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Contents

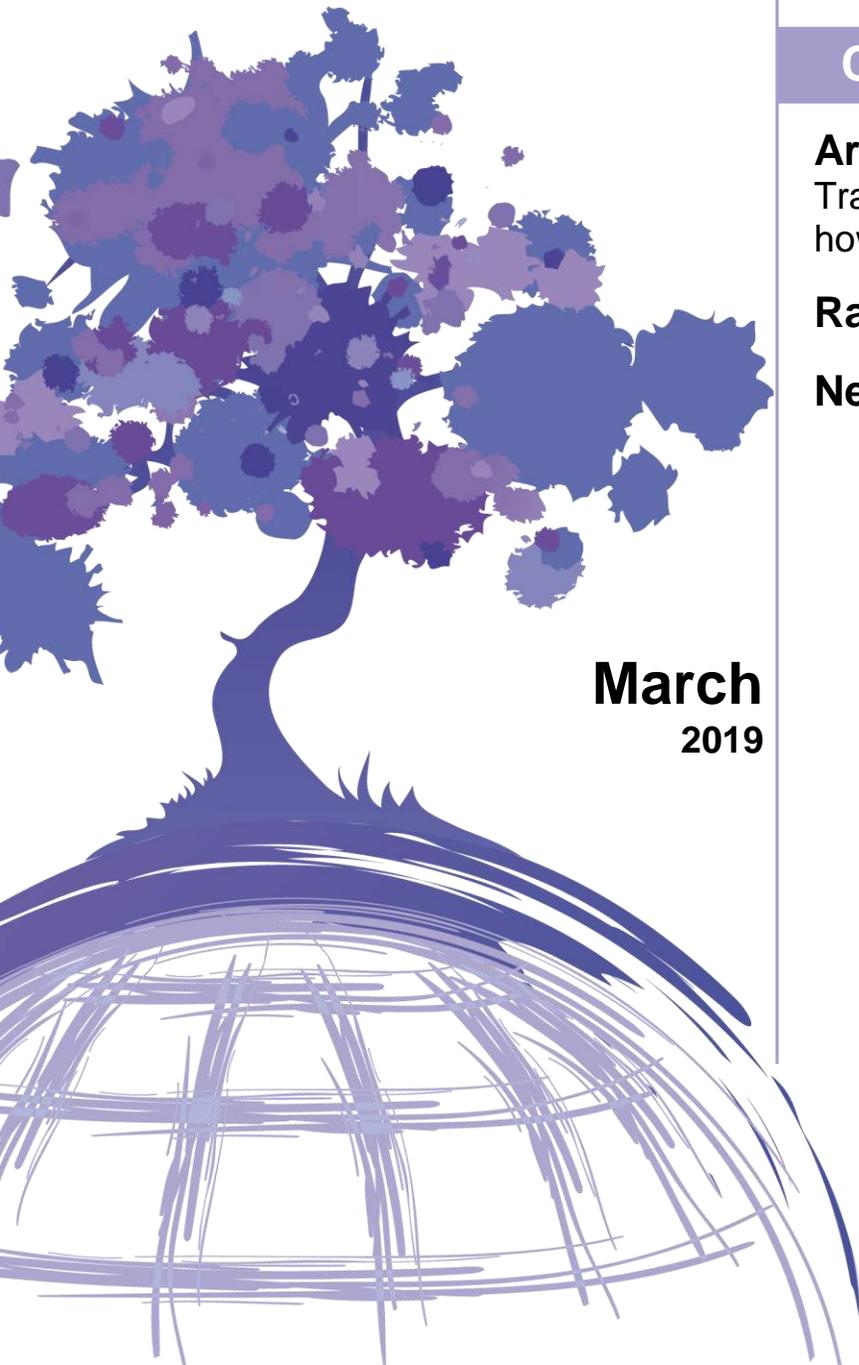
Article

Trademarks – Use of a generic prefix,
how far effective2

Ratio Decidendi.....4

News Nuggets6

March
2019



Article

Trademarks – Use of a generic prefix, how far effective

By **R. Parthasarathy** and **Abhishek Yadav**

The question whether a mark is descriptive or invented, has always been a contentious one. The Supreme Court in 1994 dealt with this issue in *J.R. Kapoor v. Micronix India*. In the said judgement, the marks in question were MICROTEL and MICRONIX. Apart from other differences, the SC noted that the word micro was indicative of the micro-chip technology being used in both products and hence the prefix micro was descriptive of the technology and no one can claim monopoly to micro and hence anyone using 'micro-chip' technology in its products is free to use 'micro' as prefix in the trade name.

Recently, the Delhi High Court dealt with two cases that involved major online booking portals fighting for exclusive rights with respect to their trademarks. The High Court dismissed the plea of infringement in a dispute between 'book my show' and 'book my event'. However, in an *ex parte order*, it decreed in favour of plaintiff using the mark 'make my trip' and held that defendant's mark 'make my happy journey' infringed the plaintiff's mark. These decisions by different Single Judges of the same High Court seem, at first glance, to be contrary to each other, as both the cases revolved around the use of a similar prefix forming part of a word mark. However, the differences as discussed in this article are relevant and need to be considered.

Contending trademark phrase is unique

In *Bigtree Entertainment (P) Ltd v. D Sharma*¹, BOOKMYSHOW went to the High Court seeking permanent injunction to restrain

defendant from using BOOKMYEVENT which it pleaded was deceptively similar and that too in respect of similar services - online ticketing services. The court refused to grant injunction and observed that the prefix BOOKMY is an apt description of a business involved in booking and the said phrase is profusely used in the market. It was held that the defendant's adoption and application of the prefix 'book my' to describe its activities as a booking domain was *prima facie* the decision in concert with other players in the booking industry.

The Court however, in the case of *MakeMyTrip v. MakeMyHappyJourney*², granted permanent injunction against MAKEMYHAPPYJOURNEY holding that the defendant had no scope of defending itself against the allegation of passing off and infringement. It may be noted that this decision was an *ex-parte* decision with only plaintiff pleading that defendant's mark 'MakeMyHappyJourney' is phonetically, visually, structurally and conceptually similar to the plaintiff's registered mark 'MakeMyTrip'. It also stated that the defendant's logo had a similar colour scheme and emphasis on 'My' was also similar, as depicted below.



The plaintiff in this case was a registered proprietor of at least 15 MakeMyTrip marks under

¹ Judgement dated 21-1-2019 in CS(COMM) 609/2016, Delhi High Court.

² Judgement dated 8-2-2019 in CS(COMM) 1211/2018, Delhi High Court.

various classes of the Trade Marks Act, 1999 and, curiously enough, had registered the term 'MAKEMY' during pendency of the present suit. It was assertively contended that the phrase MAKEMYTRIP was unique to plaintiff with 'My' being highlighted in a particular way in all its logos. The petitioner had contended that the impugned mark MAKEMYHAPPYJOURNEY was chosen specifically with the intention of creating a deceptively and confusingly similar mark. In the absence of any plea by the defendant, the court decreed against MAKEMYHAPPYJOURNEY with costs.

On the other hand, in the former case of *Bookmyshow v. Bookmyevent*, the defendant was able to turn the tables around in its favour by mounting substantial pleadings in its protection. The defendant in BOOKMYEVENT pleaded that in the past, the plaintiff and defendants have been partners for many online ticketing and promotional events thereby stressing on its simultaneous presence in the market with the plaintiff. BOOKMYEVENT furthered its argument by placing on record examples of numerous companies using the same domain prefix and pleaded that BOOKMY is a **generic term** used substantially in the industry and cannot be exclusive to any particular person. It also referred to a previous case involving plaintiff where plaintiff was refused injunction and observed that the phrase BOOKMY is a common term widely used in the context of booking shows, events, and movies.

Trademark's association in the minds of people

Evidently the court expects the plaintiff, seeking permanent injunction in its favour, to establish that there is an exclusive association of its trademark, in the mind of the public, with its business. This is difficult to prove in cases where a phrase is used as part of a Trademark and is also generic [Refer Section 17(2)(b) of the

Trademarks Act]. The concern with the use of a generic term is that it deviates from the primary utility of a Trademark, which is identification.

The Court of Justice of the European Union (CJEU) prescribes that a trademark should not confuse the public by creating associations uncalled for and is rather supposed to create an exclusive outlet for the product in the market. Google was recently denied Trademark registration for the mark STREAMS by CJEU³ which held that it is too generic and that medical professionals, for whom the application with the name STREAMS was created, may not be able to separate its meaning from what is commonly understood as data streaming with respect to internet. In another case referred to CJEU⁴, the term CYSTUS, in the category of food supplements, was denied trademark registration because of its resemblance to plant 'Cistus' where it was ruled that although the said plant forms part of the ingredient of the product, the public has to distinguish the product commercially.

Conceivably because people are less likely to remember invented names, and more adept at remembering terms they find relatable, in the past decade there has been a visible shift towards registration of common words, names and phrases

Phrases which are part of cultural idiom commonly have an easier recall value as people are habitually using them on a day to day basis. Off-late proprietors have been trying to seek registration for catchy phrases that could be associated with their products and services and could easily become popular with the target audiences. This has led to frequent registrations of short phrases comprising descriptive terms in

³ *DeepMind Technologies Ltd. v. EUIPO* – Judgement dated 31-1-2019 in Case T-97/18, CJEU.

⁴ *Georgid Pandalis v. EUIPO* – Judgement dated 31-1-2019 in Case C-194/17 P, CJEU.

trademark which though in vogue, is not in conformity with the trademark laws.

However, the court always evaluates as to whether the trademark is distinct enough to be easily identified and distinguished from other marks present in the market as well as from descriptive terms of common usage. Needless to say, that where a common term or phrase is

opted as a Trademark, the best defence might be to detach it from its conventional meaning and form new connotations.

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Ratio decidendi

Broadcast of copyright work – De minimis infringement and use for review

The Delhi High Court has held that an assignee of copyrights is not required to implead original owner and therefore the suit cannot be dismissed for non-compliance of Section 61 of the Copyright Act which provides that the licensee is required to implead the owner of the copyright as a defendant. It observed that, in view of the detailed assignment in favour of the plaintiff, the plaintiff is the deemed owner of the copyright work with the right to grant licenses.

The High Court, further, granted injunction while rejecting the defendant's pleas, including that excerpts of the copyright work were used for reporting current events and for the review in the process of dissemination of news and hence there is no infringement of the copyright. Benefit of Section 52(1)(a)(ii) of the Copyright Act was hence denied by the Court noting that the copyright work was used in a way to enhance the programmes of the defendant.

Observing that the defendant broadcasted copyrighted works for more than 500 minutes, the Court also rejected the contention that the compensatory damages cannot be awarded as

infringement was *de minimis*. Compensatory damage of ₹21,00,600 was held as reasonable. [*Super Cassette Industries v. Shreya Broadcasting* - CS (OS) 1372/2009, decided on 25-2-2019, Delhi High Court]

Trademark validity can be determined even during infringement proceedings

The Delhi High court has reiterated that defendants in an infringement proceeding, once an issue is framed about the invalidity of the trade mark by the civil court, can move the IPAB under Section 124 of the Trademark Act for determination of the validity of the registration of the mark. The mark 'BRAHMOS' was being used by the defendant for an online aptitude test.

The Division Bench of the Court hence upheld the order of Single Judge Bench staying the infringement suit to enable IPAB to determine the validity of trademark registered by the petitioner-appellant. Supreme Court's judgement in the case of *Patel Field Marshall Agencies v. P.M. Diesels Ltd.* was relied upon. The appellant had contended that the order granting an injunction in its favour precludes any *prima facie* finding of invalidity at this stage.

Further, observing that on the date when the present appeal was instituted by the appellant-

petitioner, the suit had not been transferred to the Commercial Division, the court held that Section 13 of the Commercial Courts Act was not attracted to these proceedings. The suit was converted into a 'commercial suit' within the meaning of the Commercial Courts Act, 2015, only during the pendency of this appeal. [*Brahmos Aerospace (P) Ltd v. FIITJEE Ltd.* – Judgement dated 25-2-2019 in FAO(OS)(COMM)247/2018, Delhi High Court]

Trademark infringement – Both prior use and registration, when important

The Delhi High Court has held that use of the mark ELECTRA by the defendant *prima facie* constituted infringement as plaintiff's pre-launch and preparatory activities with the mark amounted to use. The court also observed that the plaintiff was the registered proprietor of the mark and the defendant had not filed any proceeding for passing-off or for removal of the said trademark on ground of non-use, and hence the plaintiff had the exclusive right to use the same.

It was held that in order to show non-infringement, defendant's use of the impugned mark must be prior not only to plaintiff's use but also prior to plaintiff's registration. The defendant was using the mark ELECTRA along with its own trademark GODFATHER and adopted the mark GODFATHER ELECTRA. The court also reiterated that protection of a registered trademark is not dependent on its use. The SC judgement in *Gujarat Bottling Co. v. Coca Cola* was relied on. [*Radico Khaitan v. Devans Modern Breweries* – Judgement dated 7-3-2019 in CS(COMM) 724/2018, Delhi High Court]

Patents - Cross examination to be allowed in highly technical cases

The Delhi High Court has held that where there is a post-grant opposition based on an expert

opinion to invalidate a patent under Section 25(2) of the Patents Act, the petitioner (who had acquired the patentee firm) can be allowed to cross-examine the expert under Section 79. The Court observed that the case was of grant of a patent involving highly technical analysis by the expert witnesses, and that denial of cross-examination would violate the principles of natural justice.

The respondent had alleged that the right to cross examine in any proceedings before any IP Tribunal, including the Patent Office, is not an inherent or statutory right. The court however held that technical analysis conducted by the expert witness, where the expert witness had provided his view, opinion or analysis of different prior art documents or literature and his opinion thereto, cannot constitute facts *per se*, and therefore in such cases, if cross-examination is prayed for, the same should be granted. It also held that action of adjudicating authority reviewing its own decision *suo moto*, and denying cross-examination, is a manifest error of law. [*Onyx Therapeutics v. Union of India - W.P.(C) 5022/2017*, decided on 22-2-2019, Delhi High Court]

Test for violation of patent - Uncommon feature whether exists

The Gujarat High Court has held that even if the defendant's machine is not an exact replica and has distinguishing features, the real test for violation of patent is whether the uncommon feature, that has been recognized by the Controller of Patents as the plaintiff's invention, exists in the defendant's machine. The High Court restrained the defendant from using uncommon features of the patented fabric machine.

It was also held that the burden for proving that the said feature is not so uncommon, rests with defendant. It was however held that the

defendant was unable to dispute the uncommon features for the patented fabric machine. The court stayed the impugned order and restrained the defendant from using the uncommon features of the patented fabric machine, observing that there was prima facie case and balance of

convenience in favour of plaintiff. [*Agarwal Deokinandan Gopiram v. Jagdamba Textiles Pvt. Ltd.* - Civil Application (for stay) No. 1 of 2018 in R/Appeal from Order No. 38 of 2019, decided on 25-2-2019, Gujarat High Court]



News Nuggets

Sale of invention prior to patent is deemed as available for public use

The Supreme Court of United States of America has held that the inventor's sale of invention to a third party, who is obligated to keep the invention confidential, can qualify as prior art for the patentability of the invention. The court was of the view that such sale was a public disclosure, regardless of the confidentiality agreement.

The Apex Court in the case *Helsinn Healthcare v. Teva Pharmaceuticals*, involving drug for chemotherapy-induced nausea, held that addition of phrase 'or otherwise available to public' in §102(a) cannot change the settled meaning of the phrase 'on sale' in the statute, which is that an inventor's prior commercial use may constitute public use.

Ingredient name relating to plant cannot be a trademark, being descriptive for general public

The Court of Justice of the European Union has reiterated that the condition of genuine use is not fulfilled if the mark does not distinguish the product from other goods and does not contribute towards creating an outlet.

The court in *Georgid Pandalis v. EUIPO*, upheld EU's General Court decision that refused registration of the term 'Cystus' considering it to be descriptive, indicating presence of an ingredient but devoid of any distinctive character. It was held that the term Cystus was a weak distinctive character since general public will relate it with plant Cistus and not with a commercial origin of product.

Onus of proving proprietors trademark fraudulent, lies heavy on defendant

The Bombay High Court has held that only where defendant is able to establish that registration in plaintiff's favour is fraudulent, the court would refuse to grant injunction in favour of the proprietor of trademark, but the onus to prove the same lies very heavy on the defendant.

The Court in the case of *Eurobond Industries v. Euro Panel Products*, which involved the trademark EUROBOND, partly allowed the appeal quashing the injunction against the defendant. It observed that there was no discussion in the order of the Single Judge, as to on what basis injunction was granted in this case of passing-off.

Review petition before High Court maintainable after SLP dismissal by Supreme Court in *limine*

A Larger Bench of the Supreme Court has held that the review petition in High Court is maintainable even after dismissal of Special Leave Petition (SLP) by the Supreme Court, against the High Court Order. It observed that the dismissal of SLP in *limine*

by a non-speaking order does not amount to merger of the High Court order with that of the Supreme Court.

Applying the law laid down by the court in the decision in *Kunhayammed*, the Apex Court in *Khoday Distilleries v. Sri Mahadeshwara SSK* remanded the case for deciding the review petition observing that there is no difference whether review petition was filed before the SLP or after its dismissal.

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