

**IN THE HIGH COURT OF JUDICATURE AT PATNA  
COMMERCIAL APPEAL No.2 of 2025**

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Johnson Paints Co. having its Registered Office at 11A, Ashoka Place, Exhibition Road, Patna-800001, Bihar, through its Partner Namely Nitin Krishna (M), aged about 43 Years, Son of Late Krishna Prasad Resident of 91, Ashoka Place, Near Big Bazar, Exhibition Road, Post-G.P.O., P.S.-Gandhi Maidan, District-Patna.

... .. Appellant

Versus

Johnson Paints Private Limited having Registered Office at Fatuha Road, Sabalpur, Patna City, Patna-800009, Bihar.

... .. Respondent

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**Appearance :**

For the Appellant/s : Mr. Ajit Kumar, Advocate  
For the Respondent/s : Mr. Gautam Kejriwal, Advocate  
Mr. Mohit Agarwal, Advocate  
Ms. Twinkle Kumari, Advocate

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**CORAM: HONOURABLE MR. JUSTICE RAJEEV RANJAN PRASAD  
and  
HONOURABLE MR. JUSTICE PRAVEEN KUMAR  
CAV JUDGMENT  
(Per: HONOURABLE MR. JUSTICE RAJEEV RANJAN PRASAD)**

**Date : 24-04-2026**

This appeal has been preferred for setting aside the order dated 16.11.2024 passed by the learned Principal District Judge-cum-Commercial Court, Patna (hereinafter referred to as ‘the learned Commercial Court’) in Commercial Dispute Case No. 02/2023 by which the learned Commercial Court has been pleased to refuse the prayer for interim/ad-interim injunction on the petition dated 08.12.2023 filed by the plaintiff-appellant.

**Brief Facts of the Case**

2. The appellant is a registered partnership firm engaged in manufacturing and trading of various types of products such as



paints, lacquers, coatings, thinner, oxide colours, primer, preservatives against rust and deterioration, cement paints, plaster of paris, gypsum powder and its allied products (“hereinafter cumulatively referred to as “the products”).

3. According to the plaintiff, one Late Krishna Prasad is the founder of the business who had coined and adopted a trademark “JOHNSON”, initially for only few products such as red oxide, primer and cement paint known as ‘CEM’ in the year 1987. He had set up a proprietorship firm named as Johnson Paints (1) in the undivided State of Bihar. The firm got a Sales Tax No. as B.S.T. No. P.C.W. 690 (R) and C.S.T. No. P.C.W. 1874 (C).

4. It is stated that in the later stages, he had extended the business and established an upgraded manufacturing unit. He was using the widely accepted trademark “JOHNSON” named as ‘Johnson Paints Co.’ as a proprietorship firm and had been running the business smoothly. On 01.04.2014, he admitted both his sons in the existing business and converted it as ‘Johnson Paints Co.’ (a registered partnership firm). On 11.06.2016, the same firm has been reconstituted due to sudden demise of the founder of the firm. Now, the both sons-cum-existing partners are running the existing business of his father as successor of Late Krishna Prasad.



5. Learned counsel for the appellant submits that the appellant comprises a group of companies/firm namely Johnson Paints (1), Johnson Paints Industries/Johnson Paints Co., glaze paints limited, etc. collectively known as “Johnson Paints” group which includes the companies represented through the group key person Mr. Nishant Krishna and Mr. Nitin Krishna. The appellant has three manufacturing units and more than 12 branches and depots all across the country. It has a wide distribution network, which serves more than 1000 dealers all across the country and has turnover of several crores of rupees. The case of the appellant is that he is using this trademark since 21<sup>st</sup> April 1987 continuously and extensively in respect of the said goods. Because of the long and continuous use, extensive marketing and sales campaign, the paints and building materials sold under the trademark Johnson/Johnson Cem/Johnson Paints, has acquired enviable goodwill and reputation amongst the members.

6. The grievance of the plaintiff-appellant is that the respondent-defendant company i.e. Johnson Paints Pvt. Ltd., which has come into existence on 22.12.2009 has been using this trademark in the similar products thus, continuing passing off is taking place. The defendant-respondent is creating confusion in the mind of the consumers with a dishonest intention to deceive the



customers in selling their products in the same name as the trademark of the plaintiff-appellant which is causing irreparable loss and damage to goodwill and reputation of the plaintiff. The plaintiff-appellant has given the description of the various trademarks which are being used by the respondent in similar to that of the plaintiffs. The claim of the defendant-respondent with regard to the trade-marks being used by them are also shown in paragraph '14' of the plaint, the same is being reproduced hereunder:-

**Plaintiff's Trademarks**

**Defendant's Trademarks**

TM No.	Class	Trademark	User Date	TM No.	Class	Trademark	User Date
5746777	2	JOHNSONCEM	21/04/1987	2168151	2	SUPER JOHNSON CEM	01/04/2000
5746794	2	JOHNSON PAINTS (1)	21/04/1987	2241994	2	JOHNSON PAINTS PVT. LTD	22/12/2009
5746795	35	JOHNSON PAINTS (I)	21/04/1987				
5746796	2	JOHNSON PAINTS	21/04/1987	3692032	2	JOHNSON PAINTS	14/04/1990
5746797	2	JOHNSON	21/04/1987	1785981	2	J P (DEVICE	01/01/2005
5688927	2	RAINBOWCEM	16/12/1995	2168153	2	SUPER RAINBOWCEM	01/04/2000
5688928	2	BILLION CEM	01/10/2018	5810039	2	BANJO*	Proposed to be used
5688929	2	RAMBO CEM	18/07/2018	4937417	2	RAMBO*	Proposed to be used
5688931	2	MILIONCEM	11/03/1999	2168154	2	SUPER MILLION	01/04/2010
5688932	2	PETALCEM	13/03/2003	2168152	2	SUPER PETAL	01/04/2010
5688933	2	GLOBECEM	16/12/1995	2168155	2	SUPER GLOBE CEM	01/04/2000

7. Learned counsel for the appellant submits that the plaintiff-appellant filed the plaint seeking a decree of permanent injunction against the defendant and in favour of the plaintiff



restraining the defendant, their directors, officers and employees etc. to refrain from offering for advertising, offering for sale, stocking, adopting, using and/or dealing in any manner with the well known trademark Johnson with prefixes and suffixes and copyrighted art work logo/device of the plaintiff. The plaintiff-appellant also filed an application dated 08.12.2023 under Section 135(1) of the Trade Marks Act, 1999 (hereinafter referred to as 'the Act of 1999) read with Section 151 of the Code of Civil Procedure (in short 'CPC') for interim/ad-interim injunction.

**8.** The defendant-respondent opposed the application dated 08.12.2023 as according to the respondent, the appellant had filed a petition dated 08.12.2023 for grant of exemption from pre-institution mediation and settlement under Section 12(a) of the Commercial Courts Act, 2015 (hereinafter referred to as 'the Act of 2015'). On the same date, the appellant further filed a petition under Order 39, Rule 4 read with Section 151 of the CPC and the court of learned Additional District Judge-XIV granted an ex-parte order restraining the respondent, against which the respondent filed a petition on 29.04.2024 seeking recall of the ex-parte order.

**9.** It is stated that the respondent had also filed an application under Order 7, Rule 11 of the CPC for rejection of the plaint. The respondent had also filed a reply to the injunction



petition dated 08.12.2023. It is the case of the defendant-respondent that the defendant is a private limited company registered under the provisions of the Companies Act, 1956. Certificate of incorporation (Annexure 'D/1') to the written statement has been brought to show that the company was incorporated on 22<sup>nd</sup> day of December, 2009. It is engaged in the business of manufacturing and marketing all kinds of paints, cement paints, varnishes, thinners, distempers, colours, etc. It has got three manufacturing units situated at Patna and Kanpur. It has got distributors all over the country and serves more than 800 plus dealers across the country.

**10.** Learned counsel for defendant-respondent would submit that father of one of the directors of the defendant company, namely Shri Shyam Narayan Khanna, was openly, continuously and exclusively using the mark Johnson Paints, Super Johnson Cem, J.P. Johnson Pigments and Johnson White since 14.04.1990 after its assignment in their favour by Mr. Ramesh Kumar Singh via an assignment deed. Thus, it is the case of the respondent that the original user of the trademark is one Ramesh Kumar Singh who, under an assignment deed, had permitted the use of the trademark to Shri Shyam Narayan Khanna. On 14.12.1999, Mr. Shyam Narayan Khanna, vide an



assignment deed, assigned the marks to M/s Super Shalimar Chemical Industry. Thereafter, on 13.05.2011, M/s Super Shalimar Chemical Industries assigned the said marks through an assignment deed to M/s Johnsons Pigment Private Limited. Finally, on 27.06.2011, M/s Johnson Pigment Private Limited assigned the said mark to the defendant - M/s Johnson's Paints Private Limited. Subsequently, the defendant company got certificate of registration of trademark bearing Certificate No. 1873895 dated 29.05.2018 for Johnson Paints Private Limited. The defendant company also got a copyright registered for use of the title and its graphical representation - Johnson Paints (Label) from the Copyright Office, Government of India, bearing Registration No. A-106717/2013. The defendant company also got copyright for the use of label "Johnson Paints" from the Copyright Office, Government of India, vide Registration No. A-107104/2013.

**11.** It is further case of the defendant that they procured certificate of registration of trademark vide Certificate No. 1709 dated 22.05.2018 for trademark "Johnson Paints Super Johnson Cem" in Class 2 under No. 2168151 in respect of waterproof plastic finish cem. They also got copyright for artistic work "Johnson Paints Super Johnson Cem".



**12.** The defendant has taken a plea that according to the plaintiff, they applied for registration of multiple trademark under the Act of 1999 but had deliberately not provided the dates of filing of such claim trademark applications for different trademarks. The defendant has shown that the plaintiff-respondent has applied for registration of trademark on various dates only in the year 2022, which have been objected to by the defendant. It is their stand that the plaintiff firm is changing the date of its use of the aforesaid trademarks as per its convenience with sole objective to mislead the Registrar of the Trademarks. It is further stated that the so-called founder of the plaintiff firm, namely Shri Krishna Prasad, had applied as an individual for registration of trademark with respect to trademark “Johnson Cem” vide trademark application dated 14.06.1993, wherein the user’s date was stated to be since 01.04.1991. The said application was not registered, rather the same was abandoned. In the year 2003, the plaintiff again applied for registration of said trademark with usage since 04.10.1991 which was registered vide certificate dated 23.05.2016. The defendant has filed rectification seeking cancellation of the said certificate vide rectification application dated 07.06.2016 i.e. within a month of grant of the registration.



**13.** It appears from the records that the defendant-respondent had filed its written statement in which a plea was taken that the present suit was admitted on 04.01.2024 by the learned Commercial Court and it was transferred to the court of learned Additional District Judge for further proceeding. The learned Commercial Court had also exempted the mandatory requirement of re-institution mediation under Section 12(A) of the Act of 2015 on an application dated 23.12.2023 filed by the plaintiff seeking exemption from the same but it is the plea of the defendant that the state exemption was granted without issuing any notice to the defendant for hearing on the same. The defendant raised a plea that the court of learned Additional District Judge is not a Commercial Court.

**Order of the Commercial Court**

**14.** It appears from the records that the injunction application referred by the plaintiff was taken up for consideration by the learned Principal District Judge Patna. There is no dispute that the court of learned Principal District Judge Patna is the Commercial Court. The learned Commercial Court has taken note of the submissions advanced on behalf of the plaintiff and the defendant as also the case laws on the subject which were placed before the court. The learned Commercial Court has taken note of



the various pleas advanced on behalf of the defendant. The defendant has inter alia pleaded that the plaintiff has admitted in its plaint documents that the defendant has been shown as user since 1990 in one of its applications referred in paragraph '14' of the plaint, however, no objection in respect thereof has ever been filed. The defendant pleaded that the plaintiff in its plaint shows its purported sales figures from 1999-2022, however, they have not shown any sale from 1987-1999 and apart from the four invoices filed, not even a single document has been filed to show actual and continuous use of the mark from 1987-2024. Thus, no claim for prior use, goodwill or reputation concretely comes out from the averments and the documents filed with the plaint.

**15.** The learned Commercial Court took a view that the four invoices dated 21.12.1987, 26.12.1987, 19.01.1988 and 19.02.1988 issued by Johnson Paints (1) Patna having BST No. P.C.W. 69 (R) and CST No. P.C.W. 1874 (C) have been brought on record as Annexure '1' series to the plaint, however, the certificate of registration under the Central Sales Tax Rules in the name of M/s Johnson Paints Company bears No. PCW-2117 and the same is inconsistent with the invoices on two accounts. The court further observed that in a RTI procured information as to the name of the allottee of the aforesaid BST and CST numbers from the



Department of Sales Tax, it has been revealed to the defendant that the BST No. P.C.W. 690 (R) was allotted to Sri Shankar Prasad and CST No. P.C.W. 1874 (C) was allotted in year 2006-2007.

**16.** The learned Commercial Court has taken note of Section 27 of the Trade Marks Act which deals with the case of “passing off” and held that the foundation of claim of passing off is prior use of trademark by the plaintiff, leading to existence of goodwill and reputation connected with the said unregistered trademark. The learned Commercial Court found that a license issued by the Factory Inspector, Inspection Department of the Government of Bihar which is annexed as Annexure ‘1’ series to the plaint shows that the same has been issued by Inspector of Factories on 27.05.2010, for the year 2010-14 in the name of M/s Johnson Paints Company. Also, Certificate of Registration issued in form B and Rule 5(1) of the Central Sales Tax (Registration and Turnover) Rules, 1957 dated 07.12.1991 bearing number PCW-2117 has been issued in favour of M/s Johnson Paints Company. These documents do not show that the said business concerned commenced business in the year 1987 rather, these documents relate to a later period. The learned Commercial Court held that absence of sales figures for 12 years, i.e. from 1987-88 to 1999-



2000, is intriguing for which no explanation has been offered on behalf of the plaintiff.

17. It has been held that, on the contrary, father of one of the directors of the defendant, namely Shri Shyam Narayan Khanna, was openly, continuously and exclusively using the mark Johnson Paints, Super Johnson Cem, JP Johnson Pigments and Johnson White since 14.04.1990, after its assignment in their favour by Mr. Ramesh Kumar Singh via a notarised assignment deed. On 14.12.1999, via a notarised assignment deed Shri Shyam Narayan Khanna had assigned the marks to M/s Super Shalimar Chemical Industries. Thereafter, the same was assigned to M/s Johnson Pigments Private Limited and finally it came to M/s Johnson Paints Private Limited. All these assignment deeds have been brought on record by the defendant by way of Annexure 'D/3' series to the reply of the defendant dated 28.09.2024. Subsequently, the defendant company got Certificate of Registration of trade bearing Registration Certificate No. 1873895 wherein registration date is 30.11.2011 for good and description of Class 2 and the certificate date is 29.05.2018. The defendant company has also obtained Certificate of Registration of Trademark as per description provided in paragraph '18' and '19'.



18. The learned Commercial Court, therefore, took a view that the foundation of claim of the plaintiff for passing off, i.e., prior use of the trademark similar to Johnson by the plaintiff i.e. since 21.04.1987 leading to existence of goodwill and reputation could not *prima facie* be made out. Therefore, the Commercial Court held that there would be no question of ‘misrepresentation’, i.e., unauthorized use of trademark that confuses customers about the origin of products and/or are likely to cause public association with the plaintiff’s trademarks. It has been held that the plaintiff has not been able to establish actual or potential harm. No prima facie case has been made out, therefore, the interim injunction application has been rejected.

**Submissions on behalf of the Plaintiff-Appellant**

19. Learned counsel for the appellant submits that on transfer of the records of the case by the learned Commercial Court, the learned Additional District Judge firstly granted ad-interim injunction vide order dated 06.03.2024, however, on the defendant filing the petition under Order XXXIX Rule 4 CPC, vide order dated 06.06.2024 dismissed the application dated 08.12.2023 of the plaintiff, thereby the interim injunction stood vacated vide order dated 06.06.2024 passed by the learned Additional District Judge-XIV, Patna. Later on, in Commercial



Appeal No. 08 of 2024, this Court set aside order of the Commercial Court by which the records were transferred to the court of learned Additional District Judge, all the orders passed by learned Additional District Judge-XIV, Patna were declared *non-est*. In these circumstances, petition dated 08.12.2023 for injunction was heard afresh by the learned Commercial Court. It is submitted that the plaintiff-appellant filed documents as per List of Documents dated 03.06.2024 and also filed a written notes of argument on the point of injunction which were available on the record but while passing the impugned order dated 16.11.2024 those have not been taken into consideration.

**20.** Learned counsel has drawn the attention of this Court towards the supplementary affidavit filed before this Court with which the list of documents filed before the learned Commercial Court has been brought on record as Annexure 'A-30'. It is submitted that the defendant-respondent got a wrong information under the RTI from the Public Information Officer from Assistant Commissioner of State Tax, Patna City, West Circle with regard to the date of registration under the BST and the date of registration of the CST number. In this regard, Annexure 'A/20' has been placed on record to submit that the same Public Information Officer has admitted the mistake in providing



information with regard to the year of registration of BST No. - P.C.W. 690 (R) and CST No. P.C.W. 1874 (C). In Annexure 'A/20' he has given the reason behind the mistake. Annexure 'A/20' would show that both the registration numbers are of the year 1986-1987.

**21.** Learned counsel further submits that from the list of documents and the documents annexed therewith, it would appear that M/s Johnson Paints Private Limited made an application for registration of a trademark in Class 2 in respect of goods/services such as cements paint, paint, lacquers, varnishes (not being insulating varnishes), thinners, distemper and dry colours, colouring matters (not for laundry or toilet purposes) etc on 24<sup>th</sup> day of November 2011. The company claimed its users since 19.04.1990. The application was notified for objection. The affidavit enclosed therewith would show the sale figures provided by the respondent, however, the defendant filed Form TM-16 for correction of clerical error and amendment in the application. Request was made to change the date of user from 14.04.1990 to 22.12.2009 in TM-1 an additional representation. Thus, the respondent itself corrected its mistake and showed the date of user as 22.12.2009. The plaintiff-respondent has filed opposition in form TM-6 and has also filed rectification/cancellation to register



trademark number 216815. It is submitted that these documents have not been considered by the learned Commercial Court, despite those being available on the record.

**22.** Learned counsel for the plaintiff-appellant has placed on record the computer generated TM search report showing that they have made as many as 24 applications on different dates for registration of the various trademarks. They have shown the user date of those trademarks. As regards the mark 'Johnson', the plaintiff has made an application vide no. 5746797 on 31.12.2022 showing the user date as 21.04.1987. This has been opposed by the respondent. This report further shows that the plaintiff-appellant had filed application no. 599275 for Johnson Cem on 14.06.1993 showing the user date 01.04.1991, application no. 636957 dated 16.08.1994 showing user date 01.11.1993 but these two applications were abandoned. As regards Johnson Cem, another application bearing no. 1214876 was filed on 16.07.2003 and according to the plaintiff, this has been registered in favour of the plaintiff. The plaintiff filed applications on 01.01.2010 vide no. 1904110 and 1904111 for registration of the mark 'Johnson' showing the user name on 23.09.1995. It appears that while application no. 1904110 was abandoned, application no. 1904111 has been opposed. This TM search report only showed that the



parties are contesting the registration of trademark against each other.

23. Learned counsel for the appellant has relied upon the judgment of the Hon'ble Supreme Court in the case of **Neon Laboratories Limited vs. Medical Technologies Limited and Ors.** reported in (2016) 2 SCC 672. It is submitted that the predecessor in interest of the plaintiff had initiated user of the trademark 'Johnson' in the year 1987 and since then they have continued with this trademark. The plaintiff had applied for registration of this trademark several years prior to the defendant-respondent. The Hon'ble Supreme Court considered Section 34 of the Act of 1999 and considered whether the prior registration would have the effect of obliterating the significance of the goodwill that had meanwhile been established by the plaintiff-appellant. The question before the Court was as to whether a deeming provision i.e. relating registration retrospectively prevail on actuality – competing equities oscillate around prior registration and prior user. While interpreting Section 34, the Hon'ble Supreme Court held thus:- “this Section palpably holds that a proprietor of a trade mark does not have the right to prevent the use by another party of an identical or similar mark where that



user commenced prior to the user or date of registration of the proprietor. This “first user” rule is a seminal part of the Act....”

24. It is thus submitted that in the case of **Neon Laboratories Limited** (supra), the Hon’ble Supreme Court has categorically held that Section 34 gives rights to a subsequent user when its user is prior to the user of the proprietor and prior to the date of registration of the proprietor, whichever is earlier. The intention of the section is to protect the prior user from the proprietor who is not exercising the user of its mark. It is submitted that the defendant-respondent has not brought on record any prima facie material to show that Shri Shyam Narayan Khanna was openly, continuously and extensively using the mark Johnson Paints, Super Johnson Cem, J.P. Johnson Pigments and Johnson White since 14.04.1990. No prima facie document has been produced to show that the assignor of the mark, namely Ramesh Kumar Singh, had been using the trademark. Further, nothing has been brought on record to show that Mr. Shyam Narayan Khanna or Super Shalimar Chemical Industry were using this mark. It is the own case of the defendant-respondent that they got the assignment of marks through an assignment deed dated 27.06.2011 in favour of M/s Johnson Paints Pvt. Ltd.



**25.** Referring to the judgment of the Hon'ble Supreme Court in the case of **S. Syed Mohideen vs. P. Sulochana Bai** reported in **(2016) 2 SCC 683**, learned counsel for the appellant submits that the Hon'ble Supreme Court affirmed the views of the Hon'ble Delhi High Court that a "passing off" action can even lie against a registered proprietor of the mark against which the action has arisen. Their Lordships held that a trade mark exists independently of the registration which merely affords further protection under the statute, the common law rights being left completely unaffected. It has been held that the registration is only a recognition of the rights that have been pre-existing in common law in case a conflict arises between the two registered proprietors, the evaluation of the better rights in common law is essential as the same would determine whose rights between the two registered proprietors are superior.

**26.** Learned counsel has also relied upon the judgment of the Hon'ble Supreme Court in the case of **N.R. Dongre and Ors. vs. Whirlpool Corporation and Anr.** reported in **(1996) 5 SCC 714**.

**27.** Learned counsel for the appellant submits that the learned Commercial Court could not apply the three tests for injunction in the light of the judicial pronouncements in the facts



of the case, which has led to perversity, the order of the learned Commercial Court is liable to be set aside and the injunction application is fit to be allowed.

**Submissions on behalf of the Respondent-Defendant**

**28.** On the other hand, learned counsel for the respondent has opposed the appeal. Initially, the respondent filed an affidavit raising preliminary objection, however, in course of submissions, Mr. Kejriwal, learned counsel for the respondent, has made his submissions by placing on record the complete written statement and the affidavits filed before the learned Commercial Court. A written notes of submissions has also been filed on behalf of the respondent. Annexure 'D/1' to Annexure 'D/23'. Xerox copies of GST registration certificate dated 05.02.2021 has been brought on record, which shows that the respondent company got the registration number in form GST REG-06 from the registering authority in the State of Bihar for the trade name "Johnson Paints Pvt. Ltd. Unit-2". Another registration certificate dated 10.05.2023 is in the trade name "Johnson Paints Pvt. Ltd. Unit-3".

**29.** The assignment deed dated 14<sup>th</sup> day of April, 1990 (xerox copy) has been placed on record to show that one Ramesh Kumar Singh assigned the trademark J.P. Johnson Pigment, Johnson Paints, Super Johnson Cem and Super White in favour of



one Shyam Narayan Khanna, son of Lakshmi Narayan Khanna. In this deed, the assignor has described himself as the proprietor of the trademark. It is, however, admitted that the assignment deed does not mention the date of user of these products by the assignor.

**30.** Another assignment deed (Xerox copy) is dated 14.11.1999 said to have been executed by Shyam Narayan Khanna in favour of M/s Super Shalimar Chemical Industries. In this deed also, the assignor claims himself the proprietor of the seven trademarks J.P. Johnson Pigments, Johnson Paints, Super Johnson Cem and Johnson White. It is evident that all the seven trademarks name has not been mentioned.

**31.** The another deed of assignment is dated 13<sup>th</sup> day of May, 2011 by which said Shyam Narayan Khanna and Vikram Khanna trading as M/s Super Shalimar Chemical Industries, Gulmahiya Chak, Sabalpur, Patna has assigned seven trademarks J.P., Johnson Pigments, Johnson Paints, Super Johnson Cem, Johnson White, Birla Oxide, and J.K. Oxide, which they claim using as an artistic label on all types of goods of paints since 14.04.1990 in course of trade. This deed of assignment mentions consideration in the sum of Rs. 1,500/- only paid in cash by the assignee to the assignor.



**32.** The another assignment deed is the last one dated 27<sup>th</sup> day of June 2011 between M/s. Johnson Pigments Pvt. Ltd. and M/s. Johnson Paints Pvt. Ltd. By this assignment deed, the assignor has claimed itself proprietor of the trademark-Johnson Paints, J.P. and Super Johnson Cem. The assignor claimed that he was using the said trademark since 14.04.1990 for all types of goods. The consideration amount has been kept at Rs. 14,000/- paid by cash. Although this deed of assignment dated 27<sup>th</sup> June 2011 is said to be executed between the two private limited companies, it is admitted that the assignment deed does not bear the seal of the company and/or signature of the authorised person on behalf of the two companies. The deed does not mention the name of the authorised person through whom the company is represented.

**33.** On the strength of these documents placed on the record, learned counsel for the defendant-respondent has defended the order of the learned Commercial Court. It is submitted that the learned Commercial Court has considered the essential requirements to establish a case of “passing off”. The Commercial Court has found that the plaintiff has brought on record four invoices dated 21.12.1987, 26.12.1987, 19.01.1988 and 19.02.1988 issued by Johnson Paints (I), Patna having BST No.



**P.C.W. 690 (R)** and CST No. P.C.W. 1874 (C) but the certificate of registration under the Central Sales Tax Rules in the name of M/s Johnson Paints Company is inconsistent with the two invoices of the year 1987, on two counts, i.e. name of business concern of the invoices Johnson Paints Company and the certificate of registration of Johnson Paints Company. The learned Commercial Court has relied upon the RTI information. The Commercial Court has held that the license issued by the Factory Inspection Department of the Government of Bihar to the plaintiff shows that the same has been issued by Inspector of Factories on 27.05.2010 for the year 2010-14. The Commercial Court held that the certificate of registration issued in Form-B under Rule 5(1) of the Central Sales Tax (Registration and Turnover) Rules, 1957 dated 07.12.1991 bearing no. PWC-2117 issued in favour of the plaintiff company do not show that the said business concern commenced business in the year 1987, rather these documents relate to a later period. The Commercial Court further held that the sales figures furnished by the plaintiff in the plaint commence from 1999-2000 up to the year 2022-2023, even though the claim of the plaintiff is that their business commenced in the year 1987.

**34.** The learned Commercial Court has held that one of the trademarks of the plaintiffs 'Johnson Paints' is being used by



the defendant since 14.04.1990. In these circumstances, the learned Commercial Court has not committed any error in rejecting the application for injunction. Learned counsel has relied upon the judgments of the Hon'ble Supreme Court in the case of **Wander Limited and Anr. vs. Antox India Pvt. Ltd.** reported in **1990 SUPP SCC 727**, **Power Control Appliances and Ors. vs. Sumeet Machines Private Limited** reported in **(1994) 2 SCC 448**, **Pernod Ricard India Private Limited vs. Karanveer Singh Chhabra** reported in **2025 SCC OnLine SC 1701** and judgment of Hon'ble Delhi High Court in the case of **KRBL Ltd. Versus Lal Mahal Ltd. And Anr.** reported in **2015 SCC OnLine DEL 7598**. It is submitted that as per the case of the appellant itself, both the parties have been using the trademark 'Johnson' for the last several years. Both the parties have got the customer base of thousands all across the country. Both the parties have got their factory units and a brigade of employees fully dependent upon the production and trading of the products of the units. The plaintiff has simply expressed likelihood of loss and no details of any loss has been presented. No instance of any loss suffered has been shown.

**35.** Learned counsel further submits that the respondent is already a registered trademark holder with respect to seven



trademarks consisting of name 'Johnson' therefore the rights of the respondent are protected under Section 28 to 31 of the Act of 1999. It is his submission that at this stage no mini-trial can be conducted to record finding at the stage of temporary injunction. No interference is required in the order of the learned Commercial Court unless the order of the court is found suffering from perversity and arbitrariness.

### **Consideration**

**36.** At the outset, this Court would make it clear that the impugned order of the learned Commercial Court is being examined keeping in view the scope and ambit of the principles governing grant of injunction. In the case of **Pernod Ricard India Private Limited** (supra), the Hon'ble Supreme Court has discussed these legal principles in paragraph nos. '36', '36.1', '36.2', '36.3' and '36.4', which are being reproduced hereunder:-

“**36.** The Trade Marks Act, 1999 does not prescribe any rigid or exhaustive criteria for determining whether a mark is likely to deceive or cause confusion. Each case must necessarily be decided on its own facts and circumstances, with judicial precedents serving to illuminate the applicable tests and guiding principles rather than to dictate outcomes.

**36.1.** As a general rule, a proprietor whose statutory or common law rights are infringed is entitled to seek an injunction to restrain further unlawful use. However, this remedy is not absolute. The considerations governing the



grant of injunctions in trademark infringement actions broadly apply to passing off claims as well. That said, a fundamental distinction remains: while a registered proprietor may, upon proving infringement, seek to restrain all use of the infringing mark, a passing off action does not by itself confer an exclusive right. In appropriate cases, the court may mould relief in passing off so as to permit continued use by the defendant, provided it does not result in misrepresentation or deception.

**36.2.** The grant of injunction - whether for infringement or passing off - is ultimately governed by equitable principles and is subject to the general framework applicable to proprietary rights. Where actual infringement is established, that alone may justify injunctive relief; a plaintiff is not expected to wait for further acts of defiance. As judicially observed, “*the life of a trademark depends upon the promptitude with which it is vindicated.*”

**36.3.** The principles laid down in *American Cyanamid Co. v. Ethicon Ltd.*<sup>30</sup> continue to guide the Courts while determining interim injunction applications in trademark cases. The following criteria are generally applied:

(i) Serious question to be tried/triable issue: The plaintiff must show a genuine and substantial question fit for trial. It is not necessary to establish a likelihood of success at this stage, but the claim must be more than frivolous, vexatious or speculative.

(ii) Likelihood of confusion/deception: Although a detailed analysis of merits is not warranted at the interlocutory stage, courts may assess the prima facie strength of the case and the probability of consumer confusion or deception. Where the likelihood of confusion is weak or speculative, interim relief may be declined at the threshold.

(iii) Balance of convenience: The court must weigh the inconvenience or harm that may result to either party from

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30. (1975) AC 396



the grant or refusal of injunction. If the refusal would likely result in irreparable harm to the plaintiff's goodwill or mislead consumers, the balance of convenience may favor granting the injunction.

(iv) Irreparable harm: Where the use of the impugned mark by the defendant may lead to dilution of the plaintiff's brand identity, loss of consumer goodwill, or deception of the public - harms which are inherently difficult to quantify - the remedy of damages may be inadequate. In such cases, irreparable harm is presumed.

(v) Public interest: In matters involving public health, safety, or widely consumed goods, courts may consider whether the public interest warrants injunctive relief to prevent confusion or deception in the market place.

**36.4.** In conclusion, the grant of an interim injunction in trademark matters requires the court to consider multiple interrelated factors: *prima facie* case, likelihood of confusion, relative merits of the parties' claims, balance of convenience, risk of irreparable harm, and the public interest. These considerations operate cumulatively, and the absence of any one of these may be sufficient to decline interim relief.”

**37.** The legal principles being crystal clear from the judgment of the Hon'ble Supreme Court quoted hereinabove, this Court would apply the same in the facts of the present appeal. The bone of contention between the parties is over the use of the trademark “JOHNSON” for the wide range of paint products.

**38.** It is the case of the plaintiff-appellant that on or about the year 1987, Late Krishna Prasad had coined and adopted trademark ‘JOHNSON’. He had set up a proprietorship firm named ‘Johnson Paints (I)’ in the undivided state of Bihar and obtained Sales Tax Registration No. B.S.T. No. P.C.W. 690 (R) and C.S.T. No. P.C.W. 1874 (C) from the Commercial Taxes authority. Later on, his both sons were admitted in the business



and the proprietorship firm was converted into a registered partnership firm vide Deed No. 564 dated 19.08.2014. The plaintiff claims prior user of the trademark “JOHNSON/JOHNSON CEM/JOHNSON PAINTS, JP” (collectively called “Trademark”). They have claimed that they have continuously and extensively used this trademark since adoption in the year 1987, therefore, it has attained distinctiveness and has become popular trademark in the domestic markets over the three decades in India.

**39.** It is a matter of record that the plaintiff had applied for registration of trademark ‘JOHNSON CEM’, ‘JOHNSON PAINTS (I)’, ‘JOHNSON PAINTS’, ‘JOHNSON GLOBE CEM’, ‘RAINBOW CEM’, ‘GOLDEN CEM’, etc., showing their user date between 21.04.1987 and 29.01.1996. The plaintiff has shown the sales figure since 1991-1992 and the advertisement expenses since 1996-97.

**40.** The defendant-respondent has submitted that the plaintiff has filed an application under Order VI, Rule 17 of the CPC in which certain amendments have been sought for. The submission is that the said amendment petition is still pending in the learned Commercial Court, but it has not been disclosed. In sum and substance, it is submitted that the present appeal cannot



be considered on the basis of the new facts and the documentary materials which are yet to be incorporated in the plaint.

**41.** This Court makes it clear that the Court is not considering the new facts and materials and the impugned order of the learned Commercial Court is being examined keeping in view only those documents of the plaintiff and the defendants which have been discussed by the learned Commercial Court or have not been considered even as those were available on the record of the Court hearing the injunction petition.

**42.** Copy of the plaint filed under Section 26 of CPC read with Section 134(1)(c) and 135 of the Act of 1999 for permanent injunction restraining passing off of the trademarks contains reference to various documents. The details of some applied trademarks with their respective user/adoption date as provided by the plaintiff are being reproduced hereunder:-

S No.	TM No.	Trademark	Class	User Date
1	5746777	JOHNSONCEM	2	21/04/1987
2	5746794	JOHNSON PAINTS (I)	2	21/04/1987
3	5746795	JOHNSON PAINTS (I)	35	21/04/1987
4	5746796	JOHNSON PAINTS	2	21/04/1987
5	5746797	JOHNSON	2	21/04/1987
6	5688925	METAL CEM	2	01/09/2018
7	5688926	GOLDENCEM	2	29/01/1996
7	5688927	RAINBOWCEM	2	16/12/1995
8	5688928	BILLION CEM	2	01/10/2018
9	5688929	RAMBO CEM	2	18/07/2018
10	5688931	MILLIONCEM	2	11/03/1999
11	5688932	PETALCEM	2	13/02/2003
12	5688933	GLOBECEM	2	16/12/1995



43. The plaintiff has adopted artwork for their trademark under the Copyright Act, 1957. The copyright registration details have been brought on record as Annexure 'III' series. The description of the artistic work is as under:-

S No.	COPYRIGHT REG. NO.	LABEL	DATED
1	101243/2013	<i>JP</i>	19/06/2023

44. In support of their claim of user of this trademark, the plaintiff has provided the sales figure and advertisement expenses for the various financial years from the year 1999-2000 to the financial year 2022-23, which we reproduce as follows:-

FINANCIAL YEAR	SALE FIGURE (Rs)	ADVERTISEMENTS EXPENSES (Rs)
1999-00	6,955,662.00	83,656.00
2000-01	10,245,435.00	87,976.00
2001-02	10,910,921.00	105,011.00
2002-03	10,868,760.00	7,401.00
2003-04	10,818,789.00	124,723.00
2004-05	12,153,930.00	147,361.00
2005-06	12,304,965.73	123,027.00
2006-07	13,638,222.51	438,409.00
2007-08	17,037,676.09	183,854.00
2008-09	19,590,663.21	84,042.00
2009-10	22,799,889.81	445,197.00
2010-11	34,943,281.59	619,043.00
2011-12	55,903,679.74	2,153,186.00
2012-13	74,915,455.02	3,019,692.00
2013-14	97,284,466.64	2,412,411.74
2014-15	123,336,362.72	4,797,896.00
2015-16	123,982,056.33	2,638,891.00
2016-17	109,807,328.34	2,027,606.00
2017-18	348,924,455.36	2,694,301.12
2018-19	522,079,511.58	7,578,135.43
2019-20	440,149,473.00	10,121,370.00



2020-21	487,654,662.00	12,510,586.63
2021-22	430,138,515.44	8,990,257.54
2022-23	560,045,907.21	1,580,660.00

45. The plaintiff has also brought on record the photocopy of the newspaper advertisements and other documents in support of continuous usage which have been annexed as Annexure 'IV'. Annexure 'A-3' is a copy of the invoice number JPI/8210/87-88 dated 18.04.87 showing sale of cement-coating (Johnson Cem), red oxide, white putty, etc., to Lal & Company, Main Road, Katra Garh (Dhanbad). The another invoice number JPI/27/87-88 is dated 15.07.87 by which Johnson Cem and red oxide were sold to S.K. Mitra of Pakur in the district of Sahebganj. The third invoice is dated 07.01.1989 showing sale of Johnson Cem Ivory, the fourth invoice is dated 05.05.88 showing sale of Johnson Cem and various other products to Samanta Hardware Stores, Barbil (Orissa). All these invoices are bearing B.S.T. No. - P.C.W. 690 (R) and C.S.T. No. P.C.W. 1874 (C) and the telephone number. The plaintiff has also brought on record the invoice-cum-despatch advice of the year 1998 showing registration no. 1/BKP/CH-32/96 dated 12.04.1996. Another invoice-cum-despatch advice dated 10.03.2000 has been brought on record which shows the place of business, office and the telephone number of the plaintiff firm. Several such invoice-cum-despatch



advice are available on the record prima facie to satisfy this Court that the plaintiff was using the trademark “JOHNSON” since the year 1987-88.

**46.** On record, this Court finds a copy of assessment order under Section 17(2)(a) of the Bihar Finance Act for the year 1988-89. It shows that Shri Krishna Prasad was served with a notice under Section 17(2)(a) of the Finance Act, whereafter he had appeared before the Assessing Officer with his accountant Shri N.K.P. Sharma and had produced the cash book, bill, invoices, cash memo, sale register, stock register, etc. Those were examined and from the records, the Assessing Officer concluded that those were tallying with the yearly return showing gross sale amount at Rs. 5,68,976.46. The order of the Assessing Officer is dated 31.08.1993.

**47.** From Annexure ‘A-4’ to the plaint, this Court finds that it is a letter of Tiffin’s Barytes, Asbestos and Paints Limited, vide Reference No. 931/71B addressed to M/s. Johnson Paints (I) wherein the firm was requested to despatch one wagon load containing 24.5 metric tons (490 bags) of CR-1 Grade Barytes Powder from Cuddapah to Patna Saheb on their account. The details of the banker’s name, etc., were provided. A bill drawn by Tiffin’s Barytes, Asbestos and Paints Limited on 25<sup>th</sup> December



1987 through Allahabad Bank, Chowk, Patna City is also available on the record. A bill dated 6.10.1988 of Chemical Agency, Indian Bank Building, Jhauganj, Patna City addressed to M/s Johnson Paints, bill of G.S. Mineral Industries dated 20.12.1986 and bill of Bhatia Rasayan Udyog in the name of M/s Johnson Paints are on the record. Copy of the Form-C issued by M/s Samanta Hardware Stores to M/s Johnson Paints (I), Patna is also on the record.

**48.** This Court further finds that challans of the amount paid in the branch of the State Bank of India on account of taxes under the Central Sales Tax Act by the plaintiff for the year quarter ending June 1988 are on the record.

**49.** On record there is also an order dated 23<sup>rd</sup> January, 2024 passed by the Trade Marks Registry in the matter of an application number 3692032 for registration of a trade mark in Class 2 “Johnson Paints” filed by the defendant-respondent which has been shown abated. The order of the Trade Marks Registry has been passed after the objections were raised by the plaintiff-appellant. The said order is being reproduced hereunder:-

“THE TRADE MARKS ACT, 1999  
(Before the Registrar of Trade Marks,)  
IN THE MATTER OF an Application No. 3692032  
for registration of a trade mark in class 2  
trading as JOHNSON PAINTS PVT. LTD.  
SABALPUR, PATNA-800009.... Applicants  
AND  
IN THE MATTER OF Opposition No.- 1020123  
thereto by JOHNSON PAINTS CO.  
308, VARDHMAN PLAZA, DB GUPTA ROAD, OPPOSITE



POLICE STATION, PAHAR GANJ, DELHI also at 11 A/2,  
ASHOKA PALACE, EXHIBITION ROAD, PATNA -800001,  
BIHAR.... Opponents

Hearing Date : 18/01/2024

Present : Adv. Shekhar Kosta counsel for the Applicant  
Adv. Ajit Kumar counsel for the Opponent

**ORDER**

Proceedings were initiated under Section 21 of the Trade Mark Act, 1999, by the above named opponent to oppose the registration of trade mark applied for by the above named applicant. The opponent filed the rely letter in support of opposition on 30/04/2020. Thereafter the applicant was required to file the evidence in support of application within the prescribed period as per rules and whereas within the time prescribed under the rules, neither any evidence in support of application was filed nor any statement was submitted on behalf of the applicant to the effect that the applicant does not desire to adduce evidence but wants to rely on the facts mentioned in the Counter statement. An opportunity has also been provided to the applicant by fixing a hearing on 18/01/2024 to explain that why the above application shall not be abandoned under rule 46(2), Counsel for the applicant appeared and submitted that applicant has not received evidence under rule 45. Thereafter, counsel for opponent was directed to submit the receipt of delivery of evidence under 45. Thereafter by TM-M filed on dated 18/01/2024 opponent has submitted proof of service of evidence under rule 45 by email dated 01/06/2020 to the applicant. As till now applicant has not filed evidence under rule 46 nor has submitted rely letter in this regard, thus the above mentioned application is, therefore, deemed to have been abandoned under Rule 46(2) of the Trade Marks Rules 2017 and the opposition number 1020123 abates accordingly.

It is hereby further ordered that there shall be no order as to cost of these proceedings.”

**50.** Learned counsel for the respondent has submitted that the respondent has got registered several trademarks in its name, however, it is not denied that those registrations are being



contested by the plaintiff-appellant by filing rectification applications and the same are pending consideration.

**51.** As against the claim of the plaintiff of a prior user, the defendant-respondent has mainly relied upon the four deeds of assignment which this Court has taken note of while recording the case of the defendant-respondent. The plaintiff has seriously questioned the genuineness of these four deeds of assignments. At this stage, without going into the issue of genuineness of the deeds, we would only prima facie say that the deeds of assignment do not inspire confidence and lead nowhere. Admittedly, the defendant-respondent company came to be incorporated on 22.12.2009 vide Corporate Identity No. (CIN) U24222BR2009PTC015136 having its registered office at Fatuha Road, Sabalpur, Patna City, Patna. From its own document annexed with the written statement which has been brought on record before this Court it would appear that in the Trade Marks Registry, while filing application number 2241994 for the trademark as manufacturer, the respondent has shown the word mark “Johnson Paints Private Limited” “used since : 22/12/2009”. The defendant-respondent claims their rights of prior user by virtue of the deed of assignments which are Annexure ‘D/3’ series. A bare perusal of the deed of assignments would show that all these assignors claim themselves proprietor of the trademarks, the trademarks are not registered trade-marks in the name of the



assignor(s). The prima facie discrepancies noticed by this Court are being provided hereunder:-

**(i) Date of the deed of assignment:** 14.04.1990

**Name of the assignor:** Ramesh Kumar Singh

**Name of the assignee:** Shyam Narayan Khanna

**Trademark name:** (1) J.P. (2) Johnson Pigments, (3) Johnson Paints (iv) Super Johnson Cem (v) Johnson White

**Discrepancies:-** Ramesh Kumar Singh has described himself proprietor of the trademark but the fact is that these trademarks were never registered in the name of Ramesh Kumar Singh. There is no iota of prima facie evidence that Ramesh Kumar Singh was dealing in these paint products in the given trademark names. There is neither seal of the firm nor any document showing registration of the business firm. This document has not been referred by the respondent in its earlier correspondences prior to filing of the written statement. The deed does not mention a clear description of the mark (unregistered).

**(ii) Date of the deed of assignment:** 14.12.1999

**Name of the assignor:** Shyam Narayan Khanna

**Name of the assignee:** Shyam Narayan Khanna and Vikram Khanna Trading as M/s Super Salimar Chemical Industries

**Trademark name:** (1) J.P. (2) Johnson Pigments, (3) Johnson Paints (4) Super Johnson Cem (5) Johnson White (6) not mentioned (7) not mentioned

**Discrepancies:-** Apart from the above-mentioned discrepancies which have been found in case of Ramesh Kumar Singh, in this assignment deed, the assignor has assigned the trademark to himself and received consideration. There is no detail of the registration or about the business of the assignor. Trademarks names are not mentioned in the deed of assignment. The deed has been shown notarised only.

There is no indemnity clause to protect the assignee (buyer) from future claim.

**(iii) Date of the deed of assignment:** 13.05.2011

**Name of the assignor:** Shyam Narayan Khanna and Vikram Khanna Trading as M/s Super Salimar Chemical Industries

**Name of the assignee:** M/s Johnson Pigments Private Limited

**Trademark name:** (1) J.P. (2) Johnson Pigments, (3) Johnson Paints (4) Super Johnson Cem (5) Johnson White (6) Birla Oxide (7) J.K. Oxide

**Discrepancies:-**All such discrepancies which have been found above are present in this deed of assignment as well. The assignment has been made in favour of the company M/s Johnson Pigments Private



Limited and in this deed, two new trademarks have been introduced. There is no information regarding registration of the trademarks or about business of the assignor. The assignment deed is not even notarised.

**(iv) Date of the deed of assignment:** 27.06.2011

**Name of the assignor:** M/s Johnson Pigments Private Limited

**Name of the assignee:** M/s Johnson Paints Private Limited

**Trademark name:** (1) Johnson Paints (2) J.P. (3) Super Johnson Cem

**Discrepancies:-**All such discrepancies which have been found above are present in this deed of assignment as well. The assignment has been made in favour of the company M/s Johnson Pigments Private Limited and in this deed, two new trademarks have been introduced. There is no information regarding registration of the trademarks or about business of the assignor. The assignment deed is not even notarised.

52. If these four assignment deeds are looked into, without much discussion, prima facie, this Court would have no hesitation in recording that the assignment deeds, which have been seriously questioned by the plaintiff, would not help the defendant-respondent in making a submission that they had derived their rights to user by virtue of these deed of assignments. These assignments are not supported by any material at all. Moreover, the date of assignment to the defendant is 27.06.2011. The learned trial court has noticed the documents showing that the plaintiff was in this business with the word mark "JOHNSON" much prior to 27.06.2011. The assignor of the defendant-respondent never raised any issue against the use of the word mark "JOHNSON" by the plaintiff.

53. It is evident from the case of the defendant-respondent that only after its incorporation on 22.12.2009, the Company started its business. All applications for registration of the trade marks filed



by the defendant-respondent are of the subsequent years. The defendant-respondent has filed before this Court the copies of the Certificate No. 1223622 showing the registration of the work mark: Super Rainbow Cem (Label) with the name of the goods and description: Class 2 waterproof plastic finish Cem. The registration date is 20.03.2011. The parties are contesting the registration and several rectification applications are pending before the Trademark Registry. On record, this Court finds that the defendant-respondent has placed copy of the legal notices exchanged between the parties. Mr. Shekhar Pal, learned Advocate for the defendant-respondent served a notice on the plaintiff-appellant alleging infringement and passing off of the trademarks “Super Petal Cem” and “JP” and Artistic Work of the mark “Super Petal Cem” registered under the Copyright Act, 1957. In the said notice, the defendant claimed that on account of long and continuous use coupled with advertisement and publicity and by virtue of the superior quality of the goods sold there under, the said trademarks of defendant has acquired handsome goodwill and impeccable trade reputation among the public and trade. The defendant-respondent has though claimed infringement of the trademark, in the legal notice, it nowhere mentions to have acquired any proprietary right in those trademarks by virtue of the assignment deeds. In an another notice addressed by Kosta Trade Mark Company vide Reference No. KTMC/J0001 dated 29.10.2018



addressed to the plaintiff-appellant, it is mentioned that the company on whose behalf notice was issued (the defendant) is engaged in the business of manufacturing and marking of synthetic paints, distemper, paints, stainer, wall putti, cement paints, oxide colour primers, waterproof cement, all kinds of paints, cement colour, oxide colour and distemper for last several years. The notice talks of registration, but in the whole notice, there is no mention of acquisition of proprietary right with respect to those trademarks by virtue of deeds of assignment. This only affirms and strengthens the prima-facie view of this Court that the deed of assignments unless those are duly proved by the defendant cannot be relied upon at this stage to give any benefit to the defendant-respondent.

**54.** In the case of **S. Syed Mohideen** (supra), the Hon'ble Supreme Court has held that a passing off action can even lie against a registered proprietor of the mark against which the action has arisen. It has been held that a trade mark exists independently of the registration which merely affords further protection under the statute, the common law rights being left completely unaffected. It has been held that the registration is only a recognition of the rights that have been pre-existing in common law in should a conflict arise between the two registered proprietors, the evaluation of the better rights in common law is essential as the same would determine whose rights between the proprietors are superior. It is said that the later user of



the mark/name in the business cannot misrepresent his business as the business of a prior user.

**55.** In the light of the materials which have been discussed hereinabove, this Court is of the considered opinion that the learned Commercial Court has grossly erred in saying that the plaintiff has not established prior use of the trademark prima-facie. The learned Commercial Court has though noticed the four invoices dated 21.12.1987, 26.12.1987, 19.01.1988 and 19.02.1988 issued by the Johnsons Paints (I), Patna having B.S.T. No. P.C.W. 690 (R) and C.S.T. No. P.C.W. 1874 (C). but could not appreciate that at the relevant time, the business was operating as proprietorship firm of Shri Krishna Prasad. The Public Information Officer who gave the information under the RTI to the defendant vide its Letter No. 348 dated 17.08.2024 issued another letter which has been placed before this Court bearing Letter No. 770 dated 19.12.2024 to show that he has admitted that the earlier information was not correct. The learned Commercial Court has noticed the certificate of Inspector of Factories and Certificate of Registration issued in Form B under Rule 5(1) of the Central Sales Tax (Registration and Turnover) Rules, 1957 dated 07.12.1991 bearing No. PCW-2117 issued in favour of M/s Johnsons Paints Company, despite these documents, the Commercial Court has taken a view that those documents do not show that the business concerned commenced business in the year 1987. The court



was required to see the better rights in the common law but the learned Commercial Court went into an issue as to whether the plaintiff commenced its' business in the year 1987 or not. The sales figure given by the plaintiff for the period 1999-2000 up to the year 2022-23 has not been duly considered on the ground that the plaintiff was not showing the sales figure for the period 1987-88 to 1999-2000. In our considered opinion, the learned Commercial Court, despite having so much of overwhelming materials on the record showing that the plaintiff firm had got the Certificate of Registration in Form 'B' under Rule 5(1) of the Central Sales Tax Rules did not take an appropriate view of the same.

**56.** We find that on the contrary, the learned Commercial Court has placed much reliance on the deed of assignments which were brought on record by the defendant by way of Annexure 'D/3 Series' to the reply. The Commercial Court did not mention the fact that the plaintiff had raised serious questions with regard to the genuineness of the deeds of assignments. The learned Commercial Court has referred Trademarks Certificate No. 1873895 whereunder the registration date 30.11.2011 and the certificate date is 25.09.2018. In our opinion, the learned court could not appreciate that mere registration of trademark would not confer a right upon the later user to pass off its products in a deceptive manner.



57. The learned court has grossly erred and recorded perverted finding in paragraph '41' of its order by relying upon paragraph '14' of the plaint to take a view that from the details mentioned in the said paragraph, one of the defendant's trademark 'Johnsons Paints' is shown being used by defendants since 14.04.1990. The learned Commercial Court could not appreciate that the plaintiff had only described what the defendant was claiming with regard to the date of the user of the trademark 'Johnsons Paints' on the strength of the deeds of assignment.

58. Having regard to the entire discussions hereinabove, we are of the opinion that the order of the learned Commercial Court suffers from infirmities to the extent of perversity. The plaintiff-appellant has made out a strong prima facie case from the various documents placed on the record which have been discussed hereinabove. A better common law right has been established. The common law rights of the plaintiff are being infringed, therefore, the plaintiff is entitled to seek an injunction to restrain the defendant. In case of **Pernod Ricard India Private Limited** (supra), the Hon'ble Supreme Court has held that where actual infringement is established, that alone may justify an injunctive relief and a plaintiff is not expected to wait for further acts of defendant.

59. We are of the opinion that the plaintiff has shown likelihood of confusion and deception, probability of consumer



confusion and all this shall cause inconvenience and loss to the plaintiff. In our opinion, the refusal to grant injunction is likely to cause irreparable loss to the plaintiff's goodwill, therefore, the balance of convenience lies in favour of granting injunction.

**60.** Further, this Court finds that the use of the trademarks in question by the defendant would also lead to dilution of the plaintiff's brand identity. It is likely to cause deception of public which could be inherently difficult to quantify and the remedy of damages would be inadequate. Keeping in view the judgments of the Hon'ble Supreme Court, this Court would further record that even public interest warrants injunctive relief to prevent confusion or deception in the mark.

**61.** For all the aforesaid reasons, this Court sets aside the impugned order dated 16.11.2024 passed by the learned Principal District Judge-cum-Commercial Court, Patna in Commercial Dispute Case No. 02/2023 and allows the interim/ad-interim injunction on the petition dated 08.12.2023 filed by the plaintiff-appellant.

**62.** By way of ad-interim injunction, this Court restrains defendants, their directors, investors, officers, employees, delegates, dealers, distributors, retailers, stockists, representatives, assignees, associates, agents and all others acting for and on their behalf from offering for advertisements, manufacturing, offering for sale, stocking, adopting, using, and/or dealing in any manner



with the trademark “JOHNSON” with prefixes and suffixes or any other trademark identical or deceptively similar to the plaintiff’s trademark label/logo/name/trade dress and wrapper.

**63.** The learned Commercial Court is directed to expedite the hearing of the suit.

**(Rajeev Ranjan Prasad, J)**

**(Praveen Kumar, J)**

Rishi/-

<b>AFR/NAFR</b>	AFR
<b>CAV DATE</b>	18.03.2026
<b>Uploading Date</b>	25.04.2026
<b>Transmission Date</b>	25.04.2026

