COURT'S ATTRIBUTION ON THE DIFFERENCE BETWEEN MARK AND TRADEMARK

Frankfinn Aviation Services v. Tata Sia Airlines Ltd.

A case analysis

Written and Compiled by
Tishya Singh & Aashima Gautam

Delhi High Court

28th October 2022

Judges: Hon'ble Ms. Justice Jyoti Singh

Facts:

Frankfinn Aviation Services Pvt. Ltd. filed a suit with the Delhi High Court for infringement of its registered trademark 'Fly High'. The petitioner of this case, Frankfinn Aviation Services is a leading educational institute in providing soft skills to students in aviation, hospitality, and customer care. In this case, the petitioner accused Tata Group's Vistara Airlines of using its registered trademark in one of its marketing campaigns under the tagline of 'Fly Higher'.

On 21st January 2022, the Delhi High Court granted an ad interim injunction in favour of the petitioner. Later in the year, Tata group filed an application seeking vacation of the ex-parte ad interim injunction order passed by the Delhi High Court on 21st January, 2022 and decreed its judgment on 28th October, 2022.

Question of Law:

Is there a clear distinction between a 'mark' and a 'trademark'.

Registration of the trademark of Frankfinn Aviation Service's '*Fly High*' can prevent Tata Group's Vistara Airlines from using '*Fly Higher*' in light of its defense that it was not using the term as a trademark and instead as a mark.

Arguments of the Defendant:

- The Defendant operates its airline under a registered trademark and the logo as depicted below with the tagline 'Fly the new feeling'.

- The field of operations of Plaintiff and Defendant are completely different from one another. The Plaintiff provides educational services and the Defendant is in the airline industry.

- The phrase used by the Defendant 'FLY HIGHER' is a commonly used phrase in the airline industry to advertise and promote its services and to describe the success of players in the airline industry.

- The Defendants have no intentions of using 'FLY HIGHER' as a trademark, which Plaintiff claims. No goods or services are provided by the Defendant under the phrase. The phrase is merely used in a conjunction with the Defendant's already well-established trademark.

- That the Plaintiff has failed to prove the distinctiveness of its mark in its field of operation. It is not used as a standalone mark and 'FRANKFINN' is the dominant part of the Plaintiff's label.

- 'FLY HIGH' can be classified as a laudatory term that can be synonymous with 'ambitious', 'to level up' etc. along with its variations like 'FLY HIGHER'. Many airline industries have used a similar version of it as part of their social media posts and advertisement.

- Defendant's advertising campaign is carried out by a third-party agency since 2018 without any commercial arrangements between them. There is also no prima facie evidence that the Plaintiff's mark 'FLY HIGH' is used in any service that is similar to the Plaintiffs.

- Defendant does not offer services in the education or training sector under the phrase 'FLY HIGHER' and its campaign was aimed at enhancing customer experience and highlighting its own profile as India's best Airline.

- The channels of trade and class of customers are separate and distinct. The Plaintiff should substantiate the claim as an act of misrepresentation by the Defendant. Although, the Defendant has not encashed the reputation garnered by the Plaintiff.

Analysis:

The Court in this case noted that the airline was using the tagline "Fly Higher" alongside its well-known logo and trademark Vistara. The Court observed that a "mark" and a "trademark" are separate under the law.

In accordance with well-established legal standards, the Court held that Frankfinn Airlines must demonstrate that it has built up goodwill and a reputation that Vistara is attempting to profit on through misrepresentation in order to prove a claim of passing off. Additionally, a link to Frankfinn's exclusive trademark must be proven, demonstrating the probability of confusion and resulting harm to the Plaintiff's reputation.

According to the Court, Vistara Airlines already has a solid reputation and does not require it in order to run its airlines. The Court also agreed with Vistara's claim that the phrase "FLY HIGH" is demonstrably common in the aviation industry.

This claim was supported by the Master Data of more than 20 registered companies that contain the phrase "FLY HIGH/HIGH FLYER/HIGH FLYERS," which are still operating, and have not had their names removed from the Register of Companies. But more crucially, the Court made it clear that Vistara's services were not identified as coming from a particular source by the phrase "Fly Higher."

"Even if the Plaintiff's mark acquires a secondary meaning and is distinctive in relation to its products, it does not entitle such a person to preclude others from using the expression for the purpose of describing the distinguishing characteristics of their products," the Court ruled. "More importantly, where Defendant uses the expression only in a descriptive sense and not as a trademark."