

IN THE HIGH COURT OF DELHI AT NEW DELHI

% Judgment delivered on: 28.07.2016

+ **CS(COMM) 644/2016**

ADITYA BIRLA NUVO LIMITED Plaintiff

versus

M/S R.S. SALES CORPORATION & ANR Defendants

Advocates who appeared in this case:

For the Plaintiff : Mr Ajay Sahni, Ms Kanika Bajaj &
Ms Kritika Sahni.

For the Defendants : Mr B.P. Singh Dhakray and Mr Shakti Singh
Dhakray for D-1 & D-2.

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HON'BLE MR JUSTICE VIBHU BAKHRU

JUDGMENT

VIBHU BAKHRU, J

IA Nos.9965,15175 and 15177 of 2013

1. The Plaintiff has filed the above captioned suit for seeking a decree of permanent injunction restraining infringement of its registered trademark, rendition of accounts and delivery up against the Defendants.

2. The Plaintiff has filed IA No.9965/2013 under Order XXXIX Rule 1 & 2 CPC and Defendant Nos. 1 and 2 have filed IA Nos.15177/2013 and 15175/2013 - both under Order XXXIX Rule 4 of the CPC - respectively for vacation of interim order dated 17.06.2013 by virtue of which an ex-parte ad-interim injunction order was granted restraining the Defendants

from selling / marketing their products using the mark 'PETER ENGLAND'. All three applications were taken up and heard together.

3. The Plaintiff claims to be the subsequent proprietor of the trademark 'PETER ENGLAND' registered under registration No.665416 in class-25 in respect of 'clothing, footwear and headgear'. The Plaintiff further asserts that the Plaintiff (itself or through predecessor) has been selling readymade apparels and accessories bearing the registered trademark PETER ENGLAND since the year 1997. Defendant no. 1 is engaged in the business of manufacturing and selling footwear and Defendant no. 2 is Defendant no. 1's stockist. The said Defendants sell footwear *inter alia* under the trademark 'PETER ENGLAND VIP SHOES'.

4. It is averred in the plaint that the trademark 'PETER ENGLAND' was originally conceived and adopted more than a century ago, in the year 1889, by the Plaintiff's predecessor, Carrington Viyella Garments Limited (CVGL), England. It is asserted that the said company underwent a series of corporate adjustments and changes during the course of time. It applied for registration of the trademark 'PETER ENGLAND' in India vide registration No.665416 in class – 25, dated 12.05.1995. It is stated that the said trademark was assigned by an assignment deed dated 21.01.2000 in favour of the Plaintiff (then known as Indian Rayon & Industries Limited).

Subsequently, the Plaintiff's name was changed to Aditya Birla Nuvo Limited and an application for recording the change in name was filed with the office of the Registrar of Trade Marks on 24.11.2006. It is further stated that the Plaintiff has also applied for the registration of the trademark 'PETER ENGLAND' in respect of other classes, which are pending. The Plaintiff further states that apart from the trademark 'PETER ENGLAND', the Plaintiff is also the proprietor of several other trademarks, which incorporate the trademark 'PETER ENGLAND'.

5. It is further averred in the plaint that the Plaintiff filed two applications on 03.09.2001 for registration of the trademarks ELEMENTS PETER ENGLAND (label) and PETER ENGLAND (label) under registration nos. 1041517 and 1041520 in class-25 and these trademarks were published in the Trade Mark Journal no.1331 (S-1) dated 15.06.2005. Defendant No.1 opposed the said applications on the ground that it was the proprietor of the trademark 'PETER ENGLAND'.

6. Defendant No.1 has also filed an application bearing No.805051 in for registration of the trademark PETER ENGLAND with the suffix VIP SHOES and that was advertised in the Trade Mark Journal no. 1401 dated 01.10.2008. The Plaintiff has filed an opposition to the said application.

7. The Complaint filed by the Plaintiff was registered as a Civil Suit on 17.06.2013 and after hearing the learned counsel for the Plaintiff as well as going through the averments in the complaint, this Court passed an ad-interim ex-parte order restraining the Defendants from selling / marketing their products using the mark 'PETER ENGLAND'.

8. Defendant No.1 has set up a defence of prior user; it claims that it has been using the trademark 'PETER ENGLAND VIP SHOES' since the year 1998.

9. Mr B P Singh, learned counsel appearing on behalf of Defendant No.1 submitted that Defendant No.1 adopted the mark 'PETER ENGLAND VIP SHOES' in respect of shoes manufactured by Defendant No.1 in the year 1998 and has been using the said trademark since. He further submitted that Defendant No 1's turnover of footwear under the said brand during the year 1998-99 was ₹57,29,791/- which had risen to ₹1,49,56,350 in the year 2012-13. He also submitted that Defendant No.1 was a prior user of the trademark and, therefore, the injunction order passed against Defendant No.1 ought to be vacated.

10. Mr. Singh further submitted as under:

(a) that the Plaintiff had requested for change of the name of the proprietor

of the trademark with the trademark authorities, however, the Plaintiff's name has not been substituted as the registered proprietor of the mark as yet;

(b) that the Plaintiff had failed to show as to how it was connected with Indian Rayon & Industries Limited and thus, the Plaintiff was not entitled to the benefit of the trademark registered in the name of Indian Rayon & Industries Limited.

(c) that the artistic design of the logo used by the Plaintiff was different from the logo used by Defendant no. 1 and, therefore, no case was made out for violation of Section 28/29 of the Trade Marks Act, 1999;

(d) that the Plaintiff is engaged only in the manufacture and sale of apparels and is not engaged in the manufacture and sale of shoes. Therefore, the Plaintiff has no case for infringement of the trademark and design.

(e) that since it was an admitted case that the Plaintiff was not engaged in the manufacture of shoes, the trademark registration granted in favour of the Plaintiff was liable to be cancelled by virtue of Section 47 of the Trade Marks Act, 1999.

11. Mr. Singh further stated that Defendant No.1 had also applied for the

copyright registration of the label 'PETER ENGLAND VIP SHOES' and it was registered in its name on 20.08.2001 (registration No.A-59661/2001).

12. Mr Ajay Sahni, learned counsel appearing on behalf of the Plaintiff countered the submissions made by Mr Singh. He contended that registration of the trademark 'PETER ENGLAND' was applied for by Indian Rayon & Industries Limited on 12.05.1995 and it was, subsequently, registered in favour of Indian Rayon & Industries Limited. He also drew the attention of this Court to the Certificate of Incorporation dated 27.10.2005, issued by the Registrar of Companies which evidences that the name of Indian Rayon & Industries Limited was changed to Aditya Birla Nuvo Limited – the Plaintiff's current name.

13. He further submitted that although it has been stated by Defendant No.1 that its trademark is registered, but the same was incorrect in as much as, the Plaintiff had opposed the registration and as of yet the Trade mark Registry has not granted Defendant no. 1 the registration for the trademark PETER ENGLAND VIP SHOES (label). He has also relied upon the decision of the Supreme Court in *M/s. Gujarat Bottling Company Limited & Ors V. Coca Cola Company & Ors: AIR 1995 SC 2372* in support of his contention that the proprietor of the registered trademark can also sue for infringement of the trademark in respect of the goods covering that

mark irrespective of whether the said mark was used or not.

14. I have heard the learned counsels for the parties.

15. At the outset, it is necessary to refer to the trademarks in question which are reproduced below:-



PLAINTIFF



DEFENDANTS

16. On a plain view, it is apparent that the Plaintiff's trademark 'PETER ENGLAND' is similar to the Defendants' trademark 'PETER ENGLAND VIP SHOES'. Thus, it is difficult to accept the contention of Mr Singh that both marks are not similar.

17. The Plaintiff has also produced a copy of the certificate of Registration of Trade Mark dated 28.12.2005 which indicates that the trademark 'PETER ENGLAND' was registered in the name of Indian Rayon & Industries Limited in class – 25, vide registration No.665416 for clothing, footwear and headgear. The said certificate also indicates that the application for the trademark was made on 12.05.1995.

18. The Plaintiff has filed a copy of Form TM 33 dated 24.11.2006 which indicates that the Plaintiff had applied to the Trade Mark Registry for change in the name of the proprietor from Indian Rayon & Industries Limited to Aditya Birla Nuvo Limited. Mr Sahni, also handed over a printout from the website of the Trade Mark Registry which indicates that the trade mark is now registered in the name of Aditya Birla Nuvo Limited. In the aforesaid circumstances, it cannot be disputed that the Plaintiff is the registered proprietor of the trademark 'PETER ENGLAND'.

19. Mr Singh had contended that Defendant No.1 is the registered owner of the trademark. It is also averred by the Defendants in their applications (IA Nos.15175 and 15177 of 2013) that the mark 'PETER ENGLAND VIP SHOES' was registered (number 805051) with effect from 08.06.1998. However, it is apparent that the said averments are not accurate. Although, Defendant No.1 has applied for registration, but the same has not been granted as yet; the printout from the website of the Trade Mark Registry indicates that the status of the trade mark application of the Defendant no. 1 is 'opposed'.

20. In my view, there can hardly be any doubt that that the Defendants have infringed the trademark of the Plaintiff. The certificate of registration clearly indicates that the Plaintiff's mark is also registered for footwear and

plainly the trademark used by Defendant no 1 is similar to the Plaintiff's registered trademark.

21. Prima facie, the Defendants's use of the trademark is dishonest. There is no credible reason for Defendant No.1 to have adopted the trademark in question. The Plaintiff has filed copies of advertisements published in two daily newspapers in the year 1997 (Rashtriya Sahara and The Hindu) which establish that it had been using the trademark much prior to the use claimed by Defendant Nos.1 & 2. The Plaintiff is a well-known company and it is asserted that its turnover in respect of the goods sold under the trademark 'PETER ENGLAND' was ₹570 Crores in the year 2012-13.

22. In contrast to this, Mr Singh, contended that the turnover of the Defendant No.1 in respect of goods sold under the trademark in question was ₹1,49,56,350.98/- during the year 2012-13. This statement too cannot be readily accepted. Mr. Singh had drawn the attention of this Court to the affidavits filed on behalf of Defendant No.1 with the Registrar of Trade Marks wherein the sales figures of goods under the trademark 'PETER ENGLAND VIP SHOES' for the years 1998-99 to 2002-03 had been affirmed. Bare examination of the affidavit indicates that the deponent had claimed the same sales figure for each trademark namely 'PETER

ENGLAND VIP SHOES' 'LONDON VIP SHOES', 'ENGLISH QUEEN' and 'ROYAL MAN'. It is obvious that the sales turnover for each of the said brand cannot be identical. Thus, the contention that the Defendants' turnover for the goods under the brand name 'PETER ENGLAND VIP SHOES' was ₹1,49,56,350.98/- in the year 2012-13 cannot be accepted.

23. In view of the above, the Plaintiff has been able to establish all the three basic ingredients, namely a strong prima facie case; balance of convenience; and irreparable loss for grant of ad-interim injunction. On the other hand, the Defendants have failed to disclose any ground for vacating the interim order.

24. In view of the aforesaid discussion, the application of the Plaintiff under Order XXXIX Rule 1 & 2 of the CPC is allowed and the interim order dated 17.06.2013 is made absolute during the pendency of this suit. Both the applications of the Defendants being IA Nos.15175 and 15177 of 2013 are rejected.

CS(COMM) 644/2016 and IA No. 17087/2013

List on 03.11.2016.

VIBHU BAKHRU, J

JULY 28, 2016/M