IN THE HIGH COURT OF JUDICATURE AT MADRAS

Order reserved on	**21.04.2025**
Order pronounced on	**30.04.2025**

CORAM:

THE HON'BLE MR. **JUSTICE SENTHILKUMAR RAMAMOORTHY**

C.S.(Comm. Div.) No.182 of 2023 &
(T) OP(TM) No.10 of 2024

M/s. P.V.S.Knittings,
A registered partnership firm
No.3-H, Soosaiyapuram Colony Road,
Rayapuram, Tirupur-641 601. ... Plaintiff and Petitioner

v.

P. Prakash
Sole Proprietor, trading as M/s. S P S TEX
No.98, 4th Street, Solipalayam,
15 Velampalayam Road,
Tirupur-641 652. ... Defendant and Respondent

PRAYER in C.S.(CD) No.182 of 2023: This Civil Suit (Comm. Div.) filed under Order VII Rule 1 CPC read with Order IV Rule 1 OS Rules read with Sections 27, 28, 29, 134 & 135 of the Trademarks Act, 1999 and Sections 51, 55 & 62 of the Copyrights Act, 1957, praying to grant a judgment and decree on the following terms:

a) a permanent injunction restraining the Defendants, by itself, its partners, men, servants, agents, distributors, stockiest, representatives or any one claiming through or under them from in any manner infringing the plaintiff's registered trade mark TWIN BIRDS under No.3609862 in class 25 or other formative trademarks by suing a deceptively similar trademark FLY BIRDS or any other trademark deceptively similar to the plaintiff's registered trade mark or in any other manner whatsoever;

b) a permanent injunction restraining the Defendants, by itself, its partners, men, servants, agents, distributors, stockiest representatives or any one claiming through or under them from in any manner infringing the plaintiff's copyright in the artistic work depicted in the TWIN BIRDS label with the use of the two birds device by using the FLY BIRDS label with the use of the two birds in the same colour scheme of pink and white which is a substantial reproduction of the said artistic work or by use of any other label identical or similar to the plaintiff's artistic work in the TWIN BIRDS label or in any other manner whatsoever;

c) a permanent injunction restraining the Defendants, by itself, its partners, men, servants, agents, distributors, stockiest, representatives or any one claiming through or under them from in any manner passing off and/or enabling others to pass off the Defendants' products under the trademark FLY BIRDS with the use of the two birds in the same colour scheme of pink and white as and for the plaintiffs' products by manufacturing, selling, or offering to sell, distributing, displaying, printing, stocking, using, advertising their products with a trademark FLY BIRDS or any other trade mark which is identical or similar to the plaintiff's trademark and trade dress for their TWIN BIRDS or in any other manner whatsoever;

d) the Defendant be ordered to surrender to Plaintiffs for destruction of all products, labels, cartons, dyes, blocks, moulds, screen prints, packing materials and other materials bearing the traDemark FLY BIRDS or any mark deceptively similar to plaintiffs' registered trademark 'TWIN BIRDS';

e) a preliminary decree be passed in favour of the Plaintiffs directing the Defendant to render account of profits made by use of trademark FLY BIRDS and a final decree be passed in favour of the Plaintiffs for the amount of profits thus found to have been made by the Defendant after the latter have rendered accounts; and
(f) for costs of the suit.

PRAYER IN (T)OP(TM) No.10 OF 2024: This Transfer Original Petition (Trade marks) filed under Sections 47, 57 and 97 of the Trade

Marks Act, 1999, praying to (a) To cancel and rectify the said trademark No.3237870 in Class 25 in the Register by expunging all the entries relating to the said trademark No.3237870 and; (b) the registered proprietors be ordered to pay the costs of the present proceedings.

For Plaintiff/ Petitioner	: Mr.Satish Parasaran, Senior Advocate for M/s.R.Sathish Kumar & Ms.Meha Varshni, Advocates
For Defendant/ Respondent	: Ms.Chitra Sampath, Senior Advocate for Mr. A.K.Rajaraman, Advocate

COMMON JUDGMENT

The suit was filed seeking relief in respect of alleged infringement of the plaintiff's registered trade mark 'TWIN BIRDS' bearing Trade Mark No.360862 in Class 25 or other formative trade marks by using the trade mark 'FLY BIRDS' or any other trade mark deceptively similar to the plaintiff's registered trade marks. The plaintiff also seeks relief in respect of alleged passing off by the defendant by sale of products under the trade mark 'FLY BIRDS' with the device of two birds by adopting the same colour scheme of pink and white as that adopted by the plaintiff for its products under the trade mark 'TWIN BIRDS'. Apart from the above, the plaintiff has also sought relief in respect of alleged copyright infringement in relation to its label comprising the words 'TWIN BIRDS' along with the device of two birds in a pink and white colour scheme.

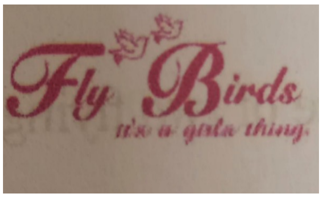
2. In (T)OP(TM) No.10 of 2024, the petitioner, i.e. the plaintiff in the civil suit, seeks rectification of the register of trade marks by cancelling the entry relating to Trade Mark No.3237870 in Class 25. Both the suit and the rectification petition are disposed of by this common judgment.

Pleadings, issues and evidence

3. In the plaint, the plaintiff states that a registered partnership firm was formed to carry on the business of manufacturing and marketing hosiery, ready made garments, under garments, knitted garments and other articles of clothing under various brand names,

including the renowned 'TWIN BIRDS' and variants thereof. The plaintiff further states that the said trade mark was adopted by the founder of the firm in the year 1969 and has been used ever since. In paragraph 6 of the plaint, the various registrations obtained by the plaintiff for both word and device marks containing the element 'TWIN BIRDS' are set out. In paragraph 7, the plaintiff states that the trade mark 'TWIN BIRDS' is used both directly by the plaintiff and through the plaintiff's licensee, Network Clothing Company Private Limited ('Network Clothing'). The plaintiff also states that the said licensee is a registered user of some of the trade marks of the plaintiff.

4. After setting out details of oppositions filed by the plaintiff to protect its trade mark at paragraph 11 of the plaint, at paragraph 13, the plaintiff states that it came across the following registered Trade Mark No.3237870 in class 25 for apparel:



According to the plaintiff, the adoption of the impugned trade mark was dishonest and intended to capitalize on the goodwill and reputation of the plaintiff. After further referring to the filing of the rectification petition, the plaintiff states that an ordinary purchaser with imperfect memory would not be able to differentiate between the plaintiff's and the defendant's products and that the plaintiff has suffered substantial loss on account of the use of the impugned mark by the defendant. After further asserting that there is no delay in filing the suit inasmuch as the plaintiff became aware of the defendant's use only in April, 2022, and instituted the present suit in April, 2023.

5. In the written statement, the defendant asserts that its device mark is different and dissimilar to the plaintiff's trade mark 'TWIN BIRDS'. The defendant further states in paragraph 6, with particulars, that the use of birds is common to trade and that there are more than

50 active trade marks containing the word 'birds'. In paragraph 7 of the written statement, the defendant has asserted that the suit is not maintainable in view of the failure to join a necessary party, namely, the licensee.

6. The defendant further states that there is a delay of five years by the plaintiff in the initiation of legal proceedings. After pointing out that the defendant's trade mark was advertised in the trade mark journal, the defendant states that the plaintiff is not entitled to relief on grounds of delay, laches and acquiescence. As regards the use of the colour 'pink', it is stated that the said colour is used universally in relation to products pertaining to girls/women. After further asserting that the plaintiff has not suffered any loss on account of the use of the impugned mark by the defendant, the defendant prays for dismissal of the suit.

7. In the rectification petition, the petitioner asserts that it adopted and used the trade mark 'TWIN BIRDS' and its variants since the early 1960s and has continued using the same ever since. After referring to the impugned trade mark, the rectification petitioner asserts that the said trade mark was adopted dishonestly. After further stating that the petitioner qualifies as a 'person aggrieved', it is stated that the use of the impugned mark is likely to cause deception or confusion. The user claim of the first respondent is disputed by pointing out defects in the documents relating to use of the impugned mark. By further asserting that the registration of the impugned mark was in violation of both Sections 9 and 11 of the Trade Marks Act, 1999 (the TM Act), the petitioner states that the said entry was therefore made without sufficient cause.

8. In the counter statement, the first respondent asserts that the application for registration was filed on 18.04.2016 by asserting use

since 01.04.2016, and that the mark was advertised in Trade Mark Journal No.1884 on 14.01.2019. Thereafter, the trade mark was registered with effect from 18.04.2016 on 30.05.2019. By further asserting that the trade marks of the petitioner and the first respondent are not similar, the said respondent states that the petitioner has acquiesced in the use of the impugned mark by failing to initiate any action in spite of being fully aware of the first respondent's use of the trade mark. Therefore, it is stated that the entry was made in conformity with applicable provisions of the TM Act and that no case is made out to rectify the register by expunging the entry.

9. Upon considering the pleadings, the Court framed the following issues on 08.01.2024 in the suit:

(a) Whether this Court has the territorial jurisdiction to try the suit?

(b) Whether the plaintiff is the registered proprietor of the trademark 'TWIN BIRDS' and other formative trademarks?

(c) Whether the mark 'FLY BIRDS' is phonetically, visually and structurally similar to the plaintiff's registered mark 'TWIN BIRDS'?

(d) Whether the suit suffers from delay, laches and acquiescence?

(e) Whether the term 'BIRDS' is common to readymade garments trade and whether the plaintiff or defendant can claim exclusive right over the same?

(f) Whether the plaintiff is the prior user of the term 'BIRDS'?

(g) Whether the defendant is *mala fide* in adopting 'Pink' and 'White' combination to depict their trademark as the same is common to cosmetics and feminine products?

(h) Whether the defendant is passing off their products as that of the plaintiff by using the trademark 'FLY BIRDS'?

(i) To what other reliefs?

10. By order dated 16.04.2024, the rectification petition was transferred to the file of this Court to be adjudicated along with the suit. Evidence was recorded in common in both the rectification petition and the suit. The plaintiff/rectification petitioner adduced evidence by examining Mr.M.Ravi, Partner, as PW1. In course of his examination-in-chief, 31 documents were exhibited as Exs.P1 to P31. PW1 was cross-examined thereafter by learned senior counsel for the defendant/respondent. The defendant/respondent adduced evidence by examining himself as DW1. During his examination-in-chief, 34 documents were exhibited as Exs.D1 to D34. DW1 was cross-examined by learned counsel for the plaintiff.

Counsel and their contentions

11. Oral arguments on behalf of the plaintiff were advanced by Mr.Satish Parasaran, learned senior counsel, and by Mr.R.Sathish Kumar, learned counsel. Oral arguments on behalf of the defendant were advanced by Mrs.Chitra Sampath, learned senior counsel,

assisted by Mr.Rajaraman, learned counsel. Both the contesting parties filed written arguments.

12. The first contention of Mr.Satish Parasaran was that the plaintiff is the registered proprietor of the trade mark 'TWIN BIRDS' and its formative marks. By referring to and relying upon Exs.P1 to P14, learned counsel submitted that these documents clearly establish that the plaintiff is the registered proprietor of multiple trade marks containing the element 'TWIN BIRDS'. He also submitted that these registrations are not only for device marks but also for word marks. As regards evidence of use, learned senior counsel referred to the invoices exhibited collectively as Ex.P18. He pointed out that the first invoice placed on record by the plaintiff is invoice dated 30.04.2007 and that this invoice clearly contains the trade mark 'TWIN BIRDS'. He also pointed out that Ex.P18 includes a large number of invoices issued by the plaintiff between 30.04.2007 and 24.03.2015. He also referred to invoices issued by Network

Clothing, the first of these invoices being invoice dated 22.01.2011, which were also included in Ex.P18.

13. As regards evidence of turnover of the plaintiff from sale of products bearing the trade mark 'TWIN BIRDS', by referring to the certificate issued by Mr.Thangavel, Chartered Accountant (Ex.P17), learned senior counsel submitted that the turn over was Rs.1,96,27,174/- in financial year 2021-22 and that the turnover of the licensee, Network Clothing, for the same financial year was Rs.101,41,48,060/-. In effect, he submitted that the aggregate turnover of the plaintiff and its licensee for financial year 2021-22 was Rs.103,40,75,234/-.

14. Learned senior counsel next referred to the rival mark 'FLY BIRDS' and submitted that the application for registration of the said mark was filed in 2016. By comparing the plaintiff's label with the defendant's label, learned senior counsel submitted that the marks

are undoubtedly deceptively similar not only on account of the use of the common word 'birds' in the two marks but also because of the commonality of both the device of two birds and the pink and white colour scheme. Learned senior counsel thereafter referred to the cross-examination of DW1 with particular reference to the answers to questions 18 to 19, 39 to 41 and 109 to 117.

15. As regards the invoices filed by the defendant, learned senior counsel submitted that these invoices appear to have been created for purposes of the case. With specific reference to invoice dated 25.4.2017 (Ex.D19), learned senior counsel submitted that the invoice was issued before the Goods and Services Tax legislations, such as the Central Goods and Services Tax Act, 2017, came into force on 01.07.2017. However, he points out that the invoice contains the GST registration number of the defendant. He also pointed out that the invoice value in numbers is shown as Rs.18,700/-, whereas, in words, it is shown as Rs.1,62,787.8. In this connection, by referring to

the answers of DW1 to question Nos.80 and 82, he pointed out that DW1 admitted that the same pen was used for signing all these invoices. Therefore, he contends that the credibility of these invoices is highly suspect and that materiality and weight should not be attached thereto.

16. By contending that the defendant failed to produce any evidence of advertising the impugned trade mark, learned senior counsel referred to the answer of DW1 to question No.91 and pointed out that DW1 admitted that the first advertisement was issued in 2022 after the defendant issued a reply to lawyer's notice dated 11.05.2022. The last contention of learned senior counsel was that Network Clothing was permitted to use the plaintiff's trade mark under a licence agreement followed by registered user agreement dated 16.12.2015 [Ex.P16]. Consequently, he submitted that the plaintiff is entitled to rely upon the evidence of use of the licensee/registered user.

17. In support of the above contentions, learned counsel for the plaintiff, Mr.Sathish Kumar, referred to and relied upon the following judgments:

(i) *Corn Products Refining Co. v. Shangrila Food Products Ltd, AIR 1960 SC 142 (Corn Products),* for the proposition that the existence of registered trade marks on the register does not qualify as evidence of use.

(ii) *Amritdhara Pharmacy v. Satya Deo Gupta (Amritdhara Pharmacy)***,** *AIR 1963 SC 449*, in support of the anti-dissection rule.

(iii) *Cadila Healthcare Limited v. Cadila Pharmaceuticals Limited, (2001) 5 SCC 73*, wherein the principles laid down in *Amritdhara Pharmacy* were cited with approval.

(iv) *National Sewing Thread Co. Ltd vs James Chadwick & Bros. Ltd,* AIR 1953 SC 357, wherein the change from the word 'Eagle' to 'Vulture' was held to be insufficient to dispel the conclusion of deceptive similarity.

(v) *Parle Products (P) Ltd v. J. P. & Co.,(1972) 1 SCC 618*, with regard to the requirement for examining overall similarity instead of looking for differences.

(vi) *M/S.Heinz Italia & Anr v. Dabur India Ltd., (2007) 6 SCC 1*, with regard to the grant of relief upon finding of dishonesty.

(vii) *Neuberg Hitech Laboratories Pvt. Ltd. v. Dr.Ganesan's Hitech Diagnostic Centre, 2022 SCC Mad 8779*, with regard to the spectrum of distinctiveness.

(viii) *R. Gopalakrishnan v. M/S. Venkateshwara Camphor Works, 2000 (IV) CTC 222*, with regard to the grant of relief upon a finding of dishonesty.

(ix) *P.M.Palani Mudaliar & Co v. M/S.Jansons Exports, AIR 2017 MAD 105 (Palani Mudaliar)*, with regard to the requirements for a finding of *publici juris.*

(x) *National Bell Co. v. Gupta Industrial Corporation, 1970 (3) SCC 665 (National Bell Co.)*, regarding the requirement of substantial use to establish that the mark is common to trade.

(xi) *Fatima Tile Works and Another v. Sudarsan Trading Co. Ltd. and another, AIR 1992 Mad 12*, for the proposition that use by an entity with which the plaintiff has trade connection is acceptable as evidence of use by the plaintiff.

18. Submissions were made in response and to the contrary by Mrs.Chitra Sampath, learned senior counsel. Her first submission was that the defendant applied for registration of the trade mark 'FLY BIRDS' on 18.04.2016 by asserting use since 01.04.2016. Therefore, she submits that the plaintiff was required to adduce evidence to establish goodwill and reputation prior to the date of adoption of the mark by the defendant. By referring to Ex.P18 series and, in particular, invoice dated 30.04.2007, learned senior counsel submitted that the invoice discloses use of 'Twin Birds rib trunk'. In other words, she submitted that these invoices do not contain any evidence of use of the device mark exhibited by the plaintiff as Ex.P5. In this connection, she contended that the suit is in respect of alleged infringement of Ex.P5 and passing off in relation thereto.

19. As regards the invoices issued by Network Clothing, learned senior counsel submitted that these invoices were not filed along with the suit. According to her, if these invoices were genuine and in the possession, custody, control or power of the plaintiff, these invoices should have been filed at the time of institution of the suit. After further submitting that the defendant disputed the invoices, she pointed out that the originals were not filed by the plaintiff. She also submitted that the plaintiff is not entitled to rely upon evidence of use by Network Clothing to establish use by the plaintiff. In support of this contention, by referring to Ex.P16, i.e. trade mark user agreement dated 16.12.2015, learned senior counsel submitted that this agreement sets out the list of registered trade marks that form the subject of the agreement, and that Trade Mark No.3015072 (Ex.P5) is not mentioned therein. Consequently, learned senior counsel submitted that the use by Network Clothing of the trade mark depicted in Ex.P5 was not authorized and that the same cannot

be relied upon by the plaintiff. In this connection, she further submitted that Ex.P16 refers to a deed of license dated 01.04.2010, but the same was not placed on record by the plaintiff. The answer of PW1 to Question No.14, wherein the witness deposed that only one agreement was signed with Network Clothing was also relied on by her.

20. As regards advertisements, learned senior counsel submitted that the invoices raised by the advertisers are in the name of Network Clothing and not in the name of the plaintiff. By referring to the evidence of PW1, learned senior counsel submits that DW1 admitted in response to Questions 10 to 12 that the plaintiff started using the trade marks only from 04.01.2010. Her next contention was that the distributor agreements between Network Clothing and third parties (Ex.P20 series) records that Network Clothing is the owner of the trade marks. With reference to the certificate issued by the Chartered Accountants (Ex.P16), learned senior counsel submitted

that the certificate does not contain any details of advertising expenditure. In fact, she contends that the sales turnover mentioned in the certificate indicates that the plaintiff's business was not affected by the sale of products bearing the impugned mark by the defendant.

21. By referring to the answer to Question No.113, learned senior counsel submitted that the plaintiff is targeting English speaking customers from higher economic strata and that this is evident from PW1's answer that the plaintiff is targeting Pan-India and global customers. By contrast, learned senior counsel submitted that the defendant's customers are local and that this eliminates the likelihood of confusion or deception. The last contention of learned senior counsel was that PW1 was unable to specify the date of knowledge of use of the impugned mark and that he stated, in response to Question No.46, that only the team was aware of the date of knowledge of such use.

22. In support of these contentions, learned senior counsel referred to and relied upon the following authorities:

(i) *Honda Motor Company Ltd. v. Kewal Brothers and others, MANU/WB/0353/1999,* particularly paragraphs 37 and 38 thereof, regarding the date of adoption of the impugned mark by the defendant being the relevant date to establish the goodwill and reputation of the plaintiff.

(ii) *Brihan Karan Sugar Syndicate Private limited v. Yashwantrao Mohite Krushna Sahakari Sakhar Karkhana, MANU/SC/1020/2023,* particularly paragraph 13 thereof, regarding the necessity to prove expenditure incurred on promotion and advertisement in an action for passing off.

(iii) *Pfizer Products Inc. v. Renovision Exports Pvt. Ltd. And another, 2024 SCC OnLine Del 3140*, particularly paragraph 30 thereof, with regard to the requirement by a plaintiff in a passing off action to establish the three elements referred to as the classic trinity test.

(iv) Definition of bird from the Cambridge Dictionary.

(v) Article in the Brittanica regarding the association of the pink colour with girls.

(vi) Reference to the colour pink in relation to girls in the Handbook on Combating Gender Stereotypes published by the Supreme Court of India.

23. By way of rejoinder, Mr.Sathish Kumar's submissions may be summarised as follows:

(i) the goods of the plaintiff and the defendant are identical and the customer base is common.

(ii) The defendant has copied multiple features, such as the word 'birds', the device of two birds and the pink and white colour combination.

(iii) It is not material as to who has issued the advertisements; what is material is that the trade mark was advertised.

(iv) The trade mark applicant can choose to apply for registration even many years after commencing use of the relevant trade mark.

(v) The plaintiff's case is not built only on Ex.P5. It is built on a range of trade marks containing the element 'TWIN BIRDS', including the device mark containing the element 'TWIN BIRDS' along with the pictorial depiction of birds in pink and white colour combination.

(vi) The TM Act does not contain any restriction regarding grant of licence in respect of unregistered trade marks. Therefore, the permission granted to Network Clothing with regard to Ex.P5 trade mark is not contrary to the TM Act.

(viii) Even if computed from the date of advertisement of the defendant's trade mark on 14.01.2019, it cannot be said that the plaintiff had acquiesced as per Section 33 of the TM Act. In view of the first advertisement by the defendant being published only in 2022, the plaintiff has approached the Court within a reasonable period. In any event, delay on the part of the plaintiff will not stand in the way of grant of relief.

Discussion, analysis and conclusion:

Issue (a)

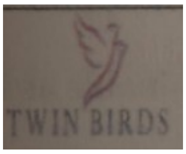
24. A preliminary issue was framed with regard to the territorial jurisdiction of the Court. In the plaint, the plaintiff asserted at paragraph 29 that the defendant's products were available at Purasawalkam and T.Nagar in Chennai. In support of this assertion, the plaintiff exhibited invoices dated 25.01.2023 issued by Women's World, Ranganathan Street, T.Nagar, Chennai, for sale of ankle leggings bearing the trade mark 'FLY BIRDS'. Similarly, the plaintiff exhibited invoice dated 25.01.2023 issued by Ranjanas Garments Private Limited No.238, Purasawalkam High Road, Purasawalkam, Chennai-600 007, for ladies' full length leggings under the brand 'FLY BIRDS'. These documents establish that the cause of action has arisen within the territorial limits over which this Court exercises

jurisdiction. Issue (a) is therefore decided in favour of the plaintiff and against the defendant.

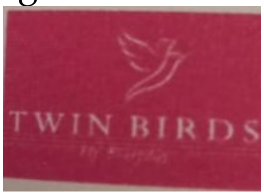
Issues (b) and (f)

25. Issue (b) relates to whether the plaintiff is the registered proprietor of the trade mark 'TWIN BIRD' and other formative trade marks. On a mere perusal of Exs.P1 to P14, which are legal use certificates relating to multiple trade marks containing the element 'TWIN BIRDS', it is beyond doubt that the plaintiff is the registered proprietor thereof.

26. Issue (f) pertains to whether the plaintiff is the prior user of the word 'BIRDS'. In Ex.P1, which is the legal use certificate of Trade Mark No.258263, it is stated that the application was on 'proposed-to-be-used' basis. Similar statements are made in Exs.P2 and P3. Ex.P4 is in relation to the following device mark under trade mark No.1912151 in Class 25:



An assertion of use since 04.01.2010 has been made in respect thereof. Ex.P5 relates to the following device mark:



As in the case of Ex.P4, an assertion of use since 04.01.2010 is made.

27. As evidence of use, the plaintiff exhibited invoices under Ex.P18. Ex.P18 consists of invoices issued by the plaintiff and by Network Clothing. The earliest invoice in Ex.P18 is invoice dated 30.04.2007, which was issued by the plaintiff, PVS Knittings. This invoice is in respect of goods under the name TB Fine Trunk or Twin Birds S. Rib Trunk. These invoices also contain a device mark. The device mark of Ex.P5 is seen in invoices issued by Network Clothing, the earliest being invoice dated 22.01.2011.

28. Learned senior counsel for the defendant objected to these invoices on the ground that they were not filed at the time of institution of the suit. This objection is no longer tenable because these documents were permitted to be filed with the leave of this Court in A.No.1715 of 2024 by order dated 26.03.2024. The other ground of challenge is that originals were not produced. On examining the invoices, each invoice contains an invoice number, TIN, CST No. and even Central Excise No. Therefore, there is no reason to doubt the credibility of these invoices merely because these invoices were filed at the time of trial and not at the time of institution of the suit or because originals were not filed.

29. Learned senior counsel for the defendant also contended that these invoices cannot be relied upon because Network Clothing was not authorized to use the device mark of Ex.P5 under Ex.P16. Therefore, this contention should be considered. By way of statutory

context, it should be borne in mind that, under Section 28 of the TM Act, the registered proprietor is entitled to sue for infringement and the joinder of the licensee is not necessary for such purpose. Ex.P16 was executed on 16.12.2015 by and between the plaintiff and Network Clothing. The first recital is as under:

> *"WHEREAS the party of the first part has already executed a Deed of License to exploit and use their trademarks, applied and pending for registration as on the date of execution i.e., 01/04/2010, favouring M/s. NETWORK CLOTHING COMPANY PRIVATE LIMITED."*

Thereafter, parties have set out a list of 34 registered trade marks in respect of which Network Clothing has been conferred the status of registered user. This list of 34 registered trade marks does not include Ex.P5. On perusal of Ex.P5, it is noticeable that the application for registration was filed on 22.07.2015, but the registration certificate was issued on 02.01.2019. Consequently, as on the date of execution of Ex.P16 agreement, the device mark shown in Ex.P5 was unregistered. Given that Ex.P16 was confined to trade marks of the plaintiff which had been registered as on 16.12.2015, the reason for non-inclusion of Ex.P5 trade mark is clear.

30. The TM Act defines 'permitted user' in Section 2(1)(r) as under:

> *"**2. Definitions and Interpretation**- 1)In this Act, unless the context otherwise requires, –*
>
> *(r) "permitted use", in relation to a registered trade mark, means the use of trade mark –*
>
> *(i)by a registered user of the trade mark in relation to goods or services –*
>
> *(a)with which he is connected in the course of trade; and*
>
> *(b)in respect of which the trade mark remains registered for the time being; and*
>
> *(c)for which he is registered as registered user; and*
>
> *(d)which complies with any conditions or limitations to which the registration of registered user is subject; or*

(ii)by a person other than the registered proprietor and registered user in relation to goods or services –

(a)with which he is connected in the course of trade; and

(b)in respect of which the trade mark remains registered for the time being; and

(c)by consent of such registered proprietor in a written agreement; and

(d)which complies with any conditions or limitations to which such user is subject and to which the registration of the trade mark is subject;"

The above definition reveals that such use may be either by a registered user or by a person other than a registered user. In both cases, the definition pertains only to registered trade marks. Since Ex.P5 trade mark was unregistered as on the date of execution of Ex.P16, it was permissible for the plaintiff to license the use thereof without complying with the requirements of Section 2(1)(r) of the TM Act.

31. In this connection, it should also be noticed that the plaintiff is a registered partnership firm and that Mr.M.Ravi is one of the partners. The said Mr.Ravi is the Managing Director of Networking Clothing, as is evident from Ex.P16. In fact, Ex.P16 has been executed on behalf of Networking Clothing by Mr.M.Ravi, Managing Director. At paragraph 7 of the plaint, the plaintiff stated, in relevant part, as under:

> *"...The plaintiff states that they are using the trademark TWIN BIRDS themselves and also through their licensee, NETWORK CLOTHING COMPANY PRIVATE LIMITED. The said company is also a registered user of some of the trademarks of the plaintiff and necessary applications have been filed in the Trade Marks Registry."*

The above pleading makes it clear that Network Clothing was using the trade mark 'TWIN BIRD' both as licensee and as registered user of certain registered trade marks of the plaintiff. In *Fatima Tile Works,* this Court concluded that it is sufficient if the connection between the proprietor of the mark and the goods is established. In the facts and circumstances outlined above, such connection has been established and, therefore, the plaintiff is entitled to rely on evidence of use by sale through its licensee/registered user, Network Clothing. The evidence on record, thus, leads to the conclusion that the plaintiff has used the word mark 'TWIN BIRDS' from 2007 and the device mark of Ex.P5 from 2011.

32. As evidence of use of the impugned mark, the defendant has placed on record invoices under Ex.D19. The first of these invoices is dated 25.04.2017. As such, there is no doubt that the plaintiff is the prior user of the mark 'TWIN BIRDS' in comparison to the defendant's first use of the mark 'FLY BIRDS'. As regards invoice dated 25.04.2017, as contended by learned senior counsel for the plaintiff, the invoice value in numbers (Rs.18,700/-) does not tally with the invoice value in words (Rs.1,62,787.8). It is also pertinent to

notice that the invoice contains the GST registration number of the defendant although the GST enactments came into force only on 01.07.2017. Since the evidence on record leads to the conclusion that the plaintiff is the prior user of the mark 'TWIN BIRDS', Issue (f) is decided in favour of the plaintiff and against the defendant.

Issue (d):

33. This issue relates to whether the suit suffers from delay, laches and acquiescence. I deal with acquiescence first. Section 33 of the TM Act, which deals with acquiescence is as under:

> ***"33. Effect of acquiescence.—***
> *(1) Where the proprietor of an earlier trade mark has acquiesced for a continuous period of five years in the use of a registered trade mark, being aware of that use, he shall no longer be entitled on the basis of that earlier trade mark—*
> *(a)to apply for a declaration that the registration of the later trade mark is invalid, or*
> *(b)to oppose the use of the later trade mark in relation to the goods or services in relation to*

which it has been so used, unless the registration of the later trade mark was not applied in good faith.

.(2)Where sub-section (1) applies, the proprietor of the later trade mark is not entitled to oppose the use of the earlier trade mark, or as the case may be, the exploitation of the earlier right, notwithstanding that the earlier trade mark may no longer be invoked against his later trade mark."

As is evident from a plain reading of Section 33, in order to establish 'acquiescence', the defendant should provide 'proof' that the plaintiff [proprietor of the earlier trade mark] acquiesced for a continuous period of five years in the use of the registered trade mark in spite of being aware of such use.

34. The plaintiff applied for registration on 18.04.2016. However, the plaintiff has not placed on record any evidence of use prior to 25.04.2017. As indicated earlier, invoice dated 25.04.2017

does not inspire confidence in view of discrepancies discussed earlier. In course of cross-examination of DW1, learned counsel for the plaintiff has also elicited other discrepancies in these invoices with regard to the use of the same pen for signing the invoices. Reference may be made, in this regard, to the answers to Questions 80 and 82 during cross-examination of DW1. The defendant's trade mark was advertised in the trade mark journal on 14.01.2019. Even if knowledge of such advertisement were to be attributed to the plaintiff, a continuous period of five years had not elapsed between 14.01.2019 and the date of institution of the suit in 2023. Therefore, the defendant has failed to establish acquiescence as per Section 33 of the TM Act. It remains to be considered whether there was delay or laches and, if so, the implications thereof.

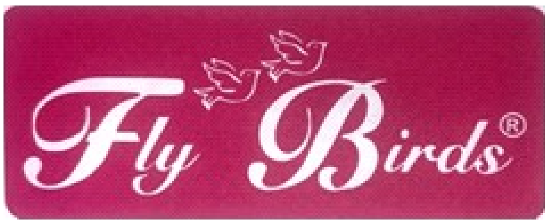
35. In the plaint, the plaintiff asserted that it became aware of the defendant's use of the impugned mark only in April, 2022. On 23.04.2022, the plaintiff filed the rectification application. A lawyer's

notice was issued by the plaintiff to the defendant on 29.04.2022 (Ex.P23). The defendant replied thereto on 11.05.2022 (Ex.P24). After obtaining copies of invoices dated 25.01.2023 evidencing sale of products bearing the impugned mark in Chennai (Ex.P26), the plaint was presented in April, 2023. In these circumstances, it cannot be concluded that there was delay and laches in filing the suit. Even otherwise, while delay and laches would be a material consideration while deciding whether interim relief should be granted, in an action for infringement of trade mark and passing off, as held by the Hon'ble Delhi High Court in *M/S. Hindustan Pencils Pvt. Ltd. v. M/s. India Stationery Products Co. and another, AIR 1990 Del 19*, delay *per se* will not stand in the way of the plaintiff obtaining relief. Issue (b) is disposed of on these terms.

Issue (c), (e) and (g):

36. Issue(c) pertains to whether the impugned mark 'FLY

BIRDS' is phonetically, visually and structurally similar to the plaintiff's registered mark 'TWIN BIRDS'. In order to consider this issue, it is pertinent to set out the two device marks.:



Fly Birds®

WRINKLE FREE PREMIUM LEGGINGS

37. The precedents cited at the bar instruct that the comparison should be made from the perspective of a customer of average intelligence and imperfect recollection. Such comparison is required to be made of the marks as a whole on the basis of the overall impression that the marks would make on the above mentioned notional person. Both the marks use a common pink and white colour scheme; both marks contain the word 'birds' prominently; and both marks contain a pictorial depiction of two birds. This discussion leads to the clear finding that the rival marks are deceptively similar and that a consumer would associate the impugned mark with the plaintiff by assuming a trade connection. Therefore, Issue (c) is decided in favour of the plaintiff and against the defendant.

38. Issue (e) relates to whether the word 'BIRDS' is common to trade in ready made garments and whether the plaintiff or defendant can claim exclusive right over the same. While 'BIRDS' is used to refer generically to all species of avian life and is, therefore, not an invented word, it would qualify as arbitrary in relation to apparel for the reason that it is not even suggestive of the nature, quality or characteristics of apparel. Because the defendant applied for and obtained registration with effect from 18.04.2016, the question as whether 'BIRDS' is common to trade should be tested as of the said date. In paragraph 6 of the written statement, the defendant has stated that there are several registered trade marks containing the element 'BIRDS', and a list of about 50 registrations are set out therein. A similar statement is made in the proof affidavit of DW1, and the same list is included in the proof affidavit. By way of documentary proof, the defendant marked Ex.D18. The said exhibit contains documents relating to the status of these marks. The documents constituting Ex.D18 relate largely to device marks and a

few word marks. DW1 was questioned in relation thereto in questions 18-27. Question and answers 19 and 27 are as under:

> *Q19: Have you filed any document before the date of your trademark application for Fly Birds on 18.04.2016 to prove that "birds" was commonly used in the garment industry before such date?*
> *A: There is a document for LIL Bird and others prior to 2016 in Ex. D18.*
> *Q27: Therefore, I put it to you that there is no document to show that when you filed the trademark application on 18.04.2016 that birds was common to trade.*
> *A: I deny.*

39. On closely examining Ex.D18, it is clear that many of the marks were applied for and, consequently, registered on a date subsequent to the date of application by the defendant. In fact, 'Lil Bird' was applied for and registered after 18.04.2016 and, therefore, the answer to question 19 by DW1 is contrary to Ex.D18. More importantly, a large majority are composite device marks containing other, including pictorial, elements. The Supreme Court held in

National Bell Co. that a conclusion on common to trade cannot be drawn unless there is evidence of substantial use by others. The Division Bench of this Court held in *Palani Mudaliar* that use by others should exceed use by the proprietor. Most importantly, any comparison should be between the rival marks as a whole. When so compared, the only reasonable inference is that the defendant failed to establish that the plaintiff's mark is common to the trade or *publici juris*. This issue is disposed of on these terms.

Issue (g)

40. Issue (g) pertains to whether the pink and white colour scheme was adopted *mala fide*. As contended by learned senior counsel for the defendant, the colour pink is often associated with products used by girls/women, and the plaintiff cannot claim exclusivity to the use of the colour pink or even the combination of pink and white *per se*. However, in the case at hand, the defendant has adopted the impugned device mark consisting of the words 'FLY

BIRDS' combined with the pictorial device of the birds and the pink and white combination. Such adoption was in 2016, which is subsequent to the plaintiff's adoption in 2010 and use in 2011. Given that the marks are used in respect of identical goods by two parties based out of the same town, when the two marks are compared as a whole in context, it appears that the adoption and use of the pink and white combination is *mala fide*.

Issue (h)

41. Issue (h) pertains to whether the defendant is passing off its products as those of the plaintiff by using the impugned mark 'FLY BIRDS'. As stated earlier, comparison of the two marks as a whole leads to the conclusion that the marks are deceptively similar. The plaintiff is the prior user and has placed on record evidence of use at least from 2011. The plaintiff has also placed on record the Chartered Accountant's certificate. The said certificate discloses that the turnover of the plaintiff was Rs.1,96,27,174/- in 2021-22 and that the

turnover of the licensee/registered user Network Clothing was Rs.101,44,48,016/- during the same period. The plaintiff has also placed on record evidence of advertising its mark under Ex.P19. Such advertisements appear to have been issued between 1995 and 2022. The evidence on record, therefore, leads to the conclusion that the plaintiff has established reputation and goodwill.

42. The inference that follows from this discussion is that the defendant has made a misrepresentation with regard to its goods in relation to the goods of the plaintiff. This is likely to cause loss to the plaintiff. Therefore, the classic trinity of reputation and goodwill, misrepresentation and likely loss stands established. Issue (h) is, therefore, decided in favour of the plaintiff and against the defendant.

43. For reasons set out above, the plaintiff is entitled to the reliefs claimed in the suit both in respect of infringement and passing

off. Since the defendant appears to have been selling goods bearing the impugned mark for many years, as regards fully ready apparel bearing the impugned mark, the orders of permanent injunction shall not operate for a period of four months from the date of receipt of a copy of this order so as to enable the defendant to liquidate such inventory. This is subject to the condition that an affidavit providing details of such inventory is filed in Court within two weeks from the date of receipt of a copy of this order after serving a copy thereof on the plaintiff's counsel. The preliminary decree to provide an account of profits shall, however, cover such inventory also. As the successful party, the plaintiff is also entitled to costs towards court fees, lawyer's fees and other expenses. The defendant is liable to pay an aggregate sum of Rs.5,00,000/- as costs to the plaintiff.

44. Likewise, for reasons set out above, the entry relating to the impugned mark in the rectification petition was made in contravention of Section 11 of the TM Act. Effectively, the entry was

made without sufficient cause, and rectification is warranted.

45. C.S. (Comm.Div.) No.182 of 2023 is, therefore, decreed as per prayers (a) to (e) of paragraph 33 of the plaint subject to the qualification that the permanent injunctions shall not operate to preclude the sale of fully ready apparel bearing the impugned mark by the defendant directly, or through authorised distributors, wholesalers, retailers and the like, for a period of four months from the date a web copy of this judgment is uploaded. This exemption is subject to the condition that the defendant files an affidavit before this Court providing particulars of fully ready apparel bearing the impugned mark within two weeks from the date the web copy of this order is uploaded under copy to plaintiff's counsel. The defendant is also directed to pay an aggregate sum of Rs.5,00,000/- as costs to the plaintiff.

46. (T)OP(TM) No.10 OF 2024 is allowed by directing the Registrar of Trade Marks to cancel the entry relating to Trade Mark No.3237870 in Class 25 in the Register of Trade Marks. This action shall be completed within 30 days from the date the web copy of this judgment is uploaded. There will be no order as to costs.

30 .04.2025

Index : Yes/No

Internet : Yes/No

Neutral Citation : Yes/No

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Plaintiff's witness:

P.W.1 – Mr.M.Ravi

Documents exhibited by the plaintiff:

Exhibits	***Documents***
Ex.P1	The copy of the trademark registration under No.258623 in Class 25 dated 23.07.1969 (compared with original)
Ex.P2	The copy of the trademark registration under No.355765 in Class 25 dated 26.11.1979 (compared with original)
Ex.P3	The copy of the trademark registration under No.360862 in Class 25 dated 18.04.1980 (compared with original)
Ex.P4	The copy of the trademark registration under No.191251 in Class 25 dated 23.07.2910 (compared with original)
Ex.P5	The copy of the trademark registration under No.3015072 in Class 25 dated 22.07.2015 (compared with original)
Ex.P6	The copy of the trademark registration under No.3015073 in Class 25 dated 22.07.2015 (compared with original)
Ex.P7	The copy of the trademark registration under No.3015074 in Class 25 dated 22.07.2015 (compared with original)
Ex.P8	The copy of the trademark registration under No.3015075 in Class 35 dated 22.07.2015 (compared with original)
Ex.P9	The copy of the trademark registration under No.3015076 in Class 24 dated 22.07.2015 (compared with original)
Ex.P10	The copy of the trademark registration under No.3015077 in Class 35 dated 22.07.2015 (compared with original)
Ex.P11	The copy of the trademark registration under No.3024985 in Class 35 dated 04.08.2015 (compared with original)

Exhibits	***Documents***
Ex.P12	The copy of the trademark registration under No.3105645 in Class 35 dated 24.11.2015 (compared with original)
Ex.P13	The copy of the trademark registration under No.5226139 in Class 24 dated 29.11.2021 (compared with original)
Ex.P14	The copy of the trademark registration under No.5226140 in Class 25 dated 29.11.2021 (compared with original)
Ex.P15	The (series 8 nos) printouts of the GST registrations from various states in India from the year 2017 to 2022 (65B affidavit filed)
Ex.P16	The copy of the licence agreement dated 16.12.2015. (Compared with original)
Ex.P17	The original chartered accountant certificate dated 24.08.2022.
Ex.P18	The copy of the invoices from the year 2007-2022. (The learned counsel for the defendant has objected that some of the documents marked are photocopies and originals have not been produced for comparison)
Ex.P19	The copy of the advertisements from the year 1995-2022. (The learned counsel for the defendant has objected that some of the documents marked are photocopies and originals have not been produced for comparison)
Ex.P20	The (series 18 documents) copy of the said distributor's agreements. (compared with original except the agreement dated 25.0.2021)
Ex.P21	The printout of the rectification petition (65B affidavit filed)
Ex.P22	The printout of the photographs of the comparison of the promotional materials (65B affidavit filed)
Ex.P23	The copy of legal notice sent by the plaintiff to the defendant dated 29.04.2022.
Ex.P24	The copy of reply notice sent by the defendant to the plaintiff

Exhibits	Documents
	dated 11.05.2022.
Ex.P25	The copy of affidavit of the evience filed by the defendant dated 11.10.2022 (65B affidavit filed)
Ex.P26	The copy of the invoices (2 nos) dated 25.01.2023
Ex.P27	The printout of the colour photos of the plaintiff's trademark TWIN BIRDS
Ex.P28	The printout of the colour photos of the defendant's trademark FLY BIRDS
Ex.P29	The copies of the printouts from the website of the petitioner.(65B affidavit filed)
Ex.P30	The copies of the online status showing petitioner's products being available online in E-commerce websites. (65B affidavit filed)
Ex.P31	The copies of the online status of the oppositions (65B affidavit filed)
Ex.P32	The extract from the register under No.5527640 in class 35 for the trademark "Fly Birds Device".
Ex.P33	The opposition is filed for an application under No.5761586 in class 25 for the trademark Flying Birds by the defendant.
Ex.P34	The opposition is filed for an application under No.53133633 in class 25 for the trademark Fly Birds by the defendant
Ex.P35	The opposition is filed for an application under No.5594624 in class 25 for the trademark Fly Birds by the defendant

Defendant's witness:

D.W.1 – Mr.P.Prakash

Documents exhibited by the Defendant:

Exhibits	*Documents*
Ex.D1	The original carton box bearing the name of the plaintiff.
Ex.D2	The photocopy of the certificate of registration -Commercial Taxes Departments – FORM – D dated 29.04.2015. (Original produced, compared and returned to the defendant's counsel.)
Ex.D3	The photocopy of the certificate of registration – Commercial Taxes Departments – FORM – B dated 30.04.2015. (original produced, compared and returned to the defendant's counsel)
Ex.D4	The printout of the trademark registry, Chennai Examination Report dated 06.10.2016.
Ex.D5	The printout of the registration certificate Government of India FORM GST- REG-06 dated 01.07.2017
Ex.D6	The printout of the trademark registry acceptance order copy dated 31.12.2018
Ex.D7	The printout of the trademark journal advertisement copy dated 14.01.2019
Ex.D8	The printout of the certificate of registration of trademark dated 30.05.2019. (the counsel for the plaintiff objects on the ground that the certificate copy of the registration is not filed.)
Ex.D9	The printout of the central board of film certification dated

Exhibits	Documents
	31.12.2021. (The counsel for the plaintiff objects on the ground that the same is a photocopy oand hence cannot be marked)
Ex.D10	The printout of Udyam Registration certificate -MSME dated 15.02.2022.
Ex.D11	The photocopy of the legal notice dated 29.04.2022 sent by the plaintiff
Ex.D12	The office copy of the reply notice sent by the defendant to the plaintiff dated 11.05.2022.
Ex.D13	The original newspaper Dhina Thanthi dated 14.07.2022.
Ex.D14	The photocopy of the defendant's trademark legal user certificate
Ex.D15	The original chartered accountants turnover certificate dated 29.05.2023. (The counsel for the plaintiff objected on the ground that the witness cannot mark the certificate given by the chartered accountant who is the third party to this suit, the objection is as regards proof.)
Ex.D16	The printout of the defendant trademark status dated 05.06.2023.
Ex.D17	The printout out of the copyright NO OBJECTION CERTIFICATE dated 13.06.2023
Ex.D18	The printout of the third parties registered trademark list and status copies. (The counsel for the plaintiff objects on the ground that the same contains only the lsit of the trademark without any details regarding applications, registration certificate, etc.)
Ex.D19	The printout of the defendant distributors list.
Ex.D20	The original defendants sale invoices from 2017 to 2023. (The counsel for the plaintiff objects on the ground that the invoices from 16.06.2022, 25.08.2022, 31.10.2022, 25.01.2023,

Exhibits	Documents
	07.02.2023 and 28.03.2023 are only photocopies and hence cannot be marked.)
Ex.D21	The printout of the television advertisements fly birds brand SUN TV Network Invoice cum Telecast certificate. (The counsel for the plaintiff objects on the ground that the same is a photocopy and hence cannot be marked.)
Ex.D22	The printout of the Chennai Broadcasting Corporation – TV ads Tax invoices. (The counsel for th plaintiff objects on the ground that the same is a photocopy and hence cannot be marked.)
Ex.D23	The printout of the TV News 5 – Shreya Broadcasting Private Limited – Tax Invoices. (The counsel for the plaintiff objects on the ground that the same is a photocopy and hence cannot be marked.)
Ex.D24	The printout of the Television Advertisements – Clippings Photography.
Ex.D25	The printout of the Distributors/Dealers Showroom Display Advertisements Photos.
Ex.D26	The printout of the Expo/Exhibition Advertisement Photography.
Ex.D27	The printout of the Photographs taken at various events sponsored by the Respondent.
Ex.D28	The printout of Advertisement Van Photography.
Ex.D29	The printout of the Advertisement Hoarding Board Photography
Ex.D30	The printout of the Carton Box Photography
Ex.D31	The printout of the Product Photography
Ex.D32	The printout of the Other brands using pink and white.
Ex.D33	(Series) 38 Nos) are the original legal user certificates of third

Exhibits	Documents
	parties.
Ex.D34	The printout of the Certificate of registration of copyright bearing diary No.22723/2023-CO/A.
MO1	The product with the tags and pho card along with the packaging cover for Fly Birds Kurti Pant.

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To

The Registrar of Trade Marks,
Trade Marks Registry,
GST Road, Guindy, Chennai-600 032
India

SENTHILKUMAR RAMAMOORTHY J.

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<u>Pre-delivery common judgment made in</u>

<u>C.S.(Comm. Div.) No.182 of 2023</u>
<u>&</u>
<u>(T) OP(TM) No.10 of 2024</u>

30.04.2025