 49 (Delhi)
(Pankaj Goel Vs. Dabur India Ltd.)
- 27) (1996)4 SCC 622
(Delhi Development Authority Vs. Skipper Construction Co. (P) Ltd., and another)
- 28) 2018 SCC Online Del 11910
(Ritnand Balved Education Foundation Vs. Ranchhod M. Shah and Ors.)
- 29) (1994)2 SCC 448
(M/s Power Control Appliances and Others Vs. Sumeet Machines Pvt.Ltd.)
- 30) 2019 SCC Online Del 10638
(Make My Trip (India) Pvt.Ltd., V/s Make My Travel (India) Pvt.Ltd.)
- 31) ILR (2007)1 Delhi 409
M/s Ansul Industries Vs. M/s Shiva Tobacco Company.

- 32) 2006 SCC Online Del 1664
(Fedders North American Vs. Show Line and Ors.)
- 33) (2006)8 SCC 726
(Ramdev Food Products (P) Ltd., Vs. Arvindbhai Rambhai Patel and Ors.)
- 34) 1967 SCC Online All 271
(Kulsumum Nisan Vs. Mohammad Farooq & Ors.)
- 35) 2002(2) CTC 213
(Sumanth Pathak Vs. TVS Suzuki Ltd.,)
- 36) 1994(28) DRJ 541
(M.T.N.L. and others Vs. Tata Press)
- 37) (1998)5 SCC 69
(Indian Bank Vs. Maharashtra State Co-Operative Marketing Federation Ltd.)
- 38) (1962) R.P.C. 265
(Parker Knoll Ltd., Vs. Knoll International Limited.)

For the defendants

- 1) AIR 1977 Cal 413
(Imperial Tobacco Co., of India Ltd., Vs. Registrar of Trademarks and another)
- 2) 1980 SCC Online Mad 176
(R.S.K.V. Raghavan Vs. G.R. Gopal & Co.)
- 3) AIR 1972 Del 172
(Geep Flashlight Industries Ltd., Vs. The Registrar of Trademarks, Government of India)
- 4) 2013-4-LW 794
(Sowkhya Way2Health Private Limited Vs. Dr. Issac Issac Mathai)

- 5) (2007)9 MLJ 267
(Apex Laboratories Ltd., Vs. Zuventus Healthcare Ltd.)
- 6) 2008(37) PTC 487 (Del)
(Schering Corporation Ltd., Vs. Getwell Life Sciences India Pvt.Ltd.,)
- 7) 2010(42) PTC 41 (Mad)
(Nutrine Confectionary Co.Ltd., Vs. Icon Household Products Pvt.Ltd.)
- 8) 2018 SCC Online Del 6397
(Three-N-Products Private Limited Vs. Kairali Exports and Ors)
- 9) 2004 SCC Online Del 855
(Satilila Charitable Society and another Vs. Skyline Education Institute (I)(P)Ltd.)
- 10) 20126(6) Mh.LJ 249
(Datamatics Global Services Ltd., Vs. Royal Datamatics Private Limited)
- 11) 2000-3-LW-165
(Kaalai Malar Publications Pvt.Ltd., Vs. Dinamalar)
- 12) 2017 SCC Online 8550
(Mehtar Wing Services Private Limited and another Vs. M/s Jindal Restaurant)
- 13) 2016 SCC Online Del 4738
(Vardhaman Builtech Pvt.Ltd., & Others Vs. Vardhaman Properties Ltrd.,)
- 14) 2017 SCC Online Del 12166
(Bigtree Entertainment Pvt.Ltd., vs. Brain Seed Sportainment Pvt.Ltd.,)

- 15) 2016 SCC Online Bom 3574
(Ultratech Cement Ltd., Vs. Dalmia Cement Bharat Limited)
- 16) 2010 SCC Online Cal 134
(Three-N-Products Private Limited Vs. Emami Limited)
- 17) 1996 SCC Online Mad 736
(Manipal Housing Finance Syndicate Ltd., and others Vs. Manipal Stock and Share Brokers Ltd., and others)
- 18) (2009)3 Bom CR 379 (Parle)
(Parle Products Ltd., Vs. Parle Agro Pvt.Ltd.)
- 19) 2016 SCC Online Del 472
(Shri Ram Education Trust Vs. SRF Foundation and another)
- 20) 2017 SCC Online Mad 4405
(Sri Krishna Sweets Private Limited Vs. Mr. M. Murali)
- 21) 2021 SCC Online Del 2630
(Black Diamond Track Parts Private Limited and others Vs. Black Diamond Motors Private Limited)
- 22) 2018 SCC Online Del 9678
(Mankind Pharma Ltd., Vs. Chandra Mani Tiwari and another)
- 23) 2017(2) MHLJ 877 (Cipla)
(Cipla Limited Vs. Cipla Industries Pvt.Ltd.)
- 24) (1994)1 SCC 1
(S.P. Changalvaraya Naidu Vs. Jagannath and others)
- 25) 2014 SCC Online Del 3008
(Triumphant Institute of Management Education Pvt.Ltd., V/s Aspiring Mind Assessment Pvt.ltd.)

- 26) (2018)3 Mh.LJ 746
(Brihan Karan Sugart Syundicate Pvt.Ltd., V/s Karmaveer Shankarrao Kale Shankari Sakhar Karkhana Ltd.)
- 27) (2008)150 (Del) 459
Micolube India Ltd., Vs. Maggon Auto Centre & another)
- 28) 2001 PTC 797 (Del)(DB)
(B.L. and Co., and others Vs. Pfizer Products Inc.)
- 29) 2012 SCC Online Del 4297
(Conslidated Contractors International Company S.A.L. Vs. Consolidated Construction Consortium and others.)
- 30) (1995)5 SCC 545
(Gujarat Bottling Co.Ltd., and others Vs. Coca Cola Co., and others.
- 31) (1975) SC 396
American Cyanamid Co.Vs. Ethicon Ltd.

51. I have gone through the said rulings, relevant provisions of law and perused the records. I have applied the principles laid down in the rulings to the facts and circumstances of the case. Since voluminous rulings are cited, it is not possible and feasible to mention each and every principle of law laid down therein in the body of the order.

52. Now the points arise for my consideration are:

- 1) Whether the plaintiffs have made out prima facie case of infringement of his registered trademark, passing off and unfair competition by the defendants?
- 2) Whether the balance of convenience lies in favour of the plaintiffs?
- 3) Whether the plaintiffs will be put to irreparable loss if the reliefs sought under the I.A.No.I to VI are not granted?
- 4) Whether the defendant No.3 has made out sufficient grounds to vacate the exparte T.I. granted against him?
- 5) What order?

53. My findings to the above points are as under:

- | | |
|--------------------|-------------------------------------------|
| Points No.1 to 3 : | In the Affirmative; |
| Point No.4 : | In the Negative; |
| Point No.5 : | As per final order,
for the following; |

REASONS

54. **POINTS NO.1 TO 4:** These points are interlinked and hence, I have taken them together for common discussion to avoid repetition of facts and ideas.

55. The plaintiffs have produced copies of the following documents in support of their case:

- 1) Resolution dt.31-07-2000 with proceedings dt.13-05-2018.
- 2) Screen shots of the website www.manipalschool-city.com.
- 3) Certificate of incorporation of the defendant No.2.
- 4) Web extracts of the defendant No.1.
- 5) Deed of Trust dated 19-05-1993.
- 6) Deed of Amendment dated 24-09-2004.
- 7) Notification dated 24-09-2004.
- 8) List of Institutes of Manipal University.
- 9) Gazette Notification dated 15-11-1995.
- 10) Admissions details of MAHE.
- 11) Famous alumni list of MAHE Deemed University.
- 12) Awards list.
- 13) Brand Assessment survey report.
- 14) MAHE prospectus for the years 2006 to 2018.

- 15) Sample degrees and/or certificate marks cards.
- 16) Invitations, correspondence and certificates.
- 17) Web extracts of www.manipal.edu/mu.html and www.manipalgroup.com.
- 18) Newspaper advertisements, leaflets, flyers, invitation.
- 19) Certificate of CA in respect of promotional expenses.
- 20) Invoices & bills of advertisements, etc.
- 21) Promotional material as to services of instituted off shore.
- 22) ICANN of domain name manipalgroup.com and manipal.edu.
- 23) Trade marks of MAHE Deemed University.
- 24) Order of Trade Mark Registry dated 09-08-2018.
- 25) Printout of the article dated 21-05-2004 in Economic Times.
- 26) Web print of Manipal School, Mangalore – manipal.school.edu.
- 27) Printout of website www.manipalschool.edu.
- 28) Advertisement of Manipal School dated 29-01-2019 in Times of India, Bengaluru.
- 29) Whois record for manipalschool-ecity.com.
- 30) Web extract of the defendant No.1 as to opening of admissions for 2019-2020.
- 31) Flyer of defendant No.1 as to Kids Carnival.
- 32) Letter to P.S., P.M.O., by the defendant No.4.
- 33) Letters obtained under RTI.

- 34) Print out of website www.manipalschool.edu.com.
- 35) Counter statement of defendant No.3.
- 36) Order dated 25-11-2002 in OSA 116 to 121 of 1997 by Madras High Court.
- 37) Letter of Intent dated 23-07-2018 by Member of HRD and Department of Higher Education.
- 38) Plaint in O.S. No.8204/2014 and 8203/2014.
- 39) Order dated 22-04-2019 in SLP and 961/2019, 954/2019.
- 40) Incorporation details of the defendant No.4.
- 41) Copy of order in Company .Pet. No.223/2010 and 224/2010.
- 42) Company Master data of the defendant No.2.
- 43) Incorporation details of the defendant No.5.
- 44) Whois Record for mahe.org.in.
- 45) Certificate of incorporation of the defendant No.4.
- 46) Certificate of change to See 8.
- 47) Master data of the defendant No.4.
- 48) TM application 3092002.
- 49) Order of TM Registry.

56. The defendants have placed on record the copies of the documents viz.,:

- 1) Trade Marks search report for word Manipal.
- 2) Memorandum of Association dated 10-10-2017.
- 3) Articles of Association dated 10-10-2017.
- 4) Board Resolution dated 04-09-2019.
- 5) Extract of website of Upendra Pai Memorial College.
- 6) Deed of Modification of Trust Deed dated 17-05-1975.
- 7) Annual Magazine of Madhav Pai Memorial College.
- 8) Magazines published by Manipal PU College.
- 9) Prospectus of Madhavi Pai Memorial College.
- 10) Extract of website of Manipal Career Academy.
- 11) Extract of website of Manipal PU College.
- 12) Extract of website of Manipal Business School.
- 13) Certificate of renewal of registration of 4th defendant.
- 14) Licence agreement of Manipal Public School.
- 15) Newspaper advertisement for MPS.
- 16) Records of TM registry for MPS 01-02-2005.
- 17) Newspaper articles of Bhatikar Model High School.
- 18) Extract of website of Bhatikar Model High School.
- 19) Extract of website of MAHE Group.
- 20) Extract of website of MPS.
- 21) Extract of website of Madhav Pai Memorial College.
- 22) Madras High Court order dated 06-12-1996.
- 23) Application for registration Trade Mark-MIS.

- 24) Franchise Agreements.
- 25) Press coverage of MIS.
- 26) Audit report of the defendant No.4.
- 27) Directors reports dated 31-03-2018 and 31-03-2019
- 28) Extract of Annual returns.
- 29) MPS Anantpur Fee details, etc.,
- 30) Plaint in O.S. No.8704/2014 ACCJ, Bengaluru.
- 31) Order in M.F.A. No.917 with 2272/17.
- 32) Plaint in Com.O.S. No.8527/2019.
- 33) Power of Attorney in favour of Srinivas Ulloor.
- 34) Annual report of the defendant No.5.

57. **The admitted or undisputed facts**

The plaintiff No.1 is a public Trust founded and established solely by Dr. Ramdas Pai in the year 1993 with the primary objective of supporting and promoting of educational activities in all its branches. The Deed of Trust dated 19-05-1993 was executed by Dr. Ramdas Pai which was amended in the year 2004. The plaintiff No.2 is established and controlled by the plaintiff No.1. The acronym of the plaintiff No.2 is MAHE who is also known as Manipal University. The defendant No.4 was a society registered in the

year 1995 which came to be registered as private limited company in 2007 and thereafter, it came to be converted and functioning as Sec.8 charitable company from 2008. The defendant No.5 is a company incorporated on 09-02-1962 primarily engaged in the manufacture and sale of mattresses. The defendant No.2 was a company incorporated on 02-04-1996 under the Companies Act. The defendant No.3 is one of the directors/ promoters and key persons of the defendant No.2, 4 and 5 who collectively intend to start a school in the name and style of the defendant No.1. www.manipalschool-ecity.com is the website being used by the defendant No.1 and the said domain name was registered on 24-11-2018. The defendant No.5 is the registrant of domain name "mahe.org.in". The defendant No.2 came to be amalgamated into the defendant No.5 as per order of Hon'ble High Court of Karnataka in Company Petition No.223 and 224 of 2010. Acronym used by the defendants for the defendant No.4 is MAHE.

58. One Mr. T.A.Pai was the common ancestor who had 4 sons namely, P. Pai, Upendra Pai, Madhav Pai and T.R.A. Pai who are collectively referred as the Pais of Manipal. The said Madhav Pai (Dr. T.M.A. Pai) was a graduate of

medicine and had a prosperous practice at Udupi. Madhav Pai and his brothers have established finance companies, insurance companies, educational institutions, medical colleges and hospitals in and around Manipal which was a small locality near Udupi and has now become an economic hub of industries, financial institutions, educational institutions and medical establishments. Dr. Ramdas Pai who is the founder trustee of the plaintiff No.1 is the son of Dr. T.M.A. Pai. The said T. Upendra Pai is the brother of Dr. T.M.A. Pai, whereas Ramesh Pai is the son of T. Upendra Pai and the defendant No.3 is the son of said Ramesh Pai. The term 'Manipal' has achieved the reputation and the name 'Manipal' is no longer the name of a place alone. On account of certain disputes that arose between the groups of T. Ramesh Pai and Dr. Ramdas Pai, the businesses of the family came to be split up in a settlement called 'Ambani Accord' in the year 1993 on the intervention of family friends including Mr. Dhirubai Ambani, Dr. Veerendra Hegde, Mr. C. Subramaniam, etc., The companies that were allotted to the Dr. Ramdas Pai group filed 3 law suits before Hon'ble Madras High Court in CS.No.19 to 21 of 1996 against the companies allotted to Ramesh Pai group for permanent injunction restraining the family of the defendant No.3 from using the

word 'Manipal' as their business/ corporate name and Hon'ble Court has dismissed the applications for interim injunction holding that none of the parties to the suit has exclusive right to the commercial use of the name 'Manipal' and both families are entitled to compete in the open market. The application of the defendant No.3 for registration of trademark 'Manipal Group' (logo) vide No.659807 came to be registered in respect of 'Lottery Tickets included in Class 16' by rejecting the opposition of the plaintiffs, against which the plaintiff Trust filed an appeal in OA/71/2011/TM/CH before IPAB which is pending final hearing. The plaintiff No.2 filed a suit in O.S.No.8203/ 2014 and 8204/2014 before City Civil Court for permanent injunction restraining the defendants therein i.e., Manipal Academy of Health and Education Pvt. Ltd., (the defendant No.4 herein) and Manipal Holdings Pvt. Ltd., from infringing and passing off his trademarks or any other trademarks deceptively similar trade name/ trademark in the field of education and the said suits are pending. The defendant No.4 with an intention to start a school in the name of the defendant No.1 has applied for registration of trademark 'Manipal International School' vide application No.3092002 which is pending registration as it has been objected to by the Trade Mark Registry. An advertisement

regarding opening of admissions for the year 2019-20 from Nursery to Grade VII for the defendant No.1 was published in website 'manipalschools-ecity.com' and in the newspaper 'The Times of India', Bengaluru Edition dated 29-01-2019. Similarly an electronic advertisements for the carnival scheduled on 17-02-2019 in which the defendant No.3 is shown as chairman of Manipal Group and Manipal Academy of Health and Education (MAHE) and is scheduled to inaugurate the defendant No.1 were also issued/ published. The defendants are using marks/ names 'Manipal International School', 'MIS', 'Manipal Group', 'MAHE' and Manipal Academy of Health and Education' for their products and services and are promoting and offering their services under the impugned trademark in Bengaluru within the jurisdiction of this court.

59. **The disputed facts**

The defendant No.1 is not an entity, but a brand/ trademark. It is not a juridical person and hence, can not be sued. The defendant No.2 was amalgamated into the defendant No.5 and was not in existence as on the date of suit. The defendant No.4 is the entity behind the defendant

No.1, but the plaintiff has intentionally not made the defendant No.4 as party to the suit at the initial stage. Interim orders obtained against non existing persons with sinister motive. The plaintiffs are not before the court with clean hands and have committed fraud on the court. The plaintiffs have not conducted trademark search properly to ascertain the identity of the user of the impugned trademark and not made the main user of the mark as the defendant No.1 which disentitle the plaintiffs to the temporary injunction.

60. The mark 'Manipal' is admittedly publici juris and a generic trade mark and no one can claim exclusive right in respect thereof. When the mark is publici juris, it can never be appropriated by any single individual as it belongs to whole world. The plaintiffs have no registration for word 'Manipal' and they do not have exclusive right to use 'Manipal'. There are number of trademarks containing the word 'Manipal' applied by multiple persons other than the plaintiffs which evidence that the word 'Manipal' is in common use and in public domain. The plaintiffs have failed to establish that the word 'Manipal', a geographical name, has acquired a secondary meaning and distinctiveness. The alleged reputation and goodwill do not exist in favour of the

word 'Manipal. The plaintiffs have not registered the word 'Manipal' per se as well known trade mark under the provisions of the Act and as such it is not a well known trademark. The report of Earnst & Young cannot be relied upon at this stage. The plaintiffs refer to themselves as 'Formerly known as MAHE (Manipal Academy of Higher Education' which shows that the plaintiffs are not the user of the mark 'MAHE'. The word 'Manipal' does not distinguish the services of the plaintiffs. Registration of a device or a label containing the word 'Manipal' does not automatically entail protection against the use of the word 'Manipal' per se by the third parties. The plaintiffs have no right in the mark 'MIS'. The reputation claimed by the plaintiffs is not solely from the Trust established in the year 1993, but dates back to the joint family reputation as the Pais of Manipal. The late Ramesh Pai has also extensively contributed to the field of education and the success of the joint family. The defendants have been running several educational institutions since 1990 and are entitled to use the word 'Manipal' to their educational initiatives. The defendants are from the very same source as the plaintiffs i.e., the family of the Pais of Manipal. Though the suits filed before Hon'ble Madras High Court were withdrawn, the finding and decision therein still holds good.

The plaintiffs cannot use the mark 'Manipal' in exclusion of the defendants. The defendant No.4 is the registered proprietor of the trademark 'Manipal Public School' in Class 41 and as such no injunction can be granted. Sec.29(5) of the Act is not applicable as the plaintiffs have not registered the trademark 'Manipal' per se. The plaintiffs have suppressed material facts and the applications suffer from delay and laches as the Manipal Academy of Health and Education society was registered in 1995, as Manipal High School Trust, Manipal Education Foundation and Manipal Pre-University College have been in existence since 1997 and as the defendant No.4 was incorporated in the year 2007. The plaintiffs have sought for damages of Rs.10 lakhs which itself shows that the losses they have allegedly suffered are not irreconcilable in nature. The plaintiffs have not made out prima facie case. Balance of convenience does not lie in their favour. They will not be put to any loss if the T.Is. as prayed are not granted.

61. On the basis of the material placed before the court, it can be said that the plaintiffs are established and developed by Dr. Ramdas Pai group, whereas the defendants belong to T. Ramesh Pai group. Pais of Manipal have

established several businesses in and around Manipal. Family businesses of Pais have been divided among these two groups in a settlement known as 'Ambani Accord' in 1993. Until then, there was no claim for exclusive use of the word 'Manipal' by any of the groups. For the first time, such a claim was made by Dr. Ramdas Pai group in CS No.19 to 21 of 1996 before Hon'ble Madras High Court in which applications for temporary injunctions sought by the plaintiffs therein came to dismissed holding that the plaintiffs therein have no exclusive right over the word 'Manipal', that the defendants therein have a right to use the word 'Manipal' and to compete with the plaintiffs therein. It is categorically contended by the defendants herein that the said order was not challenged and it has become final, that the plaintiffs have not disclosed about the said litigation and thus, they are guilty of suppression.

62. It is to be noted that the plaintiffs were not parties to the said suits. The documents produced by the plaintiffs reveal that the order passed by the Hon'ble Madras High Court in CS No.19 to 21 of 1996 was challenged in OSA No.116 to 121 of 1997 wherein Hon'ble Madras High Court has passed the following order:

“Learned Senior Counsel for the Appellants/Plaintiffs seeks leave to withdraw the Letters Patent Appeal; as also the Civil Suits with liberty to file fresh suits on the same cause of action before appropriate forum. Learned counsel for the respondents has no objection for the withdrawal of the appeals and the suits.

2. Recording the statement made by the learned senior counsel, the appeals as well as the suits are dismissed as withdrawn with liberty as sought for by the learned senior counsel for the appellants Connected C.M.Ps are closed.

3. The Learned Senior Counsel for the appellants further pleaded that the findings recorded by the Learned Single Judge in the order passed on the interlocutory applications may influence the mind of the forum, in which the new proceedings are to be initiated by the Appellants, and, therefore, an observation may be made to the effect that such findings shall not be taken into consideration by the forum in which the new proceedings are to be initiated by the in this regard inasmuch as the law, as understood, is very clear that any finding given at the interlocutory stage is not final and does not operate as res judicata.”

63. The above order makes it clear that the interim order passed by Hon’ble Madras High Court relied by the defendants is no longer in existence and it does not operate as

res judicata. In fact, the defendants are guilty of suppression of said fact and their statement that the order in CS No.19 to 21 of 1996 has become final is incorrect and misleading. Therefore, the order passed in CS No.19 to 21 of 1996 is not helpful to the defendants and judgment in Brihan Karan Sugar Syndicate case relied by them has no application.

64. Copy of Deed of Trust and of Deed of Amendment produced by the plaintiffs prima facie disclose that the plaintiff No.1 Trust was created on 19-05-1993 by Dr. Ramdas Pai and an amendment was brought to the Deed of Trust on 24-09-2004. Copies of trademarks certificates produced by the plaintiffs reveal at this juncture that the plaintiff No.2 is the proprietor of the trademarks 'Manipal Academy of Higher Education', 'Manipal Academy of Higher Education Deemed University', 'MAHE', 'Manipal University', 'Manipal Inspired by life (label)' for word and device in Class 16, 35, 41 and 42 vide different applications of which earliest is dated 20-10-2006 with earliest user is dated 01-06-1993. List of constituent institutions of Manipal University is produced and it goes to show that there are 18 institution in India and 2 institutions outside India that are the part of said university. Among them, the oldest institution is Kasturba

Medical College, Manipal which was established in 1953, whereas Manipal College of Dental Sciences, Manipal was established in 1965. Kasturba Medical College and Manipal College of Dental Sciences were accorded deemed university status in 1993 vide Notification dated 01-06-1993, whereas Manipal Institute of Technology (established in 1957) and Manipal College of Pharmaceutical Sciences, Manipal (established in 1963) became constituent of the plaintiff No.2 in 2000 vide Notification dated 24-04-2000. It appears that the plaintiffs operate as many as 29 departments/ colleges under 20 establishments. It appears that Government of Sikkim has established 'Sikkim Manipal University' in collaboration with Dr. Ramdas Pai group by an Act of State Legislature dated 15-01-1995. The said Act recognizes the plaintiff Trust as a Trust having wide and accumulated experience in establishing and running various educational institutions of high standard in the State of Karnataka and else where. Statistics as to admissions of the plaintiff No.2 reveal that number of students joining the institution went on increasing from 2000 to 2018 indicating the popularity of the plaintiff No.2. Certificate issued by the Registrar of the plaintiff No.2 goes to show that several famous personalities are the Alumini of the plaintiff No.2. The counsel for the

defendants has pointed out that Dr. Enapadam S. Krishnamoorthy, one of the Aluminis resides in Chennai and not in London as mentioned in the document. The correctness of the certificates/ documents shall be verified during the trial.

65. Awards listed in the plaint are supported by the documents which prima facie indicate that Manipal University/ Manipal Academy of Higher Education Deemed University has won several awards in the field of education and healthcare. The defendants have commented that the awards started in 2007. Anyway, such awards reflect the goodwill acquired by the plaintiffs in the field of education and healthcare. Brand assessment survey report produced by the plaintiffs reveals that an assessment as to awareness of brands in education and healthcare in India was conducted by Ernst and Young in April 2016. An Article was published in The Economic Times on 14-02-2019 as to services rendered by the plaintiffs in the field of education and healthcare. The report and article speak about brand value attached to 'Manipal' in respect of the plaintiffs and its institutions in the field of education and healthcare services. The counsel for the defendant has argued that it was a private

survey conducted in the year 2016 and the newspaper article is of the year 2019 and same cannot be accepted. But, it is to be noted that there is nothing on record to disbelieve the correctness of the said report and article at this stage. Truth of the said report and article can be tested during the trial.

66. The plaintiffs have produced prospectus of the plaintiff No.2 for the period from 2006 to 2018, sample degrees, certificates, marks cards, invitations, correspondence, newspaper advertisements, leaflets, flyers, etc., in which mark 'Manipal Academy of Higher Education'/'Manipal Inspired by life' are displayed and website address www.manipal.edu is mentioned indicating the continuous use of the registered trade marks by the plaintiffs. Advertisement bills and promotional materials prima facie reveal that the plaintiffs are spending huge amount towards marketing of their services under the trademarks Manipal Academy of Higher Education/ MAHE/ Manipal University/ Manipal Inspired by Life, that promotional activities have been conducted in India and outside India. The plaintiffs have produced extracts of websites www.manipal.edu and www.manipalgroup.com which disclose that the plaintiffs have obtained registration of said domains on 27-09-1999

and 22-12-1997 and since then are offering services on the websites with display of their registered trademarks.

67. The plaintiffs have produced copies of orders of Registrar of Trade Marks in respect of application of 'MM Online Marketing' for the registration of trademark 'Manipal Pro (label) in Class 35 which was opposed by Manipal Global Education Services Private Limited and by the plaintiff No.2. It reveals that the applicant MM Online Marketing has not filed counter statement to the opposition and as such the application No.3681783 was deemed as abandoned.

68. The plaintiffs have produced documents to show that Dr. Ramdas Pai group is running a school by name 'Manipal School' in Mangalore which is affiliated to CBSE having domain name www.manipalschool.edu.in. The plaintiffs have also produced documents which indicate that Manipal Global Education Services Private Limited, an entity under Dr. Ramdas Pai group in collaboration with ICICI Bank Limited has established ICICI Manipal Academy for Banking and Insurance (IMA) in 2008 with domain name ima.manipal.edu which has become partner with several

leading banks, insurance companies and financial institution to impart training to professionals.

69. The plaintiffs have produced copy of Letter of Intent dated 23-07-2018 issued by Government of India, Ministry of HRD, Department of Higher Education ICR Division wherein it is mentioned as under:

“And whereas, the Chancellor of Manipal Academy of Higher Education (Deemed to be University), Manipal, Karnataka submitted its application on 08-12-2017 for conferment of Institution of Eminence Deemed to be University status to Manipal Academy of Higher Education, Manipal, Karnataka.

And whereas, the EEC, after overall assessment, recommended the name of Manipal Academy of Higher Education, Manipal, Karnataka to be declared as institution of Eminence Deemed to be University as per Clause 8.4(d) of the UGC (Institution of Eminence Deemed to be Universities) Regulations, 2017. The report of Empowered Expert Committee was considered and approved by the University Grants Commission in its 533rd meeting held on 09-07-2018.

Now, therefore, Ministry of Human Resource Development, on the recommendations and approvals of EEC and UGC, hereby issues Letter of Intent to Manipal Academy of Higher Education (Deemed to be University), Manipal, Karnataka as per Clause 8.4(e)

of the UGC (Institutions of Eminence Deemed to be Universities) Regulations, 2017.”

The said letter of intent prima facie establishes the reputation and goodwill earned by the plaintiffs in the field of education.

70. The plaintiffs have produced copies of documents to show that the defendant No.2 was originally named as Manipal Control Data Electronic Commerce Limited incorporated on 02-04-1996 and it got changed the name as Manipal E-Commerce Ltd., from 16-01-2003 and amalgamated with the defendant No.5 vide order dated 11-02-2011 in Com. Petition No.223 and 224 of 2010. Copy of Whois record for manipalschool-ecity.com discloses that the domain was registered by one Murali Mohan for Manipal E-Commerce Ltd., on 24-11-2018 and it was updated on 23-01-2019 and e-mail ID of Mr. Murali Mohan is murali@manipal.com. Looking to the said extract, we cannot find fault with the action of the plaintiffs in impleading the defendant No.2 in the suit as the person behind the defendant No.1. Hence, judgment in Bank Kreiss Ag has no application to this case.

71. The plaintiffs have also produced documents which indicate that an advertisement was issued in website manipalschool-ecity.com and in newspaper 'The Times of India', Bengaluru edition dated 29-01-2019 regarding opening of admissions for the year 2019-20 for Nursery to Grade VII in new school 'Manipal International School', Suryanagar, Chandapur, Bengaluru wherein it is claimed as under:

"The legend in Education Now in Electronic City – Bangalore.

Manipal International Schools (MIS) are the premier Schools from Manipal Group, which has been imparting world class education for over last eight decades and is rated as No.1 in Education. Continuing the traditions and legacy with the same values and global education standards, Manipal group is opening a new campus in the name of Manipal International School – Electronic city, Bangalore."

72. The flyer regarding the said school indicates that a kids carnival was scheduled on 17-02-2019 in which the defendant No.3 is shown to inaugurate the ceremony. In the flyer, logo of 'Manipal Group' and photo of the defendant No.3 are displayed. The website extract pertaining to the said school does not reveal that the defendant No.4 is the company

behind the defendant No.1 school, but it indicates that the school is from Manipal Group. There is no document to believe that any company in the name 'Manipal Group' is in existence. The defendant No.3 is shown as the chairman of Manipal Group which goes to show that the defendant No.3 is the man behind the establishment of school in the name of the defendant No.1. One Dr. Ritu Chauhan is shown as the principal of the said school. Hence, filing of the suit by the plaintiffs in the name of the defendant No.1 to 3 cannot be said as mala fide and fraudulent. Thus, the principles laid down in Micolube India Ltd. case cannot be applied to the facts of this case.

73. Copies of documents pertaining to the defendant No.4 are produced by the plaintiffs which go to show that the defendant No.4 was incorporated on 09-05-2007, that the defendant No.3 and one Kowlagi Kishore Kumar are its directors, that the company was changed to Sec.8 Charitable company from 14-03-2018, that the defendant No.4 applied for trademark registration in application No.3092002 on 04-11-2015 for the word 'Manipal International School' in Class 41 as proposed to be used, that the application for registration was signed by the defendant No.3 in the capacity

of director of the defendant No.4, that the said application stood objected, that the said application was refused by the Examiner of Trade Marks vide order dated 20-04-2020 wherein it is observed as under:

“The mark applied for registration is MANIPAL INTERNATIONAL SCHOOL (word per se) in class 41 in respect of EDUCATION: PROVIDING OF TRAINING; ENTERTAINMENT; SPORTING AND CULTURAL ACTIVITIES AND ALL SERVICES INCLUDED. The said mark is not distinctive and the mark indicates the geographical origin and the characteristics of the services applied for registration. The mark is claimed to be proposed to be used only as on the date of distinctive character and lost descriptive meaning as a result of the use made of it. Further the mark applied for registration is deceptively similar to earlier trademarks on record, namely MANIPAL (Lable), MANIPAL BUSINESS SCHOOL, MANIPAL EDUCATION and MANIPAL EDUCATION as mentioned in the Examination report vide application No.1297006,1804932, 1860437 and 1860440 respectively. The registration of the said conflicting marks is valid and subsisting. Because of the subject mark’s similarity to the earlier trademarks and identity or similarity of the goods covered by the trade marks, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark. The registered proprietors are the prior user of the mark. Hence, the mark is objectionable under Section 9 and Section 11 of the Trade Marks Act, 1999. Objections cannot be waived.

After perusal of all the documents on record and submissions made by the applicant/authorised agent it is concluded that applied mark is not registrable because of the reason stated as above. Hence, application no.3092002 cannot be accepted and refused accordingly.”

74. Copy of certificate of incorporation pertaining to the defendant No.5 discloses that the said company was incorporated on 09-02-1962, that the defendant No.3 and his wife are among 10 directors of the said company. Copy of Whois record for mahe.org.in reveals that the defendant No.5 is the registrant of said domain which was created on 05-04-2014 and was updated on 30-03-2019, that the registration for the said domain expired on 05-04-2020. Acronym used for the plaintiff No.2 is MAHE. The defendant No.5 created domain name by using the said acronym. Hence, I am of the opinion that the defendant No.4 and 5 are necessary parties to the suit and are liable to answer the claim of the plaintiffs.

75. The plaintiffs have produced copy of counter statement filed by the defendant No.3 for the Opposition No.MAS 58810 filed by the plaintiff No.2 against the Application No.659807 by the defendant No.3 for the

registration of trademark 'Manipal Group' in Class 16 wherein, the defendant No.3 has stated as under:

"1. I have been trading under the name and style of Manipal Group and engaged in the business of stockist and distribution of State Lotteries ever since the year 1994. I submit that during the course of the said business I have honestly conceived and adopted the trade mark MANIPAL GROUP since the year 1994. I have done extensive and continuous business under the above trade mark since 1994 and the said trade mark has become associated with my business in respect of Stockist and distribution of State Lotteries.

4. As regards para 1(a), I submit that the MANIPAL ACADEMY OF HIGHER EDUCATION TRUST, MANIPAL, is a part of various educational charitable and financial institutions established by late Dr. Madhav Pai. The main objects of the trust are to support and promote as advancement of educational activities in all its branches and to promote the Konkani language and are and culture of the Konkani speaking people, which is nothing to do with my business. In any event I submit that the above Institution was formed and maintained by the family of Pals in which I am also one of the member of the family and hence I am entitled to use the word MANIPAL GROUP for my business.

7. With reference to the Notice of Opposition, I submit that till date not even a single instance of confusion has been proved by the

Opponents. I submit that no body in the earth will confuse the trust, formed to support and promote the advancement of educational activities in all its branches and to promote the Konkani language and art and culture of the Konkani speaking people, is nothing to do with my business. Therefore, I submit that Section 11 of the Act will not be a bar for the registration of my trade mark.”

76. It is an admitted fact that the opposition of the plaintiff No.2 was rejected and trademark 'Manipal Group' was registered in Class 16 for 'Manipal Holdings Pvt. Ltd., The plaintiff No.2 has pleaded that he has challenged the said order and same is pending final hearing before IPAB which is not disputed by the defendants. It appears from the above counter statement that the defendant No.3 has succeeded in obtaining registration for trademark 'Manipal Group' by stating that his business and that of the plaintiffs are different and distinct and there is no question of causing confusion among public.

77. The plaintiffs have produced copy of letter dated 15-07-2004 written by the defendant No.3 in the capacity of Secretary of the defendant No.4 to the Principal Secretary, PMO, New Delhi under which he offers to manage government

hospital at Bhuj, Gujrat which is managed by PM Relief Fund. In the said letter, the defendant No.3 has categorically mentioned as under:

“As you are aware, the Manipal Group has demonstrated its expertise in managing hospitals by running Kasturba Medical College, Manipal and Manipal Hospital, Bangalore”.

78. In fact the hospitals mentioned by the defendant No.3 in the said letter are managed and run by the plaintiffs. Note of PM Office indicates that the letter of the defendant No.3 has caused an impression on the government that the offer was made by the group which is running the hospitals named therein. The plaintiffs have also produced extracts of google search for word ‘Manipal’ which disclose that google search shows the institutions of the plaintiffs for the word ‘Manipal’.

79. The defendant No.1 and 2 are ex parte. The defendant No.3 to 5 have contested the applications. They have admitted the use of the mark ‘Manipal’ as their trade name, trade style, domain name and trade mark, but they

have justified their actions by contending that the use of mark 'Manipal' by them is neither an infringement of the trademarks of the plaintiffs nor passing of, that the mark 'Manipal' is publici juris and no one can claim exclusive rights in it, that the plaintiffs have no registration for the word 'Manipal' per se, that the word 'Manipal' has not acquired distinctiveness and not acquired secondary meaning for the services of the plaintiffs, that the trademarks of the plaintiffs are not well known Trade Marks, that the goodwill and reputation earned for 'Manipal' are due to joint efforts of Pais of Manipal and not by Dr.Ramdas Pai group alone, that they have every right to use the word 'Manipal' for their businesses/ trades and to compete with the plaintiffs, that trademark 'Manipal Public School' was registered by the defendant No.4 in 1995 who has established schools in the name of 'Manipal International School' and 'Manipal Global School' and continuously using the mark.

80. The defendants have also produced voluminous documents in support of their defence. The Memorandum of Association and Articles of Association of the defendant No.4 reveal that the company was formed in the year 2007 by two directors namely N.S. Murlidharan and T. Sudhakar Pai, the

defendant No.3, that the company has become charitable company U/s 8 of the Companies Act, 2013 as per resolution dated 10-10-2017 with main objects as follows:

1. To acquire establish and maintain health care centres, hospitals, nursing homes, dispensaries and other healthcare institutions and to render health care and related services to fellow human beings and also to make people generally aware about health related issues not for profit motive.

2. to acquire, establish and maintain schools colleges, universities and other institutions of primary/secondary/ vocational / technical or higher learning for rendering education including rendering education in any form or manner, not for profit motive.

3. to operate as Master Franchisee of Manipal Academy of Health & Education and other education service providers and to conceptualize, design, document, implement, support and manage a franchise network of educational / training institutions and healthcare establishments on their behalf, not for profit motive.

4. to conceptualize, design, document, implement, support and manage a franchise network of educational / training institutions and healthcare establishments and to manage and provide management consultancy in the areas of education, training, healthcare, franchising, and other related areas and to forge alliances with foreign and domestic education and healthcare institutions and to deliver their produces/services in the Indian Sub-continent but not for profit motive.

81. It can be seen that the objects of the defendant No.4 are similar to that of the plaintiff Trust. The said company has resolved on 04-09-2019 that Mr. Mohd. Samiulla, the CEO of the company is authorized to represent the company before the courts/ other authorities in suit or other proceedings by or against the company. Web extract of Upendra Pai Memorial College, Udupi-Manipal reveals that the said college is a unit of Dr. T.M.A Pai Foundation, Manipal which was established in 1991 with the name 'College of Commerce and Business Management' and has been renamed as 'Upendra Pai Memorial College' from 1997-98 to commemorate the birth centenary of late Upendra Pai. The web page mentions that Upendra Pai, the brother of late Dr. T.M.A. Pai was the backbone of all activities of Dr. T.M.A. Pai in the Banking and Education.

82. The deed of modification dated 01-08-1975 discloses that a Trust styled 'The Manipal High School Trust' under a Deed of Trust dated 21-02-1950 was created by Dr. T.M.A. Pai, who was the Registrar of the Academy of General Education, Manipal. The trustees of the said Trust by resolution dated 17-05-1975 modified the principal deed by adding new clause 29 regarding transfer of assets of the

Trust. Annual Magazines of Madhav Pai Memorial College 'Vikrama' for the year 2004-05 and 2018-19 and Prospectus of said college for the year 2003-04 and 2008-09 mention that the said college was founded by late T. Ramesh Pai and the defendant No.3 was member of governing council of the college. Mr. A.S.Pai, a freelance journalist wrote an article on Mr. Ramesh Pai in the magazine. The magazine for the year 2018-19 mentions that Mr. Ramesh Pai had the opportunity of working very closely with his uncle Dr. T.M.A. Pai in founding the Kasturba Medical College at Manipal, Kasturba Hospital at Manipal and Bangalore and other institutes. This statement is not sufficient to believe at this juncture that Mr. Ramesh Pai was co-founder of said institutions and had right to use the mark 'Manipal' against the interest of the plaintiffs.

83. Annual Magazines for the year 1996-97 and 2018-19 and web extract of Manipal P.U.College, Manipal show that a school was started on 07-06-1948 styled as 'Manipal High School' and it was upgraded to Junior college in 1972 and renamed as Manipal Pre University College in 1986. The institution was established by Dr. T.M.A. Pai who himself was its correspondent, that Mr. Ramesh Pai was its correspondent from 1954 to 2005. After death of Smt. Shantha R. Pai, the

defendant No.3 is its correspondent from 2008. Web extract of manipalcareeracademy.com mentions that Manipal Career Academy (MCA), a training centre started its operation on 18-11-1998 at Manipal and it trains students on computer courses, spoken English, fashion courses, etc., CCI Limited, Manipal re-started MCA with an aim to impart good and quality education which is relevant to industry standards on 01-04-2013, that both CCI and MAHE (the defendant No.4) are under Manipal Group lead by Mr. T. Sudhakar Pai, the defendant No.3. Web extract of Manipal Business School shows that the defendant No.3 is in Board of Governors. The website displays the logo of Manipal Group and Manipal Public School. It describes about mission statement of the defendant No.4.

84. The defendants have produced certificate of renewal, license agreement and newspaper advertisements which reveal that Manipal Academy of Health and Education was registered as a society on 05-10-1995 and its registration was renewed from time to time and was lastly renewed on 23-09-2015 till 11-06-2020. There is no explanation from the defendants regarding purpose behind renewal of the society when the defendant No.4 was registered as a company. The

said society entered into an agreement with Urmin Foundation, Ahmedabad on 18-01-2005 granting license to run a school in the name of 'Manipal Public School' under the guidance of the society, that the society has issued newspaper advertisement inviting the persons interested to set up a CBSE school in their locality with the assistance of the society in the name of Manipal Public School. The address shown in the advertisement is of the defendant No.4 and it contains logo of 'Manipal Group'.

85. It appears from certificate of Registration of Trade Mark bearing No.1335585 that trademark 'Manipal Public School' has been registered on 01-02-2005 in the name of Manipal Academy of Health Education (a society), Goa. An article was published in Herald newspaper dated 09-12-2020 regarding Shri Gurunath Vaikunth Shetye in which it is mentioned that Bal Bharati Vidyamandir established by Shetye was handed over to Manipal Academy of Health and Education who invested around Rs. 1 Crore for the development of the school. Information regarding Bhartikar Model High School indicates that the said school is managed by Model Education Society of Goa in association with Manipal Academy of Health and Education. Web pages of

MAHE (the defendant No.4), Manipal Public School and Madhav Pai Memorial College disclose that the defendant No.3 is the chairman of Manipal Group. MAHE, the society was having a mission of establishing 10,000 schools of best standards in India and of providing various healthcare services. The web page displays as under:

Welcome to MAHE

Manipal Academy of Health & Education (MAHE) is registered professional society under the 'Manipal Group'

Nine decades have passed since the formation of Manipal.

The above declaration makes it clear that the word 'Manipal' has not remained as name of a place. However, the defendants have not produced any material to believe that they have established schools under trademark 'Manipal Public School' either on regular basis or on franchise model.

86. Copies of Franchise Agreements dated 21-12-2017, 27-11-2018 and 23-02-2019 go to show that the defendant No.4 as a private limited company entered into an

agreement with Y. Rajasekhar Reddy of Hyderabad, Telangana for running a school in the name of 'Manipal Global School', that the defendant No.4 as charitable company entered into agreements with Masineni Educational Foundations, Ananthpur and Sams Maritime Education Pvt. Ltd., Chennai for running schools in the name 'Manipal International School'. The defendant No.4 is stated to be the legal owner of brand names 'Manipal Global School' and 'Manipal International School'. One Mr. Sami Ulla appears to be the signatory to the agreements as CEO of the defendant No.4. Audit reports of the defendant No.4 reveal that the company was not having any income during the year 2017-18, but has received Rs.39,71,186/- towards franchise/ royalty fee for the year 2018-19, that the defendant No.3 and one K. Kishore Kumar are the directors of the said company, whereas Sudhir M.N. resigned from his directorship. Fee receipts of Manipal International School, Anantapur indicates collection of fee by the said school, but the said receipts are for the period from August to December 2019 bearing random numbers and there is no uniformity in amount of fee charged. The defendants have not produced any material to show that the franchise model schools in Chennai and Hyderabad are functioning.

87. Plaintiff in O.S.No.8527/2019 reveals that the defendant No.4 filed a suit against the plaintiff No.2 herein for a damages of Rs.2 crore, for permanent injunction from making, publishing, distributing, repeating any defamatory/ libelous/ disparaging material and mandatory injunction directing the plaintiff No.2 herein to tender an unconditional public apology in all the editions of English newspaper 'Times of India', in Kannada newspapers 'E-Nadu', 'Udayavani', 'Times of India' and 'Vijaya Karnataka' for having defamed, denigrated and disparaged him, his trademark 'Manipal International School' and services thereunder. It appears that after grant of T.I. in this suit, the plaintiffs have published statement in the newspapers about the interim orders which lead the defendant No.4 to file the said suit which is stated to be pending before Addl. City Civil Court, Bengaluru. Annual Report of the defendant No.5 shows the name of Mr. Ramesh Pai as the founder of the company. The defendant No.3 is shown as the managing director of the company. There is no dispute that the defendant No.5 is a well known company in India engaged in the business of mattresses and allied products. The statements show that the defendant No.5 has recorded a profit of more than 75 crores for the year 2019-20.

88. The defendants have produced trademark search report for the word 'Manipal under Class 41 and 16 which contains 63 entries as to trademarks registered by using the word 'Manipal'. Most of the marks in the list belong to the plaintiffs and their sister concerns, whereas applications filed by Manipal Holdings Pvt. Ltd., of the defendant No.3 bearing Nos.1259916 and 1259917 in Class 41 and No.2802609 in Class 16 were abandoned, application Nos.1518957, 1518958, 1518959 in Class 41 and application Nos.2772482 and 4457566 in Class 16 were opposed, application No.2802608 in Class 16 was refused, application No.4457565 in Class 16 was objected, whereas application No.659807 for Manipal Group in Class 16 is registered. Similarly, application filed by Kurlon Limited, the defendant No.5 bearing No.1804932 for Manipal Business School in Class 41 is abandoned. Application filed by Manipal High School Trust bearing No.2772404 for Manipal Group in Class 41 is also abandoned. Application filed by Manipal Universal Learning Private Limited bearing No.1838620 in Class 41 is likely to be removed, application No.1860442 in Class 16 is opposed. Application filed by The Academy of General Education (Manipal) bearing No.2592336 is refused. Application filed by Manipal Education Foundation bearing No.2772398 for

Manipal Group in Class 41 is abandoned, whereas application filed by the defendant No.4 bearing No.1335585 for Manipal Public School in Class 41 is registered. Application filed by the defendant No.3 as director of the defendant No.4 bearing No.4438328 for Manipal International School in Class 41 is opposed, whereas application filed by the defendant No.4 bearing No.3092002 for Manipal International School in Class 41 is refused. Trademark registered under application No.640638 filed by M/s Manipal Industries Ltd., in Class 16 is not renewed, whereas trademarks registered under application Nos.640639, 640640, 640641 and 640642 filed by Manipal Housing Finance Syndicate Ltd., M/s Manipal Finance Corporation Ltd., M/s Manipal Sowbhagya Nidhi Ltd., Mr. T. Narayana M. Pai in Class 16 are removed. At the same time, application No.2696125 filed by the plaintiff No.2 for Manipal International School in Class 16 is also refused. The subsisting trademarks for the defendants are 'Manipal Group' standing in the name of Manipal Holdings Private Limited and 'Manipal Public School' in the name of the defendant No.4. The registration of former mark is in Class 16 for lottery tickets and the latter mark is in Class 41 for education. The plaintiffs stated to have challenged the registration of Manipal Group and the matter appears to be

pending for final hearing before IPAB. It is pertinent to note that 'Manipal Group' is not a company/ society, but it is a trademark. The defendant No.3 identifies himself as chairman of 'Manipal Group'.

89. It is argued on behalf of the defendants that there are several other proprietors such as Manipal Resorts Company Pvt. Ltd., etc., who are using the mark 'Manipal' against whom the plaintiffs have not taken legal action and hence, the plaintiffs are not entitled to prevent the defendants from using the said mark. It is to be noted that use of mark by other persons and non filing of the suits against them do not give any right to the defendants to use the said mark. Infringement of trademark by some other person and inaction of the plaintiffs to take legal action against such persons cannot be a good defence for the defendants to use the said marks. Hence, argument of the defendants in that regard is unacceptable.

90. The defendants have argued that the word 'Manipal' is a generic name/ publici juris and is neither registrable nor enforceable, that the word 'Manipal' a geographical name, has not acquired a secondary meaning

and distinctiveness, that the word per se has not acquired reputation, goodwill and distinctiveness in favour of the plaintiffs. They have relied upon ITC case, Geep Flashlight Industries case, Apex laboratories case, Schering Corporation case, Satilila Charitable Society case in support of their arguments. On the contrary, the plaintiffs have relied upon judgments in Mangalore R.K. Beedis case, Nilgiri Dairy Farm case, M/s Bikanerwala, Murugan Idli shop wherein protection was given to geographical names on account of having acquired secondary meaning qua the use made thereof. The plaintiffs have cited rulings in Max Healthcare, Anchor Health, Kirorimal Kashiram, K.R.Chinna Krishna Chettiar, Amritdhara Pharmacy, Izuk Chemical works cases wherein it was held that there is no bar for registration of geographical name as trademark if it has acquired secondary meaning due to extensive and continuous use.

91. The material produced before the court by the plaintiffs prima facie reveals that the plaintiffs are the registered proprietors for trademarks 'Manipal Academy of Higher Education', 'Manipal Academy of Higher Education Deemed University', 'MAHE', 'MAHE Deemed University', 'Manipal University' for word and device in Class 16, 35, 41

and 42 and for 'Manipal' label, 'Manipal Inspired by Life' label in Class 41 and 42. The essential and dominant feature of these trademarks is 'Manipal'. The plaintiffs have been using the said marks continuously about 3 decades, that the said trademarks are duly renewed. Such registration is prima facie evidence as to validity of the trademarks of the plaintiffs as per Sec.31 of the Act. Thus, the word 'Manipal' is no more a name of a place and publici juris, but appears to have acquired secondary meaning for the services of the plaintiffs in the field of education and healthcare. Brand assessment report, Sikkim Manipal University Act, Awards won by the plaintiffs, letter of intent of Government of India and office note of PMO in response to the letter of the defendant No.3 prima facie indicate that the plaintiffs have acquired reputation and goodwill under the mark 'Manipal'. Thus, the mark 'Manipal' appears to have acquired distinctiveness for the services of the plaintiffs in the field of education and healthcare. The defendants contend that the said popularity, reputation, goodwill and distinctiveness are due to joint efforts of Pais of Manipal, but it is to be noted that the family businesses have been distributed among two groups viz., Dr. Ramdas Pai group and T. Ramesh Pai group in 1993. Educational institutions and hospitals were not allotted to

T. Ramesh Pai group. The defendant No.3 and his father appear to have not established any educational institutions or hospitals after 1993, but the plaintiffs went on developing their institutions in the field of education and healthcare and gained lot of goodwill and reputation in India and overseas. Hence, the contentions of the defendants regarding joint efforts to build the reputation and distinctiveness of the mark 'Manipal' cannot be accepted at this stage.

92. The marks that are used by the plaintiffs fall within the meaning of Sec.2(m) and 2(zb) of the Act and the said trademarks are capable of distinguishing the services of the plaintiffs from those of others. The said marks are duly registered and fall U/s 2(w) of the Act and the plaintiff No.2 is the registered proprietor of the said marks within the meaning of Sec.2(v) of the Act. It further discloses that the trademarks of the plaintiffs appear to have become so popular to the substantial segment of the public that the use of such marks in relation to other goods or services by some other person would be likely to be taken as the services of the plaintiffs. Thus, the marks used by the plaintiffs are prima facie 'well-known Trade Marks' within the definition U/s 2(zg) of the Act. The defendants herein are admittedly not the

'permitted users' and 'registered users' of the trademarks of the plaintiffs within the definition of Sec.2(r) and 2(x) of the Act. They are claiming to be concurrent users of the impugned mark, but their use was in the field of lottery tickets and not in the field of education and healthcare. The defendant No.1 uses acronym 'MIS' and the defendant No.4 refers itself as 'MAHE' which are identical/ deceptively similar to the registered trademarks of the plaintiff No.2 within the meaning of Sec.2(h) of the Act.

93. Sec.29 of the Act reads 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 labelling 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.

94. The essential feature in the names of the defendant No.1 and 4 is also 'Manipal'. The defendant No.1 uses domain name manipalschool-ecity.com which contains the word 'Manipal' which is prominent word of the domain name. The defendant No.2 is the registrant of the said domain which is now merged with the defendant No.5. The domain was registered after merger of the defendant No.2 into the defendant No.5. The contention of the defendants that the defendant No.2 is not in existence is falsified by said registration. Similarly, the defendant No.5 is the registrant of

domain name mahe.org.in. The plaintiffs are having trademark registration for MAHE in their names. The defendant No.3 is/was the director of the defendant No.2, 4 and 5 and key person behind the establishment of the defendant No.1. The defendant No.3 on behalf of Manipal Holdings Pvt. Ltd., got registered trademark 'Manipal Group' in Class 16. The defendant No.4 is a registered company, but it has not obtained any trademark in the name of 'Manipal'. Looking to the defence, it can be said that the defendant No.3 and 4 are now intending to provide services in the field of education in the name of the defendant No.1 which is identical with the registered trademarks of the plaintiffs, whereas the defendant No.5 uses domain name which is identical with the registered trademark of the plaintiffs. Though the defendant No.2 is merged with the defendant No.5 in the year 2011, it is the registrant of the domain name manipalschool-ecity.com in the year 2018 and was updated in 2019. The defendant No.4 has obtained trademark registration for 'Manipal Public School'. Mere registration of trademark is not sufficient to get protection U/s 28(3) of the Act. It is necessary to show the continuous and simultaneous use of the mark for calling the user as concurrent user. There is nothing on record to believe that the defendants have used

the mark 'Manipal' in the field of education and healthcare after 1993 till inauguration of 'Manipal International School' in 2019. Thus, use of the said marks by the defendants as part of their trade name and domain names falls within the meaning of Sec.29(5) of the Act. Hence, it can be said that the acts of the defendant No.2 to 5 prima facie constitute infringement of trade marks of the plaintiffs.

95. It is the defence of the defendants that the reputation and goodwill for 'Manipal' is created by Pais of Manipal and not Dr. Ramdas Pai. It is to be noted that after Ambani Accord, the plaintiffs have used their trademarks in the field of education and healthcare extensively and continuously. They got registered the trademarks and thus they have got exclusive right to use the said trademarks. The defendants claim protection U/s 17 and 28(3) of the Act stating that 'Manipal' is part of trademarks of the plaintiffs and they are honest and concurrent user of the said mark. Judgment in Datamatics Global services case is relied by them.

96. 'Manipal' is name of a place. Trademark registration cannot be obtained for the word 'Manipal' only.

The other words in the trademarks of the plaintiffs are common dictionary words for which registration cannot be sought. Thus, the essential feature of the trademarks of the plaintiffs is 'Manipal'. Admittedly, the defendants are not running any hospitals/ healthcare institutions. Hence, it becomes clear that the defendants are not in the field of healthcare services. They are claiming to be running educational institutions since prior to Ambani Accord. It is argued that the defendants are running school in the name of 'Manipal Public School', running colleges in the name of 'Manipal PU College', 'Upendra Pai Memorial College' and 'Madhav Pai Memorial College'. The records before the court indicate that 'Manipal High School Trust' and 'Manipal PU College' were established by Dr. T.M.A. Pai. The defendant No.3 is stated to be the correspondent of 'Manipal PU College', but that itself is no ground to claim right over the mark 'Manipal'. If all the trustees and correspondents start claiming right over the trademarks, there is no meaning in registration of trademarks. The plaintiffs have no objection for the running of schools by the defendants either in the name of 'Pai' or in the brand name of the defendant No.5. Manipal Academy of Health and Education society has obtained registration for trademark 'Manipal Public School' on

01-02-2005, but there is no material on record to believe that the defendants have ever established/managed/ set up any school/s in the said name. However, the defendants have produced documents to show that the defendant No.4 has entered into agreement with some institutions at Anantpur, Hyderabad and Chennai for running schools on franchise model. Those agreements are from 2017 onwards. It means, the defendants have not set up school of any model till 2017. Fee receipts produced by them show that the school under the name of 'Manipal International School' is running in Anantpur. The said receipts are of the year 2019. Though much is stated about Manipal International School, Electronic City, Bengaluru, but the defendants have not produced any document regarding functioning of the said school. The schools in question are franchise model schools and are not regular schools. The defendant No.4 has issued license to the franchisees to run the schools in the name of 'Manipal Global School' and 'Manipal International School'. The defendants have not obtained trademark registration in the said names. The applications filed by the defendant No.3 for trademark 'Manipal International School' are either refused or opposed. Hence, the defendants cannot claim right over the mark 'Manipal' and cannot use the mark 'Manipal International

School' and its acronym 'MIS' for their franchise schools. The name of the defendant No.4 and its acronym MAHE are also identical or deceptively similar to the registered trademarks of the plaintiffs. The use of the said names and acronyms in relation to education and health services by the defendants is infringement of registered trademarks of the plaintiffs. It is worth to mention here that the execution of franchise/ license agreements by the defendant No.4 for running schools under franchise model in the name of 'Manipal International School' and 'Manipal Global School' itself goes to show that the word 'Manipal' has acquired secondary meaning and is not publici juris. Section 17 and 28(3) of the Act and rulings relied by the defendants in that regard do not help them to prove their contentions at this juncture. On the other hand, it is settled principle of law that there can be only one mark, one source and one proprietor. It cannot have two sources. The defendants want to compete with the plaintiffs in the field of education and healthcare claiming to have right over the mark 'Manipal'. There cannot be joint ownership of trademark (as held in M/s Power Control Appliances case). The mark 'Manipal' is not a family name. The families of Dr. Ramdas Pai and of Mr. Ramesh Pai established several institutions. Some of the institutions bear the mark 'Manipal' and the other

institutions are in different names/ logos/ marks. Therefore, the defendants cannot claim the legacy over the impugned mark at this stage. Moreover, the plaintiffs appear to have struggled a lot and spent huge amount in promoting the brand name 'Manipal' and in securing the reputation and goodwill. Looking to the description given by the defendants in their websites/ newspaper advertisement, etc., it appears that the defendants are trying to take advantage of the reputation of the plaintiffs. The defendants are further trying to pass off their services as that of the plaintiffs. This can be easily made out from the letter written by the defendant No.3 to Prime Minister's office. The highest office of the country appears to have believed the letter of the defendant No.3 as the letter from the plaintiffs' institution. When PM's office can get confused about the identity of the defendants, we cannot imagine what will be the fate of a common man who wants admission of his child in the school/ college. The very object of the Trade Marks Act, 1999 is to "*provide for registration and better protection of trade marks for goods and services and for the prevention of use of fraudulent marks*". The protection of trade marks in other words is the protection of interest of public. It is for preventing a consumer from being deceived while buying any goods or availing any service. In this regard,

Hon'ble High Court of Bombay in Ciba Ltd., case has held that "the object of maintaining a trade mark register is that the public should know whose goods they are buying and with whom particular goods are associated". Similar view was taken by Hon'ble Delhi High Court in Jolen Inc. Vs Sobhanlal case. In this case, it appears from the records that the defendants are representing themselves as part of the plaintiffs institutions and they carry the same legacy. This aspect indicates that the adoption of mark 'Manipal' by the defendants for the similar services as that of the plaintiffs is not honest. Letter of the defendant No.3 to the PM's office goes to show that it was done with dishonest intention and was deceptive. It further appears that the defendants are trying to make profits out of the reputation and goodwill of the plaintiffs. This can be termed as an unfair competition. Hon'ble High Court of Delhi in Ritnand Balved Education Foundation case which is known as Amity International School case has held that "In a passing off suit, confusion and deception has to be avoided at all costs. This would apply with greater force in the field of education.

97. As far as delay and laches is concerned, the defendants have admittedly got published the event of

inauguration of 'Manipal International School' on or about 29-01-2019. Kids Carnival Inauguration was scheduled on 17-02-2019. The present suit is filed on 15-02-2019 i.e., prior to the inauguration of the defendant No.1 school. The mark 'Manipal Public School' was registered in 2005, but no school appears to have started in the said name except giving advertisement in newspaper calling applications to establish franchise model schools. The defendant No.4 entered into franchise agreement for the establishment of franchise model school in Hyderabad in the year 2017, but there is no material to believe that the said school is functioning. Even the defendants have not published about establishment of said school. Unless it is done with the knowledge of the plaintiffs, expecting them to challenge the said act is absurd. It appears that after coming to know about the inauguration/commencement of the defendant No.1 school through newspaper ad or otherwise, the plaintiffs have approached the court without any delay. The suit is filed even before the school started functioning. Thus, there is no delay or laches on the part of the plaintiffs in filing the suit. The rulings relied by the defendants on the point of delay are not applicable to the facts and circumstances of this suit.

98. Hon'ble Supreme Court has held in Midas Hygiene Industries case that in cases of infringement either of trademark or copy right, normally injunction must follow, that grant of injunction also becomes necessary if it prima facie appears that the adoption of the mark was itself dishonest. It is held in Laxmikant Patel case even if there is no dishonesty on the part of the defendant, still if confusion results or likely to result on account of use of rival marks, injunction ought to be granted. Hon'ble High Court of Bombay has held in Bajaj Electricals Limited case that if the use their own name by the defendants likely to deceive, then there would be no defence to an action of passing off, no matter how honest and bonafide the user was. Judgment in Red Hat Inc deals with remedy for an infringement under Sec.29(4) and (5) for the use of a registered trademark as part of corporate name by the defendant.

99. In this case, the trademark, trade name and domain names of the defendants are identical and deceptively similar to the registered trademarks of the plaintiffs. The contention of the defendants that 'Manipal International School' has an independent reputation of its own is not supported by any document. The defendants have contended

that their representation of the website are correct, but looking to the representation in website, it is apparent that every description about the reputation therein refers to the plaintiffs. The defendants are using the impugned marks and names for their services in the field of education which are similar to that of the plaintiffs and such usage likely to cause confusion in the mind of consumer and deceive the public at large. Adoption of impugned marks by the defendants is prima facie deliberate and with dishonest intention. Such usage by the defendants in the field of education/ healthcare services would cause damage to the reputation and goodwill of the plaintiffs and such damage cannot be compensated in terms of money. Claim for damages by the plaintiffs is no ground to refuse the relief of temporary injunction as the relief of damages is not in alternative to the relief of injunction. The defendants are stated to be intending to serve the society by providing best education at reasonable price. The said object can be achieved by developing a brand of their own. If the defendants are required to change their names/ marks/ domain name, they will not be put much hardship. If they establish their case during trial and able to prove that interim order has caused them huge loss, they can be suitably compensated.

100. The plaintiffs have sought for grant of T.I. against the defendants from using the marks identical or deceptively similar with their registered trade marks for any goods of services. The cause of action for the suit is setting up of the defendant No.1 school by the other defendants. The defendants are stated to have started the said school/s after filing of the suit. The material before the court is sufficient to believe at this juncture that the mark 'Manipal' has acquired secondary meaning for the services of the plaintiffs in education and healthcare services and not in other field. Under the circumstances, the defendants can be prevented from using the mark 'Manipal' with or without any other word/s for their services in education and healthcare. Trade name of the defendant No.4 itself uses the mark 'Manipal'. In that regard, O.S.No.8204/2014 filed by the plaintiff No.2 is pending before Addl. City Civil and Sessions Court, Bengaluru and the said aspect will be suitably dealt therein. Similarly, the defendant No.3's another company namely Manipal Holdings Pvt. Limited has obtained trademark 'Manipal Group' for lottery tickets in Class 16 against which the plaintiffs have filed appeal and same is pending before IPAB. Use of mark 'Manipal Group' by Manipal Holdings Pvt. Ltd., is the subject matter of dispute in O.S.No.8203/ 2014

and same is also pending before Addl. City Civil and Sessions Judge, Bengaluru in which said dispute will be adjudicated. I am of the opinion that in this case, we have to see the usage of the marks in the field of education and healthcare services and to that extent order can be passed under the I.As.

101. The plaintiffs have claimed two relief in I.A.No.VI. They cannot maintain two reliefs under one I.A. Therefore, second relief under the I.A. cannot be considered at this juncture. The domain name of the defendant No.1 uses the mark 'Manipal' which is prima facie infringement of registered trade mark of the plaintiffs. Hence, the defendants can be prevented from the said domain name. They can change the name of their school as well as domain name for providing service in the field of education. Continued use of the said domain name would likely to cause irreparable loss and hardship to the plaintiffs.

102. I am of the opinion that the plaintiffs have made out prima facie case. Balance of convenience lies in their favour. The plaintiffs will be put to irreparable loss if the T.I. orders as prayed in respect of education and healthcare services are not granted. The defendants will be put to

monetary loss if the I.A.No.I to VI are allowed, but their loss can be compensated by awarding damages if they succeed in proving their defence after trial. No other efficacious remedy is available to the plaintiffs. Under the circumstances, I conclude that the plaintiffs are entitled for the reliefs in part as prayed in the I.As. At the same time, there are no sufficient grounds to vacate the exparte T.I. granted in favour of the plaintiffs. Hence, I answer the points as above.

103. **POINT NO.5**: In view of above discussion and findings, I proceed to pass the following:

ORDER

I.A. Nos.I to VI under Order XXXIX Rules 1 and 2 read with Section 151 of Code of Civil Procedure filed by the plaintiffs are hereby partly allowed with costs.

The defendants, their partners, directors, promoters, shareholders, managers, employees, assigns, successors, licensees, franchisees, representatives, agents, etc., claiming through or under them or on their behalf are hereby

restrained by an order of temporary injunction from using the trade mark 'Manipal International School', acronym 'MIS', name 'Manipal Academy of Health and Education', acronym 'MAHE', 'Manipal Group' and other marks comprising the word 'Manipal' with or without any other word/s identical or deceptively similar to the plaintiffs' registered trademarks 'MAHE (Deemed University)', 'Manipal Academy of Higher Education (Deemed University)' and 'Manipal University' singularly or in conjunction with any other word or monogram/ logo as a trademark, service mark, trade name, trading style/ corporate name/ domain name or in any other manner whatsoever and from publishing/ promoting or advertising the same, amounting to infringement, passing off, unfair competition till disposal of the suit for or in relation to education and healthcare services till disposal of the suit.

The defendants and their men are further restrained by an order of temporary injunction

from using the domain name 'manipalschool-city.com' till disposal of the suit.

Ex-parte order of T.I. dated 21-02-2019 granted in favour of the plaintiffs is made absolute in respect of education and healthcare services.

I.A.No.VII under Order XXXIX Rule 4 R/w Sec.151 of CPC filed by the defendant No.3 is dismissed with costs.

Office is directed to send copy of the order to all the parties through E-mail as required under Order XX Rule 1 of Code of Civil Procedure if mail IDs are provided.

(Dictated to the Judgment Writer directly online, typed by her, corrected by me and then pronounced in the open Court on this 22nd day of April, 2022)

(BASAVARAJ CHENGTI)
X Additional District Judge,
Bengaluru Rural District,
Bengaluru.



**IN THE HIGH COURT OF KARNATAKA AT BENGALURU
DATED THIS THE 6TH DAY OF DECEMBER, 2022**

PRESENT

THE HON'BLE MR. JUSTICE G.NARENDAR

AND

THE HON'BLE MR. JUSTICE RAJENDRA BADAMIKAR

COMMERCIAL APPEAL NO. 267 OF 2022

C/W

COMMERCIAL APPEAL NO. 284 OF 2022

IN COMAP NO.267/2022

BETWEEN:

MANIPAL ACADEMY OF
HEALTH AND EDUCATION,
AUTOMATIC HOUSE, 10/19,
GROUND FLOOR,
EAST PATEL NAGAR,
NEW DELHI - 110008.
REPRESENTED BY ITS
AUTHORISED SIGNATORY
MR. MOHAMMED SAMIULLA.

...APPELLANT

(BY SRI SIDDARTH DAVE, SENIOR ADV. ALONG WITH
SMT. IRFANA NAZEER, ADV.)

AND:

1. MANIPAL ACADEMY OF
HIGHER EDUCATION
A PUBLIC TRUST HAVING
ITS REGISTERED OFFICE AT
MADHAV NAGAR,





MANIPAL - 576104,
KARNATAKA,
REPRESENTED BY ITS
TRUSTEE DR H.S.BALLAL,

2. MANIPAL ACADEMY OF
HIGHER EDUCATION
(DEEMED UNIVERSITY)
MADHAV NAGAR,
MANIPAL 576104, KARNATAKA,
REPRESENTED BY ITS
AUTHORISED SIGNATORY
DR. NARAYAN SABHABIT.
3. MANIPAL INTERNATIONAL
SCHOOL CHANDAPURA,
BENGALURU,
CHANDAPURA - ANEKAL ROAD,
SURYANAGAR, PHASE 1,
ELECTRONIC CITY,
BENGALURU-560099, KARNATAKA.
4. MANIPAL E-COMMERCE LIMITED
N-701, NORTH BLOCK,
MANIPAL CENTRE 47,
DICKENSON ROAD, BANGALORE,
KARNATAKA 560042.
5. T SUDHAKAR PAI
N-701, NORTH BLOCK,
MANIPAL CENTRE 47
DICKENSON ROAD, BENGALURU,
KARNATAKA - 560042.
6. KURLON LIMITED
N-301, III FLOOR,
NORTH BLOCK, FRONT WING,
MANIPAL CENTRE 47, DICKENSON ROAD,
BENGALURU, KARNATAKA - 560042.

...RESPONDENTS



(BY DR. ABHISHEK MANU SINGHVI, SR. ADV. AND
SRI DHYAN CHINNAPPA, SR. ADV. ALONG WITH
SANJANTHI SAJAN POOVAYYA, ADV. AND
SRI VENKATA REDDY S.K, ADV. FOR R1 & R2,
SRI R.OM KUMAR, ADV. FOR R6,
V/O DATED 9/6/2022 NOTICE TO R3 TO R6 ARE D/W.)

THIS COMMERCIAL APPEAL IS FILED UNDER SECTION
13(1A) OF THE COMMERCIAL COURTS ACT, 2015 R/W ORDER
XLIII RULE 1(r) OF THE CPC, PRAYING TO SET ASIDE THE
ORDER DATED 22/04/2022 PASSED ON INTERLOCUTORY
APPLICATIONS BEARING I.A.NO. 1 TO 7, IN SUIT BEARING
COM.O.S.NO.960/2021 PASSED BY THE HONBLE X ADDL.
DISTRICT AND SESSIONS JUDGE (DEDICATED COMMERCIAL
COURT), BENGALURU RURAL DISTRICT, BENGALURU AND AS A
CONSEQUENCE THEREOF ETC.

IN COMAP NO.284/2022

BETWEEN:

T SUDHAKAR PAI
AGED ABOUT 69 YEARS
N-701, NORTH BLOCK,
MANIPAL CENTRE 47,
DICKENSON ROAD,
BENGALURU,
KARNATAKA-560042.

...APPELLANT

(BY SRI SIDDARTH DAVE, SENIOR ADV. ALONG WITH
SMT. IRFANA NAZEER, ADV.)





AND:

1. MANIPAL ACADEMY OF
HIGHER EDUCATION
A PUBLIC TRUST HAVING
ITS REGISTERED OFFICE AT
MADHAV NAGAR,
MANIPAL-576104,
KARNATAKA,
REPRESENTED BY ITS
TRUSTEE DR. H S BALLAL.

2. MANIPAL ACADEMY OF
HIGHER EDUCATION
(DEEMED UNIVERSITY)
MADHAV NAGAR,
MANIPAL-576104, KARNATAKA,
REPRESENTED BY ITS
AUTHORISED SIGNATORY
DR. NARAYAN SABHABIT.

3. MANIPAL INTERNATIONAL SCHOOL
CHANDAPURA, BENGALURU,
CHANDAPURA-ANEKAL ROAD,
SURYANAGAR, PHASE 1,
ELECTRONIC CITY,
BENGALURU-560099,
KARNATAKA.

4. MANIPAL E-COMMERCE LIMITED
N-701, NORTH BLOCK
MANIPAL CENTRE 47,
DICKENSON ROAD,
BANGALORE,
KARNATAKA-560042.

5. MANIPAL ACADEMY OF
HEALTH AND EDUCATION
AUTOMATIC HOUSE,
10/19, GROUND FLOOR,
EAST PATEL NAGAR,



NEW DELHI-110008,
REPRESENTED BY ITS
AUTHORISED SIGNATORY
MR MOHAMMED SAMIULLA.

6. KURLON LIMITED
N-301, III FLOOR
NORTH BLOCK, FRONT WING
MANIPAL CENTRE
47, DICKENSON ROAD,
BENGALURU,
KARNATAKA-560042.

...RESPONDENTS

(BY DR. ABHISHEK MANU SINGHVI, SR. ADV. AND
SRI DHYAN CHINNAPPA, SR. ADV. ALONG WITH
SRI VENKATA REDDY S.K, ADV. FOR R1 & R2.)

THIS COMMERCIAL APPEAL IS FILED UNDER SECTION 13(1A) OF THE COMMERCIAL COURTS ACT, 2015 R/W ORDER XLIII RULE 1(r) OF THE CPC, PRAYING TO SET ASIDE THE ORDER DATED 22/04/2022 PASSED ON INTERLOCUTORY APPLICATIONS BEARING I.A.NO. 1 TO 7, IN SUIT BEARING COM.O.S.NO.960/2021 PASSED BY THE HONBLE X ADDL. DISTRICT AND SESSIONS JUDGE (DEDICATED COMMERCIAL COURT), BENGALURU RURAL DISTRICT, BENGALURU AND AS A CONSEQUENCE THEREOF ETC.

THESE COMMERCIAL APPEALS HAVING BEEN HEARD AND RESERVED FOR JUDGMENT, COMING ON FOR PRONOUNCEMENT OF JUDGMENT THIS DAY, G.NARENDAR J., DELIVERED THE FOLLOWING:



JUDGMENT

The matter was listed before this Court on 13.07.2022 and the learned Senior counsels Sri M N Sheshadri and Sri Ashok Haranahalli were heard on behalf of the appellant and the learned Senior counsel Dr. Abhishek Manu Singhvi and Sri Dhyan Chinnappa were heard on behalf of the respondent. Thereafter, on request of both the counsels, the matter was adjourned to 27.07.2022, thereafter to 11.08.2022. Thereafter, the appellants changed counsels. On account of change of counsels hearing was adjourned. Matter was re-listed on 03.09.2022 and 12.09.2022 and arguments were concluded by learned Senior counsel Sri Siddarth Dave appearing along with learned counsel Smt. Irfana Nazeer, on behalf of the appellant. The matter was heard and was reserved for judgment.

2. The appellants are defendants No.3 and 4 before the Trial Court and are before this Court being



aggrieved by the order passed by the Trial Court on the Interlocutory Applications preferred by the applicants i.e., I.As. 1 to 6 and I.A.No.7, by the 3rd Defendant in Commercial O.S.No.960/2021 dated 22.04.2022.

3. The suit being one for injunctory reliefs in respect of the issues arising out of Intellectual Property Rights under the Trade Marks Act, 1999, the pleadings and the materials produced, in our opinion, are relevant for determination of the correctness of the order of interim injunction granted by the Trial Court, while allowing IAs 1 to 6. The Trial Court was pleased to allow the applications and thereby the ex-parte order of interim injunction granted on 21.02.2019 was made absolute and was further pleased to reject I.A.7 by the Third defendant, preferred under Order XXXIX Rule 4 for vacating the ex-parte interim order.

4. The plaintiffs have prayed for the following main reliefs in the suit :



- (a) *"Pass a decree of permanent/perpetual injunction against the Defendants, their partners, directors, promoters, shareholders, managers, assigns, successors-in-interest, licensees, franchisees, companies, representatives, servants, distributors, agents, etc. restraining them jointly and severally, from infringing the Plaintiffs' registered trade mark by using the trade mark MANIPAL INTERNATIONAL SCHOOL and/or MAHE and/or MANIPAL ACADEMY OF HEALTH AND EDUCATION and/or any other word(s) identical or deceptively similar to the Plaintiffs' registered trade mark MAHE (DEEMED UNIVERSITY) /MANIPAL ACADEMY OF HIGHER EDUCATION (DEEMED UNIVERSITY)/MANIPAL UNIVERSITY singularly or in conjunction with any other words or monogram/logo as a trade mark, service mark, trade name, trading style/corporate name/domain name, or in any other manner whatsoever; on or in relation to or any goods and/or services whatsoever, advertising, business papers, etc.;*
- (b) *Pass a decree of permanent/perpetual injunction against Defendants, their partners, directors, promoters, shareholders, managers, assigns, successors-in-interest, licensees, franchisees, companies, representatives, servants distributors, agents etc. restraining them jointly and severally, passing off their goods/ services/ business as and for the goods/services/business of Plaintiffs by*



restraining them from using MANIPAL INTERNATIONAL SCHOOL and/or MIS and/or MAHE and/or MANIPAL ACADEMY OF HEALTH AND EDUCATION and/or other marks comprising of MANIPAL or any other mark/name/words identical or deceptively similar to the Plaintiffs' trade mark(s)/name MIS/MAHE (DEEMED UNIVERSITY)/MANIPAL ACADEMY OF HIGHER EDUCATION DEEMED UNIVERSITY / MANIPAL UNIVERSITY / MANIPAL, singularly or in conjunction with any other words or monogram/logo as a trade mark, service mark, trade name, trading style, corporate name, domain name or in any other manner whatsoever; on or in relation to or any goods and/or services whatsoever, advertising, business papers, etc;

- (c) *Pass a decree of permanent/perpetual injunction against Defendants, their partners, directors, promoters, shareholders, managers, assigns, successors-in-interest, licensees, franchisees, companies, representatives, servants, distributors, agents etc. restraining them jointly and severally, from using Plaintiffs' trade mark(s)/name MAHE (DEEMED UNIVERSITY)/ MANIPAL ACADEMY OF HIGHER EDUCATION DEEMED UNIVERSITY/MANIPAL UNIVERSITY and/or other marks comprising of MANIPAL or any other mark/name/words identical or deceptively similar thereto, singularly or in conjunction with any other*



words or monogram/logo as a trade mark, service mark, trade name, trading style, advertising, business papers, etc; on or in relation to or any goods and/or services whatsoever; leading to acts of unfair competition by the Defendants with the Plaintiffs' goods and/or services;

(d) *Pass a decree of permanent/perpetual injunction against Defendants restraining the Defendants from using, either directly or indirectly, the impugned word/name/trade name/trading style "MANIPAL GROUP", singularly or in conjunction with any other words, in relation to any goods or services or business or in any manner whatsoever;*

(e) *Pass a decree of permanent/perpetual injunction against Defendants restraining the Defendants from using either directly or indirectly, the*



impugned trade mark in relation to any goods or services or business or in any manner whatsoever other than lottery tickets. This relief is without prejudice to the Plaintiff Trust's submissions in Opposition No. MAS 58810 and the pending appeal proceedings being OA No. 71/2011/TM/CH that the impugned registration vide No.659807 is granted erroneously;

(f) *Pass a decree of permanent/perpetual injunction against Defendants restraining the Defendants*



from using the domain name "manipalschool-ecity.com" and pass an order/direction to the Defendant No.2 to transfer the domain name "manipalschool-ecity.com" in favour of the Plaintiff No.1;

- (g) Pass a decree directing Defendants to deliver up to Plaintiffs for the purpose of destruction/erasure all infringing materials and materials constituting passing including but not limited to products, catalogues, pamphlets, brochures, billboards, stationery, business cards, bill books, vouchers, letterheads, signage, electronic material, reprographic material, packaging, labels or any other material bearing the trade marks/names MANIPAL INERNATIONAL SCHOOL and/or MIS and/or MAHE and/or MANIPAL ACADEMY OF HEALTH AND EDUCATION and/or other marks comprising of MANIPAL and/or any other mark/word deceptively similar to Plaintiffs' trade mark(s) / name MAHE (DEEMED UNIVERSITY) / MANIPAL ACADEMY OF HIGHER EDUCATION (DEEMED UNIVERSITY) / MANIPAL UNIVERSITY used for advertising, selling or marketing any goods and/or services;*
- (h) Pass a decree directing Defendants to deliver up to Plaintiffs for the purpose of destruction/ erasure all impugned materials including but not limited to products, catalogues, pamphlets, brochures, billboards, stationery, business cards, bill books,*



vouchers, letterheads, signage, electronic material, reprographic material, packaging, labels or any other material bearing the word/name MANIPAL GROUP and or a trade mark/name deceptively similar thereto used for advertising, selling or marketing any goods and/or services.

- (i) *Pass a decree directing Defendants to deliver up to Plaintiffs for the purpose of destruction/erasure all impugned materials including but not limited to products, catalogues, pamphlets, brochures, billboards, stationery, business cards, bill books, vouchers, letterheads, signage, reprographic material, packaging, labels or any other material*

bearing the trade mark  used for advertising, selling or marketing any goods and/or services other than those used in lottery tickets. This relief is without prejudice to the Plaintiff Trust's submissions in Opposition No. MAS 58810 and the pending appeal proceedings being OA No.71/2011/TM/CH that the impugned registration vide No. 659807 is granted erroneously.

- (j) *Pass a preliminary decree for rendition of accounts directing Defendants to produce before this Hon'ble Court or any person nominated/designated/appointed by this Hon'ble Court all accounts in general and details of all receipts in particular;*



- (k) *Pass and pronounce a final money decree in favour of Plaintiffs for payment of damages as found payable after the rendition of accounts;*
- (l) *Award costs of the present proceedings in favour of the Plaintiffs and against the Defendants; and*
- (m) *Pass any other order(s) / direction(s) in favour of the Plaintiffs and against the Defendants that this Hon'ble Court may deem fit and proper in the facts and circumstances of the present case."*

5. In lieu of and in aid of the main prayer, several interim reliefs have been prayed for under I.As.1 to 6. The parties are referred to by their nomenclature before the Trial Court and the first plaintiff and the fourth defendant are referred to as MAHE-1 and MAHE – 2 for the sake of brevity and convenience.

6. The first appeal COMAP 267/2022 is preferred by the entity going under the name and style "Manipal Academy of Health and Education" (MAHE-2, for short) and is said to be promoted by the 3rd defendant, who is also said to be the promoter of respondents No.2 and 4



and the defendant No.5 is a family concern involved in the business of furnishings, mattresses and pillows. The respondent Nos.1 and 2 are plaintiffs 1 and 2.

7. The second appeal COMAP 284/2022 is by 5th respondent herein and the instant appellant is arrayed as 3rd defendant therein and both the appeals are preferred, being aggrieved by the common order dated 22.04.2022 passed on the IAs and hence both appeals are taken up for disposal by this common order.

8. We deem it appropriate to traverse the plaint pleadings and the pleadings in the written statement. In para 2, it is pleaded that the third defendant i.e., the appellant in the companion appeal, is intending to start a school in the name and style of "Manipal International School" with the mark MIS and it is pleaded that the same is identical and deceptively similar to the trade mark of the plaintiffs.



9. In para 3, it is pleaded that the first plaintiff is a Public Trust engaged in the establishment, management, development and conduct of educational institutions in all its branches and stages, including but not limited to kinder-garden, primary and high schools, colleges, post graduate and doctorate courses in arts, science, commerce, engineering, medicine, pharmacy, dental, nursing, management, music, fine arts, architecture, etc., and in the establishment, management, development and conduct of hospitals for providing medical, surgical and nursing care or treatment for indoor and/or outdoor patients. Plaintiff No.1 manages and operates plaintiff No.2. That the first defendant is a school that is proposed to be commenced by the defendants No.2 and 3 and that the information has been gleaned from the website www.mca.gov.in and that the website the domain name, www.manipalschool.ecity.com, is being used by the first defendant.



10. In para 5, the relationship between the third defendant and the promoters of the plaintiff is set-out. In para 6, the extract from the website is set-out. It is pleaded that the defendants have misrepresented themselves. In para 7, it is contended that the plaintiff trust was established solely by one Dr. Ramdas Pai. That the second plaintiff was also established by the said Dr. Ramdas M Pai. That the first plaintiff trust deed was executed on 19.5.1993 and was registered on 22.05.1993. That the said Dr. Ramdas M Pai had greatly contributed and pioneered the establishment of the University and town of Manipal, which has now become synonymous with medical and higher education. That in para 10, it is stated that pursuant to the registration of the trust on 22.05.1993 a Notification dated 1.6.1993 was published by the Central Government declaring the Manipal Academy of Higher Education (hereinafter referred to as MAHE-1, being the plaintiff) as a deemed University and following



institutions were established under the aegis of the deemed university:-

- (a) Kasturba Medical College, Manipal and Associated teaching hospitals, Manipal;
- (b) Colleges of Dental Surgery, Manipal (now known as Manipal College of Dental Sciences);
- (c) College of Nursing, Manipal (now known as Manipal College of Nursing);
- (d) Kasturba Medical College and Associates teaching institutions, Mangalore; and
- (e) College of Dental Surgery, Mangalore.

11. On 24.04.2000, another Notification came to be issued by the Union Government bringing the Manipal institute of Technology and College of Pharmaceutical Science under the ambit of the second plaintiff. In para 12, the details of 29 Departments and Institutions are set-out. In para 13, it is pleaded that the Deemed University, MAHE-1 was popularly being referred to as the "Manipal



University". That the words "Manipal University" have become synonymous with quality education, that as on date, the plaintiff trust is managing 14 establishments and sister concern under its aegis. In para 14, it is pleaded that recognizing the quality of education provided and administered by Dr. Ramdas Pai Groups, the Government of Sikkim collaborated and established the Sikkim Manipal University by an act of the legislature and thereby a special significance came to be attached to the word "Manipal". The copy of Notification dated 15.1.1995, establishing the Sikkim – Manipal University of Health, Medical and Technological Sciences Act, 1995 is and produced along with the plaint.

12. In para 15, it is pleaded that the plaintiff trust, referred to and known as MAHE-1, has garnered reputation not only across the country, but on the international stage also, as one of the most prestigious institutes of learning. That since the year 2000 over



84,728 students of 57 different Nationalities have walked through the portals of the plaintiff University. That the plaintiff is engaging nearly 2500 faculty and over 10,000 support and service staff for the purpose of managing and running the various professional and academic institutions.

13. In para 16, it is pleaded that the University has off-campus in Mangalore and Bengaluru and off-shore campuses in Dubai (UAE), Nepal and Malaysia. That MAHE-1 or Manipal University, is known for its high quality educational facilities like Simulation Lab with computer driven Manikins, an Innovation Centre, one of Asia's largest Health Sciences Libraries, one of the worlds' best Anatomy Museums, a business incubation centre and various other centres of excellence and also the University boasts of a plethora of international collaborations with the likes of the GlobalNxt University, Malaysia and the American University of Antigua and other academic collaborations and twinning programs with several



universities in the US, UK, Australia and other countries. That the recognition is on account of its unwavering dedication towards academic excellence and the same has resulted in establishment of a unique brand value which is representative of quality of the education institutes owned and controlled by the plaintiffs.

14. Para 18, details certain luminaries produced by the university and to name a few, Mr. Satya Nadella, CEO of Microsoft Corporation, Mr. Rajeev Suri, CEO of Nokia and Mr. Sampat Shivangi, Chairman of the Mississippi Board of Mental Health and a list of some famous alumni of MAHE (MAHE-1) deemed university is sought to be produced as document No.11. In para 19 the plaintiff details the various awards that it has been receiving and it is further pleaded that the said awards have added a gleam and shine to the word "Manipal" which word has emerged as an essential feature of the trademark/service mark/trade name/logo/label of the plaintiff trust. That the



goodwill generated, lends itself to the registered Trademarks.

15. In para 20, it is pleaded that the trade/corporate name, MAHE/Manipal Academy of Higher Education

(MAHE-1) also known as Manipal University forms an essential and integral part of the plaintiffs trading style. That the plaintiff trust has amassed a colossal reputation, not only in the field of education but also among the people at large, due to its world-wide presence and high quality services and extensive promotional activities. The plaintiff trust has executed numerous educational projects under the name MAHE/Manipal Academy of Higher Education and/or Manipal University (MAHE-1). That the mark MAHE, is an integral mark of the plaintiff trust and it is pleaded that the same has acquired a secondary meaning qua the activities / goods / business / services, of the plaintiff trust.



16. In para 21, it is pleaded that a brand assessment survey report in respect of awareness of brands in education and health space in India was conducted by Ernst & Young, and that the report is a reflection of the goodwill and reputation earned by the plaintiff trust under the mark "Manipal". A copy of which is produced as document No.13.

17. In para 22, it is pleaded that in addition to the mark MAHE, the word Manipal has been registered and used as a trademark / trade name / corporate name / logo / label and the word "Manipal" is an essential feature with regard to the educational services rendered by the plaintiff. That the mark "Manipal" has been continuously and openly being used since its adoption in 1993. In para 23, it is pleaded that the plaintiff trust has aggressively promoted the mark "MAHE/Manipal" in diverse educational activities and the words have been advertised through every mode of media.



18. In para 24, it is pleaded that the plaintiff has registered a domain name "manipaledu" and its mark MAHE is prominently displayed on the website www.manipalgroup.com. In para 25, it is pleaded that enormous efforts and resources have been continuously expended to take the mark amongst masses and create awareness amongst the public about the trade/services and the mark.

19. In para 26, it is pleaded that on account of aggressive campaigning and promotions, the brand has acquired huge popularity and instant recognition, not only in India, but globally also. That nearly a lakh of the degree certificates, awarded by the numerous institutions, also prominently bear the mark, of which "Manipal" is an essential feature and the word "Manipal" used in conjunction with other words, has singularly become distinctive and exclusively associated with the plaintiff trust. In para 27 the details of amounts spent on



promoting the brand between 1993 to 2018 is detailed and it is claimed that the plaintiffs have spent nearly 2334.99 lakhs.

20. In para 28, it is pleaded that the plaintiff's services are also being extensively promoted even outside the country. That the domain name manipal.edu has been obtained and registered on 27.09.1999. That the founder of the group Dr. Ramdas Pai has also obtained registration of the domain name "manipalgroup.com" on 22.12.1997 and material in respect of the same are also produced.

21. In para 31, it is pleaded that the word/mark "Manipal" is an essential feature and is the most valued intellectual property of the plaintiff trust. The paragraph further details the trademark registration obtained by the plaintiffs in different classes, namely, Classes 16, 35, 41 and 42, which have been detailed therein.



22. In para 32, it is submitted that the registration of the trade mark have been duly renewed and are valued and subsisting on the date of the suit. In para 34 it is pleaded that, caution notices have been published in newspaper and also oppositions filed with the Trade Marks Registry to the attempts to use the word "Manipal" by third parties. In para 35 it is pleaded that the plaintiff is the lawful owner and proprietor of the mark "MAHE" (MAHE-1) and is its user since 1993. That all activities of the trust have been under the trademark of which the word "Manipal" is an essential feature.

23. In para 36, it is pleaded that the word "Manipal" has become synonymous with the activities of the trust and that members of the trade and public alike are bound to associate the word mark "Manipal" with the activities of the services rendered by the plaintiff trust. In para 37, the annual admissions are set out and it is pleaded that between the year 2000 to 2018 are total of 92,450 admissions have been carried out and that the figures by



themselves, speak volumes of the reputation garnered by the plaintiff and also demonstrates the brand value the mark has acquired. That the word "Manipal" has achieved a secondary meaning in respect of the educational and healthcare services and has become synonymous with the quality of the educational services rendered by the plaintiff. It is further pleaded that the word "Manipal", earlier a village in Mangaluru district and now part of the Udupi district Municipal Corporation, has on account of extensive and continuous use, transcended the boundaries of its location and is exclusively associated with the plaintiffs' educational services and a proof in this direction is a publication in Economic Times "Thinking beyond IIMS" which is reproduced at page 238 reads as under:

"38. MANIPAL has achieved secondary meaning in respect of educational services and denotes a particular level of quality only being provided by the Plaintiff Trust. The word "MANIPAL", earlier a village in Mangalore district and now a block under Municipality Corporation limits of Udupi District, has on account of extensive and continuous use, transcended the location meaning and is associated with Plaintiffs' educational services provided to the general public. In fact, as



early as in the year 2004, Economic Times has published an article "Thinking beyond IIMS" which itself evidences the word MANIPAL having become synonymous of the Plaintiff's services. Relevant portion of the article has been reproduced hereinbelow:

"....Think education in India and you'll think of the Indian Institutes of Technology or Management – two traditions that have blossomed and blundered under the patronage of the Indian government.

Beyond these, there's little on the macro level that the country's education landscape offers. One brand that for 50 years has fought to break this hegemony is a little hilltop destination that consistently draws students from over 30 countries to its southern climes – a feat even the famed IITs and IIMs fall short of. The town is called Manipal, the institution, Manipal.

There's little to differentiate the two – over 50% of Manipal's population is students. And it's around this group that the folklore of Manipal generating the highest telecom revenues per kilometer in the country or accounting for the highest density per km of two wheelers have grown."

(Emphasis Supplied)



Printout of the article dated 21.5.2004 in the Economic Times is filed along with the present suit and is produced herewith as Document No.25."

24. In para 40, it is pleaded that the Dr. Ramdas Pai Group, has been running a school and styled as "Manipal School" in Mangaluru. That over the years the school has achieved distinction in its scholastic and co-scholastic areas and the details are found on the website www.manipalschool.edu.in. In para 41, it is pleaded that Dr. Ramdas Pai Groups is the promoter of the Manipal Hospitals, which is claimed to be one of the foremost multi-specialty health care providers, catering to both to Indian and foreign patients and that it is part of the Manipal Education and Medical Group. That Dr. Ramdas Pai Group, has established the Manipal Hospital and has since been running and managing the Manipal Hospitals situated in Bengaluru and presently is one of the largest healthcare brands and has its presence in seven Indian



cities and marked its international presence through two locations in Klang, Malaysia and Lagos, Nigeria and is known for its quality and affordable health care.

25. In para 42, it is pleaded that more than 12,000 professionals have graduated out of the ICICI Manipal Academy Program, which is a joint venture of the Group with ICICI Bank Ltd., under an MOU which also resulted in setting up of Manipal Academy of Bengaluru, with world-class residential campuses at Jaipur and Bengaluru and it partners with 25 leading banks and has trained over 25,000 professionals whose services are utilized by the leading banks, insurance and financial service organizations.

26. In para 43, it is pleaded that the mark "Manipal" is employed by all the entities under the group in their field of activities and thereby effectively rendering the mark "Manipal", as an integral mark for all the entities that fall under Dr. Ramdas Pai Group. It is pleaded that



the mark/word "Manipal" has become inextricably associated by the members of public and trade circles with the plaintiff alone. That the aforesaid marks have become a household name and pervades the globe. That the mark has achieved the status of a "well-known mark" in terms of Section 2(zg) of the Act and hence the marks are entitled to absolute protection against any misuse/misappropriation. Some of the trade mark registrations of Manipal Education in Classes 35, 41 and 42 are detailed in para 43. That it is further pleaded, that as per the online database of Intellectual Property Office UK and European Union Intellectual Property Officer, universities across the globe such as Cambridge, Stanford, Harvard, Oxford, University of Berkley Georgetown University, London School of Economics etc., which have a geographical name as its trade mark or as part of its trade mark, have been accorded statutory protection on acquiring a secondary meaning.



27. In para 43, it is pleaded that plaintiff had filed an opposition before the Registrar, Trademarks opposing the registration of the Defendant No.3's application for the Logo "Manipal Group" subject to amending the specification of goods in respect of "Lottery Tickets included in Class-16" only. The said opposition was rejected and the plaintiff has preferred an appeal which is pending before the Intellectual Property Appellate Board. In para 44, it is pleaded that the plaintiff has filed a suit in O.S. No.8204/2014 before the City Civil Court, therein inter alia seeking a permanent injunction restraining Manipal Academy of Health and Education Private Limited from infringing and passing off plaintiff No.2's marks and the same was sought to be withdrawn and to be re-presented, which came to be partially permitted and which was appealed by the plaintiffs to this Court and which order came to be set aside and matter was remitted back to the Trial Court and which were carried in appeal to the Apex Court by the plaintiff and in which appeal the Apex



Court has granted an interim relief of status-quo. It is pleaded that none of the defendants are parties to the said suit.

28. In para 45, it is pleaded that the cause of action for the present suit arose when they came across the advertisement in the "Times of India" newspaper announcing the opening of the new school namely, Manipal International School. In para 46, it is pleaded that the petitioners did a research about the said school in order to gather more material and have extracted the claims found on the website. It is also pleaded that they came across an advertisement, wherein, the third defendant is projected as a chairman of the first defendant and was to inaugurate the Manipal International School. In para 47, it is pleaded that the third defendant/appellant in the companion appeal has misrepresented to the office of the Prime Minister in the communication addressed to the Principal Secretary, PMO.



29. In para 48 it is pleaded that in the communication to the PMO the third defendant has chosen to use the acronym – MAHE and the trade mark – Manipal Academy of Health and Education which is identical with that of the plaintiff trust. That the letter dated 15.07.2004 is demonstrative of the malafide intent of the third defendant to ride upon the goodwill and reputation earned by the plaintiff and has tried to portray himself as a part of the Group running the Kasturba Medical College, Manipal and Manipal Hospital, Bengaluru which makes it evident that the defendants are attempting to piggy-back on the goodwill and reputation earned by the plaintiff trust and canvass the same as their own.

30. In para 49, reliance is placed on the defendants pleading in the proceedings before the Registrar of Trade Marks and that the pleadings clearly reveal that the third defendant was all along well aware of the use of the mark and the word “MAHE/Manipal and the statement of the



third defendant has also been extracted in the said paragraph and the extraction reads as under:

"I submit that even though the marks are similar, the Opponents institution is an University, rendering services in the field of Education, which is nothing to do with my business."

31. In para 50, it is pleaded that the plaintiff though well aware of the activities of the plaintiffs is making efforts to identify and project themselves as an associate and create an interest amongst the general public, that they are associated with the plaintiff trust and institutions. Further reliance and extraction of the third respondent statement is also produced in the said paragraph.

32. In para 51, the defendants admitting the usage of similar mark is reproduced. In para 53, it is pleaded that despite the defendants being well aware of the fact that the plaintiff is a prior-registered user of the word "Manipal", they have adopted the same and have also



attempted to use a deceptively similar trade mark of the plaintiff. In para 54, it is pleaded that the adoption is deliberate and with a malafide and fraudulent intention. In para 55 plaintiff has pleaded about the dishonest intention and in para 56, 57, 58 pleadings are on similar lines.

33. In para 60, it is pleaded that the acts of the defendants are in violation of the plaintiffs' exclusive statutory and proprietary rights in the registered and reputed trade mark/name MIS/MAHE/Manipal Academy of Higher Education and/or other marks of which Manipal is the essential feature and render it liable for inter alia:

- a) Infringement of trade mark;
- b) Infringement by dilution;
- c) Passing off;
- d) Acts of unfair competition; and
- e) Payment of Damages.



34. In para 60, it is further contended that the Manipal group logo is coined with the intention of misapplication.

35. The plaint has been resisted by the respondents. The written statements are preferred by the defendants No.3 and 4 and in para 1 it is pleaded that the suit has been instituted against defendants No.4 and 5 only with the intention of harassing them. In para 2 it is alleged that the plaintiffs are guilty of suppression of material facts. In para 3 it is contended that the defendant No.4 Company was incorporated on 09.05.2007 as a private limited company and thereafter converted into a company incorporated for charitable purposes and that one Sri M Samiullah is its Chief Executive Officer and authorized representative.

36. In para 4, it is contended that the name Manipal is the name of a locality in the town of Udupi and is a name commonly used by a number of businesses in a



variety of industries and sectors. That the fourth defendant is promoted by the third defendant. That the third defendant and the author of the plaintiff trust belong to the illustrious families of the late T U A Pai and his late brother T M A Pai who jointly founded a number of businesses and institutions under the name and style of "Manipal".

37. In para 5 it is contended that the plaintiff's claim to the use of the word "Manipal" is no different or better than that of the 3rd defendant. That the plaintiff cannot claim exclusive right to use the word "Manipal". That the plaintiff has no right to set up a challenge to the right of the 4th defendant or the third defendant, muchless against any person from using the word "Manipal".

38. In para 6, it is contended that 4th defendant is one of 80 odd companies that have adopted the name "Manipal" as part of the company name. That the fourth defendant, is primarily engaged in advancing the



charitable objective of disseminating health care services and education at highly subsidized cost. In para 7 it is contended that the 4th defendant has honestly conceived and adopted the term "Manipal" as part of its name since the date of its incorporation in the year 2007. That the adoption of the word "Manipal" for its own name as well as for its various trademarks is lawful, bonafide, honest and beyond question of anyone and that the pleadings in para 7 - a, b, c, d, e, f, g, h, I, j, and k are proof of the same. It is pleaded that the third defendant is involved in running the Manipal Career Academy established for the purpose of taking computer education to the remote parts of the State. It is further affiliated with the Manipal Schools and the third defendant has also set up Manipal Pre-University College. That the third defendant and his late father T Ramesh U Pai have also incorporated Manipal Academy of Health and Education Society, an association, incorporated under the Goa's Society Registration Act w.e.f. 1995 and the said society has successfully run schools under the



name and style of "Manipal Public School". That the society has executed license agreement for setting up of Manipal Public School on 18.01.2005 and the establishment of the schools has been advertised in the newspapers and that the said Manipal Public School has also a registered trade mark in the records of the Trade Mark Registry. That the society has also entered into an arrangement to run the famous Bharati Bal Vidya Mandir, Raibandar Goa. That it has also entered into another arrangement for running the Bhatikar Model High School, established in 1935 and in this regard the defendants reserves its rights to produce the records to demonstrate the running of the schools as the records are not currently available with the fourth defendant.

39. That all the business and education initiatives of the third defendant i.e., the said T Sudhakar Pai, known as Manipal Education Foundation, Manipal Academy of Health and Education Society and the fourth defendant are



collectively referred to in the ordinary course of their activities as the initiatives of the Manipal Group (“educational initiatives”). That the fourth defendant also has run a website described as <https://www.mahe.org.in> and in the website, the activities are set out in detail. Extracts of the said website on the website of the Manipal Public School as well as Madhava Pai Memorial College are produced as Annexure D17. It is further pleaded that the records and documents pertaining to the educational initiatives of the 4th defendant are not in its possession, but in the possession of the respective affiliate/entities that are running the same and hence leave is prayed to produce the same later (underlining by this Court). That the above facts demonstrates that the third defendant and the Manipal Group has been continuously engaged in the field of education since the time of late T U A Pai.

40. That the third defendant and his father together with the authors of the plaintiff trust belong to the family



of "Pais of Manipal" and neither intended nor were allocated, exclusively the mark "Manipal" nor the connected various educational and business initiatives to any of the family members. That the family members of late TUA Pai i.e., the late T Ramesh U Pai and Sri T Sudhakar Pai established and managed several educational and health initiatives of the 'Original Pais of Manipal' including the following-

- (a) Academy of General Education
- (b) Hindu Orphanage
- (c) College of Dental Surgery, Manipal,
- (d) College of Dental Surgery, Mangalore,
- (e) Manipal College of Education
- (f) Vaikunta Baliga Law College,
- (g) Manipal Hospital
- (h) Dr. TMA Pai Health Complex
- (i) Manipal Artificial Limb Centre

41. In para 9 it is contended that due to irreconcilable differences between the descendants of Dr. TMA Pai and descendants of late TUA Pai, the businesses



and educational institutions of the original Pais of Manipal, came to be split among the said descendants with involvement and assistance of Mr. Dhirubai Ambani, Mr. Virendra Heggade, Dharmadikari of Dharmasthala and Mr. C Subramaniam, Former Union Minister of Union of India and Former Governor of Maharashtra. That in the course of the split, neither the authors of the plaintiff's Trust nor any other descendants of the original Pais of Manipal, were allotted the exclusive use of the mark "Manipal" nor did any of the said descendants successfully assert exclusive rights to the use of the said name (emphasis by this Court).

42. In para 10 it is contended that in view of the above, the plaintiff's claim of all exclusive rights or better rights to use of "Manipal" is unfounded, as no exclusive or better rights have been conferred on the plaintiffs. That the author of the trust had instituted CS Nos.19, 20 and 21 of 1996 before the Hon'ble Madras High Court against



the third defendant and its companies. That the said suits were rejected and the judgments of the Madras High Court has attained finality and hence it is contended that the fourth defendant has absolute and unqualified right to use the trade mark "Manipal".

43. In para 11 it is contended that the word "Manipal" refers to a name of a place/locality in the town of Udupi and that 80 odd companies are registered in the records of the Registrar of Companies, in the name of "Manipal", which is commonly used and cannot be exclusively appropriated by the plaintiff. And furthermore, the third defendant has been using the word along with his father and grand father continuously for the purposes of educational services and hence the fourth defendant has legitimate right to use the said name.

44. In para 12 it is contended that the fourth defendant is not only entitled to, but has actually entered into franchise agreements with various persons across the



country to set up and run a number of schools under the name and style of “Manipal Global School” and “Manipal International School”. That the affiliate company of the fourth defendant has honestly adopted and registered the trademark “Manipal Group”, that the fourth defendant itself has applied for registration of the trademarks “Manipal International School” and “Manipal Global School” (emphasis by this Court).

45. In para 13 it is contended that MIS, set up by the fourth defendant, has even become well-known for its standard of education and infrastructure and the same is borne out by the fact, that the launch of the Manipal International School at Electronic City, Bangalore was widely covered by the Times of India on 29.01.2019 as admitted in the plaint. That the said Manipal International School has also won numerous awards and has received extensive press coverage (underlining by this Court). It is contended in para 14 that owing to the charitable motives



and intent of the third defendant and his father, the late T Ramesh U Pai, all the educational initiatives of the third and fourth defendants have focused exclusively on disseminating education as a form of social service and not as a business initiative.

46. The defendants berate the plaintiff for not appreciating the modest and humble approach of the third and fourth defendant and instead have attempted to compare the defendants' charity based approach, to its educational initiatives, with its own business savvy approach, focused heavily on extensive marketing and promotion of its educational institutions and unaffordable fee structure, to belittle not only the right of the defendants to use the mark "Manipal" but also to undermine their efforts to disseminate education at subsidized prices.

47. In para 16 it is contended that the approach of the defendants, is more in line with the vision of the



original 'Pais of Manipal', who saw health and education as key to India's freedom from colonial rule and success, and the plaintiffs have no right to prevent the defendants No.3 and 4. It is further pleaded that the marks, in which the third and fourth defendants' educational initiatives operate, is a different sphere, than that of the plaintiff's intended market and hence on that ground also there is no confusion caused by the usage of the mark "Manipal".

48. In para 17 it is contended that the fourth defendant has continuously used the mark "Manipal" since the date of its incorporation. That the objectives of the fourth defendant are borne out by the Auditor's Report dated 20.06.2019 which provides for financial summary of the years 2017-18, 2018-19 and the extracts of the annual return for the year 2018-19.

49. In para 18 it is contended that the fourth defendant's trademarks, including but not limited to "Manipal International School", "Manipal Academy of



Health and Education”, “Manipal Group and “MAHE”, have also been in active and continuous usage as evidenced by the fee receipts for the “Manipal International Schools” it operates in the Ananthpur for the year 2019-20.

50. In para 19 it is contended that the suit O.S. No.8204/2014 was instituted against the defendant No.4 against infringing the mark “Manipal”, but plaintiffs were not successful and their attempt to convince the Court to grant interim injunction having failed they preferred an application under Order 7 Rule 10 which resulted in an order by the trial Court, which came to be challenged before the High Court in MFA Nos.916 & 917 of 2017 and MFA Nos.2271 and 2272 of 2017, in which, the order of the Civil Court was set aside by the High Court which in turn resulted in filing a special leave petition, which is pending even as on date.

51. In para 20 it is contended that the plaintiff having failed in their attempts to secure an order of



interim injunction against 4th defendant have now engaged in forum shopping and it is further pleaded that the plaintiffs have suppressed the information about the judgment of the Madras High Court rendered in C.S. Nos.19 to 21 of 1996 with the sole intention of misleading the Trial Court into granting the reliefs of permanent and temporary injunction.

52. In para 21 it is contended that the fourth defendant has a legitimate right to use the marks impugned in the above suit and the plaintiffs have not approached the court with clean hands and hence are disentitled for any equitable reliefs.

53. In para 22 it is contended that the fourth defendant was incorporated in 2007 and its predecessor Manipal Academy of Health and Education Society was constituted in 1995. That the third defendant who is a family member of the late TUA Pai is entitled to use the



mark and the plaintiff does not have any right to restrain him or the fourth defendant from using the same.

54. In para 23 it is contended that the plaintiff despite being aware of the registration of the trademark "Manipal Public School" in 2005 itself the plaintiffs have not claimed any remedy. That the trade mark "Manipal International School" is an extension of fourth defendants' right to use the term or word "Manipal". That the plaintiffs having acquiesced with the usage of the word "Manipal" along with the "Public School" or in conjunction with the words "Public School" cannot now turn around and challenge the right of the defendant to use the mark "Manipal International School".

55. In para 24 it is contended that the trademark registered is not just the word "Manipal", but "Manipal Academy of Higher Education" and merely a part of the trademark which consists of generic word or descriptive of



a place, that the registration of such mark does not confer any exclusive rights to its components.

56. In para 25 it is contended that the 5th defendant is neither necessary nor a proper party to the proceedings and the fifth defendant is a well known brand for its fleet of upholstery and furniture products and is critically acclaimed for its quality of goods. In para 26 it is contended that yet another company going by the name of "Manipal E Commerce Limited" has been incorporated on 08.01.2018, which is not arrayed as party to the above suit. It is further contended that the domain name "Manipal School-ecity.com" appears to have been registered in the name of one Manipal E-Commerce Limited on 24.11.2018, whereas the 1996 company, by virtue of amalgamation with defendant No.5 in the year 2011 ceased to be in existence as on the date of registration of the domain name being 24.11.2018. The contents in paragraphs 22 to 28 are argumentative in



nature. The reply to the plaint averments are set out thereafter.

57. On perusal of the replies it is seen that the plaint averments are answered by the standard phrases, "Hence not traversed" or is "also are denied as false" and the "plaintiff is put to strict proof of the same" or by reiterating the contentions of continuous usage of the trademark by the third and fourth defendants. The plaintiffs allegation that the third defendant having attempted to project themselves as part of the Group is denied as false.

Submissions on behalf of the Appellant:

58. It is contended that the first appeal is by the 4th defendant and the companion appeal is preferred by the 3rd defendant, who is a Director in the 4th defendant's Institution. That the 1st plaintiff and the 4th defendant are the main players in this battle. That they share the same



lineage, popularly known as "Pais of Manipal". The learned senior counsel, referring to the family tree, points out, that the founder of the 1st plaintiff Dr. S. Ramdas Pai and the father of the 3rd defendant share a common ancestor i.e. one T. Ananta Pai and the 3rd defendant is the heir of the second son of the said Sri T. Ananta Pai and the founder of the first plaintiff trust is the 3rd son of the said Sri T. Ananta Pai. That initially, a Society called Manipal Academy of General Education Society was founded in 1943 and thereafter, in 1948 the Manipal High School Trust came to be registered and the High School came to be established. That TMA Pai and father of the first plaintiff's founder and Sri T. Upendra Pai set up the KMC Manipal and KMC Mangalore in 1953. That in 1979, the 3rd son of T.A. Pai passed away.

59. That on account of discord in the family, the Ambani Accord came about on 03.11.1993 leading to a division of the properties and the properties allotted, are



detailed. A copy of the Accord is produced along with I.A. for production of additional documents. The said Accord was followed by the Heggade Accord. In the interregnum, the Medical Colleges which were under the control and the share of Dr. Ramdas Pai were conferred a deemed university status by the UGC, by which time, the trust was running Medical College, Dental College, Pharmacy College, Engineering college, etc. The Heggade Accord came to be followed by the Subramaniam Award which is also produced along with I.A. as an additional document and it is contended that under the said award educational institutions, that is, the institutions excluded under the umbrella of the Deemed University or MAHE Trust, were allotted to the family of Ramesh Pai. In 1995, the Manipal Academy of Health and Education Society was registered (MAHE-2). The other MAHE i.e. Manipal Academy of Higher Education, (MAHE-1) a Trust was established in 1993 and was under the control of Ramdas Pai.



60. It is contended that MAHE-2 was running the Bal Bharatiya Vidya Mandir School at Goa and Bhatikar Model High School. It is contended that in 2005, the MAHE-2 split into two arms. One wing to run profitable institutions and another wing to run non-profit institutions and that defendant Nos.3 and 4 applied and obtained registration of the logo Manipal Public School and the brand name of Manipal Group. That this registration was unchallenged by the plaintiff. That in 2006, MPS Lucknow was established by defendant Nos.3 and 4. In 2009, MPS Khatrijar and in 2019 MIS (Manipal International School) Bengaluru and MIS (Manipal International School) Anantpur were established by defendant Nos.3 and 4 and in 2022, MIS Darbhanga were established by the appellants.

61. It is contended that the suit of the plaintiffs is a clear abuse of the process of law. That the plaintiffs having unsuccessfully approached the High Court of



Judicature at Madras and having been unsuccessful, are by the present suit attempting to reopen the issues already adjudicated and hence, it is contended that it is a fit case for this Court to lift the corporate veil and act against the plaintiffs. It is contended that the present suits are hit by the law of estoppel.

62. That the attempts by the plaintiffs to scuttle the use of the word "Manipal" is more than 2 ½ decades old. The suits in Madras High Court in C.S. Nos.19-21/ 1996 seeking to injunct the appellant, from using the word "Manipal" and claiming that the defendants were not part of the Manipal Group, was instituted against the appellant and his father and another brother i.e. Mr. T. Ramesh Pai and T. Shantaram Pai and the suit came to be dismissed and the appeals preferred by the plaintiffs came to be withdrawn with liberty. That though liberty was reserved, no fresh suit was filed within the period of limitation of three years.



63. That the saga spilled over to Bengaluru, after a hiatus of 12 years, resulting in institution of the original suit O.S. Nos.8203-04/2014, where yet again attempts were made to scuttle the use of the mark Manipal or from claiming to be part of the Manipal Group. In the said suits the application under Order VII Rule 10 of CPC came to be filed praying to return the plaint for representing the same before the jurisdictional court at New Delhi, which came to be allowed with an order that the same can be filed where the principal place of both the business houses was located. Aggrieved, the plaintiffs preferred M.F.A. Nos.917/2017 and 2272/2017 before this Court and the same was heard and the appeals came to be partly allowed (which was authored by Hon'ble Justice GNJ) and matter was remitted back for fresh consideration. Aggrieved, the plaintiffs carried it in appeal by way of an SLP No.10699/2019 before the Hon'ble Apex Court and the



Hon'ble Apex Court was pleased to pass an interim order of the following nature:

".....In the meantime, status quo, as it exists today, shall be maintained by the parties."

64. That the SLP is still pending and the order of status-quo is holding the field. That it has been falsely represented by the plaintiff that none of the defendants of the suit were parties in the said suit. That subsequently, defendant Nos.4 and 5 came to be impleaded as parties. That in complete disregard to the order of the status-quo ordered by the Hon'ble Apex Court, the present suit originally numbered as O.S. 1244/2019 and re-numbered as O.S. 960/2021 came to be filed.

65. That the suits were originally directed against defendants No.1, 2 and 3 and thereafter, defendants No.4 and 5 were impleaded. That the present suit is a clear and continuous case of abuse of the judicial process and the plaintiffs are guilty of having approached the Court with



unclean hands and equally guilty of suppression of material facts.

66. It is contended that Manipal Group was the success story of the Pai family and was built with equal contributions from all members of the family. That the appellants are concurrent users of the Trade Mark, on account of they having been part of the family, that built the legacy and that being the case, the appellants are equally entitled to use the mark and brand and being a family name, cannot be appropriated by one branch to the exclusion of others.

67. It is contended that the contributions of Sri T.U. Ramesh Pai, in the establishment and growth of educational institutions is unparalleled. That he was instrumental in setting up KMC and Academy of General Education (Umbrella Group of 25 Educational institutions). That he was a Member of the Goa University, Syndicate Member of Mysore University, Senate Member of Madras



University, Senate Member of Mangalore University and Chairman of Vidhyadhira Theerth Charitable Trust. That he co-founded numerous healthcare enterprises like; Dr. TMA Pai Health Complex (Udupi) Dr. TMA Pai Rotary Hospital, Mangalore, Manipal Hospital, (Bengaluru), Rural Maternity and Child Welfare Centre, Karkala Health Project and Maternity Hospital and the Manipal Hospital in the Manipal Artificial Limb Centre.

68. It is contended that the founders of the plaintiffs trust and the 3rd defendant, sharing common ancestors and being very much part of Pai family, neither of them is entitled to exclusive use of the word the brand "Manipal Group" or the logo MAHE and more importantly, the word "Manipal". That the trial court has failed to appreciate this critical aspect of the litigation which was foundational to dispute resolution. That no right to exclusive use of the word "Manipal" is conferred on the Plaintiff, in any of the Accords. Be it the Ambani Accord or



the Heggade Accord or the Subramaniam Award, no exclusive right is conferred on the plaintiffs. It is contended that the prima-facie finding of the Trial Court that there is no proof of usage of word "Manipal" in the educational activities of the appellants is baseless and would submit that the registration of the mark Manipal Public School and the Deed of Modification of 1975 which reflects the appellant as one of the trustees of Manipal High School and which is running an educational institution in 1948 is proof enough.

69. That the registered Trade Mark "Manipal Public School" is in vogue since 01.04.2004. That the 3rd and 4th defendant were running schools in Uttar Pradesh and Bihar since 2006 and 2009 and this fact being within the knowledge of the plaintiffs their false claim of ignorance, regarding establishment of Manipal International School is accepted and the trial court erred in placing reliance on the same. That the Trial Court failed to appreciate the fact



that the injunction would directly affect the students who have been admitted in the schools established between 2006 and 2021. The trial court has not appreciated the hardship that would not only be caused to the appellants but also to the innocent bystanders like the children and their parents and which loss, cannot be compensated monetarily. That presently, there are 250 students enrolled in MIS Bangalore Rural, 100 students in MIS Darbhanga and 500 students in MIS Ananthapur, whose future is threatened by the grant of temporary injunction.

70. The learned senior counsel Sri Siddarth Dave would vehemently contend that the gravamen of the charge and the soul of the plaintiffs case is that they do not want the appellants to use the word "Manipal" either as a prefix or suffix, along with the nomenclature of their ventures. He would contend that Section 9 of the Trade Marks Act, 1999 is a threshold bar to the suit and is an absolute ground for refusal of registration of Trade Mark



as the same bars the registration of any word which is not distinctive and the word "Manipal" is a generic word. He would further take the Court through Section 17 and Section 2(b) and would contend that in view of the provisions of the aforesaid sections, it is impermissible to allow the word "Manipal" to be kept in captivity by the plaintiffs. He would contend that the fraud has been played on the Courts and the Court in order to secure the exclusive use of Manipal he would also take the Court through Section 30 and elaborate on the limits of the use a word which is statutorily limited.

71. He would contend that the allegation of deception is wholly one sided and the conclusion drawn by the Trial Court is on account of the trial court failing to appreciate the provisions of Section 30. He would further contend that there is no impediment as the Trade Mark are not similar and are distinguishable and in support of the above, he would place reliance on Nandhini Deluxe



case and Parle's case. That, in none of the suits has the plaintiff raised any objection to the use of the word "Manipal" in the name of Manipal High School being run from 1948 and that the objection appears to be naming another school as Manipal International School.

72. He would further contend that the plaintiffs are running a Deemed University, whereas the 3rd and 4th defendant are merely running schools and both are incomparables and the Trade Mark being dissimilar, there is no infringement that can be discerned and he would further submit that the registration of Trade Mark is confined to certain services only. That the suit claims run contrary to the statutory provision. The appellants have placed reliance on the following rulings:-

S No	Case Name / Citation	Relevant Paras
1.	Lal Babu Priyadarshi v. Amritpal Singh (2015) 16 SCC 795	19, 22
2.	ITC Ltd. v. Registrar of Trademarks AIR 1977 Cal 413 (DB)	34, 35, 37
3.	Santosh Kumar v. Central Warehousing Corporation AIR 1986 SC 1164	4



4.	Parle Products v. J.P. & Co. (1972) 1 SCC 618	9
5.	Vishnudas Trading v. Vazir Sultan Tobacco Co. Ltd. (1997) 4 SCC 201	47, 48
6.	Nandhini Deluxe v. Karnataka Co-op Milk Federation (2018) 9 SCC 183	1, 3, 25, 26, 30
7.	Renaissance Hotel Holdings Inc v. B Vijaya Sai (2022) 5 SCC 1	50, 73, 74
8.	Sohan Lal v. Amin Chand (1973) 2 SCC 608	8
9.	Bagla & Co. v. Bagla Cosmetics 2000 SCC Online Del 439	10
10.	Black Diamond Track Part Pvt. Ltd. v. Black Diamond Motors Pvt. Ltd. (2021) SCC Online Del 2630	21, 22, 26, 28
11.	Advocate General, State of Bihar v. MP Khair Industries (1980) 3 SCC 311	7 – 10
12.	Delhi Development Authority v. Skipper Construction (1995) 3 SCC 507	35, 47, 49, 52 – 57
13.	Frost International Ltd. v. Milan Developers & Builders Ltd. 2022 SCC Online SC 394	
14.	T Arivandandam v. T.V.Satyapal 1977 AIR 2421	

Contention of the Respondents:

73. Per contra, the learned senior counsel Dr. Abhishek Manu Singhvi appearing on behalf of the plaintiffs would contend that the plaintiffs have been a



consistent, unwavering and current user of the word "Manipal" in the field of education and health for the last nearly 30 years. He would brush aside the contention that the word "Manipal" is a family name and hence, no exclusivity can be claimed. He would submit that they are known as Pais of Manipal and not the other way round. He would nextly, contend that the use of a geographical name is not absolutely prohibited and elaborating further, he would submit that a geographical name may also acquire secondary significance and consequent distinctiveness.

74. He would refer to the geographical name of Champagne and Sambhal to contend that though Champagne is the name of the geographical location, it has acquired a secondary significance associated with a particular product which is manufactured in the region.

75. Elaborating further, he would submit that the names Mercedes & Benz and Mahindra & Mahindra, are surnames which have acquired a similar distinctiveness.



76. He would point out that the defendants have not associated the word "Manipal" in their ventures in the health and education. He would be dismissive of the contention with regard to the Manipal High School. He would contend that the statement "I am running school" is patently erroneous and would submit that they are not running or administering even a single school.

77. He would contend that the school MHS, is run by a trust and the appellant in the connected appeal is one among the six trustees and hence being only one among the six trustees, he has no exclusivity or proprietary right over the name and brand of the trust.

78. He would contend that it is the appellants who are guilty of suppression and misrepresentation. He would contend that, neither the defendant No.3 nor defendant No.4, are running any school and in fact have granted licences and the schools are run by franchisees and rights



have been transferred for consideration to third parties, that is, to establish and run institutions using the word "Manipal" as a prefix or in other words the Manipal International School.

79. He would take the court through various documents, more particularly, registered Trade Marks, the registration of the 1st plaintiff trust. The statement tabular sheet, detail the humongous expenses incurred in promoting the mark and the brand name. That the brand "Manipal" has been consciously developed by the plaintiffs and such a brand, one which has secured not only a national recognition but also recognition on the international stage, is now facing erosion of its credibility on account of the franchisees granted by the defendants No.3 and 4 that too, to strangers and third parties to appropriate and use the word "Manipal". He would contend that "prior user" trumps even registration and both prior user and prior registration of the mark and logo



are with the plaintiffs. He would further object to the contention of the appellant that the plaintiffs have practiced fraud. He would submit that there is neither a plea nor a claim raised before the Trial Court. He would contend that in the absence of a plea, it is impermissible to even enter upon the said contention. He would take the Court through the various registration certificates issued by the Trade Mark registry to buttress his argument.

Reply by the Appellants:

80. At this stage the appellants have resorted to change of counsels and Sri Siddharth Dave, learned senior counsel appeared and submitted on behalf of the appellants in reply.

81. Per contra, it was contended by the learned senior counsel Sri Siddharth Dave that the parties are not strangers and are uncles and cousins and both sides hail from Manipal. That this is not a case of infringement of a



Trade Mark by the outsiders. He would take the court through a genealogical tree and would submit that the common ancestors of both the plaintiffs and defendants is one Sri Tonse Anant Pai. That the first Accord came about in 1993 leading to division of properties and the second Accord of the Subramanya award came about in 1994 to further smoothen the division of assets of the group, but neither of the awards partitioned, either the word "Manipal" nor assigned it to any one of the groups. He would contend that the word "Manipal" is the thrust of the plaintiffs case and they seek to place a premium and have hold on the word Manipal. He would contend that so long as the appellants, who also hail from Manipal, being part of the family they cannot be enjoined from using the word "Manipal" or associating the word "Manipal" with their business or other entities. He would also take the court through various orders of the Madras High Court. He would submit that the attempt by the plaintiff in the form of suits before the Madras High Court in 1996 and



thereafter, suits in 2014 and thereafter, the present suit is a contumacious act, bordering on contempt and amounts to forum shopping. That the trial judge erred in granting a relief which is omnibus in nature. He would further vehemently contend that injuncting the defendants from using the word "Manipal" at the interim stage, is wholly impermissible.

82. Per contra, the learned senior counsel Dr. Abhishek Manu Singhvi would submit that the plaintiffs are the users of the word "Manipal" since 1993 and that it is a use of which that has remained uninterrupted till today. That the Trial Court has found use of the word "Manipal" by the plaintiffs trust since 1993 and he would take the court through the notes of arguments filed into court. More importantly, page 12 in para 10 and taking the Court through the details, he would submit that the details are sufficient to demonstrate the solidity of the claim of the plaintiff. Elaborating, he would submit that the trust was



created in May, 1993. That subsequently, the Government of India, (MHRD) and UGC conferred deemed to be University status to Medical college. That the Government of Sikkim recognizing their contribution in the field of education enacted an Act notifying the establishment of Sikkim Manipal University by an Act of State Legislature notified on 16.01.1995. That till date over a lakh of students have passed through the portals of the various institutions run by the second plaintiff/University. That there are about 2500 faculty and more than 10000 support and service staff employed by the plaintiffs No.1 and 2. He would submit that as on 2018 a sum of Rs.152.52 crores has been spent on building brand "Manipal". He would contend that the sheer numbers quoted, one, indicative of the Popularity the brand has acquired and the endless and untiring effort and a humongous amount of money spent that has gone into, in building the brand.



83. That the second respondent University has off-campus in Mangalore and Bengaluru and offshore campuses in Dubai, Malaysia. That Manipal School, Mangalore is also run by Dr. Ramdas Pai. That the Manipal Hospitals came to be established by the Dr. Ramdas Pai Group, the founder of the first plaintiff trust and that the Manipal Hospitals have a presence in seven Indian cities and an international presence in Malaysia and in Nigeria. He would submit that these minimum details would suffice to infer in favour of the plaintiffs.

84. He would contend that the Trial Court has not granted an injunction without recording the reasons. On the contrary, the trial court has rendered a prima-facie finding that the word "Manipal" is no more a name of the place and *publici juris* but prima-facie it appears to have acquired a secondary meaning for the services rendered by the plaintiff in the field of education and healthcare and thus concluded that the marks used by the plaintiff are



well-known Trade Marks as defined under Section 2(zg) of the Trade Marks Act.

85. Further, countering the contentions on behalf of the defendants, the learned senior counsel would submit that the contention of the appellant that the word "Manipal" is *publici juris* is wholly erroneous as they themselves have applied for registration of the Trade Mark Manipal and that the very act of seeking registration, cuts at the root of their argument. He would further contend, that the contention of the Appellants that the word "Manipal" is a geographical name and does not acquire a secondary significance or distinctiveness, requires to be rejected outright. He would place reliance on the illustrative cases of Champagne & Shambal.

86. The learned senior counsel would submit that it is indisputable that the Trade Mark registration has been granted to the plaintiff for Clause-41 which covers the field of education. He would submit that it is immaterial



whether the violator is running a School or Primary School or Middle School as schools fall in the same *genre* of education and related services. That the plaintiff is not only running the Manipal Academy of Higher Education, but the group is also running the Manipal School at Mangalore. He would contend that the defendant is trying to create a subject category in Clause-41 where, none exists nor is it permitted under the Act and that the same is in the teeth of the provisions of Section 29(2) of the Trade Marks Act and would submit that an infringement would include a use of the mark even in respect of similar goods and services.

87. He would contend that the material placed on record nowhere demonstrates that Manipal International School being run by third parties, as neither generated any independent goodwill or reputation and there is no material to support the same and the adoption of the mark



“Manipal” by the defendants is deliberate and hence, a dishonest act.

88. Taking the Court further through the provisions of Section 29(4) of the Act, he would contend that use of the mark would amount to a violation even for good and services that are dissimilar. He would further submit that the test for holding, as to whether the same amounts to passing off or not, is not whether the parties are in the same line or business, but the question would be; whether there is a likelihood of it creating a confusion in the mind of the public/consumers and the defendants have successfully misled the public by their adoption and use of the registered mark of the plaintiff. He would submit that if the defendants are not injuncted, it would preclude the plaintiffs from expanding into the area of school education which services clearly fall within Clause-41 in respect of which, a registration of mark is granted to the plaintiff.



89. As regards the order of the status-quo granted by the Hon'ble Apex Court, he would contend that the proceedings leading to the appeal before the Hon'ble Apex Court, the cause of action was the infringement caused by the defendants therein in trying to infringe the Trade Mark of the first plaintiff i.e. MAHE by promoting an other trust with a similar abbreviations, but which reads as Manipal Academy of Health and Education. But the cause of action for the instant suit is the Manipal International School. That the issue pending before the Hon'ble Apex Court arises out of an interpretation of the law laid down by the Hon'ble Apex Court in the case of *Indian Performing Rights Society Limited Vs. Sanjay Dalia & Another*¹, and has nothing to do with the infringement complained of in the instant suit. That the cause of action for the instant suit i.e. O.S. 1244/2019 and re-numbered as O.S. 960/2021 and as reiterated the cause of action is the

¹ (2015) 10 SCC 161



commencement of the alleged Manipal International School in Bengalore i.e. in 2019.

90. With regard to the suit earlier instituted in the Madras High Court, he would submit that the Appellate Bench of the High Court, had permitted withdrawal of the suit by the plaintiff that with the withdrawal, the findings therein also stood effaced by the order of the Appellate Bench. He would contend that even otherwise respondents No.1 and 2 and the plaintiffs were not parties in the 1996 suits. That the 1996 suites were preferred by nine Group Companies of the Mohandas Pai Group. The cause of actions for the 1996 suit and 2019 suit are entirely distinct. That it has also been noted by the Appellate Bench that in view of the withdrawal of the suit that findings given at the interlocutory application stage would not operate as *res-judicata*. Hence, the reliance on the proceedings of 1996 is futile.



91. As regards the adoption of a geographical name, he would submit that the same is not new to the field of education and he would proceed to name several universities of international fame such as Cambridge, Stanford, Harvard, Oxford, University of Berkley Georgetown University, London School of Economics etc., as few of the universities which are identified by the name of geographical area where they are located, and he would contend that even if the word is generic one the same may acquire a secondary meaning and distinctiveness. He would also quote the cases where in grant of Trade Mark involving geographical names have been up upheld. He would refer to the cases of *Mangalore R.K. Beedies Vs. Mohammed Hani*², *The Nilgiri Dairy Farm Vs. S.A. Rathnasabhpathy*³, *Sunder Nagar Association Regd. And Another Vs. Welfare Cultural Club (Regd) and Another*⁴,

² *ILR 1993 Kar 2393*,

³ *(1975) 2 Kant LJ 505*

⁴ *(1995) 15 PTC 270*



*M/s Bikanervala Vs. M/s New Bikanerwala*⁵. Elaborating further, he would contend that all these cases are distinct as they have dealt with cases involving grant of Trade Mark registration involving a geographical area. Further drawing the attention of the Court to the voluminous documents produced by the plaintiff in support of the case. He would contend that the same are sufficient material to infer the balance of convenience in favour of the plaintiffs. He would lastly contend that the defendants deserve to be enjoined as they have deliberately set-out to piggyback on the name and fame acquired by the plaintiffs Trade Mark and which name and fame has been diligently acquired over a period of three decades.

92. The respondents have placed reliance on the following rulings:-

SL. No.	DESCRIPTION	PAGE NOS.
SCOPE OF INTERFERENCE		
1.	Wander Ltd. And Anr. Vs. Antox India P. Ltd. 1990 (Supp) SCC 727 : Para 13 & 14	1-9

⁵ (2005) 30 PTC 113



2.	Neon Laboratories Ltd. Vs. Medical Technologies Ltd. (2016) 2 SCC 672 : Para 5 & 12	10-20
3.	M/s Inphase Power Technologies Private Ltd. And Others Vs. M/s ABB India Ltd. ILR 2017 Kar 522 : Para 35, 36 & 37	21-56
CONDUCT DISENTITLING A PARTY FROM RELIEF		
4.	Gujarat Bottling Co. Ltd. And Others Vs. Coca Cola Co. and Others (1995) 5 SCC 545 : Para 47	57-89
SUPPRESSION		
5.	Udai Chand V. Shankar Lal and others (1978) 2 SCC 209 : Para 8, 9 & 10	90-94
DIRECTION FOR CHANGE OF SCHOOL NAME		
6.	The British School Society Vs. Sanjay Gandhi Educational Society & Another 2022 SCC OnLine Del 1165 : Para 41, 42 & 44	95-106
THRESHOLD FOR INFRINGEMENT IN CASES OF EDUCATIONAL INSTITUTIONS		
7.	Ritnand Balved Education Foundation vs. Ranchhod M. Shah and Ors. 2018 SCC OnLine Del 11910 : Para 25 & 29	107-113
PRIOR USER WILL PREVAIL		
8.	Neon Laboratories Ltd. Vs. Medical Technologies Ltd. (2016) 2 SCC 672 : Para 8, 9, 11 & 12	10-20
9.	Satyam Infoway Ltd. Vs. Sifynet Net Solutions (P) Ltd. (2004) 6 SCC 145 : Para 13	114-127
CONTINUED USE OF IMPUGNED MARK AT ITS OWN PERIL		
10.	M/s Hindustan Pencils Private Ltd Vs. M/s India Stationery Products Co. & Another (1989) 38 DLT 54 : Para 38	128-151
TEST FOR PASSING OFF AND SIMILAR ACTIVITY		
11.	The Timken Company Vs. Timken Services Private Ltd. (2013) 200 DLT 453 : Para 8.33, 8.37, 8.41 & 8.53	152-180



12.	Daimler Benz Aktiengesellschaft Vs. Eagle Flask Industries Ltd. AIR 1994 Del 239 : Para 5 & 15	181-185
IN CASE OF INFRINGEMENT, INJUNCTION MUST FOLLOW ESPECIALLY, WHERE ADOPTION IS PRIMA FACIE DISHONEST		
13.	Midas Hygiene Industries P. Ltd. And Anr. Vs. Sudhir Bhatia and Ors. (2004) 3 SCC 90 : Para 5	186-188
ONE MARK, ONE SOURCE, ONE PROPRIETOR		
14.	M/s. Power Control Appliances and Others vs. Sumeet Machines Pvt. Ltd. (1994) 2 SCC 448 : Para 41	189-208
DOCTRINE OF PROMINENT/ESSENTIAL FEATURES OF TRADEMARK AND USE THEREOF CONSTITUTING INFRINGEMENT AND/OR PASSING OFF		
15.	Max Healthcare Institute Limited v. Sahrudya Health Care Private Limited 2017 SCC OnLine Del 12031 : Para 20 & 21	209-218
SECTION 29(9) OF THE ACT AND DISTINCTIVE ELEMENTS		
16.	Renaissance Hotel Holdings Inc. v. B. Vijaya Sai (2022) 5 SCC 1 : Para 37, 39 & 44	219-250
TRAFFICKING IN TRADEMARK IS NOT PERMISSIBLE		
17.	Vishnudas Trading As Vishnudas Kishendas Vs. Vazir Sultan Tobacco Co. Ltd, Hyderabad and Another (1997) 4 SCC 201 : Para 23	251-275
RIGHTS ON ACCOUNT OF PRIOR USE IS SUPERIOR TO STATUTORY RIGHT TO REGISTRATION AND SECTION 28(3)		
18.	S.Syed Mohideen v. P.Sulochana Bai (2016) 2 SCC 683 : Para 27, 30, 30.4, 30.5, 31.2	276-297
ESSENTIALS OF PASSING OFF		
19.	Cadilla Healthcare Ltd. v. Cadilla Pharmaceuticals Ltd. (2001) 5 SCC 73 : Para 10 and 35	298-320



IN CASES OF CONTINUING TORT (SUCH AS PASSING OFF AND INFRINGEMENT OF A REGISTERED TRADEMARK), THE PLAINTIFF GETS A FRESH CAUSE OF ACTION.		
20.	Bengal waterproof Limited v. Bombay Waterproof Manufacturing Company and Anr. (1997) 1 SCC 99 : Para 10	321-333

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SL. No.	DESCRIPTION	PAGE NOS.
GEOGRAPHICAL NAMES HAVING ACCORDED PROTECTION		
1.	Mangalore R.K. Beedis Vs. Mohammed Hanif (1993) SCC Online Kar 132 Para 24	1-21
2.	Nilgiri Dairy Farm Vs. S.A. Rathnasabhaphy (1975) SCC Online Kar 22 Para 19, 25 and 60	22-37
3.	M/s Bikanerwala Vs. M/s New Bikanerwala (2005) 30 PTC 113 Para 6, 31 and 32	38-52
4.	Geepee Ceval Proteins and Investement Pvt. Ltd. Vs. Saroj Oil Industry (2003) 27 PTC 190 Para 7, 8 and 9	53-62
5.	Hindustan Radiators Co. Vs Hindustan Radiators Ltd. 1987 PTC 73 Para 2, 5, 7 and 12	63-75
6.	Sunder Nagar Association Vs. Welfare Cultural Club (1995) 15 PTC 270, Para 4	76-78
SURNAME BEING ACCORDED PROTECTION ON ACQUIRING DISTINCTIVENESS		
7.	Mahendra and Mahendra Seeds Pvt. Ltd. Vs. Mahindra & Mahindra Ltd. (2003) 26 PTC 434 Para 39	79-99



8.	Mahendra & Mahendra Paper Mills Ltd. Vs. Mahindra & Mahindra Ltd. (2002) 2 SCC 147 Para 7 and 25	100-114
A GENERIC WORD MAY ACQUIRE DISTINCTIVENESS		
9.	T.V. Venugopal vs. Ushodaya Enterprises (2011) 4 SCC 85 Para 75, 90 and 93	115-150
TRIAL AND HEARING OF THE SUIT IN MATTERS RELATING TO TRADEMARKS, COPYRIGHTS AND PATENTS SHOULD BE ON AN EXPEDITED BASIS		
10.	Shree Vardhman Rice and General Mills Vs. Amar Singh Chawalwala (2009) 10 SCC 257 Para 2, 3 and 4	151-152
11.	Glenmark Pharmaceuticals Limited Vs. Merck Sharp and Dohme Corporation and Anr. (2015) 6 SCC 807 Para 7, 8 and 10	153-158
12.	Dhariwal Industries Ltd. & Ors. Vs. MSS Food Products (2005) 3 SCC 63 Para 15	159-167
A PARTY HAVING APPLIED FOR REGISTRATION OF A WORD AS A TRADE MARK CANNOT ARGUE THAT THE MARK IS DESCRIPTIVE OR GENERIC.		
13.	Indian Hotels Company Ltd. vs. Jiva Institute, 2008 SCC Online Del 1758 Para 39	168-183

GENERAL PRINCIPLES GOVERNING THE GRANT OF INJUNCTIONS:

93. The law in this regard is no more *res-integra* and the same has been well settled and oft reiterated by



the Hon'ble Apex Court. The Hon'ble Apex Court as early as in 1992 in the case of *Dalpat Kumar And Another Vs. Prahlad Singh And Others*⁶, has been pleased to hold in para 5 which reads as under:-

"5. Therefore, the burden is on the plaintiff by evidence aliunde by affidavit or otherwise 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 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 non-interference 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

⁶ (1992) 1 SCC 719



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.

94. On a reading of the above, it is apparent that the court dealing with the prayer for injunction has to come to a prima-facie conclusion that; the plaintiff has demonstrated a prima-facie case which calls for adjudication and (2) the plaintiff has demonstrated the



existence of a prima-facie right and (3) the plaintiff has demonstrated the prima-facie infraction of his right and that the infraction of the right is a condition precedent for grant of temporary injunction and lastly, the Court prima-facie conclude that failure to interfere would result in irreparable injury to the party seeking relief and that the injury must not be one that could be adequately compensated by way of damages and the balance of convenience must be in favour of the party apprehending the injury and the Court must exercise sound judicial discretion in enumeration of mischief and injury that is likely to be caused by the failure to grant injunction.

95. This Court now proceeds to examine as to whether the order of the Trial Court impugned in the appeal satisfies the mandate of law as enunciated by the Hon'ble Apex Court.

96. As noted supra, order of the trial Court reflects the detailed consideration of the plaintiffs pleadings in



paras 2 to 23. In paras 24 to 26, the Commercial Court has summarized the plaintiffs contentions regarding the cause of action. In paras 27 and 28, recorded the contentions of the plaintiff that the infringement are deliberate and motivated. In para 30 it records the grant of Ex-Parte temporary injunction. In paras 31 to 38, it has recorded the contentions of the 3rd defendant. In paras 39 to 49 it has recorded the contentions canvassed on behalf of the defendants No.4 and 5. In para 50, it has recorded the rulings relied upon both by the plaintiffs and defendants and in para 52, it has framed the following point for consideration, which are as under:-

"52. Now the points arise for my consideration are:

- 1) Whether the plaintiffs have made out prima facie case of infringement of his registered trademark, passing off and unfair competition by the defendants?*

- 2) Whether the balance of convenience lies in favour of the plaintiffs?*



- 3) *Whether the plaintiffs will be put to irreparable loss if the reliefs sought under the I.A.No.I to VI are not granted?*
- 4) *Whether the defendant No.3 has made out sufficient grounds to vacate the exparte T.I. granted against him?*
- 5) *What order?"*

97. In para 55, it has extracted the list of documents filed on behalf of the plaintiffs and in para 56 extracted the list of documents filed on behalf of the defendants and in para 57 it has recorded the admitted or undisputed facts. In para 58, it has appreciated the facts relating to the family of one Sri. T.A.Pai who is the common ancestor and the various branches of the family. It has also appreciated the fact of split in the family and the Accords or Settlements arrived at between the warring parties at the intervention of luminaries. In paras 59 to 61, it has appreciated the crux of the dispute and issues subsisting between the parties. In paras 62 and 63, it has



appreciated the filing of suits before the High Court of Judicature at Madras and the filing of appeals and leave granted by the Appellate Bench. That the findings at the interlocutory stage do not operate as *res-judicata*. In para 64, it has summarized the claims of the plaintiffs with regard to the creation of the trust, registration of the mark for word and devise in Clause, 16, 35, 41 and 42 and has also appreciated the list of 18 institutions in India and two institutions outside India that are run by the second plaintiff-University. The invitation by the State of Sikkim to the plaintiff to establish a University. It has appreciated the statistics regarding number of students who have passed through the plaintiff's University. It is also alive to the fact of several famous personalities who are alumnus of the University. In para 65, it has summarized the various awards conferred on the plaintiffs in recognition of their efforts in the field of health and education and has observed that the awards are reflection of the good will acquired by the plaintiffs. It has also appreciated the



Brand assessment survey report by a leading organization called Earnst and Young, as far back as in April, 2016. It has also appreciated the article published by the Economic Times on 14.02.2019 and has also appreciated the article which speaks about the pioneering of the plaintiffs and the institution in the field of education and healthcare and has also brushed aside the objection to consideration of the said reports published in the newspaper on the premise that there is nothing brought on record to disbelieve the same. In para 66, it has appreciated the various other documents like prospectus certificates, degree certificates, Marks Cards, invitations etc. in which the mark MAHE/Manipal Academy of Higher Education/Manipal Inspired by Life, are displayed. It has also appreciated the web address of the plaintiff. It has also appreciated the advertisement bills on the promotion material. It has recorded that the same prima-facie reveal that the plaintiff has been spending huge amount towards marketing and establishing their Trade Mark Manipal Academy of Higher



Education/MAHE/Manipal University/Manipal Inspired by Life. It has also appreciated the web address on the websites and recorded domains have been created as far back as 27.09.1999. In para 67, it has appreciated the plaintiffs opposition, to the attempt by a third party to have the Trade Mark, Manipal, registered in its favour. In para 68, it has appreciated the plaintiffs case of Dr. Ramdas Pai Group running a school name of 'Manipal School', Mangalore. The domain name of the website is also appreciated, the establishment of a institution by Dr. Ramdas Pai Group, in collaboration with ICICI Bank Limited and known as ICICI Manipal Academy for Banking and Insurance in 2008. That the domain name *ima.manipal.edu* and which institution, it has recorded, has established partnerships with several leading banks, financial companies and financial institutions for the purpose of training professional. In para 69, it has examined and appreciated the letter of intent dated 23.07.2018 issued by the Government of India (HRD)



Department recognizing the second plaintiff as an institution of eminence deemed to be University. In para 70, it has appreciated the plaintiffs contention that the defendant No.2 originally named as Manipal Control Data Electronic Commerce Limited MCDEC Limited and it got changed its name to Manipal E-Commerce Ltd., in 2003 and later got itself amalgamated with Defendant No.5. It has also examined the documents relating to registration of the domain name by one Murali Mohan for E-Commerce Ltd., on 24.11.2018 and updated on 23.01.2019 and on these basis, it justifies the impleadment of defendant No.2 and has prima-facie observed that Defendant No.2 is the person behind the first defendant. In para 71, it has appreciated the advertisement issued in the Times of India newspaper regarding the opening of Manipal International School wherein, it has, proclaimed itself as a legend in the field of education and has further claimed that it is a part of the Manipal Group which has been imparting world class education for over last eight decades. In para 72, it has



appreciated the documents produced by the plaintiff (exhibits are a photo of defendant No.3 inaugurating a ceremony). Appreciating the media proclamation, it has prima-facie recorded that material on record do not reveal the existence of a company being run in the name of Manipal Group and it has also observed that there is nothing on record to demonstrate the third defendant as a Chairman of the alleged Manipal Group and in that view it has observed that prima-facie the suit cannot be construed as a malafide or a fraudulent attempt or an abuse of the court. In para 73, it has appreciated the documents produced on behalf of the defendant. It has recorded that the documents demonstrated that the 4th defendant was incorporated on 09.05.2007 and that the defendant No.3 and one Kowlagi Kishore Kumar are its Directors and that subsequently, it has been changed to a Charitable company from 14.03.2018 onwards and 4th defendant has applied for Trade Mark registration for the word "Manipal International School on 04.11.2015 in



Clause-41. The application is signed by the 3rd defendant in his capacity as Director of the 4th defendant. The said application came to be objected and registration was refused by the Examiner of Trade Mark by 20.04.2020 and it has also extracted the reasons for rejecting the application. In para 74, it has appreciated the incorporation of the defendant No.5 Company. In para 75, it has appreciated plaintiffs opposition to the application filed by the defendant No.3 and has extracted the counter statement of the defendant No.3 which reads as under:-

"75. The Plaintiffs have produced copy of counter statement filed by the defendant No.3 for the Opposition No.MAS 58810 filed by the plaintiff No.2 against the Application No.659807 by the defendant No.3 for the registration of trademark 'Manipal Group' in Class 16 wherein, the defendant No.3 has stated as under:

"1. I have been trading under the name and style of Manipal Group and engaged in the business of stockist and distribution of State Lotteries ever since the year 1994. I submit that during the course of the said business I have honestly conceived and adopted the trade mark MANIPAL GROUP since the year 1994. I have done



extensive and continuous business under the above trade mark since 1994 and the said trade mark has become associated with my business in respect of Stockiest and distribution of State Lotteries.

4. *As regards para 1(a), I submit that the MANIPAL ACADEMY OF HIGHER EDUCATION TRUST, MANIPAL, is a part of various educational charitable and financial institutions established by late Dr. Madhav Pai. The main objects of the trust are to support and promote as advancement of educational activities in all its branches and to promote the Konkani language and are and culture of the Konkani speaking people, which is nothing to do with my business. In any event I submit that the above Institution was formed and maintained by the family of Pals in which I am also one of the member of the family and hence I am entitled to use the word MANIPAL GROUP for my business.*

7. *With reference to the Notice of Opposition, I submit that till date not even a single instance of confusion has been proved by the Opponents. I submit that no body in the earth will confuse the trust, formed to support and promote the advancement of educational activities in all its branches and to promote the Konkani language and art and culture of the Konkani speaking people, is nothing to do with my business.*



Therefore, I submit that Section 11 of the Act will not be a bar for the registration of my trade mark."

98. In para 76, it appreciates the registration of the Trade Mark Manipal Group in Clause 16. In para 77, it has appreciated the letter addressed by the defendant No.3 to the Principal Secretary, in the office of the PMO, New Delhi and has extracted the relevant and in Para 78, it has recorded that the hospitals claimed to be run by defendant No.3 in his letter to the PMO, are in fact run by the plaintiffs and has observed that an attempt has been made to convey an impression that the author is backed by the Group running the hospital therein. It has also appreciated the documents being google extracts produced by the plaintiff, which demonstrate that the word "Manipal" is synonymous to the plaintiffs institutions. In para 79, it has recorded the admissions by the defendants No.3 to 5, that they are using the word mark "Manipal" as their trade name, trade style, domain name and trade mark and has further appreciated their contention



regarding the alleged distinction and their views and has appreciated the contentions of defendants No.3 to 5. In para 80, it has appreciated the Memorandum of Association and Articles of Association of the 4th defendant Company which has formed in 2007. In para 81, it has recorded a prima-facie finding that the objectives of the 4th defendant are similar to the objectives of the plaintiff trust. In para 82, it has appreciated the Deed of Modification of Manipal High School Trust which was earlier formed on 21.02.1950 by Dr. TMA Pai the then Registrar of the Academy of General Education of Manipal. It has further appreciated the news articles regarding the contributions of one Ramesh Pai and his uncle Dr. TMA Pai and in para 83, it has recorded Annual Magazines for the year 1996-97 and 2018-19 and the extract of Manipal PU College. It has recorded that the said school was started in 1948 under the name of Manipal High School and it was upgraded to a Junior college in 1972 and renamed as Manipal Pre University College in 1986. The Trial Court is



also alive to the contributions of the founders and the demise of one of its propounders and the installation of the third defendant as correspondent in 2008. In paras 84 and 85, it has discussed the registration and establishment of Manipal Academy of Health and Education and the registration of Trade Mark "Manipal Public School" and has also extracted the display on the webpage and placing reliance on the contents, it has prima-facie observed that the same would go to show that the word Manipal has not remained as mere name of the place and has further held that there is no material produced by the defendants to demonstrate the establishments of school in the distant past to claim concurrent usage. In para 86, it has discussed the execution of franchisee agreement by the 4th defendant in favour of certain third parties in Telangana State for the establishment of the school at Anantapur. It has also examined the audit report and observed that, it did not reflect any revenue in the year 2017-18 and revenue of 39 lakhs for the revenue year 2018 to 2019.



The third defendant and one K. Kishore Kumar recorded as Directors of the Company. That the fee receipt reflects the collection of fee by the school and are not reflected in the Company records and has observed that the same reveals functioning of the schools by the franchisees in Chennai and Hyderabad. In paras 87 and 88, it has discussed the filing of O.S. No.8527/2019 on account of the plaintiffs publishing the Ex-Parte interim order granted by the court. In para 88, it has appreciated the fact, that out of the Trade Marks registered under Clause 41 and 16, most of them belong to the plaintiff including the registration mark and word "Manipal". In para 89, it has appreciated the contention of the defendant that there are several other private entities which are using the word "Manipal" and the absence of opposition to the same. In para 90, it has appreciated the defendants arguments that the word "Manipal" is a generic name and *publici juris* and neither registrable nor enforceable and rejecting the argument, it has prima-facie held that the word "Manipal" is a



geographic name and it has acquired a secondary meaning and distinctiveness and that the word "*per-se*" has not acquired reputation, goodwill and distinctiveness but for the efforts of the plaintiffs.

99. In para 91, it has prima-facie recorded the finding that the materials produced by the plaintiffs reveal that they are the registered proprietor of the Trade Mark Manipal Academy of Higher Education, Manipal Academy of Higher Education Deemed University, MAHE, MAHE Deemed University, Manipal University for word and device in Clause 16, 35, 41 and 42 and for a "Manipal Label", Manipal Inspired by Life" in Clause – 41 and 42 and has further recorded a finding that the essential and eminent feature of the aforesaid Trademark is "Manipal". It has further recorded that the plaintiffs have been using the said mark continuously for three decades and that the Trademark are duly renewed. It has further observed that such registration prima-facie indicates as to the validity of



the Trademark of the plaintiffs under Section 31 of the Act and has arrived at a prima-facie conclusion that the word "Manipal is no more a name of a place or a *publici juris*, but appears to have acquired a secondary meaning for the services rendered by the plaintiff in the field of education and healthcare. It has prima-facie disbelieved the defendants contention that the popularity, reputation, goodwill and distinctiveness are due to a joint efforts of Pais of Manipal. It has further recorded a finding that neither the 3rd defendant nor his father appear to have established educational institutions and hospitals after 1993, on the contrary it has recorded that the plaintiffs have been moving further and developing and starting institutions in the field of education and healthcare and hence, has been pleased to prima-facie reject the contention. In para 92, it has appreciated the material and rendered a prima-facie finding that the marks used by the plaintiffs fall within the meaning of 2(m) and 2(zb) of the Act, that the plaintiff No.2 is the registered proprietor of



the marks. It has also prima-facie recorded a finding that the claim of concurrent use by the defendants on account of registration of the mark was limited to the field of lottery tickets and not in the field of education and healthcare and which also is sub-judice before the Appellate Authority.

100. In para 93, it has appreciated the provisions of Section 29 of the Act and in para 94, it has discussed and recorded that the essential feature in the name of the defendants No.1 and 4 is "Manipal" and in this regard it has placed reliance on the admitted use of the domain name, the email and on the said basis has rejected the contention that defendant No.2 was no more existence. It has also observed that the 5th defendant is the registrant of the domain name mahe.org.in and it has identified that the 3rd defendant who is also a Director in defendants No.2, 4 and 5, as the key person behind the establishment of defendant No.1. It has further summarized and



observed that the material indicate, that the defendants No.3 and 4 intend to provide services in the field of education in the name of the first defendant and which is prima-facie identical with the registered trademarks of the plaintiffs. It has also recorded that the domain name used by the 5th respondent is identical with the registered trademark of the plaintiff. It has further observed that the defendants have not placed material to show their long, continuous and simultaneous use to take shelter under the concept of a concurrent user. It has also prima-facie observed that there is nothing on record to show that the defendants have been in the use of the word mark "Manipal" in the field of education and healthcare after 1993 except in the inauguration of Manipal International School in 2019. In para 95, it has not accepted the defence that the reputation and goodwill of the word "Manipal" has been on account of a joint efforts of a Pai family and it cannot be attributed to Dr. Ramdas Pai alone. In this regard, it has placed reliance on the extensive use



of the mark by the plaintiff, in the field of education and healthcare, post 1993 i.e. post Ambani Accord. In para 96, it has discussed in detail the effect of using a geographical name and the objection that registration cannot be obtained for the word “Manipal” alone and the acronyms MIS for registration of the domains and view adopted by Delhi High Court in Jolen Inc. Vs. Shobanlal Jain & Others⁷ case. In paras 96 and 97, a discussion of the contentions advanced and the reasons to either accept or reject the contentions are found. In paras 98, 99 and 100, it has recorded that the material before the Court is sufficient to believe at this juncture that the mark “Manipal” has acquired a secondary meaning for the services rendered by the plaintiff in the field of education and healthcare and not in other fields and in that view, it has deemed it necessary to grant the injunctive relief. In para 99, it has discussed comparative hardships and has held that it is always open for the defendants who have

⁷ (2004) SCC Online Mad 883



started a new venture to commence and carry on business in a different name or a changed name, and that the same would not cause any irreparable hardship to them.

Reasons and conclusion by this Court:

101. From a reading of the above, it is apparent that the trial Court has conducted a detailed exercise and has not merely appreciated the rival contentions but has also recorded cogent and possible reasons either for accepting or rejecting contention. It has also examined the various rulings and has passed an order which it deemed equitable in the facts and circumstances, prima-facie demonstrated by the parties. It has also examined the relative hardship that would be suffered and thereafter has proceeded to grant a relief.

102. The learned senior counsels have virtually replicated before this Court the arguments that they canvassed before the Trial Court also. It would not be out



of place if we observe that even at a first glance, we are faced with a wealth of pleadings and material on the part of the plaintiffs resisted by penury on the part of the defendants.

103. It would be profitable to observe at the outset that the distinct feature of argument canvassed. That the schools allegedly claimed to be run by the defendant or in fact schools that are been run by the third parties, who it is claimed are franchisees or in other words holders of rights assigned by the defendants, appears to be the factor which has provoked this litigation. We are constrained to make this prima-facie observation in view of the focal arguments by the parties. The focal contention canvassed is that it is "all in the family" and that the individuals behind the organizations are related to a common ancestor and whose progenies have been responsible for the word "Manipal" being associated with the family and on account of which the word has acquired



extensive name, reputation and goodwill. But it is also the contention of the appellant that the word "Manipal" has not acquired any secondary meaning or distinctiveness and it is merely a name of a geographical area. Such approbation and reprobation prima-facie considerably weakens the defence of the appellants. Similarly, in one breath they claim the word "Manipal" has not acquired any significance but it is on record that they have also made application for registration of the word "Manipal" as a mark under the Act. If it is the firm opinion of the defendants (that the mark is unregistrable) that the word "Manipal" cannot be registered as a mark, then the onus was on them to explain the application for registration of the "word" as a mark.

104. The plaint pleadings in para 7, 10, 12, 15, 16, 18, 19, 21, 22, 23, 26, 27 and 36 are not empty pleadings but have been prima facie backed by materials produced in support of the pleadings. The plaint pleadings



demonstrates a prima facie case of the plaintiff assiduously building the brand from 1993 onwards. These pleadings and the supporting documents prima facie demonstrates that the balance of convenience lies in favour of the plaintiff. The pleadings in para 36 of the plaint wherein the news article has been extracted would prima facie go to show the popularity of the institutions being run by the plaintiffs wherein the article would mention that 50% of the town's population consists of students. The pleadings in defence i.e., in the written statement and objections are not supported by any prima facie material.

105. The defence that the word "Manipal" has not been allocated to any of the groups during the separation of assets cuts at the very root of the defendansts case. Firstly, it has not been demonstrated that the word "Manipal" was registered has a mark or atleast developed as a trade mark by the unified group. Secondly, there is



no rebuttal material produced by the defendants to rebut the assertions of the plaintiffs regarding registration of the mark and the expansive spending for promotion of the same. That apart the defendants have categorically admitted that they are using a similar mark. If this admission is viewed in the backdrop of the discussion supra, then it leads the Court to the inevitable conclusion that if the injunction is not granted it may cause irreparable damage which may not be possibly compensated in terms of money. Though the defendants made a tall claim regarding running of schools a detailed examination of the material is not very supportive nor is there any definitive evidence, prima facie demonstrating that the defendants have indeed been running schools. That apart it is an admitted fact that the schools are run by third parties and are not under the control of the defendants. It is also an admitted fact that the defendants have been making attempts and which attempts appears to be surreptitious, post 1993 in trying to ape the marks



and the acronyms and have even admitted to applying for registration of a similar mark. In that view if the order of the trial Court granting injunction is not affirmed and upheld it could possibly cause, not only an erosion of the brand value of the mark registered and used by the plaintiff, but would indirectly be aiding the defendants in prima facie what appears to be a case of passing off by creating a confusion in the minds of the general public and in the trade circles.

106. After having appreciated the contentions and after having perused the documents, we are of the opinion that the documents make out a prima-facie case on behalf of the plaintiffs. The material produced by the plaintiffs prima-facie discloses the sustained efforts and expenditure by the plaintiffs to promote the mark "Manipal" and brand MAHE not only across the country but also on international shores and we find absence of similar efforts by the defendants more over the absence is glaring. Similarly,



prima-facie we find that the efforts of the plaintiff has been recognized in the form of rewards, awards, citations etc. by the public and authorities, which prima-facie appears to be reflective of the adulation enjoyed by the plaintiff and an even more striking feature of the material produced by the plaintiff is that, the efforts and measures to promote the mark and brand in the field of health and education, has been continuous. On the other hand, the material placed by the defendants in support of their case would demonstrate a start, stop approach and prima-facie is not demonstrative of its contention of being a continuous and concurrent user. Their contention that Manipal is a family name is belied by the material they have attempted to place before this Court by way of an additional documents. The family is described as Pais of Manipal and nowhere (they known as Manipal family) and none of the literature produce would disclose them as Manipal family. It is pertinent to note at this stage that the respondents have not placed any material to



demonstrates control over the administration of the schools, said to be run by them. The minimum requirement would have been to state particulars of the staff strength, students strength, the quantum of salary, the expenditure incurred and the profit or loss suffered, the amount spent on promotion etc. even though certain material like paper advertisements have been produced by the plaintiff in support of its claim of cause of action which advertisement feature. The schools claim to be run by the defendants no particulars are forthcoming from the side of the defendants. In the absence of such particulars of the side of the defendants, the Trial Court cannot be faulted for having appreciated such similar material placed before it by the plaintiff and which by themselves make out a case of balance of convenience being infavour of the plaintiff. The same claim to have been spent by the plaintiff for popularizing the mark and brand is in the region of 152 crores and such a similar or lesser or higher figure is conspicuously absent in the pleadings or



submissions of the defendant. This is one of the circumstances which would be a prima-facie indicator of the direction in which the Court would be required to lean. More particularly, in cases involving violation of IPR rights. It would also be a pointer towards a person who would suffer more hardship and injury if injunction is not granted. The heavy reliance of the defendants on the Manipal Public School run by the trust, has in our opinion been effectively countered by the plaintiffs and it has been prima-facie demonstrated that the 3rd defendant is merely one of the six trustees and the third defendant does not enjoy any exclusive rights or privileges in respect of the word "Manipal". Be that as it may, these findings are subject to trial and are only prima-facie findings and not a proclamation on the merits of the matter. The scope of Appellate Court has been settled by the Hon'ble Apex Court in the case of one, *Wander Ltd. And Anr. Vs. Antox*



*India P. Ltd.*⁸, wherein, in paras 13 and 14, the Hon'ble Apex Court has observed and hold as under:-

"13. *On a consideration of the matter, we are afraid, the appellate bench fell into error on two important propositions. The first is a misdirection in regard to the very scope and nature of the appeals before it and the limitations on the powers of the appellate court to substitute its own discretion in an appeal preferred against a discretionary order. The second pertains to the infirmities in the ratiocination as to the quality of Antox's alleged user of the trademark on which the passing-off action is founded. We shall deal with these two separately.*

14. *The appeals before the Division Bench were against the exercise of discretion by the Single Judge. In such appeals, the appellate court will not interfere with the exercise of discretion of the court of first instance and substitute its own discretion except where the discretion has been shown to have been exercised arbitrarily, or capriciously or perversely or where the court had ignored the settled principles of law regulating grant or refusal of interlocutory injunctions. An appeal against exercise of discretion is said to be an appeal on principle. Appellate court will 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*

⁸ 1990 (Supp) SCC 727



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. If the discretion has been exercised by the trial court reasonably and in a judicial manner the fact that the appellate court would have taken a different view may not justify interference with the trial court's exercise of discretion. After referring to these principles Gajendragadkar, J. in Printers (Mysore) Private Ltd. v. Pothan Joseph.

"... These principles are well established, but as has been observed by Viscount Simon in Charles Osenton & Co. v. Jhanaton '...the law as to the reversal by a court of appeal of an order made by a judge below in the exercise of his discretion is well established, and any difficulty that arises is due only to the application of well settled principles in an individual case'."

The appellate judgment does not seem to defer to this principle."

107. We are in concurrence with the prima-facie findings recorded by the Trial Court on the various contentions placed by the parties and as detailed supra. The findings appear to draw strength from the material placed before the Trial Court by the parties. The findings rendered by the trial court being reasonably possible



inferences on the strength of the material, we are of the considered opinion that the order under appeal does not warrant any interference.

108. This Court has appreciated the material only to the extent to examine if the findings rendered are possible and if are backed by the material on record. Re-examination would reveal that prima-facie there is no material which controverts the findings rendered by the trial Court after appreciating the material on record. The appellants have not been able to demonstrate any perversity either in the appreciation or in the reasonings assigned by the Court to allow the application and grant the relief and to reject the application by the third defendant.

109. In conclusion, we prima-facie opine that the plaintiffs have indeed made out a prima-facie case warranting interference by the Courts to prevent hardship



and injury that may be suffered by the plaintiffs in the event interim relief of injunction is not granted to them.

Accordingly, appeals stand dismissed.

In view of the peculiar circumstances, the parties are directed to bear their own cost.

Sd/-
JUDGE

Sd/-
JUDGE

YKL
List No.: 1 Sl No.: 1