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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

\+ CS(COMM) 1124/2024 & I.A. Nos. 48381/2024, 48382/2024, 48383/2024, 48384/2024 & 48385/2024

SANOFI & ANR. .....Plaintiffs

Through: Mr. Peeyoosh Kalra with Ms. V. Mohini and Ms. Aarti Aggrawal, Advocates.
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versus

SANOFI JAZZ INTERNATIONAL PVT LTD. .....Defendant

Through: None.

CORAM:
HON'BLE MS. JUSTICE MINI PUSHKARNA

<u>O R D E R</u>

% **16.12.2024**

<u>I.A. 48383/2024 (Exemption from filing certified copies of documents)</u>

1. The present is an application under Section 151 of the Code of Civil Procedure, 1908 ("CPC"), on behalf of the plaintiffs, seeking exemption from filing certified copies, typed copies of dim documents and documents with improper double space/margins and translated copies of the annexures.

2. Exemption is granted, subject to all just exceptions.

3. Plaintiffs shall file legible, clear, and translated copies of the documents, on which the plaintiffs may seek to place reliance, before the next date of hearing.

4. Accordingly, the present application is disposed of.

I.A. 48382/2024 (Exemption from filing original documents)

5. The present is an application under Section 151 CPC, on behalf of the plaintiffs, seeking exemption from filing original documents.

6. Exemption is granted, subject to all just exceptions.

7. Plaintiffs shall file legible, clear, and translated copies of the documents, on which the plaintiffs may seek to place reliance, before the next date of hearing.

8. Accordingly, the present application is disposed of.

I.A. 48385/2024 (Exemption from undergoing Pre-Institution Mediation)

9. The present is an application under Section 12A of the Commercial Courts Act, 2015, read with Section 151 of CPC, seeking exemption from undergoing Pre-Institution Mediation.

10. Having regard to the facts of the present case and in the light of the judgment of Supreme Court in the case of ***Yamini Manohar Versus T.K.D. Keerthi, 2023 SCC OnLine SC 1382***, and Division Bench of this Court in ***Chandra Kishore Chaurasia Versus RA Perfumery Works Private Ltd., 2022 SCC OnLine Del 3529***, exemption from attempting Pre-Institution Mediation, is granted.

11. Accordingly, the application stands disposed of.

I.A. 48384/2024 (Application seeking leave to file additional documents)

12. This is an application under Order XI Rule 1(4) read with Section 151 CPC, as amended by the Commercial Courts Act, 2015, seeking leave to file additional documents.

13. The plaintiffs, if wish to file additional documents at a later stage, shall do so strictly as per the provisions of Commercial Courts Act, 2015

and the Delhi High Court (Original Side) Rules, 2018.

14. The application is disposed of, with the aforesaid directions.

CS(COMM) 1124/2024

15. Let the plaint be registered as suit.

16. Upon filing of the process fee, issue summons to the defendant by all permissible modes. Summons shall state that the written statement be filed by the defendant within thirty days from the date of receipt of summons. Along with the written statement, the defendant shall also file affidavit of admission/denial of the plaintiffs' documents, without which, the written statement shall not be taken on record.

17. Liberty is given to the plaintiffs to file replication within thirty days from the date of receipt of the written statement. Further, along with the replication, if any, filed by the plaintiffs, an affidavit of admission/denial of documents of the defendants, be filed by the plaintiffs, without which, the replication shall not be taken on record. If any of the parties wish to seek inspection of the documents, the same shall be sought and given within the timelines.

18. List before the Joint Registrar (Judicial) for marking of exhibits, on 05^{th} February, 2025.

19. List before the Court on 05^{th} May, 2025.

I.A. 48381/2024 (Application under Order XXXIX Rules 1 and 2 CPC)

20. The present suit has been filed for permanent and mandatory injunction restraining the defendant from infringement of plaintiffs' prior registered and used trademark 'SANOFI', passing off, dilution along with damages, rendition of accounts of profits, delivery-up, etc.

21. Learned counsel appearing for the plaintiffs submits that plaintiff no.

1 and plaintiff no. 2 are part of the Sanofi Group, which is a global and diversified healthcare leader, and discovers, develops and distributes therapeutic solutions focused on patients' need. Plaintiffs adopted the mark 'SANOFI' in the year 1973 as their trade name and house mark. Products under the mark SANOFI were first introduced in India in early 1980s. In addition, the trade mark SANOFI is registered in favour of plaintiffs since 25th June, 1984 under Registration No. 423613 in Class 5. The plaintiffs have secured numerous trade mark registrations across various international jurisdictions with the earliest registration for the mark SANOFI dating back to the year 1977 bearing Registration No. 006827942 in Brazil.

22. It is submitted that plaintiffs are engaged in the business of healthcare products that primarily include diabetes solutions, human vaccines, innovative drugs, consumer healthcare, etc. Plaintiff no. 2 is a subsidiary of plaintiff no. 1 in India along with other group entities, thus, constituting one economic entity. Use of the trade marks by plaintiffs and other group entities being its affiliates/subsidiaries inures to the benefit of plaintiffs.

23. It is further submitted that Sanofi has 69 manufacturing sites in 32 countries and healthcare solutions available in more than 170 countries. In India, Sanofi operates through two entities – Sanofi India Limited, and Sanofi Healthcare India Pvt. Ltd. Present in more than 90 countries, Sanofi employs more than 100,000 employees, representing 142 nationalities, who constitute the foundation of its global identity and creativity. Sanofi's research organization ranks amongst the best in the world and it is the leader in various therapeutic areas, including, but not limited to, cardiovascular diseases, thrombosis, diabetes, central nervous system disorders, internal medicine, vaccines and cancer.

24. Thus, it is submitted that the trademark SANOFI, forms an integral and inalienable part of the plaintiffs' identity and business. Details of various trademarks registered by the plaintiffs in India are given in paragraph 18 of the plaint. The products and services offered by the plaintiffs are marketed and advertised widely across the globe, with the result that the same have achieved extensive recognition amongst members of the trade and public. Net sales figures of the plaintiffs can be found in paragraph 14 of the plaint. Since its commencement of business in India in year 1984, plaintiff no. 2 has been continuously advertising its products and services across numerous platforms in India. plaintiff no. 1's advertising expenses for the year ending December, 2022 was USD 382 million whereas, the advertisement expenditure of plaintiff no. 2 for the year ending December, 2022 was USD 4.17 million (INR 34.77 crores).

25. It is further submitted that the trade mark/trade name/house mark SANOFI is extremely well-known amongst the relevant trade and public and the same is considered to be valuable intellectual property by the plaintiffs that they vigorously enforce and defend against any act of infringement and/or passing off. Consequently, business/products bearing the trade mark/trade name/house mark SANOFI have attained goodwill and reputation and the same are identified by the public with the plaintiffs alone, qualifying as a well-known trade mark having attained overwhelming recognition amongst customer world over and in India.

26. It is submitted that plaintiffs are aggrieved on account of defendant's adoption and use of the mark/name 'SANOFI' which is identical to the plaintiffs' prior trade mark/trade name and house mark SANOFI. It is submitted the trademark 'SANOFI' is used as part of the corporate name by

defendant, i.e. 'Sanofi Jazz International Private Limited' which impinges on the plaintiffs' prior statutory rights vesting therein.

27. It is further submitted that in October 2021, plaintiffs came across the defendant's adoption of the mark 'SANOFI' as part of its corporate name which was identical to the plaintiffs' registered and well-known trade mark/trade name/house mark 'SANOFI'. Accordingly, the plaintiffs, through their counsel, addressed a cease and desist notice to the defendant on 07th October, 2021, calling upon them to give-up the use of the trade mark/name SANOFI and change the corporate name 'Sanofi Jazz International Private Limited'. Upon not receiving any response to the above cease and desist notice, counsel for the plaintiffs addressed a reminder letter to the defendant on 08th November, 2021. Thereafter, owing to a change in the directors of the defendant company, a fresh cease and desist notice was once again addressed to the defendant as well as its newly appointed director, Mr. Brijesh Kumar on 13th May, 2022.

28. It is submitted that counsel for the plaintiffs also tried to telephonically contact the defendant company on the number obtained from the public records, however, the calls went unanswered. It is submitted that the plaintiffs have not received any response to the cease and desist notices to date.

29. It is further submitted that plaintiffs' market enquiries regarding the defendant's business did not reveal any use of the name/mark SANOFI or SANOFI JAZZ and no physical business was found to be carried on by the defendant. A review of the online records maintained by the Registrar of Companies ("ROC") accessible at the website of the Ministry Corporate Affairs ("MCA") also indicated that the last Annual General Meeting of the

defendant company was held on 30th September, 2022 and further enquiries revealed that the defendant company cancelled their Goods and Services Tax Identification Number (GSTIN) in 2023. Therefore, the plaintiffs were under the *bona fide* belief that there is no actual business being carried on by the defendant and eventually, the defendant's company name would also be cancelled. However, despite no business being carried on by the defendant, their company name continues to be reflected as 'Active' as part of the ROC records as on date. Accordingly, the plaintiffs have filed the present suit seeking to restrain defendant's continued use/adoption of the trademark/trade name 'SANOFI'.

30. It is submitted by the plaintiffs that SANOFI is a coined, unique and arbitrary word and the defendant can have no plausible explanation to have adopted an identical word/mark and therefore adoption by the defendant is evidently dishonest and mala fide. Plaintiffs have in this regard also filed orders passed by this [***Sanofi and Anr. Vs. Zanofi Pharmaceutical Pvt. Ltd., CS(COMM) 881/2023***] as well as the Bombay High Court [***Sanofi and Ansr. Vs. Manojbhai Maganbhai Vachhani & Ors., Commercial IP Suit (L) No. 24839 of 2024***] in its favour against adoption of a deceptively similar mark 'ZANOFI' and identical mark 'SANOFI TECHNOFAB' that further fortify its successful claims against unauthorised adoption of the mark SANOFI/deceptive variation thereof as a trade name/corporate name as also trademark.

31. It is further submitted that defendant's adoption and use of the mark/name SANOFI identical to plaintiff no. 1's registered trade mark/trade name/house mark SANOFI, would tantamount to infringement of its statutory rights vested in its registered and well-known trade mark/ trade

name/ house mark SANOFI.

32. It is submitted that defendant's adoption and use of the mark/ name SANOFI is liable to result in confusion inasmuch as the consumers and traders in general may be misled into believing that the defendant's business actually originates from plaintiffs or may be put into a state of wonder that defendant has some sort of affiliation/link/connection/commercial relation with plaintiffs, either as its licensee or franchises. Such confusion would inflict injury and damage to plaintiffs' goodwill and reputation vesting in its trade mark/ trade name/ house mark SANOFI besides leading to erosion and dilution of the same.

33. In the above circumstances, the plaintiff has demonstrated a *prima facie* case for grant of injunction and, in case, no *ex parte ad interim* injunction is granted, the plaintiff will suffer an irreparable loss. Further, balance of convenience also lies in favour of the plaintiffs, and against the defendant.

34. Accordingly, till the next date of hearing, it is directed that the defendant, its promoters, directors, assigns, relatives, successors-in-interest, licensees, franchisees, partners, representatives, servants, distributors, employees, agents etc. or anyone associated with it are restrained from using the trade mark 'SANOFI'/'SANOFI JAZZ' or any other mark or marks, identical to or deceptively similar to or containing plaintiff no. 1's registered trade mark 'SANOFI' under Registration Nos. 423613, 423612, 1312119, 1383078, 1383079, 3094580, 3260122, 4052170 and 5732111, either as a trade mark/corporate name/domain name, on their website, social media webpages, online trade directories, online medical trade portals etc. and/or in any manner whatsoever so as to infringe the same/or to pass off or enable to

pass off their goods as and for the goods of the plaintiffs.

35. Issue notice to the defendant by all permissible modes upon filing of the Process Fee, returnable on the next date of hearing.

36. Let reply be filed within a period of four weeks.

37. Rejoinder thereto, if any, be filed within two weeks, thereafter.

38. Compliance of Order XXXIX Rule 3 CPC, be done, within a period of one week, from today.

39. List before the Court on 05th May, 2025.

MINI PUSHKARNA, J

DECEMBER 16, 2024

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