



C.S.(Comm.Div)No.822 of 2013

IN THE HIGH COURT OF JUDICATURE AT MADRAS

Judgment reserved on	18.04.2022
Judgment pronounced on	09.06.2022

CORAM

The Hon'ble Mr. Justice **SENTHILKUMAR RAMAMOORTHY**

Civil Suit(Com. Div) No.822 of 2013

- 1.Unimed Technologies Limited,
Part -A, Dadha Nagar, Near Kowl Bazar,
Pozhichalur, Pallavaram,
Chennai – 600 074.
Rep. by its Constituted Attorney
Mr.Srikant Nahata.
- 2.Sun Pharmaceutical Industries Limited,
CD Plot No.3, Door No.8,
Old Tower Block Street,
Nandhanam Extension,
Chennai – 600 035,
Rep. by its Constituted Attorney,
Mr.P.Natesan.
- 3.Sun Pharmaceutical Medicare Limited,
SPARC, Tandalia, Vadodara,
Vadodara GJ 390 012.
(Amended as per order in
A.No.2625/2021 dated 17.08.2021) ... Plaintiffs

vs.



C.S.(Comm.Div)No.822 of 2013

1.Cadila Healthcare Limited,
Zydus Tower,
Satellite Cross Roads,
Ahmedabad – 380 015.

2.Zydus Healthcare Limited,
Zydus Tower,
Satellite Cross Roads,
Sarkej Gandhinagar Highway,
Ahmedabad – 380 015.
(Amended as per order in A.No.7943 of 2019
dated 13.09.2019)

... Defendants

The suit is filed under Order VI Rule 1 of O.S. Rules and Order VII Rule 1 of CPC r/w Sections 27,28, 29, 134 and 135 of the Trade Marks Act,1999, praying for (a) a permanent injunction restraining the Defendants, its manufacturers, distributors, stockists, servants, agents, wholesalers, retailers, legal representatives or any other person claiming under it from in any manner manufacturing, selling offering for sale, stocking, advertising directly or indirectly dealing in medicinal and pharmaceutical preparations infringing the trademark HYVISC of the first Plaintiff registered under No.751852 in class 5 by use or deceptively similar trademark ZYVISC or any mark identical or similar to Plaintiff's registered trademark HYVISC in any manner whatsoever;



C.S.(Comm.Div)No.822 of 2013

(b) A permanent injunction restraining the Defendants, its manufacturers, distributors, stockists, servants, agents, wholesalers, retailers, legal representatives or any other person claiming under it from in any manner manufacturing, selling offering for sale, stocking, advertising directly or indirectly dealing in medicinal and pharmaceutical preparations under the trademark ZYVISC or any other trademark that is identical to and/or deceptively similar to the Plaintiff's trademark HYVISC and / or use similar packaging as that of the Plaintiff's products so as to pass off their medicinal preparations as and for the medicinal preparations of the Plaintiff's in any manner whatsoever;

(c) The Defendants be ordered to pay to the Plaintiff a sum of Rs.1,00,000/- as liquidated damages for committing acts of infringement against Plaintiff's trademark so as to pass off its products as and for the Plaintiffs' products;

(d) The Defendants be ordered and decreed to deliver up for destruction to the Plaintiff all the preparations, dies, blocks, label, packaging either filled or empty, brochures, leaflets, pamphlets, hand bills, hoardings, wall posters, calendars, carry bags, stationery items and such other sales



C.S.(Comm.Div)No.822 of 2013

promotional materials bearing and / or containing the impugned trademark

ZYVISC;

(e) A preliminary decree be passed in favour of the Plaintiffs directing the Defendants to render accounts of profits made by it by use of the almost identical trademark ZYVISC or any mark identical thereto and a final decree be passed in favour of the Plaintiffs for the amount of profits found to have been made by the Defendants after the latter has rendered accounts ; and (f) for cost of the entire proceedings.

For Plaintiffs : M/s.Arun C.Mohan and
Mrs.Brinda Mohan

For Defendant : M/s.C.Daniel and
Mrs.Gladys Daniel

JUDGMENT

The suit was filed as a rolled-up action to restrain alleged trademark infringement and passing off. Consequential and ancillary remedies for payment of a sum of Rs.1,00,000/- as liquidated damages, delivery of allegedly infringing materials for destruction, a preliminary



decree for rendition of accounts followed by a final decree of profits and costs were prayed for.

2. The first Plaintiff is a manufacturer of bulk pharmaceutical drugs. The second Plaintiff is engaged in manufacturing and marketing active pharmaceutical ingredients. According to the Plaintiffs, in course of business, a company called Milmet Laboratories Private Limited adopted the mark HYVISC in the year 1997 in respect of medicinal preparations used in the treatment of dry eyes and to accelerate the healing process after cataract operations. The aforesaid company applied for registration of the above mentioned mark under the Trade Marks Act,1999 (the Trade Marks Act). While the application for registration was pending, Milmet Laboratories Private Limited merged with the second Plaintiff herein. Consequently, the second Plaintiff became the proprietor of the trademark HYVISC. Subsequently, the second Plaintiff assigned the mark to one Sholapur Organics Pvt. Ltd. under a deed of assignment dated 01.04.2002. Sholapur Organics Pvt. Ltd. assigned the mark HYVISC to the first Plaintiff, Unimed Technologies Ltd., under a deed of assignment dated 01.07.2007. In this manner, the first Plaintiff became the exclusive



C.S.(Comm.Div)No.822 of 2013

proprietor of the mark HYVISC. The mark HYVISC is registered under No.751852 in class 5 in respect of "medicinal, pharmaceutical and veterinary preparations and substances included in class 5". While the suit was pending, the first Plaintiff assigned various marks, including the mark, Hyvisc, to the third Plaintiff. Therefore, the third Plaintiff applied for and was impleaded in the suit by order dated 17.08.2021 in Application No.2624 of 2021.

3. The Plaintiffs state that substantial and significant sales of ophthalmic preparations under the mark HYVISC were effected between the financial years 2008 - 2009 and 2012 - 2013. The Plaintiffs assert that on account of extensive publicity, long and continuous use, the trademark HYVISC has come to be identified exclusively with the Plaintiffs. The Plaintiffs state that they came across the Defendants' medicinal preparations bearing the mark ZYVISC, which is alleged to be phonetically, structurally and ocularly almost identical to the Plaintiffs' registered trademark HYVISC. The Plaintiffs further state that their products and those of the Defendants are prescribed for treatment of dry eyes and to accelerate the healing process after cataract operations. Since both the marks are very similar and are used



in respect of similar or identical products, it is stated that deception and confusion are probable and not merely likely. The Plaintiffs also state that the adoption of the mark ZYVISC by the Defendants is deliberate, *mala fide* and dishonest.

4. The Defendants state that they manufacture and market several medicinal preparations and hold more than 400 patents. One of the brands of the Defendants is "ZYVISC". The Defendants further state that they proposed changes to the mark "ZYVISC" upon receipt of the pre-suit notice dated 04.12.2013 but no further progress could be made on the said proposal because of the failure of the Plaintiffs to respond to such proposal. According to the Defendants, they had no knowledge of the Plaintiffs' trademark "HYVISC" at the time of adoption of the mark "ZYVISC". The Defendants state that the mark "ZYVISC" was adopted by taking the prefix "ZY" from the house mark of the Defendants, namely, "ZYDUS". As regards the suffix "VISC", it refers to viscoelasticity, which is a characteristic of the products. The Defendants state that the suffix "VISC" is common to the trade in relation to ophthalmic products. In order to substantiate the statement, the Defendants rely upon the website of the Trademarks Registry



reflecting about 65 marks with the suffix "VISC"(Ex.D4). The Defendants further state that their product "ZYVISC" is used in a sterile syringe with a grip and a sterile single use cannula. Since it is a schedule 'H' drug, it is stated that members of the public will not be confused with regard to the origin of the said products.

5. The Defendants further state that there is no need for the Defendants to piggyback on the Plaintiffs' reputation. The Defendants assert that the Plaintiffs have failed to prove confusion, loss of business or reputation. The Defendants also state that this Court does not have jurisdiction because the first and second Plaintiffs have their registered offices at Vadodara and the Defendants' registered offices are at Ahmedabad.

6. Upon completion of pleadings, this Court framed the following issues on 25.09.2019:

(1) Whether the Trademark ZYVISC is distinct and distinguishable as a coined word?



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(2) Whether the Defendant is infringing the Plaintiffs' registered trademark HYVISC by using a deceptively similar trademark ZYVISC?

(3) Whether the defendant's adoption of an identical mark amounts to passing off of the Plaintiffs' trademark HYVISC?

(4) Whether the Plaintiff is entitled for rendition of true and faithful accounts of all the profits earned by the Defendant using the Plaintiffs' trademark and whether it amounts to profit?

(5) To what other reliefs the parties are entitled to?

7. By order dated 19.01.2022, this Court recorded that the parties do not propose to adduce oral evidence. Accordingly, the documents filed by the Plaintiffs were marked as Exs.P1 to P12 and those filed by the Defendants were marked as Exs.D1 to D7. Oral submissions on behalf of the Plaintiffs were made by Mr.Arun C.Mohan, learned counsel, and on



C.S.(Comm.Div)No.822 of 2013

behalf of the Defendant by Mrs.Gladys Daniel, learned counsel. Both parties also submitted written arguments.

8. The Defendants pleaded at paragraph 19 of the written statement that this Court does not have jurisdiction to entertain the suit. Although this Court did not frame an issue on jurisdiction, this aspect warrants consideration since it was pleaded. As stated at the outset, the suit was filed as a rolled-up action for alleged trademark infringement and passing-off. Therefore, Section 134 of the Trade Marks Act is applicable. In terms thereof, the suit may be filed where one or more of the Plaintiffs reside or carry on business or personally work for gain. Since the Plaintiffs are corporate entities, the only material consideration is whether any of the Plaintiffs carry on business at Chennai. The Plaintiffs specified the addresses of both the first and second Plaintiff at Chennai. As pointed out by the Defendants, this is not the registered office address. The Defendants also relied on the judgment of the Hon'ble Supreme Court in *Indian Performing Rights Society Ltd. v. Sanjay Dalia (2015) 10 SCC 161 (IPRS)* to contend that the suit is not maintainable before this Court merely because the branch office of the first and second Plaintiff is at Chennai. **IPRS** is an authority for



C.S.(Comm.Div)No.822 of 2013

the proposition that Section 134(2) of the Trade Marks Act enables the filing of a suit where the plaintiff actually carries on business and is not intended to enable the filing of a suit at a place where a branch office is situated although the entire cause of action arose where the relevant plaintiff's principal place of business is situated. In substance and effect, the Supreme Court held that the enabling provision should not be abused by filing the suit at a place which has a tenuous or flimsy connection with the case. In this case, both the first and second Plaintiffs carry on business at Chennai. The Defendants have not controverted this statement except by stating that the registered office is at Baroda. The Plaintiffs have also asserted that the impugned mark is used on products sold commercially at Chennai and have exhibited a sales invoice (Ex.P-10) indicating commercial sale at Chennai. Although the Defendants pleaded, in their written statement, that the Plaintiffs failed to prove commercial sale at Chennai, the invoices filed by the Defendants (Ex.D-3) evidence commercial sale at Chennai. Therefore, it cannot be said that the Plaintiffs do not carry on business at Chennai. Besides, at least a part of the cause of action arose at Chennai. Therefore, the preliminary objection of the Defendants on jurisdiction is overruled.



Issue No. 1 and 2

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9. The first and second issues relate to whether the Defendants' trademark ZYVISC is distinct and distinguishable as a coined word and whether the Defendants are infringing the Plaintiffs' registered trademark HYVISC by using a deceptively similar trademark ZYVISC. Since these two issues are closely inter-related, they are dealt with jointly.

10. The first contention of the Plaintiffs was that the trademark "HYVISC" was adopted in or about the year 1997. The said mark was initially adopted by Sholapur Organics Private Limited on 01.04.2002 and thereafter assigned to the first Plaintiff on 01.07.2007. While the suit was pending, it was assigned to the third Plaintiff. As the registered proprietor of the trademark, the Plaintiffs contended that they are entitled to prevent infringement and passing off by the Defendants. The Plaintiffs contended that the impugned mark "ZYVISC" is phonetically, structurally and ocularly deceptively similar to the mark "ZYVISC", and that the similarities are such that even pharmacists were likely to confuse the products of the Defendants with those of the Plaintiffs. On this issue, the Plaintiffs relied upon the judgment of the Hon'ble Supreme Court in *Cadila Health Care Ltd v.*



C.S.(Comm.Div)No.822 of 2013

Cadila Pharmaceutical Ltd, AIR 2001 SC 1952, wherein the Court referred

to a judgment of a US court to the effect that even physicians are not immune from confusion or mistake.

11. The Plaintiffs further contended that the composition and strength of their products vary in comparison to the Defendants' products and that, therefore, considerable harm could be caused to patients who mistakenly consume the Defendants' products instead of the Plaintiffs'. From the evidence on record, it appears that the Plaintiffs' product "HYVISC" contains a 1% (or less) solution of sodium hyaluronate solution whereas the Defendants' product contains a 2% solution of hydroxypropyl methylcellulose ophthalmic solution USP. The Plaintiffs next contended that the trademark "HYVISC" has acquired secondary meaning through long, extensive and continuous use. By relying on the judgment of the Division Bench of this Court in *Blue Hill Logistics and another v. Ashok Leyland [2011 (4) CTC 417 (DB)]*, the Plaintiffs contended that they are entitled to the statutory presumption under Section 29(3) of the Trade Marks Act.



12. The Plaintiffs also contended that the two marks should be examined as a whole and not by breaking-up the mark into its elements. In support of this proposition, the Plaintiffs referred to and relied upon the judgment of the Division Bench of this Court in *Ciba Geigy Ltd. and another v. Crossland Research Laboratories Ltd (1995 PTC 251)*, wherein this Court held that the two rival marks should be considered as a whole, and that the true test is whether there is likelihood of confusion or deception in the minds of persons consuming the relevant products upon looking at the marks as a whole. In response to the contention of the Defendants that the suffix "VISC" is common to the pharmaceutical trade, the Plaintiffs contended that the Defendants have not adduced any evidence in the form of cartons, labels or bills. The Plaintiffs contended that the alleged usage of similar marks by third parties does not constitute a valid defence by relying on the judgment of the Delhi High Court in *Hindustan Pencils Limited v. J.N. Ghosh and Brothers Private Limited [2007 (34) PTC 49 Del]*. For the same proposition, the Plaintiffs also relied on the judgment of the Division Bench of the Bombay High Court in *Cadila Pharmaceuticals Limited v. Sami Khatib of Mumbai, Indian inhabitant, 2011 SCC Online Bom. 484*. The Plaintiffs also relied upon the judgment of the Calcutta High Court in



Strassenburg Pharmaceuticals v. Himalaya Drug Company, 2002 (24) PTC

441 (Cal), wherein the Calcutta High Court held that the deletion of the vowel 'a' from "EFACID" and the addition of the suffix "ca" instead does not distinguish the defendant's mark and that the two marks are deceptively similar notwithstanding these minor changes.

13. Likewise, the Plaintiffs relied on the Division Bench judgment of this Court in *Blue Hill Logistics and another v. Ashok Leyland 2011 (4) CTC 417 (DB)*, wherein the words "Luxura" and "Luxuria", were held to be variants of the descriptive term "luxury". Nevertheless, on account of the prior registration of the mark "Luxuria", the plaintiff therein was granted relief. The Plaintiffs also relied upon the fact that the mark "HYVISC" has been used from the year 1997 and that the subsequent adoption of the mark "ZYVISC" by the Defendants is *mala fide* and dishonest. Therefore, it was contended that the Defendants are liable.

14. On the contrary, the Defendants contended that they coined the unique word "ZYVISC" by combining two elements, namely, "ZY" and "VISC". The prefix "ZY" is drawn from the house name "ZYDUS" and the



suffix “VISC” from elasto-viscosity, which is a characteristic of the products and commonly used in relation to ophthalmic products. In order to establish that the suffix "VISC" is used extensively in the trade, the Defendants relied upon an Internet report of the Trademarks Registry and an updated report, which are marked as Ex.D4 and Ex.D7, respectively. Likewise, the Defendants relied upon an Internet report from the Trademarks Registry reflecting marks with the prefix "ZY", which was marked as Ex.D6. The Defendants also contended that their mark "ZYVISC" was adopted *bona fide* and honestly and that the said mark is both visually and phonetically different from the Plaintiffs' trademark. By relying on the judgment in *M/s.Lakme Ltd. v. M/s.Subhash Trading, 1996 (64) DLT 251*, the Defendants pointed out that the Delhi High Court refused to grant relief to the plaintiff in respect of the trademark "Lakme" although the defendant sold products under the name "Likeme".

15. Upon considering the rival contentions on these issues and the evidence on record, it should be noticed at the outset that the evidence on record discloses conclusively that the word mark "HYVISC" was first registered on 25.07.1997. The said registration is under Class 5 and



C.S.(Comm.Div)No.822 of 2013

pertains to medicinal, pharmaceutical and veterinary preparations and substances included in Class 5. The said registration was valid up to 25.07.2017. Although the Defendants contended that the renewed certificate is not on record, there is no doubt that the registration was valid as on the date of institution of the suit. The question whether the Defendants are liable for infringement and passing off should be tested as on the date of institution of the suit and, therefore, the non-production of the renewal certificate is not relevant. The Plaintiffs have also established the devolution of title by duly exhibiting documents evidencing change of proprietorship (Ex.P2). Indeed, all the parties involved in the devolution of title have been arrayed as Plaintiffs. Thus, the Plaintiffs have established that they are the registered proprietors of the trade mark "HYVISC". In addition, the Plaintiffs have established prior adoption and use with effect from 1997.

16. This leads to the question whether the use of the impugned mark "ZYVISC" constitutes infringement of the registered trade mark "HYVISC". The principal defence of the Defendants is that the mark "ZYVISC" consists of two elements, namely, "ZY" and "VISC". As regards the first element "ZY", it is stated that the said element is drawn from the



house mark “Zydus”. With regard to the second element "VISC", it is stated that the said element is common to the trade in ophthalmic products and is used widely. In an action for infringement of trademark, dishonest adoption is not an essential pre-requisite although it is a material consideration for the grant of relief. The real test is whether the impugned mark is identical or deceptively similar. Without doubt, the two marks are not identical. As regards deceptive similarity, the Defendants contended that the marks are distinctive and not phonetically or visually similar. The question whether the two rival marks are phonetically or visually similar should be judged with the eye, ear and even mind by looking at the marks as a whole. Such judgment should be made by putting oneself in the shoes of a consumer of average intelligence and imperfect recollection. Before undertaking such exercise, it may be relevant to take into account the context in which these drugs are prescribed and administered. The admitted position is that both the Plaintiffs and the Defendants manufacture and market ophthalmic products under the respective marks. While the Plaintiffs' manufacture two products, namely, the "HYVISC" Eye Drops and "HYVISC Plus", the Defendants manufacture and market "ZYVISC" Ophthalmic Solution and "ZYVISC PFS". “HYVISC Eye Drops” is a lubricant used in the treatment of



dry eyes. "HYVISC Plus" is used in eye surgeries to prevent damage to the cornea and is also used in the treatment of osteoarthritis, and is intended to be administered intra-ocularly (i.e. within the eye). As regards "Hyvisc Eye Drops", it appears to be a product which may be applied by the patient in a home environment. On the contrary, Hyvisc Plus appears to be a product used in course of eye surgeries, which is administered intra-ocularly. Likewise, the Zyvisc Ophthalmic Solution appears to be a lubricant used for dry eyes and is, therefore, likely to be purchased by the patient on a prescription and applied in a home environment. Zyvisc PFS, like Hyvisc Plus, appears to be a product used in course of eye surgeries. Therefore, this product would be prescribed by doctors and administered intra-ocularly in a hospital or ophthalmic clinic. Even in a hospital environment, however, it is likely that either the patient or the attender may be called upon to procure the medicine albeit under a prescription. Therefore, as regards the intra-ocular products, the risk of deception and confusion is mitigated but not eliminated, whereas, as regards the patient administered eye drops, the risk is higher.



17. Notwithstanding the nuances discussed above, the two marks are phonetically similar. Even visually, there is considerable similarity and both products are used in the treatment of ophthalmic conditions. Although the likelihood of confusion is reduced when a product is administered in a hospital setting, given the phonetic and ocular similarity of the two marks, the likelihood of confusion cannot be discounted. Therefore, it has to be held that the impugned mark ZYVISC is deceptively similar to the Plaintiffs' registered trade mark "HYVISC".

Issue No.3

18. Issue No.3 relates to whether the Defendants are passing off their goods as those of the Plaintiffs. While an action for trademark infringement is founded on the Plaintiffs' proprietary interest in intangible property, an action for passing off is founded on the tort of deceit. Consequently, the burden of proof is higher. In this case, the goods are substantially similar and the marks are also similar. The evidence on record indicates that the Plaintiffs adopted the mark in the year 1997, whereas the Defendants adopted the mark much later. The explanation provided by the Defendants with regard to the reasons for adoption of the mark ZYVISC



support the inference that the initial adoption was not *mala fide* but does not constitute a valid defence to the charge of infringement and passing off. In any case, the continued use of the mark ZYVISC especially in relation to ophthalmic products is likely to cause confusion amongst potential consumers of the relevant products. Therefore, the Plaintiffs are entitled to injunctive reliefs both in respect of infringement and passing off.

19. The 4th issue pertains to whether the Plaintiffs are entitled to rendition of accounts. In view of the conclusion that the Defendants are guilty of infringement and that the continued use of the impugned mark is likely to cause deception or confusion, the Plaintiffs are entitled to a preliminary decree for rendition of accounts, including particulars of profits earned by the sale of products bearing the infringing mark. On the basis of the loser pays principle, the Plaintiffs are also entitled to costs.

20. In the result, the suit is decreed by granting the reliefs prayed for as prayer a, b and d of paragraph 21. In addition, the Plaintiffs are entitled to a preliminary decree directing the Defendants to render accounts of profits made by selling products bearing the mark ZYVISC. The



C.S.(Comm.Div)No.822 of 2013

Plaintiffs are also entitled to costs assessed in a sum of Rs.3 lakhs, which includes court fees, lawyer's fees and other expenses. Since no evidence was adduced with regard to the claim for liquidated damages of Rs.1,00,000/-, the said claim is rejected.

09.06.2022

Index : Yes

Internet : Yes

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Plaintiffs' witnesses: Nil

Defendants' witnesses: Nil

Documents exhibited by the Plaintiffs:

Sl.No	Exhibits	Date	Particulars of Documents
1.	Ex.P1	25.07.1997	Certificate for registration of trademark HYVISC under No.751852 class 5.
2.	Ex.P2	-	Application filed by the first Plaintiff and its predecessor to effect change of proprietorship in the Trademarks Register along with respective fee receipts.
3.	Ex.P3	-	Invoice for sale of HYVISC
4.	Ex.P4	13.11.2013	Chartered accountant certificate of sales figures in respect of HYVISC
5.	Ex.P5	-	Product brochure for HYVISC
6.	Ex.P6	-	Extracts from medical journals listing the



C.S.(Comm.Div)No.822 of 2013

Sl.No	Exhibits	Date	Particulars of Documents
			plaintiffs' mark HYVISC
7.	Ex.P7	06.06.2013	Cease and desist notice issued plaintiffs.
8.	Ex.P8	27.06.2013	Reply issued by defendant
9.	Ex.P9	06.11.2013	Reminder issued by the Plaintiffs
10.	Ex.P10	-	Invoice proving sale of defendant's ZYVISC
11.	Ex.P11	-	Carton of Plaintiffs' HYVISC
12.	Ex.P12	-	Carton of Defendants' ZYVISC

Documents exhibited by the Defendants:

Sl. No.	Exhibits	Date	Particulars of Documents
1.	Ex.D1	-	Catalogue of the Defendant displaying their trademark ZYVISC
2.	Ex.D2	-	Copy of the turnover details for the Defendants' product bearing the trademark ZYVISC
3.	Ex.D3	-	Copy of the invoices for the Defendants' product bearing the trademark ZYVISC
4.	Ex.D4	-	The internet report from the Trademarks Registry website reflecting about 65 marks with the suffix VISC.
5.	Ex.D5	-	Affidavit of Mr.D.Venkatakrishnan filed under Section 65B of the Indian Evidence Act, 1872.
6.	Ex.D6	-	Internet report from the Trademarks Registry Website reflecting marks with the prefix "ZY"
7.	Ex.D7	-	The internet report from the Trademarks Registry website reflecting about 65 marks with the suffix VISC.

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C.S.(Comm.Div)No.822 of 2013

SENTHILKUMAR RAMAMOORTHY, J.

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Pre-Delivery Judgment

C.S.No.822 of 2013



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C.S.(Comm.Div)No.822 of 2013

09.06.2022