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

Date of decision: 28th August, 2019

+ **CM(M) 1263/2019**

FACEBOOK INC

..... Petitioner

Through: Mr. Parag Tripathi, Sr. Advocate with
Ms. Richa Srivastava, Ms. Nayantara
Narayan, Ms. Mishika Bajpai & Ms.
Malikah Mehra, Advocates

versus

SURINDER MALIK & ORS

..... Respondents

Through: Mr. Vikas Khera, Mr. Vishal K.
Sharma & Ms. Surabhi, Advocates
(M-9971573450)

AND

+ **CM(M) 1267/2019**

INSTAGRAM LLC

..... Petitioner

Through: Mr. Parag Tripathi, Sr. Advocate with
Ms. Richa Srivastava, Ms. Nayantara
Narayan, Ms. Mishika Bajpai & Ms.
Malikah Mehra, Advocates

versus

SURINDER MALIK & ORS

..... Respondents

Through: Mr. Vikas Khera, Mr. Vishal K.
Sharma & Ms. Surabhi, Advocates

CORAM:

JUSTICE PRATHIBA M. SINGH

Prathiba M. Singh, J. (Oral)

CM APPL. 38450/2019 (for exemption) in CM(M) 1263/2019

CM APPL. 38535/2019 (for exemption) in CM(M) 1267/2019

1. Allowed, subject to all just exceptions. Applications are disposed of.

CM(M) 1263/2019 & CM APPL. 38449/2019 (for stay)

CM(M) 1267/2019 & 38534/2019

2. The Plaintiff/Respondent – Mr. Surinder Malik (*hereinafter*

'Plaintiff') had filed the suit for permanent injunction, restraining infringement of trademark and passing off, and under Section 74 of the Information Technology Act, 2000 (*hereinafter, 'IT Act'*) seeking protection of the trademark 'DA MILANO'. The Plaintiff claims to be the owner of the mark 'DA MILANO' in various forms including in label and logo forms. Defendants No.1 to 4 in the suit are alleged infringers who have put posts on the Facebook and Instagram platforms advertising and offering to sell products bearing the mark 'DA MILANO'. The Plaintiff sought a permanent injunction against the alleged infringers and impleaded Facebook Inc. and Instagram LLC as Defendants No.5 and 6 so as to ensure that the posts containing the infringing marks are taken down.

3. The Defendants 5 and 6 do not dispute the rights of the Plaintiff in the trade mark 'DA MILANO' but state that they are exempted from liability, under Section 79 of the IT Act, as they are mere intermediaries.

4. The Trial Court had, vide its impugned order dated 19th March, 2019 directed Defendants No.5 and 6 to remain present for recordal of the statement under Order X CPC. The said order reads as under:

"Affidavit already filed on 05.12.2018 in compliance by defendant no.5.

In between on 01.11.2018 various applications filed on behalf of the defendant no. 5 and 6.

At the same time Ld. Counsel for the defendant no.7 also filed application under Order 1 rule 10 CPC as well as another application under Order 6 Rule 17 CPC.

At this stage, Ld. Counsel for the plaintiff has no objection, if defendant no.7 be deleted from the array of parties subject to the undertaking of his information to court as to any change in the agreement /further development.

Statement of Ld. Counsel for the plaintiff as well as Ld. Counsel for the defendant no.7 to this effect recorded separately. Ld. Counsel for the defendant no.7 has withdrawn his application under Order 1 rule 10 CPC subject to furnishing of requisite address of the Facebook Ireland Ltd.

The requisite address furnished.

Separate applications filed on behalf of defendant no. 5 and 6 respectively under Order 6 rule 17 CPC and another application of defendant no. 5 under Section 151 CPC for substitution of name of Instagram LLC with Facebook Inc. Copies of these applications be provided.

Ld. Counsel for the plaintiff has filed an application under Order 39 rule 1 and 2 CPC r/w Section 151 CPC.

*Relist for arguments on these amendment applications. While hearing the submissions of both the sides in the light of controversy in issue, this court requires **appearance of parties in person** for examination under Order 10 CPC.*

*Relist on **01.06.2019.***

Defendant Nos.5 and 6 sought recall of this order and exemption from personal appearance. The said application was considered on 1st June, 2019 when the impugned order was passed. The order reads:

“An application moved on behalf of defendant No. 5 and 6 u/s 151 of CPC seeking modification of order dated 19.03.2019/exemption from personal appearance. Copy supplied.

No plausible reason has been cited for seeking exemption of defendant no. 5 and 6 nor their Attornies are present. This court observes that the defendants are prolonging the matter unnecessarily. This court requires the examination of the defendant no.5 and 6 for certain clarifications in respect of the issues in pleadings.

Reply sought to be filed by the plaintiff. Be filed within a month. Once again pursuant to the order dated 19.03.2019, this Court directs the defendant no. 5 and 6 to comply with the directions and to appear before their application seeking modification is entertained. The matter stands adjourned for consideration on applications/ appearance as ordered above for taking up the matter under Order 10 CPC. Plaintiff states that he has to go abroad and would seek exemption only for the next date to be fixed. He may be represented through Advocate atleast for next date. Relist on 06.07.2019.”

5. The grievance in the present petition is in respect of the direction for the personal appearance of the representatives of Facebook and Instagram.
6. Mr. Parag Tripathi, Id. Senior Counsel submits that his clients are willing to comply with the interim order which has already been passed and since the said Defendants are not contesting the matter on merits against the Plaintiff and are merely intermediaries, their personal presence is not required. The submission of Id. counsel appearing on behalf of the Plaintiff is that the said order has been complied with by the two platforms, however, the Plaintiff would like to inform the platforms as and when new URLs come up wherein products bearing the mark DA MILANO are offered for sale/advertised.
7. The Court has perused the pleadings and the documents on record. The role of these platforms i.e., Facebook and Instagram, insofar as posts put up by third parties concerned is governed by the Information Technology (Intermediaries Guidelines) Rules, 2011. Considering the provisions of the IT Act and Information Technology (Intermediaries Guidelines) Rules, 2011, platforms such as Facebook and Instagram, which

claim to be intermediaries not performing any active role in the posting of such information by third party alleged infringers, have a duty only to take down the posts which are brought to their notice by the Plaintiff in terms of Section 79(3), by following due diligence. The said Section and the Guidelines thereunder have been interpreted by the Supreme Court in ***Shreya Singhal v Union of India (2015) 5 SCC 1*** to mean that any information received by the platforms would be by means of a Court order. The relevant excerpt from the judgment reads as under:

121. It must first be appreciated that Section 79 is an exemption provision. Being an exemption provision, it is closely related to provisions which provide for offences including Section 69-A. We have seen how under Section 69-A blocking can take place only by a reasoned order after complying with several procedural safeguards including a hearing to the originator and intermediary. We have also seen how there are only two ways in which a blocking order can be passed—one by the Designated Officer after complying with the 2009 Rules and the other by the Designated Officer when he has to follow an order passed by a competent court. The intermediary applying its own mind to whether information should or should not be blocked is noticeably absent in Section 69-A read with the 2009 Rules.

“122. Section 79(3)(b) has to be read down to mean that the intermediary upon receiving actual knowledge that a court order has been passed asking it to expeditiously remove or disable access to certain material must then fail to expeditiously remove or disable access to that material. This is for the reason that otherwise it would be very difficult for intermediaries like Google, Facebook, etc. to act when millions of requests are made and the intermediary is then to judge as to which of such requests are legitimate and which are not. We have been informed that in other countries worldwide this view has gained acceptance, Argentina being

in the forefront. Also, the Court order and/or the notification by the appropriate Government or its agency must strictly conform to the subject-matters laid down in Article 19(2). Unlawful acts beyond what is laid down in Article 19(2) obviously cannot form any part of Section 79. With these two caveats, we refrain from striking down Section 79(3)(b).

123. The learned Additional Solicitor General informed us that it is a common practice worldwide for intermediaries to have user agreements containing what is stated in Rule 3(2). However, Rule 3(4) needs to be read down in the same manner as Section 79(3)(b). The knowledge spoken of in the said sub-rule must only be through the medium of a court order. Subject to this, the Information Technology (Intermediaries Guidelines) Rules, 2011 are valid.

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The legal position is thus settled insofar as Section 79 is concerned. The Plaintiff does not allege that the said two platforms have any active role. Ld. Counsel for the Plaintiff has shown to the Court illustrative printouts of the posts which were using the mark DA MILANO. There is no doubt that such posts which use the mark DA MILANO in any form, when brought to the notice of the platforms, have to be removed. Mr. Tripathi submits that so long as the mark is identical and the Plaintiff notifies the platforms, they are willing to take them down.

8. Accordingly, the following directions are issued against the said platforms i.e. Facebook and Instagram:

- i) The Plaintiff shall inform Instagram and Facebook whenever they came across use of the mark ‘DA MILANO’ either in word form, logo form or in any other form on their platforms;
- ii) Upon such information being received, as per Rule 3(4) of the 2011 Guidelines, the said posts shall be taken down, within the timelines prescribed;

- iii) If the platforms have any doubt as to the violative or offending nature of the post (s), they shall intimate the Plaintiff, within the time prescribed, who shall avail of its remedies in accordance with law;
- iv) Upon any order being passed by a Court of competent jurisdiction, the same shall be intimated to the platform, which shall abide by the said order.

9. The suit is decreed against Facebook and Instagram in the above terms. Decree sheet be drawn by the Trial Court, against Facebook and Instagram. They are no longer required to appear before the Trial Court. If the platforms do not take down the offending posts after due information, the Plaintiff is permitted to move the trial court, if the suit is pending, alternatively, the Plaintiff may avail of its remedies as available in law.

10. *Dasti* under signature of the Court Master.

AUGUST 28, 2019
Rahul

PRATHIBA M. SINGH
JUDGE