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C.S.(Comm.Div) No.137 of 2022

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 16.12.2024

CORAM:

THE HON'BLE MR. JUSTICE ABDUL QUDDHOSE

C.S.(Comm.Div) No.137 of 2022

Poomex Clothing Company
(registered partnership firm),
Rep. By its Partner Mr.K.Rangasamy,
Tirupur.

... Plaintiff

Vs.

S.Thirumurugan,
Sole Proprietor M/s.Poomak,
Thanjur.

... Defendant

Prayer: Complaint filed under Order IV Rule 1 of the Original Side Rules and Order VII Rule 1 of the C.P.C. read with Sections 27, 28, 29, 134 and 135 of the Trademarks Act, 1999 and Section 63 of the Copyright Act, 1957 for

a) granting a permanent injunction, restraining the Defendant, by itself, its servants, agents, distributors, or anyone claiming through him from manufacturing, selling, advertising and offering for sale using same or similar trademark POOMAK or any other similar Trademark or in any signboard, media and use the same in invoices, letter heads and visiting cards or with respect to manufacturing and knit wear, hosiery, readymade garments, sportswear, is in any way visually or deceptively or



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phonetically similar to the plaintiff's registered trademark POOMEX in any manner whatsoever;

b) granting a permanent injunction, restraining the Defendant, by itself, its servants, agents, distributors, or anyone claiming through him from manufacturing, selling, advertising and offering for sale using same or similar trademark POOMAK or any other similar logo/label or in any signboard, media and use the same in invoices, letter heads and visiting cards in any manner visually or deceptively similar to the plaintiff's label/artistic work POOMEX;

c) a permanent injunction restraining the defendant, by himself, his partners, men, servants, agents, representatives or any one claiming through them from in any manner passing off and/or enabling others to pass off the defendant's product and services as and for the plaintiff's products and services by using, selling, or offering to sell, distributing, displaying, printing, advertising their products bearing the trademark POOMAK or any other mark identical or deceptively similar to the plaintiff's trademark POOMEX or with any prefix or suffix or in any other manner whatsoever;

d) the defendant be ordered to surrender to the plaintiff for destruction of all products, labels, dyes, blocks, moulds, screen prints, packing materials and other materials bearing the trademark POOMAK identical or deceptively similar to the plaintiff's trademark POOMEX;

e) The defendant be ordered and decreed to pay to the plaintiff a sum of Rs.25,00,000/- for acts of infringement of plaintiff's trademark and pass off their goods as that of the plaintiff; and

f) costs of the suit.



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For Plaintiff : Mr.R.Sathish Kumar

For Defendant : Mr.M.I.Mohammed Qays

JUDGMENT

This suit has been filed for infringement, passing off and for damages.

2. The plaintiff's trademark is 'Poomex' and the defendant's trademark is 'Poomak'. Admittedly, both the plaintiff as well as the defendant are in the same trade of selling inner garments. The plaintiff is having registration for their trademark 'Poomex' under Classes 24 and 25. They have been using the said trademark since 2003. The details of the trademark registrations obtained by the plaintiff have also been disclosed in the plaint. The details of the sales turn over of the plaintiff, which runs to several crores of rupees is also disclosed in the plaint. The advertisement costs incurred by the plaintiff for advertising their products under the trademark 'Poomex' is also disclosed in the plaint, which also runs to a huge amount.



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3. According to the plaintiff, they came to know recently that the defendant is using a deceptively similar trademark and selling undergarments by using the trademark 'Poomak'. A cease and desist notice was sent by the plaintiff on 18.03.2022 to the defendant calling upon them to stop using the deceptively similar mark 'Poomak'. A reply dated 26.03.2022 was also sent by the defendant to the said cease and desist notice. Since the defendant did not stop using the deceptively similar trademark, the plaintiff was constrained to file the present suit for infringement, passing off and damages.

4. A written statement has also been filed by the defendant denying the contentions of the plaintiff. The defences raised by the defendant as seen from the written statement are as follows:-

(a) The suit filed by the plaintiff has to be dismissed for want of jurisdiction, since, according to them, no part of cause of action has arisen within the jurisdiction of this Court.

(b) The defendant's trademark 'Poomak' is not deceptively similar to that of the plaintiff's trademark 'Poomex'. According to the defendant,



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their trademark is not phonetically similar to that of the plaintiff's trademark.

(c) A trademark by name 'Poomer' is already in the market and therefore, the question of the plaintiff's exclusive right to use the mark 'Poomex' does not arise.

5. Inadvertently, this Court did not frame issues earlier, but, allowed the parties to let in oral and documentary evidence. Therefore, necessarily, this Court will have to frame issues now. Based on the pleadings of the respective parties, the following issues are framed:-

- (a) Whether this Court is having territorial jurisdiction to decide the suit?
- (b) Whether the plaintiff is the registered proprietor of the trademark 'Poomex' with respect to goods under Class 25?
- (c) Whether the plaintiff is entitled to claim statutory and common law rights over the trademark 'Poomex'?
- (d) Whether the trademark 'Poomex' and 'Poomak'



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are deceptively similar to each other?

(e) Whether the plaintiff is entitled to claim reliefs as prayed for in the plaint, which includes the relief of damages as well?

(f) To what other reliefs?

6. Before the learned Additional Master - IV, High Court, Madras, Mr.C.Gokulakrishnan, Sales Manager of the plaintiff's firm, was examined as a witness (PW1) on behalf of the plaintiff. He has also filed a proof affidavit, reiterating the pleadings made in the plaint. Through PW1, the following documents were marked as exhibits:-

Ex.P1 is the original authorization letter dated 22.08.2023.

Ex.P2 is the photocopy of the certificate of Registration of Trademark POOMEX under application No. 1231782 in class 24 along with Legal User Certificate dated 31.05.2005.

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Ex.P4 is the photocopy of the IEC – Importer



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Ex.P19 is the photocopy of the plaintiff Chennai branch – Rent Agreement dated 14.10.2021.

Ex.P20 is the printout of the employees provident fund for the period January 2022.

Ex.P21 is the photocopy of the defendant – POOMAK purchase bill dated 28.02.2022.

Ex.P22 is the printout of the web extract of GST Registration particulars of the defendant dated



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02.03.2022.

Ex.P23 is the photocopy of the complaint letter received by plaintiff from one of their distributors dated 03.03.2022.

Ex.P24 is the photocopy of the purchase order copies received by the plaintiff for the period 08.03.2022 to 11.03.2022.

Ex.P25 is the photocopy of the “POOMEX” - Dealer Complaint letter against defendant dated 14.03.2022.

Ex.P26 is the original Chartered Accountant Turnover certificate dated 16.03.2022.

Ex.P27 is the photocopy of the Cease & Desist notice issued by the plaintiff along with postal acknowledgment dated 18.03.2022.

Ex.P28 is the original reply notice dated 26.03.2022.

Ex.P29 is the printout of the E-Register status of defendant's trademark application filed under No.5094313 in class 25 dated 14.04.2022.

Ex.P30 is the original defendant – POOMAK purchase bill dated 27.05.2022.

Ex.P31 is the printout of the entry extracts GST certificate with branch details dated 11.06.2022.

Ex.P32 is the printout of the defendant – POOMAK product and product box photographs.



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Ex.P33 is the photocopy of the caution notice
issued by plaintiff dated 23.06.2022.

7. The plaintiff's witness (PW1) was also cross-examined by the defendant's counsel. However, the defendant chose not to let in any oral evidence on their side.

8. With regard to territorial jurisdiction of this Court to decide this suit, the learned counsel for the plaintiff would submit that the plaintiff is having its office at Chennai and is also carrying on its business at Chennai. The infringed goods are being sold by the defendant at Chennai. However, to disprove the same, there is no contra evidence produced by the defendant. Hence, under Section 134 of the Trade Marks Act, 1999, this Court is having jurisdiction to decide the suit.

9. He would further submit that the trademark of the defendant 'Poomak' is deceptively similar to the plaintiff's registered trademark 'Poomex'. Both the marks are phonetically similar, hence, the defendant cannot be allowed to use the mark 'Poomak'. He would also submit that



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the defendant is also dealing with a similar product as that of the plaintiff, namely, manufacture and sale of undergarments. He would further submit that the plaintiff had filed an opposition petition before the Trademark Registry opposing registration of the trademark 'Poomak'. But, the defendant had not filed counter to the said opposition petition and hence, the Trademark Registry had passed an order stating that the request for grant of trademark registration for the mark 'Poomak' by the defendant has been abandoned. To substantiate his contentions, he drew the attention of this Court to the relevant documents as well as relevant orders passed by the Trademark Registry.

10. The learned counsel for the plaintiff also submits that with the consent of the plaintiff, the mark 'Poomer' is being used by one of the brothers of the partner of the plaintiff. He would also submit that as per the family arrangement, the plaintiff's partner's brother was allowed to use the mark 'Poomer' and therefore, the defence raised by the defendant in their written statement stating that a similar mark 'Poomer' is already in existence, has no value for the defendant's defence.



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11. The learned counsel for the plaintiff also drew the attention of this Court to the various registrations obtained by the plaintiff for its trademark 'Poomex' and also drew the attention of this Court to the relevant documents (exhibits) to substantiate the plaintiff's contention that they have been using the mark 'Poomex' from 2003 onwards. He would submit that since the mark 'Poomak' is deceptively similar to the plaintiff's registered trademark 'Poomex', which has acquired distinctiveness and is associated only with the plaintiff, the question of permitting the defendant to use the mark 'Poomak' does not arise. He would further submit that the trademark 'Poomex' has to be read as a whole and cannot be dissected. He would submit that 'Poomex' is an arbitrary word and has been coined only by the plaintiff and therefore, the same will have to be associated only with the plaintiff.

12. In support of his contentions, the learned counsel for the plaintiff drew the attention of this Court to the following authorities:-

(a) A judgment of the Hon'ble Supreme Court in the case of Parle Products (P) Ltd. Vs. J.P. And Co., Mysore [(1972) 1 SCC 618];



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(b) A decision of the Hon'ble Supreme Court in the case of Cadila Health Care Ltd. Vs. Cadila Pharmaceuticals Ltd. [AIR 2001 SC 1952]; and (c) a decision of the learned Single Judge of this Court in the case of Neuberg Hitech Laboratories Pvt. Ltd. Vs. Dr.Ganesan's Hitech Diagnostice Centre Pvt Ltd. (2022 SCC Online Mad 8779).

13. On the other hand, the learned counsel for the defendant would reiterate the contents of the written statement filed by the defendant, namely, (a) This Court does not have territorial jurisdiction to decide the suit, since no part of cause of action has arisen within the jurisdiction of this Court; (b) The mark 'Poomak' and 'Poomex' are not deceptively similar; and (c) The mark 'Poomer' is already in the market, and therefore, the question of stopping the defendant to use the mark 'Poomak' does not arise.

DISCUSSION:-

14. With regard to territorial jurisdiction of this Court, it is to be noted that the plaintiff is having its office at Chennai, within the jurisdiction of this Court, eventhough their principal place of business is



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elsewhere. The plaintiff has filed invoices raised by the defendant at Chennai, which would reveal that the defendant has been selling their products under the mark 'Poomak' at Chennai. In the cross-examination of the plaintiff's witness, they have not raised any question with regard to invoices, which were marked as exhibits on the side of the plaintiff. Therefore, the defence raised by the defendant in their written statement with regard to territorial jurisdiction of this Court cannot be sustained as per Section 134 of the Trade Marks Act as the defendant carrying on business at Chennai is also within the jurisdiction of this Court.

15. The following are the undisputed facts:-

(a) The plaintiff is a leading player in the manufacture and sale of undergarments in India.

(b) Admittedly, their turnover is much higher than the defendant. They have also disclosed their sales turnover and the advertisement costs incurred by them for promoting their products under their trademark 'Poomex', which reveals they have a huge turnover.

(c) The plaintiff has obtained trademark registration for their trademark 'Poomex' under Classes 24 and 25 as early as in 2003 itself



and they are in the market by using the said mark since then.

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(d) 'Poomex' is not a dictionary word and it is not a word used in normal parlance and therefore, it can be inferred that the same would have been coined only by the plaintiff.

(e) The defendant has chosen not to let in any oral evidence for the reasons best known to them.

16. In the decision relied upon by the learned counsel for the plaintiff, namely, ***Neuberg Hitech Laboratories Pvt. Ltd. (cited supra)***, a learned Single Judge of this Court has extracted four different categories of terms, namely, generic, descriptive, suggestive, arbitrary or fanciful, with respect to trademark protection, from the landmark judgment of the US Court of Appeals in ***Abercrombie & Fitch Company Vs. Hunting World Incorporated, 537 F.2d 4 (2d Cir. 1976)***, and they are as follows:-

“The cases, and in some instances the Lanham Act, identify four different categories of terms with respect to trademark protection. Arrayed in an ascending order which roughly reflects their eligibility to trademark status and the degree of protection accorded, these classes are (1) generic, (2) descriptive, (3) suggestive, (4) arbitrary or fanciful. The lines of



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demarcation, however, are not always bright...”

In the case on hand, since the plaintiff's trademark 'Poomex' is an arbitrary trademark, necessarily, the plaintiff is entitled for absolute and unconditional protection as held in the aforesaid decision of the US Court of Appeals. As observed earlier, 'Poomex' is not a dictionary word and certainly it is an arbitrary word and since the mark in question is the only mark available in the market, it can also be inferred that it was coined only by the plaintiff.

17. In another decision relied upon by the learned counsel for the plaintiff, namely, ***Cadila Health Care Ltd (cited supra)***, the Hon'ble Supreme Court has made it clear that phonetic similarity between the marks cannot be jettisoned. Admittedly, when 'Poomex', an arbitrary word coined by the plaintiff, is a unique name, which has acquired distinctiveness and associated only with the plaintiff by its long usage from 2003 onwards, the question of permitting the defendant to use the mark 'Poomak', which is phonetically similar to the plaintiff's mark 'Poomex', does not arise, as phonetic similarity cannot be jettisoned as held by the Hon'ble Supreme Court in the aforesaid decision.

18. In ***Parle Products (P) Ltd. (cited supra)***, the Hon'ble Supreme



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Court has made it clear that in an infringement suit, it would be enough if the impugned mark bears such an overall similarity to the registered mark as would be likely to mislead a person usually dealing with one to accept the other if offered to him. In the case on hand, by considering the trademark 'Poomex' as a whole, this Court finds that usage of the mark 'Poomak' by the defendant would amount to committing an act of infringement and passing off.

19. During cross-examination, PW1 deposed that only with the consent of the plaintiff and on account of the family arrangement, one of the brothers of the partner of the plaintiff has been allowed to use the mark 'Poomer'. Since sufficient explanation has been given for use of the mark 'Poomer', the question of allowing the defendant to use the mark 'Poomak' on the ground that there has been usage of the mark 'Poomer' by a third party in the market does not arise, and the said contention has to be rejected.

20. Insofar as the act of infringement and passing off committed by the defendant is concerned, the plaintiff has proved through pleadings,



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oral and documentary evidence as stated supra. However, insofar as damage claim made by the plaintiff is concerned, they have not let in any oral and documentary evidence to prove damages, which is admittedly an unliquidated claim. In order to claim damages, the said claim should be supported by oral and documentary evidence. As seen from the evidence available on record, the plaintiff has not let in any iota of evidence to prove that they are entitled for damages as prayed for. But, being a commercial suit and having committed an act of infringement and passing off, realistic costs will have to be imposed by this Court against the defendant. Section 35 of the Civil Procedure Code (CPC) as applicable to Commercial Courts Act, 2015, empowers this Court to impose realistic costs on the defendant, which includes (i) the fees and expenses of the witnesses incurred; (ii) legal fees and expenses incurred; and (iii) any other expenses incurred in connection with the proceedings. Therefore, this Court, after giving due consideration to the fact that the defendant has committed an act of infringement and passing off, deems it fit to award Rs.1,00,000/- as costs on the defendant, which is payable to the plaintiff.



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21. The plaintiff has proved that they are entitled for a decree as prayed for in paragraph No.31(a), (b) & (c) of the plaint, but, however, insofar as prayer (d) of para 31 is concerned, a direction is issued to the defendant to surrender to the plaintiff for destruction of all products, labels, dyes, blocks, moulds, screen prints, packing materials and other materials bearing the trademark 'Poomak' identical or deceptively similar to the plaintiff's trademark 'Poomax', in case they are still possessing the same, within a period of two months from the date of receipt of a copy of this judgment.

22. Insofar as the damage claim of Rs.25,00,000/- as prayed for in paragraph 31(e) of the plaint is concerned, in view of the reasons stated supra, for want of evidence, the suit claim for damages is rejected by this Court.

23. For the foregoing reasons, issues (a), (b), (c) and (d) framed by this Court supra are answered in favour of the plaintiff and against the defendant. Issue (e) pertaining to damages is answered against the plaintiff and in favour of the defendant by rejecting the said claim for



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damages. In the result, the suit is partly decreed as per the
aforementioned terms disclosed in paragraph 21 with costs of
Rs.1,00,000/- payable by the defendant to the plaintiff within a period of
two months from the date of receipt of a copy of this judgment.

16.12.2024

Index: Yes/ No
Speaking order / Non speaking order
Neutral citation : Yes / No
rkm

Plaintiff's witness:-

Mr.C.Gokulakrishnan - PW1

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Defendant's Witness:-

Nil

Documents exhibited by the defendant:-

Nil

AQJ



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ABDUL QUDDHOSE, J.

rkm

Judgment in

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