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IN THE HIGH COURT OF DELHI AT NEW DELHI*Reserved on: 11th September, 2023.**Date of decision: 13th September, 2023*

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C.A.(COMM.IPD-TM) 45/2021**STP LIMITED**

..... Appellant

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

versus

REGISTRARS OF TRADEMARKS

..... 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 impugned 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:



Trade Mark	SHALIPLUS (Device)
Trade Mark Application No.	2887876
Class	19
Goods	Building material (non-metallic); APP modified polymeric waterproofing membrane
User Claim	1st February, 2009
Date of filing	23rd January, 2015

3. Mr Shivendra Pratap Singh, Id. 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 of the Trade Marks Act, 1999.

4. Id. Counsel for the Appellant further submits that in the Examination Report, an objection was raised under Section 11 of the Trade Marks Act, 1999 that the applied trademark 'SHALIPLUS' bears identity or similarity with the earlier marks cited under bearing nos. 1201300 and 2272074. The details of the said marks are as under:

(i) SHALIPLUS (Device) bearing no. 1201300 in Class 19

(ii) SHALIPLAS bearing no. 2272074 in Class 19

5. Insofar as the first mark i.e. 'SHALIPLUS' (Device) bearing no. 1201300 is concerned, it is submitted that the said mark was renewed up to 26th May, 2013, the same was not renewed and has already been removed. Insofar as second mark i.e. 'SHALIPLAS' bearing no. 2272074 is concerned, the stand of the Appellant is that a suit being **TM No. 21/2011**



titled STP Limited v. Shalimar Seal And Tar Products (P) Ltd. & Anr. was filed by the Appellant seeking injunction *qua* the said mark ‘SHALIPLAS’ and injunction was granted by the Id. 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 Id. 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 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 have been filed 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 enjoined from 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, there is no stay of the judgment.

12. In view of the above, in the facts of this case, the two trade marks bearing nos.1201300 and 2272074, which are cited in the examination report would not be relevant and would not lead to rejection of the Appellant's application for the mark 'SHALIPLUS' considering the overwhelming use and registrations of 'SHALI' branded marks.



13. The first mark having already been removed and in respect of the second mark, the Appellant having obtained an injunction, the impugned order is not sustainable.

14. Accordingly, the Appellant's Trade Mark application no. 2887876 shall proceed for advertisement in the trade mark journal. Let the same be advertised within three months.

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

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

17. 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