

## **Word Mark – as Google Ad word, Supreme Court dismisses MakeMyTrip's challenge against the use of Make My Trip as Google Ad word by competitor.**

Adv. Sherief Sulthan (Advanced B' Level Diploma in Computer Applications Equivalent to MCA), MCSE, LLB

**Background of the case:** MakeMYtrip and Booking.com are 2 Tour operators well known all over India. **In 2019, MMT issued a notice to Booking.com to cease bidding on the key word make my trip through the Google Ads Program**, claiming makemytrip is MMT's registered Word Mark. Technically, Booking.com sponsored a keyword makemytrip in Google Ads program, so that when a user types the words makemytrip or its any combination, Google Search Engine will display Booking.com's advertisement links, as a result of search. Simply saying, when the words makemytrip was typed Booking.com's advertisement links were displayed.

MMT even sadly complained that, when a user types 'make my trip' on Google, the 1<sup>st</sup> advertisement links would appear of the company Booking.com and MMT's advertisement links would appear far below, even unnoticed by the users.

**In August 2020** also, MMT issued similar notice to Booking.Com. MMT, the TravelTech startup then filed Copyright infringement case against Booking.com and the Google alleging that the former had been illegally bidding on the trademark associated with MMT in Google Ads, which resulted in network traffic diversion in Booking.com's favour and business loss to 'MakeMyTrip' .

In April 27, 2022, a Single Judge of Hon'ble High of Delhi, Justice Pratibha M. Singh granted an injunction in favour of MMT, observing the following:-

- (1) The use of trademarks and its variations by competitor on Google Ads is deemed passing off.
- (2) The use of trademarks by competitors even as meta tag is an infringement u/s 29 of the Trademarks Act 1999.
- (3) 3<sup>rd</sup> party bidding on trademarks as sponsored keywords for use by Internet Search Engines can be constituted as misrepresentations.

**Technical Aspects of the case:** What is the role of Search Engines, meta tags, Google Ad word in internet, Website and most importantly e-commerce. To understand this, a basic understanding of Website and Searching, and Search Engines etc. are required.

**Website:** primarily it is a collection .html files (not our paper files), images, video & audio files, text & pdf (portable document format) files, database files, executable .dll etc. etc. These files are placed/copied (either directly or through online uploading procedure) onto a designated folder associated with a web address, as an example [www.abc.com](http://www.abc.com) (for our purpose web address can be called domain name also. Com is 1<sup>st</sup> level domain name and abc is 2<sup>nd</sup> level domain name. In legal terms domain name - 2<sup>nd</sup> level domain - is defined as a computer resource or service associated with an address).

And one particular file, usually Index.html or Home.html (all in simple terms) is configured as the Home page, so that when a user types [www.abc.com](http://www.abc.com) in address bar of the browser, the designated home page is downloaded to the client system.

**What is browser:** Browser is a S/w Application Program, used to access a Website . Browser program contacts the server Computer (Web Server) and downloads the requested files one by one. And when the files reaches the client system, the browser intercepts the file and interprets the code written in it, as what we see in the client systems (Pc/Laptop or mobile phone etc.).

Example browser programs:- Mozilla Firefox, Microsoft Internet Explorer, Microsoft Edge, Google Chrome etc.

### **Usual Methods of Accessing the Service of a Website:**

1. Typing the absolute address of the Website, in the address bar of the browser, as an example <http://www.abc.com>
2. Typing one or more words of the required goods/service in the search area of the Search Engine programs (also working side by side with the browser)

As an example, in Google's page when we type the word **insurance**, we mean Insurance services and Google Search Engine displays web address of companies associated with Insurance services, but in which order? That's actually the real subject matter of our case law. The order place the commercial value of the Search Engines.

In the 1<sup>st</sup> method, browser directly contacts the Web Server (Website) without the help of Search Engines. While in the 2<sup>nd</sup> method, Search Engines program displays a list of Website address along with a description matching the word typed. The order of such listing is based on certain criteria – and where holds Google's Writ/monopoly – *and everybody wants to be 1<sup>st</sup> in the list , if not possible atleast within the 3 or 4 in the list, so that a hit/click is received from the user, because users eye naturally falls on top. Falling below 7 or 8 has no use at all, especially in terms of e-commerce.* Because, if it falls below 7 or 8, due to space constraint in the display area, the listing will be in the next page of the browser in PC/Laptop, and in mobile phone, user has to scroll down to view a listing below 7 or 8. Users usually won't look beyond current page or try a scroll down, when he/she is supplied and satisfied with services listed in the top . *And in our case law the petitioner sadly complained that his listing coming far below of his competitors, where the competitor using petitioner's registered. Word Mark for this purpose.*

**Google as a Search Engine:** Google is the most popular searching program, thanks to its widest aggressive marketing strategies. Most of the hand held devices (ex., mobile phones ) now pre-programmed and shipped with, Google as the by default search program, thus people are growing accustomed with Google as search tool. Moreover now Google is became a synonym with search. There are other Search Engines also, **Yahoo search, Bing, MSN Search** etc., while Google Search Engines account for approximately 85-90% of the Internet searches.

**What is Search Engine Program?** It displays a list of web links associated with a keyword, when a key word is typed.

**How it works?** When a Website is hosted (Website files are copied to the relevant folder) and the Website is up (working) – Search Engine programs start **scanning content of .html files** to understand – what's the site meant for or what's the function of the Website – using various criteria (in technical terms algorithms). One common criteria is repeated words or phrases, and the result of the scanning is stored in a data storage (technically called database, and database in simple terms is similar to an excel work sheet, i.e., a Row x Column wise Data structure).

When a user types a word in the Search Engines' search area, it compares the typed word with what stored in the data storage, when a matching word(s) found, corresponding web address links along with descriptions are displayed.

**Use of meta tags instead of content scanning:** The above scanning method not a perfect solution, after considering millions of Websites around the world, with each day get hosted 1000s of new websites or changing its content rapidly, and with very large content – meta tags provided a more easy way.

Meta tags are special are in a Website file, where the Website owner/creator specifies what the Website meant for, to which keywords it to respond. The owner/creator supplies a list of keywords, the potential customers to type in the Search Engine, so that Search Engines to display this site's link. The Search Engines have to scan only this area, rather than scanning the entire content. Which more logical, error-safe, faster.

**Content tag & Met tag – the secret stories of unfair trade practices:** There are 100s of tags in a web page, like Title Tag <title>, Paragraph Tag <p>, different sized Highlight tag like <h1> to <h6>, meta tag <meta> etc. etc.

An example Website file

```
<html>
<head>
<title> India's No 1 Insurance Company </title>
```

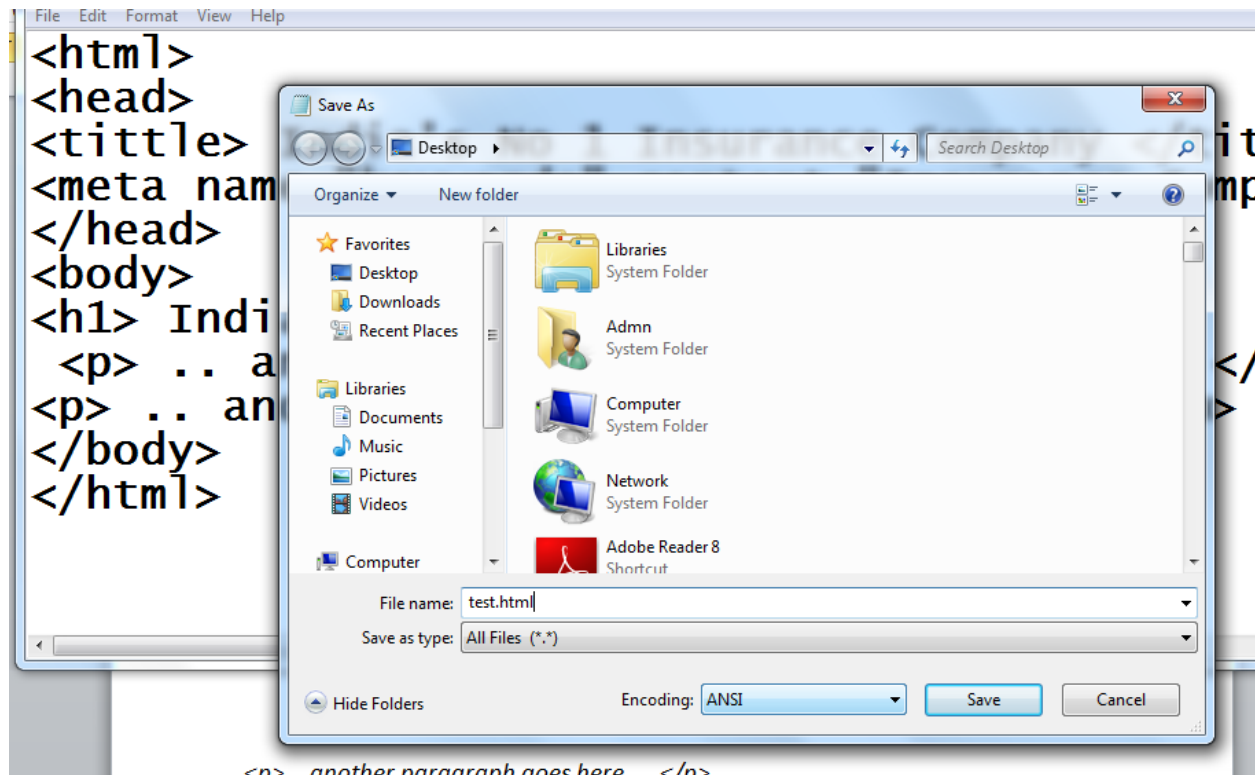
```

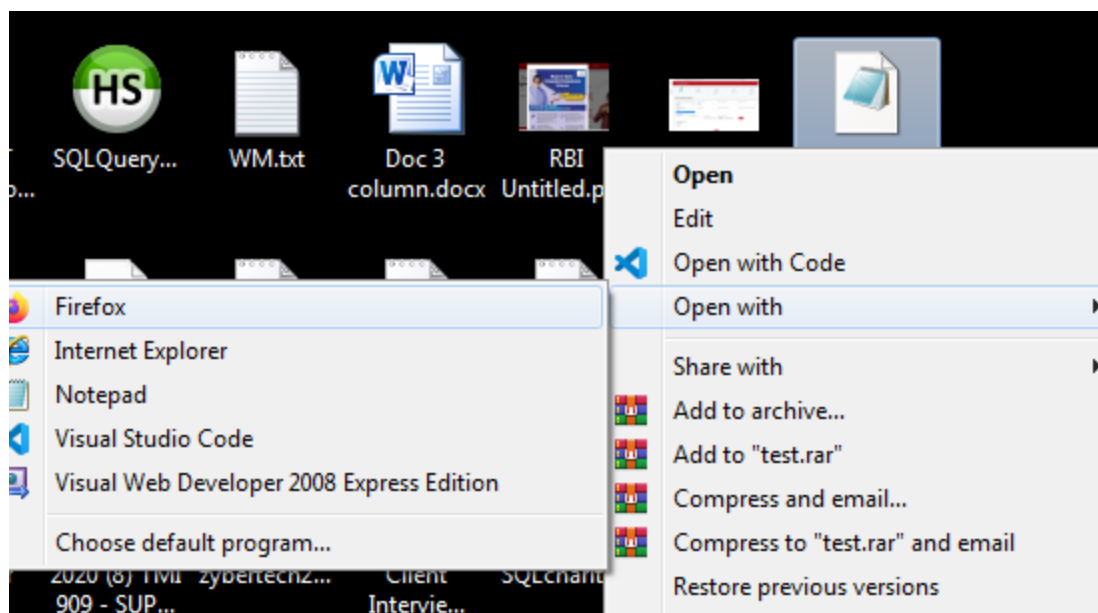
<meta name="keywords" content="Insurance Company, Insurance, Health
Insurance, Arogya Suraksha, Assured Health"> </meta>
</head>
<body>
<h1> India's No 1 Insurance Company </h1>
<p> .. an entire paragraph goes here.. </p>
<p> .. another paragraph goes here.. </p>
</body>
</html>

```

### **How to test this file**

- (1) Type/Copy the codes under italics, in Notepad
- (2) Select ->file ->save as->select All files against save as type
- (3) Type test.html against file name
- (4) Click Save - [as Picture 1 below]
- (5) Now locate your test.html in desktop
- (6) Place Mouse over it – press Mouse Right Button
- (7) Select Open with Option –
- (8) Select Firefox - [as Picture 2 below]





Main difference between above mentioned display tags and meta tag is, the content of display tag (as an example the content of Title Tag is *India's No 1 Insurance Company*) is visible to the user, while the content of meta tags are not visible to the user, and visible only to the Search Engine programs.

**Invisible feature of meta tags gave an unchallenged but unfair opportunity to competitor** – That he can easily put other company's Word Mark also in his meta tag, non-transparent to the outside world, and re-directing network traffic actually meant for opponent's Website to his Website .

**How it works?** As an example abcTour (P) Ltd maintains a Website abc.com and has registered Word Mark HappyMyTour. And BcdTour (P) Ltd maintains a Website bcd.com and also has a registered Word Mark EveryDayTour. One day, bcd.com (having regard to its online presence and abc.com's online presence and respective business volumes) decides to redirect internet users who is searching with the HappyMyTour to our Website bcd.com

For this purpose they re-code their Website file as under **bcd.com's html file**

```

<html>
<head>
<tittle> India's No 1 Tour Operator </tittle>
<meta name="keywords" content="EveryDayTour, Every Day Tour, Every
Day,Tour, HappyMyTour, Happy My Tour, Happy My, Happy Tour, My Tour,
MyTour "> </meta>
</head>
<body>
<h1> India's No 1 Tour Operator </h1>
<p> .. an entire paragraph goes here.. </p>
</body>
</html>

```

Now Search Engine programs will read the changed meta tag (which is invisible to user/public) and Search Engine's data storage, thus HappyMyTour, Happy My Tour, Happy My, Happy Tour, My Tour, MyTour are linked with bcd.com also (assume such key words already in the meta tag section of abc.com natural). And when a user types HappyMyTour, Happy My Tour, Happy My, Happy Tour, My Tour, MyTour, search result will start display bcd.com also.

### **Financial & technical issues involved here:**

1. Abc.com might have and has been investing substantial amount for popularizing its Word Mark HappyMyTour – by way of
  - (a) Newspaper advertisement
  - (b) Digital media (old term) advertising techniques like Email, SMS etc
  - (c) New gen Social media advertising platforms like whatSapp, Facebook etc
  - (d) Direct call to potential customers by employing telecallers etc
  - (e) Using the services of celebrities and models etc.
  - (f) Putting hoarding in tourist destinations and path ways
  - (g) Sponsoring social events etc.
2. When a user types HappyMyTour etc words Search Engines displays Website links, social media links such as Facebook, Instagram, YouTube, LinkedIn, and subject review links, and sometimes Wikipedia link (if so popular the company) also
3. A maximum of 7 or 8 links can be display in PC/Laptop in page, and mobile phone can also display in same numbers without scrolling down by the user. In PC/laptop user has to click the next page button

(technically saying, only at this time the next page is downloaded to the client machine, usually)

4. So to get user's attention, link must be at the top position (1 to 4 positions), else user will discard him practically.
5. Position is decided by the Search Engine according to various criteria, one such criteria is average traffic to the Website (in a day or week), traffic means number of users accessing the Website – more visitors means more traffic. Sometimes Search Engine adopt other criteria also
6. In short, there is no guarantee that abc.com and allied links will always appear in 1<sup>st</sup> positions, if a competitor Website uses its Word Mark.
7. Unlike an ice-cream brand user, or a soft drink brand user, or a liquor brand user – a casual goods/service seeker may just remember a few letters of the service provider (thanks to aggressive advertising programs mentioned above initiated by the service provider), and type what he remember, he doesn't exactly know or bothered, who is related with his typed words

***'all he want is a service'***

And he click on to the link, displayed in front of him- since he want just service at all – it is immaterial for him, whether the provider is abc.com or bcd.com. and if he choose bcd.com, bcd.com gets a customer, thanks to the efforts of abc.com in men and material.

8. On the other hand, if the user distinctly knows about abc.com and wants its service only then he may scroll down or up to click abc.com, naturally is expected.
9. In another scenario, the user distinctly knows about abc.com and wants its service only, but some alternate service provider's link is also displayed, he may choose cbd.com as an experimental basis, here also, bcd.com gets a bonus at the expenses of abc.com



**Case law: [www.Shadi.com](http://www.Shadi.com) Vs [www.ShaadiHiShaadi.com](http://www.ShaadiHiShaadi.com)  
Bombay High Court**

*Back ground of the case:* In 1996, one Siddharth Mehta launched an online Match making, matrimonial and wedding services portal under the name and mark Shaadi.com. The Plaintiff has been vigorous in promoting and publicizing its brand, mark and services, Shaadi.com / Shadi.com / Shaadi Centre. There has been much publicity in the form of printed material, television and print advertisements, online advertisements etc.

The Plaintiff claims to be the first in the country to provide online matrimonial services in this manner. Since February 2007, its main Website [www.shaadi.com](http://www.shaadi.com) has had 11.1 billion recorded visitors or hits. Since 2004, about 17.39 lakh people have subscribed to its service online and offline. Its turnover in the year 2012-2013 was approximately Rs. 91.7 Crores, a significant rise from its turnover in 2005-2006 of approximately Rs. 26.6 Crores. The total annual sales for this period from 2005-2006 to 2012-2013 are about Rs. 430 Crores. During this very period, the Plaintiffs have spent an amount of Rs. 172 Crores on publicity, promotion and advertising. Annexed to the plaint are various documents establishing these figures

**In October 2013**, the Plaintiffs found that a domain name [www.ShaadiHiShaadi.com](http://www.ShaadiHiShaadi.com) had been registered in respect of identical services: online matchmaking / matrimonial services, wedding planning, dating services etc. The Plaintiffs' Website below the words shaadi.com clearly said to be a registered trade mark with the appropriate symbol, is the tagline "The World's Largest Matrimonial Service". Defendant's Website below the domain name ShaadiHiShaadi.com appears an almost identical tagline "World's Biggest Matrimonial Service".

The Plaintiffs conducted a web analysis of the Defendant's infringing domain name ShaadiHiShaadi.com. They found that the 1st Defendant has used the Plaintiffs' proprietary mark shaadi.com and its domain name [www.shaadi.com](http://www.shaadi.com) as part of the "meta-tags" in the Defendant's domain name. The Plaintiffs' analysis showed that by illicitly plugging the Plaintiffs' mark and domain name into his Website's web pages' meta-tags, **the Defendant succeeded in diverting as much as 10.33% and 4.67% of the Internet traffic away from the Plaintiffs to himself.** The

Hon'ble High Court observed that there could be no better evidence of passing off, confusion. This is, plainly, hijacking the Plaintiffs' reputation and goodwill and riding piggyback on the Plaintiffs' valuable intellectual property.

**Entry of Google Ad words into Search Engine Arena:** How Google Ad words works? Ad Words stands for Advertising Words. Google says – a business can sponsor a key word/search word (simply put) on payment, and the sponsor's site is displayed 1<sup>st</sup> among the listed Website links.

Google Search Engine is prominent among all others, and it account for the approximately 86-90% of the Net search traffic.

**[why the word traffic is used in internet, as in the case of road traffic?**

Understand that, when we access a Website, a request in the form of electronic message – technically called packet – is to be reached at the Website almost similar to postal letter. The message contains **body**, **to address** (IP address of the server machine, usually permanent/static), **from address** (our device's IP address, usually dynamic/variable, when we connect our device to the internet, an IP address assigned to our device. Thus, each time may get a different IP address, a free/available address from our service provider. And the service provider records the IP address and connection time of each device under it).

And the server respond with requested resource, again a message is created, in the reverse direction (the **from** and **to addresses** positions reversed). It is basic method of all network communications. In short, physically (in digital form) messages must be passed between communicating devices, no magic at all. This message passing is termed as network traffic.]

This means, cmd.com can always put his link on top by paying heavy payment to Google by sponsoring his competitors Word Mark. **Technically speaking, meta tags & Google Ad Words performs the same function.** With only single difference, in Google Ad Words case, an another party also involved directly.

Bcd.Com's action of putting abc.com Word Mark in meta tag or as Google Ad Word is an unfair trade practice. Website file is an electronic document, in the file keywords are added by typing onto the computer screen, a physical action. In total, it not much different from writing a document, or painting a picture etc. Similarly in Google Ad words Form, provided by Google, the word sponsor types his desired Advertising word, also a physical action. These electronic documents are kept with these entries as long as the desired effect is required. The owner of the web page where the impugned meta tag contains, or sponsor of the Ad word, cannot absolves himself from the responsibility, who is the ultimate beneficiary of the these actions.

As an analogy, Bcd.Com's action of putting abc.com Word Mark in meta tag or as Google d word, is equivalent to Bcd.com's employee wearing abc.com's uniform, and standing just in front of the abc.com' shop, direct customers who are coming to abc.com's shop for making a grand shopping to bcd.com's shop, for the same purpose.

As an another analogy, C a client coming in search of an advocate A for filing a petition. In front of A's office, advocate B's clerk was standing, he always standing there, and he direct B's office to C.

Here 3 scenarios may occur

- (i) C, just heard of A as an advocate, and he wants to meet any advocate. Somebody told him about A. B's clerk told him B also doing the same work of filing, arguing, and winning cases (B's clerk telling C that, B is even better than A). C is satisfied with B, and A looses a potential client.
- (ii) C, wants to meet A. But not met him before, so not familiar. B's clerk point him B as A, a misrepresentation, and C goes to B, and here also A looses a potential client.
- (iii) C, wants to meet A, and known to him. B's clerk point him B as A, and C little bit confused, but withstands and doesn't believe B's clerk and goes to A itself.

Here, in the 3<sup>rd</sup> scenario only the question of confusion arise (in other 2 scenarios, A is not in the picture, because of the mercenary work of B's Clerk), but C withstand the artificially generated confusion and stick to his will. In 1 and 2 scenarios, C faces no confusion at all and goes to A's competitor, because of the mercenary work of B's Clerk, depriving the goodwill earned by A in the society through his skill and hard work.

The same analogy can be applied to **abc.com** and **bcd.com** case

- (i) User, just heard of HappyMyTour as a Tour Operator, and he wants service of any Tour Operator. Somebody told him/somehow he came to know about HappyMyTour. He typed HappyMyTour in search area and got a listing doing tour operations. He is satisfied with bcd.com, and Abc.com loses a potential client.
- (ii) User, wants the service of Abc.com. He typed HappyMyTour in search area and got a listing doing tour operations. But abc.com not listed in the easily viewable area of the screen (abc.com was listed at below 7 or 8). So, he chooses bcd.com, a misrepresentation by meta tag/Google Ad word, and he clicks bcd.com, and again Abc.com loses a potential client.
- (iii) User, wants the service of Abc.com, and HappyMyTour is known to him very clearly. In the search result appears bcd.com and abc.com in viewable areas, or abc.com little far below. User, though initially little bit confused, but withstands and scroll and up and down as many as times required, and clicks Abc.com.

### **Let's discuss the principal case law again**

Initially, Justice Pratibha M. Singh of Hon'ble High of Delhi, granted an injunction in favour of MMT, observing the following:-

- (1) Competitor's use of trademarks and its variations on Google Ads is deemed passing off.

- (2) Competitor's use of meta tag is an infringement u/s 29 of the Trademarks Act 1999.
- (3) 3<sup>rd</sup> party bidding on trademarks as sponsored keywords for use by Internet Search Engines can be constituted as misrepresentations.

However, in December 2023, a Division Bench of Justice Vibhu Bakhru and Justice Amit Mahajan, of the Hon'ble Delhi High Court observed that Booking.com is a well-known and popular platform offering travel services and that prima facie, it cannot accept that an internet user is likely to be misled into believing that the services offered by it are those of Make My Trip. The interim relief was therefore set –aside.

The Hon'ble Supreme Court on March 7, 2014 refused to entertain MakeMyTrip's challenge against [the Delhi High Court order](#). The bench led by CJI DY Chandrachud and Justices JB Pardiwala and Manoj Misra observing that

- (1) While Booking.com did use the keywords which involved the MMT's trademark at the ad-site bought from Google, that in itself was not sufficient to show passing off & infringement as the ad-site did not use MMT's keywords in its trademark form.
- (2) The Court noted the lack of any premised confusion under S.29 of the Trade Mark Act 1999.

**Conclusion:** In short, at a first glance looking, the observations of Hon'ble Delhi High Court and the Hon'ble Supreme Court considered only the 3<sup>rd</sup> scenario only, where the registered Word Mark owner and his competitor are listed together in an easily viewable area of the screen. In the light of technical aspects of Competitor's use of trademarks and/or its variations as meta tag and Google Ad word, and financially adverse impact on its registered owner, the subject has to be discussed at highest level legal circles.