IN THE HIGH COURT AT CALCUTTA
(Intellectual Property Rights Division)
ORIGINAL SIDE

BEFORE:

The Hon'ble Justice Ravi Krishan Kapur

IA NO. GA/4/2023
[OLD NO CS/269/2022]
In IP-COM/6/2025

FOX AND MANDAL AND ANR.
Vs
SOMABRATA MANDAL AND ORS.

For the plaintiffs	: Mr. S.N Mookherjee, Senior Advocate Mr. Soumya Roy Chowdhury, Advocate Mr. Paritosh Sinha, Advocate Ms. Deepti Priya, Advocate Ms. S. Khanun, Advocate
For the defendant nos. 1 and 2	: Mr. Dhiraj Kumar Trivedi, Senior Advocate Mr. Indranil Munshi, Advocate
Heard on	: 24.07.2026
Judgment on	: 24.08.2026

Ravi Krishan Kapur, J.:

1. "*The foibles of mankind in its daily life are to be found large in the records of the law*" (R.E. Megarry*: "Miscellany at Law" at page. 55*). This is only one such example. Significantly, despite the intervention of the Hon'ble Supreme Court, repeated attempts at Mediation were futile.

2. This is an application under Order XIII A of the Code of Civil Procedure, 1908 as amended by the Commercial Courts Act, 2015, praying for a summary judgment.

3. The suit is for passing off. Notwithstanding service of the Writ of Summons and lapse of the prescribed period, the defendants have not filed any Written Statement.

4. Briefly, the plaintiff no. 1, (the firm) is a registered partnership which had been constituted in 1896 and is engaged in providing legal and other similar services. Originally, the firm began as a partnership between Mr. John Kerr Fox, an English attorney and Mr. Gokul Chandra Mandal, an Indian attorney. The firm has been carrying on business operations and using the mark Fox & Mandal since 1896. In or about, March 2006, the firm had obtained registration in Class 42, claiming user since 1 January 1896. The firm is also a proprietor of a number of other marks bearing numbers 5422726, 5415105, 4089423 and 4089465 respectively. With the passage of time, the plaintiff no. 1 and its partners have also set up a limited liability partnership being the plaintiff no. 2. The firm is probably the only example of an Indo-British joint venture in the legal profession to have been in continuous existence for more than 125 years.

5. Post the death of John Kerr Fox, the firm was reconstituted in the year 1922 with the induction of other partners and since then the firm has undergone several reconstitutions. G. C. Mandal died on 28th November, 1930. Sudhir Kumar Mandal, who was also a Solicitor of great repute, became a partner of

the firm. In course of time, Dinabandhu Mandal in 1973 and then, Arun Kumar Mandal in 1984 alongwith the proforma defendant no.3, Asoke Kumar Dhar amongst others became partners of the firm. The proforma defendant no.4, Debanjan Mandal became a partner of the firm in 2004. Dinabandhu Mandal expired on 30 June, 2020 and Arun Kumar Mandal expired on 17 May, 2023. The present partners of the reconstituted firm are Asoke Kumar Dhar and Debanjan Mandal.

6. The defendant No. 2 is a partnership firm constituted in 1984 by the then partners of the plaintiff firm, including Late Dinabandhu Mandal, Late Arun Kumar Mandal, Asoke Kumar Dhar, together with others and is engaged in the same line of providing legal services. Significantly, the defendant no. 1 was neither a partner nor an employee of the firm. He and his wife have always been associated with the defendant no.2 and intentionally chose to remain outside the firm.

7. The grievance of the plaintiffs is directed against the misrepresentation and distorted impression being given by the defendant nos. 1 and 2 in holding themselves out or having any connection or association with the firm. In this context, the plaintiffs have *inter-alia* highlighted articles and press releases whereby a misleading and deceptive impression has been deliberately given by the defendant nos. 1 and 2 that they are connected to and represent the firm.

8. For the record, upon the filing of the suit, the plaintiff had filed an interlocutory application. By an order dated 15 November, 2022, this Court

had, *inter alia*, restrained the defendant nos. 1 and 2 from holding themselves out as the firm i.e. Fox and Mandal or representing that the defendant nos. 1 and 2 have any connection or relation with the services rendered by the firm. Being aggrieved by the order, the defendant nos. 1 and 2 had preferred an appeal which was dismissed on 16 November, 2022 without interfering with the ad interim order. Subsequently, the defendant nos. 1 and 2 had also preferred a Special Leave Petition which was also dismissed as withdrawn on 16 February, 2023. The application for interim reliefs was ultimately disposed of by an order dated 27 September 2023, confirming the ad interim orders. Being aggrieved by the judgment and order dated 27 September 2023, the defendant nos. 1 and 2 had preferred an appeal which was also dismissed. In such circumstances, there is a subsisting interim order whereby the defendant nos. 1 and 2, their mens, agents, servants and assigns have been restrained from holding themselves in any manner whatsoever of being associated with the plaintiff no. 1 or the plaintiff no. 2 or claiming any legacy in the year of establishment of the plaintiff no. 1 or passing off their firm or legal services as that as the plaintiff no. 1 or the plaintiff no. 2, as also from using their marks ‘Fox and Mandal’, ‘Fox & Mandal’ or ‘F&M’.

9. It is contended on behalf of the plaintiffs that insofar as the case of passing off is concerned, there are no triable issues which have been raised by the defendants. All the ingredients of passing off are admitted and proved. There is no real prospect of the defendants successfully defending the claim nor is there any other compelling reason as to why the reliefs sought for in this

application should not be disposed of without recording any oral evidence. In the absence of a Written Statement, the averments in the plaint stand admitted under Order 8 Rule 3A and 5 of the Code of Civil Procedure, 1908. In support of such contentions, the plaintiffs rely on *M/s. Power Control Appliances & Ors. vs. Sumeet Machines Pvt. Ltd. (1994) 2 SCC 448, Laxmikant V. Patel vs. Chetanbhai Shah & Anr. (2002) 3 SCC 65, Prakash Glass and Rubber Works & Anr. vs. Hindusthan Safety Glass Works Private Limited Anr. (2006) 2 CHN 555, Bhagwan Dass Khanna Jewellers vs. Bhagwan Das Khanna Jewellers Pvt. Ltd. (2013) 53 PTC 287, Byford vs. Oliver & Anr. [2013] All ER (D) 345 (Ch), S. Syed Mohideen vs. P. Sulochana Bai (2016) 2 SCC 683, Su-Kam Power Systems Ltd. vs. Kunwer Sachdev (2019) SCC OnLine Del 10764, Indus Cityscapes Constructions Pvt. Ltd. vs. Karismaa Foundations (2019) SCC OnLine Mad 39416, KR Impex vs. Punj Llord Limited (2019) SCC OnLine Del 6667, Mallcom (India) Ltd. vs. Rakesh Kumar & Ors. (2019) SCC OnLine Del 7646, Singh & Singh Law Firm LLP vs. Singh & Singh Lawyers LLP (2021) SCC OnLine Del 3059, Anchor Investments Private Limited vs. TCI Finance Limited (MANU/WB/1719/2022), Jayanta Saha vs. Janki Bhagwan Dansingani (2023) SCC OnLIne Cal 2148, Kamal Kumar Hirawat vs. Maruti Poly Films and Ors. (IP-COM No. 15 of 2024), Manoj Poddar vs. Stellar (2024) SCC OnLIne Cal 8434, Satyam Infoway Ltd. vs. Siffiynet Solutions (P) Ltd. (2024) 6 SCC 145, Edible Products India Ltd. vs. Shalimar Chemical Works Private Ltd. (2025) SCC OnLine Cal 9444.*

10. On behalf of the defendant nos. 1 and 2, it is contended that the defendant no. 1, Somabrata Mandal, being one of the legal heirs of Late Dinabandhu Mandal (as partner of the firm) has a right in the shared goodwill of the firm. The mark "Fox & Mandal" is a family mark and the defendants cannot be deprived use of the same. In fact, the defendant no. 1's mark had been registered prior to that of the firm's mark which had been registered as an associate mark with the Trademark Registry. In this connection, the defendant no. 1 had also granted a No Objection Certificate to the plaintiffs to register the mark "Fox & Mandal". The plaintiffs are also not entitled to any relief on the ground of delay or acquiescence. In any event, the plaintiffs need to show actual damage to succeed in an action for passing off which they have failed to demonstrate. In such circumstances, the present disputes cannot be adjudicated in a summary manner and the application is liable to be dismissed. In support of such contentions, the defendant nos. 1 and 2 rely on *Habib Bank Ltd. vs. A.G. Zurich [1980] EWCA Civ J 1218-2, M/s. Power Control Appliances & Ors. vs. Sumit Machines & Ors. (1994) 2 SCC 448, Swain v. Hillman & Anr. MANU/UKWA/0649/1999, Royal Brompton Hospitals NHS Trust v. Hammond & Ors. [2002] UKHL 14, Three Rivers District Council & Ors. v. Governor and Company of the Bank of England (No 3) [2003] 2 AC 1, ED&F Man Liquid Products Ltd. v. Patel & Anr. [2003] EWCA Civ 472, Ramdev Food Products (P) Ltd. vs. Arvind Bhai Ram Bhai Patel & Ors. (2006) 8 SCC 726, Doncaster Pharmaceuticals Group Ltd. & Ors. v. The Bolton Pharmaceuticals Company 100 Ltd. [2006] EWCA Civ 661, ICI Chemicals & Polymers Ltd. v. TTE Training Ltd. [2007] EWCA Civ 725,*

Khoday Disterilies Limited vs. Scotch Whisky Association & Anr. 2008 (10) SCC 723, BCH Electric Limited vs. Eaton Corporation & Anr. 2016 SCC OnLine Del 3639, Global Asset Capital Inc v. Aabar Block SARL [2017] 4 WLR 163, Bright Enterprises Private Limited v. MJ Bizcraft LLP & Anr. [2017] SCC OnLine Del 6394, Lungowe & Ors. v. Vedanta Resources Plc & Anr. [2019] UKSC 20, Syrma Technology Pvt. Ltd. v. Powerwave Technologies Sweden AD & Anr. 2020 SCC OnLine Mad 5737.

11. The "classic trinity" of reputation, misrepresentation and damage to goodwill are the basic ingredients in order to succeed in an action for passing off. "*Misrepresentation lies at the heart for an action of passing off."* (Kerly's Law of Trade Marks and Trade Names 16th Edition at Page 744). The question whether use of a particular indicia results in passing off the goods or services as those of the plaintiff is, in substance, a question of fact. The principle of law is that nobody has the right to represent his or her goods as the goods of somebody else which include the use of particular words, style, marks or indicia. This has also been described as a source identifier. In a passing off action, the Court is not concerned with the truth or falsity of the statements in the defendant's advertisements except so far as to induce the belief that the defendant's goods or business or services are that of the plaintiff.

12. In *Satyam Infoway Ltd. v. Siffynet Solutions (P) Ltd (Supra)* it has been held as follows:

> *13. The next question is, would the principles of trade mark law and in particular those relating to passing off apply? An action for passing off, as the phrase "passing off" itself suggests, is to restrain the defendant from passing off its goods or services to the*

public as that of the plaintiff's. It is an action not only to preserve the reputation of the plaintiff but also to safeguard the public. ***The defendant must have sold its goods or offered its services in a manner which has deceived or would be likely to deceive*** *the public into thinking that the defendant's goods or services are the plaintiff's. The action is normally available to the owner of a distinctive trade mark and the person who, if the word or name is an invented one, invents and uses it. If two trade rivals claim to have individually invented the same mark, then the trader who is able to establish prior user will succeed.* ***The question is, as has been aptly put, who gets these first?*** *It is not essential for the plaintiff to prove long user to establish reputation in a passing-off action. It would depend upon the volume of sales and extent of advertisement.*

14. The second element that must be established by a plaintiff in a passing-off action is ***misrepresentation by the defendant to the public****. The word misrepresentation does not mean that the plaintiff has to prove any mala fide intention on the part of the defendant. Of course, if the misrepresentation is intentional, it might lead to an inference that the reputation of the plaintiff is such that it is worth the defendant's while to cash in on it. An innocent misrepresentation would be relevant only on the question of the ultimate relief which would be granted to the plaintiff [Cadbury Schweppes v. Pub Squash, 1981 RPC 429 : (1981) 1 All ER 213 : (1981) 1 WLR 193 (PC); Erven Warnink v. Townend, 1980 RPC 31 : (1979) 2 All ER 927 : 1979 AC 731 (HL)] . What has to be established is the* ***likelihood of confusion in the minds of the public*** *(the word "public" being understood to mean actual or potential customers or users) that the goods or services offered by the defendant are the goods or the services of the plaintiff.* ***In assessing the likelihood of such confusion the courts must allow for the "imperfect recollection of a person of ordinary memory"*** *[Aristoc v. Rysta, 1945 AC 68 : (1945) 1 All ER 34 (HL)] .*

32. ***Another facet of passing off is the likelihood of confusion with possible injury to the public and consequential loss to the appellant****. The similarity in the name may lead an unwary user of the internet of average intelligence and imperfect recollection to assume a business connection between the two. Such user may, while trying to access the information or services provided by the appellant, put in that extra 'f' and be disappointed with the result. Documents have been filed by the defendant directed at establishing that the appellant's name Sify was similar to other domain names such as Scifinet, Scifi.com, etc. The exercise has been undertaken by the defendant presumably to show that the word "Sify" is not an original word and that several marks which were phonetically similar to the appellant's trade name are already registered. We are not prepared to deny the appellant's claim merely on the aforesaid basis. For one, none of the alleged previous registrants are before us. For another, the word "sci-fi" is an abbreviation of "science fiction" and is phonetically dissimilar to the word Sify. (See Collins Dictionary of the English Language.) (emphasis added)*

Similar decisions which reiterate the above principles are *Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd., (Supra); Laxmikant V. Patel v. Chetanbhai Shah, (Supra); Ramdev Food Products (P) Ltd. v. Arvindbhai Rambhai Patel, (Supra); and Brihan Karan Sugar Syndicate (P) Ltd. v. Yashwantrao Mohite Krushna Sahakari Sakhar Karkhana, (Supra).*

13. Since the demise of Late Dinabandhu Mandal, disputes and differences had arisen between the parties and the defendant no.1 has intentionally and mischievously caused a number of publications, advertisements, brochures, online articles in the media and other display materials including on their website with the intent to filch and ride on the goodwill of the firm by claiming an association and relation with the firm. The defendant no.1 has been falsely representing to the public and the world at large that he is still part of the plaintiff firm and in falsely claiming legacy of the firm and in the name 'Fox and Mandal'. Such intentional acts have been deliberately orchestrated by the defendant no.1 simply to trade on the goodwill of the firm and create confusion and deception amongst the public.

14. The defendant No. 1 and his wife, Sangeeta Mandal, came to be inducted as partners of defendant No. 2 only on 15 March 1996. It is the *nexus* which is unlawfully sought to be created by a trade rival that amounts to misrepresentation. The deliberate acts of the defendants are aimed towards creating a kind of deception or confusion and the likelihood thereof as to who is the real "Fox and Mandal" and that is where the *Rubicon* has been crossed. The attempt of the defendants to create an association, commercial or otherwise, with the firm is the misrepresentation to the public. The question to be asked is why are the defendants doing this save and except to claim an association or relation with the firm where none exists? In this context, any *free riding* is impermissible. There is nothing such as good and bad free riding. All the impugned acts are aimed towards creating confusion and deception as to the *source* of the defendants and any attempt to claim

such association with the plaintiffs is ultimately targeted at causing damage or the likelihood thereof to the plaintiffs. The impugned acts clearly suggest that a connection still exists between the plaintiff firm and the defendants. Such deception is anchored not only from the indicia being relied on by the defendants but also from a cumulative appreciation of any relation that the defendants seek to unlawfully portray. [*Singh & Singh Law Firm LLP v. Singh + Singh Lawyers LLP (Supra), Laxmikant V. Patel v. Chetanbhai Shah, (Supra)* and *Edible Products (India) Ltd. v. Shalimar Chemical Works (P) Ltd., (Supra)*].

15. The admitted facts of this case would reveal that the plaintiff no. 1 is the prior user of the mark "Fox and Mandal", "Fox & Mandal" and "F&M". The reputation and goodwill of the firm has also not been disputed. Admittedly, the plaintiffs have been using the marks since 1896 continuously, extensively and uninterruptedly. On the other hand, it is also an admitted position that the defendant nos.1 and 2 are subsequent adopters of an identical and deceptively similar mark, claiming to be user only since 1986. As a proposition of law, it is well settled that a prior user has a superior right and is entitled to protection in an action for passing off against a subsequent user. [*S. Syed Mohideen v. P. Sulochana Bai, (Supra)*].

16. It is also an admitted fact that the firm is a partnership concern in which the defendant no.1 and the defendant no.2 have never been partners. This was a conscious decision taken by the defendant nos. 1 and 2 during the lifetime of Dinabandhu Mandal and the path which they had chosen. There is no merit in the contention that any goodwill associated with the mark of the firm should be attributed jointly or concurrently by any of the individual

partners. *"Goodwill generated by a partnership is a partnership asset"* (Kerly's Law of Trade Marks and Trade Names, 16th Edition at page 756). To this extent, the efforts of individual partners, including Late Dinabandhu Mandal, are of no significance. It is settled law that only partners have a right to the property of the firm subject to contract and no third party can claim a right in the assets and properties of the firm. The marks are the property of the firm and do not belong to any person or partner individually or his heirs. *[Bhagwan Dass Khanna Jewellers vs. Bhagwan Das Khanna Jewellers Pvt. Ltd. (Supra), paragraphs 36, 37, 48 and 51], Boyford vs. Oliver & Anr., (2003) All ER(D) 3435 at paragraphs 19, 25 and 26].*

17. Insofar as the defendant no.1 having any right as one of the heirs of Late Dinabandhu Mandal is concerned, the same has already been the subject-matter of a separate suit being C.S. No.408 of 2024 where the defendant no.1 had, in view of clause 17 of the re-constituted deed of partnership dated 27th October, 2024, received in full and final satisfaction his entire monetary claim. The judgment and decree dated 28th July 2025 passed in the above suit has attained finality. The plaintiffs have also recorded satisfaction of the decree and the same has been disposed of by a Co-ordinate Bench on 9 December, 2025. In brief, the defendant no.1 has been paid the total amount under the decree and has appropriated the same. In such circumstances, the only claim which the defendant no.1 had as one of the legal heirs was an entitlement to monetary consideration which he has duly received. Accordingly, the defendant no.1 has no legal right of any kind whatsoever in the firm and consequently cannot claim any right in respect of

the assets of the same. It is true that nobody can deny the right of the defendant no.1's claim to be the great grandson of Late Gokul Chandra Mandal or one of the heirs of Late Dinabandhu Mandal, but that is wholly different from claiming any entitlement in the assets and marks of the firm.

18. There are two distinct hats which the defendant no.1 attempts to wear. One as son and heir of Late Dinabandhu Mandal. The other *eo nomine* in his own right. As far as an heir of Dinabandhu Mandal is concerned that chapter is now over. Insofar as any independent right is concerned, the defendant no.1 has consciously and of his own volition always remained out of the plaintiff no.1 firm and is for all purposes a stranger to the firm. This is the magic with legal personalities. The partnership remains. Everything else is history and counts for little in these cold Commercial Courts.

19. The contention raised on behalf of the defendant no. 1 that they had granted a No Objection Certificate to the plaintiffs to register the mark "Fox & Mandal" and the same is shown as an associate mark is irrelevant in the case of passing off. The entire story which has been engineered by the defendant no. 1 is without a shred of evidence. In any event in an action for passing off, registration is inconsequential. [*S. Syed Mohideen vs. P. Sulochana Bai (Supra)*].

20. The entire case of shared goodwill is illusory, sham and pure myth. The mark 'Fox and Mandal' is an asset of the plaintiff firm and was never an asset or property of any individual partner. The goodwill and reputation always remained with the firm. The right of the defendant no.1 as one of the

legal heirs of one of the deceased partners can only be considered in terms of the partnership deed dated October 27, 2014. There is no independent or separate right which the defendant nos. 1 or 2 can claim in the goodwill or reputation of the firm. In this context, all allegations made on behalf of the defendants that goodwill was developed and enjoyed through common and extensive use of inter-connected entities under the leadership of Late Dinabandhu Mandal have no foundational basis, even more in the absence of a written statement. The contention of the historical development and the role played by Dinabandhu Mandal, concurrent use, the existence of common partners and the evaluation of goodwill associated with the expression "Fox & Mandal" is a red herring. It is only the firm which has earned any reputation or goodwill and the efforts of the individual members of the firm over the century are inconsequential.

21. There is also no merit in the contention that the mark "Fox & Mandal" is a family mark. The firm is a separate juristic legal entity and there is nothing which the defendants have been able to demonstrate that the mark has ever been treated as a family mark. Admittedly, Mr. John Kerr Fox, who was one of the founding partners of "Fox & Mandal", was a total stranger to the Mandal family. In fact, it would be absurd to suggest that each and every member of the Mandal family even remotely connected with G.C. Mandal would be entitled to a right in the name "Fox & Mandal". This would lead to an irrational result of conferring rights upon the innumerable descendants of G.C. Mandal including those who are wholly unconnected with the firm. In this context, the decision in *Rajni Dua & Ors. v. Bhushan Kumar & Ors.*,

1998 SCC OnLine Del 620, is inapposite. This was a case concerning enforcement of a family arrangement. The goods were not only different in nature but were being sold by different branches of the family. The case involved the right of a family member to use the trade mark of a company which had been started by a common ancestor. There was also a family settlement. Moreover, there was no question of competing businesses between the parties. Similarly, in *Krishna Sweets Private Limited v. M. Murali, 2017 SCC OnLine Mad 4405,* there was a joint venture agreement and a subsequent assignment. This was not a case of a family mark. The mark was owned by the father and not a separate juristic entity.

22. The contention that the plaintiffs are not entitled to any relief on the ground of delay or acquiescence is equally unmeritorious. Acquiescence requires positive acts and cannot be inferred from mere silence or inaction. Similarly, delay is not a factor which disentitles the plaintiffs to relief. In view of the reconstitution of the firm and the decree in C.S. 408 of 2024, it would also be most unfair to permit the defendants to trade on the goodwill of the firm or claim any association with the plaintiffs. *Power Control Appliances v. Sumeet Machines (P) Ltd., (1994) 2 SCC 448* and *Ramdev Food Products (P) Ltd. vs. Arvind Bhai Ram Bhai Patel & Ors. (*Supra*).*

23. In any event, there can be *only one mark, one source and one proprietor.* Moreover, the defendant nos. 1 and 2, claiming to be trade rivals or joint owners, cannot simultaneously assert rights in the same mark of the firm or claim any association with the firm. There is simply no scope for elbowing. In such circumstances, the defendants have been unable to demonstrate a

modicum of a legal right in the firm and that is the harsh reality. In the absence of any legal standing in the plaintiff firm, whether as partner or an employee, the defendant nos. 1 and 2 have no semblance of a legal right to claim any association or relation with the plaintiff firm *qua* one of the heirs of Late Dinabandhu Mandal or even independently. All the issues sought to be raised by the defendants are a camouflage only to delay and procrastinate matters. There is no question of any trial or examination of witnesses or proof of any documents which would disentitle the plaintiffs to the grant of a summary judgment. This is not a case of mere confusion but one of deception, even more keeping in mind the common field of activity in which both the parties are involved. [*Anchor Investments Private Limited vs. TCI Finance Limited (Supra)* and *Jayanta Saha vs. Janki Bhagwan Dansingani (Supra)*].

24. There is also no merit in the contention that in an action for passing off, the plaintiffs are required to prove that they have suffered actual damages. On the contrary, the plaintiffs, in an action for passing off, can equally succeed even if there is a *likelihood* of injury or damage. Likelihood of damage is sufficient. [See *Laxmikant V. Patel -v- Chetanbhai Shah & Anr., (Supra); Satyam Infoway Ltd. -v- Siffynet Solutions (P) Ltd., (Supra at pr. 13 to 15); Prakash Glass and Rubber Works & Anr. v. Hindusthan Safety Glass Works Private Limited & Anr., (Supra @pr. 18)*].

25. The fact that there are others family members who are using the name 'Fox & Mandal', is also irrelevant. The plaintiffs, as *dominus litus,* have the right to choose who to sue. As a general principle, use by third parties cannot be a

defence in an action for passing off. [*Assam Roofing Ltd. & Anr. v. JSB Cement LLP & Anr. (Supra at pr. 88,89) and Edible Products (India) Limited v. Shalimar Chemical Works Private Limited (Supra at pr. 35,70)*].

26. As a note of caution, in the field of passing off, the applicability of previous decisions require utmost care and circumspect. Since the facts are always distinguishable, reference to other cases may not always be of any real assistance except analogically. The decision in *Habib Bank Ltd versus A.G. Zurich* (Supra) is of no assistance to the defendants. In this decision, on the given facts, the staff of the plaintiff and the defendant were freely interchangeable. There was a common origin. The argument of "*left the club*" is quite inapposite from the facts of this case where the defendant nos. 1 and 2 were "never in the club" to begin with. In *HDFC Bank PLC v. Midland Bank PLC (Supra),* the action failed because the plaintiff could not establish goodwill. This was a case of rebranding exercise and is inapplicable to the facts of this case. The decision in *Hodgkinson & Corby Ltd. v. Wards Mobility Services (Supra),* the case was not one of passing off but of the shape of a cushion. The marks of the plaintiff and defendant were admittedly different and the Court found that there was no confusion nor similarity. Similarly, *Lancer Trade Mark (Supra)* dealt with two kinds of cars, expensive and cheap. Significantly, the defendant had conceded that there was no real likelihood of visual confusion between the two marks. As a result, it was held that there was no real tangible danger of confusion between the two marks.

27. The conduct of the defendant nos.1 and 2 also deserves to be highlighted. Despite restraint orders being passed in this suit and notwithstanding having full notice and knowledge of the same, the defendant nos.1 and 2 have continued to wrongfully trace their history to that of the firm. The defendant no.2 has by various deliberate and intentional acts sought to create confusion and misrepresentation in tracing its history to 1896. Such examples are by showing an old clock which is displayed on their website and was used by the firm since 1896. Then again, by tracing or describing themselves as India's original and oldest full service law firm. Such acts, other than being in deliberate violation of restraint orders, amount to a misrepresentation and deception to the public at large that it has any association or is in any way connected with the firm and therein lies the deception or the likelihood thereof. All such intentional acts by the defendants only *tilt* the scale in favour of the plaintiffs and demonstrate a deliberate and calculated attempt towards misrepresentation, deception and the likelihood thereof.

28. In this background, the defendants have been unable to show any real prospect of defending the case of passing off. There are no triable issues raised by the defendant. It is true that non filing of the Written Statement does not automatically entitle a plaintiff to a decree. Nevertheless, the absence of a Written Statement is a vital factor in determining the requirement for a full-fledged trial. The defences raised are sham and incapable of succeeding. In such circumstances, there is no reason as to why the claim should not be disposed of without recording oral evidence. All

the ingredients to succeed in a claim for passing off i.e. (a) reputation of the goods or services (b) possibility of deception and misrepresentation (c) likelihood of damages to the plaintiffs are satisfied. In *Mallcom (India) Ltd. v. Rakesh Kumar, 2019 SCC OnLine Del 7646* it has been held as follows:

> ***24.*** *The test for summary judgment, as prescribed in Rule 3 of Order XIIIA of the CPC as applicable to Commercial Courts Act is, that "the defendant has no real prospect of successfully defending the claim" and that "there is no other compelling reason why the claim should not be disposed of before recording the oral evidence". Rule 1 of Chapter XA of the Delhi High Court (Original Side) Rules merely provides that "At the time of Case Management hearing, a Court, may of its own, decide a claim pertaining to any dispute, by a summary judgment, without recording oral evidence" and Rule 3 therein reiterates the language aforesaid of Rule 3 of Order XIIIA qua grounds for summary judgment.*

Similar views have also been held in *Su-Kam Power Systems Ltd. vs. Kunwer Sachdev (Supra at Paras. 90-92), Indus Cityscapes Constructions Pvt. Ltd. vs. Karismaa Foundations (Supra), Ahuja Radios vs. A. Karim (Supra), DS Confectionery Products Limited vs. Nirmala Gupta and Another (Supra), Medicare Limited vs. Maa Adishakti Multi trade Enterprises & Ors. (Supra).*

29. It is true that the jurisdiction under Order XIII A of the Code of Civil Procedure 1908 is to be exercised with care and caution. The legislative intent underlying the introduction of Order XIII A was never to dispense with a regular trial in every commercial dispute but to enable the Court to summarily dispose of only those issues where the Court is satisfied that the defendant has no real prospect of successfully defending the claim and that there is no other compelling reason for the matter to proceed to trial. The defendant need not at this stage establish that its defence would necessarily succeed. However, this does not mean that a Court is prevented from passing a summary judgment on the ground of every fanciful, illusory and

moonshine defence. In addition, in cases where a defendant has lost the right to file a Written Statement, this cannot be a circuitous attempt to take a second bite at the cherry. The questions being is there any real prospect of successfully defending the claim at trial or any other compelling reason why the claim should not be disposed of without recording any evidence. In such proceedings, the Court must also be alert to the fact that a defendant would tend to make every issue look more complicated and difficult than it really is. In this context, the decision in *Syrma Technology Pvt. Ltd. vs. Powerware Techonologies Sweden Ad & Anr. (Supra)* cited by the defendants is distinguishable and inapposite. In this decision, there was a manufacturing services agreement between the appellant and the holding company of the defendant. There were also a series of transactions between the parties. Then again, the Written Statement had been filed. The defendant had gone into liquidation and an Administrator had taken charge. It was in this background that after taking into consideration of the facts and circumstances of the case that the Court held that this was not a case where a summary judgment could be passed as there were triable issues.

30. Despite the pernicious practise of slipping additional authorities in the Note of Submissions which had not been cited in Court, all such decisions have been dealt with below. In *Rockwool International A/S & Anr. Vs. Thermocare Rockwool India Pvt. Ltd., 2018 SCC OnLine Del 11911,* the facts were distinguishable. The application under Order XIII A had been filed after the framing of issues and the question of whether the mark in question was a generic mark or not was found to be a triable issue. Similarly, in *Atanu*

Bhattacharjee and Anr. vs. Corporation Bank 2024 SCC OnLine Del 2399, there was no application as contemplated under Order XIII A and an oral plea for a summary judgment had been made. In *Karnani Properties Ltd. v. J.S. India Pvt. Ltd., 2025 SCC OnLine Cal 784,* it was found that the defendant had raised triable issues in the written statement in the nature of whether there was a commercial dispute or not, suppression of an earlier ejectment suit and there were other defences raised in the written statement. The Court had found the foundational facts for a summary judgment to be missing. In *Asha Dass & Ors. vs. Prime Road Solutions Pvt. Ltd. & Ors., 2021 SCC OnLine Del 3624,* the Written Statement had been filed and a positive defence taken that the electricity connection to the subject premises had been deliberately disconnected for a considerable period of time and hence this affected the liability of the defendant to pay rent or occupational charges. There was a real dispute on the given facts on the basis of which the Court refused to grant a summary judgment. Similarly, in *A2 Interiors Products Pvt. Ltd. v. Rahul Bhandari & Ors., 2022 SCC OnLine Del 2862,* the defendant had filed the Written Statement disputing the authenticity and delivery of invoices and asserting that only seventeen invoices had been raised. Additionally, there were contradictions in the case made out in the plaint which were found to be inconsistent with the plaintiff's own documents. In such circumstances, the Court held that the defendant had raised triable issues. In *Sudarshan Dhoop Pvt. Ltd. v. Hotel Queen Road Pvt. Ltd & Anr., 2022 SCC OnLine Del 2863,* the defendant had not only filed a Written Statement, but had also raised the plea of fraud and collusion challenging the very nature of the transaction as a loan which made it impossible for the Court to grant a summary judgment. There was also an issue of the evidentiary value of the ledger entries including the point of limitation which required a full-fledged trial. In *Northern ARC Capital Ltd. v. Sambandh Finserve Pvt. Ltd. & Ors., 2022 SCC OnLine Mad 2904,* in view of the preliminary issues of res judicata stamping and the RBI Guidelines, the Court refused to grant a summary judgment.

31. In *ICI Chemicals & Polymers Ltd. vs. TTE Training Ltd. (Supra),* the subject matter of the dispute dealt with a financing agreement dated March 6, 1990 and a subsequent agreement dated December 6, 2000 entered into by and between the parties. There was a subsisting jural relationship between the parties and this was a vital fact in ascertaining the true relationship between them. The decision in *ED&F Man Liquid Products Ltd. vs. Patel & Anr. (Supra),* is also distinguishable. This decision dealt with two shipments of alcohol for which the defendants were liable to be paid. It was found on facts after examination of the Witness Statement that the defendant had a real prospect of success. The decision in *Doncaster Pharmaceuticals Group Ltd. & Ors. vs. The Bolton Pharmaceuticals Company 100 Ltd. (Supra)* is also of no assistance to the defendants. This case concerned parallel imports of branded products from one Member State to another which required examination of European Union competition law and the doctrine of exhaustion of rights. Moreover, the detailed evidence in the form of Witness Statements, Exhibits, etc., which had been filed by the defendants was a crucial factor in determining the rights of the parties. It was on this basis

that the Court found that the defendants had made out a real defence and not a smoke screen defence. There were other compelling reasons on facts in not disposing of the suit in a summary manner. The decision in *Swain v. Hillman* (*Supra*) is also of no assistance to the defendants. That was a case in respect of personal injuries and did not involve the adjudication of any intellectual property right. The Court as a matter of fact found on the basis of the pleadings and evidence that there were disputed questions of fact which could not be examined in a summary manner. The decision in *Lungowe & Ors. vs. Vendanta Resources PLC & Anr.* (*Supra*) is also distinguishable. The facts did not relate to trademark infringement. It was held on facts that the case involved specialized and complex environmental litigation which made it unsuitable and difficult for summary determination. The decision in *Royal Brompton Hospital NHS Trust vs. Hammond and Others* (*Supra*) is also inapposite. This case concerned the statutory pre-conditions for contribution namely, whether two parties are "liable in respect of the same damage" under the Civil Liability Contribution Act, 1978. The factual scenario is different and involved a tripartite arrangement i.e. an architect, contractor and employer setting. The decision is confined to contribution and turned on the technical question of the "same damage" as between multiple wrongdoers.

32. In view of the above, this is a fit case for summary judgment and the prayer for a decree of perpetual injunction restraining the defendant Nos. 1 and 2, their men, servants, agents and assigns and other partners from holding themselves out in any manner whatsoever, of being associated with the

plaintiff No. 1 firm or the plaintiff No. 2, or claiming any legacy in the year of establishment of the plaintiff No.1 i.e., 1896 or passing off their firm or their legal services as that of the plaintiff No. 1 or the plaintiff No.2 and also from using the marks "Fox & Mandal", "Fox and Mandal" and "F&M" is granted. To this extent, GA 4 of 2023 stands allowed. There shall be a decree in terms of the above. The plaintiffs do not pray for any further reliefs in the suit. In view of the above, IP-COM 6 of 2025 also stands disposed of in terms of the above. All interlocutory applications stand disposed of. Let a decree be drawn up in terms of the above.

(Ravi Krishan Kapur, J.)

Later

After pronouncement of judgment, the defendants prays for stay of operation of the decree. The prayer for stay is considered and rejected.

(Ravi Krishan Kapur, J.)