United Biotech Private Limited vs Sun Pharma Laboratories Private ... on 4 May, 2026

IA-L-19536-2025 & IA-5318

IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
IN ITS COMMERCIAL DIVISION

INTERIM APPLICATION (L) NO. 19536 OF 2025
IN
COMMERCIAL IP SUIT (L) NO. 19268 OF 2025

Sun Pharma Laboratories Limited
A Company incorporated under the
Companies Act, 1956 having its
Corporate Office and principal place
Of business at Sun House, Plot No. 201 B/1
Western Express Highway, Goregaon (East) ...Applicant
Mumbai 400063 (Org. Defend

Versus

United Biotech Private Limited
A Private limited company having its
Registered address at E-142, Saket
New Delhi, Delhi, India, 110017

Also having its address at Fc/B-1 (Extn),
Mohan Co-operative Industrial Estate
Mat, Hura Road, New Delhi, Delhi
India, 110044,

Also having its address at
Bagbania, Baddi-Nalagard Road
Distt. Solan (HP) - 174101 ...Defendant

WITH
INTERIM APPLICATION NO.5318 OF 2025
IN
INTERIM APPLICATION (L) NO. 19536 OF 2025

IN
COMMERCIAL IP SUIT (L) NO. 19268 OF 2025

SQ Pathan/Sairaj

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...Applicant
Distt. Solan (HP) - 174101
(Org. Defendant)

IN THE MATTER BETWEEN :
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Of business at Sun House, Plot No. 201 B/1
Western Express Highway, Goregaon (East)
Mumbai 400063
... Plaintiff

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Bagbania, Baddi-Nalagard Road
Distt. Solan (HP) - 174101

...Defendant

SQ Pathan/Sairaj

Mr. Alankar Kirpekar a/w Mr. Ayush Tiwari, Ms. Archita Gharat, Ms. Niyati Davawala, Mr. Anil Shete, Ms. Nidhi Rao and Ms. Chandrika Devda i/b Davawala & Co. for the Plaintiff

Mr. Rashmin Khandekar a/w Mr. Bahraiz Irani, Mr. Anand Mohan, Mr. Anosh Irani, Mr. Amit Padwal, Ms Afreen Bano and Mr. Abhishek for the Defendant

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CORAM : SHARMILA U. DESHMUKH, J.
RESERVED ON : MARCH 17, 2026
PRONOUNCED ON : MAY 4, 2026

ORDER :

1. Vide order dated 29th July 2025, this Court had granted ad- interim relief in terms of prayer clauses (b) and (c) as regards passing off and appointment of a Court Receiver. Subsequently, Interim Application No. 5318 of 2025 was filed under Order XXXIX Rule 4 of the Code of Civil Procedure (`CPC'), seeking to vacate the ex-parte ad- interim order dated 29th July 2025 passed by this Court. Both applications were taken up for hearing. The decision on merits of interim application for injunction decides the fate of the application under Order XXXIX Rule 4 of CPC.

2. The Plaintiff and Defendant are engaged in the business of manufacturing and marketing medicinal and pharmaceutical preparations. The plaint traces the adoption, use and proprietary right to the trade mark "OCTRIDE" to the year 1998 through the Plaintiff's pre-decessors in title. It is stated that in the year 1998, the Plaintiff had adopted the mark "OCTIDE" which was registered and was thereafter IA-L-19536-2025 & IA-5318-2025-J.odt not pursued nor the registration renewed by the Plaintiff's pre-decessor in view of the adoption of "OCTRIDE".

3. Insofar as the mark OCTRIDE is concerned, the application for registration of the said mark was filed on 8 th September 2003, with user claim of 30th September 1998. The molecule composition of the Plaintiff's product marketed under OCTRIDE is Octreotide Acetate. The drug is prescribed to treat acromegaly, carcinoid tumors, and bleeding esophageal varices and to prevent complications following surgery of the pancreas. It is stated that the Plaintiff's products under the trademark OCTRIDE have pan India as well global sales. The annual sales figures in respect of the products

bearing the said trade mark for the period 1999 to March 2024, duly certified by the Chartered Accountant, are placed on record. The Plaintiff has also placed promotional material on record to demonstrate goodwill and reputation.

4. It is stated that in the month of June 2025, the Plaintiff's representative came across the Defendant's product bearing the impugned mark OTIDE in the markets of Chennai, Tamil Nadu, and by way of further investigation and through the Plaintiff's Myanmar team, found the product OTIDE being manufactured by Defendants in India and exported to Myanmar. The Plaintiff conducted further search, which revealed the registrations in the name of Defendant for the IA-L-19536-2025 & IA-5318-2025-J.odt mark OCTIDE and the impugned mark OTIDE. The impugned mark OTIDE was applied for registration on 29th December, 2003 with user claim since 1st January, 1999. In the examination report in respect of the Defendant's mark OCTIDE, the Plaintiff's predecessor's mark OCTIDE was cited as a conflicting mark. It is contended that the registration obtained by the Defendant is wrongful, ex-facie illegal and invalid, and is liable to be rectified and removed from the register.

5. In the affidavit-in-reply, the Defendant has contended that the Defendant was incorporated in the year 1997, and apart from the domestic market, the Defendant is exporting to various countries and has entered into licences with international entities. The mark OTIDE was adopted on 1st January 1999 for pharmaceutical preparations containing the molecule Octreotide Acetate and the adoption was made honestly from the International Non-Proprietary Name (`INN') of the molecule Octreotide. The Defendant applied for trademark registration of the OTIDE mark on 29th December 2003, claiming user since 1st January 1999. Similarly, the Defendant also applied for registration of the mark OCTIDE on 18th October 2002, claiming user since 1st January 2001. However, the mark OCTIDE has not been commercially used by the Defendant till date. The sales turnover of the Defendant's product marketed under the mark OTIDE for the period 2006-2025 is set out in the affidavit. It is submitted that there is IA-L-19536-2025 & IA-5318-2025-J.odt suppression and concealment of material facts, as the Plaintiff was aware about the existence of the use of the mark OTIDE by the Defendant since the year 1999, as both rival marks OTIDE and OCTIDE have been cited in medical journals at least since the year 2010. The Plaintiff's products and the Defendant's products are recommended as substitutes on all major e-commerce platforms where the said products are sold. For the purpose of obtaining ad-interim injunction, a false cause of action about acquiring knowledge about the existence of the Defendant's OTIDE mark in the month of June 2025 is set-out. It is contended that the Plaintiff has put up a false story that the Plaintiff's predecessor-in-interest had adopted the mark OCTIDE in 1998 and thereafter had adopted the mark OCTRIDE, whereas, the OCTIDE mark by the Plaintiff was never used, and the registration had lapsed in the year 2008. The Defendant is having statutory rights in the mark OCTIDE, as the registration is still subsisting though not commercially exploited, as well as the mark OTIDE.

6. The Defendant adopted the mark OTIDE on 1 st January 1999 and on the date of adoption of OTIDE mark, the Defendant was not aware of the Plaintiff's OCTRIDE mark. The element "TIDE" appearing in the Defendant's OTIDE mark is a suffix derived from the INN system of the World Health Organization and is descriptive of the pharmacological class to which Octreotide belongs. There is no overall similarity IA-L-19536-2025 & IA-5318-2025-J.odt between the Plaintiff's

OCTRIDE mark and the Defendant's OTIDE mark. Both the rival marks are derived from INN of the API Octreotide, and where the chemical composition of the rival drugs is the same, the question of causing any health problems or side effects does not arise.

7. In the Interim Application No. 5318 of 2025, the same submissions forming part of the affidavit-in-reply are reiterated, and it is further claimed that the Defendant's OTIDE mark has been prominently featured in print and electronic media, including medical journals. In the affidavit-in-rejoinder by the Defendant to the application under Order XXXIX Rule 4, it is stated that the ex-parte order was passed without notice to the Defendant. The Plaintiff has consciously omitted the fact that the Defendant has been using the OTIDE mark since 1999, and the impugned order causes undue hardship to the Defendant.

8. Mr. Kirpekar, learned counsel appearing for the Plaintiff, would submit that notice was issued to the Defendant and matter was adjourned from time to time due to non-appearance of Defendant. He submits that, ultimately, the matter was taken up for hearing and the ad-interim order was passed on 29th July 2025. He submits that, insofar as the Plaintiff's mark OCTIDE is concerned, the Plaintiff is not using the said mark, and hence the inquiry in the present case is confined to OCTRIDE versus OTIDE. He submits that both parties are estopped IA-L-19536-2025 & IA-5318-2025-J.odt from raising the plea that the marks are non-registrable. He submits that the Plaintiff's mark was registered under the old Act, on which date the present Section 13 relating to INN was not on the statute book.

9. He submits that, even otherwise, passing off action would be maintainable. He submits that the Defendant's application for registration of the mark OCTIDE, applied for on 18 th October 2002, was objected by citing the Plaintiff's mark as conflicting mark, and therefore, the Defendant was aware of the existence of the Plaintiff and its registered mark, and despite that, has adopted and secured registration of its mark, OTIDE, on 29th December 2003. He submits that the Plaintiff's registration of the mark OCTIDE would assist the Plaintiff's claim of infringement of the mark OCTRIDE, as under Section 55 of the Trade Marks Act, the use of one of the associated or substantially identical trademark is equivalent to the use of another. He points out the Chartered Accountant's certificate placed on record, as well as the invoices, and would submit that the readily available invoices were of the year 2010 and leave was sought to rely upon additional invoices. He would further point out the promotional materials which are set out from pages 171 onwards, and would submit that there was extensive use of the Plaintiff's mark OCTRIDE.

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10. He submits that the use by the Defendant of the impugned mark OTIDE in respect of the same ailment or consisting of the same molecule does not mean that there can be no disastrous effect. He submits that the pleading in the affidavit as regards the knowledge of the Defendant is an argument on inordinate delay and not on concealment, and the application under Order XXXIX Rule 4 proceeds on that basis, whereas the Defendant was given notice of the hearing and could have appeared. He submits that there is no positive act on the part of the Plaintiff for the Defendant to claim acquiescence.

11. He submits that the Plaintiff secured registration of its mark "OCTIDE" under the erstwhile Trade and Merchandise Marks Act, 1958, which did not contain any prohibition on use of the mark derived from INN, which came subsequently in the Trade Marks Act of 1999, and by virtue of Section 159(2) of the Trade Marks Act, 1999, the registration continues to be in force and have effect as if done under the provisions of the Trade Marks Act, 1999. He submits that registration of the mark OCTIDE helps OCTRIDE. He submits that the medical journals relied upon by the Defendant to show that both the products were listed in the medical journal show that, insofar as the price is concerned, the Defendant's price is stated as "NA," which means that the product was not available for sale, and hence it was not necessary, by virtue of IA-L-19536-2025 & IA-5318-2025-J.odt mere registration for the Defendant to initiate the present proceedings and these medical journals do not impute knowledge about the Defendant. He would further point out that the website extracts set-out at page 381 of the Defendant's application under Order XXXIX Rule 4 do not show the date of availability of the product.

12. He would further submit that the Defendant has not given any details as to its presence in the market, and there are no documents certifying the sales invoices produced on record. He submits that the Defendant's case of co-existence cannot be accepted, as the drug licence produced by the Defendant is of Philippines and not in India. He would further point out that the Defendant first applied for registration of the mark OCTIDE, claiming user since 1 st January 2001, and has now changed stance to say that the Defendant is not using OCTIDE. He submits that once the Defendant has secured registration of its mark, the Defendant is estopped from taking up the plea of the mark having been derived from INN. He submits that the Plaintiff's drug licence and the registration itself amounts to user. He submits that the documents produced in rejoinder are permissible under Order XI(1)(c), as the Plaintiff is answering the case of the Defendant. He submits that in rejoinder, the Plaintiff has produced the annual reports, and there is no sur-rejoinder. In support, he relied on the following decisions :

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(i) Automatic Electric Ltd. vs. R. K. Dhawan & Anr.1

(ii) Glaxo Automatic Electric Ltd. vs. United Biotech P. Ltd.2

(iii) Macleods Pharmaceuticals Ltd. vs. Union of India & Ors.3

(iv) Hardie Trading Ktd & Anr. vs. Addisons Paint & Chemicals Ltd.4

(v) Lupin Limited vs. Eris Lifesciences Pvt. Ltd. & Ors.5

(vi) Midas Hygiene Industries P. Ltd.& Ors. vs. Sudhir Bhatia & Ors.6

(vii) Hindustan Pencils P. Ltd. vs. India Stationary Products Co. & Ors.7

(viii) Power Control Appliances & Ors. vs. Sumeet Machines Pvt. Ltd.8

(ix) Century Traders vs. Roshan Lal Duggar & Co.9

(x) S. Syed Mohideen vs. P. Dulochana Bai10

(xi) Siyaram Silk Mills Ltd. vs. Shree Siyaram Fab Pvt. Ltd. & Ors.11 1 1999 SCC OnLine Del 27 : (1999) 77 DLT 292 : (1999) 1 Arb LR 260 : (1999) 19 PTC 81 2 MANU/DE/0999/2014 3 Judgment dated 15.02.2023 in WP/1517/2022 4 (2003) 11 SCC 92 5 MANU/MH/3536/2015 6 MANU/SC/0186/2004 7 MANU/DE/0383/1989 8 MANU/SC/0646/1994 9 F.A.O. (O.S.) 45/1976 10 (2016) 2 SCC 683 11 MANU/MH/0040/2012 IA-L-19536-2025 & IA-5318-2025-J.odt

(xii) Syncom Formulations (I) Ltd. & Anr. vs. Usan Pharmaceuticals Pvt. Ltd. & Anr.12

(xiii) Milmet Oftho Industries & Ors. vs. Allergan Inc.13

(xiv) Corn Products Refining Co. vs. Shangrila Food Products Ltd.14

(xv) Lupin Ltd. vs. Johnson & Johnson15

13. Per contra, Mr. Khandekar, learned counsel appearing for the Defendant, submits that the Defendant is a pharmaceutical company incorporated in the year 1997, having a global presence. He submits that both the rival marks are derived from Octreotide and the Defendant's mark OTIDE has been in continuous, open and extensive use since 1999 and is registered with effect from 2003. He submits that the Defendant's consolidated annual turnover for the past decade alone is approximately Rs.3,900/- crores. He submits that, any reference to the mark OCTIDE is immaterial, as the record shows that neither party has commercially used OCTIDE. He submits that the rival marks are different and there is no actionable similarity, considering that both have been derived from generic molecule Octreotide. He 12 Order dated 01.12.2023 in IA/1588/2023 in COMIP/72/2023 13 MANU/SC/0512/2004 14 MANU/SC/0115/1959 15 Order dated 23.12.2014 in NML/2178/2012 in Suit (L)/1842/2012 IA-L-19536-2025 & IA-5318-2025-J.odt submits that the Defendant is the registered proprietor of the mark OTIDE, and hence there is no question of seeking any relief for infringement.

14. He would submit that there is not even a case for passing off, as the Defendant's mark OTIDE was adopted on 1 st January 1999, and material has been produced by way of invoices showing market use at least as on 29th August 2006. He submits that for the purpose of considering reputation and goodwill in the context of passing off, the relevant date is the date of use of the mark by the Defendant, which would be, if not from 1999, at least from 2006, and there is no material produced by the Plaintiff to support any claim of goodwill or reputation apart from one Chartered Accountant's document, which is also unreliable as the Chartered Accountant has certified the sales data as being verified from the Defendant's website. He submits that the Chartered Accountant's certificate at pages 74 to 82 is for a period subsequent to the adoption of the Defendant's mark and is therefore immaterial. He submits that the certificate is stated to have been issued at the request of

the management and on the basis of information and explanation given to the CA and the necessary records produced before the CA, and there is no independent assessment.

15. He would further submit that the Plaintiff has made out a false case of acquiring knowledge about the Defendant in June 2025, IA-L-19536-2025 & IA-5318-2025-J.odt whereas, way back in the year 2010, the Plaintiff's and the Defendant's marks were cited in medical journals one below the other, showing the same being derived from the molecule Octreotide. He submits that in rejoinder, the Plaintiff has sought to brush aside such knowledge by claiming that the same had escaped the Plaintiff's attention. He submits that not only have the marks been cited in medical journals, but have also been listed as substitutes for one another, on third party on-line pharmacies and hence, it is inconceivable that the Plaintiff had no knowledge of the Defendant, particularly, when the Plaintiff claims to be vigilant in protecting its registered trademark. He submits that considering the false cause of action stated in the plaint, the Plaintiff is not entitled to any interlocutory relief.

16. He would further submit that the rival products are admittedly Octreotide Acetate products having the same composition and used for the same purpose, and therefore, no question of any health hazard arises. He would further submit that the marks having been adopted from single molecule, the trivial differences are insufficient for claiming infringement. He submits that the rival products are not similar and are sold in distinct packaging, wherein the house mark as well as the corporate names of the parties are prominently displayed, and there is no likelihood of confusion. He submits that the Plaintiff's OCTRIDE mark was not cited by the trade mark registry in the IA-L-19536-2025 & IA-5318-2025-J.odt Defendant's trade mark application for registration of OTIDE mark. He submits that the co-existence of the rival marks in the market since 1999 indicates that there is no possibility of confusion, and hence no case is made out for passing off.

17. He would submit that the action for infringement, even otherwise, is not maintainable and is without merit, as the Plaintiff has failed to plead any cogent case for going beyond the Defendant's registration of the mark. He submits that there is no question of any ex-facie illegality, as the Plaintiff's case is based on alleged actionable similarity of the rival marks, alleged likelihood of confusion and alleged failure to file documents in support of user claim of the Defendant's mark, which does not satisfy the extremely high threshold of ex-facie illegality or fraud.

18. He would submit that the Plaintiff's drug licence was obtained on 10th September 1998, merely three months prior to the relevant date, i.e. 1st January 1999, and the invoices are produced from the year 2010. He submits that the undated carton/packaging produced by the Plaintiff would not substantiate goodwill on the relevant date, and similar is the case in respect of the promotional material, which is undated and some bear the dates after 2010. He submits that there is no misrepresentation and no actionable similarity, as the added matter vis-à-vis the packaging is sufficient to point out the distinction.

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19. He submits that the ad-interim order itself would not have been passed if it had been pointed out to the Court that the Plaintiff has acquired its mark from the generic molecule and that incorrect reliance was placed on the mark OCTIDE, which had, in fact, lapsed. He would further point out paragraph 6 of the ex-parte order dated 29 th July 2025, showing that the Court proceeded on the basis that the predecessor-in-title of the Plaintiff started using the mark OCTIDE and OCTRIDE since 1998. He submits that the attention of the Court was not brought to the fact that none of the invoices of the promotional material showed user from 1998, and that the earliest invoice is from 2010. He submits that the ex-parte order came to be passed upon comparison between both marks of the Plaintiff i.e. OCTRIDE and OCTIDE, wherein OCTIDE ought not to have featured in the evaluation at all. He submits that the Defendant's mark has been openly used in the market from 1999 to 2025 and has done substantial business, and is pitched as a direct substitute/competitor for the Plaintiff's OCTRIDE product, under the Plaintiff's mark, and shown common trade channels. He submits that it is, therefore, unacceptable that the Plaintiff was unaware of the Defendant's existence till June 2025. He submits that the balance of convenience is clearly in favour of the Defendant, considering its adoption and user since the year 1999. In support, he would rely on the following decisions:

(i) Schering Corporation & Anr. vs. United Biotech (P) Ltd & Anr.16

(ii) Macleods Pharmaceuticals Ltd. vs. Swisskem Healthcare & Anr.17

(iii) Sun Pharmaceutical Laboratories Ltd. vs. Hetero Healthcare Ltd. & Anr.18

(iv) Anubhav Jain vs. Satish Kumar Jain & Anr.19

(v) Amritdhara Pharmacy vs. Satya Deo Gupta20

(vi) Sun Pharma Laboratories Ltd. vs. Psycoremedies Ltd.21

(vii) Medley Pharmaceuticals Ltd. vs. Khandelwal Laboratories Ltd.22

(viii) Wander Ltd. & Anr. vs. Antox India P. Ltd.23

(ix) Velji Karamshi Vaid & Anr. vs. V3 Fashion & Ors.24

(x) Chemco Plastic Industries Pvt. Ltd. vs. M/s. Chemco Plast25

(xi) Uniply Industries Ltd. vs. Unicorn Plywood Pvt. Ltd. & Ors.26

(xii) Corona Remedies Pvt. Ltd. vs. Franco-Indian Pharmaceuticals Pvt. Ltd.27 16 2010 SCC OnLine Bom 1528 : (2010) 7 Mah LJ 611 17 Order dated 02.07.2019 in COMIP Suit NO.32/2011 18 2022 SCC OnLine Del 2580 : (2022) 92 PTC 538 19

Judgment dated 08.02.2023 in C.O. (Comm.IPD-TM) 55/2021 20 1962 SCC OnLine 13 : (1963) 2 SCR 484 : AIR 1963 SC 449 21 MANU/TN/1162/2015 22 2005 SCC OnLine Bom 1160 : (2006) 1 Bom CR 292 23 1990 (Supp) SCC 727 24 Order dated 09.09.2025 passed in IA(L)/22614/2022 in COMIP Suit No.348/2025 25 Order dated 03.12.2025 in IA/2165/2024 in COMIP Suit/80/2024 26 (2001) 5 SCC 95 27 2023 SCC OnLine Bom 833 IA-L-19536-2025 & IA-5318-2025-J.odt

(xiii) Mangalam Organics Ltd. vs. N. Ranga Rao & Sons Pvt. Ltd.28

(xiv) Lupin Ltd. vs. Johnson & Johnson29

(xv) Sun pharmaceuticals Laboratories Ltd. vs. Hetero Healthcare Ltd. & Anr.30

20. In rejoinder, Mr. Kirpekar would submit that, insofar as the passing off action is concerned, the alleged user is required to be considered from the year 2006. He submits that there is no response to the submission that the Plaintiff's drug licence is of Philippines and Srilanka and that under Section 18(6)(c) of the Drugs and Cosmetics Act, without a licence, the impugned product could not have been manufactured and marketed by the Defendant. He would further submit that the decision relied upon by the Defendant to contest the case of goodwill and reputation on the basis of the CA certificate arises out of proceedings under Section 57 of the Trade Marks Act. He would further point out that the CA certificate is dated 2014 and is not created for the purpose of the suit and hence is believable. He would further submit that, as on the date the Defendant commenced use, the Plaintiff had already achieved substantial sales turnover and produces the chart showing the comparative sales. He would submit that the decision in the case of Macleods Pharmaceuticals vs. Swiss Cam 28 Order dated 03.09.2025 passed in IA(L)/7446/2025 in COMIP Suit/194/2025 29 501 2015 (1) Mh.L.J. 30 2022 SCC OnLine Del 2580 : (2022) 92 PTC 536 IA-L-19536-2025 & IA-5318-2025-J.odt Health Card & Ors. (supra), arose out of IPAB proceedings and the proposition of law can be found in paragraph 24 of the said decision. REASONS & ANALYSIS :

21. The action is for infringement of trade mark and passing off. The rival marks are OCTRIDE vs. OTIDE.

22. Though the plaint pleads about the registration of the mark OCTIDE, the cause of action is based on infringement of the trade mark OCTRIDE. The Defendant had secured registration of the mark OCTIDE, however neither the Plaintiff nor the Defendant commercially used the mark OCTIDE and hence the mark OCTIDE is beyond the scope of consideration.

23. The contest is essentially between Plaintiff's OCTRIDE vs. OTIDE.

The Plaintiff's mark "OCTRIDE" is used for medicinal preparation prescribed to treat acromegaly, carcinoid tumors and bleeding esophageal varices and to prevent complications following surgery of the pancreas. The active pharmaceutical ingredient (API) is Octreotide Acetate. The Defendant's product marketed under the impugned mark OTIDE was applied for registration on 29th December,

2003 claiming user since 1st January, 1999. The impugned product is used for treating identical ailment and is derived from the same molecule i.e. Octreotide Acetate.

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24. Mr. Kirpekar would emphasize on the registration of the mark "OCTIDE" to bolster its case of infringement against "OCTRIDE". Section 55 of the Trade Marks Act, 1999 provides that where use of a registered trade mark or of substantially identical trade mark is required to be proved for any purpose, the Court may accept the use of a registered associated trade mark. It is an admitted position that the registration of the Plaintiff's mark "OCTIDE" lapsed way back in the year 2008 and the mark was never commercially exploited. No help can be derived by the Plaintiff of the lapsed registration of its mark "OCTIDE", which was never put to use.

25. The Defendant has also secured registration of its mark "OTIDE" under the Trade Marks Act, 1999 and under Section 31, the registration is prima facie evidence of its validity. The registration of the Defendant's mark surpasses the challenge under Sections 9 and 11 which constitute the grounds for refusal of registration. The position is that both the Plaintiff and the Defendant are registered proprietors of the mark and are entitled to statutory protection granted by the Trade Marks Act, 1999. Section 28(3) of Trade Marks Act, 1999 reads as under:

"(3) Where two or more persons are registered proprietors of trade marks which are identical with or nearly resemble each other, the exclusive right to use of any of those trade marks shall not (except so far as their respective rights are subject to any conditions or IA-L-19536-2025 & IA-5318-2025-J.odt limitations entered on the register) be deemed to have been acquired by any of those persons as against any other of those persons merely by registration of the trade marks but each of those persons has otherwise the same rights as against other persons(not being registered users using by way of permitted use) as he would have if he were the sole registered proprietor."

26. Section 30 of the Trade Marks Act, 1999 limits the effect of registered trade mark and Section 30(2)(e) reads as under:

> "(2) A registered trade mark is not infringed where-
>
> (e) the use of registered trade mark, being one of two or more trade marks registered under this Act which are identical or nearly resemble each other, in exercise of the right to the use of that trade mark given by registration under this Act."

27. To overcome the obstacle of registration of the Defendant's mark, the Plaintiff would seek to assail the validity of the registered mark. The rival marks are derived from the API Octreotide Acetate. The Plaintiff has appropriated the first four letters "OCTR" and the last three letters "IDE" from the API and the Defendant has appropriated the last five letters "OTIDE" from the API.

28. To maintain an action for infringement of the registered trade mark against another registered proprietor, the Plaintiff is required to show that the registration of the impugned mark is ex-facie

illegal, fraudulent and as such shocks the conscience of the Court,which are IA-L-19536-2025 & IA-5318-2025-J.odt the principles laid by the Hon'ble Full Bench of this Court in Lupin Limited vs. Johnson and Johnson (supra).

29. The pleading in the plaint to assail the validity of the Defendant's registered trade mark can be found in paragraph no. 26 of the plaint that the Defendant had express and/or constructive notice of the Plaintiff's trade mark and that there is no documents produced to show user claim. The other averments are the usual pleadings as regards likelihood of confusion, mala fide intent etc, which are in essence reproduction of the ingredients of Section 29 of the Trade Marks Act, 1999.

30. In the examination report for registration of the Defendant's mark "OCTIDE", the Plaintiff's mark "OCTIDE" was cited. The same by itself is not sufficient to assail the validity as being fraudulent or illegal or such that it shocks conscience of the Court insofar as the impugned mark "OTIDE" is concerned. As the Defendant has already secured registration of its mark, it has passed the muster of distinctiveness and to disturb the same, there must be ex-facie fraud or illegality shown. As no monopoly can be claimed in the generic molecule, and both marks being derived from API, in my view, the registration is not ex- facie illegal, fraudulent or such as shocks the conscience of the Court. There is no prima facie case made out for going beyond the validity of the Defendant's registration on basis of abandoned mark of "OCTIDE"

IA-L-19536-2025 & IA-5318-2025-J.odt and absence of user document since 1999. Pertinently, the Plaintiff has not filed any rectification application, and hence, no action for infringement of trade mark would lie against the Defendant's mark. Neither party can raise the plea of the mark being non-registrable as they have themselves applied for registration of the mark which implies that the parties considered their mark to be distinctive.

31. The only issue which remains to be considered is the action for passing off. Section 27(2) of the Trade Marks Act, 1999 provides that nothing in the Trade Marks Act shall be deemed to affect right of action of passing-off.

32. The well settled tests to be applied in an action for passing off remains undisturbed as to reputation and goodwill, misrepresentation and damage. The goodwill and reputation to be established is on the date on which the use of the impugned mark commences. In case of passing off, the similarity of the rival marks should be relatable to the aspect of confusion and deception. The rival marks are OCTRIDE vs OTIDE. The Defendant has deleted the alphabet "C" and "R" from their mark. The well settled test is that the marks have to be compared as a whole and when so compared there is phonetic similarity between the two marks. It is not permissible to dissect the marks and compare its syllable to syllable. (See Order dated 8th April, 2026 passed in Commercial Appeal (L) No 42382 of 2025- Sun Pharmaceuticals India IA-L-19536-2025 & IA-5318-2025-J.odt Ltd vs Meghmani Lifesciences Ltd.). The molecule is Octreotide Acetate and it was possible for the Defendant to create sufficient distance between its mark and that of the Plaintiff using different permutations and combinations. Using portions of the API Octreotide in a deceptively similar manner results in the possibility of rival marks being pronounced similarly and likely to cause confusion especially where there is hurried utterances. The incorrect pronunciation of trade marks

used for marketing medicines is not uncommon, when the mark is derived from the molecule which is usually not a known and often used word. It cannot be accepted that there would be eloquent precise pronunciation of the Plaintiff's mark with the correct syllables. The medicines would be purchased across the country including the rural areas and exacting judicial scrutiny is the well settled principle to be applied. In my view, the decision in Cadila Health Care vs Cadila Pharmaceuticals Ltd. (supra) lays down the proposition which aligns with the concept that medicinal and pharmaceutical preparations operates in a distinct silo demanding lesser threshold of confusion and deception. The test is of bare possibility as opposed to the likelihood of confusion. When so applied, by reason of their phonetic similarity, there is strong possibility of the confusion being caused by use of the impugned mark.

33. The Defendant has secured registration of its mark on 29 th IA-L-19536-2025 & IA-5318-2025-J.odt December, 2003 claiming user since 1st January, 1999. In its Affidavit-in- reply to the Interim Application, the Defendant has annexed the certificate of product registration which is however, of Republic of Philippines and which has been issued on 8th September, 2023. The certificate of registration of the mark OTIDE under the National Medicines Regulatory Authority, 2015 shows the period of validity from the year 2018-2020 and onwards. The invoice which has been produced is of 29th August, 2006 which shows the sale of medicinal preparation bearing the impugned mark. There is no document which has been produced on record to show user since 1999 as claimed or from the year 2003 i.e. from the date of registration. In view of the material which is placed on record, at this stage, it would be appropriate to consider the use of the impugned mark as of the year 2006, and the Plaintiff has to show goodwill and reputation as of 2006.

34. Coming to the documents produced by the Plaintiff to demonstrate goodwill and reputation, the Plaintiff has produced photographs of different cartons used by the Plaintiff in respect of its product bearing the trade mark "OCTRIDE". Perusal of the said document at Exhibit-D would indicate that the cartons are undated and does not reflect any details as regards manufacturing date, batch number, etc. The photographs of the cartons cannot be accepted as proof of user. The product permission for launch of new drug OCTRIDE IA-L-19536-2025 & IA-5318-2025-J.odt was granted by the Commissioner of Food & Drugs Control Administration on 10th September, 1998. The Plaintiff has produced the chartered accountant's certificate which has been issued on 21 st November, 2014 certifying the sales in respect of the trade mark OCTRIDE for the period from 1999-2000 onwards. Considering the date of the chartered accountant's certificate, the same is evidently not issued for the purpose of filing of the suit. The area wise sales figure from the year 1999 is given as Annexure to the certificate. There is no reason as to why after obtaining product launch permission, the drug would not have been marketed by the Plaintiff. For the period from 2006-2007, the sales are shown in the range about Rs. 7,70,00,000/-. Though the invoices produced are since the year 2010, at this stage, the certificate of the chartered accountant along with the permission from the Food and Drugs Control Administration can be accepted to show use of the Plaintiff's mark since the year 1999 and the goodwill and reputation of the Plaintiff as of the year 2006, when the Defendants commenced the use of the mark. In the case of Brihan Karan Sugar Syndicate Private Limited vs. Yashwantrao Mohite Krushna Sahakari Sakhar Karkhana31, the Hon'ble Apex Court in the context of goodwill and reputation has held that while deciding an application for temporary injunction in the suit for passing-off action, 31 2023 INSC 831.

IA-L-19536-2025 & IA-5318-2025-J.odt in the given case, the statement of accounts signed by the chartered accountant of Plaintiff indicating expenses incurred on advertisement and promotion and figures of sales may constitute a material which can be considered for examining whether a prima facie case was made out by the Appellant/Plaintiff, however, at the time of final hearing of the suit, the figures must be proved in the manner known to law.

35. The Defendant has not produced any material to show user since the year 1999 and has produced chartered accountant certified statements showing the sales turn over from the year 2006-2007. The annual sales turnover for the period 2006-2007 is about 27 lakhs at the time when the Plaintiff's sales turnover was about Rs 7 Crores. At the interim stage, considering the voluminous sale of its product under the OCTRIDE mark at the relevant date upon commencement of user by the Defendant, prima facie, the Plaintiff has demonstrated reputation and goodwill in the mark.

36. In so far as the aspect of delay and misrepresentation is concerned, it will be apposite to refer to the decision of Wockhardt vs. Torrent Pharmaceuticals Ltd32 in some detail. In that case, the Appeal reached the Hon'ble Apex Court against the order of the Hon'ble Division Bench of this Court upsetting the findings of the Learned Single Judge of this Court in respect of action of passing off. The 32 AIR 2018 SC 5106 IA-L-19536-2025 & IA-5318-2025-J.odt Hon'ble Apex noted the findings of the Learned Single Judge in paragraph 2 as under:

> "2. The skeletal facts necessary to decide this appeal are that the plaintiff-respondent has a trade mark called "Chymoral" and "Chymoral Forte", which is a drug administered post-surgically for swellings that may arise and/or wounds that may arise. It is interesting to note that the expression "Chymo" comes from the generic name of the drug which is Chymotrypsin-Trypsin. The Single Judge ultimately found, after a copious reference to the facts and case law, as follows: (Torrent Pharmaceuticals Ltd. case [Torrent Pharmaceuticals Ltd. v. Wockhardt Ltd., 2017 SCC OnLine Bom 318] , SCC OnLine Bom para 50) "50. In the present case, I am not satisfied that any of these tests are met. Reputation as to source is not sufficiently demonstrated. The rival products have long co-existed and I cannot and will not presume misrepresentation by Wockhardt as to source, even assuming there is similarity. There is no explanation at all for Torrent's past conduct and the inaction with knowledge, or deemed knowledge, of Wockhardt's trade mark registration application, its advertisement and subsequent registration, with not a single objection from Torrent or is predecessor-in-title. There is no answer about the caveats or about the coexistence of other players in the market. There is simply no misrepresentation shown as required by law, at this prima facie stage.
>
> IA-L-19536-2025 & IA-5318-2025-J.odt There being no prima facie case made out, I cannot grant the injunction. The balance of convenience seems to me to favour entirely the defendants; after all, to the plaintiff's knowledge, they have had their product in the market for a very long time, at the very least for five years, possibly more, and an injunction at this stage is far removed from the prima facie status quo

> that Wander v. Antox [Wander Ltd. v. Antox (India) (P) Ltd., 1990 Supp SCC 727] tells us is the primary objective. There is no injury, let alone an irreparable one, to the plaintiff that I can tell if an injunction is refused. It has not had one all this time while the defendants' business has grown into crores. To grant the injunction would be unfairly monopolistic."

(emphasis in original)

37. The Hon'ble Apex Court held in paragraph 8 and 9 as under:

> "8. We may indicate, at this juncture, that insofar as the second test is concerned, this Court has in a plethora of judgments held that though passing off is, in essence, an action based on deceit, fraud is not a necessary element of a right of action, and that the defendant's state of mind is wholly irrelevant to the existence of a cause of action for passing off, if otherwise the defendant has imitated or adopted the plaintiff's mark. We need only state the law from one of our judgments, namely, in Laxmikant V. Patel v. Chetanbhai Shah [Laxmikant V. Patel v. Chetanbhai Shah, (2002) 3 SCC 65] , which reads as under: (SCC p. 73, para 13) IA-L-19536-2025 & IA-5318-2025-J.odt "13. In an action for passing off it is usual, rather essential, to seek an injunction, temporary or ad interim. The principles for the grant of such injunction are the same as in the case of any other action against injury complained of. The plaintiff must prove a prima facie case, availability of balance of convenience in his favour and his suffering an irreparable injury in the absence of grant of injunction. According to Kerly [Law of Trade Marks and Trade Names (12th Edn., Sweet & Maxwell, London 1986).] (ibid, para 16.16) passing off cases are often cases of deliberate and intentional misrepresentation, but it is well settled that fraud is not a necessary element of the right of action, and the absence of an intention to deceive is not a defence, though proof of fraudulent intention may materially assist a plaintiff in establishing probability of deception. Christopher Wadlow in Law of Passing Off (1995 Edn., at p. 3.06) states that the plaintiff does not have to prove actual damage in order to succeed in an action for passing off. Likelihood of damage is sufficient. The same learned author states that the defendant's state of mind is wholly irrelevant to the existence of the cause of action for passing off (ibid, paras 4.20 and 7.15). As to how the injunction granted by the court would shape depends on the facts and circumstances of each case. Where a defendant has imitated or adopted the plaintiff's distinctive trade mark or business name, the order may be an absolute injunction that he would not use or carry on business under that name. (Kerly [Law IA-L-19536-2025 & IA-5318-2025-J.odt of Trade Marks and Trade Names (12th Edn., Sweet & Maxwell, London 1986).] , ibid, para 16.97)."

This judgment has been followed in S. Syed Mohideen v. P. Sulochana Bai [S. Syed Mohideen v. P. Sulochana Bai, (2016) 2 SCC 683 : (2016) 2 SCC (Civ) 201] , SCC at pp. 699-700. Also, in Satyam Infoway Ltd. v. Siffynet Solutions (P) Ltd. [Satyam Infoway Ltd. v. Siffynet Solutions (P) Ltd., (2004) 6 SCC 145] , this Court held: (SCC p. 151, para 14) "14. The second element that must be

established by a plaintiff in a passing off action is misrepresentation by the defendant to the public. The word misrepresentation does not mean that the plaintiff has to prove any mala fide intention on the part of the defendant. Of course, if the misrepresentation is intentional, it might lead to an inference that the reputation of the plaintiff is such that it is worth the defendant's while to cash in on it. An innocent misrepresentation would be relevant only on the question of the ultimate relief which would be granted to the plaintiff [Cadbury Schweppes Pty. Ltd. v. Pub Squash Co. Pty. Ltd. [Cadbury Schweppes Pty. Ltd. v. Pub Squash Co. Pty. Ltd., 1981 RPC 429 : (1981) 1 WLR 193 (PC)] , Erven Warnink Besloten Vennootschap v. J. Townend and Sons (Hull) Ltd. [Erven Warnink Besloten Vennootschap v. J. Townend and Sons (Hull) Ltd., 1980 RPC 31 : 1979 AC 731 (HL)]].

9. The Division Bench essentially interfered with the judgment of the Single Judge on this score and also found IA-L-19536-2025 & IA-5318-2025-J.odt that the Single Judge was incorrect in stating that "reputation as to source is not sufficiently demonstrated". It found that reputation was established from the sales figures, and the fact that the plaintiff was clearly a prior user would make it clear that the first pre-requisite for the action in passing off was made out. Where the Division Bench and the Single Judge really locked horns was on the point of acquiescence. The Single Judge found that not only was there a lying by for a long period, but that there was positive action on the part of the plaintiff in leading the defendant to believe that he could build up his business, at which point the plaintiff swooped in to interdict and throttle that business as it was rising just as sales were rising. On this count, the Division Bench [Torrent Pharmaceuticals Ltd. v. Wockhardt Ltd., 2017 SCC OnLine Bom 9666] interfered with the Single Judge as follows: (SCC OnLine Bom paras 89-91) "89. The learned Judge then attributes acquiescence to the plaintiff. The plaintiff's predecessor in title did not object to the trademark registration application. It allowed others to do so and it is the plaintiff's failure to bring a suit on service of a caveat. Thus, there is no objection from the plaintiff. It only means that the plaintiff kept quiet when the application for registration was made by the defendant. They failed to object to the advertisement of the defendant's application or when the defendant brought its project in market. They did not object to other entities introducing their products in the market either. This is enough to assume IA-L-19536-2025 & IA-5318-2025-J.odt acquiescence. We do not think this to be the position on facts and in law. A plea of acquiescence to be raised in defence so as to succeed ought to be supported by weighty materials to that effect. Since the Single Judge has referred to the judgment of the Hon'ble Supreme Court in Power Control Appliances v. Sumeet Machines (P) Ltd. [Power Control Appliances v. Sumeet Machines (P) Ltd., (1994) 2 SCC 448] , we would refer to it in some details. Paras 4, 5, 7, 11, 12, 13, 14, 15 and 16 of this judgment were heavily relied upon by Mr Tulzapurkar. In that, the facts and the submissions are summarised. Then, in para 20, the argument of the respondent before the Hon'ble Supreme Court was set out. In paras 27, 28, 29 and 30, the English judgments were noted and up to para 31. Thereafter, the decisions rendered by our Hon'ble Supreme Court and other courts have been noted.

90. We are in agreement with Mr Tulzapurkar that even at this prima facie stage, there is no positive act which can be attributed to the plaintiff so as to deny the relief. There is no acquiescence which can be culled out. Beyond referring to some general principles, we do not find any material placed before the Single Judge from which an inference of acquiescence can be drawn. Mr Dwarkadas has, on this point, relied upon certain judgments and even in the written submissions, there is reference to general principles. All that the first defendant says is as under:

'(ii) The defence of the acquiescence is available to Respondent 1 since the plaintiff was aware of its right IA-L-19536-2025 & IA-5318-2025-J.odt and the defendant was ignorant of its own right and despite the same, the plaintiff assents to or lays by in relation to the acts of the defendant and in view of the same, it would be unjust in all circumstances to grant the relief of injunction to the plaintiff. It is submitted that the requirements stand duly fulfilled and on the above set of facts where from 2009/11, the appellant/its predecessors are duly aware of Respondent 1's trademark; the use of Respondent 1's mark openly and on an extensive scale; and at no point for over 7 years did the appellant or its predecessors contest the same. On the contrary, the appellant's 2014 acquisition of the trademark is with full notice of the adoption and use and registration of Respondent 1's trademark. As such, the principles of acquiescence and waiver apply with full vigour.

(iii) Acquiescence is a species of estoppel and therefore both a rule of evidence and a rule in equity.

It is an estoppel in pais: a party is prevented by his other own conduct from enforcing a right to the detriment of another who justifiably acted on such conduct.

(iv) The "positive act" as referred to in the decision of the Hon'ble Apex Court in Power Control Appliances v. Sumeet Machines (P) Ltd. [Power Control Appliances v. Sumeet Machines (P) Ltd., (1994) 2 SCC 448] (relied upon by the appellant) cannot mean that the plaintiff "green lighting" the defendant's action only to later complain of it. The "positive act" is the "sitting by" or "laying by" i.e. not mere silence or inaction but a IA-L-19536-2025 & IA-5318-2025-J.odt refusal or failure to act despite knowledge of invasion and opportunity to stop it. In the present case, from 2009, the appellant and/or its predecessors have been at notice of Respondent 1's adoption, use and registration of its trademark and against that there has been a complete failure to register any protest or objection. In 2014, the appellant acquired the trademark with full notice of Respondent 1's registration and use of the trademark "Chymtral". This qualifies for both acquiescence and estoppel defences.'

91. Thus, the attempt is to equate delay with acquiescence and which is not correct. We do not think that because the appellants stepped in the year 2014 with notice of the first respondent's registration and use of the mark that means the appellant-plaintiff has acquiesced in the same. That is not a positive act and which is required to deny the relief on the ground of acquiescence."

38. The Hon'ble Apex Court approved the view of the Hon'ble Division Bench that delay cannot be equated with acquiescence merely because the Plaintiff had stepped in after several years after notice of the Respondent's mark. This is precisely the case here, where the submission of acquiescence is that by reason of its presence in medical journals, by being cited as substitute of Plaintiff's product, trading in common channels etc. As held by the Hon'ble Division Bench and IA-L-19536-2025 & IA-5318-2025-J.odt approved by the Hon'ble Apex Court, the sitting by cannot be said to be a positive act and amounts to equating delay with acquiescence. Mr. Kirpekar has also pointed out that in the medical journals, though the mark OTIDE is reflected, the price is shown as

non applicable for the reason that the drug marketed under the impugned mark was not available. There was thus no reason for the Plaintiff to institute any proceeding as there was no damage to its reputation and goodwill.

39. The Plaintiff has been able to show the sales turnover of the product marketed under the registered trade mark OCTRIDE since the year 1999, which prima facie implies prior user of the mark since the year 1999. The documents produced by the Defendant are of the year 2006 and the comparative sales figures show the great divide between the sales under the rival marks. In Bal Pharma Ltd. vs. Centaur Laboratories Pvt. Ltd. & Anr.33, the Hon'ble Division Bench of this Court has held that where the Defendant to an action has been using the mark, even if concurrently, without making himself aware as to whether the same mark is registered in the name of some other person, he cannot be heard to complain as he has not bothered to take the elementary precaution of making himself aware by taking a search of the trade mark registry as to whether the mark is registered in the name of other person.

33 2001 SCC OnLine Bom 1176 IA-L-19536-2025 & IA-5318-2025-J.odt

40. The Supreme Court in the decision between Milment Oftho Industries (supra) after reviewing the law on the subject held as follows:

> "7. In respect of medicinal products it was held that exacting judicial scrutiny is required if there was a possibility of confusion over marks on medicinal products because the potential harm may be far more dire than that in confusion over ordinary consumer products. It was held that even though certain products may not be sold across the counter, nevertheless it was not uncommon that because of lack of competence or otherwise that mistakes arise specially where the trade marks are deceptively similar. It was held that confusion and mistakes could arise even for prescription drugs where the similar goods are marketed under marks which looked alike and sound alike. It was held that physicians are not immune from confusion or mistake. It was held that it was common knowledge that many prescriptions are telephoned to the pharmacists and others are handwritten, and frequently the handwriting is not legible. It was held that these facts enhance the chances of confusion or mistake by the pharmacists in filling the prescription if the marks appear too much alike."

41. The passing-off action which is common law remedy is founded on the principle that no man shall trade its goods as that of the others and be unjustly enriched by the others goodwill and reputation. In light of the said proposition, the fact that the compositions may be similar IA-L-19536-2025 & IA-5318-2025-J.odt by itself is not sufficient to refuse injunction against passing off. Careful scrutiny is also necessitated for the reason that the ailments that the rival drugs treat are serious ailments. In Sun Pharmaceuticals India Ltd vs Meghmani Lifesciences Ltd. (supra), the Hon'ble Division Bench held that the Plaintiff cannot claim any monopoly over a word, which may be indicative of the active ingredient used in the product or in cases where there is presence of a component which it generic, but in cases where there is phonetic similarity, there is more chance of

confusion as one product may be taken as a prescribed medicine, but it may not give the desired result.

42. Mr. Khandekar has emphasised on the difference in the packaging/trade dress of the products. In Sun Pharmaceuticals India Ltd vs Meghmani Lifesciences Ltd(supra), the Hon'ble Division Bench of this Court in context of medicinal preparations has declined to go into the difference of trade dress and has gone into phonetic similarity, which was held to have potential for confusion and is the real test to determine the similarity. This Court is respectfully bound by the decision of the Hon'ble Division Bench.

43. Coming to the decisions relied upon by Mr. Khandekar, in Schering Corporation and Another vs. United Biotech (P) Limited (supra), the Court noted that there was no possibility of confusion as the Defendant's product was purchased in bulk by hospitals and not IA-L-19536-2025 & IA-5318-2025-J.odt sold over the counter, whereas the Plaintiff's products were sold over the counter.

44. In the case of Macleods Pharmaceuticals Limited vs. Swisskem Healthcare Limited and Another (supra), the action was in respect of passing-off. The Co-ordinate Bench held that the marks were not similar and there was no consideration as regards the packaging/trade dress as no proprietary right in the packaging/trade dress was proved by the Plaintiff. In that case, the packaging was similar and despite thereof, as there was no visual, phonetic similarity between the two marks, the Court did not consider the question of similarity between the rival marks.

45. In the case of Sun Pharmaceutical Laboratories Limited vs. Hetero Healthcare Limited (supra), the inquiry was not confined to the trade dress in the context of passing-off and on overall conspectus of the matter, the Delhi High Court held the marks not to be deceptively similar.

46. In the case of Anubhav Jain vs. Satish Kumar Jain (supra), the proceedings arose out of Section 57 of the Trade Marks Act, 1999 and the Court was not convinced with mere chartered accountant's certificate unsupported by any document could suffice any evidence for user.

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47. In the case of Amritdhara Pharmacy vs. Satya Deo Gupta (supra), the Hon'ble Apex Court considered the plea of acquiescence and held in the facts of that case that there was no fraudulent user as the name was first used in 1923. In that case, the Hon'ble Apex Court found that rival marks were similar, however, did not find any fraudulent user and that the claimant was well-aware of the advertisements of Respondents. In the present case, the advertisements would indicate that the price quoted was nil which implies that the goods were not available.

48. The next decision is Sun Pharma Laboratories Limited vs. Psycoremedies Ltd. (supra), where Madras High Court found that the rival marks were constantly featuring together since 2008 and therefore, the Plaintiff ought to have knowledge of the Defendant's trade mark, in that case, the Court held that the case is of delay as well as laches and acquiescence. The decision in Wockhardt vs

Torrent Pharmaceuticals Ltd. (supra) would bind this Court.

49. In the case of Medley Pharmaceuticals Limited vs. Khandelwal Laboratories Limited (supra), this Court upon comparison of the marks therein has held that no exclusivity could be claimed by the Plaintiff as the same is commonly used by many companies in the market. The decision was rendered in the facts of that case.

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50. The proposition of law laid down in the case of Wander Limited vs. Antox India P. Limited (supra) is not debated.

51. The decision in the case of Velji Karamshi Vaid vs. V3 Fashion (supra) turned on the facts where there were no documents produced to demonstrate the goodwill and reputation and there was suppression of material facts.

52. In the decision in the case of Chemco Plastic Industries Private Limited vs. M/s Chemco Plast (supra), the Co-ordinate Bench, in the facts of that case found that the Plaintiff had failed to establish prior user of the mark. In the context of passing-off, the Co-ordinate Bench considered the classical trinity test and found that Plaintiff has not established the formidable goodwill and reputation at the time when Defendant commenced the use of the mark. On the aspect of acquiescence, it held that the user by the Plaintiff was neither dishonest nor negligent and is traceable to the year 1999. The decision was rendered in the facts of that case and there is no quarrel with the test applied by Co-ordinate Bench in the facts of that case.

53. In the case of Uniply Industries Limited vs. Unicorn Plywood Pvt. Ltd. (supra), the Hon'ble Apex Court considered the aspect of prior user and in that context noted that even prior small sales of the mark are sufficient to establish priority, the test being to determine continuous prior user and volumes of sale or the degree of familiarity IA-L-19536-2025 & IA-5318-2025-J.odt of the public with the mark. The Hon'ble Apex Court has further noted that contrary view has also been taken where the Courts have classified small sales volume as so small and inconsequential which facts have to be thrashed out at the time of trial. The Plaintiff in the present case has demonstrated prior use of its mark.

54. Insofar as Corona Remedies Private Limited vs. Franco-Indian Pharmaceuticals Private Limited (supra) is concerned, the Hon'ble Apex Court has directed that the same will not constitute a precedent.

55. The decision in the case of Mangalam Organics Limited vs. N. Ranga Rao and Sons Private Limited (supra) was rendered in the facts of that case as apart from the merits of the case, the Court found suppression of material facts.

56. In light of the above discussion, the Plaintiff has made out prima facie case for grant of interim injunction against passing off. The Plaintiff has produced documentary material to prima facie

establish the use of the registered mark OCTRIDE since the year 1999, whereas the documents produced by the Defendants prima facie establishes user since the year 2006. At the relevant time, when the Defendant commenced the use of the mark, the Plaintiff had achieved substantial goodwill and reputation. Comparatively, the Plaintiff's sales turnover was about Rs 7 crores as against the Defendant's turnover of about Rs 27 lakhs in the year 2006. The balance of convenience is in favour of IA-L-19536-2025 & IA-5318-2025-J.odt the Plaintiff as the deceptively similar mark is likely to cause damage to the reputation and goodwill of the Plaintiff. Considering that the parties are in same pharmaceutical segment, the Defendant is deemed to be aware of existence of the Plaintiff's mark.

57. In view of the above, the Interim Application (L) No.19536 of 2025 is allowed in terms of prayer clause (b), which reads thus :

> "b) that pending the hearing and final hearing of the suit, the Defendant by itself, its proprietors/partners, promoters, directors, affiliates, associate/s, sister/group companies, employees, servants, agents, dealers, stockist, super-stockists, e-commerce and warehouse aggregators, distributors, wholesalers, retailers, custodians, agents, assignees, franchisees, licensees, predecessors, successors and all persons claiming through and/or under them or acting on their behalf and all those connected with them be restrained by a temporary order and injunction of this Hon'ble Court from trading, using, manufacturing, selling, marketing, stocking, promoting, advertising, distributing, exporting, importing, exhibiting, displaying and/or offering for sale or otherwise in shops or on their own website or any other website owned, managed and/or controlled by the Defendant/s or on any other e-commerce or platforms/sites or websites and/or using in any manner in relation to their medicinal and pharmaceutical preparations the impugned marks 'OCTIDE' and 'OTIDE' and/or trademark containing the word 'OCTRIDE' and/or any mark identical and/or being deceptively and/or being confusingly similar to the Plaintiff's 'OCTRIDE' trademark so as to pass off or enable others to pass off the Defendant's goods as and for that of the Plaintiff."

58. The Interim Application (L) No. 19536 of 2025 stands disposed of accordingly.

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59. The Interim Application No.5318 of 2025 does not survive for consideration. The same stands disposed of accordingly.

[SHARMILA U. DESHMUKH, J.]