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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**
+ C.A.(COMM.IPD-TM) 162/2022, I.A. 21666/2022 (Section 151 of the CPC) and I.A. 21667/2022 (Order XLI Rule 27 of the CPC)

TWENTIETH CENTURY FOX
FILM CORPORATION Appellant
Through: Mr. Prithvi Singh, Adv.

versus

THE REGISTRAR Respondent
Through: Mr. Harish Vaidyanathan Shankar,
CGSC with Mr. R. M. Tripathi, Govt. Pleader

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

JUDGMENT (ORAL)
27.02.2023

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1. This appeal under Section 91 of the Trade Marks Act assails order dated 13th September 2022, passed by the Senior Examiner of Trade Marks in the office of the Trade Marks Registry, New Delhi, rejecting Application No. 4280126 submitted by the appellant for registration of the **AVATAR** mark, in Class 14, for “Alarm clocks; bracelets; busts of precious metal; charms; clocks; earrings; jewellery; jewellery cases of precious metal; jewellery boxes not of precious metal; jewellery chains; decorative key fobs; key chains; key rings; lapel pins; neck chains; necklaces; necktie fasteners; nonmonetary coins; ornamental lapel pins; pendants; rings; stop watches; tie clips; tie fasteners; tie tacks; wall clocks; watch bands; watch cases; watch chains; watch straps; watches; wedding bands; wrist watches on proposed to be used basis”.


2. Consequent to submission of the aforesaid application by the appellant, the office of the trademark Registry issued First Examination Report (FER) dated 25th September 2019, objecting to the registration of the proposed mark under Section 11(1) of the Trade Marks Act, 1999, on the ground that it was deceptively similar to two earlier marks. The two


marks which were cited were (i) , registered in favour of Mr.

A. Shrivinasan and (ii) , registered in favour of Mr. Avathar Varatharajan.

3. Of these two marks, the former mark was not renewed and, accordingly, was deemed to be statutorily abandoned under Section 25(3) of the Trade Marks Act.


4. The appellant, in its reply dated 19th October 2019 to the FER, submitted that (i) the appellant's mark was phonetically and visually

distinct from the cited  mark, (ii) the overall impression conveyed by the two marks was completely different and there was, therefore, no likelihood of confusion, (iii) Section 17 of the Trade Marks Act required the rival marks to be seen as a whole, without vivisecting the marks into their individual components, (iv) the goods in respect of

which the cited  was registered were also different from the goods in respect of which the appellant sought registration of its **AVATAR** mark.


5. Mr. Prithvi Singh, learned Counsel for the appellant submits,

moreover, that the goods in respect of which the registration of the appellant's mark was sought were essentially towards promotion of the movie AVATAR which was released in December 2022.

6. The Senior Examiner, by the impugned order dated 13th September 2022, rejected the aforesaid defence put up by the appellant and disallowed registration of the appellant's mark under Section 11(1)¹ of the Trade Marks Act on the ground that it was visually and phonetically similar to the cited  mark.

7. Aggrieved thereby, the appellant has approached this Court by means of the present appeal.

8. I have heard Mr. Prithvi Singh, learned Counsel for the appellant and Mr. Harish Vaidyanathan Shankar, learned Counsel for the respondent at some length.

9. The only ground on which registration of the **AVATAR** mark of the appellant has been refused, is that it is deceptively similar to the  mark registered in favour of Mr. Avathar Varatharajan and that the similarity was likely to result in confusion.

¹ 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) its identity with an earlier trade mark and similarity of goods or services covered by the trade mark; or
 - (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.


10. It is clear, from a bare reading of Section 11(1) that mere identity or similarity of the mark of which registration is sought, and the earlier mark, is not sufficient as a ground to reject the application seeking registration. Section 11(1) has two clauses. Clause (a) envisages a situation in which applicant's mark is identical to the earlier trademark and registration is sought in respect of similar goods and services. Clause (b) envisages a situation in which the applicant's mark is similar to an earlier trade mark and the goods and services covered by the two marks are identical or similar. In either case, a third condition is required to be satisfied, which is that, owing to the identity or similarity between the applicant's mark and the cited mark, and the identity of similarity between the goods covered under two marks, there exists a likelihood of confusion on the part of the public, which would include a likelihood of association with the earlier trade mark.

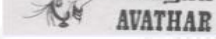
11. In examining sustainability of the objections raised in the FER, the Senior Examiner was required, therefore, to assess whether (i) the appellant's mark was identical or similar to the earlier cited mark



, (ii) whether the goods and services covered by the two marks were identical or similar and (iii) whether, because of these factors, a likelihood of confusion on the part of the public existed.


12. Applying these tests to the case at hand, the position that emerges is, as I find, thus:




(i) It cannot be said that the applicant's **AVATAR** mark is identical or similar to the cited  mark. No doubt, the two marks are phonetically similar and, perhaps, even identical. However, mere phonetic similarity is insufficient to render the marks identical or similar within the meaning of Section 11(1). The identity or similarity has to be such as would result in likelihood of confusion on the part of the public.

(ii) The cited  consists of the word "AVATHAR" in English and Tamil, with the sketch of the face of a lady alongside. It is the composite mark, as such, which has been registered. When comparing marks for the purpose of assessing infringement, Section 17² of the Trade Marks Act specifically proscribes vivisection of marks into its individual components, and holds that where a mark is registered as a whole, exclusivity is conferred on the whole mark, and not on individual parts thereof. It is this very claim to exclusivity in the earlier mark, and the possibility of confusion, were the two marks to be simultaneously registered, that forms the foundation of the proscription against registration found in Section 11(1). The possibility of confusion

² 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.
- (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.

has, in either case, to be viewed from the perspective of the same mythical gentleman of average intelligence and imperfect recollection, first invoked by the Supreme Court in *Corn Products Refining Co. v. Shangrila Food Products Ltd*³. The impression, created on the “mind’s eye” of such a gentleman is of the entire earlier mark, seen as a whole. The principle that composite marks are to be compared as a whole, unless individual parts thereof are registered separately, is a thread that runs through the Trade Marks Act. One cannot, therefore, extract, from the cited  mark, only the word “AVATHAR” in order to compare it with the appellant’s **AVATAR** mark. The marks are to be compared as a whole.


(iii) Viewed thus, it is clear that there is no similarity between the cited  mark and the appellant’s **AVATAR** mark, except the phonetic similarity between the words “AVATHAR” and “AVATAR”. The cited  mark contains the sketch of a lady as well as the word “AVATHAR” written both in English and Tamil. These features are completely absent in the appellant’s **AVATAR** mark. No person of average intelligence and imperfect recollection would, therefore, confuse the cited  mark with the appellant’s **AVATAR** mark. It is extremely unlikely that the average

³ AIR 1960 SC 142

consumer would regard **AVATAR** as merely an *avatar*⁴ of



(iv) The Court is of the opinion that the Senior Examiner erred in merely emphasising the phonetic similarity between “AVATHAR” and “AVATAR”, without recognising the fact that

the cited  mark was a composite device mark containing a sketch, as well as the word AVATHAR written in two languages, compositely registered, with no registration of its individual parts or elements. The marks, to reiterate, were required to be compared as a whole and, when so compared, they cannot be treated as similar, much less identical.

13. In that view of the matter, it is not necessary for this Court to enter into the exercise of comparing the goods or classes in respect of which registration was sought, as identity or similarity of the marks and identity or similarity of the goods are required to be cumulatively satisfied for either of clauses (a) and (b) of Section 11(1) to apply, the conjunctive link, in each clause, being “and”, not “or”. If the competing marks are neither identical nor similar, therefore, no occasion arises to compare the goods or services in respect of which the marks are registered, or proposed to be registered.

14. Moreover, and at the cost of repetition, in view of the difference between the two marks, there was no likelihood of confusion, on the part

⁴ “Incarnation”, in vernacular

of the public, between them. The third requirement of Section 11(1) is also, therefore, not satisfied.

15. I am, therefore, of the considered opinion that the Senior Examiner has erred in rejecting the appellant's application.

16. The impugned order dated 13th September 2022 is, therefore, quashed and set aside.

17. As appellant's mark was never advertised, having been rejected at an initial stage, the Registrar is directed to advertise the mark and proceed thereafter in accordance with law.

18. The appeal stands allowed in the aforesaid terms.

19. Miscellaneous applications do not survive for consideration and stand disposed of.

20. Let this order be uploaded on the website of this Court within 24 hours.

C. HARI SHANKAR, J

FEBRUARY 27, 2023

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