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

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*Date of Decision : 27.05.2024*+ **LPA 436/2024 and CM APPL. 31881-31883/2024****SHIVKUMAR SHANKARRAO THAKUR & ORS.**

..... Appellants

Through: Mr.Sachin Gupta, Advocate.

versus

**SHIV BIRI MANUFACTURING CO P LTD & ANR.**

..... Respondents

Through: None.

**CORAM:****HON'BLE MR. JUSTICE VIBHU BAKHRU****HON'BLE MS. JUSTICE TARA VITASTA GANJU****VIBHU BAKHRU, J. (ORAL)**

1. The appellants have filed the present appeal impugning the order dated 25.04.2024 passed by the learned Single Judge in C.A.(COMM.IPD-TM) 157/2021 captioned *Shivkumar Shankarrao Thakur & Ors. v. Shiv Biri Manufacturing Co. P. Ltd. & Another*.

2. The appellants had filed the said appeal before the learned Single Judge impugning the order dated 11.10.2017 passed by the learned Registrar of Trade Marks (hereafter *the Registrar*) rejecting the appellants' opposition to the application (TM Application No.1068067) for registration of the trademark, which was allowed.

3. Respondent no.1 (hereafter *SBM*) had filed the said application seeking registration of the following trademark in Class 34 (Biri, Chewing



Tabacco, Zarda, Gutka etc.):



4. The aforesaid trademark is hereafter also referred to as '*the impugned trademark*'.
5. The said application was filed by SBM on 20.12.2001 claiming the use of the impugned trademark since 01.01.1987.
6. As stated above, the said application was allowed and the Registrar granted the registration of the impugned trademark on 30.11.2017.
7. The appellants had raised the objection principally on the ground that SBM had filed an application (No.769516 dated 17.09.1997) earlier, which was granted on 25.02.2010. In the said application SBM had claimed use of the trademark covered under the said application, since the year 1992. The appellants had opposed the said application as well. However, the said opposition was dismissed as well. The learned Registrar found that there were similarities between the trademark used by the appellants and the device trademark in respect of which the registration was sought by SBM under the said application (No.769516 dated 17.09.1997). However, in view of the extended use, the learned Registrar considered it fit to allow the said



application albeit with geographical limitations. The said registration was valid only in the States of West Bengal, Assam, Bihar, Uttar Pradesh, Punjab, Haryana, Delhi, and Rajasthan.

8. The appellants preferred an appeal against the order of the learned Registrar allowing registration (No.769516 in class 34) in favour of SBM before the Intellectual Property Appellate Board (hereafter *the IPAB*). However, the same was dismissed by the order dated 28.06.2013.

9. It is the appellants' case that the impugned trademark was similar to the trademark in respect of which registration was granted earlier, the registration was required to be rejected. And, if it was granted, it had to be with geographical limitations. The appellants also claimed that the respondent's assertion that it was using the impugned trademark since 01.01.1987, was palpably erroneous as the respondent's earlier application for registration of almost similar mark claimed use since the year 1992.

10. The said opposition was rejected.

11. The learned Single Judge had declined to interfere with the order of the learned Registrar granting registration of the aforementioned trademark pursuant to the TM Application No.1068067 and rejected the appellants' objection on the ground that the impugned trademark is completely different from the trademark in respect of which registration was granted earlier (SBM's application No.769516).

12. The learned counsel appearing on behalf of the appellants earnestly contended that SBM had falsely stated that it was using the impugned mark



since 01.01.1987. He submits that the said claim is *ex facie* false as SBM had applied for the registration in the earlier round (which was granted) claiming use of the trademark since the year 1992. He further submits that the impugned mark is identical to the idea as projected by the trademark, which was registered earlier. He states that the overall commercial impression of both the marks (the trademark which was registered earlier and the impugned mark) is similar.

13. It is relevant to refer to two competing marks (the impugned trademark and trademarks used by the appellants). The same are set out below: -

| Appellant's mark                                                                                                                                            | Respondent's mark                                                                                                                                                                                                                                                                                                                            |                           |  |                                 |               |                                                                                                                                |
|-------------------------------------------------------------------------------------------------------------------------------------------------------------|----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|---------------------------|--|---------------------------------|---------------|--------------------------------------------------------------------------------------------------------------------------------|
| <p>SHANKAR<br/>No. 115757 dt. 04.12.1945<br/>use claimed 01.01.1920</p>  | <p><u>Subject Matter</u></p>  <p>No. 1068067 dt. 20.12.2001.<br/>User claim: 01.01.1987</p>                                                                                                                                                              |                           |  |                                 |               |                                                                                                                                |
| <p>No. 113385 dt. 12.09.1945<br/>use claimed 31.03.1905</p>              | <p><u>Translated Copy</u></p> <table><tr><td colspan="2">No. 203 SPECIAL SHIV BIRI</td></tr><tr><td>No. 203 SPECIAL<br/>SHIV<br/>BIRI</td><td rowspan="2">Person's face</td></tr><tr><td>M/s. M R Biri Factory<br/>M/s. Shiv Biri Manufacturing Co. Pvt. Ltd.<br/>Aurangabad, Murshidabad<br/>RC No. 13/CH.24/BIRI/ABDS/92</td></tr></table> | No. 203 SPECIAL SHIV BIRI |  | No. 203 SPECIAL<br>SHIV<br>BIRI | Person's face | M/s. M R Biri Factory<br>M/s. Shiv Biri Manufacturing Co. Pvt. Ltd.<br>Aurangabad, Murshidabad<br>RC No. 13/CH.24/BIRI/ABDS/92 |
| No. 203 SPECIAL SHIV BIRI                                                                                                                                   |                                                                                                                                                                                                                                                                                                                                              |                           |  |                                 |               |                                                                                                                                |
| No. 203 SPECIAL<br>SHIV<br>BIRI                                                                                                                             | Person's face                                                                                                                                                                                                                                                                                                                                |                           |  |                                 |               |                                                                                                                                |
| M/s. M R Biri Factory<br>M/s. Shiv Biri Manufacturing Co. Pvt. Ltd.<br>Aurangabad, Murshidabad<br>RC No. 13/CH.24/BIRI/ABDS/92                              |                                                                                                                                                                                                                                                                                                                                              |                           |  |                                 |               |                                                                                                                                |



|                                                                                                                                                                                                                                                                                                                                                                                                     |                                                                                                                                                                                                                                                                                                                                                                                                                                                              |                                                                   |  |           |         |           |         |             |                            |                                                                                                |  |                              |  |
|-----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|--------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|-------------------------------------------------------------------|--|-----------|---------|-----------|---------|-------------|----------------------------|------------------------------------------------------------------------------------------------|--|------------------------------|--|
| <p>No. 111791 dt. 16.07.1945<br/>use claimed 01.01.1917</p>                                                                                                                                                                                                                                                        | <table><tr><td colspan="2">Export Quality Beware Of Counterfeit<br/>NO. 203 SPECIAL SHIV BIRI</td></tr><tr><td>2 No. 203</td><td>No. 203</td></tr><tr><td>0 Special</td><td>Special</td></tr><tr><td>3 Shiv Biri</td><td>Person's face<br/>Shiv Biri</td></tr><tr><td colspan="2">M/s. M R Biri Factory<br/>M/s. Shiv Biri Manufacturing Co. Pvt. Ltd.<br/>Aurangabad, Murshidabad</td></tr><tr><td>No. 203 Special Shiv<br/>Biri</td><td></td></tr></table> | Export Quality Beware Of Counterfeit<br>NO. 203 SPECIAL SHIV BIRI |  | 2 No. 203 | No. 203 | 0 Special | Special | 3 Shiv Biri | Person's face<br>Shiv Biri | M/s. M R Biri Factory<br>M/s. Shiv Biri Manufacturing Co. Pvt. Ltd.<br>Aurangabad, Murshidabad |  | No. 203 Special Shiv<br>Biri |  |
| Export Quality Beware Of Counterfeit<br>NO. 203 SPECIAL SHIV BIRI                                                                                                                                                                                                                                                                                                                                   |                                                                                                                                                                                                                                                                                                                                                                                                                                                              |                                                                   |  |           |         |           |         |             |                            |                                                                                                |  |                              |  |
| 2 No. 203                                                                                                                                                                                                                                                                                                                                                                                           | No. 203                                                                                                                                                                                                                                                                                                                                                                                                                                                      |                                                                   |  |           |         |           |         |             |                            |                                                                                                |  |                              |  |
| 0 Special                                                                                                                                                                                                                                                                                                                                                                                           | Special                                                                                                                                                                                                                                                                                                                                                                                                                                                      |                                                                   |  |           |         |           |         |             |                            |                                                                                                |  |                              |  |
| 3 Shiv Biri                                                                                                                                                                                                                                                                                                                                                                                         | Person's face<br>Shiv Biri                                                                                                                                                                                                                                                                                                                                                                                                                                   |                                                                   |  |           |         |           |         |             |                            |                                                                                                |  |                              |  |
| M/s. M R Biri Factory<br>M/s. Shiv Biri Manufacturing Co. Pvt. Ltd.<br>Aurangabad, Murshidabad                                                                                                                                                                                                                                                                                                      |                                                                                                                                                                                                                                                                                                                                                                                                                                                              |                                                                   |  |           |         |           |         |             |                            |                                                                                                |  |                              |  |
| No. 203 Special Shiv<br>Biri                                                                                                                                                                                                                                                                                                                                                                        |                                                                                                                                                                                                                                                                                                                                                                                                                                                              |                                                                   |  |           |         |           |         |             |                            |                                                                                                |  |                              |  |
| <p>No. 4211 dt. 27.08.1942<br/>use claimed 01.01.1920</p>                                                                                                                                                                                                                                                         |                                                                                                                                                                                                                                                                                                                                                                                                                                                              |                                                                   |  |           |         |           |         |             |                            |                                                                                                |  |                              |  |
| <p>No. 4212 dt. 27.08.1942<br/>use claimed 31.12.1925</p>                                                                                                                                                                                                                                                        |                                                                                                                                                                                                                                                                                                                                                                                                                                                              |                                                                   |  |           |         |           |         |             |                            |                                                                                                |  |                              |  |
| <p>No. 111793 dt. 16.07.1945<br/>under proposed to be used basis</p>  <p>All registrations are subject to geographical limitation i.e. "for Bidis not for sale in the Central Provinces, Berar, Bihar, Bengal, Assam, Punjab, Marwar, Rajputana and in the Districts of Khandesh in the province of Bombay."</p> |                                                                                                                                                                                                                                                                                                                                                                                                                                                              |                                                                   |  |           |         |           |         |             |                            |                                                                                                |  |                              |  |

14. It is apparent from the plain visual examination that there is little similarity between the two competing marks. The learned Single Judge examined the same and found that there is no deceptive similarity between



the appellants' trademarks and the impugned trademark. The learned counsel for the appellant has not pointed out any evidence of confusion between the competing trademarks. We concur with the view of the learned Single judge that the impugned trademark is not similar to the appellant's trademarks.

15. It is also relevant to refer to the trade mark of SBM, which is set out below: -



No.769516 dated 17.09.1997 use claimed 01.04.1992

*BIRI FOR SALE IN THE STATES OF WEST BENGAL, M.  
P, BIHAR, UTTAR PRADESH, PUNJAB, HARAYANA,  
DELHI AND RAJASTHAN ONLY."*

16. It is apparent that the above mark of SBM (No. 769516) is not similar to the impugned trademark. The aforesaid mark also includes the pictorial depiction of Lord Shiva, which to some extent could be considered as similar to the pictorial depiction in the appellants' trademark. However, the impugned mark does not include any such pictorial depiction, but the photograph of the partner /director of SBM.



17. Since, the learned Single Judge found no similarity between the appellants' mark and the impugned trademark, the Court declined to further examine the controversy regarding the prior use of the said trademark. Clearly, if the impugned mark is found to be dissimilar to the appellants' trademark any controversy as to when SBM had adopted the said mark would be of little relevance.

18. As noticed above, the appellants' case is based on the Registrar's decision in respect of the earlier registration (No. 769516). The same is not of much relevance considering that the impugned trademark cannot held to be deceptively similar to that of the appellants' competing trademarks.

19. Accordingly, we find no infirmity in the impugned order.

20. The appeal is unmerited and accordingly stands dismissed. All pending applications are also disposed of.

21. The parties to bear their own costs.

**VIBHU BAKHRU, J**

**TARA VITASTA GANJU, J**

**MAY 27, 2024**

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*Click here to check corrigendum, if any*