
Sanofi & Anr Vs Faisal Mushtaq & Ors

Civil Suit (COMM) 929 Of 2018 & I.A. No. 7820 Of 2018

Court: Delhi High Court

Date of Decision: Nov. 16, 2018

Acts Referred:

Copyright Act, 1957 " Section 2(c), 2(o), 17

Hon'ble Judges: Manmohan, J

Bench: Single Bench

Advocate: Pravin Anand, Vaishali Mittal, Vrinda Gambhir

Final Decision: Disposed Off

Judgement

Manmohan, J

I.A. 15659/2018

1. Present application has been filed under Order XIII-A of the Commercial Courts, Commercial Division and Commercial Appellate Division of High

Courts Act, 2015. It is pertinent to mention that the present suit has been filed for permanent injunction, restraining infringement and dilution of

trademark, trade name, domain name, passing off, infringement of copyright, damages, delivery-up etc. The prayer clause in the present suit is

reproduced hereinbelow:-

" 91. In light of the above, it is most humbly and respectfully submitted before this Hon'ble Court, that it may be pleased to pass the following

reliefs:

(i) A decree of permanent injunction restraining the Defendants, their partners or proprietors, principal officers, servants, agents and distributors and

all others acting on its behalf as the case may be from manufacturing, selling, offering for sale, advertising, directly or indirectly dealing in any manner

with products and services including but not limited to pharmaceutical products, Active Pharmaceutical Ingredients (APIs); bio-similar products;

research for development of pharmaceutical drugs, new chemical entities etc. and/or any other goods and/or services using the tag-line A Universal

healthcare provider focused on patients' needs, the trademark SNOFINN, trading name SNOFINN PHARMACEUTICALS, SNOFINN,

PHARMA, SNOFINN, the logos , , the domain name www.snofinn.com or any other trademark, trading name (including as part of domain name)

similar thereto, or containing the Plaintiffs' trademark SANOFI; , and www.sanofi.com, the plaintiffs' tag-line A global healthcare leader

focused on patients' needs and any other trademark, trading name, artistic work, tag-line deceptively similar thereto leading to: A,

(a) Infringement A, of A, Plaintiff's trademark SANOFI;

(b) Infringement A, of A, Plaintiffs' copyright , and tag-line A "A global healthcare leader focused on patients' needs";

(c) Passing off Defendants' goods and services as those emanating from Plaintiffs' instead;

(d) Dilution of Plaintiffs' trademarks SANOFI;

(e) Unfair competition vis.a.vis. Plaintiffs.

(ii) A decree directing the Plaintiffs to take appropriate steps, in cooperation with the Registrar of the Defendants' domain name

www.snofinn.com , or any other domain name containing the designation SNOFINN, SANOFI or other designations similar thereto to divest the

Defendants, their directors, partners, proprietors, subsidiaries, affiliates or anyone claiming through them either directly or indirectly, and a subsequent

deletion of the said domain name;

(iii) An decree for the delivery-up of all impugned materials of the Defendant, including the Defendants' products, their packaging, container

boxes, labels, wrappers, stickers, and stationery or any other material of the Defendant containing the tag-line A "A universal healthcare provider

focused on patients' needs"; the trademark and name SNOFINN PHARMACEUTICALS ,

SNOFINN PHARMA, SNOFINN,

related Domain Name snofinn.com,

, and Plaintiffs'

trademark SANOFI; , and , related , Domain Name sanofi.com, Plaintiffs' tag-line A "A global healthcare leader focused on patients'

needs" and any other mark, tag-line deceptively similar thereto;

(iv) A decree for rendition of accounts of profits illegally earned by the Defendant on account of use of the tag-line A "A universal healthcare

provider focused on patients' need , the trademark and name SNOFINN PHARMACEUTICALS, SNOFINN PHARMA, SNOFINN, , and ,

related , Domain , Name snofinn.com, Plaintiffs' trademark SANOFI; , and related Domain Name sanofi.com, Plaintiffs' tag-line A "A

global healthcare leader focused on patients' needs" and any other mark, tag-line deceptively similar thereto; and a decree for the amount so

found be passed in favour of Plaintiffs;

(v) A decree for damages in the present proceedings;

(vi) A decree for costs in the present proceeding.

2. On 31st May, 2018, this Court granted an ex parte ad interim injunction in favour of the plaintiffs and against the defendants. The relevant portion of

the said order is reproduced hereinbelow:-

"Consequently, till further orders, the defendants their partners or proprietors, principal officers, servants, agents and distributors and all other

acting on its behalf as the case may be are restrained from manufacturing, selling, offering for sale, advertising, directly and indirectly dealing in any

manner with products and services using the tag-line "A universal healthcare provider focused on patients' needs" and/or the trademark

SNOFINN and/or trading name SNOFINN PHARMACEUTICALS and/or SNOFINN PHARMA

and/or SNOFINN and/or the logos, /

/and/or the domain name www.snofinn.com and/or any other trademark, trading name (including as part of domain name) similar thereto, or containing

the plaintiffs' trade mark

SANOFI and/or / and/or www.sanofi.com

and/or the plaintiffs' tag-line "A global healthcare leader focused on patients' needs" and any other trade mark, trading name, artistic

work, tag-line deceptively similar thereto.

3. Learned counsel for the plaintiffs states that he has instructions not to press for any relief other than the reliefs prayed for in prayer 91(i), (ii) and

(vi) of the plaint. The statement made by learned counsel for plaintiffs is accepted by this Court and plaintiffs are held bound by the same.

4. On 4th September, 2018, as none appeared for the defendants No.1, 2, 3 and 5, they were proceeded ex parte. Since despite service by publication,

none appeared on behalf of defendant No. 4, he was proceeded ex-parte on 15th November, 2018.

5. Learned counsel for the plaintiffs states that in view of the judgment of this Court in Satya Infrastructure Ltd. & Ors. Vs. Satya Infra & Estates

Pvt. Ltd., the present suit should be decreed qua the reliefs in paragraph 91(i), (ii) and (vi) of the plaint. The relevant portion of the judgment in Satya

Infrastructure Ltd. & Ors. (Supra) relied upon by learned counsel for the plaintiffs is reproduced hereinbelow:-

"I am of the opinion that no purpose will be served in such cases by directing the plaintiffs to lead ex parte evidence in the form of affidavit by way

of examination-in-chief and which invariably is a repetition of the contents of the plaint. The plaint otherwise, as per the amended CPC, besides being

verified, is also supported by affidavits of the plaintiffs. I fail to fathom any reason for according any additional sanctity to the affidavit by way of

examination-in-chief than to the affidavit in support of the plaint or to any exhibit marks being put on the documents which have been filed by the

plaintiffs and are already on record. I have therefore heard the counsel for the plaintiffs on merits qua the relief of injunction.

6. The relevant facts of the present case as pointed out by the learned counsel of the plaintiffs are as under:-

(i) The plaintiffs are a part of the Sanofi group which is the largest pharmaceutical group in Europe and the fourth largest in the world. It is stated in

the plaint that the Sanofi group is engaged in the research, development, manufacture and marketing of prescription based pharmaceutical products as

well as over-the-counter (OTC) medication. It is stated in the plaint that the plaintiffs' group has been present in India since the year 1956 through

its Indian subsidiary i.e. Plaintiff no. 2.

(ii) The plaintiffs have received numerous awards and have been ranked 89th in the Global 2000 List of Companies and ranked 233rd in the Fortune

500 List, by Forbes Magazine, and the Best Healthcare Brand by the Economic Times in 2016. It is further stated that the plaintiffs have around 280

programmes to develop a holistic approach with regard to research on drugs, development of preferential pricing policies, providing information and

educational programmes and deliver healthcare solutions in over 170 countries.

(iii) The plaintiffs first adopted the mark SANOFI in the year 1980 which is a house-mark to the plaintiffs' group of companies all across the

world and the logo, in the year 2011. It is stated that both marks are registered in various Classes under the Trade Marks Act, 1999, since 1994.

It is stated in the plaint that due to the continuous use of the aforesaid trade marks, the same have come to be solely and exclusively associated with

the activities of the plaintiff.

(iv) The colour combination of blue, green and brown/beige in the plaintiffs' "Bird of Hope" logo constitutes an original artistic work within

the meaning of Section 2(c) of the Copyright Act, 1957, and the plaintiffs' tag-line "A global healthcare leader, focused on,

patients' needs" comprises literary work within the meaning of Section 2(o) of the Copyright Act, 1957 and both are entitled to protection under

Section 17 of the Copyright Act, 1957.

(v) The plaintiffs have invested tremendous amounts in R&D and investments are likely to increase up to 6 billion Euro by 2020 and have

amassed revenues of 33.821 billion Euro in 2016.

(vi) Learned counsel for the plaintiffs states that in the first week of December, 2017, the plaintiffs came across the defendants' website

www.snofinn.com wherein the defendants were using the nearly identical trade mark SNOFINN and trade name SNOFINN

PHARMACEUTICALS as that of the plaintiffs', along with an identical logos / , as that of the plaintiffs' in relation to pharmaceutical

products and services. He further states that the defendants are using the tag- line "A universal healthcare provider focused on patients' needs", while promoting their website on search engines such as Google, which is nearly identical to the plaintiffs' tag-line "A global

healthcare leader focused on patients' needs.

(vii) Learned counsel for the plaintiffs states that a perusal of the defendants' interactive and dynamic website revealed that the defendants

are engaged in the manufacture and sale of pharmaceutical preparations and the defendants advertise their activities on the internet as those involved

in New Chemical Entities (NCEs) and generic APIs, besides making available for sale drugs such as NEXOS, OSTEOSHELL, PREGATEK and

CAMLTOP.

(viii) Learned counsel for the plaintiffs states that despite service of a cease and desist letter dated 7th December, 2017 and an email dated 12th

December, 2017, the defendants have failed to act on the plaintiffs' request.

(ix) Learned counsel for the plaintiffs states that the plaintiffs had instituted a suit Sanofi & Anr. v. Arif & Ors., CS(COMM) 862/2017 against the

defendant no. 4 and Snofinn Pharmaceuticals (predecessor in title of the defendant no. 5 company) and vide order dated 18th December, 2017, this

Court granted an ex parte ad interim injunction in favour of the plaintiff against the defendants. He states the defendants subsequently violated the said

order and continued prosecuting its application dated 18th July, 2017, seeking registration of the trademark 'S', under Class 35 of the Trade Marks

Act, 1999 before the Trade Marks Registry.

(x) Learned counsel for the plaintiffs states that subsequent to filing the aforesaid suit, the plaintiffs learnt that Snofinn Pharmaceuticals had been

incorporated as defendant no. 5 company i.e. Snofinn Pharmaceuticals Private Limited which is operating from a new address in New Delhi i.e. B-

481/A, G/F, Sangam Vihar, New Delhi and that defendant nos. 1, 2 and 3 are the directors of the defendant no. 5 company. He further states, the

defendant no. 4 is also believed to be the proprietor of Snofinn Pharmaceuticals, and therefore would also be associated with the defendant no. 5. He

states that at the time of filing the aforesaid suit, plaintiffs did not have knowledge that the defendants had filed an application dated 18th July, 2017,

seeking registration of the trademark. He states that the defendants' application is pending and the plaintiffs have opposed the same.

(xi) Learned counsel for the plaintiffs states that the plaintiffs apprised this Court of the changes in the constitution of the defendants in the aforesaid

suit and this Court was of the opinion that a new suit was required to be instituted. He states that vide order dated 29th May, 2018, this Court disposed

off the aforesaid suit while extending the operation of the ex parte ad interim injunction for a period of five weeks.

(xii) Learned counsel for plaintiffs states that while the constitution of the defendant No.5 changed from December 2017, advertisements on the

website www.snofinn.com remain the same and therefore, the defendants are in continuous infringement of the plaintiffs' rights.

(xiii) Learned counsel for the plaintiffs states that the defendants have adopted a trade mark, trading name, domain name, colour combination and

device in its logo, and a tag lines which are visually, phonetically, structurally and aurally deceptively similar to that of the plaintiffs. A

table representing the marks of the plaintiffs and defendants is reproduced hereinbelow:-

(xiv) Learned counsel for the plaintiffs states that the bare imitation, adoption and use of the nearly identical trade mark, trade name logo and tag-

line by the defendants has been done with the intent to cause confusion and create an impression amongst consumers that the defendants have a

direct nexus/affiliation with the plaintiffs, have been granted a license by the plaintiffs in relation to its products and are doing business endorsed by the

plaintiffs.

(xv) Learned counsel for the plaintiffs states that the word SANOFI is not a dictionary word and has no meaning in common parlance or in the

industry and therefore is an arbitrary and fancy mark denoting the goods and services of the plaintiffs.

7. In the opinion of this Court, a case of trade mark infringement, copyright infringement and passing off is made out. The triple identity test is satisfied

as the defendant has made use of identical trademark and trade name in relation to identical products (pharmaceutical goods and research) having an

identical trade channel (patients and those in need of pharmaceutical products).

8. This Court is further of the view that the plaintiff is entitled to a decree under Order XIII-A of the Commercial Courts, Commercial Division and

Commercial Appellate Division of the High Court Act, 2015, as the said provision empowers this Court to pass a summary judgment, without

recording evidence, if it appears that the defendant has no real prospect of defending the claim.

9. In view of the above, the suit is decreed in favour of the plaintiffs and against defendants in terms of paragraph 91(i), (ii) and (vi) of the plaint along

with the actual costs. The costs shall amongst others include the lawyer's fees as well as the amount spent on Court-fees. Registry is directed to

prepare a decree sheet accordingly.

10. Consequently, the present suit and application stand disposed of.