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IN THE HIGH COURT OF JUDICATURE AT MADRAS

(ORDINARY ORIGINAL CIVIL JURISDICTION)

TUESDAY, THE 07TH DAY OF JUNE 2022

THE HON'BLE MR. JUSTICE SENTHILKUMAR RAMAMOORTHY

A.No.4983 of 2021

in

C.S.No.669 of 2015

M/s. Puravankara Projects Limited,
No.36/2, Gandhi Mandapam Road,
Kotturpuram, Chennai – 600 085
rep by its authorized signatory,
Mr.S.John Vijayakumar

...Plaintiff

versus

1. M/s. Godaddy.com LLC,
14455, N.Hayden Road,
#219, Scottsdale,
Arizona 85260,
United States of America
2. Godaddy India Domains and
Hosting Services Pvt Ltd.,
Flat 101, Sai Krishna Enclave,
6-1-132/99, Plot No. 99, Skandagiri,
Padmarao nagar,
Secunderabad – 500 061.

***3. Mr. Rajiv Sodhi,**
Vice-President & Managing Director,
Godaddy India Domains and
Hosting Services Pvt Ltd.,
003, Tower 4A,
DLF Corporate Park,
Mehrauli Gurgaon Road,



Gurgaon 122 002, Haryana

(* Third defendant struck off. as per order dated 11.09.2020 in A.No.6941 of 2017) ...Defendants

A.No.4983 of 2021:-

1. M/s. Godaddy.com LLC,
14455, N. Hayden Road,
#219, Scottsdale,
Arizona 85260,
United States of America ...Applicant No.1/Defendant No.1
2. Godaddy India Domains and Hosting Services Private Limited,
Flat 101, Sai Krishna Enclave, 6-1-132/99,
Plot No.99, Skandagiri,
Padmarao Nagar,
Secunderabad – 500 061. ... Applicant No.2/Defendant No.2

versus

M/s. Puravankara Projects Limited,
No.36/2, Gandhi Mandapam Road,
Kotturpuram, Chennai – 600 085
rep by its authorized signatory,
Mr.S.John Vijayakumar ...Respondent/Plaintiff

Application praying that this Hon'ble Court be pleased to dispense with the procedure of trial and pass a Summary Judgment in the above suit dismissing the plaint with costs in favour of the Defendants.

This application having been heard on 09.03.2022 in the presence of

Mr Moazzam Khan for Ms.Gladys Daniel, Advocates for the Applicants



herein and Mr.R.Sathish Kumar, Advocate for the respondent herein and upon reading the judge's summons and the affidavit of John Massey filed herein and having stood over for consideration till this date and coming on this day before this Court for orders in the presence of said advocates for the parties hereto and this Court having observed that the relief of mandatory injunction [prayer (c)], the Respondent/Plaintiff seeks a direction for the removal of the trademarks PURVA, PURAVANKARA and PURAVANKARA PROJECTS used separately or in combination, this relief is not founded on apprehended infringement or passing off; yet, the alleged users of such trademarks/ registrants, who would be necessary parties, have not been joined in these proceedings, the Respondent/Plaintiff has also not provided any indication of its intention to implead such parties, Consequently, if the relief prayed for is granted it would gravely impact third party users who are not parties to the action, therefore, as regards this relief, the Respondent/ Plaintiff has no real prospect of succeeding in the suit as framed, the relief of damages of Rs.1,00,00,000/- is directed only against the Applicants/Defendants herein, being a claim for damages, the success or failure of the Respondent/Plaintiff is dependent on adducing evidence of loss on account of the adoption of suggestion tools by the Applicants/Defendants whereby names deceptively similar to the registered



That as regards prayers (a), (b) and (d), the Respondent/Plaintiff herein, be and is hereby permitted to prosecute the suit only with regard to the alleged liability of the Applicants/Defendants on account of using suggestion tools or measures similar thereto.

2) That the prayer (c) in the plaint, be and is hereby rejected summarily on the ground that the Respondent/Plaintiff has no real prospect of success.

3) That these conclusions would have a bearing while determining costs [prayer (e)] in course of final disposal.

WITNESS THE HON'BLE MR. JUSTICE MUNISHWAR NATH BHANDARI, CHIEF JUSTICE, HIGH COURT AT MADRAS AFORESAID, THIS THE 07TH DAY OF JUNE 2022.

Sd/-

ASSISTANT REGISTRAR (Comm. Cases)

//Certified to be true copy//

Dated at Madras this the day of 2022.

COURT OFFICER(O.S.)

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ARS
28.06.2022

A.No.4983 of 2021
in
C.S.No.669 of 2015

ORDER

DATED : 07.06.2022

THE HON'BLE MR. JUSTICE
SENTHILKUMAR RAMAMOORTHY

FOR APPROVAL: 29.06.2022

APPROVED ON : 05.07.2022



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IN THE HIGH COURT OF JUDICATURE AT MADRAS

Order reserved on	09.03.2022
Order pronounced on	07.06.2022

CORAM

The Hon'ble Mr. Justice **SENTHILKUMAR RAMAMOORTHY**

Application No.4983 of 2021
in
Civil Suit No.669 of 2015

1.M/s.Godaddy.com LLC
14455,N.Hayden Road,
No.219, Scottsdale,
Arizona 85260
United States of America

... 1st Applicant/1st Defendant

2.Godaddy India Domains and
Hosting Services Private Limited,
Flat No.101, Sai Krishna Enclave, 6-1-132/99,
Plot No.99, Skandagiri,
Padmarao Nagar,
Secunderabad – 500 061.

... 2nd Applicant/2nd Defendant

vs.

M/s.Puravankara Projects Limited,
No.36/2, Gandhi Mandapam Road,
Kotturpuram, Chennai – 600 085
rep by its authorized signatory
Mr.John Vijayakumar

... Respondent/Plaintiff



This Application is filed under Order XIV Rule – 8 of O.S. Rules r/w under Order XIII-A of CPC praying to dispense with the procedure of trial and pass a Summary Judgment in the above suit dismissing the plaint with costs.

For Applicants : Mr.Moazzam Khan
for Ms. Gladys Daniel

For Respondents : Mr.R.Sathish Kumar

ORDER

The Defendants in the suit are the Applicants. By this application, the Defendants pray for a summary judgment for the dismissal of the suit.

2. The Applicants/Defendants stated that the first Defendant is a domain name registrar (DNR). An organization called the Internet Corporation for Assigned Names and Numbers(ICANN) is the umbrella organization with regard to domain names. More than 1200 generic top level domain registrars and more than 2300 ICANN accredited registrars operate under ICANN. The National Internet Corporation of India (NIXI) is the Indian registry for .in domain names. Domain names are available on a first-cum-first-served basis. According to the Applicants, they are intermediaries as per Section 2(1)(w) of the Information Technology Act,



2000 (the IT Act). Since the Applicants are intermediaries, the Applicants asserted that they are entitled to the exemption provided for under Section 79 of the IT Act.

3. The Applicants contended that the suit has been filed only against one DNR and its group company in India. By such suit, the Respondent/Plaintiff seeks to restrain alleged infringement of trademark and passing off and seeks a mandatory injunction for the removal of the trademarks 'Purva,' 'Puravankara' and 'Puravankara Projects Limited' used separately or in combination with top level domains or sub domains and for the transfer of such domain names to the Respondent/Plaintiff or its authorized representatives. According to the Applicants/Defendants, the Plaintiff has no real prospect of succeeding in the suit. Apart from the protection under Section 79 of the IT Act, the Applicants also contended that necessary parties such as ICANN, NIXI and the alleged infringing registrants were not joined. Consequently, the suit is liable to be dismissed. The Applicants pointed out that the Plaintiff has registered trademarks in seven classes under the Trade Marks Act, 1999 (the Trade Marks Act) and contended that the protection under the Trade Marks Act is confined to the classes in which the trademarks are registered and, even within such classes, the protection is restricted to the relevant goods or services. Unlike a



trademark which is used in relation to specific goods or services, a domain name is not limited to particular goods or services. It is an address on the Internet, which applies without such limitation. In such context, the Applicants asserted that the Respondent/Plaintiff cannot claim monopoly on a pan-class basis. Hence, the reliefs claimed are untenable. The Applicants also pointed out that the word "Purva" has at least three meanings, namely, elder, easterly wind and east. It is also the name of a community in Kasaragod, North Kerala. The Applicants state that there are at least 650 existing domain names which use the words "Purva", "Puravankara" and "Puravankara Projects Limited" or a part thereof.

4. The Applicants/Defendants pointed out that the World Intellectual Property Organization(WIPO) has established the Uniform Dispute Resolution Process(UDRP) for domain name disputes. Consequently, the Respondent/Plaintiff has an effective alternative remedy, which is inexpensive and expeditious. The Applicants also contended that the relief would be ineffective, even if granted, because there are about 2300 DNRs operating under ICANN, about 130 DNRs operating under NIXI, and that the first Applicant/first Defendant is only one of the 2300 DNRs operating under ICANN. As a result, any of the other 2299 DNRs would still be in a position to use the allegedly infringing domain names.



The Applicants also pointed out that the Respondent/Plaintiff has not shown a single existing domain name which is infringing. All the examples cited by the Respondent/Plaintiff are outdated and such domain names are not in use through the first Applicant. With regard to the use of suggestion tools, the Applicants stated that such suggestion tools are used by most if not all DNRs functioning under ICANN. According to the Applicants, ICANN permits the use of suggestion tools by DNRs such as the first Applicant.

5. In support of the above contentions, the Applicants referred to and relied upon the following judgments:

(i) *Shreya Singhal v. Union of India* (2015) 5 SCC 1 (**Shreya Singhal**).

(ii) *Hindustan Unilever Limited v. Endurance Domains Technology LLP and others* (2020) SCC Online Bom. 809 (**Hindustan Unilever Limited**).

(iii) *Tata Sky Limited v. National Internet Exchange of India and Others* (2019) SCC Online Del. 7931 (**Tata Sky Limited**).

(iv) *Inventel Products LLC v. LI 406 F.Supp. 3d 396* (D.N.J 2019) (**Inventel Products**).

(v) *Lockheed Martin Corporation v. Network Solution Incorporation* 194 F.3d 980 (9th Cir. 1999).



(vi) *Kent RO System Limited and Others v. Amit Kotak and others*

(2017) SCC Online Del. 7201.

(vii) *Satyam Infoway Limited v. Siffynet Solutions (P) Limited*

(2004) 6 SCC 145(**Satyam Infoway**).

(viii) *Ranjan Kumar and Others v. State of Bihar and others*

(2014) 16 SCC 187.

(ix) *Kamdhenu Limited v. Aashiana Rolling Mills Limited (2021)*

SCC Online Del. 2426(**Kamdhenu**).

(x) *Su-Kam Power Systems Limited v. Kunwer Sachdev and*

Others (2019) SCC Online Del. 10764(Su-Kam).

(xi) *Myspace Inc. v. Super Cassettes Industries Limited (2016)*

SCC Online Del 6382.

(xii) *Facebook Inc. v. Surinder Malik and Others (2019) SCC*

Online Del 9887.

(xiii) *The Himalaya Drug Company & Others v. Ashok Kumar*

and others, CS (Comm) 95 of 2021 (The Himalaya Drug Company).

(xiv) *Cipla Limited, Mumbai v. Cipla Industries Pvt. Limited, AIR*

2017 Bom 75 (Cipla Limited).

6. In response to these contentions, the Respondent/Plaintiff

<https://hcservices.ecourts.gov.in/hcservices/>

submitted that it is the registered proprietor of the trademarks



"Puravankara," "Puravankara Projects", etc. Once it is established *prima facie* that the Respondent/Plaintiff is the registered proprietor, the question whether the Applicants/Defendants committed infringement should be decided in the suit. As regards the contention that the suit is liable to be rejected for non-joinder of necessary parties, the Respondent/Plaintiff contended that neither NIXI nor ICANN are necessary parties. The grievance of the Respondent/Plaintiff is against the Applicants/Defendants, who offer domain names, including suggestion tools as regards available domain names. As regards other infringers, the Respondent/Plaintiff asserts that it is not necessary to join them in the suit and it is always open to the Respondent/Plaintiff to file separate suits against the other infringers.

7. With regard to the contention that the Applicants/Defendants are intermediaries, which are entitled to protection under the IT Act, the Respondent/Plaintiff stated that the Applicants/Defendants ceased to be intermediaries or, at a minimum, ceased to be entitled to protection upon deploying suggestion tools. Therefore, it is submitted that the Applicants/Defendants are not entitled to protection either under Section 79 of the IT Act or under any other law. As regards the existence of an alternative remedy before the UDRP, the Respondent/Plaintiff contended that such remedy is not available against DNRs and is restricted to



registrants. The Respondent/Plaintiff stated that the jurisdiction of this Court is wider and is not confined to the three cumulative conditions which should be satisfied for UDRP proceedings. As long as the infringing domain names are used in the course of trade or offered for sale, it is contended that it amounts to infringement as per Section 29(1) of the Trade Marks Act.

8. For all the reasons set out above, the Respondent/Plaintiff contended that a case is made out for proceeding with the suit and that the application for summary judgment is liable to be dismissed.

9. By way of rejoinder, the Applicants/Defendants relied on the judgment in *Lungove v. Vedanta Resources PLC* [2020] A.C.1045 (***Vedanta Resources***) to contend that an application under Order XIII-A should be tested on the basis of the merits of the respondent or non-applicant's case. By drawing reference to the judgment in *Syrma Technology Private Limited, Chennai v. Powerwave Technologies Sweden AB(in Bankruptcy)*, (2020) 8 MLJ 332 (***Syrma Technology***), the Applicants contended that Rule 4 of Order XIII-A is mandatory, and that sub-Rule 3 thereof prescribes that the respondent to such application should file a reply disclosing all material facts, identify the point of law, if any, and state the



reasons why the relief sought by the applicant therein should not be granted.

The said sub-rule also prescribes that the respondent should include any documentary evidence on which it seeks to rely upon and state why there are real prospects of succeeding on the claim. On account of non-compliance with the requirements of sub-Rule 3 of Rule 4 of Order XIII-A by the Respondent/Plaintiff, it was contended that the burden of proof on the Applicants is considerably reduced. By relying upon the judgment in *The Himalaya Drug Company*, the Applicants contended that, as held therein, an intermediary such as the first Applicant, cannot decide in advance that the domain name in question is infringing. By way of illustration, it was contended that the first Applicant/first Defendant cannot adjudicate whether the proposed use of a domain name containing the word "Purva" is infringing because such adjudicatory function is the sole preserve of courts or other adjudicatory bodies and cannot be performed by a DNR such as the first Applicant. The Applicants reiterated that about six classes of necessary party, including other DNRs under ICAAN, ICANN, NIXI and the alleged infringing registrants (users of similar trademarks on GoDaddy) have not been joined. The Applicants concluded their submissions by pointing out that a list of well known surnames and well known trademarks is maintained by the Registrars of Trade Marks and that

the marks over which the Respondent/Plaintiff claims exclusivity, such as



"Puravankara", are not included in the said list.

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10. On taking into consideration the contentions of the contestants, the principal question that arises for consideration is whether the Applicants are entitled to a summary judgment as prayed for or in part. Order XIII-A of the CPC, which is applicable to commercial disputes, governs the issue. Rule 3 thereof sets out the grounds for summary judgment. The said Rule 3 is set out below:

"3. Grounds for summary judgment -

The Court may give a summary judgment against a plaintiff or defendant on a claim if it considers that -

(a) the Plaintiff has no real prospect of succeeding on the claim or the defendant has no real prospect of successfully defending the claim, as the case may be; and

(b) there is no other compelling reason why the claim should not be disposed of before recording of oral evidence."

On a textual reading of Rule 3, it is evident that an application for summary judgment may be filed either by the plaintiff(s) or the defendant(s) in an action. In either case, the applicant should establish that the counter party has no real prospect of succeeding on the claim or successfully defending



the claim, as the case may be. An additional requirement is imposed, namely, that there is no other compelling reason why the claim should not be disposed of before recording oral evidence. In **Syrma Technology**, a Division Bench of this Court concluded that the burden of proof with regard to the first limb under Rule 3 of Order XIII-A is imposed on the applicant, whereas the burden of proof as regards the second limb is imposed on the respondent in such application.

11. Order XIII-A is inspired by the Civil Procedure Rules (CPR) of the United Kingdom. In particular, paragraph 24 of the CPR deals with summary judgment. Paragraph 24.2 thereof is akin to Rule 3 of Order XIII-A and reads as under:

24.2 The court may give summary judgment against a claimant or defendant on the whole of a claim or on a particular issue if –

(a) it considers that –

(i) the claimant has no real prospect of succeeding on the claim or issue; or

(ii) the defendant has no real prospect of successfully defending the claim or issue; and

(b) there is no other compelling reason why the case or issue should be disposed of at a trial.



On comparing and contrasting Rule 3 of Order XIII-A with paragraph 24.2 of the CPR, while there are minor differences in language, in substance, the requirements are near-identical. Even as regards the second limb under Rule 3 *vis-a-vis* the second limb under CPR 24.2, once the first limb is satisfied, unless there is some other compelling reason to record oral evidence, a summary judgment should be pronounced.

12. The nature of orders that may be passed in an application for summary judgment is pertinent to the determination of this application. Rule 6 of Order XIII-A, which deals with this aspect, is set out below:

“ 6. Orders that may be made by Court -

(1) On an application made under this Order, the Court may make such orders that it may deem fit in its discretion including the following:-

(a) judgment on the claim;

(b) conditional order in accordance with Rule 7 mentioned hereunder;

(c) dismissing the application;

(d) dismissing part of the claim and a

judgment on part of the claim that is not dismissed;



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(e) striking out the pleadings (whether in whole or in part);

(f) further directions to proceed for case management under Order XV-A.

(2) Where the Court makes any of the orders as set forth in sub-rule (1)(a) to (f), the Court shall record its reasons for making such order.”

Rule 6 discloses that wide latitude is provided to the court, while dealing with an application for summary judgment, to pass a range of orders either on the whole or part of the suit claim. Indeed, the words of sub-rule (1) that precede the enumeration in clauses (a) to (f), i.e. “such orders that it may deem fit in its discretion including”, indicate conclusively that the enumeration is illustrative and not exhaustive.

13. The initial and, indeed, primary focus of inquiry in an application for summary judgment is whether, on the evidence produced by the parties, it may be concluded that the counter party has no real prospect of succeeding on the claim or defending the claim, as the case may be. Unless the requirements of clause (a) of Rule 3 are satisfied, it is unnecessary to consider clause (b) thereof. Does the expression “no real prospect of succeeding...or...successfully defending” mean that the prospect



is impossible, unlikely or improbable? Order XIII-A itself provides a clue.

Rule 7 thereof enables the court to pass a conditional order where it is possible but improbable that a claim or defence may succeed. Rule 7(1) is set out below.

"7. Conditional order. - 1) Where it appears to the Court that it is possible that a claim or defence may succeed but it is improbable that it will do so, the Court may make a conditional order as set forth in Rule 6(1)(b) above."

14. Thus, it is clear that the court may not only allow or dismiss an application for summary judgment, but also pass a conditional order where it appears that it is possible but improbable that the claim or defence may be successful. Theoretically, as regards prospects of success, it is possible to envisage a spectrum running from impossible to certain. Given the nature of adversarial litigation, it is highly improbable that a court would be in a position to conclude that the plaintiff or defendant would certainly fail or succeed. However, between the two extremes of impossibility and certainty, there are a wide range of prospects with regard to success or failure. From the scheme of Order XIII-A, it appears that an application for summary judgment would be liable to be dismissed if the



probable as regards the entire suit claim. If this conclusion were to be reached in respect of a part of the suit claim, the application may be considered only in respect of the remainder. By contrast, if the evidence on record leads to the inference that the success of the plaintiff or defendant, as the case may be, is possible but not probable, either in respect of the whole or part of the claim, the application may be disposed of by a conditional order. This raises the question whether possibility means statistical or theoretical possibility. If so interpreted, the most that an applicant for summary judgment can target is a conditional order because the statistical possibility of success can never be ruled out in adversarial litigation. The text of Rule 3 provides a pointer on interpretation by using the adjective “real” before the word “prospect”, thereby indicating that the possibility of success should be more than theoretical or statistical. By way of context, it should be noticed that the CPC was amended in its application to commercial disputes in recognition of two key facets of a justice delivery system: expeditious disposal and equitable allocation of limited resources, which entails proportionate deployment of resources based on requirement and not by adoption of a blinkered trial-is-the-only-method approach. Against this statutory context, the interpretation of substantially similar provisions of the CPR by courts in the UK and the interpretation of Order



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15. In *Terence Paul Swain v. T Hillman (Male) and T C Gay* [2001]2 All ER 91, the Court of Appeal (Civil Division) held that the words "no real prospect of succeeding" speak for themselves and that the word "real" is used in contradistinction to fanciful or unrealistic prospects of success. It was further held that if there is a real prospect of success, the discretion of granting a summary judgment does not arise merely because the court concludes that success is improbable. In *ED & F Man Liquid Products Ltd. v. Patel & another*, (2003) EWCA Civ 472, the Court of Appeal (Civil Division) examined the scope of summary judgment under the CPR. The Court held that a realistic claim is one that carries some degree of conviction and is more than merely arguable. At paragraph 9 of the judgment, the Court concluded that the overall burden of proof rests upon the claimant. It was also held that the court should not conduct a mini-trial while deciding an application for summary judgment. In *Easyair Limited (Trading as Open Air) v. Opal Telecom Limited* [2009] EWHC 339 (Ch), Mr. Justice Lewison of the Chancery Division of the High Court of England and Wales formulated seven principles. Apart from the principles discussed above, the Court concluded that if the evidence on record indicates that further material evidence can reasonably be expected at trial, a summary judgment should not be issued, but that "it is not enough simply to argue



that the case should go to trial because something may turn up which would have a bearing on the question of construction.”

16. In the Indian context, the Delhi High Court dealt with the scope of Order XIII-A CPC in *Kamadhenu*. After referring to the judgment in *Su-Kam* and the judgment of the Chancery Division in *PCR Limited v. Opal Telecoms Limited (2009) EWCA Civ. 339*, the Delhi High Court concluded that the court is required to consider whether the defences raised by the defendants are moonshine and sham. In particular, the Delhi High Court relied upon the observation in *Su-Kam* that, if it were possible for the court concerned to find the necessary facts to resolve the dispute in a fair and just manner in course of hearing an application for summary judgment, proceeding to trial would generally not be proportionate, timely or cost effective.

17. The principles pertaining to the grant of summary judgment, albeit non-exhaustive, as gleaned from the above analysis and from precedents, are set out below:

- (i) The applicant should discharge the burden of establishing that the counter party has no real prospect of succeeding on the claim, including a part thereof, or



successfully defending the claim, or a part thereof, as the case may be. The adjective 'real' is used to indicate that such prospect is not 'illusory', 'theoretical or statistical' or 'imaginary' or 'fanciful'.

(ii) Rule 6 of Order XIII-A confers wide latitude on the court to pass a range of orders in an application for summary judgment either on the whole or part of the claim. The types of order specified in Rule 6 are illustrative and not exhaustive.

(iii) If the Court concludes that the counter party could probably succeed, as regards the whole of the claim, the application is liable to be dismissed. If the court considers the success of the counter party probable as regards a part of the claim, or, in respect of some of the reliefs claimed, but not the remainder, the application may be considered as regards the remainder.

(iv) If the court concludes that it is really possible but not probable that the counter party could succeed, a conditional order may be passed. Although Rule 7 of Order XIII-A uses the word 'possible', it does not mean statistical or theoretical possibility but real possibility.



(v) Once the applicant satisfies the requirement of

clause (a) of Rule 3 of Order XIII-A, it becomes necessary for the court to consider whether there is any other compelling reason to direct parties to record oral evidence. Since the conjunction 'and' is used between clauses 'a' and 'b' of Rule 3, the requirements should be construed as cumulative.

(vi) The obligations imposed by Rules 4 and 5 on the parties to plead their respective cases and produce all material evidence in relation thereto does not shift the burden of proof. Instead, it is a procedural device to enable the court to meaningfully consider whether the whole or part of the suit claim may be disposed of summarily.

(vii) The scope of Order XIII-A is wider than Order XII, Rule 6 CPC, which is triggered only on the basis of admissions. It is also far wider than Order VII Rule 11 CPC because the court goes well beyond the plaint and examines all the evidence placed before it. However, such application is maintainable in the limited window after summons' are served but before issues are framed.

(viii) In the ultimate analysis, Order XIII-A

facilitates fulfilment of two salient but often undervalued



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objectives of a fair and just dispute resolution system, namely, expeditious disposal and equitable and proportionate allocation of the limited resources of the public court system. It represents a paradigm shift from a blinkered trial-is-the-only-method approach to the adjudication of civil suits to a more balanced approach, which preserves the trial process wherever appropriate and necessary.

18. In this legal context, the factual setting in which this application was filed is addressed next. The main grounds on which the Applicants/Defendants contended that the Respondent/Plaintiff has no real prospect of success are the following: (i) the Applicants / Defendants are intermediaries which are protected under the safe harbour provision of Section 79 of the IT Act; (ii) the Respondent/Plaintiff has not impleaded several necessary parties; (iii) the relief of mandatory injunction entails passing of orders impacting third parties; (iv) the Trade Marks Act does not provide protection on a class-agnostic or product/service agnostic basis; (v) the Respondent/Plaintiff has an alternative remedy by way of UDRP; (vi) there are other about 654 other domain names, 20 other trademarks in India



PURVA, PURAVANKARA or PURAVANKARA PROJECTS; and (vii)

the relief, even if granted, would not be effective because there are thousands of other DNRs, who are not arrayed as parties and against whom relief is not prayed for.

19. The protection claimed under Section 79 of the IT Act is addressed first. Section 79 of the IT Act provides for conditional exemption from liability as regards an intermediary as defined in Section 2(1)(w) thereof. Section 2(1)(w) defines an intermediary as under:-

(w)"intermediary", with respect to any particular electronic records, means any person who on behalf of another person receives, stores or transmits that record or provides any service with respect to that record and includes telecom service providers, network service providers, internet service providers, web-hosting service providers, search engines, online payment sites, online-auction sites, online-market places and cyber cafes"

The Respondent/Defendant is, undoubtedly, an entity which, on behalf of other persons, receives, stores or transmits information stored electronically or digitally in relation to the provision of domain name registration services.

The expression electronic record is defined widely in the IT Act and the



respect of electronic records. The Applicants also relied on several judgments such as *Hindustan Unilever Limited* and *Invental Products* to contend that Godaddy was held to be an intermediary in those judgments, and the Respondent/Plaintiff was unable to effectively controvert this contention. By proceeding on the basis that the Applicants are intermediaries, the entitlement to exemption from liability under Section 79 should be examined. Section 79 is as under:

"79 Exemption from liability of intermediary in certain cases. -

(1) Notwithstanding anything contained in any law for the time being in force but subject to the provisions of sub-sections (2) and (3), an intermediary shall not be liable for any third party information, data, or communication link made available or hosted by him.

(2) The provisions of sub-section (1) shall apply if-

(a) the function of the intermediary is limited to providing access to a communication system over which information made available by third parties is transmitted or temporarily stored or hosted; or

(b) the intermediary does not-

(i) initiate the transmission,

(ii) select the receiver of the transmission, and

(iii) select or modify the information contained in the transmission;

(c) the intermediary observes due diligence while discharging his duties under this Act and also observes such other guidelines as the Central Government may prescribe in this behalf.

(3) The provisions of sub-section (1) shall not apply if



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(a) the intermediary has conspired or abetted or aided or induced, whether by threats or promise or otherwise in the commission of the unlawful act;

(b) upon receiving actual knowledge, or on being notified by the appropriate Government or its agency that any information, data or communication link residing in or connected to a computer resource, controlled by the intermediary is being used to commit the unlawful act, the intermediary fails to expeditiously remove or disable access to that material on that resource without vitiating the evidence in any manner."

Explanation - For the purpose of this section, the expression "third party information" means any information dealt with by an intermediary in his capacity as an intermediary."

20. Thus, undoubtedly, the exemption under Section 79 is not only contingent on the person concerned being an intermediary, it is also subject to the multiple conditions stipulated therein. For instance, the exemption is restricted to third party information and data. Under subsection 2(a) of Section 79, significantly, the exemption is limited to an intermediary whose function does not extend beyond providing access to a communication system on which third party information is transmitted or temporarily stored or hosted. On the facts of this case, the Respondent/Plaintiff asserted that the Applicants/Defendants deployed suggestion tools and thereby did not merely transmit, temporarily store or



Applicants/Defendants played an active and non-passive role in suggesting alternative domain names to users of their services. On such basis, the Respondent/Plaintiff contended that the Applicants/Defendants are not intermediaries and, in any event, are not entitled to protection under Section 79 of the IT Act. While the Applicants/Defendants admitted to the deployment of suggestion tools, the contention is that this does not deprive them of the exemption under Section 79. The Applicants/Defendants also contended that the process of suggesting alternatives is automated since it is operated by a proprietary algorithm. In a recent pronouncement, the Delhi High Court concluded in *Snapdeal Private Limited v. Godaddycom LLC and Others*, LA.5407 of 2021 in CS (Comm) 176 of 2021 (***Snapdeal***) that GoDaddy is not entitled to exemption from liability under Section 79 because it offers alternative domain names to registrants and at varying prices. At this juncture, on the basis of the documents on record, the nature of the suggestion tools, the manner in which such tools function, the role played by persons availing of the services of the Applicants/Defendants *vis-a-vis* the role played by the Applicants/Defendants in relation thereto, cannot be ascertained to the extent necessary to pronounce summary judgment on exemption from liability because such determination would, at a minimum, involve a mini-trial.



21. Notwithstanding the above conclusion, the other contentions of the Applicants/Defendants should be considered. The plea of non-joinder was raised, *inter alia*, because ICAAN, NIXI and other DNRs were not joined as parties. The grievance of the Respondent/Plaintiff is not against ICAAN, NIXI or other DNRs but against the Applicants/Defendants particularly on account of the deployment of suggestion tools. Even if there are other DNRs undertaking similar activity, while it would be open to the Respondent/Plaintiff to sue them in separate proceedings, the Respondent/Plaintiff cannot be non-suited on that account. The alleged ineffectiveness of the remedy due to non-joinder of other registrars and the like is also not a valid ground to allow this application. To put it differently, the alleged ineffectiveness of the remedy prayed for on account of the existence of other potential or real infringers is not a legitimate concern of the Applicants/Defendants herein and does not qualify as a valid defence to this action. The existence of an alternative remedy by way of UDRP is also not a ground to reject the suit because such remedy is not available against DNRs such as the Applicants herein and, in any event, is not an exclusive remedy. The alleged existence of other domain names and trademarks is an argument founded on dilution. Based on materials on record, this cannot be disposed of by a summary judgment and warrants a trial. The Applicants



party in an application for summary judgment. This contention is misconceived. The said Rules merely direct the parties to such application to place all material evidence before the court. However, the non-joinder of alleged infringers/registrants warrants consideration with specific reference to the reliefs prayed for.

22. Prayer (a) relates to alleged infringement of the Respondent/Plaintiff's registered trademarks PURVA, PURAVANKARA and PURAVANKARA PROJECTS by offering for sale the same name or any names deceptively similar thereto as domain names, websites, etc. by using suggestion tools. There are two ways in which domain names are offered for sale: first, by a registrant applying for a name which is available; and, secondly, if the name applied for is unavailable, by the DNR suggesting an available alternative. If prayer (a) is to be considered in the factual context of a specific request for registration, the registrant concerned would be a necessary party. In this case, the relief is not claimed in a concrete factual context; instead, it is in the nature of a *quia timet* action. When viewed as a *quia timet* action, there are no registrants, infringing or otherwise. Therefore, non-joinder is a non-issue. Although non-joinder becomes a non-issue, the question whether the Respondent/Plaintiff has a reasonable prospect of success in a *quia timet* action of this nature is a



distinct matter which falls for consideration. Indeed, in ***Snapdeal***, upon considering substantially similar contentions, the Delhi High Court concluded that an injunction restraining the defendants therein from offering any domain names containing the trademark Snapdeal *in futuro* cannot be granted. The finding in ***Snapdeal*** was drawn by analysing Sections 28 and 29 of the Trade Marks Act, which envisage use of the infringing mark in course of trade, and concluding that a determination that the use is infringing cannot be made in advance.

23. A *quia timet* action is founded on apprehension and subject to the plaintiff concerned establishing that the apprehension is reasonable, such an action is maintainable. Even in the statutory context of the Trade Marks Act, as long as the plaintiff establishes that the apprehension of infringement is reasonable and not without basis, in my view, a *quia timet* action is maintainable. With specific reference to the facts of this case, the Applicants/Defendants conceded that the algorithm deployed by them throws up alternatives which are similar to the domain names applied for by the registrant concerned. Given the position adopted by the Applicants/Defendants, the apprehension of infringement appears reasonable. Whether the Respondent/Plaintiff is entitled to relief is,



the registered trademarks of the Respondent/Plaintiff may be construed as well known so as to extend class-agnostic and service-agnostic protection?

(ii) Even assuming that the answer to the first question is in the negative, whether such protection may be granted against offering suggestions only where the services in respect of which the domain name is sought are identical or similar? (iii) whether the protection against apprehended infringement should be restricted to identical marks? (iv) whether deceptive similarity of a mark can be tested in a vacuum, i.e., outside a specific factual context and in the absence of the registrant concerned?

24. It was concluded earlier that the exemption from liability of the Applicants under Section 79 of the IT Act cannot be determined at this juncture and should await trial and, perhaps even expert evidence, on the manner in which the Applicants' automated suggestion tool operates. Similarly, some, if not all, of the above questions cannot be answered at this stage. Besides, since the questions are inter-related, it stands to reason that they are appropriately considered and answered in a consolidated and not piece-meal fashion. In course of discussing the law on summary judgments, after noticing both Rules 6 and 7, I had observed that wide latitude is vested in the court to pass a range of orders either in respect of the whole or part of

the claim. Indeed, it bears repetition that Rule 6, which specifies the nature



of orders that may be passed, is illustrative and not exhaustive. Therefore, subject to the caveat that the judgment and decree would not bind non-parties, if the relief claimed is limited to preventing the Applicants/Defendants from deploying suggestion tools and thereby offering for sale allegedly identical or deceptively similar domain names, it certainly cannot be concluded at this juncture that the Respondent/Plaintiff has no real prospect of success. If limited in this fashion, these conclusions would apply, albeit less vigourously, to prayer (b), which is similar but for alleged passing off.

25. Turning to the relief of mandatory injunction [prayer (c)], the Respondent/Plaintiff seeks a direction for the removal of the trademarks PURVA, PURAVANKARA and PURAVANKARA PROJECTS used separately or in combination. This relief is not founded on apprehended infringement or passing off; yet, the alleged users of such trademarks/registrants, who would be necessary parties, have not been joined in these proceedings. The Respondent/Plaintiff has also not provided any indication of its intention to implead such parties. Consequently, if the relief prayed for is granted it would gravely impact third party users who are not parties to the action. Therefore, as regards this relief, the Respondent/Plaintiff has no real prospect of succeeding in the suit as framed. The relief of damages



of Rs.1,00,00,000/- is directed only against the Applicants/Defendants herein. Being a claim for damages, the success or failure of the Respondent/Plaintiff is dependent on adducing evidence of loss on account of the adoption of suggestion tools by the Applicants/Defendants whereby names deceptively similar to the registered trademarks of the Plaintiff were offered to users.

26. In light of the above discussion and findings, the Applicants are entitled to the following order. As regards prayers (a),(b) and (d), the Respondent/Plaintiff is permitted to prosecute the suit only with regard to the alleged liability of the Applicants/Defendants on account of using suggestion tools or measures similar thereto. Prayer (c) is rejected summarily on the ground that the Respondent/Plaintiff has no real prospect of success. These conclusions would have a bearing while determining costs [prayer (e)] in course of final disposal.

Sd/-S.K.R.J.
07.06.2022

//Certified to be true copy//

Dated at Madras this the day of 2022.

COURT OFFICER(O.S.)

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