

CASE ANALYSIS OF BIGTREE ENTERTAINMENT PRIVATE LIMITED V. D SHARMA

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ABSTRACT

With the rise in the number of corporations using the global internet platform to operate their enterprises and the growth in the number of start-ups in the current economic scenario, we are faced with several new problems that need to be dealt with in detail and must be resolved accordingly, keeping in mind the far-fetched impact it will have on the intellectual property right environment. India holds a high rank with its competitive business environment. In account of profitability of a business venture, brand value plays a pivotal role as an asset to develop its identity amongst customers. With a diverse market including local, national and international players, a unique trademark is a requirement to identify brand value and generate revenue.

Trademarks, like other assets of a company is capable of being exploited and in order to provide protection from infringement, apart from existing legislatures and international conventions, the judiciary has played an important role in evolving a series of tests to set a precedence on what amounts to infringement. The test of 'likelihood of confusion' has been often used as a basis to identify trademark infringement. This paper attempts to critically analyse the factors to be considered while using the test as given by J. Jayant Nath in the case of Bigtree Entertainment Pvt. Ltd. v. D Sharma and another. I have divided the ratio of the judgement to form a basis to recognize four specific factors in this regard – distinctiveness, secondary meaning or acquired meaning, invented mark and the whole mark as per Section 17(1) of the Trademark Act, 1999.

Keywords: Likelihood of Confusion, Distinctiveness, Descriptive Mark, Secondary Meaning, Invented Word, Whole Mark.

BRIEF FACTS

The Plaintiff is a highly successful online entertainment booking portal in India, with over 500 people working for it. The ticketing venture goes by the trademark 'BOOKMYSHOW', registered under class 41 and 42. It started business in 2007 and holds a significant share in the Indian market with a total revenue of over 150 crores per year. Apart from receiving extensive coverage in domestic and international media, the plaintiff has been ticketing partners to a number of prominent events such as Sunburn Goa, the music festival held in Goa, F1 races and PVR Cinemas, gaining reputation.ⁱ

The plaintiff's employees claimed to have come across the defendant's website 'BOOKMYEVENT' in October 2014 while browsing the internet and went on to approach the court, seeking an order of permanent injunction to restrain the defendants from using the mark 'BOOKMYEVENT', registered under class 41 and from using the prefix 'BOOKMY' as a part of its corporate name or domain name in the course of its business.

JUDGEMENT

The Court passed an ex parte interim injunction restraining the defendants from using 'BOOKMYEVENT' or the prefix 'BOOKMY'.ⁱⁱ

Hon'ble J Jayant Nath, in the High Court of Delhi held that the plaintiff had failed to make out a prima facie case and hence, does not see any reason to grant an injunction order in favour of the plaintiff.ⁱⁱⁱ He went on to dismiss the applications of the plaintiff. He stated that "I agree with the judgment of this court in Bigtree Entertainment Pvt. Ltd. v. Brain Seeds Sportainment Pvt. Ltd. (supra) that prefix BOOKMY is not an invented word."^{iv} This was supported by the claim that an apt description of the business taken up by a firm/institute, in this case - booking of tickets for shows, events, cinemas etc is neither distinct in nature nor has it acquired a secondary meaning. Another submission made by the plaintiff was regarding the trademark registry raising an objection against the defendant's trademark under class 41 being similar to that of the plaintiff's during registration, which was dodged by the defendant through a request for amendment by removing specifications for online booking for movies, seminars etc. The court in this regard held that the objection was meaningless "simply because the application

for registration of a trademark was amended may not amount to relinquishment of any right to use the trademark.”^v

CASE ANALYSIS

The plaintiff pleaded that the defendants intend to deceive prospective customers^{vi} and defraud the Trade Mark Registry by registering under the same class 41, and further upon concerns raised by the Ministry, filed an application in Form 7N 16 for amendment, limiting the scope of activities under the said mark. The plaintiff contended that there is a likelihood of confusion when taken into consideration that the infringing mark is phonetically, visually and structurally similar to the plaintiff’s mark.

The decision given by J. Jayant Nath is significant in the field of Trademarks Law because it discusses in detail 4 aspects to be considered when a said trademark is contended to cause ‘likelihood of confusion’ amongst the public. This includes:

1. Distinctiveness
2. Descriptive mark that has gained reputation/acquired secondary meaning
3. Invented word
4. The ‘whole mark’ as per Section 17 of the Trademark Act, 1999

Distinctiveness

The judgment, with this regard cited the case of P.P. Jewellers Pvt. Ltd. v. P.P. Buildwell Pvt. Ltd.^{vii} It was observed by the Court in this case that the Trade Mark Registry search reports show that the prefix ‘PP’ as a letter mark has been used by numerous other companies as their corporate names, not only by different classes as per the classification given by the fourth schedule to Trademark Rules, 2002 but particularly under Class 37 envisaged by the building and construction industry. This search suggests that the prefix used by the plaintiff company is not distinctive in nature. The Court held that “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.”^{viii}

Applying this to the case at hand, it can be observed that an examination of the market in which a prefix is abundantly used gives the impression that it is not distinctive but rather descriptive in nature. It was held that the term 'BOOKMY' is not arbitrary coupling of two English words^{ix} but is an appropriate description of the business adopted by an online booking portal. The defendant has merely adopted and applied this prefix to describe the activities of its business of being online ticketing partners for various events including movies, theatre shows, sports events, musical concerts etc.

Descriptive Mark that has Acquired Secondary Meaning

J. Jayant Nath made a reference to the case of *Living Media Ltd. v. Alpha Dealcom Pvt. Ltd.*,^x where the Division Bench held that there is no dispute that the plaintiff's company has gained a strong reputation in publication business for the title 'INDIA TODAY' which is a registered mark, however, mere sales figures and other financial details of the company does not crystalize into a right to prevent others from using a common word used by television and news channel services. The word 'TODAY' is a common dictionary term and its use in a non-contemporary sense without a reference to time may be considered arbitrary but its link with news cannot be ignored, making it descriptive in nature.

In *News Group Newspaper v. Rocket Record Co. Ltd.*^{xi} it was held that "Where the trade mark allegedly used by the defendant comprises ordinary English words then, as this decision illustrates, that circumstance may be taken into account by the court in the process of reasoning."

In *My Kinda Town Ltd. v. Soll*^{xii}, the court made it clear that the burden of establishing arbitrariness of a descriptive term used outside the said commercial business along with another term to make it distinctive is heavy.

The plaintiff in the present case claimed that it has gained reputation by establishing that its total revenue per year is over 150 crores and that over 500 people are employees under the company, nation-wide. They also listed that they have been ticketing partners to renowned events such as F1 races and the "Sunburn" concert at Goa which holds an international audience but applying the facts of the above mentioned cases shows that 'BOOKMY' has not acquired secondary meaning merely due to the reputation it has gained nation-wide and globally in the

said business. The term 'BOOKMY' verbatim means to book a particular show/event, making it descriptive of the business both the parties indulge in.

Invented Word

In *J.R. Kapoor v. Micronix India*^{xiii} held that a descriptive word of the said line of business cannot be considered to be invented. The term 'micro' is relevant in describing products of both the parties indulging in the business of microchip technology. Further, those who are familiar with the electronic industry are not likely to be misguided solely based on the prefix 'micro' and hence, the term was not contemplated to be inventive. Apart from this, the court also looked at the difference in the overall visual effect of the logo to conclude that there is not a remote chance of consumers being confused.

'BOOKMY', in these regards cannot be considered as an invented term but rather generic in nature, especially because of the term being used contemporarily in the same line of business that it describes. Although it is not possible to define the extension of invention required in order to elevate a said mark from being an ordinary word in common use to 'invented', adding a diminutive syllable, a trifling variation or a slight distortion still leaves the word within public domain.

Whole Mark as per Section 17(1) of Trademark Act, 1999

Section 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.^{xiv}

In the case of *F. Hoffman La Roche & Co. Ltd. v. Geoffrey Manners & Co. Pvt. Ltd.*^{xv} the court comprehensively compared the plaintiff's mark 'PROTOVIT', registered under class 5 and the defendant's mark 'DROPOVIT' registered in respect of medical and pharmaceutical preparations. It took into consideration the logo as a whole, the placing of the common vowel 'O' in both the marks, the number of letters, the combined effect of producing an alliteration, the use of the terminal syllable 'Vit' as a common abbreviation in the line of business, the uncommon elements and the possibility of the two terms being slurred over in pronunciation and held that there is no reasonable probability of confusion neither from a visual nor a phonetic point of view.

Applying this, the visual and phonetic viewing of ‘BOOKMYSHOW’ and ‘BOOKMYEVENT’ are completely different in terms of feature of both the marks, the pronunciation as well as the colour combination used. The plaintiff’s mark uses thin lettered grey font for ‘BOOK’ and ‘SHOW’ while using the same font in white for ‘MY’ which is placed in a red coloured ticket like visual whereas, the defendant’s mark uses a fat lettered hollow font filled with colourful textures. The ‘OO’ in the defendant’s mark is replaced by film reels used in the cinema industry.

Applying the Reasonable Person test, it can concur that there is no likelihood of confusion between the 2 visually, nor are the pronunciations similar.

Lastly, the Court relied upon the judgement of *Bigtree Entertainment Pvt. Ltd. v. Brainseed Sportainment Pvt. Ltd. & Another*^{xvi} where the injunction application of the plaintiff to restrain the defendant from using the said prefix “BOOKMY” was rejected on account of not acquiring a secondary meaning and on the judgement of *Fairdeal Corporation Pvt Ltd v. Vijay Pharmaceuticals*^{xvii} to conclude that the plaintiff failed to make a prima facie case and stated “I do not see any reason to grant any injunction order in favour of the plaintiff. I dismiss the applications of the plaintiff...”^{xviii} and allowed the applications made by the defendant.

REFERENCES

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- ⁱ *Bigtree Entertainment Pvt. Ltd. v. D Sharma*, 2017 S.C.C. Online Del 12166.
ⁱⁱ *Bigtree Entertainment Pvt. Ltd. v. D Sharma*, 2017 S.C.C. Online Del 12166.
ⁱⁱⁱ *Bigtree Entertainment Pvt. Ltd. v. D Sharma*, 2017 S.C.C. Online Del 12166.
^{iv} *Bigtree Entertainment Pvt. Ltd. v. D Sharma*, 2017 S.C.C. Online Del 12166.
^v *Bigtree Entertainment Pvt. Ltd. v. D Sharma*, 2017 S.C.C. Online Del 12166.
^{vi} *Bigtree Entertainment Pvt. Ltd. v. D Sharma*, 2017 S.C.C. Online Del 12166.
^{vii} *P.P Jewellers Pvt. Ltd. v. P.P. Buildwell Pvt. Ltd.*, 2009 (39) PTC 705 (IPAB).
^{viii} *P.P Jewellers Pvt. Ltd. v. P.P. Buildwell Pvt. Ltd.*, 2009 (39) PTC 705 (IPAB).
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^x *Living Media India Ltd. v. Alpha Dealcom Pvt. Ltd.*, 2016 (66) PTC 200 (Del).
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^{xii} *My Kinda Town Ltd. v. Soll*, [1982] F.S.R 147.
^{xiii} *J R Kapoor v. Micronix India*, 1994 Supp (3) S.C.C. 215 (India).
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^{xviii} *Bigtree Entertainment Pvt. Ltd. v. D Sharma*, 2017 S.C.C. Online Del 12166.