

Legal Issues in ‘Civil Enforcement for Trademark Infringement’

Topic: ‘Whether a cause of action for trademark infringement arises at the place where the trademark is registered?’

Relevant Legal Provisions

❖ Section 20(c), The Code of Civil Procedure, 1908

Other suits to be instituted where defendants reside or cause of action arises.—Subject to the limitations aforesaid, every suit shall be instituted in a Court within the local limits of whose jurisdiction—

(c) The cause of action, wholly or in part, arises.

❖ Section 29, Trade Marks Act, 1999

Infringement of registered trade marks

(1) A **registered trade mark** is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which is identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark.

(2) A **registered trade mark** is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which because of... is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trade mark.

Relevant Legal Provisions

❖ Section 29, Trade Marks Act, 1999

Infringement of registered trade marks

- (4) A **registered trade mark** is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which...
- (5) A **registered trade mark** is infringed by a person if he uses such registered trade mark, as his trade name or part of his trade name, or name of his business concern or part of the name, of his business concern dealing in goods or services in respect of which the trade mark is registered.
- (7) A **registered trade mark** is infringed by a person who applies such registered trade mark to a material intended to be used for labelling or packaging goods, as a business paper, or for advertising goods or services...
- (8) A **registered trade mark** is infringed by any advertising of that trade mark if such advertising...

Relevant Case Laws

❖ **M/s. Dhodha House v. S.K. Maingi [AIR 2006 SC 730 in the Supreme Court, decided on December 15, 2005]**

“The alleged cause of action for filing the said suit has been averred in paragraph 30 which reads as under:

*That the goods of the parties bearing the impugned trade marks are also sold in the Union Territory of Delhi. **The Trade Marks Journals No. 823 dt. 16.9.83 and No. 876 dt. 1.12.85 and Journal No. 933 dt. 16.4.1988 were published in India by the Trade Marks Registry in respect of applications of the defendants for registration of the impugned trade marks, including the Union Territory of Delhi. Therefore, this Hon’ble Court has jurisdiction to entertain and try the present suit...**” (emphasis supplied)*

“Cause of action, as is well-settled, is a bundle of facts which are necessary to be proved in a given case. Cause of action, it is trite, if arises within the jurisdiction of the court concerned empowers the court to entertain the matter.”

“A cause of action will arise only when a registered trade mark is used and not when an application is filed for registration of the trade mark. In a given case, an application for grant of registration certificate may or may not be allowed. The person in whose favour, a registration certificate has already been granted indisputably will have an opportunity to oppose the same by filing an application before the Registrar, who has the requisite jurisdiction to determine the said question. In other words, a suit may lie where an infringement of trade mark or copyright takes place but a cause of action for filing the suit would not arise within the jurisdiction of the court only because an advertisement has been issued in the Trade Marks Journal or any other journal, notifying the factum of filing of such an application.” (emphasis supplied)

Relevant Case Laws

- ❖ **M/s St. Ives Laboratories Inc. v. M/s Arif Perfumers & Anr. [2009:DHC:9390 in the High Court of Delhi, decided on February 6, 2009]**

*“5. Before entertaining a suit, the Court has to ensure whether any part of cause of action had arisen within the jurisdiction of this Court. **The registration of a trademark in Delhi cannot be a ground to invoke jurisdiction of Delhi Courts. The Trade Marks Act does not provide that registration of trademark at a particular office shall be a ground for filing a suit for infringement of trademark or passing off trademark within the limits of that Court.**” (emphasis supplied)*

*“6. It is well settled legal position that cause of action is a bundle of material facts which are necessary for the plaintiff to prove his case in order to entitle him to succeed in a given case. **However, each and every fact pleaded in the plaint does not ipso facto lead to conclusion that those facts give rise to cause of action within the Court's territorial jurisdiction. The facts pleaded must have a nexus or relevance so as to show that the Court where the suit has been filed is the proper Court of jurisdiction. Facts, which have no bearing with the lis or the dispute involved in the case, do not given rise to a cause of action so as to confer territorial jurisdiction. In M/s Kusum Ingots & Alloys Ltd. v. Union of India & Anr. (2004) 6 SCC 254 Supreme Court observed that if a small fraction of cause of action accrued had arisen within the territorial jurisdiction of a particular High Court, it was not bound to entertain the petition. It would be sufficiently empowered to refer the petition to the Court where substantial cause of action had arisen and it would be more convenient to adjudicate the matter.**” (emphasis supplied)*

Relevant Case Laws

❖ **M/s. Duro Flex Pvt. Limited v. M/s.Duroflex Seatings System [O.S.A. No.111 and 112 of 2008 in the High Court of Madras, decided on December 4, 2014]**

“40. A cause of action consists of a bundle of facts. The judgment Shiv Bhagwan Moti Ram Saroji's case (supra) has correctly emphasised the duty of the Court to ascertain what facts constitute the cause of action. For example, the cause of action is the existence of a property in case of a partition suit and thus, its location must be considered in order to determine the jurisdiction of the Court. In case of an immovable property, its existence would be an essential part of cause of action and thus, if the same is situated within the jurisdiction of a particular Court, a part of cause of action would certainly arise within the jurisdiction of that Court.”

“41. The right of a plaintiff to a registered trade mark is a proprietary right and therefore, it is property (S.B.S. Jayam and Co.'s case (supra)). It is capable of being transferred under the provisions of the Act and is a movable property as per the definition under Section 3(36) of the General Clauses Act. The principal seat of the Trademarks Registry is at Mumbai and the Register of Trademarks is also maintained at the same place. However, there are branch offices, including one at Chennai, where in the present case, the trademark of the plaintiff came to be registered. The first question thus raised in this context is, whether such registration itself would give rise to a cause of action to institute the suit in this Court?” (emphasis supplied)

“44. We are in agreement with the submission for the learned counsel for the respondents that the mere registration of the trademark at Chennai would not create the complete cause of action at Chennai. The registration of the mark is a fact, but cause of action would consist of a bundle of facts. Thus, more than one fact would have to be taken into account to determine the location of a particular trademark which connects the trademark to the place.” (emphasis supplied)

Relevant Case Laws

- ❖ **M/s. Duro Flex Pvt. Limited v. M/s.Duroflex Sitzings System [O.S.A. No.111 and 112 of 2008 in the High Court of Madras, decided on December 4, 2014]**

“45. We do believe that the course of action suggested by the learned counsel for the respondents of applying the “connecting factors” test as enunciated in Canda vs. Folster's case (supra) would be the appropriate course of action. In terms of the said pronouncement, the weight given to each factor should be related to the purpose for which the situs was being determined and thus, mere registration of a trademark at a particular place would not be finally determinative of the situs of the mark. The situs would depend upon the facts of each case and the factor that connect the trademark to that place.” (emphasis supplied)

“46. We are fortified in our view keeping in mind the observations of the learned single Judge in St. Ives Laboratory Inc.'s case (supra) that mere registration of trademark in Delhi could not be a ground for invoking the jurisdiction of the Delhi High Court as the trademarks did not allow registration of a trademark within the jurisdiction of a Court to be a ground for filing in that Court and thus, the registration could at best be construed to be part of cause of action, but would be insufficient to grant leave to institute the suit before the Court. We agree with the proposition.”

“49. We thus conclude on this question by observing that the fact that the situs of the registration of trademark is with the Trademark Registry at Chennai by itself would not be sufficient to give rise to cause of action to institute the suit in the Madras High Court, though it may be a factor to be taken into account, among the bundle of facts, for purposes of determining the situs of the cause of action.” (emphasis supplied)

Relevant Case Laws

- ❖ **Vikrant Chemico Industries Pvt Ltd v. Shri Gopal Engineering And Chemical Works Pvt Ltd & Ors. [2025:DHC:7057 in the High Court of Delhi, decided on August 20, 2025]**

“21. It is an admitted position that both the plaintiff and defendants are based out of Kanpur, Uttar Pradesh, which is evident from the memo of parties filed along with the suit. From a reading of the plaint as well as the written submissions filed by the plaintiff, it is clear that plaintiff has invoked jurisdiction of this Court under Section 20(c) of CPC i.e. the cause of action, wholly or in part, arises within jurisdiction of this court.” (emphasis supplied)

“37. Now, I shall deal with the contention of the plaintiff that the cause of action arises in Delhi since the defendant no.1 applied for trademark registration of the impugned mark ‘DOCTOR HAZEL’S’ in Delhi. This contention has been rejected by the Supreme Court in Dhodha House (Supra).” (emphasis supplied)

“38. In Dhodha House (Supra), the Supreme Court has categorically held that cause of action arises only when a registered trademark is in use and not when the application is filed for registration of a trademark. Therefore, the plaintiff cannot claim jurisdiction on the basis that its marks were registered in Delhi.” (emphasis supplied)

Relevant Case Laws

- ❖ **Kohinoor Seed Fields India Pvt Ltd v. Veda Seed Sciences Pvt Ltd [2025:DHC:10789-DB in the High Court of Delhi, decided on December 3, 2025]**

“15.1 The learned Single Judge has held the suit not to be maintainable before this Court on the following four grounds:

(i) The registration of the trade marks asserted by the appellant in Delhi could not clothe this Court with jurisdiction, in view of the law declared by the Supreme Court in Dhodha House.” (emphasis supplied)

“17.4 In paras 17 and 18 of the impugned judgment, the learned Single Judge has placed reliance on the exposition of law, in Dhodha House, to the effect that the cause of action, to institute an infringement suit, arises only where when a registered trademark is used and not “when the application is filed for registration of a trademark.” In thus paraphrasing the ratio decidendi of Dhodha House, the learned Single Judge is correct.”

“17.5 Where the learned Single Judge has erred, in our opinion, is in his failing to note that the appellant was not invoking the jurisdiction of this Court because its application for registration of the asserted marks, was filed within the jurisdiction of this Court, but because the asserted marks were registered within such jurisdiction.” (emphasis supplied)

Relevant Case Laws

- ❖ **Kohinoor Seed Fields India Pvt Ltd v. Veda Seed Sciences Pvt Ltd [2025:DHC:10789-DB in the High Court of Delhi, decided on December 3, 2025]**

“17.6 Dhodha House holds, unexceptionably, that a mere filing of an application for registration does not give rise to a cause of action for infringement. The registration of a trademark, on the other hand, unquestionably does. This is apparent from Section 28(1) of the Trade Marks Act which confers, on the proprietor of a validly registered trademark, both the right to exclusively use the said trademark as well as for remedies against infringement of the mark. Infringement, throughout Section 29 of the Trade Marks Act, presupposes registration of the infringed trade mark, as each sub-section of Section 29 commences with the words “A registered trade mark is infringed ...” (emphasis supplied)

“17.7 There can, therefore, be no infringement of an unregistered trade mark. The very first criterion to be satisfied for a case of infringement to sustain is that the infringed mark is registered. The expression “cause of action” is defined, classically, as the bundle of facts which the plaintiff would have to prove to succeed in the action.¹⁹ Alternatively, it is defined as “every fact which, if traverse Viewed thus, it is obvious that the registration of the asserted mark is an indispensable part of the right to sue for infringement, and to succeed in the suit. If the defendant traverses the assertion of the plaintiff that the mark is registered, the plaintiff would have to prove the fact. The registration of the asserted mark is, therefore, in a way the sine qua non for maintaining an infringement action and it would be necessary for the plaintiff to prove in order to support his right to a judgement of the court”... (emphasis supplied)

Relevant Case Laws

- ❖ **Kohinoor Seed Fields India Pvt Ltd v. Veda Seed Sciences Pvt Ltd [2025:DHC:10789-DB in the High Court of Delhi, decided on December 3, 2025]**

“17.9 The learned Single Judge, in holding that the registration of the asserted trademarks of the appellant in Delhi did not constitute part of the cause of action to institute the suit has, therefore, ruled contrary to Section 28(1) of the Trade Marks Act.” (emphasis supplied)

“17.10 Dhodha House does not exposit any such proposition. What it holds is that territorial jurisdiction cannot be vested in a Court merely because the advertisement of the application filed by the plaintiff seeking registration of the asserted marks was within such jurisdiction.” (emphasis supplied)

“17.11 Thus, even in Dhodha House, the application for registration of the trademark was filed at Bombay. The advertisement, advertising the filing of the application, was, inter alia, issued in Delhi. It was on the ground that the advertisement of the application was also issued in Delhi that the jurisdiction of this Court was sought to be invoked. The Supreme Court held that the mere fact that the advertisement of the filing of the application for registration of the mark, was also issued in Delhi, when the application itself was filed in Bombay, could not confer jurisdiction on this Court to entertain the suit.”

Relevant Case Laws

- ❖ **Kohinoor Seed Fields India Pvt Ltd v. Veda Seed Sciences Pvt Ltd [2025:DHC:10789-DB in the High Court of Delhi, decided on December 3, 2025]**

“17.13 The Supreme Court has clearly held, in para 31 of Dhodha House, that the suit would lie where infringement of the trademark takes place. Infringement of trademark, per definition, is dependent on the registration of the mark. Thus, in para 31, the decision in Dhodha House in fact emphasizes the jurisdiction of the Court where the asserted mark is registered to entertain an infringement action. We are, therefore, of the opinion that the fact that the marks asserted by the appellant in the present case were registered within the jurisdiction of this Court was by itself a factor which entitled the appellants to institute the suit before this Court. The learned Single Judge, in our considered opinion, is not correct in having held otherwise.” (emphasis supplied)

Conclusion

- The Supreme Court's decision in *Dhodha House* is widely considered as a leading authority on territorial jurisdiction in trademark infringement cases. However, the ratio of *Dhodha House* is nuanced. *Dhodha House* clarifies that a *trademark application* is not part of the cause of action for trademark infringement. However, it does not state that no cause of action can arise out of a *trademark registration* in a trademark infringement suit.
- *St. Ives Laboratories*, *Duro Flex*, and *Vikrant Chemico* have taken the position that *trademark registration does not give rise to a cause of action* and therefore *the courts at the place of trademark registration will not have territorial jurisdiction in a trademark infringement claim*. While the decisions in *St. Ives Laboratories* and *Vikrant Chemico* do not specify extensive reasons for this conclusion, the Full Bench decision of the Madras High Court in *Duro Flex* is extensively reasoned. The Madras High Court is of the opinion that the place of registration is one of the many factors that should be taken into account in determining the *situs* of the trademark on a case-to-case basis to determine where a cause of action has arisen in a trademark infringement claim.
- In *Kohinoor Seeds*, a Division Bench of the Delhi High Court has taken a contrary position. According to the court, *trademark registration is an integral part of the cause of action for trademark infringement, as infringement can be claimed only in respect of a registered trademark*. Hence, the courts *at the place of trademark registration will have territorial jurisdiction in a trademark infringement claim*.
- While *Kohinoor Seeds* is binding on Single Benches of the Delhi High Court, *Duro Flex* creates a contrary precedent for the Madras High Court. Hence, there remains a split on this issue between the two High Courts, which cannot be resolved by reference to *Dhodha House* as *Dhodha House* is silent on this point.

THANK YOU!

Questions?

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