

IN THE HIGH COURT AT CALCUTTA  
INTELLECTUAL PROPERTY RIGHTS DIVISION

IA NO.GA-COM/10/2026  
IN  
IP-COM/22/2025  
(OLD NO. CS/133/2010)

M/S. SAMBHU NATH & BROTHERS & ORS.

VS

JAI REJENDRA IMPEX PVT. LTD. & ORS.

BEFORE:

The Hon'ble JUSTICE ARINDAM MUKHERJEE

Date: 12<sup>th</sup> August, 2026.

APPEARANCE:

Mr. Debnath Ghosh, Sr. Adv.

Mr. Gautam Kumar Ray, Adv.

Mr. T.K. Jana, Adv.

Mr. Sourav Jana, Adv.

Mr. Biswaroop Mukherjee, Adv.

For plaintiffs

Mr. Sarosij Dasgupta, Adv.

Mr. Arindam Chandra, Adv.

Mr. Atish Ghosh, Adv.

Ms. Neha Gupta, Adv.

For defendants

THE COURT: This is an application by the plaintiffs for appointment of an Advocate-Commissioner to record the evidence. The plaintiffs say that the suit is restricted to only "passing off action". However, on a reading of the various paragraphs of the plaint with the relief claimed as in prayer (b) though it appears that the predominant cause of action of the plaintiffs as

pleaded in the plaint is for “passing off action” but it cannot be conclusively said that the plaintiffs have not at all alleged about infringement of its registered trade mark. The fact scenario has got further complicated when the two registered trade marks standing in the name of the defendant no.1 have been cancelled and/or expunged.

The order of cancellation passed by the Hon’ble High Court at Judicature at Madras has been challenged before the Hon’ble Supreme Court by the defendants by filing a Special Leave to Appeal (C) having numbers 3178-3179/2026. In the said Special Leave to Appeal by an order dated 27<sup>th</sup> January, 2026 the Hon’ble Supreme Court directed issuance of notice and further directed the parties to maintain status quo as on the date of passing of impugned judgment. The operative portion of the order passed by the Hon’ble Supreme Court on 27<sup>th</sup> January, 2026 is set out hereunder for convenience.

*“Issue notice to the respondents on the merits of the dispute only and not on the maintainability of the Letters Patent Appeal before the Division Bench of the High Court.*

*Mr. Ashutosh Yadav, learned counsel accepts notice for the respondent(s)-caveator(s).*

*We have heard learned senior counsel for the respective parties on the interim prayer sought for by the petitioner(s) herein.*

*On hearing them, we find that having regard to the issues raised on merits in these Special Leave Petitions, both sides are directed to maintain status quo as on the date of passing of the impugned judgment.”*

The defendants had filed an application for rectification of the plaintiffs' registered mark. The said application, however, has been dismissed for default on 30<sup>th</sup> April, 2025. There is no application for restoration as of now. The defendant no.1 has now come with an application under Section 124 of the Trade Marks Act, 1999 for stay of the suit.

The peculiar facts and circumstances of the instant case as recorded hereinabove has, therefore, made a simple application for appointment of an Advocate-Commissioner to record evidence into a complex nature. In the event the Hon'ble Supreme Court does not interfere with the order impugned, the cancellation of the mark of the defendant no.1 will continue. In that case unless the plaintiffs' mark is cancelled, the plaintiffs continue to be the registered owner of the trade mark. The plaintiffs, therefore, will have apart from the right to assert passing off, the right to contend infringement of its registered mark. Although, the plaintiffs assure the Court that the plaintiffs will only restrict the trial to passing off action but allowing the recording of evidence to continue the plaintiffs will be, in the case the defendant is unsuccessful before the Supreme Court lose their right to enforce infringement. The facts scenario will be different if the Hon'ble Supreme Court allows the Special Leave to Appeal thereby setting aside the order of cancellation of the registered trade mark of the defendant no.1 passed by the High Court of Madras.

Since the defendants have filed an application for stay of the suit which is, however, not germane to the passing off action and keeping in mind that the plaintiffs by their own admission will waive the right to assert

infringement even if the same is conferred on them, subsequently for the reasons as aforesaid, I am inclined to appoint an Advocate-Commissioner to record the evidence. The plaintiffs say as on date they intend to examine only two witnesses before the Commissioner.

In the aforesaid facts and circumstances, Ms. Sananda Mukhopadhyay, learned advocate (a member of the Bar Library Club, Mobile No.9836081263) is appointed as the Advocate-Commissioner for recording evidence of the plaintiffs' two witnesses. The expenses for holding the Commission to record evidence except the legal fees to be borne by the defendants shall have to be paid by the plaintiffs which will broadly include the fees of the Commissioner, the venue charges, if any, and the secretarial costs and expenses. The Advocate-Commissioner will be entitled to a remuneration of Rs.20,000/- per sitting. The Advocate-Commissioner shall in consultation with the parties fix the remuneration of her secretary/clerk.

The plaintiffs shall request the Registrar, Original Side of this Court to depute responsible officer/officers to carry the record to the venue of the Commission on the dates fixed for the Commission and also return the same back on completion of the day's work to be paid by the plaintiff.

The expenses of carrying the record and bringing the same back shall also be borne by the plaintiffs. The entire exercise of recording of the evidence in chief and cross-examination by the defendants shall be concluded by 24<sup>th</sup> December, 2026. The learned Commissioner is requested not to grant unnecessary adjournment to the parties or fix dates after long gap and shall make an endeavour to conclude the evidence by the time period provided.

The suit is for the time being directed to go out of the list with liberty to the parties to mention the same on completion of the evidence or in case of any other eventuality.

The application being IA NO.GA-COM/10/2026 is accordingly disposed of.

(ARINDAM MUKHERJEE, J.)

Sb/