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

+ **C.A.(COMM.IPD-TM) 75/2025**

JINDAL STEEL LIMITED

.....Appellant

Through: Mr. Hemant Singh, Ms. Mamta Rani Jha, Mr. Manish Kumar Mishrak, Ms. Akansha Singh, Ms. Niharika Kapoor, Mr. Saransh Saini, Ms. Saloni Raghuvanchi, Mr. Manish Kharbanda and Mr. Shivanshu Kumar, Advocates.

versus

REGISTRAR OF TRADE MARKS

.....Respondent

Through: Ms. Nidhi Raman, CGSC with Mr. Om Ram, Advocate.

CORAM:

HON'BLE MS. JUSTICE JYOTI SINGH

ORDER

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17.02.2026

1. This appeal is filed on behalf of the Appellant under Section 91 of the Trade Marks Act, 1999 ('1999 Act') read with Rule 156 of the Trade Marks Rules, 2017 challenging order dated 25.07.2025 passed by the Respondent refusing the application no. 5443972 in Class 06 for the trademark JSP. Direction is sought to the Respondent to proceed with the advertisement in the Trade Marks Journal.
2. As pleaded in the appeal, Appellant was incorporated in 1979 as Orbit Strips Private Limited and became a public limited company in 1998, when it changed its name to Jindal Steel and Power Limited. In general public and members of the trade, the company is known and referred to as 'JSPL' and 'JSP'. Such references are also made in annual reports of the Appellant as also in various correspondences, press coverages, promotional material etc.



Appellant is globally recognized in the business of mining iron ore and coal and in terms of tonnage, it is the third largest steel producer in India and is manufacturing sponge iron, ferro alloys and wide range of hot-rolled and cold-rolled products ranging from HR coils to CR coils and coated pipes etc. for several decades. Jindal group has not only diversified into power generation but also infrastructure and mineral exploration and presently, the group has manufacturing bases across India, Africa and Australia.

3. It is stated that Appellant has been using the marks JSP and JSPL as acronyms for Jindal Steel and Power/Jindal Steel & Power Limited to denote origin of the products. Application bearing no. 5286727 was filed for the trademark JSPL in class 06 with user claim of 02.04.1998 and the mark JSP acts as a source identifier for all goods manufactured by the Appellant to the extent that a potential customer will instantly associate the said trademark JSP solely and exclusively with the Appellant. Further, Appellant is using JSP on its website including <https://www.jsplstructurals.com/championship/> as well as on social media pages such as Facebook, Twitter etc. Appellant holds valid registrations for variations of JSPL in Class 06 as follows:-

S.No.	Trade mark	Appl./Reg. No.	Class
1.	 PANTHER	2563581	06
2.	JSPL TMT	2563583	06
3.	JSPL QUICKBUILD	2731001	06



4. It is stated that Appellant filed trademark application on 11.05.2022 for registration of the mark JSP bearing no. 5443972 in Class 06, the goods being '*Common metals and their alloys, ores; sponge iron; pig iron, metal materials for building and construction; steel slabs, ingots, billets, mild steel casting and blooms, alloy steel scraps; wire rod, iron beams, steel beams, TMT re-bars, steel, steel in the form of sheets, plates, foils and coils, plated steel, rolled steel, cold-finished steel bars, steel wire and rods, flange, angles and channels, steel flooring, crude steel and semi-finished steel products*' on 'proposed to be used' basis. On 12.08.2022, Respondent issued the Examination Report (ER), to which response was filed by the Appellant on 12.09.2022. In the ER, objection was raised under Section 11(1) of 1999 Act on the ground that the applied mark was identical with or similar to the cited mark **JSP** (device).

5. It is stated that in the detailed reply filed to the ER, Appellant raised multiple grounds to show that the objection was unjustified and also filed additional submissions along with documents on 21.10.2024. It was stated that cancellation/rectification had been filed against the cited mark **JSP** registered in the name of Mr. Nitin Mehta trading as Shweta Overseas, under registration no. 2466950. The application was set down for hearing for 29.01.2025 and after the hearing, vide order dated 25.07.2025 Respondent refused registration of the mark JSP under Section 11(1) of 1999 Act.

6. Mr. Hemant Singh, learned Counsel for the Appellant submits that Appellant has made an application bearing no. 5286727 in Class 06 in respect of mark JSPL with user claim of 02.04.1998 and three formative marks of JSPL have been registered in Class 06. Appellant is a well



established and globally recognised company, which has grown manifold in the business of mining, coils, coated pipes etc. for decades and is presently manufacturing in Africa and Australia also. The mark JSP is an acronym for Jindal Steel & Power and acts as a source identifier for all goods manufactured by the Appellant such that the potential customer will instantly associate JSP with the Appellant only.

7. It is urged that use of JSPL amounts to use of JSP in terms of Section 55 of 1999 Act, which provides that where the use of a registered trademark is required to be proved for any purpose, Tribunal may accept the use of one of the associated trademark or substantially identical trademarks for proving use of the trademark in question. Further, Appellant is using the mark JSP on its website and social media pages and the mark is well known amongst the traders and the members of public and is identified with goods, businesses and services originating from and/or associated with the Appellant and none else. This is evident from the Google search for the trademark JSP PANTHER, which shows only the website and business of the Appellant. It is submitted that Appellant had brought forth this point before the Respondent and benefit of Section 55 was sought, relying on the decision of IPAB in the case of ***P. Kamala Devi Chordia v. P. Ganeshan and Others., 2004 SCC OnLine IPAB 22***, where it was held that Section 54(1) (now Section 55) enables the authority to accept the use of a registered associated trademark or of a trademark with any other addition or alteration, not substantially affecting its identity, however, Respondent has not even referred to this argument, which has resulted in grave injustice to the Appellant.

8. It is further argued that Appellant brought forth in the reply to the ER



that the registered proprietor of the cited mark **JSP** was neither a prior adopter nor prior user of the said trademark and the purported user claim of 01.01.2013 was baseless and unfounded. In fact, the registered proprietor adopted the mark dishonestly with the sole intent to ride upon the goodwill and reputation acquired by the mark JSPL due to its long, continuous and commercial use since 1998. Therefore, the cited mark **JSP** cannot be a bar for registering the JSP mark of the Appellant and the application ought to have proceeded for registration, by virtue of provisions of Section 34 of 1999 Act, which emphasises the 'first user rule'. The provision stipulates that no provision of the Trade Marks Act shall let any registered user of the registered trademark interfere with/refrain use of a person who has been using any identical/similar trademark for a period of time prior to the date of first use or registration of the first mentioned trademark. The 'first user rule' in Section 34 has been recognised by the Supreme Court in *S. Syed Mohideen v. P. Sulochana Bai*, 2015 SCC OnLine SC 1084 and *Neon Laboratories Limited v. Medical Technologies Limited and Others*, 2015 SCC OnLine SC 905. Respondent ignored and overlooked the material placed on record by the Appellant to show extensive use of the JSP mark.

9. Insofar as registration of the cited mark JSP in favour of Shweta Overseas is concerned, it is argued that the mark was registered on 01.01.2013, which is well after adoption and user of trademark JSPL and hence proprietor of the cited mark cannot claim a superior right. In in any event, Appellant has filed a rectification/cancellation petition challenging the validity of the cited mark **JSP** and hence, the Hearing Officer ought to have awaited the decision in the said petition, before refusing registration



in the case of subject application.

10. Mr. Singh further submits that JSP is a dominant component of the mark JSPL and even if JSP is identical to the cited mark **JSP**, Appellant is entitled to registration of the mark JSP under Section 12 of 1999 Act, which grants discretion to the Registrar to register marks of more than one proprietor which are identical or similar and are in respect of same or similar goods/services, in case there is honest and concurrent use or there exist other special circumstances, which in the opinion of the Registrar make it proper to do so.

11. In furtherance of this argument, it is fairly urged that *albeit* Appellant did not directly urge honest and concurrent use under Section 12 of 1999 Act before the Respondent, however, it had specifically pleaded prior use of the trademark, which was sufficient for the Respondent to exercise discretion under Section 12 and grant registration on ground of honest and concurrent use and in support of this plea, reliance is placed on the judgment of the Division Bench of this Court in ***Alkem Laboratories Ltd. v. Mega International (P) Ltd., 2009 SCC OnLine Del 2878***. To sum up, Mr. Hemant Singh argues that Respondent did not consider the crucial issues flagged by the Appellant in the comprehensive reply to the ER as also the additional submissions and has ignored the relevant material on record and hence, the matter deserves to be remanded to the Respondent for re-consideration of the trademark application. Reliance is placed on the judgment of Bombay High Court in ***Yamaha Hatsudoki Kabushiki Kaisha v. Registrar of Trade Marks, 2025 SCC OnLine Bom 2332***, where the matter was remanded on the short ground that the Registrar had not



considered the submissions made by the party concerned and there was non-application of mind.

12. Ms. Nidhi Raman, CGSC, appearing for the Respondent defends the impugned order refusing registration of the trademark JSP. She submits that refusal was primarily on the ground that Appellant's mark is identical/similar to the cited trademark **JSP** and covers similar description of goods, thereby creating likelihood of confusion on the part of the public under Section 11(1) of 1999 Act. The dominant and essential part of the cited mark is the textual element **JSP** and when the said mark is compared with Appellant's mark JSP, both are clearly phonetically identical and visually deceptively similar and addition of a device or stylization in the cited mark does not detract from the identity of the word element itself.

13. It is urged that it is a settled law that where the prominent feature of a composite mark i.e., the cited mark is identical to the applied mark and goods are identical/similar, likelihood of confusion is presumed. A consumer with average intelligence and imperfect recollection is likely to wonder whether the goods under Appellant's JSP mark emanate from the same source as the goods under the cited mark **JSP**. In the instant case, both marks are concerned with Class 06 and comparison of the goods in question i.e., doors and windows fittings, handles, knobs, hinges, latches of the registered proprietor and metal materials for building and construction, steel slabs, billets, wire rod, foils and coils etc. of the Appellant overlap and are sold through same trade channels i.e., hardware stores and shops supplying constructions materials to the same class of consumers.

14. It is further argued that Appellant cannot seek benefit of Section 34 of



1999 Act to claim superior rights over the cited mark for which user claim goes back to 01.01.2013 while Appellant filed the application in 2022 on a 'proposed to be used' basis. In respect of the pending rectification against the cited mark, it is submitted that this does not operate as a bar on the Registrar's power to refuse an application for registration of a conflicting mark since on the date of refusal, the cited mark was a validly registered trademark and hence, Registrar has rightly declined registration under Section 11(1) 1999 Act, which imposes a mandatory bar on registration of a mark which is identical/similar to an earlier trademark for identical/similar goods.

15. I have heard learned Counsels for the parties and examined their submissions.

16. Indisputably, Respondent has refused registration of Appellant's mark JSP under Section 11(1) on the ground that it is similar to the cited mark JSP and both have similar description of goods, which is likely to cause confusion on the part of the public. After the ER was issued raising an objection under Section 11(1), Appellant filed a detailed and comprehensive reply dated 12.09.2022, responding to the objections raised. Broadly captured, case of the Appellant was and is that:-

(a) marks JSPL and JSP are acronyms for Jindal Steel & Power and application for trademark JSPL has been made in Class 06 with user claim from 02.04.1998. Just as JSPL, trademark JSP acts as a source identifier for all goods manufactured and supplied by the Appellant to such an extent that a potential customer instantly associates JSP solely and exclusively with the Appellant *qua* source



and origin. Therefore, under Section 55 of 1999 Act, Respondent ought to have accepted the use of JSPL as equivalent to the use of JSP;

(b) registered proprietor of cited mark **JSP** with registration No. 2466950 is neither a prior adopter nor user of the said mark from 01.01.2013, as claimed. In fact, registered proprietor has adopted the cited mark only with an intent to ride upon the goodwill and reputation acquired by trademark JSPL owing to its continuous, long, extensive and commercial use since 1998 and the adoption is thus, dishonest;

(c) Appellant's application for registration ought to have proceeded for registration owing to the 'first user rule' emanating from Section 34 of 1999 Act as also the law settled by the Supreme Court in *S. Syed (supra)* and *Neon Laboratories (supra)*; and

(d) Appellant has filed a rectification petition bearing no. 284601 against the cited mark **JSP** bearing registration No. 2466950 and hence, Respondent ought to have waited for the outcome of the petition and/or should have heard the rectification petition and the instant application for registration, together.

17. It is not disputed and cannot be disputed by learned Counsel for the Respondent that the above issues were flagged and highlighted by the Appellant before the Respondent in the reply to the ER. Since the application for registration has been refused on the alleged similarity between the applied mark and the cited mark, with similar description of goods under Section 11(1) of 1999 Act, the points raised by the Appellant



seeking benefit of Sections 55 and 34 of 1999 Act had a bearing on the just adjudication of the application. However, a plain reading of the impugned order dated 25.07.2025 indicates that none of these points have been considered by the Registrar. The order is indeed a non-speaking order and the Registrar has simply proceeded on the ground that the applied trademark is similar to the cited trademark and the goods are also similar, completely oblivious of the crucial issues raised by the Appellant. Time and again, the Supreme Court and the High Courts have insisted that even the quasi-judicial authorities must consider all relevant points and material placed before them and apply their minds before taking a decision. If the relevant material is not taken into consideration, in a given case it may lead to an unjust decision against one party and therefore, it is imperative that a reasoned and speaking order is passed indicating cogent reasons which have weighed with the authority to come to a certain decision. The reasons in the order would give an insight into the factors leading upto the decision, both to the parties concerned and the Courts testing the legality of the order in question.

18. The impugned order dated 25.07.2025 suffers from lack of reasoning as also suffers from non-application of mind to the detailed submissions made by the Appellant, as captured above. The Bombay High Court in ***I Am The Ocean, LLC v. Registrar of Trade Marks, MANU/MH/2701/2023*** remanded the matter back to the Registrar of the Trade Marks on the ground that the impugned order was passed without considering the submissions made by the petitioner therein. It was observed that the impugned order lacked cogent reasons. Bombay High Court highlighted that in several matters in the past, submissions and documents which formed part of the



replies, were not considered by the Registrars of Trade Marks and that the least that was expected of an adjudicating officer was to peruse the reply and extend the bare courtesy of application of mind and not doing so will be complete abdication of quasi judicial functions vested in the Registrar. In the above circumstances, I am of the view that the matter needs to be remanded to the Respondent for re-consideration.

19. Accordingly, the appeal is partially allowed remanding the matter for fresh consideration of the application filed by the Appellant for registration of the mark JSP. It is further directed that the application will be considered by the Respondent along with the pending rectification application bearing No.284601, with advance intimation to all parties of the date of hearing.

20. Needless to state that the order(s) will be passed after hearing the concerned parties and considering the issues raised and shall be reasoned and speaking order(s). It is made clear that this Court has not expressed any opinion on the merits of the case and Respondent shall decide the matter in accordance with law.

JYOTI SINGH, J

FEBRUARY 17, 2026/YA