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

***Reserved on: 11th September, 2023***

***Date of decision: 13th September, 2023***

\+ **C.A.(COMM.IPD-TM) 118/2021**

STP LIMITED ..... Appellant

Through: Mr Shivendra Pratap Singh and Mr Navdeep Suhag, Advocates (M: 8826906894).

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, and Mr M Sriram, Advocates.

**CORAM:**
**JUSTICE PRATHIBA M. SINGH**

**JUDGMENT**

**Prathiba M. Singh, J.**

1. This hearing has been done through hybrid mode.

2. The present appeal has been filed by the Appellant - STP Limited seeking setting aside of the order dated 31st December, 2018 passed by the Hearing Officer (Senior Examiner of Trade Marks) whereby the Appellant's application has been refused for registration. The details of the application are as under:

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|---|---|
| Trade Mark | ShaliCRMB |
| Trade Mark Application No. | 2873863 |
| Class | 19 |
| Goods | Building material (non-metallic); Chemically treated natural asphalt/bitumen for all weather roads and surfaces. |
| User Claim | Proposed to be used |
| Date of filing | 2nd January, 2015 |

3. Mr Shivendra Pratap Singh, ld. Counsel for the Appellant submits that the impugned order merely rejects the application on the ground that it is objectionable under Section 9/11 of the Trade Marks Act, 1999. However, as per the Examination Report, there was only a relative ground of objection under Section 11 and no objection was raised under Section 9.

4. Ld. Counsel for the Appellant further submits that in the Examination Report, objection was raised under Section 11 of the Trade Marks Act, 1999 that the applied trademark 'ShaliCRMB' bears identity or similarity with the earlier marks cited under bearing nos. 2272070 and 2272072 in the name of Shalimar Seal and Tar Products (P) Ltd. The details of the said marks are as under:

(i) SHALICRUM (Device) bearing no. 2272070 in class 19

(ii) SHALICURE (Device) bearing no. 2272072 in class 19

5. It is submitted that a suit being ***TM No. 21/2011 titled STP Limited v. Shalimar Seal And Tar Products (P) Ltd. & Anr.*** was filed by the

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Appellant seeking injunction *qua* the said mark 'SHALIPLAS' and injunction was granted by the ld. Trial Court.

6. Ld. Counsel for the Appellant also brings to the notice of this Court the substantial number of registrations with the prefix 'SHALI' which have been registered in the name of the Appellant herein.

7. The Court has heard ld. Counsels for the parties and perused the record.

8. A perusal of the impugned order dated 31st December, 2018 passed by the Hearing Officer (Senior Examiner of Trade Marks) would show that the same is completely cryptic and merely rejects the application on the ground that it is objectionable under Section 9/11 of the Trade Marks Act, 1999. The relevant part of the impugned order reads as under:

> *"* The trade mark applied for is objectionable under Section 9/11 of the Act. The application is accordingly refused."*

9. A perusal of the record would show that the Appellant has more than a hundred registrations for several marks with the 'SHALI' prefix such as 'SHALI PLASTIC', 'SHALIGRIP', 'SHALIDECK', etc. The word mark 'SHALI' is also registered in favour of the Appellant. The details of the registrations which are granted in favour of the Appellant are placed on record.

10. Further, the final order dated 21st August, 2018 passed by the Additional District Judge, Central Delhi in the said suit being ***TM No. 21/2011*** has been placed on record. Vide the said order dated 21st August, 2018, M/s Shalimar Seal And Tar Products (P) Ltd., i.e. the registered proprietor of the mark 'SHALI PLAS' has been permanently injuncted from

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using the prefix '*SHALI*'. The operative portion of the said order is set out below:

> "*In view of my findings on issues no. 2 & 7, the suit of the plaintiff is partly decreed in as much as the defendants, its agents, or assignees are restrained from using "SHALI" prefixed trademark in any manner. So far as trademark "Shalimar" is concerned plaintiff has acquiescence his rights in favour of the defendant. The defendant is granted three months' time to dispose off the existing stock with respect to "Shali" prefixed trademark. The defendant is also liable to pay a sum of Rs.12,50,000/- on account of rendition of accounts and Rs.12,50,000/- on account of punitive damages. The amount be paid within a period of 12 weeks failing which interest @10% p.a. shall be charged from the date of judgment till the date of payment. Subject to deposit of additional court fee decree sheet be accordingly prepared.*
> *No order as to cost.*"

11. It is pointed out that the appeal arising out of the said suit being ***RFA (IPD) 2/2022*** titled ***M/s Shalimar Seal & Tar Products Pvt. Ltd. & Anr v. M/s STP Ltd.,*** is pending before this Court. However, this is no stay of the judgment.

12. In the facts of this case, two trade marks i.e. trade marks bearing nos. 2272070 and 2272072 which are cited in the examination report would not be relevant and in fact would not lead to rejection of the Appellant's mark 'ShaliCRMB' considering the overwhelming use and registrations of 'SHALI' branded marks. Accordingly, the impugned order is not sustainable.

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13. Application no. 2873863 shall proceed for advertisement in the trade mark journal. Let the same be advertised within three months.

14. It is made clear that the present order would have no impact on opposition proceedings, if any, which may be filed against the application.

15. Accordingly, this appeal along with all pending applications is allowed in the above terms.

16. The Registry is directed to supply a copy of the present order to the office of the Controller General of Patents, Designs & Trademarks of India on the e-mail- llc-ipo@gov.in for compliance of this order.

**PRATHIBA M. SINGH**
**JUDGE**

**SEPTEMBER 13, 2023**
*Rahul/kt*

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