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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

\+ C.A.(COMM.IPD-TM) 67/2021

KOHLER CO. ..... Appellant

Through: Mr. Philip Abraham and Mr. Manish Kumar, Advocates.

versus

REGISTRAR OF TRADE MARKS ..... Respondent

Through: Mr. Harish Vaidyanathan Shankar, CGSC with Mr. Srish Kumar Mishra, Mr. Sagar Mehlawat and Mr. Alexander Mathai Paikaday, Advocates.

CORAM:
HON'BLE MR. JUSTICE SANJEEV NARULA

O R D E R

% 18.01.2023

1. The present appeal under Section 91 of the Trade Marks Act, 1999 [*hereinafter*, '***the Act***'] is directed against order dated 06th March, 2019 read along with Statement of Grounds dated 08th March, 2019, whereby Appellant's application No. 2760219 for registration of mark "SAFESHIELD" in respect of baths, bath installation products etc., falling under Class 11 [*hereinafter,* "***subject mark***"], has been refused.

2. The Statement of Grounds reads as under:

> *"The applicant advocate Sri Ram appeared. I have heard the argument and also perused the documents available on record. The same*

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and similar mark is already on record, hence, objection under section 9 and 11 is sustained, application is refused for registration.

** 11(1)(a) - Relative grounds for refusal of registration.- The said trade Mark is refused for registration because of its identity with an earlier trade mark and similarity of goods or services covered by the trade mark; or*

** 11(1)(b) - Relative grounds for refusal of registration. The said trade Mark is refused for registration because of its similarity to an earlier trade mark and the identity or similarity of the goods or services covered by the trade mark there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.*

Since the objection raised in the Examination Report under section 11 of the Trade Marks Act, 1999 and identical or similar trade mark already taken on records. Ld. Counsel failed to convince at the time of hearing his/her case and mentioned above objection cannot be waived, the above mentioned application is refused."

3. Although the Senior Examiner finds the subject mark to be objectionable both under Sections 9 and 11 of the Act, however, noticeably in the Examination Report dated 20th August, 2015, objection was raised only under Section 11 of the Act.

4. Mr. Philip Abraham, counsel for Appellant, submits that the Senior Examiner has misconstrued the provisions of the Act. The subject mark is inherently distinctive and capable of being granted registration. This is evident from Appellant's prior registration of the mark "SAFESHIELD+", which also incorporates the word "SAFESHIELD".[1] As regards, objection under Section 11, he states that the cited marks do not bear similarity to the subject mark.

5. *Per contra*, Mr. Harish Vaidyanathan Shankar, counsel for Respondent,

[1] *Vide* application No. 4150261.

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strongly opposes the appeal and submits that subject mark is deceptively similar to cited marks and there exists a likelihood of confusion on the part of public. Thus, no ground for interference is made out.

6. Heard. The subject mark, a combination of words 'Safe' and 'Shield', without any space between, is a coined term; it neither has any direct reference to, nor is it descriptive of the goods falling under class 11. At the highest, it can be considered as suggestive. Therefore, objection under Section 9 cannot sustain.

7. The cited marks for refusal under Section 11 are as follows:

S. No.	Trade Mark	Application No.	Class / Specification of Goods
1.	SHIELD	1022320	Geyser, cooler kit, fans, exhaust fans included in class 11.
2.	EVERSHIELD	2082668	Air purification and breathing protection system comprised of reactors, catalysts, adsorbents, filters, air heaters, air purifiers, oxidization chemicals and chemical compounds included in class 11.
3.	SHIELD	2286089	Sanitary apparatus (cover for wash basin drainage) included in class 11.
4.	SHIELD	2337019	Water treatment products included in class 11.

8. Mark under application No. 1022320 stood removed from the register of trademarks, prior to the refusal order. As per the website of Trademarks

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Registry, marks under application Nos. 2082668 and 2286089 have not been renewed, and are likely to be removed. Application No. 2337019 has been objected to. Nonetheless, said mark *prima facie* seems to be dissimilar to the subject mark except for the commonality of the word "SHIELD", which is not sufficient to establish likelihood of confusion. The Court is also persuaded by the fact that mark "SAFESHIELD+" stands registered in favour of the Appellant for the same class of goods.

9. In view of the above, grounds for refusal of application under Sections 9 and 11 of the Act are not sustainable. Accordingly, the appeal is allowed with following directions: -

(i) Refusal order dated 06th March, 2019 and Statement of Grounds dated 08th March, 2019, are set aside.

(ii) Trademark Registry is directed to process application No. 2760219 for registration of mark "SAFESHIELD" in class 11.

(iii) Subject mark be advertised within a period of three months from today.

(iv) If there is any opposition, the same shall be decided on its own merits, uninfluenced by observations made hereinabove.

(v) The rights in subject mark shall be restricted to "SAFESHIELD", and no exclusive rights in the words, "Safe" or "Shield", separately or individually shall vest in the Appellant. This disclaimer shall be reflected in the trade marks journal at the time of advertisement and also if the subject mark ultimately proceeds for registration.

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10. With the above directions, the appeal is disposed of along with pending application(s), if any.

11. Registry is directed to supply a copy of the present order to the Trademark Registry at llc-ipo@gov.in for compliance.

SANJEEV NARULA, J

JANUARY 18, 2023
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