



A No. 726 of 2025

IN THE HIGH COURT OF JUDICATURE AT MADRAS

<i>RESERVED ON</i>	<i>08.10.2025</i>
<i>PRONOUNCED ON</i>	<i>25.10.2025</i>

CORAM

THE HONOURABLE MR.JUSTICE N.SENTHILKUMAR

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in

C.S. (Comm Div) No.152 of 2024

1. Arun R

No. 2, 2nd Cross, Nehru Street,
Gandhinagar, Pattabiram, Chennai
Tamil Nadu, India.

2.Dinesh M

No. 46, 3rd street, MGR Nagar, Cycle
Shop, Puzhal, Chennai, Tamil Nadu,
India.

3. M/S ESPOIRS SOLUTION Rep by

its Partner G LAKSHMI PRABHA

Block No. 95, 1st Floor, Mullai Street,
Vivekanandha Nagar, Thirumullaivoyal,
Chennai, Tamil Nadu, India.

Applicant(s)



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Vs

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1. M/s Integray Health Care Private Limited
No. B2, Plot No 130, Thiruvengada Nagar, Ambattur, South End Road, Chennai - 600053, Tamil Nadu, India.

2. Vijayakumar Irusappan
No. B2, Plot No 130, Thiruvengada Nagar, Ambattur, South End Road, Chennai - 600053, Tamil Nadu, India.

3. Sabarinathan Irusappan
No. B2, Plot No 130, Thiruvengada Nagar, Ambattur, South End Road, Chennai - 600053, Tamil Nadu, India.

4. Controller Of Patents And Designs
Designs Office, Intellectual Property Office Building, CP-2 Sector V, Salt Lake City, Kolkata-700091.

Respondent(s)

PRAYER

Application filed to direct the Respondent No.4 to transfer the petition for cancellation of the impugned design registration with Design No.400027-001 in favour of Respondent No.1 filed by the Applicants herein before the Respondent No.4 bearing Reference NO.D-9/107/2024-KOL to this Honble Court.



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For Applicant(s): Mr.Ramesh Ganapathy
M/s.Mission Legal

For Respondent(s): Mr. Rajesh Vivekananthan
Deputy Solicitor General

ORDER

The applicants herein/plaintiffs have filed a suit under Order VII Rule 1 CPC read with Order IV Rule 1 of Original Side Rules read with Sections 27 & 135 of the Trade Marks Act, 1999 against respondents 1 to 3 herein/defendants 1 to 3 seeking the following reliefs:

(i) A permanent injunction restraining the defendants, their directors, all their principal officers, staff, men, agent, servants, successors, assigns in business, representatives and any other person from passing off their goods by using the impugned design/shape of the goods, "Carbon Fiber Cervical Extension" in respect of medical equipment and products in relation to it and in any manner from passing off;

(ii) that the defendants be ordered and directed to pay the



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plaintiffs a sum of Rs.5,00,000 by way of damages;

(iii) A preliminary decree be passed in favour of the plaintiffs directing the defendants to render a true and faithful accounts of all profit made by them, using the plaintiffs' said design and a final decree be passed in favour of the plaintiffs for the amount of profit thus found to have been made by the defendants, together with interest, after the defendants has rendered accounts;

(iv) That the defendants be directed to deliver-up to the plaintiffs for destruction, all labels, all other print materials, stickers, signage, visiting cards, letter heads, catalogues, pamphlets, broacher, all other advertising and promotional material, all stationery, and such other material and to shut down all the e-commerce websites as well as social media handles used for passing off the plaintiffs' design/shape.

(v) That the defendants be ordered and directed to pay a sum of Rs.3,27,772/- that is due to the plaintiffs.

(vi) That the defendants be ordered and directed to return the demo product (cervical extension device with floor support - full set) to the plaintiffs and

(vii) costs of the suit.



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2. In the above suit, the plaintiffs have filed an application to direct the 4th respondent, namely the Controller Of Patents And Designs, Kolkatta to transfer the petition for cancellation of the impugned design registration with Design No.400027-001 in favour of Respondent No.1 filed by the applicants herein before the 4th respondent bearing Reference No.D-9/107/2024-KOL, to this court.

3. The parties, namely the applicants herein/plaintiffs and the respondents 1 to 3 herein/defendants are residing in Tamil Nadu, more specifically in Chennai and the 4th respondent is the Controller of Patents and Designs, whose office is situated in Kolkata. According to the applicants, except the fact that the officiating 4th respondent is having its office at Kolkata, there are no other reasons to register the designs of the respondents 1 to 3 with the 4th respondent office.



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4. The learned counsel appearing for the applicants would contend that since the parties, namely the applicants and the respondents 1 to 3 are in Chennai, there will be no prejudice caused to the respondents 1 to 3, if the application, which is pending before the 4th respondent is transferred to this court's jurisdiction.

5. It is appropriate to extract Sections 19 and 22 of the Designs Act, 2000, as follows:

" 5. Section 19 of the Designs Act, 2000 reads as follows:

19. Cancellation of registration - (1) Any person interested may present a petition for the cancellation of the registration of a design at any time after the registration of the design, to the Controller on any of the following grounds, namely:--

(a) that the design has been previously registered in India;

or

(b) that it has been published in India or in any other country prior to the date of registration; or

(c) that the design is not a new or original design; or

(d) that the design is not registrable under this Act; or

(e) that it is not a design as defined under clause (d) of



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section 2.

(2) An appeal shall lie from any order of the Controller under this section to the High Court, and the Controller may at any time refer any such petition to the High Court, and the High Court shall decide any petition so referred.

6. Section 22 of the said Act reads as follows:

22. Piracy of registered design.

(1) During the existence of copyright in any design it shall not be lawful for any person--

(a) for the purpose of sale to apply or cause to be applied to any article in any class of articles in which the design is registered, the design or any fraudulent or obvious imitation thereof, except with the license or written consent of the registered proprietor, or to do anything with a view to enable the design to be so applied; or

(b) to import for the purposes of sale, without the consent of the registered proprietor, any article belonging to the class in which the design has been registered, and having applied to it the design or any fraudulent or obvious imitation thereof; or

(c) knowing that the design or any fraudulent or obvious imitation thereof has been applied to any article in any class of articles in which the design is registered without the consent of the registered proprietor, to publish or expose or cause to be published



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or exposed for sale that article.

(2) If any person acts in contravention of this section, he shall be liable for every contravention--

(a) to pay to the registered proprietor of the design a sum not exceeding twenty-five thousand rupees recoverable as a contract debt, or

(b) if the proprietor elects to bring a suit for the recovery of damages for any such contravention, and for an injunction against the repetition thereof, to pay such damages as may be awarded and to be restrained by injunction accordingly:

Provided that the total sum recoverable in respect of any one design under clause (a) shall not exceed fifty thousand rupees:

Provided further that no suit or any other proceeding for relief under this sub-section shall be instituted in any court below the court of District Judge.

(3) In any suit or any other proceeding for relief under sub-section (2), every ground on which the registration of a design may be cancelled under section 19 shall be available as a ground of defence.

(4) Notwithstanding anything contained in the second proviso to sub-section (2), where any ground on which the registration of a design may be cancelled under section 19 has



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been availed of as a ground of defence under sub-section (3) in any suit or other proceeding for relief under sub-section (2), the suit or such other proceedings shall be transferred by the Court, in which the suit or such other proceeding is pending, to the High Court for decision.

(5) When the court makes a decree in a suit under sub-section (2), it shall send a copy of the decree to the Controller, who shall cause an entry thereof to be made in the register of designs."

6. To support his contention, the learned counsel had relied upon a decision of the Hon'ble Supreme Court in ***Maya Applicances Pvt. Ltd. v. Preethi Kitchen Appliances Pvt. Ltd. and another*** reported in ***2020 SCC OnLine SC 1563***, wherein the Hon'ble Supreme Court had passed the following order:

"7. In the present case, since both the applications for cancellation of each other's design copyright registration is pending before the Controller of Designs, and the suit by the respondent praying for injunction on the basis of infringement and



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passing off, and damages, is pending before the High Court, the Controller of Designs is directed, given Section 19(2) of the Designs Act, to refer both the cancellation applications to the Madras High Court within a period of two weeks from the date of this order."

7. It is relevant to note that the Hon'ble Supreme Court in the first paragraph of the said order, while narrating the facts of the case, has taken note of the following, which is extracted hereunder:

"..... This was followed by a suit filed by the respondent in the High Court of Madras for an injunction against the appellant for alleged passing off and infringement of their design copyright registration. On 12.02.2018, a written statement was filed in the said suit taking up various pleas including pleas that are available under Section 19(1) of the Designs Act, 2000...."

8. The learned counsel further pointed out that he has sent a letter to the fourth respondent on 27.03.2025 stating the pendency of the proceedings before



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this court and the judgment rendered by the Hon'ble Apex Court in the above referred case i.e. ***Maya Appliances Pvt. Ltd. vs. Preethi Kitchen Applicances Pvt. Ltd.*** Despite receipt of notice dated 27.03.2025, the fourth respondent has not taken any steps or passed any orders on the basis of the notice issued by the counsel for the applicants to transfer the cancellation of the design petition to the file of this court.

9. Per contra, the learned counsel appearing for the respondents 1 to 3 has relied upon the order of this court in OP(PT) No.2 of 2024 dated 02.08.2024 between the very same parties and drew the attention of this court to paragraph Nos.12, 14 and 15 of the said order:

"12. Thus in all these enactments, the provisions themselves permit an application to be filed before the High Court. However, insofar as the Designs Act, even though the earlier Designs Act, 1911 enabled such application to be filed before the court, it has been taken away by the Designs Act, 2000 and by incorporation of Section 19, an application for cancellation of Registration can be



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made only to the Controller and an appeal against the order of the Controller is also made available by approaching this court. When an appeal is also made available to the aggrieved party by approaching this court, it cannot be said that this court can exercise concurrent jurisdiction along with the Controller. Therefore, I do not find any merit in the arguments advanced by the learned counsel for the petitioner that the ouster has to be express and in the absence of an express ouster, it has to be implied that the jurisdiction of this court is available to be exercised by this court, including entertaining an application under Section 19 for cancellation of the designs.

14. In view of the above reasons, I hold that the original petition filed before this court is not maintainable and the petitioner has to necessarily approach the Controller having jurisdiction and canvass all its objections there.

15. In fine, the original petition is dismissed. However, liberty is granted to the petitioner to move the jurisdictional controller and if the said application is made within a period of 60 days from the date of receipt of the copy of this order, the Controller shall not hold delay or limitation against the petitioner and shall take up the application on merits and decide the same in accordance with law after hearing all the parties concerned. Consequently, connected



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application is also dismissed. No costs."

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10. He also relied upon the judgment of the Hon'ble Supreme Court in Civil Appeal No.3695 of 2020 in ***S.D.Containers, Indore vs. Mold Tek Packaging Ltd. decided on 01.12.2020*** and drew the attention of this court to the observations made by the Hon'ble Supreme Court in paragraph Nos.13 and 14, which are extracted hereunder:

"13. It was held that any application for cancellation of registration under Section 19 could be filed only before the Controller and not to the High Court. Therefore, in these circumstances, it was held that the High Court would be entitled to assume jurisdiction only in appeal. It was not a case of suit for infringement in which the defendant has raised a plea of revocation of registration which is required to be transferred to the High Court in terms of Section 22(4) of the 2000 Act. Therefore, such judgment has been wrongly relied upon by the High Court assuming that the proceedings are before the Controller and that the plaintiff/respondent had filed a suit for infringement wherein a plea of revocation of registration was raised which was required to



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by referring the very same judgment at paragraph No.20, drew the attention of this court and the said finding is extracted hereunder:

" 20. In view of the above, the order of the Commercial court at the District Level is in accordance with law. However, we are unable to agree with the commercial court to transfer such suit to Calcutta High Court. The High Court, where the cause of action arises has the jurisdiction to entertain the suit in terms of Godrej Sara Lee. Since no part of cause of action has arisen within the jurisdiction of Kolkata, the suit is liable to be transferred to Madhya Pradesh High Court, Indore Bench. In fact, the plaintiff has filed suit at Indore, Madhya Pradesh only."

The Hon'ble Supreme Court has taken a view that since the parties are one and the same, instead of the case being conducted or initiated at Kolkatta, the suit may be transferred to Madhya Pradesh High Court, Indore Bench and that the plaintiff has filed the suit at Indore, Madhya Pradesh only.

13. The learned counsel appearing for the respondents 1 to 3 would



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submit that Section 22 of the Designs Act, 2000 refers to the piracy of the registered design and does not deal with passing off.

14. The learned counsel appearing for the applicants/plaintiffs relied upon the Tamil Nadu Government Gazette dated 5th April, 2023 and referred to Rule 6(14) and Rule 14 of Madras High Court Intellectual Property Rights Division Rules, 2022, which are extracted hereunder:

Rule 6: Procedure for Original Petitions (Civil Original Petition)

(14) The court may direct consolidation of a suit for infringement or passing off involving an IPR with any other proceeding(s) before it, involving the same IPR at any stage.

Rule 14: Consolidation of matters or cases or proceedings or disputes

(1) Where there are multiple proceedings relating to the same or related IPR, irrespective of whether the said proceedings are between the same parties or not, the IPD may such expert(s) on its own motion or on an application of any other parties, and after hearing such of them as desired to be heard, wherever appropriate,



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to direct consolidation of proceedings, hearings, and also to direct consolidated recording of evidence/common trial and consolidated adjudication.

(2) If the court is of the opinion that any matter pending before a Commercial Court is to be consolidated with a matter pending before the IPD it may exercise powers of transfer under Section 24, Code of Civil Procedure, 1908 for transfer and consolidation of such matter to itself.

15. I have given my anxious consideration to the rival submissions.

16. Rule 6(14) of the Madras High Court Intellectual Property Rights Division Rules, 2022, empowers the court to direct consolidation of the suit for infringement involving an IPR with any other proceeding(s) before it, involving the same IPR at any stage. Rule 14 provides for consolidation of matters or cases or proceedings or disputes and sub clause (1) and (2) of the said rule gives power to consolidate the proceedings and there is no impediment to adjudicate that the case, which falls under the category of Cancellation of Registration,



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before the court, which has competent jurisdiction.
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17. The Hon'ble Supreme Court in the cases cited supra, has, made it clear that there is no impediment to transfer the cases to a competent court when the parties are residing at one place and permitted the transfer of proceedings from the competent authority. In view of the settled proposition of the Hon'ble Supreme Court, I am of the considered view that the prayer made in this application can be granted.

18. Accordingly, this application is ordered as prayed for and the 4th Respondent, namely the Controller Of Patents And Designs, Kolkatta, is directed to transfer the petition for cancellation of the impugned design registration with Design No.400027-001 in favour of Respondent No.1 filed by the Applicants herein bearing Reference No.D-9/107/2024-KOL to this court.



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No costs.

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25.10.2025

Asr

Index: Yes/No

Speaking/Non-speaking order

Internet: Yes

Neutral Citation: Yes/No



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To

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- 1.M/s Integray Health Care Private Limited
No. B2, Plot No 130, Thiruvengada Nagar, Ambattur, South End Road, Chennai - 600053, Tamil Nadu, India.
- 2.Vijayakumar Irusappan
No. B2, Plot No 130, Thiruvengada Nagar, Ambattur, South End Road, Chennai - 600053, Tamil Nadu, India.
- 3.Sabarinathan Irusappan
No. B2, Plot No 130, Thiruvengada Nagar, Ambattur, South End Road, Chennai - 600053, Tamil Nadu, India.
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N.SENTHILKUMAR J.

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