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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) 161/2021**STP LIMITED**

..... Appellant

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

versus

**REGISTRAR OF TRADE MARKS, NEW
DELHI**

..... 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	SHALIMARK
Trade Mark Application No.	2873856
Class	19
Goods	Building material (non-metallic); Resin based thermoplastic road marking compound; water based road marking compound
User Claim	4th July, 2006
Date of filing	2nd 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.

4. Id. 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 'SHALIMARK' bears identity or similarity with the earlier marks cited. The details of the said marks are as under:

- (i) 'SHALIMAR' bearing no. 1015144 in class 19 in the name of Shalimar Colours (India) Pvt. Ltd.
- (ii) 'SHALIMAR' bearing no. 1321779 in class 19 in the name of Mr. Sunil Kumar Agarwal
- (iii) 'SHALIMAR' bearing no. 1729841 in class 19 in the name of S. Raghbir Singh

5. Insofar as the marks bearing no. 1321779 and 1729841 are concerned,



ld. Counsel for Appellant submits that they are abandoned.

6. Ld. Counsel for the Appellant also brings to the notice of this Court the substantial number of registrations with the prefix 'SHALI' which has 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 would show that the order dated 31st December, 2018 passed by the Hearing Officer (Senior Examiner of Trade Marks) 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. The marks cited in the examination report bearing no. 1321779 and 1729841 have already been abandoned. The third cited mark bearing no. 1015144 is SHALIMAR of Shalimar Colours India Pvt. Ltd. which is in respect of building material including cements, clinker, pipes (not of metal) etc. On the other hand, the Appellant's trade mark application is for the mark SHALIMARK for building material (non-metallic); Resin based



thermoplastic road marking compound; water based road marking compound.

11. Since, building material is common to the cited mark bearing no. 1015144 and to the applied mark, ld. counsel for the Appellant submits that he is willing to delete 'building material (non-metallic)' from the list of goods.

12. In view thereof, Appellant's trade mark application bearing no. 2873856 for the mark 'SHALIMARK' shall be restricted to the following goods:

*Resin based thermoplastic road marking
compound; water based road marking compound.*

13. Accordingly, the Appellant's application no. 2873856 shall proceed for advertisement for the aforementioned goods in class 19 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