2026:CHC-OS:388

IN THE HIGH COURT AT CALCUTTA

INTELLECTUAL PROPERTY RIGHTS DIVISION

ORIGINAL SIDE

Present :
THE HON'BLE JUSTICE ARINDAM MUKHERJEE

IP (COM) No.10 of 2026

ITC LIMITED

Vs.

SMM TOBACOO PRIVATE LIMITED & ORS.

For the Plaintiff : Mr. Rudraman Bhattacharya, Sr. Adv.
Mr. Sarathi Dasgupta, Adv.
Mr. K.K. Pandey, Adv.
Mr. Manosij Mukherjee, Adv.
Mr. Aayush Sinha, Adv.
Mr. Naman Chowdhury, Adv.
Mr. Bhavesh Garodia, Adv.
..... Advocates

Heard on : 8th September, 2026

Judgment on : 8th September, 2026

Arindam Mukherjee, J:

1) The plaint on being filed in the Central Filing Department of this Court has been allotted a suit number and has been placed before the Court under the heading "Presentation of Plaint" for the plaint being presented and admitted for institution of the suit.

2) The proposed plaintiff, (hereinafter for the sake of convenience referred to as 'the plaintiff') by presenting the plaint, subject to the same being admitted intends to institute a suit for infringement and passing off by seeking dispensation of the formalities under Section 12 A of the Commercial Courts Act, 2015 (hereinafter referred to as 'the 2015 Act').

3) The learned Counsel for the plaintiff refers to various paragraphs in the plaint to persuade the Court to grant dispensation of the formalities under Section 12A of the 2015 Act.

4) It is no more *res integra* that the provisions of Section 12A of the 2015 Act are mandatory in view of the decision of the Supreme Court rendered in [***Patil Automation Private Ltd. & Ors. v. Rakheja Engineers Private Ltd.,***] ***(2022) 10 SCC 1.*** The law is also well-settled now that on the basis of the averments in the plaint, the Court on being satisfied that the plaintiff contemplates urgent interim relief, the mandatory formalities under Section 12A of the 2015 Act can be dispensed with at the discretion of the Court. As to how a Court is to consider the plaintiff(s) contemplation of urgent interim relief has been explained by the Supreme Court in the judgment reported in ***2026(4) SCC 815 : AIR 2026 SC 5158 [Novenco Building &***

Industry A/S v. Xero Energy Engg. Solutions (P) Ltd. & Anr.]. The authority available to the Court for the scrutiny of the plaint at the time of presentation of plaint is provided in the judgment of the Supreme Court rendered in (***Yamini Manohar v. T.K.D. Keerthi) [2024(5) SCC 815].***

5) On a perusal of the plaint, for the limited scrutiny as has been directed by the Supreme Court in ***Yamini Manohar (supra)*** it appears from the paragraph 27 of the plaint that "In or around the third week of July 2026, the Plaintiff received specific and credible intelligence through its dedicated field investigators, revealing that unauthorised and illicit counterfeiting operations were actively being carried out in certain parts of Muzaffarpur, Bihar". " The information specifically indicated that defendant no. 1 was carrying on such counterfeiting activities equipped with mechanised cigarette making, packing and allied machinery". Pursuant thereto, through discreet inquiries and sustained monitoring, the plaintiff conclusively identified that defendant no. 1 engaged in the business of manufacturing, processing and trading in cigarette and tobacco products from its facility in Muzaffarpur, Bihar was orchestrating and operating these illicit manufacturing and distribution activities.

6) It further appears from paragraph 28 of the plaint, that the plaintiff made an First Information Report (in short, FIR) in terms whereof search and seizure operations were conducted on 22nd July, 2026 which reveal the illegal and wrongful activities of the defendant no. 1.

The plaintiff, thereafter has provided the details of recovery of goods and articles in course of search and seizure.

7) The plaintiff then refers to paragraphs 78, 79 and 85 of the pliant to seek dispensation of the mandatory formalities under Section 12A of the 2015 Act. By referring to the averments in these paragraphs the plaintiff says that it has suffered continuing wrong at the instance of the defendants and in particular defendant no. 1 and as such in connection with its intellectual property rights and as such is entitled to dispensation with the formalities of Section 12A of the 2015 Act in view of the ratio laid down in ***Novenco (supra)***.

8) The issue which fell for consideration in ***Novenco (supra)*** has been stated in page 823, paragraph 20 of the said judgment which reads as follows:

> *"The issue which arises for consideration in this appeal is whether a suit alleging continuing infringement of patent and design rights, accompanied by a prayer for interim injunction, can be said to contemplate urgent relief within the meaning of Section 12-A of the Act, notwithstanding certain delay in its institution"*

9) Before one goes into the findings in ***Novenco (supra)*** it should not be lost sight of the fact that each case is decided on the facts of such case. In ***Novenco (supra)*** when the matter was considered by the Supreme Court in October, 2025 an year and half had elapsed from the date of filing of the suit which was instituted on 4th June, 2024. The appeal before the High Court was decided on 13th November, 2024. The Hon'ble Supreme Court by an order dated 7th February,

2025 directed the plaintiff (appellant before the Supreme Court) to proceed with mediation. The mediation failed on 23rd June, 2026.

10) The main logic in the ***Novenco (supra***) judgment appears from paragraphs 21 and 22 the relevant portions whereof are set out hereunder:-

> *"21. The subject matter of the present action is continuing infringement of intellectual property. Each act of manufacture, sale, or offer for sale of the infringing product constitutes a fresh wrong and recurring cause of action. It is well-settled in law that mere delay in bringing an action does not legalise an infringement and the same cannot defeat the right of the proprietor to seek injunctive relief against the dishonest user"*

> *"22. From the standpoint of the appellant, each day of continuing infringement aggravates injury to its intellectual property and erodes its market standing. The urgency, therefore, is inherent in the nature of the wrong and does not lie in the age of the cause but in the persistence of the peril. The court cannot be unmindful of the fact that intellectual property disputes are not confined to the private realm. When imitation masquerades as innovation, it sows confusion among consumers, taints the marketplace and diminishes faith in the sanctity of the trade. The public interest, therefore, becomes the moral axis upon which the urgency turns. Therefore, the public interest element, need to prevent confusion in the market and to protect consumers from deception further imparts a colour of immediacy to the reliefs sought."*

In this background the Hon'ble Supreme Court in paragraph 24 of the said report has held as follows:

> *"24. The learned Single Judge [Novenco Building & Industry A/S v. Xero Energy Engg. Solutions (P) Ltd., 2024 SCC OnLine HP 4266] as well as the Division Bench [Novenco Building & Industry A/S v. Xero Energy Engg. Solutions (P) Ltd., 2024 SCC OnLine HP 5795] of the High Court erred in construing the test for urgent relief enumerated in Section 12-A of the Act, inasmuch as the courts have proceeded to examine the entitlement of the*

> *appellant to urgent relief based on the merits of the case rather than looking at the urgency as is evident from the plaint and the documents annexed thereto from the standpoint of the plaintiff. The High Court has proceeded on the premise that lapse of time between the appellant's discovery of infringement and filing of suit negated the element of urgency. Such an approach, in our considered view, is contrary to the principles laid down by the decisions of this Court. The High Court has also failed to take into account that the present action is one of the continuous infringement of intellectual property."*

11) In the light of the observations made in paragraphs 21, 22 and 24 as in ***Novenco (supra)*** if we analyse the facts of the instant case it will be seen that the delay is not more than a month and the cause of action, if any arises out of infringement of intellectual property of the plaintiff coupled with passing off but the striking dissimilarity is that the plaintiff immediately upon coming to know about the illicit manufacturing and distribution activities of the defendant no. 1 approached the police authorities. Both under the Trademark Act, 1999 (hereinafter referred to as 1999 Act) and Copyrights Act, 1957 (hereinafter referred to as 1957 Act) there is a measure against applying false trademark and trade description or for providing services to which false trade mark or false trade description is applied. Sections 103 and 104 of the 1999 Act while Section 63 of the 1957 Act provides for the same. This right is available to a party in addition to the right to bring a civil action for infringement and passing off.

12) The plaintiff, therefore, was specifically aware about the illegal and wrongful acts of the defendant no. 1 in July, 2026. The plaintiff therefore at that point of time could have either gone to police authorities with a complaint invoking the provisions of 1999 Act or could have approached the competent Civil Court by filing a suit alleging infringement and passing off. The plaintiff also could have at the same time maintained the criminal and civil action since such remedy are independent of each other. The plaintiff, however, chose one of the remedies available to it by lodging an FIR with the police authorities which led to search and seizure by keeping the other remedy in abeyance though the same was available. The plaintiff at that juncture on its own volition did not approach the competent Civil Court on the apprehension that its goods and services were being infringed or passed off though the right to sue had for the first time accrued in July, 2026 in favour of the plaintiff. A continuing cause of action as held in ***Novenco (supra)*** is available to an owner of an intellectual property. This revives the cause of action and keeps the same alive but a suit is required to be filed in case of urgency when the right to sue first accrues.

13) The plaintiff by relying upon Novenco (supra) has tried to project a picture that in case of intellectual property where delay in approaching the Court is not fatal, the Court has to exercise its discretion to dispense with the formalities of 12A of 2015 Act as it always require an urgent interim relief. I am unable to accept such

restricted interpretation of the mandatory provisions of Section 12A of 2015 Act by agreeing with such submission of the plaintiff. This name interpretation will lead to a conclusion that in case of suits relating to intellectual property matters irrespective of the accrual of the right to sue accruing for the first time a suit can be instituted by dispensing with the provisions of Section 12A of 2015 Act whenever the plaintiff approaches the Court. This will also render the mandatory provisions of Section 12A of the 2015 Act otiose in case of intellectual property matters which is not the legislative intention when suits relating to intellectual property right has been specifically included in the 2015 Act.

14) The judgment of ***Novenco (supra)*** has been considered by a majority of High Courts but there has been explanation to the ratio laid down in ***Novenco (supra)*** which is not in substantive deference to the view expressed in ***Novenco (supra)***. The notable amongst such judgments is a Division Bench judgement of this Court reported in ***2026 SCC Online Cal 12021 (Goodfaith Holding (P) Ltd. v. Supreme Wood Productys (P) Ltd.)*** and a Division Bench judgment of Bombay High Court reported in ***2026 SCC Online Bombay 9115 (High Point Supply Co. LLC v. Agati Healthcare (P) Ltd.)***.

15) In the aforesaid facts and circumstances when the plaintiff has absolutely chosen a specific avenue out of the two roads simultaneously available to the plaintiff for the selfsame cause, I am unable to grant dispensation of the mandatory provisions of Section

12A of the 2015 Act as the ratio laid down in ***Novenco (supra)*** is not applicable to the facts of the instant case.

16) Since the plaint has been only filed in the Central Filing Section and has only been allotted a number, the plaint does not actually enter the records of the Court unless presented and admitted, the plaint is directed to be returned for being filed after completion of the pre-suit mediation formalities along with Court fees with leave to use the same Court fees for instituting the suit on selfsame cause if needed so arise after the pre-suit mediation subject to complying with the provisions of applicable law. The department, after return of the plaint on completing the requisite formalities shall de-register the suit number allotted so that the matter is not shown to be pending.

Urgent photostat certified copy of this judgment and order, if applied for, be supplied to the parties on priority basis after compliance with all necessary formalities.

(Arindam Mukherjee, J)