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IN THE HIGH COURT OF JUDICATURE AT MADRAS

Order reserved on	27.08.2024
Order pronounced on	21.12.2024

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THE HONOURABLE MR.JUSTICE SENTHILKUMAR RAMAMOORTHY

(T)OP(TM)/404/2023
(ORA/5/2021/TM/CH(TN))

Saint Gobain Construction Products UK Ltd.
 Saint-Gobain House, Binley Business Park,
 Coventry CV3 2TT, United Kingdom

... Petitioner

-vs-

1. Mr.Tallam Uma Shankar Gupta
 Flat No.502, Satya Sai Towers,
 Nagarapalem, Guntur,
 Andhra Pradesh-522 002.

2. The Deputy Registrar of Trade Marks
 Trade Marks Registry,
 Boudhik Sampada Bhawan,
 G.S.T.Road, Guindy, Chennai-600 032.

... Respondents

PRAYER: Transfer Original Petition (Trademarks) filed under
 Section 57 of the Trade Marks Act, 1999, praying to expunge the
 registration of the impugned mark GYPLOCK bearing registration
 No.3536418 by its removal from the Trade Marks Register.



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For Petitioner : Mr.Abishek Jenasen
Ms.Aparajitha Vishwanath

For Respondents : Mr.S.P.Chockalingam for R1
Mr.Rajesh Vivekanandan,
Deputy Solicitor General for R2

ORDER

By this petition, the petitioner seeks rectification of the Register of Trade Marks by removing the entry relating to the impugned mark “GYPLOCK” bearing registration No.3536418 from such register.

2. The petitioner avers that it is a part of the Saint-Gobain Group, which is engaged in the design, manufacture and distribution of building materials. The petitioner further avers that its subsidiary, Saint-Gobain India Private Limited, entered the Indian market in the year 1996. According to the petitioner, the trademark 'GYPROC' was conceived and adopted by its predecessor more than 100 years ago. The petitioner asserts that the trademark 'GYPROC' was first registered in Canada with effect from 03.08.1921. In India, it is stated



that the trade mark had been used since 2002 in relation to building materials. It is also stated that the trade mark was registered with effect from 21.11.2006 and that such registrations are in force in classes 6, 17, 19, 37 and 39.

3. Learned counsel for the petitioner, Mr. Abishek Jenasenan, referred to the above mentioned registrations and pointed out that the petitioner has registered its trade mark in multiple countries across the world. He also submitted that the petitioner has a very large sales turnover in several countries. He also adverted to the enormous advertising expenditure incurred by the petitioner and its group entities and to the annual sales turnover from the sale of goods bearing the trade mark GYPROC in India. In particular, he submitted that the sales turnover in India for the year 2018 was Rs.7,148 crores.

4. As regards the first respondent, learned counsel submitted that the first respondent uses the impugned trade mark GYPLOCK in



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relation to natural gypsum raw materials, gypsum plaster, unplasters, gypsum stucco, gypsum - agri gypsum, paper faced gypsum board, paper faced glass reinforced gypsum board and the like, which are identical or substantially similar to the goods in respect of which the petitioner's mark is used. Learned counsel further submitted that the impugned mark is phonetically, visually and structurally similar to the petitioner's earlier trademark 'GYPROC'. Therefore, learned counsel contended that the impugned mark is liable to be removed from the register so as to protect the general public from the likelihood of confusion or deception and to maintain the purity of the register.

5. Mr.Chockalingam, learned counsel, made submissions in response. The first contention of Mr.Chockalingam was that a stand-alone petition for rectification can only be filed before the Registrar of Trade Marks. According to learned counsel, a rectification petition can be filed before this Court only if a connected action for



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infringement is pending before this Court. Learned counsel referred to and relied upon paragraphs 27 to 30 of the judgment of the Hon'ble Supreme Court in *Patel Field Marshal Agencies v. P.M.Diesels Limited*, *Manu/SC/1509/2017 (Patel Field Marshal)*, in support of this proposition. He also relied upon the judgment of the Hon'ble Supreme Court in *Jagatjit Industries Ltd. v. The Intellectual Property Appellate Board and Others*, *Manu/SC/0056/2016*, particularly paragraph 29 thereof, to reinforce the contention that a stand-alone petition for rectification does not lie before the High Court.

6. The next contention of Mr.Chockalingam was that the petitioner has failed to establish that there was a contravention or failure to observe a condition entered on the register in relation to Trademark No.3536418. Therefore, he contended that sub-section (1) of Section 57 of the Trade Marks Act, 1999 (the Trade Marks Act) does not apply. As regards the applicability of sub-section (2) of Section 57, learned counsel contended that 'GYP' is common to the



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trade inasmuch as the letters 'GYP' are derived from the word 'GYPSUM'. In order to substantiate this contention, learned counsel submitted that many marks with the prefix 'GYP' were accepted and advertised by the Registrar of Trade Marks.

7. By further submitting that the respondent's trade mark is a label mark, learned counsel contended that the said trade mark 'GYPLOCK INDIA'S CEIL', when viewed as a whole, is not likely to cause confusion or deception among the public. As regards the sales and advertisement figures of the petitioner, learned counsel contended that there is no evidence that such sales and advertising figures relate exclusively to the sale of products bearing the trademark "GYPROC". By referring to the recent judgment of this Court in *Sanofi-Aventis Deutschland GmbH v. Jagdale Industries Private Limited*, MANU/TN/3708/2024 (*Sanofi-Aventis*), learned counsel submitted that this Court concluded that confusion would not be caused by allowing the first respondent's registered trade mark



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CALDALE to remain on the register after noticing that the appellant's mark, CARDACE, was derived from the word 'cardiac' and the first respondent's mark "CALDALE" was derived from the word 'calcium'. Similarly, learned counsel contended that, other than 'GYP', which is common to the trade, ROC and LOCK are dissimilar.

8. After pointing out that the registered proprietor of the trademark 'GYPROC' is BBP United Kingdom Limited and not the petitioner, learned counsel also pointed out that the invoices on record are in the name of Saint Gobain India Private Limited or Saint Gobain Gyproc India Limited and not in the name of the petitioner. After further submitting that the petitioner has not shown a single instance of actual confusion or deception, learned counsel concluded his submissions by stating that the petition is liable to be rejected.

9. By way of rejoinder, Mr. Abishek Jenasenan submitted that *Patel Field Marshal* is irrelevant because the said judgment deals with



a situation where a rectification petition was filed after a civil suit was instituted. Since no civil suit is pending with regard to the impugned trade mark, he submitted that the said judgment has no relevance.

10. As regards the reliance on a search report to establish that other marks with the prefix 'GYP' are available, he contended that proof of use of such marks should be placed on record and that the search report is insufficient because it does not establish that products bearing said marks are available in the market. In this regard, learned counsel relied upon the judgment of the Delhi High Court in *Novartis AG v. Crest Pharma Pvt. Ltd.*, 2009 SCC OnLine Delhi 4390, particularly paragraphs 31 and 32 thereof, wherein the Delhi High Court held that mere filing of the search report from the Trade Marks office does not prove that the marks mentioned in the search report are actually used. As regards the judgment in *Senofi-Aventis*, learned counsel submitted that the judgment is distinguishable



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because this Court held that the two marks are not deceptively similar after noticing that CARDACE is a schedule 'H' drug whereas CALDALE is a calcium supplement.

10. With regard to the contention that the registration is in the name of the BPB United Kingdom Limited, by relying on the document at page 1716, learned counsel submitted that the Saint-Gobain Group acquired BPB United Kingdom on a global basis. He also relied on the news report at page 1751 to establish that the Saint-Gobain Group acquired the gypsum business from India Gypsum in 2009.

11. Upon taking stock of the rival contentions, the first issue to be considered is with regard to the maintainability of the petition. Learned counsel for the first respondent contended that a stand-alone rectification petition only lies before the Registrar of Trade Marks and not before this Court. This petition has been filed under



Section 57 of the Trade Marks Act, and the said provision, in relevant part, reads as under:

“57. Power to cancel or vary registration and to rectify the register. —

(1) On application made in the prescribed manner to the [High Court] or to the Registrar by any person aggrieved, the [Register or the High Court, as the case may be,] may make such order as it may think fit for cancelling or varying the registration of a trade mark on the ground of any contravention, or failure to observe a condition entered on the register in relation thereto.

(2) Any person aggrieved by the absence or omission from the register of any entry, or by any entry made in the register without sufficient cause, or by any entry wrongly remaining on the register, or by any error or defect in any entry in the register, may apply in the prescribed manner to the [High Court] or to the Registrar, and the [Register or the High Court, as the case may be,] may make such order for making, expunging or varying the entry as it may think fit.

(3) The [Register or the High Court, as the case may be,] may in any proceeding under this section decide any question that may be necessary or expedient to decide in connection with the rectification of the register. “

12. On a plain reading of sub-sections (1) to (3) of Section 57, it



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is evident that an application for rectification may be presented either to the High Court or to the Registrar of Trade Marks by any person aggrieved. By relying on *Patel Field Marshal* and *Jagatjit Industries*, learned counsel for the first respondent contended that such stand-alone petition is only maintainable before the Registrar of Trade Marks. In *Patel Field Marshal*, the Hon'ble Supreme Court was dealing with a case wherein a rectification petition was filed after a civil suit for infringement had been instituted. Since rectification applications may only be dealt with either by the Registrar or the High Court and not by a civil court, sub-section (1) of Section 124 provides for a stay of the civil suit until the rectification application is decided either by the High Court or the Registrar. Sub-section (1) of Section 125 deals with a situation wherein the infringement suit is filed first and the validity of the registration of the plaintiff's trademark or the defendant's trademark is questioned in such suit. In such situation, it prescribes that any subsequent rectification application should be filed only in the High Court and not before the Registrar of



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Trademarks. Sub-section (1) of Section 125 is as under:

“(1)Where in a suit for infringement of a registered trade mark the validity of the registration of the plaintiff’s trade mark is questioned by the defendant or where in any such suit the defendant raises a defence under clause (e) of sub-section (2) of section 30 and the plaintiff questions the validity of the registration of the defendant’s trade mark, the issue as to the validity of the registration of the trade mark concerned shall be determined only on an application for the rectification of the register and, notwithstanding anything contained in section 47 or section 57, such application shall be made to the [High Court] and not to the Registrar. “

13. Thus, a rectification application may be filed either under Section 47 or Section 57 before the Registrar of Trademarks or the High Court. If a civil suit is filed after such rectification application was filed, such civil suit is liable to be stayed until disposal of the rectification application. If the civil suit was first filed and the validity of registration of either the plaintiff's or defendant's trade mark was questioned in such civil suit, a subsequent rectification



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application would lie only before the High Court and not before the Registrar of Trade Marks. None of the provisions exclude the institution of a rectification application before the High Court, whereas, in the circumstances indicated above, the exercise of jurisdiction by the Registrar of Trade Marks may be excluded. Hence, the contention that this petition is not maintainable as a stand-alone petition before this Court is rejected as untenable.

14. Learned counsel for the first respondent contended that the prefix 'GYP' is common to the trade and that there are many marks containing the said prefix. There is no doubt that the petitioner's trade mark 'GYPROC' was derived from the material 'Gypsum'. Consequently, 'Gypsum' is common to the trade and cannot be appropriated exclusively by any person. When a trade mark is derived from a word denoting the substance, disease or active pharmaceutical ingredient, such trade mark is not as strong as an invented or arbitrary trademark. Whether such trademark was

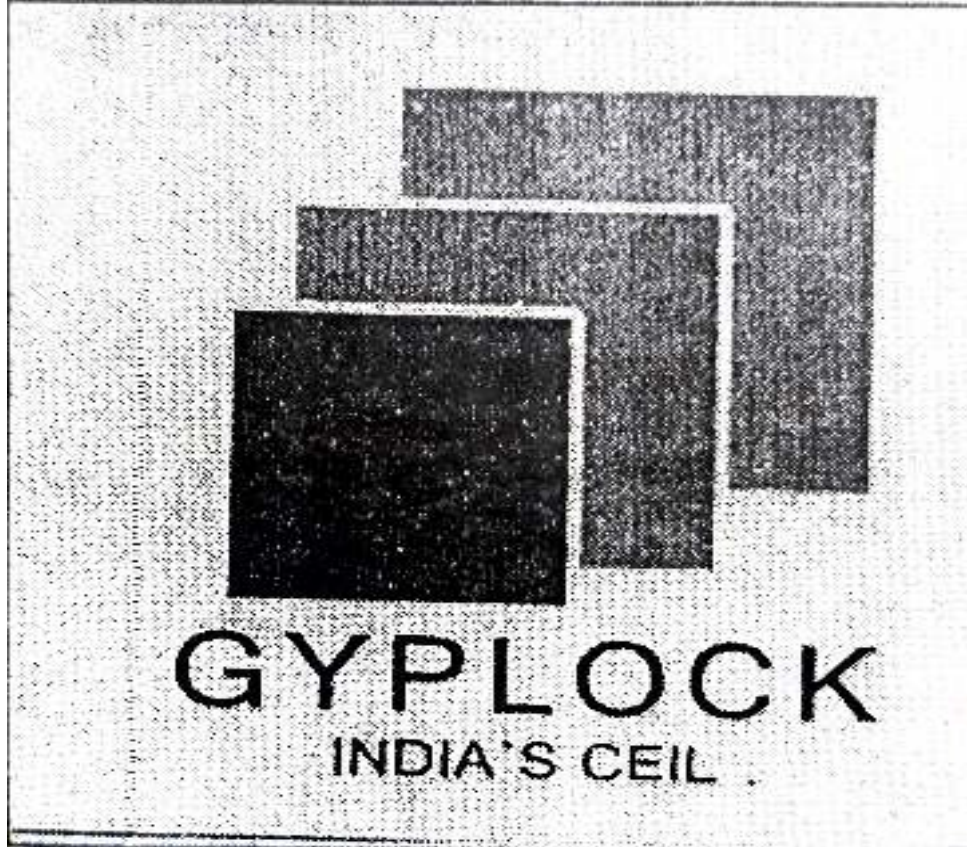


infringed and whether the registered proprietor is required to be protected would, nonetheless, depend on multiple factors, including the extent of similarity between the rival marks.

15. The petitioner has placed on record the certificate of registration for the mark 'GYPROC'. Such certificate of registration is with effect from 21.11.2006 and discloses that the registered proprietor is BPB United Kingdom Limited. Such registration is in relation to classes 6, 17, 19, 37 and 39. These classes cover metal products, insulating materials, non-metallic building materials, building construction, repair and maintenance services, and transport, packaging and storage of goods. The first respondent's registered trademark is a device mark. The said device mark is set out below:



Trade Mark Image : (1)



The said trademark was applied for on 'proposed to be used' basis on 28.04.2017. The registration was granted on 31.12.2017 with effect from 28.04.2017. The registration is in class 19 in respect of natural gypsum raw materials, gypsum plaster, gypsum stucco, etc.



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16. From these documents, the first conclusion that follows is that the petitioner's registration is prior to the first respondent's registration. In fact, it precedes the first respondent's registration by about 11 years. The second conclusion that follows is that both the rival marks are used in relation to building materials under class 19. Since use of a trademark is the principal consideration in such matters, I next examine evidence of use.

17. In the petition, the petitioner asserts use by its predecessors-in-interest for more than 100 years. In fact, the petitioner relies upon a registration of the mark 'GYPROC' in Canada with effect from 03.08.1921. The petitioner has also placed on record sales figures and advertising figures in multiple countries. As regards the Saint Gobain Group, the petitioner has placed on record evidence of the entry of such group into India in 1996 and of involvement in the production of building materials in India. The annual reports of the petitioner from the financial year 2015 have also been placed on record. The use



of the trademark 'GYPROC' in relation to building materials on social media platforms such as Instagram and Facebook have also been placed on record.

18. Invoices bearing the trademark 'GYPROC', issued by Saint Gobain India Private Limited – GYPROC, are also on record. These invoices were issued on various dates running from the year 2016 onwards. While it was contended that these invoices were not issued by the petitioner, the petitioner has placed on record evidence that it is a part of the Saint Gobain Group and that these entities are also part thereof. Reference may be made, in this regard, to the annual reports, which contain the financial statements of all the group entities. These documents clearly indicate that the petitioner is the prior adopter and user of the trademark 'GYPROC' in comparison to the first respondent's adoption and use of the mark GYPLOCK.



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19. As stated earlier, both the petitioner's trademark and the first respondent's trademark are used in relation to building materials. While the petitioner uses the suffix 'ROC', the first respondent uses the suffix 'LOCK'. Undoubtedly, there is both visual and phonetic similarity. In effect, the rival marks are similar and they are used in relation to nearly identical goods. Notwithstanding the origin of the marks from the generic name 'Gypsum', in my view, the degree of similarity is such that it is likely to cause confusion or deception among the public, including by way of associating the impugned mark with the petitioner. Consequently, a case is made out for rectification of the register in respect of the later mark. Although the first respondent contended that its mark is a device mark which also includes the words 'INDIA'S CEIL', a consumer of building materials is likely to ask for the product by reference to the prominent feature 'GYBLOCK' and not by referring to the product as 'GYBLOCK INDIA'S CEIL'. Therefore, the said contention is rejected as untenable.



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20. For reasons aforesaid, (T)OP(TM).No.404 of 2023 is allowed by directing the Registrar of Trade Marks to rectify the Register of Trade Marks by expunging the entry relating to Trademark No.3536418 in class 19 from such register. As a consequence, the certificate of registration shall also be cancelled. These actions shall be completed within eight weeks from the date of receipt of a copy of this order. There shall be no order as to costs.

21.12.2024

Index : Yes / No

Internet : Yes / No

Neutral Citation : Yes/No

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To

1. Mr.Tallam Uma Shankar Gupta
Flat No.502, Satya Sai Towers,
Nagarapalem, Guntur,
Andhra Pradesh-522 002.
2. The Deputy Registrar of Trade Marks
Trade Marks Registry,
Boudhik Sampada Bhawan,
G.S.T.Road, Guindy, Chennai-600 032.



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**Pre-delivery order made in
(T)OP(TM)/404/2023
(ORA/5/2021/TM/CHN)**

20.12.2024