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## Life threatening confusion - not a mere inconvenience

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Emcure Pharmaceuticals Ltd (Emcure) filed a suit for the infringement of their registered trademarks OROFER AND OROFER – XT against Corona Remedies Pvt Ltd. (Corona) at the Bombay High Court after the cease and desist notice did not result in settlement. Emcure alleged that its trademarks are being infringed by Corona's use of deceptively similar marks COROFER and COROFER – XT. The court after detailed hearing ruled in favour of Emcure and granted all prayers including directing Corona to handover all goods, packaging material etc bearing the marks COROFER and COROFER – XT for destruction.

### **Emcure's contentions:**

1. It has registered the word marks OROFER and OROFER – XT on October 30, 1996 in Class 5 in relation to pharmaceutical preparation for iron deficiency, anaemia, folic acid deficiency, zinc deficiency and so on and so forth.
2. Emcure claimed use of the mark since 1997 and sales in excess of Rs. 950 million between 1997 and 2012.
3. OROFER and OROFER – XT is frequently prescribed by orthopaedic surgeons and by gynaecologists to address folic acid and Vitamin B deficiency in pregnancy.
4. Emcure alleged that the product is widely exported to 34 countries and filed relevant documents in this regard including certified statement of sales and expenses, sample invoices and specimen advertising and promotional materials.
5. There is no structural, visual and phonetic dissimilarity between the rival marks and such similarity is bound to cause confusion and deception.
6. Both Emcure's and Corona's products use a similar ingredient, Ferrous Ascorbate. Both products are sold over the counter and can be ordered on the telephone.
7. No evidence of use claim since 2001 has been provided by Corona.
8. For acquiescence defence, Corona must show that Emcure had knowledge of Corona's use.

### **Corona's contentions:**

1. Corona's marks COROFER and COROFER – XT are not deceptively similar to those of Emcure and there are apparent and discernible differences.
2. Emcure's registrations were not cited as the conflicting marks during the application process and therefore, honesty in adoption and user cannot be questioned.
3. Corona claimed use since 2001 for COROFER and COROFER – XT.
4. COROFER and COROFER – XT are a combination of their corporate name and the first three letters of the word Ferrous (for iron), which is descriptive of the ingredients or purpose of the pharmaceutical preparation.

5. Emcure has acquiesced in Corona's use of the rival marks for over 5 years and therefore Emcure is now statutorily barred from claiming interim relief.
6. Corona has made considerable expenses in marketing, promotion and sales of COROFER and COROFER – XT therefore it too has acquired goodwill in the marks.

**The court framed the following issues to arrive at a decision:**

1. Are Corona's marks deceptively similar to those of Emcure's?

The court held where the entire mark is incorporated in the rival mark, deceptive similarity is established. The court further concluded there is no difference between Emcure and Corona's mark except the preceding letter C.

2. Is use of the term FER by many other marks determinative i.e. therefore its use by Corona does not lead to infringement of Emcure's marks?

The fact that there may be other marks with the term FER in them is inconsequential. Corona cannot claim lack of distinctiveness when they themselves have sought for registration of a mark with this very expression.

3. Would it be a valid defence if it is shown that Emcure is not the first user of OROFER mark?

Corona contended that one Advent Laboratories Patna was a prior user of OROFER mark from 1983 with the registration date September 24, 1985. However, Emcure denied this and claimed that the mark was filed on proposed to be used basis and there is no evidence of its actual use. The court refuted Corona's argument and held "that Section 28 (3) and Section 12 of the Act contemplate the co-existence of multiple simultaneous proprietors of a single mark. As between such registered proprietors inter se none has rights of exclusivity vis-a vis the other. But against any third party, each of them has the full panoply of rights".

4. Would it amount to acquiescence if it shown that Emcure had knowledge of Corona's use?

The court observed that the law is well settled in this regard that "mere failure to sue without a positive act of encouragement is no acquiescence. Acquiescence is not mere negligence or oversight.

The court opined in the present case, no details of use have been provided by Corona and thus no question of acquiescence arises as Emcure wouldn't have ever come to know. Moreover, Emcure had sent cease and desist letter including filing an opposition against Corona. Thus, court after citing several decisions held "even assuming that such adoption was honest, but the continued user of it (after cease and desist notices were being sent), if not dishonest, was at their own peril".

**Finally, the court granted injunction in favour of Emcure with the following observations:**

1. Emcure has made out a strong prima facie case. The structural similarity is far too close to be happenstance.
2. The court whilst citing Supreme Court decision in Cadila Health Care Ltd v Cadila Pharmaceutical Ltd held that there is an overarching public interest that requires a lower threshold of proof of confusing or deceptive similarity where the trademarks in question are applied to pharmaceutical products: “drugs are poisons, not sweets”. A life threatening confusion is not a mere inconvenience and here it’s not just balance of convenience between the two contestants, but convenience of public should be taken into consideration. If the injunction is not granted, it would lead to potential harm or injury to the public.

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