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

% Judgment delivered on: 22.08.2025

\+ **C.A.(COMM.IPD-TM) 17/2025 & I.A. 8861/2025**

MENSA BRAND TECHNOLOGIES PRIVATE LIMITED .....Appellant

versus

REGISTRAR OF TRADE MARKS .....Respondent

Advocates who appeared in this case

For the Appellant	:	Mr. Aditya Gupta, Mr. Siddharth Varshney & Ms. Aakriti Bansal, Advocates.
For the Respondent	:	Ms. Nidhi Raman, CGSC with Mr. Arnav Mittal & Mr. Om Ram, Advocates

CORAM:
HON'BLE MR. JUSTICE TEJAS KARIA

JUDGMENT

TEJAS KARIA, J

1. The present Appeal has been filed under Section 91 of the Trade Marks Act, 1999, ("**Act**") being aggrieved by the order dated 17.01.2025 passed by the Registrar of Trade Marks ("**Impugned Order**"). The

Respondent, *vide* the Impugned Order, refused Application No. 6701235 filed by the *Mensa Brand Technologies Private Limited*, i.e., the Appellant for registration of the Trade Mark "PRO.FITNESS" in Class 30 ("**Subject Trade Mark**") on the ground that the Subject Trade Mark lacked distinctiveness as required under Section 9(1)(a) of the Act.

2. The Appellant is a Company engaged in selling rice-based snack food, rice cakes, crackers, rice crackers, rice crisps, rice thins, cookies, peanut butter cookies, filled cookies, peanut butter cups, chocolate ganache, chocolate fudge, frosting, frosting mixes, cake frosting, rolled oats, oats, foodstuff made of oats, processed oats for human consumption.

FACTUAL BACKGROUND

3. On 08.11.2024, the Appellant's predecessor-in-interest filed the Trade Mark Application No. 6701235 for the Subject Trade Mark "PRO.FITNESS" in Class 30 on a 'proposed to be used' basis. The Appellant's predecessor-in-interest filed a request for an expedited process of the Application for registration of the Subject Trade Mark, in the requisite form, on 11.11.2024.

4. The Respondent issued a First Examination Report ("**FER**") on 12.11.2024 raising objection under Section 9(1)(a) of the Act, stating that the Subject Trade Mark was not distinctive and not capable of distinguishing the goods or services of one person from those of others.

5. The Appellant responded to the FER through a detailed reply along with the relevant case laws on 12.12.2024. Thereafter, the Respondent issued a hearing notice dated 16.12.2025 scheduling a pre-publication hearing for the Subject Trade Mark on 16.01.2025. The Counsel for the

Appellant appeared for the hearing on 16.01.2025 and made submissions in favour of the registration of the Subject Trade Mark.

6. The Application for the registration of the Subject Trade Mark was rejected the next day, i.e., on 17.01.2025 *vide* the Impugned Order. Aggrieved by the rejection of the Application for registration of the Subject Trade Mark, the Appellant has filed the present Appeal submitting that the Impugned Order is arbitrary, legally flawed, and contrary to the basic principles governing Trade Mark examination.

SUBMISSIONS ON BEHALF OF THE APPELLANT

7. The learned Counsel for the Appellant submitted that the Appellant has successfully applied for and registered the Trade Mark "PROFITNESS" and other formative marks in India. The details of the Appellant's registrations and the applications, which have been accepted by the Respondent for the Trade Mark "PROFITNESS" and other formative marks in India are as under:

Sr. No.	Application No.	Class	Mark	Status as mentioned in the Appeal	Updated Status	Date of Acceptance
1.	6701225	5	PRO FITNESS	Accepted and advertised	Registered	16.01.2025
2.	6701226	5	PROFITNESS	Accepted and advertised	Registered	16.01.2025
3.	6701230	30	PRO FITNESS	Accepted and advertised	Registered	17.01.2025

4.	6701233	30	PROFITNESS	Accepted and advertised	Registered	17.01.2025
5.	6701236	30	PRO.FITNESS	Accepted and advertised	Registered	20.01.2025
6.	6701231	30	PRO FITNESS	Accepted and advertised	Registered	11.02.2025
7.	6701239	30	PROFITNESS	Accepted and advertised	Registered	27.01.2025
8.	6701240	30	PROFITNESS	Accepted and advertised	Registered	27.01.2025
9.	6701241	30	PRO.FITNESS	Accepted and advertised	Registered	27.01.2025
10.	6701242	30	PRO.FITNESS	Accepted and advertised	Registered	27.01.2025
11.	6701224	5	PRO FITNESS	Accepted and advertised	Period of opposition expired on 17.07. 2025	04.03.2025
12.	6701227	5	PROFITNESS	Accepted and advertised	No change- period of opposition expired on 24.07. 2025	10.03.2025
13.	6701229	5	PRO.FITNESS	Accepted and	No	10.03.2025

				advertised	change-period of opposition expired on 24.07. 2025	
14.	6701238	30	PRO FITNESS	Accepted and advertised	Registered	06.02.2025
15.	6536543	5	PROFITNESS	Registered	N/A	02.08.2024
16.	**Impugned Application** 6701235	30	PRO.FITNESS	Refused	N/A	

8. The learned Counsel for the Appellant submitted that the Subject Trade Mark "PRO.FITNESS" is not a commonly used phrase and has been coined and stylised in a manner that gives it a distinctive identity. It is neither found in the dictionary, nor is it a term used in the ordinary course of trade.

9. The learned Counsel for the Appellant further submitted that the Respondent erroneously treated the Subject Trade Mark as a combination of two generic words, "PRO" and "FITNESS", and ignored the settled rule that a Trade Mark has to be looked at in its entirety, a principle often referred to as the Anti-Dissection Rule. This rule is recognised under Section 17(1) of the Act and reaffirmed in several decisions, including ***Ticona Polymers Inc. v. Registrar of Trade Marks***, 2023 SCC OnLine Del 1234; ***Muneer Ahmad v. Registrar of Trade Marks***, 2023 SCC OnLine Del 7345 and ***Grey Matters***

Educational Trust v. Examiner of Trade Marks, 2024 SCC OnLine Del 7390.

10. The learned Counsel for the Appellant further submitted that the Registrar conflated two different legal standards, i.e., the absence of distinctiveness under Section 9(1)(a) of the Act and descriptiveness under Section 9(1)(b) of the Act. The Registrar gave no explanation as to how the mark, viewed as a whole, fails to distinguish the Appellant's products from others in the market.

11. The learned Counsel for the Appellant further submitted that the dot placed between the words "PRO" and "FITNESS" adds visual distinction and renders the Subject Trade Mark inventive. The Subject Trade Mark does not directly describe any characteristic or quality of the goods for which the registration is sought.

12. The learned Counsel for the Appellant further submitted that following the rejection of the Application for the Subject Trade Mark, the Respondent has accepted or advertised at least 15 other applications of the Appellant containing the identical or similar "PRO.FITNESS" Trade Marks including Applications Nos. 6701225, 6701230, and 6701233. It was submitted that the Respondent has displayed inconsistency and arbitrariness in the decision-making process.

13. The learned Counsel for the Appellant placed reliance on a catena of judicial precedents to support the submission that the Subject Trade Mark "PRO.FITNESS" is distinctive, coined, and registrable under Section 9(1)(a) of the Act. The principle that coined marks or invented combinations, even if composed of common elements, can function as source identifiers, was established in early jurisprudence. This was recognised in ***Griffiths Hughes***

Ltd. v. Vick Chemical Co., AIR 1951 Cal 386, and subsequently applied in ***A.R. Khaleel and Sons v. Registrar of Trade Marks***, AIR 1960 Mad 251. The Supreme Court later affirmed and crystallised this principle in ***F. Hoffmann-La Roche & Co. Ltd. v. Geoffrey Manners & Co. Pvt. Ltd.,*** (1969) 2 SCC 716, lending authoritative support to the established jurisprudential position.

14. The learned Counsel for the Appellant further relied upon the judgment of ***Sky Enterprise Pvt. Ltd. v. Abaad Masala & Co***., 2020 SCC OnLine Bom 750, wherein the Bombay High Court reiterated that phonetic and visual distinctiveness may render a mark registrable even if some components are descriptive. The principle of consistency in decision-making was reaffirmed by the Intellectual Property Appellate Board (IPAB) in ***Hindustan Unilever Ltd. v. Registrar of Trade Marks***, 2020 SCC OnLine IPAB 69.

15. The learned Counsel for the Appellant further relied upon the judgment of this Court in ***Disruptive Health Solutions Pvt. Ltd. v. Registrar of Trade Marks***, 2022 SCC OnLine Del 2002, wherein it was held that the marks that are arbitrary or structurally novel can function as badges of origin. Similar reasoning was adopted in ***Abu Dhabi Global Market v. Registrar of Trademarks***, 2023 SCC OnLine Del 2947, and in ***Ticona Polymers Inc. v. Registrar of Trade Marks*** (*supra*), wherein this Court set aside the order of refusal of the mark "COOLPOLY", with the finding that composite marks must be assessed in totality.

16. The learned Counsel for the Appellant further relied upon the judgments of ***Grey Matters Educational Trust v. Examiner of Trade Marks*** (*supra*) and ***Muneer Ahmad*** (*supra*), this Court reiterated that the Registrar

cannot apply Section 9(1)(a) of the Act mechanically or dissect a composite mark into generic parts when the whole exhibits distinctiveness.

17. Accordingly, the Impugned Order deserves to be set aside and the Respondent be directed to procced with the advertisement of the Subject Trade Mark.

SUBMISSIONS ON BEHALF OF THE RESPONDENT

18. The learned CGSC for the Respondent submitted that the Appellant had failed to bring to the attention of the Respondent the existence of similar or related Trade Mark Applications. It was further submitted that the Respondent acted under a *bona fide* belief that the Subject Trade Mark could not be registered in accordance with law and assessed the application based on the material on record available at the time.

ANALYSIS AND FINDINGS

19. Having considered the submissions and the record, the rejection of the Application for registration of Subject Trade Mark "PRO.FITNESS" under Section 9(1)(a) of the Act proceeds on an incorrect application of the law.

20. It is trite law that the distinctiveness of a Trade Mark must be judged as a whole, without dissecting it into its individual elements as has been established in the decision of this Court in the case of ***Under Armour Inc. v. Anish Agarawal & Another***, 2025 SCC OnLine Del 3784, wherein it is held that it is well settled that the question whether competing Trade Marks are similar cannot be decided by dissecting them and then comparing their parts for similarities.

21. The Respondent's treatment of "PRO" and "FITNESS" as separate generic words fails to consider the Subject Trade Mark in its entirety,

contrary to the Anti-Dissection Rule affirmed in ***Ticona Polymers Inc.*** (*supra*), ***Grey Matters Educational Trust*** (*supra*), and ***Muneer Ahmad*** (*supra*).

22. The Subject Trade Mark, though composed of familiar words, is presented in a distinctive configuration. The dot between "PRO" and "FITNESS" is not merely punctuation, it creates a break in meaning and contributes to the overall visual and phonetic uniqueness of the Trade Mark. This nuance has not been addressed in the Impugned Order.

23. The Respondent has not concluded that "PRO.FITNESS" is a commonly used expression in the trade, or that it is incapable of identifying the source of the goods. The subsequent acceptance of over 15 Applications of the Appellant bearing the identical and other formative marks for identical goods by the Respondent belies the conclusion arrived at in the Impugned Order.

24. The Respondent's contention that the Appellant was duty-bound to apprise the Respondent of the other Trade Mark Applications is fundamentally misconceived. No such obligation is imposed upon an Applicant under the provisions of the Act. The onus of conducting a fair, thorough, and consistent examination lies squarely with the Respondent. Furthermore, the Impugned Order suffers from a complete absence of reasoning. It fails to address the specific contentions raised in response to the FER and neglects to apply any meaningful analysis under the distinctiveness test.

25. In view of the facts and circumstances, the present Appeal deserves to be allowed. Accordingly, the Impugned Order dated 17.01.2025 is hereby set aside. The Respondent is directed to advertise the Subject Trade Mark,

"PRO.FITNESS" under Application No. 6701235 in the Trade Marks Journal, within two months and proceed further in accordance with law.

26. A copy of the present Order shall be sent to the Office of the Controller General of Patents, Designs and Trade Marks on e-mail ID – llc-ipo@gov.in, for necessary compliance.

27. The Appeal is allowed and the pending Application stands disposed of.

TEJAS KARIA, J

AUGUST 22, 2025/ *'A/N'*