



2025:DHC:6176-DB



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

+ RFA(COMM) 381/2025, CM APPL. 42135/2025

DEEPAK KUMAR KHEMKA .....APPELLANT

Through: Mr. Rishi Bansal and Mr.  
Mankaran Singh, Advs.

versus

YOGESH KUMAR JAISWAL & ORS. ....RESPONDENTS

Through:

**CORAM:**

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

**HON'BLE MR. JUSTICE OM PRAKASH SHUKLA**

**JUDGMENT (ORAL)**

**28.07.2025**

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**C. HARI SHANKAR, J.**

1. This appeal assails order dated 4/5 June 2025, passed by the learned District Judge (Commercial Court-02)<sup>1</sup> in CS (Comm) 391/2024.

2. By the impugned order, the learned Commercial Court has dismissed CS (Comm) 391/2024, instituted by the appellant, under Order VII Rule 11 of the CPC<sup>2</sup>, on the ground that it did not disclose any sustainable cause of action, on the basis of which the suit could be maintained.

3. The facts are not in dispute.

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<sup>1</sup> "the learned Commercial Court" hereinafter



4. The appellant claimed to be manufacturing and selling articles of tobacco, matchboxes, supari, pan masala, mouth freshener, aerated water and non-alcoholic drinks, among other goods, under the trade marks “SHUDH, SHUDH PLUS and SHUDH PLUS ULTRA LABEL”. The plaint refers to these marks, collectively, as the “SHUDH formative trademarks/labels”.

5. The cause of action for instituting the plaint, as per the recitals therein, was an application filed by the defendant for registration of the trade mark/label ATS SHUDH in Class 34 of the Nice Classification<sup>3</sup>. The appellant claimed to have learnt of the filing of the said application by the respondent in the third week of March 2024. The application was filed for tobacco, chewing tobacco, zarda, khaini and other smokers articles, on proposed to be used basis. The trade mark application of the respondent was published in the Trade Mark Journal on 12 February 2024. It is not in dispute that the appellant has filed an opposition against the said application on 19 March 2024.

6. It was further averred, in the plaint, that inquiries conducted by the appellant in the last week of March 2024 revealed that the respondent had recently adopted the trade mark/label ATS SHUDH or



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<sup>2</sup> Code of Civil Procedure, 1908

<sup>3</sup> The international index of classification of goods and services for the purposes of trade mark registration, adopted by the Nice Agreement in 1957.



bearing the said trade mark/label were prevalent in the market. Nonetheless, on the ground that the appellant had “a strong and credible apprehension that the impugned goods bearing the impugned trade marks (were) going to be infused into the markets” within the jurisdiction of the Commercial Court at Saket, the suit was instituted by the appellant as a *quia timet* action<sup>4</sup> praying as under:

a. For a decree of permanent injunction restraining the Defendants by themselves as also through their individual proprietors, agents, representatives distributors, assigns, heirs, successors, stockists and all others acting for and on their behalf from soliciting, networking, manufacturing, marketing, trading, using, selling, displaying, advertising or by any other mode or manner dealing in or using the impugned trademark/ label ATS



SHUDH or soliciting/using it through any online medium or online websites or through any online platforms or through any social medias or any other identical with and/or deceptively similar word/mark/label to the plaintiffs Trademarks/labels which is identical/deceptively similar to the plaintiff's trademark/label SHUDH and other formative marks in relation to their impugned goods and business and related/cognate/allied goods and from doing any other acts or deeds amounting to or likely to:-

- i. Infringement of the Plaintiffs registered Trademarks/labels.
- ii. Passing off and violation of the Plaintiffs common law rights in the plaintiffs said Trademarks/labels & dilution of the plaintiffs rights.
- iii. Infringement of the plaintiffs Copyrights/labels.

b. Restraining the defendant from disposing off or dealing

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<sup>4</sup> “Quia timet” literally meaning “before he fears”, representing an action to injunct an act which is reasonably apprehended but has not yet happened.



with its assets including its shops and premises, or any other assets as may be brought to the notice of this Hon'ble Court during the course of the proceedings and on the defendant' disclosure thereof and which the defendant is called upon to disclose and/or on its ascertainment by the plaintiff as the plaintiff is not aware of the same as per Section 135 (2) (c) of the Trade Marks Act, 1999 as it could adversely affect the plaintiffs ability to recover the costs and pecuniary reliefs thereon.

c) For an order for delivery up of all the impugned finished and unfinished materials bearing the impugned and violative trade mark or any other deceptively similar trade mark/label including its blocks, labels, display boards, sign boards, trade literatures and goods etc. to the plaintiff for the purposes of destruction and erasure.

d) For an order for rendition of accounts of profits earned by the defendant by their impugned illegal trade activities under the impugned trademark and a decree for the amount so found in favour of the plaintiff on such rendition of accounts.

e) In the alternative to accounts for the decree of grant of damages to the tune of Rs. 5,00,000/- (Rs. Five lakhs only) from the defendants to the plaintiff.

f) for an order for cost of proceedings, and

g) For such other and further order as this Hon'ble Court may deem fit and proper in the facts and circumstances of the present case.

Prayed accordingly.”

**7.** The respondent, as the defendant in the suit, filed an application under Order VII Rule 11 of the CPC, for dismissal of the suit as it did not disclose any valid or cogent cause of action against the respondent.

**8.** By the impugned order dated 4/5 June 2025, the learned Commercial Court has allowed the respondent's application under



Order VII Rule 11(a)<sup>5</sup> and has, therefore, dismissed the appellant's suit.

9. Aggrieved thereby, the appellant has approached this Court by means of the present appeal.

10. We have heard Mr. Rishi Bansal, learned Counsel for the appellant at length.

11. Before noting the submissions of Mr. Bansal, we may reproduce the following paragraphs from the impugned order, which contain the reasoning of the learned Commercial Court:

“11. Order 7 rule 11 CPC lays that a plaint can be rejected where it does not disclose any cause of action. It has been held by the Courts in plethora of judgments that for the purposes of order 7 rule 11 CPC, only plaint is to be considered. Coming to the plaint of plaintiff, the first reference to defendant comes in para 19 where plaintiff has written that in 3<sup>rd</sup> week of March 2024 during routine search, plaintiff came across a deceptively/phonetically similar trademark ATS SHUDH under application no. 5308717 which was applied on January 2022 and advertised in Trademark Journal dated 12.02.2024. In para 22, plaintiff has written that he has filed an opposition against the impugned trademark on 19.03.2024. In para 23, it is written that plaintiff has strong and credible apprehension that impugned goods bearing the impugned trademark are going to be infused into the markets within the jurisdiction of this Court. In para 25 also, plaintiff is writing that it is the apprehension of plaintiff that defendant is most likely to start using the impugned trademark. In para 29, plaintiff writes that he made inquiry into the market regarding activity of defendants, however, he has not come across any impugned goods under the impugned trademark. In para 39, plaintiff writes that cause of action arose in March 2024 when plaintiff came across impugned trademark. It is stated that defendant has applied for trademark without any territorial jurisdiction thereby including territory of

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<sup>5</sup> 11. **Rejection of plaint.** – The plaint shall be rejected in the following cases:—  
(a) where it does not disclose a cause of action;



Delhi.

12. It is thus plaintiff's admitted case that though he is apprehending that goods are likely to be infused in the territory of Delhi, the same are not available anywhere in any market across the country. From where the plaintiff gets this apprehension that since the impugned goods are being sold at X place therefore, they will be brought from X place to other places including in Delhi? The application of defendant (no. 5308717) was filed on proposed to be basis and thus, defendant has not filed any document with TM registry showing that the trademark in question is being used anywhere in India as on date of filing of application. The plaintiff as stated here in above, has not stated in the plaint that the products were being sold anywhere in India as on date of the plaint or are being sold as on date of arguments of this application.

13. This Court is bound by the judgment of Hon'ble Supreme Court and has to follow the dicta as laid down in *K. Narayanan and ors. v S. Muarli*<sup>6</sup> and *Dhodha House and others v S. K. Mainga and ors.*<sup>7</sup> by Hon'ble Supreme Court. The plaintiff except for stating that the defendant has applied for trademark application 5308717 in class 34 in relation to impugned goods has not made any averment regarding actual use of trademark by defendant anywhere. In fact the plaintiff has categorically stated that it could not find any physical product of defendant under the impugned trademark/label.

14. As per Hon'ble Supreme Court, cause of action will arise in favour of plaintiff only when the registered trademark is used by the defendant and not when application for registration is filed.

15. The plaintiff could still have maintained its case in view of judgment in *Dhodha House (supra)* if it could show that there was some actual infringement taking place, since the court held that suit may lie where the infringement of trademark or copyright takes place. The advertising in the trademark journal or any other journal however, does not give cause of action for filing the suit in terms of the cited judgment.

16. The proper course of action with the plaintiff in the given circumstances, therefore, would be to oppose the trademark of defendant before the registry. Ld. Counsel for defendant made a statement during argument that defendant has abandoned his trademark application also. This submission of Ld. Counsel made during arguments cannot be a consideration for application u/o 7 rule 11 CPC. However, this Court is bound by the judgments of

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<sup>6</sup> (2008) 10 SCC 479

<sup>7</sup> (2006) 9 SCC 41



Hon'ble Supreme Court holding that mere filing of trademark registration application is not a cause of action for filing suits in absence of actual infringement being shown.

17. The application filed by the defendant is allowed. The suit filed by plaintiff is rejected u/O 7 rule 11 CPC.”

12. Mr. Bansal submits that the learned Commercial Court has misapplied the judgment of the Supreme Court in *Narayanan* and *Dodha House*. He submits that *Narayanan* was not a case involving infringement of trade mark, but was a case involving passing off.

13. We may reproduce paras 11, 13, 20, 17, 23 and 24 of *Narayanan* thus:

“11. Let us now consider the submissions of the learned counsel for the parties. The learned counsel for the appellants argued before us that the Division Bench of the High Court in its impugned judgment had taken a contrary view from the judgment of the Division Bench of the High Court of Delhi in *Jawahar Engg. Co. v Jawahar Engineers (P) Ltd.*<sup>8</sup> which has held that the real point which confers jurisdiction on the court is not the place where the advertisement is published but the place for which the trade mark is sought for sale. It has also held that when an injunction is sought, it is not necessary that the threat should have become a reality before the injunction is granted or refused and it can even be sought for a threat that is still to materialise.

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13. The learned counsel for the appellants submitted that when the respondent filed a trade mark application at the Trade Mark Registry at Chennai, a threat was communicated regarding the use of the trade mark in Chennai, and it was immaterial whether there was actual use or not and the appellants would be entitled to an injunction (being a prohibitive remedy) against the said mark. The learned counsel for the appellants finally argued that the respondent had based its application for registration of the trade mark on use of the mark throughout India without any geographical limitation from 1-4-1995, which included the city of Chennai, which thus entitled the appellants to file the suit at the

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<sup>8</sup> 1983 PTC 207 (Del)



High Court of Madras based on the claims made in the trade mark application.

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17. It was further argued that actual sale of goods was necessary to be proved in the case of passing-off action and therefore the court within whose jurisdiction the commercial sale of goods took place, had jurisdiction to entertain a suit for passing off.

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20. Having heard the learned counsel for the parties and after carefully examining the aforementioned judgment of the High Court and also of the learned Single Judge, we do not find any infirmity in the judgment of Division Bench of the High Court holding that before registration is granted for the trade mark, there is no right in the person to assert that the mark **has been infringed** and that a proposed registration which may or may not be granted, will not confer a cause of action to the plaintiff, whether the application for registration is filed by the plaintiff or the defendant.

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23. In *Dhodha House v S.K. Maingi* it has been observed as follows:

“31. A cause of action will arise only when a registered trade mark is used and not when an application is filed for registration of the trade mark. In a given case, an application for grant of registration certificate may or may not be allowed. The person in whose favour a registration certificate has already been granted (sic) indisputably will have an opportunity to oppose the same by filing an application before the Registrar, who has the requisite jurisdiction to determine the said question. In other words, a suit may lie where an infringement of trade mark or copyright takes place but a cause of action for filing the suit would not arise within the jurisdiction of the court only because an advertisement has been issued in the Trade Marks Journal or any other journal, notifying the factum of filing of such an application.”

(emphasis supplied)

In the aforesaid decision, this Court has expressed its concurrence with the views observed by the Division Bench of the High Court



of Madras in *Premier Distilleries (P) Ltd. v Sushi Distilleries*<sup>9</sup> which observed as under:

“9. The cause of action in a suit for passing off, on the other hand and as already observed, has nothing at all to do with the location of the Registrar's office or the factum of applying or not applying for registration. It is wholly unnecessary for the plaintiff to prove that he had applied for registration. The fact that the plaintiff had not applied for registration will not improve the case of the defendant either. *Filing of an application for registration of a trade mark, therefore, does not constitute a part of cause of action where the suit is one for passing off.*”

(emphasis supplied)

24. In this view of the matter, we are, therefore, of the opinion that filing of an application for registration of a trade mark does not constitute a part of cause of action in a suit for passing off. The appellants cannot file the suit in the High Court of Madras seeking an injunction to restrain the respondent from passing off his goods using the trade mark A-ONE, based only on the claims made in the trade mark application of the respondent filed before the Trade Mark Registry, since the necessary requirements of an action for passing off are absent.”

**14.** Insofar as the decision in *Dhodha House* is concerned, Mr. Bansal submits that the Court was, in that case, was concerned with the aspect of territorial jurisdiction, and not particularly with the issue of whether a mere filing of a trade mark application by the defendant would confer, on the plaintiff, a valid cause of action to maintain a suit. He has, in this context, relied on paras 30 and 31 of *Dhodha House*. Para 31 already stands reproduced *supra*. Para 30 reads:

“30. The said decision has no application in the instant case for more than one reason. For the purpose of registration of a trade mark, an application must be filed in the branch office of the Registrar of Trade Marks. It is not in dispute that under Section 5(3) of the 1958 Act, the Central Government has issued a notification in the Official Gazette defining the territorial limits within which an office of the Trade Marks Registry may exercise its functions. The office of the Trade Marks Registry at New Delhi

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<sup>9</sup> (2001) 3 CTC 652 (Mad)



exercises jurisdiction over the States of Haryana, Himachal Pradesh, Jammu and Kashmir, Punjab, Rajasthan and Uttar Pradesh and the Union Territory of Chandigarh and the National Capital Territory of Delhi. Whereas in *Dhodha House v S.K. Maingi* no such application has been filed, admittedly in *Patel Field Marshal Industries v P.M. Diesels Ltd.*<sup>10</sup> the Delhi office has no jurisdiction as parties are residents of Rajkot and an application was filed by the appellant for registration of its trade mark at Bombay. If an objection is to be filed, the same has to be filed at Bombay. An advertisement by itself in a journal or a paper would not confer jurisdiction upon a court, as would be evident from the following observations of this Court in *Oil and Natural Gas Commission v Utpal Kumar Basu*<sup>11</sup>:

“Therefore, broadly speaking, NICCO claims that a part of the cause of action arose within the jurisdiction of the Calcutta High Court because it became aware of the advertisement in Calcutta, it submitted its bid or tender from Calcutta and made representations demanding justice from Calcutta on learning about the rejection of its offer. The advertisement itself mentioned that the tenders should be submitted to EIL at New Delhi; that those would be scrutinised at New Delhi and that a final decision whether or not to award the contract to the tenderer would be taken at New Delhi. Of course, the execution of the contract work was to be carried out at Hazira in Gujarat. Therefore, merely because it read the advertisement at Calcutta and submitted the offer from Calcutta and made representations from Calcutta would not, in our opinion, constitute facts forming an integral part of the cause of action. So also the mere fact that it sent fax messages from Calcutta and received a reply thereto at Calcutta would not constitute an integral part of the cause of action.”

15. Mr. Bansal further places reliance on the judgments of the Division Benches of this Court in *Jawahar Engineering Co v Jawahar Engineers Pvt Ltd*<sup>12</sup> and *Maan Pharmaceuticals Ltd v Mindway HealthCare Pvt Ltd*<sup>13</sup>, as well as the judgment of a learned Single Judge of this Court in *Pfizer Products, Inc v Rajesh Chopra*<sup>14</sup>.

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<sup>10</sup> (2018) 2 SCC 112

<sup>11</sup> (1994) 4 SCC 711

<sup>12</sup> AIR 1984 Del 166

<sup>13</sup> (2022) 92 PTC 647

<sup>14</sup> (2006) 127 DLT 783



16. Having heard Mr. Rishi Bansal, learned Counsel for the appellant, we are of the opinion that the impugned order of the learned Commercial Court is unexceptionable, especially in view of para 20 of the judgment of the Supreme Court in *Narayanan*. Mr. Bansal's attempt at seeking to argue that the decision in *Narayanan* has to be rendered as restricted to passing off does not impress us. While it is true that the decisions of the Supreme Court have to be seen in the background of the facts before the Court, nonetheless, where the Court lays down a clear proposition of law, it would be folly on the part of any Court, lower in the judicial hierarchy, to ignore such a proposition on the tenuous ground that it has been rendered in the peculiar facts before the Supreme Court.

17. Para 20 of *K. Narayanan* is clear and categorical. It holds, in plain terms that “before registration is granted for the trademark, there is no right in the person to assert that the mark *has been infringed* and that a proposed registration which may or may not be granted will not confer a cause of action to the plaintiff, whether the application for registration is filed by the plaintiff or the defendant”.

18. What Mr. Bansal essentially seeks is that we should read the reference to “infringement”, in para 20 of the judgment of the Supreme Court as referring to passing off.

19. It goes without saying that this Court can hardly seek to rewrite a judgment of the Supreme Court. Moreover, even in the opening sentence of para 13 of the same decision, we find that the Court has



recorded the submission of the Counsel for the appellant before it held that the filing of a trademark application by the respondent at the Trade Mark Registry at Chennai amounted to a communication of a threat regarding the use of the trademark at Chennai and it was immaterial whether there was actual use or not. Clearly, these two observations, read together, indicate that the Supreme Court is of the view that no application for injunction on the ground of infringement of the trademark would lie where the defendant has only applied for a registration of the mark.

**20.** When we read paras 13 and 20 in juxtaposition, it is clear that the Supreme Court has held that no cause of action, to maintain a suit *for infringement*, would lie merely on the defendant filing an application for registration of a trade mark.

**21.** We may note, in this context, that Section 29<sup>15</sup> of the Trade

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<sup>15</sup> **29. Infringement of registered trade marks. –**

- (1) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which is identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark.
- (2) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which because of—
- (a) its identity with the registered trade mark and the similarity of the goods or services covered by such registered trade mark; or
  - (b) its similarity to the registered trade mark and the identity or similarity of the goods or services covered by such registered trade mark; or
  - (c) its identity with the registered trade mark and the identity of the goods or services covered by such registered trade mark,
- is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trade mark.
- (3) In any case falling under clause (c) of sub-section (2), the court shall presume that it is likely to cause confusion on the part of the public.
- (4) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which—
- (a) is identical with or similar to the registered trade mark; and
  - (b) is used in relation to goods or services which are not similar to those for which the trade mark is registered; and
  - (c) the registered trade mark has a reputation in India and the use of the mark without due cause takes unfair advantage of or is detrimental to, the distinctive character or repute of the registered trade mark.



Marks Act envisages *use* of the allegedly infringement trade mark by the defendant, in the circumstances outlined by the various subsections of Section 29, as amounting to “infringement”. Absent use by the defendant, there is no infringement. There is, therefore, robust justification for the view, expressed in para 20 of *Narayanan*, that no cause of action to maintain a suit for infringement would lie at a stage when the defendant has merely applied for a registration of its mark. Of course, if there is material to indicate that, apart from merely applying for registration of the mark, the defendant also intends to use the mark, whether before or after its registration, it would certainly suffice to maintain a *quia timet* action. The trigger point for an infringement action is *use*, not *registration* of the plaintiff’s mark, or a mark which is identical or deceptively similar thereto, by the defendant.

**22.** We have also examined, therefore, whether there was any independent material on the record to indicate the existence of any looming threat of the respondent using the mark. There is a specific finding by the learned Commercial Court that, apart from a bald averment that the appellant apprehended that the respondent would commence use of the mark, no supportive material in that regard had been placed on record. The learned Commercial Court has, in para 11 of the impugned order, also noted that, in para 25 of the plaint, the appellant had specifically acknowledged that when he made market inquires he had not come across any goods under the mark of the respondent, of which he sought an injunction.



23. Thus, even on facts, the learned Commercial Court has found that no supportive material to sustain a *quia timet* action on the ground of apprehension of use of the allegedly infringing mark by the respondents, was made out. Mr. Bansal has not been able to invite attention to any material, on record, which would dent the correctness of this finding.

24. Mr. Bansal has acknowledged, at the commencement of arguments, that the suit instituted by the appellant against the respondent alleged infringement, and not passing off. In view of the judgment of the Supreme Court in *Narayanan* and *Dhodha House* as well as the facts noted *supra*, we are of the opinion that the judgment of the learned Commercial Court is unexceptionable on facts and in law.

25. The decisions of this Court, cited by Mr. Bansal, do not note or consider *Narayanan*. It is not necessary, therefore, for us to advert thereto.

26. We also note that the appellant has in fact moved the Registrar of Trade Marks by way of objections against the application filed by the respondents for registration of the allegedly infringing marks. That, in fact, is the correct course of action for the appellant to pursue at this stage. Needless to say, the decision of the learned Commercial Court would not in any manner influence the objections filed by the appellant before the Registry of the Trade Marks.



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27. We find no cause to issue notice in this appeal. The appeal is accordingly dismissed in *limine*.

**C. HARI SHANKAR, J.**

**OM PRAKASH SHUKLA, J.**

**JULY 28, 2025/aky**