

THE HIGH COURT OF DELHI AT NEW DELHI

% Judgment Reserved on: 02.11.2010
Judgment Pronounced on: 10.11.2010

+ **CS(OS) No. 1289/2008**

TIMES INTERNET LTD.Plaintiff

- versus -

**M/s BELIZE DOMAIN WHOIS SERVICE LTD. & OTHERS
.....Defendants**

Advocates who appeared in this case:

For the Plaintiff : Mr Abhishek Malhotra, Mr Nitin Bhatia,
Mr K. Datta and Ms Sahana
Baswapatua, Advs.

For the Defendant : None.

CORAM:-

HON'BLE MR JUSTICE V.K. JAIN

1. Whether Reporters of local papers may be allowed to see the judgment? No
2. To be referred to the Reporter or not? No
3. Whether the judgment should be reported in Digest? No

V.K. JAIN, J

1. This is a suit for permanent injunction, damages and delivery of the infringing material. Bennett Coleman & Co. Ltd. entered the field of e-commerce, created a portal named "indatimes.com" and also developed an internet site "http.www.indiatimes.com". The company started offering a wide range of services including internet shopping, online

games, etc. It has been alleged in the plaint that the trademark and logo “Indiatimes” was coined by M/s Bennett Coleman & Co. which runs numerous publications such as Times of India, The Economic Times, Navbharat Times, Delhi Times and Bombay Times. It has also been claimed that in the course of time the website “indiatimes.com” acquired an extensive reputation amongst the people and large number of persons started using its services and purchasing goods through it.

2. The internet business was assigned by M/s Bennett Coleman & Co. to the plaintiff company under an agreement dated 1st April 2000. The plaintiff claims to have incurred huge expenditure on advertisements including development, designing and maintenance cost. It has been alleged that the plaintiff incurred expenditure to the tune of ₹151,314,105/-, ₹260,355,373/- and ₹246,236,506/- in the years 2004-05, 2005-06 and 2006-07, respectively. The logo “indiatimes” is stated to have been written in a unique and distinctive style with a unique layout, colour scheme and arrangement of features and the case of the plaintiff is that for these reasons, this mark constitutes an original artistic work. The plaintiff is the first person to use this

artistic work under Section 2(c) of the Copyright Act and, therefore, is its owner. It has also been alleged that the name/mark “indiatimes” has come to be associated exclusively with the plaintiff company and the mere mention of the word “indiatimes” signifies the services and products marketed by the plaintiff through its e-commerce website. The products marketed by this mark/name are known for the quality, authenticity and best prices/bargains. The trademark “travel.indatimes.com” was also registered in the name of the plaintiff company w.e.f. 7th June 2000. It is also offering extensive travel services and the on clicking “<http://travel.indiatimes.com> “ on the internet, the user is taken to the page “<http://travel.indiatimes.com/ovt/faces/travelIndex.jsp>”, which is the travel services desk of the plaintiff on the internet. The same page can also be accessed by clicking on various links on the home page of “indiatimes.com” and this service is immensely popular, attracting large business. It has also been claimed that in the late year preceding filing of the suit, travel services of the plaintiff generated business of ₹1,335,834,443/-. The plaintiff has also got the name “indiatimes.com” registered as a domain name with Network

solutions Inc, which has also the other domain names registered, w.e.f. 12th November 1996.

3. The plaintiff recently came to know that a domain name “indiatimetravel.com” has been got registered by defendant No.1 giving the address of defendant No.3 as the address for administrative and technical contact. Defendant No.2 is the Registrar of the domain name. On search, it has been found that the aforesaid website is not promoting or transacting in any real travel business or service and this name is merely carrying sponsored links, where clicks on the link earns revenue for the domain owners without offering any service of the real value to the users. Defendant No.1 is thus trying to take advantage of the branding and promotional initiatives of the plaintiff company in relation to the site “indiatimetravel.com”. It has also been claimed that the domain name “indiatimetravel.com” is identical with the registered trademark of defendant No.1 “travel.indiatimes.com” and the web address “http://travel.indiatimes.com” belonging to the plaintiff company and is deceptively similar to the domain name of the plaintiff company “indiatimes.com”. According to the plaintiff, the domain name got registered

by defendant No.1 is virtually a copy of its domain name “indiatimes.com” and in any case is deceptively similar to that name. Any user on the net who comes across a domain name “indiatimetravel.com” is likely to get confused and believe that the said domain name belongs to the plaintiff company. Defendant No.1 thus wants to earn huge money by using the plaintiff’s domain name at the cost of the plaintiff company.

4. The plaintiff has sought an injunction restraining the defendants from using or squatting from the trademark or domain name “indiatimetravel.com” or operating any business or selling, offering for sale, advertising and/or deal in any manner in service or goods using the trademark/domain name “indiatimetravel.com” or any other identical or deceptively similar name. An injunction has also been sought seeking direction for transfer of the domain name “indiatimetravel.com” to the plaintiff. Damages amounting to ₹20Lacs have been also sought by the plaintiff from defendants No.1 and 2. It has also sought delivery up of all materials/documents in their possession bearing the mark/name “indiatimetravel.com” or any other deceptively similar mark.

5. The defendants were proceeded ex parte vide order dated September 25, 2008. The plaintiff has filed affidavit of Sh. Rajeev Dhawan, Authorized Signatory of the plaintiff company, by way of ex parte evidence. In his affidavit, Mr Rajeev Dhawan has supported on oath, the case of setup by the plaintiff company in the plaint, as set out in the preceding paragraphs. He has also tendered documents Ex.P-1 to P-13 in evidence.

6. Ex.P-3 is the agreement executed between Bennett and Coleman Co. and plaintiff company on 1st April 2000. Under this agreement, the portal “indiatimes.com” has been transferred to the plaintiff company, as a going concern, along with all the employees of “indiatimes.com”. Thus, the plaintiff company is now the owner of the portal “indiatimes.com” with all its assets and liabilities.

7. Ex.P-4 is the printout indicating registration of the domain name “indiatimes.com” with Visesh Infotecnics Ltd. in favour of the plaintiff company w.e.f. 22nd November 1996 and the registration of the domain name is valid till 27th November 2016. Printouts Ex.P-5 and Ex.P-6 show that on opening the website “indiatimes.com” the user can access a number of pages, including the pages for shopping. Ex.P-7

is the printout from the web portal of the plaintiff company, which shows that a number of travel related services are being offered by this portal.

8. The printout Ex.P-8 shows that the domain name “indiatimetravel.com” has been registered in the name of defendant No.1 M/s Belize Domain Whois Service Ltd. It also shows that the domain name was created on 21st July 2005 and it expired on 21st July 2008. This printout was taken on 21st May 2008 and indicates the records as updated till 8th January 2007. Ex.P-9 is the printout which shows that the domain name “indiatimetravel.com” was registered by defendant No.2 InterCosmos Media Group, Inc. on 21st July 2005 and the registration was valid up to 21st July 2008. Ex.P-10 is the printout from the website “indiatimetravel.com”, which also shows its registration in the year 2008.

9. Ex.P-12 is the certificate of registration of trademark “travel.indiatimes.com” in the name of the plaintiff company in respect of computer software and hardware, including computer software for searching and retrieving information, sites, and other resources on computer networks, computer software, namely, a directory

of information, sites, and resources available on computer networks, screen savers, computer accessories, mouse pads, pre-recorded videotapes, and sunglasses goods in class 9.

10. In **CS(OS) No.1108/2006**, decided on 29th

October, 2010, this Court, *inter alia*, held as under:

“18. A person is well within his right to sell his goods or render services using any trade name for the purpose. With the passage of time the goods sold or the services rendered by him, as the case may be, may acquire certain reputation or goodwill in the market which becomes the property of that person and needs to be protected by the court. It is not permissible for any other person to start selling goods or rendering services either using the same name or imitating that name so as to cause injury to that person and enrich himself at the cost of the person who had already been using that name and had acquired a certain reputation with the passage of time and on account of the quality of the goods sold or services rendered by him. Any attempt on the part of a person to enrich upon the goodwill generated by any other person needs to be curbed by the court whenever approached by the aggrieved party in this regard.

19. Even if the person using or imitating the trade mark or goodwill of another person is yet to commence his business activities his dishonest intention to make use of the mark and name of the other party will be obvious from the very use or

imitation of the mark and goodwill of the other person and, therefore, it should not be a defence to say that there has so far been no use of the offending corporate name or mark.”

Though the aforesaid observations were made in respect of a registered trade mark, they would equally apply in a case of passing off.

11. In **Cadila Health Care Ltd. vs. Cadila Pharmaceuticals Ltd.** (2001) 5 SCC 573, the Supreme Court, *inter alia*, observed that its decisions in the last four decades had clearly laid down that what had to be seen in the case of a passing off action was the similarity between the competing marks and to determine whether there was likelihood of deception or causing confusion.

12. In **Satyam Infoway Ltd. vs. Sifynet Solutions Pvt. Ltd.** 2004 (28) PTC 566 (SC), the appellant registered several domain names like www.sifynet, www.sifymall.com, www.sifyrealestate.com etc. 'Sify' was a coined word of the appellant which claimed a vital reputation and goodwill in that name. The respondent, at a later date, started carrying on business of internet marketing under the domain names www.siffynet.net and www.siffynet.com and also obtained registration of these two domain names with

Internet Corporation for Assigned Names and Numbers (ICANN). Coming to know of it, the appellant filed a Civil Suit against the respondent claiming that the respondent was passing off its business and services by using the appellants' business name and domain name. The City Civil Court Judge allowed the application of the appellant for grant of injunction, noticing that the appellant was the prior user of the trade name 'Sify' which had earned good reputation in connection with Internet and computer services and that the respondent domain names were similar to the domain name of the appellant and confusion will be caused in the mind of general public by such deceptive similarity. The High Court, however, set aside the order passed by the City Civil Court. Allowing the appeal, the Supreme Court, *inter alia*, observed as under:-

“11. The original role of a domain name was no doubt to provide an address for computers on the internet. But the internet has developed from a mere means of communication to a mode of carrying on commercial activity. With the increase of commercial activity on the internet, a domain name is also used as a business identifier. Therefore, the domain name not only serves as an address for internet communication but also identifies the specific internet site. In the commercial field, each domain name

owner provides information/services which are associated with such domain name. Thus a domain name may pertain to provision of services within the meaning of Section 2(z). A domain name is easy to remember and use, and is chosen as an instrument of commercial enterprise not only because it facilitates the ability of consumers to navigate the Internet to find websites they are looking for, but also at the same time, serves to identify and distinguish the business itself, or its goods or services, and to specify its corresponding online Internet location. Consequently a domain name as an address must, of necessity, be peculiar and unique and where a domain name is used in connection with a business, the value of maintaining an exclusive identity becomes critical. "As more and more commercial enterprises trade or advertise their presence on the web, domain names have become more and more valuable and the potential for dispute is high.

15. The use of the same or similar domain name may lead to a diversion of users which could result from such users mistakenly accessing one domain name instead of another. This may occur in e-commerce with its rapid progress and instant (and theoretically limitless) accessibility to users and potential customers and particularly so in areas of specific overlap. Ordinary consumers/users seeking to locate the functions available under one domain name may be confused if they accidentally arrived at a different but similar website which offers no such services. Such users could well conclude that the first domain name owner had

mis-represented its goods or services through its promotional activities and the first domain owner would thereby lose their custom. It is apparent therefore that a domain name may have all the characteristics of a trademark and could found an action for passing off.

23. As far as India is concerned, there is no legislation which explicitly refers to dispute resolution in connection with domain names. But although the operation of the Trade Marks Act, 1999 itself is not extra territorial and may not allow for adequate protection of domain names, this does not mean that domain names are not to be legally protected to the extent possible under the laws relating to passing off.”

13. The case of the plaintiff is that the mark “Indiatimes” was coined by its predecessor in interest, Bennett Coleman and Company Limited. A perusal of the printout Ex.P-4 shows that this mark was created w.e.f 22nd November, 1996 and its registration as domain name expires on 21st November, 2016. A perusal of the printout Ex.P-9 shows that the domain name “Indiatimestravel.com” was created on 21st July, 2005 and its registration on the domain name was to expire on 21st July, 2008. Thus, not only did the plaintiff create the mark “Indiatimes.com”, it has also been extensively using that mark since much prior to the dated on which the mark

“indiatimetravel.com” was got registered by defendant No.1 as a domain name. The word “indiatimes” is an essential feature of the trademark created and being used by the plaintiff and/or its predecessor Bennett and Coleman and Company since 22nd November, 1996. No one else is entitled in law, to use any mark which adopts and incorporates this essential feature of the mark of the plaintiff. It can hardly be disputed that the words “indiatimes” are an essential component of the domain name “indiatimetravel.com” got registered by defendant No.1 with defendant No.2. Defendant No.1 has not come forward to tell the Court as to what prompted it to use a mark, which includes the words “indiatimes” as its essential component and get it registered as a domain name with defendant No.2. Hence, I see no reason to reject the case of the plaintiff that the domain name “indiatimetravel.com” has been got registered by defendant No.1 and is being used by it only with a view to encash upon the reputation and image built around the mark “indiatimes”, coined by predecessor of the plaintiff. The plaintiff has incurred huge expenditure, as detailed in para 6 of the affidavit of Shri C.V. Dhawan, between 1988-89 to 2006-07, on

development, designing and maintenance of its portal and the products & services being offered through it. There is a strong possibility of the person, seeking to buy a product or a service on the web portal of the plaintiff getting confused on account of similarity of names in the domain name of the plaintiff-company and the domain name adopted by defendant No.1, on account of use of the word “indiatimes” in both the marks and, therefore, clicking on the web portal of defendant No.1 on the assumption and under a bona fide belief that he was clicking on a website of the plaintiff-company. He may also believe that since the word “indiatimes” has been used as an essential component of the web name adopted by defendant No.1, that web name was also somehow associated with the plaintiff-company and consequently he may click on the web portal of defendant No.1, thereby bringing revenues to it, since mere clicking on the web portal of defendant No.1 generates revenue for that company. The use of the web name “indiatimetravel.com” is, therefore, likely to result in confusion in the mind of web user on account of deceptive similarity in the web name “indiatimes” and “indiatimetravel.com” on account of the words “indiatimes”

being an essential feature of both the web names. If the products and services which are advertised on the web portal of defendant No.1 are not as good as the products and services advertised on the web portal of plaintiff-company, considering that the name “indiatimes” has come to be associated with the plaintiff-company on account of its extensive use and the expenses incurred on promoting and building this name, use of the impugned web name by defendant No.1 may also result in lowering the reputation and image of the plaintiff-company amongst the web users. It appears that by using the web name “indiatimestravel.com”, defendant No.1 wants to take undue advantage of the huge expenditure incurred by the plaintiff-company and its predecessor on building and promoting the name “indiatimes”. As noted earlier, defendant No.1 having not chosen not to appear before this Court, there is no escape from the conclusion that the web name got registered by defendant No.1 was got registered by it with an ulterior motive and was not in good faith.

14. When questioned as to how the plaintiff can ensure compliance in case the injunctions, as sought by the plaintiff, is granted to it, the learned counsel for the plaintiff

referred to Uniform Domain Name Dispute Resolution Policy of defendant No.2 which, *inter alia*, provides as under:

“3. **Cancellations, Transfers, and Changes.** We will cancel, transfer or otherwise make changes to domain name registrations under the following circumstances.

- (a) subject to the provisions of paragraphs 8, our receipt of written or appropriate electronic instructions from you or your authorized agent to take such action;
- (b) our receipt of an order from a court or arbitral tribunal, in each case of competent jurisdiction, requiring such action; and /or
- (c) our receipt of a decision of an Administrative Panel requiring such action in any administrative proceeding to which you were a party and which was conducted under this Policy or a later version of this Policy adopted by ICANN. (see paragraph 4(i) and (k) below.)

We may also cancel, transfer or otherwise make changes to a domain name registration in accordance with the terms of your Registration Agreement or other legal requirements.”

15. It is, therefore, difficult to dispute the contention of the plaintiff that the domain name adopted and got registered by defendant No.1 being identical to the coined

trademark of the plaintiff on account of use of the words “indiatimes” in it, it is a clear case of passing off and defendant No.1 is not entitled to continue using the domain name “indiatimetravel.com”. Since the right to use the words “indiatimes” vests only with the plaintiff, defendant No.2 is obliged to transfer the domain name adopted and got registered with it by defendant No.1 to the plaintiff.

16. Though the plaintiff has also claimed damages, no evidence has been led by it to prove any damage to it and no arguments in respect of this relief were advanced on behalf of the plaintiff.

17. For the reasons given in the preceding paragraphs, the suit is hereby decreed to the extent that defendant No.2 is directed to transfer the domain name “indiatimetravel.com” from defendant No1 to the plaintiff-company within four weeks of the copy of this judgment being served upon it. There shall be no order as to costs.

Decree Sheet be prepared accordingly.

(V.K. JAIN)
JUDGE

NOVEMBER 10, 2010

Ag/BG