

## IP Hotline

November 03, 2011

### EX STUDENTS OF ST. STEPHENS COLLEGE MAY FORM AN ALUMNUS ASSOCIATION BUT MAY NOT USE NAME OF ST. STEPHENS: DELHI HIGH COURT

In *St. Stephens College, Delhi ("Plaintiff") v St. Stephens College Alumni Association and Others ("Defendant")* (CS(OS) 2364/2011), the Delhi High Court has issued an injunction restraining the Defendants (who are members of the St. Stephens College Alumni Association) from naming their organization with a name that may show association with the college and also from using the official crest, logo, motto and domain name of the Plaintiff. However, the Delhi High Court did allow the Defendants to use the name "Association of Old Stephanians" along with the requirement that they would to display on their website an appropriate disclaimer to expressly clarify that they are not the official alumni association of the Plaintiff and have no affiliation with the Plaintiff.

#### FACTS

The Plaintiff is a leading and well renowned educational institution. The Defendants who are former students of the Plaintiff, formed the Defendant association and subsequently registered it as a society under the Societies Registration Act, 1100%. The Defendants at the time of such registration submitted an affidavit stating therein that there are no other societies with identical or resembling names.

The Plaintiff, whilst alleging this to be a mala fide act on the part of the Defendants (committed on account of the fact that the Plaintiff had withdrawn its earlier invitation extended to one of the Defendants to represent the alumni on the governing body of the Plaintiff) filed an action for passing off, seeking an injunction restraining the Defendant from using its current name, the Plaintiff's crest, motto and logo and representing themselves as the alumni association of the Plaintiff or from operating their website (<http://ststephensalumni.co.in>) wherein the Plaintiff's name was used. Further, the Plaintiff also sought to restrain the Defendants from interfering in the association, management and affairs of the Plaintiff.

#### Arguments before the High Court:

##### Arguments of the Plaintiff

The Plaintiff contended that:

1. The Plaintiff alleged that the Defendants' by using the current name of the association (as part of the name of their association and as part of their domain name) were passing off their activities as those of the Plaintiff's official alumni association and were misleading former students of the Plaintiff into joining them under the belief that the Defendant society was the recognised and authorised alumni association of the Plaintiff.
2. The Plaintiff also alleged that the Defendant had malafide intentions as the Defendant's website (<http://ststephensalumni.co.in>) used the crest of the Plaintiff over which the Plaintiff claims proprietary copyright since its inception in 1926. The Defendants had also in their website provided a hyperlink to the website of the Plaintiff ([www.stephens.edu](http://www.stephens.edu)).
3. The Defendants had neither replied to nor stopped their activities pursuant to a cease and desist notice issued by the Plaintiff requiring them to stop using the name "St. Stephens" and/or its derivatives and the Plaintiff's crest and motto.

##### Arguments of the Defendant

The Defendant contended that:

1. There were several institutions using the name "St Stephen's" (such as St. Stephen's College Pathanapuram, Kerala, St. Stephen College of Teacher Education, Kanyakumari). As such the college had effectively waived its "right to exclusive use of the name St. Stephens College".
2. The Defendant was not making use of the name of the Plaintiff for any commercial purpose.
3. The Defendant also submitted before the court that they were ready to stop using the current name and instead suggested four alternative names: (a) Old Stephanians Association; (b) Stephanians; (c) Association of Stephanians; and (d) Association of Old Stephanians). The Defendants also submitted that they were willing to put a disclaimer on their website stating that they are not the registered / authorised alumni association of the Plaintiff and have no connections with the Plaintiff or its official alumni association.

However, the Plaintiffs refused to accept this and maintained that the Defendants, despite being former students of the Plaintiff had no right to use the words "St. Stephens College", "St. Stephens" or "Stephanians".

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The Plaintiff had not registered the name of the college as their trademark. The High Court noted that there exists no exclusive right in a name unless such name has been granted statutory protection. However, the courts do have power to restrain an organization from adopting a name which is similar to the name of an existing organization if:

- it can be proved that the new organization was attempting to pass off its activities as those of the existing organization such use; and
- such use of the name causes damage or is likely to cause damage to the reputation and goodwill of the existing organization on account of confusion being created in the mind of the public due to the similarity in the names.

The Delhi High Court accepted that *prima facie* the use of the name “Association of Old Stephanians” by the Defendants coupled with a disclaimer (similar to the one proposed by the Defendants in their submissions) is sufficient to ensure that no former student of the Plaintiff is confused or mistaken with regards to the identity of the official alumni association of the Plaintiff. The court also made the following observations in support of the above conclusion:

1. The Defendants under Article 19 (1)(c) of the Constitution of India have a fundamental right to form an association consisting wholly of former students of the Plaintiff.
2. Since the membership is restricted to former students of the Plaintiff college, the Defendants have a right to describe themselves as Stephanians (by virtue of their having studied in the Plaintiff college) and can use the word “Stephanian” as part of the name of their society (as this signifies the common link amongst them).
3. The name “Association of Old Stephanians” is not similar to the name Plaintiff college since the words “St. Stephens College” does not appear in the name; it accordingly does not convey the impression that it is the official alumni association of the Plaintiff. On the contrary, it conveys the impression that it is an association formed by the former students of the Plaintiff.
4. Considering the educational background, level of awareness and credentials of the students of the Plaintiff, it highly unlikely that they can be misled by the Defendants to believe that a society named “Association of Old Stephanians” is the official alumni association of the Plaintiff. The proposed disclaimer along with a notice on the Plaintiff’s website and individual communications to all former students (informing them that the Plaintiff has no connections with such an association) are enough to show to the former students that the association formed by the Defendants has not been recognised and is not affiliated to the Plaintiff or its official alumni association.

During the course of the arguments the court considered various precedents in which the courts had stepped in to restrain actions of passing off. For instance in the case of *International Association of Lions Clubs vs. National Association of Indian Lions & Ors* (2006(33)PTC79(Bom)) the defendant were making use of the words ‘Lion’, ‘Lioness’ and ‘Leo’ in its name and emblem without any due justification. The court restrained the defendant from such use as the words were synonymous with the Lions Club which is an internationally reputed organization.

However, the court distinguished the instant case from the abovementioned decision as in the present case the Defendants have a just and valid association with the Plaintiff and (assuming they form an association named “Association of Old Stephanians”) are neither using the name of the Plaintiff nor seeking to exploit it for any commercial purpose. Since they are an association of former students of the Plaintiff, it is essential for them to use a name which will indicate that membership is only open to former students.

Therefore, whilst the court passed an injunction restraining the Defendants from using the current name of the association and also from using the official crest, logo, motto and domain name containing the name of the Plaintiff, it allowed them to use the name “Association of Old Stephanians” with the requirement that they include an appropriately worded disclaimer on their website.

ANALYSIS

The main purpose of the common law right of passing off is to ensure that one is not able to pass off its business or goods as those of another more known organisation and thus exploit the goodwill and reputation built by such other organisation over a period time. In order to determine whether an injunction is warranted in the interest of the public who may likely to be deceived or confused on account of similarity of two names, the court will generally merely see if there lies any probability of confusion even if no case of actual deception or damage is proved.

However, in this instant decision it is clear that in an action of passing off it also becomes important to consider the purpose for which a particular name (even if relatively similar to any other existing name) is being used by a person as a part of its name.

- Ankita Manav, Rakhi Jindal & Gowree Gokhale

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