



WEB COPY



Writ Petition (IPD) Nos.19, 20, 21, 22 & 23 of 2025

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 26.02.2026

CORAM

THE HONOURABLE MR.JUSTICE N.ANAND VENKATESH

Writ Petition (IPD) Nos.19, 20, 21, 22 & 23 of 2025

and

W.M.P. (IPD) Nos.15, 16, 17 & 18 of 2025

The Scotch Whisky Association
1st Floor, Quartermile Two
2 Lister Square, Edinburgh EH3 9GI
Scotland, United Kingdom,
represented by its Constituted Attorney
Mr.Sunil Mehdiratta

... Petitioner in all W.Ps.

Vs

1.The Registrar of Trade Marks,
O/o.The Trade Marks Registry,
Intellectual Property Office Building,
GST Road, Guindy,
Chennai – 600 032.

2.Khoday India Limited
Brewery House, 7th Mile,
Kanakapura Road,
Bengaluru – 560 062.

Also at:
Khoday House,
26/2, Sankey Road Cross,
Bengaluru – 560 052.

... Respondents in all W.Ps.

Writ Petition (IPD) Nos.19, 20, 21 & 22 of 2025

Writ Petitions filed under Article 226 of the Constitution of India seeking issuance of a writ of mandamus directing the first respondent to adjourn the hearing in Opposition Nos.MAS-737983, MAS-721701, MAS-721066 and MAS-108630 filed by the petitioner against the second respondent's trade mark Nos.863125, 838249, 819559



Writ Petition (IPD) Nos.19, 20, 21, 22 & 23 of 2025

and 817310 *sine-die* awaiting the judgment of the Hon'ble Bombay High Court in Commercial IP Suit No.296 of 2021 (formerly Suit No.1729 of 1987).

Writ Petition (IPD) No.23 of 2025

Writ Petition filed under Article 226 of the Constitution of India seeking issuance of a writ of mandamus directing the first respondent to consolidate the Opposition Nos.MAS-737983, MAS-721701, MAS-721066 and MAS-108630 for the purpose of hearing and adjudication.

For Petitioner : Mr.Arun C Mohan
[in all W.Ps.]
For Respondents : Mr.K.V.Muthuvisakan
[in all W.Ps.] Senior Panel Counsel [R1]
Mr.R.Sathish Kumar [R2]

COMMON ORDER

All these writ petitions have been filed to direct the first respondent to adjourn the oppositions filed by the petitioner against the second respondent's trade mark Application Nos.863125, 838249, 819559 and 817310 *sine-die* awaiting the judgment of the Bombay High Court in Commercial IP Suit No.296 of 2021 and to consolidate the Opposition Nos.MAS-737983, MAS-721701, MAS-721066 and MAS-108630 for the purpose of hearing and adjudication.

2. When these writ petitions came up for final hearing on 29.01.2026, this Court passed the following order:

“All these writ petitions have been filed for a direction to the 1st respondent to keep the opposition filed by the petitioner Association against the 2nd respondent's trade mark application



WEB COPY



Writ Petition (IPD) Nos.19, 20, 21, 22 & 23 of 2025

pending, awaiting the final judgment of the Bombay High Court in the pending Commercial IP Suit No.296 of 2021.

2.It is seen from records that the suit was filed in the year 1987 and it has been renumbered in the year 2021 and it has been brought to the notice of this Court that the suit is now at the stage of examination of witnesses on the side of the defendant. Apart from that, from the year 2018 onwards, the 1st respondent is adjourning the hearing every time for one year and it has taken place till now. Thus, for the last eight years, the 1st respondent has thought it fit, not to proceed further with the hearing, based on the opposition given by the petitioner.

3.In view of the same, the learned Senior Panel Counsel appearing on behalf of the 1st respondent shall take instructions from the 1st respondent, as to whether the application can be adjourned sine-die, till a final judgment is delivered by the Bombay High Court.

4.Post all these writ petitions under the caption “for orders” on 12.02.2026.”

3. The matter was once again listed for hearing on 12.02.2026

and the following order came to be passed by this Court:

“Learned Senior Panel counsel appearing on behalf of the first respondent submitted that the first respondent has taken into consideration the case pending before the Bombay High Court and the matter is being adjourned from time to time. Therefore, the first respondent will take a call as to whether the matter is going to be adjourned till the Bombay High Court takes a decision or the first respondent is going to process the application by considering the opposition submitted by the petitioner.

2. In the considered view of this Court, the application was submitted by the second respondent during the years 1998-1999 for two word marks and two label marks. The oppositions were filed by the petitioner and from the year 2018 onwards, the proceedings are adjourned once in a year and it has continued till this year. Thus, the first respondent has not chosen to take a decision on the opposition filed by the petitioner for the last eight years. Under such circumstances, this Court cannot proceed



further with these writ petitions on the mere assumption that the first respondent is going to decide the opposition filed by the petitioner. Even assuming that the first respondent is going to deal with the application and the opposition, the first respondent will go strictly by the provisions of the Geographical Indications of Goods (Registration and Protection) Act, 1999, which provides for prohibition of registration of geographical indication as a trademark. Hence, it cannot be presumed that the first respondent is not aware about the effect of the concerned provision.

3. This Court cannot pass orders in these writ petitions on mere apprehensions and surmises, more particularly, considering the fact that the first respondent has not thought it fit to deal with the opposition for nearly eight years. When this Court expressed its mind, learned counsel for petitioner sought time to take instructions from his client.

Post these writ petitions finally on 26.02.2026 under the caption 'for orders'."

4. When the matter was taken up for hearing today, learned counsel for second respondent, in all these writ petitions, relied upon the judgment of the Apex Court in ***Khoday Distilleries Limited v. Scotch Whisky Association and others [(2008) 10 SCC 723]***. That was the case where the earlier battle took place between the petitioner and second respondent and the Apex Court ultimately interfered with the order passed by the Single Judge as well the Division Bench of this Court and allowed the appeal.

5. Learned counsel for petitioner, by relying upon this judgment, submitted that the above judgment of the Apex Court is



peculiar in the sense that the Apex Court did not go into the merits of the case and the order passed by this Court was interfered mainly by applying the bollinger test. Therefore, it was contended that the above judgment of the Apex Court does not really deal with the merits of the case and that cannot be taken advantage by the second respondent and the actual merits is now being gone into by the Bombay High Court.

6. Learned counsel for petitioner, by relying upon the judgment of the Apex Court in *Whirlpool Corporation v. Registrar of Trade Marks [(1998) 8 SCC 1]*, submitted that it was a case under Trade Marks Act and the Apex Court was considering the scope and effect of Section 56 of the Old Act and it was held that if the proceedings are pending before the Court, the Registrar will have to keep his hands off and not touch those or any other proceedings, which may in any way relate to those proceedings, which are pending in the Court. By relying upon the above judgment, learned counsel submitted that the same ratio will apply to the facts of the present case also since substantive suit between the parties is pending before the Bombay High Court and therefore, the Registrar of Trade Marks will have to keep off his hand and cannot primarily deal with the opposition.



7. In the considered view of this Court, as was stated in the earlier order, the petitioner has approached this Court on a mere apprehension that the first respondent is going to act upon the application and pass orders. However, the first respondent is yet to take a call and that is the reason why the first respondent has chosen to postpone the hearing of the petition for the last eight years. That by itself is a ground to reject all these writ petitions since the apprehension has not translated itself into any action on the part of the first respondent till date.

8. Apart from the above, even assuming that the first respondent is going to deal with the application and the opposition, whatever objections are being raised by the petitioner is going to be considered and the first respondent is presumed to be aware of the provisions of the Geographical Indications of Goods (Registration and Protection) Act, 1999. Hence, this Court cannot pre-empt that the first respondent will act otherwise even without considering the objections taken by the parties.

9. In the considered view of this Court, a discretionary jurisdiction is exercised by the High Court under Article 226 of the Constitution of India. Hence, on the facts of the present case, this Court



Writ Petition (IPD) Nos.19, 20, 21, 22 & 23 of 2025

finds that these writ petitions have been filed only based on apprehensions and it is now too well settled that the High Court will not exercise its discretionary jurisdiction in a writ petition filed on mere apprehensions. Apart from that, the High Court cannot assume that the first respondent will exercise the power without taking into consideration the Geographical Indications of Goods (Registration and Protection) Act, 1999 and such a pre-emptive exercise of jurisdiction is not warranted in a writ petition.

10. In the light of the above discussion, this Court does not find any ground to exercise its jurisdiction under Article 226 of the Constitution of India and it goes without saying that the first respondent will act strictly in accordance with law.

These writ petitions are disposed of in the above terms. No costs. Consequently, connected miscellaneous petitions are closed.

26.02.2026

Index:yes/no
NCC:yes/no
Speaking Order/Non-speaking Order
gm



WEB COPY



Writ Petition (IPD) Nos.19, 20, 21, 22 & 23 of 2025

N.ANAND VENKATESH, J

gm

To
The Registrar of Trade Marks,
O/o.The Trade Marks Registry,
Intellectual Property Office Building,
GST Road, Guindy,
Chennai – 600 032.

Writ Petition (IPD) Nos.19, 20, 21, 22 & 23 of 2025

26.02.2026