

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

% **Date of decision: 2nd April, 2019**

+ **CS(COMM) 1202/2016, IA No.10758/2016 (u/O XXXIX R-1&2 CPC) & IA No.13041/2016 (u/O XXXIX R-4 CPC)**

TATA SKY LIMITED

..... Plaintiff

Through: Mr. Tanmay Mehta, Mr. Anurag Sahay, Ms. Mallika Bhatia, Mr. Raghav Wadhwa & Mr. Siddhant Kumar Singh, Advs.

Versus

NATIONAL INTERNET EXCHANGE OF INDIA (NIXI) AND ORS

..... Defendants

Through: Mr. Vakul Sharma, Adv. for D-1.
Mr. Saurabh Tiwari, Adv. for D-2.

CORAM:

HON'BLE MR. JUSTICE RAJIV SAHAI ENDLAW

1. The plaintiff instituted this suit for (a) permanent injunction to restrain the defendant no.3 Vishwanath Suchirla from passing off the trade name and trade mark "TATA SKY" of the plaintiff as his own, whether as part of a trade mark, trade name, corporate name, domain name etc.; (b) permanent injunction restraining defendant no.1 National Internet Exchange of India (NIXI) and defendant no.2 GoDaddy Operating Company, LLC from registering or continuing with existing registration of any domain name which is identical or deceptively similar to the official domain name www.tatasky.com of the plaintiff; (c) mandatory injunction directing defendants no.1 to 3 to block access to and take down the offending domain names (i) <http://tataskybangalore.co.in>, (ii) <http://tataskydelhi.co.in>, (iii) <http://tataskymumbai.co.in>, (iv) <http://tataskypune.co.in>, (v) <http://tataskychennai.co.in>, and, (vi) <http://tataskyhyderabad.co.in> listed in

paragraph no.10 of the plaint and to de-register them and to extinguish the said domain names from the registry; (d) mandatory injunction directing defendant no.3 to take necessary steps so that offending websites do not reflect in the search results related to “TATA SKY” on search engine websites such as Google and Yahoo; and, (e) ancillary reliefs of delivery and damages.

2. The suit came up before this Court first on 2nd September, 2016 when, while issuing summons / notice thereof, defendant no.3 Vishwanath Suchirla was restrained from passing off the trade name and trade mark “TATA SKY” whether as part of trade mark, trade name, corporate name, domain name etc. and the defendants were restrained from registering or continuing with the existing registration of any domain name which is identical or deceptively similar to the official domain name of the plaintiff i.e. www.tatasky.com including but not limited to the domain names and websites listed in paragraph no.10 of the plaint.

3. The defendant no.3 Vishwanath Suchirla failed to appear despite service and the counsel for the plaintiff states that the defendant no.3 has already been proceeded against *ex parte*.

4. The counsel for the defendant no.1 and the counsel for defendant no.2 appear and pleadings qua them have been completed.

5. The counsel for the defendant no.1 and the counsel for the defendant no.2 have no objection to the reliefs claimed by the plaintiff against the defendant no.3 being granted. In fact, the counsel for the plaintiff states that the offending domain names have already been blocked by the defendants, by putting a server lock thereon.

6. The plaintiff even otherwise, on pleadings and documents has made out a case for grant of reliefs insofar as against defendant no.3 and the need to relegate the plaintiff to *ex-parte* evidence against defendant no.3 is not felt.

7. A decree is accordingly passed, in favour of the plaintiff and against the defendant no.3 Vishwanath Suchirla, of permanent injunction in terms of prayer paragraphs (a) and (b) of the plaint dated 4th / 5th August, 2016.

8. The counsel for the plaintiff does not press the other reliefs against the defendant no.3 Vishwanath Suchirla since the defendant no.3 has not contested the suit.

9. Decree sheet against defendant no.3 be prepared.

10. The counsel for defendant no.1 and counsel for defendant no.2 say that defendants no.1 and 2 have no objection, upon this court being satisfied in this regard, to issuance of a direction against them in terms of prayer paragraphs (b) and (c) of the plaint dated 4th / 5th August, 2016 and as summarized above, but only qua the domain names mentioned in paragraph no.10 of the plaint. On enquiry, the counsel for the plaintiff states that the plaintiff opts for extinguishment of the domain names listed in paragraph no.10 of the plaint.

11. A decree is accordingly passed, in favour of the plaintiff and against the defendants no.1 and 2, to forthwith extinguish the domain names listed in para no.10 of the plaint.

12. Decree sheet against defendants no.1&2 also be drawn up.

13. The dispute however survives qua the claim of the plaintiff against defendants no.1 and 2, of permanent and mandatory injunction restraining

the said defendants from, in future also, from time to time, registering or allowing registration of any other domain name which is identical or deceptively similar to the domain name www.tatasky.com of the plaintiff and directing the defendants to forthwith take down any such domain names even if registered inadvertently.

14. Per contra, the counsels for the defendants no.1&2 contend that no general order can be issued directing the defendants no.1&2 to auto block registration of any domain name which may be infringing the mark / domain name of the plaintiff or which may be similar or identical to the domain name of the plaintiff or amounting to “passing off” as the plaintiff. It is further the contention of the defendants no.1&2 that the defendant no.1, as per the policy of the Government of India, is not to itself take a decision on the grievances as of the plaintiff and is required to refer the same to the arbitration in accordance with the Disputes Resolution Mechanism devised under the said policy. The counsels for defendants no.1 and 2 further contend that the process of registration of domain names is automated and there is no mechanism for the defendants to auto block the registration of any domain name. The counsels for defendants no.1 and 2 state that defendants do not have any adjudicatory powers to determine whether a domain name of which registration is sought is similar or deceptively similar to the trade mark and domain name of the plaintiff; it is further stated that the defendants however have devised a dispute resolution mechanism, whereunder on a grievance being received with respect to registration of any particular domain name, the same is referred to arbitration in accordance with the policy of the defendants no.1 and 2. It is further stated that the plaintiff, against any such / similar grievance in future against any other domain name

registered with defendant no.1, has option either to institute a civil suit or avail of the dispute resolution mechanism of defendant no.1.

15. The counsel for the plaintiff has contended that a general direction be issued to the defendants no.1&2. He argues, that the plaintiff ought not to be compelled to repeatedly institute suits or resort to arbitration devised by the defendant No.1 NIXI, all at a cost, whenever someone infringes the mark/domain name of the plaintiff. It is stated that the plaintiff has already had to file several suits with similar grievance and invariably the infringer fails to contest and merely registers a variation, also infringing the mark/domain name of plaintiff, defeating the order obtained by plaintiff and compelling plaintiff to file another suit. It is contended that the plaintiff has no privity with any of the defendants and cannot be compelled to arbitrate. It is also the contention that the first come first serve policy adopted by the defendant no.1 and referred to in paragraph 19 of *Satyam Infoway Ltd. Vs. Sifynet Solutions (P) Ltd.* (2004) 6 SCC 145 cited by counsel for defendant no.1, is contrary to Information Technology (Intermediaries Guidelines) Rules, 2011, which requires due diligence by intermediaries. Reliance is placed on *Kent RO Systems Ltd. Vs. Amit Kotak* 240 (2017) DLT 3, *Christian Louboutin Sas Vs. Nakul Bajaj* 253 (2018) DLT 728 and *Tata Sky Ltd. Vs. YouTube LLC* 2016 SCC OnLine Del 4476.

16. My reading shows that, each device connected to a computer network that uses the Internet Protocol for communication, has a numerical label assigned to it, which serves the function *inter alia* of network interface identification and location addressing. This numerical label is called the Internet Protocol (IP) address. The numerical label constituting IP address

is difficult to remember. Domain registration is the process of registering a domain name, which identifies one or more IP addresses with a name that is easier to remember. I find that the defendant No.1 NIXI was established as a Government non-profit company to provide neutral Internet Exchange Point Services in India and to facilitate the handing over of domestic internet traffic between Internet Service Providers in India rather than using servers in United States or elsewhere and thereby saving foreign exchange. Utilising servers routed through and administered by India also reduces chances of Indian Data being intercepted by others. The defendant No.1, on its website claims to be authorised by Government of India as .IN Registry.

17. During the hearing also, it has been informed (i) that domain names on the internet can be registered *inter alia* as (a) .COM, or as (b) .IN (for India, being the Country Code Top-Level Domain); (ii) the registration of domain names as .COM is governed by the Uniform Domain Name Disputes Resolution Policy created by World Intellectual Property Organisation (WIPO); (iii) that the defendant no.1 NIXI has been incorporated under Section 25 of the Companies Act 1956, by the Government of India, for the purpose of registration of .IN domain names; (iv) that the Memorandum and Articles of Association of defendant no.1 *inter alia* provide for the defendant no.1 to refer to disputes arising in the course of its business between itself and others, to Arbitration; (v) the Memorandum and Articles of Association of the defendant no.1 also provide for the defendant no.1 to carry on registration of domain names through appointed Registrars; (vi) that the defendant no.1 has appointed Registrars for carrying out the registration of domain names with the defendant no.2 being one of such Registrars; (vii) the impugned domain names, at the time of institution of the suit stood

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registered with the defendant no.1 through defendant no.2 in the name of the defendant no.3; (viii) that as per the prevalent policy of the defendant no.1, the defendant no.1 has created a panel of Arbitrators and the grievances as made by the plaintiff with the defendant no.1 are referred by the defendant no.1 to an Arbitrator from a panel of Arbitrators of the defendant no.1; (ix) the prevalent cost of such arbitration is Rs.30,000/- besides GST, with Rs.10,000/- being appropriated by the defendant No.1 as administration fee and Rs.20,000/- being paid to the Arbitrator appointed by the defendant no.1; and, (x) that the panel of Arbitrators is prepared by inviting applications from interested persons and by screening of the said applications by the defendant no.1.

18. The injunction, of the nature / kind sought by the plaintiff and contested by defendants no.1&2, in legal parlance has come to be known as 'Dynamic Injunction'.

19. I have considered the entitlement of the plaintiff, in the facts and circumstances aforesaid, to a dynamic injunction restraining the defendants from, for all time registering a domain name similar / deceptively similar to that of the plaintiff and to remove any such mark registered inadvertently or found in future.

20. The power to adjudge similarity / deceptive similarity, under our laws, vests either in the Courts or in authorities / tribunals constituted by law to determine the same. Such power indeed entails adjudication of rival claims and even if not contested, does not entitle the grievant to, at the mere asking have removed the domain name registered by another, unless establishes a case of similarity / deceptive similarity. No such power is shown to have

been vested by law in defendant no.1 and in the absence thereof, in my opinion, no such direction to defendant no.1, to exercise adjudicatory power, can be given. The judgments relied upon by the counsel for plaintiff, are qua intermediaries and not against Registrar of Domain Names. I however do not want to, in this proceeding, return a positive finding that defendant no.1 NIXI is not a intermediary within the meaning of Section 2(w) of the Information Technology Act, 2000. Suffice it is to state that the defendant no.1 NIXI, being a body corporate and not authorized by its Memorandum and Articles of Association, to do what the plaintiff wants this Court to direct defendant no.1 to do, cannot be so directed.

21. The dynamic injunction as sought by the plaintiff, will indeed require the defendant no.1 to, whenever anyone seeks registration of a domain name, examine and verify whether the same is similar to trade mark or domain name of plaintiff or for that matter, of any other person. Without the defendant no.1 being authorized in this regard, it cannot be directed to perform this task.

22. Merit is however found in contention of counsel for plaintiff, of infringers, merely by changing an alphabet and/or numerical, succeeding in defeating the injunctions granted. In my opinion, law and the legal system must keep pace with the infringers / violators and if fail to do so, will sound the death knell thereof, encouraging jungle raj.

23. In my opinion, 'Artificial Intelligence' can be suitably employed to, within the parameters defined by law and / or the Courts, prevent such repeated infringement and violations, eliminating the need for the grievants

to repeatedly approach the Court and / or the dispute redressal mechanism and which may tire the grievants, opening the field for violators / infringers.

24. This Court, in similar suits other than by the plaintiff, is also concerned with the same issue. Though in some of such cases including those cited by counsel for plaintiff, a general direction as sought by the plaintiff has been issued to intermediaries but difficulties in implementation thereof also are being brought before the Court.

25. I have enquired from the counsel for defendant No.1 NIXI, that since the defendant No.1 is performing the function of Registrar of Domain Names, why does the defendant No.1 NIXI, even if is unable to screen the name of which registration is sought owing to registration being automated and is unable to introduce autoblock of offending domain names, as the intermediaries have been directed to introduce in enforcement of The Preconception and Pre-natal Diagnostic Techniques (Prohibition of Sex Selection) Act, 1994, why it does not have a Grievance Officer, to whom grievances of registration of offending / objectionable domain names can be addressed and who can deal with the same, unless entail a complex question of law or fact and in which cases option can be given to either approach the Civil Court or to avail of arbitration of defendant No.1 NIXI.

26. Attention of counsels for defendants No.1&2 is drawn to Section 16 of Companies Act, 2013, Section 57 of Trade Marks Act, 1999, Section 19 of Patents Act, 1970 which empower the Registrar of Companies, Trade Marks and Controller of Patents respectively, to deal with such grievances of infringement and/or passing off. I am of the *prima facie* view, that the defendant No.1 NIXI, a non-profit government company, while functioning

as Registrar of domain names is performing a public function, as the Registrars under the aforementioned statutes are functioning and in performance and discharge of such public function owes a duty to act fairly and justly and in compliance of other laws and not allow its such public function to be abused for violating other laws/statutes. The defendant No.1 NIXI, in performance and discharge of such function cannot devise its own dispute resolution mechanism and is bound by the prevalent judicial system and constitutional duty to develop spirit of inquiry and reform and not encourage avoidable litigation. The defendant No.1 NIXI has no authority in law to impose arbitration on unwilling grievants. Though the right of such grievants to approach the Civil Courts is not controverted but it has been held in *Karfule Ltd. Vs. Arical Daniel Varghese* AIR 1953 Bom (DB) and *State of Punjab Vs. M/s. Geeta Iron & Brass Works Ltd.* (1978) 1 SCC 68 that government should discourage rather than encourage litigation, further burdening the already overburdened Courts. It thus appears to me that even if it is not possible for defendant No.1 NIXI to at the threshold prevent bad faith registrations of domain name, there is no reason why it cannot, either itself or through a Grievance Officer, not entertain complaints of such registrations and expeditiously dispose off the same. It is also not known, on what basis the costs of arbitration are computed and panel of arbitrators prepared. Even if there were to be a fee on complaints, there has to be a fair, transparent policy therefor and such complaints should be heard and decided by officers of defendant No.1 NIXI, on whom responsibility can be fixed, rather than by arbitrators from a panel prepared by defendant No.1 NIXI, on whom as independent persons, no responsibility can be fixed. Though the counsel for defendant No.1 has contended that the defendant No.1 NIXI is

not an intermediary within the meaning of the Information Technology Act but I may mention that Information Technology (Intermediaries Guidelines) Rules, 2011, vide Rule 3(11) requires intermediaries to publish on their website the name of Grievance Officer and his contact details as well as mechanism by which users can notify their complaints and requires such Grievance Officer to redress the complaints within one month of receipt thereof. The defendant No.1 NIXI, even if not an intermediary, performing an akin function, I see no reason why should not have the same mechanism as prescribed legislatively for intermediaries.

27. However, all the aforesaid issues, strictly speaking, do not arise in this suit wherein Ministry of Electronics and Information Technology, Government of India is not even a party, though adjudication thereof will indeed curb such litigation. The questions aforesaid thus arise in public interest and are not to be adjudicated by this bench but by Hon'ble the Chief Justice or his assigned bench.

28. I therefore, while disposing of the present suit as aforesaid, direct the file to be placed before Hon'ble the Chief Justice for passing appropriate orders on the aforesaid issues which are found to arise in public interest. The counsel for the plaintiff may approach the Secretariat of the Hon'ble the Chief Justice for finding out further development in the matter.

RAJIV SAHAI ENDLAW, J

APRIL 02, 2019/‘gsr’/pp..