



\$~15

* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

+ **CM(M)-IPD 16/2023 & CM APPL. 42459/2023**

SHRI DHIRAJ KUMAR

..... Petitioner

Through: Mr. T.K. Tiwari, Advocate.

versus

R H AGRO OVERSEAS PVT LTD & ANR.

..... Respondents

Through: Ms. Rina Majumdar, Mrs. Bindra Rana,
and Ms. Shilpi Sinha, Advocates.

CORAM:

HON'BLE MR. JUSTICE ANISH DAYAL

ORDER

%

20.02.2024

CM(M)-IPD 16/2023 & CM APPL. 42459/2023 (for stay of proceedings)

1. This petition has been filed assailing order dated 09th May, 2023, passed by District Judge (Commercial)-04, South District, Delhi, Saket Courts, Delhi in **C.S (COMM.) No. 03/2023** titled as ***M/s R.H. Agro Overseas Pvt. Ltd & Anr. Vs. Dhiraj Kumar & Anr.***

2. Respondents herein, (original plaintiffs) filed a civil suit for permanent injunction restraining infringement of trademarks and copyright including passing off and other attendant reliefs against the petitioners herein.

3. Respondents/plaintiffs claimed registration in their trademark 'NAFIS' (registered since 2006), 'NAFIS' logo (registered since 2012), and 'NAFIS' products (registered since 2012) in classes 16, 30, and 31 for rice; as also copyright in the artistic work in its packaging of 'NAFIS' brand basmati rice.



Other trademarks have also been obtained by plaintiffs therein.

4. On 13th January, 2023, the matter came up before the District Judge; counsel for plaintiff pressed an application under Order XXXIX Rule 1 & 2, Code of Civil Procedure, 1908 ('CPC') seeking an *ex-parte ad interim* injunction on the ground that defendant was likely to remove the goods from his establishment and godowns which would defeat the very purpose of the suit.

5. Accordingly, an order was passed on 19th January, 2023 granting an *ex-parte ad interim* injunction in favour of plaintiffs and against defendants therein restraining them directly or indirectly in any manner from infringing the plaintiffs' registered trade marks or using defendant's mark 'NAFIS' or any other mark which is visually, phonetically, confusingly, or deceptively similar thereto in respect of their goods and services or indulging in any act which would amount to passing off.

6. Aside from the *ex-parte ad interim* injunction, an application for appointment of Local Commissioner was also allowed by the District Judge and a Local Commissioner was appointed. Local Commission had been executed.

7. On 13th March, 2023, both parties agreed to explore the possibilities of settlement and the parties were then directed to appear before the Mediator. However, subsequently, mediation failed. Counsel for respondent herein also showed screenshots of WhatsApp chat that she had with counsel for defendant wherein it was stated by the latter that there was no purpose in continuing mediation since the terms were not acceptable.

8. However, petitioner/defendant has despite these events sought to assert his application under Order VII Rule 11, CPC on the ground that District Judge did not refer the parties to pre-litigation mediation in compliance of Section 12-



A of the Commercial Courts Act, 2015 and instead proceeded ahead to issue summons and passed an *ad interim* injunction.

9. A perusal of the impugned order would show that various decisions passed by Hon'ble Supreme Court in ***Patil Automation Pvt. Ltd. v. Rakheja Engineers Pvt. Ltd.***, 2022 (10) SCC 1 and Delhi High Court in ***Chandra Kishore Chaurasiya v RA Perfumery Works Pvt. Ltd.***, 2022/DHC/004454 have been adverted to by the District Judge in this regard. Relying on the same, the District Judge has rightly held that if urgent relief is made out, the remedy of pre-institution mediation as contained in Section 12-A of the Commercial Courts Act, 2015 may not be directed.

10. This issue has since also found deliberation recently in the Hon'ble Supreme Court decision of ***Yamini Mahohar v. T K D Keerthi***, SLP(C) No. 32275/2023, relevant portions of which are extracted as under:

“We are of the opinion that when a plaint is filed under the CC Act, with a prayer for an urgent interim relief, the commercial court should examine the nature and the subject matter of the suit, the cause of action, and the prayer for interim relief. The prayer for urgent interim relief should not be a disguise or mask to wriggle out of and get over Section 12A of the CC Act. The facts and circumstances of the case have to be considered holistically from the standpoint of the plaintiff. Non-grant of interim relief at the ad-interim stage, when the plaint is taken up for registration/admission and examination, will not justify dismissal of the commercial suit under Order VII, Rule 11 of the Code; at times, interim relief is granted after issuance of notice. Nor can the suit be dismissed under Order VII, Rule 11 of the Code, because the interim relief, post the arguments, is denied on merits and on examination of the three principles, namely, (i) prima facie case, (ii) irreparable harm and injury, and (iii) balance of convenience. The



fact that the court issued notice and/or granted interim stay may indicate that the court is inclined to entertain the plaint.”

(emphasis added)

11. Be that as it may, the purpose of mediation is so that parties can attempt a settlement between themselves. It is clear from proceedings before the District Judge that parties were referred to mediation at their request, and mediation has subsequently failed. In light of the same, at this stage of the suit, to reverse the clock and contend that they ought to have gone for pre-litigation mediation is neither apposite nor useful, and untenable.

12. Furthermore, proceedings between the parties, the suit have gone ahead. The defendants’ anxiety to press an application under Order VII Rule 11 of CPC for pre-institution of mediation is, therefore, rendered effectively infructuous and serves no purpose whatsoever.

13. Counsel for petitioner herein further states that he had taken another ground in his application under Order VII, Rule 11 of CPC relating to a bar under Section 93 of the Trade Marks Act, 1999 (**‘TM Act’**) under which, a challenge to an order or decision passed by the Registrar of Trade Marks is appealable under Section 91 of the TM Act.

14. For this, he adverts to the order of publication of his trademark pursuant to filing of his application. He states that the order of publication could have been appealed by the claimant/respondent under Section 91 of TM Act and they were precluded from approaching the Court for a suit for injunction. *Ex facie*, this plea and proposition by the petitioner/defendant is without any basis.

15. A plaintiff who seeks to protect their registered trade mark from infringement and passing off are entitled to proceed in a civil suit as per Section 134 of the Trademarks Act and there is no exclusion/prohibition in this regard.



Also, there is no order which necessitates an appeal under section 91. The trade mark registration proceedings are underway before the Registrar of Trade Marks and the opposition has still to be considered.

16. In any event as has been noted in the impugned order section 93 was deleted from the Act in 2021 w.e.f. 04.04.2021 and the suit was filed on 02.01.2023. Appeals post-amendment are preferred before the High Court.

17. Present petition is accordingly dismissed.

18. Pending applications, if any, also stand disposed of.

19. Parties may go ahead with the suit proceedings before the District Judge.

20. Order be uploaded on the website of this Court.

ANISH DAYAL, J

FEBRUARY 20, 2024/RK/sc