



A.No.4062 of 2023
C.S.(Comm Div.)DR.No.45549 of 2023

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED : 20.09.2023

CORAM

THE HONOURABLE MS.JUSTICE P.T. ASHA

A.No.4062 of 2023
in
C.S.(Comm Div.)DR.No.45549 of 2023

1.M.Balaji

Partner of M/s Optix Healthcare,
No.8-A, Gandhi Street, Velmurugan Nagar,
Bye Pass Road,
Madurai - 625010
Tamil Nadu, India

2.M.Maria Parthiban

Partner of M/s Optix Healthcare,
V 4/86, Park Nagar, Ayyalamman Padithurai
Kudamuruthy Palam, Kambarasam Pettai (Post)
Trichy - 620102.
Tamil Nadu, India

... Applicants/Plaintiffs

Vs.

Baskaran S.

Partner of M/s Optix Healthcare,
P.NO.93, 4th Cross Street,
Marvel River View County, Near City Union Bank,
Manapakkam,
Kanchipuram -6000125
Tamil Nadu, India

...Defendant/Respondent



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PRAYER in A.No.4062 of 2023: This application is filed under XIV Rule 8 and Order III Rule 1 of the O.S.Rules read with Clause 12 of the Letters Patent praying to grant leave of Court to the applicants to sue for the infringement of copyright, Trademarks and passing off by the respondent herein before this Court.

PRAYER in C.S.(Comm.Div).Dr. No.45549 of 2023:

a) A permanent injunction restraining the Defendant, his directors, all his principal officers, staffs, their men, agents, servants, successors, assigns in business representatives and any other person from passing off his/their goods using the impugned trademark " OPTIXX HEALTH CARE" or any other word/words/logo/artistic work/design/device that are identical or deceptively similar to that of the Plaintiffs' trademark" OPTIXX HEALTH CARE" "or product in respect of medicinal services.

b) A permanent injunction restraining the Defendant, his directors, all his principal officers, staffs, their men, agents, servants, successors, assigns in business representatives and any other person from infringing the



Copyright of the Plaintiffs " OPTIXX HEALTH CARE" by using impugned artistic work" OPTIXX" or any other word/words/logo/artistic work/design/device that are identical or deceptively similar to that of the Plaintiffs artistic work and products in respect of medicinal services.

c) A permanent injunction restraining the Defendant, his directors, all his principal officers, staffs, their men, agents, servants, successors, assigns in business representatives and any other person from passing off his/their goods using the impugned mark" OPTIXX" "or any other word/words/logo/artistic work/design/device that are identical or deceptively similar to that of the Plaintiffs' mark"OPTIX Health Care" product in respect of medicinal services.

d) A permanent injunction restraining the Defendant, his directors, all his principal officers, staffs, men, agents, servants, successors, assigns in business representatives and any other person from infringing the Trademark of the Plaintiffs " X-Tears". by using the impugned mark "X-TEARS" or any other letter/word/words/device that are identical or deceptively similar to the



said registered trademark of the Plaintiffs having Application No: 3803445 in Class 05 in respect of medicinal services.

e) A permanent injunction restraining the Defendant, its directors, all his principal officers, staffs, their men, agents, servants, successors, assigns in business representatives and any other person from person from passing off his/their goods using the impugned trademark "X-TEARS" or any other word/words/logo/artistic work/design/device that are identical or deceptively similar to that of the Plaintiffs' trademark "X-Tears" having the Trademark Application No. 3803445 in Class 05 in respect of medicinal services.

f) A permanent injunction restraining the Defendant, his directors, all his principal officers, staffs, men, agents, servants, successors, assigns in business representatives and any other person from infringing the Trademark of the Plaintiffs "Y-Naat" "by using the impugned mark "Y NAAT" or any other letter/word/words/device that are identical or deceptively similar to the said registered trademark of the Plaintiffs having Application No: 3803446 in



Class 05 in respect of medicinal services.

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g) A permanent injunction restraining the Defendant, its directors, all his principal officers, staffs, their men, agents, servants, successors, assigns in business representatives and any other person from person from passing off his/their goods using the impugned trademark "Y NAAT" or any other word/words/logo/artistic work/design/device that are identical or deceptively similar to that of the Plaintiffs' trademark "Y-Naat" having the Trademark Application No. 3803446 in Class 05 in respect of medicinal services.

h) A permanent injunction restraining the Defendant, his directors, all his principal officers, staffs, men, agents, servants, successors, assigns in business representatives and any other person from infringing the Trademark of the Plaintiffs "flurb" by using the impugned marks "FLURB" and "FLURBEL" or any other letter/word/words/device that are identical or deceptively similar to the said registered trademark of the Plaintiffs having Application No: 3803447 in Class 05 in respect of medicinal services.



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i) A permanent injunction restraining the Defendant, its directors, all his principal officers, staffs, their men, agents, servants, successors, assigns in business representatives and any other person from person from passing off his/their goods using the impugned trademarks "FLURB" and "FLURBEL" or any other word/words/logo/artistic work/design/device that are identical or deceptively similar to that of the Plaintiffs' trademark "flurb" having the Trademark Application No. 3803447 in Class 05 in respect of medicinal services.

j) A Preliminary Decree be passed in favour of the Plaintiffs directing the Defendant to render a true and faithful accounts of all profit made by them, using the Plaintiffs' said Trademarks and a final Decree be passed in favour of the Plaintiffs for the amount of profit thus found to have been made by the Defendant, together with interest, after the Defendant has rendered accounts.



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k) That the Defendant be directed to deliver-up to the Plaintiffs for destruction, all labels, all other print materials, stickers, signage, visiting cards, letter heads, catalogues, pamphlets, brochures, all other advertising, and promotional material, all stationary, and such other material used for passing off and violating plaintiffs' trademark.

l) . for the costs of the suit; and

g) pass such other or further orders as this Hon'ble Court deems fit, in the interest of justice.

For Plaintiffs : M/s.Ramesh Ganapathy

ORDER

The above application is filed seeking the leave of Court to sue the respondent/defendant for the infringement of copyright, Trademarks and passing off of the applicant's mark before this Court.

2. The affidavit filed in support of the leave to sue application does not contain the reasons as to how this Court gets jurisdiction. There is no plea that the cause of action has arisen within the jurisdiction of this Court.



However, a perusal of the plaint would show that the plaintiff has put forward a statement that cause of action has arisen within the jurisdiction of this Court where the partnership deed dated 21.01.2016 has been executed. However, a perusal of the above-referred partnership deed would show that the plaintiffs herein are both residing at Madurai and Trichy respectively and the defendant has shown to be residing at Iyyapanthangal, Chennai. The memorandum of understanding dated 15.12.2021 also shows the residence of the respondents at Madurai and Trichy respectively and the defendant at Iyyapanthangal, Chennai.

3. They have primarily rested their cause of action within the jurisdiction of this Court on the basis that the trademarks have been registered within the jurisdiction of this Court. They would contend that the trademark have been applied for and registered with the Trademarks Registry at Chennai which gives them the jurisdiction to institute the suit here.

4. The cause of action is also sought to be conferred on this Court on the basis that the legal notices have been sent from Chennai and other letters



to the Registrar of Trademark and to the Assistant Director of Drugs Control Chennai has also been dispatched from Chennai. That apart, they have also rested their case on an application under Section 11(6) of the Arbitration and Conciliation Act having been filed on the file of this Court. To put it in a nutshell jurisdiction sought to be conferred on this Court for the following reasons:-

- (a) The trademarks of the applicant is registered with the Trademarks Registry at Chennai,
- (b) The legal notices and other letters have been sent from Chennai.
- (c) The petition for appointment of an Arbitrator u/s. 11(6) of the Arbitration and Conciliation Act, 1996 has been filed on the file of this Court.

5. Let us now consider whether the aforesaid reasons would confer jurisdiction on this Court. The registration of trademarks with the Trademarks Registry, Chennai does not confer jurisdiction on this Court as held by this Court in the judgement of ***Duro Flex Pvt. Ltd. vs. Duroflex Sitings System [2014 5 LW 673]***,. In the said judgement, the Full Bench of



this Court was considering the issue as to whether the situs of the Trade Marks registry would confer jurisdiction. The bench had raised the following issues for consideration, which are extracted herein :-

(i) Whether the situs of the Trade Mark Registry in Chennai and the name being on its register would itself give rise to cause of action to institute a suit in the Madras High Court?

(ii) Whether the principles of Forum Conveniens or analogous principles apply for consideration of an application for leave to sue under Clause 12 of the Letters Patent in case part of cause of action arises at Chennai? It is the aforesaid two legal questions that have arisen for our consideration.

The Full Bench had answered the issues as follows:

“We thus conclude on this question by observing that the fact that the situs of the registration of Trade Marks is with the Trade Marks Registry at Chennai by itself would not be



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sufficient to give rise to cause of action to institute the suit in the Madras High Court, though it may be a factor to be taken into account, among the bundle of facts, for purposes of determining the situs of the cause of action. The legal view to the contrary expressed in the various judgments referred to by the learned counsel for the appellant thus stands overruled.”

6. The second reason is the dispatch of the letters and legal notice from Chennai would confer jurisdiction on this Court. This by no stretch of imagination would confer jurisdiction as this cannot be considered as a factor giving rise to a cause of action. The third reason is the filing of the Section 11 (6) petition. As per the Arbitration and Conciliation Act it is only the Hon'ble Chief Justice or any person designated by him who can entertain and pass orders on a petition filed u/s.11(6) of the Arbitration and Conciliation Act.



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7. Therefore, none of the reasons given for invoking the jurisdiction of this Court can be taken into consideration. Even the reference in the deed that it has been signed at Chennai would not confer jurisdiction on this Court. Both the plaintiff and the defendant are residing/carrying on business/working for gain outside the jurisdiction of this Court.

8. In fine, the leave to sue is declined, the plaint shall be returned to the plaintiff for presentation before the proper forum.

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Index:Yes/No
Speaking order/Non-speaking order
Neutral Citation:Yes/No
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P.T. ASHA, J.

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