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(T)OP(TM)/400/2023

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 22.11.2023

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THE HONOURABLE MR.JUSTICE SENTHILKUMAR RAMAMOORTHY

(T)OP(TM)/400/2023
(ORA/1/2021/TM/CHN)

1.Legrand France,
128, Avenue Du Marechal,
De Lattre - De - Tassigny,
87000 Limoges, France,
Represented by its Constituted Attorney,
Mrs.Ranjeet Kaur.

2. Novateur Electrical and Digital Systems Pvt Ltd,
183, 10th floor, Prestige Center Court-Office Block,
Vijaya Forum Mall, Nsk Salai, Vadapalani,
Chennai 600 026, rep by its Company Secretary.

... Petitioners

-vs-

1.Praveen Kumar Jain
Trading as Biocon Tapes India,
No.234, 2nd floor,
Above Hotel Vijay Vihar,
Garudachar complex,
Chickpet, Bangalore - 560 053.

2.The Registrar of Trademarks,
Office of the Trade Marks Registry,
Chennai 600 032.

... Respondents



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PRAYER: Transfer Original Petition (Trade Marks) filed under Section 57 of the Trade Marks Act, 1999, praying to exercise its discretion in favour of the applicants and against the respondents, remove/expunge/rectify/cancel the entry relating to trademark “LEGRAND” under registration No.2392074 in Class 17 by the respondents herein.

For Petitioners : Mr.Arun C.Mohan

For R1 : No appearance

For R2 : Mr.M.Karthikeyan, SPC

ORDER

The petitioners have applied for rectification of the Register of Trade Marks by removing the entry relating to the trade mark 'LEGRAND' under Trade Mark No.2392074 in Class 17.

2. Upon being permitted to serve notice privately on the 1st respondent, the petitioners placed on record an affidavit of service. The track consignment report annexed thereto evidences service of notice on the 1st respondent on 24.06.2023. Therefore, the Registry



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was directed to print the name of the 1st respondent in the cause list for the hearing on 24.07.2023. In spite of service of notice and the name of the 1st respondent being printed in the cause list, there was no representation for the 1st respondent at the hearing on 24.07.2023 or on subsequent hearings. By order dated 23.08.2023, learned counsel for the petitioners was permitted to serve notice on learned counsel/agent who acted for the 1st respondent in proceedings before the Trade Marks Registry. An affidavit of service was filed by the petitioners and the track consignment report annexed thereto indicated that notice was served on learned counsel/agent for the 1st respondent on 16.10.2023. In spite of service on learned counsel/agent for the 1st respondent also, the 1st respondent continues to remain unrepresented. The matter is proceeded with in the absence of the 1st respondent in the said facts and circumstances.

3. Learned counsel for the petitioners submitted that the 1st petitioner operates on a global scale with facilities in nearly 90 countries. The predecessor-in-interest of the 1st petitioner commenced



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business in the year 1904 and adopted the trade mark 'LEGRAND'.

The said trade mark was used in India since 1970. Learned counsel invited my attention to the certificate of registration obtained by the 1st petitioner in Class 9 in relation to various electrical equipments and accessories. Such registration has been obtained on 27.10.1986. Learned counsel also referred to subsequent registrations obtained in various classes for word and device marks containing the word 'LEGRAND'. Learned counsel next referred to invoices for the sale of products bearing the trade mark 'LEGRAND' and to the certificate dated 07.06.2016 of Daver Sikri & Co., Chartered Accountants, providing the turnover of the 'LEGRAND' division of the 2nd petitioner from the financial year 2011 - 2012 to the financial year 2015 - 2016.

4. As regards the 1st respondent, learned counsel submitted that the 1st respondent dishonestly adopted the identical trade mark 'LEGRAND' for products in Class 17 such as adhesive tapes, PVC



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insulating tapes, duct tapes, and the like. He also pointed out that such registration was obtained with effect from 07.09.2012 by asserting use from 14.07.2012. Since adhesive tapes and duct tapes are allied/cognate goods, learned counsel submitted that the registration of the 1st respondent's trade mark is likely to lead to confusion among the public and that the register is liable to be rectified.

5. The petitioners pleaded that the trade mark 'LEGRAND' was adopted by the 1st petitioner's predecessor in the year 1904 in France. As regards use in India, it is pleaded that the mark has been used in India since 1970. The invoices placed on record by the petitioners provide evidence of use from the year 2013. The sales figures of the 2nd petitioner are set out in the petition at paragraph 9(f) and the promotional expenses at paragraph 9(g). In support thereof, the certificates issued by the Chartered Accountants have been placed on record at pages 63 and 64 of the paper book.



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6. The registration certificates obtained by the petitioners have also been placed on record. The earliest of these certificates was issued on 27.10.1986.

7. The petitioners apply the trade mark 'LEGRAND' in relation to electrical goods such as switches, electrical instruments, accessories and the like. It should be recognised that the trade mark is an invented word, which qualifies as an arbitrary mark with reference to the goods in relation to which it is applied. The petitioners undoubtedly adopted the mark much prior to the 1st respondent and obtained registrations from 1986 onwards. As stated earlier, there is evidence of use at least from 2013 in India.

8. The trade mark application of the 1st respondent discloses that registration was applied for on 07.09.2012 by asserting use from 14.07.2012. The registration has been obtained in respect of adhesive tapes, PVC insulating tapes, duct tapes and the like. These goods are not identical to the goods in respect of which the petitioners' mark is



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applied. The question that arises is whether the goods to which the 1st respondent applies the trade mark can be construed as similar goods.

In order to determine whether goods are similar, one of the material considerations is whether there is complementarity between the goods. If the use of the goods to which the impugned mark is applied is necessary or important for the use of the goods to which the earlier mark is applied or vice versa, the goods may be construed as complementary. In this case, the petitioners have applied the mark in relation to switches and other electrical products. Adhesive tapes, PVC insulating tapes, duct tapes and the like are often required to be used in relation to the use of the petitioners' goods. It is also likely that the channels of distribution will overlap. Therefore, the goods of the 1st respondent may be considered as similar to the goods of the petitioners.

9. Under Section 11(1) of the Trade Marks Act, 1999, the registered proprietor of an earlier mark is entitled to oppose the registration of the later mark if the marks are identical or similar and



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are applied in respect of identical or similar goods. The 1st respondent's mark, in this case, is identical to the petitioners' trade mark, which, significantly is an invented and arbitrary trade mark. Therefore, the entry relating to the 1st respondent's trade mark was made without sufficient cause.

10. For reasons set out above, (T)OP(TM)/400/2023 is allowed by directing the Registrar of Trade Marks to cancel the certificate of registration relating to the trade mark 'LEGRAND', which was registered under Trade Mark No.2392074 in Class 17 and to remove the entry relating thereto from the Register of Trade Marks. These actions shall be completed within a period of four weeks from the date of receipt of a copy of this order. There shall be no order as to costs.

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Index : Yes / No
Internet : Yes / No
Neutral Citation: Yes / No



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