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

\# **CNR No. DLHC010096982024**

\+ CS(COMM) 182/2024

ITC LIMITED .....Plaintiff

Through: Mr. Hemant Singh, Ms. Mamta Jha, Ms. Shruttima Ehersa, Ms. Aiswarya Debadarshini and Ms. Sanya Srivastava, Advocates.

versus

STC TOBACCO PVT LTD & ORS. .....Defendants

Through: Mr. Lakshya Gupta and Mr. Saurabh Kumar, Advocates for D-4.

**CORAM:**
**HON'BLE MS. JUSTICE JYOTI SINGH**

**O R D E R**

**% 16.09.2026**

**O.A. 212/2024**

1. This chamber appeal is filed on behalf of the Appellant, who is Defendant No. 4 in the suit under Rule 5 Chapter II of Delhi High Court (Original Side) Rules, 2018 challenging order dated 21.11.2024 passed by the learned Joint Registrar in I.A. 10350/2024 filed under Order I Rule 10 CPC, whereby the application was dismissed, declining to delete the Appellant from the array of parties.

2. Learned counsel for the Appellant submits that I.A. No. 10350/2024 was filed for deletion of the Appellant as there is no cause of action against the said Defendant. Appellant uses the registered mark GOLD FALCON, which is totally dissimilar to Plaintiff's trademark GOLD FLAKE. Even the investigator in his report has made no mention of any manufacture or sale of the impugned products bearing the mark GOLD FALCON. Moreover,



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Appellant is the registered proprietor of the said mark under registration No.5321295 and it is settled law that there can be no infringement action against the proprietor of a registered trademark and hence, no injunction can be granted against use, by the proprietor of a registered trademark, of the mark in the Class in which it is registered in his favour, on the ground of infringement and to buttress this plea, reliance is placed on the judgment of the Division Bench of this Court in ***Sana Herbals Private Limited v. Mohsin Dehlvi and Another, 2026 SCC OnLine Del 21***. It is, therefore, urged that the impugned order be set aside and Appellant be deleted from the array of parties.

3. Mr. Hemant Singh, learned counsel for the Plaintiff strenuously opposes the appeal and submits that Appellant is a necessary party to the present suit, which is for infringement as also passing off. He submits that there are serious allegations against Defendant No. 4 in the plaint, both individually and jointly and severally with other Defendants, for using deceptively similar trademark and the websites of Defendants No.1 to 7 have listings of cigarettes bearing the impugned mark, in addition to sales through offline stores. It is also argued that though an infringement action can be taken against a registered proprietor, in any event, the present suit is also for passing off and being guilty of both infringement and passing off, Appellant cannot seek deletion at this stage. The learned Joint Registrar is right in holding that the extent of commercial use of the impugned mark by the Appellant or the extent of his involvement are a matter of trial and cannot be a ground to delete a necessary party at this stage and thus, there is no legal infirmity in the impugned order.

4. Faced with the argument of Mr. Hemant Singh, learned counsel for



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the Appellant submits that even if the Plaintiff is right that the suit includes relief of passing off, the learned Joint Registrar ought to have deleted the Appellant *qua* the relief of infringement and continued the proceedings limited to the relief of passing off.

5. Upon hearing the learned counsels and on perusal of the impugned order dated 21.11.2024, this Court finds no infirmity in the order, warranting interference in the present appeal. Learned Joint Registrar has dismissed the application for deletion and rightly so, on the ground that the submission of the Appellant that there is no material to show that the infringing products are manufactured by the Appellant or there is no commercial use of the mark/label GOLD FALCON, cannot be accepted at the face value inasmuch as whether or not there is actual manufacturing or distribution of the cigarettes under the mark GOLD FALCON and if so, to what extent the Appellant is involved, are matter of trial.

6. As for the argument of the Appellant that Plaintiff has not furnished any proof of use of the impugned mark in course of trade and hence, there is no cause of action, Joint Registrar has noted that in the plaint itself, a picture of a pack of cigarettes bearing the mark GOLD FALCON has been reproduced and investigator's report appended to the suit *prima facie* shows availability of cigarettes bearing the mark GOLD FALCON on online platforms. Court agrees with the view taken by the learned Joint Registrar that in light of the material on record, at this stage, no ground for deletion of the Appellant is made out. Plaintiff has placed on record material *prima facie* showing sale of cigarettes bearing the mark GOLD FALCON and there are pleadings in the plaint that Appellant along with Defendants No. 1 to 3 and 5 to 7 has been manufacturing, distributing, storing and selling



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cigarettes under the impugned mark. Whether or not these averments are factually correct and if correct, the extent of involvement of the Appellant and his commercial use, can only be assessed after evidence is led.

7. The argument of the Appellant that he may be deleted *qua* the relief of infringement is wholly untenable in law. Present suit is both for infringement of trademark and passing off and Mr. Hemant Singh is right in his submission that remedy of passing off is a common law remedy and not dependent on the registration of Plaintiff's mark *albeit* he strenuously disputes that no action for infringement can lie against the Appellant. There can be no piecemeal deletion of a party dependent on the reliefs claimed in the suit and this argument is totally alien to the jurisprudence of impleadment/deletion of necessary/proper parties to a suit.

8. For all the aforesaid reasons, there is no merit in the appeal and the same is accordingly dismissed.

**CS(COMM) 182/2024 & I.As. 39411/2024, 44279/2024**

9. List before the learned Joint Registrar for further proceedings on 16.10.2026.

**JYOTI SINGH, J**

**SEPTEMBER 16, 2026**
***S.Sharma***



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