



C.S.No.334 of 1998

IN THE HIGH COURT OF JUDICATURE AT MADRAS

Dated : 01.08.2024

CORAM

THE HONOURABLE Mr. JUSTICE P.VELMURUGAN

C.S.No.334 of 1998

Needle Industries (India) Ltd.,
A3, DBS PAXINA
10, Bishop Waller Avenue South
Mylapore, Chennai – 600 004.

... Plaintiff

Vs.

1. Sanjai Jaiswal, trading as :
Super Thread Industries
D-12/3, Nichi Bramhpuri
Kotwalpura, Bansfatak
Varanasi, U.P.State.
2. Sanjeev Kumar Deepak Kumar
a partnership firm rep.by
its partner Sanjeev Kumar
CK 45/5, Raja Darwaja
Varanasi, U.P.State
Pin Code – 221 001.
3. Sanjeev Kumar
Partner
Sanjeev Kumar Deepak Kumar
CK 45/5, Raja Darwaja
Varanasi, U.P.State Pin Code – 221 001.
4. Deepak Kumar



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Partner
Sanjeev Kumar Deepak Kumar
CK 45/5, Raja Darwaja
Varanasi, U.P.State
Pin Code 221 001.

... Defendants

Civil Suit has been filed under Order IV of High Court Original Side Rules, 1994 and Order VII Rule I of Civil Procedure Code, 1908 and Sections 27, 105 and 106 of Trade and Merchandise Marks Act, 1958 and Sections 55 and 62 of Copyright Act, 1957, prays for a judgment and decree for :

(a) granting a permanent injunction, restraining the defendants, by themselves or through their servants, agents, representatives or anyone claiming through them, from reproducing, publishing, printing or causing to publish or using in any manner or in any material form or on any goods, the impugned artistic work shown in Document No.11 or any other artistic work, which contains a reproduction of the whole or any portion of the plaintiff's work "PONY & DEVICE" artistic work displayed in Document No.2 or in any manner infringing the copyright of the plaintiff;

(b) granting a permanent injunction restraining the defendants and their servants, agents, representatives, or anyone claiming through them,



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from manufacturing, selling offering for sale or advertising for sale their Yarn & Thread and other similar goods using the trademark "PONY & DEVISE" and / or the impugned trademark devices as shown in Document No.11, or any other trademark, identical or deceptively similar to the plaintiff's trademark "PONY & DEVICE", as shown in document No.1, 4 and 5 and passing-off or enabling others to pass-off the defendant's goods as and for those of the plaintiff's goods;

(c) directing the defendants to surrender to the plaintiff all the representations in any material form and all their goods, packaging materials, cartons, sales promotion material, advertising material and hoardings, letter-heads, visiting cards, office stationery and all other materials containing / bearing the trademark "PONY & DEVICE" and or the trademark/artistic works as shown in document No.11 to the plaintiff for destruction;

(d) for a preliminary decree in favour of the plaintiff, directing the defendants to render an account of profits made by them by the use of the trademark "PONY & DEVICE" and the trademarks / artistic works shown in Document Nos.1, 2, 4 & 5 or on any of their goods, or in any manner



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and a final decree in favour of the plaintiff for the amount of the profit found to have been made by the defendants after the defendants have rendered accounts; and

(e) directing the defendants to pay to the plaintiff the costs of the suit .

For Plaintiff : Ms. Gladys Daniel

For Defendants : Ms. Nandini Murali
for D1 and D2

D3 and D4 set *ex-parte*
on 08.12.2008

J U D G M E N T

This Civil Suit has been filed seeking for (i) permanent injunction, restraining the defendants, by themselves or through their servants, agents, representatives or anyone claiming through them, from re-producing, publishing, printing or causing to publish or using in any manner or in any material form or on any goods, in respect of the impugned artistic work shown in Document No.11 or any other artistic work, which contains a re-production of the whole or any portion of the plaintiff's work "PONY & DEVICE" artistic work displayed in Document



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No.2 or in any manner infringing the copyright of the plaintiff; (ii) permanent injunction restraining the defendants and their servants, agents, representatives, or anyone claiming through them, from manufacturing, selling, offering for sale or advertising for sale of their Yarn & Thread and other similar goods using the trademark "PONY & DEVICE" and / or the impugned trademark devices, as shown in Document No.11, or any other trademark, identical or deceptively similar to the plaintiff's trademark "PONY & DEVICE", as shown in Document Nos.1, 4 and 5 and passing-off or enabling others to pass-off the defendant's goods as and for those of the plaintiff's goods ; (iii) directing the defendants to surrender to the plaintiff all the representations in any material form and all their goods, packaging materials, cartons, sales promotion material, advertising material and hoardings, letter-heads, visiting cards, office stationery and all other materials containing / bearing the trademark "PONY & DEVICE" and or the trademark/artistic works, as shown in Document No.11 to the plaintiff for destruction; (iv) for a preliminary decree in favour of the plaintiff, directing the defendants to render an account of profits made by them by the use of the trademark "PONY & DEVICE" and the trademarks / artistic works shown in



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Document Nos.1, 2, 4 & 5 or on any of their goods, or in any manner and a final decree in favour of the plaintiff for the amount of the profit found to have been made by the defendants after the defendants have rendered accounts; and (v) directing the defendants to pay to the plaintiff the costs of the suit .

2. The brief facts, in nutshell, are thus :-

2.1. The plaintiff/Company is in the field of manufacturing and marketing of all kinds of knitting and sewing accessories including varieties of needles, knitting pins and threads etc., From 1967, the plaintiff had adopted a trademark PONY & DEVICE, which was registered in respect of goods in Class 26 of the Trade Marks and Merchandise Act, 1958. Application for registration in respect of the goods under Class 23 includes items like sewing thread, yarn etc., was made on 20.02.1995. The PONY labels incorporating device of a pony as well as the word is used in the wrappers and other packaging materials. The plaintiff has been using PONY labels in a distinctive colour scheme of green, beige, black, yellow, pink, magenta, white and red in connection with their goods, since 1978. The said mark is used by the



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plaintiff extensively within India and in about 70 countries around the world, on their products. The plaintiff/Company had also obtained registration of this mark in about 67 different countries. The plaintiff has also received awards for outstanding exports in respect of its products from the Government every year for the past 20 years. They have spent large sums of money for the sales promotion of its products and has been advertising in National and International magazines. They have sales office in over 19 centres in India and about 6000 dealers all over India. The plaintiff has earned valuable National and International reputation and goodwill for the PONY label. The trademark PONY & DEVICE has attained the status of the trusted mark in the eyes and minds of the public.

2.2. In or about July, 1997, the plaintiff learnt through an advertisement in the Trademarks Journal No.1155, dated 16.7.1997 that the first defendant had applied for registration of the trademark PONY label in Class 23 relating to Yarns and threads. The first defendant has claimed to be the prior user through-out India and sought for registration. On coming to know of this publication, the plaintiff at once made arrangements to file their opposition within the stipulated time and this



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was also taken on record by the Registry of the Registrar of Trademark, New Delhi. The plaintiff was under the bona-fide impression that the first defendant would give up the use of the impugned trademark. However, contrary to the expectation, the defendants have decided to adopt a divergent stand and have continued to use the offending mark and they are making clandestine sales in several places.

2.3. The second defendant/Firm has been appointed as a stockist of the first defendant. Defendants 3 and 4 are partners of the second defendant. The second defendant, who is a dealer of the plaintiff for several years, has apparently been instrumental in dealing with the spurious products passed-off under the label bearing a mark similar to that of the plaintiff. Every seller is bound to give a warranty that its trademark used on the label are genuine. The plaintiff is also the owner of the copyright in a distinctive and artistic work PONY LABEL. The copyright has been registered as an artistic work under the Copyright Act, 1957. Even prior to that, the plaintiff had used the said artistic work right from 1967. The defendants' PONY label with the layout, design, get-up and border, designed to make it appear visually similar to the plaintiff's



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registered copyright in the artistic work. The defendants do not have any licence agreement with the plaintiff. The goods passed-off by the defendants are inferior to that of the plaintiff's goods. The plaintiff's use of the mark in respect of cognate goods, are sufficient for filing this suit for passing-off. The infringement of the copyright is also a criminal offence.

3. Defendants 3 and 4 were set *ex-parte* on 08.12.2008. Defendants 1 and 2 have not chosen to file written statement, but they have filed a memo dated 28.07.2021 seeking to adopt the counter affidavit in O.A.Nos.212 and 213 of 1998 as written statement of the defendants 1 and 2 and the same was taken on file by this Court on 02.08.2021. In the counter affidavit, the defendants 1 and 2 denied the various averments made in the plaint. According to them, no part of the cause of action had arisen within the jurisdiction of this Court. The suit instituted by the plaintiff is a fraudulent piece of litigation. Apart from material suppressions, the plaintiff has gone to the extent of misusing and abusing the judicial process. Shri.Devbanshi has principal place of trading business at Varanasi in the State of Uttar Pradesh. The defendants



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had created sales net work to push sales in and outside Uttar Pradesh, as and when orders were received from other parts of the country. The plaintiff ought to have filed the suit either at Varanasi or at the High Court of Allahabad. The plaintiff is a Limited Company and has wide net works of sales activities. The plaintiff's registered office is located outside the jurisdiction of this Court and this suit is filed with a view to harass the second defendant. Therefore, the suit is liable to be dismissed in-limine in the absence of any leave obtained by the plaintiff. The plaintiff was never in the line of business of textile items prior to 1995. The plaintiff, all along knew that the second defendant had been the dealer of products classified in Class 26 and also marketed the products of the first defendant which are completely different items. The matter is under consideration of the Registrar of Trademarks and the plaintiff as well as the first defendant are parties. The plaintiff cannot jump on any conclusion as to whether the Registrar would allow exclusive rights to it. There is absolutely no case made out for infringement of copyright or passing-off. The plaintiff has by-passed the judicial process and by suppressing the material facts, they had obtained interim order. The damage done to the reputation and goodwill by the plaintiff, cannot be



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compensated in any terms.

4. Upon hearing the learned counsel for the parties, the following issues are framed by this Court on 26.08.2021 :

i) *Whether the plaintiff is the prior user of the trademark "PONY"?*

ii) *Whether the use of the trademark "PONY" by the defendant amounts to passing-off ?*

iii) *Whether the user by the defendant is bonafide ?*

iv) *Whether the claim of confusion could be sustained in the light of the fact that the parties are trading in different goods ?*

v) *Whether this Court has got jurisdiction to entertain the suit ?*

vi) *Whether the suit is liable to be dismissed on the ground of acquiescence ? and*

vii) *To what other reliefs the parties are entitled to ?*

5. On the side of the plaintiff, the Senior Divisional Sales Manager



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of the plaint/Company, Mr.Peppin Machado was examined as P.W.1, and Exs.P1 to P16 were marked through him.

6. Defendants 1 and 2 have not chosen to file written statement within a reasonable time and thereafter, a memo dated 28.07.2021 was filed seeking to adopt the counter in O.A.Nos.212 and 213 of 1998 as written statement of the defendants 1 and 2 and the same was taken on file by this Court on 02.08.2021. Thereafter, issues were framed by this Court on 26.08.2021. This Court, vide order dated 16.11.2021, held that there is no requirement for recording oral evidence and the matter has been posted before the learned Additional Master - II for marking of documents on the side of the plaintiff. Accordingly, on 07.12.2021, the plaintiff marked 16 documents as Ex.P1 to Ex.P16 and the matter was posted before this Court at the request of defendants' side for receiving additional documents. Thus, the first defendant filed A.No.4571 of 2021 seeking to bring on record certain additional documents and the same was allowed by this Court on 09.12.2021 by imposing costs of Rs.30,000/- to be paid to the Tamil Nadu State Legal Services Authority. Subsequently, 1st defendant had filed yet another application in A.No.264 of 2022



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seeking to permit him to file an additional written statement in the above suit, which came to be dismissed by this Court on 15.03.2022. The suit was thereafter directed to be listed before the learned Master for continuation of trial. Though the defendants have been continuously seeking time to let in evidence, the matter was posted before this Court for non-adherence of the Case Management Schedule. Again, this Court re-fixed the Case Management Schedule and posted the matter before the learned Master for filing Proof Affidavit and marking of documents by D.W.1. However, the defendants 1 and 2 have failed to adhere to the said schedule, and the matter has been posted before this Court. In the meanwhile, the first defendant filed an application in A.No.731 of 2024 seeking permission of this Court to let in evidence through videoconferencing in the suit and this Court, vide order dated 12.02.2024, directed the learned Additional Master-II to complete recording of defendants' side evidence through videoconferencing. However, due to non-cooperation of the defendants, again the matter was posted before this Court. Despite sufficient opportunity given to the defendants to adduce evidence, they have not taken any effective steps for examination of their witnesses. Hence, the defendants' side evidence was closed, vide



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order dated 11.06.2024. Thereafter, again the first defendant filed applications in A.Nos.3047 and 3048 of 2024 seeking to re-open the evidence of the defendants and to recall the defendants' side witness i.e., D.W.1. Despite sufficient opportunities having been provided to the defendants 1 and 2 since 2021, to adduce oral evidence, they failed to file proof affidavit and mark documents. Instead, the defendants 1 and 2 had been unnecessarily dragging on the subject matter by filing frivolous applications since 2021, causing prejudice to the plaintiff. Hence, this Court, vide order dated 27.06.2024, dismissed the said applications by granting liberty to the defendants to file their written submissions. However, the defendants have not filed their written submissions also till date.

7. Today, when the matter is taken up for hearing, the learned counsel appearing for defendants 1 and 2 submitted that defendants 1 and 2 have filed an application for filing additional documents before this Registry, however, as on date, no such application is pending before this Court. The suit is of the year 1998, and for the past 25 years, despite numerous and sufficient opportunity having been provided to the



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defendants 1 and 2 to defend their case, in every stage, the defendants 1 and 2 have protracted the case in one way or the other, without any valid reason. Today, when the matter is taken up for hearing, the learned counsel for the defendants 1 and 2 is on videoconferencing platform and sought time for making her submissions.

8. Considering the age of the case and as seen from the orders passed by this Court and also the proceedings of the learned Master, the defendants 1 and 2 have been continuously protracting the case in one way or the other. In every stage, due opportunity was given to the defendants 1 and 2 to defend their case on merits, but without utilizing the same, they are prolonging the suit. Therefore, this Court is inclined to dispose of the suit on merits, after hearing the arguments of the learned counsel for the plaintiff.

9. Learned counsel for the plaintiff submitted that the plaintiff/Company is in the field of manufacturing and marketing of all kinds of knitting and sewing accessories, including varieties of needles, knitting pins, threads, etc. since 1949. Owing to their reputation earned



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over the years, in 1967, the plaintiff adopted the trademark PONY along with its unique device (Ex.P13) and have acquired the suit subject copyright registration. The plaintiff also acquired trademark registration under No.273295 for the mark PONY and its Device under Class 26 as in Ex.P2. Application for registration in respect of the goods under Class 23 includes items like sewing thread, yarn, etc., and the plaintiff applied for it on 20.02.1995. All the said registrations are valid and subsisting. She further submitted that in July, 1997, the plaintiff came across an advertisement of the first defendant's impugned trademark PONY label (Ex.P12) under application No.495663 in Class 23 in the Trademark Journal No.1155 dated 16.07.1997 (Ex.P.8). The first defendant has claimed prior user right through-out India and sought for registration. On coming to know of this publication, the plaintiff immediately made arrangements to file their opposition by filing form TM-5 (Ex.P9) under the bona-fide impression that the first defendant would give up the use of the impugned trademark and label. The second defendant was an agent of the plaintiff and was marketing their needles for a long period from 1983 and the plaintiff's invoices in favour of the second defendant are marked as Ex.P.4. Since the first defendant continued to infringe the plaintiff's



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copyrighted label, the plaintiff filed the present suit.

10. Heard the learned counsel appearing for the plaintiff and perused the materials available on record.

11. Issue No.1 : Whether the plaintiff is the prior user of the trademark "PONY" ?

11.1. The specific case of the plaintiff/Company is that the principal business of the plaintiff is in the field of manufacturing and marketing of needle of various descriptions. The plaintiff's manufacturing operations date back to 1949. The plaintiff, until 1982, was known as Needle Industries (India) Limited. It was converted into a private limited Company on March 8, 1982 and thereafter, it came to be known as Needle Industries (India) Pvt.Ltd. On 30.06.1988, it was re-converted into a Public Limited Company. The plaintiff/Company, in the course of their business, from 1967 onwards, had adopted the trademark PONY & DEVICE, which was registered in respect of goods in Class 26. The plaintiff /Company had also obtained registration of the mark in various



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other countries. They have spent huge amount for promotion of sale of the product and advertised in National and International magazines. The trademark had attained the status of trusted mark in the eyes and minds of the public. During July, 1997, the plaintiff/Company came to know through advertisement in the Trademark journal that the first defendant had applied for registration of the trademark PONY label in Class 23 relating to Yarns and threads. The first defendant has claimed right of prior user through-out India and sought for registration. The plaintiff/Company filed the opposition before the Registrar of Trademarks, New Delhi. The second defendant, who is a dealer of the plaintiff/Company for several years, has apparently been instrumental in dealing with the spurious products passed-off under the label bearing a mark similar to that of the plaintiff. The plaintiff is also the owner of the copyright in a distinctive and artistic work and registered the artistic work under Copyright Act, 1957. Even prior to that, the plaintiff had used the said artistic work right from 1967. The defendants' PONY label with the lay-out, design, get-up and border, is designed to make it appear visually similar to the plaintiff's registered copyright in the artistic work. The



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defendants do not have any licence agreement with the plaintiff had passed-off the goods as that of the plaintiff's goods, and in view of the infringement of the copyright of the plaintiff and also from passing-off the goods, the present suit has been filed.

11.2. In order to prove the case of the plaintiff, the Senior Divisional Sales Manager of the plaintiff/Company, Mr.Peppin Machado was examined as P.W.1, and Exs.P1 to P16 were marked through him. Ex.P.2 is the photocopy of the plaintiff's trademark registration under Class 26 and renewals dated 07.07.1971 and Ex.P.3 is the photocopy of Copy Right Registration Certificate.

11.3. On a perusal of Ex.P.2 and Ex.P.3, it is seen that the plaintiff/Company has proved that they had registered the trademark PONY & DEVICE way back in 1971 onwards, whereas, from Ex.P.8 photocopy of the publication dated 16.07.1997 of the first defendant's trade mark in Journal, it is seen that the first defendant has claimed right of prior user through-out India and sought for registration in the year



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1987 onwards.

11.4. From the pleadings and documentary evidence, this Court finds that the plaintiff/Company is the prior user and has shown the user of the trademark "PONY" even in 1971 itself. This issue is thus answered accordingly in favour of the plaintiff.

12. Issue No.2 : Whether the use of the trademark "PONY" by the defendants amounts to passing off ?

12.1. There is no dispute that the plaintiff/Company is the manufacturer of needles of various descriptions and from 1967 onwards, they had adopted the trademark "PONY & DEVICE", which was registered in respect of goods in Class 26. The registration of the trade mark is dated 07.07.1971, as seen from Ex.P.2 and they have also registered the artistic work under Copyright Act, 1957. The plaintiff enjoys an exclusive statutory right over the label in Ex.P.13 as the owner of its copyright and trademark. The first defendant is in the business of manufacturing sewing threads and yarns and they are the subsequent adopters of PONY label in the year 1987 onwards, which is evident from



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Ex.P.8/Journal Publication, dated 16.07.1997.

12.2 It is the contention of the plaintiff that the second defendant was an agent of the plaintiff and marketing the plaintiff's needles from the year 1983. Thereafter, the second defendant was appointed as a stockist of the first defendant. The first defendant, under the wrongful influence of the second defendant, adopted the impugned trademark PONY with deceptively similar lay-out, design, get-up and border, designed to make it appear visually similar to the plaintiff's registered copyright in the artistic work, with a view to trade upon the good-will and reputation enjoyed by the plaintiff. Further, the defendants do not have any licence agreement with the plaintiff. The goods passed-off by the defendants, are inferior to that of the plaintiff's goods. It is the further contention of the plaintiff that needles and threads are cognate goods and are sold through the same trade channels. Therefore, the use of the plaintiff's prior and registered trademark "PONY" along with an identical device by the defendants, clearly amounts to passing-off.

12.3. The suit came to be filed in the year 1998. From the



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documentary evidence, it is crystal clear that the plaintiff/Company has proved that they are the prior user of the said trademark "PONY & DEVICE". However, the defendants have not let in any oral and documentary evidence that they are the genuine proprietor of the said impugned trademark. Therefore, from the documentary evidence, this Court finds that the plaintiff/Company has proved their use of the trademark "PONY" by the defendants, which amounts to passing-off. This issue is answered accordingly in favour of the plaintiff.

13. Issue No.3 : Whether the user by the defendants is *bona-fide* ?

13.1. According to the plaintiff, the plaintiff/Company enjoys an exclusive statutory right over the label "PONY & DEVICE" as the owner of its copyright and trademark, whereas, the first defendant chose to adopt the exact same word and device that belongs to the plaintiff with respect to their products in the year 1987. Further, the second defendant being the previous dealer of the plaintiff and thus, being well aware of the good-will and reputation attached to the plaintiff's mark PONY label, has



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sought to take an undue advantage of the plaintiff's acquired registered trademark. The conduct of the defendants in copying all the peculiar features of the plaintiff's registered label, is an unwarranted usage and it cannot be an innocent coincidence, but a conscious and continuous effort by the defendants to ride upon the plaintiff's existing reputation and goodwill. The defendants are knowingly violating the plaintiff's statutory right. The said adoption by the defendants, is dis-honest and mala-fide.

13.2. Admittedly, the plaintiff/Company registered the trademark "PONY & DEVICE" in the year 1971 itself, which is clearly proved from Ex.P.2 and Ex.P.3. However, there are no materials to show that the defendants are using the trademark "PONY" earlier to that the plaintiff. On a reading of documentary evidence, this Court does not find any reason that the defendants have shown any valid or *bona-fide* reason to use the trademark of the plaintiff and also the materials, which are manufactured. Therefore, the use of the impugned mark by the defendants, is not *bona-fide*. This issue is answered in favour of the plaintiff.



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14. Issue No.4 : Whether the claim of confusion could be sustained, in the light of the fact that the parties are trading in different goods ?

14.1. According to the plaintiff, they are the large manufacturer of needles of various descriptions and they had adopted the unique mark "PONY & DEVICE" along with the distinctive label in 1967, which was registered in respect of goods in Class 26 and the copyright has been registered as an artistic work under the Copyright Act, 1957, whereas, the first defendant adopted the same mark "PONY" with deceptively similar label and using the same from 1987 on wards.

14.2. It is the contention of the learned counsel for the plaintiff that the second defendant, who was the previous dealer of the plaintiff/Company was marketing the plaintiff's needles for a long period from 1983. While the things stood thus, the first defendant, under the wrongful influence of the second defendant, adopted the label mark which is deceptively similar to that of the plaintiff's registered label and are manufacturing threads. Soon after it came to the knowledge about the



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same, the plaintiff has filed the present suit against the defendants for infringement and passing-off.

14.3. Per contra, it is the contention of the defendants that they are manufacturing the thread which was registered in respect of goods in Class 23 of Yarns and threads. The plaintiff also admitted that initially, they were manufacturing needles, but in the year 1995 onwards, they are manufacturing threads also. Thereafter, the plaintiff has done extensive business all over India continuously and substantially and are till now using the trade mark "PONY" and they are manufacturing and marketing needles and threads. The plaintiff states that the goods of the plaintiff and the defendants are not completely different, instead both are cognate goods sold through same trade channels. The claim of difference in the goods between the plaintiff's and defendants', does not legally sustain, owing to the definite cause of confusion. The main contention of the plaintiff is that goods passed-off by the defendants are inferior to that of the plaintiff's goods, which would spoil the reputation of the plaintiff/Company.



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14.4. The plaintiff has proved their case by oral and documentary evidence, whereas, the defendants have not produced any documents to show that both parties are trading in different goods. Though the defendants are also manufacturing needles, they have infringed the trademark product of thread and it cannot be stated that they are trading in different goods for the purpose of escaping liability under the Copyright and Trademark Acts. Since the plaintiff has stated that the defendants, without any *bona-fide* reason, damaged the reputation and good-will of the plaintiff, the claim of confusion raised by the plaintiff, is sustainable. This issue is answered in favour of the plaintiff.

15. Issue No.5 : Whether this Court has got jurisdiction to entertain the suit ?

15.1. Admittedly, the plaintiff/Company had adopted the trademark PONY & DEVICE, which was registered in respect of goods in Class 26 in the year 1971. The plaintiff has an exclusive right over the trademark PONY and also the artistic work of the label of the said mark, so as to exclude others from using the same or similar marks, which was



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established by the plaintiff by marking Ex.P.2 and Ex.P.3. Thus, the acts of the defendants amount to infringement and passing-off of the copyright of the plaintiff.

15.2. The plaintiff has its registered office at Mylapore, Chennai and the major cause of action has arisen within the jurisdiction of this Court. As per Section 134 of the Trademarks Act, this Court has jurisdiction to entertain this suit. This issue is answered accordingly.

16. Issue No.6 : Whether the suit is liable to be dismissed on the ground of acquiescence ?

16.1. The plaintiff has acquired the Copyright and Trademark registration for their unique label mark "PONY LABEL" adopted in 1967 and since then, the plaintiff has been continuously and uninterruptedly using the mark PONY, along with the device for their products, including different kinds of needles used for knitting and tailoring. The defendants adopted the impugned label mark for cognate goods and even applied for its trademark Registration under No.495663 in Class 23, which came to



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the knowledge of the plaintiff through the publication in the Trademarks Journal No.1155, dated 16.7.1997. Consequently, the plaintiff duly opposed the said registration. Thereafter, the plaintiff has preferred to file the present suit, as the defendants continued their infringing activities even after filing of the objection.

16.2. The main defence taken by the defendants in the counter affidavit is that the plaintiff came to know about the manufacturing of the thread under the Trademark Act of the defendants even much earlier. The plaintiff was well aware of the trademark of the defendants and the plaintiff also made objections for registration of the trademark of the defendants, however, the competent authority vide order dated 06.07.2000 has held that the first defendant is the genuine proprietor of the mark and they are the prior user and has shown the user of the trademark even in 1987 itself. However, that said order was not challenged by the plaintiff. The learned counsel for the plaintiff submitted that even though the defendants' trademark were also registered under the Trademarks Act in 1987, the plaintiff's trademark was registered in the year 1971 itself. The second defendant was the dealer of



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the plaintiff's products and, the plaintiff came to know about the infringement of the defendants under Ex.P.8. After coming to know about from the publication that the defendants are using the trademark, which is similar to that of the plaintiff's trademark, the plaintiff has filed the present suit. However, the defendants have not established that the plaintiff is well aware of the trademark of the defendants is much earlier, and despite that, the plaintiff/company has now alleged that the defendants are continuously using their trademark. However, the defendants have not established their case by way of oral and documentary evidence. In the absence of the same, this Court finds that the plaintiff has exhausted all available reasonable remedies to prevent the use of their mark by any third parties and the defendants impugned use could have only been known to the plaintiff through Ex.P.8 and not otherwise. This issue is answered in favour of the plaintiff.

17. Issue No.7 : To what other reliefs the parties are entitled to ?

17.1. In view of the answer to the issues 1 to 6 above, the plaintiff is entitled to get a decree as prayed for in the plaint.

18. In result, the suit is decreed with costs. The plaintiff is entitled to all the reliefs as sought for in the plaint. Consequently,



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connected, pending applications, if any are closed.

01.08.2024

Index: Yes/No

Speaking Order : Yes/No

Neutral Citation Case : Yes/No

ms

List of Witness examined on the side of the plaintiff

Peppin Machado - PW1

List of documents marked on the side of the plaintiff

SL. No	Exhibits	DESCRIPTION OF DOCUMENTS	DATED
1.	P1	Original Authorization letter	24.11.2021
2.	P2	Photocopy of the plaintiff's trademark registration under Class 26 and renewals	07.07.1971
3.	P3	Photocopy of Copyright Registration Certificate	
4.	P4	Photocopy of the plaintiff's invoices in favour of the second defendant on various dates	
5.	P5	Photocopy of the plaintiff's pending applications for Registration under Class 26	
6.	P6	Photocopy of the plaintiff's pending applications for registration under Class 23	
7.	P7	Photocopy of the plaintiff's invoices in respect of thread and yarn	
8.	P8	Photocopy of publication of 1 st defendant's Trademark in Journal	
9.	P9	Photocopy of objections filed by the plaintiff for the publication	
10.	P10	Photocopy of list of plaintiff's trademark registered in foreign countries	
11.	P11	Photocopy of plaintiff's catalogue & sales	



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		promotional material	
12.	P12	Photocopy of the defendants' impugned wrapper with impugned word and device	
13.	P13	Photocopy of the plaintiff's wrapper	
14.	P14	Photocopy of the Certificates of merit for outstanding export promotion received by plaintiff from 1974	
15.	P15	Photocopy of the advertisement made by the plaintiff to promote sales	
16.	P16	Photocopy of the sales effected by the plaintiff to countries abroad	

List of witnesses examined on the side of the defendants : Nil

List of documents marked on the side of the defendants : Nil

01.08.2024



WEB COPY



C.S.No.334 of 1998

P.VELMURUGAN, J

ms

C.S.No.334 of 1998

01.08.2024