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\* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

+ CS(COMM) 146/2023

ITC LIMITED

..... Plaintiff

Through: Mr. Rajshekhar Rao, Sr.  
Advocate with Mr. Afzal B. Khan, Mr.  
Vishal Nagpal and Ms. Suhrita Majumdar,  
Adv.

versus

GOLDSTEP TOBACCO  
PRIVATE LIMITED & ORS.

..... Defendants

Through:

**CORAM:**

**HON'BLE MR. JUSTICE C.HARI SHANKAR**

**ORDER**

**14.03.2023**

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1. The plaintiff alleges infringement and passing off, by the defendants, of its products as those of the plaintiff. It is alleged that, by adopting the name GOLD VIMAL and employing a logo which is deceptively similar to the registered trademark of the plaintiff, the defendants have infringed the plaintiff's registered trademark within the meaning of Section 29 of the Trade Marks Act, 1999 and have also passed off their products as those of the plaintiff.

2. For the purposes of the present order, it is not necessary to enter into the details of the facts set out in the plaint. Suffice it to state that the plaintiff, in the present plaint, asserting its mark GOLD FLAKE, whereunder the plaintiff has been manufacturing and selling cigarettes for over a hundred years. It is claimed in the plaint that the mark GOLD FLAKE has become iconic in consumer consciousness. Para




11 of the plaint sets out the turnover of the plaintiff in the past ten years, from sales of the GOLD FLAKE brand of cigarettes. In the year 2021-2022 alone, the turnover is to the tune of ₹29,671 crores.

3. The plaintiff holds, *inter alia*, the following registrations under the Trade Mark Act:

SI. No.	Application Date	Application No.	Trade Mark
1.	06-05-1997	755715	
2.	06-05-1997	755717	
3.	14-08-2012	2379737	
4.	23-05-2012	2336485	
5.	04-04-2013	2507491	GOLD FLAKE SUPER STAR
6.	16-02-2015	2903525	
7.	27-07-2016	3320942	



8.	07-07-2017	3587126	
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4. In respect of its SUPER STAR variants, the plaintiff possesses the following registrations:

Trade Mark	Application No.	Application Date	Status
WILLS SUPERSTAR	326310	20/06/1977	Registered
	2373008	31/07/2012	Registered
	2373009	31/07/2012	Registered
	2373010	31/07/2012	Registered



	2379730	31/07/2012	Registered
	2379731	14/08/2012	Registered
	2379732	14/08/2012	Registered
GOLD FLAKE SUPER STAR	2507491	04/04/2013	Registered
	2903525	16/02/2015	Registered
	2903526	16/02/2015	Registered

5. The plaintiff also has the following copyright registrations in its favour under the Copyright Act:



Application Date	Registration No.	Artistic Work
26.04.2010	A-124191/2018	
26.04.2010	A-124187/2018	
10.11.2010	A-95699/2013	
18.07.2011	A-99121/2013	





6. The plaintiff further submits that the STAR device also stands registered as a trade mark in the plaintiff's favour *vide* registration dated 12<sup>th</sup> June 1981.

7. The defendants, it is submitted, are manufacturing and selling cigarettes, *inter alia*, in Delhi under the name GOLD VIMAL using a logo and packaging which is deceptively similar to that of the plaintiff. The impugned label and impugned mark have been thus depicted in para 26 of the plaint:



Impugned Label-I	
Impugned Mark-I	GOLD VIMAL
 <p data-bbox="263 840 1013 869">“Manufactured by GOLD STEP TOBACCO PVT. LTD.”</p>	

8. Para 26(iv) of the plaint sets out the similarities between the trade dresses of the plaintiff and the defendants, thus:

Similarities in essential features	Packaging of the Infringing Product I	Plaintiff's GOLD FLAKE PREMIUM package
Overall look and get up of the front panel and manner of placement of individual elements		
Colour Scheme	Colour combination of red and gold	Colour combination of red and gold
Device	<ul style="list-style-type: none"> <li>• GOLD VIMAL in black font in the background of a red roundel</li> <li>• The GOLD VIMAL (Device) in golden letter.</li> <li>• Printing of Gold Vimal in</li> </ul>	<ul style="list-style-type: none"> <li>• GOLD FLAKE in black font in the background of a red roundel</li> <li>• The GOLD FLAKE written on golden background.</li> <li>• Printing of WD &amp; HO Wills,</li> </ul>



	Golden font along the roundel device	Honeydew in Golden font along the roundel device
<b>Similarities in essential features</b>	<b>Packaging of the Infringing Product I</b>	<b>Plaintiff's GOLD FLAKE PREMIUM package</b>
Placement of variant name	“PREMIUM” in gold font and red background in the right hand side corner	“PREMIUM” in gold font and red background in the right hand side corner
Line design on pack	Specially designed concentric lines moving away from the roundel	Specially designed concentric lines moving away from the roundel
<b>Brand elements and their manner of placement on the top and side panels. Also imitates the plaintiff's registered STAR device</b>	 	 
<b>Lower Panel</b>		
<b>Similarities in essential features</b>	<b>Packaging of the Infringing Product I</b>	<b>Plaintiff's GOLD FLAKE PREMIUM package</b>



9. The defendants have also launched a cigarette by the name



“SUPER STAR”, using a logo similar to “GOLD



FLAKE” logo of the plaintiff.

10. A perusal of the contents of the plaint makes out a *prima facie* case of infringement, by the defendants, of the registered trade mark of the plaintiff. The similarity in the trade dress of the defendants and the plaintiff is so great that it cannot be attributed to mere coincidence.

11. As such, let the plaint be registered as a suit. Issue summons in the suit.

12. Written statement, accompanied by affidavit of admission and denial of the documents filed by the plaintiff be filed within 30 days with advance copy to learned Counsel for the plaintiff who may file replication thereto, accompanied by affidavit of admission and denial of the documents filed by the defendants within 30 days thereof.



13. List before the learned Joint Registrar (Judicial) for completion of the pleadings, admission and denial of documents and marking of exhibits on 15<sup>th</sup> May 2023, whereafter the matter would be placed before the Court for case management hearing and further proceedings.

**I.A. 4978/2023(Order XXXIX Rules 1 and 2 of the CPC)**

14. This application by the plaintiff under Order XXXIX Rules 1 and 2 of the Code of Civil Procedure, 1908 (CPC), seeking *ad interim* interlocutory injunctive reliefs.

15. The recitals hereinabove, as well as a perusal of the contents of the plaint, make out a *prima facie* case in favour of the plaintiff and against the defendants, of infringement as well as passing off.

16. In such circumstances, the judgments of the Supreme Court in *Laxmikant v. Patel v. Chetanbhai Shah*<sup>1</sup> and *Midas Hygiene Industries (P) Ltd v. Sudhir Bhatia*<sup>2</sup>, require the Court to grant *ex parte* injunction in order to ensure that infringing activities do not continue. In the present case, the situation is exacerbated by the fact that the plaintiff and defendants are dealing in cigarettes and there is enhanced danger if infringing products were to remaining in the market.

17. In view thereof, issue notice, returnable on 6<sup>th</sup> July 2023 before the Court.

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<sup>1</sup> (2002) 3 SCC 65

<sup>2</sup> (2004) 3 SCC 90

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**18.** Reply be filed within four weeks with advance copy to learned Counsel for the plaintiff, who may file rejoinder thereto, if any, within four weeks thereof.

**19.** Till the next date of hearing, the defendants as well as all those acting on their behalf shall stand restrained from manufacturing, selling, advertising or directly or indirectly dealing in any products



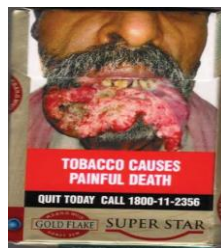
bearing the impugned labels



or any other name or mark deceptively similar to the plaintiff's registered GOLD FLAKE or SUPER STAR trade labels or marks. The defendants shall also stand restrained from dealing with



any products using the trade dress



similar to the trade dress of the plaintiff. Specifically, the defendants shall stand enjoined from manufacturing any products bearing any of the marks or trade dress impugned in the present plaint.

**20.** The plaintiff to comply with Order XXXIX Rule 3 of the CPC in accordance with the directions to follow hereinafter.



**I.A. 4979/2023(Order XXVI Rule 2) of the CPC)**

21. By this application, the plaintiff seeks appointment of a learned Local Commissioner to visit the following premises of Defendant 1 at Goldstep Tobacco Private limited, Jethuli, behind ITI Building, Fatuah, Patna, Bihar – 803201 and to seize and inventorize the allegedly infringing products present at the said premises.

22. Following the dictum in *Laxmikant V. Patel*<sup>1</sup> and *Midas Hygiene*<sup>2</sup>, this Court appoints Mr. Siddarth Agarwal, Adv. (Mob: +91 9045513840), as the learned Local Commissioner to visit the aforesaid premises. The terms of the commission shall be as under:

(i) The learned Local Commissioner shall take into custody any products found in the aforesaid premises bearing the impugned marks or trade dress in the present case, and inventorize all such products. Consequent on inventorization, the products shall be handed over to the defendants under *Superdari*, to be kept in safe custody pending further orders of this Court.

(ii) The learned Local Commissioner shall also take into custody any materials found in the premises which are used for manufacturing or printing the offending or infringing goods or labels, and, after inventorizing the said material, hand them over on *Superdari* to the defendants.

(iii) The learned Local Commissioner shall also be entitled to visit any other premises, which may come to his knowledge during the execution of the commission, where any infringing goods are stored or kept and, if any such goods or materials are found at such premises, to take into custody such goods or



materials in terms of the directions already issued hereinabove.

(iv) The commission shall be executed peacefully without unnecessarily disrupting the activities of the defendants. The defendants are also directed to cooperate with the execution of the commission and not to unnecessarily impede the execution in any manner.

(v) Should the necessity arise, the learned Local Commissioner shall be entitled to seek assistance of the jurisdictional police authorities to execute the aforesaid commission. In that event, this order shall operate as a *mandamus* to the police authorities to render all cooperation necessary for the said purpose.

(vi) The proceedings shall be videographed so that the Court is satisfied that there has been no unnecessary impediment created in execution of the commission. Videography shall be arranged by the plaintiff at its own costs and expense.

(vii) The commission shall be executed on 20<sup>th</sup> March 2023 at 11:00 am.

(viii) The learned Local Commissioner shall be entitled to fees of ₹ 1 lakh for execution of the commission apart from transport to and fro as well as other incidental expenses at actuals. The fees shall be paid in advance of the execution of the commission.

(ix) The learned Local Commissioner shall file a report regarding execution of the commission within a week of

execution thereof.



23. The Registry is directed not to upload this order on the website of this Court till the report is filed by the learned Local Commissioner.

24. The time for compliance of Order XXXIX Rule 3 of the CPC shall also reckon from the date of filing of the report by the learned Local Commissioner.

**I.A. 4980/2023 (Section 12A of the Commercial Courts Act, 2015)**

25. In view of the judgment of the Division Bench of this Court in *Chandra Kishore Chaurasia v. R.A. Perfumery Works Pvt Ltd*<sup>3</sup>, exemption is granted from the requirement of pre-institution mediation under Section 12A of the Commercial Courts Act, 2015.

26. The application stands allowed accordingly.

**I.A. 4981/2023 (Order XI Rule 1(4) of the CPC)**

27. This application seeks permission to file additional documents. The plaintiff is permitted to place additional documents on record in accordance with Order XI Rule 1(4) of the Code of Civil Procedure, 1908 (CPC) as amended by the Commercial Courts Act within four weeks from today.

28. The application stands disposed of accordingly.

**I.A. 4982/2023 (Exemption)**

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<sup>3</sup> 2022 SCC OnLine Del 3529  
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29. Subject to the plaintiffs submitting legible copies of any dim or illegible documents within 30 days, exemption is granted for the present.

30. The application is disposed of.

**I.A. 4983/2023 (exemption from advance service)**

31. For the reasons stated in the application, the plaintiff is exempted from the requirement of serving an advance notice on the defendants.

32. This application stands allowed accordingly.

33. *Dasti*

**C.HARI SHANKAR, J**

**MARCH 14, 2023/rb**