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C.S. No.335 of 2020

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED : 19.02.2024

CORAM

THE HON'BLE MR. JUSTICE ABDUL QUDDHOSE

C.S. No.335 of 2020

M/s.Kalyan Jewellers India Ltd.,
rep. by its Business Head and
Authorised Signatory
Sujumon K.

.. Plaintiff

Vs

1.Antony Adams

2.Subha Bharat

3.PDR Limited

4.Synergy Wholesale PTY Limited

.. Defendants

(fourth defendant impleaded as per order
dated 07.10.2021 in A.No.2755 of 2021)

Prayer: Civil Suit filed under Sections 27, 28, 29, 134 & 135 of the Trademarks Act, 1999 read with Order IV Rule 1 of High Court Original Side Rules and Order VII Rule 1 of CPC read with Section 2(1)(C)XVII read with 1st Proviso of Section 7 of the Commercial Courts, Commercial Division and Commercial Appellate Division of High Courts Act 2015 prays for judgment and decree:

a)For Permanent Injunction restraining the 1st and 2nd Defendants by themselves, their partners, men, servants, agents, representative, franchisees,



licensees and or all other person acting on their behalf from in any manner infringing or enabling other to infringe Plaintiff's trademarks "Kalyan" and "Kalyanjewellers" by using the domain name <kalyanjewellers.com> or any other similar, identical domain name or phonetic variant of the domain name;

b)For Permanent injunction restraining the 1st and 2nd Defendants by themselves, their partners, men, servants, agents, representative, franchisees, licensees and or all other person acting on their behalf from in any manner passing off or enabling other to pass off the goods of the 1st and 2nd Defendant using the domain name <kalyanjewellers.com> or any other similar, identical domain name or phonetic variant of the domain name;

c)Grant a Mandatory injunction directing the Defendant No.3 and Defendant No.4 (amended as per order dated 07.10.2021 in A.No.2756 of 2021) to cancel the domain name registration for <kalyanjewellers.com> in favour of Defendant Nos.1 and 2;

cc)Grant a permanent injunction restraining the defendant No.4 by themselves, their partner, men, servants, agents, representative, franchisees, licensees and or all other person acting on their behalf in any manner from transferring the domain name <kalyanjewellers.com> or any other similar, identical domain name or phonetic variant of the domain name;
(amended as per order dated 07.10.2021 in A.No.2756 of 2021)

d)Directing the defendants to transfer the domain name <kalyanjewellers.com> to the plaintiff;

e)for the costs of the suit.



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C.S. No.335 of 2018

For Plaintiff : Ms.Mithreyi Kasthurirangan for
Mr.K.Harishankar

For Defendants : Set Exparte

JUDGMENT

This suit has been filed seeking for the following reliefs:

a)For permanent injunction restraining the defendants 1 and 2 by themselves, their partners, men, servants, agents, representative, franchisees, licensees and or all other person acting on their behalf from in any manner infringing or enabling other to infringe plaintiff's trademarks "Kalyan" and "Kalyanjewellers" by using the domain name <kalyanjewellers.com> or any other similar, identical domain name or phonetic variant of the domain name;

b)For permanent injunction restraining the defendants 1 and 2 by themselves, their partners, men, servants, agents, representative, franchisees, licensees and or all other person acting on their behalf from in any manner passing off or enabling other to pass off the goods of the defendants 1 and 2 using the domain name <kalyanjewellers.com> or any other similar, identical domain name or phonetic variant of the domain name;



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c)Grant a mandatory injunction directing the defendants 3 and 4 to cancel the domain name registration for <kalyanjewellers.com> in favour of the defendants 1 and 2;

d)Grant a permanent injunction restraining the fourth defendant by themselves, their partner, men, servants, agents, representative, franchisees, licensees and or all other person acting on their behalf in any manner from transferring the domain name <kalyanjewellers.com> or any other similar, identical domain name or phonetic variant of the domain name;

e)Directing the defendants to transfer the domain name <kalyanjewellers.com> to the plaintiff;

f)for the costs of the suit.

2.The plaintiff states that they are in retail jewellery business since 1993. The plaintiff claims that they have 144 showrooms spread across India, UAE, Qatar and Oman and they have been spending huge amount of money for promoting their products and services. The plaintiff claims that they also advertise their products and services under various trademarks, such as "Kalyan" and "Kalyan Jewellers". According to the plaintiff, they have engaged several Indian celebrities and Brand Ambassadors for



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promoting their products under the trademarks, such as "Kalyan" and "Kalyan Jewellers" and they have approximately spent Rs.15 million since the year 2014 till the date of filing of the suit for promoting their brand "Kalyan" and "Kalyan Jewellers". According to the plaintiff, they have obtained trademark registration in respect of their trademark "Kalyan" and "Kalyan Jewellers" under Classes 14, 16 & 35 in India and several foreign countries, including Singapore, UAE, Saudi Arabia, Qatar, Oman, Kuwait and Bahrain. The plaintiff claims that they own various domain names, containing the word "Kalyan" and "Kalyan Jewellers", which they use to identify their various businesses.

3. According to the plaintiff, in the year 2018, they came to know that a domain name <Kalyanjewellers.com> has been registered by the first and second defendants, who had no connection with the plaintiff's trademarks "Kalyan" and "Kalyan Jewellers". According to the plaintiff, the first defendant had registered the said domain name in the year 2004 with 'Net4India' and in the year 2010, the first defendant transferred the registration of the domain name to the third defendant. According to the plaintiff, after filing of the suit, they came to know that the domain name



registration has been transferred to the fourth defendant and therefore, the fourth defendant was impleaded as a party defendant to the suit on 07.10.2021.

4. According to the plaintiff, after coming to know the registration of the domain name using the plaintiff's trademarks "Kalyan" and "Kalyan Jewellers", the plaintiff initiated proceedings before the World Intellectual Property Organization (WIPO) Arbitration and Mediation Centre in case No.D2020-1615 in accordance with Uniform Domain Name Dispute Resolution Policy (UNDRP). According to the plaintiff, the WIPO essentially deals with cases of 'cybersquatting', where persons block domain names unconnected with their business and later profit on their sale when the real businesses approach them.

5. By Order dated 27.08.2020, an Administrative Panel Decision was issued by WIPO and the scope of enquiry before WIPO as seen from the said decision dated 27.08.2020 is as follows:

a) The disputed domain name is identical or confusingly similar to a trademark or service mark in which complainant has rights;



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- b)The respondent has no rights or legitimate interests in respect of the disputed domain name; and
- c)The disputed domain name has been registered and is being used in bad faith.

6.According to the plaintiff, as seen from the findings of the WIPO dated 27.08.2020 in the dispute raised by the plaintiff, WIPO has held in favour of the plaintiff with regard to the issues 1 and 2 since the said issues of disputed domain name are being identical and legitimate interests. With regard to the third issue of use in "bad faith" is concerned, WIPO has directed the plaintiff to approach the competent forum. Only under those circumstances, the plaintiff has been constrained to file this suit.

7.The defendants have been set exparte in this suit. Till date, no application has been filed by any of them seeking to set aside the exparte order. Since the defendants were set exparte in this suit, an exparte evidence was let in by the plaintiff before the learned Additional Master IV. The plaintiff's Authorised Representative Mr.Sujumon was examined as a witness (PW1) on their side. He has filed a proof affidavit reiterating the



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contents of the plaint and he sought for a judgment and decree in favour of the plaintiff as prayed for in the plaint. After recording evidence, the suit has been posted before this Court. Before the learned Additional Master IV, the following documents were marked as Exs.P1 to P12 on the side of the plaintiff through PW1:

Ex. P1 is the original authorization letter dated 31.10.2020.

Ex.P2 is the photocopy of the registration certificate of the trademarks "Kalyan" and "Kalyan jewellers" dated 22.06.1994.

Ex.P3 is the photocopy of the plaintiff's incorporation certificate dated 15.06.2016.

Ex.P4 is the printout of the e-mail conversations with the first defendant calling him to settle the dispute dated 12.11.2017.

Ex.P5 is the photocopy of the auditors certificate setting out promotional expenditure made by the plaintiff dated 22.02.2020.

Ex.P6 is the printout of the screen shots of the social media pages operated by the plaintiff dated 11.03.2020.

Ex.P7 is the photocopy of the complaint and response filed by the plaintiff and 1st and 2nd defendants before the WIPO Arbitration and Mediation Centre dated 24.06.2020.



Ex.P8 is the photocopy of the Administrative Panel Decision in WIPO proceedings dated 27.08.2020.

Ex.P9 is the printout of the screen shots of the plaintiff's website dated 10.11.2020.

Ex.P10 is the photocopy of the WHOIS search report for the domain name <kalyanjewellers.com> dated 10.11.2020.

Ex.P11 is the printout of the screen shots of Google search with the keyword "kalyanjewellers.com" dated 10.11.2020.

Ex.P12 is the printout of the screen shots of the 2nd defendant's website kalyanjewellers.com dated 10.11.2020.

8.As seen from the aforementioned documents, more particularly, Ex.P8, World Intellectual Property Organization, i.e., WIPO, decision dated 27.08.2020, which essentially deals with cases of 'cybersquatting', where persons block domain names unconnected with their business and later profit on their sale when the real businesses approach them, has given a categorical finding with regard to two issues out of three issues in favour of the plaintiff, which were the subject matter of consideration before WIPO and it reads as follows:



- a)The disputed domain name is identical or confusingly similar to a trademark or service mark in which complainant has rights;
- b)The respondent has no rights or legitimate interests in respect of the disputed domain name.

9.With regard to the third issue, namely, the disputed domain name has been registered and is being used in bad faith, is concerned, the WIPO has directed the plaintiff to approach the competent forum for adjudication of the said issue. The finding with regard to the third issue namely, bad faith, which is the subject matter of consideration in this suit, given by WIPO in its decision dated 27.08.2020/Ex.P8 is as follows:

"...To be sure, though, these other uses of "kalyan" when viewed in the totality of the evidence that is before the Panel regarding Complainant's claimed rights in 2004, takes this case out from the more narrow "clear cut" cybersquatting scenarios contemplated by the Policy. The Complainant is, of course, free to challenge Respondent's claims in court where a fuller record can be developed...."

10.Since the Civil Court is the competent forum for adjudicating the third issue, the plaintiff has filed this suit. When WIPO i.e. World



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Intellectual Property Organization, which essentially deals with cases of 'cybersquatting', where persons block domain names unconnected with their business and later profit on their sale when the real businesses approach them, has given a categorical finding that the disputed domain name is identical or confusingly similar to a trademark or service mark in which plaintiff (complainant) has rights and the respondent (defendants) have no rights or legitimate interests in respect of the disputed domain name, necessarily, this Court will have to grant the relief in favour of the plaintiff with regard to the third issue, which was the subject matter of consideration before the WIPO, namely, the disputed domain name has been registered and has been used in bad faith by the defendants for the following reasons:

a)The plaintiff is in retail jewellery business since 1993 as seen from the oral and documentary evidence placed on record as well as from the pleadings made in the plaint;

b)The plaintiff has about 144 showrooms spread across India, UAE, Qatar and Oman as seen from the documentary evidence placed on record before this Court by the plaintiff in the form of exhibits;

c)The plaintiff has also spent huge amount of money for promoting their products and services in the name of "Kalyan" and "Kalyan Jewellers".



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As seen from the pleadings as well as the documents, which have been marked as exhibits, they have approximately spent Rs.15 million since the year 2014 till the date of filing of the suit for promoting their brand "Kalyan" and "Kalyan Jewellers". Ex.P5 also proves the same;

d)They have also obtained trademark registration in respect of their trademark "Kalyan" and "Kalyan Jewellers" under Classes 14, 16 & 35 in India and several foreign countries including Singapore, UAE, Saudi Arabia, Qatar, Oman, Kuwait and Bahrain. To prove the same, documents have been marked as exhibits on the side of the plaintiff;

e)The plaintiff also owns various domain names, containing the word "Kalyan" and "Kalyan Jewellers", which they use to identify their various businesses as seen from the exhibits marked on the side of the plaintiff;

f)The plaintiff has also proved to show that the first defendant is using the domain name <Kalyanjewellers.com>, which is identical to the plaintiff's trademarks "Kalyan" and "Kalyan Jewellers". The same has also been confirmed through the findings of the WIPO dated 27.08.2020/Ex.P8.

11.Admittedly, the first defendant has no connection with the plaintiff's nature of business, namely, promoting and selling jewellery items.



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The first defendant had registered the domain name in the year 2004 with 'Net4India' and in the year 2010, the first defendant transferred the registration of the domain name to the third defendant. According to the plaintiff, after filing of the suit, they came to know that the domain name registration has been transferred to the fourth defendant and therefore, the fourth defendant was impleaded as a party defendant to the suit on 07.10.2021. The documents in the form of exhibits have also been filed by the plaintiff to prove the same. Since the plaintiff has proved through oral and documentary evidence as well as from the pleadings that they are entitled for the relief sought for in the plaint, this Court is inclined to grant a judgment and decree as prayed for in this suit.

12. For the foregoing reasons, this suit is decreed by granting the following reliefs in favour of the plaintiff against the defendants:

a) A judgment and decree for permanent injunction restraining the defendants 1 and 2 by themselves, their partners, men, servants, agents, representative, franchisees, licensees and or all other person acting on their behalf from in any manner infringing or enabling others to infringe



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plaintiff's trademarks "Kalyan" and "Kalyanjewellers" by using the domain name <kalyanjewellers.com> or any other similar, identical domain name or phonetic variant of the domain name;

b)A judgment and decree for permanent injunction restraining the defendants 1 and 2 by themselves, their partners, men, servants, agents, representative, franchisees, licensees and or all other person acting on their behalf from in any manner passing off or enabling others to pass off the goods of the defendants 1 and 2 using the domain name <kalyanjewellers.com> or any other similar, identical domain name or phonetic variant of the domain name;

c)A mandatory injunction directing the defendants 3 and 4 to cancel the domain name registration for <kalyanjewellers.com> granted in favour of the defendants 1 and 2;

d)A permanent injunction restraining the fourth defendant by themselves, their partner, men, servants, agents, representative, franchisees, licensees and or all other person acting on their behalf in any manner from transferring the domain name <kalyanjewellers.com> or any other similar, identical domain name or phonetic variant of the domain name;



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e)The defendants are directed to transfer the domain name <kalyanjewellers.com> in favour of the plaintiff within a period of six weeks from the date of receipt of a copy of this judgment;

f)The defendants are directed to pay the costs of the suit to the plaintiff.

19.02.2024

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List of Witness examined on the side of the Plaintiff:-

(PW1) Mr.Sujumon K.

List of Exhibits marked on the side of the Plaintiff:-

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