

(2011) 03 BOM CK 0037

Bombay High Court

Case No: Notice of Motion No. 3432 of 2010 in Suit No. 3073 of 2010

Tata Sky Ltd.

APPELLANT

Vs

Sachin Cody and Others

RESPONDENT

Date of Decision: March 14, 2011

Citation: (2011) 46 PTC 422

Hon'ble Judges: D.Y. Chandrachud, J

Bench: Single Bench

Advocate: Nishad Nadkarni with Mr. Shailendra Bhandare instructed by Legasis Partners, for the Appellant; G.A. Karmalkar instructed by . Mr. G.S. Hegde for Defendant No. 1, for the Respondent

Judgement

Dr. D.Y. Chandrachud, J.

The Plaintiff is a Joint Venture Company between Tata Sons Limited and Sky Broadcasting Group plc. The Plaintiff provides Direct to Home (DTH) services in India through a satellite television service. This service is provided in High Definition (HD) or, as the case may be, DVD quality picture since the commencement of business in 2005. The suit has been instituted before the Court to seek relief against what the Plaintiff perceives as the wrongful conduct of the First Defendant of cyber squatting by registering, trafficking in or using domain names dishonestly with an intent to profit from the goodwill of a well known and famous trademark and by infringement of copyright. The Second Defendant to the suit is a domain name registrar. The Third Defendant is a web hosting agency. The Plaintiff launched services in India in or about 2005 using the trade mark Tata Sky to provide to a television audience in India a wide range of viewing options comprising of entertainment, sports and news in a High Definition/DVD format with CD quality sound. The Plaintiff has an extensive customer service network with a work force of 3000 Engineers together with call centres manned by multi-lingual customer service representatives. The Plaintiff commenced business under the combined mark of Tata Sky of which the mark Tata is used under licence from Tata Sons Limited while

the mark Sky is used under licence from Sky Broadcasting Group plc. The Plaintiff has used brand extensions of Tata Sky combined with a distinctive logo. Sometime after 2008 the Plaintiff launched a new line of activity in a range which has been labelled as Tata Sky Plus. The Plaintiff has also launched a range of products under the mark Tata Sky HD; the letters HD denoting High Definition.

2. The Plaintiff is the proprietor of several domain names including tatasky.com and tataskyplus.com which were registered on 7 July 2005 and 4 August 2008. The Plaintiff uses these domain names in relation to its websites which are utilized for the purpose of the business. The Plaintiff is the owner of the copyright subsisting in the content appearing on its websites which is inter alia in the nature of literary, artistic and photographic work.

3. The sales turnover of the Plaintiff under the Tata Sky marks was Rs. 31 crores for 2006-07, Rs. 259 crores for 2007-08, Rs. 601 crores for 2008-09 and Rs. 980 crores for 2009-10. The Tata Sky marks have been promoted and advertised in the print and electronic media. The Plaintiff therefore claims to have acquired reputation and goodwill in the marks which are associated with the Plaintiff in the trade and the public at large.

4. The First Defendant launched a website using the domain name tataskyplushd.com. This domain name according to the Plaintiff is identical with and similar to the Tata Sky marks and the prior domain names of the Plaintiff. The website of the First Defendant was registered with the Second Defendant as Registrar while the Third Defendant facilitated the registration and hosting of the website. The Plaintiff addressed a cease and desist notice to the First Defendant. The First Defendant declined to accede to the request of the Plaintiff to transfer or surrender the domain name.

5. According to the Plaintiff the registration of the domain name by the First Defendant is a dishonest act for the reason that:

(i) the domain name of the First Defendant is deceptively close to the Plaintiff's domain name and websites;

(ii) the First Defendant has purloined the copyright in the artistic works on the Plaintiff's website which has been substantially reproduced on the website of the First Defendant;

(iii) the First Defendant has used the Tata Sky mark as part of its domain name; and

(iv) the First Defendant has not merely used the Plaintiff's house mark Tata Sky but has also used the brand extensions of the Plaintiff, namely, Plus and HD.

6. The Plaintiff has sought an order of permanent injunction restraining the First Defendant from using the domain name tataskyplushd.com or any other mark resembling the marks of the Plaintiff. A mandatory direction is sought against the

First Defendant to transfer or surrender or to cancel the domain name which has been registered. Relief has been sought against the Second and Third Defendants as well. A Motion for interim relief was taken out.

7. On 7 December 2010 an ad interim order was passed by a learned Single Judge in terms of prayer Clauses (a), (b) and (f) of the Motion, while issuing notice to the First Defendant. Prayer Clause (a) of the Motion seeks an injunction against the First Defendant from using or causing the use of the domain name of the Plaintiff or of the Plaintiff's mark or any mark deceptively similar thereto. Prayer (b) seeks an injunction against the Second Defendant, restraining it from providing domain name registration. Prayer Clause (c) seeks a direction to the First Defendant to transfer the registration of the disputed domain name to the Plaintiff or in the alternative to surrender or to cause the cancellation thereof. By prayers (d) and (e) directions have been sought against the Second and Third Defendants. Prayer (f) seeks an injunction against an infringement of the copyright of the Plaintiff.

8. The material which has been placed on record prima facie indicates that the Plaintiff has a registration in regard to the domain name tataskyplus.com as well as in respect of the name tatasky.com. The Plaintiff has continuously used the mark Tata Sky which is representative of a Joint Venture between the Tata and Star Group of Companies. The Plaintiff has other domain names registered using Tata Sky as a constituent part of the name. The First Defendant obtained registration of the domain name tata sky plus hd. The website of the First Defendant is not merely deceptively similar to the website of the Plaintiff but almost identical in all material respects. The get up, film actor and the overall design bear a striking similarity with the website of the Plaintiff. In these circumstances, there is justification in the grievance of the Plaintiff that the adoption of the domain name tata sky plus hd is an undisguised attempt to tread on the reputation of the Plaintiff which must be injuncted.

9. The Plaintiff however submits that the ad interim relief which was granted on 7 December 2010 would not by itself subserve the interests of justice since a mandatory direction requiring the First Defendant to surrender or transfer the domain name of the Plaintiff or in the alternative to obtain a cancellation from the Registrar is warranted. Though no reply has been filed in response to the Motion by the First Defendant, Learned Counsel appearing on behalf of the First Defendant submitted that interim relief requiring the First Defendant to transfer or surrender the domain name or to have it cancelled should not be granted at the interim stage without an evaluation of the facts and evidence at trial.

10. There is no merit in the defence which has been urged on behalf of the First Defendant. For one thing, on 12 January 2011 an adjournment was granted by the Court to the First Defendant on the request of his Advocate for filing an Affidavit in Reply. None has been filed for well over two months. Moreover, the First Defendant has no plausible or justifiable reason for adopting and registering a domain name

which uses the logo of the Plaintiff -- Tata Sky in combination with the words Plus and HD which represent the services that have been introduced by the Plaintiff as part of its business. Evidently, the First Defendant is carrying on an activity in the nature of cyber squatting.

11. Courts when they deal with matters relating to the infringement or violation of proprietary interests in intellectual property must be conscious of the grave consequences of the use of deceptively similar domain names in cyberspace. The arms of the law must reach out to such cases of wrong doing. Wrong doers are in a sense a step ahead of regulatory enforcement. This only emphasises the need to strike at such violations which have no justification other than to trade on the established reputation of an existing mark. As Rodney Ryder, 2001 Edition 150 in his Guide to Cyber law notes with the emergence of the Internet as an advertising forum, recruiting mechanism and market place for products and services, companies doing business online have a strong desire to acquire domain names that are easy to remember and find an association with their products. The author notes that the natural connection between trademarks and domain names has been exploited by those who have registered the trade marks of others as domain names and then try to sell those domain names back to the trademark owners or third parties at a high profit. The domain name registrant evidently acts in bad faith only with a view to ultimately transfer back the domain name to the owner of the mark. The facts of this case provide no justification whatsoever for the First Defendant to have used a mark which is deceptively similar to that of the Plaintiff, incorporating it as a part of the domain name and utilizing in the process the artistic works of the Plaintiff and the copyright embodied therein.

12. In [Satyam Infoway Ltd. Vs. Sifynet Solutions Pvt. Ltd.](#), the Supreme Court emphasized the importance of domain names and the danger that is exposed by unlawful infraction in the following observations:

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 parrying 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 (Intellectual Property and the Internet -RODNEY D RYDER - Page 96

to 97). 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. Whereas a large number of trademarks containing the same name can comfortably co-exist because they are associated with different products, belong to business in different jurisdictions etc, the distinctive nature of the domain name providing global exclusivity is much sought after. The fact that many consumers searching for a particular site are likely, in the first place, to try and guess its domain name has further enhanced this value. (See Information Technology Law Diane Rowland and Elizabeth Macdonald 2nd Edition P-521)

13. In a judgment of the Delhi High Court in [Pfizer Products Inc. Vs. Mr. Altamash Khan and Another](#), a learned Single Judge issued interim mandatory orders to the Defendant to transfer the domain name to the Plaintiff at the ad interim stage. In an earlier judgment of the Delhi High Court in [Eicher Limited and Another Vs. Web Link India and Another](#), a similar view of the law was adopted.

14. An interim mandatory direction requiring the First Defendant to transfer the domain name to the Plaintiff is warranted. For one thing, a wrongful violation of the proprietary interest of the Plaintiffs has to be dealt with swiftly and effectively. Moreover, the Second Defendant is one amongst many registrars accredited with the registration of domain names. Merely directing the cancellation of domain name will not serve the ends of justice. The hiatus between the cancellation of a domain name and a fresh registration of a domain name by the Plaintiff would be sufficient to allow other violations to take place in the meantime anywhere and at any point of time in cyberspace. The essential nature of cyberspace mandates flexible and efficient judicial remedies. The seamless nature of cyberspace and the ease and flexibility with which a violation can take place should suggest a course of action where other infringers are not left with an opportunity to tread upon and violate the proprietary interest of the Plaintiff in the mark.

15. In the circumstances, the Motion would have to be made absolute. Hence, for the reasons already indicated the Motion is made absolute in terms of prayer Clauses (a) to (f). As regards prayers (c) and (d), it would be necessary to clarify that the Court has granted the principal relief that has been sought of a direction to transfer to the Plaintiff the registration of the domain name tataskyplushd.com. Hence, an alternative relief of the surrender and cancellation of the domain name is not required to be granted.