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IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
NOTICE OF MOTION (L) NO. 2154 OF 2016
IN
SUIT (L) NO. 755 OF 2016

SUN PHARMA LABORATORIES LTD,
a company incorporated under the Companies Act, 1956, having its registered office at Sun House, Plot No. 2-01 B/1, Western Express Highway, Goregaon (East), Mumbai 400 063 …Plaintiffs

versus

1. **THE MADRAS PHARMACEUTICALS,**
   137-B, Old Mahabalipuram Road,
   Karapakkam, Chennai 600 096
2. **SANOFI INDIA LTD**,
   having its registered office at Sanofi House,
   CT Survey No. 117-B, L&T Business Park,
   Saki Vihar Road, Powai, Mumbai 400 072 ...Defendants

APPEARANCES

FOR THE PLAINTIFF	**Mr. Ravi Kadam, Senior Advocate**, *with Mr. H.W. Kane, Mr. Rahul Kadam & Mr. Nikhil Sharma, i/b W.S. Kane & Co.*
FOR THE DEFENDANTS	**Mr. Janak Dwarkadas, Senior Advocate**, *with Mr. Amit Thakkar & Mr. Ramesh Gajria, i/b Gajria & Co.*

CORAM : G.S.Patel, J.

DATED : 24th October 2016

ORAL JUDGMENT:

1. This is an action in trade mark infringement and passing off. The principal dispute is between the Plaintiff and the 2nd Defendant, two pharmaceutical companies. The 1st Defendant is a manufacturer for the 2nd Defendant.

2. The facts are few. The Plaintiff manufactures a pharmaceutical product under the mark **METOSARTAN**. This mark is registered to the Plaintiff in Class 05 under Registration No. 2041169 with effect from 21st October 2010. The fact that it has been used since then is undisputed. The product contains a formulation of Metoprolol Succinate and Telmisartan. This is prescribed for hypertension with Ischemic Heart Disease (IHD), hypertension with diabetes and hypertension with cardiac co-morbidities. Metoprolol is a beta-blocker that affects the heart and blood circulation. It is used to treat angina (chest pain) and hypertension (high blood pressure). It is also used to treat or prevent heart attacks. Telmisartan is an Angiotensin II Receptor Blocker (ARB). It works by relaxing blood vessels, which helps to lower blood pressure. This drug may also be used to treat heart failure and to help protect the kidneys from damage due to diabetes. To quickly put the contest into perspective, the 2nd Defendant's product, **METOSAN**, which the Plaintiff says infringes its trade mark, contains only Metoprolol but not Telmisartan.

3. Copies of the Plaintiff's sales certificates are annexed.[1] These show that from 2010 till 2012, the Plaintiffs sales were over Rs. 900 lakhs. After the transfer of one division, the sales from 2012 to 2016 exceeded Rs. 10,000 lakhs. There are also breakdowns of State-wise sales.[2] Some sample invoices are also annexed;[3] the earliest of these is of October 2010.[4] It is on this basis that the Plaintiff claims statutory and common law rights, saying that its mark has attained considerable reputation and goodwill.

4. The Plaintiff claims that some time in 2016 it learnt of the Defendants' marketing and manufacture of a rival pharmaceutical preparation containing Metoprolol Succinate under the mark **METOSAN**. This is the immediate cause for the present Suit.

5. Mr. Kadam for the Plaintiff says that the Defendants' mark is structurally, visually and phonetically similar, and, for all intents and purposes indistinguishable from the Plaintiff's registered mark. The Plaintiff, therefore, seeks an injunction and a restraint against the Defendants in both infringement and passing off.

6. I have heard Mr. Kadam for the Plaintiff and Mr. Dwarkadas at some length, and considered carefully their submissions. Mr. Dwarkadas took me through a fairly comprehensive note of arguments, and Mr. Kadam, too, submitted his points in rebuttal. I am not entirely persuaded by Mr. Dwarkadas's defence, to which I

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1. Plaint, Exs. "C1" and "C2", *pp.* 23–26.
2. Plaint, Ex. "C-1", *p.* 24, and Ex. "C-2", *p.* 26.
3. Plaint, Exs. "D-1" to "D-7", *pp.* 27–33.
4. Plaint, Ex. "D-1", *p.* 27.

will turn presently. At least on the cause of action in infringement, I have found against the Defendants and for the Plaintiff. I am not, however, convinced that I should grant the injunction in passing off. It seems to me that there is a needless conflation of these two distinct causes of action, perhaps because they do overlap in some respects. I will address that issue towards the end of this judgment, and only say here that I do not believe there is a *prima facie* case made out in the fundamentals of the cause of action in passing off, *viz.*, a case in the tort of *deceit*.

7. The defence is mounted on several counts. Mr. Dwarkadas submits, on the basis of a reading of Section 29(2)(b) of the Trade Marks Act, 1999, that one must first see whether the rival marks are similar or dissimilar and only then proceed to the question of a likelihood of confusion or deceptive similarity and not *vice versa*. We cannot, he says, and I think quite correctly, move backwards from an initial test of confusion or deceptive similarity to then assess whether there is any similarity at all. The tests must run in this sequence, he submits, and only if there is a *prima facie* finding of similarity can one proceed to examine whether that similarity is confusing or deceptive. The third test, an assessment of the likelihood of severe adverse consequences, will only follow thereafter. I see no reason to quarrel with this proposition, generally stated. I do not, however, believe that it is correctly applied to the situation at hand. I have not understood Mr. Kadam to work his case in reverse, *i.e.*, to first suggest danger, then to urge confusion and deception, and finally to mount the argument on similarity on an inverted pyramid.

8. To the contrary: Mr. Kadam is careful to construct his case in precisely the manner Mr. Dwarkadas suggests. Mr. Kadam agrees — this is not so much a concession as an acknowledgement of the inescapable — that the Plaintiff's mark is a portmanteau word, an amalgam of the names of two generic drugs Metoprolol and Telmisartan. In the Plaintiff's mark the first four letters are taken from the former and the last six letters are taken from the latter. The mark combines parts of the names of two generic drugs, and it does so to reflect its particular formulation. There is, Mr. Kadam says, no other mark like it; the formulation of both drugs includes Metoprolol, but that is all that the Defendants' drug has, while the Plaintiff's drug has Telmisartan in addition. Between **METOSARTAN** and **METOSAN** there is only the difference of the elision of the letters 'ART' (or 'RTA'). This, Mr. Kadam submits, is hardly the kind of sufficiency of distinctiveness that the law demands. As to the structural and visual similarity, this is a matter that speaks for itself. The difference is too slight to matter. About the aural and phonetic similarity too, there can be no manner of doubt. Applying the well-established, even well-worn, test of the quidam consumer (he of average intelligence and imperfect recollection), the saying of one name might well be taken for the other. Both are Schedule H prescription drugs; but prescriptions are all too often indecipherable and a harried pharmacist might well mistake one for the other with a difference this slight. The first test is, therefore, Mr. Kadam argues satisfied, and I do believe it is hard to fault his argument on this.

9. Mr. Dwarkadas's response is that there is no occasion at all for testing any such similarity because the Plaintiff's mark is

inherently not registrable. It ought never to have been entered on the register, and is liable to be struck off. This is the principal defence, and it is set out at some length in the substantial Affidavit in Reply. Mr. Dwarkadas says that the Defendants' mark is a combination of a part of the generic drug Metoprolol and 2nd Defendant's corporate name Sanofi. The result, according to Mr. Dwarkadas, is a completely invented word. The Plaintiff's mark, on the other hand, is admittedly coined from the names of two generic drugs and nothing besides. Both sources of the Plaintiff's mark are to be found in the list of International Non-proprietary Names or INN. These are unique names that, being pharmaceutical substances or active pharmaceutical ingredients, are firmly in the public domain. None may claim exclusivity over these generic names. They are intended for use in pharmacopoeias, labelling, product information, scientific use and so on. These generic names with INN status are used by the World Health Organization (**"WHO"**), as also other organizations. Mr. Dwarkadas argues that since the Plaintiff's mark **METOSARTAN** is drawn from two generic drugs, therefore, the combination itself is prohibited. This is defence is based on a reading of Section 13 of the Trade Marks Act, 1999:

> "13. **Prohibition of registration of names of chemical elements or international non-proprietary names**.—
>
> No **word** —
>
> (a) which is the commonly used and accepted name of any single chemical element or any single chemical compound (as distinguished from a mixture) in respect of a chemical substance or preparation, or

> (b) which is declared by the World Health Organization and notified in the prescribed manner by the Registrar from time to time, as an international non-proprietary name or which is deceptively similar to such name,
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> shall be registered as a trade mark and any such registration shall be deemed for the purpose of Sec. 57 to be an entry made in the register without sufficient cause or an entry wrongly remaining on the register, as the circumstances may require."

(*Emphasis added*)

10. I do not believe Mr. Dwarkadas's argument to be on sufficiently sure footing. It is true that the Plaintiff's mark is a combination of the names of two generics, Metoprolol Succinate and Telmisartan. Section 13 would operate to render either of these two generics incapable of registration. That cannot possibly hold true for a combination of generic names. That proposition, *viz.*, that no mark for a drug is registrable as a whole if it uses any part of a generic name, is overbroad and without statutory support. Mr. Kadam says that there is absolutely no warrant for the proposition that merely because source elements are INN's, none can make partial use of those generics or combine parts of those names, and I think he is correct.

11. In support of his argument that since the Plaintiff's mark is drawn from two generic drugs, therefore, the combination itself is prohibited, Mr Dwarkadas relies on the decision of this Court in

Ranbaxy Laboratories Ltd v Indchemie Health Specialities Pvt Ltd.[5] The dispute in that case was between the two drugs **ZANOCIN** and **ZENOXIM**. The Court drew a distinction between the suffixes *ocin* and *oxim*, and the sound of the letter *C* in the plaintiff's mark and the phonetics of the letter *X* in the defendant's mark. I am not persuaded that the portions of this decision on which Mr. Dwarkadas relies lend themselves to any generalized proposition on the question of similarity. Much of this is case-dependent. The finding here was that the claimant's mark was so largely derived from a generic source that it could only be descriptive. Mr. Dwarkadas's argument is, therefore, that if both component elements are found to be entirely attributable to generic drugs, then the same result must follow.

12. Mr. Dwarkadas then relies on the Division Bench judgment in *Bal Pharma Ltd v Wockhardt Ltd & Anr*.[6] Here the two marks were **AZIWIN** and **AZIWOK**, both used in the context of azithromycin tablets and syrups. Both claimed a common source. The word *azi* was found to be descriptive and common to the trade, the suffixes *wok* and *win* to be entirely different and, therefore, the Court found no chance of confusion. To much the same effect is the decision of the Delhi High Court in *Schering Corporation & Others v Getwell Life Sciences India Pvt Ltd*[7] regarding the marks **TEMODAL** and **TEMOGET**. The Court found that the two marks were not identical and shared no phonetic or visual similarity. The plaintiff

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5. 2002 (24) PTC 510 (Bom).

6. Order dated 12th June 2002 in Appeal No. 498 of 2002, per AP Shah J (as he then was) and Smt NN Mhatre J.

7. 2008 (37) PTC 487 (Del.).

could claim no exclusivity in the clipped aspect or part of the name *temo*, this being common to the trade and part of a generic chemical compound Temozolomide. Similarly, there is the decision of a Division Bench of this Court in *Schering Corporation, New Jersey, USA & Anr v United Biotech Pvt Ltd, New Delhi & Anr*.[8] The Division Bench said that where a proprietor adopts a mark based on the generic drug or ingredient, he does so with full knowledge of the risk that others too may follow suit. The first user cannot claim exclusivity in the mark or name that is derived from the generic drug. At best, he can claim exclusivity in the added features which differentiate his mark from the generic drug or ingredient.

13. I find that a common thread through all these judgments is that a comparison was drawn between the invented portions of the marks, *i.e.*, those not derived from generic sources; where there was found to be no similarity, injunctions were refused. None of these are cases where a proprietor combines not a portion of one generic drug either completely or wholly with an invented suffix or prefix, but takes instead portions of two generic drugs and puts them together and does so in a unique fashion. Would the same test apply and carry forward to such a situation as well? Mr. Kadam does not claim exclusivity in *meto* or *sartan* taken separately, but in their combination taken as a whole. Consider for instance a combination of parts of two well-known generic drugs paracetamol and ibuprofen. These are often prescribed and taken together and there are many formulations that combine the two (including products from the 2nd Defendant). Any number of combinations of these are

8. 2011 (1) Bom C.R. 89.

possible: *profenomol*, *ibumol* and *paraprofen*. The fatal fallacy is in the defence argument's assumption that all combinations of any parts of multiple generic names are, *ex hypothesi*, equal, and all are equally descriptive. Thus, for instance, *Metosartan* is as descriptive, on this theory, as might be, say *Telmipro*, *Sartalol* and perhaps even *Etomis*. On the face of it, the suggestion is not one that commends itself.

14. Moreover, it seems to be too far removed from the statutory intent when Mr. Dwarkadas suggests that if, by such a process of deconstruction, every portion of a mark can be traced back to a generic, then the whole of the mark is deprived of all protection altogether. Accepting this proposition would amount to carving out an exception to Section 17(2)(b):

> **"17. Effect of registration of parts of a mark.—**
>
> (1) When a trade mark consists of several matters, its registration shall confer on the proprietor exclusive right to the use of the trade mark taken as a whole.
>
> (2) Notwithstanding anything contained in sub-section (1), when a trade mark—
>
> (a) contains any part—
>
> (ii) Which is not the subject of a separate application by the proprietor for registration as a trade mark; or
>
> (ii) which is not separately registered by the proprietor as a trade mark; or
>
> (b) contains any matter which is common to the trade or is otherwise of a non-distinctive character,

> the registration thereof shall not confer any exclusive right in the matter forming only a part of the whole of the trade mark so registered."

15. Section 13 contains a prohibition on the use of a *word* which is the commonly used and accepted name of a generic drug (or declared by the WHO and notified as provided in sub clause (b)). It is this word or name that cannot be registered as a trade mark. Section 13 does not by itself contain a restriction against use of *part* of a common generic name combined with something else or with some other expression. There are in the market, as is well-known, a very large number of formulations which contain the words *mycin* or *flox* on and all of these have acquired distinctiveness and received protection. I imagine that acceptance of Mr. Dwarkadas's submission would take us to a position where no pharmaceutical preparation known by a name any part of which can be traced to a generic drug would ever be able to receive any sort of protection. That, I think, is not the purpose or intent of the law and it does not seem to me to have been the purpose of the intent of the judgments on which Mr. Dwarkadas places reliance.

16. Mr. Dwarkadas's submission that there is no likelihood of confusion or deceptive similarity is, therefore, not one I am prepared to accept. Here again, his argument is founded essentially on the assumption that the two marks are distinct.

17. When Mr. Dwarkadas, therefore, turning to the aspect of confusion or deceptive similarity, argues that as between *SARTAN* and *SAN* one contains six alphabets and two syllables and the other

three alphabets and one syllable, I think he probably credits the ordinary chemist, anxious patient or weary physician with too great a capability of invariably drawing such nice distinctions. Sometimes these drugs are ordered on the telephone. Very often they are handed out over the counter against indecipherable prescriptions. I am not persuaded that there is the kind of distinction that Mr. Dwarkadas seeks. I do believe that there is a sufficient similarity, structural, phonetic and visual between the two marks even if they are to be dissected in the manner he suggests. We no longer need proof of actual confusion. The test of probability is itself reduced to one of near possibility. That speaks to the smallest or slightest likelihood as being sufficient.

18. Further, in *Lupin Ltd v Eris Lifesciences Pvt Ltd & Others,*[9] a learned Single Judge of this Court said that in a Suit for infringement all that needs to be shown is registration of the mark. That satisfies the test of distinctiveness for the purpose of Section 9 and 11 of the Trade Marks Act, 1999. A defendant's honesty or dishonesty in the adoption of the rival mark is of no consequence on the cause of action in infringement. In any case, I find it difficult to understand how the Plaintiff's mark would not have been cited as a conflicting mark on the 2nd Defendant's application for registration. If the 2nd Defendant did not take a search, it cannot be heard to complain; it was bound to take a search both in the Registry[10] and in

9. 2016 (67) PTC 144 (Bom).

10. *Bal Pharma Ltd v Centaur Laboratories Pvt Ltd and Anr*, 2002 (24) PTC 226 (Bom).

the market[11] and this law is well settled. If it is found that the rival mark is deceptively similar there can be no question of raising a plea of equity based on honest adoption.

19. I am not satisfied in the present case by the Defendants' plea that there is sufficient distinction or that the Plaintiff's mark is purely descriptive and should be directed to be taken off the register. In any case, that would require me to go to the next level and find that this case fits within the narrow exceptions allowed by the Full Bench of this Court in *Lupin Ltd v Johnson & Johnson*.[12] That is not something that I am prepared to do at a *prima facie* stage.

20. There are other defences taken as well, but these are quickly despatched. I do not think it is necessary to spend more time over the arguments of delay, laches or acquiescence or on the question of prior adoption or user. It is not in dispute that the 2nd Defendant's application for registration of **METOSAN** is as recent as 15th April 2015 on a "proposed to be used basis".

21. Finally, there is the question of the danger involved. When we consider these familiar situations and we set them up against what Mr. Kadam points out are the inherent and very real dangers of mis-administration of the drug, I believe it is necessary for a Court to exercise a higher level of care in its assessment. Mr. Kadam relies on the decisions in *Cadila Health Care Ltd v Cadila Pharmaceuticals*

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11. *Gorbatschow Wodka K.G. v John Distilleries Ltd*, 2011 (47) PTC 100 (Bom).

12. 2015 (61) PTC 1 (Bom) (FB).

Ltd,[13] *Medley Laboratories (P) Ltd, Mumbai & Anr v Alkem Laboratories Ltd,*[14] *and Bal Pharma Ltd v Centaur Laboratories Pvt. Ltd& Anr.*[15] Of immediate relevance is the decision of the Division Bench of this Court in *Medley v Alkem*.[16] Here, the Division Bench was concerned with the two marks **SUPAXIN** and **SPOXIN**. The Division Bench considered the definition of the expression "deceptively similar" and in paragraphs 27 to 29 and 33 said:

> "27. According to the Supreme Court, therefore, a stricter approach should be adopted while applying the test to judge the possibility of confusion of one medicinal product for another by a consumer. Confusion in the case of non-medicinal product may only cause economic loss to the consumer. Confusion between two medicinal products may have disastrous effect on health, and in some cases, on life. Hence, in medicinal preparations, much more care should be taken and the Court must be circumspect in dealing with the matters and in making appropriate orders.
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> 28. The case of the appellants is that suffix 'XIN' being common to both the drugs, there is likelihood of confusion. The mark of the plaintiffs is registered, and, hence, it has statutory protection. It relates to a medicinal preparation. In the circumstances, in our opinion, the test of 'possibility' laid down in *Cadila Health Care Ltd* would apply. Applying the said test, there is likelihood, or in any

13. (2001) 5 SCC 73.
14. 2002 (25) PTC 592 (Bom) (DB).
15. 2002 (24) PTC 226 (Bom) (DB).
16. *Supra*

case, possibility of consumer being confused, and the plaintiffs were entitled to interim injunction. Moreover, SPOXIN and SUPAXIN are visually, phonetically and structurally similar. No doubt, both the drugs are sold under prescription, but that fact alone is not sufficient to prevent confusion which is likely to arise.

29. We are also impressed by the argument of the learned counsel for the appellants that in such cases, it is not necessary that there should be actual evidence of confusion : Likelihood (and even possibility) is sufficient. The following observations of Parker, J. in *Re Pianotist Co.'s Application*, (1906) 23 RPC 774, which have been quoted in various decisions, including *Cadila Health Care Ltd*, read thus :--

> "You must take the two words. You must judge them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks."

33. In our opinion, however, when the test is 'possibility' of confusion in medicinal preparations, as held by the Supreme Court in *Cadila Health Care Ltd*, and the Courts have been asked by the Apex Court to

> take special care, in such cases, since confusion may harm and result in unpleasant consequences, if not disastrous results, the learned Single Judge ought to have granted injunction as prayed by the plaintiffs. Since the learned Single Judge has, prima facie, recorded findings which can be said to be adjudicatory in nature, and by taking the view that there was no likelihood of confusion on the part of customers or repercussion on health as the drugs are available only on doctor's prescription, and a wrong test was applied, the appellants are right in contending that the decision deserves interference.

22. Therefore, once similarity is shown, and the possibility of confusion established, when dealing with pharmaceuticals, a Court must be much more on the *qui vive*. He points to the Supreme Court decision in *Cadila Health Care Ltd v Cadila Pharmaceuticals Ltd*,[17] and particularly the observations in paragraph 25, and the reminder that we are concerned here with sophisticated drugs and pharmaceuticals, not confectionary. The Supreme Court said that where drugs have a difference in composition, the applicable tests should be strictly applied, for the two drugs may have quite different, and possibly catastrophic effects if wrongly administered. The Courts must be particularly vigilant if the rival compositions are different. Mr. Kadam referred me to some literature on the subject. He emphasized that Metosartan targets two distinct conditions in combination. Telmisartan is principally used to target high blood pressure and associated ailments such as heart attacks.

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17. (2001) 5 SCC 73.

Metoprolol is intended to address hypertension. The combination addresses, as I have noted, patients who have a multitude of clinical issues that require simultaneous treatment. The result, Mr. Kadam submits, is that a wrongful administration of Telmisartan can have quite unintended and possibly disastrous side effects. This is true whether a person who needs the combination is not administered it, or where a person who does not need the combination is administered it. This is, therefore, in his submission, a classic case where Courts must be more than usually vigilant. If, therefore, it is found that there is similarity and there is a possibility of confusion, then the final determinant, that of unintended and disastrous consequences and danger comes into play, the injunction must, therefore, in his submission, follow. But that was said in the context of a claim in passing off.

23. Though I accept Mr. Kadam's arguments and submissions on the cause of action in infringement, I will not, however, at this stage make an order in terms of prayer clause (b) which is the injunction in passing off. I am not prepared to accept the submission, even based on *Cadila*, that an injunction in passing off must be granted for the asking, or that simply because an infringement injunction is granted, one in passing off must follow. These are two different remedies, and when the statute saves the separate remedy in passing off, it does so for good reason. The considerations may overlap to some extent, but that cannot and does not mean that we should ignore so totally the essence of a cause of action in passing off. That is, after all, a tortious action in *deceit*. Other factors must be more

carefully weighed than is possible at this stage. In the words of Denning LJ in *Parker Knoll v Knoll International Ltd*:[18]

> "Secondly, 'to deceive' is one thing. To 'cause confusion' is another. The difference in this: **When you deceive a man, you tell him a lie. You make a false representation to him and thereby cause him to believe a thing to be true which is false. You may not do it knowingly, or intentionally, but still you do it, and so you deceive him. But you may cause confusion without telling him a lie at all, and without making any false representation to him. You may indeed tell him the truth, the whole truth and nothing but the truth, but still you may cause confusion in his mind, not by any fault of yours, but because he has not the knowledge or ability to distinguish it from the other pieces of truth known to him or because he may not even take the trouble to do so.**"

24. There is nothing before me to suggest that the 2nd Defendant, Sanofi, made any attempt at misrepresentation, or portrayed its drug as something other than what it is, wittingly or unwittingly, or put out a falsehood. Indeed, on the considerations in passing off, the other factors canvassed by Mr. Dwarkadas may well assume cardinal importance: differences in price points, trade dress and so on. Indeed, it rather seems to me that Sanofi, the 2nd Defendant, took a studied decision to go ahead with Metosan, believing it had sufficient points of distinction, but also ensuring that its packaging and pricing set it apart. The confusion I have

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18. [1962] RPC 265

addressed is only in the adoption of the mark itself; the Plaintiff's claim that the two words are much too similar and that confusion is apt to occur. Oliver LJ in *Reckitt & Colman Products Ltd v Borden Inc.*[19] first set out the three probanda of a tortious action in passing off, and which we now know as the 'Classical Trinity': (i) goodwill owned by a claimant; (ii) misrepresentation; and (iii) damage to that goodwill. The Classical Trinity places on a plaintiff the burden of proving goodwill in its goods or services, trade dress, brand, mark or even the thing itself. A plaintiff must also show false representation (it matters not that this is unintended) to the public that leads it to believe that the goods or services of the defendant are those of the plaintiff. Fraud is not a necessary element.[20] The similarity tests that we use in infringement have a role to play; but they are not always and necessarily determinative. In a situation like the present, for instance, where the marks *per se* are found to be similar but the manner of their use is differentiated, it is surely entirely possible to grant the injunction in infringement without being forced into an otherwise unsupported conclusion of a case in passing off. Sanofi is not some upstart that needs to masquerade its goods' origins as emanating from the Plaintiff. This may, therefore, be that rare case where the Plaintiff succeeds on a *prima facie* case in infringement but not on the case in passing off. It is not possible, in my view, to extrapolate from this an assumption that there is deceit on the 2nd Defendant's part. That will require much more material than I have at hand, and is best left to the trial. I leave all contentions open in that regard. In any case, I do not see how, in fairness, the Plaintiff

19. [1990] 1 All ER 873.

20. *Laxmikant V. Patel v Chetanbhai Shah & Anr.*, (2002) 3 SCC 65.

can insist on the second injunction in passing off on the pleadings as they stand.

25. Having reviewed the material, I am satisfied that there is a sufficient case made out for the grant of relief in terms of prayer clause (a) of the Notice of Motion, the injunction in infringement.

> "(a) that pending the hearing and final disposal of the suit, the Defendants by themselves, their proprietor, partners, directors, agents, servants, stockists, dealers, distributors and all persons claiming through them be restrained by temporary order and injunction of this Hon'ble Court from infringing the Plaintiff's registered trade mark No.2041169 in class 5 by using the trade mark METOSAN or any other trade mark deceptively similar to the Plaintiff's registered trade mark METOSARTAN in respect of pharmaceutical and medicinal preparations and substance or in any other manner whatsoever;"

26. The Notice of Motion is disposed of in these terms with no order as to costs. At the request of Mr. Thakkar for the Defendants, the operation of this order is stayed for a period of eight weeks from the date it is uploaded. Since this order is dictated in open court, and will take a few days to transcribe and correct, that upload might take till after the Court reopens following the Diwali vacation which commences a few days from now.

(G. S. PATEL, J.)