

OIPD-1

ORDER SHEET

IP-COM/4/2026

IN THE HIGH COURT AT CALCUTTA
INTELLECTUAL PROPERTY RIGHTS DIVISION

HARSHIT JAIN & ORS.
VS.
ACIA PACIFIC BUILDWARE LLP

BEFORE:

The Hon'ble JUSTICE ARINDAM MUKHERJEE

Date: 1st April, 2026.

Mr. Sourojit Dasgupta, Mr. Abhishek Jain, Mr.
Sourav Thakur, Advocates for the plaintiffs.

The Court : The plaint on being filed in the Central Filing Department of this Court has been allotted a suit number and has appeared in the list for presentation and admission of the plaint for institution of the suit. The plaintiffs have sought for dispensation of the formalities under Section 12A of the Commercial Courts Act, 2015 (hereinafter referred to as 2015 Act), leave under Clause 12 of Letters Patent, 1865 and leave under Order II Rule II of the Code of Civil Procedure, 1908 (in short CPC). On a perusal of the plaint it appears that one Sanico Enterprise Pvt. Ltd (hereinafter for the sake of convenience "Sanico") is the holder of the registered trademark "DuraGrace European Collection" since 11.11.2009 for sanitary wares of all kinds. Plaintiffs are using the said mark as assignee since 5th November, 2019. The mark is valid till 11.11.2029. The defendant is selling the same class of products i.e., sanitary wares under the name and style "DuraGres" and thereby have infringed the registered mark of the plaintiffs and has been passing off its product as that of the plaintiff.

It appears from the documents annexed to the plaint that the defendant applied for registration of the wordmark “DuraGres” which was published in the Journal No. 2140-0 on 22.01.2024. Although, another entity Somany Ceramics Limited had objected against such application made by the defendant but the plaintiffs never opposed the same. The plaintiffs on the allegation that they started receiving complaints from their clients on and from October, 2025 issued a cease and desist notice dated 15.11.2025 and have filed the plaint on 25.03.2026. The plaintiffs’ on contemplation of urgent interim relief seek dispensation for the formalities of Section 12A of the 2015 Act. That the provisions of Section 12A are mandatory is no more *res integra* after the judgment of ***Patil Automation Pvt. Ltd. vs. Rakheja Engineers Pvt. Ltd. reported in 2022 (10) SCC 1.*** The limited authority to scrutinise the plaint and the consequences in case of a commercial suit has been elucidated by the Supreme Court in ***2024 (5) SCC 815 (Yamini Manohar vs. T.K.D. Keerthi).*** These two judgments have been analysed by the Supreme Court in the judgment reported in ***2025 (9) SCC 424 (Dhanbad Fuels (Pvt.) Ltd. vs. Union of India & Anr.).*** In paragraph 71 of the Dhanbad Fuels (supra) the following has been held:

“71. In light of the aforesaid discussion, we summarise our findings as under:

71.1. *The decision of this Court in Patil Automation [Patil Automation (P) Ltd. v. Rakheja Engineers (P) Ltd., (2022) 10 SCC 1 : (2023) 1 SCC (Civ) 545] lays down the correct position of law as regards Section 12-A of the 2015 Act by holding it to be mandatory in nature.*

71.2. *As held in para 104 of the decision in Patil Automation [Patil Automation (P) Ltd. v. Rakheja Engineers (P) Ltd., (2022) 10 SCC 1 : (2023) 1 SCC (Civ) 545], the declaration of the mandatory nature of Section 12-A of the 2015 Act relates back to the date of the amending Act.*

71.3. *As held in para 113.1 of the decision in Patil Automation [Patil Automation (P) Ltd. v. Rakheja Engineers (P)*

Ltd., (2022) 10 SCC 1 : (2023) 1 SCC (Civ) 545] , any suit which is instituted under the 2015 Act without complying with Section 12-A is liable to be rejected under Order 7 Rule 11. However, this declaration applies prospectively to suits instituted on or after 20-8-2022.

71.4. *A suit which contemplates an urgent interim relief may be filed under the 2015 Act without first resorting to mediation as prescribed under Section 12-A of the 2015 Act.*

71.5. *Unlike Section 80(2)CPC, leave of the court is not required to be obtained before filing a suit without complying with Section 12-A of the 2015 Act.*

71.6. *The test for “urgent interim relief” is if on an examination of the nature and the subject-matter of the suit and the cause of action, the prayer of urgent interim relief by the plaintiff could be said to be contemplable when the matter is seen from the standpoint of the plaintiff.*

71.7. *The Courts must also be wary of the fact that the urgent interim relief must not be merely an unfounded excuse by the plaintiff to bypass the mandatory requirement of Section 12-A of the 2015 Act.*

71.8. *Even if the urgent interim relief ultimately comes to be denied, the suit of the plaintiff may be proceeded with without compliance with Section 12-A if the test for “urgent interim relief” is satisfied notwithstanding the actual outcome on merits.*

71.9. *Suits instituted without complying with Section 12-A of the 2015 Act prior to 20-8-2022 cannot be rejected under Order 7 Rule 11 on the ground of non-compliance with Section 12-A unless they fall within the exceptions stipulated in paras 113.2 and 113.3 of the decision in Patil Automation [Patil Automation (P) Ltd. v. Rakheja Engineers (P) Ltd., (2022) 10 SCC 1 : (2023) 1 SCC (Civ) 545] .*

71.10. *In suits instituted without complying with Section 12-A of the 2015 Act prior to 20-8-2022 which are pending adjudication before the trial court, the court shall keep the suit in abeyance and refer the parties to time-bound mediation in accordance with Section 12-A of the 2015 Act if an objection is raised by the defendant by filing an application under Order 7 Rule 11, or in cases where any of the parties expresses an intent to resolve the dispute by mediation.”*

Contemplation of urgent interim relief for dispensation of the

formalities under Section 12 A of the 2015 Act has to be considered when the right to sue first accrues. The Hon’ble Supreme Court has in the judgment reported in **2016 (13) SCC 1 (Sundaram Finance Limited vs.**

Noorjahan Beevi & Anr.) elucidated as to when right to sue first accrues. The right to sue in the instant case first arose in favour of the plaintiffs when the application for registration of wordmark made by the defendant was published in the journal on 22.01.2024.

The plaintiffs did not approach the Court within a reasonable period from 22.01.2024 to institute the suit by seeking dispensation of the formalities under Section 12 A of the 2015 Act. The right to sue, therefor, had accrued for the first time on 22.01.2024. The plaintiffs did not approach the Court immediately thereafter. There is no pleading even that the plaintiffs did not know about the publication of the journal. The contemplation of urgent interim relief would have been realistic, if the plaintiffs had approached the Court at that point of time. The plaintiffs have cited the judgement reported in **2025 SCC Online SC 2278 (Novenco Building & Industry A/S v. Xero Energy Engineering Solutions (P) Ltd. & Anr.)** to contend that infringement or passing off are continuous cause of action and as such the suit can be filed seeking dispensation of the formalities under Section 12 A of 2015 Act. In contemplation of urgent interim relief even in 2026 as complaints were received in October, 2025. Firstly, the judgments in Patil Automation (supra), Yamini Manohar (surpa) and Dhanbad Fuels (supra) which were decided prior to Novenco (supra) were not brought to the notice of the Hon'ble Supreme Court while deciding Novenco (supra). Assuming without admitting that the Hon'ble Supreme Court had the notice of the aforesaid three judgments and also Novenco (supra) does not assist the plaintiffs. It is not in dispute that continuous wrong saves the limitation for which the suit can be filed and maintained even at a subsequent stage but he same parameters are not applicable for

dispensation of formalities under Section 12A of the 2015 Act. If the plea of the plaintiff as in the instant case that dispensation can be sought for even after a considerable time after the right to sue first accrued, would render the proposition of pre-suit mediation otiose when it has been held mandatory by the Hon'ble Supreme Court. In such a situation a plaintiff in a case of infringement and passing off may approach the Court at any time citing the continuity of cause of action and seek dispensation of the formalities under Section 12A of the 2015 Act. There is, however, no dispute that infringement or passing off gives rise to continuity of cause of action.

After reading the plaint proposed to be filed for instituting the suit after dispensing with the formalities under Section 12A of the Commercial Courts Act, 2015 and in the light of the discussion as aforesaid, I do not find any contemplation of urgent interim relief. The plaintiff is, therefore, directed to go for pre-litigation mediation. The plaint on being filed in the Central Filing Department has been only allotted a number. It is only on admission of the plaint on being presented the suit is instituted. Only on institution the plaint enters the record of the Court in true sense.

In the aforesaid facts and circumstances, the plaint is directed to be returned to one plaintiff with the Court fees. The plaintiffs will have the right to present the same on completion of the pre-litigation mediation or if the same is a non-starter.

The number allotted to the plaint be deregistered from the database after return of the plaint on completion of all formalities.

(ARINDAM MUKHERJEE, J.)