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

+ **CS(COMM) 668/2016**

YAHOO INC

..... Plaintiff

Through: Mr. Pravin Anand, Advocate with
Ms. Udit Patra and Mr. Shamim
Nooreydzan, Advocates.

versus

MR RINSHAD RINU & ORS.

..... Defendants

Through: None.

Reserved On : 29th May, 2017

Date of Decision: 03 July, 2017

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CORAM:

HON'BLE MR. JUSTICE MANMOHAN

JUDGMENT

MANMOHAN, J.:

1. Present suit has been filed for permanent injunction restraining infringement of trademarks, passing off, dilution and tarnishment, unfair competition, damages or rendition of accounts, delivery up etc. The prayer clause in the suit is reproduced hereinbelow:-

"58. It is, therefore, prayed that this Hon'ble Court may be pleased to grant:

*(i) An order for permanent injunction restraining the Defendant Nos.1 to 5 from offering services, advertising including on the internet and in any other manner using the **Yahoo** trademark or any other deceptively similar mark amounting to*

infringement of the Plaintiff's registered trademark as enlisted in Annexure A of the plaint, specifically Plaintiff's trademark registration nos.1356813, 1420637 and 1311393 in Class 39;

(ii) An order for permanent injunction restraining the Defendant Nos. 1 to 5, their partners or proprietor as the case may be, their principal officers, servants and agents, group/sister concerns or companies, from passing off their services as that of the Plaintiff;

*(iii) An order for permanent injunction restraining the Defendant Nos.1 to 5, their partners or proprietor as the case may be, their principal officers, servants and agents, from operating the website www.yahookochi.com or any other website incorporating the **Yahoo** trademark of the Plaintiff;*

(iv) An order directing the Defendant No.6, GoDaddy.com., LLC, the Registrar of the impugned domain name <yahookochi.com> to suspend the operation of the said domain name and to transfer the same to the Plaintiff;

(v) An order for permanent injunction restraining the Defendant Nos.1 to 5, their partners or proprietor as the case may be, their principal officers, servants and agents, group/sister concerns or companies, from diluting and tarnishing the Plaintiff's trademarks by virtue of their substandard services;

*(vi) An order for the delivery-up of all impugned materials of the Defendant Nos.1 to 5 that infringe the Plaintiffs **Yahoo** trademark or pass-off the Defendants' services as that of the Plaintiffs;*

(vii) A sum of Rs.1,00,05,000/- for a decree of damages against Defendant Nos. 1 to 5, as valued for the purposes of this suit for the purposes of loss of sales, reputation and goodwill of the Plaintiff's trademarks caused by the activities of the Defendants; or

(viii) An order requiring the Defendants to render accounts of all sums earned by the Defendant Nos. 1 to 5 through their unlawful

and infringing activities referred to in this plaint and decree for the same in favour of the Plaintiff and against the Defendants;

(ix) An order for costs in the present proceedings; and

(x) Any further orders as this Hon'ble Court deems fit and proper in the facts and circumstances of this case."

2. On 20th October, 2015, this Court granted an ex parte ad interim injunction in favour of the plaintiff and against the defendants. The relevant portion of the said order is reproduced hereinbelow:-

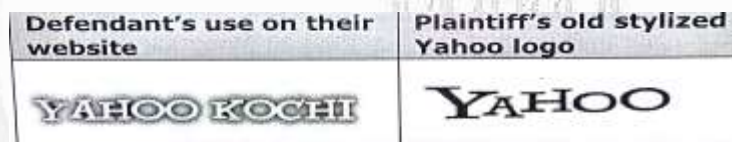
"Learned counsel for the plaintiff is pressing for an ex parte ad-interim order. He has referred various orders passed by the Court from time to time, particularly, the order passed by this Court on 4th December, 2014 in CS(OS) No.3444/2012 whereby the domain name of YAHOO has been restrained permanently. In the said order, it was also declared that the mark YAHOO is a well-known trademark. Counsel has also referred various paras of the plaint and the documents placed on the record. I am of the view that the plaintiff has been able to make out a strong prima-facie case for the grant of an ex parte ad-interim injunction. Hence, till further orders, the defendants No.1 to 5 are restrained from using the mark YAHOO in relation to the trademark as well as domain name obtained by them and they are also restrained from using the said trademark in any manner whatsoever in order to create confusion or deception in the trade. Defendant No.6 is directed to suspend the said name within one week from the date of receipt of the order.

The interim order shall become operative within one week from the date of service upon the defendants."

3. Since despite service defendants did not enter appearance, they were proceeded ex parte vide order dated 26th October, 2016 and the ex parte interim injunction was confirmed.

4. Mr. Praveen Anand, learned counsel for plaintiff stated that the plaintiff is owner of registered trade mark YAHOO and YAHOO formative trade marks in various classes including Class 39. In support of his submission, he relied upon exhibits Ex.PW1/4 to Ex.PW1/18. He stated that plaintiff's trade mark YAHOO is recognized as a well known trade mark and is included in the list of well known trade marks maintained by the Trade Mark Registry.

5. Mr. Anand contended that defendants are infringing the plaintiff's trade mark. In support of his contention, he referred to a print out from defendants' website-www.yahookochi.com (Ex.PW1/22). He also referred to photographs of defendants' premises and the business card of the defendants to show that they are using the old YAHOO logo of the plaintiff. The plaintiff's old stylized YAHOO logo as well as the defendants' logo used on their website is reproduced hereinbelow:-



6. Mr. Anand pointed out that a Cease and Desist notice dated 23rd May, 2015 had been sent by the plaintiff to the defendants and in reply the defendants had refused to change their name on the ground that they had spent huge amount of money and time in promoting and advertising the mark in question.

7. Having perused the papers and having heard the learned counsel for plaintiff, this Court is of the view that the services being offered by the defendants fall under Class 39 of the Nice Classification in which the plaintiff has trade mark registration for YAHOO formative marks. The plaintiff also operates various websites under its YAHOO trade mark providing information

on travel and tourism services.

8. This Court is of the opinion that the adoption of the YAHOO mark by the defendants is dishonest as is evident from the fact that the font used by the defendants to represent YAHOO in their trading name is identical to the unique stylized font which the plaintiff used to represents its YAHOO trade mark till 2014. There is also no plausible explanation for the adoption of the identical mark as part of trading name and domain name of the defendants. Further, the defendants cannot have any justification for the adoption of the mark YAHOO. The potentiality of harm is enormous on the internet as the plaintiff has a very wide internet presence and operates various YAHOO formative websites.

9. In any event, as the averments in the plaint have not been rebutted by the defendants inspite of ample opportunities given by this Court, they are deemed to have been admitted.

10. Since the websites of the defendants was operational for six months, the present suit is decreed in accordance with para 58(i) to (v) as well as cost assessed at Rs.4,91,114/-. The plaintiff is also held entitled to compensatory damages of Rs.2 lacs and punitive damages of Rs.3 lacs. Registry is directed to prepare a decree sheet accordingly.

JULY 03, 2017

MANMOHAN, J