

Shephali

**IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
NOTICE OF MOTION NO. 255 OF 2014
IN
SUIT NO. 86 OF 2014**

Medley Pharmaceuticals Limited	...Plaintiffs
<i>Versus</i>	
Megh Healthcare Private Limited	...Defendants

Dr. Veerendra Tulzapurkar, Senior Advocate, a/w Ms. Pooja Kshirsagar, i/b M/s. Bharat Shah & Co., for the Plaintiffs.
Dr. Birendra Saraf, a/w Mr. Rashmin Khandekar & Ms. Miloni Gala, i/b Mr. Mahesh Mahadgut, for the Defendants.

**CORAM: G.S. PATEL, J
DATED: 30th March 2016**

PC:-

1. The application is for interim relief in a Suit for passing off. The two marks in question both relate to Vitamin D3 formulations. The Plaintiffs' mark is used on Vitamin D3 sachets, said to be sugar free and in a delicious orange flavour. The Defendants' mark is used on cartons of Vitamin D3 capsules.

2. The Plaintiffs' mark is "SunDE"; the Defendants' mark is "Sun-D3". I must straightaway say that on a comparison of the

Plaintiffs' mark¹ and the Defendants' mark,² I am not persuaded that there is such a sufficient similarity between them as would justify an injunction. I understand the use by both parties of the word "SUN" in relation to a Vitamin D3 preparation. That seems to me merely obvious. I doubt either of them can claim exclusivity in the word "SUN", and there are limits in the way this word can be pronounced or visually depicted.

3. Leaving aside the question of sales figures, invoices and who entered the market when, all of which might have been relevant had I felt that there was even a slight possibility of confusion, deception or misrepresentation, what is material is what Dr. Saraf for the Defendants points out in relation to the Plaintiffs' own view on similarity. The material annexed to the Notice of Motion shows that the Plaintiffs themselves were of the view at a much earlier stage in 2013 that the mark "SUN D3", then proposed to be used by the Plaintiffs, was entirely distinguishable from another mark "SUNDEE" (of a third party) that was cited at the time as conflicting.³ Now what is peculiar in this case is that it is the Plaintiffs who adopted the mark "SUNDE" but now claim that the Defendants' adoption of the mark "SUN-D3" (of which the Plaintiffs earlier sought registration) is deceptively and strikingly similar and therefore furnishes a ground in passing off.

4. This cannot possibly be. This is a classic case of the Plaintiffs being, as Shakespeare famously said, "hoist by their own petard". Clearly the Plaintiffs cannot have it both ways. They cannot say for

¹ Plaint, *pp.* 34-35.

² Plaint, *p.* 83

³ Motion paperbook, *pp.* 25-31.

the purposes of registration that there is no similarity and the marks are distinguishable, but for the purposes of passing off in this Motion contend exactly the reverse. The Plaintiffs earlier said there was no similarity and that the marks then cited were distinguishable. Unfortunately for the Plaintiffs, I agree today with what they said then.

5. The Notice of Motion fails. It is dismissed. No costs.

(G. S. PATEL, J.)