

IN THE HIGH COURT OF KARNATAKA, BENGALURU

DATED THIS THE 15<sup>th</sup> DAY OF JULY, 2019

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BEFORE

THE HON'BLE MR. JUSTICE KRISHNA S.DIXIT

**WRIT PETITION NO. 23009 OF 2019 (GM-CPC)**

BETWEEN:

M/S FINE FOOTWEAR PRIVATE LIMITED  
NO. 30, 1<sup>ST</sup> FLOOR,  
ARCHANA MARKET, SULTANPET,  
BANGALORE 560053.  
REP. BY ITS DIRECTOR,  
SRI. DEEPAK GULATI.

... PETITIONER

(BY SRI. SAGAR G NAHAR, ADVOCATE)

AND:

1. SKECHERS U.S.A. INC.  
228, MANHATTAN BEACH BLVD.,  
MANHATTAN BEACH,  
CALIFORNIA 90266.
2. SKECHERS U.S.A. INC, II  
228, MANHATTAN BEACH BLVD,  
MANHATTAN BEACH,  
CALIFORNIA 90266.
3. SKECHERS SOUTH ASIA PRIVATE LIMITED  
803 & 804, FULCRUM B WING,  
CTS NO. 48, SAHAR ROAD,  
ANDHERI (EAST), MUMBAI 400099.
4. SKECHERS RETAIL INDIA PRIVATE LIMITED  
803 & 804, FULCRUM "B" WING,  
CTS NO. 48, SAHAR ROAD,  
ANDHERI (EAST), MUMBAI 400099.

NO. 1 TO 4 ARE REPRESENTED BY:  
VINAY GUPTA, FINANCE DIRECTOR,  
SKECHERS SOUTH ASIA PVT. LTD.

5. PAVAN ENTERPRISES,  
SHOP NO.14, 2<sup>ND</sup> FLOOR, 1<sup>ST</sup> CROSS,  
LALBAGH ROAD, SUDHAMANAGAR,  
BANGALORE – 560 027.

REPRESENTED BY ITS MANAGING PARTNER.

6. SAI. VINAYAKA,  
NO.723, LAKSHMINARAYANA COMPLEX,  
MODI HOSPITAL ROAD, BASAVESHWARA NAGAR,  
BANGALORE – 560 086.
  
7. SHREE SHYAM FOOTWEAR,  
NO.720, 9<sup>TH</sup> CROSS, 2<sup>ND</sup> STAGE,  
MODI HOSPITAL ROAD,  
WEST OF CHORD ROAD,  
MAHALAKSHMIPURAM,  
BANGALORE – 560 086.  
REPRESENTED BY ITS PROPRIETER.
  
8. FEET FASHION,  
NO.28, NTI LAYOUT, VIDYARANYAPURA,  
MAIN ROAD, VIDYARANYAPURA,  
BANGALORE – 560 097.  
REPRESENTED BY ITS PROPRIETER.

... RESPONDENTS

(BY SRI. ARUN KUMAR, SENIOR COUNSEL FOR  
SRI. ANIND THOMAS, ADVOCATE FOR R1 TO 4)

THIS WRIT PETITION IS FILED UNDER ARTICLE 227 OF THE CONSTITUTION OF INDIA PRAYING TO CALL FOR RECORDS IN O.S.NO.2598/2019 PENDING ON THE FILE OF XVIII ADDITIONAL CITY CIVIL AND SESSIONS JUDGE, (CCH-10), BANGALORE, AND ISSUE A WRIT OF CERTIORARI OR ANY OTHER WRIT, DIRECTION OR ORDER QUASHING THE ENTIRE PROCEEDINGS IN O.S.NO.2598/2019 VIDE ANNEX-E, WHILE DECLARING THE SAME AS ONE WITHOUT JURISDICTION AND VOID AB INITIO AND QUASH/SET ASIDE EX-PARTE AD-INTERIM ORDER DATED 12.04.2019 PASSED IN O.S.NO.2598/2019 BY THE XVIII ADDITIONAL CITY CIVIL AND SESSIONS JUDGE, (CCH-10) BANGALORE, VIDE ANNEX-E, WHILE DECLARING THE SAME TO BE NON-EST IN LAW.

THESE PETITIONS COMING ON FOR PRELIMINARY HEARING IN 'B' GROUP THIS DAY, THE COURT MADE THE FOLLOWING:-

**ORDER**

Petitioner being the first diffident in a civil suit in O.S. No.2598/2019 filed by Respondent Nos.1 to 4 herein, is knocking at the doors of Writ Court for assailing the order dated 12.04.2019, a copy whereof is at Annexure 'E' whereby the learned XVIIIth Additional City Civil Judge, Bengaluru, having favoured the said Respondents' IA No.3 has granted temporary injunctive relief against him. The contesting respondents having been represented by their counsel, resist the writ petition.

2. Learned counsel for the petitioner argues that the impugned order is *non est* since the *lis* in the suit is a "Commercial Dispute" exclusively triable by the Commercial Court established for Bengaluru Urban under the provisions of The Commercial Courts Act, 2015 (hereafter '2015 Act' for short).

3. Learned Sr. Advocate, Shri Arun Kumar appearing for the counsel on record for the Respondent – plaintiffs, per contra, contends that the dispute is not a "Commercial Dispute", since it does not relate to any of the items enumerated under Sec.2(1)(c) (xvii) which

speaks of Intellectual Property Rights; secondly, a suit does not become triable by the Commercial Court merely because it involves a commercial dispute if the value of its subject matter is below specified value as defined under Section 2(1)(i) r/w 12 of the Act; in any circumstance, the law heavily leaning in favour of civil court's jurisdiction not being barred, the writ petition is liable to be dismissed.

4. I have heard the learned counsel for the petitioner and the learned Sr. Counsel appearing for the respondents; I have perused the petition papers and adverted to the decision cited at the Bar.

5. Product packaging or the look of a product has nowadays become just as essential as the product itself. A trade dress ordinarily is the visual appearance of a product or its packaging which forms an important component as the source of the product itself; learned Author P.Narayanan in his 'Trade Marks & Passing Off' 6<sup>th</sup> Edition published by Eastern Law House Pvt. Ltd., Calcutta at p.980 writes: *"Trade dress encompasses the total image or overall impression created by a product or its package"*.

6. Hon'ble Justice J.D. Kapoor of High Court of Delhi in the case of **Colgate Palmolive Company v. Anchor Health and Beauty Care Pvt. Ltd., 2003 (27) PTC 478** observed that '*Trade dress is the sole of identification of goods*' to their source or origin and a customer forms an overall impression of the source of origin of the goods from the visual impression of its colour combination as well as from the shape of its container and packaging. In the United States of America the trade dress has been given statutory protection under Section 43(a) of the Lanham Act, but trade dress is not explicitly mentioned in our Trade Marks Act, 1999. However, the definition of a trademark under Section 2(zb) of the said Act includes within its ambit "*shape of goods, their packaging and combination of colors*". Thus there is force in the submission of learned counsel for the petitioner that Trade Mark is the genus and Trade dress is its species. This makes it clear that trade dress is included within the definition of a trademark and consequently it is protected in the same manner as an unregistered trademark, since Trade dress under the 1999 Act does not require any

formal registration though it is connected with the reputation and the goodwill which is built with time.

7. The contention of the respondent side that the commercial dispute is triable by ordinary civil court unless the specified value of its subject matter is not less than three lakh rupees, needs to be accepted because the suit of the respondents, going by the text & context of the plaint in general and its prayer columns in particular, is principally for an injunctive relief; that at paragraph No.80 of the plaint, respondents have currently valued the subject matter of their suit at Rs.2,000/- and have paid a Court Fee of Rs.150/- presumably under Section 26 of KCF & SV Act, 1958; apparently, they have not stated anything about specified value of the subject of the “Commercial Dispute”.

8. In **KALLA YADAGIRI vs. KHOTADAL REDILIY, 1999 (1) ALT 211 FB**, the High Court of Andhra Pradesh has crisply stated as under:

*“What decides the jurisdiction with regard to a particular case is the nature of claim as brought. The plaintiff is bound to assess the relief he claims on the basis of the benefit he seeks to obtain by filing the suit... In a suit for*

*injunction simplicitor, it is the value of the relief claimed and not on the value of the property involved... suffice it to say that the proper method is to value for the Court fees first and take that value for the purpose of jurisdiction, for, value will control the matter for Court fees and jurisdiction. It is not the value of the thing affected that settles the value of relief sought, but it is the value of the relief sought, which determines the jurisdiction "Subject matter" is not the same thing as property. Subject matter is the substance for adjudication and it has reference to the right which the plaintiff seeks to enforce and the valuation of the suit depends upon the value of the subject matter thereof..."*

The High Court of Delhi in the case of **MRS. SONI DHAWE VS M/S. TRANS ASIAN INDUSTRIES EXPOSITIONS FVT. LTD., AIR 2016 DELHI 186** at has observed as under:

*"The Commercial Courts has not been enacted to interfere with the Court Fees Act or Suits Valuation Act ... Section 12 of the Commercial Courts Act providing for determination of specified value as defined in Section 2(1)(i) thereof is not intended to provide for a new mode of determining the valuation of the suit for the purpose of jurisdiction and court fees. It would be incongruous to hold that while for the purpose of payment of court fees the deemed fiction provided in the Court Fees Act for determining the value of property is to apply but not for determining the specified value under the Commercial Courts Act... Section 12 of the Commercial Courts Act has to be read harmoniously with the Court Fees Act & Suits Valuation Act..."*

9. It has been a well settled position of law that the plaintiff being the *dominus litis* has the prerogative of choosing the Court and determine the valuation of the suit for the purpose of pecuniary jurisdiction, special jurisdiction or for computation of court fees; the opposing party cannot insist that the suit be tried before some other Court without establishing the lack of jurisdiction of the Court in which the cause is brought; the suit involves a commercial dispute, is true; but, there is no material placed on record to *prima facie* show that its specified value is Rupees Three Lakh or above, in terms of Section 2(1)(i) r/w Section 12 of the 2015 Act. A Coordinate Bench of this Court in RFA No. 1/2015 in the case of **KIRLOSKAR AAF LIMITED VS. M/S AMERICAN AIR FILTERS COMPANY INC & ANOTHER** vide judgment dated 25.09.2018 at paragraph No.8 observed "*the twin requirements of this Act are that a dispute has to be a Commercial Dispute and secondly it must be of a certain pecuniary limit, namely Rupees Three Lakh or above ...*" In other words, the Commercial Courts have jurisdiction only in such matters which pass the Twin Test i.e., existence of a "Commercial Dispute" as defined under Section

2(1)(c)(xvii) and the “Specified Value” as defined under Section 2(c)(i) r/w Section 12 of the 2015 Act. In the present writ petition, although the suit involves a Commercial Dispute, the subject matter of the suit is apparently less than the Specified Value. To put it succinctly, the commercial courts shall have exclusive jurisdiction if both the commercial dispute and specified value concur to exist and not just one of them, as rightly contended by learned Sr. Counsel for the respondent.

10. The jurisdiction of the Courts to try all suits of civil nature is very expansive as is evident from the plain language of Sec.9 CPC, 1908. This is because of the principle *ubi jus ibi remedium*; it is only where cognizance of a specified type of a suit is barred by a statute either expressly or impliedly that the jurisdiction of the civil court would be ousted to entertain such a suit; the general principle is that a statute excluding the jurisdiction of the civil courts should be construed *stricto sensu*; law abhors ouster of jurisdiction of civil courts; the English and Indian decisions in this regard galore and need hardly to be mentioned.

In the above circumstances, this writ petition being devoid of merits, is dismissed, with liberty to the petitioner to seek framing of an issue as to suit being of specified value and therefore civil court lacks jurisdiction.

The observations made hereinabove being confined to the disposal of this writ petition on the basis of material now placed on record, shall not influence the decision making on such an issue if and when raised.

No costs.

**Sd/-  
JUDGE**

Snb/