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

+ **C.A.(COMM.IPD-TM) 81/2025**

SEEMA GOEL

.....Appellant

Through: Mr. Roop Singh, Advocate.

versus

THE REGISTRAR OF TRADE MARKS

.....Respondent

Through: Ms. Nidhi Raman, CGSC with Mr. Om Ram and Mr. Arnav Mittal, Advocates.

CORAM:

HON'BLE MS. JUSTICE JYOTI SINGH

ORDER

29.01.2026

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1. This appeal is filed on behalf of the Appellant under Section 91 of the Trade Marks Act, 1999 ('1999 Act') laying a challenge to impugned order dated 12.08.2025 passed by the learned Registrar of Trade Marks in Trademark Application No. 4550705 filed by the Appellant, whereby

Respondent has refused registration of the trademark  citing two trademarks stated to be deceptively similar to the applied trademark.

2. Case of the Appellant is that she adopted the trademark  and started using the trademark from 19.06.2019. On 30.06.2020, Appellant filed an application for registration of the said trademark in Form TM-A bearing Application No. 4550705 for goods and services in Class 35 i.e., retailing of fashion jewellery, ladies bags and purses and ladies garments. On 25.08.2020, Respondent issued an Examination Report calling upon the



Appellant to file a reply within one month. Respondent objected to registration under Section 11(1) of 1999 Act on the ground that the applied trademark was identical with or similar to earlier two trademarks in respect of identical or similar description of goods and there was thus likelihood of confusion in the members of the public. The cited trademarks were  and  under Application Nos. 4264942 and 4467210 respectively, both registered in Class 25 with description of goods being '*clothing, headgear and footwear*' and '*clothing, footwear and headwear*' respectively.

3. It is stated that Appellant filed a reply to the Examination Report on 24.09.2020, after which hearing notice was issued on 25.10.2024 fixing online hearing for 04.12.2024, which the Appellant attended. Appellant pointed out that there was some discrepancy in the Examination Report uploaded on Registry's website and that the Examination Report dated 30.09.2020 was not received by the Appellant. Respondent permitted the Appellant to file a reply to the Examination Report dated 30.09.2020 on the date of hearing itself, which the Appellant did. Second notice was issued for hearing on 24.02.2025 and after the hearing was concluded, written submissions were filed by the Appellant. Appellant also filed a request to amend the name of the trademark from 'OLIVE and design' to 'OLIVE and Device'. Thereafter, hearings were held on several dates and finally vide impugned order dated 12.08.2025, Respondent refused to register the trademark.

4. Learned counsel for the Appellant submits that the impugned order is arbitrary and illegal and passed without considering the correct facts and



law. Appellant is an individual trading under the brand OLIVE founded in June, 2019, primarily dealing in retail of fashion jewellery, ladies bags, purses and garments. She has been using the trademark continuously and extensively since 19.06.2019 with respect to goods covered in Classes 14, 18, 25 and 35. Appellant had filed an 'affidavit of use' along with proof showing use of the trademark since 19.06.2019 and stating that the brand OLIVE had acquired enviable reputation in the market.

5. It is argued that Respondent failed to appreciate that Appellant has already secured registrations of the mark  in Classes 18 and 25 and therefore, there was no reason to deny registration in Class 35. The registrations are as follows:-

Sl. No.	Trademark	Class/goods and services	Trademark Application No., filing date, date of use and date of registration
1.		18 Ladies bags and purses	TM 4550703 Date of filing: 30.06.2020 Date of use: 19.06.2019 Date of registration: 06.07.2024
2.		25 Ladies apparel	TM 4550704 Date of filing: 30.06.2020 Date of use: 19.06.2019 Date of registration: 09.11.2023

6. Learned counsel argued that Appellant is the 'prior adopter' and 'prior user' of the applied trademark and hence, by being 'first in the market' to adopt and use the trademark, she has acquired a superior right over the cited



trademarks. The first cited trademark in the impugned order bearing Application No. 4264942 was applied on 14.08.2019 on 'proposed to be used' basis and the second cited trademark bearing Application No. 4467210 was applied on 09.03.2020, stated to be in use from 01.11.2019. Therefore, clearly, both the cited trademarks were not used prior to user of the applied mark by the Appellant. It is urged that Section 34 of 1999 Act recognises and protects the rights of prior users and therefore, registration of a prior user could not have been refused by the Respondent. Learned counsel relies on the judgments of the Supreme Court in *Milmet Oftho Industries and Others v. Allergan Inc., (2004) 12 SCC 624; Neon Laboratories Limited v. Medical Technologies Limited and Others, (2016) 2 SCC 672; and S. Syed Mohideen v. P. Sulochana Bai, (2016) 2 SCC 683*, to support the proposition that prior user's rights override the rights of the subsequent user even though the latter's trademark may be registered. Reliance is also placed on the judgment of this Court in *Kia Wang v. Registrar of Trademarks and Another, 2023 SCC OnLine Del 5844*, where Court has emphasised on the superior rights of a prior user as against a registered proprietor.

7. It is also argued that Respondent failed to appreciate that the applied trademark and the cited trademarks are visually, structurally and phonetically different and have no resemblance. Any prudent customer with average intelligence and imperfect recollection will be able to distinguish between them. Last but not the least, learned counsel also relies on Section 11(1) of 1999 Act to argue that the proscription to register a trademark arises when the applied trademark because of its identity with an earlier trademark and similarity of goods or services or its similarity with an earlier trademark and identity or similarity with the goods and services



covered by the trademark, is likely to cause confusion on the part of the public, which includes likelihood of association with the earlier trademark. In the instant case, the earlier trademark is the trademark of the Appellant and therefore, registration could not be refused under Section 11(1) of 1999 Act.

8. Ms. Nidhi Raman, learned CGSC arguing on behalf of the Respondent opposes the appeal and defends the impugned order dated 12.08.2025. It is submitted that the order is well-reasoned and based on sound principles of law and provisions of 1999 Act, more specifically Section 11(1) have been correctly applied to protect the rights of registered proprietors and public interest against confusion. Section 11 of 1999 Act provides that a trademark shall not be registered if because of its identity with an earlier trademark and similarity of goods/services covered by the trademark or because of its similarity to an earlier trademark and identity/similarity of goods/services covered by the trademark, there exists a likelihood of confusion in public, which includes likelihood of association with earlier trademark. In the present case, the mark has been refused for registration owing to high degree of phonetic and visual similarities between the dominant parts of the cited marks and the applied mark, which is likely to create confusion. When the essential features of the applied mark and the cited marks are compared, the similarity is apparent and addition of minor artistic elements or tag lines do not sufficiently distinguish the marks in the eyes of a consumer of average intelligence and imperfect recollection. Therefore, allowing the registration of Appellant's mark would inevitably result in confusion in the market as consumers would associate her goods with the established sources of the cited marks.



9. It is further submitted that goods and services under the subject mark are similar to those covered by the cited marks. It is settled that even if marks are applied for registration in different classes, a conflict arises if the services are integral to the sale of those specified goods. In the instant case,

retailing of fashion accessories or garments under the mark  is directly complimentary to the OLIVE branded clothing and footwear, for which the cited marks are registered. This will reinforce the likelihood of confusion. The conflict will arise as the average consumer may perceive that the retail services in Class 35 and specific goods such as clothing in Class 25 originate from the same source. Reliance is placed on the judgment of the Supreme Court in ***Corn Products Refining Co. v. Shangrila Food Products Ltd., 1959 SCC OnLine SC 11***, where the Supreme Court held that absolute identity of two competing marks or their close resemblance is only one of the tests for determining likelihood of confusion and trade connection between different goods is the other test.

10. It is further argued that the word 'OLIVE' is the most prominent and essential feature of Appellant's mark and is identical to the dominant part of the cited marks i.e. OLIVE. In ***M/s. South India Beverages Pvt. Ltd. v. General Mills Marketing Inc. & Anr., 2014 SCC OnLine Del 1953***, this Court held that dominant features are significant because they attract attention and consumers are more likely to remember and rely on them for identification of the product. Therefore, addition of secondary matter by the Appellant such as tagline 'Spice Up Your Style' does not cure the defect of deceptive similarity.

11. With respect to the claim of prior user raised by the Appellant,



learned counsel for Respondent submits that in order to succeed on the basis of prior use as against the statutory rights of a registered proprietor, Appellant was required to furnish evidence of a high threshold indicating prior use and the goodwill of the Appellant associated therewith, which the Appellant has failed to produce. It is also urged that if Appellant has a grievance with the registration of cited marks, she may resort to proper proceedings for cancellation and rectification, but till the time the cited marks are validly registered, similar/identical marks cannot be registered.

12. Heard learned counsels for the parties and examined their submissions.

13. Indisputably, Respondent has refused registration of Appellant's mark



under Section 11(1) of 1999 Act on the ground that it is deceptively similar to the two cited marks and there being similarity of goods/services, there is likelihood of confusion amongst the public. For ready reference, comparative of Appellant's mark and the two cited marks is as follows:-

Appellant's Mark	Cited Earlier Mark



14. The competing goods are as follows:-

Appellant's goods	Goods covered by the earlier cited marks
Retailing of fashion jewellery, ladies bags and purses, ladies garments	Clothing, Headgear, Footwear

15. Appellant applied for registration on 30.06.2020 under Application No. is 4550705 in Class 35, with user claim from 19.06.2019. Cited mark '1' was applied for on 14.08.2019 with user claim 'proposed to be used' in Class 25, while cited mark '2' was applied for on 09.03.2020 with user claim from 01.11.2019. The dominant part of Appellant's mark is OLIVE and when it is compared with the cited marks, there can be no doubt that they are visually and phonetically similar. The competing goods are also similar and overlapping and hence there is likelihood of confusion in the members of public. Therefore, no infirmity can be found in the impugned order, whereby Respondent has refused to register Appellant's mark under Section 11(1) of 1999 Act. In **South India Beverages (supra)**, the Division Bench of this Court held that though it needs no reiteration that a mark must be considered in its entirety, yet it is permissible to accord more or less importance or 'dominance' to a particular portion or element of a mark in case of composite marks. Dominant features are significant because they attract attention and consumers are more likely to remember and rely on them for purposes of identification of the product. Usually, the dominant portion of the mark is that which has the greatest strength or carries more weight. Descriptive or generic components, having little or no source identifying significance, are generally less significant in the analysis. It was also held that phonetic similarity constitutes an important index of whether a



mark bears a misleading similarity to another.

16. In ***Corn Products (supra)***, the Supreme Court emphasised that not only the absolute identity of two competing marks but also the trade connection between different goods is an important test and there is no reason why the test of trade connection between different goods should not apply where competing marks closely resemble each other.

17. In the present case, the cited marks and the Appellant's applied mark are deceptively similar, both visually and phonetically and goods are similar/identical and hence, there is every likelihood of confusion amongst the members of the public. Section 11(1) of 1999 Act proscribes registration of a mark which because of its identity with an earlier trademark and similarity with goods/services covered by the mark or which because of its similarity to an earlier trademark and identity/similarity of goods/services covered by the mark, is likely to cause confusion on the part of the public. Hence, registration has been rightly refused by the Respondent.

18. Learned counsel for the Appellant submits that since the Appellant is a prior adopter and prior user of the applied trademark, the registration ought not have been refused applying the principles laid down in ***Milmet Oftho (supra)***, ***Neon Laboratories (supra)*** and ***S. Syed Mohideen (supra)***. There can be no quarrel with the proposition that right of a prior user is superior to a registrant of a trademark as held by the Supreme Court in the aforementioned judgments. However, in the present case, Appellant is unable to furnish sufficient evidence of user to establish the distinctiveness acquired by the mark through use and/or that the mark has by its extensive and continuous user has acquired a secondary meaning and is associated with the Appellant alone. The documents placed on record relate to period



post the registration of the cited marks, save and except, one document, which is of April, 2019 i.e., a Facebook page and hence, she cannot claim superior rights over the registrants of the cited marks.

19. The argument on Section 11 is also misconceived. Appellant cannot claim that her mark is an ‘earlier trademark’ under Section 11(1) of 1999 Act. The expression ‘earlier trademark’ has been defined in ‘Explanation’ to Section 11(4) and means a registered trademark or an application under Section 18 bearing an earlier date of filing or an international registration referred to in Section 36E or convention application referred to in Section 154 which has a date of application earlier than that of the trademark in question. Appellant’s applied mark does not fall in either of the categories mentioned in the explanation and cannot be termed as ‘earlier trademark’.

20. At this stage, learned counsel also asserts that Respondent has ignored the registration of Appellant’s mark in different classes. The argument is wholly misconceived. Each mark has to be tested for registration independently and based on the cited marks, if any, and the facts obtaining in a given case. Registration in one class does not grant any vested right to the applicant to seek automatic registration in another class, as a matter of right.

21. For all the aforesaid reasons, this Court finds no infirmity in the impugned order dated 12.08.2025 and the appeal is accordingly dismissed.

JYOTI SINGH, J

JANUARY 29, 2026

S.Sharma