



2023:DHC:9170



\$~3 & 4

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

+ **C.O. (COMM.IPD-TM) 255/2021**

BENNET, COLEMAN AND COMPANY LTD ... Petitioner
Through: Ms. Mamta Rani Jha, Ms.
Pragya Jain and Ms. Soumya Khandelwal,
Advs.

versus

FASHION ONE TELEVISION LLC AND ANR.. Respondents
Through: Mr. Abhishek Saket and Ms.
Sanna Harta, Advs.
Mr. Harish Vaidyanathan Shankar, CGSC
with Mr. Srish Kumar Mishra, Mr.
Alexander Mathai Paikaday and Mr.
Krishnan V., Advs.

+ **C.O. (COMM.IPD-TM) 144/2022**

**BENNETT, COLEMAN AND COMPANY LIMITED TIMES
OF INDIA BUILDING DR. D.N. ROAD MUMBAI- 4000001,
MAHARASHTRA Petitioner**
Through: Ms. Mamta Rani Jha, Ms.
Pragya Jain and Ms. Soumya Khandelwal,
Advs.

versus

**FASHION ONE TELEVISION LLC 820 MERIDIAN AVE.,
SUITE 100, MIAMI BEACH, FLORIDA 33139, USA AND
THE REGISTRAR OF TRADEMARKS Respondent**
Through: Mr. Abhishek Saket and Ms.
Sanna Harta, Advs.

**CORAM:
HON'BLE MR. JUSTICE C. HARI SHANKAR**

J U D G M E N T (O R A L)

Signature Not Verified

Digitally Signed
By: ROHIT BARARIA
Signing Date: 19.12.2023
18:30:04

C.O. (COMM.IPD-TM) 255/2021 & C.O. (COMM.IPD-TM) 144/2022

Page 1 of 11



2023:DHC:9170



%

18.12.2023

C.O. (COMM.IPD-TM) 255/2021

1. Mr. Abhishek Saket, learned Counsel for the respondent appears and submits that, despite efforts to contact his client, he has not been successful. I had noted, on the last date, that this case could not be repeatedly adjourned awaiting the convenience of the respondent in contacting his counsel and instructing him in the matter.
2. Besides, the issue in controversy appears to be covered by the judgment of this Court in C.O. (COMM.IPD-TM) 117/2021 (*Bennet, Coleman and Company Ltd. v. Vnow Technologies Pvt. Ltd¹*).
3. The petitioner is aggrieved by Registration No. 2581941 whereby the Trade Marks Registry has registered the mark **Fashion Now** /FASHION NOW in favour of Respondent 1 in Class 38 of the NICE classification applicable to registration of trade marks, w.e.f. 19 August 2013, in respect of the service “broadcast of television programs”.
4. The petitioner is the proprietor of the marks TIMES NOW, ET NOW, MOVIES NOW, ROMEDY NOW and MIRROR NOW, also registered in the petitioner’s favour in Class 38.
5. The services in respect of which these registrations have been granted are the following:



2023:DHC:9170



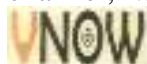
Marks	Class	Services
TIMES NOW	38	television and radio broadcasting, cable television broadcasting, news agencies, providing telecommunications and user access to a global computer network and services, telecommunications and communication by computer terminals, cellular telephone services, optic fibre networks, telegrams and telephone, electronic and facsimile transmission, transmission of message and images, wire service.
ET NOW	38	television & radio broadcasting; cable television broadcasting; news agencies; providing telecommunications & user access to a global computer network and services; telecommunications & communication by computer terminals; cellular telephone services; optic fibre networks; telegrams & telephone; electronic & facsimile transmission; transmission of messages & images, wire service.
MOVIES NOW	38	television and radio broadcasting cable television broadcasting; satellite transmission; news agencies; providing telecommunications and user access to a global computer network and services; telecommunications and communication by computer terminals; cellular telephone services; optic fibre networks; telegrams and telephone; electronic and facsimile transmission: transmission of news, messages and images through global computer network; wire service
ROMEDY NOW	38	television & radio broadcasting; cable television broadcasting; news agencies; providing telecommunications & user access to a global computer network and services; telecommunications & communication by computer terminals; cellular telephone services; optic fibre networks; telegrams & telephone; electronic & facsimile transmission; transmission of message & images, wire service.
MIRROR NOW	38	Telecommunications, television broadcasting, cellular telephone communication, communications by computer terminals, internet and websites, internet portals, internet broadcasting, electronic mail, providing online forums, satellite transmission, computer aided transmission of messages and images, providing access to databases, facsimile transmission, providing user access to global



		computer networks, providing telecommunications connections to a global computer network, transmission of digital files, transmission of cards online.
--	--	--

6. This Court, in its judgment in **Bennet Coleman**, has observed and held as under:

“10. Having heard Ms. Mamta Rani Jha, learned Counsel for the petitioner, and perused the record, it is apparent, from the record, that the petitioner has registrations, in its favour, of several marks which involve ‘NOW’ as the latter part of the mark, under class 38. The submission of Ms. Mamta Rani Jha is that, in the circumstances, an unwary viewer who views the defendant’s channel, which provides identical services under the impugned



mark, would be inclined to draw an association between the impugned mark and the ‘NOW centric’ marks of the plaintiff, merits acceptance.

11. That proprietorial rights can emerge even from a family of marks held by a registrant, in which part of the marks may be common, stands recognized by a Division Bench of this Court in **Amar Singh Chawal Wala v. Shree Vardhman Rice & General Mills**², which has been followed by another Division Bench in **Kirorimal Kashiram Marketing v. Shree Sita Chawal Udyog Mill**³. One may usefully reproduce, in this context, para 18 of the report in **Amar Singh Chawal Wala**:

“18. It is not possible to agree with the reasoning of the learned Single Judge that the word QILLA is not associated with rice and therefore no ordinary purchaser of rice would associate the Defendant's mark as that of the Plaintiffs. It is plain from the pleadings that the Plaintiff has been using the words QILLA consistently in connection with the rice being sold by them with only the first word indicating the colour viz., GOLDEN, LAL or NEELA. *It must be held that the Plaintiff has been able to prima facie show that it has developed a ‘family of marks’ and that by merely changing the first word from GOLDEN, LAL or NEELA to the word HARA there is every possibility of confusion being caused both in trade and in the mind of any person desiring*

² ILR (2009) 6 Del 399

³ AIR 1963 SC 449



to purchase rice. Likewise the use of the picture or depiction of a fort in the background on the label/packing of the rice is also likely to cause confusion in the mind of the purchaser and in the trade that the product being sold by the Defendants are in fact those manufactured by the Plaintiff.”

(Emphasis supplied)

12. In a similar vein, the High Court of Bombay, in *Neon Laboratories Ltd v. Themis Medicare Ltd*⁴, held the “XYLOX family of marks” comprising XYLOX 2%, XYLOX HEAVY, XYLOX GEL, XYLOX ADRENALINE and XYLOX 2% Jelly to be infringing the “LOX family of marks” comprising LOX 2% ADRENALINE, LOX 4%, LOX 5%, LOX HEAVY 5%, LOX VISCOUS, LOXALPRIN, LOXALPRY, LOXIMLA, PLOX and RILOX.

13. The ‘NOW’-centric ‘TIMES NOW’, ‘ET NOW’, ‘MOVIES NOW’, ‘MIRROR NOW’ and ‘ROMEDY NOW’ marks constitute a “family of marks” within the meaning of the concept as understood in *Amar Singh Chawal Wala* and *Neon Laboratories*, especially as they cover services provided in the same Class 38. I will refer to the registered trade marks of the plaintiff, therefore, as “the ‘NOW’ family of marks” hereinafter, instead of “the ‘NOW’-centric marks”.

14. Section 17(1)⁵ clarifies that the proprietorial rights conferred by registration is for the mark as a whole. In other words, the rights conferred on the petitioner by the registrations held by it in respect of the NOW family of marks are over the TIMES NOW, ET NOW, ROMEDY NOW, MOVIES NOW and MIRROR NOW marks as a whole in each case, and not for the mark ‘NOW’ *per se*. Section 17(2)(a)⁶ makes matters clearer, by disentitling exclusivity in respect of part of a mark which is registered as a whole. This has, over time, come to be known as “the anti-dissection rule”.

⁴ (2014) 60 PTC 621

⁵ 17. Effect of registration of parts of a mark. –

(1) When a trade mark consists of several matters, its registration shall confer on the proprietor exclusive right to the use of the trade mark taken as a whole.

⁶ (2) Notwithstanding anything contained in sub-section (1), when a trade mark –

(a) contains any part –

(i) which is not the subject of a separate application by the proprietor for registration as a trade mark; or

(ii) which is not separately registered by the proprietor as a trade mark; or

(b) contains any matter which is common to the trade or is otherwise of a non-distinctive character, the registration thereof shall not confer any exclusive right in the matter forming only a part of the whole of the trade mark so registered.



15. The registrations held by the petitioner in the ‘NOW’ family of marks confers, therefore, on it, rights to claim exclusivity in respect of each of the marks *as a whole*, and not in respect of the ‘NOW’ part of each of the marks.

16. The anti-dissection rule is, however, subject to a caveat, elucidated thus by Pradeep Nandrajog, J. (as he then was), speaking for a Division Bench of this Court, in ***South India Beverages Pvt Ltd v. General Mills Marketing Inc.***⁷:

“19. Though it bears no reiteration that while a mark is to be considered in entirety, yet it is permissible to accord more or less importance or ‘*dominance*’ to a particular portion or element of a mark in cases of composite marks. Thus, a particular element of a composite mark which enjoys greater prominence vis-à-vis other constituent elements, may be termed as a ‘*dominant mark*’.

20. At this juncture it would be apposite to refer to a recent decision of this Court reported as ***Stiefel Laboratories v. Ajanta Pharma Ltd***⁸. The Court whilst expounding upon the principle of ‘anti-dissection’ cited with approval the views of the eminent author on the subject comprised in his authoritative treatise-McCarthy on Trademarks and Unfair Competition. It was observed:

“41. The anti-dissection rule which is under these circumstances required to be applied in India is really based upon nature of customer. It has been rightly set out in McCarthy on Trademarks and Unfair Competition about the said rule particularly in Para 23.15 which is reproduced hereunder:

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

⁷ (2015) 61 PTC 231
⁸ (2014) 211 DLT 296



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 entirety. 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 than minor points of



difference. A court should not engage in “technical gymnastics” in an 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.”

21. The view of the author makes it scintillatingly clear, beyond pale of doubt, that the principle of ‘*anti dissection*’ does not impose an absolute embargo upon the consideration of the constituent elements of a composite mark. The said elements may be viewed as a *preliminary step* on the way to an ultimate determination of probable customer reaction to the conflicting composites as a whole. Thus, the principle of ‘*anti-dissection*’ and identification of ‘*dominant mark*’ are not antithetical to one another and if viewed in a holistic perspective, the said principles rather compliment each other.

23. It is also settled that while a trademark is supposed to be looked at in entirety, yet the *consideration of a trademark as a whole does not condone infringement where less than the entire trademark is appropriated*. It is therefore not improper to identify elements or features of the marks that are more or less important for purpose of analysis in cases of composite marks.

26. 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 a mark is that which has the greater strength or carries more weight. Descriptive or generic components, having little or no



source identifying significance, are generally less significant in the analysis. However, words that are arbitrary and distinct possess greater strength and are thus accorded greater protection. [*Autozone, Inc. v. Tandy Corporation*⁹]

(Emphasis in original)

17. Where, therefore, part of a composite mark is *dominant*, another mark, which copies or replicates that dominant part, may infringe. As *South India Beverages* holds, this caveat does not violate the “anti dissection rule” statutorily engrafted in Section 17(2)(a) of the Trade Marks Act, as it merely identifies that part of the whole mark which, being dominant, confers, to the whole mark as registered, distinctiveness and exclusivity.

18. Where a family of marks is involved, as in the present case, the identification of the dominant part is greatly simplified. The very moniker that I have chosen to impart to the registered marks of the plaintiff – the ‘NOW’-family – itself identifies ‘NOW’ as the dominant part of the mark family. It is but obvious that a viewer who views the TIMES NOW, ET NOW, ROMEDY NOW, MIRROR NOW and MOVIES NOW channels would identify NOW as the distinctive common feature of all the marks and, therefore, their “dominant” part.

19. The sequitur is obvious. If such a viewer, endowed with the mythical attributes of an average intelligence and an imperfect recollection, were to come across another channel, providing similar services, with a title of which ‘NOW’ is the latter part, there is every likelihood of his regarding the channel as part of the petitioner’s repertoire, or at least as having an association with the NOW-family of channels of the petitioner.”

7. The above findings apply, *mutatis mutandis*, to the present case.

The impugned mark **Fashion Now** / **FASHION NOW** is also registered in Class 38 for telecommunication and broadcasting services. These are the very services in respect of which the afore-noted TIMES NOW, ET NOW, MOVIES NOW, ROMEDY NOW and MIRROR NOW



marks of the plaintiff are registered, in the same Class 38.

8. As the decision in *Bennet Coleman* notes, the plaintiff has a subsisting interest in the “NOW” family of marks, as they are indelibly associated with the plaintiff.

9. Applying the decision in *Bennet Coleman* supra, to the facts of this case, the mark **Fashion Now** /FASHION NOW cannot be allowed to continue on the register in Class 38 in favour of Respondent 1.

10. Accordingly, the Registration No. 2581941 dated 19 August 2013 granted to the mark **Fashion Now** /FASHION NOW by the trade marks registry in Class 38 is quashed and set aside. The Registrar of Trade Marks is directed to take immediate action to remove the said mark from the register.

11. The petition stands allowed accordingly.

C.O. (COMM.IPD-TM) 144/2022

12. The decision in C.O. (COMM.IPD-TM) 255/2021 passed today would equally apply to this case, as the challenge, here, is to the

device mark  /FASHION NOW also registered in favour of the Respondent *vide* Registration No. 2581940 dated 19 August 2013 in Class 38.



2023:DHC:9170



13. The said registration is also, therefore, held to be invalid and is directed to be taken off the record.

14. Let a copy of this order be communicated to the Registrar of Trade Marks for appropriate action.

15. This petition stands allowed in the aforesaid terms.

C. HARI SHANKAR, J.

DECEMBER 18, 2023

dsn

Click here to check corrigendum, if any