



2025:DHC:10358



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

% Judgment delivered on: 24/11/2025

+ **CS(COMM) 221/2024**

ITC LIMITED

.....Plaintiff

versus

PELICAN TOBACCO CO LTD & ORS.

....Defendants

Advocates who appeared in this case

For the Plaintiff : Mr. Arvind Nigam and Mr. Arvind Nayar, Senior Advocates with Ms. Mamta Rani Jha, Ms. Shruttima Ehersa, Ms. Aiswarya Debdarshini, Mr. Agnish Aditya, Mr. Akshay Joshi and Ms. Sanyukta Kaushik, Advocates.

For the Defendants : Mr. Sanjeev Bindal, Mr. Bharat Gupta, Mr. Krishna Nagri and Mr. G.S. Singh, Advocates.

CORAM:

HON'BLE MR. JUSTICE TEJAS KARIA

JUDGMENT

TEJAS KARIA, J

I.A. No. 5805/2024 and I.A. 30198/2024

1. I.A. 5805/2024 has been filed under Order XXXIX Rules 1 and 2 of Code of Civil Procedure, 1908 ("CPC") seeking injunction restraining infringement of Trade Mark, Copyright, and passing off of the Trade Marks



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‘GOLD FLAKE’ and ‘



, and ‘



and the Trade Dress ‘



and ‘

2. The Plaintiff is involved in the trade and manufacture of cigarettes under the Plaintiff’s Marks, Plaintiff’s Labels and the Plaintiff’s Trade Dress (“**Plaintiff’s Product**”). The Defendants are using the Marks, ‘GOLD FIGHTER’ and ‘GOLD FLAME’ (“**Impugned Marks**”), the labels, ‘



, and ‘



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Labels”) and ‘ , ‘ , ‘



’ (“**Impugned Trade Dresses**”) for sale of Cigarettes (“**Infringing Products**”).

3. *Vide* Order dated 13.03.2024, an *ex-parte ad-interim* injunction was granted in favour of the Plaintiff restraining the Defendants by themselves or through directors, partners or proprietors as the case may be, group companies, associates, divisions, firms, assignees in business, licensees, franchisees, dealers, distributors, their principal officers, servants, distributors and agents, and all others acting for and on behalf of the Defendants from manufacturing, selling, offering for sale, advertising, directly or indirectly dealing in any cigarettes bearing the Impugned Marks and Impugned Labels and / or any other Trade Mark / Trade Dress and get up / packaging / logo as may be identical to and / or deceptively similar to



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the Plaintiff's Marks and the Plaintiff's Trade Dress.

4. I.A. 30198/2024 has been filed under Order XXXIX Rule 4 of CPC for vacation of *ex-parte* Order dated 13.03.2024.

SUBMISSIONS ON BEHALF OF THE PLAINTIFF

5. The learned Senior Counsel for the Plaintiff made the following submissions:

5.1. The Plaintiff is the exclusive proprietor and user of the Plaintiff's Mark for more than a hundred years. The Mark 'GOLD FLAKE' was originally adopted by the Plaintiff's predecessor-in-interest on or about the year 1905, for use in relation to cigarettes and later in 1910, the Mark 'GOLD FLAKE' was assigned to the Plaintiff. The Plaintiff has been using the Mark 'GOLD FLAKE' openly, continuously and extensively in India for more than hundred years and over the years, has created numerous variants under the Plaintiff's Marks, and even the word 'GOLD' has become synonymous only with the Plaintiff in so far as cigarettes are concerned, while 'GOLD FLAKE', 'GOLD' and 'FLAKE' have attained their own identity severally and jointly.

5.2. The Plaintiff has received Trade Mark registrations for the Plaintiff's Marks and the Plaintiff's Labels. The details of the Trade Mark registrations for the Plaintiff's Mark and the Plaintiff's Labels are as under:



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S.No.	Trade Mark	Registration No.	Class & Goods Description
1.		7678 11/11/1942	34 Manufactured tobacco
2.		348904 04/05/1979	34 Manufactured tobacco
3.		755715 06/05/1997	34 Manufactured tobacco, including cigarettes included in class 34
4.		1299540 27/07/2004	34 Tobacco (raw or manufactured), smokers articles and matches including safety matches and wax matches



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5.		2379737 14/08/2012	34 Manufactured tobacco, raw tobacco, tobacco smokers' articles, matches, cigarettes, cigars cigarillos, cigar accessories including humidors, cigar ashtrays, cigar matches, cigar cutters, cigarettes, cigarettes
6.		377013 12/06/1981	34 Manufactured tobacco



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5.3. The Plaintiff's Trade Dress including the Plaintiff's Labels constitutes original artistic work and has received Copyright registration. The details of the Copyright Registrations received by the Plaintiff for the Plaintiff's Trade Dress are as under:

Application Date	Registration No.	Artistic Work
26.04.2010	A-124191/2018	
26.04.2010	A-124187/2018	
10.11.2020	A-95699/2013	



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18.07.2011	A-99121/ 2013	
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5.4. The Plaintiff has spent a considerable amount of time, effort and financial resources in building the Plaintiff's Marks in the Indian market, which can be gauged from the fact that Plaintiff's cumulative sales turnover for the Plaintiff's Marks and its variants since the year 1996 to 2024 is ₹3,74,288 Crores and sales figures for the Financial Year ("FY") 2023-2024 alone are ₹40,186 Crores.

5.5. The Mark 'GOLD FLAKE' has been recognized to be a well-known Trade Mark by the High Court of Madras in *ITC Limited v. Golden Tobacco Limited*, 2018 SCC OnLine Mad 2437, and the reputation and goodwill over the Plaintiff's Mark has been granted protection by various courts across the country, including by this Court.

5.6. Defendant Nos. 1 and 2 are a group of companies involved in manufacture, supply and sale of cigarettes under the Impugned Marks ("Infringing Products"). Defendant No. 3 is the dealer of Defendant Nos. 1 and 2 and engaged in bulk supply of cigarettes under the Impugned Marks. Around October 2023, the Plaintiff discovered that the Infringing Products were being sold. The Plaintiff hired a private investigator to ascertain the extent of sale of the Infringing Products and the investigator submitted the investigation report dated



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15.02.2024 which revealed that the Defendants are selling the Infringing Products under the Impugned Marks and the Impugned Labels.

5.7. The Defendants have replicated all essential features of the Plaintiff's Marks and the Plaintiff's Labels. The Defendants' minor variation, substituting 'K' with 'M' to form 'GOLD FLAME' from 'GOLD FLAKE', is a superficial change that does nothing to dispel confusion or deception. The Defendants' adoption is not innocuous but a deliberate act to ride upon the goodwill and reputation of the Plaintiff's Marks and to create an injurious association in the minds of consumers that the Infringing Products are related to the Plaintiff's Products.

5.8. The learned Senior Counsel for the Plaintiff relied on **Kaviraj Pandit Durga Dutt Sharma v. Navaratna Laboratories**, AIR 1965 SC 980, **Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd.**, (2001) 5 SCC 73, **Laxmikant Patel v. Chetanbhai Shah**, 2002(3) SCC 65, **Amar Singh Chawal v. Shri Vardhman Rice & Genl. Mills**, ILR (2009) VI Delhi 399 and **South India Beverages v. General Mills Marketing**, 2014 SCC Online Del 1953 to submit that all the conditions for a claim for passing off to be established have been met in the present case. The Plaintiff's Marks and the Impugned Marks are deceptively similar, they are visually and phonetically similar, the nature of the Marks is similar, the consumer base and the class of consumers is also similar. Along with infringement of the Plaintiff's Marks, the Defendants have also tried to pass off the Infringing Products as that of the Plaintiff.



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5.9. The Defendants have besides adopting the Impugned Marks that are deceptively similar to the Plaintiff's Marks have also adopted the Impugned Labels and the Impugned Trade Dress that is deceptively similar to the Plaintiff's Labels and the Plaintiff's Trade Dress. There can be no explanation for the Defendants' use of deceptively similar Trade Dress for goods identical to those sold by the Plaintiff, but to ride upon its goodwill and reputation. Reliance was placed on ***Ruston & Hornby Ltd. v. Z. Engineering Co.***, AIR 1970 SC 1649, ***Gorbatschow Wodka KG v. John Distilleries Ltd.***, 2011 SCC Online Bom 557 and ***Faber Castell & Anr. v. Cello Pens Pvt. Ltd. & Anr.***, 2016 (65) PTC 76 [Bom] to submit that the Defendants having adopted the dominant features of the Plaintiff's Trade Dress in the Impugned Trade Dress amounted to passing off of the Infringing Products as the products of the Plaintiff.

5.10. Cigarettes as a product are sold to consumers of all walks of life, who rely on the imperfect recollection of the overall Trade Dress. There is no side-by-side comparison of the Plaintiff's Product and the Infringing Products and the consumers may not comprehend the minute differences in Trade Dress or Trade Mark. Further, cigarettes are not always sold in packs, but as loose sticks and the miniscule branding thereon is identical. A retailer might take advantage of this close similarity to sell the Infringing Products as opposed to the genuine cigarette to reap higher profits. Such initial interest confusion leads to infringement of the Plaintiff's Marks and the Plaintiff's Labels. The Defendants' argument that consumers know the taste of



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the cigarettes is immaterial since by the time the consumer consumes the products, initial interest confusion has already taken place.

5.11. Reliance was placed on ***Parle Products Pvt. Ltd. v. J.P. & Co. Mysore*** (1972) 1 SCC 618, and ***Baker Hughes Limited v. Hiroo Khushalani & Anr.***, 1998 (V) AD (Delhi) 525, to submit that even if pursuant to purchasing the Infringing Products the consumers realise that the Infringing Products are in fact not the products of the Plaintiff, the same still gives rise to the category of confusion identified as ‘Initial Interest Confusion’. Causing Initial Interest Confusion in the minds of the consumers will also lead to Infringement of the Plaintiff’s Marks.

5.12. The Defendants have raised a misconceived plea that the Plaintiff’s Trade Dress and the Plaintiff’s Marks are different from the Impugned Trade Dresses and the Impugned Marks. However, microscopic analysis of competing Trade Dresses is impermissible. Any minor differences are wholly insufficient to negate the similarity between the Trade Dress, especially in view of feature-by-feature copying of Trade Dress and get up and deceptively similar Marks.

5.13. The Supreme Court in ***Kaviraj Pandit (supra)*** has clearly held that infringement is made out, once the broad essential features of the plaintiff’s registered mark have been copied. The Supreme Court in ***Cadila (supra)*** has specifically overruled the judgment of ***S.M. Dychem Ltd. v. Cadbury (India) Ltd.***, (2000) 5 SCC 573 which is cited by the Defendants.

5.14. The plea raised by the Defendants that the display area for the Impugned Marks is limited due to the statutory requirement under the



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Cigarettes and Other Tobacco Products (Prohibition of Advertisement and other Regulation of Trade and Commerce, Production, Supply and Distribution) Act, 2003 mandating 85% space for health warnings is wholly misconceived and untenable. To the contrary, the limited available space for branding only heightens the likelihood of confusion and deception. Given this statutory restriction, the imitation by the Defendants of the Plaintiff's Marks, along with the Plaintiff's Labels, becomes even more prominent and misleading. The Defendants' argument is further weakened by the fact that they have extended the infringement to the cigarette sticks themselves, which bears a roundel device deceptively similar to the Plaintiff's Labels. This clearly demonstrates deliberate intent to mimic and pass off their products as those of the Plaintiff.

5.15. A consumer of average intelligence and imperfect recollection or not well-versed in English would be unable to distinguish between the competing products. The substantial similarity in the competing Trade Dresses, colour scheme, and layout, coupled with the confined branding space, significantly increases the risk of confusion in the minds of the consuming public.

5.16. The Defendants have wrongly alleged that there is delay in filing the Suit on the ground that in 2020 and 2021 the Plaintiff filed oppositions against the Defendant's applications for the mark 'GOLD



FLAME' and ' '. The said applications claim use since 2015 and therefore, there is a delay. However, such a plea is wholly misconceived as the Plaintiff has fairly disclosed the



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pending Opposition proceedings, *inter se* the Parties, however, the Infringing Products were not found at the time of the said proceedings. The Plaintiff has disputed the user claim during the Opposition proceedings itself. The Defendant has filed forged and fabricated documents in all its applications. The Plaintiff has filed the present Suit in 2024 once the Infringing Products have become available on the e-commerce platforms.

5.17. The Plaintiff has continuously filed oppositions against the Defendants, therefore, there is no acquiescence. Acquiescence requires a clear and positive act of consent, which is absent in the present case. The Plaintiff has consistently and unequivocally opposed the Defendants' adoption and use of Marks containing the Plaintiff's Marks.

5.18. The Defendants have failed to explain how they came about the Impugned Marks, Impugned Trade Dress and the Impugned Labels. Such imitation itself evinces the dishonesty of the Defendants. The defence of delay or laches is not available to a party that has adopted a Mark dishonestly. No amount of subsequent use can confer any right to a party that has adopted a Trade Mark, being fully aware of the rights of another. There is no justification for the Defendant to adopt the Impugned Marks when it is well-aware of the repute of the Plaintiff's Marks.

5.19. In ***Midas Hygiene (P) Ltd. v. Sudhir Bhatia***, 2004 SCC OnLine SC 106 and ***Hindustan Pencils Pvt. Ltd. v. India Stationery Products*** 1989 SCC OnLine Del 34, it was held that delay in filing a suit is not a ground to deny injunction, when the adoption is in itself



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dishonest. The Defendants' reliance on unrelated marks such as 'PERIS GOLD' and 'FUN GOLD' is misplaced. These registrations have no bearing on the present dispute, which concerns the deliberate imitation of the Plaintiff's Marks. The Defendants have copied the structural elements, Plaintiff's Labels, overall visual layout, label format, and colour scheme of the Plaintiff's Trade Dress.

5.20. The Defendants have also applied to claim registration over the term 'GOLD FLAME' and other such 'GOLD' formative marks, and therefore, it is estopped in claiming that 'GOLD' is generic. Defendants have not placed on record any actual evidence to show that 'GOLD' is common to trade prior to the adoption by the Plaintiff. The Plaintiff is not expected to sue every small infringer. Further, use by third-party is not a valid defence for infringement of Trade Marks as has been held in the case of **Pankaj Goel v. Dabur India Ltd.** 2008 SCC OnLine Del 1744. The Defendants have also applied to claim registration over the term 'GOLD FLAME' and other such GOLD formative marks, and therefore it is estopped from claiming that Gold is generic. A party cannot approbate and reprobate as has been held in the decisions in **RN Gosain v Yashpal Dhir**, (1992) (4) SCC 683 and **Automatic Electric Limited v. R. K. Dhawan** 1999 SCC OnLine Del 27.

5.21. The Defendant's plea that because the Plaintiff has increased its revenues, there is no legal injury to the Plaintiff is wholly facetious. The fact that the Plaintiff's figures have increased makes no difference to the aspect of infringement. The high sales figures itself indicates the reason for copying the overall Trade Mark / Trade Dress



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/ Copyright. The Plaintiff is suffering notional loss of sales due to diversion of trade, apart from significant injury to its brand equity through misappropriation of goodwill and dilution of its distinctiveness. The unlawful gains and profits derived by the Defendants through sale of Infringing Products are liable to be accounted for and restored to the Plaintiff. In ***Ruston & Hornsby (supra)***, it has been held that in cases of Trade Mark infringement, it is not necessary for the Plaintiff to prove actual deception or quantifiable damage. The mere likelihood of confusion or association is sufficient.

5.22. The Plaintiff has invested huge resources in its brand ‘GOLD FLAKE’, including ensuring that it meets impeccable quality standards. To the contrary, the Defendant is free to manufacture and sell cigarettes using any other brand and trade dress. The Defendant has already given an undertaking that it has stopped manufacturing the Infringing Products. There is no reason that the injunction should not be made absolute. The *prima facie* case, balance of convenience and irreparable injury is in favour of the Plaintiff.

5.23. ‘GOLD’ has evolved beyond its ordinary meaning within the cigarette industry to become indelibly associated with the ‘GOLD FLAKE’ brand, thereby acquiring a secondary meaning. This transformation implies to consumers that ‘GOLD’ specifically relates to the ‘GOLD FLAKE’ brand, affording it a level of protection even against otherwise descriptive use. The Plaintiff has established secondary meaning in the term ‘GOLD’ and the Mark, ‘GOLD FLAME’. The Supreme Court in ***Pernod Ricard India (P) Ltd. v.***



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Karanveer Singh Chhabra, 2025 SCC OnLine SC 1701, has held that rights can be claimed in descriptive Marks once it is established that the descriptive Marks have acquired secondary meaning through extensive and exclusive use and are uniquely associated with the plaintiff's goods in the mind of the public.

5.24. Accordingly, the *ex-parte ad-interim* injunction granted vide Order dated 13.03.2024 shall be made absolute until the disposal of the present Suit.

SUBMISSIONS ON BEHALF OF THE DEFENDANT NOS. 1 AND 2

6. The learned Counsel for Defendants No. 1 and 2 made the following submissions:

6.1. The Plaintiff was aware of the Impugned Marks since the year 2012, since when the Plaintiff first came across Applications filed by Defendant Nos. 1 and 2 for registration of the Marks, 'PARIS GOLD', 'FLAME', 'GOLD FLAME', 'GOLD FAME', 'GOLD



FRAME' and ' '. The Plaintiff admittedly became aware of Defendant Nos. 1 and 2's Mark, 'GOLD FLAME' in Class 34 in 2017 and filed opposition proceedings against the Mark, 'GOLD FLAME' on 08.05.2020 even though Defendant Nos. 1 and 2 have filed Application for registration of the Mark, 'GOLD FLAME' with user detail of 01.11.2015.

6.2. There is a delay of more than seven years in filing the present Suit since the Plaintiff is aware about the Impugned Marks since 2017, a delay of four years from the filing of opposition proceedings before the Trade Mark Registry, and a delay of six months since the



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Infringing Products were found by the Plaintiff in open market. Plaintiff's knowledge of the use of the Impugned Marks since at least 2017 but inaction until 2024 undermines urgency and supports the finding of acquiescence. In ***Essel Propack Ltd. v. Essel Kitchenware Ltd.***, 2016 SCC OnLine Bom 937, the Bombay High Court dismissed the case of the plaintiff on the ground that the plaintiff sat over its rights for a long period of time before asserting them. The Supreme Court in ***Toyota Jidosha Kabushiki Kaisha v. Prius Auto Industries Ltd.***, (2018) 2 SCC 1, dismissed the appeal of the plaintiff on the ground of delay in filing the appeal.

6.3. The Plaintiff is attempting to proclaim monopoly over common descriptive marks and elements common to tobacco, cigarette, etc. covered under class 34. Under the Trade Marks Act, 1999 ("**Trade Marks Act**"), exclusive rights are only for the mark as a whole, not for common components. Monopoly cannot be claimed over descriptive and laudatory common words. There is nothing exclusive or inherently distinctive about Plaintiff's use of the mark 'GOLD' in the Plaintiff's Marks or the Plaintiff's Trade Dress.

6.4. In ***Jain Riceland Pvt. Ltd. v. Sagar Overseas***, 2017 SCC OnLine Del 11305, this Court allowed the application under order 39 rule 4 to vacate the interim injunction against the defendants and was clear when laying down the dictum that generic words cannot acquire distinctiveness. In ***Yatra Online Limited Vs. Mach Conferences and Events Limited*** (2025) SCC Online DEL 5610, this Court held that generic and commonly descriptive words cannot be protected under common law of passing off.



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6.5. Defendant Nos. 1 and 2 conceived and adopted 'GOLD FLAME' in the year 2015 and have been using it since, consistently and extensively. The Impugned Marks, Impugned Labels and the Impugned Trade Dress and Plaintiff's Marks, Plaintiff's Labels and the Plaintiff's Trade Dress are not visually or structurally deceptive or confusingly similar and hence, even an action of passing off would not be maintainable. Detailed comparative analysis of Plaintiff's Trade Dress with the Impugned Trade Dress clearly establishes the dissimilarities in the Plaintiff's Marks and the Impugned Marks and the Plaintiff's Trade Dress and the Impugned Trade Dress respectively. The only common element between the two is the word 'GOLD' and packaging in golden colour, which is a generic word and the Plaintiff cannot have a monopoly over the generic word 'GOLD' and the packaging in golden colour.

6.6. Buyers in the tobacco market purchase cigarettes by name, minimizing possibility of confusion. Consumers of tobacco products particularly cigarettes are usually frequent buyers and are reasonably well-informed hence confusion is highly unlikely. Defendant in its Trade Dress explicitly states 'Pelican's', thereby having no intention of passing off its products as Plaintiff's products. In **S.M. Dyechem** (supra), the Supreme Court held that defendants' name on the goods was an indication that there was no passing off, even though the trade dress might be similar.

6.7. The Plaintiff's submission that there is an imitation of the Plaintiff's Labels which are in Roundel shape, is wholly misconceived as the Impugned Label for 'GOLD FLAME' Mark is on a rectangular



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background and 'GOLD FIGHTER' Mark is on a hexagonal background thereby clearly distinguishing the visual representations in the Defendants' Products and the Plaintiff's Product. Third-party tobacco products are also sold under the Mark 'GOLD' and other formative 'GOLD' Marks, Golden Colour Trade Dress and Trade Dress similar to the Plaintiff's Trade Dress.

6.8. This Court in **Wow Momo Foods Private Limited v. Wow Burger & Another** in CS(COMM) 1161/2024 and I.A. 48983-48984/2024, denied interim injunction to the plaintiff asserting their right over the word 'wow' considering the common nature of the word 'wow' and similarly the Plaintiff cannot monopolise the word 'GOLD' considering that the word 'GOLD' is very common and accordingly, the *ex-parte ad-interim* injunction granted *vide* order dated 13.03.2024 deserves to be vacated.

6.9. The Plaintiff's own disclosure shows exponential growth in turnover and profits, negating claims of loss or dilutive harm. On the contrary, the injunction has caused the Defendants, being a very small player in the industry, irreparable loss and injury, as its business has been completely halted. The Plaintiff has suppressed material facts about its knowledge and market awareness of Defendants' Products, thereby misleading the Court in order to secure an *ex-parte ad-interim* injunction against the Defendants, which if brought before this Court earlier, it may have not granted *ex-parte ad-interim* injunction against the Defendants.

6.10. Accordingly, the *ex-parte ad-interim* injunction granted *vide* Order dated 13.03.2024 deserves to be vacated.



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SUBMISSIONS ON BEHALF OF THE DEFENDANT NO. 3

7. Defendant No. 3 has not entered appearance despite multiple opportunities and is proceeded *ex-parte*.

ANALYSIS AND FINDINGS

8. A Trade Mark indicates the source of the goods or services, in respect of which it is used. A Trade Mark is an indicator of origin, distinguishing the goods and services of a party from those of its competitors. Thus, a Trade Mark is said to possess a distinctive character, when it serves to identify and distinguish the goods or services of a party from those of others. In the present case, the Plaintiff's Marks serves as a source indicator for the products provided by the Plaintiff. Therefore, the Plaintiff's Marks have attained a distinctive character and have become identifiers and distinguish the goods of the Plaintiff from those of other parties, including, from those of the Defendants. By extensive, continuous, and prolonged usage, the public at large commonly associates the Mark 'GOLD FLAKE', with the Plaintiff. The Impugned Marks are deceptively similar to the Plaintiff's Marks.

9. The test of infringement and passing off laid down in the decisions of ***Kaviraj Pandit (supra)***, ***Cadila Health Care (supra)***, ***Laxmikant Patel (supra)***, ***Amar Singh (supra)*** and ***South India Beverages (supra)*** has been made out in the present case. The Plaintiff's Marks and the Impugned Marks are deceptively similar, they are visually and phonetically similar, the nature of the Marks is similar, the consumer base and the class of consumers is also similar. The Plaintiff's Marks and the Impugned Marks are visually and phonetically identical, the Plaintiff and the Defendants are dealing in a similar category of products. The Plaintiff has established that the Defendant



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has not only infringed the Plaintiff's Marks, the Defendants have also tried to pass off the Infringing Products as the products of the Plaintiff.

10. Not only the Impugned Marks are deceptively similar to the Plaintiff's Marks, the Impugned Trade Dress and the Impugned Labels are also deceptively similar to the Plaintiff's Trade Dress and the Plaintiff's Labels. The Plaintiff has relied upon the decisions in ***Ruston & Hornby (supra)*** ***Gorbatschow Wodka (supra)*** and ***Faber Castell (supra)*** to submit that the Defendants having adopted the dominant features of the Plaintiff's Trade Dress in the Impugned Trade Dress amounted to passing off of the Infringing Products as the products of the Plaintiff. Copying of essential features of the Plaintiff's Trade Dress while dealing with the Infringing Products leads to the finding that the Defendants have tried to pass off the Infringing Products as the products of the Plaintiff. Accordingly, an action of passing off has also been established by the Plaintiff against the Defendants.

11. The Cigarettes and Other Tobacco Products (Prohibition of Advertisement and other Regulation of Trade and Commerce, Production, Supply and Distribution) Act, 2003, mandates that the cigarette packages must contain health hazard of cigarettes and accordingly, a major portion of a box of cigarettes is covered by health hazards and warning to the consumers, what little portion is left for the sellers of cigarettes to customize as per their marketing strategy becomes even more prominent and stark similarity among competing sellers in the limited space available to them would increase the likelihood of confusion among the consumers of the competing products.

12. This Court in ***Under Armour Inc v. Anish Agarwal*** 2025 SCC OnLine Del 3784, held that the initial interest confusion test proceeds on the



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principle that confusion in the minds of consumers may arise at the preliminary stage, prior to the actual purchase being completed. At the point of finalising the transaction, the consumer may no longer be in doubt as to the true origin of the goods or services. Nonetheless, even such transient confusion at the initial stage is sufficient to meet the requirement of deceptive similarity under Section 29 of the Trade Marks Act. The infringer's objective may be served merely by diverting the consumer's initial attention. The consumer may, thereafter, consciously opt for the infringer's product on account of its own characteristics, with complete knowledge that it is unconnected with the registered Trade Mark. The Defendants' use of the Impugned Marks is with the purpose of causing confusion in the mind of the customers to generate sales of the Infringing Products riding upon the goodwill of the Plaintiff's Mark. The Defendants cannot be allowed to take advantage of the Plaintiff's goodwill and use a Mark that is deceptively similar to the Plaintiff's Marks in order to generate sales of the Infringing Products.

13. The learned Counsel for the Plaintiff has relied upon ***Midas Hygiene (supra)*** and ***Hindustan Pencils (supra)*** to submit that delay in filing a suit is not a ground to deny injunction, when the adoption is in itself dishonest. The learned Counsel for the Respondent has relied upon the decisions in ***Essel Propack (supra)*** and ***Toyota Jidosha (supra)*** to submit that delay in filing a suit for injunction would be detrimental to the case of the Plaintiff. In cases of infringement of Trade Mark an injunction must follow and merely delay, if any, in seeking the remedy of injunction cannot be a ground to deny injunction to the Plaintiff as has been held in the cases of ***Midas Hygiene (supra)*** and ***Hindustan Pencils (supra)***. Further, as held in ***Midas Hygiene***



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(*supra*) where the adoption of the Marks is *prima facie* dishonest, grant of an injunction becomes necessary. The Defendants have failed to come up with a plausible reason as to how the Defendants came up with the Impugned Marks, accordingly, the use of the Impugned Marks, is *prima facie* dishonest.

14. The Plaintiff is not expected to sue every small infringer and use of Marks, deceptively similar to the Plaintiff's Marks, by third-parties is not a valid defence against infringement of Trade Marks as has been held by this Court in **Pankaj Goel** (*supra*). The plea of the Defendant Nos. 1 and 2 that the Plaintiff has not been able to show damages due to the introduction of the Infringing Products in the market is not a valid plea in a case of infringement of Trade Marks. It is trite law that mere likelihood of confusion is enough to establish a case of infringement of Trade Marks and actual confusion is not required to be demonstrated.

15. The learned Counsel for the Defendant Nos. 1 and 2 have relied on **Jain Riceland** (*supra*), **Yatra Online Limited** (*supra*) and **Wow Momo** (*supra*) to submit that the Plaintiff cannot establish monopoly over the use of the word 'GOLD' as the word 'GOLD' is a very common. The word 'GOLD' has nothing to do with cigarettes in normal context, it is the Plaintiff who has started using the word 'GOLD' with respect to cigarettes. The Plaintiff has acquired substantial goodwill in the Plaintiff's Marks and the Mark 'GOLD FLAKE' has also been declared a well-known Mark by the High Court of Madras in **ITC Limited** (*supra*). The Plaintiff has been using the Mark 'GOLD FLAKE' as a composite Mark for over a hundred years and has built a reputation and market for the Plaintiff's Products under the Plaintiff's Marks. Considering the overall similarities in



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the Plaintiff's Marks and the Impugned Marks, the Plaintiff is entitled to protection of the Plaintiff's Marks.

16. The decision in **Wow Momo** (*supra*) has been set aside by the Division Bench of this Court in **Wow Momo Foods Private Limited v. Wow Burger and Anr.**, 2025:DHC:9320-DB, with the finding that the dominant feature of the rival marks is the word 'WOW' and applying the dominant feature test, a *prima facie* case of infringement was made out. Applying the dominant feature test to the present case, the dominant feature of the Plaintiff's Marks and the Impugned Marks is the word 'GOLD' and, therefore, a *prima facie* case of infringement is made out against the Defendant's use of the Impugned Marks.

17. The use of the word 'GOLD' has become indelibly associated with the Plaintiff's Product and thereby the Mark 'GOLD' has acquired a secondary meaning within the cigarette industry. The Plaintiff has successfully established that the Plaintiff has acquired secondary meaning in the term 'GOLD' and the Mark, 'GOLD FLAME' with respect to cigarettes. The Supreme Court in **Pernod Ricard India** (*supra*), has once again reiterated that the rights can be claimed in descriptive Marks once it is established that the descriptive Marks have acquired secondary meaning through extensive and exclusive use and are uniquely associated with the plaintiff's goods in the mind of the public. The Plaintiff has been able to meet the threshold laid down in **Pernod Ricard India** (*supra*).

18. The Plaintiff is the registered proprietor of the Plaintiff's Marks with the earliest registration for the Mark 'GOLD FLAKE' in India was in the year 1942. The Plaintiff has been using the Mark 'GOLD FLAKE' in India continuously since the year 1905 with respect to cigarettes. The Plaintiff has



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demonstrated the goodwill and reputation acquired by the Plaintiff's Marks. The Plaintiff has earned considerable revenue of ₹40,186 Crores for FY 2023-24 selling the Plaintiff's Products under the Plaintiff's Marks. The Defendants' use of the Impugned Marks is dishonest and is nothing but an attempt to ride the goodwill and reputation of the Plaintiff's Marks so as to cause confusion in the market. Further, the Mark 'GOLD FLAKE' has been recognized to be a well-known Trade Mark by the High Court of Madras in *ITC Limited (supra)*.

19. Further the test of confusion is to be seen from the perspective of an average person with imperfect recollection getting confused and in view of the Plaintiff's Marks and the Impugned Marks being almost identical, any ordinary person would get confused and would not be able to distinguish between the Plaintiff's Marks and the Impugned Marks.

20. Having considered the submissions advanced by the learned Counsel for the Parties, the pleadings and the documents on record, a strong *prima facie* case has been made out on behalf of the Plaintiff for grant of interim injunction.

21. The Plaintiff has established its prior user as well as goodwill and reputation, on the basis of the documents on record. Injunction is a relief in equity, and in view of the aforesaid discussion, the same is in favour of the Plaintiff and against the Defendants. Further, the balance of convenience also lies in favour of the Plaintiff and against the Defendants and grave prejudice is likely to be caused to the Plaintiff if interim injunction as prayed for is not granted in favour of the Plaintiff and against the Defendants.

22. The Defendants have replicated all essential features of the Plaintiff's Marks and the Plaintiff's Labels. The Defendants' minor variation,



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substituting 'K' with 'M' to form 'GOLD FLAME' from 'GOLD FLAKE' does not make the competing Marks dissimilar. Cigarettes are purchased by all classes of consumers and when sold loose, the consumers may not check the exact spelling before purchasing the Infringing Product.

23. This is a case of triple identity where the Plaintiff's Marks and the Impugned Marks are identical, the product category is identical and the trade channel as also the consumer base is identical. The Plaintiff being the prior user, adopter of the Mark 'GOLD FLAKE' is entitled to protection. The identity in the Impugned Marks is so close to the Plaintiff's Marks that they are indistinguishable.

24. In view of the above, injunction granted in favour of the Plaintiff and against the Defendants *vide* Order dated 13.03.2024 is confirmed and made absolute and shall continue during the pendency and till final disposal of the present Suit.

25. Accordingly, I.A. 5805/2024 is allowed and, consequently, I.A. 30198/2024 filed by the Defendant Nos. 1 and 2 for vacation of the *ex-parte ad-interim* injunction granted *vide* Order dated 13.03.2024 is hereby dismissed. Both the Applications stand disposed of.

TEJAS KARIA, J

NOVEMBER 24, 2025

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