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ABOUT US

INTERNATIONAL JOURNAL FOR LEGAL RESEARCH & ANALYSIS ISSN 2582-6433 is an Online Journal is Monthly, Peer Review, Academic Journal, Published online, that seeks to provide an interactive platform for the publication of Short Articles, Long Articles, Book Review, Case Comments, Research Papers, Essay in the field of Law & Multidisciplinary issue. Our aim is to upgrade the level of interaction and discourse about contemporary issues of law. We are eager to become a highly cited academic publication, through quality contributions from students, academics, professionals from the industry, the bar and the bench. INTERNATIONAL JOURNAL FOR LEGAL RESEARCH & ANALYSIS ISSN 2582-6433 welcomes contributions from all legal branches, as long as the work is original, unpublished and is in consonance with the submission guidelines.

KEYWORD BASED ADVERTISEMENT AND TRADEMARK PROTECTION

INTRODUCTION:

AUTHORED BY - NISHANTH GOWDA S

Businesses have moved to the virtual world as a result of technological advancements and people's growing reliance on the internet. Online advertising is one of the most effective forms of advertising in the modern world. The basic goal of internet advertisements is to show the best advertisements to potential clients at the appropriate moment.¹

Advertisers use search engines Bing Ads or Google Adwords, respectively, to buy any keyword that will then trigger their advertisements when a user uses it as a search string which means keywords bidding. If multiple users bid for the same keyword, the highest bidder will have his sponsored advertisements or links appear next to the organic results that the algorithm produced in response to the search string.

TRADEMARK INFRINGEMENT:

Section 29 states that using a mark that is identical to or deceptively similar to one that is registered in respect of goods or services by an individual who is not the registered proprietor constitutes infringement.²

Section 29(6)(d) deals with whether a person uses a registered trademark on business papers or in advertising.³ If the individual knew or had cause to know that the use of the mark would lead to infringement of the said trademark without duly authorized by the proprietor or a licensee, in the course of advertising goods or service, such act would be infringement to the mark holder.⁴

¹ Chiranjeev Gogoi, Trademark Infringement Through Keyword Advertising In India: Issues And Challenges, http://docs.manupatra.in/newsline/articles/Upload/03DB7DF0-4F52-45EA-ABFF-AC5DB67FC9D9.2-C_IPR.pdf

² Section 29 of Trade Marks Act, 1999

³ Section 29(6)(d) of Trade Marks Act, 1999

⁴ Sec 29(7) of Trade Marks Act, 1999

Section 29(8) deals with infringement of mark by way of advertising, if such advertising takes unfair advantage and contrary to industrial or commercial practices; hampers the distinctive character; and against the trademark reputation.⁵

KEYWORD TRADE INFRINGEMENT:

The term "Keyword Trademark Infringement" refers to a situation in which a firm with trademark rights claims that its rights have been violated when the mark is used by other businesses, particularly rivals, as keywords in online searches to promote their own products or services. Customers are misdirected to the wrong websites as a result, and the reputation of the original business may be severely harmed if the latter company so chooses. Hence, the latter business can benefit from the former's goodwill. For example, if someone opens a new NGO and purchases Child Rights as a keyword, the NGO advertisements might show up whenever someone searches for Child Rights and You (CRY). It seems that the advertisers made a wise decision because the popular phrase CRY would receive more views than the keywords for the recently established Organization.⁶

According to the ECJ⁷, to show trademark infringement, four essential requirements must be demonstrated. The infringement must be:

- (i) made in the course of business;
- (ii) made without the mark owner's consent;
- (iii) related to identical or similar goods or services; and
- (iv) affecting the mark's functionality.⁸

In **M/s DRS Logistics Pvt. Ltd and Anr v Google India Pvt. Ltd and Ors**,⁹ the Plaintiff approached the Delhi High Court seeking protection of his trademark "Agarwal Packers & Movers", under which it has been offering transport and logistics services for decades. The plaintiff complained of a number

⁵ Sec 29(8) Trade Marks Act, 1999

⁶ Bhumesh Verma, Keyword Advertisement and IPR Considerations, <https://www.scconline.com/blog/post/2019/06/04/keyword-advertisement-and-ipr-considerations/>

⁷ European Court of Justice

⁸ Google France SARL v. Louis Vuitton Malletier SA, Case C-236/08, order dated 23-3-2010 ECLI:EU:C:2010:159

⁹ CS(COMM) 1/2017

of third parties, largely of its competitors, that use the plaintiff's trademarks as a keyword on the defendants search engines, allowing their competing websites to be displayed as top search results when the plaintiff's trademark is entered into search engine by an unsuspecting consumer. Despite several favorable judgements against specific third-party advertisers, the plaintiff was forced to take action directly against the search engines that were parties to the current lawsuit since the unauthorized use of its trademarks had not stopped. Plaintiff's arguments continued to centre on (i) customer uncertainty regarding the source of the competitor's services and (ii) traffic being diverted from the plaintiff's website to the competitor's or advertiser's website. The main argument put forth by the defendants was that using keywords in such an invisible way did not amount to trademark infringement. This is so that the Trademarks Act of 1999's definition of "use"¹⁰—which does not include using a trademark as a keyword—can be applied.

The High Court held that this type of trademark use is considered invisible trademark infringement and is in line with the definition of Sec 2(2)(b) read with Sec 29(6)(d) and directed the defendants to:

- Investigate all of the plaintiffs' complaints alleging the use of their trademark to divert traffic..
- Examine the entire impact of the advertisement to see if the plaintiff's trademarks are violated..
- And if they find that the use infringes on the plaintiff's trademarks, they will block or remove it.¹¹

In **Amway India Enterprises Pvt Ltd and Ors v IMG Technology Pvt Ltd and Ors**,¹² The Division bench of this court has held that the use of the trademark "Amway" by third-party e-commerce platforms to promote their own sales constitutes a trademark infringement because it is done without the owner's permission. In fact, the court found that Section 29(8) explicitly states that there has been an infringement even in the absence of a sale if any advertising of a mark unfairly benefits from it or undermines its distinctiveness.

¹⁰ Sec 2(2)(b) and (c) of Trade Marks Act, 1999.

¹¹ King Stubb and Kasiva, Invisible Trademark Infringement: India's Standpoint, <https://ksandk.com/ipr/invisible-trademark-infringement-india/>

¹² 260 (2019) DLT 690

Makemytrip India Private Limited vs Booking.com B. V. & Ors.¹³ the petitioner filed this lawsuit to prevent the defendant from using the trademarked word "MakeMyTrip" as a keyword. The petitioner contended that whenever a third party searches for the word "MakeMyTrip" on Google, Booking.com's advertisement used to appear frequently as the first result, which is violative of the petitioner trademark right. However, the defendants argued that restricting the use of the keyword "MakeMyTrip" would violate competition law and the use of general phrases like "make," "my," and "trip" permissible under Sections 34 and 35 of the Act. In a similar vein, the other defendant (Google) contended that it is a widely held belief that using a trademark as a term does not constitute trademark infringement.

The Court observed that any business may bid for keywords that potentially contain any person's trademark under the Google AdWords programme. Later Competitors bid against one another for one another's trademarks in an effort to improve the exposure of their products and services on search engines. Thus the owner is compelled to invest in the Google AdWords Program as a result. The Court relied on "DRS Logistics" expansive interpretation of Section 2(2)(b) read with Section 29(9) (spoken use of word marks can also be infringement), to opine that invisible marks can constitute use, and therefore infringement.¹⁴

CONCLUSION

Due to lack of public awareness, there aren't many of these cases before Indian courts right now, but there will undoubtedly be more of them in the future. In *Consim Info Pvt. Ltd. v. Google India* the court have established a precedent to follow the use keyword advertising and the legal disputes that may result in infringement. The Division bench granted injunction against the defendant company using the word protected under trademark, however, pursuant to TradeMarks Policy between the Google India and the plaintiff, the court opined that there was no requirement of disturbing the arrangement among the parties To protect trademark owners from online infringement, the Indian Judiciary and Indian Legislature still have a ways to go in developing cases and legislation.

¹³ CS(COMM)268/2022

¹⁴ Sangita Sharma, *MakeMyTrip vs Booking.com – Looking at the Delhi High Court Injunction on Usage of Adwords*, <https://spicyip.com/2022/05/makemytrip-vs-booking-com-looking-at-the-delhi-high-court-injunction-on-usage-of-adwords.html>