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O.S.A(CAD)Nos.68, 69, 70, 71 & 72 of 2024

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED : 08.07.2024

CORAM

THE HONOURABLE MR.JUSTICE M.SUNDAR

and

THE HONOURABLE MRS.JUSTICE K.GOVINDARAJAN

THILAKAVADI

O.S.A(CAD)Nos.68, 69, 70, 71 & 72 of 2024

and

C.M.P.Nos.13581, 13587, 13580, 13586, 13592 & 13594 of 2024

in

O.S.A(CAD)Nos.68, 69, 70, 71 & 72 of 2024

Mahaluxmi Rubber Udyog
Rep. by its Partner
Mr.Sunny Jhamb

... Appellant in all OSAs

Vs.

1. MRF Limited
Represented by its Authorized Signatory
Mr.M.D.Paul

2. M/s.Amman Enterprises
12 LGN Road, Anna Salai
Border Thottam
Chennai, Tamil Nadu-600 002.

... Respondents in all OSAs



O.S.A(CAD)Nos.68, 69, 70, 71 & 72 of 2024

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OSA(CAD)No.68 of 2024 filed under Section 13(1) of the Commercial Courts Act, 2015 read with Order XXXVI Rule 9 of Original Side Rules, praying to set aside the order dated 16.04.2024 passed in O.A.Nos.170 of 2024 in C.S(Comm.Div)No.53 of 2024.

OSA(CAD)No.69 of 2024 filed under Section 13(1) of the Commercial Courts Act, 2015 read with Order XXXVI Rule 9 of Original Side Rules, praying to set aside the order dated 16.04.2024 passed in O.A.Nos.169 of 2024 in C.S(Comm.Div)No.53 of 2024.

OSA(CAD)No.70 of 2024 filed under Section 13(1) of the Commercial Courts Act, 2015 read with Order XXXVI Rule 9 of Original Side Rules, praying to set aside the order dated 16.04.2024 passed in O.A.Nos.172 of 2024 in C.S(Comm.Div)No.53 of 2024.

OSA(CAD)No.71 of 2024 filed under Section 13(1) of the Commercial Courts Act, 2015 read with Order XXXVI Rule 9 of Original Side Rules, praying to set aside the order dated 16.04.2024 passed in O.A.Nos.171 of 2024 in C.S(Comm.Div)No.53 of 2024.

OSA(CAD)No.72 of 2024 filed under Section 13(1) of the Commercial Courts Act, 2015 read with Order XXXVI Rule 9 of Original Side Rules, praying to set aside the order dated 16.04.2024 passed in O.A.Nos.168 of 2024 in C.S(Comm.Div)No.53 of 2024.

For Appellant	:	Mr.P.V.Balasubramanian Senior Counsel for Mr.Adarsh Ramanujan
For Respondent	:	Mr.M.S.Bharath



O.S.A(CAD)Nos.68, 69, 70, 71 & 72 of 2024

for R1

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J U D G M E N T

[Judgment of the Court was made by M.SUNDAR, J.,]

Captioned matters are in the Admission Board today.

2. Captioned intra-Court appeals i.e., 'Original Side Appeals' {hereinafter 'OSAs' for the sake of brevity} have been filed in this 'Commercial Appellate Division' {hereinafter 'CAD' for the sake of brevity} on 14.06.2024 assailing a 'common order dated 16.04.2024 being a common order in five applications namely, O.A.Nos.168, 169, 170, 171 and 172 of 2024 in C.S(Comm.Div.)No.53 of 2024' {hereinafter 'impugned common order' for the sake of convenience, clarity and brevity} on the file of Commercial Division of this Court.

3. Mr.P.V.Balasubramanian, learned Senior Counsel, instructed by Mr.Adarsh Ramanujan, counsel on record for sole appellant in all five captioned OSAs and petitioners in all six captioned 'Civil Miscellaneous



O.S.A(CAD)Nos.68, 69, 70, 71 & 72 of 2024

Petitions' {hereinafter 'CMPs' for the sake of brevity} and Mr.M.S.Bharath, learned counsel, who has lodged a caveat on behalf of first respondent are before us.

4. To be noted, appellant before us is D1 {'Mahaluxmi Rubber Udyog' [hereinafter 'Mahaluxmi' for the sake of brevity]}, R1 and caveator before us is the plaintiff {'MRF Limited' [hereinafter 'MRF' for the sake of brevity]} and R2 before us is D2 {'Amman Enterprises' [hereinafter 'Amman' for the sake of brevity]} before the Commercial Division in C.S.(Comm.Div)No.53 of 2024. Appellant / D1 has been served with suit summons on 03.04.2024. 120 days therefrom will elapse on 01.08.2024 but appellant as D1 has filed written statement with a Condonation of Delay on 12.06.2024 and we are informed that the same has been allowed on terms, terms have been complied and written statement has been taken on file. As regards R2, which is D2 before the Commercial Division, we find from the website (as confirmed by learned counsel for caveator) that D2 has been served with suit summons on 13.03.2024. 120 days therefrom will elapse on 11.07.2024 but D2 has not filed written statement until this day. In this scenario, after some



O.S.A(CAD)Nos.68, 69, 70, 71 & 72 of 2024

arguments, the main OSAs were taken up with the consent of both sides in the Admission Board itself. We make it clear that the order we propose to make will not in any manner affect the rights of D2 (R2 before us) and it would not even be affecting the rights of the plaintiff and D1. Therefore, we deem it appropriate to take up the main OSAs, with the consent of both sides in the Admission Board as there is adequate safety valve qua rights and contentions of D2 before the Commercial Division (R2 before this CAD).

5. We now plough into the matter. Considering the limited legal perimeter within which the captioned OSAs perambulate, factual matrix in a nutshell i.e., short facts shorn of elaboration or in other words, short facts imperative for appreciating this common order will suffice.

6. Short facts are that R1 before us which is on caveat i.e., MRF is the sole plaintiff in C.S.(Comm.Div.)No.53 of 2024; that as already alluded to supra, the lone appellant before us is D1 and R2 before us is D2; that the suit filed by MRF is vide a plaint dated 23.01.2024; that there are 10 limbs of prayers in the plaint; that prayers pertain to permanent injunctions as



O.S.A(CAD)Nos.68, 69, 70, 71 & 72 of 2024

regards (a) plaintiff's registered trade marks (b) connected letter device (c) trade dress / packaging / colour scheme / get up / layout (d) Artworks (e) dilution of the good will (f) a declaration that plaintiff's trademark is a well known trademark within the meaning of Section 2(1)(zg) of 'the Trade Marks Act, 1999' {hereinafter 'TM Act' for the sake of brevity} (g) rendition of accounts (h) delivery of alleged offending material (i) damages of Rs.50 Lakhs and (j) costs;

7. Before we proceed further though it may not be well within the remit of the captioned OSAs, we make it clear that the question as to whether a declaration qua well known trademark vide Section 2(1)(zg) of TM Act can be sought in the Court or as to whether it should be sought before the Registrar before the Trademark Registry (subject of course to judicial review by Court) qua *inter alia* Section 11 of TM Act is left open; that we stop with that and we express no opinion or view on the same in this order for two reasons and they are (i) it is not well within the remit of captioned OSAs and (ii) a Hon'ble Division Bench of this Court is in seizen of this question by way of a reference owing to two divergent views taken by



O.S.A(CAD)Nos.68, 69, 70, 71 & 72 of 2024

two Hon'ble single Benches; that however, we deem it appropriate to write

{for the sake of clarity} this as this order should not be construed as having

taken a view that such a declaration [well known trademark vide Section

2(1)(zg) of TM Act] can be sought in Court; that according to official

website of this Court, the date of institution of the suit is 01.03.2024; that

the first listing of applications along with suit before the Commercial

Division was on 05.03.2024; that Hon'ble Commercial Division ordered

notice returnable by 26.03.2024; that on 26.03.2024, D1 {Mahaluxmi} was

before the Commercial Division; that the Commercial Division made an

order saying that defendants shall change the colour scheme and get-up of

their packing label on or before 12.04.2024 and further held that on failure

to do so, interim injunction in five applications i.e., O.A.Nos.168 to 172 of

2024 will kick in but Hon'ble Commercial Division made it clear that interim

injunction is restricted only to colour scheme and get-up and not to word

mark i.e., Word Mark 'MRU' used by defendants; that in this 26.03.2024

order, the reference is to two defendants in plural but we are informed by

Mr.Adarsh Ramanujam that his predecessor counsel and he have filed

vakalat only for Mahaluxmi (D1) and not Amman (D2); that pursuant to



O.S.A(CAD)Nos.68, 69, 70, 71 & 72 of 2024

this order, Mahaluxmi filed a memo dated 12.04.2024 with three Annexures namely, Annexures A, B and C; that according to learned Senior counsel for Mahaluxmi, this memo and three annexures thereat are in strict compliance with 26.03.2024 order; that it is submitted that Mahaluxmi is accepting 26.03.2024 order and that they have neither appealed nor would appeal against the same; that the endeavour of Mahaluxmi is only to comply with 26.03.2024 order (this submission made at the Bar on instructions is recorded); that the case file placed before us does not have colour scanning and therefore, considering the nature of the matter, we would put in the colour scanned versions shown to us in the hearing for the sake of convenience (that would be in the latter part of this order elsewhere infra); that post filing of this memo by Mahaluxmi i.e., memo dated 12.04.2024 along with three annexures, five applications namely, O.A.Nos.168 to 172 of 2024 and A.No.1233 of 2024 were listed before a Hon'ble Commercial Division (now presided by another Hon'ble single Judge i.e., single Judge other than the Hon'ble single Judge who made earlier mentioned 05.03.2024 and 26.03.2024 orders); that the Commercial Division on 16.04.2024 recorded that no counter affidavit has been filed by the respondents i.e.,



O.S.A(CAD)Nos.68, 69, 70, 71 & 72 of 2024

Mahaluxmi and Amman, Hon'ble Commercial Division went on to hold that earlier mentioned memo with regard to change of Artworks cannot be treated as counter affidavit; that there is no denial of facts by way of filing counter affidavit and categorically held that the memo filed by Mahaluxmi and Amman are not accepted by the Commercial Division and as a sequitur allowed all five applications. Aggrieved, Mahaluxmi is on appeal vide captioned OSAs.

8. As already alluded to supra, we are now hearing out the main OSAs. Before proceeding further as per allusion earlier, we are now setting out infra the colour scanned versions of material placed before us in Court in the hearing.



O.S.A(CAD)Nos.68, 69, 70, 71 & 72 of 2024

Plaintiff's pouch front view

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O.S.A(CAD)Nos.68, 69, 70, 71 & 72 of 2024

Plaintiff's pouch back view

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O.S.A(CAD)Nos.68, 69, 70, 71 & 72 of 2024

Defendants' pouch front view

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Page Nos.12/36



O.S.A(CAD)Nos.68, 69, 70, 71 & 72 of 2024

Defendants' pouch back view

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Three annexures filed along with memo dated 12.04.2024 are as follows:

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148

Annexure A

vol-I





Annexure - B

vol-I





WEB COPY

150

Annexure - C

Vol-1





O.S.A(CAD)Nos.68, 69, 70, 71 & 72 of 2024

9. We also deem it appropriate to scan and reproduce the
aforementioned orders dated 05.03.2024, 26.03.2024 and common
impugned order dated 16.04.2024 in its entirety and the same read as
follows:

Order dated 05.03.2024:

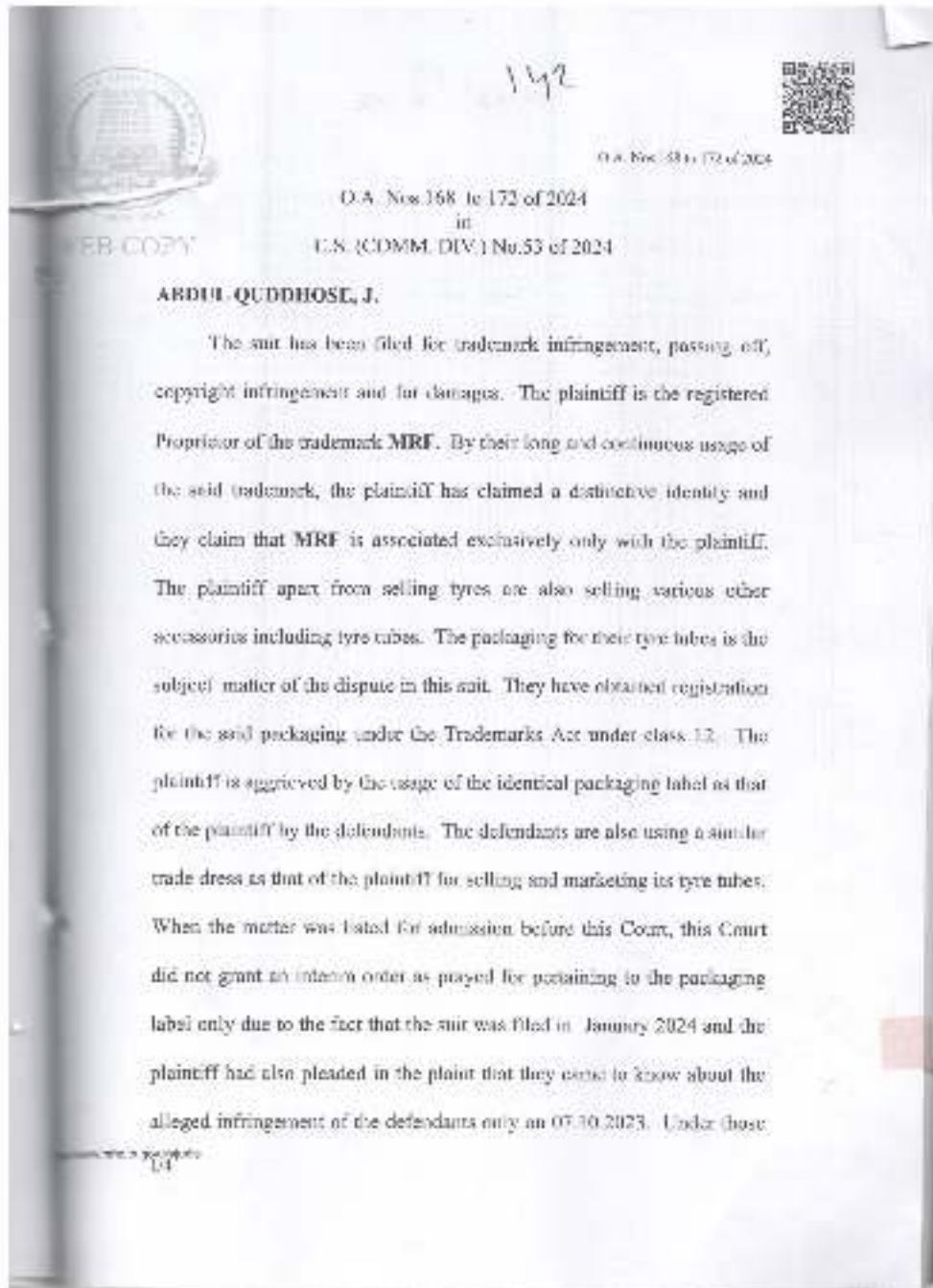




O.S.A(CAD)Nos.68, 69, 70, 71 & 72 of 2024

Order dated 26.03.2024:

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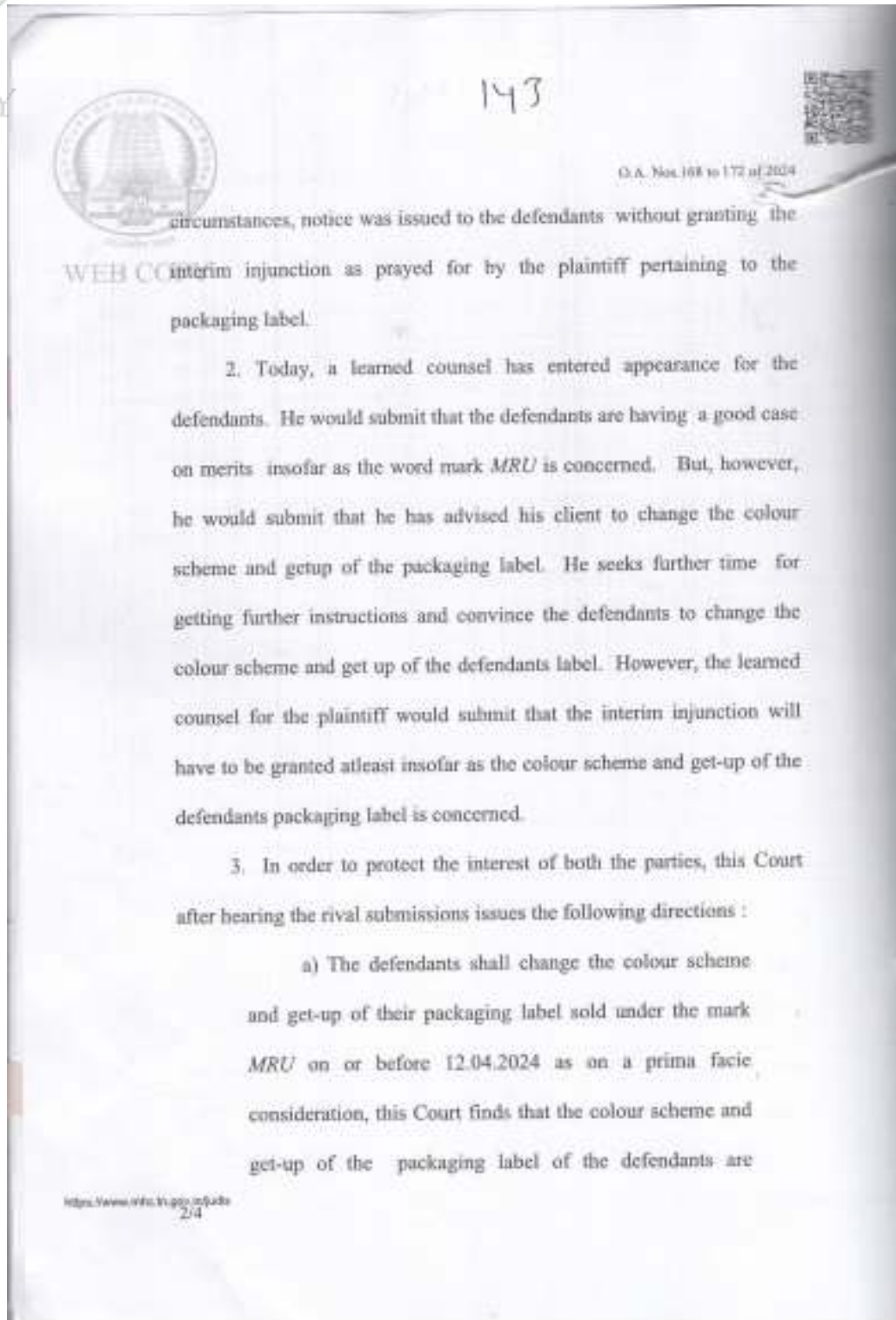




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O.S.A(CAD)Nos.68, 69, 70, 71 & 72 of 2024

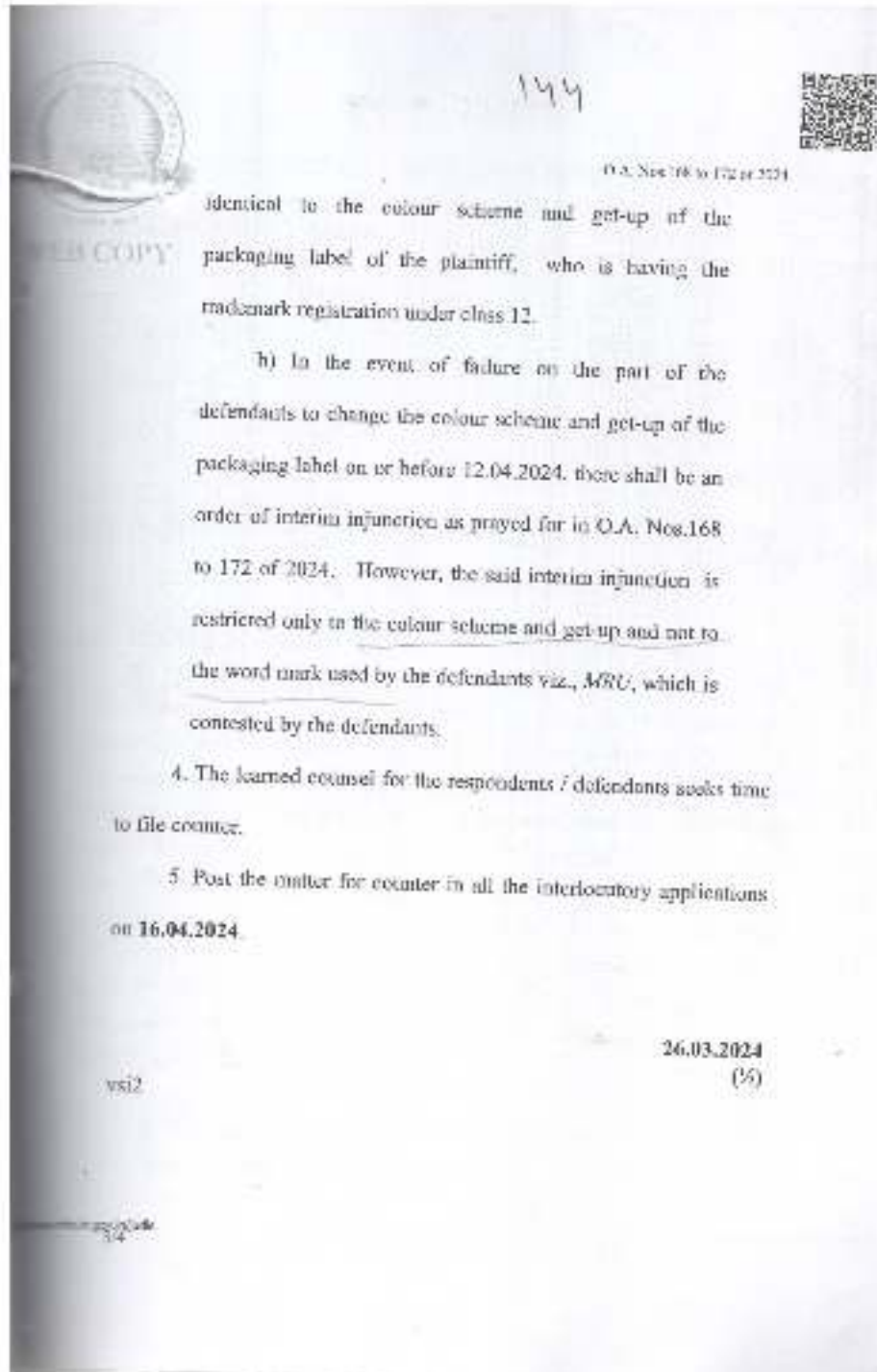




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O.S.A(CAD)Nos.68, 69, 70, 71 & 72 of 2024

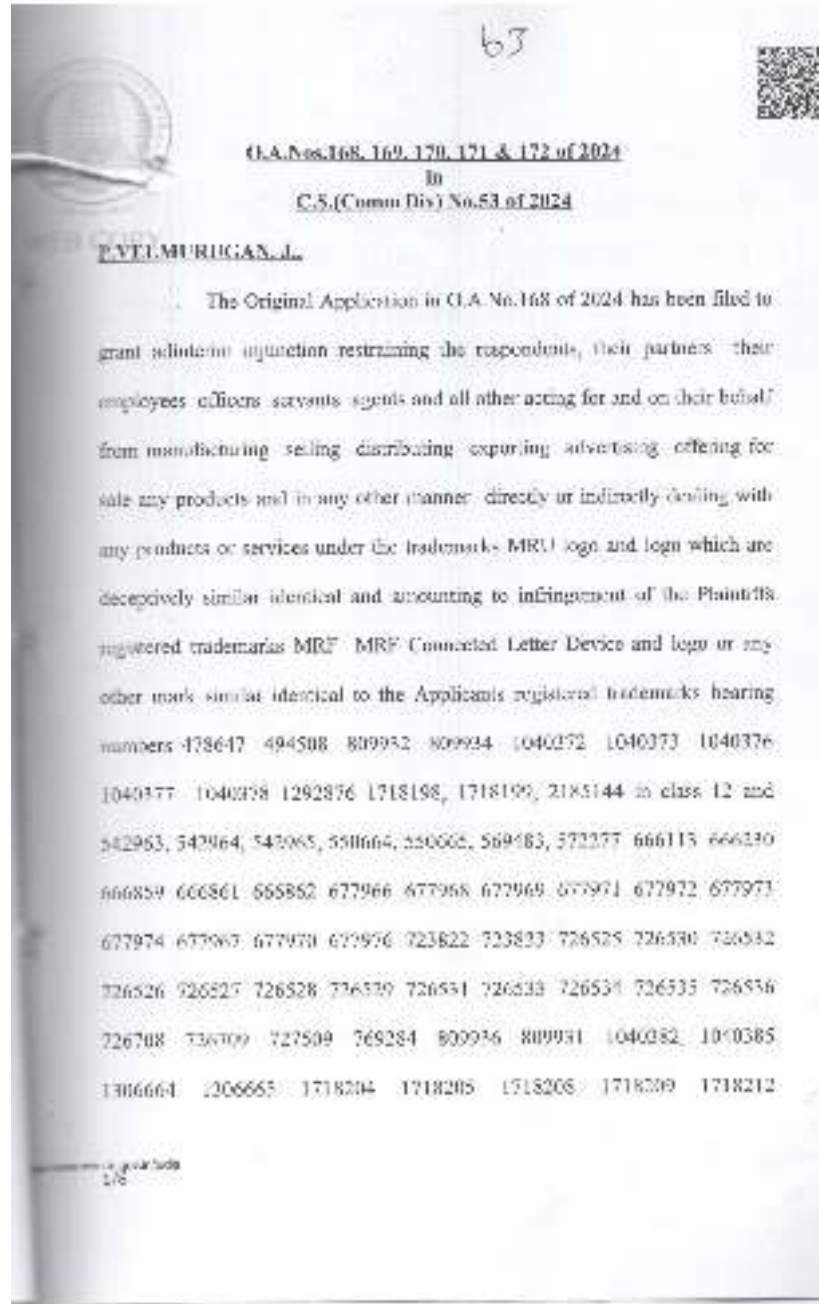




O.S.A(CAD)Nos.68, 69, 70, 71 & 72 of 2024

Common impugned order dated 16.04.2024:

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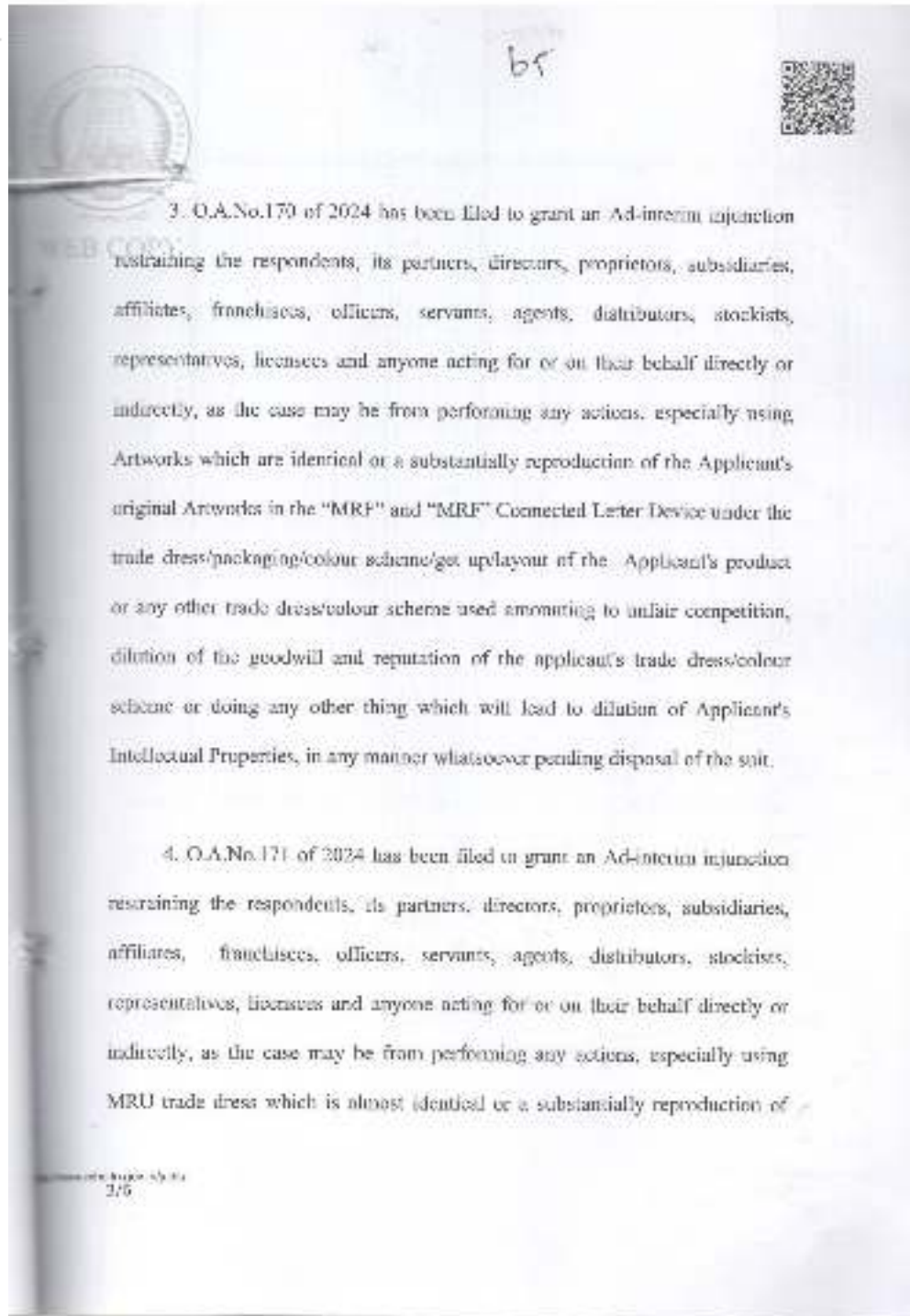




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O.S.A(CAD)Nos.68, 69, 70, 71 & 72 of 2024

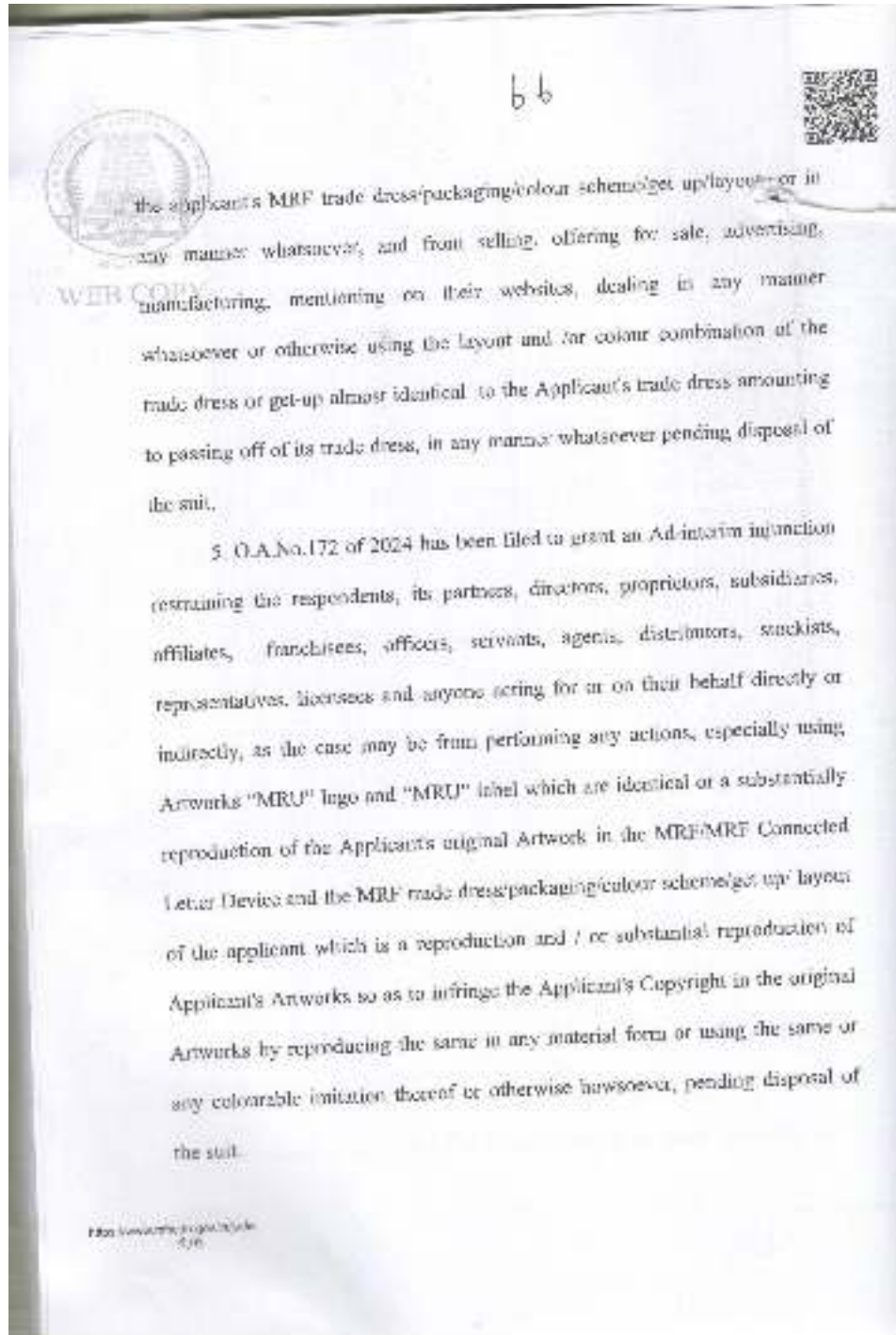




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O.S.A(CAD)Nos.68, 69, 70, 71 & 72 of 2024

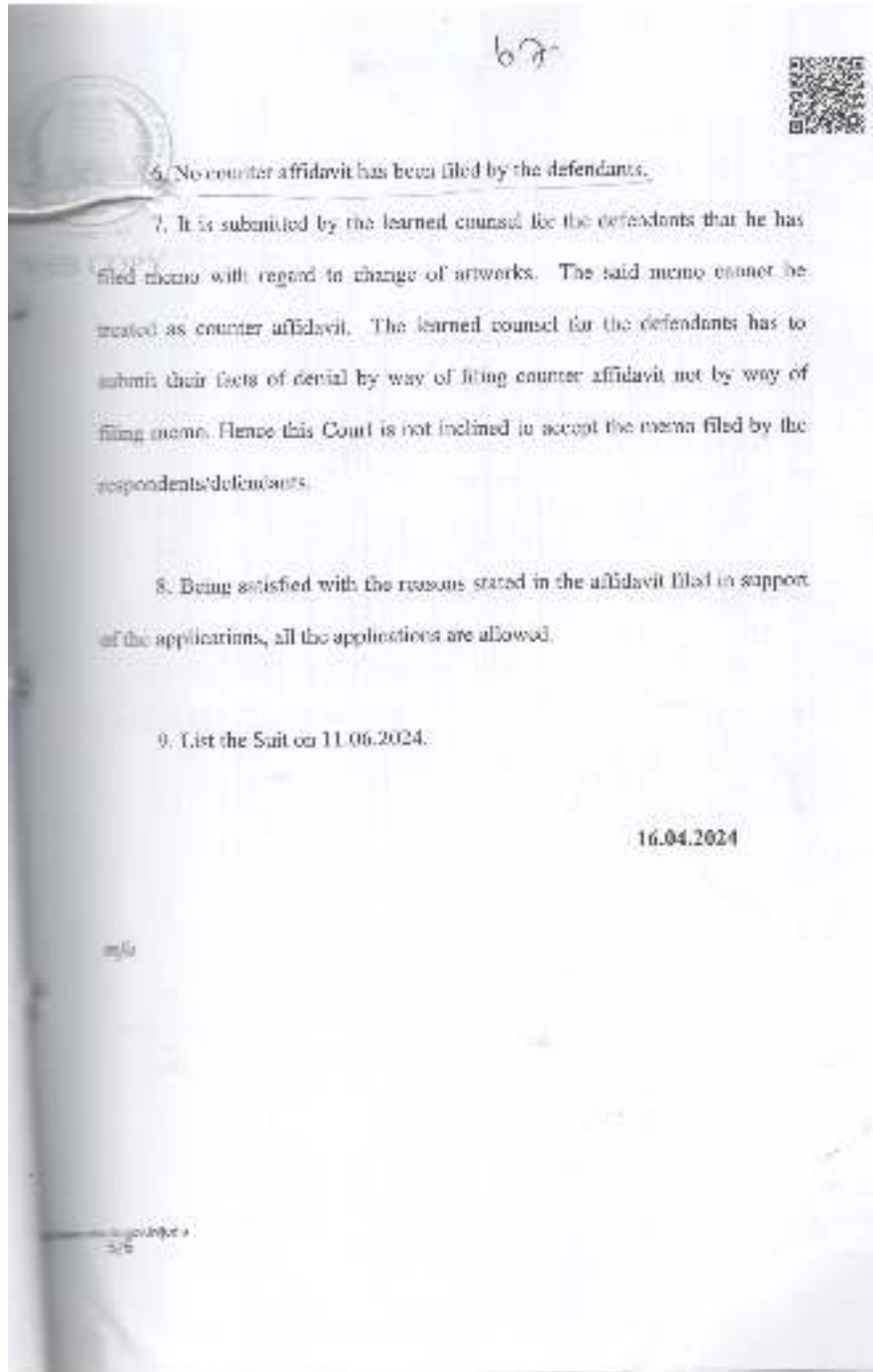




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O.S.A(CAD)Nos.68, 69, 70, 71 & 72 of 2024





O.S.A(CAD)Nos.68, 69, 70, 71 & 72 of 2024

10. At the risk of repetition, we deem it appropriate to reiterate that we have already recorded that learned Senior counsel for Mahaluxmi, on instructions, submits that the aforementioned 26.03.2024 order has neither been appealed nor will be appealed against and that it will only be complied with.

11. This Court having captured essential facts and set out the same by way of factual matrix in a nutshell containing facts imperative for appreciating this order and also the trajectory the matter has taken thus far / before us, now proceeds to consider the common impugned order.

12. The factual matrix and the trajectory read in conjunction with one another and in continuation of one another is a clear case of *rep ipsa loquitur* i.e., it speaks for itself. The reason is, the Hon'ble Commercial Division after ordering notice in five applications, has thought it appropriate to make 26.03.2024 order with two limbs which are sub-paragraph Nos.(a), (b) of paragraph No.3 thereat (extracted and reproduced supra). R1 namely, Mahaluxmi saying that it is accepting the order, has filed the aforementioned



O.S.A(CAD)Nos.68, 69, 70, 71 & 72 of 2024

memo dated 12.04.2024 with aforementioned three annexures. Therefore, the legal drill in the next listing on 16.04.2024 should have been to examine if the memo is in compliance i.e., whether Mahaluxmi is in compliance and come to a conclusion as to whether sub-paragraph (b) of Paragraph No.3 has kicked in but that legal drill has not been undertaken by the Commercial Division. On the contrary, Hon'ble Commercial Division has proceeded on the basis that counter affidavit has not been filed and has rejected the memo of Mahaluxmi. In other words, memo of Mahaluxmi has not been considered. Memo of Mahaluxmi has not been examined. The question as to whether Mahaluxmi is in compliance with sub-paragraph No.(a) of paragraph No.3 of 26.03.2024 order was not examined. *De hors* such examination, on the sole point that counter affidavit has not been filed denying facts, all five applications have been allowed. Therefore, we are of the considered view that this is a fit case to interfere qua common impugned order and remand the same back to Hon'ble Commercial Division with a request to consider the memo dated 12.04.2024 (together with three annexures i.e., Annexures A, B and C) filed by Mahaluxmi in the light of 26.03.2024 order (which has been given a legal quietus and therefore,



O.S.A(CAD)Nos.68, 69, 70, 71 & 72 of 2024

attained finality owing to the stated position of Mahaluxmi) and embark upon the legal drill as to whether sub-paragraph No.(a) of paragraph No.3 has been complied or if anything more is required for compliance and in that light answer whether the injunction vide sub-paragraph No.(b) of Section 3 has kicked in. This legal drill would have included comparison of Annexures A, B and C vide memo dated 12.04.2024 as per ***Parle Principle*** i.e., whether a man of average intelligence, ordinary prudence and imperfect recollection will be lulled into the belief that what he is seeing now is what he had seen earlier and examining whether Mahaluxmi is in compliance qua sub-paragraph (a) of paragraph No.3 obviously in the light of other attendant determinants at Commercial Division. The reason for writing that such a legal drill should have ensued is, 26.03.2024 order is clearly a conditional futuristic injunction. It is a conditional futuristic injunction wherein and whereby interim orders in five applications would kick in when Mahaluxmi does not comply with sub-paragraph No.(a) of paragraph No.(3) of 26.03.2024 order. To be noted, it is clear that Mahaluxmi has no option other than complying with sub-paragraph No.(a) of paragraph No.(3) of 26.03.2024 order as 26.03.2024 order has been given legal quietus by



O.S.A(CAD)Nos.68, 69, 70, 71 & 72 of 2024

Mahaluxmi and it has attained finality. We deem it appropriate to hasten to add that this position will not apply to Amman. To be noted, sub-paragraph (b) of paragraph No.3 which is a conditional futuristic injunction makes it clear that an injunction would kick in is restricted only to colour scheme and get up and that it is not to word mark but in all five applications being allowed vide common impugned order, now there is an injunction operating qua the word mark also. It is further to be noted, on a demurrer, *de hors* counter, Mahaluxmi has filed written statement in the main suit.

13. Before we write the operative part of this order, we deem it appropriate to deal with C.M.P.No.13587 of 2024 in O.S.A(CAD)No.68 of 2024, the same is under Order XLI Rule 27 of 'the Code of Civil Procedure, 1908 (Central Act V of 1908) [hereinafter 'CPC' for the sake of brevity]. Mr.P.V.Balasubramanian, learned Senior Counsel, on instructions, submits that Order XLI Rule 27 of CPC is qua documents that have been filed by Mahaluxmi along with written statement i.e., written statement of D1 and as now we would be leaving open all questions and we would now be remanding the matter back to the Commercial Division, we make it clear



O.S.A(CAD)Nos.68, 69, 70, 71 & 72 of 2024

that all the documents filed by Mahaluxmi along with written statement will go through usual process of admission, denial and marking of exhibits etc., in accordance with law in trial. We express no opinion or view on this Order XLI Rule 27 CMP and we dispose of the same i.e., C.M.P.No.13587 of 2024 in O.S.A(CAD)No.68 of 2024 as closed holding that all rights and contentions of D1 Mahaluxmi are preserved qua the suit and applications thereat. We also deem it appropriate to write that as regards aforementioned 05.03.2024 order, A.No.1233 of 2024 is for combining causes of action under Clause 14 of Letters Patent. This application i.e., A.No.1233 of 2024 is not one of the applications in which the aforementioned 26.03.2024 order or impugned common order dated 16.04.2024 have been made. Therefore, we deem it appropriate to leave it at that but we only reiterate the order dated 19.10.2022 made by the then Commercial Division in O.A.No.651 of 2022 in C.S(Comm.Div.) No.205 of 2022 that clause 14 application should be allowed only after putting the defendant on notice in the light of the language in which clause 14 of Letters Patent is couched and clause 14 of Letters Patent reads as follows:

'14. Joinder of several causes of action - And we do further



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O.S.A(CAD)Nos.68, 69, 70, 71 & 72 of 2024

ordain that where plaintiff has several causes of action against 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 the High Court shall seem fit.'

14. The most relevant paragraph of order dated 19.10.2022 made in O.A.No.651 of 2022 in C.S(Comm.Div.) No.205 of 2022 is paragraph No.15 and the same reads as follows:

'15. To be noted, an application in A.No.4238 of 2022 under Clause 14 of Letters Patent of Madras High Court has been filed with a prayer for combining causes of action. In the light of the language in which Clause 14 of Letters Patent is couched, it is imperative that defendants are given an opportunity to show cause as to why causes of action should not be combined before a decision is taken in such an application. Therefore, notice has been ordered today in that application. In this view of the matter, it is made clear that this Commercial Division has considered only that part of the cause of action over which it has jurisdiction. To be noted, section 134(2) of TM Act is available only for infringement of a registered trade mark or relating to any right in a registered



trade mark and not for passing off suits vide section 134(1)(c) of TM Act.'

It has become necessary to advert to this clause 14 of Letters Patent aspect as 05.03.2024 order refers to A.No.1233 of 2024 also and we are informed that it is with a prayer for combining causes of action under Clause 14 of Letters Patent.

15. In the main captioned five OSAs, in the light of the narrative, discussion and dispositive reasoning thus far, the following order is made:

(i) Impugned common order being common order dated 16.04.2024 made in O.A.Nos.168, 169, 170, 171 and 172 of 2024 in C.S(Comm.Div.)No.53 of 2024 is set aside and all five applications are remitted back to Hon'ble Commercial Division for disposal afresh in the light of order dated 26.03.2024 in five applications (order which has attained finality / given legal quietus by Mahaluxmi) and the memo filed by Mahaluxmi i.e., memo dated 12.04.2024 together with three annexures;

(ii) We make it clear that impugned common order has



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been set aside for the purpose of facilitating a *de novo* legal drill and therefore, though obvious we make it clear for the sake of specificity that we have not expressed any view or opinion on the merits of the matter and all questions are left open for the parties (including Annam) i.e., Mahaluxmi, MRF and Amman to be canvassed before the Commercial Division;

(iii) It is open to Amman to file counter or memo in the *interregnum* if permissible in law and if Amman is so advised and if so desired;

(iv) All the rights and contentions of all parties including Amman are preserved for the aforesaid purpose;

(v) It is open to the Commercial Division to call for further memo to bring Mahaluxmi within compliance qua subparagraph (a) of paragraph No.(3) of 26.03.2024 order as it is clearly submitted by Mahaluxmi that it is accepting 26.03.2024 order. We say so to make it clear that door is not shut qua this course;

(vi) The aforementioned *de novo* exercise shall be



O.S.A(CAD)Nos.68, 69, 70, 71 & 72 of 2024

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embarked upon, commenced and completed as expeditiously as the business of Hon'ble Commercial Division would permit;

(vii) As already alluded to supra, as there was an injunction qua word mark also now owing to the common impugned order allowing all five applications and that order has been set aside, it will now be open to Mahaluxmi and obviously, Amman to file counter affidavit, if so advised, if so desired obviously rights of MRF also stand preserved.

16. As we are informed that a Hon'ble Division Bench is in seizen of question of reference qua order dated 27.07.2018 in C.S.No.357 of 2017 and A.No.3874 of 2018 regarding well known trademark under Section 2(1)(zg) of TM Act, owing to divergent views of two Hon'ble Judges and that one Hon'ble Judge of Division Bench has since been elevated as Chief Justice of a High Court, Registry is directed to place this matter before Hon'ble Acting Chief Justice and seek orders regarding reconstitution of the Division Bench of Hon'ble Mr.Justice S.Vaidyanathan (then Hon'ble Judge of this Court now Hon'ble Chief Justice of another High Court) and Hon'ble



O.S.A(CAD)Nos.68, 69, 70, 71 & 72 of 2024

Mr.Justice K.Rajasekar (one Hon'ble Judge of Division Bench) which was hearing this question and we find that matter was listed before that Bench on 26.09.2023.

17. Ergo, as a sequitur, captioned main five OSAs are disposed of in aforementioned manner. As a further sequitur, as captioned five CMPs being CMP Nos.13581, 13580, 13586, 13592 & 13594 of 2024 have been filed with prayers for stay of common impugned order which has now been set aside, the same are disposed of as closed albeit without expressing any view or opinion on the merits of the matter. There shall be no order as to costs.

(M.S.,J.)

(K.G.T.,J.)

08.07.2024

Index : Yes

Speaking order

Neutral Citation : Yes

mk

To

The Sub-Assistant Registrar

Original Side

High Court, Madras.

M.SUNDAR, J.,

Page Nos.35/36



WEB COPY



O.S.A(CAD)Nos.68, 69, 70, 71 & 72 of 2024

and
K.GOVINDARAJAN THILAKAVADI, J.,

mk

O.S.A(CAD)Nos.68, 69, 70, 71 & 72 of 2024

08.07.2024