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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

+ CS(OS) 2606/2008

Judgment pronounced on December 22, 2011

ICICI BANK LTD. Plaintiff

Through: Ms.Safia Said, Advocate.

versus

CHUANDONG XU & ANR. D+ Defendant

Through

CORAM:

HON'BLE MR. JUSTICE G.S.SISTANI

G.S.SISTANI, J.

1. Plaintiff has filed present suit for permanent injunction restraining infringement of trademark, passing off, unfair competition, delivery up, rendition of accounts of profits, damages, etc. against the defendants, seeking to restrain defendants, their agents, representatives and all those acting on its behalf from using or operating in any manner the website 'www.icicigroup.com' / domain name <icicigroup.com>, or any deceptive variant(s) thereof, amounting to infringement of plaintiff's trademark "ICICI".
2. Despite service, none appeared on behalf of the defendants. Accordingly, by order dated 19.01.2010 defendants were proceeded ex parte. Liberty was granted to the plaintiff to file ex parte evidence and the matter was placed before Joint Registrar for marking exhibits on documents.

3. Necessary facts to be noticed for disposal of this suit are that the Plaintiff adopted its trademark/service mark “ICICI” in the year 1955. The Plaintiff’s trademark “ICICI” is an abbreviation of arbitrary words consisting of “Industrial Credit and Investment Corporation of India” and over the years has acquired tremendous reputation and goodwill. The Plaintiff’s trademark registrations date back to the year 1998 and have been exhibited as Ex PW1/2. The Plaintiffs’ domain name <icicibank.com> was registered on 16th July, 1996. The Plaintiff has filed Registration certificates for their Trademark “ICICI” which stands registered in various jurisdictions such as, Hongkong, Japan, Korea, China etc.
4. Plaintiff has filed affidavit by way of evidence of Sh.Sanjay Sharma, the constituted and lawful attorney of the plaintiff. Copy of the power of attorney in favour of Sh.Sanjay Sharma, has been exhibited as Ex.PW-1/1.
5. Sh.Sanjay Sharma, has deposed that the plaintiff is a private sector bank offering a wide range of banking products and financial services to its corporate and retail customers through a variety of delivery channels and through its specialized subsidiaries and affiliates in the areas of investment banking, life and non-life insurance, venture capital and asset management; and plaintiff’s equity shares are listed in India on Bombay Stock Exchange and National Stock Exchange. It is deposed that the Plaintiff’s reputation and goodwill under mark “ICICI” extends beyond India and the same is evident from the presence of the Plaintiff on the New York Stock Exchange (“NYSE”).

6. The witness has deposed that the plaintiff adopted the mark “ICICI”, in respect of its services, in the year 1955 and the first use of the trademark “ICICI” was on 5th January 1955, the date on which the Plaintiff’s predecessor ICICI LIMITED was incorporated. Plaintiff’s predecessors in business, a company under the name “ICICI LIMITED”, formerly known as ‘Industrial Credit and Investment Corporation of India’ was incorporated under the aegis of the Government of India, World Bank and representatives of private Industry on January 5, 1955, as a Public Limited Company, with the primary objective of providing foreign currency loans to industrial projects and to encourage and assist industrial development and investment in India, and which was also designated as a ‘public financial institution’ vide section 4A of the Companies Act, 1956. ICICI LIMITED in the year 1994 established a separate wholly owned banking subsidiary under the name ICICI Banking Corporation Ltd. Later on ICICI Banking Corporation was renamed as “ICICI BANK LIMITED”. In the year 1999, the Plaintiff became the first Indian company and the first bank or financial institution from Non-Japan Asia to be listed on the New York Stock Exchange (NYSE).
7. This witness has also deposed that in the year 2002, the Board of Directors of ICICI and ICICI Bank Limited approved the merger of ICICI Limited and two of its wholly owned retail finance subsidiaries; ICICI Personal Financial Services Limited and ICICI Capital Services Limited with ICICI Bank Limited. After receiving all necessary regulatory approvals, ICICI Limited integrated the

group's financing and banking operations, both wholesale and retail, into a single entity i.e. ICICI BANK LIMITED.

8. This witness has further deposed that the Plaintiff's mark "ICICI" was first adopted and incorporated by the Plaintiff (its predecessors in business) in the year 1955, in respect of not only the services rendered by it, but, also as a part of the Plaintiff's corporate name/trading style/trade name/trademark/service brand. Plaintiff is the registered proprietor of the trademark "ICICI" in India, under various classes. The Legal Proceeding Certificates of the Plaintiffs' trademark "ICICI" registered under various classes in India have been exhibited as **Exhibit PW1/2**, and that the Plaintiff's trademark "ICICI" stands registered in many jurisdictions, such as, Hong Kong, Japan, Korea, Russia, Saudi Arabia, Singapore, Switzerland, China etc. It has also been deposed that copies of the aforesaid registration certificates have been filed along with the plaint. This witness has proved the net profit figures of the plaintiff, which is given below:

ICICI Bank (Standalone)

Fiscal Year	Net Profit (Rs. in bn.)
2009-10	40.25
2008-09	37.58
2007-08	41.58
2006-07	31.10
2005-06	25.40
2004-05	20.05
2003-04	16.37

9. The aforesaid figures are taken from the Annual Reports of the Plaintiff, relevant extracts of which have been filed along with the plaint and exhibited as **EXHIBIT PW1/3**. It is also deposed that the Plaintiff has expended enormous amount of money in its advertisement and publicity. Following is a chart elaborating on the same.

Year	Expenditure on Advertisement and Publicity
2006	Rs. 1,855,514
2007	Rs. 2,177,368
2008	Rs. 2,078,608
2009	Rs. 1,402,840
2010	Rs. 1,108,010

10. The Annual Reports of the Plaintiff, evidencing the same are annexed herewith and marked as **EXHIBIT PW1/4**.
11. It has further been deposed by this witness that currently, ICICI Group, in addition to the subsidiaries of erstwhile ICICI, also comprises of various companies involved in businesses ranging from investment banking, life and non-life insurance, venture capital and asset management; some of which are - ICICI Prudential Life Insurance Company Limited, ICICI Lombard General Insurance Company, ICICI Securities Limited, ICICI Venture Funds Management Company Limited, ICICI International Limited, ICICI Home Finance Company Limited, ICICI Trusteeship Services Limited, ICICI Investment Management Company Limited, ICICI

Bank UK PLC., ICICI Bank Canada, ICICI Bank Eurasia Limited Liability Company, ICICI Prudential Asset Management Company Limited, ICICI Prudential Trust Limited, ICICI Wealth Management Inc. Cumulatively, the subsidiaries of the Plaintiff along with the parent company constitute the entire ICICI group.

12. It has further been deposed that above group companies also use the trademark 'ICICI' by virtue of specific trademark license agreements entered into with the Plaintiff. Plaintiff has invested enormous sums of money in its promotional activities and in the process has created a massive global reputation for its services around the world. Plaintiff not only has a significant presence in India but also across the globe. Plaintiff's trademark "ICICI" has also been extensively advertised in various Indian and foreign publications having a circulation and reach in India and around the world. Copies of Advertisements and Write-ups reflecting the goodwill and reputation of the Plaintiff's mark "ICICI" have already been filed along with the plaint.
13. This witness has further deposed that the Plaintiff is also well known worldwide *inter alia* on account of the nature of its business and the fact that it has a huge clientele from overseas including financial institutions, NRI's etc. and has a corporate presence in 18 countries including subsidiaries in Mauritius, U.K. and Canada. Plaintiff is an extremely well-known company and has been awarded with numerous awards over the years. ICICI Bank was voted as the Best Derivatives House in India at the Asset Triple A investment Awards,

2010; and was also awarded Financial Insights Innovations Award, 2011 and the Best Foreign Exchange Bank and the Best Trade Finance Bank at Annual Finance Asia Country Awards, 2010.

14. It has further been deposed that for promoting, advertising and popularizing its services under the corporate name/trading style/trade name/trademark/service mark “ICICI”, the Plaintiff maintains a formidable presence on the Internet; and that the trademark/trading style “ICICI” features prominently on the Plaintiff’s website www.icicibank.com. The domain name <icicibank.com> was registered by the Plaintiff on 16th July, 1996. The said website, contains extensive information about the services rendered and provided by the Plaintiff under its trademark/trading style/service mark “ICICI”. The website has hundreds of thousands of visits from people looking for information on the Plaintiff’s innumerable and wide spectrum of services. In addition to the above, the Plaintiff also possesses further domain name registrations, a large amount of which involves the Plaintiff’s corporate name/trading style/trade name/trademark/service mark “ICICI”, some of which are <icicilife.org>, <iciciprulife.org>, <iciciprulife.net>, <icicibima.org>, <icicilife.net>, <icicibank.com.sg>, <icicicaps.com>,, <iciciresearchcentre.org>, <icicibankuk.co.uk>, <icici.biz>, <icicibankchina.cn>, <icicibankchina.org.cn>, <icicibankchina.net.cn>, <icicibankchina.com.cn> and so on and so forth. These reflect considerable value that the trademark/trading style/ service mark “ICICI” holds for the Plaintiff, as well as the

extent of care that has been taken in ensuring that no entity other than the Plaintiff makes use of the said trademark/trade name, as a domain name.

15. It has further been deposed that by virtue of extensive publicity and use around the world, the trademark “ICICI” has become a famous/well known trade mark within the purview of a well-known trade mark as defined under Section 2 (1) (zg) of the Trade Marks Act, 1999. The said Act provides protection to well known trademarks, which have become so to a substantial segment of the public in relation to the goods and services offered by them. I further state that, any unauthorized use of such trademark in relation to similar/other goods would likely be taken as indicative of a connection with the Plaintiff’s goods and services. Plaintiff under the trademark “ICICI” has acquired an impeccable reputation and goodwill in India and around the globe. The Plaintiff, by virtue of being the prior adopter and user of the trademark ‘ICICI’ is the rightful and legal owner of the said mark. It is deposed that no entity could have a justification for adopting such a well known mark as its domain name <icicigroup.com> which in all likelihood is to be mistaken as a subsidiary or affiliate or associate of the Plaintiff Company or as a collective representation of the Plaintiff Company and its various subsidiaries and affiliates .
16. This witness has further deposed that an entity desirous of trading or providing its services through the medium of the Internet, invariably uses its existing trademark or service mark as part of its domain

name so as to avoid confusion between what is advertised upon the Internet and the mark as used in the physical world as also due to the fact that the use of the real-world trademark helps serve as the most visible, identifiable and verifiable indicator of existence of the entity upon the Internet. In view of the aforesaid, the Plaintiff's domain name comprising of the mark "ICICI", serves not only as its trademark/service mark on the World Wide Web but further provides an 'online corporate' identity to millions of people and potential customers, thereby serving the function of its trade / service mark upon the Internet. On account of being prior, extensive and continuous user of the mark "ICICI" since the year 1955, it is only the Plaintiff who is entitled to the use of the aforesaid mark in India and around the globe, and no entity other than the Plaintiff has any right or justification to use the same or a deceptively similar mark in respect of its domain name / URL/trademark/service mark/corporate name/trade name.

17. It has also been deposed that Defendant No.1 appears to be an entity operating in China, who has unauthorizedly and illegally registered the domain name <icicigroup.com>. Defendant No.2 is the registrar, with whom the Defendant No.1's domain name <icicigroup.com> has been registered. The information pertaining to the aforesaid domain name registration came to the knowledge of the Plaintiff after it conducted a search at the "WHOIS" database on the Internet. It was then that the Plaintiff came to know that the disputed domain name <icicigroup.com> was not available and the same had been

registered by the Defendant No.1. Plaintiff does not possess information at the present point of time about the exact constitution of the Defendant No.1 entity and deposed that the same will be known only after discovery in the present proceeding. Copy of the printout of the WHOIS database search conducted by the Plaintiff has been filed along with the plaint and is marked and exhibited as **EXHIBIT PW1/5**.

18. It has also been deposed that the Defendant No.1 in the present proceeding has registered the domain name <icicigroup.com>. Defendant No.1 is seeking to capitalize on the goodwill associated with the trademark/service mark/trading style/trade name of the Plaintiff. Defendant No.1 herein is an entity operating in China, where the Plaintiff already is the Registered Proprietor of the trademark “ICICI”, in class 9 with effect from year 2004, by virtue of an Application number 4283290 dated 23rd September, 2004 in the China Patent and Trademark Office. Defendant No.1 is trying to encash upon the goodwill and reputation so associated with the Plaintiff’s trademark and has thus registered in bad faith and without authorization, the domain name in issue <icicigroup.com> which, (i) wholly incorporates the word “ICICI” (ii) is identical to the Plaintiff’s trademark “ICICI”, and (iii) as the Defendant No.1 has no right or justification in the impugned domain name <icicigroup.com>, it is solely intended for the purpose of creating confusion and deception in the minds of the internet users, that the Defendant No.1’s website is connected or affiliated with the

Plaintiff's or that the Defendant No.1 is being endorsed or promoted by the Plaintiff. It is also deposed that the domain name <icicigroup.com> is identical to the corporate name/trading style/trade name/trademark/service mark of the Plaintiff, thereby making confusion and deception inevitable. The Legal Proceeding Certificate of the Plaintiffs' aforesaid trademark "ICICI", filed in China is annexed herewith and may be marked and exhibited as **Exhibit PW1/6**.

19. It has further been deposed that deposed that the URL of the Defendant No.1's 'http://www.icicigroup.com/' is identical and confusingly similar to the trademark forming part of the Plaintiff's URL / website located at www.icicibank.com, and that an Internet user who wishes to visit the Plaintiff's site, namely, www.icicibank.com for information regarding the Plaintiff's services, but not being completely familiar with the exact web address of the Plaintiff's site, can enter into the address toolbar of his Internet browser, the URL "www.icicigroup.com" and therefore be taken to the website of the Defendant No.1 instead. It is also deposed that any person who keys in "ICICI" on any internet search engine would have the search results of the Plaintiff and the Defendant No.1 thrown out resulting in a state of wonderment and confusion in the mind of such person as to whether the Plaintiff's and Defendant No.1's websites are associated, connected or affiliated with each other. It is deposed that the domain names and URLs form part and parcel of the 'online' identity of an entity and serve the

function of its trade / service mark upon the Internet. It is also deposed that the act of the Defendant No.1 in registering a domain name <icicigroup.com>, which is identical and deceptively / or confusingly similar to that of the Plaintiff's domain name and URL, severely infringes the rights of the Plaintiff and is, thus, in contravention of the trademark rights vesting in the Plaintiff in respect of its mark "ICICI". Plaintiff's domain name, located at the URL <http://www.icicibank.com/>, functions as a trademark/service mark not only in the real world but also in the virtual world, and that no entity other than the Plaintiff, therefore, has any right or justification to use the well established trademark "ICICI" or a deceptively similar mark, in respect of or as a part of its domain name / URL.

20. This witness has also deposed that the registration of the domain name <icicigroup.com>, which is subsequent to the date of adoption of the trademark/trade name "ICICI" by the Plaintiff, is clearly in bad faith and reeks of mala fides. Bad faith registration is writ large from the fact that the Defendant No.1 could have no justification for seeking registration of a domain name of which the Plaintiff's trademark "ICICI" is a part. Plaintiff, "ICICI" is a well-known trademark in India and all over the world. It is one of the most written about brands in recent times, which is evident from the voluminous material filed along with the present proceeding. The domain name <icicigroup.com>, registered in the name of the Defendant No.1 is an instrument of fraud and deception, which is

causing considerable damage to the Plaintiff's business interests, apart from prejudicing substantial public interest.

21. This witness has also deposed that the Plaintiff's representative vide email dated 11th December, 2007, had communicated to the Defendant No.1 its intentions to have the domain name <icicigroup.com> transferred in the name of the Plaintiff, as the same wholly incorporates the corporate name/trading style/trade name/trademark/service mark of the Plaintiff. However, the response gathered from the Defendant No.1 vide email dated 10th and 11th of December, 2007, was that only after the payment of an astronomical figure of 800,000 USD, would the Defendant No.1 transfer the disputed domain name <icicigroup.com>, in favor of the Plaintiff. It is also deposed that defendant No.1 has no legitimate right, interest or justification in regard to the domain name <icicigroup.com>, and has only registered the same in order to encash upon the goodwill so amassed by the Plaintiff in the last decades. The email correspondences as exchanged between the Plaintiff and the Defendant No.1 have been filed along with the plaint and the same is exhibited as **Exhibit PW1/7**.
22. This witness has also deposed that the Defendant No.1's unauthorized registration of the domain name <icicigroup.com> has significantly injured the Plaintiffs interests and will continue to do so unless forthwith enjoined. Specifically, the Defendant No.1 (a) has traded upon and threatens to further trade upon the significant and valuable goodwill in the Plaintiff's trademark "ICICI"; (b) has

caused, or is likely to cause, public confusion as to the source, sponsorship or affiliation of its website www.icicigroup.com; (c) has damaged and threatens to further damage the Plaintiff's significant and valuable goodwill in the "ICICI" mark; (d) has injured and threatens to further injure the Plaintiff's right to use its mark "ICICI".

23. It is also deposed that the claim to proprietorship in and to the domain name <icicigroup.com> by the Defendant No.1 is thoroughly dishonest and the use of the same without the consent, authorization or license from the Plaintiff constitutes a brazen act of Infringement and Passing off which entitles Plaintiff to an injunction restraining the said Defendant No.1 from using the domain name <icicigroup.com> and URL 'www.icicigroup.com'. The activities of the Defendant No.1 are likely to cause confusion, deception or persuade Internet users into believing that the registration by the Defendant No.1 of the unauthorized domain name <icicigroup.com> has been effected on behalf of the Plaintiff or is sponsored, licensed or authorized by, or affiliated, connected or otherwise associated with the Plaintiff or its products and services. The registration and use of the domain name <icicigroup.com> by the Defendant No.1 is entirely without due cause in order to take unfair advantage of the reputation and goodwill attached with the Plaintiff's registered trademark "ICICI". This is also deposed that the registration and use of the domain name <icicigroup.com> by the Defendant No.1 is detrimental to the distinctive character and repute of the Plaintiff's

registered trademark “ICICI”. This witness further stated that this Hon’ble Court, after considering the facts and records, relied upon by the Plaintiff, had vide its order dated 18th December, 2008, given an *ad interim exparte* injunction restraining the Defendant No.1 from using/operating the website www.icicigroup.com in an English Language or translated version in an English language and also had restrained the said Defendant from transferring, alienating, or selling the said website to any third party. The Court had also directed the Defendant no.2 to ensure the compliance of its order dated 18th December, 2008.

24. This witness has also deposed that Plaintiff has not at any point of time condoned or acquiesced in the aforementioned unlawful conduct of the Defendant No.1, but has always acted post haste, in redressal of its grievances against the Defendant No.1. It is also deposed that the Plaintiff on 9th June, 2008, had filed a Complaint D2008-0880 against the Defendant No.1 herein, before the WIPO Arbitration and Mediation Center. The sole panelist at WIPO acknowledged the following:

- a.) the Complainant/Plaintiff’s mark “ICICI” is distinctive of the Plaintiff Company,
- b.) the same has been reproduced in its entirety as the Defendant No.1’s disputed domain name <icicigroup.com>,

- c.) the Defendant No.1's domain name <icicigroup.com> is visually and aurally identical or confusingly similar to the Plaintiff's trademark "ICICI", in which the Complainant/Plaintiff possess all rights, and
- d.) in the virtual world there are no territorial boundaries and for a domain name with a ".com" generic top level domain, the users are not confined to only Chinese Internet users and hence, the public at large is likely to be deceived by the Defendant No.1 herein.

25. The Arbitral Tribunal however went on to hold that though the Respondent/Defendant No.1's disputed domain name <icicigroup.com> is identical or confusingly similar to the Complainant/Plaintiff's trademarks in which it has rights, the Respondent/Defendant No.1 is making a legitimate use of the domain name as *"amongst the Chinese Internet users, the term "icicigroup" means a community of like-minded netizens with common interests and the "i" denotes "love" ("爱", phonetic pronunciation is "ai" and is commonly represented by the letter "i") and "cici" can mean a variety of things including pottery (瓷); phrases (词) or here (此), all of which share the phonetic pronunciation "ci". It is plausible that ICICI does not therefore uniquely refer to Complainant and can be used in this manner especially within the Chinese Internet users". Further, "Respondent's website is very different whether in terms of the look-and-feel, the*

contents and the language from Complainant's official website. Respondent's website does not offer any products or services which are related or in competition with Complainant's banking products and services. Respondent's website is also not linked to any other websites in competition with Complainant. There can be no confusion between the two websites. Any initial confusion generated by the visual or aural similarities of the disputed domain name and Complainant's mark is dissipated when one looks at the website of Respondent in comparison with Complainant's website". Hence, the panel found the Respondent/Defendant No.1 to have legitimate rights or interests in the disputed domain name and therefore the complaint was denied. A copy of the aforesaid award passed by the WIPO Arbitration and Mediation Center has been filed along with the plaint.

26. This witness has also deposed that the Plaintiff in compliance of this Hon'ble Court's past orders, has on more than one occasion, served the Defendants with the order of summons, via the process of both email and courier. This witness has further deposed that the proof of the Defendants having been served with the summons of this Hon'ble Court, is the Defendant No.1's email dated 12th January, 2009, addressed to the counsel of the Plaintiff, acknowledging the proceeding initiated against the Defendants before the Hon'ble Court. It is deposed that the Defendant No.1's email dated 12th January, 2009, along with the Counsel of the Plaintiff's affidavit detailing the receipt of the said email have been filed and marked and

exhibited as **Exhibit PW1/8**. Plaintiff's counsel in compliance of the Hon'ble Court's order dated 18th May and 13th October, 2009, had also filed a personal Affidavit along with documents reflecting the proof of service and delivery details of the order of summons via email to the recipients, .i.e. the Defendant No.1 and Defendant No. 2. Plaintiff's Counsel's Affidavit deposing having served the Defendants via email the order of summons along with the complete set of pleadings and the delivery reports as received thereafter have been filed and marked and exhibited as **Exhibit PW1/9**.

9. Counsel for the plaintiff submits that while issuing summons in the suit, this court had restrained defendant no.1 from using/ operating the website www.icicigroup.com in English language or translated version in English language and is also restrained from transferring, alienating or selling the said website to any third party.
10. I have heard counsel for the plaintiff and carefully perused the evidence and documents placed on record. The plaintiff has been able to establish that the trade-mark / service-mark "ICICI" was adopted by the plaintiff in the year 1955 and the plaintiff's trade-mark registrations date back to the year 1998 (Ex PW1/2). Plaintiff has also filed registration certificates for their trade-mark 'ICICI' which stands registered in various jurisdictions, such as, Hongkong, Japan, Korea, China etc. It is contended before this court that the plaintiffs trade-mark 'ICICI' is an abbreviation of arbitrary words consisting of "Industrial Credit and Investment Corporation of India". Based on the evidence and documents on record, the plaintiff

has further established that the plaintiff's trade-mark has over the years acquired tremendous reputation and goodwill. Annual reports (Ex.PW-1/3), advertisement and publicity report (Ex.PW-1/4), right-ups reflecting goodwill and reputation and list of plaintiff's domain names have also been placed on record. The voluminous material placed on record would show that the trade-mark of the plaintiff is extensively and widely used as a service mark in relation to the services in question, and thus, it is highly distinctive and is capable of distinguishing the product of one entity from another. Further by virtue of extensive publicity and use of the mark around the world, the trade-mark ICICI has acquired the significance of a well known mark within the purview of a well known mark as defined in Section 2 (1) (zg) of the Trade Marks Act. In the case of **Satyam Infoway Ltd. vs Sifynet Solutions Pvt. Ltd.** (2004) 28 PTC 566 (SC), the Supreme Court had observed that, *"the appellant's internet based business was, from 1999, high profile. The evident media prominence to 'SIFY' and large subscriber base could have left the respondent in no doubt as to its successful existence prior to the adoption of Siffy as part of its corporate name and registration of Sifynet and Siffy.com as its domain names. It would therefore appear that the justification followed the choice and that the respondent's choice of the word "Siffy" was not original but inspired by the appellant's business name and that the respondent's explanation for its choice of the word "Siffy" as a corporate and domain name is an invented post-rationalisation."* It was further held that *"The doubtful explanation given by the respondent for the choice of the word*

"Siffy" coupled with the reputation of the appellant can rationally lead us to the conclusion that the respondent was seeking to cash in on the appellant's reputation as a provider of service on the internet. In view of our findings albeit prima facie on the dishonest adoption of the appellant's tradename by the respondent, the investments made by the appellant in connection with the trade name, and the public association of the tradename Sify with the appellant, the appellant is entitled to the relief it claims."

11. I am also satisfied that the defendant has infringed the trade-mark of the plaintiff, as the plaintiff is a prior user of the trade-mark. The mark of the plaintiff and the defendant is identical. The Plaintiff is the registered proprietor of the trademark "ICICI" in the territory of India and also in the territory of China in class 9 under registration No. 4283290, dated 23rd September, 2004, exhibited as Exhibit PW1/6. The Defendants, an entity operating in China registered their domain name <icicigroup.com> on 21st September, 2005, exhibited as Exhibit PW1/5. The Defendant's domain name <icicigroup.com> is identical with that of the Plaintiff's trademark "ICICI" and, considering that the Plaintiff attained Trademark registration in the territory of China prior in time to the Defendant's domain name registration, clearly shows the malafides adopted by the Defendant to register in bad faith an identical domain name to create confusion and deception in the minds of the internet users.
12. Reliance has also been placed on **Kaviraj Pandit Durga Dutt Sharma Versus Navaratna Pharmaceuticals Laboratories,**

PTC(SUPPL)(2)680(SC), wherein the Supreme court was of the view that *“In an action for infringement, the Plaintiff must, no doubt, make out that the use of the Defendant’s mark is likely to deceive, but where the similarity between the Plaintiff’s and the Defendant’s mark is so close either visually, phonetically or otherwise and the court reaches that there is an imitation, no further evidence is required.”*

13. I am also satisfied that the Defendants have no legitimate right, interest or justification in regard to the disputed domain name <icicigroup.com> and has registered the same in order to encash on the goodwill of the Plaintiffs. Further based on the communications between the parties and e-mail of defendant no.1 dated 10th and 11th December, 2007 wherein the defendant no.1 has agreed to transfer the disputed domain name on payment of 800,000 USD, that the registration of the defendant of the domain name ‘www.icicigroup.com’ is in bad faith.
14. The plaintiff has also been able to make out a case of passing off. The Defendant No.1’s claim to proprietorship in and to the domain name <icicigroup.com> is thoroughly dishonest and likely to cause confusion, deception or persuade Internet users into believing that the registration by the Defendant No.1 of the unauthorized domain name <icicigroup.com> has been effected on behalf of the Plaintiff or is sponsored, licensed or authorized by, or affiliated, connected or otherwise associated with the Plaintiff or its products and services. The registration and use of the domain name <icicigroup.com> by the Defendant No.1 is entirely without due cause in order to take

unfair advantage of the reputation and goodwill attached with the Plaintiff's registered trademark "ICICI" and therefore constitutes a brazen act of infringement and passing off.

15. In the case of **Yahoo Inc v. Akash Arora, 1999** PTC (19) 201 (Delhi) wherein the Hon'ble Court observed and held that *"The services of the plaintiff under the trademark/domain name 'Yahoo!' have been widely publicised and written about globally. In an Internet service, a particular Internet site could be reached by anyone anywhere in the world who proposes to visit the said Internet site. With the advancement and progress in technology, services rendered in the Internet has also come to be recognized and accepted and are being given protection so as to protect such provider of service from passing off the services rendered by others as that of the Plaintiff. As a matter of fact in a matter where services rendered through the domain name in the Internet, a very alert vigil is necessary and a strict view is to be taken for its easy access and reach by anyone from any corner of the globe. There can be no two opinions that the two marks/domain names 'Yahoo!' of the plaintiff and 'Yahooindia' of the defendant are almost similar except for use of the suffix 'India' in the latter. The degree of the similarity of the marks usually is vitally important and significant in an action for passing off for in such a case there is every possibility and likelihood of confusion and deception being caused. When both the domain names are considered, it is crystal clear that the two names being almost identical or similar in nature, there is every possibility of an Internet user being confused and deceived in believing that both the domain*

names belong to one common source and connection, although the two belong to two different concerns.”

16. Despite service, the defendant has failed to contest this matter. The evidence of the plaintiff has gone unrebutted. Accordingly in the above circumstances interim order dated 18.12.2008 is confirmed and present suit is decreed in favour of the plaintiff and against the defendant in terms of prayers 29 (I), (II), (III) and (V) of the plaint, with costs. Decree sheet be prepared accordingly.

G.S.SISTANI,J

DECEMBER 22, 2011

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