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IN THE HIGH COURT OF JUDICATURE AT BOMBAY

ORDINARY ORIGINAL CIVIL JURISDICTION

LEAVE PETITION NO.306 OF 2014

IN

SUIT (L) NO.1067 OF 2014

Indchemie Health Specialties Pvt. Ltd. ...Plaintiff

vs

Intas Pharmaceuticals And Anr. ...Defendants.

.....

Mr. Mahesh Mahadgut, for the Plaintiff.

Mr. Venkatesh Dhond, Senior Counsel, a/w. Mr. Adheesh Nargolkar, Mr. Shailendra Bhandare, Mr. Rashmin Khandekar, Mr. R.A. Iyer and Ms. Vidhi Kotak, i/b. Khaitan & Co., for Defendant No.1.

....

AND

NOTICE OF MOTION (L) NO.2540 OF 2014

IN

SUIT (L) NO.1067 OF 2014

Mr. Mahesh Mahadgut, for the Plaintiff.

Mr. Shailendra Bhandare, i/b. Khaitan & Co., for Defendant No.1.

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CORAM : S.C. GUPTE, J.

DATED: JANUARY 14, 2015

P.C.:

. This Leave Petition is taken out by the Plaintiff in a trademark infringement and passing off suit, under Clause XIV of the Letters Patent. The Leave Petition is on the footing that Plaintiff's suit for

infringement of its registered trademark is maintainable before this Court and that under Clause XIV of the Letters Patent, the Plaintiff be permitted to combine the cause of action for passing off with the cause of action for infringement of trademark in the proposed suit. The cause of action for passing off arises outside the jurisdiction of this Court.

2. The Plaintiff claims to be the registered proprietor of the trademark "CHERI" in class 5 in respect of pharmaceutical preparations. It is the Plaintiff's case that the Defendants have been using an identical mark or a deceptively similar mark with the addition of a word, namely, "MULTI CHERRY" for similar goods. It is the Plaintiff's case that such use by the Defendants not only amounts to infringement of the Plaintiff's registered trademark but results into passing off of the Defendants' goods as the goods of the Plaintiff. The Plaintiff carries on business in Mumbai and its goods are available in Mumbai. It is claimed that by virtue of Section 134 of the Trade Marks Act, 1999, the Plaintiff is entitled to file the present suit for infringement of its registered trademark within the jurisdiction of this Court. Having regard to the fact that the same set of facts, as are averred towards the Plaintiff's case of infringement, give rise to the cause of action of passing off, the Plaintiff has prayed for leave under Clause XIV for combining the causes of action for infringement and passing off.

3. The application is opposed by the Defendants on two grounds : Firstly, it is submitted that the cause of action for infringement not having arisen within the jurisdiction of this Court, no leave can be granted under Clause XIV of the Letters Patent for

combining the cause of action for passing off with that of infringement. Secondly, it is submitted that the suit for infringement, as framed, is *ex facie* not maintainable and that, in the premises, no leave ought to be granted for combining the causes of action. Mr. Dhond, learned Senior Counsel appearing for the Defendants, relies on a judgment of this Court in the case of **Jagdish Gopal Kamath Vs. Lime & Chilli Hospitality Services Pvt. Ltd.**¹ in this behalf.

4. Clause XIV of the Letters Patent reads thus :

"And We do further ordain that where plaintiff has several causes of action against a defendant, such causes of action not being for land or other immovable property, and the said High Court shall have original jurisdiction in respect of one of such causes of action, it shall be lawful for the said High Court to call on the defendant to show cause why the several causes of action should not be joined together in one suit, and to make such order for trial of the same as to the said High Court shall seem fit."

5. The requirement of Clause XIV, as may be seen even from a bare reading of the Clause, is that the High Court shall have original jurisdiction in respect of one of the several causes of action which are available to a plaintiff against a defendant. It is not necessary that such cause of action ought to have arisen within the jurisdiction of the High Court. A court has jurisdiction in respect of a cause of action not only on the ground that such cause of action arises within the territorial limits of

¹ Petition No.972 of 2012, S.J. Kathawalla, J. dtd. 22/4/2013

its jurisdiction but even on other grounds such as residence or business of the defendant within the local limits of its jurisdiction. In the case of Section 134(2) of the Trade Marks Act, 1999, a registered proprietor of a trademark can institute a suit for infringement in a district court within the local limits of whose jurisdiction at the time of institution of the suit, the registered proprietor actually or voluntarily resides or carries on business or personally works for gain. Thus, in the case of an infringement action, this Court has jurisdiction in respect of the subject matter of dispute by reason of the residence or business of the plaintiff proprietor. Once it is clear that the Court has jurisdiction in respect of the cause of action for infringement by reason of the residence or business of the plaintiff being within the jurisdiction of the Court, this Court can legitimately call upon the defendant to show cause why the other cause of action claimed by the plaintiff, namely, passing off by the defendant of his goods as those of the plaintiff, cannot be combined with the cause of action for infringement. I am fortified in this view by a judgment of a learned Single Judge of this Court in **UltraTech Cement Limited Vs Shree Balaji Cement Industries**.² The first objection of the Defendants, thus, has no merit.

6. As for the second objection, it is submitted by Mr. Dhond that the Plaintiff in the present case holds registration of its trademark CHERRI in respect of pharmaceutical preparations. It is submitted that the Defendants' goods, in respect of which the Defendants use the offending mark MULTY CHERRY, are not pharmaceutical preparations but are dietary supplements intended to supplement a normal diet and to

² Petition No.369 of 2013, S.J. Kathawalla, J. dtd. 18 January 2014

have health benefits. It is submitted by Mr. Dhond that the Defendants have found out after a search in the Trade Marks Registry that the original specification of goods for which the Plaintiff applied for registration in class 5 was medicinal and pharmaceutical preparations and that on a specific objection raised by the Trade Marks Registry, the Plaintiff agreed to amend the specification to read simply as "pharmaceutical preparations". It is submitted that this fact has been suppressed by the Plaintiff from this Court. In the premises, it is submitted by Mr. Dhond that *ex facie* the Plaintiff's registration, restricted as it is merely to pharmaceutical preparations, does not cover the goods in relation to which the Defendants use their offending mark. Relying on the judgment of this Court in **Jagdish Gopal Kamat** (supra), it is submitted that *ex facie* the suit for infringement, as framed by the Plaintiff, is not maintainable and, therefore, this Court ought not to grant leave to combine the two causes of action. No doubt it is true, as held by this Court in **Jagdish Gopal Kamat** (supra), that if the suit as filed is on its face not maintainable and it is nothing but an abuse of process of law or court, the Court may well refuse to grant leave under Clause XIV of the Letters Patent. The rationale of this principle is that grant of leave in such a circumstance itself is nothing but a total abuse of the process of law or court. The requirement, however, is that the Court must be in a position to arrive at the conclusion that the suit as framed is not maintainable without there being any need to consider any defence to the suit and that such suit must amount to an abuse of the process of law or court. In the present case, whether the goods, in respect of which the Defendants use their mark, are pharmaceutical preparations or not is not free from doubt. Secondly, by placing reliance on the material of the

trademark application of the Plaintiff and the response of the Registry thereto and the amendment of the Plaintiff's application after such response, which are not forming part of the plaint, the Defendants require the Court to consider material other than what appears on the face of the plaint and which material also calls for an enquiry. This is not permissible for the Court to do whilst exercising powers under Clause XIV of the Letters Patent. On the reading of the plaint it is by no means clear that the suit is *ex facie* not maintainable or that it amounts to abuse of the process of law or court. There is, thus, no merit in this defence either.

7. The Leave Petition of the Plaintiff is, accordingly, allowed and the Plaintiff is granted leave under Clause XIV of the Letters Patent for combining the causes of action for passing off and infringement in the suit herein. There shall be no order as to costs.

8. The Motion is also on board today at Sr. No.7. Learned Counsel for the Defendants seeks a short adjournment. The Motion is shown for ad-interim reliefs. It may come up on board on 20 January 2015. In view of the fact that the pleadings are already complete, the parties are put to notice that the Motion may be heard finally at the ad-interim stage.

(S.C. GUPTE, J.)