

\$~20

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

Date of Decision: 27th April, 2022

+ **CS (COMM) 268/2022 & I.As. 6443-47/2022**

MAKEMYTRIP INDIA PRIVATE LIMITED Plaintiff

Through: Mr. Amit Sibal, Sr. Advocate with
Mr. Mohti Goel, Mr. Sidhant Goel,
Mr. Deepankar Mishra, Mr. Abhishek
Kotnala and Mr. Karmanya Dev
Sharma, Advocates. (M:9716746496)

versus

BOOKING.COM B. V. & ORS. Defendants

Through: Mr. Chander Lall, Sr. Advocate with
Mr. Ankur Sangal, Ms. Pragya
Mishra and Mr. Shashwat Rakshit,
Advs. for D-1 & 2. (M:8874643389)
Mr. Arun Kathpalia, Sr. Advocate
with Mr. Aditya Gupta and Mr.
Sauhard Alung, Advocates for D-3.
(M:9425341404)
Mr. Sandeep Sethi, Sr. Advocate with
Mr. Neel Mason, Mr. Ankit Rastogi,
Mr. Vihan Dang, Ms. Vennela Reddy,
Ms. Aditi Umopathy, Mr. Parva
Khare and Ms. Devangini Rai,
Advocates for D-4 Google LLC.
(M:8373934003)

**CORAM:
JUSTICE PRATHIBA M. SINGH**

Prathiba M. Singh, J. (Oral)

1. This hearing has been done through hybrid mode.

I.A. 6446/2022 (for exemption)

2. This is an application seeking exemption from filing original

documents. Recording the Plaintiff's undertaking that the inspection of original documents shall be given, if demanded, and that the original documents shall be filed prior to the stage of admission/denial, the exemption is allowed.

3. *I.A. 6446/2022* is disposed of.

I.A.6447/2022 (for court fees)

4. This is an application seeking extension of time for filing of court fees. Ld. counsel for the Plaintiff submits that he has deposited the court fee in the treasury. One week time is extended for placing the stamp on record.

5. *I.A.6447/2022* is disposed of.

I.A. 6445/2022 (additional documents)

6. This is an application seeking leave to file additional documents under the Commercial Courts, Commercial Division and Commercial Appellate Division of High Courts Act, 2015 (*hereinafter, 'Commercial Courts Act'*). The Plaintiff, if it wishes to file additional documents at a later stage, shall do so strictly as per the provisions of the Commercial Courts Act.

7. *I.A. 6445/2022* is disposed of.

I.A.6444/2022 (sealed cover)

8. This is an application seeking leave to file select documents in a sealed cover. These documents have been perused by the Court and they set out the daily budget of the Plaintiff on the Google Ads Program.

9. Considering that the Defendant No.1 is one of the biggest competitors of the Plaintiff, the documents shall be kept in a sealed cover.

I.A.6444/2022 is disposed of.

CS (COMM) 268/2022

10. Let the plaint be registered as a suit.

11. Issue summons to the Defendants through all modes upon filing of Process Fee.

12. The summons to the Defendants shall indicate that the written statement(s) to the plaint shall be positively filed within 30 days from date of receipt of summons. Along with the written statements, the Defendants shall also file an affidavit of admission/denial of the documents of the Plaintiff, without which the written statements shall not be taken on record.

13. Liberty is given to the Plaintiff to file a replication within 15 days of the receipt of the written statement(s). Along with the replication, if any, filed by the Plaintiff, an affidavit of admission/denial of documents of the Defendants, be filed by the Plaintiff, without which the replication shall not be taken on record. If any of the parties wish to seek inspection of any documents, the same shall be sought and given within the timelines.

14. List before Court on 27th July, 2022.

I.A.6443/2022 (u/O XXXIX Rules 1 & 2 CPC)

15. This suit is one amongst a large number of suits, which have been filed before this Court by various trademark owners seeking protection from misuse of the trademarks by their competitors, who use the trademarks for the purpose of getting greater visibility of their own advertisements on Google searches in order to promote their own services. Two such cases, namely, *CS(COMM)- 392/2019* titled *Cars24 Services Pvt. Ltd. v. Girnarsoft Automobiles Pvt. Ltd.* and *CS(COMM) 155/2022* titled *Upcurve Business Services Pvt. Ltd. v. Easy Trip Planners Pvt. Limited* are currently part-heard before this Court.

16. The Plaintiff - MakeMyTrip (India) Pvt. Ltd. has filed the present suit for permanent injunction seeking protection of its registered trademarks 'MakeMyTrip' and its variants. It is the case of the Plaintiff that the Plaintiff's marks are being used by Defendant No.1- Booking.com B.V. as keywords on the Google Ads Program for promoting Defendant no.1's services as advertisements when search results are displayed on the Google search engine.

17. In the present case, the domain name www.makemytrip.com, was registered by the Plaintiff way back in May, 2000. The Plaintiff is the registered owner of the trademark 'MakeMyTrip' in various classes 9, 35, 39 & 43 since the last several years. In the application bearing number 2149947 for the registration of the mark 'MakeMyTrip' in Class 39, the user claim is of the year June, 2000. The said mark has been used by the Plaintiff for the last 22 years in various variants and logo forms. The Plaintiff also has registered trademark for 'MakeMy', 'MyTrip', 'MMT' etc. and the logos thereof in various variants. The Plaintiff also claims to have registrations for the mark 'MakeMyTrip' in several other countries of the world including Australia, Bhutan, Canada, Indonesia etc. as set out in paragraph 14 of the plaint. The revenue of the Plaintiff for the year prior to the pandemic i.e., 2019-20, is to the tune of Rs.3130 crores. It has also spent a substantial amount of money on advertisement and promotion of its services.

18. The Plaintiff being one of the leading online travel portals in India, has won several awards and recognitions in the travel industry. It also has memberships of international bodies such as The International Air Transport Association ("IATA"), Indian Association of Tour Operators ("IATO"), and

Travel Agents Federation of India (“TAFI”) etc. The Plaintiff has arrangements and agreements with various travel companies, hotels, airlines, whose services are also listed on the Plaintiff’s platform. It also claims to have substantial social media presence and millions of users make bookings through the mobile application of the Plaintiff. The Plaintiff has also filed several proceedings before this Court in order to protect its trademark ‘MakeMyTrip’ including on the Google Ads Program which are listed in paragraph 29 of the suit.

19. In the present case, the Plaintiff is aggrieved by the use of the mark ‘MakeMyTrip’ as a keyword by the Defendant No.1 on the Google Ads Program. The case of the Plaintiff is that when a search is carried out for ‘MakeMyTrip’ in the Google search bar, quite often the first advertisement which is displayed in the search results in the advertisement category is that of Defendant No.1- Booking.com, who is one of the major competitors of the Plaintiff. The Plaintiff has placed on record the screenshots of the search results, as well as auction insight of its own account on Google Ads Program to show that Defendant No.1- Booking.com has made bids for the keyword ‘makemytrip’ on the Google Ads Program in order to ensure that its website is shown as one of top three search results in the advertisement category when someone searches for ‘MakeMyTrip’ on Google. According to the Plaintiff, such use of its registered mark would constitute infringement, especially when done by its competitor such as booking.com.

20. Mr. Amit Sibal, Id. Senior Counsel appearing for the Plaintiff submits that there has been exchange of notices between the Plaintiff and Defendant No.1. According to the Plaintiff, the first notice was issued on 09th October, 2019 asking Defendant No.1 to cease bidding on the keyword ‘makemytrip’

through the Google Ads Program. As per the Plaintiff, Defendant No.1 stopped bidding for the Plaintiff's mark post the said notice. Thereafter, another cease-and-desist letter was issued to Defendant No.1 on 28th August, 2020 asking Defendant No.1 to cease its unauthorized and illegal bidding for the trademark 'MakeMyTrip' as a keyword. As per the Plaintiff, Defendant No.1 again stopped committing the infringing activity. However, as of 2022, Defendant No.1 refused to comply with the requisitions of the Plaintiff and in fact, took a position that in view of the judgment of the European Commission in Case AT.40428-GUESS dated 17th December, 2018 (*hereinafter "Guess judgment"*), that there cannot be any restriction on the use of a trademark on the Google Ads Program as a keyword, including by competitors. It is submitted by Mr. Sibal, Id. Senior Counsel, that the use of the Plaintiff's mark would constitute infringement under Sections 29(6)(d), 29(7), 29(8) and 29(9) of the Trade Marks Act, 1999 (*hereinafter "Act"*). Defendant No.1 is using the complete identity of the mark of the Plaintiff as a keyword, and therefore it ought to be restrained.

21. On the other hand, Mr. Chander Lall, Id. Senior counsel, appearing for Defendant No.1 submits that there has been concealment and suppression of material facts by the Plaintiff. He relies upon a Strategic Partnership Agreement (*hereinafter "Agreement"*) dated 27th May, 2016 entered into between Defendant No.1 and the Plaintiff wherein, under clause 4.4.1.2, Defendant No.1 - Booking.com permitted the Plaintiff to conduct, undertake, use, and perform paid searches or Search Engine Marketing (SEM) activities using the mark 'booking.com'. He submits that such a license though issued earlier, was not required after the *Guess judgment* of the European Commission. Therefore, letters were issued by Defendant

No.1 to all partners and affiliates in 2019 saying that there cannot be any bidding restrictions on the use of the phrase or exact mark including trademarks. Thus, the keyword bidding restriction under clause 4.4.1.2 of the Agreement was removed. He submits that the existence of these two documents ought to have been disclosed by the Plaintiff. He further submits that Defendant No.1, though conducting business in India, is also a global player in the area of providing hotel booking, airline bookings etc. An injunction against Defendant No.1, restraining it from bidding on the trade mark of the Plaintiff would put it in contravention of the law of other foreign jurisdictions such as the European Union. Accordingly, he submits that Defendant No.1 ought to be permitted to file a reply in this matter, before any order is passed. He further argues that any restriction which may be put on the use of the Plaintiff's mark 'MakeMyTrip' as a keyword through the Google Ads Program would be contrary to competition law. Finally, he submits that the words 'make', 'my', 'trip' can be used in a generic and descriptive fashion, which in any case ought not to be enjoined in view of Sections 34 and 35 of the Act.

22. Mr. Kathpalia, Id. Senior Counsel appearing for Google submits that paragraph 76 of the plaint is mysteriously worded and is completely misleading. He submits that in another suit filed by the Plaintiff against M/s. Easy Trip Planners Pvt. Ltd., data had disclosed that Defendant No.1 was using the Plaintiff's mark 'MakeMyTrip' as a keyword on the Google Ads Program in the year 2018. Thus, the claim of the Plaintiff, as captured in the plaint, that the cause of action arose in the month of October, 2019, amounts to suppression and concealment of material facts. Further it is argued that the use of the trademark as a keyword is not infringement of trademark and

this is the position internationally including in the UK, US, European Union, Australia, New Zealand, Russia, South Africa, Canada, Spain, Italy, Japan, and China. He also submits that the use of trademark of the Plaintiff by Defendant No.1 does not amount to infringement in terms of the judgment passed by the Id. Single judge of this Court in ***DRS Logistics (P) Ltd & Ors. v. Google India Pvt. Ltd. 2021 (88) PTC 217 (Del)***. Finally, he submits that this is a case where no interim injunction ought to be granted and the Defendants should be permitted to file the reply.

23. Heard Id. Senior counsels for the parties. This Court has to consider the legal position under the Trade Marks Act, 1999. The judgment of the Id. Single judge in ***DRS Logistics (Supra)*** is clear to the effect that the use of a registered trade mark as a keyword would constitute trade mark infringement. This is clear from the reading of paragraph 82 of the said judgment which reads as under:

“82. Mr. Lall is right in saying that Sections 2(2)(b) and 2(2)(c) have to be read in addition to Section 29(6), 29(7), 29 and 29(9). Having said that a perusal of Section 29(9) makes it clear that an infringement of a trademark can be by way of spoken use which is different from printed or visual representations of the mark. That is invisible use of the mark can also infringe a trademark.”

24. Moreover, a perusal of Section 29 of the Act shows that there are various situations where the use of a registered mark would be infringing. A perusal of Section 29(4)(c) of the Act shows that if any party takes unfair advantage of distinctive character or repute of a registered trademark, without due cause, then it would also be infringing use in addition to infringement in terms of Sections 29(6) and 29(7) of the Act. Section 29(4)

of the Act reads as under:

“(4) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which—

(a) is identical with or similar to the registered trade mark; and

(b) is used in relation to goods or services which are not similar to those for which the trade mark is registered; and

(c) the registered trade mark has a reputation in India and the use of the mark without due cause takes unfair advantage of or is detrimental to, the distinctive character or repute of the registered trade mark.”

25. The nature of use of a trademark as a keyword on the Google Ads Program deserves to be mentioned in the present context. The goodwill in a mark is created by the proprietor of the mark. The reason why the user may be searching for a particular mark is due to the investment made by the trademark owner in the said mark in promotion, advertisement, merchandising and other promotional activities. The user acquires knowledge of the mark due to the investment made by the proprietor and the popularity that the mark achieves. When a user, therefore, searches for a well-known mark or a mark, which he or she has heard about in the past, on a search engine, it is due to the goodwill and reputation which is associated with the mark. It has nothing to do either with the search engine or with the competitor. The distinctive character of the said mark is because of the use by the Plaintiff and the promotion which the Plaintiff does of its own trademark.

26. It is in this background that the Court has to analyse as to whether the

encashment of the goodwill and reputation of a registered trade mark by third parties by bidding on it as a keyword through the Google Ads Program would amount to infringement and passing off or not?

27. Defendant Nos.3 and 4 operate the popular search engine www.google.com and its various country variants, the function of which is to enable an internet user to search for webpages on the internet by using keywords. There are two types of search results that are displayed when a user types any keywords in the search bar –

- Paid search results i.e., Advertisements
- Organic search results

28. Google Ads Program is an online advertising service offered by Google for businesses which allows anyone to adopt and use keywords through Google that matches the terms or phrases that internet users are most likely to search for. The advertisements of the bidders which may be rated on various factors, for a keyword, are shown in the advertisement section, which is above the organic search results. Through this program, any business entity or person can book or bid for a keyword which may include a trade mark – say of a competitor. If the said advertisement is rated highly by Google, the said competitor's advertisement may be listed in the advertisement section, when a user types the proprietor's trade mark in the search bar. This forces the trade mark owner to also start participating and bidding in the Google Ad Program.

29. Therefore, by using a registered trade mark as a keyword, Google Ads Program seeks to create a platform for two competitors to bid against each other for the marks belonging to each other for better visibility of their goods and services on the search engine. Therefore, in effect, what a

trademark proprietor is being forced to do is to bid for its own trademark, in order for the advertisements of its goods and services under the said trademark to be reflected in the advertisement section of the search results and not be hijacked by a competitor. This entails the trademark owner to make investments in the Google Ads Program on a daily basis, failing which its competitors could use the trademark for advertising their own goods and services and have listings higher on the Google search results.

30. Even in the present case, though there may be some delay in terms of cause of action having arisen in the year 2018, the Court has to consider the fact that the Plaintiff is being forced to bid for his own registered mark on the Google Ads Program on a daily and monthly basis. As per the Plaintiff's submissions, the monthly investment being made by the Plaintiff is to the tune of Rs. 6 crores. This is precisely because of the fact that Defendant Nos.3 and 4 allow even non-proprietors, such as Defendant No.1 in the present case, to bid for a registered trademark as a keyword. The Court has to consider as to whether such an act could be justified, especially when it amounts to taking advantage of the distinctive character and reputation of the Plaintiff's trademark. To this the answer given by the Defendants is that the mark 'MakeMyTrip' is not reflected either in the Ad title, metatags or in the Ad text and hidden use cannot be infringement.

31. This Court is of the opinion that the use of the mark 'MakeMyTrip' as a keyword through Google Ads Program by one of its major competitors, Booking.com is infringing use under Sections 2(2)(b), 29(4)(c), 29(6)(d), 29(7) and 29(8)(a) of the Act. It is now well settled in India that use of a registered mark by competitors even as metatags would be infringement, though the same may be invisible to a user as held in *DRS Logistics*

(*Supra*). The relevant paragraph reads as under:

“86. Having noted the above Judgments, it is clear that the use of the mark as meta-tags was held to be infringement of trademark. It follows, that invisible use of trademark to divert the traffic from proprietors' website to the advertisers' / infringers' website shall amount to use of mark for the purpose of Section 29, which includes Section 29(6) and 29(8), related to advertising.”

32. Moreover, there is not much of a difference in the use of a mark in a metatag or a source code of a website which is not visible and in use of a mark as a keyword by Google Ads Program, inasmuch as the mark being used in a hidden manner does not take away the fact that it is, in fact, ‘use’ of the mark as defined under Section 2(2)(b) of the Act in relation to those very services. Here again, it is pertinent to refer to the observations of the Id. Single judge in *DRS Logistics (supra)* who has held as under:

“90. It is important to note, that had the AdWords Program of Google not existed, the only option available to the infringer / prospective advertiser in order to achieve the same result would have been to change their meta-tags (source coding) which has already been held to be "use" of trademark and as such infringement. This aspect also highlights the fact that the same result is sought to be achieved through different means.”

33. Further, there is no doubt in the mind of the Court that use of the Plaintiff’s mark by Defendant No.1 as a keyword on the Google Ads Program is use for the purpose of ‘advertising’. Google is encashing the goodwill of the trade mark owner by allowing the competitor to book the said mark as a keyword. No argument has been advanced by the Defendants

that the use of a registered trade mark as a keyword through Google Ads Program does not amount to advertising. Any contrary view would be devoid of any merit and would be against the very purpose of Google Ads Program. Thus, the said use would also be infringing use in view of Section 29(6)(d) of the Act, which squarely covers use of a registered trade mark in advertising. The said section is as extracted under:

“(6) For the purposes of this section, a person uses a registered mark, if, in particular, he—

- (a) affixes it to goods or the packaging thereof;*
- (b) offers or exposes goods for sale, puts them on the market, or stocks them for those purposes under the registered trade mark, or offers or supplies services under the registered trade mark;*
- (c) imports or exports goods under the mark; or*
- (d) uses the registered trade mark on business papers or in advertising.”*

34. Defendant No.1 is using the mark of the Plaintiff, even though the same is not visible, for the purpose of advertising in an attempt to divert business from the Plaintiff’s website to its own website. The same is done by encashing on the goodwill of Plaintiff’s mark ‘MakeMyTrip’. In the *prima facie* opinion of the Court, this practice amounts to taking unfair advantage of the Plaintiff’s mark and also falls foul of section 29(8) of the Act which is extracted below:

“(8) A registered trade mark is infringed by any advertising of that trade mark if such advertising—

(a) takes unfair advantage of and is contrary to honest practices in industrial or commercial matters; or

(b) is detrimental to its distinctive character; or

(c) is against the reputation of the trade mark.”

35. In similar suits filed by the Plaintiff, orders have been passed by the various Ld. Single Judges, restraining competitors from bidding for any ‘keywords’ on the Google Ads Program that are identical or deceptive variants of the Plaintiff’s mark ‘MakeMyTrip’. An *ex parte ad interim* injunction was passed by the Court in **CS(COMM) 916/2018** titled ***Make My Trip (India Private Limited) v. Happy Easy Go India Pvt. Ltd.*** wherein the Court observed that Defendant No.1’s act of bidding for the mark of the Plaintiff ‘MakeMyTrip’ on the Google Ads Program would *prima facie* constitute infringement and passing off. The said order dated 30th May, 2018 reads as under:

“Keeping in view the aforesaid as well as the order dated 3rd April, 2013 passed by a Coordinate Bench of this Court in “HSIL Limited Vs. Omkara Infoweb Pvt Ltd & Ors., CS(OS) 594/2013, this Court is of the opinion that a prima facie case of infringement and passing off is made out in favour of the plaintiff and balance of convenience is also in its favour. Further, irreparable harm or injury would be caused to the plaintiff if an interim injunction order is not passed.

Consequently, till further orders, the defendant no. 1, its partner, directors, shareholders, assigns in business, affiliates, subsidiaries, agents, broadcasters, representatives, advertisers, franchisees, licensees and/or all other persons acting on its behalf are restrained from bidding for, adopting and using Plaintiff’s MakeMyTrip word Mark, or any deceptive variant thereof, whether with the inclusion of spaces or other special characters in the trade mark MakeMyTrip, as an Ad Word through the Ad Word Program of Google or any other ad word/key word

program in any manner whatsoever.

Let the provisions of Order XXXIX Rule 3 CPC be complied within a period of two weeks.

Order dasti under the signature of Court Master.”

36. A similar order has been passed by the Court in **CS(COMM)1287/2018** titled **MakeMyTrip (India) Private Limited v. Easy Trip Planners Pvt. Ltd.** In the said case the court was of the opinion that Defendant No.1's bidding for the Plaintiff's mark 'MakeMyTrip' would *prima facie* constitute trademark infringement and passing off. Thus, an *ex parte ad interim* injunction was passed by the Court against Defendant No.1 vide order dated 13th December, 2018 in the following terms:

“Keeping in view the aforesaid as well as the order dated 3rd April, 2013 passed by a Coordinate Bench of this Court in “HSIL Limited Vs. Omkara Infoweb Pvt Ltd & Ors., CS(OS) 594/2013 and in Make My Trip (India) Private Limited Vs. Happy Easy Go India Private Limited, CS (COMM) 916/2018 dated 30th May, 2018, this Court is of the opinion that a prima facie case of infringement and passing off is made out in favour of the plaintiff and balance of convenience is also in its favour. Further, irreparable harm or injury would be caused to the plaintiff if an interim injunction order is not passed.

Consequently, till further orders, the defendant no. 1, its partners, directors, shareholders, assigns in business, affiliates, subsidiaries, agents, broadcasters, representatives, advertisers, franchisees, licensees and/or all other persons acting on its behalf are restrained from bidding for, adopting and using Plaintiff's MakeMyTrip Word Mark, or any deceptive variant thereof, whether with the inclusion of spaces or other special characters in the trade mark MakeMyTrip, as an Ad Word through the Ad Word Program of Google or any other ad word/key word

program in any manner whatsoever.

Let the provisions of Order XXXIX Rule 3 CPC be complied within a period of two weeks.

Order dasti under the signature of Court Master.”

37. In **CS(COMM) 285/2020** titled **MakeMyTrip India Private Limited v. Wing In Travel Advisory Pvt. Ltd.** a decree was passed against Defendant No.1 therein, in view of the statement made by the said Defendant that it will not bid for, adopt, or use the Plaintiff's registered trademarks i.e., 'MakeMyTrip' or 'MMT' [with or without space] or any of its variant or any other mark which is deceptively similar to the Plaintiff's marks. The order dated 2nd September, 2020 in the said suit reads as under-

4. Mr. Mehta says he has obtained instructions, to the effect, that defendant no. 1 will not bid for, adopt or use the plaintiff's registered trademarks i.e., MakeMyTrip or MMT [with or without space] or any of its variants or any other mark which is deceptively similar to the plaintiff's marks.

5. Having heard Mr. Mehta, Mr. Sibal says that the plaintiff, in these circumstances, will not press for damages or costs against defendant no. 1 and that the suit can be decreed against defendant no. 1 in terms of the statement made by Mr. Mehta on behalf of the said defendant.

6. The statement of Mr. Mehta, as noted in paragraph 4 above, is taken on record.

6.1 The defendant no.1 will not be mulct with damages and costs.

7. Accordingly, the suit is decreed qua defendant no. 1 in the terms of the statement of Mr. Mehta as recorded paragraph 4 and what is stated in paragraph 6.1 above.

38. The said suit was withdrawn by the Plaintiff qua Defendant Nos. 2 and 3 with liberty to file a fresh proceeding, in view of the fact that the suit

was decreed *qua* Defendant No.1.

39. In *CS(COMM) 524/2020* titled *MakeMyTrip (India) Pvt. Limited v. M/s Travelogy & Ors.*, another decree has been passed vide order dated 17th February, 2021 against Defendant No.1 therein, to the following effect-

“2. Learned counsel appearing for defendant No.1 states that defendant No.1 has never bid and shall also not in future bid for or in any manner adopt the plaintiff’s MakeMyTrip Word Marks, or any deceptive variant thereof. He also states that he has no objection if a decree is passed in terms of prayer para 95(a) and (b) of the plaint.

3. Learned senior counsel appearing for defendant No.3 however refutes the contention of defendant No.1 that they have never bid earlier.

4. In view of the submission of defendant No.1, a decree is passed in favour of the plaintiff and against defendant No.1 in terms of prayer para 95(a) and (b) of the plaint.

5. Learned senior counsel appearing for defendants No.2 and 3 respectively, however state that the issue regarding ‘infringement’ as stated above in prayer para 95(a) and (b) of the plaint be kept open for adjudication.

6. In my opinion, a decree is being passed against defendant No.1 only. The same does not bind other defendants. Hence, the plea/objection raised by defendants No.2 and 3 is misplaced.

7. List on 08.04.2021.”

40. The Bombay High Court in the case of *People Interactive (I) Pvt. Ltd. v. Gaurav Jerry MIPR 2014(3)101* considered the question of use of registered trademarks as a ‘keyword’ by a rival website. In the said case, the Court took the view that invisible use of registered trade mark by non-proprietors dilutes the mark. The Court further went on to equate it with

online piracy. The same is as extracted below:

“12. Meta-tags are routinely used by the search engines and search engine robots to assess webpage contents and other relevant material relating to a webpage in the building of search engine indices. This is where an illicit use of meta tags can be severely damaging. For, if in the meta tags of one website a person uses the domain name or other unique identifying marks, characters or name of another, a search engine, being robotized, is bound to confuse the two, and to report that the first and the second are the same. A search for the latter (the original, the victim) is very likely to yield results for the former, the one that has pirated the identifying marks or name. Now if any individual was to run up a web site and use this Court's "keywords" or "description" meta tag contents, a search engine robot would identify that illicit website as being the "official website of the Bombay High Court."

13. This is precisely what seems to have happened in this case. The Plaintiffs' analysis showed that by illicitly plugging the Plaintiffs' mark and domain name into his website's web pages' meta-tags, the 1st Defendant succeeded in diverting as much as 10.33% and 4.67% of the Internet traffic away from the Plaintiffs to himself. There could be no better evidence of passing off, confusion and deception. This is, plainly, hijacking the Plaintiffs' reputation and goodwill and riding piggyback on the Plaintiffs' valuable intellectual property.

14. I believe the Plaintiffs have made out not just a strong, but an overwhelming prima facie case. Dishonesty is writ large on the actions of the 1st Defendant. He has used the Plaintiffs' mark shaadi.com as a suffix to another expression. He has attempted to misappropriate the Plaintiffs' mark. He has made false claims regarding the extent and size of his service. He has, plainly, hijacked Internet traffic

from the Plaintiffs' site by a thoroughly dishonest and mala fide use of the Plaintiffs' mark and name in the meta tags of his own rival website. The distinctive character of the Plaintiffs' mark is thus diluted and compromised by the actions of the Defendant. The 1st Defendant's action is nothing but online piracy. It cannot be permitted to continue."

41. Insofar as the ***Guess judgement*** is concerned, the factual background in the said case is completely different. The European Commission was concerned therein with a case where authorised distributors and retailers of 'GUESS' products were contractually being prevented from using 'GUESS' brand names and trademarks as keywords or bidding therefor on the Google Ads Program. The conclusion of the Commission therein is as under:

" By means of the contractual provisions and practices referred to in Section 5.2, **Guess Europe effectively restricted intra-brand competition and partitioned national markets for its products contrary to Article 101(1) of the Treaty.** There are no circumstances in the economic or legal context of those provisions and practices to support a finding that they were not liable to impair competition or did not have an anticompetitive object within the meaning of Article 101(1) of the Treaty."

42. From the above extract, it is clear that the Commission was dealing with 'intra-brand' competition and partitioning national markets, being restricted contractually. In the case at hand, the facts are entirely different as the Plaintiff seeks to restrict Defendant No.1, which is its competitor, from using its mark as a keyword through Google Ads Program.

43. As far as the question of passing off is concerned, the essence of passing off is a misrepresentation made by the Defendant which is calculated to cause damage to the business or goodwill of the claimant. The traditional

concept of ‘misrepresentation’ and ‘passing off’ consists of the Defendant adopting for his own goods or business some material such as a name or a mark which is deceptively similar to the claimant’s mark. In the opinion of this Court, restricting an action of passing off to such an ‘adoption’ might be obsolete in view of the technological advances in today’s digital world. The concept of ‘deceit’ which forms the fulcrum of an action for passing off is clearly present in cases such as this one.

44. The impact of Google Ads Program can be best described by way of an illustration: If a person is looking to buy an air ticket and types ‘MakeMyTrip’ in the search bar, and the first result in the Ad section is of Booking.com, the user may simply visit the latter’s website by clicking on the link and book the ticket. In effect therefore, the user has been directed to a competing website and a direct business loss has been caused to the trade mark owner’s business.

45. In the present case, the question that is pertinent is whether use of a registered trade mark as a keyword through Google Ads Program can amount to misrepresentation as a matter of principle. Going by the traditional wisdom, such use of a mark as a keyword by the Defendant might not constitute passing off as there is no visible use of the mark by the Defendant. However, in *Kerly’s Law of Trade Marks and Trade Names (15th Ed., p.628 & 629)* it is stated that third party bidding on trademarks as sponsored keywords for use by internet search engines can constitute misrepresentation. The same is extracted as under:

“18-126 With the increase in importance of Internet trading and promotion, the use of third party trade marks in metatags (the unseen text on Internet web pages scanned by search engines) and other

mechanisms (such as sponsored keywords) to achieve the aim of having a party's webpage offered by search engines in response to a search for the third party side is viewed by trade mark proprietors with increasing concern. The present attitude of the Court of Appeal as to whether such "invisible" use of trade mark can amount to passing off is sceptical. It is submitted that such invisible use might very well amount to misrepresentation in some circumstances, but the absent other factors, it is perhaps unlikely that any such misrepresentation would lead to deception on the part of the public. In this regard, since bidding on sponsored keywords for use by Internet search engines has been held to constitute use in the course of trade for the purposes trade mark infringement by the party placing the advertisement it is difficult to see how such the placing of an advertisement using a mark in which a third party owns goodwill can prima facie be excluded from constituting a misrepresentation as a matter of principle. However, if nobody is misled or likely to be misled, there can be no passing off. As ever, the outcome of each case will be dependent of the particular facts."

46. Thus, the "invisible" use of a mark as a keyword can constitute passing off as a matter of principle. This, however, would not mean that the Plaintiff cannot be permitted to book its own trade mark as a keyword. The Plaintiff itself can surely use its trademark as a keyword on the Google Ads Program if it wishes to promote itself on the search engine.

47. In view of the facts, orders and legal position as discussed above, this Court is *prima facie* of the opinion that the use of the Plaintiff's registered mark 'MakeMyTrip' on the Google Ads Program as a keyword would amount to trademark infringement. The same would be detrimental to the Plaintiff's monetary interest as also to the brand equity of the Plaintiff's

mark. To allow competitors such as www.booking.com and even Google to encash upon the reputation of the Plaintiff's mark for their own monetary advantage is not permissible in the opinion of the Court. The balance of convenience lies in the favour of the Plaintiff and if the injunction is not granted, irreparable injury would be caused to the Plaintiff as Defendant no.1 and its other competitors would continue to bid for the Plaintiff's mark 'MakeMyTrip', on a daily basis, resulting in severe prejudice to the Plaintiff, its mark, its brand equity and its business.

48. Under these circumstances, the Defendants are restrained from using the mark 'MakeMyTrip' together/ in conjunction, with or without spaces for the purpose of using it as a keyword on the Google Ads Program till the next date of hearing. However, this shall not prevent the Defendants from using words 'make', 'my', 'trip' not conjunctively on a standalone basis in a descriptive or generic sense on the Google Ads Program.

49. Insofar as the global repercussion of this interim injunction is concerned, at this stage, it is clarified that this injunction shall be restricted to the territory of India. Mr. Sibal, Id. Counsel, submits that the injunction ought to cover even the mark 'MMT' which is registered in favour of the Plaintiff. Since the mark 'MMT' is only consisting of letters from the English alphabet, the Court would like to examine the matter further as to whether the Plaintiff would be entitled to an injunction *qua* this mark or not.

50. At the request of Mr. Chander Lall, one week time is granted to the Defendants to comply with/implement this order.

51. Reply to this application be filed within four weeks. Rejoinder thereto, if any, be filed within two weeks.

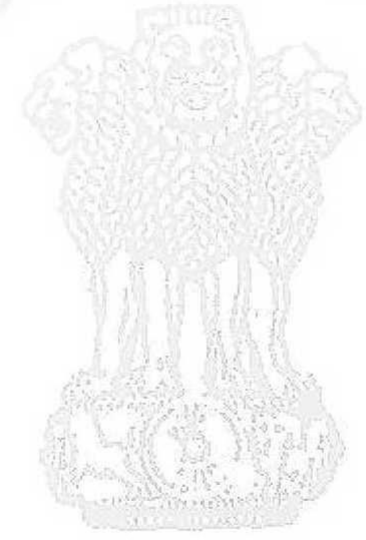
52. All documents handed over in Court apart from judgments shall be

filed in the Registry so that the same are brought on record.

53. As already noted above, there are matters being heard by this Court where the same issue is involved, which are part heard. List this matter on 27th July, 2022 along with *CS(COMM)- 392/2019* titled *Cars24 Services Pvt. Ltd. v. Girnarsoft Automobiles Pvt. Ltd.* and *CS(COMM) 155/2022* titled *Upcurve Business Services Pvt. Ltd. v. Easy Trip Planners Pvt. Limited* for further consideration of the Court.

**PRATHIBA M. SINGH
JUDGE**

APRIL 27, 2022/dk/sk



सत्यमेव जयते