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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**
+ **C.A.(COMM.IPD-TM) 157/2021**
SHIVKUMAR SHANKARRAO THAKUR AND ORS. ... Appellants

Through: Mr. Sachin Gupta, Ms. Prashansa
Singh, Mr. Rohit Pradhan and Mr.
Manan Mondal, Advs.

versus

SHIV BIRI MANUFACTURING CO.P.LTD. AND ANR

..... Respondents

Through: Dr. Ashok Soni, Sr. Adv. with Mr.
Gagan Narang, Ms. Urvi Syal, Mr.
Romil Bagrecha, Mr. Aman Soni and
Mr. Yash Dadhich, Advs.
Mr. Harish Vaidyanathan Shankar,
CGSC with Mr. Srish Kumar Mishra,
Mr. Alexander Mathai Paikaday, Mr.
Lakshay Gunawat and Mr. Krishnan
V., Advs.

CORAM:
HON'BLE MR. JUSTICE ANISH DAYAL

ORDER
25.04.2024

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1. This appeal assails order dated 11th October, 2017 passed by the Registrar of Trade Marks rejecting the opposition filed by the respondent (No.175331) to the trademark application No.1068067 (“**impugned registration**”) filed by the respondent for the following mark in Class 34 (Biri, Chewing Tobacco, Zarda, Gutka etc.):



2. The said mark was applied for by the respondent on 20th December, 2001, with user detail of 01st January, 1987, and registration was granted on 30th November, 2017.
3. The opposition by the petitioner was partially based upon an earlier opposition that had been filed by the petitioner against an earlier registration application by the respondent No.769516 (dated 17th September, 1997 on ‘*proposed to be used*’ basis in Class 34) which was granted on 25th February, 2010. The opposition to this prior registration had been dismissed by the Registrar of Trade Marks, however, a geographical limitation was provided for the respondent to sell only in the States of West Bengal, Assam, Bihar, Uttar Pradesh, Punjab, Haryana, Delhi and Rajasthan.
4. An appeal had been filed by the petitioner against the said order of the Registrar of Trade Marks before the Intellectual Property Appellate Board (“**IPAB**”), which was also dismissed on 28th June, 2013.



5. Mr. Sachin Gupta, Counsel for the petitioner, contends that since there was a geographical limitation prescribed for the earlier registration of the respondent, the same geographical limitation may be prescribed for the impugned registration as well.

6. Further, he states that the earlier registration filed in 1997 was on a '*proposed to be used*' basis, while in the later registration, user was claimed since 01st January, 1987, which is dishonest and cannot be allowed, especially since no evidence of use has been produced.

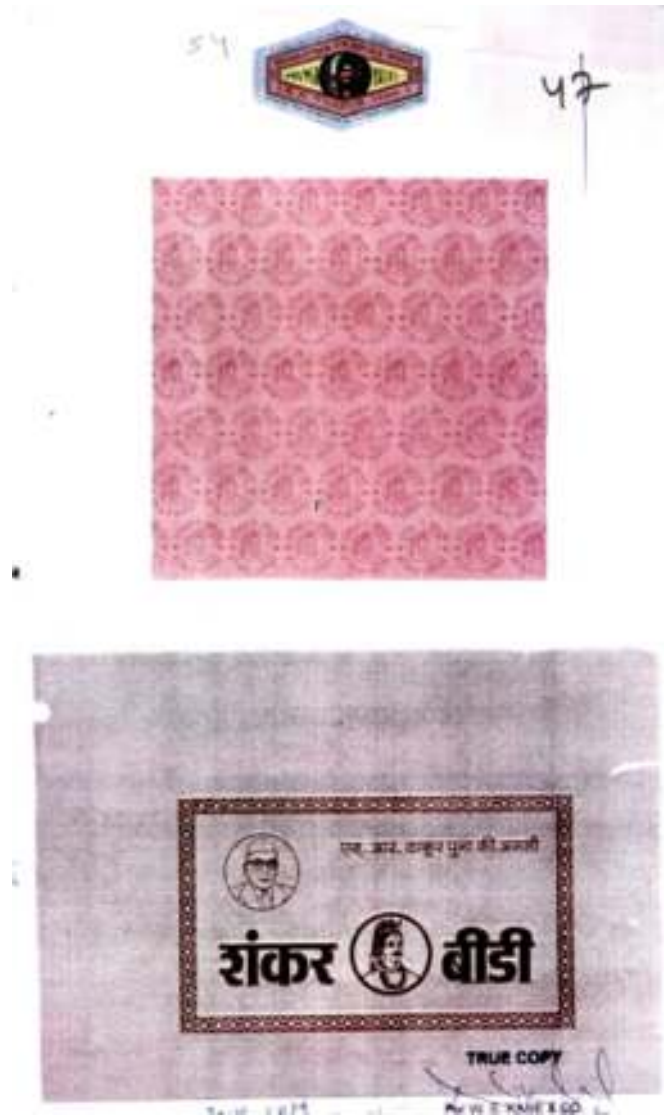
7. Dr. Soni, Senior Counsel appearing on behalf of the respondent through VC, contends that the plea of geographical limitation with respect to the impugned mark registered is untenable on the ground that the impugned mark adopted by the respondent is different in various respects from the earlier registered mark, in that, it does not have a picture of Lord Shiva, and in any event, it is completely dissimilar in all respects to that of the petitioner's mark which is as under:



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8. He contends that the geographical limitation applied to the earlier mark, and does not necessarily act as a precedent for the subsequent mark, and respondent's opposition was dismissed on merits by the Registrar in both these occasions, and was also deliberated upon by the IPAB for the earlier mark.

9. This Court has perused the disputed marks of the petitioner and the respondent, and does not find any similarity in the same, let alone deceptive



similarity. Considering that, firstly, the trademark used by the petitioner is either in '*Lawangi Biris*' and with the byline '*S R Thakur Poona City*' in English and Hindi. The petitioner's packaging has a small imprint saying '*Shankar Biri*' with a picture of Lord Shankar. One isolated mark of the petitioner, as noted, above has simpliciter '*Shankar Biri*' on it, again with the description '*S R Thakur Poona Ki Asli*'. There is no doubt that such comprehensive artistic work in description is categorical and identifies the source of these goods.

10. The respondent's mark, on the other hand, which is impugned herein, has '*No.203 Special Shiv Biri*' in English and Hindi printed on the label, with a picture of a person who is identified as Zakir Hussain, one of the partners of the respondent and now the director. The said label does not have any picture of Lord Shankar and has other elements which are completely distinctive and different from that of the petitioner's mark. There is no similarity in the device in any form, either in the artistic work or in the various elements on the label, the font or otherwise, in the main trademark used by the parties.

11. In this regard, considering the above, the petitioner's case is not made out as there is distinctive dissimilarity between the two marks and, therefore, rectification at the behest of the petitioner of the respondent's mark cannot be allowed.

12. As regards the contention that a user of 01st January, 1987 was claimed for the registration of the impugned mark, it is noted that the two marks registered by the respondent are completely different. In any event, since the marks are completely dissimilar, and that the petitioner's case has no legs to



stand on, this needn't be dwelled upon.

13. Furthermore, the Court has perused the impugned order and does not find any infirmity in the same. An argument was raised by petitioner's counsel that the issue of geographical limitation was erroneously dismissed by the impugned order in the last paragraph. However, since the Court has gone through the documents and the marks, it may not be necessary to delve further on this issue or, in fact, remand the matter just for this purpose. The geographical limitation was applied to the earlier mark, which was completely different from the impugned mark, and therefore, cannot operate as a precedent for subsequent marks sought to be registered, particularly since the impugned mark is distinctively different from the petitioner's mark.

14. Accordingly, the petition is disposed of.

15. Pending applications, if any, are rendered infructuous.

16. Order be uploaded on the website of this Court.

ANISH DAYAL, J

APRIL 25, 2024/MK