

### MakeMyTrip obtains injunction against MakeMyTours India - Nishith Desai Associates

January 28 2015

In *Make My Trip (India) Pvt Ltd v Make My Tours Pvt Ltd* (2014 SCC Online Del 7404, December 23 2014), the Delhi High Court has granted an injunction in favour of *Make My Trip (India) Pvt Ltd* (MakeMyTrip), thus restraining Make My Tours Pvt Ltd (MakeMyTours) from infringing MakeMyTrip's trademarks, and from passing off or attempting to pass off its business, products or services as those of MakeMyTrip. The court found that MakeMyTours was using word and logo marks that were virtually identical to those used by MakeMyTrip for identical services.

MakeMyTrip was founded in 2000 under the name Travel by Web Private Limited. The name was changed to Makemytrip.com Pvt Ltd on August 2 2000 and, subsequently, to MakeMyTrip (India) Pvt Ltd, which is its present name. MakeMyTrip claims to be a pioneer in the online travel industry in India. It operates through its primary website at 'www.makemytrip.com' and other platforms to provide a wide range of travel services and products both in India and abroad, including air tickets, hotels, rail tickets, bus tickets, car hire, domestic and international holiday packages and ancillary travel requirements, such as facilitating access to insurance.

MakeMyTrip argued that, in October 2014, it came across MakeMyTours' website at 'www.makemytours.com', which provided services identical to those of MakeMyTrip. It claimed that MakeMyTours was using the mark MAKEMYTOURS, which was deceptively similar to MakeMyTrip's mark MAKEMYTRIP, as well as the MY logo, which was similar to MakeMyTrip's MY logo mark.

MakeMyTours' logo:



MakeMyTrip's logo:




Unlike on the plaintiff's website, customers were unable to make online bookings through MakeMyTours' website, but were required to contact MakeMyTours in person, as per the contact details displayed on its website. Further, on conducting an investigation into the business activities of MakeMyTours, MakeMyTrip found that MakeMyTours was carrying on business from its premises under identical marks as those used by MakeMyTrip. After making enquiries with the Trademarks Registry, MakeMyTrip found that MakeMyTours had applied for registration of the mark MAKEMYTOURS on May 2 2012, claiming use of the mark since April 1 2012 (Application No 2325382 in Class 39).

MakeMyTrip filed the present suit, seeking an injunction against MakeMyTours preventing it from using the following marks:

- MAKEMYTOURS
- 
- 

MakeMyTrip argued that MakeMyTours infringed:

- the following marks:  

- copyright in the artistic works for these marks (collectively, MakeMyTrip's marks).

It is noteworthy that, at the time of filing the suit, MakeMyTours' website was non-operational.

To substantiate its claim for an injunction against MakeMyTours, MakeMyTrip contended that:

1. Its website was one of the most accessed and used online travel booking and planning portals in India, and the number of online visitors was consistently increasing. To support this claim, MakeMyTrip submitted records to the court indicating the number of hits on its website in August

2014.

2. It had applied for/obtained registration for its marks in India, as well as in several foreign jurisdictions.
3. It had obtained copyright registration in India in respect to the artistic work in its marks.
4. It had made substantial investments in advertising and promoting its marks worldwide via electronic and print media. To support this claim, MakeMyTrip submitted records of expenses incurred on advertising and promoting its marks during the year 2013-14.
5. MakeMyTrip's marks have appeared in leading Indian and international daily newspapers and magazines.
6. It had sponsored national and international events, including Bollywood movies and international sports events.
7. The revenues generated by its marks in India for the period 2013-14 were significant.
8. It had received several national and international awards, including being recognised as a 'superbrand' for 2009-2010 by [Superbrands India](#).

MakeMyTrip further contended that it had been active in enforcing its rights in its marks in the past and had obtained *ex parte ad interim* injunctions restraining certain third parties from using marks similar or identical to its own marks. Further, it also submitted that it had applied for registration of the mark MAKEMYTRIP on May 25 2011, claiming use since June 27 2000 (Application No 2149947 in Class 39), while MakeMyTours had applied for registration of the mark MAKEMYTOURS on May 2 2012, claiming use of the mark since April 1 2012 (Application No 2325382 in Class 39). MakeMyTrip was thus the prior user of the marks.

MakeMyTrip further submitted that, "by virtue of prior adoption, substantial expenditure on promotion, long, continuous and extensive use in India, significant turnover and diligent enforcement", its marks had acquired a secondary meaning in the business and trade, qualifying them as "well-known marks" within the meaning of Section 2(1)(zg) and Section 11(6) of the [Trademarks Act 1999](#), which entitled them to statutory protection.

Section 2(1)(zg) reads as follows:

*"a 'well-known trademark', in relation to any goods or services, means a mark which has become well known to a substantial segment of the public which uses such goods or receives such services, such that the use of such mark in relation to other goods or services would be likely to be taken as indicating a connection in the course of trade or rendering of services between those goods or services and a person using the mark in relation to the first-mentioned goods or services."*

Section 11(6) reads as follows:

*"The registrar shall, while determining whether a trademark is a well-known trademark, take into account any fact which he consider relevant for determining a trademark as a well-known trademark, including:*

*(i) the knowledge or recognition of that trademark in the relevant section of the public, including knowledge in India obtained as a result of promotion of the trademark;*

*(ii) the duration, extent and geographical area of any use of that trademark;*

*(iii) the duration, extent and geographical area of any promotion of the trademark, including advertising or publicity and presentation, at fairs or exhibitions, of the goods or services to which the trademark applies;*

*(iv) the duration and geographical area of any registration of, or any application for, registration of that trademark under this act to the extent they reflect the use or recognition of the trademark; and*

*(v) the record of successful enforcement of the rights in that trademark, in particular the extent to which the trademark has been recognised as a well-known trademark by any court or registrar under that record."*

After hearing the arguments of MakeMyTrip, the court expressed the view that the public identified and associated MakeMyTrip's marks with MakeMyTrip alone. The court observed that the use of MakeMyTours' marks seemed to be motivated by an intention to trade upon, and benefit from, the reputation and goodwill enjoyed by MakeMyTrip in its marks. MakeMyTours' use and promotion of virtually identical marks for identical services were creating a false sense of affiliation/collaboration between MakeMyTrip and MakeMyTours, and was bound to confuse and deceive the public into believing that the source of MakeMyTours' services was MakeMyTrip.

Since MakeMyTrip had made out a *prima facie* case and the balance of convenience lay in its favour, the court restrained MakeMyTours, until the next hearing in the case (which is scheduled for February 13 2015), from using its marks and/or any descriptive variation thereof in relation to its business, products or services, as a trademark or as part of its trade/corporate name, internet domain name, web address, email address or any other manner so as to infringe MakeMyTrip's statutory trademark rights, and/or to pass off, or attempt to pass off, its business, products or services as those of MakeMyTrip. The court clarified, however, that MakeMyTours could continue to use the marks MY TOUR and MY TRAVEL in a different style/script.

*Aaron Kamath, Aarushi Jain and Vivek Kathpalia, Nishith Desai Associates, Mumbai*

---

**World Trademark Review ([www.worldtrademarkreview.com](http://www.worldtrademarkreview.com)) is a subscription-based, practitioner-led, bi-monthly publication and daily email service which focuses on the issues that matter to trademark professionals the world over. Each issue of the magazine provides in-depth coverage of emerging national and regional trends, analysis of important markets and interviews with high-profile trademark personalities, as well as columns on trademark management, online issues and counterfeiting.**