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**O.A.Nos.864 to 868 of 2024
in
C.S. (Comm. Div.) No.227 of 2024
and
A.Nos.5876 and 5877 of 2024**

ABDUL QUDDHOSE.J.,

Compagnie De Saint-Gobain and Anr.

... Applicants

Vs.

Sakthi Sai Safety Glass India and Anr.

... Respondents

This suit has been filed for Trade Mark infringement, passing off and for copyright infringement.

2. The Trade Mark involved is "SAINT-GOBAIN". The plaintiffs claim to be a reputed player in the glass manufacturing industry and they claim that they have been using the Trade Mark "SAINT-GOBAIN" for a long number of years. In the plaint, they have disclosed the details of their credentials. The said facts are not disputed by the first respondent / first defendant as seen from the counter affidavit filed before this Court.



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3. The plaintiffs had earlier appointed the first respondent / first defendant as their glass processor and the first respondent / first defendant, under a contract, was permitted to use the plaintiffs' Trade Mark "SAINT-GOBAIN".

4. According to the plaintiffs, the contract was terminated and therefore, the first respondent / first defendant is no longer permitted to use the plaintiffs' Trade Mark "SAINT-GOBAIN". According to the applicants / plaintiffs, despite issuing the cease and desist notice to the first respondent / first defendant, requesting them not to use the plaintiffs' Trade Mark "SAINT-GOBAIN" and having undertaken in their reply that they have stopped using the Trade Mark "SAINT-GOBAIN", the first respondent / first defendant is continuing to use the plaintiffs' Trade Mark "SAINT-GOBAIN" for the sale and distribution of toughened glasses. The details of the alleged usage of the first respondent / first defendant are disclosed in the plaint as well as in the affidavit filed in support of these applications.

5. The applicants / plaintiffs have also contended that since, only recently, they came to know that the first respondent / first defendant has re-



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commenced the usage of the applicants' / plaintiffs' Trade Mark "SAINT-GOBAIN", they were constrained to file these interim injunction applications without going for pre-suit mediation as prescribed under Section 12A of the Commercial Courts Act. According to the applicants / plaintiffs, since urgent interim reliefs are required, there became a necessity for the applicants / plaintiffs to approach this Court without exercising the statutory requirement of Section 12 A of the Commercial Courts Act by going for pre-suit mediation.

6. A counter affidavit has been filed by the respondents / defendants, denying the contentions of the applicants / plaintiffs. In the counter affidavit, they have raised the following defences:

a) The applicants / plaintiffs have not complied with the statutory requirement of Section 12 A of the Commercial Courts Act by going for pre-suit mediation prior to the filing of the suit;

b) Since the suit claim arises out of a contract entered into between the applicants / plaintiffs and the respondents / defendants, the Trade Mark infringement suit filed by the applicants / plaintiffs is not maintainable;

c) The contract entered into between the applicants / plaintiffs and the



respondents / defendants contains an arbitration clause and therefore, the present suit filed by the applicants / plaintiffs is not maintainable;

d) The suit has been filed by suppression of material facts as the applicants / plaintiffs have not approached this Court with clean hands;

e) The respondents / defendants were very much willing to go for an amicable settlement with the applicants / plaintiffs. But, despite exchange of correspondences between the respondents / defendants and the applicants / plaintiffs, offering to go for an amicable settlement, the present suit has been filed without complying the requirement of Section 12 A of the Commercial Courts Act and therefore, the suit is not maintainable;

f) The applicants / plaintiffs have taken inconsistent pleas in the plaint as well as in the affidavit filed in support of these applications.

7. Mr.P.S. Raman, learned Senior Counsel appearing for the applicants / plaintiffs, drew the attention of this Court to the various documents filed along with the plaint. In particular, he drew the attention of this Court to the label used by the first respondent / first defendant and would submit that since the first respondent / first defendant is using the plaintiffs' Trade Mark viz., "SAINT-GOBAIN" for selling toughened



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glasses, the first respondent / first defendant has infringed the plaintiffs' Trade Mark. The learned Senior Counsel appearing for the applicants / plaintiffs also drew the attention of this Court to the cease and desist notice issued by the applicants / plaintiffs dated 14.11.2023 and the reply dated 21.11.2023 sent by the respondents / defendants, wherein, according to him, the respondents have given an undertaking stating that they have stopped using the applicants / plaintiffs' Trade Mark "SAINT-GOBAIN". According to him, having agreed not to use the plaintiffs' Trade Mark but now having re-commenced using the said Trade Mark, the applicants / plaintiffs are entitled for the relief of interim injunction as prayed for in these applications.

8. The learned Senior Counsel appearing for the applicants / plaintiffs would also highlight the distinctive identity of the plaintiffs' Trade Mark "SAINT-GOBAIN" after drawing the attention of this Court to the averments contained in the plaint. According to him, having attained distinctive identity by long usage, the respondents / defendants cannot be permitted to infringe the applicants / plaintiffs' Trade Mark "SAINT-GOBAIN".

9. The learned Senior Counsel appearing for the applicants / plaintiffs



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would also submit that only in respect of the agreements which have been terminated by the applicants / plaintiffs, the interim injunction is prayed for in these applications. In so far as toughened glasses are concerned, the applicants / plaintiffs have already terminated the contract of the respondents / defendants and the applicants / plaintiffs are, therefore, entitled to seek injunction as prayed for in these applications.

10. The learned Senior Counsel appearing for the applicants / plaintiffs would submit on instructions that the interim injunction that may be granted by this Court can be restricted only to the agreements which have been terminated by the applicants / plaintiffs and he would submit that the agreements which are still alive, are for wall coverings and high painting tops. According to him, excepting for the aforesaid two agreements, which are getting expired on 31.12.2024, the other agreements have been terminated by the applicants / plaintiffs. Therefore, according to him, the interim injunction can be granted for all the agreements, excepting for those two agreements referred to supra. Further, he would contend that the arbitration clause relied upon by the respondents / defendants is not found in the Trade Mark licence agreement dated 30.12.2021. Therefore, according



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to him, the suit claim is not an arbitrable dispute. He would also submit that in case of a Trade Mark infringement suit, as well as copyright infringement suit, which is an *action in rem*, the said dispute is not arbitrable.

11. The learned Senior Counsel appearing for the applicants / plaintiffs drew the attention of this Court to a Judgment of the Honourable Supreme Court in the case of ***A. Ayyasamy Vs. A. Paramasivam and Others reported in 2016 (10) SCC 386*** and would submit that as per the said decision, patent, Trade Mark and copyright infringement suits are not arbitrable. Hence, he would submit that the present suit is maintainable even if there is an arbitration clause available in the contract. Further, he would also submit that since the Trade Mark licence agreement does not contain an arbitration clause, this suit is maintainable.

12. On the other hand, the learned counsel for the respondents / defendants would reiterate the contents of the counter affidavit filed in support of these applications and would contend as follows:

a) The suit is not maintainable since the the applicants / plaintiffs have not complied with the statutory requirement of Section 12 A of the



Commercial Courts Act, by going for pre-suit mediation prior to the filing of the suit;

b) The contract entered into between the applicants / plaintiffs and the respondents / defendants contains an arbitration clause. Hence, the suit is not maintainable as the dispute can be resolved only through mediation / arbitration;

c) The learned counsel for the respondents / defendants drew the attention of this Court to Section 30 of the Trade Mark Act and would submit that since the dispute arises out of a contract, Section 30 of the Trade Mark Act applies to the facts of the instant case. According to him, the respondents / defendants having entered into a contract with the applicants / plaintiffs, the respondents / defendants are not a third party and hence, Section 30 of the Trade Marks Act gets attracted.

13. The learned counsel for the respondents / defendants would also submit that as seen from the exchange of correspondences between the applicants / plaintiffs and the respondents / defendants, the respondents / defendants were always willing for an amicable settlement to resolve the dispute with the applicants / plaintiffs. According to him, without instituting



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the pre-suit mediation as per Section 12 A of the Commercial Courts Act, the suit has been filed and therefore, the suit and the connected applications are not maintainable.

14. The respondents / defendants had purchased machinery valued more than 1.25 Crores from the applicants / plaintiffs and the name of the machinery is "SAINT-GOBAIN SEVA FURNACE" and therefore, the applicants / plaintiffs could not have any objection for the respondents / defendants, using the name "SAINT-GOBAIN SEVA FURNACE". He would submit that the respondents / defendants are using the name "SAINT-GOBAIN SEVA FURNACE" only for the product description and not for anything else.

Discussion:

15. The issue that arises for consideration to adjudicate these interlocutory applications are as follows:

- a) Whether the suit claim is an arbitrable dispute?;
- b) Whether there is non-compliance of Section 12A of the Commercial Courts Act by the plaintiff?;



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c) Whether the plaintiff has made out a *prima facie* case and has also established balance of convenience and irreparable hardship for the grant of interim injunction as prayed for in these applications?

16. Admittedly, the first respondent / first defendant was appointed as a processor by the applicant / plaintiff, who is a manufacturer of the products sold under the Trade Mark "SAINT-GOBAIN". It is also an admitted fact that the applicant / plaintiff is having Trade Mark registration for "SAINT-GOBAIN" marks under various classes. It is also an admitted fact that the applicant / plaintiff is a leading player in the business of glass manufacturing.

17. Two contracts were entered into between the applicants / plaintiffs with the first respondent / first defendant. One is the service level agreement dated 16.08.2022, which deals with the scope of work entrusted to the first respondent / first defendant by the applicants / plaintiffs. The other is the licence agreement dated 30.12.2021, which grants licence to the first respondent / first defendant to use the applicants' / plaintiffs' Trade Mark "SAINT-GOBAIN" till the expiry of the licence period. The arbitration



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clause is found only in the service level agreement dated 16.08.2022, but is not found in the licence agreement dated 30.12.2021. The suit filed by the applicants / plaintiffs is a suit for Trade Mark infringement and for passing off in respect of the applicants' / plaintiffs' Trade Mark "SAINT-GOBAIN". Therefore, the dispute arises out of only the licence agreement dated 30.12.2021 and not the service level agreement dated 16.08.2022.

18. The respondents / defendants have entered appearance in the suit as well as in the interlocutory applications filed by the applicants / plaintiffs. They have also filed a counter affidavit in the interlocutory applications filed by the applicants / plaintiffs. Though, they have raised a contention that the suit is not maintainable on the ground of the existence of an arbitration clause, they have not filed an application under Section 8 of the Arbitration and Conciliation Act, seeking for reference of the dispute to arbitration. Except for taking a plea in the counter that on account of the existence of arbitration clause, the suit is not maintainable, the respondents / defendants have not exercised the statutory provision available under the Arbitration and Conciliation Act for reference of the dispute to arbitration under Section 8 of the Arbitration and Conciliation Act.



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19. Admittedly, the contract pertaining to toughened glass between the applicants / plaintiffs and the respondents / defendants has got expired and it has also not been renewed thereafter. The applicants / plaintiffs also contend that since the contract in respect of toughened glasses has got expired, the first respondent / first defendant cannot claim rights arising out of the expired contract.

20. *Prima facie* Section 30 of the Trade Marks Act will not apply to cases where the contract has got expired as in the present case. Since the licence for using the applicants' / plaintiffs' Trade Mark "SAINT-GOBAIN" has come to an end as per the licence agreement dated 30.12.2021, which is an exclusive agreement pertaining to the usage of the Trade Mark "SAINT-GOBAIN", Section 30 of the Trade Marks Act will not get attracted. Section 30 of the Trade Marks Act reads as follows:

"30. Limits on effect of registered trade mark.

—(1) Nothing in section 29 shall be construed as preventing the use of a registered trade mark by any person for the purposes of identifying goods or services as those of the proprietor provided the use—



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(a) is in accordance with honest practices in industrial or commercial matters, and

(b) is not such as to take unfair advantage of or be detrimental to the distinctive character or repute of the trade mark.

(2) A registered trade mark is not infringed where—

(a) the use in relation to goods or services indicates the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services or other characteristics of goods or services;

(b) a trade mark is registered subject to any conditions or limitations, the use of the trade mark in any manner in relation to goods to be sold or otherwise traded in, in any place, or in relation to goods to be exported to any market or in relation to services for use or available for acceptance in any place or country outside India or in any other circumstances, to which, having regard to those conditions or limitations, the registration does not extend;

(c) the use by a person of a trade mark—

(i) in relation to goods connected in the course of trade with the proprietor or a registered



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user of the trade mark if, as to those goods or a bulk of which they form part, the registered proprietor or the registered user conforming to the permitted use has applied the trade mark and has not subsequently removed or obliterated it, or has at any time expressly or impliedly consented to the use of the trade mark; or

(ii) in relation to services to which the proprietor of such mark or of a registered user conforming to the permitted use has applied the mark, where the purpose and effect of the use of the mark is to indicate, in accordance with the fact, that those services have been performed by the proprietor or a registered user of the mark;

(d) the use of a trade mark by a person in relation to goods adapted to form part of, or to be accessory to, other goods or services in relation to which the trade mark has been used without infringement of the right given by registration under this Act or might for the time being be so used, if the use of the trade mark is reasonably necessary in order to indicate that the goods or services are so adapted, and neither the purpose nor the effect of the use of the trade mark is to indicate, otherwise than in accordance with the fact, a connection in the course of trade between any person and the goods or services,



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as the case may be;

(e) the use of a registered trade mark, being one of two or more trade marks registered under this Act which are identical or nearly resemble each other, in exercise of the right to the use of that trade mark given by registration under this Act.

(3) Where the goods bearing a registered trade mark are lawfully acquired by a person, the sale of the goods in the market or otherwise dealing in those goods by that person or by a person claiming under or through him is not infringement of a trade mark by reason only of—

(a) the registered trade mark having been assigned by the registered proprietor to some other person, after the acquisition of those goods; or

(b) the goods having been put on the market under the registered trade mark by the proprietor or with his consent.

(4) Sub-section (3) shall not apply where there exists legitimate reasons for the proprietor to oppose further dealings in the goods in particular, where the condition of the goods, has been changed or impaired after they have been put on the market. "



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As seen from the aforementioned section, only in cases where the contract is alive and has not been terminated either on account of its expiry or on account of any breach, Section 30 of the Trade Marks Act, 1999 may aid the respondents / defendants if at all.

21. The question, under what circumstances a Trade Mark dispute is arbitrable, is answered in the following paragraphs:

Until the recent four-part test laid down by the Honourable Supreme Court in the case of *Vidya Drolia*, arbitrability of disputes in India was primarily determined by the criteria laid down by the Honourable Supreme Court in the case of *Booz Allen Hamilton Vs. SBI Home Finance* reported in **2011 (5) SCC 532**. In *Booz Allen* case, the Honourable Supreme Court while listing out well recognized examples of non arbitrable disputes also laid down two broad categories of disputes that are ousted from the scope of arbitration and they are as follows:

a) **Ouster based on rights in rem** - Disputes relating to the rights that operated in personam could be resolved through arbitration, while those disputes that concerned in rem rights had to be necessarily adjudicated by



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public tribunals. However, the Honourable Supreme Court went on to clarify that the aforesaid rule was not a 'rigid' or inflexible one. It also observed that in personam subordinate rights flowing from rights in rem were clearly arbitrable;

b) Ouster based on forum exercising exclusive jurisdiction –

Disputes arising out of a special statute, which are reserved for the exclusive jurisdiction of special courts are generally considered to be non arbitrable.

Until 2020, the issue of arbitrability of Intellectual Property disputes was always contested based on the aforesaid tests.

22. The dictum of the Hon'ble Supreme Court in *Booz Allen*, affirming that subordinate *in personam* rights flowing from rights *in rem* were arbitrable, had paved the way for arbitration of IP disputes in India. In fact, the Hon'ble Supreme Court, in *Booz Allen*, itself provided an instance to support this distinction, i.e., while rights under a patent licence may be arbitrated, the validity of the underlying patent are not. Thus, instead of a blanket ban on the arbitration of IP disputes, it became crucial for the courts and tribunals to have a case-by-case analysis of the actual issue involved to adjudicate on the arbitrability of IP disputes.



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23. In the cases of *A. Ayyasamy vs. A. Paramasivam and Ors.* and *Emaar MGF Land Ltd. V.Aftab Singh*, while dealing with the issue of arbitrability of fraud and landlord-tenant disputes, respectively, the Honourable Supreme Court has also made general observations about IP disputes being outside the scope of arbitration.

24. In *Vidya Drolia* case, the Hon'ble Supreme Court, propounded a fourfold test to ascertain the instances in which the subject matter of a dispute in an arbitration agreement is not arbitrable (*Vidya Drolia Test*). These include:

- a) When the cause of action and subject matter of the dispute relate to actions *in rem*, that do not pertain to subordinate rights *in personam* that arise from rights *in rem*;
- b) When the cause of action and subject matter of the dispute affects third party rights; have *erga omnes* effect; require centralised adjudication, and mutual adjudication would not be appropriate and enforceable;
- c) When the cause of action and subject matter of the dispute relate to inalienable sovereign and public interest functions of the State and hence



mutual adjudication would be unenforceable;

d) When the subject matter of the dispute is expressly or by necessary implication non-arbitrable as per mandatory statute(s).

25. However, the Hon'ble Supreme Court has further explained in Vidya Drolia's case that the aforementioned tests are not watertight compartments; they dovetail and overlap, *albeit* when applied holistically and pragmatically, will help and assist in determining and ascertaining, with a great degree of certainty, when a dispute or subject matter is non-arbitrable under the Indian law.

26. The Honourable Supreme Court in Vidya Drolia's case in the later part of the Judgment also clarified that the issue of arbitrability should necessarily be dealt with on a case to case basis. In the case on hand, the agreement which had earlier permitted the respondents / defendants to use the applicants' / plaintiffs' Trade Mark "SAINT-GOBAIN" has admittedly got expired. The applicants / plaintiffs has also expressed its unwillingness to renew the contracts, which were earlier executed by them in favour of the respondents / defendants. The licencing agreement pertaining to grant of



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licence to use the Trade Mark "SAINT-GOBAIN" in favour of the respondents / defendants also does not contain an arbitration clause. The respondents / defendants have also not filed any application under Section 8 of the Arbitration and Conciliation Act, seeking for reference of the dispute to arbitration even assuming there exists an arbitration clause in the contract entered into between the applicants / plaintiffs and the respondents / defendants. The respondents / defendants have also acquiesced to the jurisdiction of this Court by filing a detailed counter to the injunction applications filed by the applicants / plaintiffs. The defences raised by the respondents / defendants in their counter include the defences on merit as well, apart from raising the plea of existence of an arbitration clause.

27. Section 8 of the Arbitration and Conciliation Act stipulates that for seeking a direction from the Court to refer the dispute to arbitration, the said application should be filed before contesting the suit on merits. In the instant case, apart from not filing an application under Section 8 of the Arbitration and Conciliation Act, the respondents / defendants have chosen to contest the suit as well as the interlocutory applications filed by the applicants / plaintiffs on merits by raising various defences.



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28. It is also to be noted that the suit *per se* has been filed by the applicants / plaintiffs against the respondents / defendants only as a Trade Mark infringement and passing off suit. The Trade Mark infringement and passing off action are statutory rights given to any aggrieved party under the provisions of the Trade Marks Act and is an *action in rem*. Therefore, when the contract between the applicants / plaintiffs and the respondents / defendants has got expired, it is clear the Trade Mark infringement and passing off suit filed by the applicants / plaintiffs does not arise out of any contract, as the suit instituted by the applicants / plaintiffs is only an action in rem.

29. Both in Vidya Drolia case as well as in *Booz Allen's* case, the Honourable Supreme Court held that Trade Mark disputes of the nature, this Court is presently dealing with is an action in rem and it is not an arbitrable dispute. The contract permitting the respondents / defendants to use the applicants' / plaintiffs' Trade Mark "SAINT-GOBAIN" also does not contain any arbitration clause. This also supports the contention of the applicants / plaintiffs that the subject matter of this dispute is not arbitrable. Therefore,



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the first defence raised by the respondents / defendants that the suit is not maintainable on account of there being an arbitration clause, has to be rejected by this Court.

30. In so far as the non compliance of Section 12A of the Commercial Courts Act by the applicants / plaintiffs is concerned, the said contention of the respondents / defendants has also got to be rejected for the following reasons:

a) Adequate averments have been made in the plaint as to why the plaintiff did not go for pre-suit mediation in as per Section 12A of the Commercial Courts Act. In the reply to the cease and desist notice, the respondents / defendants have stated that they shall stop using the applicants' / plaintiffs' Trade Mark "SAINT-GOBAIN". The said reply was sent on 21.11.2023. But, however, according to the applicants / plaintiffs, the respondents / defendants have re-commenced using the applicants' / plaintiffs' Trade Mark "SAINT-GOBAIN" in respect of the very same toughened glass despite the fact that the contracts entered into with the respondents / defendants has got expired and the applicants / plaintiffs has refused to renew those contracts;



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b) According to the applicants / plaintiffs, as seen from the pleadings, only recently they came to know that the respondents / defendants have re-commenced using the plaintiffs' Trade Mark "SAINT-GOBAIN", which necessitated them to file a suit and seek urgent interim reliefs as prayed for in these applications against the respondents / defendants by not going for pre-suit mediation, in order to protect the interest of the applicants / plaintiffs. This Court at the interlocutory stage will have to look into only the averments contained in the pleadings to find out whether there is urgent necessity for the applicants / plaintiffs to approach this Court and seek for urgent interim relief complying with the requirements of pre-suit mediation.

31. Since adequate averments have been made in the pleadings for not going for pre-suit mediation, which satisfies this Court's conscience, this Court is of the considered view that only due to the necessity to seek the urgent interim reliefs, the applicants / plaintiffs did not institute pre-suit mediation as contemplated under Section 12A of the Commercial Courts Act. Therefore, the second defence raised by the respondents / defendants, namely, non-compliance of Section 12A of the Commercial Courts Act by



the applicants / plaintiffs has to be rejected by this Court.

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32. *Prima facie* this Court does not find any suppression of material facts by the applicants / plaintiffs as seen from the documents filed along with the plaint. There has been sufficient exchange of communications between the applicants / plaintiffs and the respondents / defendants. On a *prima facie* consideration of those communications, this Court does not notice from the correspondence that the applicants / plaintiffs were willing to extend the period of the contract. On the other hand, only the respondents / defendants, who have stated in the reply to the cease and desist notice that they have stopped using the manner and style of co-branding of the applicants' / plaintiffs' Trade Mark "SAINT-GOBAIN" as per the rights given to them under the expired service level agreement dated 16.08.2022. Admittedly, the applicants / plaintiffs is a leading player, both in the domestic and international market, in the field of manufacturing and selling of toughened glasses and other allied products.

33. The applicants / plaintiffs has obtained Trade Mark registration under various classes of the Trade Marks Act and they have been using the



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said Trade Marks for long number of years and by the long usage, certainly they would have acquired a distinctiveness for their Trade Mark "SAINT-GOBAIN" as a mark associated only with them.

34. On the other hand, the respondents / defendants are small time players, when compared to the applicants / plaintiffs and their market share is also relatively much lesser when compared to the applicants / plaintiffs. It is also not in dispute that the respondents / defendants are continuing to use the mark "SAINT-GOBAIN", which exclusively belongs to the applicants / plaintiffs for the sale of toughened glasses, though they may contend that since they have purchased the machinery only from the applicants / plaintiffs, under the name "SAINT-GOBAIN SEVA FURNACE", the applicants / plaintiffs cannot raise any objection for the usage of "SAINT-GOBAIN" by the respondents / defendants. Being a registered proprietor and exclusive owner of the Trade Mark "SAINT-GOBAIN" and the contract with the respondents / defendants having got expired, the question of the respondents / defendants continuing to use the applicants' / plaintiffs' Trade Mark "SAINT-GOBAIN", for toughened glass and other products for which the contract has already got expired / terminated, does not arise as it would



amount to committing an act of infringement/passing off.

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35. Once the contracts have got expired / terminated, any dispute pertaining to the usage of the Trade Mark is an *in rem* dispute as it affects the world at large as the present suit is an infringement and passing off suit. On a prima facie consideration, there has been no suppression of material facts by the applicants / plaintiffs. The contracts produced by the respondents / defendants before this Court are contracts, which have either got expired or it pertains to products, which are not the subject matter of the present dispute. Excepting for two contracts, the other contracts have already got expired. Even the said two contracts are scheduled to get expire shortly.

36. Though the Honourable Supreme Court has held in both its decisions, i.e. *M/s.Patil Automation Private Limited vs. Rakheja Engineers Private Limited reported in 2022 (10) SCC 1* as well as in *Yamini Manohar vs T.K.D.Keethi reported in 2023 SCC Online SC 1382* that compliance of Section 12A of the Commercial Courts Act is mandatory, in both the decisions, it has been held that whenever an urgent interim relief



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is made out, there is no necessity for the party to initiate pre-suit mediation.

37. As observed earlier, only out of an urgent necessity, the applicants / plaintiffs have filed this suit without instituting pre-suit mediation being the registered proprietor of the trade mark "SAINT-GOBAIN" and the said trade mark has acquired distinctiveness and is also associated exclusively with the applicants / plaintiffs, the applicants / plaintiffs are certainly entitled for the interim injunction as prayed for in these applications. The case of the applicants / plaintiffs falls under the exceptions for the necessity to institute pre-suit mediation as laid down by the Honourable Supreme Court in both *Patil Automation case* as well as *Yamini Manohar* case referred to supra. On a prima facie consideration, this Court also does not find merit in the respondents' / defendants' contention that by cleaver drafting of the plaint, the applicants / plaintiffs has avoided the pre-suit mediation.

38. The decisions relied upon by the learned counsel for the respondents / defendants in

1. SBI General Insurance Co. Ltd., Vs. Krish Spinning reported in ***2024 SCC Online SC 1754;***



2. *EBIX Cash Pvt. Ltd., Vs. State of Maharashtra and 2 Ors. (Writ*

Petition No.6707 of 2024 - Bombay High Court - 22.07.2024 - DB);

3. *National Agricultural Co-Op ... Vs. Gains Trading Ltd., (2007) 5*

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are not applicable to the facts of the instant case as Section 30 of the Trade Marks Act, which was highlighted by the learned counsel for the respondents / defendants during the course of his arguments does not get attracted for the following reasons:

a)The contract permitting the respondents / defendants to use the applicants' / plaintiffs' Trade Mark "SAINT-GOBAIN" has got expired and further the licence agreement dated 30.12.2021 does not contain an arbitration clause;

b)The subject matter of the dispute is certainly a Trade Mark dispute and it does not arise out of any contract as the earlier contract entered into with the respondents / defendants has admittedly got expired and the same has also not been renewed by the applicants / plaintiffs.

39. The applicants / plaintiffs have satisfied the trinity test of

a) *Prima facie* case;

b) Balance of convenience; and



c) Irreparable hardship

and therefore, they are entitled for interim injunction as prayed for in these applications. However, interim injunctions can be granted only in respect of those contracts, which has come to an end, which includes the service level agreement dated 16.08.2022, which pertains to toughened glass and is the subject matter of the present dispute and not in respect of contracts for other allied products, which are scheduled to come to an end on the respective dates mentioned in those contracts. But, even in respect of those two live contracts, the interim injunction order granted by this Court shall become operative immediately on the expiry of those contracts as well.

40. Any observation made by this Court in this order has been made only for the purpose of deciding these interlocutory applications and the same will not have any bearing, while this Court adjudicates the main suit.

41. In the result, these applications are disposed of by granting interim injunction in favour of the applicants / plaintiffs against the respondents / defendants as prayed for in these applications in respect of the contracts entered into between the applicants / plaintiffs and the first respondent / first defendant in so far as the contracts which have already



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been expired / terminated and in so far as the contracts which are still alive and likely to expire shortly, the interim injunction granted by this Court in favour of the applicants / plaintiffs against the respondents / defendants as prayed for in these applications shall become operative only after those contracts have got expired / terminated. But, in case, the said contracts are renewed by the applicants / plaintiffs for a further period, the interim injunction granted by this Court shall not apply to those contracts.

42. In terms of the aforesaid directions, O.A.Nos.864 to 868 of 2024 are disposed of.

09.12.2024

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Index: Yes/No

Speaking/Non Speaking Order

Neutral Citation Case: Yes/No

Note: Post the matter for filing of written statement on 13.01.2025.



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