

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 24.06.2015

CORAM:

THE HONOURABLE MRS.JUSTICE S.VIMALA

Civil Suit No.791 of 2013

Schwan-STABILO Schwanhaeusser GMBH & Co. KG,
Schwanweg 1
90562 Heroldsberg
Germany

... Plaintiff

vs.

Luxor Writing Instruments Pvt. Ltd.,
Having its registered office at:
5, Okhla Industrial Estate, Phase III,
New Delhi- 110 020
and also,
manufacturing address at:
867 Udyog Vihar, Phase-V,
Gurgaon - 122 016, Haryana,
and also,
Branch Office at:
No.9A & B, No.37 PM Tower,
9th Floor, near IDBI Bank,
Greens Road, Thousand Lights,
Chennai - 600 006

... Defendant

This Civil Suit filed under Order IV Rule 1 of the Original Side Rules read with Order VII Rule 1 of the CPC and Sections 27, 134 and 135 of the Trade Marks Act, 1999, praying for a decree and judgment for:

a) Permanent injunction restraining the defendant, its agents, servants, representatives and/or any one claiming through or under them, from violation of plaintiff's trademark 'POINT 88' by passing off stationery products, including writing instruments, under the Trademark 'POINTO 80' and/or its variants or any

other identical, similar or closely resembling or deceptively similar mark as that of the plaintiff's trademark 'POINT 88'.

b) Permanent injunction restraining the defendants, its agents, servants, representatives and/or any one claiming, through or under them, from using colourable imitation and passing off of the Trade Dress, being the unique hexagonal shape and the striped edges across the length of the pen, the unique ventilated hexagonal shape of the cap being of the same colour as the colour of the ink of the pen, adopted by the plaintiff in respect of writing instruments bearing Trademark "POINT 88" and "PEN 68".

c) Permanent injunction against the defendant, its agents, servants, representatives and or any one claiming through or under them from infringing the copyrights and/or 'passing off' its packaging, labels and advertisement material under colourable imitation and violation of plaintiff's packaging, labels and advertisement material respectively in respect of the stationery products bearing Trademark 'POINT 88', directly or indirectly, identical or similar, by means of a mark as that of 'POINT 80' and/or its variants or any other identical, similar or closely resembling or deceptively similar Mark as that of the plaintiff's 'POINT 88';

d) direction to the defendant to render their true and faithful books of account along with their annual statement on turnover before this Court and be made liable to pay to the plaintiff accordingly all the profit earned by the use of such a similar mark violating the

plaintiff's rights and interest;

e) direction to the defendant, its agents, servants, representatives and or any one claiming through or under them to deliver to the plaintiff all the writing instruments, papers, brochures, labels, pamphlets, advertisement material and stationery bearing the impugned Mark 'POINTO 80' and/or its variants or any other identical, similar or closely resembling or deceptively similar thereto and the Trade Dress adopted by the plaintiff in respect of the stationery products bearing Trademark 'POINT 88' and 'PEN 68' for destruction; and

f) the costs of the suit.

For Plaintiff : M/s.Surana & Surana
For Defendant : No Appearance

J U D G M E N T

The plaintiff has filed the suit seeking relief of injunction restraining the defendants/agents/servants/representatives /claiming under the defendant, from using the Trade Mark "POINT 88" and by passing off stationery products, including writing instruments under the Trade Mark "POINTO 80" and/or its variants or any other identical similar or deceptively similar mark as that of plaintiff's Trade Mark "POINT 88" and for other incidental reliefs.

Brief facts:

2. The Plaintiff is a world renowned company in the business of dealing in stationery goods for more than 150 years. Some of the legendary examples of innovations by Plaintiff include the first coloured copying pencil, which was introduced in the market in 1875, first eye-brow pencil in 1927, the launch of 'STABILO BOSS' highlighter in 1971, which continues to remain the world's best-selling highlighter.

2.1. The products of the Plaintiff are available in India since late 1970's through their authorized agents and distributors.

2.2. The plaintiff is the Registered Proprietor of Trade Mark 'POINT 88' as well as its Trade Dress in many jurisdictions across the world, *inter alia*, including Algeria, Austria, etc.,

2.3. 'POINT 88' has unique and inherently distinct Trade Dress features, like the hexagonal shape and orange coloured shaft with white striped edges across the length of the pen, and metal enclosed tip for a long life-span, long cap-off time, hexagonal ventilated cap, cap and bottom cover of the same color as the color of the ink. Erring the popularity and innovative design, "POINT 88" was exhibited and stored as popular historical innovation

in the "Neue Ausstellung im Neuen Museum", Germany.

2.4. In India, the product and Trade Dress, viz., hexagonal shape, orange coloured shaft with white striped edges across the length of the pen with the word mark 'POINT 88' has been applied for Registration vide Trade Mark Application No.2356422 under Class 16. The word mark 'POINT 88' bearing Trade Mark Application No.2494324 for Class 16 is also pending registration. So too in respect of 'PEN 68', the product and Trade Dress have been sought statutory protection vide Trade Mark Application Nos.2356423, 2356424 & 2356425 under Class 16.

2.5. On account of priority in adoption and use, Trade Mark 'POINT 88' and Trade Dress of Plaintiff's POINT 88, are well known, and are entitled for utmost protection.

2.6. The plaintiff's 'POINT 88' has claimed over 51% market share in the writing instruments segment in Europe in the fiscal year 2011-12.

Infringement by Defendant

3. In the month of September 2013, in course of its periodic discussions on brands and status check of Trade Marks filed in India, Plaintiff learnt from their Attorneys that the defendant has applied for Registration

of Trade Mark 'POINTO 80' on 'proposed-to-be-used basis' bearing TM App. No.2402313 under Class 16, that is closely resembling Plaintiff's 'POINT 88'.

3.1. Upon market survey, the plaintiff was informed about a Fine Liner pen 'POINTO 80' of the defendant being made available in different parts of India, including at Chennai. Upon purchase of Defendant's product 'POINTO 80' from a store in Chennai, the Plaintiff found that not only the mark was deceptively similar to Plaintiff's 'POINT 88' but also the unique features of Plaintiff's products 'Trade Dress' too have been slavishly imitated by the defendant.

3.2. Even though both could be compared in terms of name, nature, shape, description, packing, aesthetics, description and label colour of the pen, it is enough if the essential and important features are compared and evaluated.

Plaintiff's Trade Mark
POINT 88

Defendant's Trade Mark
POINTO 80

Comparison of features : Plaintiff vis-à-vis the Defendant product

Features	POINT 88	POINTO 80
Nature of the pen	Fine Liner 0.4mm	Fine Liner 0.4mm

Shape of the pen	Hexagonal; with hexagonal cap; cap and bottom cover, being the same color as color of the ink.	Hexagonal; with hexagonal cap; cap and bottom cover, being the same color as color of the ink.
Aesthetics	Uni-colour striation on edges across the length of the pen Uni-colour on the shaft of the pen	Uni-colour striation on edges across the length of the pen Uni-colour on shaft of the pen

3.3. It is the case of the plaintiff that the trademark of the plaintiff 'POINT 88' and Trade dress has worldwide registration and it has its own popularity and trans border reputation, recognition on account of quality, long continuous and prior use.

3.4. The defendant was aware of the plaintiff, their product, their brand, Trade Dress, and also the recognition, repute and goodwill of the brand 'POINT 88' prior to their adoption of the impugned Mark 'POINTO 80'. Despite knowing to be exclusive indicators of the plaintiff's product, the defendant has still opted to thrive its business on Plaintiff's efforts, repute and goodwill in the Trade Mark 'POINT 88' usurping its unique Trade Dress and other features stated above.

3.5. The defendant, being aware of the plaintiff's well known mark and product 'POINT 88', has adopted and used closely resembling mark 'POINTO 80' for similar business to parasitically thrive, sustain their existence and 'pass-off' their goods by closely piggy-riding under the illustrious well known mark 'POINT 88' at the efforts and expense of the plaintiff.

3.6. The impugned Trade Mark of the defendant in all likelihood would cause confusion and deception amongst public, patrons, travelling businessmen and customers of plaintiff who have known, utilized and/or patronized Plaintiff's products over decades.

3.7. Such an act of the defendant also amounts to flagrant violation of rights vested in the Plaintiff as well as contrary to fair trade and business ethics.

3.8 Hence the Plaintiff claims relief in respect of 'passing off' of goods under the Trade Mark "POINT 88" and Trade Dress, by the defendant or by unauthorized entities and persons.

4. The owner of the registered trademark may commence legal proceedings and seek for two types of remedies depending upon the nature of the trademark he possessed, namely, an action for infringement in the case

of registered trademark and an action of passing off in the case of unregistered trademark. While action for infringement is a statutory remedy, the action for passing off is a common law remedy. In an action involving both, the Court may grant relief and monetary compensation for damages for loss of business and/or confiscation / destruction of the infringing labels etc.,

5. The three fundamental elements of passing off are Reputation, Misrepresentation and Damage to goodwill. These three elements are also known as the CLASSICAL TRINITY, as restated by the House of Lords in the case of **Reckitt & Colman Ltd V Borden Inc, reported in [1990] 1 All E.R. 873**. It was stated in this case that in a suit for passing off the plaintiff must establish firstly, goodwill or reputation attached to his goods or services: Secondly he must prove a misrepresentation by the defendant to the public i.e. leading or likely to lead the public to believe that the goods and services offered by him are that of the plaintiff's and lastly he must demonstrate that he has suffered a loss due to the belief that the defendant's goods and services are those of the plaintiff's.

6. The plaintiff has established its goodwill and reputation in the business through documentary evidence (Exs.A-7, A-15 to A-17). The attempt and attitude of the defendant and their interest in applying unfair trade practice would be evident through the adoption of the similar name and trade dress as that of the plaintiff. Therefore, the case of the plaintiff that he has suffered loss on account of the use of the deceptively similar product by the plaintiff must be accepted as true and correct. Thus, the plaintiff is entitled to the relief as prayed for.

7. In the result, the suit is decreed as prayed for with costs.

sd/.S.V.J

24.06.2015

//Certified to be a true copy//

Dated this the day of 2015.

R.s/30.09.2015

COURT OFFICER

From 25.09.2008 the Registry is issuing certified copies of the Order/Judgment Decree in this format.