

IN THE HIGH COURT OF JUDICATURE AT BOMBAY**ORDINARY ORIGINAL CIVIL JURISDICTION****INTERIM APPLICATION NO.1 OF 2019****IN****COMMERCIAL IP SUIT (L) NO.1180 OF 2019****WITH****LEAVE PETITION NO.177 OF 2019****IN****COMMERCIAL IP SUIT (L) NO.1180 OF 2019**

Sun Pharmaceutical Industries Limited And Anr. ...Plaintiffs

vs.

Sun Pharma ...Defendant

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Mr. H.W. Kane, a/w. Mr. Aasif Navodia and Ms. Vedangi Soman, i/b.
W.S. Kane & Co., for the Plaintiffs/Applicants.

None for the Defendant.

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CORAM : S.C. GUPTE, J.

DATE: 22 NOVEMBER 2019

P.C.:

. This Commercial IP Suit complains of infringement of registered trade marks, as also passing off of goods by the Defendant as those of the Plaintiffs. The Plaintiffs carry on business of manufacturing and marketing pharmaceutical and medicinal preparations under the name and style of "Sun Pharmaceutical Industries Ltd.". It is the Plaintiffs' case that since the year 1978, the Plaintiffs have been openly, regularly and extensively using the house marks "SUN" and "SUN PHARMA" in respect of medicines and pharmaceuticals marketed by

them. The Plaintiffs have registered the trade marks “SUN” and “SUN PHARMA”, both as word marks and label marks, in Class 05 (medicinal and pharmaceutical preparations) and Class 35 (marketing, selling and advertising of drugs and pharmaceutical products). The Plaintiffs have a large sales turnover in respect of the products sold under the house marks “SUN” and “SUN PHARMA”. The Plaintiffs have disclosed particulars of such turnover since beginning as well as promotional expenditure over the last more than two decades. Averments made in the plaint and materials disclosed with it indicate not only the Plaintiffs’ proprietorship of the registered trade marks but their extensive reputation and goodwill in the house marks and other trade marks containing the word “SUN” either as a prefix or a suffix. It is submitted by the Plaintiffs that the Defendant is manufacturing and marketing or trading in similar goods using the impugned trade name “SUN PHARMA” and trade marks “SUN” and “SUN PHARMA” in a clandestine manner. It is submitted that ulterior or malafide motives of the Defendant in this behalf are reflected in the fact that the Defendant has not even printed its complete address on the packaging of the products bearing the impugned trade name and marks. On these facts, the Plaintiffs pray for ad-interim reliefs in respect of the offending use of the trade name as well as trade marks of the Plaintiffs by the Defendant.

2. The ad-interim application was moved on the last occasion, i.e. on 14 November 2019, with a notice to the Defendant. This Court was, however, of the view that, in the facts of the case, one more opportunity may be given to the Defendant to show cause to the interim application. The Plaintiffs were, accordingly, directed to give a fresh

notice and renew their application. Accordingly, the Plaintiffs have given a sufficient notice of today's ad-interim application to the Defendant and moved for urgent ad-interim reliefs. Learned Counsel for the Plaintiffs submits that an affidavit in proof of service has already been filed in the office. It is submitted that service was effected both by courier and by e-mail. A printout of the e-mil sent by the Plaintiffs to the Defendant has been separately tendered in this Court. None, however, appears for the Defendant to show cause.

3. The Plaintiffs have also moved a leave petition for combining the cause of action of passing off with that of infringement, since the Defendant carries on business outside the local limits of the jurisdiction of this Court. That petition has also been duly served and, as in the case of the interim application, an affidavit in proof of such service has already been filed in the Court.

4. In these facts, a clear case for infringement of registered trade mark as also a case of passing off has been made out by the Plaintiffs. The material produced with the plaint indicates that the Defendant is using the very trade name and house marks of the Plaintiffs, which, as we have noted above, are registered trade marks of the Plaintiffs. There is nothing on record to justify the Defendant's use of the offending trade name as well as house marks.

5. In accordance with sub-section (5) of Section 29 of the Trade Marks Act, 1999, use of a registered trade mark as a trade name or part of a trade name or name of a business concern or part of the

name of business concern by the defendant amounts to infringement of a registered trade mark. A Full Bench of this Court, in the case of **Cipla Ltd., Mumbai vs. Cipla Industries Pvt. Ltd., Delhi**,¹ has held so on a construction of sub-section (5) of Section 29. The Full Bench has clarified that the provision of sub-section (5), which is distinct from sub-section (4), is attracted when a person doing trade or business in goods or services, in respect of which a trade mark is registered, uses the registered trade mark in relation to his trade name.

6. Accordingly, Leave Petition No.177 of 2019 is allowed. The Plaintiffs are permitted to combine the two causes of action.

7. Also, in the premises, there will be ad-interim injunction in terms of prayer clauses (a) and (b), which are quoted below :

- (a) That pending the hearing and final disposal of the suit, the Defendant by itself, its proprietor, partner, agents, servants, stockists, dealers and all persons claiming through it be restrained by an order and temporary injunction of this Hon'ble Court from infringing the Plaintiffs' house mark SUN/SUN PHARMA bearing registration nos.408870, 600634, 1564369, 1822656, 2207238 and/or 600135 in Class 05 and nos. 1573582, 2382308 and 2934273 in Class 35 by using the impugned trading name and/or the impugned trade mark SUN PHARMA or any other trading name or mark deceptively similar to the 1st Plaintiff's house

¹ 2017(2) Mh.L.J. 877

mark bearing registration nos.408870, 600634, 1564369, 1822656, 2207238 and/or 6001359 in Class 05 and nos.1573582, 2382308 and 2934273 in Class 35 in respect of medicinal and/or pharmaceutical preparations and/or similar goods or in any other manner whatsoever;

- (b) That pending the hearing and final disposal of the suit, the Defendant by itself, its proprietor, partner, agents, servants, stockists, dealers and all persons claiming through it be restrained by an order and temporary injunction of this Hon'ble Court from manufacturing and/or marketing and/or selling and/or advertising and/or trading in and/or otherwise dealing in medicinal and/or pharmaceutical preparations or similar goods under the impugned trading name and/or the impugned trade mark SUN PHARMA and/or any other trading name/trade mark deceptively similar to the Plaintiffs' well-known house mark SUN/SUN PHARMA or trading name and style SUN PHARMACEUTICAL INDUSTRIES/SUN PHARMACEUTICAL LABORATORIES, so as to pass off or enable others to pass off the Defendant's goods and/or business as and for the Plaintiffs' well-known goods and/or business or in any other manner whatsoever.

8. Reply, if any, to the interim application, to be filed by the Defendant within a period of four weeks from today. Rejoinder, if any, within two weeks thereafter. The interim application to come up for hearing in due course.

Smita
Gonsalves

Digitally signed by
Smita Gonsalves
Date: 2019.11.29
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(S.C.GUPTE, J.)