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

% Judgment Pronounced on: 21.01.2019

+ CS(COMM) 609/2016

BIGTREE ENTERTAINMENT PVT LTD. Petitioner

Through Mr.Sandeep Sethi, Sr.Adv. with
Ms.Swathi Sukumar, Ms.Surya
Rajappan and Mr.V.Akshay, Advs.

versus

D SHARMA & ANR Respondents

Through Mr.M.K.Miglani, Mr.Jithin M.George,
Mr.Vivek Kishore and Mr.Rahul
Chandra, Advs.

**CORAM:
HON'BLE MR. JUSTICE JAYANT NATH**

JAYANT NATH, J.

**I.A. Nos. 25542/2014 (u/O 39 R 1 & 2 CPC), 1345/2015 (u/O 39 R 4
CPC), 12014/2016(u/O 39 R 1 & 2 CPC) & 1028/2017 (u/O 39 R 1 & 2
CPC)**

1. The present suit is filed by the plaintiff seeking an order of permanent injunction to restrain the defendants, their partners, proprietors, etc from in any manner using the mark 'BOOKMYEVENT' or using the prefix 'BOOKMY' as trade mark/trade name or as part of its corporate name, domain name or trading name in respect of online ticketing services or any similar services. Other connected reliefs have also been sought.

2. In IA No. 25542/2014, on 23.12.2014 this court had passed an ex parte interim injunction restraining the defendants from using the mark 'BOOKMYEVENT' or using the prefix 'BOOKMY' as trade mark/trade name or part of its corporate name, domain name or trading name in respect of online ticketing services or any other similar services.

3. IA No. 1345/2015 is filed for setting aside of the injunction order dated 23.12.2014. On 20.01.2015 in IA No. 1345/2015, the above injunction order was kept in abeyance till the next date of hearing. IA No. 12014/2016 is filed by the plaintiff to restrain the defendants, their partners, franchisees, licensees, etc. from using the mark 'BOOKMYEVENT' or using the prefix 'BOOKMY'. In the said application, it is pleaded that the defendants have conceded the impugned mark's limited scope of activities and are estopped from carrying on any activities which they themselves have given up by filing TM-16. Hence, the said application. IA No. 1028/2017 is filed by the defendants under Order 39 Rules 1 and 2 CPC to restrain the plaintiff from misusing the order dated 23.12.2014.

4. The basic facts as stated in the plaint by the plaintiff are that the plaintiff is a highly successful online ticketing venture 'BOOKMYSHOW' started in 2007. It is pleaded that the said 'BOOKMYSHOW.COM' is a leading entertainment booking portal in the country and has a significant share in the market with approximately 500 persons working for the company. It has also been pleaded that since 2010 'BOOKMYSHOW' has been a ticketing partner to the organizers of "Sunburn", the music festival held in Goa, F1 Race, etc. It has a five year deal as the online ticketing partner for PVR Cinemas. It is pleaded that BOOKMYSHOW business has received extensive coverage in domestic and international media. Total

revenues are said to be above Rs.150 crores per year. It is pleaded that by extensive sales, wide publicity, the plaintiff's trade mark BOOKMYSHOW has acquired secondary meaning and has come to be exclusively associated with the plaintiff. It has also been pleaded that the plaintiff has acquired rights in the trade mark 'BOOKMY' which has become a prefix associated exclusively with the plaintiff. The prefix 'BOOKMY' is an essential part of the plaintiff's registered trade mark. It is stated that the same has acquired distinctiveness over a period of time due to open, continuous and extensive use. It has also been pleaded that the plaintiff has filed various applications to consolidate its right in BOOKMYSHOW and BOOKMY trademarks which are pending and that the plaintiff has secured trade mark registration for the BOOKMYSHOW trade mark in Class 41 and 42.

5. It is further pleaded that defendant No. 2 appears to be a company using the trade name and style "Book my Event.in" based in New Delhi. In October 2014, while one of the plaintiff's employees was browsing the internet, the plaintiff was shocked to find that the defendants have adopted the brand 'Book my event' in relation to the same line of business as the plaintiff's 'BOOKMYSHOW' business. It is pleaded that the plaintiff has discovered that the defendant operates a website which is a copy of the plaintiff's 'BOOKMYSHOW' website. It is pleaded that the defendants intend to deceive prospective customers and purchasing public. Defendants have also attempted to defraud the Trade Marks Registry by applying for registration of the device/logo of the infringing trade mark under Class 41. Defendant No. 2 has wrongly stated the user date as 03.12.2012. It is pleaded that the defendants' infringing mark is phonetically, visually and structurally similar to the plaintiff's well known 'BOOKMY' and 'BOOKMYSHOW'

trademarks. There is likelihood of confusion considering that the defendants are using the trade mark in relation to the same class of services as those offered by the plaintiff. It is stated that the plaintiff has been using the trademarks 'BOOKMYSHOW' and 'BOOKMY' for more than 7 years now and for more than 5 years before the adoption of the infringing mark by the defendants. By 2012, the plaintiff's mark had acquired substantial goodwill and reputation. Hence, the present suit.

6. The defendants have filed their written statement. It has been pleaded that the plaintiff has wrongly pleaded that the cause of action arose in October 2014. It is pleaded that the plaintiff and defendants have been ticketing and promotional partners for several events/concerts, etc. The brand name and logo of the defendants and the plaintiff have appeared on various promotional contents, newspapers, pamphlets, sale tickets, etc. side by side. The first concert in this regard was held in 2011 titled as "Sham-E- Mehfil" which was a live Ghazal concert by Ghulam Ali and Ustad Ghulam Mustafa Khan held in Talkatora Stadium, New Delhi. The plaintiff was the online ticketing partner and the defendants were the online promotional partners. It has further been pleaded that in 2013, Formula-1 Event was organized by M/s. Jaypee Sports International Limited where similar situation prevailed. Similarly an event titled as "Sufiana Rang" featuring Sabri Brothers was held on 15.03.2014. It has further been pleaded that BOOKMY is a generic term used substantially in the industry and cannot be a subject matter of any trade mark. The registered trade mark of the plaintiff is 'BOOKMYSHOW' and the defendants are using the mark 'BOOKMYEVENT'. The features of the mark and colour combination used are entirely different. There can be no question of any deception.

7. I have heard learned counsel for the parties.
8. Learned senior counsel for the plaintiff has relied upon the judgments in the case of *Midas Hygiene Industries P. Ltd. & Anr. vs. Sudhir Bhatia & Ors.*, (2004) 3 SCC 90, *The Indian Hotels Company Ltd. & Anr. vs. Jiva Institute of Vedic Science and Culture*, 2008 (37) PTC 468 (Del.) and *Procter & Gamble Manufacturing(Tianjin) Co. Ltd. & Ors. vs. Anchor Health & Beauty Care Pvt. Ltd.*, 2014 (59) PTC 421 (Del.) to claim that the defendants are liable to be restrained from using the prefix 'BOOKMY' and they cannot be allowed to use their mark 'BOOKMYEVENT'. It has also been pleaded that by their application, the defendants have confined their trade mark to education, providing training, etc. by filing Form TM-16 and have sought to delete use of the mark for online ticket booking for movie, etc.
9. Learned counsel for the defendants has relied upon the judgment of the learned Single Judge of this court in the case of *Bigtree Entertainment Pvt. Ltd. vs. Brain Seeds Sportainment Pvt. Ltd. & Anr.*, 2018 (73) PTC 115 (Del) where injunction application of the plaintiff for the said prefix 'BOOKMY' was rejected holding that 'BOOKMY' is descriptive in nature and that the trade mark 'BOOKMYSHOW' has not acquired a distinctive meaning and hence, no injunction can be granted. It is pleaded that in appeal being FAO (OS) 218/2017, on 15.12.2017 the Division Bench had clarified that the orders of the Single Judge would not be treated as conclusive in any proceedings and all rights and contentions of the parties are reserved. However, it is stated that as the facts are identical, this court is bound to take the same view as that of the co-ordinate Bench. Reliance is also placed on the judgment of this court in *The Fairdeal Corporation Pvt. Ltd. vs. Vijay*

Pharmaceuticals, 1985 (5) PTC 80 (Del.) and J.R.Kapoor vs. Micronix India, 1994 (14) PTC SC 260.

10. The insistence of the plaintiff is that the defendants cannot use the mark 'BOOKMY' as prefix and should be restrained from using the same. It has been pleaded that such user would be contrary to the rights of the plaintiff in view of the fact that trademark 'BOOKMYSHOW' stands registered.

11. Section 17 of the Trade Marks Act reads as follows:-

“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.”

12. Reference in this context may be had to the judgment of the Single Bench of this court in *Bigtree Entertainment Pvt. Ltd. vs. Brain Sedes Sportainment Pvt. Ltd. vs. Anr.(supra)* where this court held as follows:-

“9.It is not in dispute that the plaintiff owns a trademark for its domain name, www.bookmyshow.com. Therefore determining whether the defendant's use of the prefix common to both trademarks, "BOOKMY", amounts to infringement and/or passing off of the plaintiff'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:

"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 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 'micro' has much relevance in describing the products. Further, the word 'micro' 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 'micro' in the trade name. Once, therefore, it is held that the word 'micro' 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 'tel' and 'nix' 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 'MICRONIX' 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 'MICROTEL' is in thick bold letters in red colour without any design around. As regards the logo, the respondent's logo consists of the word 'M' in a slim letter with 'I' sporting a dot on it and drawn in the well of 'M'. Below the letter 'M' in small letters is written the word 'MICRONIX' 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., 'M' 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."

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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:

"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 "PP" 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 "PP" 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."

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 "BOOKMY" 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. Defendant'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.

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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 "BOOKMY" is only associated in the minds of the public with the plaintiff's business and nobody else, thus has acquired a secondary meaning and distinctiveness. Considering the fact that the words "BOOKMY" are descriptive in nature and plaintiff's trademark "BOOKMYSHOW" has not acquired a distinctive meaning no case for grant of injunction pending hearing of the suit is made out."

13. The Division Bench in FAO (OS) 218/2017 on 15.12.2017 had noted as follows:-

"In these circumstances, the present order as well as the Single Judge's impugned order shall not be treated as conclusive in any proceedings including the Suit and all rights and contentions of the parties are reserved."

14. Hence, the Division Bench did hold that the order of the Single Judge would not be treated as conclusive in any proceedings.

15. I have however applied my mind independently to the facts of the case. The issue would be as to whether the mark " BOOKMY" has attained an exclusive meaning and the plaintiff can claim exclusive rights on the same.

16. I may look at the legal position in this regard independent of the above case. In *J.R.Kapoor vs. Micronix India (supra)* the Supreme Court was

dealing with the mark MICROTEL and MICRONIX wherein the Supreme Court held as follows:-

“6.....Thus micro-chip technology being the base of many of the products, the word ‘micro’ has much relevance in describing the products. Further, the word ‘micro’ 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 ‘micro’ in the trade name. Once, therefore, it is held that the word ‘micro’ 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 ‘tel’ and ‘nix’ 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 ‘MICRONIX’ 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 ‘MICROTEL’ is in thick bold letters in red colour without any design around. As regards the logo, the respondent's logo consists of the word ‘M’ in a slim letter with ‘I’ sporting a dot on it and drawn in the well of ‘M’. Below the letter ‘M’ in small letters is written the word

‘MICRONIX’ 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., ‘M’ 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.”

17. Similarly, in *F.Hoffman La Roche & Co.Ltd. vs.Geoffrey Manners & Co Pvt. Ltd., AIR 1970 C 2062* the court was dealing with trademark PROTOVIT which was registered in class 5 in respect of pharmaceutical preparation for human use and for veterinary use, infants’ and invalids’ foods and DROPOVIT was registered in respect of medicinal and pharmaceutical preparations and substances. The Supreme court held as follows:-

“12. In order to decide whether the word “Dropovit” is deceptively similar to the word “Protovit” 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 ‘O’, the next is a consonant and the fifth is again a common vowel ‘O’. The combined effect is to produce an alliteration. The affidavits of the appellant indicate that last three letters “Vit” 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 “Vit” indicating that the goods are vitamin preparations. It is apparent that the terminal syllable “Vit” 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 ‘D’ and ‘P’ in “Dropovit” and the corresponding letters ‘P’ and ‘T’ in “Protovit” 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.”

18. Reference may also be had to the judgments of the Division Bench of this court in *Living Media Limited vs. Alpha Dealcom Pvt.LTd. & Ors. 2016(66) PTC 200 (Del) (DB)*. The case of the plaintiff was that it was engaged in the publication of various magazines like India Today Travel Plus, Design Today and Magazine like Spice Today and Money Today etc. It was their case that they are using the mark ‘Today’ in its variance continuously since 1975 and has spent sufficient resources to promote and publicise these brands and that the plaintiff has earned the status of a well known trademark. The defendant had applied for registration of the trademark Nation Today. In that background the court held as follows:-

“17.The discussion of the facts discloses that the plaintiffs are owners of several registered trade marks. Prominent amongst these is INDIA TODAY which has been used for a weekly magazine since 1975; others are MUSIC TODAY, BUSINESS TODAY, a travel magazine “INDIA TODAY TRAVEL PLUS”, an architecture and design magazine “DESIGN TODAY”, and other magazines under the trade marks SPICE TODAY and MONEY TODAY, etc. The plaintiff also publishes daily newspaper MAIL TODAY. It has apparently acquired two trade marks TODAY in Classes 16 and 35. The argument for temporary injunction is that the plaintiffs have acquired distinctiveness

to the extent that TODAY has gained a secondary meaning in the news, publishing and media segment; it is also a well known trade mark. In support, they contend that the advertising and growing sales figures testify to the mark's gaining strength. The bedrock of their reputation is the word mark TODAY, with which the users and members of the public invariably associate the plaintiffs. Quite naturally, the defendant resists the argument and points out that TODAY is a descriptive term: descriptive of the services rendered by the plaintiff; it also has a strong descriptive or service associative meaning to the defendant's business i.e. news channel. Additionally, the defendant points out that TODAY has been used by several other channels and products and that per se absence of use of that word by the plaintiff in the English news channel segment cannot entitle it to ad interim injunctive relief.

18. There is no dispute about the fact that the plaintiff has been in the news magazine publication business for over four decades; if it asserts that it has acquired a strong reputation for the title INDIA TODAY, which is its registered trade mark, the Court would be correct in assuming it to be so.

However, does that per se along with sales figures and other financial details testifying to various brands and trade marks owned by the plaintiff, crystallise into a right to prevent others from using a common word, "TODAY" in respect of television news channel services. It is here that the matter requires a slightly closer scrutiny. The word TODAY is a common term and a dictionary one. Used in a non-contemporary sense i.e. without reference to time and as a mark, it could well be urged that it constitutes an arbitrary mark. However, its link with news is unmistakable. In this context, what acquires distinctiveness is the combination India Today.

19. The law demands closer scrutiny, when it comes to the use of common words (such as TODAY), that are descriptive (or semi-descriptive) of the services or goods offered by the service provider or

trader. This reluctance was best described in *Joseph Crosfield & Sons Ltd., In re* [(1910) 1 Ch 130] “Wealthy traders are habitually eager to enclose part of the great common of the English language and to exclude the general public of the present day and of the future from access to the inclosure.” Again, in *Mars GB Ltd. v. Cadbury Ltd.* [1987 RPC 387] it was held that:

“Where the trade mark allegedly used by the defendant comprises ordinary English words (such as ‘Page Three’, considered by Slade J. in *News Group Newspapers Ltd. v. Rocket Record Co. Ltd.* [1981 FSR 89] at 102) then, as this decision illustrates, that circumstance may be taken into account by the court in the process of reasoning.”

The burden of establishing that what are descriptive of the commercial activity and can be protected particularly when the plaintiff is not directly using it in the same field, but using it in combination with another or other words is heavy, as expressed in **My Kinda Town Ltd. v. Soll**[1983 RPC 407.]”

19. The aforesaid judgment would apply squarely to the facts of the present case. The plaintiff is using the mark ‘BOOK MY SHOW’ and claims that the plaintiff has earned a strong reputation in the market. Based on this, it has been pleaded that the prefix ‘BOOK MY’ has attained exclusive meaning under which only the plaintiff can claim rights. As noted in the above judgment it cannot be forgotten that ‘BOOK MY’ is a common English term. Its link with booking for shows, events, films etc is but obvious. It is a common general term descriptive of the services which are sought to be provided, namely, booking of a show, event, movie etc. That apart a closer look at the mark shows that prima facie the visual effect of both Trade Marks is not the same in the minds of the buyers. Prima facie the colour scheme, the font used by the defendant are entirely different and

people are unlikely to be misguided or confused by the said trade names and looks of the defendant's trade mark.

20. I agree with the judgment of this court in *Bigtree Entertainment Pvt. Ltd. vs. Brain Seeds Sportainment Pvt. Ltd. (supra)* that prefix BOOKMY is not an invented word. In fact, it is an apt description of a business that is involved, namely, booking of tickets for shows, events, films, etc. The fact as to whether this prefix BOOKMY has been accorded a secondary meaning and distinctiveness can only be established after the parties have led their evidence.

21. I may at this stage deal with another submission raised by the plaintiff to contend that the defendants have relinquished the use of the impugned trademark since filing of the suit in the field of booking of events. It is pleaded that defendant had filed an application for registration of the impugned mark under class 41. The trademark registry raised an objection about existence of the plaintiff's trademark under class 41 being a same/similar trademark. In response the defendant thereafter filed an application in Form 7N 16 for amendment of the trademark application. By way of amendment they requested that the specifications of online ticket booking for movies, seminars, etc. be removed from the specifications contained in the original trademark application. Hence, it is stated that by way of an amendment the defendant has limited the scope of his activities under the said trademark and is estopped from reclaiming the same. It is manifest that this objection is meaningless. Simply because the application for registration of a trademark was amended may not amount to relinquishment of any right to use the trademark. The plea is completely

misplaced. The plaintiff is seeking an injunction and must first make out a prima facie case.

22. Plaintiff has failed to make out a prima facie case. I do not see any reason to grant any injunction order in favour of the plaintiff. I dismiss the applications of the plaintiff i.e. IA No. 25542/2014 and 12014/2016. The applications of the defendants i.e. IA No. 1345/2015 and 1028/2017 are allowed as above.

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23. List before the Joint Registrar on 19.03.2019.

**(JAYANT NATH)
JUDGE**

**JANUARY 18, 2019
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