

Plea of Acquiescence in absence of consent is a failed defence – Delhi High Court

written by Priyanka Ajjannavar | November 21, 2019



The Hon'ble Justice Sanjeev Narula of Hon'ble Delhi High Court in judgment dated October 18, 2019 in the matter of *Make My Trip (India) Private Limited V. of Make My Travel (India) Private Limited*^[1] granted "temporary ad-interim injunction restraining the defendant from using the marks 'Make My Travel' and 'MMT', tag line 'Dreams unlimited', website 'www.makemytravelindia.com' and the logo 'Make My Travel'."

FACTS

Make My Trip (India) Private Limited (*herein-after referred to as 'Plaintiff'*)

is a company that offers an extensive range of travel services and products, both in India and abroad. The services of the Plaintiff include, booking of air tickets, rail tickets, bus tickets, hotel reservations, car hire, domestic and international holiday packages and ancillary travel requirements such as facilitating access to travel insurance under name of "Make My Trip" since the

year 2000. Make My

Travel (India) Private Limited (*herein-after referred to as 'Defendant'*) is

a company, incorporated in the year 2010-2011 and has been involved in the business same as that of the Plaintiff.

The Plaintiff has been

using Word mark "MakeMyTrip", letter mark "MMT" and tag lines "Memories Unlimited" and "Hotels Unlimited" continuously and uninterruptedly since the year 2001.

In the present case

Plaintiff has sorted for permanent injunction restraining the Defendant from adopting and using word-mark 'Make My Travel', letter mark 'MMT' and the tag line 'Dreams Unlimited' and Hotels Unlimited and domain name makemytrip.com. During the pendency of the case, Hon'ble High Court granted temporary injunction in favour of the Plaintiff.

ISSUES

The Hon'ble Court considered the following Questions of Law and Fact:

1. Whether the Court was right in granting temporary injunction restraining the Defendant from using the marks?
2. Whether the Court was right in rejecting the Plea of Acquiescence?

SUBMISSIONS

The learned counsel for the Plaintiff contended that the Plaintiff has incessantly and ceaselessly used the word mark 'MakeMyTrip,' Letter Mark 'MMT' and the tag line "Memories Unlimited" and "Hotels Unlimited" for its business activities. The Plaintiff has an immense reputation and goodwill on account of extensive and continuous use of marks. In order to add further distinctiveness and brand recall to its 'MakeMyTrip' word-mark, the Plaintiff, over the years, has conceived, adopted and used various captivating and appealing logos, all of which contain the 'MakeMyTrip' word mark, as their essential feature.

Learned counsel for the Plaintiff further submits that the infringement and passing off of Plaintiff's marks is proved by the following factors:

- a) Phonetically, visually, structurally and conceptually the competing marks are identical and/or deceptively similar.
- b) Identity of idea: The mark 'MakeMyTravel' and 'MakeMyTrip' are combination of three words, where first two words are identical and last word "travel" and "trip" convey the same meaning, idea and concept
- c) Nature of goods and services in respect of which the trademarks are being used are identical.
- d) Class of purchasers that is likely to use services of the Plaintiffs and the Defendants is the same.

Hence, *any unauthorized use of the 'MakeMyTrip' Marks and/or any other deceptively similar mark would violate the Plaintiff's statutory and common law rights.*

On the other hand the learned counsel for the Defendant contended that Plaintiff's suit is not bonafide. The Plaintiff has suppressed material facts. The Defendant strongly emphasized that the Plaintiff has deliberately suppressed some of the vital documents and the communications exchanged between the executives and the franchisees of the Plaintiff. It is further submits that the Defendant has also set up the plea of acquiescence, alleging that since the Plaintiff has previously not objected to the use of the name "Make My Travel (India) Pvt. Ltd." by the Defendant, it cannot now be permitted to object to the use of the said name.

Observation and Judgement

While deciding the application of Plaintiff under Order XXXIX Rule 1 & 2 and application of Defendant under Order XXXIX Rule 4 at preliminary stage, the court considered the Well settled law governing the grant of Interim injunction viz. prima facie case, balance of convenience and the irreparable injury likely to be caused. High Court while placing reliance on several precedents, laid down the test to be applied while estimating the question regarding the infringement.

In F. Hoffman La Roche v.

Geofferey Manners [2]

the Apex Court held that true test is whether the totality of the proposed trade mark is such that it is likely to cause deception or confusion or mistake

in the minds of persons accustomed to the existing trade mark. The court had to

lay stress on the common features rather than on the differences in essential features.

Referring to its earlier judgment Amritdhara Pharmacy v. Satyadev Gupta[3],

in the court held that for deceptive resemblance,

two important questions that need to be kept in mind are:

1. Who are

the people that the resemblance must be likely to deceive or confuse? and

2. What rules

of comparison are to be adopted in judging whether such resemblance exists?

It was further held that confusion is perhaps an

appropriate description of the state of mind of a consumer who on seeing a mark

thinks that it differs from the mark on goods which he has previously bought, but is doubtful whether the impression is not due to imperfect recollection.

Further, in Shree Nath Heritage Liquor Pvt. Ltd. v

Allied Blender & Distillers Pvt. Ltd.[4], the Hon'ble Supreme Court held

that in case of relative synonymy, words or phrases may be similar in

certain contexts while not in others and in such cases, where certain words

which may not be similar in every context but convey the same idea in a

particular context, similar brand name recollection impairment may be observed.

Thus, it was held that marks containing words with the same sense relation (or

falling in the same semantic field, or conveying the same or similar idea in the mind) as that of previously existing marks are likely to be considered so similar as to be refused registration or deemed to constitute infringement of the previously existing trademark.

In Emcure Pharmaceuticals Ltd. v. Corona Remedies Pvt. Ltd.[5] the Bombay High Court extensively discussed the defence of acquiescence as available to an alleged infringer of the trademark. It was held that a mere failure to sue without a positive act of encouragement is no defence and is not acquiescence. Further, examining the concept of "acquiescence", it was

observed that acquiescence is a species of estoppel, a rule in equity and a rule of evidence and it is essential to the acquiescence doctrine that it is accompanied by an encouragement or an inducement. He who possesses a legal right must have encouraged the alleged violator of that right in acting to

the latter's detriment, confident in the knowledge that the former is not asserting his rights against the violator. Acquiescence is sitting by when another invades your rights and spends money in the doing of it. It is conducted incompatible with claims of exclusivity, but it requires positive acts, not mere silence or inaction (of the stripe involved in the concept of laches). Acquiescence is not mere negligence or oversight. There must be the abandonment of the right to exclusivity.

In the present case, while the first two words of the marks "MakeMyTrip" and "MakeMyTravel" are identical, the last words, TRIP and TRAVEL

are similar and convey the same idea. Similarly, the Defendant's tag line DREAMS UNLIMITED is deceptively similar to the Plaintiff's taglines HOTELS UNLIMITED and MEMORIES UNLIMITED. While the second word in the tag lines is identical, the first words DREAMS, MEMORIES and HOTELS, when considered in the

context of travel and holiday-related services, may be used in the same context or idea.

Therefore, the application filed by Plaintiff under Order XXXIX Rule 1 & 2 is allowed, and the injunction order is made absolute and shall continue to operate during the pendency of the present suit

Conclusion

The Hon'ble High Court keeping the law laid down by the Supreme Court in the various judgments and having regard to the facts of the case the Court is of the opinion that the primary requirements of Temporary injunctions

lies in favour of the Plaintiff. Hence, the injunction order is made absolute.

Furthermore, to adopt the doctrine of acquiescence the person who possesses legal right should give assent to the infringer for using the mark. Mere silence or non-intervention against the violator doesn't amount to consent.

• [1] CS(COMM) 889/2018

• [2] (1969) 2 SCC 716

• [3] AIR 1963 SC 449

• [4] (2015) 221 DLT 359

• [5] 2014 SCC OnLine Bom 1064

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