

**IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
INTERIM APPLICATION NO. 3929 OF 2022
WITH
LEAVE PETITION (LODGING) NO. 30734 OF 2021
IN
COMMERCIAL IP SUIT NO. 236 OF 2022**

Franco-Indian Pharmaceuticals Private Limited ... Applicant/
Orig. Plaintiff

vs.

Challa Rajiv Reddy and another ... Defendants

Mr. Amit Jamsandekar a/w. Ms. Archita Gharat, Mr. Vighnesh Kamat, Mr. Sai Prasad Mandlik and Mr. Kiran Mehta, i/by. Mr. Kiran J. Mehta for applicant/plaintiff.

Ms. Madhavi Doshi, i/by. Phoenix Legal for defendant No.2.

**CORAM : MANISH PITALE, J
DATE : 5th DECEMBER, 2022**

P.C. :

. The applicant/plaintiff is constrained to move the present suit and the application for grant of ad-interim reliefs in the context of its registered trade mark 'DIAVIT', which is a word mark, registration of which dates back to 24th November, 2000. It is the case of the plaintiff that the defendants have introduced into the market pharmaceutical preparations with the impugned trade marks 'DIABEET-M1', 'DIABEET-M2', 'DIABEET-M3', and 'DIABEET-VG2', which are identical to or deceptively similar with the registered trade mark of the plaintiff.

2. It is emphasized that the registered trade mark of the plaintiff is also in the same class i.e. class 5 pertaining to medicinal and pharmaceutical preparations. It is submitted that the medicinal preparation of the plaintiffs bearing the registered trade mark 'DIAVIT' is used as a supporting therapy for treatment of diabetes. It is brought to the notice of this Court that the impugned products of the defendants also pertain to treatment of diabetes, thereby contending that there is every likelihood of consumers/patients confusing the impugned products to be those of the plaintiff's, bearing the registered trade mark.

3. It is submitted that the plaintiff has earned considerable goodwill over a period of time and the sales turnover indicates the same. Certificate issued by Chartered Accountant placed on record shows the increase in the sales turnover from the year 2001-2002 and for the year 2018-2019, the sales turnover was to the tune of Rs.17.10 crores and the figure pertaining to the promotional expenses is also placed on record.

4. The plaintiff has also placed on record the invoices from the year 2006 onwards to show its presence in the market with the said product. The visual representation of the pack of capsules manufactured and sold by the plaintiff bearing the registered trade mark 'DIAVIT' have been placed on record alongwith the plaint.

5. It is contended that defendant No.1, who is marketing the impugned products, applied for registration of the impugned marks and that the same were advertised in the Trade Mark Journal. The plaintiff became aware of the same some time in October, 2021. The plaintiff was constrained to move opposition proceedings in the same, which are pending. It is brought to the

notice of this Court that the use of the impugned trade marks by the defendants was not evident till the plaintiff saw the presence of the said products on an online trading platform www.medplusmart.com. When the plaintiff ordered the said impugned products on the said trading platform, the delivery location was in Hyderabad. Thereupon, the plaintiff has approached this Court.

6. The service report shows that both the defendants were served. Writ of summons also stood served on defendants on 20th June, 2022. While defendant No.2 i.e. the manufacturer has filed written statement, the defendant No.1, despite service, has chosen not to file the written statement and the extended period of 120 days for filing written statement has already expired. Defendant No.2 has not filed any reply to the present application and defendant No.1 has also failed to file the reply.

7. It is in this backdrop that the learned counsel for the plaintiff has prayed for allowing the leave petition for combining the cause of action of infringement with that of passing off and also for allowing the present application seeking the said interim reliefs.

8. Learned counsel for defendant No.2 has relied upon the written statement placed on record. It is submitted that the defendant No.2 is only a contract manufacturer, manufacturing the impugned products for defendant No.1 under the bona fide belief that defendant No.1 is a legal and valid proprietor of the impugned trade marks. In fact, the learned counsel for defendant No.2 submits that she has instructions to move an application for deleting the name of defendant No.2 from the array of defendants, as there can be no substantive grievance of the plaintiff as against the defendant No.2.

9. This court has heard the learned counsel for the rival parties and perused the material on record.

10. The material placed on record alongwith the plaint and present application demonstrates the presence of the plaintiff with its products bearing registered trade mark 'DIAVIT' for considerable period of time. Registration dates back to 24th November, 2000 and there are sufficient pleadings in the plaint to indicate the sale of the product of the plaintiff bearing registered trade mark from the year 2001-2002 onwards. The sales turnover and the amount spent towards promotion of the product sufficiently indicate the presence of plaintiff in market with the said product bearing the registered trade mark and the fact that considerable goodwill has been earned over a period of time.

11. A comparison of the registered trade mark of the plaintiff 'DIAVIT' with the variants of the trade mark 'DIABEET' being used by the defendants *prima facie* shows that there is phonetic, visual and structural similarity between the marks. The prominent and essential features of the registered trade mark have been copied by the defendants in the impugned trade marks. Even in the application preferred by defendant No.1 before the Registrar of Trade Marks for grant of registration, it appears that the user has been claimed only from 2020. Even if the statement made in written statement of defendant No.2 is to be taken into consideration, it appears that the impugned products have been manufactured by defendant No.2 for defendant No.1 from the year 2016, which is much later as compared to the presence of plaintiff in the market, which dates back to the year 2000. Therefore, there is sufficient material placed on record on behalf of plaintiff

to make out a strong *prima facie* case in its favour for grant of interim reliefs in the context of the cause of action of infringement as well as passing off.

12. Defendant No.1 has chosen not to appear before this Court despite service of application as well as summons. There is no denial on behalf of the defendant No.1 as regards the specific pleadings in the plaint as well as application. It is stated that defendant No.2 is merely a contract manufacturer, manufacturing the impugned products under the bona fide belief that defendant No.1 is a legal and valid proprietor of the impugned trade marks.

13. Since the defendants have been served, the leave petition is taken up for consideration. In the interest of justice, the same is allowed, particularly to avoid multiplicity of proceedings. In the light of the leave petition being allowed, prayer for grant of interim relief for the cause of action of passing off is also taken up for consideration. There are sufficient pleadings in the plaint to demonstrate that a strong *prima facie* case is made out for grant of interim relief in respect of passing off also.

14. In view of the above, it is found that the plaintiff has indeed made out a strong *prima facie* case for grant of interim reliefs. The continued use of the impugned marks and sale of impugned products would certainly cause grave and irreparable loss to the plaintiff, which demonstrates that the balance of convenience also lies in the favour of plaintiff.

15. In view of the above, the application is allowed in terms of prayer clauses (a) and (b), which read as follows:

- “a) that pending the hearing and final disposal of the suit, the Respondents by themselves, their directors, partners, associates, employees, servants, agents, dealers, stockists, distributors, assignees, licensees and all those connected

with them in the business be restrained by an order and injunction of this Hon'ble Court from using, manufacturing, marketing, distributing, stocking, selling, promoting, publishing, exporting, importing, advertising, exhibiting, displaying for sale or otherwise in shops or on their own websites or on any e-commerce sites in relation to their medicinal and pharmaceutical preparations the impugned trade mark/s DIABEET-M1, DIABEET-M2, DIABEET-M3 and DIABEET-VG2 or any mark identical and/or deceptively similar to the Applicant's trade mark DIAVIT registered under No.972717 in class 05, so as to infringe the Applicant's registered trade mark number as above mentioned;

- b) that pending the hearing and final disposal of the suit, the Respondents by themselves, their directors, partners, associates, employees, servants, dealers, agents, stockist, distributors, assignees, licensees and all those connected with him in the business be restrained by an order and injunction of this Hon'ble Court from using, manufacturing, marketing, distributing, stocking, selling, promoting, publishing, exporting, importing, advertising, exhibiting, displaying for sale or otherwise in shops or on their own websites or on any e-commerce sites in any manner in relation to its medicinal and pharmaceutical preparations the impugned mark/s DIABEET-M1, DIABEET-M2, DIABEET-M3 and DIABEET-VG2 or any mark identical and/or deceptively similar thereto being confusingly similar to the Applicant's marks DIAVIT/ DIAVIT PLUS so as to pass off or enable others to pass off the Respondents goods as and for that of the Applicant;"

16. Application is disposed of.

(MANISH PITALE, J)

Priya Kambli