

**IN THE HIGH COURT AT CALCUTTA
ORIGINAL SIDE
(Intellectual Property Rights Division)**

BEFORE:

The Hon'ble Justice Ravi Krishan Kapur

**IP-COM/12/2025
IA NO: GA-COM/1/2025,
GA-COM/2/2025,
GA-COM/4/2025**

**ITC LIMITED
VS
PRAVIN KUMAR AND ORS**

For the petitioner	: Mr. S. N. Mookherjee, Senior Advocate Mr. Ranjan Bachawat, Senior Advocate Mr. Ratnanko Banerjee, Senior Advocate Mr. Sarathi Dasgupta, Advocate Mr. Naman Chowhdury, Advocate Mr. Paritosh Sinha, Advocate Mr. K.K. Pandey, Advocate Mr. Manosij Mukherjee, Advocate Ms. Pooja Sett, Advocate Mr. Aayush Sinha, Advocate Mr. Bhavesh Garodia, Advocate Ms. Sayani De, Advocate Mr. Dipto Ghosh, Advocate Mr. Teesham Das, Advocate Ms. Mallika Bothra, Advocate
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For the respondent no. 1	: Mr. Jishnu Saha, Senior Advocate Mr. Debnath Ghosh, Senior Advocate Mr. Sourojit Dasgupta, Advocate Mr. Sudhakar Prasad, Advocate Mr. Biswaroop Mukherjee, Advocate Mr. N. Banerjee, Advocate Mr. Pradipta Basu, Advocate Mrs. Nanki Roy, Advocate
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Judgment on	: 20.06.2025
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Ravi Krishan Kapur, J.:

1. This is a rolled up action complaining of infringement of trademark, copyright and passing off.
2. GA-COM 1 of 2025 is an application seeking interim reliefs. GA-COM 2 is an application filed by the respondent no.1 seeking vacating of the interim order dated 6 February 2025 read with order dated 7 February 2025 and for dismissal of GA-COM 1 of 2025. GA-COM 4 of 2025 is an application seeking revocation of dispensation granted under section 12A of the Commercial Courts Act, 2015. By consent of the parties all these applications were heard analogously.
3. The petitioner is a reputed multinational company *inter-alia* engaged in the manufacture, sale and distribution of cigarettes. The petitioner is also the proprietor of a well-known trademark “GOLD FLAKE”, GOLD FLAKE roundel devices and the attendant trade dress. The petitioner has several other registrations in its favour which include the word mark registration ‘GOLD FLAKE Hallmark’, ‘GOLD FLAKE Ultima’, ‘GOLD FLAKE Century’ and ‘GOLD FLAKE Super Star’. In addition, the petitioner has also several copyright registrations in respect of the mark “GOLD FLAKE”. It is alleged that the petitioner has been extensively using the mark “GOLD FLAKE”, ‘GOLD FLAKE roundel devices’, the attendant trade dress uninterruptedly and continuously since 1905. The sales turnover of the petitioner for cigarettes under the mark GOLD FLAKE are in excess of thousands of crores. The petitioner also claims that with the passage of time, the

word “GOLD” has become exclusively associated with the petitioner’s cigarettes. The petitioner has also obtained several registrations of the device mark “GOLD FLAKE”. The details of all such registrations of the trademark and copyright of the petitioner are morefully enumerated in the petition.

4. The grievance in this suit is against the respondents selling cigarettes under the impugned mark ‘GOLD STAG’ with the words ‘IJM’ appearing in miniscule font, the impugned device and the impugned trade dress. It is alleged that through a web of companies and associate concerns all acting in collusion and conspiracy, the respondent nos. 1 to 9 are selling cigarettes under the mark ‘GOLD STAG’. It is also alleged that the word “GOLD” is an essential and distinct feature of the petitioner’s registered mark. The mark ‘GOLD FLAKE’ as well as “GOLD” have also been recognised to have acquired immense goodwill and distinctiveness in respect of cigarettes which are exclusively attributable to the product ‘GOLD FLAKE’ belonging to the petitioner. It is also alleged that the respondents acting as co-conspirators have been working surreptitiously to sell counterfeit cigarettes. All the principal respondents are inter-related and have common shareholders, directors, associates and employees. The respondent no.4 has obtained the impugned registration of the mark ‘GOLD STAG’ without any intention to use the same but merely to trade by selling the right of use to others. In this background, the petitioner complains of infringement, passing off, counterfeiting and trafficking by the respondent nos.1 to 9 and claims protective reliefs

insofar as violations of its rights *vis-a-vis* 'GOLD FLAKE' are concerned.

5. On behalf of the respondents, it is contended that the ad interim order dated 6 February 2025, read with an order dated 7 February 2025, is liable to be vacated on the ground that there has been non compliance with Order 39 Rule 3 of the Code of Civil Procedure, 1908. The respondent no.1 has not been served contemporaneously in terms of Order 39 Rule 3. It is further contended that the *ex parte* order dated 6 February 2025 has been obtained by suppression of material facts. The petitioner had suppressed the fact of registration in favour of the petitioner under the brand name 'IJM GOLD STAG' as well as the disclaimer attached to the petitioner's trademark registration 'GOLD FLAKE'.
6. It is further contended that the registration in favour of the petitioner is only in respect of the words 'GOLD FLAKE' and the petitioner can claim no monopoly nor exclusivity in respect of the word 'GOLD'. The petitioner does not have any registration for the word mark 'GOLD' *per se*. In support of such contentions, the respondent no.1 relies on the disclaimer in the petitioner's registration and submits that no right can be claimed in respect of 'GOLD'. In any event, the word 'GOLD' is laudatory in nature and commonly used in the tobacco industry. It is also contended that there is no similarity of any kind whatsoever between the impugned trade dress or device of the respondents and that of the petitioner. In such circumstances, the application is liable to be dismissed.

GA 4 of 2025

7. This is an application seeking revocation of dispensation granted under section 12A of the Commercial Courts Act, 2015. For convenience, section 12A of the Act reads as follows:

12-A. Pre-litigation Mediation and Settlement.—(1) A suit, which does not contemplate any urgent interim relief under this Act, shall not be instituted unless the petitioner exhausts the remedy of pre-litigation mediation in accordance with such manner and procedure as may be prescribed by rules made by the Central Government.

(2) For the purposes of pre-litigation mediation, the Central Government may, by notification, authorize— (i) the Authority, constituted under the Legal Services Authorities Act, 1987 (39 of 1987); or (ii) a mediation service provider as defined under clause (m) of Section 3 of the Mediation Act, 2023.

(3) Notwithstanding anything contained in the Legal Services Authorities Act, 1987 (39 of 1987), the Authority or mediation service provider authorized by the Central Government under sub-section (2) shall complete the process of mediation within a period of one hundred and twenty days from the date of application made by the petitioner under sub-section (1): Provided that the period of mediation may be extended for a further period of sixty days with the consent of the parties: Provided further that, the period during which the parties spent for pre-litigation mediation shall not be computed for the purposes of limitation under the Limitation Act, 1963 (36 of 1963).

(4) If the parties to the commercial dispute arrive at a settlement, the same shall be reduced into writing and shall be signed by the parties and the mediator.

(5) The mediated settlement agreement arrived at under this section shall be dealt with in accordance with the provisions of Sections 27 and 28 of the Mediation Act, 2023.

8. It is no longer *res integra* that the provisions of section 12A of the Act are mandatory in nature and no suit shall be instituted without exhausting the requirement of Pre-Litigation Mediation or Settlement. [Dhanbad Fuels Pvt. Ltd. vs. Union of India and Anr. 2025 SCC OnLine 1129 and Patil Automation (P) Ltd. vs. Rakheja Engineers (P) Ltd. (2022) 10 SCC 1]. The only exception is where the suit “contemplates any

urgent interim relief". In *Yamini Manohar vs. T.K.D. Keerthi*, 2023 SCC OnLine SC 1382, it has been held as follows:

10. We are of the opinion that when a plaint is filed under the CC Act, with a prayer for an urgent interim relief, the Commercial Court should examine the nature and the subject-matter of the suit, the cause of action, and the prayer for interim relief. The prayer for urgent interim relief should not be a disguise or mask to wriggle out of and get over Section 12-A of the CC Act. The facts and circumstances of the case have to be considered holistically from the standpoint of the petitioner. Non-grant of interim relief at the ad interim stage, when the plaint is taken up for registration/admission and examination, will not justify dismissal of the commercial suit under Order 7 Rule 11 of the Code; at times, interim relief is granted after issuance of notice. Nor can the suit be dismissed under Order 7 Rule 11 of the Code, because the interim relief, post the arguments, is denied on merits and on examination of the three principles, namely: (i) prima facie case, (ii) irreparable harm and injury, and (iii) balance of convenience. The fact that the court issued notice and/or granted interim stay may indicate that the court is inclined to entertain the plaint.

*11. Having stated so, it is difficult to agree with the proposition that the petitioner has the absolute choice and right to paralyse Section 12-A of the CC Act by making a prayer for urgent interim relief. Camouflage and guise to bypass the statutory mandate of pre-litigation mediation should be checked when deception and falsity is apparent or established. The proposition that the Commercial Courts do have a role, albeit a limited one, should be accepted, otherwise it would be up to the petitioner alone to decide whether to resort to the procedure under Section 12-A of the CC Act. An "absolute and unfettered right" approach is not justified if the pre-institution mediation under Section 12-A of the CC Act is mandatory, as held by this Court in *Patil Automation [Patil Automation (P) Ltd. v. Rakheja Engineers (P) Ltd., (2022) 10 SCC 1 : (2023) 1 SCC (Civ) 545]*.*

9. Thus, a Court must be satisfied that camouflage and guise is not being resorted to circumvent and bypass the statutory mandate of Pre-Litigation Mediation. The limited window which is only available to the Court to revoke leave granted under section 12A is where the petitioner has deceptively and fraudulently sought to create urgency where none exists. This would require to the Court to examine the nature and subject matter of the suit, the cause of action and the reliefs sought for in the plaint. In doing so, the Court must consider the plaint holistically and from the stand point of the petitioner in determining whether the plaint, documents and the facts indicate

urgent interim reliefs. There can be neither deception nor falsity in seeking such urgency.

10. In the facts of this case, the petitioner complains of violation of its intellectual property rights. It is alleged that the petitioner has promptly approached the Court by filing the present suit on 28 January 2025 only after coming across the infringing products in the market and the corresponding facts in or about December 2024. By an order dated 5 February 2025, this Court *inter-alia* admitted the plaint and dispensed with the requirement under section 12A of the Act. It is alleged in the plaint that though the respondent no.1 holds registration for TM 'IAKA MANBRO' the same was not being used as a mark. The petitioner alleges to have been unaware of the licenses granted to the respondent no.1 by the respondent nos. 2, 3 or 4. The petitioner also alleges to be in the dark as to how the respondent no.1 was claiming to be registered proprietor of the impugned mark. The plaint discloses that the respondent no.4 was enjoying a trademark registration of 'IJM GOLD STAG' and the petitioner has pleaded invalidity of the same. The petitioner has alleged that the registration being enjoyed by the respondent no.4 was not available in the public domain and could not be filed alongwith the plaint. The respondents are primarily group companies and associate concerns who have been acting in concert in selling cigarettes under the impugned mark. The petitioner also alleges that the infringing products *per se* do not disclose any connection with the respondent no.4 and the exact connection between the respondents was not easily ascertainable from any of the documents in the public domain.

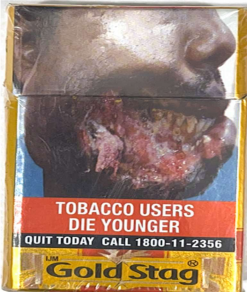
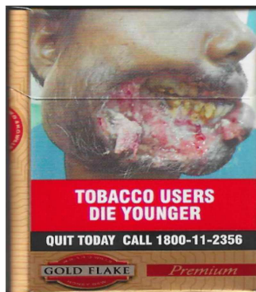
11. On behalf of the respondent no.1 it is alleged that the sequence of events would demonstrate that there was no urgency in seeking dispensation under section 12A of the Act and that the petitioner has suppressed various relevant facts.
12. On a consideration of the plaint and the documents annexed, it appears that there are sufficient materials in seeking dispensation under section 12A of the Act. There is no material fact which has been concealed or suppressed in the plaint. Significantly, there is nothing relied on by the respondent no.1 to prove that the petitioner had direct or actual knowledge of the impugned mark in the market and the inter-relationship between the respondent nos. 1 to 9. Such knowledge cannot be imputed on the basis of guesswork, surmises or conjectures. This fact is of vital importance in ascertaining whether or not dispensation granted is liable to be revoked or not. The petitioner as *dominus litis* has pleaded sufficient urgency and a microscopic analysis is not necessary (*Chemco Plastic Industries Pvt. Ltd. vs. Chemco Plast 2024 SCC OnLine Bom 1607*). The length of delay or the interval or time gap cannot be considered in isolation (*Unique Entrepreneurs and Finance Limited vs. Really Agritech Pvt. Ltd. and Anr. 2025 SCC OnLine Cal 2426*). The rival contentions insofar as the merits of the case are concerned cannot also be gone into at this stage of the suit. On a combined reading of the plaint and the documents in support thereof, urgency has been sufficiently pleaded and there are no grounds to revoke dispensation thereof.
13. The petitioner had also annexed the filing with the Registry of the extract of "IJM GOLD RING" instead of "IJM GOLD STAG". The

petitioner has disclosed the fact that the respondent no.4 was enjoying trade mark registration both in the plaint and the petition. An inadvertent and bonafide non disclosure cannot be equated with a deliberate and an intentional attempt to deceive the Court. In any event, the documents alleged to have been suppressed would have no material bearing insofar as dispensation under section 12A of the Act is concerned. In this connection, reliance is placed on the decisions, *Unique Entrepreneurs and Finance Limited vs. Really Agritech Pvt. Ltd. and Anr.* 2025 SCC OnLine Cal 2426 is distinguishable. In that decision, the material and relevant facts i.e. Kisan Mela and prior dealings between the parties were germane factors as to knowledge which amounted to gross suppression by the petitioner. The chain of events suggests that regardless of the registration of the word mark “IJM GOLD STAG” in favour of the respondent no.4, the exact relationship by and between the respondents was not readily available and the petitioner had been monitoring the activities of the respondent nos. 1 to 9 in trying to ascertain the true relationship between the parties. Thus, there is sufficient justification and explanation. (Unreported decision of this Court in *Nocil Ltd. vs. Finorchem Ltd. and Anr.* dated 15 May 2025 in IP-COM/25/2024). In such circumstances, the application GA/4/2025 for revocation of dispensation under section 12A of the Commercial Courts Act 2015 is without merit and is dismissed.

GA-COM/1/2025 and GA-COM/2/2025

14. Upon filing of this suit, by an ad interim order dated 6 February 2025, this Court had granted ad interim orders of restraint and also directed Special Officers to visit the offices of the respondents and file a Report. Pursuant to the above direction, the Special Officers have filed their reports which were taken on record.

15. The rival packaging of the parties are set out below:

	IMPUGNED PRODUCT	PETITIONER'S PRODUCT
Front Panel		
Top Panel		
Side Panel		
Cigarette stick		
Roundel Devices		

16. At the outset, the relevant sections of the Trade Marks Act, 1999 are set out below:

17. Effect of registration of parts of a mark.—(1) When a trade mark consists of several matters, its registration shall confer on the proprietor exclusive right to the use of the trade mark taken as a whole.

(2) Notwithstanding anything contained in sub-section (1), when a trade mark—

(a) contains any part—

(i) which is not the subject of a separate application by the proprietor for registration as a trade mark; or

(ii) which is not separately registered by the proprietor as a trade mark; or ;

(b) contains any matter which is common to the trade or is otherwise of a non-distinctive character, the registration thereof shall not confer any exclusive right in the matter forming only a part of the whole of the trade mark so registered.

28. Rights conferred by registration.—(1) Subject to the other provisions of this Act, the registration of a trade mark shall, if valid, give to the registered proprietor of the trade mark the exclusive right to the use of the trade mark in relation to the goods or services in respect of which the trade mark is registered and to obtain relief in respect of infringement of the trade mark in the manner provided by this Act.

(2) The exclusive right to the use of a trade mark given under sub-section (1) shall be subject to any conditions and limitations to which the registration is subject.

(3) Where two or more persons are registered proprietors of trade marks, which are identical with or nearly resemble each other, the exclusive right to the use of any of those trade marks shall not (except so far as their respective rights are subject to any conditions or limitations entered on the register) be deemed to have been acquired by any one of those persons as against any other of those persons merely by registration of the trade marks but each of those persons has otherwise the same rights as against other persons (not being registered users using by way of permitted use) as he would have if he were the sole registered proprietor.

29. Infringement of registered trade marks.—(1) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which is identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark.

(2) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which because of—

(a) its identity with the registered trade mark and the similarity of the goods or services covered by such registered trade mark; or

(b) its similarity to the registered trade mark and the identity or similarity of the goods or services covered by such registered trade mark; or

(c) its identity with the registered trade mark and the identity of the goods or services covered by such registered trade mark, is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trade mark.

(3) In any case falling under clause (c) of sub-section (2), the court shall presume that it is likely to cause confusion on the part of the public.

(4) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which—

(a) is identical with or similar to the registered trade mark; and

(b) is used in relation to goods or services which are not similar to those for which the trade mark is registered; and

(c) the registered trade mark has a reputation in India and the use of the mark without due cause takes unfair advantage of or is detrimental to, the distinctive character or repute of the registered trade mark.

(5) A registered trade mark is infringed by a person if he uses such registered trade mark, as his trade name or part of his trade name, or name of his business concern or part of the

name, of his business concern dealing in goods or services in respect of which the trade mark is registered.

(6) For the purposes of this section, a person uses a registered mark, if, in particular, he—

(a) affixes it to goods or the packaging thereof;

(b) offers or exposes goods for sale, puts them on the market, or stocks them for those purposes under the registered trade mark, or offers or supplies services under the registered trade mark;

(c) imports or exports goods under the mark; or

(d) uses the registered trade mark on business papers or in advertising.

(7) A registered trade mark is infringed by a person who applies such registered trade mark to a material intended to be used for labelling or packaging goods, as a business paper, or for advertising goods or services, provided such person, when he applied the mark, knew or had reason to believe that the application of the mark was not duly authorised by the proprietor or a licensee.

(8) A registered trade mark is infringed by any advertising of that trade mark if such advertising—

(a) takes unfair advantage of and is contrary to honest practices in industrial or commercial matters; or

(b) is detrimental to its distinctive character; or

(c) is against the reputation of the trade mark.

(9) Where the distinctive elements of a registered trade mark consist of or include words, the trade mark may be infringed by the spoken use of those words as well as by their visual representation and reference in this section to the use of a mark shall be construed accordingly.

17. It is true that section 17 of the Trade Marks Act, 1999 confers exclusive rights on the registered proprietor to use the trademark as a whole and not in parts, particularly when the parts are non-distinctive or purely descriptive. Even under Section 17(2)(b), such exclusivity can only be asserted where part of the composite mark relied upon is

truly distinctive and not common to the trade; otherwise, no exclusivity can be claimed over such matter. Thus, any assertion of exclusivity over elements of a composite mark, unless supported by distinctiveness not common to the trade and independently established, cannot sustain a claim of statutory infringement. (*Three-N-Products Pvt. Ltd. vs. Emami Ltd. 2010 SCC OnLine Cal 134*).

18. As a general principle, laudatory expressions—such as "Super," "Best," "Gold," or "Ultra" are often used to praise and describe the quality of goods and are considered non-distinctive and common to trade. Courts have held that such words, when forming part of a composite mark, do not *per se* confer any exclusive proprietary right on a party. Thus, in cases where such descriptive or laudatory elements are part of a registered mark, registration does not grant exclusivity over those elements alone under Section 17(2)(b). (*Vasundhra Jewellers Pvt. Ltd. vs. Kirat Vinodbhai Jadvani & Anr. 2022 SCC OnLine Del 3370*, *Vardhman Buildtech Pvt. Ltd. vs. Vardhman Properties Ltd. 2016 SCC OnLine Del 4738*, *Soothe Healthcare (P) Ltd. vs. Dabur India Ltd. 2022 SCC OnLine Del 2006*, *Three-N-Products Pvt. Ltd. vs. Emami Ltd. 2010 SCC OnLine Cal 134*).
19. Indisputably, repeated judicial pronouncements, suggest that the word 'GOLD' has been found to be a prominent feature of the petitioner's mark also enjoying distinctiveness but does this fact *per se* give then a monopoly on the word 'GOLD'. (*ITC Limited vs. Golden Tobacco Limited 2018 SCC OnLine Mad 2437*, *ITC Ltd. vs. NTC Industries Ltd. 2015 (64) PTC 244 (Bom)*; *ITC Limited vs. Whole Leaf Tobacco Venture Pvt. Ltd. and Ors.* before the Hon'ble High Court at Calcutta,

Order dated 19/02/2018 in GA no. 3437 of 2018, CS No. 261/2018; *ITC Ltd. vs. Tapisserie Lifestyle Private Limited and Anr.* before the High Court at Delhi, Order dated 24/03/2022 in CS (Comm) 667/2021 and IAs No. 160907 of 2021 and 611 of 2022 and *ITC Limited vs. Golden Tobie Private Limited & Ors.* before The High Court at Delhi, Order dated 19/05/2022 in CS (Comm) 331/2022.

20. Time has its own role to play in intellectual property matters. The fact that the mark of the petitioner was coined more than a century ago and has been in open, continuous and uninterrupted use by the petitioner is a factor which would be required to be taken into consideration. It is also true that there is a disclaimer in some of the registrations granted to the petitioner but does the ultimate consumer have knowledge of the same? Though the petitioner has no registration in respect of the word “GOLD” and proceedings are pending before the Registry, nevertheless, the fact that trade rivals have in a deliberate and calculated manner repeatedly sought to encash on the word “GOLD” cannot be ignored. In this connection, a tabular representation relied on by the petitioner is set out below:

Sl No.	Suit Details	Order Date	Mark in Dispute
1.	ITC Limited v. Golden Tobie Tobacco Private Limited & Ors., CS(COMM) No. 331/2022	19.05.2022	<i>GOLD MAGIC GOLD TOUCH GOLD STRIKE</i>
2.	ITC Limited v. Gold Step Tobacco Private Limited & Ors., CS(COMM) No. 146/2023	14.03.2023	<i>GOLD VIMAL</i>
3.	ITC Limited v. DAV Industries LLP, CS(COMM) No. 60/2024	22.01.2024	<i>GOLD FROST GOLD FUN</i>
4.	ITC Limited v Gold Step Tobacco Private Limited & Ors., CS(COMM) No. 124/2024	08.02.2024	<i>GOLD STEP</i>
5.	ITC Limited v. STC Tobacco Put. Ltd & Ors., CS(COMM) No. 182/2024	29.02.2024	<i>GOLD FALCON GOLD FLICKER</i>
6.	ITC Limited vs. Elora Tobacco Company Ltd. & CS(COMM)	07.03.2024	<i>GOLD IMPACT</i>

	201/2024 Ors.,		
7.	ITC Limited v. Pelican Tobacco Company Limited & Ors., CS (COMM) No. 221/2024	13.03.2024	<i>GOLD FIGHTER</i> <i>GOLD FLAME</i>

21. It is true that the evidence relied on by the respondent no.1 suggests that there is some use of the word 'GOLD' nevertheless, it may be insufficient to be described as common to the trade. In this connection a number of registrations and search reports which the respondent no.1 has relied upon would demonstrate that most of the marks cited were abandoned or have lapsed. In addition, several of those marks did not pertain to cigarettes but different goods such as bidis, pan masala etc. In any event mere registration or filing of an application does not automatically translate into use in the trade. Some of the packagings relied on by the respondent no.1 were merely depicted though there was no evidence of the physical packets being available in market. In addition, a number of packets did not even contain the mandatory health warnings which is now compulsory in India. On the other hand, though, under the law there can be only one mark, one source or one proprietor there are a multitude of registrations for GOLD formatives in class 34 which cannot be disregarded. In addition, the respondent no.4 is enjoying registration of the word mark 'GOLD STAG' bearing registration no. 2331406. *Prima facie*, keeping the competing rights of the parties, the petitioner's case of infringement based exclusively on the word 'GOLD' and having a secondary meaning is found to be unacceptable and will have to await trial. (*Parakh Vanijya Pvt. Ltd. v. Baroma Agro Product*, (2018) 16 SCC 632).

22. On the other hand, the registration of a device or label entitles the proprietor to protection against its unauthorized use by a rival in trade when such use involves identical or deceptively similar trade dress. The test in such cases continues to be the eye. A bare examination of the impugned packaging would demonstrate that there are striking similarities and resemblances between the two products. In the two products, the word GOLD FLAKE and GOLD STAG are written in black. The trademarks GOLD STAG and GOLD FLAKE are in cased in a device. The colour Red had been used for the devices in respect of both the marks. Both products contain 'GOLD', Black and Red colour combination. In conclusion, the infringing products thus depict strikingly essential resemblances in their get up, layout, colour combination, use of devices and placement of features similar to the petitioner's trade dress.

23. The copyright registrations relied on by the respondent no.1 are also invalid and contrary to the Copyright Act 1957 and the Rules framed thereunder. The year of first publication is alleged to be 2013 showing the mandatory graphical warning rule which had only came into force on 1 April 2016. There is also no certificate produced by the respondent no.1 as mandated under Rule 70(6) of the Copyright Rules. There are also serious infirmities in the license from the respondent no.2 to respondent no.1 which go to the root on the genuineness and veracity of the documents in favour of the respondent no.1. In any event, there has been no compliance with section 30 read with section 30(A) and 19 of the Copyright Act 1957 which mandatorily requires any such agreement to be in *writing*. The

impugned mark is a slavish imitation and a crude copy of the dominant theme underlying the mark of the petitioner and constitutes infringement of the petitioner's original artistic works which are independently entitled to protection under the provisions of the Copyright Act, 1957. The long, continuous and extensive use alongwith the unique colour combination has become synonymous with the product of the petitioner. Such similarities in get-up, colour scheme, and presentation also constitute trade dress infringement, inter alia under section 2(c) of the Copyright Act 1957. *Prima facie*, the imitation of the trade dress and misleading overall impression created by "IJM GOLD STAG" raises serious concerns of consumer confusion and actionable infringement [*Colgate Palmolive Co. v. Anchor Health & Beauty Care Pvt. Ltd.*, (2003) 27 PTC 478 (Del)].

24. As stated hereinbefore, this is a combined action for infringement, copyright, and passing off. To this extent, the decision cited by the respondent no.1 that a suit registered against registered proprietor is not maintainable is inapplicable. There is no absolute bar in the filing of a suit for infringement against a registered proprietor. Moreso, where the plea of invalidity of the defendant's mark is raised. (Unreported decision in *Apricot Foods Pvt. Ltd. vs. Narendra Kumar* dated 21 December 2013 in Appeal No.378 of 2013 in Suit no.604 of 2010 passed by the High Court at Bombay and (2013) 5 Mah LJ 306). In any event, a suit for passing off being a common law action is always maintainable even against a registered proprietor. A perusal of the impugned mark as a whole would suggest that there is every likelihood or possibility of deception and confusion from the similarity

of the two products. The test remains the Court's perception of the degree of resemblance between the marks. In this context, the price variation between the two products does not aid the case of the respondent no.1. [*Kaviraj Pandit Durga Dutt Sharma vs Navaratna Pharmaceutical AIR 1965 SC 980* at paras 28 and 29; *Ruston & Hornsby Ltd. vs. The Zamindara Engineering Co. (1969) 2 SCC 727* at paras 3 and 7; *Ramdev Food Products Pvt. Ltd vs. Arvindbhai Rambhai Patel 2006 (8) SCC 726* at paras 91, 92, 94 and 97.

25. The connection and commonality between the directors and ex-directors of the respondents also appears from a chart relied on by the petitioner and is not disputed by the respondent no.1. For convenience, the chart is set out below:

DIRECTORS AND EX-DIRECTORS OVERLAP CHART

Entity	Directors	Ex-Directors
RESPONDENT NO.2: INAYAT GLOBAL PRIVATE LIMITED	Balram, Vinod Kumar	Kanhaiya Lal, Krishan Kumar
RESPONDENT NO.3: CHANDER SHEIKHAR MARWAH		Ex-director of D-4, D-5, Promoter of D5 as per India Mart
RESPONDENT NO.4: IJM CIGARETTE COMPANY PRIVATE LIMITED	Deepak Kumar, Sant Lal	Ankush Marwaha, Krishan Kumar, Chander Sheikhar Marwah
RESPONDENT NO.5: IJM ENTERPRISES PVT. LTD.	Baldish Singh, Sanjeev Bhardwaj	Ankush Marwaha, Krishan Kumar, Chander Sheikhar Marwah
RESPONDENT NO.7: NAGAHIA ENTERPRISES	Kanhaiya Lal, Deepak Kumar	Satish Kumar, Ankush Marwaha
RESPONDENT NO.9: IJM FILTER CO. PVT. LTD.	Deepak Kumar, Balram	Ankush Sharma, Sanjeev Bhardwaj, Krishan Kumar

26. In view of the above, there are sufficient materials at this stage to conclude that the respondent nos. 1 to 9 are inextricably connected with each other so as to form one economic unit. *Prima facie*, the respondents are acting in concert where the respondent no.1 acts as a mask for the wrongful activities of the remaining respondents. The alleged licensing agreements in favour of the respondent no.1 are also invalid, fabricated and an afterthought. One of the two agreements is described as an agreement for rent. There is also no written agreement

for the period 1 April 2021 to 29 July 2022. In addition, the invoices relied on pre-date the license agreements. No other respondent has come before this Court and the respondent no.1 has attempted to make submissions on their behalf for which no credence should be given. It is obvious that the remaining respondents are waiting in the wings with ulterior purpose. *Prima facie*, the dishonest and malafide conduct of the respondent nos.1 to 9 are writ large in these proceedings. In this backdrop, the case of trafficking and counterfeiting would require further examination at the trial.

27. There is also no merit in the contention that the provisions of Order 39 Rule 3 of the Code of Civil Procedure have not been complied with. In matters of such nature, it is common for a Court to extend the period of compliance under Order 39 Rule 3 when appointing a Special Officer or a Local Commissioner to carry out search and seizure operations for preservation of evidence in order to obviate any disappearance by the respondents. The intention behind such orders is for service to be effected after conducting such search and seizure operations. The Special Officer had served the respondent no.1 alongwith all suit papers on 28 February 2025 when the Special Officer had visited the premises of the respondent no.1 in terms of the ad interim order. The petitioner had also served the respondent no.1 by post on 1 March 2025 and the same was received on 5 March 2025. There has to be an inbuilt element of surprise in executing such orders which are essential to prevent the respondents from destroying evidence or avoiding liability. Thus, Courts do permit deferred service, acknowledging that the object of justice would be defeated if the

respondent is given advance notice. This procedural safeguard ensures that the respondents are not forewarned and thereby are not in a position to fabricate, conceal, destroy or misappropriate incriminating materials or evidence targeted by the Court's intervention. In view of the above, there has been sufficient compliance under Order 39 Rule 3 of the Code of Civil Procedure, 1908 and there is no merit in this objection. [*Autodesk Inc. and Anr. vs. A.V.T. Shankardass and Anr. (2008) 105 DRJ 188*], *Time Warner Entertainment Company v. RPG Netcom, 2007 (34) PTC 668 (Del.)* and *Microsoft Corporation v. Kiran and Ors., 2007 (35) PTC 748 (Del.)*].

28. In such circumstances, the petitioner has been able to make out a strong *prima facie* case on merits. The balance of convenience and irreparable injury are also in favour of orders being passed as prayed for herein. For the above reasons, GA/1/2025 stands allowed. There shall be an order in terms of prayers (b), (c), (d), (e) (f), (g) and (h) of the Notice of Motion in GA 1 of 2025. The ad interim orders dated 6 February 2025 read with the order dated 7 February 2025 stands modified to the above extent. In view of the different reports filed by the respective Special Officers, liberty is granted to the Special Officers to make a formal prayer for discharge upon notice to all the parties. Accordingly, GA/2/2025 and GA/4/2025 stand dismissed.

(Ravi Krishan Kapur, J.)