

\$~17

* **IN THE HIGH COURT OF DELHI AT NEW DELHI**
+ **CS(COMM) 301/2022 & I.As. 7251-53/2022**

HEAD DIGITAL WORKS PRIVATE LIMITED Plaintiff

Through: Mr. Sajan Poovayya, Sr. Advocate
with Mr. Akhil Anand, Mr. Himanshu
Vij, Mr. Adit Vikramaditya Garg, Mr.
Pratibhanu Singh and Ms. Raksha
Agarwal, Advocates.
(M:9910600266)

versus

TICTOK SKILL GAMES PVT LTD Defendant

Through: Mr. Abhishek Malhotra and Ms.
Shilpa Gamnani, Advocates.
(M:8806230299)

CORAM:

JUSTICE PRATHIBA M. SINGH

ORDER

% **10.05.2022**

1. This hearing has been done through hybrid mode.

I.A. 7252/2022 (for exemption)

2. Allowed, subject to all just exceptions. *I.A. 7252/2022* is disposed of.

I.A. 7253/2022 (for additional documents)

3. This is an application seeking leave to file additional documents under the Commercial Courts, Commercial Division and Commercial Appellate Division of High Courts Act, 2015 (*hereinafter*, 'Commercial Courts Act'). The Plaintiff, if it wishes to file additional documents at a later stage, shall do so strictly as per the provisions of the Commercial Courts Act.

4. *I.A. 7253/2022* is disposed of.

CS(COMM) 301/2022 & I.A. 7251/2022(for stay)

5. The present suit seeking permanent and mandatory injunction has been filed by the Plaintiff- Head Digital Works Pvt. Ltd. The Plaintiff is

engaged in the business of designing and developing software related to games of skill, deploying and maintaining an online gaming website and a mobile application via the internet. It operates and provides the said services through its website www.a23.com and its mobile application 'A23'. The present suit has been filed by the Plaintiff to protect its marks 'Ace2three' and 'A23' which are registered as trademarks under various classes. The said marks are registered trademarks of the Plaintiff since 2006 and 2020 respectively. The Plaintiff's marks relate to online gaming platforms operated and controlled by the Plaintiff and are stated to represent India's first ever online rummy platform. The Plaintiff is aggrieved by the use of the marks 'A23' and 'Ace2three' as 'keywords' by the Defendant on the Apple Application Store (*hereinafter 'App Store'*). It is the case of the Plaintiff that in February, 2022 it came to the knowledge of the Plaintiff that the Defendant was using Plaintiff's mark as 'keywords' on the App Store.

6. The submission of Mr. Sajan Poovayya, Id. Senior. counsel appearing for the Plaintiff is that when any user searches for 'A23' or 'Ace2three' on the App Store the first result in the advertisement section of the search result is that of the Defendant's app 'WinZO Games'. The following screenshots are relied upon by Id. Sr. counsel for the Plaintiff:



7. It is, further, submitted by the Id. Senior Counsel that a case has already been filed by the Defendant against the Plaintiff herein being *CS(COMM) 613/2021* titled *Tictok Skill Games Private Limited. v. Head Digital Works Private Limited* in respect of use of the marks 'WinZO', 'WinZO Games' as a meta tag/title tag by the Plaintiff herein. In the said case, the Court has granted an injunction restraining the Plaintiff herein from using the mark/name 'WinZO'/'WinZO Games' or its variants on its website and web advertisements. The Id. Senior Counsel also relies upon the

recent order dated 27th April, 2022 passed by this Court in **CS(COMM) 268/2022 titled MakeMyTrip India Private Limited v. Booking.com B.V.**

8. Ms. Shilpa, Id. Counsel appearing for the Defendant submits that without prejudice to the rights and contentions of the Defendant on merits, the Defendant's stand is that it has not and does not intend to use the Plaintiff's marks 'A23' or 'Ace2three' as an adword, keyword, or metatag.

9. Recently in **MakeMyTrip (supra)**, on the issue of use of trade marks as a keyword on search engines, this Court observed as under:

"31. This Court is of the opinion that the use of the mark 'MakeMyTrip' as a keyword through Google Ads Program by one of its major competitors, Booking.com is infringing use under Sections 2(2)(b), 29(4)(c), 29(6)(d), 29(7) and 29(8)(a) of the Act. It is now well settled in India that use of a registered mark by competitors even as metatags would be infringement, though the same may be invisible to a user as held in DRS Logistics (Supra). The relevant paragraph reads as under:

"86. Having noted the above Judgments, it is clear that the use of the mark as meta-tags was held to be infringement of trademark. It follows, that invisible use of trademark to divert the traffic from proprietors' website to the advertisers' / infringers' website shall amount to use of mark for the purpose of Section 29, which includes Section 29(6) and 29(8), related to advertising."

32. Moreover, there is not much of a difference in the use of a mark in a metatag or a source code of a website which is not visible and in use of a mark as a keyword by Google Ads Program, inasmuch as the mark being used in a hidden manner does not take away the fact that it is, in fact, 'use' of the mark as defined under Section 2(2)(b) of the Act in relation to those very services. Here again, it is

*pertinent to refer to the observations of the ld. Single judge in **DRS Logistics (supra)** who has held as under:*

“90. It is important to note, that had the AdWords Program of Google not existed, the only option available to the infringer / prospective advertiser in order to achieve the same result would have been to change their meta-tags (source coding) which has already been held to be "use" of trademark and as such infringement. This aspect also highlights the fact that the same result is sought to be achieved through different means.””

10. There would, in fact, be no difference in the use of trade marks as a keyword on search engines as opposed to use as a keyword on App store searches. So long as the key words are being used for promoting a business, using a competitor’s trade mark, the same would be violative of the rights of the trade mark owner.

11. Considering the history of litigation between the parties as also the order in *MakeMyTrip (supra)*, the invisible use of the Plaintiff’s mark as an ‘adword’ or ‘keyword’ on any online platforms by the Defendant would be violative of the Plaintiff’s rights in the marks.

12. Since, the Defendant states that it is not using and does not intend to use the said marks as ‘adword’ or ‘keyword’, it is directed that the Defendant shall abide by the said stand and not use the marks ‘A23’ and ‘Ace2three’ or any other variants/formative mark thereof as an adword, keyword, meta tag, or domain name, with or without space on any of the online search engines or application-based search platforms including Apple Application Store etc.

13. Both the parties submit that in view of the suit and countersuit being

pending between them, they wish to explore amicable resolution of disputes.

14. Accordingly, list before the Delhi High Court Mediation and Conciliation Centre (*hereinafter* “*Mediation Centre*”) on 23rd May, 2022 at 2:00 P.M.

15. Parties to appear before the Mediation Centre either virtually or physically, subject to the convenience of all concerned. It shall be ensured that competent officials on behalf of the Plaintiff and the Defendant shall be present in the mediation proceedings.

16. List before Court 22nd August, 2022.

PRATHIBA M. SINGH, J.

MAY 10, 2022

dj/sk