



WEB COPY



A.No.5354 of 2022
in C.S (Comm.Div.) (D) No.94590 of 2022

A.No.5354 of 2022
in C.S (Comm.Div.) (D) No.94590 of 2022
(Filing Number)

M.SUNDAR, J.,

Captioned application has been taken out with a 'Leave to Sue' ['LTS'] prayer qua intended plaintiff in the captioned C.S (Comm.Div.) (D) No.94590 of 2022 (Filing Number).

2. At the time of presentation of intended plaintiff on 29.08.2022, plaintiff presented the same without an LTS application. Registry raised objections, the matter was listed before this Commercial Division under the caption 'FOR MAINTAINABILITY' and after hearing counsel for applicant, proceedings dated 18.11.2022 were made as learned counsel said he would take out an LTS application.

3. The aforementioned maintainability note and 18.11.2022 proceedings are as follows:



WEB COPY



A.No.5354 of 2022
in C.S (Comm.Div.) (D) No.94590 of 2022

THE HON'BLE MR. JUSTICE M.SUNDAR

C.S.D.NO.94590 OF 2022

It is respectfully submitted that M/s M.S.Rivanti, Akshaya P Section, S.Hari Vallabhi, Ravi Kumar Natarajan, Reshma Rajagopal and Nethra M, counsel for the plaintiff filed the plaint in C.S.D.No.94590/2022 praying to (a) A permanent injunction restraining the Defendants, their partners, their employees, officers, servants, agents, and all others acting for and on their behalf from manufacturing, selling, distributing, exporting, advertising, offering for sale, any products and in any other manner, directly or indirectly, dealing with any products in the name of "TECHISUMO" and / or TEXMO which is deceptively similar or phonetically identical and visually with colour combination similar to the Plaintiff's well-known registered trademark "TEXMO" amounting to an infringement of the Plaintiff's registered trademarks bearing number 315019 in class 7, 315050 in class 7, 819833 in class 7, 794420 in class 4, 794425 in class 2, 794426 in class 11, 794431 in class 11, 794432 in class 22, 794433 in class 23, 794464 in class 23, 794434 in class 24, 794438 in class 09, 794417 in class 25, 794465 in class 24, 794418 in class 26, 794441 in class 03, 794442 in class 02, 794424 in class 03, 794436 in class 18, 794448 in class 14, 794454 in class 26, 794460 in class 19, 3898379 in class 11, 1645256 in class 07, (b) A permanent injunction restraining



A.No.5354 of 2022
in C.S (Comm.Div.) (D) No.94590 of 2022

WEB COPY

the Defendant, their partners, their employees, officers, servants, agents and all others acting for and on their behalf from manufacturing, selling, distributing, exporting, advertising, offering for sale, and in any other manner, directly or indirectly, dealing with any products in the name of 'TECHSUMO' and / or TEXMO amounting to passing off, (c) A permanent injunction restraining the Defendant, their partners, their employees, officers, servants, agents and all others acting for and on their behalf from using impugned mark "TECHSUMO" and / or TEXMO or any mark which is deceptively similar and or phonetically identical and visually with colour combination similar to the Plaintiff's well-known registered trademark "TEXMO" in any of the websites, domain names, social media platforms, mobile application and other intermediaries in any language. (d) The Defendant be ordered to pay the Plaintiff a sum of 25,00,000 (Rupees Twenty-five lakhs) as damages for having committing infringement of the plaintiff's registered trademark, passing off trademark dilution and tarnishment of trademark in respect of the mark "TEXMO", (e) A preliminary decree be passed in favour of the Plaintiff directing the Defendant to render true and proper accounts of the profits arising out of the number of sales generated by the Defendant in respect of their alleged activities especially sale and export of products bearing the mark 'TECHSUMO' and / or TEXMO for their business, after the latter have rendered accounts and (f) To grant order of delivery up of any brochures/ printed material



WEB COPY



A.No.5354 of 2022
in C.S (Comm.Div.) (D) No.94590 of 2022

and/or any material bearing TECHSUMO and / or TEXMO which infringes Plaintiffs' well known registered trademark 'TEXMO'

It is further submitted that while scrutinizing the plaint C.S.DNo.94590/2022 the plaintiff and the defendant are outside the Jurisdiction of this Hon'ble Court and part of cause of action arose within the jurisdiction of this Hon'ble court by supplying and selling impugned products by infringing the plaintiff's product. Hence the registry returned the plaint with the following endorsement along with other returns:

State as to how the suit can be entertained before this Hon'ble Court since the plaintiff and defendant are outside the Jurisdiction of this Hon'ble Court – clarify.

The counsel for the plaintiff represented the plaint with the following endorsement:

Leave to sue is not required since the defendant has admitted to have availability in Chennai. Therefore, Leave to sue is not required. Further it is a settled law that any suit under Section 134 of the Trade Marks Act does not require Leave to Sue, may be posted for Maintainability.



A.No.5354 of 2022
in C.S (Comm.Div.) (D) No.94590 of 2022

WEB COPY

It is submitted that, as per Clause 12 of Letters Patent, If the cause of action, arisen in part, within the Ordinary Original Jurisdiction of this Hon'ble Court, leave of the court should have been obtained first. Hence the Registry is having doubt as to whether leave of the Hon'ble Court under Clause 12 of Letters Patent is required for the suits instituted under Section 134 of Trade Mark Act especially in this suit as both plaintiff and defendant having their address outside the Jurisdiction of this Hon'ble Court.

In the above said circumstances, kind orders of your Lordship are solicited as to whether the plaint in C.S.D.No.94590/2022 may be posted for Maintainability.

MOST RESPECTFULLY SUBMITTED

Pb
9/11/2022

Proceedings dated 18.11.2022

'Captioned matter is listed under the cause list caption 'FOR MAINTAINABILITY'.

2. Mr.R.Sathish Kumar along with Mr.V.S.Krishna, learned counsel representing Mr.Ram Kumar Natarajan, counsel on record for plaintiff, is before this Commercial Division.

3. Main suit is for the reliefs qua alleged infringement and alleged passing off qua a registered Trademark of the plaintiff and the product (this Commercial Division is informed) is submersible



A.No.5354 of 2022
in C.S (Comm.Div.) (D) No.94590 of 2022

pumps. This matter came up for maintainability owing to objection that an application under Clause 12 of Letters Patent has to be taken out in the light of the defendant not being within the jurisdiction of this Commercial Division.

4. Learned counsel submits that he would come up with an application under Clause 12 of Letters Patent and then advance his submissions. Learned counsel requests that all contentions including the contention regarding need for a Clause 12 application may please be preserved. Request acceded to.'

5. As learned counsel for plaintiff has to come up with the Clause 12 application, no further orders are required on Maintainability. If a Clause 12 of Letters Patent application is filed by the plaintiff, the same shall be processed in accordance with law.' '

4. As regards the compliance of the counsel for applicant that '..... it is settled law that a suit under Section 134 of the Trademarks Act does not require Leave to Sue....' came up for consideration.

5. At the outset, captioned suit is not one under Section 134 of 'The Trademarks Act, 1999' [hereinafter 'TM Act' for the sake of brevity] though Section 134 comes into play. It is effectively a suit under Sections 11 and 27 of TM Act and most importantly, it is to be noted that



it is also a common law action as limb (b) of the prayer paragraph (paragraph 67 of intended plaint) seeks relief for passing off. There are seven limbs of reliefs in the plaint [sub-paragraph (a) to (g)] and paragraph 67 being the prayer paragraph can be usefully reproduced hereunder:

'PRAYER

67. The Plaintiff therefore humbly prays that this Hon'ble Court may be pleased to pass a judgment and decree on the following terms:

*a. A **permanent injunction** restraining the Defendant, their partners, their employees, officers, servants, agents, and all others acting for and on their behalf from manufacturing, selling, distributing, exporting, advertising, offering for sale, any products and in any other manner, directly or indirectly, dealing with any products in the name of "TECHSUMO" and / or TEXMO which is deceptively similar or phonetically identical and visually with colour combination similar to the Plaintiff's well known registered trademark "TEXMO" amounting to an infringement of the Plaintiff's registered trademarks bearing number 315049 in class 7, 315050 in class 7, 819813 in class 7, 794420 in class 4, 794425 in class 2, 794426 in class 11, 794451 in class 11, 794432 in class 22, 794433 in class 23, 794464 in class 23, 794434 in class 24, 7944438 in class 09, 794417 in class 25, 794465 in class 24, 794418 in class 26, 794441 in class 03, 794442 in class 02, 794424 in class 03, 794436 in class 19, 794448 in class 14, 794454 in class*



26, 794460 in class 19, 3898579 in class 11, 3646256 in class 07.

b) A **permanent injunction** restraining the defendant, their partners, their employees, officers, servants, agents and all others acting for and on their behalf from manufacturing, selling, distributing, exporting, advertising, offering for sale and in any other manner, directly or indirectly, dealing with any products in the name of “**TECHSUMO**” and / or **TEXMO** amounting to **passing off**.

c) A **permanent injunction** restraining the defendant, their partners, their employees, officers, servants, agents and all others acting for and on their behalf from using impugned mark “**TECHSUMO**” and / or **TEXMO** or any mark which is deceptively similar and or phonetically identical and visually with colour combination similar to the Plaintiff's well-known registered trademark “**TEXMO**” in any of the websites, domain names, social media platforms, mobile application and other intermediaries in any language.

d) The defendant be ordered to pay the plaintiff a sum of Rs.25,00,000/- (Rupees Twenty-five-lakhs) as **damages** for having committing infringement of the plaintiff's registered trademark, passing off trademark dilution and tarnishment of trademark in respect of the mark “**TEXMO**”

e) A preliminary decree be passed in favour of the plaintiff directing the Defendant to **render true and proper accounts** of the profits arising out of the number of sales generated by the defendant in respect of their alleged activities especially sale and export of products bearing the mark “**TECHSUMO**” and / or **TEXMO** for



A.No.5354 of 2022
in C.S (Comm.Div.) (D) No.94590 of 2022

their business, after the latter have rendered accounts.

*f) To grant order of **delivery up** of any brochures / printed material and/or any material bearing “**TECHSUMO**” and / or **TEXMO** which infringes Plaintiffs' well known registered trademark “**TEXMO**”.*

g) Costs and such other relief as this Hon'ble Court may deem fit, in the circumstance of the case, in the interests of justice and equity.'

The note and proceedings supra are telltale and they speak for themselves. Therefore it is not necessary to dilate on the same any further.

6. There is no difficulty in accepting the submission that Section 134(2) is available for prayers limbs (a) and (c) as Section 134(2) is available for prayers under Section 134(1) (a) and (b) (not Section 134(1) (c) of TM Act). However, as regards limb (b) of the prayer, obviously Section 134 (2) is not available. Absent Section 20 of 'The Code of Civil Procedure, 1908' ['CPC' for the sake of brevity] one has to take resort to Clause 12 of Letters Patent. To be noted, there will be further discussion about this elsewhere infra.



A.No.5354 of 2022
in C.S (Comm.Div.) (D) No.94590 of 2022

7. Before that, it is necessary to say that limbs (d) to (g) of plaint prayer are not restricted to limbs (a) and (c). They pertain to limb (b) also.

8. This takes us back to limb (b) of plaint prayer paragraph and Clause 12 of Letters Patent. In an attempt to justify the compliance that it is settled law that LTS application is not required for a suit under Section 134 of TM Act, learned counsel referred to Clause 12 of Letters Patent and submitted that Clause 12 will not come into play when the cause of action has 'wholly' arisen within the territorial jurisdiction of this Court. What the territorial jurisdiction of this Court is and how it has to be determined is an another conundrum which will be dealt with in orders where it is imperative but that can be put aside in this case as Plaintiff Document No.33, being an invoice dated 17.11.2021, is in the heart of the city and is indisputably within the jurisdiction of this Commercial Division. However, this question is left open if there is a revocation application. To be noted, a scanned reproduction of plaint document No.33 is as follows:



A.No.5354 of 2022
in C.S (Comm.Div.) (D) No.94590 of 2022

WEB COPY

The image shows a scanned document with a header section containing the 'TECHSUMO' logo and various fields for case details. The document is mostly blank with some handwritten text at the bottom.

9. After a careful reading of limb (b) of the prayer paragraph, this Commercial Division wanted to know from the learned counsel for applicant as to whether the reliefs sought for qua passing off is limited to passing off action within the territorial jurisdiction of this Commercial Division. The answer was in the negative. This means that as regards passing off action and the relief sought qua passing off action, it cannot



A.No.5354 of 2022
in C.S (Comm.Div.) (D) No.94590 of 2022

be gainsaid that the cause of action has arisen 'wholly' within the territorial jurisdiction of this Court. Learned counsel emphatically submitted that the relief is qua passing off in the whole of Tamil Nadu and may be other territories outside Tamil Nadu also (pan India).

10. As already alluded to supra, prayer limbs (d) to (g) are dovetailed with prayer limb (b) also and they are not restricted to limb (a) & (c). This means that as regards prayer limb (b), this Commercial Division will have jurisdiction over a part of the cause of action. The sequitur is, LTS is imperative in the case on hand. Further sequitur is, this Commercial Division should now decide as to whether this Commercial Division will exercise jurisdiction over the entire suit. The answer is fairly simple and it is in the affirmative. It is in the affirmative because the relief qua passing off is dovetailed with reliefs of infringement of registered trademarks besides damages, rendition of accounts and other incidental / ancillary reliefs. If the plaintiff were to file separate passing off suits in the respective Commercial Courts in the various Districts or if the plaintiff were to file separate suit for passing off and infringement, there is a high degree of possibility of an anomalous situation emerging, if different orders are passed by different



A.No.5354 of 2022
in C.S (Comm.Div.) (D) No.94590 of 2022

Courts and there may even be conflict of orders. It is in this context that this Commercial Division observed that the answer is very fairly simple and in the affirmative.

11. Clause 12 phenomenon besides interplay between Section 20 CPC and Clause 12 of Letters Patent was examined by this Court in ***Captain Tractors Pvt. Ltd., Vs. Ashok Leyland Ltd.***, reported in **2018 SCC OnLine Mad 13669**. Relevant paragraph is sub-paragraph (w) of Paragraph 7 and the same reads as follows:

' 7(w) From the narrative supra, it will emerge clearly that the sole defendant placed reliance on Section 20 CPC which is inapplicable to this Court in the light of Section 120 CPC. This takes us to Clause 12 of Letters Patent. In the earlier part of this order, this Commercial Division has alluded to the dynamics and dimensions of Clause 12, i.e., kinds/categories of suits and situations qua territorial jurisdiction with regard to suits other than suits for land. Therefore, it is deemed appropriate to refer to one judgment of Hon'ble Supreme Court which has examined interplay if any between Section 20 CPC and Clause 12 of Letters Patent. This is Jindal Vijayanagar Steel (JSW Steel Ltd.) v. Jindal Praxair Oxygen Co. Ltd., reported in (2006) 11 SCC 521. Relevant paragraph is paragraph 50 and the same reads as follows:

'50. The principles of Section 20 cannot be made applicable to clause 12 of the Letters Patent since CPC itself by Section 120 specifically excludes the applicability of Section 20 CPC to the Chartered High Courts. It is submitted that when CPC itself



provides that Section 20 is specifically excluded, the principles of Section 20 cannot be made applicable or be attracted when a corporation is being sued under the Letters Patent. The judgment of this Court in Sarguja Transport case [(1987) 1 SCC 5 : 1987 SCC (Cri) 19] cannot apply for the following reasons:

(i) The principles of CPC were made applicable to writ petitions on the premise that these would not be contrary to the provisions of Article 226.

(ii) If the appellant's argument is accepted it would render Section 120 CPC nugatory and otiose since Section 120 expressly refers to three sections (i.e. Sections 16, 17 and 20) and makes them inapplicable.

(iii) The Letters Patent, is a special charter conferring jurisdiction on the Chartered High Courts. When there is a special enactment such as the Letters Patent, which expressly lays down the criteria on the jurisdiction of the Chartered High Court, it is totally unnecessary and in fact futile to refer to another legislation such as CPC (which is not applicable) to determine the jurisdiction of the Chartered High Court.

(iv) The facts in Sarguja Transport case [(1987) 1 SCC 5 : 1987 SCC (Cri) 19] Were entirely different since there was no corresponding legislation which laid down the territorial (sic jurisdiction) of the Court exercising writ jurisdiction.



A.No.5354 of 2022
in C.S (Comm.Div.) (D) No.94590 of 2022

Thus the judgment of this Court in Sarguja Transport case [(1987) 1 SCC 5 : 1987 SCC (Cri) 19] cannot be applied in the facts of the present case.

My understanding of aforesaid judicial principle laid down by Supreme Court means that Section 20 CPC and Clause 12 of Letters Patent are not twins or siblings, but are distant cousins, who have to be read in their respective realms.

To be noted, the above order was carried in appeal by way of an intra-court appeal and a Hon'ble Division Bench by order dated 24.01.2020 in O.S.A.No.483 of 2018 dismissed the Original Side Appeal.

12. Learned counsel also pressed into service WIPRO case law [***Wipro Limited and another Vs.Oushadha Chandrika Ayurvedic India (P) Limited and Ors.*** reported in ***2008-2-L.W.430***] (penned by Hon'ble Justice A.P.Shah as Chief Justice of this Court, as his Lordship then was) in support of his contention that Section 134 excludes Clause 12. There are two facets to this matter. From the order placed before this Commercial Division, it is not clear as to whether there was passing off prayer in those suits. Paragraph 3 which captures plaint prayers reads as follows:



A.No.5354 of 2022
in C.S (Comm.Div.) (D) No.94590 of 2022

WEB COPY

'3.C.S. No.874 of 2007 is filed by the plaintiffs for a permanent injunction restraining the defendants from infringing their registered trade mark "Chandrika" and from manufacturing, selling, advertising and offering for sale, soaps or toilet preparation with prefix or suffix with the expression "Chandrika". In C.S. No.996 of 2007, the plaintiffs seek a permanent injunction restraining the defendants from infringing their copyright "Chandrika" and the colour scheme and get-up and restraining them from reproducing by selling, advertising or offering for sale, soaps by using the impugned copyright "Chandrika".

13. This Commercial Division therefore requisitioned the suit files in C.S.No.874 of 2007, C.S.No.996 of 2007, perused the plaint and the suit prayer are as follows:

Prayer in C.S.No.874 of 2007

*“(a)granting a permanent injunction, restraining the Defendants by itself, its servants, agents, distributors or anyone claiming through them from manufacturing, selling, advertising and offering for sale using the registered Trade Mark **CHANDRIKA** or OUSHADHA **CHANDRIKA** or **CHANDRIKA** upon soaps or any goods or in any media and use the same in invoices, letter heads and visiting cards or by using any other trade mark with prefix or suffix with the expression **CHANDRIKA** or any other similar sounding expression which is in any way visually, phonetically or deceptively similar to the Plaintiffs Registered Trade Mark **CHANDRIKA** or in any manner infringing the Plaintiffs Registered Trademark Nos.304121, 210561, 210560, 395616, 503956, 503957 and 454994 for soaps.*



A.No.5354 of 2022
in C.S (Comm.Div.) (D) No.94590 of 2022

(b) *granting a permanent injunction, restraining the Defendants by themselves, their servants, agents, men or anyone claiming through them from manufacturing, marketing, distributing, offering or advertising for sale soaps or any toilet preparation of all kinds using the Mark OUSHADHA **CHANDRIKA** or **CHANDRIKA** or its color scheme and get up as shown in Document No.2 in the course of their business and pass of their soaps of all kinds using the Plaintiffs Trade Mark **CHANDRIKA** or its color scheme and get up of the cartons of the Plaintiff goods as shown in Document No.1 or enable others to pass off by using deceptive marks.*

(c) *Directing the Defendants to surrender to the Plaintiffs all the soaps, packing materials, cartons, advertisement materials and hoardings, letter-heads, visiting cards, office stationery and all other materials containing/bearing the Trade Mark **CHANDRIKA** or **OUSHADHA CHANDRIKA** and other deceptively similar Trade Marks in respect of soaps.*

(d) *For a preliminary decree in favour of the Plaintiffs, directing the Defendants to render an account of profits made by them by the use of the Trade Mark **CHANDRIKA** or **OUSHADHA CHANDRIKA** on the goods referred and for a final decree in favour of the plaintiff for the amount of the profits found to have been made by the Defendants, after the Defendants have rendered accounts:*

(e) *directing the Defendants to pay to the Plaintiffs the costs to the suit; and*

(f) *pass such further or other order, as this Hon'ble Court*



WEB COPY



A.No.5354 of 2022
in C.S (Comm.Div.) (D) No.94590 of 2022

may deem fit and proper in the circumstances of the case and thus render justice.'

'Prayer in C.S.No.996 of 2007

*(a) granting a permanent injunction, restraining the Defendants, by themselves, their servants, agents, distributors, or anyone claiming through them from reproducing by selling, advertising and or offering for sale by using the impugned Copyright **CHANDRIKA** as shown in Document No.2 upon the goods or in any media and use the same in invoices, letter heads and visiting cards or by using any other Copyright which is any way visually, phonetically or deceptively similar to the Plaintiffs Registered Copyright **CHANDRIKA** the picture mark as shown in Document No.1 or in any manner infringing the Plaintiffs Copyright as shown in Document No.1.*

*(b) granting a permanent injunction, restraining the Defendants by themselves, their servants, agents, men, or anyone claiming through them from manufacturing, marketing, distributing, offering or advertising for sale soaps or any toilet preparation of all kinds using the Mark **USHADHA CHANDRIKA** or **CHANDRIKA** or its color scheme and get up as shown in Document No.2 in the course of their business and pass off their soaps of all kinds using the Plaintiffs Trade Mark **CHANDRIKA** or its color scheme and get up of the cartons of the Plaintiff goods as shown in Document No.1 or enable others to pass off by using deceptive marks and names.*



A.No.5354 of 2022
in C.S (Comm.Div.) (D) No.94590 of 2022

*(c) Directing the Defendants to surrender to the Plaintiffs all the soaps, packing materials, cartons, advertisement materials and hoardings, letter-heads, visiting cards, office stationery and all other materials containing/ bearing the Trade Mark **CHANDRIKA** or **OUSHADHA CHANDRIKA** and other deceptively similar Trade marks in respect of soaps.*

*(d) For a preliminary decree in favour of the plaintiffs, directing the Defendants to render an account of profits made by them by the use of the Trade Mark **CHANDRIKA** or **OUSHADHA CHANDRIKA** on the goods referred and for a final decree in favour of the plaintiff for the amount of the profits found to have been made by the Defendants, after the Defendants have rendered accounts:*

(e) directing the Defendants to pay to the Plaintiffs the costs to the suit, and

(f) pass such further or other order, as this Hon'ble Court may deem fit and proper in the circumstances of the case and thus render justice.'

14. This means that reliefs qua passing off have also been sought in above suits and this takes us to the other facet of the matter and that is WIPRO does not go into the question of passing off action which is a common law remedy and therefore, WIPRO does not come to the aid of the applicant in the case on hand.



WEB COPY



A.No.5354 of 2022
in C.S (Comm.Div.) (D) No.94590 of 2022



A.No.5354 of 2022
in C.S (Comm.Div.) (D) No.94590 of 2022

WEB COPY

15. If there is a revocation application by the defendant (subject of course to the suit crossing Section 12A of CCA barrier) all these issues will still be available for the defendant to canvass in the revocation application without being impeded by this order.

16. Leave granted with the above rider. Captioned LTS application ordered in the above manner. There shall be no order as to costs.

28.11.2022

gpa



WEB COPY



A.No.5354 of 2022
in C.S (Comm.Div.) (D) No.94590 of 2022

M.SUNDAR.J.,

gpa

A.No.5354 of 2022
in
C.S (Comm.Div.) (D)No.94590 of 2022
(Filing No.)

28.11.2022