

# Emcure Pharmaceuticals Limited vs Siddhi Herbals on 19 September, 2024

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IN THE HIGH COURT OF DELHI AT NEW DELHI  
CS(COMM) 810/2024, I.A. 39809/2024, I.A.  
39811/2024  
EMCURE PHARMACEUTICALS LIMITED

SIDDHI HERBALS

Through:

CORAM:

HON'BLE MS. JUSTICE MINI PUSHKARNA

% 19.09.2024 I.A. 39810/2024 (Exemption from filing original copies of documents)

1. The present is an application under Section 151 of the Code of Civil Procedure, 1908 ("CPC"), on behalf of the plaintiff, seeking exemption from filing original/true typed and vernacular copy of the dim documents.

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

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

4. Accordingly, the present application is disposed of. I.A. 39811/2024 (Exemption from instituting Pre-Institution Mediation)

5. 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.

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6. 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.

7. Accordingly, the application stands disposed of. CS(COMM) 810/2024

8. Ms. Aarchana Sahadeva, learned counsel appearing for the plaintiff makes an oral request seeking exemption from serving advance notice to the defendant. She submits that urgent relief is being prayed for. Therefore, she may be granted exemption from serving the advance copy of the plaint, to the defendant.

9. Considering the submissions made before this Court, exemption is granted.

10. Accordingly, let the plaint be registered as suit.

11. Upon filing of the process fee, issue summons to the defendants by all permissible modes. Summons shall state that the written statement be filed by the defendants 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.

12. 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 plaintiff, an affidavit of admission/denial of documents of the defendant, be filed by the plaintiffs, without which, the This is a digitally signed order.

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13. List before the Joint Registrar (Judicial) for marking of exhibits, on 13th November, 2024.

14. List before the Court on 13th January, 2025.

I.A. 39809/2024 (Application under Order XXXIX Rules 1 & 2 read with Section 151 of CPC)

15. The present suit has been filed for permanent injunction restraining infringement/violation of rights of the plaintiff in the trademark OROFER/OROFER-XT, passing off of the trademark, trade dress/ packaging/ layout, viz. copyright infringement, unfair competition, misrepresentation, dilution, damages, rendition of accounts, etc. This is a digitally signed order.

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16. The present suit has been instituted seeking to restrain the defendant from continuing inter alia with acts of infringement of the plaintiff's registered trade mark 'OROFER', along with passing off its products, marketed under a nearly identical trade mark ORAFER-XT, as that of the plaintiff's

OROFER-XT, copyright infringement on account of adoption and using a nearly identical trade dress viz. as that of the plaintiff's OROFER-XT product sold under the trade dress, . Pertinently, both the products are used for identical purposes and cater to an identical class of customers. A comparison of the competing products is as under:

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17. It is submitted that, from the aforesaid comparative table, it is evident that with complete knowledge of the plaintiff's well-established product and its market reputation, the defendant has deliberately adopted a trade mark/ trade dress which is nearly identical to the plaintiff's trade mark/ trade dress, so as to pass-off its goods as those of the plaintiff. Further, the actions of the defendants also amount to infringing the plaintiff's registered trade mark OROFER and its copyright in its trade dress / label / packaging.

18. It is submitted that, the plaintiff's products, which are manufactured This is a digitally signed order.

The authenticity of the order can be re-verified from Delhi High Court Order Portal by scanning the QR code shown above. The Order is downloaded from the DHC Server on 21/09/2024 at 13:03:45 under the trade mark OROFER are Schedule H drugs, which are essentially prescribed by doctors, for treating Anemia, inter alia to women during their pregnancy. Thus, requisite licenses and permissions have been obtained by the plaintiff under the provisions of the Drugs and Cosmetics Act, 1940 for manufacturing and marketing the drugs in India. It is submitted that the plaintiff's products are not sold over-the-counter, but in fact can be prescribed only on a doctor's prescription. On the other hand, on perusal of the defendant's products under the impugned trademarks, it appears that the defendant has obtained permission under the provisions of the Foods Safety and Standards Act, 2006, which is inter alia applicable to 'food' and 'nutraceuticals'. It is submitted that the defendant's products are over-the- counter products, and can be dispensed without a doctor's prescription. Thus, on account of the defendant adopting an identical trade mark, coupled with identical trade dress, not only are the chances of confusion between the competing products heightened, there is a very real possibility of extreme harm and injury being caused to patient population, including, but not limited to pregnant women, who end up purchasing the defendant's nutraceuticals, instead of the plaintiff's drugs.

19. It is submitted that the plaintiff, honestly and bonafidely conceived and adopted the registered trade mark OROFER in the year 1996 which has been used extensively and continuously since then. Over the years, the Plaintiff went on to conceive and adopt numerous OROFER derivative trademarks, such as OROFER-EPO, OROFER-XT, OROFER FCM, OROFER-S, etc.

20. The plaintiff is also the registered proprietor of the trade mark OROFER and its variants as under:

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21. It is further submitted that OROFER-Xt, which was conceived and used by the plaintiff since 2004, is one of the most popular brands of the plaintiff, and has accrued widespread goodwill and reputation over the years. The said product of the plaintiff is marketed in the form of both tonic and tablets, in the following unique and extremely distinctive trade dress / label / packaging:

22. It is submitted that, the plaintiff conceived, designed and adopted a unique, distinctive and artistic trade dress/product, packaging, almost contemporaneous with the adoption of the trade mark OROFER-Xt, which is reproduced as under:

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23. It is submitted that, the plaintiff has obtained copyright registrations in its favour, with respect to multiple product packaging of OROFER and its variants, including, but not limited to the following trade dress:

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24. It is further submitted that representatives of the plaintiff came across the Defendant's products under the impugned trademark / trade dress only in August, 2024. A pictorial representation of the impugned product that the representatives of the plaintiff came across, is reproduced as under:

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25. It is submitted that further investigation conducted by the plaintiff about the impugned trademark / trade dress, revealed that no trade mark application has been filed by the defendants seeking registration of the impugned mark. Further, the plaintiff herein conducted a thorough search on the database maintained by IQVIA Consulting and Information Services India Private Limited (formerly IMS Health Information & Consulting Services India Private Limited), in order to ascertain the launch dates of the 'ORAFER-Xt' range of products using the impugned trademark/ trade dress.

26. It is submitted that on an enquiry raised by the plaintiff about the date of commencement of use of the impugned mark by the defendant, the plaintiff received an email intimating it that no products under the impugned mark, by the defendant have been captured in its database. It is submitted that IQVIA is an independent, third-party company, which inter alia maintains an independent brand and company wise database of drugs manufactured and marketed across the world. Thus, it is submitted that the defendant is a new entrant into the market.

27. It is submitted that, from a bare perusal of the competing products, it is amply evident that the defendants are attempting to systematically copy the plaintiff's trademark/ trade dress and various distinguishing features of the plaintiff's trade mark/ trade dress / product packs / labels. The comparison table, as given in plaint, is reproduced as under:

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28. It is submitted that from the aforesaid, it is clear that the actions of the defendants are blatantly dishonest and aimed at profiteering illegally from This is a digitally signed order.

The authenticity of the order can be re-verified from Delhi High Court Order Portal by scanning the QR code shown above. The Order is downloaded from the DHC Server on 21/09/2024 at 13:03:46 the plaintiff's hard-earned goodwill and reputation. It is further submitted that the differences in the competing trade mark and the products are so indiscernible, that the actions of the defendant are akin to counterfeiting, and thus puts in danger public health at large.

29. Thus, it is submitted that, the present is a fit case of triple identity inasmuch as:

a) Nearly identical trademark/ trade dress: OROFER/ OROFER-

Xt/

Xt/

b) Identical products: Pharmaceutical products in the form of iron tonic v. Nutraceutical products in the form of iron tonic.

c) Identical trade channels and identical class of consumers.

30. It is thus submitted that the conduct of the defendants, in addition to infringement of the plaintiff's registered trademark OROFER, amounts to passing off of the plaintiff's trademark/ trade dress, copyright infringement, misrepresentation and dilution, as well as unfair competition.

31. Learned counsel appearing for the plaintiff submits that the sales figures of the plaintiff for the year 2023-24 was to the tune of approximately 312 Crores. She further submits that the plaintiff had obtained drug license as early as in the year 1998.

32. Learned counsel appearing for the plaintiff has further drawn the This is a digitally signed order.

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33. She further draws the attention of this Court to the letter from IQVIA, an agency, which keeps the data base with respect to the various drugs which are manufactured and marketed in the country. The letter received from the said entity, is reproduced as under:

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34. By referring to the aforesaid letter, learned counsel appearing for the plaintiff submits that the defendant is a new entrant in the market, clearly establishing the prior of the mark by the plaintiff.

35. In the above said 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 plaintiff, and against the defendant.

36. Accordingly, till the next date of hearing, the defendant, its directors, executives, partners, proprietors, principal officers, assignees, retailers, distributors, wholesalers, family members and anyone acting for and on its behalf, are restrained from manufacturing and selling, distributing, offering for sale, advertising or promoting the impugned trademark/trade dress/label/package 'ORAFAER/ORAFAER-

XT/ ' or any other trademark/ trade dress/ label/packaging, which is either identical to or deceptively similar to the plaintiff's trademark/ trade dress 'OROFER/OROFER-

XT/ thereby, resulting in infringement/passing off of the registered trademark of the plaintiff, as well as plaintiff's copyrights in the artistic works in its trade dress/ label/ This is a digitally signed order.

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37. Issue notice to the defendants by all modes.

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

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

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

41. Re-notify on 13th January, 2025.

MINI PUSHKARNA, J SEPTEMBER 19, 2024/kr This is a digitally signed order.

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