
(2020) 08 IPAB CK 0012

In the Intellectual Property Appellate Board

Case No : ORA/30/2014/TM/MUM

Parker Hannifin France Sas.

APPELLANT

Vs

Kanwar Sachdeva And Ors.

RESPONDENT

Date of Decision : 07-08-2020

Acts Referred:

Trade Marks Act, 1999 — Section 2(1), 9, 9(2), 11, 11 (1), 11 (10), 11 (3), 11(1), 11(2), 11(3), 18(4), 30(1), 47, 47(1), 57, 57(2)

Citation : (2020) 08 IPAB CK 0012

Hon'ble Judges : Manmohan Singh, J; Dr. Onkar Nath Singh, Technical Membe

Bench : Division Bench

Advocate : Dalia Sen Oberoi, Mania

Final Decision : Dismissed

Judgement

1. The applicant has filed the present petition for removal on the grounds of non-use and cancellation of Trade mark No. 1120353 registered in the name of Kanwar Sachdeva in class 07 under Sections 47 and 57 of the Trade Marks Act, 1999.

2. The details of the Impugned registered Trade Mark are:

Trade Mark No: 1120353

Class: 07

Trade Mark: LEGRIS (word)

Date of Application: 22.07.2002

First Date of Use: 15.05.1999

Date of Advertisement: 13.08.2003 made available to the public on 18.08.2003

Journal No: 1300-3

Date of Registration: 28.09.2005

Valid Till: 22.07.2022

3. Despite of service, no counter statement has been filed by the respondent No. 1. No one is present when the matter was taken. The petition is filed

to take the matter on urgent basis in view of non filing of counter statement.

4. The said request was allowed. Counsel for the applicant has made her submission in support of non case.

5. The applicant's details of Trade Mark, if any, applied/registered in the name of applicant herein:

6. Facts as per statement made in the petition:

The Applicant which is a wholly-owned subsidiary of Parker Hannifin Corporation, USA was founded in the year 1918. The Applicant is a \$13 billion

global company with annual sales exceeding \$13 billion in the year 2012. It is the world's leading diversified manufacturer of motion and control

technologies and systems, providing precision-engineered solutions for a wide variety of mobile, industrial and aerospace markets. The Applicant

employs approximately 60,000 people in 48 countries around the world. Their engineering-expertise and broad range of core technologies uniquely

positions the company to solve some of the world's greatest engineering challenges. With leading market positions and successful international

expansions worldwide, the Applicant is ranked at 216th in the world list of Fortune 500 companies released annually by the Fortune 500 magazine.

Last year, the Applicant was ranked at 248.

6.1. In 2008, the Applicant acquired the French company LEGRIS SAS (earlier known as LEGRIS SA), which was subsequently merged with them

on December 31, 2010. Due to such acquisition and merger, the Applicant has acquired statutory and common law rights in

the intellectual property rights previously owned by LEGRIS SAS. With specific reference to trademarks, the Applicant has among other marks

acquired exclusive rights over the well-known mark (trade mark no. 1461703 in classes 6 & 17) earlier owned by LEGRIS SAS. The

Applicants have filed requisite applications before the Registrar of Trade Marks to record themselves as the subsequent proprietor of the afore-

mentioned mark on July 6, 2012 and the same is pending. Hereinafter any reference to the Applicant shall mean and include LEGRIS SAS and their

predecessors. A copy of the extract from the companies register of the Registry of the Commercial Court of Rennes in France along with an English

translation evidencing the merger, a copy of the application dated July 6, 2012 and a copy of the registration certificate of trade mark no. 1461703 are

annexed hereto and marked as Annexure A-2 (colly).

6.2. That the predecessors of the Applicants i.e. LEGRIS S AS began their operations as a small valve making factory in the year 1863 in France

under the trading name LEGRIS. The trading name was derived from the name of the founder Ambrose Legris. In the year 1969, Legris invented and

launched push-in fittings/connections named LF 3000 which has won several international awards and the concept has also been adopted worldwide.

In the same year, Legris launched an industrial unit in Spain and a sales subsidiary in Great Britain, which marked their entry into the international

markets. In 1988, Legris SA became a division of Group Legris Industries and in the period from 1994 to 2000, Legris received ISO: 9001 quality

certification for all its sites in France. In the year 1996, Legris launched Transair, which is a division of Legris, specializing in compressed air pipe

work systems. In the year 1997, Legris created its own Autoline which was dedicated to the automobile 1st assembly activity (passenger cars and

heavy goods vehicles). In the period from 2000 to 2003, Legris acquired few new sites and established itself in South America as 'Legris do Brasil'

and its 5th subsidy was created in India as Legris India Private Limited. With the purchase of the Bell-Hermetic company (a German manufacturer of

high pressure connectors), Legris extended its activities to the hydraulic market and offered a wider range of products to its customers. The period

2003 to 2007 saw tremendous growth for Legris as over 200,000 Transair installations were completed. On December 15, 2008, Legris SA changed

its name and legal description to Legris SAS, Societe pars Action Simplified i.e. a simplified joint-stock company. Copy of the documents evidencing

the earliest use of the mark is annexed hereto and marked as Annexure A-3.

6.3. It is stated that due to such long, extensive and continuous use of 150 years around the world by the Applicant, the mark LEGRIS is associated by

the general public and the trade solely with the Applicant. The extent of the mark LEGRIS being well-known can be gauged from the fact that a book

has been written on the history of the company by a leading French author,

Reynald Secher titled ""LEGRIS-HISTOIRE D'UNE SAGA

INDUSTRIELLE (LEGRIS-History of an industrial saga)"". A copy of the internet page evidencing the availability of the book is annexed hereto and marked as Annexure A-4.

6.4. The Applicant designs, manufactures and sells value-added technical solutions for connecting, conveying and controlling fluids. The Applicant has from its original core business developed its core competencies in three major activities under the trade mark LEGRIS and (hereinafter known as the ""LEGRIS family marks""):

Legris Connectic: The Applicant offers over 12,000 product references, fittings, valves and accessories designed for a wide variety of industrial applications. Pneumatic equipment (bagging machines, assembling machines) and hydraulic (injection machines, machining tool, building machines) are the main applications.

Legris Transair: Sold under the Transair trade brand, a system of compressed air, vacuum and inert gases networks, intended for all industrial sectors.

Transair is an intelligent and flexible system designed for quick and easy-to-modify compressed air systems installation.

Legris Autoline: Push-in connect solutions for applications on light vehicles and heavy goods vehicles. Legris Autoline is behind the innovative concept of the quick connector which is intended for fuel systems; this concept not only saves a lot of time for the user but is also completely reliable and economical.

6.5. That the Applicant under its well-known and distinctive LEGRIS family marks provides custom made products to its customers, through the facility of Computer-aided design (hereinafter referred to as ""CAD"") by especially designing the equipments and products as per the specific needs of its customers and guaranteeing utmost satisfaction to each and every customer. The Applicant's products are vital to virtually everything that moves or requires control, including the manufacture and processing of raw materials, durable goods, infrastructure development and all forms of transport. Their products are virtually available in every corner of the world, through its painstaking efforts and investments by incorporating subsidiaries the world over. A list of the subsidiaries is annexed hereto and marked as Annexure A-5.

6.6. The products and services of the Applicant bearing the LEGRIS family marks are available in the following countries through their subsidiaries or

affiliates:

Africa-Algeria, Angola, Benin, Botswana, British Indian Ocean Territory, Burkina Faso, Burundi, Cameroon, Cape Verde, Central African

Republic, Chad, Comoros, Congo, Congo (Democratic Republic), Djibouti, Equatorial Guinea, Eritrea, Ethiopia, Gabon, Gambia, Ghana, Guinea, Guinea

Bissau, Ivory Coast, Kenya, Lesotho, Liberia, Libya, Madagascar, Malawi, Mali, Mauritania, Mauritius, Mayotte, Morocco, Mozambique, Namibia,

Niger, Nigeria, Reunion Island, Rwanda, Saint Helena, Sao Tome And Principe, Senegal, Seychelles, Sierra Leone, Somalia, South Africa, Sudan,

Swaziland, Tanzania, Togo, Tunisia, Uganda, Western Sahara, Zambia, Zimbabwe;

Asia-Afghanistan, Armenia, Azerbaijan, Bangladesh, Bhutan, Brunei, Darussalam, Cambodia, China, Georgia, Hong Kong, India, Indonesia, Japan,

Kazakhstan, Korea (North), Korea (South), Kyrgyzstan, Lao, Macau, Malaysia, Maldives, Mongolia, Myanmar, Nepal, Pakistan, Philippines,

Singapore, Sri Lanka, Taiwan, Tajikistan, Thailand, Turkmenistan, Uzbekistan, Vietnam; Central America-Anguilla, Antigua And Barbuda, Aruba,

Bahamas, Barbados, Belize, Bermuda, Cayman Islands, Costa Rica, Cuba, Dominica, Dominican Republic, El Salvador, Falkland Islands, Grenada,

Guadeloupe, Guatemala, Haiti, Honduras, Jamaica, Martinique, Montserrat, Netherlands Antilles, Nicaragua, Panama, Puerto Rico, Saint Kitts And

Nevis, Saint Lucia, Saint Vincent And, Grenadines, Trinidad And Tobago, Virgin Islands (Uk), Virgin Islands (Us); Europe-Albania, Andorra, Austria,

Belarus, Belgium, Bosnia and Herzegovina, Bulgaria, Croatia, Czech Republic, Denmark, Estonia, Faroe Islands, Finland, France, Germany, Gibraltar,

Greece, Hungary, Iceland, Ireland, Italy, Latvia, Liechtenstein, Lithuania, Luxembourg, Macedonia, Malta, Moldova, Monaco, Netherlands, Norway,

Poland, Portugal, Romania, Russia, San Marino, Slovakia, Slovenia, Spain, Svalbard and Jan Mayen, Sweden, Switzerland, Turkey, Ukraine, United

Kingdom, Vatican, Yugoslavia; Middle East-Bahrain, Cyprus, Egypt, Iran, Iraq, Israel, Jordan, Kuwait, Lebanon, Oman, Palestinian Territory, Qatar,

Saudi Arabia, Syria, United Arab Emirate, Yemen;

North America-Canada, Greenland, Mexico, Saint Pierre And Miquelon, USA; Oceania-American Samoa, Antarctica, Australia, Bouvet Island,

Christmas Island, Cocos Islands, Cook Islands, Fiji, French, Polynesia, French Southern Territories, Guam, Heard And McDonald Islands, Kiribati,

Mariana Islands, Marshall Islands, Micronesia, Minor Outlying Islands, Nauru, New Caledonia, New Zealand, Niue, Norfolk Island, Palau, Papua

New Guinea, Pitcairn, Samoa, Solomon Islands, South Georgia And The South Sandwich Islands, Tokelau, Tonga, Tuvalu, Vanuatu, Wallis And

Futuna;

South America-Argentina, Bolivia, Brazil, Chile, Colombia, Ecuador, French Guyana, Guyana, Paraguay, Peru, Suriname, Uruguay, Venezuela.

The sale of the products in more than 200 countries around the world shows that the Applicant is the prior adopter and user of the LEGRIS family

marks and due to such long, extensive and continuous use it has gained proprietary rights in the mark and no other trader can claim rights over these marks.

6.7. In addition to the common law rights enjoyed by the Applicant in respect of use and popularity of the LEGRIS family marks, it has also obtained

registrations of the mark in a large number of countries such as Argentina, Brazil, Canada, Chile, China, France, Hong Kong, Israel,

Japan, Korea (North), Korea (South), Malaysia, Mexico, Philippines, South Africa, Taiwan, Thailand, Australia, Austria, Benelux, Bulgaria, Canada,

Cyprus, Czech Republic, Denmark, Estonia, European Union, Finland, Germany, Greece, Hungary, Iceland, Ireland, Italy, Japan, Latvia, Lithuania,

Malta, Morocco, Norway, Poland, Portugal, Romania, Russian Federation, Singapore, Slovakia, Slovenia, Spain, Sweden, Switzerland, Turkey,

Ukraine, United Kingdom, United States of America, WIPO. The Applicants have secured registration around the world in classes 6, 7, 8, 9, 11, 12, 17

and 20. Copies of the afore-mentioned international registrations are annexed hereto and marked as Annexure A-6.

6.8. As already stated above, the Applicant has been using the mark LEGRIS continuously since 1863 around the world. In 1980's, the Applicants

adopted and started using the mark around the world as the logo of the company. In 2002, the Applicants slightly modified the mark

and adopted as the logo around the world. Due to such prior adoption and use of the mark, the mark qualifies as a well-known mark

under Section 11 of the Trade Marks Act, 1999.

6.9. With regard to India, the Applicant has been using the mark LEGRIS along with the mark since 1984 continuously and

extensively. That the Applicants had also sought statutory protection of their earlier logo under trade mark nos. 833694 (Class 6) and

833695 (Class 17). The bearing trade mark no. 1461703 in classes 6 & 17 was adopted and is being used in India by the Applicant

since March 1, 2003. To further cement their presence in India, the Applicant on September 5, 2000 incorporated its first wholly-owned subsidiary in

India under the name Legris India Holding Private Limited. Subsequently, on February 20, 2001, the Applicant through their afore-mentioned wholly-

owned subsidiary incorporated another subsidiary Legris India Private Limited to manage their sales and business dealings in India. Apart from the

afore-mentioned, the Applicant also has various other subsidiaries through which it carries on business in India, namely Parker Hannifin India Private

Limited and Annapurna Kenmore Tube Products Private Limited. The Applicant through these subsidiaries provides spare part services and

High/Low pressure valve products and technical components, including CAD bearing the trademark LEGRIS.

The products and services provided by the Applicant under its well-known LEGRIS family marks are of very high quality. The Applicant has honestly

and independently conceived the trademark/name Legris which has no specific meaning or relevance in the English dictionary or relevance in relation

to the nature of products/services provided by the Applicant. As already stated above, LEGRIS was derived from the name of the founder Ambrose

Legris. Owing to the high quality products and services provided by the Applicant, the well-known said mark/name Legris has acquired tremendous

reputation and goodwill for itself across the globe including in India.

6.10. That the Applicant has had enormous sales of its products bearing the well-known LEGRIS family marks since its inception, which have

increased appreciably over the last few years. In the year 2007, the Applicant recorded revenues of USD 340 million (approximately INR 1802 crore)

worldwide. The worldwide sales figures from the year 2009-2012 for the products sold under the well-known LEGRIS family marks are as follows:

Specifically in relation to India, the Applicant has recorded tremendous sales of goods under its well-known LEGRIS family marks, as provided below:

* The aforesaid figures have been obtained by the Applicant from its book of accounts, which are regularly maintained by them in the normal course of business.

6.11. The international fame and reputation of the Applicants' famous LEGRIS family marks through the Internet, advertisements and other publicity

material appearing in international magazines, has tremendously enhanced the already existing huge reputation of the Applicants vis-a-vis its products

and services. The Applicant's products and services bearing the well-known LEGRIS family marks are advertised and displayed on a number of

websites giving easy access to the information of the goods and services bearing the well-known mark to customers, traders and the public at large.

The ownership and control of more than 100 domain names clearly establishes that the mark LEGRIS is associated solely with the Applicants around

the world and none else. Listed below are details of some of the domain names owned by the Applicant:

6.12. That the Applicant has incurred enormous sums of expenses till date for the promotion and marketing of its products under the LEGRIS

family marks. The worldwide promotional and marketing figures of the Applicant's products for the past few years are as follows:

The Financial Year for the Applicant is from June to May

With specific reference to India, the Applicant has incurred and continues to incur large amount of expenses towards promotion and marketing of its

product under the well-known LEGRIS family marks, the details of which are as follows:

* The aforesaid figures have been obtained by the Applicant from its book of accounts, which are regularly maintained by them in its normal course of business.

6.13. Since the year 1863, the Applicant has been exclusively selling and marketing its products under its distinctive and well-known mark/name

LEGRIS. The said mark/name Legris has come to be exclusively associated with the Applicant only and none other. Its exclusive use belongs to the

Applicant only and none other. The Applicant takes extreme care in manufacturing and selling its high quality products under its well-known said

mark/name Legris. The Applicant leaves no stone unturned to prevent and maintain its highest quality of standards in manufacturing and selling its

products. Also, the Applicant by way of utmost precision, research and development prepares the products according to the specific requirements of its customers, leaving no scope for any mistake. In addition thereto and by virtue of such long-standing, uninterrupted and extensive use, sales and promotion, as mentioned in the preceding paragraphs, the said mark/name LEGRIS has become well-known and has been exclusively and solely associated with the Applicant only.

6.14. The Applicant's said mark/name LEGRIS is a well-known mark on a global footing and has attained very high goodwill internationally including in India, through vast use/sales, publicity, dissemination of information about the mark and products/services by the means of articles, advertisements, news items, etc. The Applicant and its well-known mark/name Legris represents quality, determination, reliability, efficacy, innovation, growth and development. The Applicant's growing business and quality products and services earned immeasurable goodwill and valuable intellectual property which the Applicant is proud of and toil hard to defend. The Applicant's trademark clearly qualifies for protection under Article 6 bis of Paris Convention covering ""well-known"" trademarks which is mentioned under Section 2(1)(zg), 11(2) & (6) of the Trade Marks Act, 1999.

7. That the Applicant also carried out an investigation to determine if the mark is being used by the Respondent No. 1 as stated in their application.

However, as per the results of the investigation, the mark is not being used by the Respondent No. 1 in the course of their trade and the registration has been obtained primarily to block the register. The present petition is filed as it was apprehended the respondent no. 1 may start offending activities. Thus, the applicant is acquired party.

8. In view of facts and material placed on record, it is evident that the registration of trade mark no. 1120353 in class 7 by Respondent No. 1 i.e. Kanwar Sachdeva for ""machine tools"" has been wrongly granted by the Respondent No. 2 and should be removed from the register as it is in breach of provisions of Section 9(2)(a), 11(1) (a), 11(3)(a), 18 (4), 30 (1) (a) & b and 47(1) (a) & (b) of the Trade Marks Act and therefore is liable to be removed and cancelled under Section 57 (2) of the Trade Marks Act, 1999 as Respondent No. 1 no applied mark which is phonetically, visually and structurally identical to the Applicants' well-known and prior mark LEGRIS and

has been registered by Respondent No. 2 without considering the principles of Section 9 and Section 11 of the Trade Marks Act, 1999 and hence the trade mark is liable to be removed and cancelled under Section 57 (2) from the Register.

9. That the Respondent No. 2 has granted registration to the Respondent No. 1 in contravention of the provisions of Section 11 (1) (a) as the mark of the Respondent is identical to that of the Applicant and the nature and composition of the goods registered in class 7 i.e. machine tools is identical with the goods falling in the international registrations obtained under class 7 by the Applicant i.e. Taps, valves and junctions, pressure regulators, tubes and valves, the aforesaid goods being parts of machines or engines. The registration of the mark of the Respondent is also causing grave harm and injury to the Applicant as the goods pass through the same trade channels.

10. The grant of registration of the trade mark by Respondent No. 2 to Respondent No. 1 is against the principles of Section 11 (3) (a). As stated above, the trade mark LEGRIS is being used by the Applicant around the world since 1863 and in India since the year 1984 and due to such long, continuous and extensive use, the mark is associated solely with the Applicant and none else. No other trader can therefore register the mark in their name. The registration of the mark in the name of Respondent No. 1 should therefore have been refused by the Respondent No. 2 as the same is against the law of passing-off.

11. The adoption of the mark is purely dishonesty can be gauged from the fact that apart from the present application, the Respondent No. 1 had also applied for the trade mark bearing no. 1121685 in Class 7, which is identical to the well-known and prior mark of the Applicants. It is brought to the kind attention of the Hon'ble Tribunal that at the time of application of trade mark no. 1121685, the Applicant already had prior existing registrations under trade mark no. 833694 and 833695. The respondent no. 1 has failed to file any evidence of user claimed at the time of registration. It appears that the respondent no. 1 is not intimated in the mark as the respondent no. 1 has failed to contest the petition.

12. Due to the long, extensive and continuous use of the mark LEGRIS worldwide, including India, it has acquired the status of a well-known mark under Section 11 (10) of the Trade Marks Act, 1999 and the respondent no. 1

cannot claim rights over the mark. Therefore, the mark is liable to be cancelled under the provisions of Section 57 (2) of the Trade Marks Act, 1999. The respondent No. 1 has not rebutted the case of the applicant. No

evidence of user is filed. It appears that respondent No. 1 is not interested to contest the mark. The respondent No. 1 is not proprietor of trade mark.

User. If any, was tainted and dishonest. Thus the mark is wrongly remaining on Register and is liable to be removed.

13. In the light of above the registered trade mark no. 1120353 in the name of Kanwar Sachdeva in class 07 is removed from the register on the

grounds of non-use under Section 47 of the Trade Marks Act, 1999 and is cancelled under the provisions of Section 57 of the Trade Marks Act, 1999.

Copy of order be sent to respondent No. 2 to remove the entry.

14. No. costs.