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

+ **CS(OS) 2476/2013**

% *Date of decision : 08<sup>th</sup> September, 2014*

**BHARTI AIRTEL LTD** ..... Plaintiff

Through: Mr.Sudeep Chatterjee and  
Ms.Deepthi Alexander, Advocates

versus

**AIRTELASIA & ORS** ..... Defendant

Through

**CORAM:**

**HON'BLE MR. JUSTICE G.S.SISTANI**

**G.S.SISTANI, J. (ORAL)**

1. Present suit has been filed by the plaintiff for permanent injunction restraining violation and infringement of rights in the Trade Mark/Trade Name/Logo/Label 'AIRTEL', Trade dress, Domain Name, Passing Off and Dilution, Damages/Rendition of Accounts and Delivery up.
2. Summons in the suit and notice in the application were issued on 11.12.2013 and 21.05.2014. Affidavit of service has been filed to show that the Defendants have been served. Despite service, none has chosen to appear on behalf of the Defendants. Accordingly, the Defendants are proceeded ex parte.
3. Counsel for the plaintiff submits that the plaint is duly supported by the affidavit of Mr P L Lamba, Vice President (Legal), the affidavit to be treated as an affidavit by way of evidence. As per the plaint, the Plaintiff Company is one of the biggest telecom companies engaged in a variety of services including cellular phones, broadband and internet services,

satellite, carrier, international services, calling cards, e-business services, etc. Its flagship brand and mark is the AIRTEL mark which is now a globally well-known name and mark. It is also stated in the plaint that the Plaintiff Company was previously incorporated as Bharti Tele-Ventures Limited and thereafter in the year 2006, the name of the company was changed to Bharti Airtel Limited. Copy of the Fresh Certificate of Incorporation consequent upon change of name has been filed along with the plaint.

4. It has been averred in the plaint that the Plaintiff Company is the fourth largest mobile operator in the world in terms of subscriber base and is one of the leading private sector providers of telecommunication services having an aggregate of over 269 million customers as on March 31, 2013, consisting of GSM mobile and broadband & telephone customers with operations in 20 countries across Asia and Africa.
5. It has next been averred in the plaint that the Plaintiff Company in the year 2009 had also launched an international call back services under the brand AIRTEL WORLD SIM which allowed users to receive incoming calls on their India Airtel number and save up to 85% and further users can easily make outgoing calls across the world and in the country they are in at a fraction of international calling rates and it can be used across more than 150 countries.
6. Plaint also discloses that the word “**AIRTEL**” has been inseparable and essential part of the Plaintiff Company and from the date of inception to as on date, the said mark has been used uninterruptedly and continuously, by the Plaintiff Company and has come to be exclusively associated with the Plaintiff Company alone.
7. It has been averred in the plaint that in the year 1994 the Plaintiff Company conceived, invented, coined and adopted the distinctive mark

AIRTEL as its trademark for its goods as well as services. It has further been averred that the word AIRTEL is not used in common language and does not find any place in any dictionary. It is a coined word and is therefore, entitled to a very high degree of protection.

8. It has next been averred in the plaint that the Plaintiff Company is the registered owner, user and proprietor of the trade mark **AIRTEL** in India as well as in several countries abroad and renders telecommunication and other services under this brand/mark/logo. Further the Plaintiff Company had introduced a new logo in September 2010 marking the Plaintiff Company's 200 million customer milestone. Copies of the trademark registration certificates for the mark AIRTEL and/or its derivatives that stands registered in India in favour of the Plaintiff Company and the trademark 'AIRTEL' registrations internationally have been filed along with the plaint. It is stated in the plaint that the plaintiff Company has also filed the trademark applications in India which are pending registrations and copies of the pending applications have also been filed along with the plaint.
9. It has also been averred in the plaint that the mark/brand name/logo "AIRTEL" form an extremely important and prominent part of the identity of the Plaintiff Company as well as its Group Companies as the mark/name/logo "AIRTEL" is not only used for their trading style but the said word forms an inalienable part of the Group's identification itself.
10. It has next been averred in the plaint that the Plaintiff Company is also the owner of various **AIRTEL** domain names including airtel.com, airtel.in, airteldigitaldish.com, airtelmoney.com, airtelmoney.net, airtelmoney.org, airtelmoney.in, airtelworld.in, airtelworld.com, airtelindia.com, airtel.co.in, airtellive.com, airtel-broadband.com, airtel.in, airtel3.com, airtelthree.com, airtelthree.in, airtellive.in, airtel-broadband.com, airtel-

boradband.in, airtelenterprise.in, airtelindia.in,  
airtellingdistance.in,airtellingdistance.com, airteltelephone.com,  
airteltelephone.in. Printouts of some of the domains have been filed along  
with the plaint.

11. Further as per the plaint, the Plaintiff Company widely publicizes and advertises its products/services in print as well as electronic media all over the country and the sales and marketing expenditure runs into millions of dollars every year. Sample copies of the media coverage/press clippings, publicity material for the mark AIRTEL in the print media have been filed along with the plaint.
12. It has also been averred in the plaint that by virtue of extensive use and vast publicity under the trade mark “AIRTEL”, the Plaintiff Company enjoys exclusive proprietary rights therein and members of the trade and relevant purchasing public identify and associate the said trademark with Plaintiff’s Company products and business alone.
13. It has further been averred in the plaint that by virtue of long and continuous use, the Plaintiff Company’s mark/brand/logo “**AIRTEL**” have acquired the status of a well known mark within the meaning of section 2 (zg), 11(6), 11(7), 11(8) and 11(9) of the Trade Marks Act, 1999 in as much as a mere mention of the word “**AIRTEL**” in relation to various goods and services being offered under it directly gets related to the Plaintiff Company and has been duly protected by various judicial courts.
14. Further, as per the plaint, the mark is inherently distinctive and through extensive use, marketing and advertising of the said trademark by the Plaintiff Company all over India as well as abroad and due to protection by Courts etc., the said mark has become a “WELL KNOWN

TRADEMARK” and the adoption of the same by any third party necessarily causes confusion in the minds of the public.

15. It has also been averred in the plaint that the rights of the Plaintiff Company in the mark/brand/logo “AIRTEL” as such have been recognized by courts/ tribunals not only in India but also in different jurisdictions including WIPO. Copies of orders in favour of plaintiff in multiple judicial proceedings have been filed along with the plaint.
16. It has further been averred in the plaint that the Defendant No.1 appears to be engaged in providing services relating to telecommunication services including mobile international calling cards as per its website and is also the registrant of the domain [www.airtelasia.com](http://www.airtelasia.com). The Defendant No.2 is the registrar of the domain name [www.airtelasia.com](http://www.airtelasia.com) and the Defendant No.3 is the registration service provider of the domain name [www.airtelasia.com](http://www.airtelasia.com).
17. It has next been averred that the Defendant No.1 who is providing international calling card services has not only copied the registered and well-known mark of the Plaintiff Company but has also copied the entire concept of the Plaintiff Company in its calling card services. Further it has been averred that the Defendant No.1 is using the domain name [www.airtelasia.com](http://www.airtelasia.com). The Defendant no.2 herein is operating under the ICANN and all registrants of the domain names facilitated by this Registrar are bound by the Uniform Domain Names Disputes Resolution Policy (UDRP).
18. Plaint also discloses that the Defendant No.1 has copied all the essential elements of the Plaintiff Company’s mark, writing style, get-up, thereby violating with impunity the rights of the Plaintiff Company. It has been averred that the Defendant No.1 has copied the entire registered and well-known mark AIRTEL of the Plaintiff Company and has merely added a

suffix ASIA to deceive the customers and innocent people. The representations of both the marks is given below which clearly establishes the fraudulent conduct and malafide of the Defendants:

| PLAINTIFF COMPANY'S LOGO                                                          | DEFENDANT NO.1 LOGO                                                                |
|-----------------------------------------------------------------------------------|------------------------------------------------------------------------------------|
|  |  |

19. It has also been averred in the plaint that the comparative look at the two marks would reveal that the Defendant’s mark is a slavish imitation of the Plaintiff Company’s mark which is so blatant that it is a case of *res ipsa loquitur*. Further it has been averred that on a first look, most consumers believe the Defendant No.1’s services to be the Plaintiff Company’s services and due to the similarities, it is possible that any consumer, globally, can presume that the services originate from the Plaintiff Company, especially the telecommunication industry. It has next been averred that the Plaintiff Company’s global reputation in telecommunication and mobile services which is associated with the mark/name AIRTEL is likely to be misused by the Defendant No.1 and owing to the nature of the services, class of customers, adoption of a similar mark with an identical get-up, etc. is bound to create confusion and deception in the market thereby amounting to passing off.
20. Further as per the plaint, the Defendant No.1 is using the mark AIRTEL in relation to telecommunication/ mobile services including international calling cards and a perusal of the Defendants’ website

[www.airtelasia.com](http://www.airtelasia.com) shows that the Defendants are not merely offering telecommunication services in the form of calling cards etc., but are also making available downloadable applications to be used on phones etc., for making calls. It has also been averred in the plaint that the credentials of the defendant's business are extremely suspicious and do not inspire confidence and the entire business is based on riding piggy-back upon the reputation and fame of the plaintiff's mark AIRTEL which is a globally renowned mark.

21. It has next been averred that the use of the mark AIRTEL by the Defendants is in complete violation of the Plaintiff Company's right protected under statute and under common law as the Plaintiff Company has a global reputation to protect and the mark AIRTEL/ AIRTELASIA if permitted to be used indiscriminately would be completely diluted. It has also been averred that the mark AIRTEL enjoys enormous goodwill and equity especially in the telecommunication industry including mobile services and are the market leaders in this segment and the Defendant No.1 has chosen to use the mark AIRTEL/ AIRTELASIA with a view to encash upon the goodwill and reputation of the Plaintiff Company. The dishonesty is further established from the fact that the Defendant No.1 has in fact started using "AIRTEL" *per se* as is evident from their domain name registration for their website [www.airtelasia.com](http://www.airtelasia.com).
22. It has also been averred in the plaint that the customers are familiar with the plaintiff Company's services owing to the extensive advertisement in the electronic media, therefore, the attempt by any other service providers to adopt identical mark and concept of the Plaintiff Company but not containing the high quality is likely to lead to tarnishment of the image of the Plaintiff Company leading to severe dilution of the Plaintiff Company's marks and services.

23. It has further been averred in the plaint that upon seeing the defendant No.1's mark, the first impression of visual impact is that of the plaintiffs mark and even if one was to ignore the above mentioned similarity, the overall similarity between the two marks is so close that the consumers would be lead to believe that the defendant No.1 is another division of the plaintiff Company.
24. It has next been averred in the plaint that the registration of domain containing the mark "AIRTEL" by the defendant No.1 violates the common law as well as statutory rights of the plaintiff Company and on a bare perusal of the impugned website confusion is inevitable as to their origin because the domain name used by the defendant No.1 is identical to the marks of the plaintiff Company. It has also been averred that the malafide intentions of defendant No. 1 is evident from its act of getting the domain names registered with the plaintiff Company's registered and well-known mark which clearly establishes that the defendant got the impugned domain names registered keeping in mind the reputation of the Plaintiff Company in an attempt to confuse the general public at large into believing that it is connected with the plaintiff company in some manner.
25. It has also been stated in the plaint that except the plaintiff company, no third party can either create or alienate/transfer any sort of right in the mark "AIRTEL" and since defendant No. 1 has no rights in the said marks, it cannot be allowed to use or create any domain name or other mark or name or trading style containing the mark "AIRTEL". It has further been averred that the registration of the domain name [www.airtelasia.com](http://www.airtelasia.com) is completely dishonest, illegal and malafide with a view to make monetary gain out of the plaintiff company's brand as the brand AIRTEL is the most well recognized brands in India and also in other countries.

26. Further as per the plaint, the dishonesty and the misuse on part of Defendant No.1 is irrefutably established from the following factors:

- Registration of the domain name with the said mark AIRTEL without having any connection with any of the Plaintiff Company;
- The domain name being identical or confusingly similar to the trade marks in which the Plaintiff Company has rights;
- The said Defendant No.1 having no proprietary or contractual rights in any registered or common law trademark corresponding in whole or in part to the disputed domain name.
- Using an identical logo;

27. It has also been averred in the plaint that the illegality in the registration of the disputed domain name arises from the fact that domain names today are a part and parcel of corporate identity and acts as the address of the company on the internet and can be termed as a web address or a web mark just like a trade mark or service mark. It has next been averred that the mere act of registration by Defendant No. 1 of the disputed domain names containing the mark AIRTEL in its entirety constitutes passing off and violation of the Plaintiff Company's statutory right in the registered trademarks and the Defendant No.1's conduct results in an Infringement of the Trademark rights in the registered trade mark/ logo AIRTEL, Infringement of Copyright in the AIRTEL writing style and acts of unfair competition, passing off and dilution.

28. I have heard counsel for the plaintiff and perused the documents placed on record along with plaint duly supported by the affidavit. Trade mark registration certificates of the trade mark "AIRTEL" and/or its derivatives in favor of the plaintiff have been filed along with the plaint and list

showing worldwide registration of trade mark “AIRTEL” has also been filed. Plaintiff has proved that the plaintiff company is the owner of various **AIRTEL** domain names, the list of which has also been filed along with the plaint. Plaintiff has also relied upon various orders passed in their favour proving that the rights of the Plaintiff Company in the mark/brand/logo “**AIRTEL**” have been recognized by courts/ tribunals not only in India but also in different jurisdictions including WIPO. Furthermore, plaintiff has relied upon the copies of various press clippings and advertisements which have been filed along with the plaint to prove the vast scale on which plaintiff has advertised their brand over a period of years and enormous expenditure incurred by the plaintiff in advertising/promoting its brand.

29. On the basis of the documents placed on record, the plaintiff has been able to establish that the Plaintiff Company is one of the biggest telecom companies engaged in a variety of services including cellular phones, broadband and internet services, satellite, carrier, international services, calling cards, e-business services, etc and is the market leader in the telecommunication segment having unique trade dress, get-up, colour combination etc. Plaintiff has also been able to establish that the Plaintiff Company in the year 1994 conceived, invented, coined and adopted the distinctive mark **AIRTEL** as its trademark for its goods as well as services and is the registered owner, prior user and proprietor of the trademark/brand/logo “**AIRTEL**” in India as well as in several countries abroad. Further, the plaintiff has also established that the Plaintiff Company is the owner of the artistic work in the **AIRTEL**. The said mark is the original artistic work with unique colour combination, style and get-up and writing style is distinctive which is an original artistic work under Section 2(c) of Copyright Act, 1956 and is entitled to the

highest degree of protection and all rights in the logo belong to the Plaintiff Company. Plaintiff has further been able to establish that the Plaintiff Company widely publicizes and advertises its products/services in print as well as electronic media all over the country and the sales and marketing expenditure runs into millions of dollars every year due to which the Plaintiff Company's mark/brand/logo "AIRTEL" have acquired the status of a well known mark within the meaning of section 2 (zg), 11(6), 11(7), 11(8) and 11(9) of the Trade Marks Act, 1999.

30. In the case of *Tata Sons Ltd v Manoj Dodia and Ors*, reported at 2011(46)PTC244(Del), following observations were made by another bench of this court with respect to the factors that ought to be looked into while considering what constitutes a "well known mark":

"13. Trademarks Act, 1999 does not specify the factors which the Court needs to consider while determining whether a mark is a well known mark or not, though it does contain factors which the Registrar has to consider whether a trademark is a well known mark or not. In determining whether a trademark is a well known mark or not, the Court needs to consider a number of factors including (i) the extent of knowledge of the mark to, and its recognition by the relevant public; (ii) the duration of the use of the mark; (iii) the extent of the products and services in relation to which the mark is being used; (iv) the method, frequency, extent and duration of advertising and promotion of the mark; (v) the geographical extent of the trading area in which the mark is used; (vi) the state of registration of the mark; (vii) the volume of business of the goods or services sold under that mark; (viii) the nature and extent of the use of same or similar mark by other parties; (ix) the extent to which the rights claimed in the mark have been successfully enforced, particularly before the Courts of law and trademark registry and (x) actual or potential number of persons consuming goods or availing services being sold under that brand." In

my view the mark of the plaintiff satisfies all the necessary ingredients for falling in the category of a well known mark.

30. In the case of *Evergreen Sweet House vs. Ever Green and Ors. Reported at 2008 (38) PTC 325 (Del)*, it was observed as under:

15. A mark is said to be deceptively similar to another (Section 2(1) (h), Trademarks Act, 1999) if it so nearly resembles that other mark as to be likely to deceive or cause confusion. Section 29(1) deals with a situation where the Defendant uses a mark, which is identical or deceptively similar to that of the Plaintiff, in respect of the same goods or services, and in such a manner that it is likely that such use is taken as being an use as a trademark. This amounts to infringement. To fall within section 29(1), the defendant's use of the mark must be so that it is likely that the public assumes that the said mark is used as a trademark. Section 29(2) deals with three situations; one where the defendants mark is identical to that of the plaintiff and in respect of similar goods. Two, where the, marks are similar and in respect of goods which are identical or similar. Three, the marks as well as the goods are identical. Infringement does not take place if only one of the three ingredients are satisfied; the plaintiff has to prove that use by the defendant is likely to cause confusion on the part of the public or is likely to have an association with the registered mark."

31. *In Laxmikant V Patel vs Chetanbhai and Anr*, reported at AIR 2002 SC 275, Lordships of Supreme Court have held that a competitor initiating sale of goods or services in the same name or by imitating the name results in injury to the business of one who has the property in that name. The law does not permit any one to carry on his business in such a way as would persuade the customers or clients in believing that the goods or services belonging to someone else are his or are associated therewith. It does not matter whether the latter person does so fraudulently or otherwise. The reasons are two. Firstly, honesty and fair play are, and

ought to be, the basic policies in the world of business. Secondly, when a person adopts or intends to adopt a name in connection with his business or services which already belongs to someone else it results in confusion and has propensity of diverting the customers and clients of someone else to himself and thereby resulting in injury.

32. Having regard to the documents placed on record, I am of the view that the Defendants, who are engaged in the same line of business as the plaintiff i.e. mobile services including international calling cards are carrying on their business under the impugned name “**AIRTELASIA**” which is identical and deceptively similar to the plaintiff’s trade name/mark “**AIRTEL**”. Further, the Defendants are well aware of the reputation of the Plaintiff Company and have chosen to use the mark **AIRTEL/ AIRTELASIA** with a view to encash upon the goodwill and reputation of the Plaintiff Company. Also Defendants by using an identical mark by adding ASIA to it has blatantly copied all the substantial features of the Plaintiff Company’s mark AIRTEL including writing style, colour scheme, font, style, get-up, etc which amounts to infringement of the Plaintiff Company’s proprietary rights under Section 29(1) of the Trade Marks Act, 1999. Thus, the launch of identical/ look-alike service in an identical/similar substantial imitating mark, identical get-up, lay-out and colour combination, identical/similar writing styles by Defendants is a clear case of passing off and complete dilution of the brand equity which the Plaintiff Company’s mark enjoys. Furthermore, adoption of domain name [www.airtelasia.com](http://www.airtelasia.com) by the defendants is completely malafide, dishonest and illegal. The domain name adopted by the defendants, by virtue of being so deceptively similar to that of the plaintiff, is bound to create confusion in the minds of public with respect

to its origin and any average internet user would presume that the defendants are carrying on their business in association with the plaintiff.

33. For the reasons stated above, the plaintiff has made out a case for grant of decree as prayed in the plaint. Accordingly, the order dated 08.09.2014 is confirmed and the suit is decreed in favour of the plaintiff and against the defendant no.1. The domain name shall be transferred on receipt of copy of the judgment by defendant no.2. Decree sheet be drawn up accordingly

**G.S.SISTANI, J**

**SEPTEMBER 08, 2014**

**ssn**