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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 25.08.2021

CORAM :

THE HON'BLE MR.SANJIB BANERJEE, CHIEF JUSTICE

AND

THE HON'BLE MR.JUSTICE P.D.AUDIKESSAVALU

O.S.A.(CAD) Nos.59, 61 and 62 of 2021
and C.M.P.Nos.13277, 13279, 13290, 13221 and 13291 of 2021

CSG Holding Company Ltd.,
CSG Building,
No.1, 6th Industrial Road,
Shekou Shenzhen, P.R.China 518067
rep. By its Power Agent, Pradeep Yadav.

...Appellant in
all appeals

Vs

1. Saint-Gobain Glass France
A French Societe Anonyme (SA)
Les Miroirs, 18, Avenue d Alsace,
92400, Courbevoie France,
rep. By power Agent, T.Bhaskaran.

2. M/s.Saint Gobain Glass India Ltd.,
Level 7, Sigapi Achi Building,
18/3, Rukmoni Lakshmipathy Road,
Egmore, Chennai 600 008.

...Respondents in
all appeals

Appeals filed against the common order dated 11.12.2019 in
A.No.5012 of 2019, O.A.No.982 of 2012 and O.A.No.981 of 2012 in
C.S.No.754 of 2012 on the file of original side of this court.

For the Appellant : Mr.Arun C.Mohan

For the Respondents/
Caveators : Mr.P.S.Raman,
Senior Counsel,
for M/s.Madan Babu.



COMMON JUDGMENT

(Delivered by the Hon'ble Chief Justice)

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The appeals by the defendant arise out of a common judgment and order of December 11, 2019 passed in a suit for infringement and passing-off involving the mark "SGG" and a triangular device used by the plaintiffs in connection with their sale of glass and glass products.

2. The defendant claims that the SGG mark that it uses as a part of its trade mark emanates from the name of the defendant and is registered in several countries. The defendant complains that an ex parte injunction obtained by the plaintiffs has, in effect, been continued by the judgment and order impugned by failing to take into account relevant considerations, particularly the fact that the letters used as a part of the defendant's mark are not used in connection with the plaintiffs' product.

3. The impugned judgment has narrated the facts, including the Saint Gobain Group being established in the year 1665 and being a pioneer in the manufacture of glass, glassware and mirrors under the broader name "Saint-Gobain". The history of the plaintiffs has been recorded that they supplied 357 mirrors for the Hall of Mirrors in the Palais de Versailles in 1684. The plaintiffs apparently began exporting their products outside France in 1856 and established a foreign plant in the year 1937. The plaintiffs and their associate concerns apparently operate in 64 countries and the plaintiffs and their products enjoy considerable reputation and goodwill in this country and the trading and general public associate the mark "SGG" with Saint Gobain glass.

4. The impugned judgment refers to the registration of the word marks SGG and Saint Gobain in several classes and the Saint Gobain logo with the triangular device. Apparently, the plaintiffs came to be aware of the defendant Chinese company and its use of the mark "SG" with a triangle device which was deceptively similar to the plaintiffs' mark. The Chinese company's attempt at registration in this country was objected to by the plaintiffs. The relevant application is pending along with the plaintiffs' objection thereto. It appears that, quite needlessly, in addition to the infringement and passing-off action, a case of breach of copyright was also attempted to be made out by the plaintiffs.

5. There is much confusion in such regard. Once a particular graphical representation is a part of a logo or a



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device or is used as a part of a trade mark, an action for infringement or passing-off, as the case may be would suffice and an attendant copyright claim may be completely unnecessary. However, such aspect of the matter has to be left to the trial of the suit.

6. The trial court has referred to several of the leading judgments in the field, including the judgments reported at (1989) 1 SCC 264 (Madan & Co. vs. Wazir Jaivir Chand); (2001) 5 SCC 73 (Cadila Health Care Ltd vs. Cadila Pharmaceuticals Ltd); and 1985 (5) PTC 1 (Del) (B.K.Engineering Co. vs. Ubhi Enterprises), to ultimately reach the conclusion that a prima facie case had been made out. Several provisions of the governing statute were also noticed, including the rival contentions as to whether the marks in the form asserted had been used in connection with any product or had been used only in trade correspondence.

7. Upon referring to the various judgments, particularly the one in Cadila, the trial court rendered the view 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 measure is to look at the marks as a whole, but at the same time not to disregard the parts which are common". The trial court also referred to word marks that, when said out aloud, are phonetically similar and found in the present case that the marks were both phonetically and visually similar.

8. Considering the business, reputation and history of the plaintiffs and their worldwide reputation, including in this country, an injunction was granted.

9. There does not appear to be any infirmity in the judgment and order impugned. Relevant considerations appear to have been taken into account after narrating the rival contentions. There is no doubt that there is an element of discretion at large and such discretion has not been exercised in a perverse manner warranting interference at the appellate stage. In any event, the injunction has continued for a considerable period of time and it is best that the parties make every endeavour to ensure that the trial is concluded as expeditiously as possible.

10. The judgment and order impugned dated December 11, 2019 do not call for any interference. However, the defendant will be entitled to canvass all grounds available in course of the trial, irrespective of the prima facie expression of any view on any aspect by the trial court in the judgment and order impugned herein.



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11. O.S.A. (CAD) Nos.59, 61 and 62 of 2021 are disposed of. C.M.P.Nos.13277, 13279, 13290, 13321 and 13291 of 2021 are closed. There will be no order as to costs.

Sd/-
Deputy Registrar (CS)

//True Copy//

Sub Assistant Registrar

sra

To:

The Sub Assistant Registrar,
Original Side,
High Court, Madras.

+1 CC to M/s.Arun.C.Mohan, Advocate, Sr.No. 42810.

O.S.A. (CAD) Nos.59, 61
and 62 of 2021

RLS (CO)
LS (07/09/2021)