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

\+ C.A.(COMM.IPD-TM) 121/2021

GREY MATTERS EDUCATIONAL TRUST .....Appellant

Through: Mr. Kunal Khanna, Mr. Krtin Bhasin, Mr. Madhav Anand, Advs.
M: 9999757185
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versus

EXAMINER OF TRADE MARKS .....Respondent

Through: Mr. Harish Vaidyanthan Shankar, CGSC with Mr. Srish Kumar Mishra and Mr. Alexander Mathai Paikaday, Advocates

CORAM:
HON'BLE MS. JUSTICE MINI PUSHKARNA

JUDGMENT

% 23.10.2024

MINI PUSHKARNA, J:

1. The present appeal has been filed under Section 91 of the Trade Marks Act, 1999 ("the Act") challenging the order dated 25th January, 2019 passed by the respondent, wherein, the application of the appellant for registration of trademark 'Planet E School', vide application no. 2878088, under Class 41, for providing educational services, was dismissed.

2.1 Learned counsel appearing for the appellant submits that the trademark of the appellant is entirely different from the cited marks, and the same is neither identical nor deceptively similar to other cited marks. The mark of the appellant is different visually, phonetically and structurally, from the other cited marks.

2.2 It is submitted that the appellant is an honest and *bona fide* user of the

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mark. The trademark applied for registration by the appellant, stands distinctive from other marks, as it has to be considered as a whole. Section 17 of the Act entitles registration of a trademark comprising of several features, even if the matter forming part of such several features, stand registered in the name of an earlier proprietor.

2.3 The appellant is agreeable to restrict its registration only to the State of Punjab.

3.1 Per contra, learned counsel appearing for the respondent submits that there are other registrations with the mark 'Planet', which already exist. He submits that there are valid and existing registered marks, which have been cited against the appellant. One of the cited marks is also with respect to one of the educational services, so there is a clear case of confusion, if the mark of the appellant is allowed to be registered. The cited marks are identical/ similar to the goods of the impugned trademark.

3.2 Section 9(1)(A) of the Act, prohibits registration of trademarks which are devoid of any distinctive character, i.e., not capable of distinguishing the goods or services of one person from those of another person. The appellant has failed to establish secondary meaning, as per proviso of Section 9(1) of the Act before the Trademark Registry.

3.3 In the present case, the refused trademark is a word mark. The conflicting marks are all device marks, which are the element of the refused trademark. Refused trademark cannot be allowed to be registered, for the said registration will give an undue advantage to the appellant, along with the right to sue the conflicting marks.

4. Having heard learned counsel for the parties, at the outset, this Court notes the impugned order dated 25th January, 2019, wherein, the application of the appellant for registration of the trademark in question has been

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rejected, as follows:

> *"xxx xxx xxx*
>
> *The trade mark applied for is objectionable under Section 9/11 of the Act. The application is accordingly refused.*
>
> *xxx xxx xxx"*

5. Perusal of the aforesaid order shows that the application of the appellant for trademark registration has been rejected by a one line order that the trademark applied for, is objectionable under Section 9 and 11 of the Act. No detailed reasons have been given by the respondent for rejecting the application of the appellant. The comprehensive reply filed by the appellant before the Trademark Registry in response to the First Examination Report ("FER"), has not even been considered, or discussed in the impugned order.

6. The conflicting marks, cited by the Trademark Registry, are as follows:

Appl. No.	Conflicting Mark	Status of TM Website as of 28.09.2024	Valid Upto	TM Image
1252370	E (LOGO)	Removed	-	
1252812	E!(Label)	Registered	30.05.2021	

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1313235	PLANET EDU	Registered	20.03.2022	
1380129	PLANET WITH LOGO	Registered	29.08.2025	
1442758	E (LOGO)	Registered	05.04.2026	
1625593	PLANET	Registered	28.11.2027	
1644579	Planet M (WORD)	Registered	22.01.2018	
1733415	PLANET (Device)	Registered	17.09.2018	
1943141	PLANET M	Registered	29.03.2020	
1943145	PLANET M	Registered	29.03.2020	
2068459	PLANET K SCHOOL SOLUTIONS- A NEW PARADIGM IN LEARNING	Abandoned		
2077087	PLANET	Registered	29.12.2020	
2090269	PLANET G (WORD)	Registered	27.01.2021	

7. Considering the aforesaid table, it is evident that the common word amongst the cited marks and the mark sought to be registered by the appellant, is 'Planet' and 'E'. There are several marks that have already been registered containing the word 'Planet'. However, if the cited marks are

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viewed as a whole and compared with the mark of the appellant, the marks cited by the Trademark Registry cannot be said to be similar or deceptively similar to the mark of the appellant. The trademark applied for by the appellant for registration is distinctive from other marks, when considered in its entirety. The anti-dissection rule is a well established principle of trademark law that requires trademarks to be viewed as a whole, rather than being broken down into their individual parts. The Court will consider the overall structural, visual and phonetic similarity, while comparing two or more trademarks. Seen in this background, the cited marks are *prima facie* not similar to the appellant's marks. Therefore, objection under Section 11 of the Act is devoid of any merits.

8. Merely because the word 'Planet' is a generic term, the mark of the plaintiff, taken as a whole, cannot be rejected. The mark of the appellant is a combination of the words, 'Planet', 'E' and 'School'. When seen independently, the said words are generic. However, when the said words are combined, it acquires distinctiveness and a unique character. When viewed as a whole, the mark of the appellant is distinctive and capable of distinguishing the goods or services of one person from those of another person. Therefore, objection under Section 9 of the Act is not sustainable.

9. While holding that a mark cannot be dissected into its individual parts while examining its entitlement to registration, this Court in the case of ***Ticona Polymers, Inc. Versus Registrar of Trade Marks***[1], has held as follows:

> *"xxx xxx xxx*
>
> *12.* ***It is well settled that a mark cannot be dissected into its individual parts while examining its entitlement to registration. Though Section 17(1)2 of the Trademarks Act statutory embodies***

[1] ***2023 SCC OnLine Del 1234***

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> ***this anti-dissection principle in the context of infringement proceedings, the principle would apply, mutatis mutandis, even at the stage when the mark is examined for its entitlement for registration as it is only the factum of registration which brings, in its wake, the privileges that follow, including protection against infringement****.*
>
> *xxx xxx xxx"*
>
> *(Emphasis Supplied)*

10. It is well recognized that in deciding a question of similarity between two marks, the Court is required to consider the composite marks as an indivisible whole, rather than splitting them into component parts to determine deceptive similarity between the marks. Thus a Division Bench of this Court in the case of ***Vasundhra Jewellers Pvt. Ltd. Versus Kirat Vinodbhai Jadvani and Another***[2]***,*** observed as follows:

> *"xxx xxx xxx*
>
> *32.* ***It is well settled that a composite trademark or label trademark is not required to be dissected to determine whether there is any deceptive similarity with another trademark. The question whether there is any deceptive similarity between two trademarks has to be ascertained by examining the marks in question as a whole.*** *In South India Beverages India Private Limited v. General Mills Marketing Inc, 2014 SCC OnLine Del 1953, the Division Bench of this Court had explained the 'anti-dissection rule' in some detail.* ***The Court reiterated that "conflicting composite marks are to be compared by looking at them as a whole, rather than breaking the marks up into their components parts for comparison". However, the Court had also observed that "while a mark is to be considered in entirety, yet it is impermissible to accord more or less importance or 'dominance' to a particular portion or element of a mark in cases of composite marks"****.*
>
> *33.* ***Having stated the above, it is also necessary to bear in mind that examining the dominant part of the trademark for comparing it with the conflicting mark is solely for the purpose of determining whether competing marks are deceptively similar when viewed as a whole. It is, thus, not permissible to hold that two competing marks are deceptively similar by examining a portion of one mark and comparing it with the portion of another mark, if the composite***

[2] ***2022 SCC OnLine Del 3370***

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marks viewed as a whole are dissimilar. *It is relevant to refer to the text from* ***McCarthy on Trademarks and Unfair Competition****, which explains the said principle as under:—*

> *"23.15 Comparing Marks: Differences v. Similarities*
>
> *[1]* ***The Anti-Dissection Rule***
>
> *[a]* ***Compare composites as a Whole: Conflicting composite marks are to be compared by looking at them as a whole, rather than breaking the marks up into their component parts for comparison. This is the "anti dissection" rule. The rationale for the rule is that the commercial impression of a composite trademark on an ordinary prospective buyer is created by the mark as a whole, not by its component parts. However, it is not a violation of the anti-dissection rule to view the component parts of conflicting composite marks as a preliminary step on the way to an ultimate determination of probable customer reaction to the conflicting composites as a whole. Thus, conflicting marks must be compared in their entireties. A mark should not be dissected or split up into its component parts and each part then compared with corresponding parts of the conflicting mark to determine the likelihood of confusion. It is the impression that the mark as a whole creates on the average reasonably prudent buyer and not the parts thereof, that is important.*** *As the Supreme Court observed: "The commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety." The anti-dissection rule is based upon a common sense observation of customer behavior: the typical shopper does not retain all of the individual details of a composite mark in his or her mind, but retains only an overall, general impression created by the composite as a whole. It is the overall impression created by the mark from the ordinary shopper's cursory observation in the marketplace that will or will not lead to a likelihood of confusion, not the impression created from a meticulous comparison as expressed in carefully weighed analysis in legal briefs. In litigation over the alleged similarity of marks, the owner will emphasize the similarities and the alleged infringer will emphasize the differences. The point is that the two marks should not be examined with a microscope to find the differences, for this is not the way the average purchaser views the marks. To the average buyer, the points of similarity are more important that minor points of difference. A court should not engage in "technical gymnastics" in an*

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attempt to find some minor differences between conflicting marks.

However, where there are both similarities and differences in the marks, there must be weighed against one another to see which predominate.

The rationale of the anti-dissection rule is based upon this assumption:"An average purchaser does not retain all the details of a mark, but rather the mental impression of the mark creates in its totality. ***It has been held to be a violation of the anti-dissection rule to focus upon the "prominent" feature of a mark and decide likely confusion solely upon that feature, ignoring all other elements of the mark. Similarly, it is improper to find that one portion of a composite mark has no trademark significance, leading to a direct comparison between only that which remains.****"*

xxx xxx xxx"

(Emphasis Supplied)

11. This Court also notes the submission of learned counsel appearing for the appellant that the appellant shall restrict the usage of its trademark only to the State of Punjab.

12. In view of the aforesaid, the present appeal is allowed, with the following directions:

12.1 The order dated 25th January, 2019 passed by the Trade Marks Registry, is hereby set aside.

12.2 The appellant shall not claim any exclusive right in the word 'Planet' independently.

12.3 The mark of the appellant shall be restricted only to the State of Punjab.

12.4 The Trade Marks Registry is directed to process the application of the appellant for registration of the subject mark.

12.5 The mark of the appellant shall be advertised in accordance with the provisions of the Trade Marks Act, 1999 and Trade Marks Rules, 2017. In

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case of any opposition, the same shall be considered on its merits.

13. The present appeal is accordingly allowed, in the aforesaid terms.

(MINI PUSHKARNA)
JUDGE

OCTOBER 23, 2024/kr

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