

(2012) 02 DEL CK 0030

In the Delhi High Court

Case No : I.A. No"s. 10846, 12084 and 12085 of 2011 in CS (OS) No. 1672 of 2011

Premier Tissues India Ltd.

APPELLANT

Vs

Rolia Tissues Industries and Another

RESPONDENT

Date of Decision : 22-02-2012

Acts Referred:

Civil Procedure Code, 1908 (CPC) — Order 34 Rule 1, Order 34 Rule 2, Order 34 Rule 4, 151
Companies Act, 1956 — Section 34
Trade Marks Act, 1999 — Section 28
Trade Marks Rules, 2002 — Rule 37

Citation : (2012) 187 DLT 619 : (2012) 50 PTC 206

Hon'ble Judges : Manmohan Singh, J

Bench : Single Bench

Advocate : Vijay Pal Dalmia, with Mr. Vikas Mishra and Ms. Christine Chiramel, for the Appellant; A.K. Goel, with Mr. Praveen Kumar, for the Respondent

Final Decision : Dismissed

Judgement

Manmohan Singh, J.—The brief facts of the case are that the plaintiff, a company incorporated in India under the provisions of the Companies Act, 1956 having its registered office at No.230, II Floor, 15th Cross, Sampige Road, Malleswaram, Bangalore- 560003 has filed the present suit for permanent injunction restraining the defendants from infringing the registered trademark "PREMIER" and copyright of the plaintiff, passing off, dilution, unfair trade practice and damages.

2. By way of this order, I propose to decide the following three applications:

- a) I.A. No.10846/2011 under Order XXXIX Rules 1 & 2 of the Code of Civil Procedure, 1908 filed by the Plaintiff.
- b) I.A. No.12084/2011 under Order XXXIX Rules 1 & 2 of the Code of Civil Procedure, 1908 filed by the Defendants.

c) I.A. No.12085/2011 under Order XXXIX Rule 4 of the Code of Civil Procedure, 1908 filed by the defendants.

3. The plaintiff company through its predecessor "First Aryco India Ltd." had adopted a trade mark "PREMIER" on 10.01.1997 for manufacturing and marketing of a wide range of tissue paper products namely Tissues, Tissue Paper, Facial Tissues, Hanky Packs, Kitchen Towels, Toilet Tissues, Jumbo Rolls, Pop Up Napkins, Specialty Napkins. (Cocktail, Luncheon, Dinner), Serviettes, C-Fold Hand Towels, Napkins, Pop U Dispensers, Soap Dispensers etc.

4. It is averred in the plaint that the plaintiff manufactures and exports a wide range of tissue paper products including tissue papers, napkins, jumbo rolls, kitchen rolls, toilet rolls, etc. (herein after referred to as the "tissue paper products") and sells and markets the said products under various brands including "PREMIER". The plaintiff has been using the said trademark since 1998. The tissue paper products of the plaintiff are packed, marketed and sold in packings/boxes having peculiar artwork, layout, pattern, get up, special fonts, design placement, colour combination, wordings and descriptions which form an original work of art that is exclusively owned by the plaintiff and accordingly, all rights under the Copyright Act, 1957 also exclusively vest with the plaintiff. The trademark "PREMIER" is prominently written on all the boxes/packings/labels etc.

5. One of the products of the plaintiff i.e. Special Face Tissues is packed, marketed and sold under the trademark "PREMIER" in packings/boxes having peculiar artwork, layout, pattern, get up, special fonts, design placement, colour combination, wordings and descriptions which form an original work of art which is exclusively owned by the plaintiff and accordingly all rights under the Copyright Act, 1957 also vest with the plaintiff. On the top right of the box of "Special Face Tissues", the face of a lady is depicted and placed in the background and submerged in the background colour of the box of the product along with the trademark "PREMIER" and some descriptive words. On the front left portion of the packing/box of the product, the front photo of a happy child, on the right front portion, the facial portion of a happy child, on right front portion the facial portion of a smiling aged lady and on the left portion of the packing/box, the photo of smiling faces and a bust of a happy couple are depicted, placed and submerged with the background colour of the box of the product along with the trademark "PREMIER" and some descriptive words.

6. It is stated by the plaintiff that the entire artwork of the packing/box of PREMIER "Special Tissue" having peculiar artwork, layout, pattern, get up, special fonts, design placement and colour combination (hereinafter referred to as the "Special Tissue Box") also form a trademark, which has become distinctive and capable of distinguishing the same in the market from others. The "Special Tissue Box" of the plaintiff is also exclusively associated with the plaintiff by the trade and purchasing public and is also protectable under the provisions of the Trade Marks Act, 1999 as well as the Copyright Act, 1957. The plaintiff has registered its trademark "PREMIER" which is prominent and distinctive of the

products of the plaintiff. The details of the registration of the trademark are given in para 16 of the plaint.

7. It also stated that the plaintiff has also been using another trademark "ROYAL" and the same is also registered under the Trade Marks Act, 1999 in Class 16 in respect of tissue paper products. The plaintiff has also registered the domain name <http://www.premiertissues.com>.

8. It is further averred that sometime in the first week June, 2011 the plaintiff came to know that the defendants are engaged in unauthorized manufacturing, packing and marketing of tissue papers under the trademark "PREMIUM" in packing/boxes which are deceptively similar to the trademark "PREMIER" and "PREMIER SPECIAL TISSUE BOX" the artwork, layout, pattern, get up, fonts, design placement and colour combination of the defendant's boxes is also deceptively similar to the plaintiff's boxes. According to the plaintiff, its investigation revealed that the said infringing tissue boxes of the defendant are being sold in various shops and by roadside vendors in Delhi as well as other parts of the country.

9. Further, the plaintiff came to know that the defendants are engaged in large scale manufacturing of tissue paper products under the trademark "PREMIUM" in boxes and packing having deceptively similar artwork, layout, pattern, get up, fonts, design placement and colour combination as that of the plaintiff's boxes particularly "PREMIER SPECIAL TISSUE BOX" and are advertising their products on <http://www.premiumtissues.net/about-rolia.html> and <http://www.roliatissues.com/>.

10. As per the plaintiff, defendant Nos.1 and 2 in collaboration with each other, are misleading the customers and general public by using the impugned trademark "PREMIUM" and a bare comparison of the packing/box of the defendants will show that the defendants are trying to pass off their spurious goods as that of the plaintiff by creating deception and confusion in the market and in the minds of the purchasing public. The said infringing activities of the defendants have resulted in infringement of the registered trademark "PREMIER" and registered copyright of the plaintiff.

11. The plaintiff avers that it is the prior and lawful user of the trademark "PREMIER", "PREMIER SPECIAL TISSUE BOX" and the copyright in the artwork, layout, pattern, get up, fonts, design placement and colour combination of the plaintiff's "PREMIER SPECIAL TISSUE BOX" and it has statutory as well as common law rights vested in it to prevent any misappropriation and misuse of its trademark and copyright in any manner.

12. Case of the Defendants

12.1 Defendant left M/s. Wintex Tissues in the year 1993 and thereafter, started his own business of foils under trademark "PRIME" in the year 1994 (having different kinds of art works for foils) and of tissue paper etc. in the year 1995

under the trade mark ROLIA PREMIUM/PREMIUM as the proprietor under taking style M/s. Rolia Tissues and thereafter opened another firm M/s. Rolia Tissues Industries.

12.2 The defendant extended his business to tissue paper in 1995. Defendant developed the box of the ROLIA PREMIUM TISSUES and prepared rough sketch artwork in 1995 in house with the help of employees of the firm and thereafter, through the help of computer graphics and other artwork were added. The font of the PREMIUM is one of the known fonts which is openly available for use on computer/internet and was taken from there and said font is generic and is not an original artistic work. The defendants claims copyright over the said carton being first to prepare the same. The said name was initially used on small scale and thereafter, since 1997 on a larger scale.

12.3 The defendants mainly supplied since 1996-97 to the GIANT SUPER STORE and HOME STORES LTD. (SABKA BAZAR) on very low rates i.e. about 1/3rd of the marketing price with good quality of products. Defendants were not required to give advertisements as his products were being sold by Super Stores. The advertisements were made by the said Super Stores through various media suitable to them like in house display/pamphlets/newspapers etc.

12.4 The defendants have four/five types of boxes for facial tissues and 20/30 different packaging for other goods. Said original packaging are filed by the defendants. The plaintiff has not challenged the rest of the packaging of the defendants.

12.5 Defendants are prior user of trademark/packaging ROLIA PREMIUM TISSUE, ROLIA PREMIUM and PREMIUM since the year 1995.

12.6 defendant's trade mark "ROLIA PREMIUM TISSUES" is registered under No.1594703 dated 24.08.2007 and the same is still valid, subsisting and in full force. However, the defendants have right over the word PREMIUM on account of long prior user.

12.7 Defendants are continuously and openly using the said trade marks ROLIA PREMIUM TISSUE, PREMIUM TISSUE, ROLIA PREMIUM and PREMIUM since 1995.

12.8 Defendants herein are a honest, bonafide, prior and exclusive users of the trade mark ROLIA PREMIUM TISSUE, ROLIA PREMIUM and PREMIUM since 1995 in northern India. Defendants are the owners of copyright in its various artistic packaging/outer packing including the one in dispute etc. of ROLIA PREMIUM TISSUE, ROLIA PREMIUM and PREMIUM which is an original artistic work consisting of unique get up, colour combination, font, design, placement, literary work etc. and also the defendants are the prior user of said artistic packaging in respect of the said goods.

12.9 The defendants came from a very poor family, having rural background, not having many resources, left the job before starting his business and could not maintain complete start years records as was informed that a firm is not required

to preserve records for more than 6 years. The defendant's main sale is to two big super stores namely Giant Super Stores and Home Stores Ltd. (SABKA BAZAR). The defendant has hope that the said super stores will provide him necessary oral as well as documentary evidence. The SABKA BAZAAR has changed hands to Wadhwa Group who had shifted all the documents to its Bombay office. Both the super stores have also filed supporting affidavits in this regard. However, the defendants have filed available unimpeachable documentary evidence and first bill filed is dated 06.07.1997.

13. The defendants have also filed counter-claim against the plaintiff on account of prior user. The defendants have sought an injunction against the plaintiff and have filed the application under Order XXXIX, Rules 1 & 2 CPC (being I.A. No.12084/2011).

14. Large number of documents have been filed by both parties along with their pleadings as well as during the course of hearing of interim applications.

15. When the suit along with interim application was listed first time before the Court, partial interim order was passed to the following effect in the presence of the defendants:

Mr Goel has handed over the set of documents and states that the defendants are using the different cartons which are available at page nos. 36 to 39 in the copies of the documents supplied by him. On the other hand, the plaintiff has filed the four cartons/packaging material allegedly used by the defendants which is almost identical with the cartons/packaging of the defendants. Since the colour, scheme, getup, layout and arrangement of features of the said cartons filed by the plaintiff and the defendants which are available at page no. 24 to 26 of the list of documents are similar, the defendants are restrained to use the said cartons/packaging material which are available at page nos. 24 to 26 of the documents file.

16. Both the parties have referred large numbers of decisions in support of their respective submissions. However, both the parties during the hearing of interim applications have not denied the following facts relating to subject matter of the present case:

(a) That the trade marks "PREMIER" and "PREMIUM" used by the parties are deceptively similar as admitted in their pleadings.

(b) Most of the packaging used by the parties is similar.

(c) Goods in question are same and are available in the same market.

(d) Both the parties are claiming prior user and are seeking injunction against each other.

17. It has now become necessary for the court to examine the relevant issue as to which party has documentary proof and has cogent, reliable and unimpeachable documentary evidence in order to come to the positive conclusion

of prior user of the trade mark and trade dress in question as claimed by both parties.

18. While coming to conclusion, the Court has to keep in mind the conduct of the parties not only on the date of suit, but also prior point of time when the respective claims were made by the parties in various authorities and other places.

19. The learned counsel appearing on behalf of both the parties have admitted that incase both parties would continue to use trade marks and trade dress, as they have been using, there would be confusion and deception. Scanned copies of some of the packaging used by the parties are shown as under:-

Plaintiff : A

Defendants :

Plaintiff : B

Defendants :

Plaintiff : C

Defendants :

Plaintiff : D

Defendants :

20. Law relating to passing off action is quite well settled in order to succeed in getting an interim injunction. Party claiming prior/earlier user of the mark in question has to established prior user in time by production of cogent and clear evidence. As far as the case of infringement is concerned, Supreme Court in the case of Kaviraj Pandit Durga Dutt Sharma Vs. Navaratna Pharmaceutical Laboratories, has laid down as under :

the action for infringement is a statutory remedy conferred on the registered proprietor of a registered trade mark for the vindication of "the exclusive right to the use of the trade mark in relation to those goods".....In an action for infringement, the plaintiff must, no doubt, make out that the use of the defendant's mark is likely to deceive, but where the similarity between the plaintiff's and the defendant's mark is so close either visually, phonetically or otherwise and the court reaches the conclusion that there is in imitation, no further evidence is required to establish that the plaintiff's rights are violated. Expressed in another way, if the essential features of the trade mark of the plaintiff have been adopted by the defendant, the fact that the get-up, packing and other writing or marks on the goods or on the packets in which he offers his goods for sale show marked differences, or indicate clearly a trade origin different from that of the registered proprietor of the mark would be immaterial.....

Therefore, I am of the view that it is not necessary at this interim stage to refer and discuss all decisions relied upon by the parties when both parties are not disputing the settled proposition of law regarding prior user and infringement of trade marks, copyright and passing off as according to themselves one party has infringed the rights of another party.

The Plaintiff's arguments

21. The first commercial use of the trade mark PREMIER is since 1998 in respect of goods mentioned above. The history of the incorporation and its subsequent developments is as under :

- a. Initially "First Aryco India Ltd.", incorporated in the year 1997, on 10.01.1997.
- b. Premier Aryco India Ltd., incorporated on 19.03.1998.
- c. Name of Premier Aryco India Ltd., changed to Premier Tissues India Ltd. on 04.03.2005.
- d. The present name of the plaintiff company is Premier Tissues India Ltd.

22. The details of the publicity in the media including newspapers are as under :

- a. Economic Times dated 30.01.1998.
- b. Business Line dated 30.01.1998.
- c. The Hindu dated 30.01.1998.
- d. Indian Express dated 29.01.1998.
- e. Deccan Herald dated 29.01.1998.

The other details and documents are also filed alongwith list of documents dated 29.09.2011.

23. Plaintiff predecessor "First Aryco India Ltd." applied for the registration of the trade mark "PREMIER" as per the details given below :

S. No.

Trade Mark

Registration No.

Date of Application

Class

Status

Reference

1.

PREMIER (label)

783229

23.12.1997

16

Registered, renewed and valid till date

Page No.1-6 of the list of documents dated 11.07.2011 filed by the plaintiff

2.

PREMIER

783229

23.12.1997

16

Registered, renewed and valid till date

Page No.1-6 of the list of documents dated 11.07.2011 filed by the plaintiff

24. Premier Aryco India Ltd. was incorporated on 19.03.1998 and its name was changed to Premier Tissues India Ltd. on 4.3.2005.

25. According to the plaintiff, the total annual turnover under the trade mark/ name is approximately Rs.176,57,25,000/- (One hundred and Seventy Six Crore Fifty Seven Lac Twenty Five Thousand).

26. It is submitted by the plaintiff that the plaintiff has also spent a considerable amount of sum of Rs.2,08,00,000/- (Rs. Two Crores, and Eight Lac only) on advertisement of its products under the trade mark "PREMIER". All the advertisements including the advertisement of the plaintiff's products under the trade mark "PREMIER" including the advertisement in the January 15, 2001 issue of Femina Magazine, shows that the products of the plaintiff were being sold throughout India including Delhi.

27. The plaintiff's products were also sold to Wipro, Infosys, Taj Group of Hotels, Meridian Group of Hotels, Manipal Hospitals, Apollo Hospitals etc. who are its institutional buyers.

28. The plaintiff has filed various original bills of its products under the trade mark "PREMIUM", for the period starting from 30.04.1999 upto 31.07.2006. The plaintiff has also filed some of the copies of Form 3, which is statement of monthly turnover and tax paid in advance, before the authorities for the period starting from October, 1998 to March 2002. All the abovementioned forms and bills mentioned following numbers for the payment of sales tax :

i. KST No.72720074 dated 07.10.1998.

ii. CST No.72770077 dated 07.10.1998.

29. It is stated by the plaintiff that in the year 2010 Avantha Group took over the plaintiff company, and there was a change in the management of the Company. During the course of its business the plaintiff company several times upgraded its billing systems, incorporating new software and statutory changes to meet the exigencies of its operations. It is also stated that when the Company was taken over by the Avantha Group, to streamline the operations of the plaintiff company, it was decided to feed the past records of bills into the billing system. However, while feeding the data pertaining to the past bills, the plaintiff's employees did not realize that due care was required to be taken for feeding the billing information in the computerized accounting system by taking care of various statutory and other changes relating to shifting from state sales tax/CST to VAT system as well as changes in the name of the plaintiff company. It is submitted that inadvertently the entire exercise resulted in faulty data conversion leading to anomalies and errors in billing system. According to the plaintiff, when for the purpose of filing this suit, the copies of bills were demanded by the counsel for the plaintiff, the accounts department of the plaintiff company inadvertently gave the printouts of the bills which were not properly fed into the computer system. Relying upon such print outs, the plaintiff filed the bills alongwith the suit. The plaintiff later on realized its mistake on pointing out by its counsel and thereafter, put strenuous efforts to dig out the old records which resulted in the discovery of some of the original bills pertaining to the sale of the goods under trade mark "PREMIER".

30. Similar situation arose in the case of Pioneer Nuts and Bolts Pvt. Ltd. Vs. Goodwill Enterprises, wherein the prior user was claimed by the parties. The relevant paras of the said judgment are as under:

12. The question was whether the Defendant had made out a case for prior use. The learned Single Judge noted that trade mark registration was given to the Plaintiff in 2005 with effect from 1998 and 2002. Copyright registration was obtained in 2005. Although the earliest use of the disputed mark was claimed by the Plaintiff to be 1996, the invoices and bills produced were of the years 2004 onwards. The income tax and sales tax returns from 1996 onwards mentioned the Plaintiff's income and sales but not its products. On the other hand, the Defendant had been able to show three advertisements, two of 26.12.1993 and one of 1999, trade enquiries of 1993, 1994 and 1995 and different invoices pertaining to Calcutta and Madras. The Plaintiff's case was that the Defendant was a squatter and merely advertising the mark but never using it. Referring to the judgment in Revlon Inc. and Others Vs. Sarita Manufacturing Co., , it was held by the learned single Judge that the dissemination of knowledge of a trade mark in respect of a product through advertisement in media amounts to use of the trade mark whether or not the advertisement is coupled with the actual existence of the product in the market. The learned single Judge negatived the argument of the Plaintiff about the advertisements produced by the Defendant amounting to no credible evidence of user.

13. The other issue was of prior user. The learned single Judge relied on the copies of the partnership deeds where Harpreet Singh was shown as partner of the firm from 1991 in relation to the business and the product. Reliance was placed on the judgment in *Swaran Singh v. Usha Industries (India)*, AIR 1986 Del 343: 1986 (60 PTC 287 (Del) (DB) and *Micolube India Ltd. Vs. Maggon Auto Centre and Another*, to hold that the Plaintiff has been able to establish prima facie existence of registration in its favour, in relation to the subject marks, with effect from 1998 and 2002. Yet there was no credible evidence of proof of the use of the mark from that period; the materials were sketchy. It was held that the Plaintiff had not produced any material to show that it had used the mark prior to 1998. On the other hand, the Defendant has "prima facie shown that the mark was advertized in 1993 and 1999 and trade enquiries through original letters, indents, etc. existed in 1993, 1994, 1995 onwards". The issuance of telegraphic name "TUFF" by the Postal Department in 1994, 1995 was also noticed and it was held that the Defendant was "prima facie continuously using the marks since 1993 at least, enabling it to the benefit of Section 34 of the Act." Accordingly the injunction was refused.

23. Turning to the case on hand, the Defendant has been unable to show that its goods bearing the mark TUFF were at any point of time since 1991 and prior to 1996 available in the market. There is absolutely no evidence placed on record by the Defendant to show that it has actually sold its goods using the mark "TUFF" or "TUFF & TUFF" even thereafter. For proving prior user, the Defendant repeatedly referred to the two newspaper advertisements inserted by it in 1993, the six trade enquiries between 1994 and 1995 emanating from these advertisements. Between 1993 and 1995, there were seven indents of John and John Traders and one indent of Bolt House. There is also a letter from John and John Traders asking the Defendant to send goods from outside. Then we have the grant by the Postal Department of the telegraphic address "TUFF" to the Defendant.

24. In light of the law as explained in the aforementioned decisions as applied to the facts of the present case, the advertisements issued in the newspapers can hardly constitute the proof of service on the user of the mark from those dates. Likewise, the grant of a telegraphic address, or the soliciting of business, or the receipt of trade enquiries cannot by themselves satisfy the legal requirement of the defendant having to show that it used the marks, earlier than the Plaintiff did, in relation to goods.

25. As regards the filing of trade mark applications, the unilateral self-serving declaration by the Defendant in some of them of user since 1991 cannot constitute evidence of the commencement of use from that date. The opposition to the Defendant's applications has still not been disposed of and no registration as such has been granted to the Defendant. Therefore, this does not carry the case of the Defendant any further. In any event the claims of user made in the applications by the Defendant have been inconsistent. In the application No.

942787 filed on 27.7.2000, user was claimed since 1.4.1995. In application No. 1301515 filed on 10.8.2004, it was stated "proposed to be used". In application No. 1302920 filed on 16.8.2004, the user was claimed since 1.1.1991 and in application No. 1365632 filed on 21.6.2005, the user was claimed since 17.6.2005. These inconsistent positions taken by the Defendant creates more difficulties for it about the claim of prior user.

31. Let me now consider the rival submissions of the parties and documentary evidence in relation to the trade marks PREMIER and PREMIUM and their packaging material :

(a) THE DATE OF APPLICATION AND USER CLAIMED BY THE PARTIES IN THE TRADE MARK REGISTRY.

Plaintiff

Defendants

Two registered trade marks PREMIER/PREMIER label under Nos.783230 and 783229 in Class 16 as of 23.12.1997 claiming user since 23.12.1997.

The defendants"; application of ROLIA PREMIUM TISSUES bearing No.1594703 in Class 16 is dated 24.08.2007 claiming user since 17.08.2005. The said mark was registered with the disclaimer whereby defendant No.2 claimed no exclusive right for the word PREMIUM TISSUE.

As referred above, in case a party has agreed to the disclaimer and obtained the registration with disclaimer, no benefit of registration within the meaning of Section 28 can be derived as the registration is subject to the disclaimer. From the date of registrations of the parties and as per record of Trade Marks Office, it is clear that the defendants are subsequent on both counts i.e. on the date of application and the user claimed in the Trade Mark Registry. Mr. Ashok K. Goel, learned counsel appearing on behalf of defendants has tried to justify that the user of 2005 as claimed by the defendants by saying that it was a wrong advice given by the Trade Mark Agent and now application for amendment of user has been filed in the trade mark registry. The submission has no force as when the application was filed by the defendants admittedly, the user claimed was 2005. It is immaterial at this stage to submit that now the application for change of user has been filed.

32. Advertisement of Trade Mark

a) Plaintiff : The plaintiff has filed various advertisements by way of publicity of trade mark PREMIER in the media including newspapers, news items and in the magazines since the year 1998.

b) The following documents are filed :

a) Copy of the newspaper article of several newspaper of the year 1998 which features the name of the predecessor of the plaintiff and corporate name/mark

"PREMIER".

b) Fresh certificate of incorporation consent on change of name highlighting the claim of the plaintiff and use of the corporate name/mark "PREMIER".

c) Original Femina Magazine dated 15.01.2001 featuring the advertisement of mark "PREMIER" with the font and writing style in question of the plaintiff.

d) Internet Print-out of WHOIS record highlighting the creation of the domain name www.premiertissues.com on 07.09.2001 filed with list of documents dated 11.07.2011 by the plaintiff.

e) Advertisement in Femina Magazine dated 15.08.2007, 12.09.2007, 26.09.2007, 10.10.2007, 16.07.2008, 13.08.2008, 14.01.2009 filed with list of documents dated 11.07.2011 by the plaintiff.

c) Defendants : There is not a single advertisement in the newspaper or in any known magazine as cogent and clear evidence filed from the date of user claimed by the defendants or prior to the user claimed by the plaintiff. Hence, it is clear that on advertisement of their products, the defendants are not able to establish the prior user.

33. Sales and Advertisement Figures Plaintiff : The plaintiff has filed the sale and advertisement figures pertaining to the trade mark PREMIER since 1999-2000 to 2010 as mentioned in para 12 of the written arguments and for last year, the total annual turnover of the plaintiff's products was about Rs.176,57,25,000 (One Hundred and Seventy Six Crores Fifty Seven Lac Twenty Five Thousand) and they are selling their products to various well known clients in India.

34. In order to show prior user the defendants have produced the sale figures by way of certificate issued by the chartered accountant Narinder Handa and Associates from the year 1997-98 to 2010-2011 filed alongwith list of documents dated 30.08.2011. The defendants have also filed acknowledgement slip of income tax return of defendant No.1 for the assessment years 1998-99, 1999-2000 and 2000-2001 alongwith list of documents dated 26.07.2011. But these documents do not indicate about the use of mark PREMIUM except that two firms (defendants) were carrying on business of tissue papers. The defendants have also filed the certificate issued by Central Bank of India in the name of the defendants firm about the transaction in the Bank since 21.2.2009, but, the mark PREMIUM was not mentioned.

35. The defendants have also referred to many documents filed by them but in order to show prior user of the trade mark PREMIUM in relation to the goods the following documents are relied upon :

a) Bill dated 06.07.1997 in respect of sale under trademark ROLIA PREMIUM issued by the defendants duly received by GIANT THE SUPER MARKET.

b) Bill dated 12.10.1997 issued by the defendants which is counter signed by Sh. Ajit Mayor duly supported by an affidavit.

- c) Bill dated 30.01.1998 in respect of sale under trademark PREMIUM issued by the defendants duly received by GIANT THE SUPER MARKET.
- d) Bill dated 06.09.1998 in respect of sale under trademark PREMIUM issued by the defendants and duly received by GIANT THE SUPER MARKET.
- e) Alleged packaging/sheet of the defendant's mark PREMIUM dated Jan 1998.
- f) Sales figure of M/s. Rolia Tissues industries from financial years 1997-98 to 2010-11 duly certified by Chartered Accountant.
- g) Original copy of the certificate issued by Central Bank of India, Badarpur Branch, New Delhi for the opening of the Bank Account of M/s. Rolia Tissues on 21.02.1997.
- h) Original copy of the Income Tax Acknowledgement Form, showing for the financial year 1997-98 of the defendants under the firm name Rolia Tissues Industries.
- i) Original copy of the challan showing payment of the income tax for the financial year 1998-99 of the defendant No.1.
- j) Original copy of the computation of the income for the financial year 1998-99 of the defendants under the firm name M/s. Rolia Tissues Industries.
- k) Original copy of the Saral Form showing filing of income tax return of Sh. Durgesh Saxena for the financial year 2000-2001.

36. In support of documents referred to above, the defendants have also referred to two affidavits of Mr. Ajit Mayor, Ex. Managing Director of M/s. Ajit Mayor and Company and Mr. Majid Khan Ex. Assistant Manager of M/s. Home Store India Ltd.

37. As regard documents i.e. certificate issued by Central Bank of India, Income Tax acknowledgement for the years 1997-98, 1998-99, challan showing the payment of the income tax, sale figures and certificate issued by the chartered accountant are concerned, the same have already been discussed in earlier paras that none of the documents show about the use of the trade mark PREMIUM in question. These documents only indicate that there was a firm during this period in the year 1995-96 under the name and style of Rolia Tissues Industries who was carrying on its business of selling tissues papers but, these documents do not indicate in any manner that the trade mark PREMIUM is being used as mentioned on these documents.

38. The original bills dated 6.7.1997, 12.10.1997, colour copies of box cover sheet of the defendants for the period January, 1998, do not contain local sales tax and central sales tax numbers. These bills were issued by Rolia Tissues which have been filed in order to prove prior user of the trade mark PREMIUM. There is not a single document on record by the defendants of third party, like post card, inland letter, newspaper advertisement, copy of magazines or any other

document in the nature of cogent and clear evidence, though there is a third party evidence available on record from the period 2005 which is subsequent to the user of the plaintiff.

39. This court is of the view that since the defendants are claiming the prior user and are also seeking the interim injunction against the plaintiff, it has become more necessary for the defendants to file clear and cogent evidence which could not be challenged at this prima facie stage. The same is missing in the present case. It is necessary in the present case due to the fact as the defendants themselves have claimed in the Trade Mark Registry on 17.5.2005 (the specific date of user is given). It is also pertinent to mention here that when the application of defendant was examined under Rule 37 of the Trade Marks Rules, 2002, at that time, the plaintiff's trade mark PREMIER was already in existence/pending for registration. At that time the defendants themselves gave up its exclusive rights to the use of the mark PREMIUM and accepted the condition of the Registrar and disclaimed its registration.

40. If the defendants got the prior user as claimed in the year 1995 in the present case, then, why the defendants did not claim the same user in the Trade Mark Registry in their application No.1594703 in Class 16. It was the most appropriate stage to put their claim of user. Even in the second application bearing No.1955501 filed by the defendants, the user claimed was 01.10.1999. Therefore, prima facie, it is clear that the defendants were/are taking inconsistent stand about the user at different stages. It has rather created doubt in the mind of Court, if at this stage any application for change of user has been filed in Trade Mark Registry. As discussed, there is no clear, cogent and undisputed evidence produced by the defendants to show the prior user claimed by them. On the other hand, the plaintiff's documents, like advertisements and news report, are available on record from the year 1998 for user claimed by the plaintiff.

41. As far as the two affidavits filed by the defendants are concerned, both the companies are not in existence any more. The affidavits are filed by Ex. Managing Director of Ajit Mayor and Company Pvt. Ltd. and Ex. Assistant Manager of M/s. Home Store India Ltd. These affidavits have been filed by the defendants in support of claim of longer and prior user and the same cannot be given due credence as these affidavits would have to be tested at the time of trial. The identity, authority and authenticity of the deponents cannot be given due credence at this stage unless they are supported with solid evidence.

42. The defendants have challenged the validity of documents filed by plaintiff by stating that these cannot be looked into. But, this Court is of the view that apart from the documents challenged, there are large number of other documents available on record which are cogent and clear evidence of prior user i.e. from the year 1998.

43. In view of the above, it appears from the record that two set of packaging

are almost similar. Both marks, PREMIER and PREMIUM are deceptively similar. The defendants could not have designed their packaging without placing the packaging of the plaintiff. Prima facie, it is clear that it is a case of violation of vested rights of the plaintiff and pirator thereof cannot become rightful owner in any manner. Thus, the plaintiff has made out a strong case of injunction.

44. Under these circumstances, I am of the considered view that the plaintiff has been able to make a strong prima facie case for infringement of trade mark, copyright and passing off. The balance of convenience also lies in favour of the plaintiff and against the defendants. Incase the defendants/counter claimant is not stopped from using the mark and trade dress in the similar packaging, the plaintiff will suffer irreparable loss and injury, which cannot be compensated in terms of money. Therefore, plaintiff's application, being I.A. No.10846/2011 under Order XXXIX, Rules 1 and 2 read with Section 151 CPC, is allowed. The defendants, their dealers, retailers, servants, agents or any one acting for and on their behalf, are restrained from using the trade mark PREMIUM and/or any other trade mark, which is deceptively and confusingly similar to the plaintiff's registered trade mark PREMIER as well as similar packaging/trade dress amounting to infringement of copyright and passing off their goods as that of the plaintiff in respect of tissues of all kinds, or any other allied and cognate goods. It is clarified that the finding arrived by this Court about the defendant's user is tentative and prima facie view which shall have no bearing when the matter would be considered after the trial on merit.

45. The applications filed by defendants, being I.A. No.12084/2011 under Order XXXIX Rules 1 and 2 read with Section 151 CPC and I.A. No. 12085/2011 under Order XXXIX Rule 4 read with Section 151 CPC, are dismissed.