



OSA (CAD) Nos.15 to 19 of 2025

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 07.02.2025

CORAM

THE HON'BLE MR.K.R.SHRIRAM, CHIEF JUSTICE

AND

THE HON'BLE MRS.JUSTICE R.KALAIMATHI

**OSA(CAD) Nos. 15 to 19 of 2025
and CMP Nos.2145, 2157, 2161, 2176 and 2178 of 2025**

1. M/s.Sakthi Sai Safety Glass India,
A Partnership Firm Through its Partner,
Mr.B.Ganesh, No.16, 17 and 18,
Anna Industrial, Gopal Nagar,
Vadaperumbakkam, Madhavaram,
Chennai - 600 060 Tamil Nadu.

2. Sakthi Sai Glass Traders,
Through its Partners, Mr.B.Ganesh and
Mr.Karunakaran, No.934 (Old No.559),
Poonamallee High Road, Arumbakkam,
Chennai 600 106, Tamil Nadu.

.. Appellants
in all OSAs.

Vs

1. Compagnie De Saint-Gobain
Tour Saint Gobain, 12 Place de l Iris 92400,
Courbevoie France, Rep. by its Constituted
Attorney, Mr.Animesh Saha,
Having office at Floor No.7, Sigapi Achi Building,
18/3, Rukmini Lakshmipathy Road,
Egmore , Chennai 600 008,
Tamil Nadu, India.



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2. Saint-Gobain India Private Limited,
Rep. by its Authorized Signatory Mr.Animesh Saha,
Floor No.7, Sigapi Achi Building, 18/3,
Rukmini Lakshmipathy Road, Egmore,
Chennai 600 008, Tamil Nadu, India.

.. Respondents
in all OSAs.

Prayer: Appeals filed under Section 13 of the Commercial Courts Act, 2015, read with Order XXXVI Rule 9 of Original Side Rules against the common order dated 09.12.2024 passed in O.A.Nos.867, 866, 868, 865 and 864 of 2024 in C.S. (Comm Div) No.227 of 2024 on the file of original side of this Court.

For Appellant(s): Mr.G.Ramesh

For Respondent(s): Mr.P.S.Raman
Senior Counsel
Mr. M.S.Bharath

* * * * *

COMMON JUDGMENT

(Judgment of the Court was delivered by the Hon'ble Chief Justice)

The appeals have been filed impugning a common order dated 09.12.2024 passed by the learned Single Judge by which an interim injunction was given in favour of plaintiffs, that is respondents herein, in respect of the contract entered into between plaintiffs and first defendant, who is the first appellant.



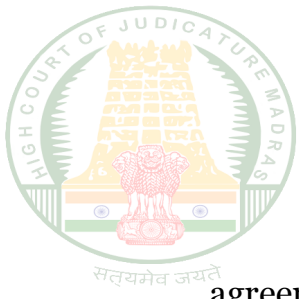
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2. The interim injunction granted, in effect, is restraining defendants, that is appellants from directly or indirectly dealing with any products or rendering any services under the Trade Mark or any other mark which is identical / similar to plaintiffs' Trade Mark "Saint-Gobain" and committing infringement, passing off, copyright in the plaintiffs' original artistic work, domain name and dilution of plaintiffs' Trade Mark "Saint-Gobain".

3. Plaintiffs are stated to be a reputed player in the glass manufacturing industry and have been using the Trade Mark "Saint-Gobain" for many years. The details of the credentials are disclosed in the plaint. It is recorded in the impugned order that these facts have not been disputed by defendants.

4. Respondents (hereinafter referred to as 'plaintiffs') had appointed appellants (hereinafter referred to as 'defendants') as their glass processor and under a contract, defendants were permitted to use the plaintiffs' Trade Mark "Saint-Gobain". It is stated that the period of contract had expired by efflux of time and was not renewed. It is plaintiffs' case that the



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agreement having expired, the relationship with defendants has come to an end. Therefore, defendants were no longer permitted to use the plaintiffs' Trade Mark "Saint-Gobain". Despite issuing Cease and Desist notice, defendants continued to use the plaintiffs' Trade Mark "Saint-Gobain" for sale and distribution of toughened glass. The glass was manufactured by some other party/parties. It is plaintiffs' case that defendants had even given an undertaking to stop using the Trade Mark "Saint-Gobain", which undertaking was breached.

5. Once plaintiffs' came to know that defendants have re-commenced the use of plaintiffs' Trade Mark "SAINT-GOBAIN", plaintiffs filed the interim injunction applications without going for pre-suit mediation as prescribed under Section 12A of the Commercial Courts Act, 2015. Plaintiffs have filed an affidavit stating that as urgent reliefs were required, it became a necessity for plaintiffs to approach the Court without exhausting the statutory requirement of Section 12A of the Commercial Courts Act, 2015, by going for pre-suit mediation.



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6. Defendants filed a counter denying the allegations and raised the defence of - a) plaintiffs not having complied with the mandatory requirement of Section 12A of the Commercial Courts Act, 2015, the relief sought should not be granted; b) as the claim arises out of a contract entered into between the parties, Trademark Infringement Suit is not maintainable; c) the contracts provide for arbitration and therefore, the matter should be referred to arbitration; d) there has been suppression of material facts by plaintiffs; e) despite defendants were ready and willing to go for an amicable settlement and there were exchange of correspondences to that effect, present suit has been filed without complying with the requirement of Section 12A of the Commercial Courts Act, 2015 and hence, the suit is not maintainable.

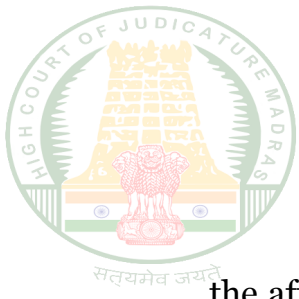
7. It is plaintiffs' case, which of course not disputed by defendants, is that plaintiffs' Trade Mark "SAINT-GOBAIN" has attained a distinctive identity by long usage. According to plaintiffs, hence, defendants cannot be permitted to use the Trade Mark "SAINT-GOBAIN".



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8. On the issue of non-compliance with the statutory requirement of Section 12A of the Commercial Courts Act, Sri.Raman submitted that an affidavit of one Animesh Saha affirmed on 12.11.2024 was filed, in which, it is recorded that several rounds of discussion happened between parties to amicably resolve the disputes and on 07.02.2024, defendants addressed an e-mail referring to the discussions and indicating that they will suspend using the infringing mark. Based on the settlement discussions with defendants and the said e-mail dated 07.02.2024, plaintiffs even issued a draft undertaking letter on 16.02.2024 to defendants to be executed by defendants. The same, however, was not signed by defendants. Even in the plaint, there are averments to that effect at paragraph Nos.49 to 76. In fact, in the plaint, there is also a reference to the e-mail dated 07.02.2024 from defendants assuring that they shall discontinue the use of the infringement Trade mark. We have to note that none of the allegations has been denied in the counter filed for opposing the interim injunction. Mr.Ramesh states that the affidavit was filed after the plaint was filed. The affidavit only reflects what transpired before the plaint was filed and therefore, this objection of Mr.Ramesh is irrelevant. In any case, a reply to



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the affidavit could have been filed. It was not done. Hence, the allegations are not denied.

9. Apropos of the defence of invocation of the arbitration clause raised by defendants, it is apposite to refer to the law enunciated by the Supreme Court in *Vidya Drolia v. Durga Trading Corporation*¹, to the effect that whether a subject-matter can or cannot be arbitrated should necessarily be dealt with on case-to-case basis, rather than having a bold exposition that certain subject-matters are incapable of arbitration. The Apex Court in the said decision has propounded a fourfold test and held as under:

“76. In view of the above discussion, we would like to propound a fourfold test for determining when the subject-matter of a dispute in an arbitration agreement is not arbitrable:

76.1. (1) When cause of action and subject-matter of the dispute relates to actions in rem, that do not pertain to subordinate rights in personam that arise from rights in rem.

76.2. (2) When 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.

76.3. (3) When cause of action and subject-matter of the dispute relates to inalienable sovereign and public interest functions of the

¹ (2021) 2 SCC 1



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State and hence mutual adjudication would be unenforceable.

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

10. The Apex Court further observed that *"These tests are not watertight compartments; they dovetail and overlap, albeit when applied holistically and pragmatically will help and assist in determining and ascertaining with great degree of certainty when as per law in India, a dispute or subject-matter is non-arbitrable. Only when the answer is affirmative that the subject-matter of the dispute would be non-arbitrable."*

11. The law laid down by the Apex Court is to the effect that if the right claimed is *in rem*, then it is not arbitrable; and if the right claimed is *in personam*, it is arbitrable.

12. In the case on hand, the learned Single Judge after considering the overall conspectus of the matter has arrived at a prima face view that since the contracts entered into between the parties got expired/terminated, any dispute pertaining to the usage of the Trademark is an *in rem* dispute, as it affects the world at large.



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13. Moreover, it is not in dispute that defendants have not filed an application under Section 8 of the Arbitration and Conciliation Act, 1996 seeking reference of the dispute to arbitration, but, on the contrary, have chosen to file a counter on merits in the injunction application filed by plaintiffs and, by their conduct, acquiesced to the jurisdiction of the court, where action has been brought by the plaintiffs. Therefore, we are of the view that the defence raised seeking invocation of arbitration clause does not merit consideration at this belated stage.

14. As regards the third point of suppression of material facts, the learned Single Judge has come to a finding of fact that there was no suppression of material fact. The learned Single Judge has relied upon the exchange of communication between parties to come to this conclusion.

Paragraph 32 of the impugned order reads as under:

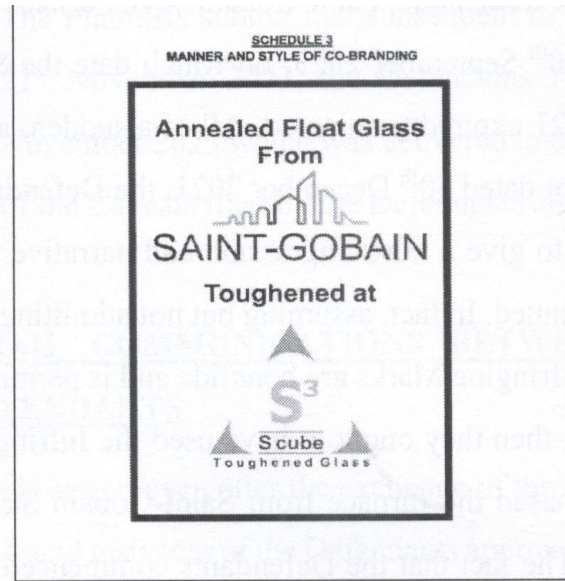
"32. Prima facie this Court does not find any suppression of material facts by the applicants/plaintiffs as seen from the documents filed along with the plaint. There has been sufficient exchange of communications between the applicants/plaintiffs and the respondents/defendants. On a prima facie consideration 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



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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 filed of manufacturing and selling of toughened glasses and other allied products."

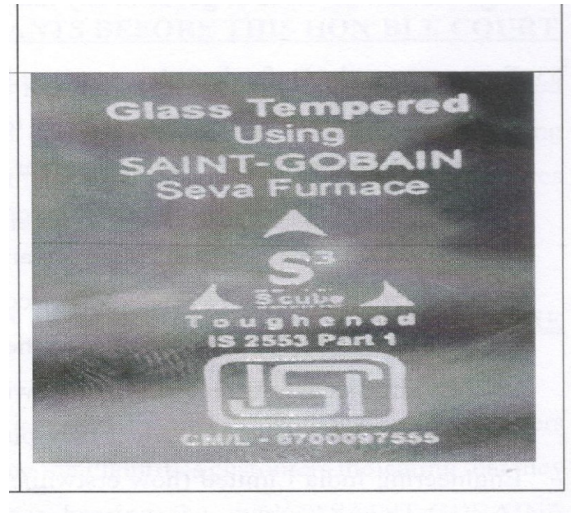
15. The suit is still pending before the learned Single Judge. The defendants have not filed the written statement. Defendants, as per the licensing agreement, were allowed to use the plaintiffs' Trade Mark. Pursuant to the licensing agreement, defendants were permitted to use the following style of co-branding:-





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After the period of contract expired and the same was not renewed, defendants were allegedly purchasing the glass products of someone else, and, in our view, trying to pass off as plaintiffs' product. Defendants started using the following style of branding:



16. It is plaintiffs' case that by using the words "SAINT-GOBAIN Seva" in defendants' style of branding, plaintiffs' Trade Mark is infringed. *Prima facie*, having seen both the logos, we are satisfied that there is infringement. Sri.Raman, on instructions, stated that plaintiffs will have no



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objection if defendants stop using the words "Glass Tempered Using SAINT-GOBAIN Seva Furnace". Sri.Ramesh replied saying that defendants were actually using "SAINT-GOBAIN Seva Furnace" which was a furnace it had purchased from plaintiffs and therefore, defendants are only informing as to what process it uses and which furnace is used for toughening the glass. Sri.Raman submitted that it would still be an infringement of Trade Mark.

17. In our view, the balance of convenience would tilt in favour of plaintiffs because any person purchasing defendants' product might get influenced to buy the product assuming that it was a 'SAINT-GOBAIN' product. We clarify that this is also only our *prima facie* view, since the suit itself is pending.

18. We find no merit in the appeals. Appeals are, accordingly, dismissed. Mr.Raman is pressing for costs. A sum of Rs.2,00,000/- (Rupees two lakhs only) is imposed as costs, to be paid by defendants (appellants) to plaintiffs (respondents). This amount shall be paid within two weeks from today by way of cheque drawn in favour of advocate on record for



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plaintiffs.
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19. We are informed that the written statement is yet to be filed. Mr.Ramesh states that the written statement will be filed and copy served within 30 days from today. Statement is accepted and time granted. Within two weeks thereafter, parties shall exchange the affidavit of documents and within two weeks after exchange of affidavits, shall also exchange statement of admission and denial. The suit be listed, subject to the convenience of the trial Court, on 25.04.2025, for framing of issues. Parties shall file agreed draft issues and separate list of issues on which they are unable to agree with.

Consequently, interim applications are closed.

(K.R.SHRIRAM, CJ.)

(R.KALAIMATHI, J.)

07.02.2025

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The Hon'ble Chief Justice
and
R.Kalaimathi, J.

(sra)

To

The Section Officer,
VR Section, Original Section,
Madras High Court, Chennai.

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