

IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on	Delivered on
18.10.2019	11.12.2019

CORAM:

THE HONOURABLE MR.JUSTICE **N. SATHISH KUMAR**

**A.Nos.5616, 5617, 5618 of 2016,
364 of 2018 and 5012 of 2019
in C.S.No.754 of 2012**

COMMON ORDER

Application Nos.5616, 5617 and 5618 of 2016 are filed to condone delay of 1297 days in filing the applications to set aside the exparte order dated 7.1.2013 in O.A.Nos.980, 981 and 982 of 2012 respectively in C.S.No.754 of 2012.

2. Application Nos.364 of 2018 and 5012 of 2019 are filed to vacate the exparte injunction order dated passed in O.A.982 of 2012 and O.A.980 of 2012 respectively in C.S.No.754 of 2012.

3. The above applications are filed mainly on the ground that notice has not been properly served as per the Civil Procedure Code.

Therefore, ex-parte order passed by this Court has to be vacated and the interim injunction applications to be heard afresh.

4. Since the learned Senior Counsel Mr.P.S.Raman has submitted that the injunction application itself can be disposed afresh, this Court is of the view that instead of going to the merits whether notice has been served or not, is inclined to hear the injunction application afresh. Accordingly exparte order passed by this Court is set aside and injunction application O.A.980 and 981 of 2012 heard fresh. Both counsels have advanced their arguments in the above applications.

O.A.No.980 and 981 of 2012 in C.S.No.754 of 2014

5. Suit in C.S.No.754 of 2014 and has been filed for infringement and passing off the plaintiff registered trade mark SGG and/or the Triangular Bridge Device filed as Complaint document. It is stated in the complaint that the 1st Plaintiff is the world leader in the habitat and construction markets, designing, manufacturing and distributing building materials, and providing innovative solutions to meet growing

demand in emerging economies. The Plaintiffs group is one of the top 100 industrial groups in the world. The Saint Gobain Group of which the Plaintiffs are a part, was established in the year 1665 and is a pioneer in the manufacture of glass, glasswares and mirrors under the name Saint-Gobain. The Saint Gobain had the privilege of supplying 357 mirrors for the Hall of Mirrors in the palace of Versailles in 1684. The First Plaintiff began exporting its products, in particular glass, to other countries in 1856, and established its first foreign plant in 1937. Second Plaintiff is a limited liability company. The Plaintiffs group operates in about 64 countries. They enjoy immense reputation and goodwill in India, and the general and trading public exclusively associate the mark "SGG" being the abbreviation of the Saint Gobain Glass, with the Plaintiff group.

6. Ever since the year 2000, the Plaintiff have been manufacturing and marketing amongst other products, various types of glass including flat glass, solar reflective glasses, mirror glass, magnetron coated glass etc., The Plaintiff have, from the inception,

used an artistic work as its corporate trade mark/logo, being an artistic representation of the name/trademark 'saint gobain' under a triangular device in a new, original and unique manner. The Second Plaintiff applied for and has obtained registrations in respect of goods contained in classes 19 and 20 and obtained the following registrations:

<i>S.No.</i>	<i>Appl.No.</i>	<i>Trademark</i>	<i>Class</i>
1	1132951	SGG	19
2	1132952	SAINT GOBAIN LOGO	20
3	1132953	SAINT GOBAIN	20
4	1132954	SGG	20
5	1132955	SAINT GOBAIN	19
6	1132956	SAINT GOBAIN LOGO	19

7. In march 2010, the Second Plaintiff learnt that the Defendant, a Chinese company, having no presence in India at all, has adopted an identical trade mark "SG" together with a triangle device in respect of goods that are same and/or similar to the goods of the plaintiff and had made an application under No.1753967 seeking registration of the trade mark on 14/11/2008. The trade mark of the Defendant is

reproduced herein below:-



8. The Plaintiffs filed their opposition, objecting to the registration. However, the Plaintiffs in the last week of October 2011, were served with the copies of the Defendant's invoices claiming to be evidence of use of the impugned mark in India. Hence the suit. In the above suit two applications were taken out. Application No.980 of 2012 restraining the Defendants from in any manner infringing the applicant's registered trade mark SGG by importing, selling , offering for sale, stocking, advertising either directly or indirectly glass products under the trademark "SG" and/or the triangular device or any other mark which is identical with or deceptively similar to the applicant's registered trademark SGG or the `Triangle Bridge Device` filed as Plaintiffs document No.2 and/or `SG Device` filed as Plainti document No.3.

9. In O.A.No.981 of 2012 also filed for interim injunction restraining the Respondent and their men claiming in any manner manufacturing, importing, selling, offering for sale, advertising either directly or indirectly any goods and in particular glass under the trademark "SG" and the triangular device or any other mark which identical with or deceptively similar to the applicant's trademark SGG and/or the `Triangular Bridge Device` filed as Plaint Document No.2 and 1`SG Device` filed as Plaint document No.3.

10. O.A.No.982 of 2012 filed to restrain the defendants from in any manner infringing the applicant's copyright in the 'Triangular Bridge Device' by using/reproducing the "SG" together with the triangular device or any other artistic work. The above applications were ordered on 07.01.2013 on the ground that there is no representation and the Defendants were not appeared despite service of notice. Thereafter, it appears that the Defendants had entered appearance 26.02.2016 and filed a written statement. Thereafter they have filed a O.S.A.as against the interim orders passed by this Court

earlier as stated above. O.S.A.Sr.No.17068,17074 and 17080 of 2016. The Division Bench dismiss the appeal on the ground that whether the appellants were served or not it is for the single judge to look into and it also observed that if it is found that there was no service on the appellant, the sequitur would be to recall the already existing injunction order, giving an opportunity to the appellant and in either eventually, the remedy of appeal would be available to the appellant. Thereafter these applications have been taken out. It is to be noted that the application filed to set aside the exparte order were filed on 26.08.2016 after four months after disposal of the O.S.A. Those applications were returned. The Defendants have not represented those applications immediately. The present application to vacate the injunction filed in June 2019. It is relevant to note that when the interim orders operating against the Defendants, the Defendants have applied for international registration in their favour on 20.04.2017. Admittedly, the Injunction was very much operative at the relevant point of time and they were also aware of the injunction was in force, they challenged the injunction in O.S.A.Nos.SR.17068, 17074 and

17080 of 2016. Even after the dismissal of the O.S.A., without pursuing the applications to vacate the exparte injunction they obtained international registration on 20.04.2017. These facts are relevant for other reasons also.

11. In 2008 itself the Defendant filed an Application No.1753967 seeking registration of the trademark "SG". However, their attempt was unsuccessful as the Plaintiff has filed opposition. That apart, similar application in USA also appears to be dismissed. Thereafter, when the interim order already operative against the Defendant, they have obtained other registrations on 20.04.2017.

12. It is the contention of the Defendants that the Plaintiffs were well aware of the Applicant's/Defendant's foreign registrations as well as use of the mark "SG" in numerous jurisdiction around the world including India and they suppressed the material facts pertaining to foreign registration and use of mark "SG" by the Defendant in India. It is their contention that the Defendant's company was established in

the year 1984. After 20 years of extensive growth in the glass and solar energy industry in China the Assets of the Company was more than RMB.10 Billian and with nearly 10,000 employees. The Applicant/Defendant is the registered proprietor of the mark "SG" in several jurisdictions around the world. They have honestly adopted the mark "SG" and that there are several other traders who have secured registration over SG comprising marks in Class 19 under No.1656865, 1262219 and 1235424. Therefore, the Plaintiff cannot claim monopoly over the letter SG. On account of difference in marks there is no likelihood of confusion or deception in course of trade. They have also stated that their business also existence in India. Their further contention is that the plaintiff did not produce the material documents pertaining to the opposition proceedings including documents, evidence in using foreign registration by the applicant mark within the knowledge of respondents when they deliberately did not place the same on record and concealed material facts from this Court. Despite the knowledge of the applicant's foreign registration and use of mark in India and abroad the Respondent deliberately concealed

the same before this Court. The Applicant applied for Registration of the mark "SG" having International Registration No.1363956 designating India in Class 19 in respect of goods namely "Architectural float glass; architectural solar glass with a low-iron coating; architectural photovoltaic glass; architectural ultra-white ultra-thin aluminum silicate glass; architectural insulating glass; architectural glass for thermal insulation; architectural enamelled glass; safety glass; architectural glass; glass construction material (not including sanitary equipment); architectural glass panel (window); non-metallic roof panels formed by solar cells; window glass (except for vehicle windows)." The said mark was published in the Indian Trade Mark Journal No.1847-0 dated 30-04-2018 and there was no objection raised by any third party including the Respondent. Hence their contention that where two persons are registered proprietors of trade marks, the exclusive right to the use of any of those marks shall not be deemed to have been acquired by any one of those persons as against any other of those persons. Hence as per Section 29 and 30 of the Act there cannot be any injunction.

13. Mr.P.S. Raman, learned Senior Counsel appearing for the plaintiff submitted that the First Plaintiff has established that they are pioneer in manufacture of glass. The plaintiffs business expanded and as on date has presence in over 45 countries. The trademarks "Saint-Gobain" and "SGG" has been used by the group since 1665. The triangular bridge device along with the name in bold used by plaintiff group.

The trademark SG triangular logo commenced usage.



However no document in support to use of trademark filed to show

that they are doing the business under the trademark in India. The invoices for alleged sale by the Defendant does not show the trademark. Whereas the Second Plaintiff, the Indian Subsidiary of the First Plaintiff established in the year 1997. The Trademark SGG used by Second Defendant in India on its invoices. The application by the Defendant in Application No.1753967 in respect of Class-19 goods. The Defendant claiming user as 'Proposed to be used'. Besides the Plaintiffs sales turnover was more than Rs.7,872 Crores. Second Plaintiff's advertisement expenses alone Rs.108 Crores. It is his further contention that on 02.07.2010 the Defendant's Trademark Application for registration of trademark "SG" rejected by US trademark registry for default and the Defendants filed an application under International Application for Registration of SG triangular Logo in respect of Class 19 goods claiming 'Proposed to be used, suppressing the pendency of TM NO.1753967 dated 17.11.2008. It is the contention of the learned senior counsel that the Trademark SGG used by the second plaintiff the word SG used by the defendant is certainly amounts to infringement. Any registration applied on

20.04.2017 is suppression of material facts particularly when the injunction is operating against the defendant. Same cannot be given any importance.

14. In support of his submissions he relied upon the following judgements:

1. *Madan & Co. V. Wazir Jaivir Chand*
[(1989) 1 SCC 264]

2. *Cadila Health Care Ltd., vs. Cadila Pharmaceuticals Ltd., [(2001) 5 SCC 73]*

3. *B.K. Engineers vs. Ubhi Enterprises B.K. vs. B.K.[1985 (5) PTC 1]*

4. *Aktiebolaget SKF v. Rajesh Engineering Corp.(Delhi)- SKI vs.SKF [1996 (16) PTC 160]*

5. *S.Mehar Singh v. M.L.Gupta (Delhi)- MLI vs. ML [1997 (17) PTC 660]*

6. *Hindustan Petroleum v. H.P.Oil*

*Corporation (Bombay) – HP [2004 (28)
PTC 362]*

7. *Mahindra & Mahindra v. MNM Marketing
- M & M v. MNM [2014 SCC Online Bom
1343]*

8. *Financial Software and Systems vs.
Flextronic Software – FSS [2006 (33)
PTC 687]*

9. *VIT University vs. Bagaria Education Trust
and others [O.A.Nos.640, 576 and 577
of 2012 in C.S.No.476 of 2012 dated
01.06.2015 Madras High Court]*

15. It is the contention of the learned counsel for the Defendants the SG word mark not a triangular and Defendants also in the market in various countries under the trademark. The Defendants obtained various registration in foreign jurisdictions besides they have also obtained international registration in India. Therefore, there cannot be any injunction against the defendants under the Trademarks Act. Even invoices of the defendants the word SGG is not there. No similarity in

the mark and there is no deception or confusion. Further the Defendants invoices filed clearly indicate that they are selling the product under the trademark SG from the very inception as per Section 17(2) also attracts in this case. Hence it is his contention that there cannot be any injunction against the defendants/applicants.

16. In support of his contention he relied upon the following judgments:

1. *Bharat N. Parikh and Ors. v. Ashok Tripathy Trading as Ashlok* [**2003 (33) PTC 587 (Mad)**]
2. *V.V.V. & Sons Edible Oils Ltd., Vs. Anjaneya Detergent and Ors.* [**2019 (78) PTC 240 (Mad)**]
3. *S.Syed Mohideen vs. P.Sulochana Bai* [**2016 (66) PTC1(SC)**]
4. *F.Hoffmann-La Roche & Co. Ltd., vs. Geoffrey Manners & Co.Pvt. Ltd.,* [**1970 AIR 2062**]

5. *Rhizome Distilleries Pvt.Ltd., vs. Union of India* [**2012(50)PTC1 (Mad)**]

6. *The Registrar of Trade Marks vs. Ashok Chandras Rakhit Ltd.*, [**AIR 1955 SC 558**]

7. *Cadila Health car Ltd., vs. Cadila Pharmaceuticals Ltd.*, [**AIR 2001 SC 1952**]

8. *Amirtdhara Pharmacy vs. Satyadeo Gupta* [**AIR 1963 SC 449**]

9. *Corn Productgs Refining Co. vs. Shangrila Food Products Limited* [**AIR 1960 SC 142**]

10. *Apex Laboratories Ltd., vs. Zuventus Health Care Ltd.*, [**(2007) 1 MLJ 657**]

11. *Indo-Pharma Pharmaceutical Works Ltd., vs. Citadel Fine Pharmaceuticals Ltd.*, [**AIR 1998 Mad 347**]

*12. Unimed Technologies Ltd., and Ors. vs.
EyekareKilitch Ltd., and Ors. [2013 (54)
PTC 394 (Mad)]*

17. The main contention of the plaintiff is that the trademark artistic work used by the applicant in respect of their goods and business and the public have long associated the Plaintiffs said trademarks/ artistic works. They employ the device of a triangle along with its trade mark "Saint-Gobain" and the said device forms an integral part of the Plaintiffs' trademark. The trade mark "Saint-Gobain", the trademark / artistic works 'Triangular Bridge Device; the trade mark "SGG" and the 'SG Device' are collectively referred to as the 'Plaintiffs trade marks'. It is not in dispute that the Plaintiff have obtained the registration of trademark SGG on 12.09.2002 in application No.1132951 from the date of user 01.01.2000 and also the device and on 12.09.2002 Application No.1132952 from 01.01.2000 for Saint-Gobain and SGG logo as stated in the plaint. The main contention of the Defendant is that they are using the trade mark SG and selling the goods. It is also not disputed that the Defendant has made a Trade Mark application in respect of the Class 19 goods on

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14.11.2018 which was opposed by the Plaintiff wherein the defendants name user as 'Proposed to be used'. Similarly the applications filed for registration in USA for the same trade mark for obtaining the trademark SG the triangular device rejected by US trademark registry. These facts are not in dispute. The main contention of the defendants is that they have been selling the product "SG" and invoices filed in the typedset clearly proved the same. I have perused the invoices. Though the invoices filed by the Defendants contained the device SG. The all invoices issued outside the country, no way relate to India. Therefore, the invoices relied upon by the Defendants to contend that they are also marketing the similar product under the trade mark SG in India cannot be countenanced.

18. Admittedly, the trademark applications filed in the year 2018 they claiming user as 'Proposed to be used'. The above statement in the application clearly indicate that the defendants has not yet started their business in the trademark SG. Whereas they claim used as 'Proposed to be used'. Therefore, any invoices issued various other

countries, the same cannot be pressed into service that in the Indian Market also using the invoices in similar mark. It is to be noted that the plaintiff has obtained the mark SG and Saint Gobain and SG Logo as stated in the plaint. It is not in dispute. The application filed as early as 2018 by the defendants which was opposed by the Plaintiff. As narrated above interim orders were operating against them from the very beginning. Even after the O.As were disposed on 26.4.2016 they have not come before this Court immediately to vacate the order of injunction. After failing their attempt to get a registration in USA and India in the year 2018, during the pendency of the suit, they obtained international registration certificate on 20.04.2017 for the mark SG. Above registration was obtained by suppression of the material facts, the pendency of the earlier application filed in the year 2008. Therefore, though under Section 28(3) of the Act comes to the aid of the persons who have also registered proprietors of trade mark which are nearly resemble each other and no one exclusive right to use any of those trade mark, the fact remains in this case is that the subsequent registration is obtained particularly when the injunction is

already operating against the defendants, that apart by suppression of earlier application. Therefore mere subsequent registration will not enure any benefits to the defendants at this stage. Whether such registration obtained during the pendency of the suit is valid or not can be gone only at the stage of the trial and not at this stage.

19. In the judgment reported in ***Cadila Health Care Ltd., case*** (supra) in para 35 the Honurable Supreme Court has held as follows:

"35. Broadly stated in an action for passing off on the basis of unregistered trade mark generally for deciding the question of deceptive similarity the following factors to be considered:

a) The nature of the marks i.e. whether the marks are word marks or label marks or composite marks, i.e. both words and label works.

b) The degree of resemblance between the marks, phonetically similar and hence similar in idea.

c) The nature of the goods in respect of which they are used as trade marks.

d) The similarity in the nature, character and performance of the goods of the rival traders.

e) The class of purchasers who are likely to buy the goods bearing the marks they require, on their education and intelligence and a degree of care they are likely to exercise in purchasing and/or using the goods.

f) The mode of purchasing the goods or placing orders for the goods and

g) Any other surrounding circumstances which may be relevant in the extent of dissimilarity between the competing marks."

20. Admittedly both are doing the same business and the trademark SGG is of the Plaintiff is and the trademark SG adopted by the defendant not only phonetic similar there are difference between the marks. The goods also similar in characters

21. In the judgment of the Delhi High Court in **B.K. Engineers case** (supra) the Delhi High Court has held that use of trademark

"B.K.-81" as against the plaintiff's house mark/trade name "B.K." the
plaint would have deception thereby protect the mark of the plaintiff.

22. In **Aktiebolaget SKF's case** (supra) it is also held that the
trademark of the defendant appears to be colourable imitation of the
registered trade mark the adoption of the trade mark is dishonest.

23. In **Hindustan Petroleum Corporation Limited case**
(supra)Bombay High Court has held that adopting abbreviation of its
corporate name as trademark adopting the letters HP by the defendant
amounts to infringement. In this case also identity and similarity of
the impugned mark and similarity of the goods covered by the marks
have been clearly established by the Plaintiff.

24. In **Mahendra and Mahendra Limited and another's case**
(supra) the Bombay High Court held that the abbreviation of the word
Mahendra & Mahendra and "M & M"(word per se and label) to be
protected.

25. In ***Financial Software and Systems Pvt. Ltd., case*** (supra) this Court has held that the Plaintiff using the mark FSS the adoption of similar mark by defendant amounts to infringement.

26. In ***VIT University case*** (supra) this Court has also upheld to protect the mark VIT the abbreviation form of the educational institutions as against the defendant who have also adopted the similar trademark in the abbreviation form of the Vivekananda Institution of Technology.

27. No doubt the Respondent relied upon the judgement of ***Bharat N. Parikh and others case*** (supra) wherein this Court has held that when two or more persons are registered proprietors of trade mark, which are identical with or nearly resemble each other, the exclusive right to use of any of those marks shall not be deemed to have been acquired by any one of those persons as against any other of those persons. Further, as per Section 30 of the Trademarks Act no suit for infringement of registered trademark is maintainable against

the registered trademark owner.

28. Similarly, the other judgment relied on by the Applicant/Defendant in **V.V.V. & Sons Edible Oils Ltd., case** (supra) this Court has held as follows:

"16. In the light of the aforesaid provision i.e., Section 28 of TM Act read in the context of the narrative supra, which inter-alia captures the trajectory of this lis thus far, it is clear that the plaintiff has no real prospect of succeeding on the claim and there is no other compelling reason as to why a summary judgment should not be passed.

17. Under the aforesaid circumstances, Mr.M.Musthafa Khan, learned counsel drawing my attention to the obtaining position that though a suit for infringement of suit TMs is hit by Section 28 of TM Act, it is open to the plaintiffs to file a suit for passing off, which is a common law remedy. To be noted, suit seeking relief of injunction of registered TMs/suit TMs are those claiming statutory reliefs under TM Act and suit complaining of passing off are those claiming common law remedies."

29. The Honourable Supreme Court in **S.Syed Mohideen's case** (supra) has held that when there are two registered owners exclusive

right to use trademark shall not be deemed to have been acquired by one registrant as against the other registered owner of the trade mark.

30. In ***F.Hoffmann-La Roche & Co. Ltd., case*** (Supra) the Apex Court has held that the marks must be compared as a whole, the true test being whether the totality of the proposed trademark is such that it is likely to cause deception or confusion or mistake in the minds of persons accustomed to the existing trade mark. Microscopic examination not called for. Both visual and phonetic tests must be applied.

31. In ***Rhizome Distilleries Pvt. Ltd., Case*** (supra) this Court has held that the conflicting composition marks must be compared in their entireties.

32. In the ***Registrar of Trade Marks case*** (supra) the Honourable Apex Court has held that where a distinctive label is registered as a whole, such registration cannot possibly give any

exclusive statutory right to the proprietor of the trade mark to the use of any particular word or name contained therein.

33. In ***Cadila Health Care Ltd., case*** (supra) the Honourable Apex Court has held that where common marks are included in the rival trade marks, more regard is to be paid to the parts not common and the proper course is to look at the marks as a whole, but at the same time not to disregard the parts which are common.

34. There is no doubt in the propositions laid in the judgement cited by the learned counsel appearing for the applicants/defendants. The fact remains that though the defendant has stated to be marketed the same product in the trade mark industry and foreign territory, in India he did not have valid trade mark at the relevant point of time when the suit was filed. In the year 2008 itself this application was opposed they claimed to be the user as 'proposed to be used'. Invoices relied upon by the defendants nothing to do with the Indian Market. The international registration has applied only during the

pendency of this suit that too when the injunction is in operative against them, that too by suppressing the material facts viz., the earlier pending applications filed in the year 2008. Therefore, the conduct prima facie indicate that their adoption noting but dishonest. The Registration is also rejected in USA. The Plaintiff has got registered trade mark for the mark SGG and Saint Gobain Glass device, SGG Logo and Saint Gobain glass as stated in the plaint. The mark SGG and the different mark SG not only phonetically similar but also visually similar in respect of the same goods and the Plaintiff has obtained registration in the year 2000 itself. When the plaintiff has registration in their name, it is a prima facie evidence for them. Though the registration obtained by the defendant in the year 2017 as stated above the registration has been obtained when the injunction was operating against them besides suppressing the vital information about the pending application filed by the defendant. Such being the position, the Defendants cannot now take shelter under Section 28(3) of the Act, whether such registration is valid or invalid cannot be gone at this stage. On prima facie it established that the conduct of the Defendants

is dishonest not only in obtaining the registration suppressing the fact of pending application but also violating orders of the Court.

35. Having filed the written statement in the year 2016, despite the fact that the Division Bench has granted liberty to move a single judge in the year 2016 itself, having filed an application to set aside the exparte order in the year 2016 and not pursued the same. only after obtaining the alleged registration in the year 2017 now the application has been filed in the year 2019 to vacate the order of injunction. The above conduct also clearly indicate that the Defendant cannot claim any right and the registered mark is in favour of the Plaintiff. Such marks are necessarily be protected. Considering the entire aspect this Court is of the view that Plaintiff has made a prima facie case and the balance of convenience in his favour. If the Order of Injunctions is not granted, it will lead to irreparable injury to the Plaintiff. Accordingly, this Court grants the injunction in favour of plaintiff. Accordingly, all the above applications are ordered.

36. In the result, Application Nos.5616, 5617 and 5618 of 2016 are ordered. Application Nos.364 of 2018 and 5012 of 2019 in C.S.No.754 of 2012 are dismissed. The applications for injunctions in O.A.980, 981 and 982 of 2012 in C.S.No.754 of 2012 are allowed.

11.12.2019

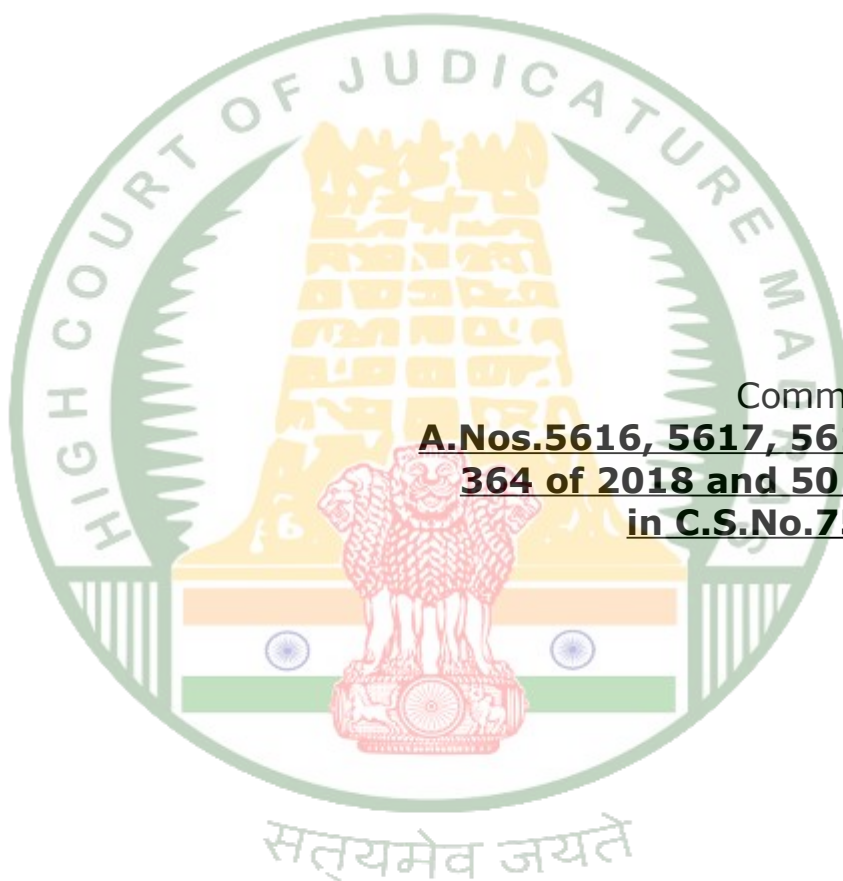
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