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IN THE HIGH COURT OF JUDICATURE AT MADRAS

RESERVED ON : 22.09.2026

PRONOUNCED ON : 30.09.2026

CORAM

THE HON'BLE DR.JUSTICE A.D.MARIA CLETE

(TM) A No. 8 of 2026

IN OP(TM) NO. 64 OF 2025

Rio Children's Hospital Pvt Ltd
Represented by its Managing Director
Dr.M.Saravanan,
40/4c, 2b1, Vandiyur Bit-1,
Ring Road, Madurai - 625020,
Tamil Nadu.

..Petitioner(s)

Vs

Rajesh Jayaraj
TRADING AS RIO SCANS AND LABS
No.3, Ezhil Nagar,
Opp.To RTO Office,
NGO A Colony,
Tirunelveli,
Tamil Nadu - 627007.

..Respondent(s)

PRAYER: To order to transfer of the physical records of the pending commercial Suit bearing number O.S. No. 302 of 2022 from the file of the Principal District Judge, Madurai to the IPR Division of this Court and Consolidate the said Suit proceedings along with Rectification Petition bearing OP(TM) No.64 of 2025 and also direct consolidated recording of evidence/common trial and consolidated adjudication.

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For Petitioner(s): Ms.Aanchal M.Nichani

For Respondent(s): Mr.A.Swaminathan

ORDER

This application has been filed by the applicant/petitioner seeking transfer of O.S.No.302 of 2022, pending on the file of the Principal District Court, Madurai, to the Intellectual Property Division of this Court, for consolidation of the said suit with O.P.(TM) No.64 of 2025 and for a joint trial of both proceedings.

2. The applicant has instituted O.S.No.302 of 2022 before the Principal District Court, Madurai, against the respondent seeking reliefs in respect of infringement and passing off in relation to the trade mark “RIO”. Subsequently, the applicant filed O.P.(TM) No.64 of 2025 before this Court seeking rectification/removal of the respondent’s registered trade mark “RIO SCANS AND LABS”, bearing Application No.5183815, from the Register of Trade Marks.

3. According to the applicant, the subject matter of the suit and the rectification petition concerns the same rival marks and the same parties and,

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therefore, the suit is required to be transferred to this Court and consolidated with the rectification proceeding.

4. Learned counsel for the applicant submitted that the present application has been filed under Section 24 of the Code of Civil Procedure, 1908 read with Rule 14 of the Madras High Court Intellectual Property Rights Division Rules, 2022. It was submitted that Rule 14 specifically empowers the Intellectual Property Division to consolidate proceedings relating to the same or related intellectual property rights and, where the connected proceeding is pending before a Commercial Court, to exercise the power of transfer under Section 24 CPC.

5. Learned counsel submitted that both O.S.No.302 of 2022 and O.P.(TM) No.64 of 2025 arise out of the competing marks containing the word “RIO”. The validity of the respondent’s registration is directly questioned in the rectification petition and the same registration forms the basis of the rival claims in the infringement suit. Therefore, according to the applicant, the decision in the rectification proceeding would have a direct bearing upon the infringement action.

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6. It was further submitted that the issues in O.S.No.302 of 2022 have not yet been framed and, therefore, transfer of the suit at this stage would not cause any prejudice to the respondent. According to the applicant, Section 124 of the Trade Marks Act, 1999 is only an enabling provision dealing with stay of proceedings when validity of registration is questioned and does not answer the issue of transfer and consolidation under Rule 14.

7. Learned counsel relied upon the decision in ***King Point Enterprise Co. Ltd. v. Maarg India*** reported in **MANU/ TN / 4601/2023** and submitted that where a suit contains claims both for infringement and passing off, a joint trial with the rectification proceeding may appropriately be directed, while regulating the sequence in which the issues relating to validity and infringement are decided.

8. Reliance was also placed upon ***M/s. Woltop India Pvt. Ltd. v. Union of India and others*** reported in **MANU/ TN / 0727/2025** to contend that Rule 14 enables consolidation of proceedings pending before Courts or authorities over which this Court exercises supervisory jurisdiction.

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9. Learned counsel further relied upon the decisions of the Delhi High Court in ***Arif Elahi v. Martin Davis(CS(COMM) 59 /2025)*** and ***KRBL Limited v. Fair Food Overseas Pvt. Ltd. and others*** reported in **MANU/ DE/ 9998/2025** to contend that transfer and consolidation of related intellectual property proceedings would avoid multiplicity of proceedings and conflicting decisions and would facilitate adjudication of the disputes by a single Court.

10. It was therefore submitted that, since the rival trade marks, the parties and substantial factual questions overlap, the suit pending before the Principal District Court, Madurai, ought to be transferred to this Court. According to the applicant, a consolidated trial would reduce duplication of evidence and expense and would enable the question regarding validity of the respondent's registration to be determined first, followed by adjudication of the infringement and passing off claims.

11. Per contra, learned counsel for the respondent strongly opposed the application. It was submitted that the respondent has been continuously using the trade name "RIO SCANS AND LABS" from 01.09.2016 and that its trade mark was registered on 26.05.2023 with effect from 22.10.2021.

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12. Learned counsel submitted that the applicant was aware of the respondent's use of the mark from the year 2016 and was also aware of its registration, but failed to oppose the registration or seek rectification within a reasonable time. It was therefore contended that the rectification petition itself is belated and that questions of acquiescence under Section 33 of the Trade Marks Act also arise.

13. It was further contended that the applicant had suppressed material facts and earlier proceedings. The respondent referred to the plaint in O.S.No.302 of 2022, the written statement filed therein, the dismissal of the interim injunction application in I.A.No.1094 of 2022 by order dated 20.09.2024, and the subsequent appellate proceedings, and contended that these proceedings had not been properly disclosed while instituting the rectification petition.

14. Learned counsel also questioned the maintainability and territorial jurisdiction of O.S.No.302 of 2022. It was submitted that the respondent is a registered proprietor and that the infringement action, as framed, is not maintainable. It was further submitted that the respondent does not carry on business at Madurai and that its business, witnesses and documents are situated

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at Tirunelveli. Therefore, according to the respondent, the suit itself raises questions concerning territorial jurisdiction.

15. Learned counsel submitted that an action for infringement and passing off requires detailed examination of witnesses and documents. Since the witnesses, parties and relevant documents concerning the alleged passing off are primarily situated at Tirunelveli, transfer of the suit to Chennai would cause unnecessary inconvenience and prejudice to the respondent.

16. It was further contended that Rule 14 cannot be applied as a matter of course merely because a rectification petition and an infringement suit concern the same trade mark. According to the respondent, if every infringement suit were automatically transferred to the Intellectual Property Division whenever a rectification proceeding was filed, the statutory scheme under Section 124 of the Trade Marks Act would be rendered largely unnecessary.

17. Learned counsel referred to the principles in ***Patel Field Marshal Agencies v. P.M. Diesels Ltd.*** Reported in **AIR 2017 SC 1388** and submitted that the Trade Marks Act itself provides the manner in which validity of registration is to be dealt with when such an issue arises in an infringement suit.

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It was therefore contended that the statutory procedure cannot be bypassed merely by seeking transfer under Rule 14.

18. Learned counsel also sought to distinguish the decisions relied upon by the applicant, including in re ***King Point Enterprise***, on the ground that the factual situation therein was different. It was submitted that O.S.No.302 of 2022 is pending before the Principal District Court, Madurai, whereas the present rectification proceeding is before the Intellectual Property Division at the Principal Seat.

19. It was also submitted that the Delhi High Court decisions relied upon by the applicant arose in a different jurisdictional setting. According to the respondent, transfer of proceedings from a District Court situated within Delhi to the Delhi High Court cannot automatically be equated with transfer of a suit pending before the Principal District Court at Madurai to the Principal Seat of this Court at Chennai.

20. Learned counsel therefore submitted that there is no compelling necessity for transfer and that the applicant can prosecute the rectification petition before this Court and pursue the civil suit before the competent Court subject to the

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provisions of the Trade Marks Act. The application was accordingly sought to be dismissed.

21. Heard the learned counsel appearing on either side and perused the materials placed on record.

22. The question that arises for consideration is whether the facts of the present case warrant exercise of the power under Rule 14(2) of the Madras High Court Intellectual Property Rights Division Rules, 2022 read with Section 24 CPC to withdraw O.S.No.302 of 2022 from the Principal District Court, Madurai, and transfer the same to this Court for consolidation with O.P.(TM) No.64 of 2025.

23. Rule 14(1) enables the Intellectual Property Division, wherever appropriate, to direct consolidation of proceedings relating to the same or related intellectual property rights and also to direct consolidated recording of evidence, common trial and consolidated adjudication. Rule 14(2) further enables the Court, if it is of the opinion that a matter pending before a Commercial Court is required to be consolidated with a proceeding pending

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before the Intellectual Property Division, to exercise the power of transfer under Section 24 CPC.

24. The use of the words **"***wherever appropriate***"** in Rule 14(1) and **"**if the Court is of the opinion**"** in Rule 14(2) makes it clear that consolidation and transfer are discretionary. Rule 14 does not provide that every civil suit concerning the same trade mark must necessarily be transferred to the Intellectual Property Division merely because a rectification proceeding is subsequently instituted.

25. There is no doubt that the suit and the rectification proceeding are connected. The respondent's registered mark "RIO SCANS AND LABS" is the subject matter of the rectification petition and the competing rights concerning the mark "RIO" also arise for consideration in the suit.

26. However, the nature and scope of the two proceedings are different. O.P. (TM) No.64 of 2025 concerns the validity and continuance of the respondent's registration on the Register of Trade Marks. O.S.No.302 of 2022 is an action seeking reliefs for infringement and passing off.

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27. While determination of the validity of the respondent's registration may have a bearing upon the infringement claim, the passing off action survives independently and has to be decided on the basis of prior use, goodwill, reputation, misrepresentation and likelihood of deception or confusion. Considerable oral and documentary evidence may therefore be required in the suit irrespective of the result of the rectification proceeding.

28. The Trade Marks Act, 1999 itself contains a statutory mechanism under Section 124 to regulate an infringement suit when validity of registration is questioned. The availability of the power under Rule 14 does not mean that this statutory mechanism becomes redundant. The two provisions have to operate harmoniously.

29. If the contention of the applicant that the mere pendency of a rectification proceeding concerning the same mark is sufficient to transfer the civil suit is accepted as a general proposition, virtually every suit for infringement in which rectification proceedings are instituted would become liable to be transferred to the Intellectual Property Division. Such an automatic consequence is not contemplated by Rule 14.

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30. The decisions relied upon by the applicant recognise the power of consolidation and the advantages of avoiding inconsistent decisions. They do not, however, lay down that transfer must necessarily follow in every case where the two proceedings concern the same or related trade marks. Whether consolidation is appropriate ultimately depends upon the facts and procedural setting of each case.

31. In the present case, O.S.No.302 of 2022 was instituted in the year 2022 before the Principal District Court, Madurai. The applicant itself chose that forum. The rectification petition came to be instituted subsequently in the year 2025. No sufficient circumstance has been demonstrated to show that continuation of the suit before the Court where it was originally instituted would result in failure of justice or render effective adjudication impossible.

32. The issues concerning territorial jurisdiction of the suit, maintainability of the infringement action, prior use, acquiescence, suppression of proceedings and other objections raised by the respondent are matters to be decided on their own merits by the competent Court. No finding on those questions is required for deciding this transfer application.

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33. The fact that the issues in the suit have not yet been framed is also not, by itself, sufficient to order transfer. The stage of the proceeding is certainly relevant, but the applicant must additionally establish that consolidation before this Court is necessary or sufficiently expedient in the interests of justice. Such necessity has not been established in the present case.

34. This Court is therefore not persuaded that merely because certain questions concerning the competing marks overlap, O.S.No.302 of 2022 should be withdrawn from the Principal District Court, Madurai and transferred to the Intellectual Property Division at Chennai.

35. The rectification petition may proceed before this Court and the effect of the decision rendered therein can be worked out in the civil suit in accordance with the provisions of the Trade Marks Act, 1999. The Court dealing with the suit shall regulate the proceedings before it in accordance with law, including the statutory consequences arising from the rectification proceedings.

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DR.A.D.MARIA CLETE, J.

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36. In the result, (TM) A.No.8 of 2026 is dismissed. There shall be no order as to costs.

30-09-2026

Index: Yes/No **(1/2)**

Speaking/Non-speaking order

Neutral Citation: Yes/No

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