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*O.S.A. (CAD) Nos.85 to 87 of 2024
and O.S.A. (CAD) SR. No.93940 of 2024*

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 22.08.2024

CORAM

THE HONOURABLE MR.JUSTICE **M.SUNDAR**
and
THE HONOURABLE MRS.JUSTICE **K.GOVINDARAJAN THILAKAVADI**

**O.S.A. (CAD) Nos.85, 86 and 87 of 2024
and O.S.A. (CAD) SR. No.93940 of 2024
and
C.M.P. No.16193 of 2024 in O.S.A. (CAD) No.85 of 2024
and
C.M.P. No.16199 of 2024 in O.S.A. (CAD) No.86 of 2024
and
C.M.P. No.16205 of 2024 in O.S.A. (CAD) No.87 of 2024**

Chetan Kothari
trading as Raman Traders,
RS No.62/2, 62/4, 62/5 Unit VI,
Suzlon Energy Ltd., Mannadipet Commune,
Thiruvandar Koil Village,
Puducherry – 605 102.

.. Appellant in
all the appeals

Vs

Kaleesuwari Refinery Private Limited
rep. By its Manager (Legal) Mr.A.Saravanan,
No.53, Rajasekaran Street,
Opp.Kalyani Hospital, Dr.Radhakrishnan Salai,
Mylapore, Chennai – 600 004.

.. Respondent in
all the appeals

Prayer in O.S.A. (CAD) Nos.85, 86 and 87 of 2024: Appeals
filed under Section 13 (1-A) of The Commercial Courts Act, 2015
read with Order XXXVI Rule 1 of the Original Side Rules to set aside



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the common order dated 02.07.2024 in O.A. Nos.694, 695 and 696 of 2023 in C.S. (Comm. Div.) No.197 of 2023.

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Prayer in O.S.A. (CAD) SR. No.93940 of 2024: Appeal filed under Clause 15 of Letters Patent to set aside the common order dated 02.07.2024 in A.No.6332 of 2023 in C.S. (Comm. Div.) No.197 of 2023.

For Appellant : Mr.Rajesh Ramanathan
in all the appeals

For Respondent : Mr.P.S.Raman,
Senior Counsel
instructed by Mr.Vijayan Subramanian
in all the appeals

COMMON JUDGMENT

(Judgment of the Court was delivered by **M.Sundar, J.**)

This common consent order will now dispose of the captioned four OSAs and the captioned three CMPs thereat.

2. When three of the captioned OSAs viz., O.S.A. (CAD) Nos.85, 86 and 87 of 2024 along with CMPs thereat (C.M.P. Nos.16193, 16199 and 16205 of 2024) were listed in the Admission Board before this Court on 30.07.2024, the following proceedings/orders were drawn up/made:



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'O.S.A (CAD) Nos. 85, 86 & 87 of 2024

and

C.M.P.Nos.16193, 16199 and 16205 of 2024

in

O.S.A (CAD) Nos. 85, 86 & 87 of 2024

M.SUNDAR.J.,

and

K.GOVINDARAJAN THILAKAVADI, J.,

(Order of the Court was made by M.SUNDAR.J.,)

Captioned 'Original Side Appeals' ['OSAs' in plural and 'OSA' in singular for the sake of brevity and convenience] have been filed in this 'Commercial Appellate Division' ['CAD' for the sake of brevity] on 19.07.2024 assailing a common order dated 02.07.2024 made in O.A.Nos.694 to 696 of 2023 and A.No.6332 of 2023 in C.S (Comm.Div.) No.197 of 2023 by the Commercial Division of this Court.

2. Common order in O.A.Nos.694 to 696 of 2023 (three applications) have been assailed in captioned three OSAs. Mr.Rajesh Ramanathan along with Mr.S.Diwakar, learned counsel for the appellant submits that a fourth OSA has been filed against dismissal of A.No.6332 of 2023 also in O.S.A SR.No.93940 of 2024 dated 02.07.2024. To be noted, O.A Nos.694 to 696 of 2023 being injunctions applications have been allowed by the common order dated 02.07.2024. This '02.07.2024 common order' shall hereinafter be referred to as 'impugned order' for the sake of convenience and clarity.

3. The sole defendant in the suit i.e., C.S (Comm.Div.) No.197 of 2023 is the lone appellant before us and the sole



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plaintiff in the suit is the lone respondent before us. For convenience, the appellant/defendant (Chetan Kothari) will be referred to as 'Chetan' and the respondent / plaintiff will be referred to as 'KRPL' denoting 'Kaleesuwari Refinery Private Limited'.

4. Short facts are that KRPL filed a suit [date of presentation and institutions not given separately in the website] but we deem it appropriate to record that date of plaint is 15.02.2023, date of presentation is 22.02.2023 and date of institution of suit is 07.08.2023. The suit was filed for injunctions qua infringement of registered trademark, passing off, fraudulent imitation, accounts, destruction of alleged offending material, costs and the usual residuary limb. Chetan has filed a written statement and pleadings are complete. Along with the suit O.A.Nos.694 to 696 of 2023 were taken out with prayers for interim injunction qua injunction against infringement, injunction against passing off and injunction qua design of bottle. As already alluded to supra, all these three applications were allowed by the impugned order which was made after full contest. Along with these three applications, A.No.6332 of 2023 taken out by Chetan under Section 124 of 'The Trademarks Act, 1999' [hereinafter 'TM Act' for the sake of brevity and convenience] with a prayer seeking an observation that there is a tenable ground for rectification, came to be dismissed. As already alluded to supra, O.S.A SR.No.93940 of 2024 has been filed against such dismissal.

5. The submissions of Mr.Rajesh Ramanathan, learned counsel are as follows:



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a) Section 12-A of 'the Commercial Courts Act, 2015 (Act No.4 of 2016)' [hereinafter 'CCA' for the sake of brevity] has been bypassed;

b) There is no similarity and therefore, the injunction prayers ought not to have been acceded to vide impugned order;

c) As regards combining causes of action under Clause 14 of Letters Patent vide A.No.1073 of 2023 (order dated 26.06.2023) made by Hon'ble single Judge, the cause of action qua alleged infringement of design as regards the bottle was not pressed. The causes of action combined were only infringement and passing off;

d) As Chetan's application under Section 124 of TM Act (A.No.6332 of 2023) has been dismissed, there is impediment in filing the rectification application but Chetan is ready to file rectification application in the IP Division of this Court;

e) Chetan had filed an earlier suit for groundless threat under Section 142 of TM Act in C.S (Comm.Div.) No.181 of 2022 on receipt of cease-and-desist notice (cease-and-desist notice dated 08.08.2022, plaint Document No.9) and on filing of C.S (Comm.Div.) No.197 of 2023, the groundless threat suit of Chetan came to be disposed of on 29.01.2024.

6. We find that it has also become necessary to look at the 'Legal Use Certificate' ('LUC' for the sake of brevity). Therefore, we direct the Registry to list this matter again in the Admission Board i.e., Motion List one week hence but with the following:



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a) Suit file in C.S (Comm.Div.) No.181 of 2022 (groundless threat suit) filed by Chetan which was disposed of on 29.01.2024 by the Commercial Division;

b) Appeal filed in O.S.A SR.No.93940 of 2024 filed by Chetan against dismissal of A.No.6332 of 2023 (Section 124 application)

c) Entire suit filed together with plaint and written statement documents in C.S (Comm.Div.) No.197 of 2023.

List in the Admission Board i.e., Motion List under the same cause list caption 'FOR ADMISSION' on Monday. List on 05.08.2024.'

3. Today, Mr.S.Rajesh Ramanathan, learned counsel for appellant (Chetan) in all four captioned OSAs and Mr.Vijayan Subramanian, learned counsel on record for KRPL (Kaleesuwari Refinery Pvt. Ltd.,) which is sole respondent in all the four OSAs led by learned senior counsel Mr.P.S.Raman are before this Court.

4. Learned counsel on both sides and learned senior counsel appearing for counsel on record for KRPL on instructions submitted in one voice in unison that (a) aforementioned 30.07.2024 proceedings of this CAD correctly captures the facts, dates, events and the trajectory the matter has taken and (b) the captioned four OSAs and captioned three CMPs thereat can be disposed of by a consent order, the details of which will be set out infra.



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5. The short forms, abbreviations and short references used in the earlier proceedings dated 30.07.2024 will continue to be used in the instant proceedings for the sake of convenience and clarity.

6. Before we write the consent order, we deem it appropriate to record the following undisputed position/facts:

6.1 The suit in C.S.(Comm. Div.) No.197 of 2023 is at the stage of framing issues and CMH (Case Management Hearing) under Order XV-A of amended CPC as amended by CCA. To be noted, both sides submit that admission and denial of documents exercise has been completed;

6.2 Learned counsel on record for Chetan i.e., appellant before us will now file a rectification petition in the I.P. Division of this Court within a fortnight from today i.e., on or before 05.09.2024 (with advance copies to counsel for KRPL), counsel for KRPL shall complete pleadings within a fortnight therefrom i.e., 19.09.2024 and that the rectification petition can be tagged with C.S. (Comm. Div.) No.197 of 2023 as per the operating rules i.e., The Madras High Court Intellectual Property Rights Division Rules, 2022 (hereinafter 'IPD Rules' for the sake of brevity);



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6.3 Thereafter, admission and denial of documents in the rectification petition will be completed in a fortnight therefrom i.e., by 03.10.2024. This means that the intended rectification petition of Chetan will also be in the same stage as that of the infringement suit viz., C.S. (Comm. Div.) No.197 of 2023 by 03.10.2024;

6.4 Rectification petition filed by KRPL before the Trade Mark Registry shall now be transferred by consent to this Court forthwith and that also shall be tagged with infringement suit as well as the intended rectification petition of Chetan and the same shall also be carried to same stage by both parties on or before 03.10.2024;

6.5 Both learned counsel agree for appointment of a retired learned Judge of the District Judiciary in the State of Tamil Nadu as Dedicated Commissioner for recording evidence in the infringement suit as well as the two rectification petitions which will be tagged and obviously this will be post 03.10.2024;

6.6 Injunctions granted vide impugned common order dated 02.07.2024 will now be suspended without expression of any view or opinion on merits and without impacting other similar matters



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but Chetan will maintain true and faithful accounts and file the same once a month in the Registry after favouring learned counsel for KRPL with an advance copy and this will operate till the disposal of the infringement suit and the intended rectification petition and rectification petition of KRPL which is to be transferred forthwith from Trade Mark Registry to IP Division of this Court;

6.7 Both parties agree that the question as regards Section 12-A of CCA can be left open in the instant case without expression of any view or opinion on the merits. Parties will go for trial and the question regarding Section 12-A of CCA and other points raised by learned counsel for Chetan i.e., Mr.Rajesh Ramanathan which have inter-alia been captured in paragraph 5 of previous proceedings made by this CAD in the listing on 30.07.2024 (extracted/reproduced supra) will be decided in another matter i.e., in a legal drill where deciding on Section 12-A of CCA and the other points become imperative for returning a verdict;

7. In the light of the narrative thus far, the following consent order is made:

7.1 Chetan shall file (after giving advance copies to KRPL counsel) a rectification petition in the I.P.



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*Division of this Court within a fortnight from today i.e.,
by 05.09.2024 and KRPL shall complete pleadings in
the same by 19.09.2024, (to be noted, KRPL shall
complete pleadings without insisting on formal notice
in a fortnight therefrom i.e., by 19.09.2024) and
admission and denial of documents shall be completed
in a fortnight therefrom i.e., by 03.10.2024;*

*7.2 Rectification proceedings bearing No.276568
(qua Trade Mark Registration No.4412714 in Class 4)
filed by KRPL before the Registrar of Trade Mark
Registry shall now stand transferred forthwith to the
I.P. Division of this Court on this order being uploaded.
It is open to the parties to present a copy of this order
or a soft copy of the same in the Trade Mark Registry
to activate this transfer;*

*7.3 Completion of pleadings and admission and
denial of documents in the trade mark rectification
proceedings initiated by KRPL shall also be completed
by 03.10.2024 so that those proceedings also by
03.10.2024 are at the same stage as that of the*



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infringement suit and the intended rectification petition

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to be filed in I.P. Division by Chetan;

*7.4 Aforementioned suit being C.S. (Comm. Div.)
No.197 of 2023, intended Rectification Petition to be
filed by Chetan and the rectification proceedings filed
by KRPL before the Trade Mark Registry which is to be
transferred forthwith shall all be tagged together by
the Registry and listed before Hon'ble Commercial
Division on 03.10.2024;*

*7.5 On 03.10.2024, the parties shall do the
needful to complete the exercise of framing issues so
that the matter may be placed before the Dedicated
Commissioner on a date at the discretion of
Commercial Division;*

*7.6 As regards the Dedicated Commissioner,
Mr.V.Paul Das (retired Sub Judge), residing at
No.82/106, Perambur High Road Lane, Jamalia,
Chennai - 600 012 (Mobile No.9443494445) is
appointed as Dedicated Commissioner for recording*



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evidence and the remuneration for the entire exercise is fixed at Rs.2,00,000/- to be borne in equal moieties (Rs.1,00,000/- each by both sides). Expenses shall be borne in equal moieties by both sides and that will be in addition to the total remuneration of Rs.2,00,000/-;

7.7 Learned Commissioner from the date fixed by the Hon'ble Commercial Division shall complete the exercise of recording evidence and marking documents as expeditiously as possible but in any event within four weeks from the date fixed by the Hon'ble Commercial Division and such date will be fixed by the Commercial Division after framing issues;

7.8 Learned Commissioner shall hold sittings either in the Arbitration Centre or in the Mediation Centre under aegis of this Court;

7.9 Directors of Arbitration and Mediation Centres are requested to make necessary arrangements, if any request is made in this regard by parties or learned Commissioner;



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7.10 Obviously, expenses in terms of rent for Arbitration/Mediation Centre etc., shall also be borne by both parties in equal moieties (as alluded to supra vide 7.6);

7.11 Learned Dedicated Commissioner will not have any adjudication powers and if there is any objection with regard to any deposition or marking of any document, the same shall be recorded and the Commercial Division will ultimately take a call when the main suit and the two rectification petitions tagged with the same are heard out;

7.12 Injunctions granted vide impugned common order dated 02.07.2024 are now suspended by consent without expressing any opinion on the merits of the matter. This suspension shall not be construed as any expression on the merits of the matter and shall not impact any other similar matter as between the parties. However, Chetan shall maintain true and faithful accounts and as regards sales qua alleged



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offending mark and file accounts in the Court at regular intervals of one calendar month as per Gregorian calendar;

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7.13 After recording of evidence by the learned Dedicated Commissioner, the matter shall obviously go before the Commercial Division for written arguments/arguments and verdict for all this i.e., that part of the legal drill time lines under CCA will apply from that stage (to be noted, as regards earlier part of the legal drill i.e., upto the stage of matter being listed before learned Commissioner for recording evidence parties by consent have agreed for shorter time frames i.e., time frames shorter than that prescribed vide CCA);

7.14 As regards Section 12-A of CCA and other points raised by learned counsel for appellant as already alluded to supra, the question is left open in this matter and it will be decided in another matter where the legal drill thereat becomes necessary. It is made clear that question regarding Section 12-A of



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CCA and other points are being left open as three

*OSAs (O.S.A. (CAD) Nos.85, 86 and 87 of 2024) and
O.S.A. (CAD) SR. No.93940 of 2024 are being
disposed of by consent order;*

*7.15 In the intended rectification petition to be
filed by Chetan, though obvious, we make it clear that
all the rights and contentions of KRPL including the
points that have been raised in the captioned appeals
are left open for KRPL to raise in resisting the
rectification. We also make it clear all rights and
contentions of both sides (except Section 12-A of CCA
point) are left open for ensuing legal drill i.e., legal drill
that is to ensue pursuant to this consent order.;*

*7.16 The maintainability issue regarding O.S.A.
(CAD) SR. No.93940 of 2024 is also left open in this
matter and this CAD will decide the same in another
matter in a legal drill where it becomes imperative to
return a verdict in the main matter;*



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7.17 As the matters i.e., infringement suit, two

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rectification petitions are tagged, it will obviously be a joint trial which will be in sync with IPD Rules;

7.18 O.S.A. (CAD) SR. No.93940 of 2024 is also disposed of as closed by this common order without expression of any view or opinion on the merits of the matter.

8. Captioned four OSAs and captioned three CMPs thereat are disposed of in the aforesaid manner with the aforesaid directives. There shall be no order as to costs.

(M.S.J.) (K.G.T.J.)
22.08.2024

Index:Yes/No
Neutral Citation: Yes/No
mmi

P.S. I: Upload forthwith

P.S.II : All concerned including the Registry of Madras High Court to act forthwith on the uploaded soft copy of this proceedings as uploaded in the official website of this Court. To be noted, the soft copies uploaded in the official website of this Court are water marked, besides being QR Coded.

P.S.III : Registry to communicate this order to the Registrar of Trade Marks forthwith and Registrar of Trade Marks to act on the basis of the uploaded copy of this order as uploaded in the official website/portal of this Court.



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To

1. The Registrar of Trade Marks
Intellectual Property Office Building,
G.S.T. Road, Guindy, Chennai – 32.
2. The Sub Assistant Registrar,
Original Side, High Court,
Madras.



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mmi**

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