



WEB COPY



O.A.No.651 of 2022
in C.S (Comm.Div.) No.205 of 2022

O.A.No.651 of 2022
in C.S (Comm.Div.) No.205 of 2022

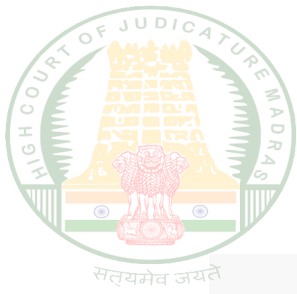
M.SUNDAR.J

In this order, the parties to the captioned application shall be referred to by their respective ranks in the main suit for the sake of convenience and clarity.

2. In the main suit, there is a sole plaintiff and there are ten defendants. The sole plaintiff is lone applicant in the captioned application and defendants 1 to 10 in the main suit are respondents 1 to 10 respectively in the captioned application.

3. In the hearing today, Mr.P.S.Raman, learned Senior Counsel instructed by Mr.H.Siddarth, learned counsel on record for the plaintiff and Mr.P.Giridharan, first named learned counsel on record for the plaintiff were before this Commercial Division.

4. This order has to be read in continuation of earlier proceedings made in the previous listing on 13.10.2022 in the captioned application along with seven other applications and a scanned reproduction of the same is as follows :



WEB COPY



O.A.No.651 of 2022
in C.S (Comm.Div.) No.205 of 2022

O.A.Nos.621 & 624 of 2022
and
O.A.No.650 to 652 of 2022
and
A.Nos.4238 to 4240 of 2022
in
C.S (Comm. Div.) No.205 of 2022

M.SUNDAR.J.,

Read this in conjunction with and in continuation of earlier proceedings made in the previous listing on 27.09.2022.

2. The amended plaint is before this Commercial Division. Mr.P.S.Raman, learned Senior Counsel instructed by Mr.H.Siddarth, counsel on record along with Mr.P.Giridharan for the sole plaintiff are before this Commercial Division.

3. When the matter was taken up, it came to light that the plaint qua reliefs for infringement of registered Trade Marks is primarily predicated on plaint Document Nos.5 and 6. To be noted, plaint Document No.5 is constituted by 9 trademark registration certificates. Eight are Legal Use Certificates and one is RG-2 (to be noted 'RG-2' is Form number and it cannot be used in legal proceedings). Plaint Document No.6 is regarding the active status of 'Trade mark' (hereinafter 'TM' for brevity) registrations.

4. A cursory perusal of Plaint Document No.5 brings to light that plaintiff is a registrant / proprietor qua aforementioned trade mark

Page No.1/2



WEB COPY




O.A.No.651 of 2022
in C.S (Comm.Div.) No.205 of 2022

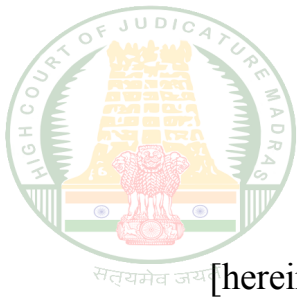
registrations in Classes 9, 35, 36, 38 and 42. This Commercial Division is informed that Fourth schedule to Trademark Rules, 2002 has since been omitted. Whether trademark Rules, 2017 are operating is the question. The further question that arose was regarding publication of a class wise and an alphabetical index of goods and services including goods and services of Indian origin vide sub-rule (2) of Rule 20 of Trademark Rules, 2017 i.e., whether such a publication has been made. Therefore, this Commercial Division wanted to know what these classes mentioned in TM registration certificates mean.

5. Faced with the above situation, learned senior counsel requested for a short accommodation to examine the position and revert to this Commercial Division. Request acceded to.

List on 19.10.2022.


13.10.2022

5. Adverting to earlier proceedings, as regards plaint document Nos.5 and 6, it was submitted that the classes referred to in the eight legal use certificates are classes in 'International Classification of goods and services (NICE classification)'. Attention of this Court was drawn to Sections 7 and 8 of 'The Trade Marks Act, 1999 (47 of 1999)' [hereinafter 'TM Act' for brevity] which talk about 'classification of goods and services' and 'publication of alphabetical index' respectively by the Trade Marks Registrar. This has to be read along with 'Trade Marks Rules, 2002'

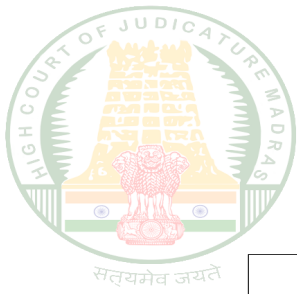


O.A.No.651 of 2022
in C.S (Comm.Div.) No.205 of 2022

WEB COPY

[hereinafter '2002 TM Rules' for convenience]. To be noted, TM Act and 2002 TM Rules kicked in on 15.09.2003. Rule 22 of 2002 TM Rules has relevance and this takes us to the Fourth Schedule. Rule 22 and Fourth Schedule were in operation till 2013 and thereafter 2002 TM Rules stood substituted and Fourth Schedule stood omitted. Rule 22 as it stood earlier and substituted are as follows :

<i>Rule 22 (Prior to substitution by G.S.R. 21(E) dated 14.1.2013)</i>	<i>Rule 22 (After substitution by G.S.R. 21(E) dated 14.1.2013)</i>
22. Classification of goods or services : 1) For the purposes of the registration of trade marks, goods and services shall be classified in the manner specified in the Fourth Schedule. 2) The goods and services specified in the Fourth Schedule only provide a means by which the general content of numbered international classes can be quickly identified. It corresponds to the major content of each class and are not intended to be exhaustive in accordance with the international classification of goods and services. For determining the classification of particular goods and services and for full disclosure of the contents of international classification, the applicant may refer to the alphabetical index of goods and	22. Classification of goods or services 1) For the purposes of registration of trademarks, the goods and services shall be classified as per current edition of the "International Classification of goods and services (NICE Classification)" published by World Intellectual Property Organization (WIPO). 2) The Registrar shall publish a class wise and alphabetical index of such goods and services, including goods and services of Indian origin.



O.A.No.651 of 2022
in C.S (Comm.Div.) No.205 of 2022

WEB COPY

Rule 22 (Prior to substitution by G.S.R. 21(E) dated 14.1.2013)	Rule 22 (After substitution by G.S.R. 21(E) dated 14.1.2013)
services, if any, published by the Registrar under Section 8 or the current edition of the International Classification of Goods and Services for the purpose of registration of trade mark published by the World Intellectual Property Organisation or subsequent edition as may be published. 3) The Registrar shall identify and include in the alphabetical index of classification of goods and services, as far as practicable, goods or services of Indian origin.	

6. To be noted, above is owing to Trade Marks (Amendment) Rules, 2013 but that will be adverted to later if need arises. It is submitted that the Trademark Registry has neither 'classified goods and services' nor published an alphabetical index as per Sections 7 and 8 respectively of TM Act. This aspect also left open to be dealt with later depending on the trajectory the matter takes. Nonetheless the submission that the classes referred to in eight legal use certificates as classes as in 'NICE Classification' is *prima facie* acceptable but this is a *prima facie* view subject to disputation and contestation if any. This means that the



O.A.No.651 of 2022
in C.S (Comm.Div.) No.205 of 2022

WEB COPY

plaintiff is a registrant / proprietor qua classes 9, 35, 36 and 38 vide sub-classes. In class 9, sub-classes are 090717, 090791, 090591; in class 35, sub-class is 350166; in class 36, sub-classes are 360128, 360058 and in class 38, sub-classes are 380022 and 380023 is learned senior counsel's say. To be noted, these are sub-classes vide 'NICE Classification'.

7. This takes this Commercial Division to Section 12A of 'The Commercial Courts Act, 2015 (Act 4 of 2016)' which will hereinafter be referred to as 'CCA' for the sake of convenience and clarity. As regards Section 12A, advertent to plaint documents, attention of this Commercial Division was drawn to Cease and Desist Notice dated 14.03.2022, reply dated 29.03.2022, rejoinder dated 18.05.2022 and sur-rejoinder dated 01.06.2022 being plaint document Nos.16, 17, 18 and 19 respectively. Thereafter, attention of this Commercial Division was drawn *inter alia* to paragraph 80 of the plaint to say that the Trade Registration applications of defendants 1,2, 5 and 6 were accepted on 08.08.2022 and the same was made known to the plaintiff only on 29.08.2022 vide plaint document No.15. To be noted, the date of presentation of plaint is 12.09.2022, leave to sue was granted vide A.No.4095 of 2022 on 16.09.2022 and the date of institution of suit is 21.09.2022.



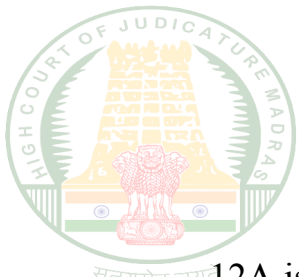
O.A.No.651 of 2022
in C.S (Comm.Div.) No.205 of 2022

WEB COPY

8. Mr.P.S.Raman, learned senior counsel on instructions submitted that after sur-rejoinder dated 01.06.2022 (plaint document No.19) from defendants 1,2,5 and 6, the plaintiff was lulled into belief that the matter has been concluded and that defendants 1 to 6 would not pursue their trade mark registration applications. However, plaintiff was taken by surprise when acceptance of the applications was communicated to plaintiff on 29.08.2022 is learned senior counsel's say. This submission is recorded subject of course to contestations by defendants. It was also submitted by learned senior counsel that there can be an interim order as against the proprietor of registered trade marks also and that the instant case qualifies as one in this view of the matter.

9. Submissions qua section 12-A of CCA were heard in the light of *Patil Automation* principle i.e., ***Patil Automation Private Limited and others Vs. Rakheja Engineer Private Limited*** case law reported in **2022 SCC OnLine SC 1028**. The *Patil Automation* order is on 17.08.2022 and the prospective operation is on and from 20.08.2022.

10. In the light of narrative thus far and in the light of Cease and Desist Notice and exchange of notices between the parties prior to the same, 'contemplation of urgent interim relief' within the meaning of Section


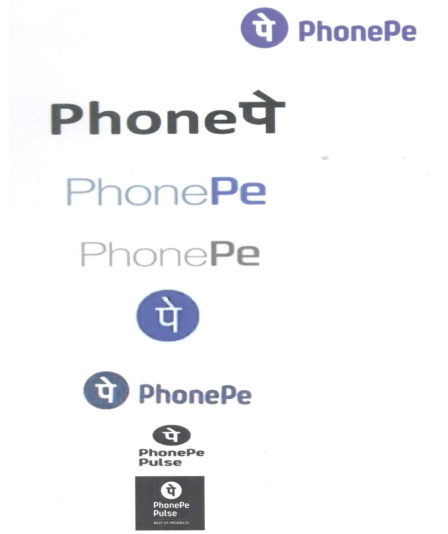


O.A.No.651 of 2022
in C.S (Comm.Div.) No.205 of 2022

12A is *prima facie* made out but the rights of the defendants are protected to raise this issue if so advised and if so desired post notice.

WEB COPY

11. The two competing marks are before this Commercial Division as plaint document Nos.24 and 25. The competing marks as demonstrated in the hearing are as follows :



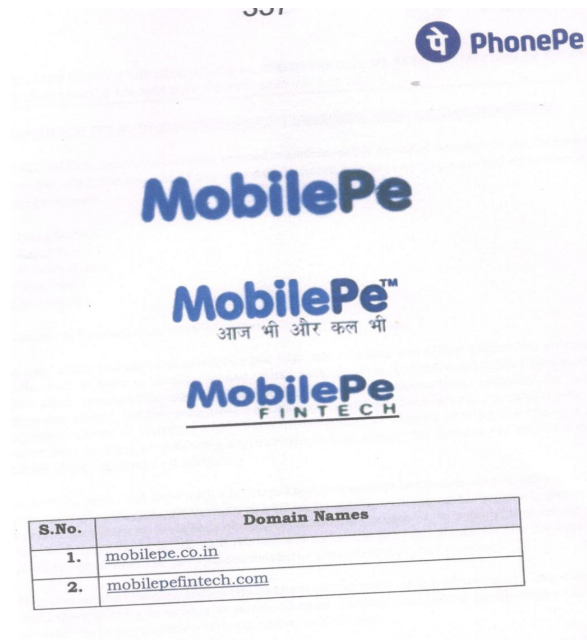
S.No.	Domain Names
1.	phonpe.com
2.	Blog.phonpe.com
3.	tech.phonpe.com
4.	phonpe.in
5.	at-phonpe.co.in
6.	at-phonpe.com
7.	byphonpe.co.in
8.	byphonpe.com
9.	inphonpe.co.in
10.	inphonpe.com
11.	onphonpe.co.in
12.	onphonpe.com
13.	phonepe.net



WEB COPY



O.A.No.651 of 2022
in C.S (Comm.Div.) No.205 of 2022



To be noted, the plaint documents are colour photocopies, whereas the aforementioned scanned reproduction is in black and white.

12. It was contended that as regards plaint document No.5, trademarks pertain to trademark registration as well as device. This Commercial Division compared the two marks by applying the *Parle* principle being ratio laid down by Hon'ble Supreme Court in *Parle Products (P) Ltd. Vs. J.P. and Co., [(1972) 1 SCC 618]* i.e., avoiding side by side comparison, stepping into the shoes of a man of average intelligence with ordinary prudence and imperfect recollection. A *prima facie* case qua possible deception has been made out. To be noted, this is



O.A.No.651 of 2022
in C.S (Comm.Div.) No.205 of 2022

सत्यमेव जयते a *prima facie* view subject to contestation.

WEB COPY

13. This Commercial Division is of the view that at this stage a limited order of *status quo* qua 'UPI' (Unified Payments Interface) and 'BHIM' (Bharat Interface for Money) [to be noted, both are brand names qua 'Payments Financial Services'] alone would be granted, as this Commercial Division is informed that defendants 1 to 6 are not into this activity as yet. In support of this, a portal of npic.org.in was demonstrated in Court. To be noted, NPCI stands for 'National Payments Corporation of India' and this Commercial Division is informed that it is a Regulatory Authority. This was referred to say that as of today there are only 22 entities with such licences referred to as 'TPAP' (Third Party Apps Provider). It is submitted that even as of today, defendants 1 to 6 are not into this activity and for this purpose, the Apps were opened and demonstrated to this Court by counsel. Therefore, besides *prima facie* case, possible irreparable legal injury aspect qua 'Payments and Financial Services' ['UPI' and 'BHIM'] is also made out. This moves the balance of convenience aspect towards grant of limited order of *status quo* as alluded to supra. Therefore, *prima facie* case, balance of convenience and irreparable legal injury parameters have impelled this Commercial Division



O.A.No.651 of 2022
in C.S (Comm.Div.) No.205 of 2022

WEB COPY

to grant this limited order of *status quo* as of today. For the purpose of specificity, it is made clear that the defendants 1 to 6 can continue with all other business activities which they are carrying on as of today with the aforementioned competing marks which can be broadly referred to as wallet recharge unhindered by this interim order of *status quo*.

14. The above is the reason for grant of interim status quo as of today before issue of notice i.e., in tune with Order XXXIX Rule 3 of 'the Code of Civil Procedure, 1908' ('CPC' for brevity).

15. To be noted, an application in A.No.4238 of 2022 under Clause 14 of Letters Patent of Madras High Court has been filed with a prayer for combining causes of action. In the light of the language in which Clause 14 of Letters Patent is couched, it is imperative that defendants are given an opportunity to show cause as to why causes of action should not be combined before a decision is taken in such an application. Therefore, notice has been ordered today in that application. In this view of the matter, it is made clear that this Commercial Division has considered only that part of the cause of action over which it has jurisdiction. To be noted, section 134(2) of TM Act is available only for infringement of a registered trade mark or relating to any right in a registered trade mark and not for



O.A.No.651 of 2022
in C.S (Comm.Div.) No.205 of 2022

passing off suits vide section 134(1)(c) of TM Act.

WEB COPY

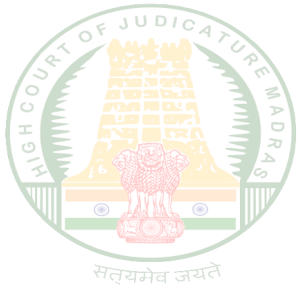
16. The plaintiff to comply with the provisions of Order XXXIX Rule 3 CPC and file an affidavit of compliance.

17. Notice to all defendants returnable by a fortnight i.e., returnable by 02.11.2022. Private notice permitted. Notice through electronic modes of communications (subject to demonstration of service) is permitted with regard to defendants 7, 9 and 10 alone.

List on 02.11.2022.

19.10.2022

ds



WEB COPY



O.A.No.651 of 2022
in C.S (Comm.Div.) No.205 of 2022

M.SUNDAR.J.,

ds

O.A.No.651 of 2022
in C.S (Comm.Div.) No.205 of 2022

19.10.2022