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O.S.A. (CAD) No. 96 of 2021

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 20.06.2023

CORAM :

THE HON'BLE MR. SANJAY V.GANGAPURWALA, CHIEF JUSTICE

AND

THE HON'BLE MR.JUSTICE P.D.AUDIKESAVALU

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Ashique Exports (P) Ltd.
Represented by its Managing Director,
Mr.P.C. Thahir "Thai Enclave",
No.57, West Madha Church Road,
Royapuram,
Chennai – 600 013.

.. Appellant

Vs

1. Suresh K.K.
Trading as M/s. Shastha Industries,
Pattimattom P.O.,
Kizhakkambalam,
Ernakulam Pin – 683 562,
Kerala.
2. S&B Industries,
Represented by its Proprietor,
Suresh K.K.
Kanninadu – 682 310,
Ernakulam,
Kerala.
3. Sastha Traders,
Represented by its Proprietor Suresh K.K.,
Pattimattom P.O., Kizhakkambalam,
Ernakulam, Pin – 683 562,
Kerala.

.. Respondents



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Prayer: Appeal Clause 15 of the Letters Patent read with Section 13 of the Commercial Courts Act, 2015 to set aside the order dated 04.11.2020 made in C.S. No. 643 of 2012 and to allow the above appeal.

For the Appellant : Mr. P.Radhakrishnan

For the Respondents : Ms. S.Suba Shiny

JUDGMENT

(Judgment of the Court was made by P.D.AUDIKESSAVALU, J.)

This intra-court appeal invoking Clause 15 of the Letters Patent, 1865, read with Section 13 of the Commercial Courts Act, 2015 (hereinafter referred to as 'the Commercial Act' for short) arises out of the judgment and decree dated 04.11.2020 passed in C.S. No. 643 of 2012 on the file of the Original Side of this Court.

2. The parties are hereinafter referred to as per their description in the suit for the sake of clarity and convenience.

3. The Plaintiff, which is a company registered under the Companies Act, 1956, claims to be a leading manufacturer of soap and detergent and doing extensive business in marketing of the washing soap adopting



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the trademark 'Super Wash – 555' from 01.01.1997 onwards for which registration was applied on 24.03.1997 and the Trademark Registry allocated Trademark Application No. 749397 with certificate dated 28.03.2008 with effect from 24.03.1997 for the same. It is further stated that the said trademark, which was honestly conceived by the Plaintiff, has become distinctive of the goods of the Plaintiff and none else. While so, the Plaintiff came to know in May 2012 that the Defendants have commenced business using an identical soap wrapper consisting of the words 'Super Wash' for the soap manufactured by them with ulterior motive to pass off their goods as that of the Plaintiff. After making an enquiry relating to the business activities of the Defendants, the suit in C.S. No. 643 of 2012 has been laid by the Plaintiff claiming the following reliefs:-

- (a) granting permanent injunction restraining the Defendants by themselves, their servants or agents or anyone claiming through them from in any manner infringing the Plaintiff's Trade Mark 'Super Wash' and 'Super Wash – 555' washing soap by using the similar or deceptively similar Trade Mark on the wrapper together with any write up or any other representation or words which are in any manner identical to and deceptively similar with the Trade Mark of the Plaintiffs on the defendant's products;



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- (b) granting permanent injunction restraining the Defendants by themselves, their servants or agents or anyone claiming through them from in any manner passing off the Defendant's washing soap 'Super Wash' washing soap bearing the offending trade mark with identical and/or deceptively similar colour scheme, get up and write up as and for the celebrated washing soap of the Plaintiff bearing the trade mark 'Super Wash - 555' washing soap, with peculiar get up and write up either by manufacturing or selling of offering for sale or in any manner advertising the Defendant's offending product 'Super Wash' to the public;
- (c) directing the Defendants to surrender to the Plaintiff the entire stock of unused offending 'Super Wash' washing soap wrappers together with blocks and dyes for destruction;
- (d) directing the Defendants to render a true and faithful account of the profits earned by it through the sale of the offending bath soap bearing the offending trade mark 'Super Wash' wrapper/carton and directing payment of such profits to the Plaintiffs for the infringement and passing off committed by the Defendants; and
- (e) directing to the Defendant to pay the Plaintiff the costs of the suit.

4. The Defendants had filed Written Statement disputing the claims of the Plaintiff relating to the carrying on business in the manufacture of



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soap and detergent using the Trademark 'Super Wash – 555' and has asserted that the Defendants have been manufacturing the product of hand made washing soap from 03.12.1997 prior to that of the Plaintiff, which has earned goodwill and reputation amongst the general public and customers. It is also explained that the words in the soap manufactured by the Defendants is in Malayalam language and marketed within the territory of Kerala and not outside that State and that there is no similarity in the product of the Plaintiff and that of the Defendants through the eye of the common man and on comparison of wrapper, the difference in the lay-out, colour combination and the letter font size could be noticed.

5. The following issues had been framed for trial on the basis of the pleadings of the parties:-

- “(i) Whether the Plaintiff is prior user of the trademark 'Super Wash – 555' ?;
- (ii) Whether the Defendants are passing off the product of the Defendants as that of the Plaintiff?
- (iii) Whether the Plaintiff is entitled to the relief as prayed for?; and
- (iv) To what other reliefs the Plaintiff is entitled to?”



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6. While determining the first issue as to whether the Plaintiff is the prior user of the Trademark 'Super Wash – 555', the Court noticed that the documents marked as exhibits by the Plaintiff in the suit are only photocopies, which are inadmissible in evidence, and despite objections raised at the time of marking the documents when the witnesses were examined, no effort had been taken by the Plaintiff to explain as to what had happened to the original documents, which had neither been produced nor atleast brought for comparison with the photocopies marked. At the same time, it has been duly taken note that the Defendants had been prudent to file the originals of the documents relied by them, such as, additional provisional registration certificate dated 24.08.1998 (**Ex.-D1**) issued by the small scale industries, bill book containing of the product 'Super Wash' made on 21.01.1998, and order placed by the Kerala State Civil Supplies Corporation in the year 1998 (**Ex.-D6**), in proof of their version of the case. Inasmuch as the photocopies of documents produced by the Plaintiff were inadmissible in evidence, the Court arrived at the conclusion that the claim of the Plaintiff remained unproved.

7. In respect of the second issue relating as to whether the Defendants are passing off their product as that of the Plaintiff, it has been pointed out that the Plaintiff had not obtained any leave under



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Clause 12 of the Letters Patent, 1865, to sue against the Defendants, who are not carrying on business within the territorial limits of jurisdiction of the Original Side of this Court and against whom no cause of action for passing off had also arising within such territorial limits. It was further held that Section 134 of the Trademarks Act, 1999, could not be relied by the Plaintiff at the place where it is carrying on business without showing that any part of the cause of action had also arisen at that place. As a consequence, that issue was also answered against the Plaintiff and the suit was dismissed by judgment and decree dated 04.11.2020 by the Court, which is assailed by the Plaintiff in this appeal.

8. We have heard Mr. P.Radhakrishnan, Learned Counsel for the Appellant and Ms. S.Suba Shiny, Learned Counsel for the Respondents and perused the materials placed on record, apart from the pleadings of the parties.

9. Learned Counsel for the Plaintiff strenuously pleads in this appeal that when there is no dispute raised by the Defendants relating to the authenticity of the photocopies of the documents produced by the Plaintiff, the Learned Judge ought not to have refused to refer to them in deciding the suit.



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10. At this juncture, it would assume significance that in the Written Statement filed by the Defendants, it had been stated at para 4 as follows:-

"4. The defendants denies the allegations made in Para 3 & 4 of the plaint as false, vexatious and unsustainable and invites the plaintiff to prove the same. This defendant is not aware as to whether the plaintiff is manufacturing and marketing among other products, soaps and detergents for several years and the same was registered with the trade mark registry or not regarding the wrapper colour, nature and structure of the plaintiff's product. It is for the plaintiff to prove the same beyond any reasonable doubt with concrete evidence."

Moreover, it has been specifically recorded at the time of examination of the witnesses of the Plaintiff that the Defendants have objected for the marking of the photocopies of the documents by the Plaintiff in this case. It is, no doubt, true that Rule 1 of Order XI of Code of Civil Procedure, 1908, as amended by the Commercial Courts Act, enables a Plaintiff to file a list of all documents along with its photocopies at the time of presentation of the plaint in the suit, but it is beyond any pale of doubt that such documents must be proved by primary evidence as stipulated in section 64 of Indian Evidence Act, 1872, at the trial in the suit. If it is intended by a party to prove a document by secondary



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evidence, the conditions mentioned in Section 65 of the Indian Evidence Act, 1872, would have to be strictly followed, which has not at all been carried out in this case. Inasmuch as the Plaintiff has not come forward with any explanation, much less in a satisfactory manner, as to why it has not been able to produce the originals of the documents for which photocopies had been produced, it would not be possible to accept the same as its evidence in the suit. While arriving at the conclusion that it would not possible to accept the photocopies of the documents marked by the Plaintiff as evidence without producing their originals, the Learned Judge has relied on the decision of the Hon'ble Supreme Court of India in **Shalimar Chemical Works Limited -vs- Surendra Oil and Dal Mills (Refineries)** [(2010) 8 SCC 423] where it has been held as follows:-

"15. On a careful consideration of the whole matter, we feel that serious mistakes were committed in the case at all stages. The trial court should not have "marked" as exhibits the xerox copies of the certificates of registration of trade mark in face of the objection raised by the defendants. It should have declined to take them on record as evidence and left the plaintiff to support its case by whatever means it proposed rather than leaving the issue of admissibility of those copies open and hanging, by marking them as exhibits subject to objection of



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proof and admissibility. The appellant, therefore, had a legitimate grievance in appeal about the way the trial proceeded.

16. The learned Single Judge rightly allowed the appellant's plea for production of the original certificates of registration of trade mark as additional evidence because that was simply in the interest of justice and there was sufficient statutory basis for that under clause (b) of Order 41 Rule 27. But then the Single Judge seriously erred in proceeding simultaneously to allow the appeal and not giving the respondent-defendants an opportunity to lead evidence in rebuttal of the documents taken in as additional evidence.

17. The Division Bench was again wrong in taking the view that in the facts of the case, the production of additional evidence was not permissible under Order 41 Rule 27. As shown above, the additional documents produced by the appellant were liable to be taken on record as provided under Order 41 Rule 27(b) in the interest of justice. But it was certainly right in holding that the way the learned Single Judge disposed of the appeal caused serious prejudice to the respondent-defendants. In the facts and circumstances of the case, therefore, the proper course for the Division Bench was to set aside the order of the learned Single Judge without



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disturbing it insofar as it took the originals of the certificates of registration produced by the appellant on record and to remand the matter to give opportunity to the respondent-defendants to produce evidence in rebuttal if they so desired. We, accordingly, proceed to do so."

In the light of the said principles, when it is apparent that no efforts have been taken by the Plaintiff in this case to produce the originals of the photocopies of the relevant documents till this stage of the proceedings, there is no scope to differ from what has been expressed by the Learned Judge in the impugned judgment in that regard.

11. It is not the case of any of the parties that the Defendants are either carrying on business or manufacturing or marketing their products within the territorial limits of the jurisdiction of the Original Side of this Court. This would obviously mean that the requirements of Clause 12 of the Letters Patent, 1865, have not been satisfied for the institution of the suit in the Original Side of this Court. Section 124 of the Trademarks Act, 1999, also cannot come to the aid of the Plaintiff when no part of the cause of action has arisen within the territorial limits of jurisdiction of the Original Side of this Court. This view taken is fortified by the ruling of the Hon'ble Supreme Court of India in ***Indian Performing Rights Society Limited -vs- Sanjay Dalia*** [(2015) 10 SCC 161].



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12. In view of the foregoing discussion, in the absence of any error in the impugned judgment warranting interference by this Court, the same has to be confirmed in this appeal.

In the result, the appeal, which is devoid of merits, is dismissed.

No costs.

(S.V.G., CJ.) (P.D.A., J.)
20.06.2023

Maya

Index : Yes

NCC : Yes

To:

1. The Sub Assistant Registrar,
Original Side,
Madras High Court,
Chennai - 600 104.



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AND
P.D.AUDIKESSAVALU, J.

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