

MANU/DE/1555/2006

**Equivalent Citation:** [2006]133CompCas712(Delhi), 129(2006)DLT450, 2006(89)DRJ18, 2006(32)PTC470(Del)

**IN THE HIGH COURT OF DELHI**

CS (OS) No. 2048/2003

Decided On: 29.03.2006

Appellants: **Zee Telefilms Ltd. and Ors.****Vs.**Respondent: **Zee and Ors.****Hon'ble Judges/Coram:**

Sanjay Kishan Kaul, J.

**Counsels:**

For Appellant/Petitioner/plaintiff: Pratibha M. Singh and Shruti Kakar, Advs

For Respondents/Defendant:Nemo

**Subject: Intellectual Property Rights****Cases Referred:**

Pfizer Products, Inc. v. B.L. &amp; Co. and Ors. CS (OS) No. 1165/2001

**Case Note:**

**Intellectual Property Rights - Passing-off - Domain names - Permanent injunction - Domain names registered by defendants identical to the plaintiffs' channel names - plaintiffs were aggrieved by registration of various domain names by the defendants starting with the word 'Zee' - plaintiffs filed a suit for permanent injunction restraining passing-off in respect of domain names - plaintiff contended that the word 'Zee' was an arbitrary and fanciful word, which was adopted by the plaintiffs for all its business activities in India and abroad and, thus, it was not open for the defendants to have got the same names registered as their domain name - Held, facts set out in the plaint and the evidence produced, thus, clearly showed that the established rights of the plaintiffs in the names of the various channels were sought to be utilized by the defendants as their domain names - Decree passed in favor of the plaintiffs - Appeal disposed of**

**JUDGMENT****Sanjay Kishan Kaul, J.**

1. The plaintiffs have filed a suit for permanent injunction restraining passing off in respect of domain names Zeetv.com, Zeecinema.com, Zeeenglish.com, Zeemgm.com, Trendz.com and Zeemusic.com and acts of unfair competition, dilution, rendition of accounts, etc.

2. The plaintiff no.1 is an existing company under the Indian laws and plaintiff no.2 is existing under the laws of Mauritius while plaintiff no.3 is existing under the law of British Virgin Islands. All these companies are stated to be part and parcel of the Zee Groups of Companies. The suit has been instituted through Mr.K. Shukla in pursuance to board resolutions.

3. The plaintiffs are stated to be group companies engaged in the production of programmers/broadcasting of various channels which constitute Zee Network including the channels referred to above. The plaintiffs claim to be also the broadcaster of niche channels like Trendz (a fashion channel) and Smile TV etc. The telecast takes place all over the world.

4. plaintiff no.2 is the broadcaster of the channels while plaintiff no.3 is stated to own the trademark Zee in several other countries (including India) The mark Zee is stated to have been adopted in the year 1992 and has been used since then. The mark is stated to have listed as one of the top ten brands in India in the year 1995. The plaintiffs are aggrieved by the registration of various domain names by the defendants starting with the word 'Zee'.

5. The defendants did not put appearance despite service and were proceeded ex parte.

manupatra 6. The plaintiffs have led the evidence of Mr. Amit Bhatia, authorized representative, who has proved the authorization in pursuance to board resolution. Same was given mark A. The original resolution has been produced in court and thus the document mark A is exhibited as ExPW1/1.

7. The domain names which the defendants have got registered are identical to the plaintiffs' channel names. The plaintiffs claim to have carried out a search of the data base of the concerned registering authority and it is there from that the domain names were found registered in the name of the defendants.

8. The plaintiffs claim that the word 'Zee' is arbitrary and fanciful word which has been adopted by the plaintiffs in the year 1992 for all its business activities in India and abroad and thus it was not open for the defendants to have got the same names registered as their domain name. The object of the defendants so registering the domain name is thus to use the goodwill of the plaintiff and to claim association with the plaintiffs.

9. The applications for registration are stated to be pending in India except for Trendz which has been stated to be registered. A copy of the same was filed as mark C and the original has been produced in the court today and the same is exhibited as Ex PW1/4. It is in view of the aforesaid allegations that the plaintiffs have prayed for a decree of permanent injunction in terms of prayer clause 31(a) & (b) and a mandatory injunction to the defendants directing them to transfer the domain names as per prayer clause 31(c) of the plaint.

10. The facts set out in the plaint and the evidence produced thus clearly show the established rights of the plaintiffs in the names of the various channels are sought to be utilized by the defendants as their domain names.

11. A decree is passed in favor of the plaintiffs and against the defendants in terms of Prayer clause 31(a) to (c) of the plaint. The plaintiffs do not press prayer clause 31(d). The plaintiffs shall also be entitled to costs. Decree sheet be drawn up accordingly.

12. It is, however, observed on a perusal of the plaint that the suit is deficiently stamped in view of judgment of this Court in CS (OS) No. 1165/2001 titled 'Pfizer Products, Inc. v. B.L. & Co. and Ors' decided on 03.10.2005. Learned counsel for the plaintiff undertakes to make up the deficient of court fees within fifteen days and the and the decree-sheet be drawn up only on such court fee being paid.

13. Learned counsel for the plaintiff states that the problem which is arising in the present case on account of domain name registrations is permeating in a number of cases. The concerned entity is stated to be ICANN, located in California, USA, which oversees domain name registration.

14. India is stated to be subscribing to the Uniform Domain Name Dispute Resolution Policy (ExP1/21) and thus courts in India are courts of competent jurisdiction. Learned counsel for the plaintiff submits that a mechanism must be set in operation whereby this kind of problem does not arise and one of the solutions to the same is suggested to be a methodology to be adopted by ICANN whereby the facility is made available to the registered owners of the trademarks to register with ICANN on payment of fee with the stipulation that in case any person seeks to register a domain name consisting of the registered mark, no objection would be required to be obtained from the owner of the registered mark. A similar policy is stated to be in force in India by National Informatics Centre.

15. In my considered view it would be advisable to have such a mechanism available globally especially in view of number of litigations which are being filed in this Court on account of such registration of domain names where the defendant does not even appear before the court to contest the matter. This occurs as the defendants have no legitimate right in the mark and adopt the domain name with the motive of misleading the internet users. In view thereof it would be appropriate for the plaintiff to approach ICANN to request for such a mechanism to be placed into operation.