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

% *Date of Decision : 28th April, 2023*

\+ C.A.(COMM.IPD-TM) 27/2021

SHELL BRANDS INTERNATIONAL AG ..... Appellant

Through: Mr.Anirudh Bakhru, Ms.Neeharika, Mr.Raghav Vig, Ms.Sejal Tayal, Ms.Vijay Laxmi Rathi, Mr.Umang Tyagi, Mr.Naqeeb Nawab and Mr.Avirup Benjamin, Advocates.

versus

THE 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 AMIT BANSAL

AMIT BANSAL, J. (Oral)

1. The present appeal was filed before the Intellectual Property Appellate Board (IPAB) and pursuant to the enactment of Tribunal Reforms Act, 2021, the present appeal has been received on transfer.

2. This appeal has been filed impugning the order dated 15th March, 2018 passed by the Senior Examiner of Trademarks in respect of Application No.2365543 for the mark  in class 4.

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3. Notice in the appeal was issued on 5th August, 2019, no reply has been filed.

4. The brief facts leading to the filing of the present appeal are as under:

4.1. The appellant is a member of the Shell Group of Companies, of which Royal Dutch Shell Plc is the parent company.

4.2. The Shell Group of Companies is engaged in the business of exploring and producing oil and gas, providing energy solutions and petrochemicals, producing and selling fuels for automobiles, ships and planes.

4.3. The appellant applied for registration of the aforesaid mark for oils, greases, lubricants and fuels in class 4 vide application dated 18th July, 2012 claiming user since 1st July, 2005.

4.4. In the application, the appellant has sought registration of the device of the drum bearing colour combination of red and yellow and had only claimed rights in the said combination of the colour and not in the device of drum.

4.5. The said mark was examined and an objection was raised under Sections 11 and 9(1)(b) of the Trade Marks Act, 1999. The appellant filed response to the examination report on 13th March, 2018. Subsequently, a hearing was given to the appellant and pursuant thereto, the impugned order was passed.

4.6. The refusal order was posted on 15th March, 2018, and the grounds for rejection were provided on 26th July, 2018.

5. Counsel for the appellant has made following submissions:

i. While taking the ground of Section 11(1) for refusal of registration, the examination report failed to provide any marks

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similar to the impugned mark.

ii. None of the four grounds referred to in the impugned order are relevant for the adjudication of the present trademark application.

iii. There was no mandatory requirement for filing a user affidavit.

6. *Per contra*, the counsel for the respondent submits that under Rule 27 of the Trademark Rules, 2002, the Registrar has been given discretion to call upon an applicant to file a user affidavit.

7. I have heard the counsels for the parties.

8. One of the most glaring aspects of the impugned order is that while the respondent has placed reliance on Section 11 of the Trade Marks Act to reject the application of the appellant, it does not provide any similar or identical earlier trademarks in support of the said contention. In the absence of providing similar/identical marks, an objection under Section 11 cannot be taken at all.

9. Insofar as the objection under Section 9(1)(b) of Trade Marks Act is concerned, the impugned order has simply reproduced the language of Section 9(1)(b) without stating as to how the impugned mark falls under any of the grounds provided in Section 9(1)(b).

10. Rule 27 of the Trademark Rules 2002, which was the applicable rule at the time when the present application was filed, is set out below:

> *"27. Statement of user in applications.—An application to register a trade mark shall, unless the trade mark is proposed to be used, contain a statement of the period during which, and the person by whom it has been used in respect of the goods or services mentioned in the application.* ***The Registrar may require the applicant to file an affidavit testifying to such user with exhibits showing the mark as used."***

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11. A perusal of the aforesaid rule would show that there is no mandatory requirement for an applicant to file a user affidavit. Discretion has been given to the Registrar to require an applicant to file a user affidavit. However, in the present case, it is an admitted position that the Registrar never called upon the applicant to file a user affidavit. Therefore, refusal on the aforesaid grounds is unsustainable.

12. I have perused various judgments referred to in the impugned order. None of the aforesaid orders have any correlation to the rejection of the present trademark application.

13. In view of the above, the present appeal is allowed, the impugned order dated 15th March, 2018 is set aside.

14. The Registrar is accordingly directed to proceed with the advertisement of the subject trademark application. Let the same be advertised within a period of three months.

15. If there is any opposition to the said application, the same shall be decided on its own merits without being affected by the observations made herein.

16. The Registry to supply a copy of the present order to the Trade Marks Registry at llc-ipo@gov.in for compliance.

AMIT BANSAL, J

APRIL 28, 2023
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