



**E- Journal of Academic Innovation and
Research in Intellectual Property
Assets (E-JAIRIPA)**

Vol. V (ISSUE I) JAN -JUNE 2024, pg. 77-89



DECODING THE ANTI-DISSECTION AND DOMINANT FEATURE RULES: CONFLICT OR COMPLEMENT?

Nayana. K. B.¹ and Shivansh Sharma²

Abstract

This research paper delves into the intricate relationship between the Anti-Dissection Rule and the Dominant Feature Rule within trademark law, exploring whether these principles are in conflict or complement one another. Trademarks serve as vital assets for businesses, providing a unique identity and fostering consumer trust. However, the rise of similar trademarks in a competitive market has necessitated robust legal frameworks to prevent consumer confusion and ensure fair competition. The Anti-Dissection Rule posits that trademarks should be evaluated in their entirety, emphasizing the overall impression on consumers rather than focusing on individual components. This approach aligns with the objective of trademark protection, which seeks to avoid public confusion by considering the trademark as a whole. Conversely, the Dominant Feature Rule highlights the importance of identifying and protecting the primary elements of a trademark that consumers rely on for differentiation. Courts across jurisdictions grapple with applying these rules, particularly in cases where composite trademarks with distinctive elements are involved.

Through a detailed examination of case law, including landmark decisions such as PhonePe Ltd v. Ezy Services and Ultratech Cement Ltd v. Dalmia Cement Bharat Ltd, this paper illustrates how courts navigate the tension between these rules. The analysis reveals that while the Anti-Dissection Rule discourages dissecting trademarks into parts, the Dominant Feature Rule ensures that the most prominent elements of a trademark are safeguarded against infringement. Ultimately, this study argues that these two principles, rather than being antithetical, can be harmonized to provide comprehensive protection for trademarks. By considering both the overall impression and the dominant features, courts can more effectively address the challenges posed by modern trademark disputes, preserving the integrity of

¹ 4th yr student at National Law University, Odisha.

² 4th yr student at National Law University, Odisha.

intellectual property rights in an increasingly globalized market.

Keywords: Anti-dissection; Dominant Feature Rule; Trademark Law; Intellectual Property Rights; Consumer Confusion.

Introduction

The concept of trademark, as defined by intellectual property law, holds a significant position. It serves as a valuable asset for businesses, establishing a distinct identity for their products or services and instilling trust among consumers in a competitive market. The essence of a trademark lies in its unique and distinguishable nature. This legal right is based on the fundamental principle of the dominant feature. This research paper embarks on a comprehensive exploration of the Dominant Feature Rule within the domain of trademark law. It aims to unravel the complexities of this rule, analyze its application in different jurisdictions, and elucidate its crucial role in safeguarding intellectual property rights. Through a detailed examination of case laws, legislative frameworks, and scholarly discourse, this study seeks to provide a clear understanding of the underlying principles, practical implications, and evolving trends associated with this fundamental doctrine. The genesis of the Dominant Feature Rule lies in the necessity to identify the primary elements that consumers rely on to distinguish and identify goods and services in the marketplace. Essentially, this rule dictates that when determining trademark infringement, courts must prioritize the dominant or distinctive features of a mark over its generic or descriptive components. By emphasizing the dominant elements, this rule strengthens the protection granted to trademarks, preserving their integrity and ensuring fair competition in commercial spheres. The application of the Dominant Feature Rule traverses a complex terrain shaped by diverse legal frameworks and approaches in jurisprudence. Courts across jurisdictions grapple with nuanced interpretations and applications of this rule, considering factors such as consumer perception, market context, and the interplay between visual, phonetic, and conceptual elements of trademarks.

This paper conducts a thorough examination of case law and statutory provisions to explore the diverse approaches taken by various legal systems, providing valuable insights into the factors influencing judicial decision-making and outcomes in trademark disputes. Additionally, it seeks to shed light on the changing landscape of the Dominant Feature Rule in light of modern challenges such as globalization, technological progress, and new forms of trademark usage. By analyzing recent developments and key precedents, the paper aims to clarify the evolving scope of trademark protection in a dynamic and interconnected global market. Ultimately, this study delves into the realm of trademark law, unraveling the complexities of the Dominant Feature Rule and its significant implications for safeguarding intellectual property rights. Through meticulous analysis and critical examination, it aims to enrich the ongoing conversation on

trademark jurisprudence, providing valuable insights for professionals, academics, and policymakers.

Basic Rule of Trademark Infringement

A Trademark serves as a unique protection and safeguards the value that is attached to the word of products or services offered by a business. The presence of like products in the market full of competitors makes it indispensable to protect the trademark. This protection ensures that the competitors do not sell similar products or services under the guise of the original company's name and the consumers are not confused and are better informed about the products or services they are buying.

This protection seems perfect until the problem of similar trademark arises. Since upon being granted trademark protection, the person gets the exclusive rights over its usage. But, there are instances where the trademarks are similar which leads to confusion in the market to the consumers destroying the objective of the trademark protection. This is where the anti-dissection rule comes to play³.

The theory of anti-dissection rule under trademark provides whether the alleged trademark violation or alleged similarity of the trademarks should be looked at its entirety or in parts or on the way the consumers perceive of the trademark. The underlying assumption of the theory is that the trademark when viewed in its entirety has a deeper and lasting impression on the consumers than the individual components of the trademark. Experts of trademark like McCarthy have tried to provide us with the rationale behind the rule. A great emphasis is placed on the importance of evaluating trademarks based on their commercial impression that it has on the average consumers in the market⁴. So, McCarthy has an opinion that when the conflict arises with respect to the trademarks on the ground that they are similar, the courts should instead of dissecting them into conflicting composite marks, should consider it in its entirety. This is coherent with the object of trademark that is to avoid public confusion.⁵

What the Statute Has to Say on Anti-Dissection

Anti-dissection rule has a genesis in sections 15 and 19 of the Trademark Act, 1999. Section 15 of the act has clearly provided that if the proprietor claims the trademark, needs to get each part of the trademark

³ Sonal Sinha, "PhonePe v. BharatPe: Anti Dissection v. Dominant Mark Test", The IP Press, June 16, 2021. < <https://www.theippress.com/2021/06/16/phonepe-vs-bharatpe-anti-dissection-vs-dominant-mark-test/>> (last accessed on March 18, 2024).

⁴ Swastik Shukla and Divyanshi Shukla, "Rooh Afza v. Dil Afza: A Classical Case of Deceptive Similarity", NLIU-IP Journal, February 9, 2023. < <https://csipr.nliu.ac.in/trademark/rooh-afza-v-dil-afza-a-classic-case-of-deceptive-similarity/>> (last accessed on March 18, 2024).

⁵ Diksha Mehta, "Analysis of grounds of Trademark Infringement", SSRN, August 1, 2020. <https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3788821> (last accessed on March 10, 2024).

registered separately or everything as a whole⁶. They may be registered as a series in one registration. This becomes even more crucial in cases of trademark infringement as the rights to take action against infringer is limited only to the extent the distinctive part of the trademark is misused. Trademark, in cases of presence of composite elements are in general protected as a whole. But, section 15 and 19 of the Act provides for registration of parts of the trademarks and trademarks as a series.

If the proprietor intends then he can get each component of the trademark registered, provided each element fulfils the conditions of an independent trademark and will be examined separately to determine the protection⁷.

Section 17 clause (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) Contain 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.*

The understanding of the section 17 provides that a person having a trademark on the composite marks, having different components in its trademark cannot claim exclusive rights over each individual characters⁸, as the protection is granted to it as a whole. If he wants to have claim over individual component of the trademark, he is supposed to get them registered under section 15 of the act.

Sub-section (2) of the section 17 uses “the registration thereof shall not confer any exclusive right”, which when read with the context makes it clear that registration of the composite mark as the trademark will not ipso facto confers any exclusive rights as to the individual parts of the composite mark. But, if the trade mark holder can establish exclusivity of the individual elements of the composite mark, he can then assert the exclusivity over the same.

Section 15(1) where the proprietor of a trademark claims to be entitled to the exclusive use of any part thereof separately, he may apply to register the whole and the part as separate trademarks.

The composite components of the trademark can be trademarked individually and the claim over the same would stand strong. The judiciary have tried to emphasis on these sections time and again. In the case of Ultratech Cement Limited and ors. V. Dalmia Cement Bharat Limited⁹, the trade mark (‘Dalmia Ultra’) and (UltraTech Cement’) was challenged by the Ultratech Cements, claiming that the usage of ‘Ultra’ by

⁶ Trade Mark Act, 1999, s. 15.

⁷ Mahak Meena, “Case notes on Subway IP LLC v. Infinity Food and Ors”, Khurana & Khurana, March 12, 2024. <<https://www.khuranaandkhurana.com/2024/03/12/case-note-on-subway-ip-llc-v-infinity-food-and-ors/>> (last accessed on March 18, 2024).

⁸ Trade Mark Act, 1999, s. 17.

⁹ Ultratech Cement Ltd v Dalmia Cement Bharat Ltd, 2016 SCC Online Bom 3574.

the Dalmia Cements being in the same industry has caused confusion in the public. The courts rightly held that Ultratech has not got the term ‘Ultra’ registered separately in order to claim trademark infringement. It also considered the point that Dalmia Cements has built its goodwill in the market and usage of ‘Ultra’ does not pose any problem to the UltraTech Cements.

Rule of Anti-Dissection V. Rule of Dominant Feature: A Legal Conundrum

It is a general perception that both these rules seem to be in contravention to each other. The rule of anti-dissection does not totally prohibit the consideration of each constituent elements in a composite mark. It is done to get a basic understanding of the overall impression created by the mark. When viewed holistically, they complement each other. Dissection the components of a trademark will vitiate the accuracy to assess the confusion caused by the likelihood, leaving many consequences. This rule helps in better and comprehensive evaluation of the trademarks, thereby preserving the integrity of the trademark protection.¹⁰ When the rule of anti-dissection is settled principle in the trademark violation but when the dominant or the essential component of the trademark is used by the competitor as their trademark, creates a deceptive similarity which ultimately causes confusion and violates the object of the trademark protection.¹¹ This is when having principle of dominant feature makes sure that such violations do not go unnoticed.¹²

Case Law Analysis

The recent judgement of the Delhi High Court in the case of *PhonePe Ltd v. Ezy Services*,¹³ has underscored the importance of protecting trademarks as a whole and not dissecting its components. The plaintiff had sued the defendant for a permanent and absolute injunction, from using the suffix “Pe” or any variant that can be deceptive to the users. Since both of the parties offer similar services in the online payment systems. The plaintiff and the defendant differ very slightly as to whom their services are available to, consumers. The plaintiff provides online transaction services between anyone who has their app, irrespective of the nature of the transaction. Be it a consumer-to-consumer or consumer-to-merchant.

¹⁰ Larisa Ertekin, Alina Sorescu and Mark. B. Houston, “Hands off My Brand! The Financial Consequences of Protecting Brands Through Trademark Infringement Lawsuits”, JSTOR, Vol.82. p 45-64. <<https://www.jstor.org/stable/44879063>> (last accessed on March 5, 2024).

¹¹ Yashvardhan Ranat, “Explained: PhonePe v. BharatPe Trade Mark Dispute- “Pe”/ Pay-as-you-go”, SCC OnLine, May 19, 2021. <<https://www.sconline.com/blog/post/2021/05/19/explained-phonepe-v-bharatpe-trade-mark-dispute-pe-pay-as-you-go/>>. (last accessed on February 28, 2024).

¹² Simranjeet Kaur, ““SUBWAY” and “SUBERB” not phonetically and deceptively similar; Delhi High Court dismisses Subway’s plea for injunction for its mark “SUBWAY” against Infinity Food’s mark “SUBERB””, SCC OnLine, January 17, 2023. <<https://www.sconline.com/blog/post/2023/01/17/subway-and-suberb-not-phonetically-and-deceptively-similar-delhi-high-court-dismisses-subway-plea-for-injunction-for-its-mark-subway-against-infinity-food-mark-suberb-legal-research-updates-news/>>.

¹³ *Phonepe (P) Ltd v Ezy Services*, 2022 SCC OnLine Del 2638.

While on the other hand, the defendant provides online payment services are exclusive to only the merchants. The court observed that the suffix “Pe” is a generic term used for “Pay” as the plaintiff is in the business of payments. Just misspelling the word, which remains phonetically identical to the original word will not change the literal meaning and has no unique stance under the trademark law to protect the same. Unless such misspellings or terms acquire their own meaning over the commercial usage.

The plaintiff’s argument was the categorization of dominant and essential features of the trademark. They argued that the word “phone” is an ordinary word and when combined with “Pe” gives “PhonePe”, thus, here the term “Pe” becomes the dominant and essential feature that needs protection against the defendant. Further adding that by keeping “P” in the “Pe”, they meant it to be a proper suffix and not as a single word. When any person with average and reasonable intelligence and recollection sees “Pe” in the defendants’ “BharatPe” will create a wrong impression of the plaintiff’s company, who have built their goodwill in the market for years before the establishment of defendant.

The defendant’s arguments relied on the principle of anti-dissection. They contested that the plaintiff had obtained the trademark protection not for “Pe” but for the whole of “PhonePe”. The idea behind this was to have an application that would work on all payment interfaces. Even if the dominant feature has to be considered, still would not amount to infringement as the words “Phone” and “Bharat” are different in all aspects. It was further put that there were no objections under section 11 of the trademark Acts, 1999 on the grounds of similarity to earlier trademarks.

The courts were challenged with the question to whether to apply the rule of anti-dissection or rule of dominant feature. It went with the rule of anti-dissection. It emphasized section 17(1), calling for a question to plaintiff that they never got their trademark protection for separate/individual components. This assumed that the consumers build perspective not from the components but from the entirety of the trademark. While it might be contended, the courts clarified that this application of the rule is just a preliminary step in the process of determination of the probable conflict in cases where there are conflicting composite words. The court further looked into the matter, as to the financial aspect, and asked the plaintiff to produce six months audit statements.

The court referred to the case of *South India Beverages Ltd. v. General Mills Mktg. Inc.*¹⁴ where it is provided that there might be cases that a particular element of a composite mark enjoys a much greater prominence than the other elements and this might call for terming that component as a “dominant mark”. Thus, it makes it clear that the rule of anti-dissection does not hinder the consideration of individual

¹⁴ *South India Beverages Pvt Ltd v General Mills Marketing*, 2014 SCC OnLine Del 1953.

components of any composite marks. It can be seen that both rules are employed in arriving at the conclusion of whether there is infringement or not, making them act in consonance/ complement each other rather than being antithetical.

Further, In the case of *Allied Blenders & Distillers (P) Ltd. v. SNJ Distillers (P) Ltd.*,¹⁵ the question was which part of the plaintiff's mark, Officer's Choice, was a dominant feature and which part was not. The court ruled that:

"11. In a composite mark, it is possible for both parts to be dominant. In Plaintiff's composite trademarks, [officer's choice] as an illustration, words 'Officer' and 'Choice' are both dominant. The additional factors which are pointers to the fact that 'Choice' is a dominant part of the composite marks are that : (a) restraint orders have been passed by the Courts against several third parties from using the marks which contain the word 'Choice', without the word 'Officer' such as 'Master's Choice', 'Collector's Choice', 'Our Choice', 'Sailor's Choice', 'Club's Choice', 'Spinner's Choice', 'Banker's Choice', 'Corporate Choice', etc.; (b) third parties copy the mark Choice as part of their trademark; (c) Plaintiff holds separate registrations for the mark 'Choice' in Class 32; and (d) 'Choice' is not descriptive of the goods but is arbitrary in nature."

In the case of *Sona Mandhira (P) Ltd. v. Sona BLW Precision Forgings Ltd.*,¹⁶ the court ruled that:

"67. In the present case, the plaintiffs have registration in their favour, of which the word "SONA" is a predominant part. It has registrations in the word mark "SONA BLW" as well. Applying the ratio of South India Beverages Pvt. Ltd. (supra), this Court in its judgment dated 02.08.2022 passed in CS(COMM) 383/2022, titled Sona BLW Precision Forgings Ltd. v. Sonae EV Private Limited, has held that "SONA" forms a dominant part of the plaintiffs' Trade Mark, thus is entitled to protection. It is also of import that the word "SONA" otherwise cannot be said to be descriptive or even suggestive of the goods in which the plaintiff deals in. Further, the reason given by the defendants for adoption of the word 'SONA' in its corporate name does not impress me, as has been explained hereinafter"

In *Lt. Overseas North America Inc. v. KRBL Ltd.*, 2023 SCC OnLine Del 1121, the court ruled that:

"51. Applying the above test to the facts of the present case, the word 'ROYAL' remains a dominant part of the trade mark of the plaintiffs. Remove the said word, the remaining is only an embellishment. Therefore, the word 'ROYAL' per se would also be entitled to protection, though while making a comparison with the complained mark, due deference would have to be laid to the fact that the plaintiff

¹⁵ *Allied Blenders & Distillers (P) Ltd v SNJ Distillers (P) Ltd*, 2023 SCC OnLine Del 2251.

¹⁶ *Sona Mandhira (P) Ltd v Sona BLW Precision Forgings Ltd*, 2023 SCC OnLine Del 2184.

does not have a word mark registration.”

“52. The plea of the defendant that the word ‘ROYAL’ is common to trade also cannot be accepted at the present stage. It would have to await a final decision when the parties have led their evidence. As held by this Court in *Pankaj Goel (supra)*, a use of a similar mark by a third party in violation of the plaintiff’s right is no defence.”

In *Subhash Chand Bansal v. Khadim’s*¹⁷, the court ruled that:

“27. Mere use of the prefix KHADIM’S, would not take the case out of the purview of Section 29 of the Trade Marks Act irrespective of whether the word KHADIM’S is bigger, equal or smaller than the word KHAZANA. There is a strong possibility of customers findings the shoes and boots etc. being sold under the trademark KHADIM’S KHAZANA in the stores of defendant no. 2 and confusing the same with the trademark of the plaintiff on account of use of the word KHAZANA in the trademark of the defendants. Moreover, a customer of average intelligence may presume that it is the product of the plaintiff which is being sold in the stores of the defendants and that is why the word KHAZANA is written on the product and/or its packaging or the customers may presume that there is some kind of trade connection between the plaintiff and defendant no. 2 and that is why the word KHAZANA is being used as a part of the trademark of the defendants, in respect of identical products.”

In *Bata India Limited v. Chawla Boot House*,¹⁸ the court ruled that

“24. After using the mark ‘POWER’ for almost 48 years, it cannot be said that the Plaintiff does not have a reasonable expectation of expansion into leather goods. Moreover, permitting Defendant No. 2 to use the mark ‘POWER FLEX’ today would also create a reasonable promise for Defendant No. 2 to expand the use of the mark ‘POWER FLEX’ in the sporting footwear. Thus, dissection of the product range, cannot be made so minutely i.e. sporting footwear leather footwear. Broadly these products fall under the class of footwear. It is a known fact that footwear brands usually use their brands for accessories/clothing like T-shirts, shorts, socks, belts, wallets, etc. Thus, in modern day usage, the brand is always evolving and the product category cannot be cast in stone.”

In summary, the Delhi High Court gives weight to the dominant features of a trademark, recognizes the potential for brand extensions, and takes a very comprehensive approach when it comes to determining the likelihood of confusion and infringement, considering various factors beyond the exact registered mark.

¹⁷ *Subhash Chand Bansal v Khadim’s*, 2012 SCC OnLine Del 4326.

¹⁸ *Bata India Limited v Chawla Boot House*, 2019 SCC OnLine Del 8147.

Legal Framework and Criteria for Determining Dominant Features

When it comes to deciding upon disputes regarding trademarks, the most crucial aspect to be taken care of is consumer perception. Thus, the courts, while ruling upon such cases, take into consideration certain principles that are related to consumer perception of brands and their marks.

The main conundrum is between two rules: the **Rule of Anti-Dissection** and the **Rule of Dominant**

Feature.

1. Rule of Anti Dissection

It says that, in case a conflict arises over some marks, they should be considered as a whole while the discrete elements of each character should not be taken into account. The principle of the theory is that the scheme mark which is composed of elements whole with the structure will be recognized by the consumer as the whole rather than the individual parts. In a nutshell, it discourages nitpicking minor differences between conflicting marks.

Section 15¹⁹ of the Trade Marks Act, 1999 states that:

“15. Registration of parts of trade marks and of trade marks as a series.—(1) Where the proprietor of a trade mark claims to be entitled to the exclusive use of any part thereof separately, he may apply to register the whole and the part as separate trade marks. (2) Each such separate trade mark shall satisfy all the conditions applying to and have all the incidents of, an independent trade mark. (3) Where a person claiming to be the proprietor of several trade marks in respect of the same or similar goods or services or description of goods or description of services, which, while resembling each other in the material particulars thereof, yet differ in respect of— (a) statement of the goods or services in relation to which they are respectively used or proposed to be used; or (b) statement of number, price, quality or names of places; or (c) other matter of a non-distinctive character which does not substantially affect the identity of the trade mark; or (d) colour, seeks to register those trade marks, they may be registered as a series in one registration”

Meanwhile, Section 17²⁰ states that:

“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 15 (ii) which is not separately registered by the proprietor as a trade mark; or (b) contains any matter which

¹⁹ Trade Marks Act 1999, s. 15.

²⁰ *Ibid*, s. 17.

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.”

When these sections are read conjointly, the legislative intent behind them is clear. The intent is that all these elements that make up the trademark, need to be read as a composite work and not as an amalgamation of singular units. Thus, the courts must not go into a hyper-semantic approach to differentiate between the marks.

The very basis of this proposition is the assumption, which is centred around the consumers, in the sense that a trademark is meant to create an impact on the consumer as a whole, not as individual components.

Thus, this Rule has now become a very important parameter when it comes to trademarks. It ensures that trademarks are assessed as a composition of all its ancillaries as a whole. This is done in order to save the uniqueness so that there is no confusion when it comes to the consumers.

2. Rule of Dominant Feature

This rule only finds a faint presence in Section 11(1)(b)²¹ of the Trade Marks Act, 1999 which states that:

“11. Relative grounds for refusal of registration.—(1) Save as provided in section 12, a trade mark shall not be registered if, because of—...(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.”

Courts often rely upon this as the basis for the Dominant Feature rule. The courts usually pronounce that a certain trademark has been infringed because a very strong part of the said mark has been used in the mark in dispute. Although this rule has a feeble legislative presence, the judicial backing that the rule has gotten over the years puts this rule on the same pedestal as the Anti-Dissection rule.

However, in India, the judicial footing regarding the said principles is not clear. Sometimes the court prefers the anti-dissection rule over the dominant feature rule, and sometimes the court prefers the dominant feature rule over the anti-dissection rule.

In the case of *Cadila Healthcare Ltd. v. Aureate Healthcare Pvt. Ltd. and Ors*²², the marks in question were “PANTOBLOC” and “PANTODAC”. The Delhi High court ruled that the marks must be read conjointly and not as different parts and ruled that the mark of the defendant was deceptively similar to that of the plaintiff.

The Delhi High Court in the case of *South India Beverages Pvt. Ltd. v. General Mills Marketing*²³, has rightly held that these two rules are not antithetical to one another, rather they are complimentary when viewed holistically. In this case, the plaintiff has the trademark ‘HAAGEN DAZS’, while the defendant

²¹ *Ibid*, s. 11.

²² *Cadila Healthcare Ltd v Aureate Healthcare Pvt Ltd*, 2012 SCC OnLine Del 3940.

²³ *South India Beverages Pvt Ltd v General Mills Marketing*, 2014 SCC OnLine Del 1953.

had the mark ‘D’DAAZ’, the High court granted the petitioner with the interim injunction from restraining the respondent from using its mark as it was deceptively similar to that of the plaintiff’s trademark. Both the parties were into the ice cream and confectionary business. The matter was further appealed in the Supreme Court.

In case of application of the anti-dissection rule, the plaintiff’s mark (‘HAAGEN DAZS’) should be compared in its entirety with the mark of defendant (‘D’DAAZ’) rather than dissecting them into different components. This would reject the claim of trademark violation as they are nowhere similar enough to cause public confusion.

In case of application of the dominant feature rule, the plaintiff’s mark (‘HAAGEN’) will be compared with the defendant’s mark (‘DAZS’), which would again reject the claim of trademark infringement.

The court in the present case harmonized the application of both the rules. It is recommended that both the rules should be applied simultaneously in deciding the case of trademark infringement. Here, the plaintiff’s mark (‘HAAGEN DAZS’), the court held that each component of the mark is equally dominant and significant and it is incoherent to choose only (‘HAAGEN’) as the dominant feature and reject (‘DAZS’) as not. Thus, by application of both the rules together, there was a clear deception by the defendant by using the mark. Furthermore, the court underlined the underlaying phonetic similarities in both the marks.

The Courts have also recognized that the rule of dominant feature is not in violation of the rule of anti-dissection. “For instance, in the *South India Beverages Pvt. Ltd. v. General Mills Marketing Inc*²⁴ case above, the Court observed that 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 complement each other. Further, the High Court of Delhi. While comparing the two Rules in the case of *Stiefel Laboratories v. Ajanta Pharma Ltd.*²⁵ observed that the rule of dominant feature is not in violation of the rule of anti-dissection, rather it is a preliminary step on the way to an ultimate determination of the confusion amongst the consumers.”

At the same time, in the case of *Sabmiller India Ltd. v. Jagpin Breweries Ltd.*²⁶, wherein the Plaintiff was the proprietor of the marks ‘ ’ and ‘FIVE THOUSAND’ and the Defendant claimed to be the proprietor of the mark ‘COX 5001’. The Bombay Court observed that the balance of convenience was in favour of the Plaintiff, as irreparable harm and injury would be caused to the Plaintiff if the Defendant was not enjoined from using the impugned trademark COX 5001 in respect of beer as that would lead to confusion amongst

²⁴ *Ibid.*

²⁵ *Stiefel Laboratories v Ajanta Pharma Ltd*, 2014 SCC OnLine Del 3405.

²⁶ *Sabmiller India Ltd v Jagpin Breweries Ltd*, 2014 SCC OnLine Bom 4842.

the consumers.”

Balancing Rules

To assess which rule would be applicable, the courts utilize different techniques. Firstly, it assesses Visual, Phonetic, and Structural Similarity. Visual Similarity examines how similar the marks appear visually, Phonetic Similarity considers how similar the marks sound when pronounced and Structural Similarity analyzes the structure and makeup of the rival marks. Another test relied upon by the courts is called “triple identity test”. In this, firstly, the identity of the goods and services is analysed,²⁷ whether the parties offer the same or similar products or services. Second, Availability and Consumer Base is considered, as to where the products are available and who the target consumers are. If both the plaintiff’s and defendant’s products are available at the same retail outlets and cater to the same class of consumers, there’s a higher potential for consumer confusion. Apart from trademark infringement, trade dress (the overall visual appearance and design of a product) also plays a role.

Conclusion

In the assignment, the focus is put on Dominant Feature Rule, a significant principle ensuring safeguarding of intellectual property rights. The main idea of the Dominant Feature Rule is to reveal the most expressive features of a mark that is shared with less a common part. Such components give a strong trademark protection. There is nothing more important in this situation than to assess the significance of primary signs that people regard as essential factors for making a choice. This principle reinforces that courts should be guided by the salient features of a mark when using it as a measure of trademark infringement, which ensures legitimate competition and safeguards the trademark values.

The Anti-Dissection Rule, however, attempts to synthesize the concurrent distinctive feature rule by highlighting that a mark should be taken into account as the whole and not severed into its components. Thus, a rule has been adopted to scrutinize trademarks as to whether their main commercial impression appears to the average consumers. The Trade Marks Act, 1999, in section 15, 17, and 19 has an established a legal structure for part registrations of marks and gives a clear rule that complete registration of a mark conveys exclusive right to the use of the mark as a whole.

In the legal dispute over trademarks, the courts, in their judgments, closely watch the consumers’ perception because it is a key factor. There is always a complex choice among Anti-Dissection Rule of

²⁷ “Decision sidesteps anti-dissection rule to insist that trademark components matter”, Worldtrademarkreview, May 11, 2023. <<https://www.worldtrademarkreview.com/article/decision-sidesteps-anti-dissection-rule-insist-trademark-components-matter>>. (last accessed on March 8, 2024).

Syntax and the Dominant Feature Rule. Rule of Anti-Dissection outlaws cherry-picking fewer differences that assessments rely on, and works to consider marks as an integrated whole, as this would maintain their uniqueness, and avert the possibility of confusing customers. However, in microscope feature the dominant feature Rule mainly seeks to pin point the basic theme of the To determine infringement.

One of significant cases aspiring from has been cited as *PhonePe Ltd v. Ezy Service* that illustrates how trademarks as whole are essential to be protected rather than being given pieces for the sake of keeping each part. Judges have always said that consumers' general perception of a trademark depends more on its totality than on what those parts stand for.

The mandatory compliance with both the Non-Dissection Rule and the Prominent Feature Rule leads to a properly balanced trademarks assessment in order to block the resemblance issues that might cause confusion in the minds of the consumers.

Finally, an in-depth study of both the Anti-Dissection Rule and the Dominant Feature Rule in the search of faster and better solutions to a trademark conflict would be necessary, therefore. Appealing to the unitary nature of theoretical brands and their other features that may be regarded as the leading ones, the courts will protect the intellectual property rights and consumer rights in observing the fairness of competition in a commercial world.
