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

% *Judgment delivered on: 10.04.2026*

+ **CS(COMM) 130/2025**

**ASHIANA ISPAT LIMITED** .....Plaintiff

versus

**KAMDHENU LIMITED** .....Defendant

+ **CS(COMM) 569/2025**

**M/S KAMDHENU LIMITED** .....Plaintiff

Versus

**M/S ASHIANA ISPAT LIMITED & ORS.** .....Defendants

**Advocates who appeared in these cases**

Mr. Chander M. Lall, Senior Advocate along with Mr. Achuttan Sreekumar, Mr. Ankur Sudan, Mr. Swastik Bisarya, Ms. Vidhi Jain and Ms. Annanya Mehan, Advocates for Plaintiff in CS(COMM) 130/2025 and for Defendants in CS(COMM) 569/2025.

Mr. Akhil Sibal, Senior Advocate along with Mr. Sudarshan Kr. Bansal, Mr. Mohit Goel, Mr. Sidhant Goel, Mr. Abhishek Kotnala, Ms. Ridhie Bajaj, Mr. Shivang Bansal, Ms. Sugandha Shahi, Mr. Amit Chanchal Jha, Ms. Somya Khandelwal, Mr. Devansh Mishra & Ms. Nishtha Kapoor, Advocates for Defendant in CS(COMM) 130/2025 and for Plaintiff in CS(COMM) 569/2025.

**CORAM**

**HON'BLE MR. JUSTICE TEJAS KARIA**



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## JUDGMENT

**TEJAS KARIA, J**

**IA No.3990/2025 in CS(COMM) No.130/2025**

**IA No.14115/2025 in CS(COMM) No.569/2025**

### **INTRODUCTION:**

1. Ashiana Ispat Limited (“**AIL**”) has filed the Suit being CS (COMM) 130 of 2025 (“**AIL Suit**”) against Kamdhenu Limited (“**KL**”) *inter alia* alleging passing off of AIL’s products bearing the Mark ‘AL KAMDHENU GOLD’ (“**Impugned Mark**”) as that of KL’s.
2. Kamdhenu Limited (“**KL**”) has filed the Suit being CS (COMM) 569 of 2025 (“**KL Suit**”) *inter alia* for alleged infringement of trade mark and copyright, passing off, delivery up, damages etc. against AIL and other Defendants having entered into service agreements with AIL for manufacturing TMT steel bars under the Impugned Mark being allegedly deceptively similar to KL’s registered Trade Marks including *inter alia* ‘KAMDHENU’, ‘KAMDHENU GOLD’ and ‘KAMDHENU GOLD TMT’.
3. Since the Impugned Mark in dispute in both AIL Suit and KL Suit is the same, by way of this Judgment I.A. No. 3990/2025 filed in the AIL Suit and I.A. No. 14115/2025 filed in KL Suit, both filed under Order XXXIX Rules 1 and 2 read with Section 151 of the Code of Civil Procedure, 1908 (“**CPC**”) are being considered and disposed of together.

### **SUBMISSIONS ON BEHALF OF AIL:**

4. The learned Senior Counsel for AIL made the following submissions:
  - 4.1. AIL, established in the year 1992, is in the business of manufacturing integrated steel under the Impugned Mark and



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various permutations combinations thereof. AIL was initially incorporated by one Mr. Prem Chand Gupta and his family and was subsequently listed on stock exchanges, including the Bombay Stock Exchange (“BSE”).

- 4.2. With the widespread network of dealers and distributors, AIL ensures availability of quality steel in majority of districts of India. The e-network of satisfied consumers as well as customers across country proves the worth and mettle of AIL.
- 4.3. AIL has a fully functional primary website parked at the domain name [www.ashianaispat.in](http://www.ashianaispat.in). Additionally, AIL on 23.11.2024 registered a domain name, [www.alkamdhenugold.com](http://www.alkamdhenugold.com) and if any person keys-in the said domain, they will be redirected to the aforementioned primary website of AIL. AIL also has an active presence on social media and operates official pages under the name ‘AL KAMDHENU GOLD’ on various platforms, including Facebook and Instagram.
- 4.4. AIL in order to expand its business and to create a new entity with a brand name ‘AL KAMDHENU GOLD’, has also checked with the Ministry of Corporate Affairs for the availability of the company name ‘AL KAMDHENU GOLD PVT LTD’ and the Ministry of Corporate Affairs has issued a letter dated 08.02.2025 approving the availability of the name ‘AL KAMDHENU GOLD PRIVATE LIMITED’ for registration.



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- 4.5. AIL is also working towards expanding its business outside India and in this regard, AIL applied for and on 24.01.2025 was granted a business license by the Government of Dubai, UAE to conduct its business under the company name AL KAMDHENU GOLD L.L.C-FZ through its office located in Dubai, UAE.
- 4.6. In the year 1996, AIL was taken over by the joint management of the KL, formerly known as Kamdhenu Ispat Limited. KL's management was jointly run by two families namely the Agarwal Family i.e., the family that currently owns and controls KL and the Jain Family i.e., the family that currently owns and controls AIL. While the Agarwal family comprised of the brothers, namely Mr. Pradeep Agarwal and Mr. Satish Agarwal, the Jain family comprised of the brothers-in-law Mr. Neeraj Jain and Mr. Naresh Chand *alias* Naresh Jain, who are now part of AIL's management. The commitment of both AIL and KL played a pivotal role in establishing 'KAMDHENU' as a well-known and reputable brand in the steel industry.
- 4.7. Once AIL was taken over by the joint management comprising of the Jain and Agarwal families, both AIL and KL were run, operated and managed by the Agarwal Family and the Jain Family up till the year 2002. The Annual Reports for the years 1995-2001 of AIL shows that AIL was under the joint management of Agarwal and Jain Families, primarily comprising of Mr. Pradeep Agarwal, Mr. Satish Agarwal and Mr. Naresh Chand *alias* Naresh Jain.



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- 4.8. On 05.06.1996, the joint management of KL, comprising of both Jain and Agarwal families, applied for the registration of the Word Mark 'KAMDEHNU' *vide* TM application No. 717214 in Class 6 with the user claim of 01.04.1991 and subsequently obtained registration of the same. In the same year, AIL was taken over by the joint management, i.e., the Jain family and Agarwal family by virtue of an open offer made under SEBI (SAST) Regulation, 1994.
- 4.9. The brand and Mark 'KAMDHENU' were conceived / adopted in the year 1994 and further developed by the joint efforts and collective contribution of both the Jain and Agarwal families. Both the Agarwal family and the Jain family were working together and were the beneficiaries of the profits made from the sale of various steel products bearing the Mark 'KAMDHENU' and permutations / combinations thereof.
- 4.10. Subsequently, in the year 1997, KL executed an Agreement dated 26.02.1997 with AIL ("**1997 Agreement**") and formally allowed AIL to use the Mark 'KAMDHENU' for a period of three years. The 1997 Agreement was signed by Mr. Pradeep Kumar Agarwal as the Director of KL and Mr. Satish Kumar Agarwal as the Director of AIL. This further shows that AIL and KL were working in harmony to develop the KAMDHENU brand and to make full commercial use of the Mark 'KAMDHENU'.
- 4.11. In the year 2002, due to differences amongst the families / management, both the Jain and the Agarwal families decided to



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divide the business amicably, pursuant to which the Agarwal family transferred its shareholding in AIL to the Jain family, and the Jain family transferred its shareholding in KL to the Aggarwal family.

- 4.12. In furtherance thereto, AIL and KL entered into an agreement dated 26.12.2002 (“**2002 Agreement**”) with the intention of demarcating their respective rights over the Mark ‘KAMDHENU’ and permutations / combinations thereof. The relevant clauses of the 2002 Agreement, wherein AIL is referred as Licensee and KL as Licensor, are reproduced below:

*“22. That during the subsistence of the said permitted user agreement, the Licensee shall be entitled to adopt and use the trademark AL KAMDHENU GOLD in relation to steel bars and other cognate and related goods. The expression AL KAMDHENU GOLD will be used in juxtapose and the words AL, KAMDHENU and GOLD will always be used in similar size, lettering style and colour scheme. The Licensee will be entitled to file application for its registration under the provisions of Trade and Merchandise Marks Act 1958 as its Proprietors thereof. The Licensor has also filed application for registration of trademark KAMDHENU GOLD in the Trade Mark office under application No.842704 in Class 6 in relation to Steel Bars. The Licensor agrees to withdraw the said application without prejudice to his rights and contentions in the trademark KAMDHENU. The Licensor will have no objection to its adoption, user and registration of the said trade mart AL KAMDHENU GOLD.*

*24. That upon final registration of trademark AL KAMDHENU GOLD, the Licensee will become exclusive and absolute owner for the said trade mark. After the registration of the trademark AL KAMDHENU GOLD with the Licensee, the Licensee shall immediately thereafter cease in all manner the use of the trademark KAMDHENU and shall thereafter only use the Registered trade mark AL KAMDHENU GOLD in the manner provided hereinabove.*



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*The Licensor immediately thereafter i.e. after the grant of registration shall not use the trademark AL KAMDHENU GOLD.*

*26. ....(b) This agreement shall automatically terminate on the grant of registration of the trade mark AL KAMDHENU GOLD to the licensee. However, it shall thereafter continue to exist in respect of the stipulations set out herein above as agreed upon by the parties herein above to be followed by them after the grant of registration including that of the joint marketing and common market channels to be followed by both the parties.*

*27. The Licensor agrees that it cannot during the term of this agreement a right to terminate this agreement except in the event of default on part of the Licensee to perform its obligations hereunder, provided such default is not remedied by the Licensee within 60 days from the date of receipt of a notice in writing given by the Licensor specifying such alleged default and calling upon the Licensee to rectify the same.”*

A perusal of the 2002 Agreement evidences the following:

- (a) KL will be the absolute owner of the Mark ‘KAMDHENU’;  
and
- (b) AIL will be the absolute owner of the Impugned Mark.

4.13. Clauses 22 to 27 of the 2002 Agreement show the intention of AIL and KL, which was to divide the rights over the Mark ‘KAMDHENU’ and permutation / combination thereof in such a way, that KL continues to use the Mark ‘KAMDHENU’ (word *per se*), and AIL will be the absolute owner of the Impugned Mark, subject to its registration. The said understanding was only achieved because KL was well aware that AIL has put in equal efforts in conceiving, advertising and promoting the brand KAMDHENU and, therefore, KL acknowledged AIL’s right over the Impugned Mark, where AL



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is the acronym of Ashiana (Ispat) Limited. The Impugned Mark can only be associated with AIL, as it directly reflects the identity of AIL and its longstanding use, reputation, and goodwill in the market, which is also admitted and acknowledged by KL.

- 4.14. By virtue of the 2002 Agreement, AIL started using the Impugned Mark for selling and marketing its steel products, while also using the Mark 'KAMDHENU' for manufacturing / selling steel products for KL. AIL is the prior user of the Impugned Mark to the knowledge of KL and KL has categorically acknowledged AIL to be the absolute owner of the Impugned Mark.
- 4.15. The 2002 Agreement shows KL's intention to give up all their rights in the Impugned Mark, which is further strengthened by the fact that KL themselves undertook to withdraw its TM application No. 842704 for the Mark 'KAMDHENU GOLD', to give AIL, the complete rights over the Impugned Mark and various permutations and combinations thereof. Despite the said understanding, KL did not withdraw the said TM application No. 842704 and obtained the registration for 'KAMDHENU GOLD'.
- 4.16. KL had also filed another TM application No. 1009954 dated 17.05.2001 for the Mark 'KAMDHENU GOLD TMT'. In terms of the 2002 Agreement, KL ought to have withdrawn the said application as well. However, instead of withdrawing the same, KL *mala fide*ly ensured registration of the said mark.



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- 4.17. By virtue of the 2002 Agreement, KL appointed AIL as the Licensee of the Mark 'KAMDHENU' for a period of 99 years for a nominal License Fee of Rs. 1000 per annum. This arrangement unequivocally reaffirmed AIL's long-term and uninterrupted right to use the Mark 'KAMDHENU' lawfully as per the agreed terms.
- 4.18. The 2002 Agreement was structured as a Trade Mark Assignment Agreement, whereby KL has unequivocally relinquished its rights over the Impugned Mark and has recognised AIL as the exclusive user of the Impugned Mark. Although the 2002 Agreement stipulates that AIL will become the absolute owner of the Impugned Mark upon its registration, KL's agreement to withdraw its trademark application for the Mark, 'KAMDHENU' GOLD' clearly demonstrates KL's acknowledgement of AIL's ownership of the Impugned Mark.
- 4.19. Pursuant to the 2002 Agreement, AIL on 27.12.2002 *vide* TM application No. 1161758 applied for the registration of the Impugned Mark in Class 6 ("TMA 1161758"). However, due to the various settlement discussions and internal restricting that were taking place between both the Parties, AIL could not thoroughly pursue TMA 1161758 and due to inadvertence and oversight TMA 1161758 got abandoned in the year 2007. Further, AIL has reasons to believe that the TMA 1161758 was opposed by some parties at the behest / instructions of KL.
- 4.20. AIL continued to manufacture products under the KAMDHENU brand for KL, devoting significant time, energy,



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and resources to fulfilling its obligations under the 2002 Agreement with KL. As a result, AIL's attention to the manufacture and sale of products under the Impugned Mark was diluted. Nevertheless, AIL consistently maintained its rights and ongoing use of the Impugned Mark on its products and promotional materials, albeit without optimal utilization due to existing manufacturing commitments with KL. Furthermore, KL explicitly acknowledged AIL's rights to the Impugned Mark, eliminating concerns regarding potential loss of these rights. Consequently, AIL prioritized compliance with manufacturing and other contractual obligations. Ultimately, AIL's objective was to secure registration of the Impugned Mark in accordance with the provisions of the 2002 Agreement.

- 4.21. Due to AIL's admitted prior longstanding and continuous use, coupled with investments in marketing and the resultant turnover, the Impugned Mark has acquired goodwill and reputation in the industry. Subsequent to the 2002 Agreement, AIL in all good faith has been continuously and extensively using the Impugned Mark in the course of AIL's business, while not interfering with KL's use of the Marks 'KAMDHENU'.
- 4.22. In any event, KL has admitted and acknowledged AIL to be the absolute owners of the Impugned Mark in the 2002 Agreement. AIL's products under the Impugned Mark are known for their quality, and the Impugned Mark itself has come to represent AIL's business identity.



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- 4.23. On 29.01.2021, AIL and KL entered into a subsequent agreement (“**2021 Agreement**”) for the Marks ‘KAMDHENU’ / ‘KAMDHENU NXT’ which modified the terms of the pre-existing arrangement and imposed a royalty fee of Rs. 100 per ton for the use of the Marks ‘KAMDHENU’ / ‘KAMDHENU NXT’ by AIL. 2021 Agreement was KL’s attempt to significantly increase the financial burden on AIL for usage of the Marks ‘KAMDHENU’ / ‘KAMDHENU NXT’ and compelling compliance under the threat of revocation of brand usage rights.
- 4.24. Between 2019 and 2024, KL, utilising its position, engaged in monopolistic practices by issuing controlled and limited orders to AIL, and subsequently withholding orders for products bearing the Marks ‘KAMDHENU’ / ‘KAMDHENU NXT’, which eventually resulted in the closure of AIL’s manufacturing unit. Furthermore, KL placed orders following the shutdown, despite full knowledge that the unit was incapable of fulfilling them.
- 4.25. On 19.09.2024, KL issued a letter entitled ‘Termination of License User Agreement dated 29 January 2021’, stating grounds for termination such as failure to fulfil orders and delayed royalty payments. The communication dated 19.09.2024 does not reference the 2002 Agreement, under which rights to the Impugned Mark were granted to AIL, but instead expressly declares that KL unequivocally, irrevocably,



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completely, and permanently terminates all MoUs, agreements, and the 2021 Agreement.

- 4.26. KL also published a caution notice in a newspaper on 06.11.2024 stating that all business relationship with AIL has been severed as regards the Marks 'KAMDHENU' / 'KAMDHENU NXT' and clandestinely not mentioning the Impugned Mark knowing and acknowledging that AIL is the absolute owner of the Impugned Mark. AIL *vide* letter dated 27.01.2025 duly replied to KL's termination letter denying all false and frivolous allegations made against AIL by KL.
- 4.27. On 05.12.2024, AIL filed a fresh application for registration of the Impugned Mark *vide* TM application No. 6742246 in Class 6 claiming user since 26.12.2002. KL, even after categorically agreeing through the 2002 Agreement that AIL is entitled to registration of the Impugned Mark, with utmost *mala fide* and dishonesty filed its objection to AIL's application No. 6742246 *vide* letter dated 17.12.2024 falsely pleading in its objection that the 2002 Agreement between AIL and KL stands cancelled.
- 4.28. On 17.12.2024, KL filed TM application No. 6759794 for the Impugned Mark, asserting usage since 2001. This act is contrary to the terms of the 2002 Agreement, under which KL explicitly relinquished all rights to the Impugned Mark and acknowledged AIL's exclusive entitlement to its use and registration. KL's subsequent attempt to claim rights over the Impugned Mark, despite having contractually disclaimed such rights, lacks legal foundation and suggests questionable intent.



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- 4.29. As soon as AIL was made aware about KL's TM application No. 6759794 for the Impugned Mark, AIL filed a pre-opposition letter dated 28.01.2025 to the said application of KL. Subsequently, both AIL's and KL's applications for the Impugned Mark were accepted by the Trade Mark Registry.
- 4.30. On 17.01.2025, AIL, in good faith and based on KL's acknowledgment of AIL as the absolute owner of the Impugned Mark, assigned the Impugned Mark subject of TM application No. 6742246 to Naresh Chand *alias* Naresh Jain (a director of AIL) with retrospective effect from 09.12.2024, without waiting for registration of the mark. Subsequently, on 18.01.2025, Naresh Chand *alias* Naresh Jain assigned the Impugned Mark to Kamdhenu Steel and Alloys Limited ("KSAL"), with retrospective effect from 16.12.2024. These changes in ownership, executed through the Assignment Deeds dated 17.01.2025 and 18.01.2025 ("**Assignment Deeds**"), represent an internal restructuring within AIL's management intended to facilitate business operations in light of the challenges faced and industry developments. Throughout this process, the Jain Family, who manages AIL, ensured that all rights in the Impugned Mark remained within the family and its affiliated companies, preventing any transfer to KL, the Agarwal Family, or unrelated third parties. The Assignment Deeds formed part of a legitimate business strategy aimed at further developing the 'AL KAMDHENU GOLD' brand.



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- 4.31. KL *mala fide*ly filed a Civil Suit being CS (COMM.) No. 53 / 2025 (“**Saket Suit**”) before the District and Sessions Court, Saket District, New Delhi (“**Saket Court**”) against M/s Yashoda Nandan Ispat Private Limited (“**Yashoda**”) and KSAL and obtained an injunction *vide* order dated 29.01.2025 against the said entities restraining them from using the Marks ‘KAMDHENU’ / ‘AL KAMDHENU GOLD’, by playing fraud on the Saket Court by not providing the complete picture and by suppressing vital information and documents.
- 4.32. A perusal of the plaint, pleadings and documents of the Saket Suit show that KL is claiming rights over the Impugned Mark and Marks ‘KAMDHENU GOLD’ and ‘KAMDHENU GOLD TMT’ and have all the intention to sell products bearing the Impugned Mark and Marks ‘KAMDHENU GOLD’ and ‘KAMDHENU GOLD TMT’. Moreover, in the proceedings before the Trade Marks Registry pertaining to KL’s trade mark registration Nos. 842704 and 1009954 for the Marks ‘KAMDHENU GOLD’ and ‘KAMDHENU GOLD TMT’, respectively, KL has made categorical statements that KL is using the Impugned Mark and Marks ‘KAMDHENU GOLD’ and ‘KAMDHENU GOLD TMT’. However, AIL has not come across any product of KL bearing the Impugned Mark and Marks ‘KAMDHENU GOLD’ and ‘KAMDHENU GOLD TMT’.
- 4.33. This act of KL shows that KL is unauthorizedly asserting rights over the Impugned Mark, which KL itself has assigned to AIL



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by virtue of 2002 Agreement. Having allowed and facilitated AIL's extensive use of the Impugned Mark over the years, KL cannot now, in a complete reversal of its prior commitments, seek to dispute or encroach upon AIL's rights. Such dishonest and *mala fide* conduct of KL amounts to an unjust attempt to undermine AIL's rights vested in the Impugned Mark and disrupts the long-standing arrangement established between the Parties under the 2002 Agreement. KL's actions amount to an attempt to interfere with AIL's established rights over the Impugned Mark and amount to passing off.

- 4.34. KL's unlawful use and attempted registration of the Impugned Mark is intended to deceive the public and divert business from AIL. KL is trying to unjustly benefit from the goodwill and reputation that AIL has built over the years for the Impugned Mark amounting to an act of unfair competition, wherein KL seeks to exploit AIL's brand value and market presence for KL's own wrongful gains.
- 4.35. The act of passing off by KL is further evident from the fact that AIL has rights over the Impugned Mark by virtue of the 2002 Agreement which cannot be disputed, and any attempt by KL to use or claim rights over the Impugned Mark is an unlawful attempt to mislead consumers and disrupt AIL's business.
- 4.36. The damage that has already been caused and the damage that is continuing to be caused to AIL and to AIL's reputation and goodwill is insurmountable and not capable of being accurately



assessed in monetary terms and therefore, KL should be enjoined from asserting any right over the Impugned Mark and Marks 'KAMDHENU GOLD' and 'KAMDHENU GOLD TMT' and from using the Impugned Mark or any other deceptively similar mark thereto in any manner whatsoever.

- 4.37. Thus, balance of convenience tilts in favor of AIL and against KL and grave prejudice, irreparable harm and injury will be caused to AIL if I.A. No. 3990 of 2025 in the AIL Suit is not allowed. However, no prejudice whatsoever will be caused to KL in case I.A. No. 3990 of 2025 in the AIL Suit is allowed.
- 4.38. Reliance was placed on *S. Syed Mohideen v. P. Sulochana Bai*, (2016) 2 SCC 683 to highlight the rights of prior user.
- 4.39. Reliance was further placed on *Midas Hygiene Industries v. Sudhir Bhatia*, (2004) 3 SCC 90 to submit that the grant of injunction also becomes necessary if *prima facie* it appears that the adoption of the mark was itself dishonest.
- 4.40. Reliance was placed on following judgments to submit that the rights once waived cannot be subsequently asserted:
- i. *AMPA Cycles Private Limited vs Jagmohan Ratra* 2021 SCC OnLine Del 3626
  - ii. *Ramdev Food Products (P) Ltd. vs Arvindbhai Rambhai Patel and Others* (2006) 8 Supreme Court Cases 726
  - iii. *Lindsay Petroleum Co. v Hurd* (1874) LR 5 PC 221
- 4.41. Reliance was placed on following judgments to submit that single actual use also amounts to use:



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- i. ***Century Traders vs. Roshan Lal Duggar & Co.*** 1977 SCC OnLine Del 50
  - ii. ***Kent Cables (P) Ltd. v. Kent Ro Systems Ltd.*** 2023 SCC OnLine Del 3288
- 4.42. Reliance was placed on ***Ajay Narain vs Arti Singh and Ors.*** MANU/DE/8545/2024 to submit that there cannot be unilateral termination of contract.
- 4.43. Reliance was placed on ***Kores (India) Limited vs M/s. Khoday Eshwarsa & Son and another*** 1984 SCC OnLine Bom 65 for submissions on the aspect of honest concurrent user.
- 4.44. Reliance was placed on following judgments to submit that family arrangement acts as estoppel:
- i. ***Thayyullathil Kunhikannan & Ors. vs. Thayullathil Kalliani & others*** 1989 SCC OnLine Ker 267
  - ii. ***Shri Ram Education Trust vs SRF Foundation & Anr.*** 2016 SCC OnLine Del 472
  - iii. ***Darshan Lal Dhooper vs. Motia Rani & Ors.*** 2002 SCC OnLine Del 958
- 4.45. Reliance was placed on following judgments to submit that positive encouragement amounts to acquiescence:
- i. ***M/s Power Control Appliances And Others vs. Sumeet Machines Pvt. Ltd.*** (1994) 2 Supreme Court Cases 448
  - ii. ***Habib Bank Limited v Habib Bank A. G. Zurich*** (1981) 1 WLR 1265
  - iii. ***Rowland vs Michell*** 1896 13 RPC 457



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- iv. *Lupin Laboratories Ltd. vs Jain Products* 1998 SCC  
OnLine Bom 107
- v. *M/s. Hidesign vs. M/s. Hi-Design Creations* 1991 SCC  
OnLine Del 10

### **SUBMISSIONS ON BEHALF OF KL:**

- 5. The learned Senior Counsel for KL made the following submissions:
  - 5.1. KL in the year 1994 *bona fide* and honestly adopted the Mark ‘KAMDHENU’ and its trade name bearing the Word / Mark ‘KAMDHENU’ and since then and over a period of time has been creating KAMDHENU stylized, artistic, formative, labels and variant trade marks; art works / labels bearing the Word / Mark ‘KAMDHENU’; domain bearing the Word / Mark ‘KAMDHENU’ (“**KAMDHENU Mark**”) and KL is the proprietor and owner thereof. KL since the year 1994 is engaged in the business of manufacture and trade of steel bars and with the passage of time forayed into the business of manufacture and trade of construction material such as structural steel, plywood, PVC pipes, Plaster of Paris, water proofing compounds, wall putty, paint and various other goods and business falling in various classes and offering services in connection therewith under the KAMDHENU Marks. KL has been commercially using the KAMDHENU Mark in the course of trade, upon, on and in relation to KL’s goods / business, continuously and uninterruptedly. As a result, KL has built substantial goodwill and reputation under the KAMDHENU Mark. The KAMDHENU Mark have already become distinctive and associated with the KL’s goods / businesses.



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- 5.2. KL is the prior adopter and user of the KAMDHENU Mark since 1994 in respect of Class 6 goods such as steel bars, TMT bars, *sarias* etc. KL is the registered proprietor of KAMDHENU Mark since 1996 and other KAMDHENU formative marks such as ‘KAMDHENU GOLD’ and ‘KAMDHENU GOLD TMT’. The Word / Mark ‘KAMDHENU’ forms an essential, distinguishing, memorable, key, vital and dominant feature of the KAMDHENU Mark.
- 5.3. KL has taken efforts to create consumer awareness for KL’s goods / business under the KAMDHENU Mark. As of March 2024, KL along with its franchisees have spent over Rs. 870 crores in promotion of the KAMDHENU Mark during the financial year 1995 to 2024.
- 5.4. KL has already built up a valuable trade under the KAMDHENU Mark and conducted handsome business thereunder. The revenue from operations and overall brand turnover in respect of the KL’s goods / businesses for the financial years 1995 to 2024 are Rs. 13680 crores and Rs. 1,48,000 crores respectively.
- 5.5. The purchasing public and the trade industry at large identify and distinguish KL’s goods / businesses with KL and from KL’s source and origin alone. The KAMDHENU Mark to this effect, has acquired secondary significance with KL’s goods / businesses and public at large associates the KAMDHENU Mark with KL’s goods / businesses. KL through its dedicated research and development keep on improving efficiency, efficacy, and dependability of KL’s



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goods / businesses under the KAMDHENU Mark. KL maintains highest standard of quality in relation to KL's goods / businesses.

5.6. In order to secure the statutory rights in the KAMDHENU Marks, KL has also applied for and obtained various trade mark registrations pertaining to the KAMDHENU Marks, *inter alia*, in Classes 6, 16, 19, 35 and 39 under the Trade Marks Act, 1999, (“**Trade Marks Act**”) which are all legal, valid, subsisting and in full force.

5.7. Representations of some of the KAMDHENU Mark are as under:



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- 5.8. The art works involved in KL’s labels are original artistic works and KL is the owner and proprietor of the copyright therein within the meaning of the Copyright Act, 1957. KL has also filed for copyright registration. Some of the artworks, wherein word mark KAMDHENU forms essential part, are duly registered in favour of KL under Nos. A-58058/2000 and A-58100/2000 under the provisions of Copyright Act, 1957.
- 5.9. In the background of its reputation and goodwill in the KAMDHENU Mark, KL diversified its business and granted its



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licenses / permissions to several parties i.e., individuals, firms and companies to use KAMDHENU Mark in relation to various goods / services like structural steel, Plaster of Paris, Wire Bond, Paints, Ply Wood, Milk, PVC Pipes, Construction Chemicals, Packaged Drinking Water etc. As per law, use of the mark by KL's licensees / franchisee / distributors / dealers shall be deemed to be KL's use thereof. In view of KL's formidable rights and established reputation in its KAMDHENU brand, AIL approached KL seeking permission and / or a license to use KL's established and proprietary KAMDHENU Mark.

- 5.10. 1997 Agreement expressly recognised KL as the proprietor of the KAMDHENU Mark and further permitted AIL to use KAMDHENU Mark in respect of steel bars as a permitted user for a period of three years. It was further, *inter alia*, stipulated in the 1997 Agreement that the KAMDHENU Mark could be used by AIL only so long as the steel bars were manufactured by AIL in accordance with the specifications and directions supplied by KL.
- 5.11. 2002 Agreement, *inter alia*, provided that (i) the parties are unrelated and are distinct and separate entities; (ii) KL is the proprietor of the KAMDHENU Mark both under statutory and common law along with all accompanying goodwill in relation to steel bars and allied / cognate goods; (iii) all use under 2002 Agreement was to inure to the benefit of KL; (iv) the rights of KL to use the KAMDHENU Mark during or after the termination of 2002 Agreement as proprietor thereof was preserved; (v) AIL expressly acknowledged that KL enjoys exclusive proprietary



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rights over KAMDHENU Mark; (vi) use by AIL would not confer any right, title or interest whatsoever in favour of AIL; (vii) AIL was permitted to sublicense the Impugned Mark only to one other company provided one of its directors was common to both; (viii) AIL was required to manufacture steel bars in accordance with IS 1786:1985 of Bureau of Indian Standards (“**BIS**”); (ix) during the subsistence of 2002 Agreement, AIL would be entitled to adopt and use the Impugned Mark in relation to steel bars and other cognate and related goods and AIL was additionally permitted to file an application for its registration of Impugned Mark under the Trade Marks Act as a proprietor thereof; and (x) KL’s application for registration of the Mark ‘KAMDHENU GOLD’ in the Trade Marks Office under TM application No. 842704 in Class 6 in relation to steel bars was agreed to be withdrawn, without in any manner affecting its rights *qua* the KAMDHENU Mark.

- 5.12. As per 2002 Agreement, up to the time of registration of Impugned Mark in favour of AIL, KL was also entitled to use the Impugned Mark. Only upon final registration of the Impugned Mark, AIL was to become the exclusive and absolute owner of the Impugned Mark, and AIL was further obliged to thereafter immediately seize in all manner the use of KAMDHENU Mark and only use the Impugned Mark in the manner as stipulated under the 2002 Agreement. Further, KL was also, upon registration of Impugned Mark in favour of AIL, to refrain from using the Impugned Mark.
- 5.13. Significantly, unlike for the KAMDHENU Mark, where AIL was permitted only one sub-license to another company, no power to



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sub-license was provided in respect of the Impugned Mark. A restricted power to assign or transfer Impugned Mark was given to AIL after its registration in favour of the persons specifically named in the 2002 Agreement or their legal heirs / successors. Apart therefrom, the 2002 Agreement specifically prohibited any assignment or creation of any third-party rights whatsoever by AIL in respect of Impugned Mark.

- 5.14. 2002 Agreement was to terminate after a period of 99 years or upon grant of registration of the Impugned Mark in favour of AIL, subject to continuing obligations and stipulations as provided in the 2002 Agreement, or by KL in the event of default by AIL to perform its obligations. Post termination, a reasonable period of time was to be given to AIL to dispose of any unsold stock pertaining to goods sold under the licensed Impugned Mark.
- 5.15. 2021 Agreement provided for permitted use of the Marks 'KAMDHENU' / 'KAMDHENU NXT' by AIL in relation to TMT Steel bars, acknowledging KL's proprietary and exclusive rights in the Marks 'KAMDHENU' / 'KAMDHENU NXT', as well as in the Mark 'KAMDHENU GOLD' registered under No. 842704. AIL explicitly acknowledged in 2021 Agreement that 2002 Agreement was executed pertaining to the specific product being Cold Twisted Bars (CDT bars) / Tor Steel, which were now obsolete, hence AIL sought license from KL to manufacture TMT steel bars under the Marks 'KAMDHENU' / 'KAMDHENU NXT'. Thus, the 2021 Agreement novated / superseded / terminated the previous 2002 Agreement.



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- 5.16. There is fundamental difference and consequent improvement in the steel bars manufactured under BIS norms being IS:1786- 1985 and those under IS: 1786-2008. Such differences and improvements are in the chemical compositions, physical properties, total elongation and maximum force percent min; mandrel diameter for bend test; mandrel diameter for re-bend test and these are enumerated in the BIS Standard itself. The goods covered by 2002 Agreement were under BIS norms being IS:1786-1985, which is specifically mentioned in Clause 12 thereof and that has become obsolete.
- 5.17. Under 2021 Agreement, AIL was granted a ‘bare license’ to use the Marks ‘KAMDHENU’ / ‘KAMDHENU NXT’, explicitly providing that any right, title, interest or goodwill whatsoever, which may arise out of the use of the Marks ‘KAMDHENU’ / ‘KAMDHENU NXT’ shall be for the absolute benefit of KL. 2021 Agreement was executed for a period of 80 years, however the same was terminable in the event of failure on part of AIL to remedy its default or in case AIL was found to be defaming / misusing and / or not adhering to the quality standards set forth by KL for the products sold under the Marks ‘KAMDHENU’ / ‘KAMDHENU NXT’.
- 5.18. Further, 2021 Agreement prohibited AIL from carrying on business of manufacture and sale of the products under the Marks ‘KAMDHENU’ / ‘KAMDHENU NXT’ after termination of the 2021 Agreement. Significantly, 2021 Agreement made no mention of any subsisting rights of AIL in the Impugned Mark.



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- 5.19. Owing to the numerous defaults by AIL, as well as instances of misuse and defamation of KAMDHENU Mark, KL *vide* the notice of termination dated 19.09.2024 terminated the 2021 Agreement as well as all other MoUs and agreements with AIL. All subsisting agreements with AIL thereby stood terminated and extinguished.
- 5.20. The MoU dated 27.02.2012 entered between KL and KSAL (“MoU”) also expressly recognised KL as the proprietor and beneficial owner of KAMDHENU Mark including specifically the Mark ‘KAMDHENU GOLD’ registered *vide* TM No. 8427042. KSAL further undertook to never use KAMDHENU Mark in connection with any goods / services related to KL and to never claim or seek to acquire any rights in KAMDHENU Mark or deceptively similar marks.
- 5.21. Subject to such unequivocal undertakings, KSAL was allowed to use the KAMDHENU Mark for the limited purpose of using the KAMDHENU Mark as part of its corporate name on the specific representation that it was merely a land holding and cross-holding company with no independent business related to that of KL, and would in due course also change its name.
- 5.22. On 25.01.2025, KL upon discovering TMT bars being manufactured and sold under the Impugned Mark, filed the Saket Suit against the manufacturer and marketer of the same, *viz.* Yashoda and KSAL asserting its statutory and common law rights in the Marks ‘KAMDHENU’ and ‘KAMDHENU GOLD’ formative marks. The Saket Court *vide* order dated 29.01.2025 granted an *ex parte ad interim* injunction which was later made



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absolute on 09.06.2025 restraining Yashoda and KSAL from infringing KL's rights in the KAMDHENU Mark.

- 5.23. Subsequently, AIL filed TM application No. 6742246 on 05.12.2024 for the Impugned Mark in Class 6 falsely claiming user since 26.12.2002 and wrongly advertng to the superseded / novated / terminated 2002 Agreement as the basis for the rights in the Impugned Mark.
- 5.24. AIL also filed TM applications *vide* Nos. 6845025 on 07.02.2025, 6845771 on 07.02.2025, 6890699 on 05.03.2025, 6890704 on 05.03.2025 in Class 6 for the Impugned Mark. These Trade Mark Applications had been advertised in the TM Journal without undergoing the requisite statutory scrutiny, especially in regard to the prior registered marks of KL.
- 5.25. Immediately after instituting the AIL Suit on 13.02.2025, AIL in connivance with its director Mr. Naresh Jain, and KSAL, purportedly cancelled the Assignment Deeds by a written communication purportedly dated 15.02.2025 addressed only to Mr. Naresh Jain and not KSAL. It is a settled law that once title has been transferred by way of an instrument, as AIL claims to have done, the same cannot be cancelled *simpliciter*, it has to be assigned back to the original assignor. Thus, the purported cancellation of the Assignment Deeds is invalid.
- 5.26. AIL could not have entered into any assignment for a trade mark as listed company and could have not executed the Assignment Deeds without the approvals of the shareholders and Board of Directors and intimation to the Stock Exchange, in which it had no



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rights in the first place. AIL has usurped the property of the public listed company by way of the alleged assignment of 17.01.2025, in as much as the consideration for the Assignment Deeds has been only Rs. 11,000/- while AIL alleges to have made expenses of over Rs. 32 Crore on the advertisement and on sale promotion for the Impugned Mark. Even the Assignment Deeds had been made to an individual director of AIL amounting to a diversion of public funds, which further brings out *mala fide* of AIL.

- 5.27. The alleged applications filed by AIL for registration of the Impugned Mark are all without the leave, license or approval of KL and are in violation of KL's rights. The alleged applications are neither maintainable in law and nor on facts and have been filed *mala fide* and on false grounds and claims as AIL is not the proprietor of the Impugned Mark covered by the alleged applications and is not entitled to their registration.
- 5.28. AIL has failed to establish the *sine qua non* of a passing off action, i.e. prior goodwill in the Impugned Mark attributable to AIL, misrepresentation by KL and damage to AIL. AIL has not filed a single credible document establishing any use of the Impugned Mark in the course of trade. The purported user documents filed by AIL do not establish prior use of the Impugned Mark by AIL as the earliest invoice filed by AIL for the Impugned Mark is dated 03.06.2025; the quarterly financial results from 2004-2006, 2009-2014 in newspapers are a mere assertion of the rights of AIL as a licensee, and do not constitute any actual use of the Impugned Mark by AIL as a trade mark for steel bars. The quarterly financial



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results from 2021-2024 i.e., after termination / supersession / novation of the 2002 Agreement, do not refer to the Impugned Mark; The newspaper advertisements filed by AIL are also only recent, i.e. 05.01.2025 onwards; the Chartered Accountant (“CA”) certificate dated 11.02.2025 for the years 2001-2024 showing AIL’s purported annual turnover, etc. does not specify that the figures pertaining to sales made by AIL under the Impugned Mark. The invoices filed by AIL make no reference to the Impugned Mark. The product images allegedly under the Impugned Mark filed by AIL are not AIL’s.

- 5.29. On 15.05.2025, KL became aware that in the month of April 2025-May 2025 AIL has entered into six service agreements with Defendant Nos. 2 to 7 in the KL Suit for manufacture of TMT bars under the Impugned Mark. Thus, it was in the month of April 2025 only that AIL for the first time commenced / intended to commence any use of the Impugned Mark.
- 5.30. Since the institution of the KL Suit, AIL has entered into 10 additional service agreements and is flooding the market by selling products bearing the Impugned Mark, which are of poor quality and over which KL has no control thereby diluting and tarnishing KAMDHENU Mark and KAMDHENU GOLD formative Marks including the Impugned Mark. KL is suffering huge losses and will continue to do so as AIL has entered into and flooded the market despite being aware of KL’s prior use and rights in KAMDHENU Mark and KAMDHENU GOLD formative Marks including the Impugned Mark.



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- 5.31. At the time of the verification carried out by KL, no stocks of ‘KAMDHENU NXT TMT BARS’ were found with AIL at its plant. However, AIL had valued the stocks at Rs. 34 Crores in their published results for 30.09.2024. The only products under the Impugned Mark found in the market were of Yashoda and KSAL against whom KL has already instituted the Saket Suit.
- 5.32. However, the intention of AIL to use the Impugned Mark in the course of trade on, upon and in relation to AIL’s goods / business is no longer speculative but is imminent. AIL is likely to commence the actual use of the Impugned Mark in the course of trade in the market and KL’s apprehensions to that effect are credible and well founded. The user, if any, by AIL of the Impugned Mark would be extremely recent and that too extremely slight, sporadic and intermittent.
- 5.33. The Impugned Mark is identical with and deceptively similar to the KAMDHENU Mark in each and every manner including phonetically, visually, structurally, conceptually and in its essential features. Even the AIL’s goods / business in relation to which AIL is using the Impugned Mark is of the same / similar / allied / cognate nature and description to KL’s goods / business and more so as covered by KL’s trade mark registrations in Class 06, 16, 19, 35 and 39. Even the market and trade which includes the consumers and public at large of KL and AIL are the same / similar.
- 5.34. The Impugned Mark is a variant and extension of KL’s prior, senior, and registered KAMDHENU Mark and KAMDHENU



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GOLD formative Marks of which KL is the lawful proprietor. The prefix 'AL' has been adopted by KL for two reasons: *firstly*, to signify KL's intention to enter Middle Eastern markets where 'AL' is a commonly used article meaning 'the' and is often adopted in trade marks and business names in that region; *secondly*, because 'Al' also denotes aluminium, a key component in the chemical composition of KL's goods, symbolizing strength and durability.

5.35. By AIL's use of the Impugned Mark on, upon and in relation to AIL's goods / business, consumer, market, trade, public, market and trade, confusion and deception is ensuing or likely to ensue and the market and trade would be confused and deceived into purchasing and doing business with AIL under the impression that they are dealing with KL or that AIL's goods / business are sponsored, affiliated, associated with KL or is licensed thereto or is an extension of KL or are from KL's source and origin *viz* KL, KL's goods / business and KL's KAMDHENU Mark. By AIL's impugned acts loss and injury is being caused to KL as well as to the market and trade.

5.36. AIL is / was fully aware of KL's rights in the KAMDHENU Mark including its standing, goodwill, use, reputation, distinctiveness, registrations and all benefits at the time of the alleged adoption and use of the Impugned Mark which it *mala fide* and in bad faith adopted and so using inspired therefrom and to derive unjust benefits thereupon. The very adoption of the Impugned Mark by AIL is tainted at inception. The alleged adoption and use by AIL are acts of deceit and misrepresentation. AIL by the Impugned



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Mark and goods is disparaging, diluting, diminishing and discrediting the KAMDHENU Mark including strength, goodwill and reputation. This is more so as KL and AIL are in the same / similar line of business.

- 5.37. AIL voluntarily and consciously withdrew and / or let abandoned its TMA 1161758 in Class 6 for the Impugned Mark filed on 27.12.2002 on a 'proposed to be used' basis. AIL had done so under orders dated 07.01.2008 passed by the Registrar of Trade Marks, which was thirteen years prior to the execution of 2021 Agreement. *Vide* order dated 07.01.2008 even costs had been imposed upon AIL.
- 5.38. TM application No. 1009954 for registration of the Mark 'KAMDHENU GOLD TMT' in Class 6 was duly pending at the time of execution of 2002 Agreement and was put on the Register on 13.06.2005 to the due knowledge, admission and acknowledgement of AIL.
- 5.39. Under both 2002 Agreement and 2021 Agreement, AIL could not have any proprietary or ownership rights in the KAMDHENU Mark in any manner whatsoever and nor could AIL acquire such rights in light of clause 16 of 2002 Agreement and clause 7 (b) and clause 8 of 2021 Agreement.
- 5.40. KL has terminated all MoUs and agreements with AIL *vide* written notice dated 19.09.2024 served upon AIL and by caution notices published in various newspapers dated 06.11.2024 wherein KL notified the public at large which included AIL of its terminating all MOUs and license user agreements with AIL and of AIL to



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have no authority to use the Marks ‘KAMDHENU’ / ‘KAMDHENU NXT’ word *per se* or its formatives, trade name, labels, logos and copyrights bearing the same and of any such use to be in violation of KL’s rights. Even though 2002 Agreement had already been terminated, annulled, novated and superseded even prior thereto, nevertheless, without prejudice to the aforesaid, all MoUs / agreements, including 2002 Agreement, if subsisting, also stood terminated.

- 5.41. Even 2021 Agreement between KL and AIL stands duly terminated / cancelled / annulled / rescinded. AIL to its own knowledge and acknowledgement has never challenged the said terminations before any competent forum or Court of Law and has accepted the same.
- 5.42. All the licence agreements namely 1997 Agreement, 2002 Agreement and 2021 Agreement were on a contractual and commercial basis and in the capacity of Licensor i.e., KL and Licensee i.e., AIL and in all these agreements it has been recognized and admitted that AIL and KL being respectively Licensee and Licensor thereto are distinct and separate legal entities and it was on this basis that the 1997 Agreement, 2002 Agreement and 2021 Agreement had been entered into.
- 5.43. KL prior and after the 1997 Agreement, 2002 Agreement and 2021 Agreement continued to create, use and file for registration of its various KAMDHENU and KAMDHENU formative and variant marks created over a period of time for its goods and businesses including for those KL forayed into.



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- 5.44. AIL's claims and alleged rights are barred under the doctrine of 'licensee estoppel' and as such AIL is estopped from challenging KL's rights in the KAMDHENU and KAMDHENU formative and variant marks including the Marks 'KAMDHENU GOLD', 'KAMDHENU GOLD TMT' and the Impugned Mark and AIL is further estopped from setting up any rights of its own therein and as also from disputing the separate and distinct stature of AIL and KL and of the agreements between the Parties to be contractual and commercial.
- 5.45. Under 2002 Agreement AIL could have got rights, if at all, in the Impugned Mark only on AIL being granted trade mark registration thereto. Thus, such a right, if at all, was contingent on the grant of the trade mark registration to it. No trade mark registration was ever granted to AIL and AIL itself let its TMA 1161758 to be withdrawn and / or let abandoned to its own knowledge, admission and acknowledgement. AIL Suit is not maintainable inasmuch as 2002 Agreement and 2021 Agreement in the very nature were determinable and were not in perpetuity.
- 5.46. AIL has been already out of business with its plant closed and AIL had defaulted in not supplying twenty eight trucks of TMT Bars to the dealer networks. AIL has been heavily in debt, has defaulted in the market and in dire financial crises, suffering low and adverse acceptance in the market and is facing NCLT and SARFAESI proceedings and in order to gain acceptability in the market and business community has now 'cooked up' the story of its alleged rights in the Impugned Mark to encash upon the standing and



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reputation in the KAMDHENU Mark to usurp the same to revive itself. AIL has also repeatedly defaulted in paying royalty to KL.

5.47. The application for registration of the Impugned Mark under TM application No. 6742246 in Class 6 was filed by AIL *mala fide* and without the leave, license or approval of KL and to raise a false defence and is in violation of KL's rights. The user claim of 26.12.2002 in TM application No. 6742246 is a false claim by AIL. TM application No. 6742246 was also filed after the termination letter dated 19.09.2024 and caution notices dated 06.11.2024 and even after 2021 Agreement. AIL's subsequent attempt to file for and obtain registration for the Impugned Mark in the year 2024 and 2025 under TM application Nos. 6742246, 6845771 and 6845025 and after the termination of all agreements and MoUs with AIL and after the withdrawal and / or abandonment of TMA 1161758 is legally untenable and also indicative of its *mala fide* intent inasmuch as AIL wrongfully seeks rights in a trade mark which does not belong to AIL being a licensee, now ex-licensee, and seeks to usurp the very same trade mark to which AIL was licensed to by KL.

5.48. KL has its own independent corporate identity and structure irrespective of its director or the families to which they may belong. AIL's reliance and pleadings on the families involved is, therefore, a concocted story raised to draw unjust advantage and set-up a false case. It is to AIL's own knowledge that all rights and properties including the intellectual property rights in the trade



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marks and trade name and the goodwill involved vest with KL and not with any individual director(s).

- 5.49. There was never ever a division of the business and AIL and KL were always separate legal entities having their own business and management structure and model and the relationship *inter se* between AIL and KL were always commercial and contractual, as a Licensor and Licensee. The transfer of shareholdings was all in individual capacities as per their individual choices and did not affect the corporate identity of AIL or KL. AIL at the time of its acquisition was a public listed company with the BSE and as such even otherwise individual shareholdings or of directorship was of no consequence.
- 5.50. AIL Suit has been filed *mala fide* and out of trade and business jealousy and is not maintainable due to AIL's long delay, laches and acquiescence to KL's rights and usage and further barred by the principles of estoppel.
- 5.51. AIL's allegations of manufacture of 'integrated steel' is also wrong to its own knowledge as 'integrated steel' is referred to manufacturing steel from iron ore to finish products which AIL admittedly has never done so. AIL's alleged domain [www.alkamdhenugold.com](http://www.alkamdhenugold.com) is in violation of KL's rights and use in the KAMDHENU Marks including Marks 'KAMDHENU GOLD', 'KAMDHENU GOLD TMT' and the Impugned Mark. The registration of the AIL's alleged domain [www.alkamdhenugold.com](http://www.alkamdhenugold.com) by AIL is *mala fide* and in bad faith and is without the leave, license or approval of KL.



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- 5.52. The term ‘Turbo TMT’ is also a misnomer and no such term exists in the industry. AIL, if at all, was only using the dealer and distribution network of KL in the designated areas of Delhi / NCR only. AIL only used the technology, know-how and Marks of KL.
- 5.53. AIL’s alleged interaction with the Ministry of Corporate Affairs, Government of India and seeking incorporation of a company under the name of AL KAMDHENU GOLD PVT. LTD is a sham, fraudulent and *mala fide* operations conducted by it to derive unjust benefits to the detriment of KL. KL has already filed its objections with the Registrar of Companies against the incorporation of the company under the name of AL KAMDHENU GOLD PVT. LTD.
- 5.54. AIL’s alleged application and grant of business license by the Government of Dubai to conduct its business under the company name AL KAMDHENU GOLD LLC - FZ through its alleged office at Dubai, U.A.E. is all without the leave, license or approval of KL and is in violation of KL’s rights. Such overseas dealings are in violation of KL’s rights amounting to infringement and passing off.
- 5.55. KL’s TM application No. 6759794 has been lawfully accepted by the Registrar of Trade Marks and so published in the Official Trade Mark Journal. AIL obtained the acceptance order to its application under Nos. 6742246, 6845771 and 6845025 by concealments and manipulations and by playing a fraud upon the Registrar of Trade Marks.



- 5.56. By the Impugned Mark and by its alleged usage and filings AIL is seeking to pass off AIL's goods and business as that of KL and to infringe KAMDHENU Mark. AIL is doing so *mala fide* and to reap illegal profits and gains by trading upon KL's well-established rights, usage, goodwill and reputation in the KAMDHENU Mark. KL has a *prima facie* case for injunction in its favour and balance of convenience also lies in favour of KL. Irreparable harm and injury would be caused to KL which cannot be compensated in monetary terms, if AIL continues to use the Impugned Mark of which 'KAMDHENU' / 'KAMDHENU GOLD' forms an essential and prominent feature and thereby infringe KAMDHENU Mark and KAMDHENU GOLD formative Marks and pass off AIL's goods / business as that of KL.
- 5.57. Reliance has been placed on the following judgments to highlight the difference between an assignment and a license:
- i. ***Classic Equipments (P) Ltd. vs. Johnson Enterprises and Others***, 2009 SCC OnLine Del 4387
  - ii. ***Sun Pharmaceuticals Industries Limited Vs. Cipla Limited***, 2008 SCC OnLine Del 1135
- 5.58. Reliance has further been placed on ***Latif Estate Line India Ltd. v. Hadeeja Ammal***, 2011 SCC OnLine Mad 215 to submit that, transfer of title cannot cancel *simpliciter*, it has to be assigned / transferred back to the original assignor.
- 5.59. Reliance has been placed on the following judgments to submit that, license once revoked any use by licensee would amount to infringement:



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- i. *IMS Learning Resources Private Limited Versus Young Achievers*, CS (COMM) 602/2018
  - ii. *Morgardshammar India Limited & Others Versus Morgardshammar AB*, 2012 SCC OnLine Del 4945
  - iii. *Velcro Industries B.V. v. Velcro India Ltd.*, 1993 (1) Arb.LR 465
  - iv. *Baker Hughes Limited v. Hiroo Khushalani*, 1998 PTC (18) 580
- 5.60. Reliance has further been placed on *J.K. Jain and Ors. v. Ziff-Davies Inc.*, 2000 PTC 244 (DB) to submit that, an ex-licensee is estopped from resisting injunction by licensor after termination of agreement.
- 5.61. Reliance has been placed on *Power Control Appliances v. Sumeet Machines Pvt. Ltd.*, MANU/SC/0646/1994 to submit that, there can be only one mark, one source and one proprietor.
- 5.62. Reliance has further been placed on the following judgments to submit that, in a passing-off suit the Plaintiff has to show goodwill and reputation of the business:
- i. *Gora Mal Hari Ram Vs. Bharat Soap and Oil Industries*, MANU/DE/0431/1983
  - ii. *American Home Products Corporation Vs. Mac Laboratories Pvt. Ltd. and Ors.*, MANU/SC/0204/1985
  - iii. *Laxmikant V. Patel Vs. Chetanbhat Shah and Ors.*, MANU/SC/0763/2001



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5.63. Reliance has been placed on the following judgments to submit that, 'KAMDHENU' is the dominant / essential feature of the plaintiff's family of marks:

- i. *Renaissance Hotel Holdings Inc. v. B. Vijaya Sai*, (2022) 5 SCC 1
- ii. *Ruston & Hornsby Ltd. v. Zamindara Eng. Co.*, (1969) 2 SCC 727
- iii. *KRBL Limited v. Praveen Kumar Buyyani & Ors.*, 316 (2025) DLT 783
- iv. *Under Armour Inc v. Anish Agarwal & Ors.* 2025: DHC :4243-DB
- v. *Amba Shakti Steel s Ltd. v. Sequence Ferro Private Limited*  
Neutral Citation: 2024: DHC:6703-DB
- vi. *Jaquar & Co. (P) Ltd. v. Ashirvad Pipes (P) Ltd.*, 2024 SCC OnLine Del 2281
- vii. *M/S. South India Beverages Pvt. Ltd. Vs. General Mills Marketing Inc. & Anr.*, FAO (OS) 289/2014, Delhi High Court
- viii. *Living Media India Limited and Ors. Vs. Aabtak Channel.Com (John Does) and Ors.*, CS(COMM) 193/2022  
Delhi High Court

**REJOINDER SUBMISSIONS ON BEHALF OF AIL:**

6. The learned Senior Counsel for AIL made the following submissions:
  - 6.1. The defences raised by KL are vague and evasive and do not pertain to the Impugned Mark. KL has attempted to create a false narrative regarding the business relationship between AIL and KL and various agreements entered between the Parties.



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KL's interpretation and understanding of the various agreements between the parties including 2002 Agreement is flawed and contrary to their stand taken at the time of execution of the said agreements.

- 6.2. KL is trying to mislead this Court by stating that under 2002 Agreement, AIL was entitled to adopt and use the Impugned Mark only during the subsistence of the 2002 Agreement. However, a mere perusal of 2002 Agreement would evidence that it was agreed between the Parties that KL will be the absolute owner of the Mark 'KAMDHENU' and AIL will be the absolute owner of the Impugned Mark.
- 6.3. KL's argument that the goods for which 2002 Agreement has been stipulated had become obsolete is irrelevant as the present dispute does not concern the nature of goods dealt in 2002 Agreement.
- 6.4. AIL in 2021 Agreement did not explicitly and unequivocally recognize and acknowledge KL's right in the Mark 'KAMDHENU GOLD' registered under TM application No. 842704. While entering into 2021 Agreement, which pertained solely to the Marks 'KAMDHENU' and 'KAMDHENU NXT', KL with *mala fide* and fraudulent intent inserted a reference to TM application No. 842704, which pertains to the Mark 'KAMDHENU GOLD' within the recitals of the 2021 Agreement. AIL, having placed trust in KL, did not verify each and every TM application Number mentioned in 2021 Agreement. Since 2021 Agreement concerned only the Marks



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‘KAMDHENU’ and ‘KAMDHENU NXT’, AIL had no reason to anticipate that KL would clandestinely include TM application No. 842704 which pertains to the Mark ‘KAMDHENU GOLD’.

- 6.5. It is a settled principle of law that when two parties enter into an agreement to perform certain acts, and due to oversight or mistake, certain terms or expressions are inaccurately used in the written document, it is the true intention of the parties that must be considered to determine the purpose and effect of the agreement. In the present case both Naresh Chand and KSAL acknowledges AIL to be the absolute owner of the Impugned Mark and neither of them is claiming any right over the Impugned Mark.
- 6.6. KL’s contention that AIL has deliberately concealed and suppressed the MoU is frivolous. KSAL is not a party to the present dispute and the MoU does not concern with the facts of the present dispute. The MoU only came into the knowledge of AIL when KL filed the Saket Suit. KL has filed the Saket Suit on the basis of the MoU and in the Saket Suit, KSAL has denied the authenticity and enforceability of the MoU, taking the following stand with respect to the MOU:
- i. The MoU is alleged to be signed by Mr. Neeraj Kumar Jain on behalf of KSAL. However, as per the records and knowledge of Mr. Neeraj Kumar Jain, Defendant No. 2 in the AIL Suit had no authority to sign the MoU in the first place, no board resolution has been issued by KSAL in



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favour of Mr. Neeraj Kumar Jain, as is required in case of a company and therefore the MoU is null and *void ab initio*.

- ii. Further, no reference to a Board Resolution in favour of Mr. Neeraj Kumar Jain exists in the Minutes Book maintained by KSAL, for the period since its incorporation to the alleged signing of the MoU. KSAL could never have entered into the MoU as the same seriously prejudices the rights, entitlements and objectives of KSAL, as per the Articles of Memorandum and Association; but also goes against the commercial sense of business.
- iii. The MoU is also against the fundamental right of freedom of trade and commerce of KSAL and amounts to oppression and mismanagement.
- iv. The MoU is an afterthought, and internal arrangement among individuals who were closely related to each other, and no third party, including KSAL, was ever made aware of its existence. Mr. Neeraj Kumar Jain is the founding shareholder and promoter of KL in equal proportion to Mr. Satish Kumar Agarwal, as also the father-in-law of the niece of Mr. Satish Kumar Agarwal, who has signed the MoU on behalf of AIL. Mr. Neeraj Kumar Jain and Mr. Satish Kumar Agarwal, who signed the MoU on behalf of Defendant No. 2 in the AIL Suit and AIL, respectively, are closely related. Even the two witnesses who signed the MoU i.e., Vivek Maheswari and Sangeeta Kalra were also



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in fact closely related to KL and while Vivek Maheshwari has been the AGM in KL, Sangeeta Kalra has been a shareholder in KL.

- v. The MoU bears a physical stamp, despite the fact that at the time of the execution of the MoU, e-stamping had already been introduced and prevalent across New Delhi, which further raises serious doubts regarding the authenticity and genuineness of the MoU.
- 6.7. Further, the AIL Suit does not suffer from delay, laches and acquiescence as the AIL Suit was filed as soon as AIL became aware that KL is trying to unauthorizedly claim rights over the Impugned Mark despite categorically giving up the same *vide* 2002 Agreement. With respect to the 2002 Agreement, it is AIL's case that 2002 Agreement is still valid and AIL seeks directions against KL for the specific performance of 2002 Agreement.
- 6.8. On 27.12.2002, *vide* TMA 1161758, AIL through the common lawyer with KL applied for the registration of the Impugned Mark in Class 6. However, TMA 1161758 was inadvertently abandoned in 2008 and the lawyer never informed AIL. Nonetheless AIL commenced and has since 2002 been *bona fide* using the Impugned Mark. Concurrently, AIL also continued to manufacture products under the brand 'KAMDHENU' for KL in compliance with 2002 Agreement, with the ultimate objective of getting the registration of the Impugned Mark.



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- 6.9. KL's claim of irreparable injury is illusory, especially when AIL has used the Impugned Mark openly, continuously and uninterruptedly since 2002 and KL has knowingly acquiesced to this use for over two decades and has never made use of the Impugned Mark.
- 6.10. Admittedly, TMA 1161758 was filed immediately after the execution of the 2002 Agreement by the lawyer who is now representing KL and against AIL in the present proceedings. The Trade Marks Registry has issued orders dated 07.01.2008 deeming AIL's TMA 1161758 as abandoned and a copy of the same was served on the said lawyer. The said lawyer did not inform AIL of the abandonment and it resulted in AIL losing its statutory rights over the Impugned Mark. Thereafter, the same lawyer applied for the same Impugned Mark on behalf of KL under TM application No. 6759794 in Class 6 for steel bars and other related products and also challenged AIL's rights over the Impugned Mark through various proceedings before this Court and before the Trade Marks Registry. AIL has also addressed a legal notice to the lawyer in this regard.
- 6.11. KL has never used the Impugned Mark in any capacity, nor has filed a single shred of evidence to support its fraudulent claims of use. KL's application dated 17.12.2024 has falsely claimed user since 2001 in a deliberate attempt to mislead the Trade Marks Registry and this Court. Hence, KL's assertion of rights and use of the Marks 'KAMDHENU GOLD', 'KAMDHENU GOLD TMT', and the Impugned Mark are inconsistent. TM



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application No. 842704 for the Mark ‘KAMDHENU GOLD’ filed on 24.02.1999 has been filed on ‘proposed to be used’ basis, TM application No. 1009954 for the Mark ‘KAMDHENU GOLD TMT’ filed on 17.05.2001 has been filed claiming user since 01.04.1997, while TM application No. 6759794 for the Impugned Mark filed on 17.12.2024 has been filed claiming user since 17.05.2001 which is the filing date of the said application for the Mark ‘KAMDHENU GOLD TMT’. Such mischievous conduct, laced with material suppression and falsehood renders all of KL’s assertions legally untenable.

- 6.12. KL has further filed various proceedings before this Court being W. P. (C) - IPD Nos. 29 to 33 of 2025 challenging AIL’s TM application Nos. 6890699, 6845025, 6890704 and 6742246 for the Impugned Mark, 6845771 for the Mark



‘’, in contravention to 2002 Agreement.

- 6.13. AIL in the AIL Suit has disclosed that AIL has expanded its business outside India and has set up a company namely AL KAMDHENUGOLD L.L.C-FZ in Dubai, U.A.E. Now, KL with utmost *mala fide* has applied for the registration of Impugned Mark in Dubai, in an attempt to disturb the legitimate commercial rights of AIL which is in direct breach of the 2002 Agreement. It is a settled position in law that when *mala fide* is writ large then injunction must follow.



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- 6.14. A perusal of the subject line of the termination letter dated 19.09.2024 reveals that it pertains exclusively to 2021 Agreement and contains no reference whatsoever to 2002 Agreement. Without prejudice to the foregoing, AIL duly responded to the termination letter dated 19.09.2024 *vide* its reply dated 27.01.2025, categorically denying all baseless and false allegations levelled by KL and has further prayed for specific performance of the 2002 Agreement in the AIL Suit. Furthermore, KL has no unilateral right to terminate 2002 Agreement, as none of its clauses confer upon KL any such power of revocation or termination.
- 6.15. Furthermore, KL has falsely pleaded before this Court that 2021 Agreement superseded 2002 Agreement, however, 2021 Agreement merely modifies the terms of the license granted to AIL in respect of the Marks 'KAMDHENU' / 'KAMDHENU NXT' and has no bearing whatsoever on the assignment of the Impugned Mark to AIL as contemplated in 2002 Agreement. 2021 Agreement neither alters nor overrides any of the rights assigned to AIL under the 2002 Agreement, particularly with regard to AIL's exclusive and absolute ownership of the Impugned Mark.
- 6.16. KL is also trying to portray a misleading picture before this Court that AIL has not used the Impugned Mark. However, KL itself has never used the Impugned Mark, nor has it placed on record any material or document to establish its use of the Impugned Mark and has an inconsistent user claim throughout



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its applications for the use of the Mark ‘KAMDHENU GOLD’ / ‘KAMDHENU GOLD TMT’ / Impugned Mark. Such conduct on the part of KL reflects a clear abuse of its position and is indicative of a willful and arbitrary assertion of rights it does not possess. AIL has placed sufficient documentary evidence on record to show that AIL has been using the Impugned Mark continuously since the year 2002. AIL has placed enough material on record to show that AIL has been using the Impugned Mark and that the Impugned Mark has acquired goodwill and reputation. Moreover, it is a settled position in law that to claim proprietorship over a mark, it is not necessary that the mark should have been in use for considerable length of time and even a single actual use with intent to continue use confers a right to such mark as a trademark.

- 6.17. 2002 Agreement categorically assigned the exclusive and absolute proprietary rights in the Impugned Mark to AIL. This was a conscious, deliberate, and informed transfer made by KL with full knowledge of the consequences. Having divested itself of all rights in the Impugned Mark and allowed AIL to use the Impugned Mark for over two decades, KL is estopped in law and equity from now turning around to challenge the very rights it relinquished. This belated attempt to claw back contractually alienated rights is not only barred by the doctrine of estoppel but also amounts to fraud upon the court.
- 6.18. Owing to AIL’s admitted prior longstanding and continued use, coupled with investments in marketing and the resultant



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turnover, the Impugned Mark acquired significant goodwill and reputation in the industry since 2002, allowing AIL to create a niche for itself immediately when AIL started focusing on the Impugned Mark. Further, the consumer / buyer of the Impugned Mark is not the buyer of KAMDHENU Mark and AIL has in fact tapped into the nonexistent markets of KL and established a distinct and self-sustaining market, separate from KL.

- 6.19. In conclusion, AIL is the owner of the Impugned Mark and KL is the owner of the KAMDHENU Mark. Both Parties have categorically admitted the rights of one another in the said Marks through 2002 Agreement. Having allowed AIL to use the Impugned Mark and having agreed to withdraw trade mark application for the Mark 'KAMDHENU GOLD' to enable AIL to have the Impugned Mark registered, KL cannot under any stretch of imagination be allowed to go against 2002 Agreement, which has not been challenged till date and is valid and subsisting.

**ANALYSIS AND FINDINGS:**

7. It is well established that when interim relief is sought in a suit and the opposing party raises concerns regarding the maintainability of the suit or alleges that it is barred by law and further argues on this basis that interim relief should not be granted, the Court must first form and record at least a *prima facie* determination that the suit is maintainable and not barred by law before granting any such interim relief. Accordingly, prior to evaluating the substantive merits of the present Applications, it is essential to address the



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preliminary objection raised by the learned Senior Counsel for KL concerning the maintainability of the AIL Suit.

8. KL has questioned the maintainability of the AIL Suit primarily on two grounds. *Firstly*, it is asserted that the rights in the Impugned Mark were assigned by AIL to Naresh Chand *alias* Naresh Jain, and thereafter by Naresh Chand *alias* Naresh Jain to KSAL, by way of Assignment Deeds. It was submitted on behalf of KL that following the institution of the AIL Suit on 13.02.2025, AIL, in conjunction with its director Naresh Chand *alias* Naresh Jain and KSAL, sought to cancel the Assignment Deeds through a written communication addressed solely to Naresh Chand *alias* Naresh Jain, and not to KSAL. KL contends that once title has been transferred by an instrument, such as AIL claims to have done, it cannot be unilaterally cancelled as a reassignment to the original assignor is required. On this basis, it is argued on behalf of KL that the purported cancellation of the Assignment Deeds is invalid, and AIL, therefore, lacks locus to sustain the Suit.

9. In the present matter, it is AIL's own admission that, without awaiting registration of the Impugned Mark in its favour, AIL assigned the Impugned Mark, first to Naresh Chand *alias* Naresh Jain and thereafter to KSAL. It is also not in dispute that AIL's applications in respect of the Impugned Mark have not yet proceeded to registration. In this backdrop, where the rights claimed by AIL in the Impugned Mark had not attained finality, the scope of what could have been conveyed under the Assignment Deeds, even prior to registration, and whether the same operates to denude AIL of its ability to maintain the AIL Suit in its own name, are matters which fall for



consideration on merits intrinsic to the dispute between the Parties, and certainly do not warrant non-suiting AIL at this interlocutory stage.

10. *Secondly*, it was contended on behalf of KL that in the absence of declaratory relief challenging the termination letter dated 19.09.2024, the AIL Suit, filed for mandatory injunction and specific performance of 2002 Agreement, must fail and in this regard reliance was placed on *I.S. Sikandar v. K. Subramani*, (2013) 15 SCC 27 wherein the Supreme Court was dealing with an agreement for sale that provided for stipulated sale within a stipulated time frame and on failure of the plaintiff therein to respond to the notice seeking execution of sale, the agreement was terminated. In that context, the Supreme Court in *I.S. Sikandar (supra)* observed that:

*“36. Since the plaintiff did not perform his part of contract within the extended period in the legal notice referred to supra, the agreement of sale was terminated as per notice dated 28-3-1985 and thus, there is termination of the agreement of sale between the plaintiff and defendants 1-4 w.e.f. 10-4-1985*

*37. As could be seen from the prayers sought for in the original suit, the plaintiff has not sought for declaratory relief to declare the termination of agreement of sale as bad in law. In the absence of such prayer by the plaintiff the original suit filed by him before the trial court for grant of decree for specific performance in respect of the suit scheduled property on the basis of agreement of sale and consequential relief of decree for permanent injunction is not maintainable in law.*

*38. Therefore, we have to hold that the relief sought for by the plaintiff for the grant of decree for specific performance of execution of sale deed in respect of the suit scheduled property in his favor on the basis of non-existing agreement of sale is wholly unsustainable in law.”*

[Emphasis Supplied]

11. In the AIL Suit, AIL seeks specific performance of 2002 Agreement, asserting that 2002 Agreement remains in effect and has not been superseded by the 2021 Agreement. AIL further contends that the



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termination dated 19.09.2024 pertains solely to the 2021 Agreement and does not impact the validity or enforceability of the 2002 Agreement. Conversely, KL argues that the 2021 Agreement novated the 2002 Agreement such that, upon termination of the 2021 Agreement, no rights remain under the 2002 Agreement, rendering the AIL Suit unsustainable without seeking a declaratory relief.

12. The necessity for declaratory relief would arise if, based on a *prima facie* assessment, the termination introduces a clear legal obstacle to enforcing the contract. In the preset case, AIL disputes both the alleged novation effected by the 2021 Agreement and the application of the termination letter dated 19.09.2024 to the 2002 Agreement. Requiring AIL to challenge the termination letter as a condition for seeking specific performance of the 2002 Agreement would essentially compel AIL to accept, contrary to its stated position, that the 2002 Agreement was indeed novated by the 2021 Agreement and that the termination affects its rights.

13. Since AIL maintains that the 2002 Agreement remains operative, it is entitled to proceed accordingly and treat the termination letter dated 19.09.2024 as having no legal effect upon its rights under the 2002 Agreement. Declaratory relief is warranted when there is genuine uncertainty regarding the plaintiff's rights, with the grant of relief depending on the resolution of such uncertainty. However, where a contract is terminated unilaterally, such action may constitute a repudiatory breach, thereby entitling the aggrieved party to treat the contract as continuing and to seek specific performance without first obtaining declaratory relief concerning the validity of the termination.



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14. The decision in *I.S. Sikandar (supra)* is also factually distinguishable, as in that case, the termination of the agreement was not disputed, and the plaintiff sought enforcement of a contract which, by its own account, had already ceased to exist. In contrast, the present case involves a dispute regarding both the applicability of the termination and the plea of novation. Under these circumstances, the objections to the maintainability of the AIL Suit cannot be decided at this preliminary stage and is kept open.

15. In view of the above, the submissions made for respective Applications filed by AIL and KL under Order XXXIX Rules 1 and 2 read with Section 151 of the CPC, seeking interim injunctions are considered hereinbelow.

16. AIL contends that the alleged joint management of KL is pertinent to the rights of the Parties. Specifically, AIL asserts that in 1996 it was brought under the joint direction of KL, which itself was managed collaboratively by the Agarwal family and the Jain family. AIL further submits that the Brand and Mark ‘KAMDHENU,’ first established in 1994, was developed through the joint efforts and contributions of both families, each benefiting from profits generated by the sale of steel products bearing KAMDHENU Mark and its various permutations and combinations. Accordingly, to evaluate AIL’s claims, it is necessary to examine relevant provisions of the 1997 Agreement, 2002 Agreement, and 2021 Agreement (“**Agreements**”) that are central to the dispute.

17. In this regard, the 1997 Agreement states that:

*“...The second party is not related to the first party and therefore both the entities are separate and the first party has no control over the second party.”*



The 2002 Agreement states that:

*“WHEREAS, the Licensor and Licensee are totally unrelated parties and both the entities are separate and distinct; and...”*

The 2021 Agreement further states that:

*“G. The relationship between the First Party and the Second Party hereto is purely commercial and contractual and they are separate legal entities and are not related to each other.”*

18. An analysis of the relevant clauses of the Agreements confirms that the Agreements were executed with the explicit understanding that the Parties are unaffiliated and operate independently. The relationship between the Parties has consistently involved distinct entities conducting business solely within a commercial and contractual context. Within this arrangement, all rights pertaining to trademarks, trade names, and associated goodwill reside with corporate entities rather than any individual directors. Consequently, any claims based on purported family arrangements or collaborative development of KAMDHENU Mark do not impact the legal rights of the Parties.

19. Reliance placed by AIL on *Thayyullathil Kunhikannan (supra)*, *Shri Ram Education Trust (supra)* is not helpful as these decisions pertain to issues of succession and inheritance rights, and not to contractual arrangements between admittedly unrelated Parties acting in their commercial capacity as in the present case. Likewise, *Darshan Lal Dhooper (supra)*, does not advance AIL’s case as the same having arisen in an uncontested petition on a wholly distinct set of facts.

20. AIL has further asserted, with considerable emphasis, that 2002 Agreement constituted a trademark assignment agreement and KL had



unambiguously relinquished any rights to the Impugned Mark and has recognized AIL as its exclusive user.

21. For addressing this issue, the legal framework governing the assignment and licensing of trademarks is discussed below:

22. This Court in ***Classic Equipments (P) Ltd.*** (*supra*) observed as under:

*“26. Assignment has been defined in Section 2(a) of the Trade and Merchandise Marks Act, 1958 corresponding to Section 2(b) of the Trade Marks Act, 1999 as under: 2(a) "assignment" means an assignment in writing by act of the parties concerned.*

*27. The expression "assignment" has been considered by the Supreme Court in Nand Kishore Prasad v. State of Bihar, AIR 1978 SC 1277, wherein at para 10 it was observed "Assignment", it has been stated in Black's Law Dictionary. Special Deluxe Ed., p. 106, "is a transfer or making over to another of the whole of any property, real or personal, in possession or in action, or of any estate or right therein". It has further been stated as "The transfer by a party of all its rights to some kind of property, usually intangible property such as rights in lease, mortgage, arrangement of sale or partnership".*

*28. The distinction between a license and assignment has been stated in Chapter 20 of Law of Trade Marks by passing off by P. Narayana Sixth Edition. The relevant portions of the paragraph 20.02 are extracted hereunder:*

*20.02 Distinction between licensing and assignment Property in a trade mark consists in the exclusive right to use the mark in relation to some goods, subject of course to the right of honest concurrent user by others Assignment is a permanent transfer of this right to use, while licence is a temporary transfer of this right, either exclusively or non-exclusively"..... licence could be revoked, whereas an assignment is irrevocable.*

*29. Once an Assignment Deed has been executed, the assignor ceases to have any right, title or interest in the property assigned. It is not open to the assignor to cancel the assignment by means of a communication. The Deed of assignment can only be cancelled under the provisions of Specific Relief Act...*

[Emphasis Supplied]



23. Assignment of trade mark is taken to be a transfer of the trade mark by the owner or proprietor thereof to a third party. By assignment, the original owner or proprietor of trade mark is divested of his right, title or interest therein. Whereas licence to use a trade mark is distinct and different from assignment. A licence signifies a permitted use of a trade mark, without any transfer of ownership, with the proprietary rights and goodwill continuing to vest in the licensor.

24. Therefore, it is important to consider how the relevant provisions of the Trade Marks Act govern the aspects of permitted use of a trade mark:

Section 2(1)(r) of the Trade Marks Act defines ‘Permitted use’ as under:

*“Permitted use”, in relation to a registered trademark, means the use of trademark-*

*(i) by a registered user of the trademark in relation to goods or services-*

*(a) with which he is connected in the course of trade; and*

*(b) in respect of which the trademark remains registered for the time being; and*

*(c) for which he is registered as registered user; and*

*(d) which complies with any conditions or limitations to which the registration of registered user is subject; or*

*(ii) by a person other than the registered proprietor and registered user in relation to goods or services-*

*(a) with which he is connected in the course of trade; and*

*(b) in respect of which the trademark remains registered for the time being; and*

*(c) by consent of such registered proprietor in a written agreement; and*

*(d) which complies with any conditions or limitations to which such user is subject and to which the registration of the trademark is subject;”*

Whereas Section 48 (2) of the Trade Marks Act provides that:

*“The permitted use of a trade mark shall be deemed to be used by the proprietor thereof, and shall be deemed not to be used by a person other than the proprietor, for the purposes of section 47 or*



*for any other purpose for which such use is material under this Act or any other law.”*

25. According to Section 48(2) of the Trade Marks Act, use of a trade mark by a licensee is legally considered as use by the proprietor for all purposes under the Trade Marks Act or any other relevant law.

26. A review of the Agreements indicates that the relationship between the Parties is clearly defined as licensor and licensee. The Agreements consistently state that no right, title, or interest in the KAMDHENU Mark is conveyed to AIL, and all goodwill generated from the use of the KAMDHENU Mark accrued exclusively to KL. In this context, reference may be made to Clause 5 of the 2002 Agreement:

*“5. The licensee expressly acknowledges, agrees and admits that*

- 1) The said trade mark is the exclusive proprietary rights of Licensor;*
- 2) By use of the said trade mark, the Licensee does not and shall not, nor shall it be deemed to have acquired any right, title or interest whatsoever (other than the bare license and right to continue and use them hereunder granted) in, to or over the said trade mark at any time hereafter;*
- 3) Any right, title, interest or goodwill whatsoever which may arise out of the use of the any of the trademarks;*
  - i. Vests with Licensor, who is the exclusive proprietary of the same;*  
*and*
  - ii. Shall be deemed to be held by the Licensee for the absolute benefit of licensor.”*

[Emphasis Supplied]

27. Clause 22 of 2002 Agreement provides that AIL shall be entitled to adopt and use the Impugned Mark in relation to steel bars and other cognate and related goods, however, also dictates AIL as to the form and manner of such usage of the Impugned Mark. Clauses 23 and 24 of 2002 Agreement further provide that up to the time of registration of the Impugned Mark as envisaged under Clause 24 of 2002 Agreement, KL will be entitled to use



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the Impugned Mark in relation to Steel Bars and other cognate and related goods.

28. Clause 24 of 2002 Agreement also, in clear terms, provides that AIL ‘*will become exclusive and absolute owner*’ only upon final registration of the Impugned Mark. The vesting of ownership is thus expressly contingent, and no proprietary rights accrue unless and until such registration is obtained by AIL. Clause 26(b) of 2002 Agreement further provides for automatic termination of 2002 Agreement upon such registration, indicating that the parties to the 2002 Agreement envisaged a transition from a license regime to an ownership regime only upon final registration of the Impugned Mark by AIL.

29. Accordingly, Clauses 22 to 26 of 2002 Agreement, when read conjointly, do not provide for any present transfer of proprietary rights, but merely contemplate a future and contingent possibility of such transfer upon registration of the Impugned Mark in favour of AIL. The pervasive control retained by KL over the manner, scope and continuance of use of the Impugned Mark by AIL including termination rights indicate that there was no assignment of Impugned Mark. The 2002 Agreement, therefore, in substance and effect, constitutes a license user arrangement even in respect of the Impugned Mark, and cannot be construed as being in the nature of an assignment thereof.

30. On the aspect of novation of 2002 Agreement by 2021 Agreement, Recital E of 2021 Agreement reads as under:

*“E. The First Party executed an Agreement dated 26th December, 2002 with Ashiana Ispat Limited for manufacturing and sale of Steel Bars under the Trade Mark KAMDHENU for a period of 99 years. The said Agreement was executed pertaining to the product steel bars which were Cold Twisted Bars (CTD bars)/Tor Steel. However,*



*over a period of time, the said products have become obsolete and new products have been introduced. Now, in view of the current requirement of reinforcement steel bars to fulfill the requirement of high rise buildings scaling upto great heights, metro rails and big infrastructure projects, the First Party after extensive research has developed the next generation TMT Bar known as KAMDHENU NXT. That since the old form of steel bars, CTD bars/tor steel have already been obsolete, the Second Party is now interested to continue the current arrangement between the Parties to manufacture latest and modern version of steel bars, KAMDHENU NXT to fulfill the requirements of the industry.”*

31. ‘Novation’ implies a fresh contract directly or by implication in place of the original contract. Black’s Law Dictionary 6<sup>th</sup> Edition at Page No. 1064 defines ‘Novation’ as:

*“Novation. A type of substituted contract that has the effect of adding a party, either as obligor or obligee, who was not a party to the original duty. Substitution of a new contract, debt, or obligation for an existing one, between the same or different parties. The substitution by mutual agreement of one debtor for another or of one creditor for another, whereby the old debt is extinguished. A novation substitutes a new party and discharges one of the original parties to a contract by agreement of all parties. See Restatement of Contracts, Second, § 280. The requisites of a novation are a previous valid obligation, an agreement of all the parties to a new contract, the extinguishment of the old obligation, and the validity of the new one. Blyther v. Pentagon Federal Credit Union, D.C. Mun. App., 182 A.2d 892, 894.*

*In the civil law, there are three kinds of novation: where the debtor and creditor remain the same, but a new debt takes the place of the old one; where the debt remains the same, but a new debtor is substituted; where the debt and debtor remain, but a new creditor is substituted. Wheeler v. Ewardell 173 Va 168, 2 S.E.2d 377, 388.”*

32. Section 62 of the Contract Act, 1872 (“**Contract Act**”) allows novation, rescission, modification and alteration of an earlier contract with a new agreement or even alteration of an earlier agreement. It gives rights to parties to put a contract to an end or terminate it. Under the new agreement or upon amendment of an earlier contract, prior rights of the parties are



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extinguished and new rights and obligations come into existence. Original contract is discharged or modified and substituted by the new obligations under the new contract or as a result of amendment. Unless the new contract is void or unenforceable or the amended terms are unenforceable, a party cannot revert back to the original contract. Section 62 of the Contract Act is based upon the principle that a contract is the outcome of a mutual agreement and it is equally open to the parties to mutually agree to bring the said contract to an end, enter into a new contract or modify the earlier contract. Contractual obligations can be modified by mutual consent. Parties can vary the terms of the contract and absolve a party from the original obligations. Once Section 62 of the Contract Act applies, parties are bound by the terms and conditions mentioned in the second contract or the amended terms and not by the first contract. The question is of intention of the parties, when they enter into second contract or modify earlier terms. Section 62 of the Contract Act does not require additional or new consideration or possibility thereof by any party, to be a valid and enforceable contract. Discharge of the original contract is regarded as consideration in the new contract. Release from the past consideration is a good consideration to enter into a new contract. No further consideration is required.

33. In the present case, Recital E of 2021 Agreement expressly takes note of the 2002 Agreement and records the shift in the nature of products from the erstwhile CTD / Tor Steel bars to the next-generation TMT bars, i.e., KAMDHENU NXT, and records that, *'in view of the current requirement of reinforcement steel bars'* KL has developed the next generation TMT bar known as KAMDHENU NXT, and that AIL is *'now interested to continue*



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*the current arrangement between the Parties to manufacture latest and modern version of steel bars’.*

34. The language of Recital E also assumes significance inasmuch as it characterizes the very subject matter of 2002 Agreement, CTD / Tor Steel bars as having become ‘*obsolete*’ reflecting a discontinuity with the earlier regime as under 2002 Agreement. The foundation of 2002 Agreement having ceased to exist, the Parties, by mutual consent, entered into 2021 Agreement to govern their rights and obligations in respect of a new and distinct product. In such circumstances, intention to substitute the earlier agreement is discernible from the terms of the subsequent agreement read in light of the surrounding commercial context.

35. In this conspectus and having regard to the principle that novation under Section 62 is founded on the mutual intention of the parties to substitute a new contract in place of the old, *prima facie* 2021 Agreement constitutes a novation of the 2002 Agreement.

36. In the present Applications, the reliefs sought by AIL arise from a claim of passing off, whereas the reliefs sought by KL arise from a claim of infringement and passing off.

37. Salmond & Heuston in Law of Torts, 20<sup>th</sup> edition at Page No. 395 on the remedy of passing off states that the legal and economic basis of passing off is to provide protection for the right of property, which exists not in a particular name, mark or style but in an established business, commercial or professional reputation or goodwill. The law on the remedy of passing off is designed to protect traders against that form of unfair competition which consists in acquiring for oneself, by means of false or misleading devices, the benefit of the reputation already achieved by rival traders.






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38. In a passing-off action the plaintiff will have to prove that his mark has by user acquired such goodwill / reputation as to become distinctive of the plaintiff's goods so that if it is used in relation to any goods of the kind dealt with by the plaintiff, it will be understood by the trade and public as meaning that the goods are the plaintiff's goods. In this backdrop, the submission advanced on behalf of AIL that AIL is the prior user of the Impugned Mark and has actively used the Impugned Mark in the course of trade and has thereby built considerable goodwill requires examination.

39. It is an admitted position of AIL that as AIL continued to manufacture products under KAMDHENU Mark for KL most of AIL's time, energy and resources were spent on focusing on the manufacturing of the products under KAMDHENU Mark and that the manufacture and sale of products under the Impugned Mark got lessor attention. Invoices dated 26.12.1997, 30.07.1997, 28.07.1999, 30.09.2000, 27.09.2000, 11.10.2003, 29.10.2003, 30.09.2004 and even up to 29.08.2024, placed on record by AIL, do not bear

the Impugned Mark, but instead bear the Marks '', /

 , / '', or carry the words '*Manufacturers of KAMDHENU® BRAND HSD BAR*'. Therefore, *prima facie*, the invoices filed by AIL from 1997 to 2024 do not show any use of the Impugned Mark by AIL.

40. The advertisements dated 30.10.2004, 03.10.2005, 15.02.2011, 15.12.2014, 19.01.2025, 05.01.2025 and 09.02.2025, placed on record by AIL, bear the Impugned Mark. The advertisement dated 03.10.2005



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mentions the Impugned Mark along with the disclaimer '*for 99 years as per agreement*'.

41. There is no cavil with the proposition that even advertisement of trade mark without existence of goods in the market is also to be considered as use of the trade mark. However, considering the facts and circumstances in the present case, the evidentiary value of such use must be assessed in the context in which it is made.

42. It is already observed above that a plain reading of 2002 Agreement indicates that the Parties operated within a licensor-licensee framework and 2002 Agreement in substance and effect constituted a permissive user arrangement even in respect of the Impugned Mark and consequently, any use of the Impugned Mark by AIL during the subsistence of 2002 Agreement, and prior to the grant of registration of the same in favour of AIL would not confer any independent goodwill upon AIL and any goodwill so generated would enure to the benefit of KL, especially when AIL itself has put disclaimer that it does not have any independent right over the Impugned Mark in the advertisement relied upon by AIL.

43. In the present case, some of the advertisements relied upon by AIL were published during the subsistence of 2002 Agreement necessarily falling within a permitted user of the Impugned Mark. Any such use, or goodwill including by way of advertisements, would therefore, enure to the benefit of KL, being the licensor, in view of Section 48 (2) of the Trade Marks Act and cannot be appropriated by AIL to independently establish prior user and goodwill.

44. In view of the above, AIL has not been able to establish *prima facie* case by establishing prior use or goodwill in its favour.



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45. As regards the claim of infringement and passing off on behalf of KL, it is settled law, that in an application for interim injunction, the burden is on the plaintiff to *prima facie* establish that there is right in favour of the plaintiff and there has been infraction of the enjoyment of the said right as a condition precedent for the grant of interim injunction. The Court then has to be satisfied that non-interference by the court would result in irreparable injury to the party seeking relief and that there is no other remedy available to the party except one to grant injunction and he needs protection from the consequences of apprehended injury, one that cannot be adequately compensated by way of damages. The third condition also is that the balance of convenience must be in favour of granting injunction.

46. The Court while granting or refusing to grant injunction should exercise sound judicial discretion to find the amount of substantial mischief or injury which is likely to be caused to the parties, if the injunction is refused and compare it with that which is likely to be caused to the other side if the injunction is granted.

47. KL has placed reliance on its registrations for Marks incorporating 'KAMDHENU GOLD' and related formative marks. The expression 'KAMDHENU GOLD', which forms dominant part of the Impugned Mark is admittedly coined by KL and when taken as a whole, constitutes a combination of two words being arbitrary and not descriptive of the goods in question. The Impugned Mark wholly incorporates KL's registered Mark 'KAMDHENU GOLD', with the addition of the prefix 'AL', which, *prima facie*, does not alter the essential character of the Mark 'KAMDHENU GOLD'. The dominant and distinctive element of the Mark 'KAMDHENU GOLD' thus stands appropriated in its entirety.



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48. Admittedly, since the execution of 2002 Agreement, AIL's business activities are largely in relation to the manufacture of goods under KAMDHENU Mark for KL, pointing to a market association of the KAMDHENU Mark including the Mark 'KAMDHENU GOLD' with KL, instead of AIL. Given the identity of the goods, structural, phonetic and conceptual similarity and the prominence of the element 'KAMDHENU GOLD' in the Impugned Mark, any concurrent use of the Impugned Mark by AIL is likely to cause confusion leading to association of AIL's use of the Impugned Mark with KAMDHENU Mark and result in diversion of trade.

49. If AIL would have obtained registration of the Impugned Mark in terms of 2002 Agreement, AIL could have asserted right over the Impugned Mark. Although AIL initially filed the application for registration of Impugned Mark in December 2002, subsequently the same was abandoned in January 2008. This clearly reflects lack of proactiveness on part of AIL to protect its rights. Although AIL attributes this lapse to its counsel, it remains evident that no substantive efforts were made by AIL to assert rights in the Impugned Mark until nearly sixteen years later, when a new application under TM Application No. 6742246 in Class 6 was submitted on 05.12.2024 after purported termination of 2002 Agreement.

50. Ordinarily, an entity seeking proprietary rights in a mark is expected to exercise due diligence in safeguarding such interests. The delayed filing, particularly following disputes between the Parties, including the receipt of the termination letter dated 19.09.2024 and caution notices issued on 06.11.2024 supports KL's argument that AIL's claim of exclusive rights over the Impugned Mark is potentially untenable.



51. The Annual Reports submitted by AIL do not indicate that the marketability of AIL's products is dependent on the use of the Impugned Mark. Furthermore, AIL has not provided evidence to demonstrate that its sales are significantly influenced by the use of the Impugned Mark. The records also show that KL has substantial sales figures and advertising expenditures, which support the conclusion that the marks 'KAMDHENU' / 'KAMDHENU GOLD' serve as the primary and established identifiers for KL's goods and business. This increases the likelihood that consumers may associate AIL's products or business with those of KL.

52. Undisputedly, AIL's adoption of the Impugned Mark stems solely from 2002 Agreement and does not originate independently. Given these circumstances, pending a conclusive determination regarding the Parties' rights under the Agreements and the ongoing Applications for registration of the Impugned Mark by both AIL and KL, AIL does not have any right to use the Impugned Mark independently.

53. Any use of the Impugned Mark by AIL is likely to adversely affect KL, potentially causing irreparable harm to KL's asserted rights. Accordingly, the balance of convenience favors KL, as KL is the registered proprietor of 'KAMDHENU', 'KAMDHENU GOLD', and 'KAMDHENU GOLD TMT'.

54. KL has also provided evidence of use, goodwill, and reputation associated with the KAMDHENU Mark, 'KAMDHENU GOLD' and 'KAMDHENU GOLD TMT'. This establishes KL's entitlement to protection against any actions that might diminish the goodwill attached to the KAMDHENU Mark in the marketplace.



55. The Supreme Court in *Pernod Ricard India (P) Ltd. v. Karanveer Singh Chhabra*, 2025 SCC OnLine SC 1701 has observed that:

“36.2. The grant of injunction - whether for infringement or passing off - is ultimately governed by equitable principles and is subject to the general framework applicable to proprietary rights. Where actual infringement is established, that alone may justify injunctive relief; a plaintiff is not expected to wait for further acts of defiance. As judicially observed, “the life of a trademark depends upon the promptitude with which it is vindicated.””

36.3. The principles laid down in *American Cyanamid Co. v. Ethicon Ltd.*<sup>30</sup> continue to guide the Courts while determining interim injunction applications in trademark cases. The following criteria are generally applied:

(i) *Serious question to be tried/triable issue:* The plaintiff must show a genuine and substantial question fit for trial. It is not necessary to establish a likelihood of success at this stage, but the claim must be more than frivolous, vexatious or speculative.

(ii) *Likelihood of confusion/deception:* Although a detailed analysis of merits is not warranted at the interlocutory stage, courts may assess the *prima facie* strength of the case and the probability of consumer confusion or deception. Where the likelihood of confusion is weak or speculative, interim relief may be declined at the threshold.

(iii) *Balance of convenience:* The court must weigh the inconvenience or harm that may result to either party from the grant or refusal of injunction. If the refusal would likely result in irreparable harm to the plaintiff’s goodwill or mislead consumers, the balance of convenience may favor granting the injunction.

(iv) *Irreparable harm:* Where the use of the impugned mark by the defendant may lead to dilution of the plaintiff’s brand identity, loss of consumer goodwill, or deception of the public - harms which are inherently difficult to quantify - the remedy of damages may be inadequate. In such cases, irreparable harm is presumed.

(v) *Public interest:* In matters involving public health, safety, or widely consumed goods, courts may consider whether the public interest warrants injunctive relief to prevent confusion or deception in the marketplace.



36.4. In conclusion, the grant of an interim injunction in trademark matters requires the court to consider multiple interrelated factors: prima facie case, likelihood of confusion, relative merits of the parties' claims, balance of convenience, risk of irreparable harm, and the public interest. These considerations operate cumulatively, and the absence of any one of these may be sufficient to decline interim relief.”

[Emphasis Supplied]

56. Given that the products at issue are reinforcement steel bars utilized in transportation and infrastructure projects, where safety and structural integrity are critical, any defect or deficiency associated with goods bearing the Impugned Mark may reasonably be associated with KL, thereby impacting KL's reputation and goodwill. The nature of these products makes monetary compensation insufficient for such injury. Therefore, permitting AIL to continue use of the Impugned Mark is likely to cause irreparable harm to KL. Accordingly, KL has established *prima facie* case for infringement and passing off, warranting the grant of an interim injunction in favour of KL and against the Defendants in the KL Suit.

**CONCLUSION:**

57. In view of the above, Defendants in KL Suit, jointly and severally, their directors, principal officers, proprietors, partners, dealers, distributors assigns and all others acting on their behalf are restrained from manufacturing, marketing, distributing, trading, wholesaling, soliciting, advertising, promoting, selling, using or dealing by any modes or means including in the physical markets or through the internet including ecommerce platforms, their own website or through social media platforms and directed to disable / remove / take down / block the listings of the products using the Impugned Mark 'AL KAMDHENU GOLD' in any manner or mode by itself or any other trade name / mark bearing the Word /



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Mark 'KAMDHENU' as its essential feature, or identical with or deceptively similar thereto including the Marks 'KAMDHENU GOLD' and 'KAMDHENU GOLD TMT' as a trade mark or as a part of a domain name upon or in relation to AIL's goods / business including steel products, TMT bars, steel bars, MS pipes, bright steel bars, steel pipes, metal pipes, and other allied / cognate products thereto or supplying services in connection therewith amounting to infringement and passing off of the Marks / Labels 'KAMDHENU' / 'KAMDHENU GOLD' / 'KAMDHENU GOLD TMT'.

58. As a consequence, the interim relief sought by AIL in AIL Suit cannot be granted.

59. Accordingly, I.A. No. 14115/2025, filed in CS (COMM) 569/2025 filed by Kamdhenu Limited is allowed in above terms and, consequently, I.A. No. 3990/2025 filed in CS (COMM) 130/2025 filed by Ashiana Ispat Limited seeking interim injunction is dismissed. Both Applications stand disposed of.

**TEJAS KARIA, J**

**APRIL 10, 2026**

*HK*