In the High Court at Calcutta
Civil Appellate Jurisdiction
ORIGINAL SIDE

The Hon'ble Mr. Justice Sabyasachi Bhattacharyya
And
The Hon'ble Mr. Justice Supratim Bhattacharya

TEMPAPO-IPD NO. 6 OF 2025
IA NO: GA-COM 2 OF 2026

PRAVIN KUMAR
VS
ITC LIMITED AND ORS

OCOT NO. 7 OF 2025

PRAVIN KUMAR
VS
ITC LIMITED AND ORS

For the appellant	:	Mr. Tilak Kumar Bose, Sr. Adv., Mr. Soumya Ray Choudhury, Adv., Ms. Srishti Kaul, Adv., Mr. Suryaneel Das, Adv., Mr. Dhruv Chadha, Adv., Mr. Subha Pathak, Adv., Mr. Chiranjit Paul, Adv., Ms. Oindrila Ghosal, Adv.
For the respondents	:	Mr. S.N. Mukherjee, Sr. Adv., Mr. Paritosh Sinha, Adv., Mr. K.K. Pandey, Adv., Mr. Monosij Mukherjee, Adv., Mr. Sauradip Banerjee, Adv., Mr. Ayush Sinha, Adv., Mr. Naman Chowdhury, Adv., Mr. Bhavesh Garodia, Adv., Mr. Viraj Nandy, Adv., Ms. Sonia Nandy, Adv., Ms. Sayani De, Adv.
Heard on	:	18.02.2026, 25.02.2026, 18.03.2026, 01.04.2026, 08.04.2026, 24.06.2026, 01.07.2026, 15.07.2026 & 22.07.2026

Reserved on : 22.07.2026

Judgment on : 18.09.2026

Sabyasachi Bhattacharyya, J.:-

1. The present appeal arises out of a suit filed by the plaintiff/respondent no.1 seeking injunction against the defendant no.1/appellant and the other defendants, being the rest of the respondents herein, in respect of alleged infringement of the trade mark and trade dress of the plaintiff in respect of its cigarette brand "Gold Flake", as well as of alleged passing off of the said trade name as well as trade dress of the plaintiff by the defendants by way of user of the trade name "IJM Gold Stag" and the associated trade dress.

2. By the impugned order, the learned Single Judge dismissed a vacating application of the defendant no.1/appellant and partially allowed the temporary injunction application filed by the respondents, thereby granting injunction primarily on account of passing off.

3. A cross-objection has been filed by the plaintiff/respondent no.1 against the part of the impugned order whereby injunction on account of infringement was refused.

4. As an aside, it is noted that after the matter was assigned to this Bench, the appellant placed before this Court an order of the Hon'ble Supreme Court passed in Writ Petition (Civil) No. 1273 of 2025 on January 23, 2026, recording a request to this Court to dispose of the appeal within six months. Accordingly, the hearing was commenced on the very next available date thereafter. However, extensive arguments were advanced and several judgments were cited by both parties, which culminated in elaborate written notes of arguments being filed by both sides, totalling between themselves about 97 pages. The arguments were concluded on July 22, 2026, which itself was beyond the stipulated period of six months. The above circumstances led to the time-line stipulated by the Hon'ble Supreme Court being exceeded.

5. Learned senior counsel for the defendant no.1/appellant, in support of the appeal, argues that the learned Single Judge lacked inherent jurisdiction to entertain the suit and to pass the impugned order. It is pointed out that the alleged infringement/passing off occurred in the State of Punjab, which is beyond the territorial jurisdiction of this Court. The addresses of the defendants are in Punjab and the business of the defendants is also conducted in Punjab, and not in Kolkata. Thus, in the absence of any leave under Clause 14 of the Letters Patent for the High Court of Judicature at Fort William in Bengal (herein after referred to as "the Letters Patent"), no injunction could be granted. Learned senior counsel points out that although a leave under Clause 14 may be obtained subsequent to the filing of the suit, no interim relief can be granted before such leave is actually granted.

6. Learned senior counsel cites the judgment passed in *Hindustan Unilever Limited v. Three Leaves India Pvt. Ltd.*, reported at *2016 SCC OnLine Cal 11151*, which, it is submitted, was affirmed in APOT 214 of 2016 on July 20, 2026, in support of the proposition that no injunction can be granted where the action is of passing off, combined with infringement, without a Clause 14 leave.

7. The appellant also cites *Asma Lateef and another v. Shabbir Ahmad and others*, reported at *(2024) 4 SCC 696*, where the Hon'ble Supreme Court held that where an objection as to maintainability/jurisdiction is raised, the same is to be determined at least *prima facie* before granting interlocutory relief.

8. In the present case, it is submitted, the cause of action arose beyond the jurisdiction of this Court and the defendants carry on their business only in Punjab, which is beyond the jurisdiction of this Court as well, thus denuding the Calcutta High Court of jurisdiction, which extends beyond territoriality and enters into the domain of subject-matter jurisdiction. It is submitted that, Section 134(2) of the Trade Marks Act (for short, "the TM Act") does not apply to passing off. Furthermore, the said provision merely creates an additional forum for the benefit of the proprietor and does not vest unrestricted power on a Court not otherwise having jurisdiction to assume so wherever the proprietor has office. It is contended that since the plaintiff/respondent no.1 also has business in Punjab and has offices for such purpose within Punjab, the learned Single Judge erred in law in assuming jurisdiction. Leave under Clause 1t of the Letters Patent, it is submitted, was also specifically required to be granted.

9. Learned senior counsel for the appellants cites *Indian Performing Rights Society Ltd. v. Sanjay Dalia and another*, reported at *(2015) 10 SCC 161*, where it was held that if the plaintiff carries on business at a place where the cause of action has arisen, the suit must be instituted there, not another place merely because the plaintiff maintains an office there. A suit of composite nature does not permit the Court to entertain a cause of action without having territorial jurisdiction. It was reiterated that Section 62(2) of the Copyright Act, 1957 (hereinafter referred to as "CR Act") and Section 134(2) of the TM Act are merely to alleviate the proprietor's hardship, not to facilitate forum shopping or to create inconvenience for the defendant.

10. Next relying on *Ultra Home Construction Pvt. Ltd. v. Purushottam Kumar Chaubey*, reported at *2016 SCC OnLine Del 376*, it is argued that when the principal office of the plaintiff is elsewhere but the plaintiff still has a subordinate establishment where the cause of action arises, the Courts at the latter place can invoke jurisdiction.

11. It is further contended that since the lack of jurisdiction pertains not only to territoriality but also to inherent jurisdiction, no specific objection was required to be taken at the inception before the learned Trial Judge.

12. Learned senior counsel appearing for the appellant next submits that there cannot be any infringement action against another user of identical or deceptively similar registered trade mark. By placing particular reliance on Section 28(3) and Section 30(2)(e) of the TM Act, it is argued that one registered proprietor cannot sue another for infringement. In this context, it is submitted that the impugned trade mark "IJM Gold Stag" is duly registered, having Registration No. 2331406 (Class 34) dated May 11, 2012, which has since been renewed and is still subsisting.

13. In support of the above proposition, learned senior counsel cites *S. Syed Mohideen v. P. Sulochana Bai*, reported at *(2016) 2 SCC 683*, and an unreported judgment of the Delhi High Court in *M/s. Vaidya Rishi India Private Limited & Anr. v. Suresh Dutt Parashar & Ors.* dated August 7, 2025, passed in *FAO (COMM) 122/2024*.

14. It is contended that Section 124 of the TM Act contemplates certain situations where a suit for infringement may be instituted against a registered proprietor of a trade mark and injunction may also be granted under certain circumstances, where the issue of invalidity of the defendant's trade mark is raised by the plaintiff. However, in the present case, it is submitted, no such case has been made out in the plaint or the temporary injunction application. Furthermore, for such a suit to be maintainable, the Court must be satisfied as to the invalidity of the defendant's trade mark and such validity is to be determined in a rectification application. In the present case, the said tests are not satisfied.

15. The defendant no.1/appellant, it is argued, has written permission from the registered proprietor, which would be evident from the documents produced before the learned Single Judge. Moreover, the learned Single Judge himself held in the impugned order that the defendants have common directors and operate as a single economic entity. Thus, the use of the impugned trade mark by its registered/licensed users could not be assailed in the suit by another alleged registered proprietor.

16. Thirdly, it is argued that the premise of purported similarity between the two marks is the word "Gold" which is common to thee marks of both parties. However, the plaintiff specifically disclaimed the same while making applications for registration of its various trade marks, which is evident from the official portal of the Trade Mark Registry. Moreover, the plaintiff/respondent no.1 has registration for composite marks, labels and devices, containing the expression "Gold", without having any separate registration for the term "Gold", which is otherwise a generic laudatory word.

No secondary meaning of the said word, exclusive to the plaintiff, has been established. Under sub-sections (1) and (2) of Section 17 of the TM Act, a mark is to be considered as a whole unless there are separate applications for registration of its parts. Consumer knowledge, it is submitted, is immaterial to ascertain the legal effect of a disclaimer.

17. It is next submitted that since the registrations of its marks were obtained by the plaintiff by denying exclusivity in the term "Gold" on public record, it is debarred by the principle of Prosecution History Estoppel from taking a contrary stand before the Court or any other forum. Learned senior counsel cites *PhonePe (P) Ltd. v. Resilient Innovations (P) Ltd.*, reported at *2023 SCC OnLine Bom 764*, for such proposition as well as *Parakh Vanijya (P) Ltd. v. Baroma Agro Product*, reported at *(2018) 16 SCC 632*, for the contention that if there is a specific disclaimer, there cannot be an exclusive claim in respect of the disclaimed word.

18. *Three-N-Products Private Limited v. Emami Limited*, reported at *2008 SCC OnLine Cal 589*, is cited by the appellant for the proposition that a proprietor cannot extract descriptive or common components from a composite registered mark to obtain exclusivity in the same. *Premlata v. Naseeb Bee*, reported at *(2022) 6 SCC 585*, is relied on to contend that a party cannot adopt an inconsistent position to obtain advantage after getting benefit earlier on a contrary stand.

19. *Raman Kwatra v. KEI Industries Ltd.*, reported at *2023 SCC OnLine Del 38*, is cited by the appellant for the proposition that an applicant for registration of a trade mark cannot approbate something before the Trade Mark Registry and reprobate the same in Court.

20. Learned senior counsel appearing for the appellant further cites *Sudarshan Seeds Pvt. Ltd. v. Vishal Krishi Products Pvt. Ltd.*, reported at *2017 SCC OnLine Cal 16310*, in support of the argument that a party is required to accurately disclose the precise mark which is registered for getting interlocutory protection.

21. In this context, learned senior counsel points out that although the plaintiff has taken the plea that there is an application pending for rectification of the recording of "Gold" as disclaimed, no order has still been passed thereon and, as such, the word still remains disclaimed on the records. Moreover, rectification has been sought only in respect of one mark whereas there are disclaimers in respect of the word "Gold" in at least six of the registrations.

22. Fourthly, the appellant argues that no case of passing off, which was the premise of the impugned order of injunction, has been made out by the plaintiff. The only common element between the plaintiff's product and the defendants' product is the word "Gold" which, in any event, is disclaimed by the plaintiff and is laudatory in nature and common to the trade.

23. Moreover, there is no visual similarity between the trade marks and trade dresses of the parties, which will be evident from a bare perusal of the said trade marks/trade dresses.

24. Subtracting the word "Gold", the plaintiff's product would read "Flake", whereas that of the defendants', "IJM" and "Stag". Moreover, the plaintiff's product has a red roundel device/medallion on white background, which is a part of a horizontal arrangement, whereas the defendants' trade dress is in prominent bold black letter across a vertical red ribbon and is not enclosed within any roundel similar to the plaintiff's trade dress.

25. Whereas the plaintiff's mark is in small block letters in conventional font, that of the defendants is in large, bold and stylised mixed-case letters. The accompanying expression of the plaintiff's products is "Honeydew Blend", whereas that of the defendants is "Premium Quality". The pre-dominant colour combination in the plaintiff's product is gold-brown as regards the mark and a horizontally arranged descriptor, whereas that of the defendants is pre-dominant yellow-gold, with a vertical red ribbon and a different arrangement of rectangular elements.

26. Lastly, on overall visual effect, the plaintiff's mark contains a roundel device in the major part of the design whereas there is no such roundel device at all in the defendants' mark.

27. Moreover, the plaintiff does not have any registration of the colour combination red and gold and therefore, cannot claim monopoly over the use of the same.

28. Learned senior counsel for the appellant next submits that the governing statute in the field is the Cigarettes and Other Tobacco Products (Prohibition of Advertisement and Regulation of Trade and Commerce, Production, Supply and Distribution) Act, 2003 (for short, "the COTPA"). As per the same, the majority of the mark on the packaging of cigarettes and other tobacco-related products (85%) has to contain a statutory image, which is found in all cigarette packets in India.

29. The learned Single Judge, it is argued, took into account the said mandatory 85% of the image, which is common to all cigarette brands, to find similarity between the two products, which amounts to perversity. For a proper assessment of whether the two marks are deceptively similar or identical, only the part of the trade mark/trade dress other than the said 85% statutory image was required to be taken into account, which was not done in the present case.

30. Learned senior counsel cites *ITC Limited v. Crescendo Tobacco Agency*, reported at *2011 SCC OnLine Cal 518*, for the proposition that in passing off and infringement actions, the overall presentation and likelihood of misrepresentation as to trade origin is required to be ascertained.

31. In *PhonePe (supra)*[1], it is submitted, it was also held that when the common portion of a mark is widely used, greater significance is to be attached to the uncommon portion. Learned senior counsel also relies on *Vikrant Chemico Industries (P) Ltd. v. Shri Gopal Engineering & Chemical Works (P) Ltd.*, reported at *2025 SCC OnLine Del 5562*, where it was held that in such actions, the overall get-up has to be cumulatively assessed. In *Pernod Ricard India (P) Ltd. v. Karanveer Singh Chhabra, 2025*, reported at *SCC OnLine SC 1701*, it was held a generic/laudatory word cannot be removed and taken separately from a composite setting in infringement/passing off actions.

32. The next contention of the appellants is that the plaintiff/respondent no. 1 does not have a subsisting copyright in its mark. It is the plaintiff's case that its label is historical, being in use since the year 1910. Under Section 22 of the CR Act, copyright subsists for 60 years from the death of the author. Here, no author has been identified and, as such, it is to be assumed that such copyright ceased after the passage of 60 years from the year 1910.

33. The copyright certification produced by the plaintiff is of the years 2010 and 2011. However, an expired copyright cannot be revived and a later

[1] ***PhonePe (P) Ltd. v. Resilient Innovations (P) Ltd.*, reported at *2023 SCC OnLine Bom 764***

adaptation/re-adaptation of an already expired copyright does not confer a fresh copyright in the historical features.

34. Learned senior counsel refers to the bar stipulated in Section 15(2) of the CR Act which provides that the copyright in any design which is capable of being registered under the Designs Act, 2000 but has not been so registered, shall cease as soon as any article in which the design has been reproduced more than fifty times by an industrial process by the owner of the copyright or, with his licence, by any other person.

35. Here, the claimed trade dress is covered by the Designs Act, 2000 but has not been registered under the said Act. Since the mark/dress is being used commercially since long, it has obviously exceeded the stipulated number of users within the contemplation of Section 15(2) of the CR Act. The plaintiff's case is also based on the design, which has been sold separately for consideration, thus attracting the bar indicated above.

36. Learned senior counsel cites *Tejpal Yadav v. State*, reported at *2015 SCC OnLine Del 13429* to argue that there cannot be any design contained in packaging.

37. On a John Doe Injunction granted by the learned Single Judge at the inception, special officers were appointed, who apparently found infringement in "some of the packs" of the defendant's products. Such packets were recovered in Punjab and the exact work alleged to have been copied has not been identified.

38. It is further argued that the registration application for copyright is to be accompanied by a certificate from the Registrar of Trade Marks, confirming that there is no identical or deceptively similar registered trade mark. Such requirement is a mandate of law, which is evident from a composite reading of Section 45(1) of the CR Act and Rule 70(6) of the Copyright Rules, 2013 (hereinafter referred to "the CR Rules"). There is not even any pleading as to compliance of the said requirement. Learned senior counsel cites *Mohd. Ershad v. Registrar of Copyrights*, reported at *2022 SCC OnLine Del 2815*, to argue that such compliance is mandatory.

39. In reply, learned senior counsel appearing for the plaintiff/respondent no. 1 argues that no objection as to non-compliance of Clause 14 of the Letters Patent was raised at any point of time before the learned Single Judge and issue cannot be raised for the first time in appeal. Clause 14, it is submitted, does not contemplate any "leave" but only a "notice". Non-compliance thereof does not pertain to inherent lack of jurisdiction. Moreover, the defendant no. 1/appellant also participated in the proceeding. Learned senior counsel cites *Union of India v. Central Administrative Tribunal, 2023*, reported at *SCC OnLine Mad 371*, and *Arvind Laboratories v. Hahnemann Laboratory (P) Ltd.*, reported at *2007 SCC OnLine Mad 1652*, in support of the above contention.

40. As opposed to the facts in *Hindustan Unilever Limited (supra)*[2], in the instant case, leave under Clause 14 of the Letters Patent has been expressly sought by the plaintiff and show cause was issued on the same, despite which the defendants have not shown any such cause. Thus, the said objection cannot be raised here, since the defendants waived such objection by actively participating in the interlocutory proceeding and opposing the injunction

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[2] ***Hindustan Unilever Limited v. Three Leaves India Pvt. Ltd.*, reported at *2016 SCC OnLine Cal 11151***

application. Even in the vacating application filed in the suit by the defendant no. 1/appellant, including on the passing off component of the matter, in support of which the appellant argued at length before the learned Single Judge, such objection was not raised.

41. As admitted by the appellant and also held in *Godfrey Phillips (India) Limited v. I.T.C. Limited*, reported at *2011 SCC OnLine Cal 1160*, leave under Clause 14 can be granted even at a subsequent stage.

42. Moreover, the reliefs sought in the suit are not restricted to passing off but also relate to infringement of the trade mark and trade dress of the plaintiff, which was also incorporated in prayers (c) and (e) of IP COM 12 of 2025, the injunction application.

43. It is next submitted that even the objection as to territorial jurisdiction under Clause 12 of the Letters Patent, which is to be taken at the earliest possible opportunity, was not raised before the learned Single Judge, nor is there any factual foundation of the appellant's contention that the plaintiff/respondent no. 1 has a subordinate office in Punjab. It is contended that Section 134(2) of the TM Act has a non obstante provision and the plaintiff admittedly has its registered office in Kolkata.

44. It is submitted that, by dint of Section 120 of the Code of Civil Procedure, 1908 (for short, "the Code"), the provisions of the Code, including Section 20 thereof, is not applicable in Original Side proceedings of this Court. Moreover, in view of the present action being in the nature of a *quia timet* action, real and credible apprehension of the impugned product being marketed in West Bengal, including Kolkata, would suffice to grant interim protection.

45. Next moving on to the question of whether any suit for infringement/passing off is maintainable against a registered proprietors/user, learned senior counsel for the appellant/respondent no. 1 contends that such a suit is very much maintainable within the scheme of Sections 28, 29, 30(32)(e), 31 and 124 of the TM Act. In support of such contention, learned senior counsel relies on *M/s. Apricot Foods Private Limited v. M/s. S. Narendra Kumar & Co.*, an unreported Division Bench Judgment of the Bombay High Court dated December 21, 2013, in *APPEAL (LODG) NO.378 OF 2013.*

46. Learned senior counsel takes the Court through the said provisions to elaborate such point. It is argued that Section 28(1) makes the said provision subject to other provisions of the Act and makes it applicable only if the trade mark is valid. There is no bar to preferring a challenge even against a purported registered proprietor if the defendant's trade mark is invalid, as contemplated in Section 28(3).

47. Under Section 30(2)(e), a trade mark cannot be said to be infringed if it is in the exercise of a right to use the same. In the present case, the defendants do not have a right to use the infringing trade mark and the said trade mark is palpably invalid.

48. Moreover, under Section 31 of the TM Act, registration is only prima facie evidence of validity of a trade mark and is not conclusive. Section 124, it is argued, provides for different situations where a suit for infringement or passing off by a registered user is to be stayed and, if no rectification proceedings are pending, three months' adjournment can be given after framing of issues only if the court is satisfied *prima facie* as to the invalidity objection being tenable, in order to enable rectification in the register.

49. It is argued that in the present case the trade mark of the alleged registered proprietor, defendant/respondent no. 4, is invalid and is wrongly on the register, which has been categorically pleaded in paragraph no. 35 of the plaint. The time for filing written statement lapsed on December 18, 2025, after 120 days from the service of summons, which time-limit is applicable to a commercial suit. An application for condonation of the delay in filing written statement is now pending but no order has been passed for condonation. Therefore, there is no written statement and/or defence under Section 30(2)(e) of the TM Act as of now. Under Section 124(5) of the TM Act, even if a stay is operative, it will not preclude from the court from passing interlocutory orders. The issue, it is submitted, is pending reference before a Larger Bench in *Abros Sports International (P) Ltd. v. Ashish Bansal*, reported at *2025 SCC OnLine Del 3410*.

50. It is submitted that all the aforesaid provisions clearly indicate that there is no absolute bar in maintaining a passing off/infringement action even against a registered proprietor/user.

51. Learned senior counsel next contends that a contradictory stand has been taken by the defendants. Whereas Section 28(3) of the TM Act has been relied on in the vacating application of the order of injunction in respect of infringement, no defence has been allowed under Section 29(1) and 29(4). Section 29(1) of the TM Act speaks of the plaintiff's registration and not that of the infringer.

52. Also, Section 2(1)(r)(ii)(c)of the TM Act contemplates "permitted use" by way of a written consent from the registered proprietor. In the present case, there was a purported consent from the defendant-respondent no. 4 of its mark and not the plaintiff's mark. Thus, Section 29(1) is not attracted.

53. Moreover, it is argued that the defendant no. 1/appellant is not the registered proprietor and cannot take a defence under Sections 28(3) and Section 30(2)(e). That apart, the defendant no. 1 in the present case has expressly abandoned such defence.

54. The learned Single Judge observed in the impugned order that the purported license agreements relied by the defendant no. 1/appellant from defendant/respondent no. 4 were invalid. From the documents produced by the defendants, it transpires that those were agreements for rent and were executed and authorised on July 29, 2022. The agreement was apparently for the period from April 1, 2021 to March 31, 2023, thus, pre-dating the execution of the same. In any event, admittedly there was no license between April 1, 2021 and July 29, 2022. However, the invoices produced by the appellant allege that the agreement/consent already existed.

55. Moreover, the infringing packets do not mention the defendant no. 4/alleged proprietor in such capacity. Rather, the expression "®" appears in the packets next to the name of the defendant no. 1/appellant, IAKA Global. Thus, a false impression is sought to be given that the appellant is the registered proprietor of the mark, which is contrary to his pleading.

56. Learned senior counsel further argues that the royalty payment documents relied on by the defendants, allegedly executed by the defendant no. 1/appellant in favour of the defendant/respondent no. 4, are fabricated. The vouchers are unsigned, unstamped and without any number, license fees for particular years being split into multiple vouchers of Rs.10,000/- or less each, to circumvent Section 40(A)(3) of the Income Tax Act, 1961, and the account heads in the vouchers shown as "Legal Expenses A/C", not royalty. Also, the vouchers are for the periods between 2022-23 and 2023-24 and not for 2021-22. The appellant contends that defendant/respondent no. 2 has been using IJM Gold Stag under permission from defendant/respondent no. 4, which is false. The document dated March 4, 2025 was executed after service of the suit papers and does not reflect any consideration for the permissions or reasons for abandonment of use. No document of permission to use by defendant/respondent no. 2, granted by defendant/respondent no. 4, since 2013 has been produced. Defendant/respondent no. 2 asserted its independent rights to the marks by filing applications of registration of the marks "IGPL Gold Stag" and "IGPL Gold Stag Super" in 2019, therefore belying its claim as a permissive user.

57. Moreover, the defendant/respondent no. 2 claimed to be the proprietor of the "Gold Stag" mark by independently applying for registration on December 23, 2016, December 23, 2018 and October 7, 2019. The mark of the defendant no. 4 was cited as objection by the Trade Mark Registry and defendant no. 2 gave out that it was different from its own mark. Defendant no. 1/appellant also claimed abandonment of the trade mark in its application for copyright registration, but applied for registration of similar trade marks even after obtaining copyright registration on July 18, 2019, that is on October 7, 2019.

58. No permission from the defendant no. 4 to defendant no. 2 has been disclosed and the defendant no. 2, itself being a licensee, could not have granted further license to the defendant no. 1/appellant.

59. Learned senior counsel for the plaintiff/respondent no. 1 further argues that there is no substantial evidence to establish the use of the trade mark "IJM Gold Stag" by defendant nos. 1 and 2. The documents pertaining to sale, produced by the defendants, are evidently fabricated, being undated, self-attested sales figure certificates without any relevant particulars, the sales being meagre. Thus, the defendant no. 1/appellant is a fly-by-night operator. Moreover, the invoices of the appellant are from March, 2021, pre-dating the alleged license from defendant no. 4. All the sales, as reflected from the said documents, are to a single entity, namely one Jagdambay Enterprise, allegedly a wholesale distributor. The invoices even pre-date the appellant's registration with the Tobacco Board dated July 19, 2021 and indicate stock transfers, not sales. One Mr. Deepak Kumar is the common thread between the defendants, being the proprietor of AA Enterprises as well as Director of defendant nos. 4, 7 and 9. All the invoices are apparently in his favour. He also signed the license agreement allegedly executed by defendant no. 4 in favour of defendant no. 1/appellant. Thus, there is no concrete proof of valid sales by the defendant no. 1/appellant.

60. Elaborating on the disclaimer of the term "Gold", it is argued that the said word is a pragmatic feature of the plaintiff's trade mark and has also acquired a secondary meaning in relation to the plaintiff. The said facts, it is argued, are borne out by different judgments of the Delhi High Court dated March 24, 2022, February 27, 2024 and March 13, 2024. In *Pernod Ricard India (supra)*[3], it was recognised that the Court may identify the prominent

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[3] ***Pernod Ricard India (P) Ltd. v. Karanveer Singh Chhabra, 2025***, **reported at** ***SCC OnLine SC 1701***

feature of a trade mark and even generic terms can be monopolised if those have acquired a secondary meaning in respect of the mark of a proprietor/user. The plaintiff's trade mark was registered prior to that of the defendant no. 4, that is on May 16, 2012. There has been open, continuous and extensive use of the term 'Gold' in its products by the plaintiff since the year 1905. The striking resemblance in get-up, lay out, colour combination, use of devices and placement of features between the products of the parties is palpable.

61. Hence, irrespective of the disclaimer, the word 'gold' is inextricably associated with the plaintiffs mark.

62. It was recognised in *ITC Limited v. Golden Tobacco Limited*, reported at *2018 SCC OnLine Mad 2437* by the Delhi High Court that the disclaimers on the term 'Gold' in respect of the plaintiff's trade mark registrations in the Trade Mark Registry were erroneous. The plaintiff has specifically written to the Registrar seeking correction of the same on February 24, 2020 and the concerned portal of the Trade Mark Registrar indicates that the status reports (which are relied on by the defendant no. 1/appellant) are "not for legal use". Moreover, the disclaimers have since been removed from the status page of the Trade Mark Registry website. Moreover, at least regarding three of the registered trade marks, there was no such disclaimer. By relying on *WOW MOMO Foods (P) Ltd. v. WOW Burger*, reported at *2025 SCC OnLine Del 6545*, it is argued that the disclaimer in respect of a particular mark cannot affect the other registered marks of the same proprietor. As to the similarity between the infringing mark and that of the plaintiff/respondent no. 1, it is argued that the appellant's contentions in that regard are misplaced. Since 85 per cent of the packaging is covered by the statutory health warning, only 15 per cent is reserved for the unique mark of a seller/user. With such limited place for the actual marks, confusion and deception is imminent when the marks are structurally similar and/or identical. In support of such contention, learned senior counsel for the respondent no. 1 cites *ITC Limited v. Golden Tobacco Limited (supra)*[4], ITC Ltd. v. Pelican Tobacco Co. Ltd., reported at 2025 SCC OnLine Del 8592 and ITC Limited vs Whole Leaf Tobacco Venture Pvt. Ltd And Others, reported at AIR 2019 Cal 215.

63. The respondent no. 1 next contends that the defendant no. 1/appellant is not a licensee of the copyright originally registered in the name of defendant no. 2. The registrations relied on by the defendant are *ex facie* invalid, being obtained by fraud and contrary to the CR Act and Rules. The date of the alleged first publication is 2013, whereas the graphical warning rule came into effect on and from April 1, 2016, that is, three years thereafter. The work bears the date of manufacture to be February, 2018. Moreover, no notice was given to the plaintiff, which is an "interested person" under Rule 70(9) of the CR Rules. Also, written licenses are required under Sections 30, 30A and 19 of the CR Act, which are absent in the present case.

64. The copyright license allegedly given by the defendant no. 2 to the defendant no. 1/appellant is fabricated. It is seen from the document produced by the appellant that there was an alleged oral agreement in 2021, without mentioning any exact date, and a letter issued in that regard was dated March 4, 2025, after filing of the suit. There is neither any particular in the

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[4] ***ITC Limited v. Golden Tobacco Limited, reported at 2018 SCC OnLine Mad 2437***

purported license of copyright furnished by the appellant, nor any signature on behalf of the appellant on the March 4, 2025 letter.

65. Insofar as the plaintiff's copyright registration is concerned, although the appellant argues that the same is invalid, such objection was never raised before the learned Single Judge, nor is there any such ground in the memorandum of the present appeal. If confronted with such objection at any earlier stage, the plaintiff could very well have produced the No-Objection Certificates from the artist and in the Trade Mark Registry which are available with the plaintiff. The artistic work of the plaintiff was also not challenged before the learned Single Judge. In any event, artistic quality is not required to be possessed by a work to come under Section 2(c)(i) of the CR Act.

66. The appellant argues that the plaintiff is not the 'author' of the artistic work under the CR Act, whereas the plaintiff/respondent no. 1 does not claim to be so at all. It claims ownership, and not authorship, of the copyright under Section 17(c) of the CR Act and the product labels were created under the instruction of and for the plaintiff.

67. The appellant's argument of expiry of the copyright after 60 years is also misplaced and such objection was not raised before the learned Single Judge. The plaintiff's later registrations of copyright are adaptions of its earlier artistic work under Section 14(c)(v) of the CR Act. Earlier, the star in the mark was inside the roundel whereas now it is outside the same. In any event, the artist Mr. Meet Jain is still alive whereas the 60 years' moratorium starts from the death of the author, thus, not applicable in the present case.

68. Under Section 2(d) of the Designs act, 2000, artistic designs are applicable to 'articles' under Section 2(a) which are capable of being made and sold separately. Cigarette packaging is not such an 'article', since it is sold only with cigarette/tobacco products.

69. The alleged difference in pricing of the products of the plaintiff and the defendant no. 1 respectively is not germane, since their products are sold from the same sales outlets and trading channels and to the same set of customers.

70. Lastly, the respondent no. 1 argues that the objection as to purported non-compliance of Order XXXIX Rule 3 of the Code was not pressed by the appellant during arguments. Even otherwise, the same could at best have vitiated the initial ex parte order of ad interim objection, which has since merged with the final order of temporary injunction which is impugned before this court, dated June 20, 2025.

71. Thus, the respondent no.1 seeks dismissal of the appeal.

72. From the arguments advanced by the parties, the following issues can be culled out for adjudication of the present appeal:

(i) Jurisdiction;

(ii) Suit for infringement against registered user – maintainability;

(iii) Whether the defendant no.1/appellant is entitled to claim right of user on the strength of the trade mark of the infringing product;

(iv) Whether the plaintiff/defendant no. 1 can assert rights on the word "Gold" in the trade mark "Gold Flake";

(v) Whether any case of passing off/infringement has been made out by the plaintiff on merits.

73. The above issues are dealt with as follows:

(i) ***<u>Jurisdiction</u>***

74. In order to ascertain whether the learned Single Judge had jurisdiction to entertain the suit, the interplay between Clauses 12 and 14 of the Letters Patent of this Court are to be looked into. The said Clauses are set out below:

> *"12. Original jurisdiction as to suits.—And We do further ordain, that the said High Court of Judicature at Fort William in Bengal, in the exercise of its ordinary original civil jurisdiction, shall be empowered to receive, try, and determine suits of every description, if, in the case of suits for land or other immoveable property, such land or property shall be situated, or in all other cases if the cause of action shall have arisen, either wholly, or, in case the leave of the Court shall have been first obtained, in part, within the local limits of the ordinary original jurisdiction commencement of the suit shall dwell, or carry on business, or personally work for gain within such limits; except that the said High Court shall not have such original jurisdiction in cases falling within the jurisdiction of the Small Cause Court at Calcutta, in which the debt or damage, or value of the property6 sued for, does not exceed One hundred rupees.*
>
> * * *
>
> *14. Joinder of several causes of action.—And We do further ordain, that where Plaintiff has several causes of action against a Defendant, such causes of action no being for land or other immovable property, and the said High Court shall have original jurisdiction in respect of one of such causes of action, it shall be lawful for the said High Court to call on the Defendant to show cause why the several causes of action should not be joined together in one suit, and to make such order for trial of the same as to the said High Court shall seem fit."*

75. From a bare perusal of the two provisions, it is evident that the two operate in somewhat separate fields. Whereas Clause 12 refers to the self-same cause of action, a part of which might have arisen beyond the local limits of the ordinary original jurisdiction of this Court, Clause 14 refers to several causes of action, one of which arises outside the jurisdiction of this Court.

76. Cause of action is comprised of a series of facts which entitle the Plaintiff to get the reliefs claimed in the suit and, as such, is inextricably linked with the reliefs sought.

77. In the present suit, both reliefs, infringement of registered trade marks and copyrights as well as passing off, have been sought. Thus, it is Clause 14 which is more applicable than Clause 12.

78. Insofar as Clause 12 is concerned, in Paragraph Nos. 36, 44, 45, 54, 56, 57 and 58 of the plaint, which are referred to in Paragraph No. 69 thereof, it has been mentioned categorically that a part of the cause of action has arisen within the jurisdiction of this Court. In Paragraph Nos. 71 and 71, the plaintiffs, on the basis of the plaint averments, expresses reasonable apprehension and uncertainty as to whether their trade marks/copyrights would be infringed or passed off within West Bengal, including Kolkata as well. Thus, there are sufficient pleadings in the plaint as to part of the cause of action having arisen within the territorial jurisdiction of this Court. At the stage of deciding an application for injunction, the Court is to look at the frame of the suit, as disclosed in the plaint. It is the frame of the suit which is the determinant and the context of deciding the question of jurisdiction as a component of *prima facie* case for grant of temporary injunction. The veracity of the pleadings can only be assessed conclusively during trial on evidence.

79. Insofar as leave under Clause 12 is concerned, we need not dwell much on the academics of the same in the facts of the instant case, since such leave was, in fact, granted by the learned Single Judge. In the Order dated February 5, 2025 passed in IP-COM 12 of 2025, the suit Court recorded that leave was granted under Order II Rule 2 of the Code. However, *vide* Order dated February 18, 2025 passed therein, the learned Single Judge corrected the Order dated February 5, 2025 to the effect that leave under Clause 12 of the Letters Patent, 1865 was granted by the said earlier order, whereas it was wrongly recorded as Order II Rule 2.

80. Thus, leave under Clause 12 having been granted at the inception, no objection as to jurisdiction can be raised on such ground.

81. Coming to Clause 14, we find a cardinal difference between the said provision and Clause 12. From a plain reading of the language of Clause 12, it is evident that in order to assume jurisdiction to take up suit where a part of the cause of action arises out of the territorial jurisdiction of this Court, "leave" shall have to be "obtained". Thus, a specific leave, that too before proceeding to entertain the suit, is envisaged under Clause 12. The language of Clause 12 is that such leave shall be necessary to empower the Court to "receive", try and determine suits of every description, thereby meaning that the leave has to be obtained even before receiving the suit formally.

82. On the other hand, Clause 14 envisages no such leave but merely a "show cause" to be issued, followed by an "order for trial" of the suit, in the event several causes of action, one of which lies outside the jurisdiction of this Court, are to be joined.

83. This principle was reiterated by the Madras High Court in *Arvind Laboratories (supra)*

84. Thus, a mere show cause would suffice under Clause 14, as opposed to a leave, followed by an order, that too for the purpose of trial of the suit and not to entertain or 'receive' it. Such order is not to "receive" the suit, as in Clause 12, but for "trial" of the suit. Hence, a show cause has to be issued and an order passed for joinder of several causes of action under Clause 14 at any point of time before the trial of the suit commences. As such, there cannot be any embargo on the Court entertaining the suit and passing interim orders at any point of time before trial commences, even without any order under Clause 14.

85. A Division Bench of this Court, in *Godfrey Phillips (supra)*, categorically held that leave under Clause 14 of the Letters Patent may be granted at a subsequent stage after filing of the suit.

86. In the facts of the present case, a show cause was actually issued under Clause 14, to which no reply was given by the defendant/appellant within the time stipulated in the order issuing show cause. Hence, the defendant/appellant has lost his right to oppose an order of joinder of the different causes of action for the purpose of trial. Clause 14, in the facts of the case, has been substantially complied with by the suit court.

87. We cannot lose sight of the fact that both Clauses 12 and 14 of the Letters Patent pertain to territorial jurisdiction of the court and not subject-matter jurisdiction, contrary to the submissions made by the appellant.

88. Under both the provisions, the thrust is on a part of the cause of action or one/some of the several causes of action arising outside the territorial jurisdiction of the court, thus, directly linking the issue of jurisdiction with territoriality.

89. It is well-settled that an objection as to territorial jurisdiction has to be taken at the earliest possible opportunity.

90. It is noteworthy that although the provisions of the Code of Civil Procedure are applicable by default to a suit instituted in the Original Side of this court, Section 120 of the Code specifically bars the applicability of Sections 16, 17 and 20 of the Code, which relate to jurisdiction, to such a suit. However, conspicuously, the operation of Section 21 of the Code, which mandates an objection as to territorial or pecuniary jurisdiction to be taken at the earliest possible opportunity, is not precluded to suits in the Original Side of this Court by Section 120 of the Code. Hence, an objection as to territorial jurisdiction has to be taken at the first instance, although the jurisdiction of the court is otherwise governed by the Clauses of the Letters Patent and not by Sections, 16, 17 and 20 of the Code. The defendant/appellant, however, has not taken any such objection before the suit court. Rather, he has waived his right to take such objection by choosing to abstain from giving any reply to the show cause issued under Clause 14 by the suit court.

91. In *Hindustan Unilever Limited (supra)*[5], leave was not taken either under Clause 12 or 14 of the Letters Patent. Moreover, there was lack of material documents and other grounds in the said case, which prompted the court to come to its conclusions, none of which are applicable to the present case. Hence, the proposition laid down therein is not attracted in the particular context of the case at hand.

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[5] ***Hindustan Unilever Limited v. Three Leaves India Pvt. Ltd.*, reported at *2016 SCC OnLine Cal 11151***

92. In *Asma Lateef (supra)*[6], it was held that the court is to affirm and record *prima facie* satisfaction as to maintainability of a suit in respect of a bar of law *if objection is raised by the person affected*. Here, no such objection was raised before the suit court but is being urged for the first time in the present appeal. Hence, the proposition laid down in *Asma Lateef (supra)*[6] is not attracted as well.

93. The next aspect of the matter on the question of jurisdiction is the effect of Section 134(2) of the TM Act and Section 62(2) of the CR Act, both of which are couched in similar language.

94. The said provisions, in unambiguous terms, provide that a suit for infringement of a registered trade mark or for passing off and/or for infringement of copyright can be instituted within the local limits of the District Court having jurisdiction at the time of institution of the suit, which includes the District Court having jurisdiction over the locality where the plaintiff or plaintiffs actually or voluntarily reside or carry on business or personally work for gain. It is an admitted position that the respondent no. 1-company has its registered head office in Kolkata, within the territorial jurisdiction of this court.

95. In *Indian Performing Rights Society Ltd. (supra)*[7], it was held that where the plaintiff's principal office and a part of the cause of action lie within the jurisdiction of a particular court, the suit has to be filed there, even if the plaintiff has a subordinate office elsewhere.

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[6] ***Asma Lateef and another v. Shabbir Ahmad and others***, reported at ***(2024) 4 SCC 696***

[7] ***Indian Performing Rights Society Ltd. v. Sanjay Dalia and another***, reported at ***(2015) 10 SCC 161***

96. In the present case, the exact reverse has been argued by the defendant, contending that the suit should have been filed in Punjab, where at least a part of the cause of action has arisen and the principal has a subordinate office, it being undisputed that the principal office of the plaintiff is situated at Kolkata. Thus, the proposition laid down in *Indian Performing Rights Society Ltd. (supra)*[8] is not squarely applicable to the present case. As opposed to the said case, the principal office of the plaintiff is situated in Kolkata, within the jurisdiction of this court; thus, squarely covered by Section 134(2) of the TM Act and Section 62(2) of the CR Act. Nothing has been brought on record to indicate that the plaintiff/respondent no. 1 has any subordinate office in Punjab at all.

97. Another distinguishing feature is that in *Indian Performing Rights Society Ltd. (supra)*[8], the Hon'ble Supreme Court relied on Section 20 of the Code of Civil Procedure to interpret the *non obstante* clause in question purposively, whereas, by operation of Section 120 of the Code, Section 20 is not applicable at all to suits in the Original Side of this court.

98. Insofar as *Ultra Home Construction Pvt. Ltd. (supra)*[9] is concerned, the said proposition was based on *Indian Performing Rights Society Ltd. (supra)*[8] and Section 20 of the Code and, hence, is also not applicable to the present case. With utmost respect, in *Ultra Home Construction Pvt. Ltd. (supra)*[9], the Delhi High Court somewhat misinterpreted the provision laid down in

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[8] ***Indian Performing Rights Society Ltd. v. Sanjay Dalia and another*, reported at *(2015) 10 SCC 161***

[9] ***Ultra Home Construction Pvt. Ltd. v. Purushottam Kumar Chaubey*, reported at *2016 SCC OnLine Del 376***

Indian Performing Rights Society Ltd. (supra)[10], where it was held that if the principal office and a part of the cause of action arises within the jurisdiction of a court, the suit has to be filed there, and not in a jurisdiction where an obscure subordinate office of the plaintiff is situated.

99. By necessary implication, such proposition would not be applicable to the present case, where the plaintiffs' principal office is situated within the territorial jurisdiction of this court and, as per the plaint, a part of the cause of action also arises herein. Rather, nothing has been produced to show that the plaintiff has any subordinate office in Punjab. The proposition laid down in *Indian Performing Rights Society Ltd. (supra)*[10] was turned on his head in *Ultra Home Construction Pvt. Ltd. (supra)*[11] by applying the ratio therein in a reverse factual matrix, despite the principal office of the plaintiff being situated elsewhere.

100. In such view of the matter, this court comes to the conclusion that the suit court had and has the jurisdiction to entertain the suit and to decide the same on merits.

(ii) <u>Suit for infringement against registered user – maintainability</u>

101. The scheme contained in Sections 28, 29 and 30 of the TM Act is to be considered to answer this question.

102. Under Section 30(2)(e), a registered trade mark is not infringed where the use of a registered trade mark, being one of two or more trade marks

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[10] ***Indian Performing Rights Society Ltd. v. Sanjay Dalia and another***, **reported at *(2015) 10 SCC 161***

[11] ***Ultra Home Construction Pvt. Ltd. v. Purushottam Kumar Chaubey***, **reported at *2016 SCC OnLine Del 376***

registered under the TM Act, which are identical or nearly resemble each other, is in exercise of the right to the use of that trade mark given by registration under the Act.

103. There is one important ingredient which is to be noted in the above provision. The bar therein applies only when the alleged infringer uses such trade mark "in exercise of the right to use of that trade mark *given by registration*". Thus, such bar applies only in cases of infringement of trade mark solely on the basis of registration, but does not cover passing off actions, which are registration-agnostic.

104. Again, Section 28(3) of the TM Act provides that 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, although 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 was the sole registered proprietor.

105. Section 28(1)(3), thus, carves out an exception to the infringement provided under Section 29 in general. Under Section 29(4)(a), 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 similar to the registered trade mark.

106. A conjoint reading of Section 30(2)(e) and Section 28(3) of the TM Act indicates a direct link between the infringement and the registration. Whereas the former provision refers to the right to use "given by registration", the latter speaks about right to use "merely by registration". Hence, the exception carved out in the said provisions both relate to infringement of a registered trade mark merely on the strength of such registration and do not apply to passing off actions, which are independent of registration.

107. Both Section 28(3) and Section 29(4) exclude from the purview of infringement "registered proprietors" and "registered users using by way of permitted use". Thus, under the said provisions, the proprietor/owner of a registered trade mark is debarred from claiming infringement against other registered proprietors and registered permitted users of identical or similar trade marks.

108. A close scrutiny of the context of usage of the said similar expression in both the provisions would reveal that the registered permitted users being referred to therein are not users of the *infringing trade mark* but of the *trade mark which is alleged to be infringed*. Otherwise, there will be a confusion of ideas as per the language of the said Sections.

109. As a necessary corollary, registered permitted users of the *infringing trade mark* are not protected from legal action for infringement under any of the said provisions. It is obvious from the language of Section 29(4) of the TM Act that registered proprietors and permitted users are placed on the same footing insofar as protection from infringement action is concerned. Since a similar expression is used also in Section 28(3), the term "registered/permitted users", as used in Section 28(3), must draw its hue from Section 29(4) in view of the identity of the phrase and ought to be construed to refer to registered/permitted users of the infringed trade mark itself, and not to registered/permitted users of the infringing (identical/similar) mark.

110. Thus, even an infringement action is maintainable against a registered permitted user of an infringing trade mark, if such permission is given by the infringer, although the proprietor of the similar or deceptive infringing trade mark is protected under Section 28(3). Thus, the protection under Section 28(3) covers only registered proprietors/owners of the similar or identical infringing trade mark and not permitted users of such mark.

111. Accordingly, the following moot concepts emerge from a conjoint reading of Sections 28 to 30 of the TM Act :

(i) No infringement can be claimed against the proprietor of a registered trade mark which is identical with or nearly resembles the 'infringed' trade mark;

(ii) No such claim can be made against a registered permitted user of the infringed trade mark;

(iii) Infringement can be claimed against the registered permitted user claiming under the proprietor of an identical or merely similar trademark; and

(iv) A passing off action is maintainable universally, including against registered proprietors and permitted users of an identical or deceptively similar trade mark.

112. It is also to be noted here that Section 124 of the TM Act circumscribes the algorithm created by Sections 28 to 30. The said Section is quoted hereinbelow:

"***124. Stay of proceedings where the validity of registration of the trade mark is questioned, etc.****—(1) Where in any suit for infringement of a trade mark—*

(a) the defendant pleads that registration of the plaintiff's trade mark is invalid;

(b) the defendant raises a defence under clause (e) of sub-section (2) of section 30 and the plaintiff pleads the invalidity of registration of the defendant's trade mark,

the court trying the suit (hereinafter referred to as the court), shall,—

(i) If any proceedings for rectification of the register in relation to the plaintiff's or defendant's trade mark are pending before the Registrar of the High Court, stay the suit pending the final disposal of such proceedings;

(ii) if no such proceedings are pending and the court is satisfied that the plea regarding the invalidity of the registration of the plaintiff's or defendant's trade mark is prima facie *tenable, raise an issue regarding the same and adjourn the case for a period of three months from the date of the framing of the issue in order to enable the party concerned to apply to the High Court for rectification of the register.*

(2) If the party concerned proves the court that he has made any such application as is referred to in clause (b)(ii) of sub-section (1) within the time specified therein or within such extended time as the court may for sufficient cause allow, the trail of the suit shall stand stayed until the final disposal of the rectification proceedings.

(3) If no such application as aforesaid has been made within the time so specified or within such extended time as the court may allow, the issue as to the validity of the registration of the trade mark concerned shall be deemed to have been abandoned and the court shall proceed with the suit in regard to the other issues in the case.

(4) The final order made in any rectification proceedings referred to in sub-section (1) or sub-section (2) shall be binding upon the parties and the court shall dispose of the suit conformably to such order in so far as it relates to the issue as to the validity of the registration of the trade mark.

(5) The stay of a suit for the infringement of a trade mark under this section shall not preclude the court from making any interlocutory order (including any order granting an injunction directing account to be kept, appointing a receiver or attaching any property), during the period of the stay of the suit."

113. Thus, Section 124 implicitly recognises the maintainability of a suit for infringement of a trade mark universally, without distinguishing between registered proprietors of an identical and nearly resembling trade marks and others. Under sub-section (1) of Section 124, such a suit is maintainable when the defendant pleads that the plaintiff's trade mark is invalid or the defendant raises a defence under Section 30(2)(e) and the plaintiff pleads the invalidity of registration of the defendant's trade mark.

114. Under Section 124 (1)(b), even if a plea of the defendant being the proprietor of an identical or similar trade mark is taken under Section 28(3) or 30(2)(e), the suit will be maintainable if the plaintiff pleads the invalidity of registration of the defendant's trade mark.

115. In such cases, it is further provided that the court shall stay the suit pending final disposal of any subsisting rectification proceeding or adjourn the case for three months from the date of framing of the issues to enable the concerned party to apply to the High Court for rectification of the register.

116. The subsequent sub-sections of Section 124, from (2) to (4), provide for the course of action to be taken by the court in such situations. Under sub-section (5) of Section 124, it is categorically provided that the stay of a suit for infringement of trade mark under the said section *shall not preclude the court from making any interlocutory order* (including an order granting an injunction directing account to be kept, appointing a receiver on attaching any property), *during the period of the stay of a suit.* Hence, even if a competing registration is claimed in respect of the alleged infringing trade mark of the defendant, not only the institution of the suit but also the grant of interlocutory protective orders is permitted under Section 124.

117. Read in conjunction, Sections 28 to 30 on the one hand and Section 124 of the TM Act on the other, although providing a bar against claim of infringement against a registered proprietor of an identical or similar trade mark, permit such claim to be made the subject-matter of a suit and, if a *prima facie* case is made out, even to grant interim protection in such a suit.

118. In the facts of the present case, the temporary injunction application was heard in the presence of both the parties. In Paragraph 23 of the plaint, it is alleged that the defendant no. 1/appellant is not a registered user of the offending trade mark "IJM Gold Stag". Again, in Paragraph no. 26, it is pleaded that there is no such product in the name of defendant/respondent no. 2.

119. In Paragraph no. 47 of the plaint, it is averred that although the defendant/respondent no. 4 has a registration in respect of the offending product, but there is no proof of any product being in the market in the name of defendant/respondent no. 4 under the offending trade mark. It is further pleaded categorically that registration in the name of defendant/respondent no. 4 was wrongly granted.

120. Thus, the pleadings in the plaint and the injunction application, read with the averments of the written objection filed by the defendant no. 1/appellant, squarely brings the matter within the purview of Section 124 (1)(b), thus rendering the suit maintainable.

121. Under sub-section (5) of Section 124, there is no bar to the court granting an interlocutory protection as well. The proper course of action for the suit court would be, at best, to await the outcome of rectification application, if any pending, and/or adjourn the hearing of the suit for three months from the date of framing of issues to enable the party concerned to apply to this Court for rectification of the register. However, in the present appeal, which is against a temporary injunction order before framing of issues, the said question does not arise at all.

122. Hence, while deciding this question, we conclude as follows:

(a) Section 28 to 30 of the TM Act, *per se*, do not operate as a bar to filing of a suit or grant of interlocutory order therein but merely debar a claim to the exclusive right of one registered proprietor against another in respect of identical or nearly similar trade marks, subject to the circumstances mentioned under Section 124 of the said Act. Rather, Section 124 recognises the right to file a suit even against a proprietor of a deceptively similar or identical trade mark, which is registered, if the validity of such registration is disputed. The question of whether both the proprietors have duly registered trade marks, thus attracting the bar under Sections 28 to 30, is to be considered only upon trial on evidence.

(b) At best, if a dispute is raised in the suit in that regard, the court will either grant a stay, if a rectification application is pending, or adjourn the suit for three months for framing of issues in order to enable the issue to be resolved.

123. The appellant cites *S. Syed Mohideen (supra)*[12], where the Hon'ble Supreme Court was dealing with an appeal arising out of the final disposal of a suit, where evidence was fully adduced by the parties, as opposed to the stage of interlocutory injunction, as in the present case.

124. Secondly, Paragraph no. 17 of the said judgment indicates that in the said case, the action was in respect of a valid registration of the defendant and the court proceeded on the premise of such validity, as opposed to the present case, where the plaintiff has categorically disputed the validity of the registration of respondent no. 4 and disputed outright that the other respondents have any right to use the offending trade mark.

125. Thirdly, in Paragraph no. 28 of the said report, it is recognised by the Hon'ble Supreme Court that the bar in respect of a competing similar registered trade mark was only in the context of Section 28 of the TM Act, without reference to the other provisions of the Act.

126. In paragraph no. 33.2 of the said report, the Hon'ble Supreme Court held that in case of a conflict between two registered proprietors, the better and superior rights in common law, on the strength of open, extensive and pervasive prior user, is to be evaluated. In the said case, injunction was, in fact, granted on the premise of such extensive and continuous prior user, in the process observing that registration was merely a recognition of the rights pre-existing in common law.

127. Hence, even as per *S. Syed Mohideen (supra)*[12], registration itself is not the sole basis of the rights for an infringement or passing off action but is merely a recognition of the pre-existing rights in common law. The Court,

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[12] ***S. Syed Mohideen v. P. Sulochana Bai***, **reported at *(2016) 2 SCC 683***

thus, has to ascertain even in case of competing registered trade marks as to which one of the competing marks is backed by superior right of user.

128. In *M/s. Vaidya Rishi India Private Limited (supra)*[13], the Hon'ble Supreme Court primarily relied on *S. Syed Mohideen (supra)*[18]. However, with due respect, the effect of Paragraph no. 33.2 of the *S. Syed Mohideen* judgment was somewhat misconstrued in *M/s. Vaidya Rishi India Private Limited (supra)* by holding that the Hon'ble Supreme Court had merely held that there was no bar in a passing off action. However, in the relevant paragraphs, as discussed above, the Hon'ble Supreme Court did not confine its examination merely to passing off but categorically observed that registration was merely the recognition of a pre-existing common law right and, even in case of a conflict between two registered proprietors, chose to grant injunction in favour of the prior common and pervasive user on the strength of such common law right of the prior user, despite the adversary having a registered trade mark as well. Moreover, in Paragraph no. 19.13 of *M/s. Vaidya Rishi India Private Limited (supra)*[13], the Delhi High Court recognised that the Hon'ble Supreme Court, in *S. Syed Mohideen (supra)*[14], did not consider Section 124 of the TM Act but nonetheless, went on to observe that it made no difference, which, in view of our earlier discussion, does not appear to be the correct position of law.

129. This question, thus, is decided in favour of the plaintiff/respondent no. 1, holding the suit to be maintainable, both for infringement and/or passing off.

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[13] ***M/s. Vaidya Rishi India Private Limited & Anr. v. Suresh Dutt Parashar & Ors.*** **dated August 7, 2025, passed in** ***FAO (COMM) 122/2024***

[14] ***S. Syed Mohideen v. P. Sulochana Bai*****, reported at** ***(2016) 2 SCC 683***

(iii) ***Whether the defendant no.1/appellant is entitled to claim right of user on the strength of the trade mark of the infringing product***

130. The defendant no. 1/appellant claims right of user in the alleged infringing trade mark on the strength of written permission granted by the registered proprietor thereof. However, no document substantiating such registration has been brought before the court. Hence, the requirement under Section 48 of the TM Act is not satisfied as such.

131. Again, under Section 49(1)(a) of the TM Act, in order to have a valid right of user, it is mandatory that there has to be an agreement between the registered proprietor and the user in writing. At least, a duly authenticated copy thereof is to be produced. Clause (b) of sub-section (1) of Section 49 requires an affidavit to be made with an application for registration of the right of user by the registered proprietor or by his authorised person to the satisfaction of the Registrar, giving particulars as enumerated therein, which has also not been brought before the court in the present case.

132. In the plaint, the plaintiff/respondent no. 1 has alleged that the so-called license agreements allegedly issued by defendant no. 4, the registered proprietor, in favour of defendant no. 1/appellant, are invalid. The first premise of such invalidity is that the amount payable under the agreement produced has been described as “rent”. However, benefit of doubt can be given in favour of the appellant to the extent that the terminology “rent” is a lose translation of the contents of the original document and the true purport of the expression “rent” might have been lost in translation. Also, the absence of any specific terminology in Indian languages for 'license fee', as opposed to 'rent', may be responsible for such description of the amount. Hence, *ipso facto*, such 'misdescription' does not *per se* render the agreement invalid.

133. The plaintiff/respondent no. 1 further alleges that the agreement produced by the appellant was executed on July 29, 2022 whereas the user has been claimed from April 1, 2021 to March 31, 2023 in the said document itself. Thus, admittedly, the appellant did not have permission of user of the trade mark during the period between April 1, 2021 and July 29, 2022, when the said agreement was actually executed. The TM Act does not recognise any retrospective agreement as such.

134. Another sticking point for the appellant is that the infringing packets, which were ceased by the Special Officers appointed by this court, used the sign "®" against the name of the sole proprietorship of defendant no. 1/appellant, thus giving the false impression that the said proprietorship concern of the appellant is the owner of the trade mark, which is contradictory to his claim that he is a registered *user*, as opposed to a registered *proprietor*. In the packets carrying the trade mark, it has not been claimed that defendant no. 4 (IJM Cigarette Company Private Limited) is the proprietor, which is contradictory to the defence case as made out in the written objection to the temporary injunction application filed in the suit court.

135. Thirdly, the plaintiff alleges that the royalty payment documents produced by the defendant no. 1/appellant are fabricated. We find such argument to be viable, in view of the vouchers being unsigned, unstamped and carrying no numbers. Moreover, the account head under which the payments have been mentioned in the vouchers produced by the appellant give out that the payments were on account of "legal expenses", and not royalty. Moreover, although the license had been claimed from 2021 to 2023, the vouchers are of the period 2022-23 to 2023-24. Thus no voucher has been produced for the period 2021-22.

136. That apart, a document dated March 4, 2025 has been produced by the defendant no.1/appellant to show permission from the defendant no. 4/proprietor of the registered trade mark "IJM Gold Stag", which document was prepared after the service of the summons of the suit and does not reflect any consideration having been paid for such permission and/or any reason for abandonment of user by the defendant no. 4.

137. Again, no document of permission of defendant no. 4 to defendant no. 2 since the year 2013, as claimed by the plaintiff, has been produced.

138. As per the allegation of the defendant no.1/appellant, the defendant no. 2 was the permitted user of the infringing trade mark under defendant no. 4. However, a palpable contradiction arises since the defendant no. 2 asserted its independent proprietary rights by filing registration application for the mark "IGPL Gold Stag" and "IGPL Gold Stag Super", in the year 2019. We further notice that the defendant no. 2 claimed proprietorship of 'IJM Gold Stag' by independently applying for registration in its own name on December 23, 2016, December 23, 2018 and October 7. 2019. In such applications, the mark of defendant no. 4 was cited by the Trade Mark Registry as an objection to the applications, to which the defendant no. 2 took a defence that its marks were different, thus belying the case made out in the present litigation as to the defendant no. 2 being a permissive user under defendant no. 4 and vitiating the claim made by the defendant no. 1/appellant that the defendant no. 2, itself a permitted user, granted right of user to the appellant.

139. The defendant no. 1 claimed abandonment of the infringing trade mark in its copyright registration application, but again applied on October 7, 2019 for registration of a similar trade mark, even after obtaining copyright registration on July 18, 2019.

140. Furthermore, no permission from the defendant no. 4 to the Defendant no. 2 has been disclosed. As such, the defendant no. 2 itself, claiming to be licensee, could not have granted further license to the defendant no. 1/appellant.

141. Moreover, no substantial evidence to establish the use of the trade mark 'IJM Gold Stag' by defendant no. 1 and 2 has been produced by way of any document to establish valid sales by them.

142. The plaintiffs/respondent no. 1 alleges that the defendant no. 1 is a fly-by-night operator and the documents regarding to its purported sale are fabricated, being undated, self-attested, sales figure certificates with no relevant particulars. All the sales depicted therein are of meagre amounts, being directed towards a single entity, one Jagdambay Enterprises, allegedly a wholesale distributor. The invoices furnished by the appellant pre-date its registration with Tobacco Board on July 19, 2021 and indicate stock transfers rather the sales.

143. One Dipak Kumar is the common thread between the defendants, being the proprietor of one AA Enterprises as well as the common Director of defendant nos. 4, 7 and 9. Although such fact, by itself, might not have been germane, but all the invoices furnished in the suit court by the appellant were in favour of such Dipak Kumar, who, surprisingly, also signed the purported license agreement between the defendant no. 4 and 1.

144. However, although the plaintiff further argues that the amount paid was split into the vouchers of Rs. 10,000/- or less each to circumvent Section 40(A)(3) of the Income Tax Act, 1961, such consideration, by itself, may not be germane for the present consideration, although it might have some relevance with regard to the alleged infraction of the said Act.

145. However, from the other points indicated above, a sufficiently strong arguable case has been made out as to whether the defendant no. 1/appellant and defendant no. 2, at all, have or had any valid right of permissive user. Again, the defendant no. 4 has not been shown to have ever exercised its proprietary rights in respect of the infringing trade mark. Thus, a sufficiently strong arguable case has been made out as to whether the defendant no. 1/appellant is at all be entitled to claim valid right of user on the strength of the trade mark of the allegedly infringing product.

146. Thus, this issue is also held against the appellant.

(iv) Whether the plaintiff/defendant no. 1 can assert rights on the word "Gold" in the trade mark "Gold Flake"

147. The appellant has heavily relied on the disclaimer of the word 'Gold' by the plaintiff/respondent no. 1 in its applications for registration of the trade mark 'Gold Flake' as a whole.

148. In *PhonePe (supra)*[15], it was held by the Bombay High Court that if a person disclaims the right to a particular word of a trade mark before the Registry, it cannot do a *volte face* and claim the same right in court, being debarred by "prosecution history estoppel". Again, in *Parakh Vanijya (P) Ltd. (supra)*[16], the Hon'ble Supreme Court recognised the principle that the proprietor cannot have an exclusive claim to a disclaimed word in a trade mark. A similar proposition was reiterated in *Premlata (supra)*[17] and *Raman Kwatra (supra)*[18], where the Hon'ble Supreme Court and the Delhi High Court respectively held that a proprietor cannot approbate and reprobate at the same time in respect of components in a trade mark.

149. The above proposition is well-settled, but is not conclusive enough to cover every aspect of the plaintiff's claim in the present case. The first distinguishing feature is that in the present case, disclaimer is reflected from the official website of the Trade Mark Registry portal only in respect of one of the trade marks, whereas there are at least three other trade marks of similar nature which do not contain any such disclaimer. In *WOW MOMO Foods (P) Ltd. (supra)*[19] the Delhi High Court categorically held that the disclaimer in respect of one registration cannot affect others, which is a settled proposition of law. Hence, in any event, most of the trade marks under the name 'Gold Flake' fall outside the purview of the disclaimer.

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[15] ***PhonePe (P) Ltd. v. Resilient Innovations (P) Ltd.***, reported at ***2023 SCC OnLine Bom 764***
[16] ***Parakh Vanijya (P) Ltd. v. Baroma Agro Product***, reported at ***(2018) 16 SCC 632***
[17] ***Premlata v. Naseeb Bee***, reported at ***(2022) 6 SCC 585***
[18] ***Raman Kwatra v. KEI Industries Ltd.***, reported at ***2023 SCC OnLine Del 38***
[19] ***WOW MOMO Foods (P) Ltd. v. WOW Burger***, reported at ***2025 SCC OnLine Del 6545***

150. Even in respect of the alleged disclaimer, the plaintiff claims that an application has been filed for correction of such recording in the portal, on February 24, 2020.

151. The Trade Mark Registration Portal merely depicts a status report showing the disclaimer which is qualified with the expression "not for legal use". The plaintiff also alleges that the disclaimer has subsequently been removed from the portal. In *ITC Limited v. Golden Tobacco Limited (supra)*[20], the Madras High Court recognised that such disclaimer recording was erroneous.

152. Looking at the matter from the perspective of Section 124 of the TM Act, even with regard to the alleged disclaimed trade mark, the court has to wait for the outcome of the rectification application and final decision of the suit will be subject to the said outcome. Thus, such question can only be conclusively decided, even with regard to the sole disclaimer, at the final hearing of the suit or, at least, till the correction application is finally decided.

153. Even otherwise, if any stay/adjournment is granted in respect of the suit, it does not debar any interlocutory order from being passed in favour of the plaintiff, as per Section 124(5) of the TM Act. As such, it would be premature at the injunction stage to apply the ratio laid down in the judgments relied on by the appellant, as discussed above.

154. From a different perspective, even if we proceed on the premise that a disclaimer has been recorded and no exclusive registration has been separately sought by the plaintiff in respect of the word "Gold", a question

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[20] ***ITC Limited v. Golden Tobacco Limited, reported at 2018 SCC OnLine Mad 2437***

arises as to whether a descriptive or common component can be extracted from a composite trade mark on the ground of the same having acquired "secondary meaning" in respect of the plaintiff.

155. In *Three-N-Products Private Limited (supra)*[21], it was observed by this court that a descriptive/common component cannot be extracted from a composite registered mark to obtain exclusivity. In *Sudarshan Seeds Pvt. Ltd. (supra)*[22], it was observed that a party has to accurately disclose the precise marks which are registered to get interlocutory protection.

156. However, even going by the said proposition, in *Pernod Ricard India (supra)*[23], the Hon'ble Supreme Court held that the court may identify the 'prominent feature' of a trade mark and even a generic term can be monopolised if it has acquired a secondary meaning in respect of the plaintiff.

157. Different High Courts of the country, in multiple judgments/orders, have recognised that the plaintiff/ITC has acquired secondary meaning in the word "Gold" due to open, continuous and extensive use since the year 1905. Such cases are listed below:

I. *ITC Limited v. Tapisserie Lifestyle Private Limited & Another, Hon'ble Delhi High Court order dated March 24, 2022, CS(COMM) 667/2021 [Gold Flake v. Hash Gold];*

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[21] ***Three-N-Products Private Limited v. Emami Limited, reported at 2008 SCC OnLine Cal 589***
[22] ***Sudarshan Seeds Pvt. Ltd. v. Vishal Krishi Products Pvt. Ltd., reported at 2017 SCC OnLine Cal 16310***
[23] ***Pernod Ricard India (P) Ltd. v. Karanveer Singh Chhabra, 2025*, reported at *SCC OnLine SC 1701***

II. *ITC Limited v. Golden Tobie Private Limtied and Others, Hon'ble Delhi High Court order dated, February, 27, 2024, CS(COMM) 331/2022 [Gold Flake v. Gold Magic, Gold Touch, Gold Strike];*

III. *ITC Ltd. v. Pelican Tobacco Co. Ltd. (supra)*[24]*;*

IV. *ITC Limited v. Whole Leaf Tobacco Venture Pvt. Ltd (supra)*[25]*;*

V. *ITC Limited v. NTC Industries Limited, reported at 2015 SCC OnLine Bom 4976 [Gold Flake v. National Gold Flake];*

VI. *ITC Limited v. Gold Step Tobacco Private Limited & Ors., CS(COMM) No. 146/2023 (Hon'ble Delhi High Court Order dated March 14, 2023) [Gold Flake v. Gold Vimal];*

VII. *ITC Limited v. DAV Industries LLP, CS(COM) No. 60/2024 (Hon'ble Delhi High Court order dated January 22, 2024) [Gold Flake v. Gold Frost, Gold Fun];*

VIII. *ITC Limited v. Gold Step Tobacco Private Limited & Ors., CS(COMM) No. 124/2024 (Hon'ble Delhi High Court order dated February 8, 2024) [Gold Flake v. Gold Step];*

IX. *ITC Limited v. STC Tobacco Pvt. Ltd. & Ors., CS(COMM) No. 182/2024 (Hon'ble Delhi High Court order dated February 29, 2024) [Gold Flake v. Gold Falcon, Gold Flicker];*

X. *ITC Limited v. Elora Tobacco Company Ltd. & Ors., CS(COMM) 201/2024 (Hon'ble Delhi High Court order dated March 7, 2024) [Gold Flake v. Gold Impact].*

158. Acquisition of such secondary meaning has also been pleaded in the plaint.

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[24] ***ITC Ltd. v. Pelican Tobacco Co. Ltd., reported at 2025 SCC OnLine Del 8592***

[25] ***ITC Limited vs Whole Leaf Tobacco Venture Pvt. Ltd And Others, reported at AIR 2019 Cal 215***

159. Insofar as the 'artistic work' claimed for the purpose of copyright in the plaintiffs mark is concerned, although the appellant has contended that an artistic mark prevailing since 1905 cannot be revived after it expired post-efflux of 60 years, the plaintiff cites Section 14(c)(v) of the CR Act to argue that the present marks are adaptations of the earlier artistic work, which is permissible in law. In respect of the present artwork, one Meet Jain, it is argued by the plaintiff, who is the author of the artistic work, is still alive and, as such, the copyright subsists, as the moratorium of 60 years commences only from the demise of the author.

160. It is validly argued by the plaintiff/respondent no. 1 that the said issue was never raised by the respondent no. 1/plaintiff before the suit court, in which case the plaintiff could very well have controverted such contention by citing the above facts.

161. We agree with such argument of the plaintiff, since the said issue cannot be raised for the first time before this court, sitting in appeal, particularly in view of the defendant no. 1/appellant having got ample opportunity of arguments in respect of the temporary injunction application and having contested the same tooth and nail by filing written objection.

162. It may be noted here that the argument as to the artistic design attracting the provisions of the Designs act, 2000 is not necessary to be gone into in view of the above discussions, more so since Section 2(d) of the 2000 Act specifies 'articles' to be capable of being made and sold separately. Cigarette packaging, as contended by the respondent no. 1, is not such an article but is only a part of cigarette/tobacco products and their packaging and is not sold independently.

163. Hence, The plaintiff/respondent no.1 has made out a *prima facie* case for claiming that the word "Gold" has acquired a secondary meaning in respect of its products, and, thus, is an integral component of its trade mark.

(v) ***Whether any case of passing off/infringement has been made out by the plaintiff on merits***

164. Insofar as the merits of the injunction application are concerned, the appellant's argument as to difference of pricing of the products of the plaintiff and the defendant no. 1 does not hold water, since such difference, even if any, loses relevance in the reality of the market-place where, it is often the practice that the retailers compromise a part of their profit-margin to sell cigarettes at a lower price than available before other retailers. A common purchaser, in usual course of affairs, might not bank much on such difference of pricing to scrutinize the distinction between the two products. Rather, such less pricing of the products of the defendants might aggravate the deception, since the propensity of the customer would be more in favour of leaning towards the less-priced packet, if deceptively similar to a product already established in the market.

165. The appellant heavily relies on the COTPA, 2003 to argue that 85% of the allegedly infringing trade mark comprises of a statutory image, which is common for all products, including that of the plaintiff and, thus, a comparison should be made only between the rest 15% of the mark of the parties respectively.

166. Even going by the principle laid down in *ITC Limited v. Crescendo Tobacco Agency (supra)*[26] and *Vikrant Chemico Industries (P) Ltd. (supra)*[27], we have to see the overall presentation and likelihood of misrepresentation in cases of infringement and passing off.

167. With a limited space of only 15% left for placement of the actual mark, after making way for the statutory image which covers 85% of the pictorial, the possibility of confusion and deception is all the more accentuated and there may be confusion in the mind of the common buyer even if there is slightest similarity between the marks.

168. In the event the trade mark itself is comprised of the entirety of the packet, it would be far easier for the customer to distinguish between it and a different mark. However, by limiting the mark to a miniscule portion of the image, the chance of distinguishing it from a deceptively similar mark is considerably reduced; thus, the overall impression given to the customer in reality, taking a pragmatic viewpoint, has to include the 85% statutory image as well. When a purchaser buys a cigarette packet, it is the total picture (including the statutory image) which he sees in its entirety, and no normal person would separately scrutinize the actual mark. Such proposition finds support in the judgments of *ITC Limited v. Golden Tobacco Limited (supra)*[28], *ITC Ltd. v. Pelican Tobacco Co. Ltd. (supra)*[29] and *ITC Limited vs Whole Leaf Tobacco Venture Pvt. Ltd (supra)*[30].

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[26] ***ITC Limited v. Crescendo Tobacco Agency, reported at 2011 SCC OnLine Cal 518***
[27] ***Vikrant Chemico Industries (P) Ltd. v. Shri Gopal Engineering & Chemical Works (P) Ltd., reported at 2025 SCC OnLine Del 5562***
[28] ***ITC Limited v. Golden Tobacco Limited, reported at 2018 SCC OnLine Mad 2437***
[29] ***ITC Ltd. v. Pelican Tobacco Co. Ltd., reported at 2025 SCC OnLine Del 8592***
[30] ***ITC Limited vs Whole Leaf Tobacco Venture Pvt. Ltd And Others, reported at AIR 2019 Cal 215***

169. The test in a passing off or infringement action is that of a "common man", who goes to the market without having a photographic memory of the exact mark of the product intended to be purchased. Apart from the fact that much of the population is colour-blind to different degrees, there may be sufficient confusion, even for a person capable of distinguishing colours, between the yellow and gold marks respectively of the products of the defendant no. 1/appellant and the plaintiffs/respondent no. 1, more so, if combined with some shade of red and carrying the word "Gold", limited to 15% of the total mark.

170. The very nature of the product sold under the trade marks-in-question, which is widely consumed in India, defines the section of the populace which buys the same, which is quite universal, cutting across all strata of society. The economic theory of Veblen Effect or "conspicuous consumption" is not applicable to such a common product and it is not expected that the buyer will necessarily be so discerning as to scrutinize and subtly distinguish between the shapes of the devices or the background of the mark. Hence, the distinction between the oval shape of the roundel device of the plaintiff's product and a rather linear background of the defendants' product loses relevance at the ground-level when a purchaser actually goes to the market to buy such a product. Even otherwise, the so-called "discerning" buyers do not always purchase the products by themselves but get it through their agents, who might not, in turn, be discerning enough to distinguish between the two products.

171. On a visual comparison of the trade marks as well, we find sufficient similarity between them. Thus, we do not find any illegality on the part of the learned Single Judge which can amount to perversity or a gross error, in coming to the conclusion that there is every chance of deception and confusion in the mind of the purchaser between the marks of the appellant and the respondent no. 1. The learned Trial Judge came to one of the plausible conclusions and it is not for the appellate court to substitute its own view for that of the learned Trial Judge simply because such view is also plausible. For interference in an appeal, there has to be an error of law or fact, which we fail to find in the present case.

172. Hence, we come to the conclusion that sufficient triable issues have been raised by the plaintiff to be entitled to temporary injunction as granted by the learned Single Judge.

173. Having held in favour of maintainability of the suit, we also have to consider that the appellant has two further threshold hurdles to overcome.

174. First, the consideration in the instant appeal is confined to the preliminary stage of grant of injunction, where a *prima facie* case, on the strength of triable issues, is to be made out. Unlike most of the judgments cited by the appellant, neither this Court nor the learned Single Judge are deciding the suit or a connected appeal finally, upon trial on evidence, where the findings would have a conclusive texture. For the purpose of a *prima facie* case, sufficiently arguable issues have been raised by the plaintiff/respondent no. 1 in the instant case, justifying the grant of injunction.

175. Secondly, in an intra-court appeal, between two Benches of different strengths of the same High Court, the appellate Bench has to be doubly cautious. In the present instance, the learned Single Judge took one of the plausible views on the materials him and we do not find any illegality, let alone perversity, to justify interference with the same.

176. Thus, the high tests for interference governing an intra-court Letters Patent appeal have not been satisfied by the appellant in the instant case.

177. Hence, the appellant fails to cross both the aforesaid preliminary tests.

178. In fine, we find no merits in the appeal in view of the above findings, since a sufficient *prima facie* case of infringement and passing off has been made out by the plaintiff. The other tests of grant of temporary injunction are also satisfied in the light of the materials and pleadings before the learned Single Judge.

179. Insofar as the cross-objection filed by the respondent no. 1 is concerned, we do not find any merits in the same. By the impugned order, the learned Single Judge passed orders in terms of prayers (b), (c), (d), (e), (f), (g) and (h) of the notice of motion in GA 1 of 2025. Prayers (c) and (e) categorically cover infringement of the plaintiffs' rights in its registered trade marks. Thus, the very premise of the cross-objection, that similar protection ought to have been given as passing off in respect of infringement as well, is misplaced. The learned Single Judge, by the impugned order, has granted ample protection with regard to not only passing off but infringement of the plaintiff's trade mark and trade dress as well. Thus, there is no substance in the cross-objection.

CONCLUSION

180. Accordingly, TEMPAPO-IPD No. 6 of 2025 is dismissed on contest, thereby affirming the impugned judgment and order dated February 6, 2025, passed in IA: GA-COM 1 of 2025 with IP-COM 12 of 2025.

181. Consequentially, GA-COM 2 of 2026 is also disposed of.

182. OCOT No. 7 of 2025 is also dismissed on contest.

183. There will be no order as to costs.

184. Urgent Photostat certified copies of this judgment, if applied for, be supplied to the parties upon compliance of all formalities.

(Sabyasachi Bhattacharyya, J.)

I agree.

(Supratim Bhattacharya, J.)