(2017) 12 DEL CK 0344

Delhi High Court

Case No: Civil Suit (COMM) No. 327 Of 2016

Bigtree Entertainment Pvt Ltd		APPELLANT
	Vs	
Brain Seed Sportainment Pvt Ltd & Anr		RESPONDENT

Date of Decision: Dec. 13, 2017

Acts Referred:
Trade Marks Act, 1999 â€" Section 17(1), 17(2)

Citation: (2017) 12 DEL CK 0344

Hon'ble Judges: Mukta Gupta, J

Bench: Single Bench

Advocate: Sidharth Aggarwal, Swathi Sukumar, Rupali Samuel, Surya Rajappan, Akshay Vaddagiri, M.K. Miglani, Nitin Thukral, Aayushmann Gauba, Galav Sharma

Judgement

Mukta Gupta, J

IA 4462/2016 (u/O XXXIX R 1&2 CPC) and IA 6054/2016 (u/O XXXIX R 4 CPC by defendants)

1. Bigtree Entertainment Pvt. Ltd, hereafter referred to as Ã¢â‚¬Ëœplaintiffâ€™, in the present suit inter alia seeks permanent injunction against the

defendant, its partners, proprietors, or as the case may be, assignees in business franchisees licensees, distributors, dealers and agents from in any

manner using the mark Ã¢â‚¬Å“BOOKMYSPORTSÃ¢â‚¬â€‹, or using the prefix Ã¢â‚¬Å“BOOKMYÃ¢â‚¬â€‹.

2. As per the plaint, plaintiff company was established in 1999. Through its website Ã¢â‚¬Å“www.bookmyshow.comÃ¢â‚¬ and mobile app

BOOKMYSHOW, plaintiff provides a range of ticketing solutions through call centers, Internet ticketing, kiosk and a mobile ticketing platform. Since

launching of its website in 2007, plaintiff has emerged as a prominent player in the ticketing industry and has established its presence in 26 states in

India. Plaintiff has been the official ticketing partner inter alia for major sports events and cinema houses and has placed on record numerous extract

of news reports highlighting its extensive coverage in domestic and international markets. Plaintiff has also placed on record its sales figures from

2010-2015 and given examples of various accolades won and capital raised in light of its performance. Plaintiff has secured several trademarks under

Classes 41 and 42 for BOOKMYSHOW word marks and logos, notwithstanding filing applications for numerous other BOOKMYSHOW and

BOOKMY trademarks as well. Plaintiff has given examples of diligently safeguarding its trademark interests in the past, including against

Ã¢â‚¬Å“www.bookmysport.inÃ¢â‚¬, who, it is noted, has no relation to defendant. Plaintiff believes that its performance in the ticketing industry and wide

publicity since associated with the plaintiff have given the BOOKMYSHOW trademark a secondary meaning associated with high standards of

service delivery and professionalism, further claiming that the prefix BOOKMY is an essential part of plaintiffÃ¢â‚¬â„¢s registered trademark as it has

acquired a distinctiveness over a period of time that is exclusively associated with the plaintiff.

3. Brain Seed Sportainment Pvt. Ltd, hereinafter referred to as Ã¢â‚¬Ëœdefendant, is a corporate entity incorporated on 15th May, 2015. DefendantÃ¢â‚¬â„¢s

website, Ã¢â‚¬Å“www.bookmysports.comÃ¢â‚¬, is an online platform for booking sports facilities. The domain name Ã¢â‚¬Å“www.bookmysports.comÃ¢â‚¬ was

created on 6th March, 2010. The creator is unknown. During the period 6th March, 2010 to 15th May, 2015, the domain was parked on the World

Wide Web with no activity. Archival history reaffirming this was placed on record. Plaintiff claims to have been first aware of defendantÃ¢â‚¬â„¢s

existence in December 2015 after one of its employees found a media article on the Internet detailing the defendantÃ¢â‚¬â„¢s launch. In the plaint, the

plaintiff claims that defendantÃ¢â‚¬â„¢s trademark is deceptively similar to the plaintiffÃ¢â‚¬â„¢s and can mislead prospective clients into associating

defendantÃ¢â‚¬â„¢s domain with the plaintiffÃ¢â‚¬â„¢s due to the substantial goodwill and publicity acquired by plaintiff. Plaintiff contends that this amounts to

infringement and passing off of the plaintiffÃ¢â‚¬â„¢s trademarks. Plaintiff concedes that it does not possess trademark on the prefix BOOKMY but avers

that it is not the words BOOK, MY, and SHOW in isolation, but the interplay of these words which give the trademark distinctiveness. Plaintiff claims

that continued existence of defendantÃ¢â‚¬â„¢s domain name is financially highly detrimental and injurious to plaintiffÃ¢â‚¬â„¢s reputation.

4. When this suit came up on 19th April 2016, this Court granted an ex-parte ad interim order of injunction as prayed for in Clause (a). This interim

order was later suspended on 20th September 2016. This order remains in abeyance till date.

5. In the written statement, defendant has taken a number of objections to averments in the plaint. In paragraph 3, defendant claims against the

plaintiff (i-iii) concealment of contrary stand in other proceedings, (iv) plaintiff has specifically but falsely pleaded to be the exclusive user and adopter

of the mark BOOKMY/BOOKMYSHOW, (v) third party prior use and registrations concealed, (vi) concealment and misrepresentation qua cause of

action, and (vii) concealment of opposition to and rectifications filed against the plaintiffÃ¢â‚¬â„¢s trademark BOOKMY and BOOKMYSHOW.

Defendant claims that the plaintiff has admitted in a letter to the Registrar of Trademarks that defendantÃ¢â‚¬â„¢s trademark BOOKMYSPORTS is

dissimilar and distinct from plaintiffÃ¢â‚¬â„¢s trademark BOOKMYSHOW. Defendant further claims that its domain of activity being booking sports

facilities is squarely different from that of the plaintiffÃ¢â‚¬â„¢s except insofar as they are both engaged in facilitating online bookings. Defendant further

claims that the prefix BOOKMY is not a invented phrase meriting legal protection, but a descriptive one that is common to the particular business

being run. To support this defendant has placed on record a list of domain names containing the prefix in question that have been registered prior to

plaintiffÃ¢â‚¬â„¢s, as well as a list of domain names that have been registered since. Defendant claims that given the quantity of domain names that exist

with the prefix in question, plaintiff cannot claim its usage of the prefix conveys distinctiveness toward the plaintiffÃ¢â‚¬â„¢s brand. Defendant further

submits that its trademark is visually, structurally, and conceptually different from the plaintiffÃ¢â‚¬â„¢s and is not likely to cause deception or confusion

with the plaintiffÃ¢â‚¬â„¢s mark. Learned counsel for the defendant relies on the judgments reported in (1898) 15 R.P.C. 465 Hodgson & Simpson v.

Kynoch Ltd; (1955) 2 SCR 252 Registrar of Trade Marks v. Ashok Chandra Rakhit Ltd;. (2010) ILR 2 Del 165 P.P. Jewellers Pvt. Ltd v. P.P.

Buildwell Pvt. Ltd; (2010) 169 DLT 35 P.P. Jewellers Pvt. Ltd v. P.P. Buildwell Pvt. Ltd. ; 1994 Supp (3) SCC 215 J.R. Kapoor v. Micronix India;

(1969) 2 SCC 716 F. Hoffmann-La Roche and Co. Ltd. v. Geoffrey Manners and Co. Private Ltd; .(2014) 3 HCC (Del) 248 Living Media India Ltd.

v. Alpha Dealcom (P) Ltd.; 2016 (65) PTC 614 (Del) SK Sachdeva v. Shri. Educare Limited a;nd (2010) 174 DLT 279 Marico Limited v. Agro Tech

Foods Limited.

6. In the rejoinder affidavit plaintiff sought to clarify the parameters of its suit. Plaintiff stated that one of its word marks BOOKMYSHOW was

registered in class 41 and another one was registered in class 42. Plaintiff states that as per the World Intellectual Property OrganizationÃ¢â‚¬â„¢s

(WIPO) Nice Classification, the services that are protected under Class 41 include the very activities that defendant is engaged in, including but not

limited to 410035, providing sports facilities, and 410190, rental of sports grounds. Plaintiff also contends that defendant is guilty of dishonest adoption

as the defendant realized the goodwill of BOOKMYSHOW and the BOOKMY prefix. To support this claim plaintiff asserts that defendant has not

placed on record any information of its customer base, volume of sales, or any other details of its business activities. Plaintiff also brings to notice that

the defendant has not challenged the legal validity of the plaintiffÃ¢â‚¬â„¢s mark. Plaintiff claims that this is because defendant itself wants the mark

BOOKMYSPORTS as defendant has filed a trademark application for BOOKMYSPORTS as well. Plaintiff contends that a party that wants a

monopoly on a mark cannot be heard to say that the mark cannot be registered.

7. Learned counsel for the plaintiff further claims that defendant only read to the Court Section 17(1) of the Trade Marks Act, 1999 (in short TM

Act), without reading sub-clause (2). Section 17 of the TM Act reads as under:

Ã¢â‚¬Å“17. Effect of registration of parts of a mark.Ã¢â‚¬

(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 markÃ¢â‚¬

(a) contains any partÃ¢â‚¬

(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.Ã¢â‚¬â€‹

8. Learned counsel for the plaintiff states that plaintiff filed a separate application for the word mark BOOKMY. Finally learned counsel for the

plaintiff disputed defendantÃ¢â‚¬â„¢s claims that it has suppressed and concealed material particulars from the Court. Plaintiff does not deny its

correspondence with the Registrar of Trademarks, but states that this should be construed as a layered response rather than a legally binding ceding of

its rights. Learned counsel for the plaintiff relied on the judgments reported in (2002) 98 DLT 565 Essel Packaging Ltd. v. Sridhar Narra; (2009) 156

DLT 1 Ford Motor Company v. CR Borman ;(2004) 29 PTC 435 Dr. Reddy's Laboratories Ltd. v. Reddy Pharmaceuticals Limite d; (2004) 6 SCC

145 Satyam Infoway Ltd. v. Siffynet Solutions (P) Ltd;. (2015) 221 DLT 359 Shree Nath Heritage Liquor Pvt. Ltd. v. Allied Blenders & Distillers

Pvt. Ltd; and (1999) 77 DLT 292 Automatic Electric Ltd. v. R.K.Dhawan.

9. It is not in dispute that the plaintiff owns a trademark for its domain name, www.bookmyshow.com. Therefore determining whether the

defendantÃ¢â‚¬â„¢s use of the prefix common to both trademarks, Ã¢â‚¬Å“BOOKMYÃ¢â‚¬, amounts to infringement and/or passing off of the plaintiffÃ¢â‚¬â„¢s

mark hinges on the ancillary question of whether the prefix is a descriptive phrase or an invented term.

10. The question of whether a phrase is descriptive or invented was considered in great depth by the Supreme Court in 1994 Supp (3) SCC 215 J.R.

Kapoor v. Micronix India, and it was held that a word which is descriptive of the industry or market in which the concerned party operates cannot be

deemed to be invented:

Ã¢â‚¬Å“6. There are two things which impress us. Firstly, the appellant is not manufacturing any one product such as the boosters, which has

been mainly taken into consideration by the High Court. He is producing various electrical and electronic apparatus in many of which

micro-chip technology is used. Even the boosters which he manufactures and sells are of two types, viz., transistorised boosters and

integrated circuit boosters whereas the respondent-plaintiff manufactures aerial boosters only of the first type. Thus micro-chip technology

being the base of many of the products, the word Ã¢â‚¬ËœmicroÃ¢â‚¬â„¢ has much relevance in describing the products. Further, the word

Ã¢â‚¬ËœmicroÃ¢â‚¬â„¢ being descriptive of the micro technology used for production of many electronic goods which daily come to the market, no

one can claim monopoly over the use of the said word. Anyone producing any product with the use of micro-chip technology would be

justified in using the said word as a prefix to his trade name. What is further, those who are familiar with the use of electronic goods know

fully well and are not likely to be misguided or confused merely by, the prefix Ã¢â‚¬Ëœmicroà¢â‚¬â„¢ in the trade name. Once, therefore, it is held

that the word Ã¢â‚¬Ëœmicroà¢â‚¬â„¢ is a common or general name descriptive of the products which are sold or of the technology by which the

products are manufactured, and the users of such products are, therefore, not likely to be misguided or confused by the said word, the only

question which has to be prima facie decided at this stage is whether the words Ã¢â‚¬Ëœtelà¢â‚¬â„¢ and Ã¢â‚¬Ëœnixà¢â‚¬â„¢ in the trade names of the

appellant and the respondent are deceptive for the buyers and users and are likely to misguide or confuse them in purchasing one for the

other. According to us, phonetically the words being totally dissimilar are not going to create any such confusion in the mind of the users.

Secondly, even the visual impression of the said two trade names is different. In the first instance, the respondent's trade name

Ã¢â‚¬Ëœ MICRONIXÃ¢â‚¬â„¢ is in black and white in slimmer letters and they are ensconced in designs of elongated triangles both above and below

the said name. On the other hand, the appellant's trade name Ã¢â‚¬Ëœ MICROTELÃ¢â‚¬â„¢ is in thick bold letters in red colour without any design

around. As regards the logo, the respondent's logo consists of the word Ã¢â‚¬Ëœ MÃ¢â‚¬â„¢ in a slim letter with Ã¢â‚¬Ëœ IÃ¢â‚¬â„¢ sporting a dot on it and

drawn in the well of Ã¢â‚¬Ëœ MÃ¢â‚¬â„¢. Below the letter Ã¢â‚¬Ëœ MÃ¢â‚¬â„¢ in small letters is written the word Ã¢â‚¬Ëœ MICRONIXÃ¢â‚¬â„¢ and all these letters and

words are written in white in a black square in north-south direction. As against this, the appellant's logo is one letter, viz., Ã¢â‚¬Ëœ MÃ¢â‚¬â„¢ which

is drawn in bold broad letter with its left leg slimmer than all other parts which are in thick broad brush. The letter has also white lines

drawn across it which is in blue colour. There is no other letter nor is it set against any background. We are, therefore, unable to see how

the visual effect of both the logos will be the same on the mind of the buyers. This being the case, we are of the view that there is not even

the remotest chance of the buyers and users being misguided or confused by the two trade names and logos. Same is the case with the

carton which merely reproduces both the trade names and the logos.Ã¢â‚¬‹

11. In (1969) 2 SCC 716 F. Hoffmann-La Roche and Co. Ltd. v. Geoffrey Manners and Co. Private Ltd. Supreme Court applied the principle of using

the characteristics of the market in which a party operates as a test to determine descriptiveness or inventiveness and held that the words which are

descriptive of a particular industry cannot be deemed to be invented:

Ã¢â‚¬Å“8. In order to decide whether the word Ã¢â‚¬Å“DropovitÃ¢â‚¬ is deceptively similar to the word Ã¢â‚¬Å“ProtovitÃ¢â‚¬ each of the two words must,

therefore, be taken as a whole word. Each of the two words consists of eight letters, the last three letters are common, and in the uncommon

part the first two are consonants, the next is the same vowel Ã¢â‚¬ËœOÃ¢â‚¬â„¢, the next is a consonant and the fifth is again a common vowel

Ã¢â‚¬ËœOÃ¢â‚¬â„¢. The combined effect is to produce an alliteration. The affidavits of the appellant indicate that last three letters Ã¢â‚¬Å“VitÃ¢â‚¬ is a well

known common abbreviation used in the pharmaceutical trade to denote vitamin preparations. In his affidavit, dated January 11, 1961

Frank Murdoch, has referred to the existence on the register of about 57 trade marks which have the common suffix Ã¢â‚¬Å“VitÃ¢â‚¬ indicating

that the goods are vitamin preparations. It is apparent that the terminal syllable Ã¢â‚¬Å“VitÃ¢â‚¬ in the two marks is both descriptive and common

to the trade. If greater regard is paid to the uncommon element in these two words, it is difficult to hold that one will be mistaken for or

confused with the other. The letters Ã¢â‚¬ËœDÃ¢â‚¬â„¢ and Ã¢â‚¬ËœPÃ¢â‚¬â„¢ in Ã¢â‚¬Å“DropovitÃ¢â‚¬ and the corresponding letters Ã¢â‚¬ËœPÃ¢â‚¬â„¢ and Ã¢â‚¬ËœTÃ¢â‚¬â„¢ in

Ã¢â‚¬Å“ProtovitÃ¢â‚¬ cannot possibly be slurred over in pronunciation and the words are so dissimilar that there is no reasonable probability of

confusion between the words either from the visual or phonetic point of view.Ã¢â‚¬â€‹

12. There does not exist a straightforward process to determine whether a phrase is invented or descriptive. In (2010) ILR 2 Del 165 P.P. Jewellers

Pvt. Ltd v. P.P. Buildwell Pvt. Ltd. this Court observed that existence of other companies bearing the prefix in question in itself may suggest that the

word is descriptive rather than distinctive. It was held:

Ã¢â‚¬Å“20. Then there are the Trade Mark Registry search reports which have been placed on record by the Defendants to show that an

application for registration of the mark PP has been made by the Plaintiff in almost every class of goods. There are numerous other

applicants for the said letter mark. A search was also made in the office of the Registrar of Companies which showed that there are a large

number of companies registered with the letters Ã¢â‚¬Å“PPÃ¢â‚¬ and therefore, there is nothing distinctive about those letters. Even for the kind of

services envisaged by Class 37 i.e. building and construction industry there are several companies with the letters Ã¢â‚¬Å“PPÃ¢â‚¬ as part of their

corporate name. While search reports in the Trade Marks Registry or in the Office of the ROC, do not by themselves prove use of the marks,

they are relevant for determining whether the letter mark in question is distinctive or merely descriptive.Ã¢â‚¬â€‹

13. Turning to the present case, plaintiffÃ¢â‚¬â„¢s domain www.bookmyshow.com and defendantÃ¢â‚¬â„¢s domain www.bookmysports.com are not the sole

users of the prefix Ã¢â‚¬Å“BOOKMYÃ¢â‚¬. In the written statement learned counsel for the defendant has submitted several pages of domain names

beginning with Ã¢â‚¬Å“BOOKMYÃ¢â‚¬ that have existed both before and subsequent to the plaintiffÃ¢â‚¬â„¢s website. This gives the first indication that the

prefix is a descriptive one.

14. Examination of the market in which the prefix is abundant further gives the impression that the prefix is not invented but a description of the type

of business that is being run. The phrase Ã¢â‚¬Å“BOOKMYÃ¢â‚¬ is not an arbitrary coupling of two English words. It is instead an apt description of a

business that is involved in the booking of a particular thing for its consumers, whether it is a concert, a movie, or a sports facility. DefendantÃ¢â‚¬â„¢s

adoption and application of this prefix to describe its activities as a sports facility booking domain appears prime facie to be a decision in concert with

other players in the booking industry.

15. Learned counsel for the plaintiff submits that the plaintiffÃ¢â‚¬â„¢s flourishing business has accorded the prefix Ã¢â‚¬Å“BOOKMYÃ¢â‚¬ with a secondary

meaning. The question of whether goodwill attached to a complete trademark carries over to part of that trademark was considered by a Division

Bench in this Court in (2010) 169 DLT 35 P.P. Jewellers Pvt. Ltd v. P.P. Buildwell Pvt. Ltd:

Ã¢â‚¬Å“21. It is to be seen as to whether the goodwill attained by the Appellants in its name Ã¢â‚¬Å“P.P. JewellersÃ¢â‚¬ or Ã¢â‚¬Å“PP TowerÃ¢â‚¬ or Ã¢â‚¬Å“PP

Designs EstateÃ¢â‚¬ has entitled the Appellant to claim goodwill and exclusivity in the word mark Ã¢â‚¬Å“PPÃ¢â‚¬ so as to oust others from using it

even in the business of construction. As the Appellant is not the only user of this word mark Ã¢â‚¬Å“PPÃ¢â‚¬â€‹, relying on the decision of the Hon'ble

Supreme Court in the case of Reliance Industries Ltd. v. Reliance Polycrete Ltd., 1997 PTC (17) 581, we are inclined to hold it in the

negative. The Hon'ble Supreme Court in the said decision held:

Ã¢â‚¬Å“Reliance has become synonymous with the Appellant's and their group Companies. In other words the Public or the common man

associates the word Ã¢â‚¬ËœRelianceÃ¢â‚¬â„¢ on with the Appellants and their group Companies irrespective of what the field of activity or trade in

which it is used. Mr. Nair is quite right that apart from showing that the Appellant-Company is incorporated in 1966, very conveniently it is

not stated when the other Companies were incorporated. Very conveniently it is also not stated what activities are carried out by the other

group Companies. Even otherwise by the time the Appellant-Company was incorporated, there were already in existence at least 10 Joint

Stock Companies with the word Ã¢â‚¬ËœRelianceÃ¢â‚¬â„¢ as their Corporate Name. Since then, there are in existence, only up to 1990, 167 Joint

Stock Companies with the name Ã¢â‚¬ËœRelianceÃ¢â‚¬â„¢ as their Corporate Names. As pointed out by Mr. Nair the Bombay Telephone Directory

has listed 92 Companies/firms with the name Ã¢â‚¬ËœRelianceÃ¢â‚¬â„¢. Undoubtedly the Appellant-Company is a big Company having a large

turnover. In the field of yarns and/or threads they may have acquired a distinctiveness in order to enable them to get a registered Mark in

Class-23. However, there is no material or evidence to show that the word Ã¢â‚¬Å“RelianceÃ¢â‚¬ is associated by the public only with the

Appellants or their group Companies in all fields of activities or trades. All the cases cited by Mr. Tulzapurkar were the cases where the

word was not a common English word but an invented word which had come to be associated with the Appellant-Company. Those cases

could therefore have no application to the present case, when the word is a common word in English language and where no material is

placed before the Court to show that in all fields of activities or trades it has come to be associated only with the Appellants or their group

Companies. In my prima facie view it does appear to be a case of too much self importance given to themselves by the Appellants. Fact that

so many Joint Stock Companies and firms, having word Ã¢â‚¬ËœRelianceÃ¢â‚¬â„¢ as their Corporate/firm name exist belies case that public/common

man associates the word only with the Appellants or their group Companies, no matter what the field of activity.Ã¢â‚¬â€‹

16. In the present case defendant has placed on record examples of numerous other companies that operate with the same domain prefix, and the

plaintiff has yet to put on record any evidence suggesting that the prefix Ã¢â‚¬Å“BOOKMYÃ¢â‚¬ is only associated in the minds of the public with the

plaintiffÃ¢â‚¬â„¢s business and nobody else, thus has acquired a secondary meaning and distinctiveness. Considering the fact that the words

Ã¢â‚¬Å“BOOKMYÃ¢â‚¬ are descriptive in nature and plaintiffÃ¢â‚¬â„¢s trademark Ã¢â‚¬Å“BOOKMYSHOWÃ¢â‚¬ has not acquired a distinctive meaning no case for

grant of injunction pending hearing of the suit is made out.

17. In view of the discussion aforesaid IA No.4462/2016 is dismissed and IA No.6054/2016 is disposed of.