



Sharayu Khot.

IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION

LEAVE PETITION NO. 132 OF 2020
IN
COMMERCIAL IPR SUIT NO. 178 OF 2022

Bajaj Electricals Limited

...Petitioner/
Plaintiff

Versus

Electronics Mart India Limited & Ors.

...Respondents/
Defendants

Dr. Virendra Tulzapurkar, Senior Counsel a/w Mr. Ameet Naik, Mr. Aseem Naphade, Mr. Madhu Gagodia, Mr. Sujoy Mukherji, Deveesha Tudekar i/by Naik Naik & Co. for the Petitioner/Plaintiff.

Mr. Ravi Kadam, Senior Counsel, Mr. Rohan Kadam a/w Ms. Saloni Shah, Ms. Pranita Saboo, Ms. Rucha Vaidya i/by DSK Legal for the Respondents/Defendants.

CORAM : R.I. CHAGLA J

DATE : 26 September 2024

ORDER :

1. By this Leave Petition, the Petitioner seeks leave under Clause XIV of the Letters Patent Act to combine the cause of action of passing off with the cause of action of infringement of trade mark.

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2. It is an admitted position that the Petitioner's registered office is in Mumbai and the Petitioner is carrying on business in Mumbai. This Court has therefore, jurisdiction to entertain the Suit in respect of infringement of trademark under Section 134(2) of the Trademarks Act, 1999 (in short "**the Act**").

3. The Respondents are carrying on business outside Mumbai and it is an admitted position that no cause of action for passing off has arisen within the jurisdiction of this Court. Accordingly, the Petitioners have filed the present Leave Petition under Clause XIV of the Letters Patent.

4. The Respondents have filed Reply to the Leave Petition raising hardship to the Respondents, if the leave is granted. The contention on behalf of the Respondents is that there being no Rejoinder, the contentions in the Affidavit in Reply to the Leave Petition are deemed to have been admitted, and therefore, leave sought for in the Leave Petition should be refused.

5. Dr. Tulzapurkar, the learned Senior Counsel appearing for the Petitioner has submitted that this Court has jurisdiction to

grant relief in respect of infringement of trademark as the Petitioners are carrying on business in Mumbai and have their principal place in Mumbai. This position is not disputed by the Respondents.

6. Dr. Tulzapurkar has accordingly submitted that the Petitioners are entitled to invoke Clause XIV of the Letters Patent on the ground that this Court has jurisdiction in respect of infringement and therefore the claim for passing off be combined with the relief for infringement to avoid multiplicity of proceedings.

7. Dr. Tulzapurkar has placed reliance on **Arte Indiana Vs. M/s. P Mittulaul Lalah & Sons¹** and **Indian Performing Rights Society Ltd. Vs. Sanjay Dalia²** in support of his submission. In **Sanjay Dalia** (supra) the Plaintiff had filed the Suit for infringement of copyright and trademark in the Court of Delhi on the ground that the Plaintiff had one of the offices in Delhi. The registered office of the Plaintiff was in Mumbai. The cause of action had arisen outside Delhi. The Plaintiff by placing reliance on Section 134(2) of the Act filed a Suit in the Delhi High Court. The Supreme Court held that the provisions

1 1999 (2) Mah. L.J. page 957 paragraphs 3, 4 and 5

2 (2015) 10 SCC 161

of Section 134(2) of the Act contemplates a Suit at the place where the Plaintiff has principal place of business or the registered office and not at a place where there is a branch office and where no cause of action has arisen.

8. Dr. Tulzapurkar has also relied upon on the subsequent decision of this Court in **Manugraph India Ltd. Vs. Simarq Technologies Pvt. Ltd.**³, where this Court has interpreted the judgment of the Supreme Court in **Sanjay Dalia** (supra) and held that the Plaintiff can file a Suit where its registered office or principal office is situated and does not have to go to the place where its branch office is situated and where the cause of action has arisen.

9. Dr. Tulzapurkar has also relied upon the decision of this Court in **Kalpataru Properties Pvt. Ltd. Vs. Sri Kalpataruvu Chits (India) Pvt. Ltd.**⁴ in support of his submission that where the Court has jurisdiction in respect of one cause of action, i.e. infringement the cause of action in respect of which does not have jurisdiction i.e. passing off can be combined to avoid multiplicity of proceedings.

³ 2016 SCC OnLine Bom. 5334

⁴ 2017 SCC Online Bom. 4209

10. Dr. Tulzapurkar has submitted that the only question that arises is whether leave should be granted under Clause XIV of the Letters Patent to combine the cause of action for which the Court has no jurisdiction with the cause of action for infringement, for which this Court has jurisdiction. The main factor which is required to be considered by the Court while considering the question of grant of leave under Clause XIV of the Letters Patent, is whether the grant of leave will avoid multiplicity of proceedings. If the leave is not granted, the Plaintiff will have to file a Suit where the defendants are carrying on business or cause of action has arisen for passing off. This will result in multiplicity of proceedings. The object of providing Clause XIV of Letters Patent being to avoid multiplicity of proceedings.

11. Dr. Tulzapurkar has submitted that no hardship will be caused to the Defendants, if the Defendants are required to defend the Plaintiff's claim for infringement combined with the cause of action for passing off. In infringement, this Court will have to decide whether the impugned mark of the Defendants is deceptively similar to the Plaintiff, and whether the registered trademark is causing confusion or deception. In passing off claim, the

aforementioned two issues are also required to be considered. In addition, the Plaintiff/Petitioners will have to establish that the Plaintiff's mark has acquired reputation which is established by the Plaintiff to answer the above issues.

12. Dr. Tulzapurkar has submitted that in paragraph 5 of the Affidavit in Reply, certain material has been relied upon by the Respondents. It has been contended therein that this material is available only in Hyderabad and which is required for the Respondent No. 1 to prove its honest adoption and open, continuous and extensive use for over forty years. Further, that the Respondents would incur heavy expenses to present its case before this Court by producing the material before this Court. He has submitted that there is no question of considering the grounds or material mentioned in paragraph 5 of the Reply for deciding passing off. The Defendants plea of honest, continuous and extensive user is not a defence in a passing off action. The fact that the Defendants have dealers in Telangana or that their books are in Telangana etc. are totally irrelevant for the purpose of deciding the issue of passing off.

13. Dr. Tulzapurkar has submitted that the contention

of the Respondents that by reason of the Petitioner not having filed Rejoinder, the Petitioner has admitted that it will cause hardship to the Respondents if leave is granted, is stated to be rejected in the facts of the present case, as the material on the basis of which the Respondents are treating that hardship will be caused is totally irrelevant and not applicable to a Suit for passing off.

14. Dr. Tulzapurkar has accordingly, submitted that the decisions of the co-ordinate Court and of the Appeal Court referred to above are binding on this Court and the Petitioner is entitled to obtain leave under Clause XIV of the Letters Patent.

15. Mr. Ravi Kadam, the learned Senior Counsel appearing for the Respondents has submitted that the joinder of cause of action for passing off with trademark infringement under Clause XIV of the Letters Patent is impermissible and militates against the scheme and provisions of the Trademarks Act. He has submitted that it is also contrary to settled legal principles for construing and/or interpreting legal fictions. He has referred to Clause XIV of the Letters Patent and has submitted that Clause XIV enables this Court where it has jurisdiction over one cause of action, to call upon the

Defendants to show cause against the grant of leave for joining a cause of action arising outside jurisdiction. Ordinarily, this Court derives its jurisdiction from Clause XII of the Letters Patent, which confers jurisdiction upon the Court only over cases where Defendants reside and/or carry on business within jurisdiction and/or over causes of action (or a material part thereof) which arise within jurisdiction. Thus, in an ordinary case, the Court may have jurisdiction over one cause of action in terms of Clause XII, but not over the other. Clause XIV addresses such a scenario.

16. Mr. Kadam has submitted that it is an admitted position that the Defendants are outside jurisdiction. It is equally undisputed that no cause of action has arisen within the jurisdiction of this Court. These admissions can be gleaned from the Petitioner's own pleadings viz. paragraph 7 / page 6 of the Leave Petition.

17. Mr. Kadam has submitted that the Petitioner is not invoking Clause XII of the Letters Patent to base their claim for trademark infringement before this Court. Instead, the Petitioner asserts that it has its principal place of business within jurisdiction. Basis this situs, it has invoked Section 134(2) of the Act, to institute

its claim for trademark infringement before this Court. On the rationale that this Court has jurisdiction to try the claim for trademark infringement under Section 134(2) of the Act, the Petitioner has argued that this Court may join passing off under Clause XIV of the Letters Patent.

18. Mr. Kadam has submitted that the joinder of a cause of action for passing off outside jurisdiction under Clause XIV of the Letters Patent is impermissible and militates against the scheme and provisions of the Trademarks Act.

19. Mr. Kadam has referred to the long form title of the Trademarks Act which declares that it is a consolidating and amending legislation. He has submitted that the Act is a complete Code in itself which exhaustively deals with all matters contained therein. He has in this context placed reliance on the decision of the Supreme Court in **Innoventive Industries Vs. ICICI Bank**⁵.

20. Mr. Kadam has submitted that the Act contains provisions for deciding the jurisdiction of this Court, which can be

⁵ (2018) 1 SCC 407 at paras 54-55

seized of matters relating to an action for trademark infringement and passing off traceable to Section 134 of the Act. He has submitted that Section 134(1) is enacted in negative terms and accordingly, creates a bar since it begins with the words “*No Suit...*”. He has submitted that it *ex facie* enacts a twofold bar on the institution of Suits for “*infringement of a registered trademark*”, 'relating to any right in a registered trademark or “*for passing off...*”. He has submitted that it prohibits the institution of such Suits in Courts inferior to a District Court other than the District Court “*having jurisdiction*”.

21. Mr. Kadam has submitted that thus, there is a bar to the filing of such classes of Suits other than to a “*District Court having jurisdiction to try the Suit.*” This bar plainly speaks of a District Court having jurisdiction in terms of Section 20 and/or Clause XII of the Letters Patent.

22. Mr. Kadam has submitted that Section 134(2) of the Act, however, carves out an exception to the general prohibition under Section 134(1). He has submitted that the said provision relaxes the prohibition of Section 134(1) qua Suits for “*infringement*

of a registered trademark” or “relating to any right in a registered trademark”. He has submitted that the said provision declares that for the purposes of these classes of Suits under Section 134(1)(a) and (b), an action may be instituted in a District Court, where the Plaintiff resides or carries on business.

23. Mr. Kadam has submitted that from a reading of Section 134(2) of the Act, it is evident that it is a deeming provision since it artificially expands the definition of a “*District Court*” to include a District Court where the Plaintiffs reside and/or carry on business. He has submitted that but for Section 134(2) of the Act, the District Court having jurisdiction under Section 134(1) of the Act would ordinarily be the one empowered under Section 20 of the Code of Civil Procedure, 1908 (“**CPC**”) or Clause XII of the Letters Patent. Clearly, Section 134(2) of the Act is a special provision which meets the definition of a “*legal fiction*”. He has submitted that it is too well settled that that the legal fiction need not use the words “*shall deem*” and/or “*as if*”. He has placed reliance on the decision of the Supreme Court in **CIT Vs. Urmila Ramesh**⁶.

⁶ 1998 3 SCC 6 para 9

24. Mr. Kadam has submitted that Section 134(2) of the Act creates a legal fiction, its construction must accord and conform to the settled principles for construing such legislative devices. It is well settled that the operation of a legal fiction cannot be extended beyond its avowed purpose. It cannot travel beyond the Section. It cannot be imported into another Statute or extended by analogy. He has placed reliance on the decisions of the Supreme Court in **State of Maharashtra Vs. Laljit Rajshi Shah**⁷ and **Mancheri Putthuseri Vs. Kuthiravattani Estate Receiver**⁸.

25. Mr. Kadam has submitted that the legal fiction under Section 134(2) of the Act is not uncanalised or unfettered. Parliament thought fit to restrict its operation strictly for the purposes of clauses (a) and (b) of Sub-Section 1. Legislature has consciously chosen not to extend the operation of this legal fiction to Section 134 (1) (c) of the Act i.e. a Suit for passing off.

26. Mr. Kadam has submitted that a Suit for passing off simpliciter would have to be filed in the District Court having

⁷ (2000) 2 SCC 699 para 6

⁸ (1996) 6 SCC 185 para 8

jurisdiction where the Defendants reside and/or where the cause of action arisen. This may arise from the Legislature's desire to incentivize trademark registration. Thus, there is a bar and prohibition against filing the Suit for passing off where the Plaintiff resides/carries on business.

27. Mr. Kadam has submitted that since Section 134(2) of the Act creates a legal fiction expressly confined "*for the purposes of clauses (a) and (b) of Sub-Section 1*", it cannot be construed to travel beyond the Section. It also cannot be pressed ganged and/or imported into the provisions of any another law. This would include the provision for "*original jurisdiction*" under Clause XIV. That would violate the settled principles that legal fictions cannot be imported into other statutes or beyond the Section.

28. Mr. Kadam has submitted that it is a settled legal postulate that what cannot be done directly, cannot be done indirectly. Section 134 (1) of the Act enacts a bar to instituting a Suit for passing off other than in a District Court having jurisdiction. This bar is under the Trademarks Act, a special law. It cannot be circumvented by taking recourse to the general law under Clause XIV

of the Letters Patent.

29. Mr. Kadam has submitted that there is no legal basis for invoking Clause XIV of the Letters Patent to join the cause of action for passing off. This would militate against the settled principles for construing legal fictions and would amount to circumventing the Legislature's bar to filing passing off Suits in the District Courts other than those having jurisdiction in terms of Section 20 the CPC and Clause XII of the Letters Patent.

30. Mr. Kadam has submitted that any doubts on whether passing off can be joined with a trademark infringement action under Clause XIV of the Letters Patent are dispelled by Sections 135 (1) and 27 (2) of the Act. He has referred to Section 135(1), which confers powers upon the Court to grant reliefs of various kinds in Suits for trademark infringement or passing off. The Section explicitly prescribes that such power can be exercised only, *“in any Suit for infringement or passing off referred to in Section 134”*. In other words, the power to grant any kind of relief for passing off can be exercised only in a Suit for passing off validly instituted under Section 134, i.e. in a 'District Court having

jurisdiction' in terms of Section 20 of the CPC and Clause XII of the Letters Patent. The Legislative conferment of power to grant relief is circumscribed to a passing off Suit validly instituted in terms of Section 134(1) of the Act. This conclusively rules out grant of reliefs (and ergo joinder) qua a cause of action of passing off under Clause XIV, since such a Suit would no longer be one instituted in terms of Section 134.

31. Mr. Kadam has also relied upon Section 27(2) of the Act, which declares that, "*Nothing in this Act shall affect.... the remedies thereof*". He has submitted that Section 27(2) is another expression of Legislative intent that passing off will not be affected by any provision of the Trademarks Act. The legal fiction under Section 134(2) of the Act expressly confined for "*the purposes of clauses (a) and (b) of Sub-Section 1*" is once again subject to this limitation. This is another pointer of Legislative intent that joinder of passing off arising outside jurisdiction is impermissible.

32. Mr. Kadam has submitted that none of the decisions cited by the Petitioner address the point of law pressed in these submissions. He has submitted the recourse to Clause XIV of

the Letters Patent in the face of statutory prohibitions under the special law of Trademarks Act and basis a mere legal fiction under Section 134 (2) of the Act (which in law cannot travel beyond the Section or imported in another Act) is wholly impermissible in law.

33. Mr. Kadam has submitted that this is a fit case for refusing leave due to undue hardship and harassment meted to the Defendants. He has submitted that it is an admitted position that the Defendants carry on business at Hyderabad. It is also an admitted position that the Petitioner also carries on business at Hyderabad. Hyderabad is natural and convenient for both the parties.

34. Mr. Kadam has placed reliance upon paragraphs 5-7 / pages 12 and 13 of Respondent No. 1's Reply to the Leave Petition, wherein the Respondent No. 1 has averred that it will be subjected to undue hardship and harassment. He has submitted that in paragraph 5 of the Respondent No. 1's Reply various material has been referred to prove the Respondent No. 1's honest adoption and its open, continuous and extensive use over forty years.

35. Mr. Kadam has referred to paragraph 6 of the said

Affidavit in Reply where the Respondent No.1 has averred that it will be put to undue hardship in presenting its case for trial in Mumbai since the materials relied on at trial are at Hyderabad and are also of some vintage. Respondent No.1 will have to incur heavy expense and will be gravely inconvenienced in fully presenting its case before this Court. Further, in paragraph 3 it is averred that on the other hand, no prejudice or harm will be caused to the Petitioner since it admittedly carries on business at Hyderabad.

36. Mr. Kadam has submitted that it is settled law that the Court may refuse leave under Clause XIV of Letters Patent in cases where undue hardship, inconvenience and/or harassment will be caused to the Defendants. He has placed reliance upon **Harman Overseas Vs. Dongguan TR Bearing Company Ltd.**⁹ and the decision of the Supreme Court in **Sanjay Dalia** (supra) at paragraph 18.

37. Mr. Kadam has submitted that multiplicity of litigation is consequentially, not the only yardstick for assessing a case for leave. Notwithstanding the fact that this Court may have jurisdiction over one cause of action, it nevertheless may refuse to

⁹ 2018 (2) Born CR 167 at Paras 31-32,42

grant leave to join another cause of action if the Defendants are put to hardship and are unduly harassed.

38. Mr. Kadam has submitted that it is settled law that facts not rebutted stand admitted and proved under the doctrine of non-traverse. He has in this context placed reliance upon the decisions of the Supreme Court in **Hazara Singh Gill Vs. State of Punjab**¹⁰, **Asha Vs. Pt. B.D Sharma University**¹¹, **VICM Kattha Industries Pvt. Ltd. Vs. State of Haryana**¹² and decision of this Court in **M.V Ramesh Vs. WI**¹³.

39. Mr. Kadam has submitted that the Respondents' case of hardship and harassment stands admitted and is therefore, duly proved since the Petitioner has not consciously chosen not to rebut the plea by filing an Affidavit of Rejoinder. The Petitioner thus, accepts that the Respondents will be unduly prejudiced in presenting their case.

¹⁰ (1964) 4 SCR 1 Paras 3-5

¹¹ (2012) 7 SCC 389 Paras 14,17 and 19

¹² (2013) 9 SCC 338 Paras 17-18

¹³ 2021 SCC Online Bom 502 Paras 10-13

40. Mr. Kadam has submitted that for these reasons, the present Petition for leave under Clause XIV of the Letters Patent is misconceived in law and must be dismissed.

41. Having considered the rival submissions, in my view, it would be necessary to consider whether there is an exclusion of Clause XIV of the Letters Patent Act in Section 134(2) of the Trademarks Act, and for which it is necessary to reproduce Section 134(1) and (2) of the Act as under :-

“134. Suit for infringement, etc. to be instituted before District Court.—

(1) No suit—

*(a) for the infringement of a registered trade mark;
or*

*(b) relating to any right in a registered trade mark;
or*

(c) for passing off arising out of the use by the defendant of any trade mark which is identical with or deceptively similar to the plaintiff's trade mark, whether registered or unregistered, shall be instituted in any Court inferior to a District Court having jurisdiction to try the suit.

- (2) *For the purpose of clauses (a) and (b) of subsection (1), a "District Court having jurisdiction" shall, notwithstanding anything contained in the Code of Civil Procedure, 1908 (5 of 1908) or any other law for the time being in force, include a District Court within the local limits of whose jurisdiction, at the time of the institution of the suit or other proceeding, the person instituting the suit or proceeding, or, where there are more than one such persons any of them, actually and voluntarily resides or carries on business or personally works for gain."*

42. Under Section 134(1) of the Act, no Suit for infringement of a registered trademark or relating to any right in a registered trademark or for passing off is to be instituted in any Court inferior to a District Court, having jurisdiction to try the Suit. Whereas Section 134(2), which in my view, is an enabling provision as it enables the Plaintiff instead of filing a Suit where the Defendant resides and/or the cause of action has arisen, to file a Suit for infringement of trademark or relating to any right in a registered trademark in a District Court within the local limits of whose jurisdiction, at the time of institution of the Suit, the person instituting the Suit i.e. the Plaintiff, actually and voluntarily resides

or carries on business or personally works for gain.

43. The contention on behalf of the Respondent is that Section 134(2) is a deeming provision since it artificially expands the definition of a “District Court” to include the District Court where the Plaintiff resides and/or carries on business. Further, that the deeming fiction cannot be extended beyond Section 134(2) i.e. to cover a Suit for passing off. In my view, these contentions cannot be accepted. Section 134(2) only enables the Plaintiff in a Suit for infringement of trademark or relating to any right in a registered trademark to file a Suit in the District Court within the local limits of whose jurisdiction at the time of instituting the Suit, the Plaintiff actually and voluntarily resides or carries on business or personally works for gain. Section 134(2) of the Act does not bar the applicability of Clause XIV of the Letters Patent.

44. Further, when Section 134 of the Trademarks Act was enacted, the legislature was conscious of Clause XIV of the Letters Patent and if the legislature had intended that Clause XIV should not be resorted to the legislature would have made a provision to that effect in Section 134.

45. It is pertinent to note that Clause XIV of the Letters Patent provides for joinder of cause of action where there are several causes of action against a Defendant and where the High Court has original jurisdiction in respect of one of such cause of actions, it would be lawful for the Court to call on the Defendant to show cause why several cause of actions should not be joint together in one Suit. Thus, Clause XIV of the Letters Patent empowers the Court having jurisdiction over one cause of action and not having jurisdiction over another cause of action to join that other cause of action by granting leave.

46. Thus, Section 134(2) of the Act which is an enabling provision allows the Plaintiff to file the Suits mentioned therein in a Court which would be other than a Court having jurisdiction under Section 20 of CPC read with Clause XII of the Letters Patent. There is no bar to the Plaintiff from filing a Petition under Clause XIV of the Letters Patent to join the cause of action which falls outside the jurisdiction with the cause of action over which the Court has jurisdiction by virtue of the enabling provision i.e. Section 134(2). Thus, for a cause of action for passing off which does not fall within Section 134(2) of the Act, leave under Clause XIV

of the Letters Patent would ordinarily granted by this Court to join that cause of action with the cause of action of infringement over which it has jurisdiction under Clause XIV in order to prevent multiplicity of proceedings.

47. The contention on behalf of the Respondents if accepted, would result in the Plaintiff being unable to seek leave under Clause XIV of the Letters Patent to join a cause of action falling outside jurisdiction of this Court, with the cause of action falling within the jurisdiction of this Court and would make Clause XIV of the Letters Patent otiose. The whole purpose of Clause XIV of the Letters Patent is to permit the Court to combine the aforementioned causes of action.

48. Having answered the issue of whether Clause XIV of the Letters Patent is barred by Section 134(2) of the Trademarks Act in the negative, the only issue which would require consideration is whether the Leave Petition is filed to avoid multiplicity of proceedings and in which case leave will be granted.

49. The decisions relied upon on behalf of the Plaintiff

viz, **Arte Indiana** (supra), **Sanjay Dalia** (supra), **Manugraph India Ltd.** (supra) and **Kalpataru Properties Pvt. Ltd.** (supra) have considered multiplicity of proceedings and have allowed combination of causes of action under Clause XIV of the Letters Patent. In **Sanjay Dalia** (supra) as further interpreted by this Court in **Manugraph India Ltd.** (supra), the Court has considered that Section 134(2) contemplates a Suit to be filed where the Plaintiff has its principal place of business or the registered office and not a place where it has a branch office and no cause of action has arisen.

50. In **International Associations of Lions Clubs Vs. Association Of Lions India & Ors.**¹⁴, this Court has in paragraph 9 held as under :-

“9 We can not ignore the fact that clause-14 of the Letters Patent was enacted to sub-serve the purpose of avoidance of multiplicity of proceedings. It is well settled that if the Plaintiffs are entitled to maintain suit in this Court in respect of grievance of breach of copyright, then there is no reason to refuse leave so as to drive the parties to file litigation in several courts. It has been so held in unreported judgment of D.B. of

¹⁴ (2007)35 PTC 44

this Court Goldseal Engineering Products Private Limited v. Hindustan Manufacturer (Appeal No. 505 of 1992 decided on 10/06/1994) : (1992) 12 PTC 1 (Bom). It is also observed therein that practical view should be taken and parties should not be driven from Court to Court on technicalities. Keeping in mind the above principles and having regard to provision of Order 1 Rule 3 of CPC and Order 2 Rule 3 of CPC. It is necessary to find out whether there is any impediment in granting leave under clause 14 in the instant case.”

51. Thus, the Court has considered that Clause XIV of the Letters Patent was enacted to sub-serve the purpose of avoidance of multiplicity of proceedings. Further, it is held in the above decision that if the Plaintiffs are entitled to maintain a Suit in a Court in respect of grievance of breach of copyright, contemplated under Section 134(1) read with Section 134(2) of the Act, then there is no reason to refuse leave under Clause XIV so as to drive the parties to file litigation in several Courts.

52. Presuming that this Court accepts the contention of the Respondents that Clause XIV of the Letters Patent is barred by Section 134(2) of the Trademarks Act, this would result in

multiplicity of proceedings,, thus defeating the purpose for which Clause XIV was enacted. This was certainly not the contemplation of the legislature in enacting either Section 134 of the Act or Clause XIV of the Letters Patent Act and would result in grave injustice to the Plaintiff.

53. Now coming to the issue of hardship and whether hardship will be caused to the Defendants, if the Defendants are required to defend the Plaintiff's claim for infringement as well as passing off. In my view, there will be no hardship caused to the Defendants. In a Suit for infringement, the Court has to decide whether the impugned mark of the Defendants is deceptively similar to the Plaintiff and whether the impugned mark is causing confusion or deception. These two issues will also require consideration in the case of passing off. In addition, the Plaintiff will have to establish that the Plaintiff's mark has acquired reputation. The material referred to in paragraph 5 of the Affidavit in Reply of the Respondent No. 1 to the Leave Petition which is stated to be in Hyderabad and relied upon in support of the Respondents' plea of honest, continuous and extensive user is of no significance as this plea cannot be raised as a defence in a passing off action. The argument of the Respondents

that there is no Rejoinder Affidavit filed and hence, the Petitioner has admitted that it will cause hardship to the Respondents, if leave is granted, cannot be accepted. The material on the basis of which the Respondents are relying upon in support of their contention that hardship is caused to them, is irrelevant in a Suit for passing off.

54. In view thereof, leave under Clause XIV of the Letters Patent is required to be granted to avoid multiplicity of proceedings, considering that this Court has jurisdiction in respect of one of the causes of action i.e. infringement and can join the other cause of action i.e. passing off in respect of which does not have jurisdiction.

55. Accordingly, Leave Petition No. 132 of 2020 is made absolute in terms of prayer clause (a).

56. There shall be no order as to costs.

[R.I. CHAGLA J.]