

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

IP-COM/28/2024
IA NO: GA-COM/1/2024, GA-COM/4/2024,
GA-COM/5/2025, GA-COM/6/2025

PANKAJ PLASTIC INDUSTRIES PRIVATE LIMITED
VS
ANITA ANU

BEFORE:
The Hon'ble JUSTICE RAVI KRISHAN KAPUR
Date : 6th May, 2025.

Appearance:
Mr. Debnath Ghosh, Senior Advocate
Mr. Sarosij Dasgupta, Advocate
Mr. Biswaroop Mukherjee, Advocate
Mr. Avijit Dey, Advocate
...for the plaintiff

Mr. Soumya Ray Chowdhury, Advocate
Mr. Prithwish Roy Chowdhury, Advocate
Ms. Susrea Mitra, Advocate
Ms. Bhwana Tikrewal, Advocate
...for defendants.

The Court: This is an application seeking revocation of dispensation granted to the plaintiff without exhausting the remedy of Pre-Institution Mediation and Settlement under Section 12A of the Commercial Courts Act, 2015.

Briefly, the plaintiff is, inter alia, engaged in the manufacture and distributorship of plastic pipes, machines and machine tools, which are sold under the mark Pankaj Flex. In addition, there are different trademarks i.e. Pankaj Flex, Pankaj Flexy and Pankaj all which have been assigned to the plaintiff. The full particulars of the above marks, registered with the plaintiff have been enumerated in the plaint. In this suit, it is alleged that the defendant

has adopted a deceptively similar mark, i.e. *Poly Punkaj* to ride on the goodwill of the plaintiff and create confusion insofar as the source of the goods are concerned. In such circumstances, the plaintiff sues for infringement and passing off.

The relevant pleadings in obtaining dispensation under Section 12A of the Act are set out below:

93. The cause of action in the instant case arose for the first time in the month of January, 2024 when the plaintiff came to know that the defendant started flooding the market with its impugned products under the impugned marks "POLY-PUNKAJ", and the same is continuing day to day. The causes of action of the plaintiff, as against the defendant, are for infringement of the plaintiff's registered trademarks involving "PUNKAJ", and passing off by reasons of use of the marks "POLY-PUNKAJ", and also for infringement of the registered copyright of the plaintiff, by the defendant. Such causes of action of the plaintiff, as against the defendant, are recurring in nature, and every sale of goods, by the defendant, under the mark "POLY-PUNKAJ", gives rise to fresh cause of action to the plaintiff, to sue for infringement and passing off. Such cause of action arose within and also outside of the jurisdiction as aforesaid. Hence, there is no delay on the part of the plaintiff's, in filing the present suit and no part of the plaintiff's claim is barred by laws of limitation.

98. The instant suit is for infringement and passing off, which contemplates urgent reliefs to protect the interests of the plaintiff. The Trade Marks Act, 1999 makes it abundantly clear that it is the option of the plaintiff to seek urgent interim reliefs. The defendant has obtained registration of the mark "POLY-PUNKAJ" imitating the same colour combination and artistic work which has been adopted by the plaintiff and the mark appears to have been registered on 3rd December, 2023. The plaintiff has duly filed an application for rectification on 4th January, 2024. The parties are already litigating over its rights in respect of the registrability of the defendant's mark "POLY PUNKAJ" before the Trade Marks Registry, wherein it is the specific case of the plaintiff that the impugned mark "POLY-PUNKAJ" is devoid of any distinctive character and is not capable of distinguishing the goods of the defendant from those of the other. Furthermore, it is also the specific case of the plaintiff that the defendant's purported mark "POLY-PUNKAJ" is identical to the

plaintiff's prior mark "PANKAJ" and is used in respect of similar goods covered by the said mark and there exists a likelihood of confusion on the part of the public and by adopting the impugned mark "POLY-PUNKAJ" the defendant is seeking a wrongful association with the plaintiff and its mark "PANKAJ". There is bad faith involved on the part of the defendant in applying for and obtaining the registration of the mark "POLY-PUNKAJ", despite being fully aware of the plaintiff's mark "PANKAJ". Every sale of goods by the defendant under the impugned mark gives rise to a fresh cause of action to the plaintiff to sue for infringement of copyright, trademark and passing off. In such circumstances, there is no possibility of any pre-suit mediation and the plaintiff is beseeching this Hon'ble Court to dispense with the provisions of Section 12A of the Commercial Courts Act, 2015. Considering that the defendant has not only adopted an identical and/or deceptively similar mark as that of the plaintiff's mark, while also adopting a slavish imitation of the artistic work for the goods marketed, sold and distributed under the said "PANKAJ" marks by the plaintiff, the plaintiff reasonably believes that any attempt at a pre-institution mediation and settlement of the disputes with the defendant would tantamount an idle formality."

Upon filing of the suit, by an order dated 20th September, 2024, the plaintiff obtained leave under Clause 12 of the Letters Patent 1865, Order 2 Rule 2 of the Code of Civil Procedure, 1908 and dispensation with the requirement of Section 12A of the Commercial Courts Act, 2015. Thereafter, there have been diverse interlocutory proceedings which have been filed by both the parties.

On behalf of the defendant it is contended that there are no grounds pleaded to dispense with the requirement of Section 12A of the Act. It is alleged that the plaintiff came to learn of the impugned products being sold in the market for the first time in January 2024. Upon making further enquires, the plaintiff also ascertained that the impugned mark had been registered on 3 December 2023. Accordingly, the plaintiff had filed an application for

rectification on 4 January, 2024. The suit had been instituted on the 20th September 2024. There is no explanation of any kind whatsoever as to why the plaintiff has waited for approximately nine months in the filing of this suit. The averments in the plaint insofar as dispensation under Section 12A of the Act has been prayed for are general, vague and insufficient for any dispensation to be granted. In support of such contentions, reliance is placed on the following decisions: *Patil Automation Private Limited and Ors. vs Rakheja Engineers Private Limited* (2022) 10 SCC1, *Yamini Manohar vs T.K.D. Keerthi* (2024) 5 SCC 815, *Proactive Ship Management Private Limited vs. Owners and Parties Interested in the Vessel Green Ocean* 2024 SCC OnLine Cal 1838, Unreported decision in *Unique Entrepreneurs and Finance Limited vs. Really Agritech Pvt. Ltd and Anr.* dated 20th March, 2025 passed by the Hon'ble High Court at Calcutta, *Srmb Srijan Private Limited vs. B.S. Sponge Pvt. Ltd.* MANU/WB/1666/2023, *Indian Explosives Pvt. Ltd. vs. Ideal Detonators Pvt. Ltd.* reported in 2023 SCC OnLine Cal 1944 and Unreported decision dated 3rd March, 2025 *Pranoy Kumar Saha vs. Rabindra Narayan Das.*

On behalf of the plaintiff, it is contended that in the absence of fraud, deception or misrepresentation, there is no power to revoke leave under section 12A of the Act. In any event, the plaint has to be read holistically from the standpoint of the plaintiff. It is submitted that in matters pertaining to intellectual property, the urgency for reliefs arises from the very nature of the subject matter and dispensation ought to be granted as a matter of course. In support of such contentions, the defendant relied on the decisions in *Yamini Manohar vs. TKD Keerthi* (2024) 5 SCC 815, *Shristi Infrastructure Development*

Corporation Limited vs. Sarga Hotel Private Limited & Anr. 2024 SCC OnLine Cal 7817(DB), Kohinoor Seed Fields Pvt. Ltd. vs. Veda Seed Sciences Pvt. Ltd and Ors. MANU/TL/1081/2024, Chemco Plastic Industries Pvt. Ltd. vs. Chemco Plast (2024) OnLine Bom 1607, Quality Services & Solutions Pvt. Ltd. and Ors. vs. QSS Inspection and Testing Pvt. Ltd (2024) SCC OnLine Bom and Lala Shri Bhagwan & Anr. vs. Shri Ram Chand & Anr. AIR 1965 SC 1767.

Significantly, the plaintiff chose to surreptitiously include in the Notes of Submissions case laws which had neither been cited nor referred to during the hearing of the application. In addition, a plea which had also not been raised i.e. that this Bench should not hear the matter since dispensation has been granted by a Co-ordinate Bench has also been inserted in for the first time in the Notes of Arguments.

Section 12A of the Commercial Courts Act is as follows:

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

(2) The Central Government may, by notification, authorise the Authorities constituted under the Legal Services Authorities Act, 1987 (39 of 1987), for the purposes of pre-institution mediation.

(3) Notwithstanding anything contained in the Legal Services Authorities Act, 1987 (39 of 1987), the Authority authorised by the Central Government under sub-section (2) shall complete the process of mediation within a period of three months from the date of application made by the plaintiff under sub-section (1):

Provided that the period of mediation may be extended for a further period of two months with the consent of the parties:

Provided further that, the period during which the parties remained occupied with the pre-institution mediation, such period shall not be computed for the purpose of limitation under the Limitation Act, 1963 (36 of 1963).

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

(5) The settlement arrived at under this section shall have the same status and effect as if it is an arbitral award on agreed terms under sub-section (4) of section 30 of the Arbitration and Conciliation Act, 1996 (26 of 1996).]"

In *Yamini Manohar versus TKD Kirti*, 2023 SCC OnLine SC 1382, it has been held as follows;

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

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

It is no longer *res integra* that section 12A of the Act is imperative and any suit which is filed without exhausting the remedy under section 12A is liable to be rejected (*Patil Automation (P) Ltd. v. Rakheja Engineers (P) Ltd.*, (2022) 10 SCC 1). The only exception with the requirement under Section 12A is where the plaint contemplates grant of urgent interim reliefs. This requires urgency to be pleaded in the plaint and must be supported by necessary facts and the documentary evidence. Undoubtedly, there is a very narrow window which has been left open in *Yamini Manohar (Supra)* i.e. those cases where a plaintiff seeks to artificially, falsely or deceptively create urgency only to circumvent with the requirement of Pre-Institution Mediation or Settlement.

There can be no straight jacket formula in such cases. Each case depends on its own facts and the facts can only appear from the plaint and documents in support thereof. It is also true that the length of time *per se* does not disentitle a plaintiff to seek dispensation. Similarly, the merits of the underlying dispute are irrelevant at this stage of the proceedings. The totality of the circumstances has to be considered and a holistic reading must be given to the plaint. However, urgency has to be primarily ascertained on the basis of the averments in the plaint and the facts in support thereof (*Proactive Ship Management Private Limited vs. Owners and Parties Interested in the Vessel Green Ocean 2024 SCC OnLine Cal 1838*, Unreported decision in *Unique Entrepreneurs and Finance Limited vs. Really Agritech Pvt. Ltd and Anr.* dated 20th March, 2025 passed by the Hon'ble High Court at Calcutta and *Srmb Srijan Private Limited vs. B.S. Sponge Pvt. Ltd.* MANU/WB/1666/2023).

In the facts of this case, the plaintiff has admitted that they had knowledge of the impugned product since January 2024. Having admitted this factual position, it was incumbent on the plaintiff to provide grounds or justify as to why they had waited for nine months before instituting the suit and obtaining dispensation under Section 12A of the Act. The plaint is wholly silent on this aspect of the matter. The omnibus averment in the plaint is that being a suit pertaining to intellectual property rights, the cause of action is continuous and recurring and hence the need for urgent interim reliefs. There is no quarrel with the proposition that the cause of action in a suit for infringement and passing off is recurring in nature. Nevertheless, for the purposes of granting dispensation under section 12A of the Act, any examination can only be conducted on the touchstone of when the *right to sue* arose. Otherwise, no suit for infringement or passing off would ever require Pre-Institution Mediation or Settlement. The section cannot be interpreted in a manner to render the same meaningless or nugatory [*Union of India vs Deoki Nandan Aggarwal* 1992 Supp (1) SCC 323].

In *Yamini Manohar (Supra)* the Supreme Court held that suits where the urgency was artificially created would not bypass the requirement under section 12A of the Act. Non-furnishing of an explanation or justification despite having knowledge of the alleged act of infringement or passing off in the facts of this case is a clear attempt to artificially create urgency. In the absence of any pleadings to justify the delay, there is no question of relying on any supporting evidence at all. Unfortunately, the plaint is merely a cut and paste job. The plaintiff has not even attempted to proffer any explanation as to what

transpired from the date of knowledge i.e. January 2024 till the date of filing i.e. September 2024.

The attempt to slip in submissions or additional authorities in the Notes of Arguments which were not cited during the hearing is unfair, improper and pernicious to say the least. So, is the pleading, which has been deceptively inserted in the Notes of Arguments that this Court should release the matter and the same be placed before the Coordinate Bench which had granted dispensation under section 12A. Significantly, this point was never argued at the time of hearing of the application nor were any of the additional citations even referred to. The decision in *Shristi Infrastructure Development Corporation Limited (Supra)* is distinguishable. This was not a case of there being no pleadings to justify the delay. All other authorities cited by the defendant are inapposite. Judgments when cited as precedents are binding in the context in which they are rendered. In *Quinn v. Leathem (1901) AC 495*, which has been quoted and approved by the Supreme Court, it was held as follows:

“Now, ... there are two observations of a general character which I wish to make, and one is to repeat what I have very often said before, that every judgment must be read as applicable to the particular facts proved, or assumed to be proved, since the generality of the expressions which may be found there are not intended to be expositions of the whole law, but governed and qualified by the particular facts of the case in which such expressions are to be found. The other is that a case is only an authority for what it actually decides. I entirely deny that it can be quoted for a proposition that may seem to follow logically from it. Such a mode of reasoning assumes that the law is necessarily a logical code, whereas every lawyer must acknowledge that the law is not always logical at all.”

In view of the above, GA-COM 6 of 2025 stands allowed. There shall be an order in terms of prayers (a) and (b) of the Master's Summons. IP-COM 28 of 2024 stands dismissed. All interim orders stand vacated. Consequently the interlocutory applications being GA-COM 4 of 2024 and GA-COM 1 of 2025 are dismissed. Accordingly, GA-COM 5 of 2025 is also rendered infructuous.

(RAVI KRISHAN KAPUR, J.)

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