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

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Date of Decision : 28.11.2025

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C.A.(COMM.IPD-TM) 38/2024

STREET ONE GMBH

.....Appellant

Through: Mr. Sailen Bhatia, Ms. Preeta Panthaki, Mr. Atif Sayyed, Mr. Bhavesh and Ms. Deeksha Gulati, Advocates.

versus

THE REGISTRAR OF TRADE MARKS AND ORSRespondents

Through: Ms. Saumya Tandon, CGSC with Mr. Gaurav Singh Sengar, Advocate for R1 & 2.
Mr. Rohan Rohatgi and Ms. Muthu Prabha, Advocates for R3.

CORAM:**HON'BLE MR. JUSTICE TEJAS KARIA****TEJAS KARIA, J. (ORAL)**

1. The present Appeal has been preferred by the Appellant under Section 91 of the Trade Marks Act, 1999 (“**Act**”) and Rule 125 of the Trade Marks Rules, 2017 assailing the order dated 25.01.2024 (“**Impugned Order**”) passed by Respondent No. 1 in Opposition No. 1109787 filed against Trade Mark Application No. 4754800 filed by Respondent No.3 for the registration



of the Mark “**STREET9**” (“**Subject Mark**”) on 24.11.2020 with user claim from 01.04.2014 in Class 25.

2. The Appellant claims that the Trade Mark “STREET ONE/
Street One” (“**Appellant’s Mark**”) was adopted by the Appellant in the year 1983 and the Appellant’s Mark forms an essential part of the corporate name of the Appellant.

3. Respondent No. 3 is the Applicant for the registration of the Subject Mark and its Trade Mark Application No. 4754800 was accepted and advertised by the Trade Marks Registry, and was published in Journal No. 1986 dated 08.02.2021, inviting third-party oppositions against the same in accordance with law.

4. On 07.06.2021, the Appellant filed an Opposition bearing No. 1109787 (“**Appellant’s Opposition**”) against the registration of the Subject Mark on the grounds of lack of distinctiveness of the Subject Mark due to its deceptive similarity and likelihood of confusion or association with the Appellant’s Mark.

5. After hearing the submissions of the Appellant and Respondent No. 3, *vide* Impugned Order, the Appellant’s Opposition was dismissed, and the registration of the Subject Mark was allowed in Class 25. Aggrieved by the Impugned Order, the Appellant has filed the present Appeal.

6. The learned Counsel for the Appellant submitted that the Appellant has obtained registration of the Appellant’s Mark in various Classes in India, and the details of the same are as under:



TM No.	Trade Mark	Date of Application	Class	Journal No. and Date
1192878	STREET ONE	April 21, 2003	14	1297-3 28/06/2003
1192881		April 21, 2003	25	1322-0 29/11/2004
1192879		April 21, 2003	16	1322-0 29/11/2004
1192880		April 21, 2003	18	1297-3 28/06/2003

7. The learned Counsel for the Appellant submitted that Respondent No.1 has erroneously passed the Impugned Order without appreciating that Section 11 of the Act is an *alter ego* of Section 29 of the Act. Once a Trade Mark is registered, the question of prior use of the competing Marks no longer remains relevant for determination under Section 11 of the Act.

8. The learned Counsel for the Appellant submitted that Respondent No. 1 has incorrectly applied the provisions of Section 11 of the Act in deciding the Appellant's Opposition to Respondent No. 3's application for the registration of the Subject Mark.

9. It is prayed by the learned Counsel for the Appellant that the Impugned Order be set aside and the matter be remanded back to Respondent No. 1 for a fresh consideration.

10. *Per contra*, the learned Counsel for Respondent Nos. 1 and 2 submitted that a factual examination of the use and reputation of a Trade Mark is mandatory and the Appellant failed to discharge the burden of proving the



same.

11. The learned Counsel for Respondent No. 3 opposed the present Appeal and submitted that Section 11 of the Act has to be read in conjunction with Section 47 of the Act, which provides for the removal of a registered Trade Mark from the register on the ground of non-use of the said Mark.

12. In view of the foregoing submissions, it is prayed by the Respondents that the Impugned Order be upheld and the present Appeal be dismissed.

13. The Appellant has assailed the Impugned Order on the limited ground that the Impugned Order is not in consonance with the provisions of Section 11 of the Act as the question of prior use of the competing Marks is not relevant to deciding the Appellant's Opposition, as the date of filing the application for the registration of the Appellant's Mark was indubitably prior to the date of filing of the application for the registration of the Subject Mark.

14. The relevant portion of the Impugned Order is extracted hereinunder:

"9. The applicant filed the present application for the mark "STREET9" in November 2020, claiming to be user since 2014. On the other hand, the opponent claims to have been using the mark

*"**Street One**" since 2003 and is registered under application no. 1192881. However, upon examination of the documents, it is evident that the opponent's claim of using the mark since 2003 is not proper as there is no supporting documents to substantiate his claim. This discrepancy undermines the opponent's assertion of use of the mark since 2003 on the other hand the applicant has produced sufficient document in support of his claim since 2014.*

*10. The opponent's assertion of prior use of the mark "**Street One**" since 2003 has been refuted by the evidence provided, showing that their application no. 1192881 was filed in April 2003 as proposed to be used. It is a settled principle that "the*



presence of a mark in the register does not prove its use at all. It is possible that the mark may have been registered but not used. It is not permissible in law to infer use from the presence of the marks on the register." If there is non-use of the mark from the date of registration of the mark and consequently the opponents would not be entitled to any protection. This view is further reinforced by the judgment in "Imperial Group's case", wherein it was held that where there is no trading use to give rise to goodwill there is no interest to be protected by a trademark and a trademark cannot exist in vacuum. However, the said application was filed only in 2003 and the opponent has failed to furnish any substantial evidence showing that their prior use dating back to 2003. As a result, the opponent's claim of prior use lacks credibility and supporting evidence.

It is also pertinent to mention that the opponent has not provided any single document to show the trans-border reputation or presence of customer base in India.

11. *Based on the aforementioned analysis and findings, it is evident that the opponent's adoption of the impugned mark*

STREET9 predates the applicant's claims, but the Opponent's claim of prior use and copying the impugned mark by the Applicant is unfounded. The opponent's unsubstantiated assertions of prior use are contradicted by the lack of supporting evidence. Therefore, the Opponent's registration under application no. 1192881, being filed in April 2003, does not establish a valid claim of prior usage. The Applicant's application filed in 2020 demonstrates their prior use of the mark which is before the Opponent's application.

12. *Considering the lack of evidence substantiating the Opponent's claims and the compelling evidence provided by the Applicant, I uphold the proprietary claims of the applicants under Section 18(1)*

of the Act and concludes that the Applicant's mark STREET9 is entitled to registration."

15. It is evident from the above that Respondent No. 1 dismissed the Appellant's Opposition on the ground that the Appellant has not been able to



establish the Appellant's claim of prior use of the Appellant's Mark and, therefore, the said claim is unfounded.

16. The learned Counsel for the Appellant submitted that the rights conferred on the Appellant by virtue of the registration of the Appellant's Mark renders any claim of prior use irrelevant to the present controversy.

17. In **American Home Products Corpn. v. Mac Laboratories (P) Ltd.**, (1986) 1 SCC 465, the Supreme Court highlighted the contours of the rights acquired by virtue of the registration of a Trade Mark. The relevant portion of the said judgment is as under:

“36.When a person gets his trade mark registered, he acquires valuable rights by reason of such registration. Registration of his trade mark gives him the exclusive right to the use of the trade mark in connection with the goods in respect of which it is registered and if there is any invasion of this right by any other person using a mark which is the same or deceptively similar to his trade mark, he can protect his trade mark by an action for infringement in which he can obtain injunction, damages or an account of profits made by the other person. In such an action, the registration of a trade mark is prima facie evidence of its validity. After the expiry of seven years from the date of the registration a trade mark is to be valid in all respects except in the three cases set out in Section 32. The proprietor of an unregistered trade mark whose mark is unauthorisedly used by another cannot, however, sue for the infringement of such trade mark. His only remedy lies in bringing a passing-off action, an inconvenient remedy as compared to an infringement action. In a passing-off action the plaintiff will have to prove that his mark has by user acquired such reputation as to become distinctive of the plaintiff's goods so that if it is used in relation to any goods of the kind dealt with by the plaintiff, it will be understood by the trade and public as meaning that the goods are the plaintiff's goods. In an infringement action, the plaintiff is not required to prove the reputation of his mark. Further, under



Section 37 a registered mark is assignable and transmissible either with or without goodwill of the business concerned while under Section 38, an unregistered trade mark is not assignable or transmissible except in the three cases set out in Section 38(2)."

18. This Court in ***Sun Pharma Laboratories Ltd. v. Finecure Pharmaceuticals Ltd.***, 2023 SCC OnLine Del 4932 explained the scope of the term 'earlier Trade Mark' under Section 11 of the Act and observed as under:

"88. Section 11(1) is, structurally, practically an alter ego of Section 29(2) - or, should one say, vice versa. The only difference is that Section 11(1) is subject to Section 12. If, therefore, the case justifies invocation of Section 12, then, despite the ingredients of Section 11(1) being present, the applicant's mark may nonetheless proceed to registration.

89. Section 11(1)(a) proscribes registration of a trademark which, owing to its identity to an earlier trademark, and similarity of the goods or services covered by the two marks, results in a likelihood of confusion, or a likelihood of an inference of association with the earlier marked, in the minds of the public. It needs no detailed study to make out that the ingredients of Section 11(1)(a) are practically the same as those of Section 29(2)(a). The only difference is that Section 29(2)(a) envisages identity of a later unregistered trademark with an earlier registered trademark, resulting in confusion or an inference of association, whereas the identity envisaged by Section 11(1)(a) is between the mark seeking registration and an "earlier trademark".

90. "Earlier trademark" is defined in clause (a) in the Explanation in Section 11 as including "an application under section 18 bearing an earlier date of filing". The application filed by Takeda for registration of PANTOCID, being earlier in point of time to the application filed



by the plaintiff for registration of the very same mark, constituted an “earlier trademark” within the meaning of Section 11. The marks were identical. Registration of the marks were being sought for identical goods. Likelihood of confusion was, therefore, *ex facie* apparent. The application of the plaintiff, for registration of the mark PANTOCID, therefore, directly attracted Section 11(1)(a) of the Trade Marks Act. Registration of the mark was, therefore, proscribed.

91. The submission of learned Senior Counsel for the plaintiff that, as Takeda never actually used the registered PANTOCID mark, there was no likelihood of confusion, has, to employ a time-worn cliché, merely to be stated to be rejected. Likelihood of confusion, in Section 11(1), is not dependent on actual use of the marks. If that were so, Section 11(1) would stand entirely excluded in the case of marks which were registered, or of which registration was sought, on “proposed to be used” basis. As in the case of Section 29(2), the likelihood of confusion, under Section 11(1), has to be gauged, by the Court, by comparing the marks. If they are identical, or deceptively similar, so as to result in likelihood of confusion in the public, the ingredients of Section 11(1) stand satisfied. Likelihood of confusion is all that is required to be shown; not actual confusion.”

19. Relevant extract of Section 11 of the Act is as under:

“11. Relative grounds for refusal of registration.—

(1) Save as provided in section 12, a trade mark shall not be registered if, because of—

(a) a registered trade mark 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 trade mark in question, taking account, where appropriate, of the priorities claimed in respect of the trade marks;

(b) its similarity to an earlier trade mark and the identity or similarity of the goods or services covered by the trade mark, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.



Explanation.- For the purposes of this section, earlier trade mark means—

[(a) a registered trade mark 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 trade mark in question, taking account, where appropriate, of the priorities claimed in respect of the trade marks ; Subs. by Act 40 of 2010, s. 2, for clause (a) (w.e.f. 8-7-2013]

(b) a trade mark which, on the date of the application for registration of the trade mark in question, or where appropriate, of the priority claimed in respect of the application, was entitled to protection as a well-known trade mark.”

20. Clause (a) of Explanation in Section 11 of the Act makes it clear that an ‘earlier Trade Mark’ means a registered Trade Mark, which has a date of application earlier than that of the Trade Mark in question.

21. In the present case, there is no cavil that the date of filing the application for the registration of the Appellant’s Mark is prior in time to the date of filing of the application for the registration of the Subject Mark in question. Therefore, the Appellant’s Mark is clearly the earlier Trade Mark in accordance with the provisions of Section 11 of the Act.

22. Further, from a perusal of Section 11(1) of the Act, it is evident that a Trade Mark will not be registered if there exists a likelihood of confusion on the part of the public because of its identity or similarity to an earlier Trade Mark.

23. Therefore, for the purpose of deciding whether the Subject Mark is identical or deceptively similar to the prior registered Appellant’s Mark, Respondent No. 1 ought to have considered whether the Appellant’s Mark constitutes an ‘earlier Trade Mark’ in accordance with the provisions of



Section 11 of the Act.

24. Respondent No. 1 *vide* Impugned Order dismissed the Appellant's Opposition on the ground that the Appellant's claim of prior use of the Appellant's Mark is unsubstantiated. The reason for dismissing the Appellant's Opposition is fallacious as unless there is prior use, no applicant of earlier Trade Mark can ever file the opposition under Section 21 of the Act, which gives right to 'any person' to file opposition. Hence, prior user is not necessary for filing opposition under Section 21 of the Act. The observations in the Impugned Order are contrary to the scheme of the Act as prior use of the registered Trade Mark has no significance for the determination of the Appellant's Opposition since the Appellant's Mark is clearly an 'earlier Trade Mark' in terms of Section 11 of the Act, especially when Section 21 of the Act does not put any such requirement and allows 'any person' to file opposition.

25. Accordingly, Respondent No. 1 was required to examine the likelihood of confusion under Section 11 (1) of the Act irrespective of the actual use of the Appellant's Mark as the same is not necessary at all to determine the likelihood of confusion. If for filing opposition, the opponent is required to establish prior use, Section 11 (1) would be rendered otiose as held in case of as held in ***Sun Pharma*** (supra) for the marks that are registered or the marks of which the registration has been sought on 'proposed to be used' basis. The registration of the Trade Mark is a *prima facie* evidence of its validity and the registered proprietor of the Trade Mark acquires valuable rights on account of the registration as held in ***American Home Products*** (supra).

26. The submission of learned Counsel for Respondent No. 3 that Section



11 has to be read in conjunction with Section 47 of the Act cannot be accepted as the Appellant's Mark has not been removed from the Register of Trade Marks under Section 47 on account of non-use and, therefore, the Appellant's Mark shall continue to be considered as an 'earlier Trade Mark' for the purposes of Section 11 of the Act.

27. Therefore, Respondent No. 1 has erred in dismissing the Appellant's Opposition on the ground that the Appellant's claim of prior use has not been established.

28. Accordingly, the present Appeal is allowed and the Impugned Order dated 25.01.2024 is hereby set aside. The matter is remanded back to Respondent No. 1 for deciding the Appellant's Opposition No. 1109787 afresh.

29. Needless to say, any observation made in this Order shall not affect the merits of the case before Respondent No. 1, which shall be decided in accordance with law.

30. The learned Counsel for Respondent No. 3 requests that the Appellant's Opposition bearing No. 1109787 be taken up for hearing by Respondent No. 1 along with other connected Oppositions bearing Opposition No. 1116157 to Trade Mark Application No. 3584274 in Class 25 and Opposition No. 1379209 to Trade Mark Application No. 5133988 in Class 18. The learned Counsel for the Plaintiff has no objection to the same.

31. Accordingly, Respondent No.1 is directed to decide the Appellant's Opposition bearing No. 1109787 afresh in accordance with law after giving opportunity of hearing to the parties along with Opposition No. 1116157 to Trade Mark Application No. 3584274 in Class 25 and Opposition No.



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1379209 to Trade Mark Application No. 5133988 in Class 18 within six (6) months from receipt of a copy of this Order.

32. The Registry is directed to send a copy of this Order to the Office of Controller General of Patents, Designs and Trade Marks of India for compliance.

33. With the aforesaid directions, the present Appeal stands disposed of.

TEJAS KARIA, J

NOVEMBER 28, 2025/sms